THE

LAW AND PRACTICE

OF

LETTERS PATENT FOR INVENTIONS

BY

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SECOND EDITION

BY

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PREFACE.

It may be safely stated that at no previous period have so many important industries and undertakings rested upon the monopoly granted by letters patent for inventions. This has not unnaturally led to a corresponding increase of the volume of patent business.

The seven years which have elapsed since the publication of the first edition of this work have been fertile in judicial decisions of importance and authority.

The original object of this work (the first edition of which was published in 1890) was to provide a complete compendium of patent law and practice, and in the preparation of this the second edition every effort has been made to further secure this result, and to render the work a guide to all matters connected with the law relating to patents for inventions.

This edition has been almost entirely the work of my friend Mr. T. M. Stevens, Barrister-at-Law, and such additional merits as it exhibits, compared with

its predecessor, which I believe to be very considerable, are almost entirely due to him.

In the preparation of this edition the old matter has been thoroughly revised, and such additions made as experience and the decisions of the Courts have rendered advisable or necessary. This has involved very considerable labour. In fact, over 120 pages have been added to the text of the work, whilst the notes to the Acts and the Appendix of Forms have also been augmented. Notwithstanding this, the volume has not been enlarged, the space for new matter having been obtained by throwing into the smaller type of the notes much of the historical information, (the existence of which is one of the characteristics of the book,) and by excluding repealed statutes and some other material which formerly appeared in the Appendices.

The chapter on *Subject-matter* has been entirely re-written. The chapters on *Specifications*, *Infringement*, and the *Action of Infringement* have been re-arranged, and considerable additions have been made; those on the *Grant*, and on the *Action for Threats* have been entirely re-written. In the Appendix will be found several interesting grants made prior to the Statute of Monopolies.

The chapter on Assignments and Licences is from the pen of Mr. D. M. Kerly, Barrister-at-Law, author of *The Law of Trade Marks*.

Mr. E. W. Hulme, Librarian of the Patent Office, has, in many matters, historical and otherwise, continued the valuable assistance which he gave in the preparation of the first edition.

LEWIS EDMUNDS.

1, Garden Court,
The Temple,
February, 1897.

PREFACE TO FIRST EDITION.

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.

* * * * * * * * *

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 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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ADDENDUM.

Rickmann v. *Thierry* was reversed in the House of Lords, and is reported in 14 R. P. C. 105. The dicta of the Lord Chancellor fully support the view enunciated at p. 33, that a patent may be granted for a product.

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 the prerogative of making grants to subjects. Such grants are in general made by *letters patent* (*littere 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 titles of honour, such as peerages and baronetcies; appointments to offices such as those of many of the ministers of the Crown and of the judges of the Superior Courts; special privileges, such as 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 to the true and first inventors thereof (*c*) for the monopoly of

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

"making, using, exercising, and vending" (*d*) new inventions. It is this last form of royal grant which it is the object of this work to discuss.

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 which obtained in regard to patents of invention before 1852 (*g*).

Constituent elements 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 affected 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.

Plan of next three chapters.

We propose, in the next chapter, to give an account of monopolies before the Statute of Monopolies, and to deal with the statute itself.

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.

(*d*) See the words of the patent, p. 667.
(*e*) See also Patents Act, 1883, s. 46.
(*f*) Or the Wafer Great Seal.
(*g*) For which see p. 110.

CHAPTER II.

EARLY HISTORY OF PATENT LAW.

SECT. I.—MONOPOLIES AND THE COMMON LAW.

Patent law did not originate with the Statute of Monopolies.

ALTHOUGH the modern law of patents depends to a very large extent upon the construction and effect of sect. 6 of the Statute of Monopolies, the idea sometimes entertained that patent law commenced with the passing of that statute is recognised by lawyers to be erroneous. The statement that our system of patent law dates from 1624 is about as true as that the feudal system was introduced to England by William the Conqueror. Borrowing an expression of a well-known historian in regard to the latter event, and applying it to the Statute of Monopolies, it may be said that the statute is a turning point and not a fresh starting point in the history of this branch of law.

Sect. 6 of the Statute of Monopolies is declaratory.

For the meaning of patentable invention the Patent Act, 1883, sect. 46, refers us back to the Statute of Monopolies, sect. 6. But it will be seen that this section itself is but declaratory of the common law, and was always so intended to be. It follows not only that the question, whether a given invention is patentable or not, will depend to a large extent on the common law, but that to obtain a correct idea of the meaning of sect. 6 of the Statute of Monopolies, the common law as to patents must be known.

A Crown prerogative.

The grant of letters patent conferring a monopoly is a power within the prerogative of the Crown (now, however, regulated as to procedure by the provisions of the Patents Act, 1883). At one time the Crown possessed very many powers which are now exercised by Parliament, and the prerogative may be regarded as such of the original legislative and administrative functions of the Crown as have not been surrendered to or filched by the Great Council of the nation. The regulation of trade was a power to which the Crown clung for some time after the bulk of its former prerogatives had passed away, and as late as the reigns of Edward III. and Richard II. the King claimed and

The Crown and trade.

exercised the extraordinary powers which were claimed to a certain extent successfully by James I. in *Bates' case*. The right to interfere generally with trade might seem to involve the right to give special privileges to individual traders, and, in fact, *temp*

Early cases.

Edward III. (*a*), it was judicially said that arts and sciences 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*).

Early statutes.

Parliament jealously watched the doings of the Crown in this respect, and on more than one occasion we find statutes passed making for liberty of trade. See (*e.g.*) 9 Edw. III. st. 1, c. 1; 25 Edw. III. st. 4, c. 2; 31 Edw. III. c. 10; 2 Rich. II. st. 1, c. 1; 12 Hen. VII. c. 6.

A check on the improper granting of monopolies was not imposed by statute alone. These patent grants were made in virtue of the prerogative, but the prerogative itself could be used only in accordance with law and for the general good: "All prerogatives must be for the advantage and good of the people, otherwise they ought not to be allowed by law" (*c*).

Prerogative is a part of the Common Law.

The prerogative, other than that given by statute, is itself a part of the common law, and cannot be inconsistent with the fundamental rules of the common law (*d*); the prerogative powers are as capable of ascertainment and definition by the Courts as any other part of the unwritten law of the land (*e*).

This is expressed thus by Lord Kenyon: "The prerogatives of the King are not given for the personal advantage of the King,

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

(*b*) Moore, 675; *Darcy* v. *Allin*. Mr. E. W. Hulme states that the alchemical commission was of the time of Hen. VI. and not of Edw. III., as stated in the authorities. See an excellent paper in 12 Law Quarterly Review, p. 141.

(*c*) Bacon Abrig. Prerog., p. 38 (ed. 1832).

(*d*) Viner, Prerog. c. 8.

(*e*) This is not quite in accordance with Blackstone's view of "prerogative," which he refers to as being "out of the ordinary course of the common law." But see Anson on The Crown, Chapter I., sect. 1.

but they are allowed to exist because they are beneficial to the subject. They are therefore to be guarded on account of the public; they are not to be extended farther than the laws and constitution of the country have allowed them; but within these bounds they are entitled to every protection" (*f*).

Grants in restraint of trade are bad.

One important common law principle is that contracts or grants in restraint of trade, if contrary to the public advantage, are invalid. This rule is familiar in its application to the general law of contract. It is equally applicable to grants: "And indeed the freedom of trade and labour is of such consequence, that as no person can by his own act totally deliver himself of this privilege, much less can he be restrained by the King's letters patent" (*g*). It seemed clear, then, that whilst the King could at common law grant monopolies, he must exercise his power for the general good, and therefore could make grant of monopolies only when the good to be obtained from them overbalanced the evil arising from a restraint of trade.

In practice two classes of monopolies were known.

Monopolies in practice fell into one of two classes: (1) such as were granted in return for the introduction or invention of a new trade or new article (*h*); (2) and such as were granted in restraint of trade in articles and arts already known. The former class (provided that the monopoly was granted only for a limited time) was defensible as an encouragement and reward for ingenuity, work, or expense incurred producing an addition to the material wealth of the nation. The latter was an unalloyed evil, contrary to the common law, and not worthy of being made an exception to the rule that a grant in restraint of trade is invalid.

The use made by the Crown of its powers shows a corresponding division. Whilst, on the one hand, those who improved trade by the invention or introduction of something beneficial were granted monopolies; on the other hand courtiers, those attached to the Crown service, and those willing to replenish the

(*f*) *Rorke* v. *Dayrell*, 1791, 4 T. R. at p. 410. A comparison of the history of the King's claim to grant monopolies and of his claim to the dispensing power would not be altogether fanciful. The common law recognised to some extent the King's right to both, and his right to both eventually was much modified in consequence of abuses.

(*g*) Bacon Abrig. Prerog., F. 4; see also Chitty on the Prerogative, 177.

(*h*) At one time the monopolies were probably rewards for introducing from abroad new manufactures at the request of the King; later they were granted as rewards at the prayer of the importer or inventor. See an article in the Law Quarterly Review, April, 1896, by E. W. Hulme.

royal treasury, received grants of an objectionable nature. These latter were a source of annoyance, which in the years of Queen Elizabeth caused the historical skirmish between that monarch and the Commons. Such monopolies from time immemorial have been considered illegal. In fact, to apply for them was held to be an offence at common law (*i*) of a nature similar to that of engrossing (*k*), though Hawkins says he cannot find a modern instance in which any such application has been punished as a crime (*l*).

Remedy of illegal monopolies.

As in theory the King can do no wrong, and as in fact there is no easy practicable way of attacking him if he should transgress by the grant of illegal monopolies, the method adopted to meet the evil was to revoke the grant on the pretence that the Crown had been deceived. (See 5 Co. 94a, and for a modern illustration, *Eastern Archipelago* v. *Reg.* (*m*).)

The following cases on patents at common law illustrate the above, and also show what were the requisites of a good monopoly prior to the Statute of James I.

Pechey's Case. 50 Edw. III.

In the reign of Edward III. one Pechey obtained the sole right to import sweet wine into London; at a parliament held 50 Edw. III. this grant was adjudged void; Coke says that Pechey was punished (*n*).

Hastings' Case.

Hastings' Case (*post*, p. 883, cited in Noy's report of *Darcy* v. *Allin*). A patent was granted to Hastings that in consideration that he brought in the skill of making frisadoes as they were made at Haarlem, being not used in England, he should have the sole trade of the making and selling the same for divers years, and infringers were to be liable to a fine. Hastings proceeded for infringement against certain persons, but was defeated upon the ground that his process was not a novelty in England.

Matthey's Case.

Matthey's Case (*nn*) is also quoted in Noy 178. Here the patent was vitiated because the knives which constituted its subject-matter did not differ appreciably from some in use prior to Matthey's patent. The case is especially good as an illustration, as it was admitted that Matthey had "laboured very greatly" on the work of introducing his knives from abroad.

Humphrey's patent.

Humphrey's Patent (see Noy's report of *Darcy* v. *Allin*) was

(*i*) Coke, 3 Inst. c. 85.
(*k*) Hawkins C. C., Bk. i. c. 29.
(*l*) P. 625.
(*m*) (1853) 2 E. & B. 857; 23 L. J. Q. B. 82.
(*n*) 3 Inst. 85.
(*nn*) Properly *Mathew's Patent.* See the patent set out, *post*, 885.

for the sole and only use of a sieve or instrument for melting lead. On proceedings for infringement the Court stated that the question was whether it was newly invented by him, "whereby he might have the sole privilege, or else used before at Mendiff, in the west country, which if it were there before used, then the Court were of opinion that he should not have the sole use thereof."

The Case of Monopolies, *Darcy* v. *Allin*.

The Case of Monopolies—Darcy v. *Allin* (*o*) is the great authority relative to common law patents. The grant was for a monopoly of making and selling playing cards for a period of twelve years, extended to a further period of twenty-one years after the expiration of the original term. The patent stated that "the Queen, perceiving that divers subjects of able bodies, who might go to plough, did employ themselves in the art of making cards," did grant the monopoly. The Court held the grant to be bad as (i) "that it is a monopoly and against the common law," and (ii) that it is against divers Acts of Parliament (*e.g.* 9 Edw. III. c. 1 and 2). The Queen was deceived; she thought the grant would be for the public good; in fact, it was lost. Thus was it stated.

In Coke's report we read: "There are three inseparable incidents to every monopoly against the commonwealth; 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" (*p*).

That the "monopoly" struck at in *Darcy* v. *Allin* was of the general kind, and not one limited to a new invention produced or imported by the monopolist, is evident from the above. But during the time of Coke the term "monopoly" was almost always used in the obnoxious sense. In Noy's report, however, appears this very important passage:—

"Now therefore I will show you how the Judges have heretofore

(*o*) 44 Eliz.; 11 Co. Rep. 84; Noy 173.

(*p*) The history of the glass patents (Jac. I.) illustrates the truth of these statements.

Requisites of a good patent at common law.

allowed of monopoly patents; which is that 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 was never used before, and that for the good of the realm, that 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."

Monopolies not always illegal at common law.

These cases are important, as they show conclusively that a grant of monopoly was not always illegal at common law. The decisions just cited are in each case against the validity of the particular grant in question, but in none was it said that monopolies were invariably invalid (*q*). Expressions are sometimes used which will convey this idea. Thus Coke says that monopolies are void as against the common law of the kingdom; but he defines a monopoly to be "An institution, or allowance by the King by his grant, commission, or otherwise to any person or persons, bodies politique or corporate, of and for the sole buying, selling, making, working or using any thing, whereby any person or persons, bodies politique or corporate, are sought to be restrained of any freedom or liberty that they had before, or hindered in their lawful trade" (3 Inst. c. 85).

Illegal monopolies.

This definition—which is followed by Hawkins and Blackstone—refers only to the class of monopoly which interfered with trades already known, and does not comprise those granted as an encouragement to inventors and importers of new things from abroad (*r*).

Summary in Bacon's Abridg.

The law is thus summed up in Bacon Abrig. Prerog., F. 4: "The King's grant of a monopoly as of the sole buying, selling, working, making, or using of any commodity is not only void of the common law, but the persons procuring such grants are said to be punished by fine and imprisonment. . . . But notwithstanding this, it is agreed, that the King may for a reasonable time grant to a person the sole use of any art invented by him; and this it seems the King might do at common law, and is therefore a matter excepted out of the Statute of Monopolies, 21 Jac. I. c. 3." (See also Chitty on the Prerogative, 177.)

(*q*) *Case of the Clothworkers of Ipswich* (1615), Cod. 252; Rol. 4; *Mitchell* v. *Reynolds* (1713), 10 Mod. 130.

(*r*) The definition given by Comyns is more comprehensive: "A monopoly is when the sale of any merchandise or commodity is restrained to one or a certain number" (Digest, Trade D. 4).

If contrary to this, it is stated by any authority that monopolies are always void as against the common law, the term "monopoly" must, in such statement, be taken in the limited sense it acquired during the struggle against illegal monopolies in the time of Elizabeth and James I.

From the *Case of Monopolies* (Noy 178) may be deduced the requisites of a good patent at common law. They are these :— Summary of requisites of a good patent.

(1) It must not extend to the sole right to sell articles in common use, nor to the exercise of a known occupation.

(2) It is necessary that the grantee should be at least the introducer of the invention within the realm.

(3) The term must be for some limited period, such as might be sufficient for the instruction of others. In the glass patent cases (*infra*) Coke stated that twenty-one years was too long.

(4) The subject-matter must be such as, in the result, led to a new trade, or manufacture, or engine tending to the furtherance of a new trade.

(5) The subject-matter must possess the incident of novelty within the realm.

(6) The patent must not be prejudicial to the community; this involved that it must have the incident of utility.

No specification was required, but a clause in the letters patent was sometimes inserted requiring the patentee to take apprentices and teach them the new trade.

These requisites may usefully be compared with the requirements of sect. 6 of the Statute of Monopolies. This fixed the time during which the monopoly should last at fourteen years; in other respects it is obvious that the section was intended merely to reproduce and not to do away with the common law.

Some important patents granted before 1624 are to be found set out at length in Webster's Patent Cases—viz., the smalt patents, p. 9; the iron patent, p. 14; and the glass patents, p. 17. Old patents.

The smalt patents were three in number and were granted in 1606, 1609, and 1618. Though they all refer to the same subject-matter the times limited were twenty-one years, thirty-one years, and thirty-one years respectively. The patent recites that the smalt had never before been made in England, and provided that if the grant should be prejudicial to the commonwealth it should be revoked. In fact, the first grant was revoked and the grant of The smalt patents.

1610 made in its place, though whether for the benefit of the community may be open to doubt. But it will be observed that the Crown recognised novelty as a requisite of a patent, and granted the monopoly only for a limited time. It is also worthy of note that though monopolies were the subject of parliamentary attention, no point against the Crown seems to have been made with regard to this patent.

The iron patent.

The *Iron Patent* was granted to Lord Dudley in 1622. It recites the novelty of the invention, its utility, and the advisability of encouraging inventors. It was expressed to be for fourteen years, unless revoked within that time as being inconvenient to the commonwealth; and it was provided that this patent should not be in derogation of any former grant relating to the making of iron or iron works. This is a very fair specimen of a good patent granted according to the rules of common law.

The glass patents.

Mansell's Glass Patents were the subject of much complaint in the House of Commons. Their effect was to raise the price of glass, and to lower the quality. (See report of Sir Edward Coke quoted 1 Web. P. C. 27.) The result of the agitation was a new patent, which recited that the former patents had become void in law as being hurtful to the commonwealth, revoked them, and granted a monopoly for fifteen years, with important modifications in favour of freedom of trade.

But though the glass patents were attacked it was not suggested that the power to grant monopolies of a proper kind did not reside in the Crown. In fact, when the patent was modified it was allowed to be good, and in the Statute of Monopolies it is expressly declared that this patent as well as those dealing with smalt and the Dudley iron process should not be prejudiced by any of the provisions of that Act. (See sects. 13 and 14.)

Effect of the Statute of Monopolies.

In the result the law as declared by statute and the common law are the same. A patent valid at common law will not be affected by the statute; a patent invalid by the common law will be invalid under the statute. A change of expression of no real importance is really the sole new result effected by the statute. Before 1624 monopolies fell into two classes; those in the one class were void, those in the other were valid. The statute makes *all* monopolies void, but declares the latter class an exception to the rule. Hereafter we shall hear little of the word "monopoly" as applied to valid grants; the words "patent" or

"patent for invention" will take its place. But in dealing with the subject-matter of patent rights, the Statute of Monopolies must be read in aid of the common law as understood at the date of the passing of the statute.

Sect. II.—The Statute of Monopolies.

Protests against monopolies, *tempo* Elizabeth.

Under Elizabeth and James I. the abuses of the power of granting monopolies aroused the attention of the House of Commons, and in the time of Elizabeth (*s*) a petition was presented complaining of the patents, but she still persisted in defending the monopolists. Accordingly, a Bill was introduced into the Lower House, abolishing all the obnoxious grants. A memorable debate took place. Eventually the Queen sent for the Speaker, and advised him to acquaint the House that she would immediately cancel the most grievous of these patents (*t*). The following extract from the Queen's answer shows how clearly she understood the limits to her prerogative: "I never put 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

(*s*) A passage from Hume (386) shows the condition of affairs under Elizabeth. He says: "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, ashen bones, train oil, lists of cloth, potashes, aniseeds, vinegar, sea coals, steel, aqua vitæ, brushes, pots, bottles, saltpetre, lead, accidences, oil, calamine stone, oil of blubber, glasses, paper, earth, 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 things 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. . . . The patentees of saltpetre, having power of entering every house, and of committing what havoc they pleased in stables, cellars, or wheresoever they suspected saltpetre might be gathered, commonly extorted money from those who desired to free themselves from their 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 and enact."

(*t*) See Hume, 386. Also Cecil's speech, Parl. Hist. 1601, i. 934; Lord John Russell's History of English Government, p. 477.

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" (*u*).

Accession of James I.

Matters did not improve on the accession of James I. (*x*). 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) (*y*).

Alum patents.

Book published by James I.

Other monopolies were granted, and Parliament again protested against the abuse of the royal prerogative. In 1610 the King published a book (*z*), 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.

Gold and silver lace patents.

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 King stated that he was ignorant of the abuse of his patent, and by royal proclamation he revoked it (*a*).

In 1624 (*b*) advantage was taken of the good feeling then

(*u*) Cobbet's Parl. Hist. of England, i. 923. But it seems the Queen did not revoke all the monopolies complained against: Rymer, xvi. 540; Carte, iii. 702; Lodge, iii. 159; Hallam, Const. Hist., i. 357, n.

(*x*) However, Professor S. R. Gardiner (History of England from 1603—1642, vol. iv. p. 1 *et seq.*) says 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.

(*y*) Parl. Rep., &c. 1829, Appendix, 167. See Statute of Monopolies, sect. 11, *infra*, p. 751.

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

(*a*) Parl. Rep. 1829, p. 167.

(*b*) According to the law as it then stood, every Act related back to the first day of the session, unless otherwise provided. Hence the Statute of Monopolies passed in 1624 dates back to 1623.

existing between James and his Parliament (*c*), and of the declaration to which he had committed himself in 1610 (*d*), to secure the enactment of the Statute of Monopolies (21 Jac. I. c. 3) (*e*).

The Statute of Monopolies.

This famous statute (*e*) 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, 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 use or execution."

Monopolies against which the Act was directed.

The monopolies against which this Act was directed are those referred to *ante*, p. 8, and defined by Coke as being against the common law and the commonwealth, *i.e.*, unlawful monopolies. In prohibiting all such grants of monopolies, the statute was

(*c*) Web. Let. Pat. 7.
(*d*) Coke, 3 Inst. 182.
(*e*) See Appendix, p. 745, where the whole statute is given. The repealed sections are printed in smaller type.

merely declaratory of the common law, already clearly established by the decisions in *Pechey's case* (*f*), in *Hasting's case* (*g*), and in *Darcy* v. *Allin* (*h*).

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) (*i*), 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."

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" (*k*). The Court of Star Chamber also had considered all infringements of patents and grants of the Crown as contempts of royal authority, and on that principle had supported any patent the Crown thought fit to grant (*l*).

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 (*m*), 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.

Letters patent for inventions depend upon the provisions of

(*f*) 50 Edw. III.; 3 Inst. 181.
(*g*) *Supra*, p. 6.
(*h*) (1602) 11 Co. 84; Noy 178; 1 W. P. C. 1.
(*i*) Coke, 3 Inst. 183.
(*k*) 3 Inst. 182, 183.
(*l*) Web. Let. Pat., p. 42. n. (*y*).
(*m*) 3 Inst. 187.

Sect. 6. Proviso in favour of inventors.

sect. 6 (*n*), 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 hereafter to be made, but that the same shall be of 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

(*n*) Section 5 relates to patents granted for periods not exceeding twenty-one years and in force at the time of the statute being passed. With these exceptions, the words of sects. 5 and 6 are the same. See Coke, 3 Inst. 181.

(*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.*

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," 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 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 wherefore 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 term of fourteen years.

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.

Statute of Monopolies, sects. 7—14.

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 sects. 7—14.

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

Judges.

Sect. 8 excepted all warrants under Privy Seal made by his

(*r*) *Ibid.* 184.

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.

Sect. 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.

Sect. 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.

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

Sect. 12 saved all privileges heretofore enjoyed by the hoastmen of the town of Newcastle-upon-Tyne for selling, carrying, and shipping any pit coals out of the river Tyne. It also saved commissions for the licensing of taverns. Newcastle-on-Tyne, &c.

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

Sect. 14 saved letters patent granted to Abraham Baker, concerning the making of smalt, dated 16th Feb., 16 Jas. I. (t); 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. (u). Baker's smalt patent. Lord Dudley's patent.

(s) Mansell's patent is printed in full in 1 Web. P. C. at p. 17. See observations upon, and proceedings in connection with, this patent in 1 Web. P. C. 3, n. and 32, n. (q). And see *ante*, p. 10.

(t) See this patent printed in full, and observations thereon, in 1 Web. P. C., p. 12, and p. 32, n. (r). And see *ante*, p. 9.

(u) 1 Web. P. C. 14, and p. 33, n. (r); *ante*, p. 10.

CHAPTER III.

SUBJECT-MATTER FOR LETTERS PATENT.

In order that an invention may be subject for letters patent, it is necessary that it should be (1) a manner of manufacture; (2) new; (3) useful; and (4) more or less ingenious. It is proposed to deal with these matters in the above-named order.

Sect. I.—"Any Manner of Manufacture."

Meaning 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.

Any manner of "manufacture" has not the same meaning as "invention."

It is sometimes stated that "any manner of manufacture" is almost synonymous with "invention." But this is scarcely so. There are many inventions which cannot be covered by the words "any manner of manufacture." Such, for instance, are the inventions of the mind which find outward expression in literary works, in artistic designs, in pictures and sculpture. They may, perhaps, be protected under other statutes, but the Statute of Monopolies does not deal with them. A new game of cards, a new method of balancing accounts, a mathematical problem and its solution, an improved means of calculation, each of these may be in its way an excellent invention, but the Statute of Monopolies affords no opportunity for granting any special right in relation to any of them.

The subject-matter of a patent is not an invention unless the invention is an art or manufacture. "The arts and manufactures of the country constitute the class of object" (*a*). It therefore becomes necessary to consider what is a manufacture. In *Hornblower* v. *Boulton* (*b*), Lord Kenyon stated that a manufacture is something made by the hands of man. This seems fairly wide, but yet is, perhaps, hardly wide enough to include everything which is accepted as any manner of manufacture within the meaning of the Statute of Monopolies. As will be shown hereafter, a patent may be granted for a process or method. The word "manufacture" may mean the art or practice of making, or it may mean anything made by art (*c*), and the words "working and making," which are used with the word "manufacture" in the Statute of Monopolies, show that the meaning of manufacture in that statute includes the former meaning. Lord Kenyon's definition, therefore, should be extended so as to include not only what is made by the hands of man, but also any method which results in the production of an article made by the hands of man, otherwise it will not include everything which the section of the Statute of Monopolies is intended to embrace.

What is a manufacture?

It is necessary that the invention should result in an article which is industrial and vendible (*d*). Abbott, C. J., in *Rex* v. *Wheeler* (*e*), said: "Now the word 'manufacture' has been generally understood to denote either a thing made which is useful for its own sake, and vendible as such, 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, or it may perhaps (*f*) extend also to a new process to be carried on by known implements or elements, acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or of a better and more useful kind."

An industrial article must be the result.

In *Boulton* v. *Bull* (*g*), Heath, J., says: "Such manufactures are reducible to two classes. The first class includes machinery,

The subject should be vendible.

(*a*) Webster on Subject-Matter, p. 8.
(*b*) (1799) 8 T. R. 99.
(*c*) Hindmarch, p. 81.
(*d*) *Boulton* v. *Bull* (1795), 2 H. Bl. 482.
(*e*) (1819) 2 B. & Ald. at p. 349.
(*f*) There is no doubt now. See *post*, p. 24.
(*g*) (1795) 2 H. Bl. 482.

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. That which is the subject of a patent ought to be specified, and it ought to be that which is vendible, otherwise it cannot be a manufacture" (*h*).

It seems consonant both to the intention of the statute and to the wording, that the word "manufacture" should imply something vendible. The object of the statute is to allow grants of monopolies to inventive persons, including importers, whose ability or industry favour the trade of the country; the statute provides that this may be done provided, *inter alia*, that the monopoly does not raise the prices of commodities at home, and is not hurtful to trade.

Patents have been granted where no new thing produced.

There are cases, however, where patents have been granted when no thing is produced, and when the subject-matter is not a process which results in the genesis of a new article. *Hartley's Patent* (*i*) was for the application of plates of metal and wire to buildings and ships, securing the joints by doubling in or otherwise, and so making the buildings or ships fireproof. The patent was mentioned without disapproval by Eyre, C. J., in *Boulton* v. *Bull* (*k*), and Mr. Webster thinks that the invention was a manufacture (*l*). There seems, however, to be some doubt whether this was indeed a good patent.

In *Forsyth* v. *Riviere* (*m*) (application of known detonating powder to the discharge of known firearms), and *Electric Telegraph Co.* v. *Brett* (*n*) (method of giving duplicate signals at intermediate stations), patents were held good though the immediate result of the invention was neither the production of a new thing nor of a process resulting in the production of a thing. Applications of old things to a new use, accompanied by the exercise of inventive power, are often patentable (*o*) though there be no production of a new thing. But in every

(*h*) And see per Tindal, C. J., in *Cornish* v. *Keene*, 1 W. P. C. 517.
(*i*) See 1 W. P. C. 54 *et seq.*
(*k*) (1795) 2 H. Bl. 463.
(*l*) 1 Pat. Cases, 56, n.
(*m*) (1819) 1 W. P. C. 97.
(*n*) (1851) 20 L. J. C. P. 123; 10 C. B. 838.
(*o*) See *post*, p. 42.

case the invention must refer to and be applicable to a tangible thing. A disembodied idea is not patentable.

The rule now always followed is laid down thus in *Crane* v. *Price* (*p*),—viz., if the result produced is either a new article or a better article, or a cheaper article than that produced before, the invention is one which may be the subject-matter of a patent.

Rule in *Crane* v. *Price*.

A patent is not granted for the article itself. The monopoly is for the art of making the thing. Thus, if a patent is granted for the manufacture of a certain kind of chair, the patent does not give an exclusive right to a chair made in accordance with the invention, and no action of detinue would lie for the recovery of any such chairs; the right obtained would be the right to make the chair. And no one would infringe the patent merely by sitting down on the chair (*q*).

Patent not granted for the thing, but for the art.

A mere principle, *e.g.*, 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" (*r*).

Principles.

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 produce effects in any art, trade, mystery, or manual occupation is undoubtedly patentable (*s*). In the case of *Otto* v. *Linford* (*t*), the late Master of the Rolls, Sir George Jessel, put the distinction,

A principle applied can.

(*p*) (1852) 1 W. P. C. at p. 409.

(*q*) Hindmarch, pp. 92, 93.

(*r*) Hindmarch, p. 90.

(*s*) *Boulton* v. *Bull* (1795), 2 H. Bl. 463; *Hornblower* v. *Boulton* (1799), 8 T. R. 95, in which, however, Grose, J., does not seem very decided as to the principle; *Hogg* v. *Pratt* (1837), 1 Web. P. C. 484; *The Household Co.* v. *Neilson* (1883), 1 Web. P. C. 673, 683; 9 C. & F. 788; *Electric Telegraph Co.* v. *Brett* (1851), 20 L. J. C. P. 123; 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; *Goddard* v. *Lyon* (1884), 11 R. P. C. at p. 358.

(*t*) (1881), 46 L. T. 39; cp. *Badische Anilin* v. *Levinstein* (1885), 2 R. P. C. 91; 24 Ch. Div. at p. 163; 52 L. J. Ch. 704.

which is here referred to, with his accustomed clearness: "If you have a new principle 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. One of the strongest illustrations that I know of is the patent for the hot blast in the iron manufacture (*u*), 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" (*x*).

Minter v. *Wells* (*y*) 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 nonsuit 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 said that a *discovery* cannot be the subject of letters patent (*z*). In this statement "discovery" is used synonymously with "principle." For instance, the persons who "discovered" abstract phenomena of electricity, or magnetism; the expansive

(*u*) The case here referred to is *Neilson* v. *Harford* (1841), 8 M. & W. 806; 1 W. P. C. 331.

(*x*) (1881) 46 L. T. 39; cp. *Badische Anilin* v. *Levinstein* (1885), 2 R. P. C. 91; 4 R. P. C. 449; 24 Ch. Div. 156; 29 Ch. Div. 325.

(*y*) (1834) 1 C. M. & R. 505; 1 Web. P. C. 134.

(*z*) See per Lindley, L. J., in *Lane Fox* v. *Kensington Electric Light Co.* (1892), L. R. 3 Ch. 424; 9 R. P. C. at p. 416.

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 "discoveries," though any mode of applying them would *cæteris paribus* be patentable. So a discovery that resistance causes light is not good subject-matter; but if the principle be embodied as Edison embodied it in the electric lamp the position is changed.

Patent for every means of producing a thing.

It has been pointed out that a claim to every method of making an article would amount to a claim for a principle, and would be bad. Assuming that the patent is for a process this would undoubtedly be so. And, it is submitted, the claim for a totally new product might be good, and yet prove no exception to this rule (*a*).

In the case of *Neilson* v. *Harford* (*b*) the patent was for a method of applying for iron smelting purposes a hot blast instead of a cold blast to the furnace. In the course of argument counsel said: "We do claim every vessel and every shape of vessel, closed vessel, in which air can be heated between the blowing apparatus and the furnace." Baron Alderson replied: "Then I think that is a principle, if you claim every shape. . . . If you claim every shape you claim a principle. There is no difference between a principle to be carried into effect in any way you will, and claiming the principle itself" (*c*).

A recent example of a claim held to be for a principle is to be found in *Patterson* v. *Gaslight and Coke Co.* (*d*). The plaintiff claimed, "The employment of sulphide of calcium in separate purifiers as a means of purifying coal gas from sulphur existing in other forms than in that of sulphuretted hydrogen." The Court of Appeal held this bad, as being nothing but the enunciation of a chemical truth, that pure sulphides will absorb the sulphur compounds.

The idea may be an important consideration.

But though an idea cannot be patented, yet when the apparatus for carrying out the idea is patented the idea itself must be taken into account in considering the validity of the patent (*e*).

(*a*) See post, under "Products," p. 29.

(*b*) (1841) 1 W. P. C. 295, 331; 8 M. & W. 806; 11 L. J. Ex. 20.

(*c*) This dictum has been repeatedly acted upon, and has been affirmed by the Court of Appeal in more than one case. See, e.g., *Automatic Weighing Machine Co.* v. *Knight* (1889), 6 R. P. C. at p. 309, and *Nobel's Explosive Co.* v. *Anderson* (1894), 11 R. P. C. 519. But *quære* whether the application of it has not been pushed too far. See note in 1 W. P. C. 355.

(*d*) (1876) 2 Ch. Div. 812; 45 L. J. Ch. 843.

(*e*) Per Lord Herschell in *Goddard* v. *Lyon*, 11 R. P. C. at p. 358.

The class of inventions which may be included in the term "any manner of manufacture" can best be illustrated under the following heads: (1) Processes; (2) Products; (3) Combinations; (4) Additions and Improvements; (5) Applications and Analogous User.

(A) *Processes.*

Meaning of the word.

A process consists of operations pursued in regular sequence. It may be mechanical, *e.g.*, printing; or chemical, *e.g.*, soap-making; or both, *e.g.*, paper-making. There was at one time a doubt whether a patent could be obtained for a process. The words of the Statute of Monopolies are: "The sole working or making of any new manner of manufacture." Now this may mean that the substance produced by the act of manufacturing is to be protected, or it may mean that the actual method of manufacturing is the subject-matter of the monopoly, or it may refer to both the one and the other. A patent cannot be granted save for that which produces a vendible article, but the monopoly may relate to the article or to the method of producing the article. In *Ralston* v. *Smith* (*f*) Lord Westbury said: "By a large interpretation given to the word 'manufacture,' it not only comprehends productions, but it also comprehends the means of producing them. Therefore, in addition to the thing produced, it will comprehend a new machine, or a new combination of machinery. It will comprehend a new process or an improvement of an old process." This states the modern view of the law, which coincides with that held throughout the greater period of time which has elapsed since patents for inventions were first granted.

At one time doubtful if a process was patentable.

The modern view.

Another view.

In *Hornblower* v. *Boulton* (*g*) Lord Kenyon said that the word "manufacture" meant "something made by the hands of man." If the word be limited to this meaning, a patent for a process would be excluded from the exception to the Statute of Monopolies. It would be possible to have a patent for the result of the process if the result were new, but not for the process itself. Though the decision in the case does not lend countenance to this limited meaning of the word "manufacture," it may be, perhaps, that some passages of the judgment delivered do. (See per Grose, J., at pp. 102, 103. See also the curious passage

(*f*) (1865) 11 H. L. C. 223; 35 L. J. C. P. 49.

(*g*) (1799) 8 T. R. 95.

in which Lawrence, J., states that the word "method" may mean "engine" (p. 106).)

In *Rex* v. *Wheeler* (*h*) Abbott, C. J. (in a passage already quoted), 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—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. Or it may perhaps extend also to a new process to be carried on by known implements, or elements, acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper and more expeditious manner, or of a better and more useful kind."

In *Hill* v. *Thompson* (*i*) Lord Eldon used language which though not exactly in point, tends to show that he thought a patent for a process might be valid; in *Gibson* v. *Brand* (*k*) Tindal, C. J., whilst inclining (it may be said) to allow that a process could be within sect. 6 of the Statute of Monopolies, refused to decide what he considered to be unnecessary to put an end to the litigation.

Such would seem to be the authorities upon which it was at one time argued that a process is not a "manner of new manufacture" within the saving clause of the Statute of Monopolies. We may now declare any such argument to be unsound. An examination of the above authorities will show that in no case was there a definite judicial condemnation of process patents. Nothing but implied objections and expressed doubts can be extracted from the judgments.

Reasons for saying that processes are patentable.

On the other hand, reason and authority are to be found in favour of the view that the words "any manner of new manufacture" must be interpreted to include processes. The statute provides that a patent for the *working or making* of any manner of new manufacture shall be allowable. These terms are appropriate to both senses of the word "manufacture," to the verb and to the noun.

(*h*) (1819) 2 B. & Ald. 345.
(*i*) (1817) 3 Mer. 622, 626; 1 W. P. C. 35.
(*k*) 1841) 4 M. & G. 179; 1 W. P. C. 631; 11 L. J. C. P. 177, 179.

Common law and processes.

Moreover, the section in question merely retained the right of the Crown to grant monopolies of the nature of those permitted at common law (see before). The words of the section therefore may be interpreted in the light of patents for inventions granted about the time of the passing of the statute. Now before the year 1624 we read of patents for processes, some of which were upset, some upheld, but in no case was there any successful objection that the subject-matter was invalid as not being a manufacture. See the case of the knives (Matthey's patent), quoted in Noy's report of *Darcy* v. *Allin*; the smalt case (3 Jac. I.); the Dudley iron patent (19 Jac. I.); the glass patent (21 Jac. I.). All these were patents for processes. (See *ante*, p. 6.)

In 1777 a patent was granted to one Hartley by a special Act (17 Geo. III. c. 6), but there was a proviso reserving a right of objection if the invention was not a new manufacture within the meaning of the statute of James. The subject-matter of the invention was the application of plates of metal for the prevention of fire. In the next-mentioned case, Eyre, C. J., referring to this patent, treated it as valid, and as being an example of a patentable method or process.

Boulton v. *Bull* (*l*) was decided about four years before *Hornblower* v. *Boulton* referred to above. The actual decision was not satisfactory, as the Court was evenly divided in opinion. But Eyre, C. J., said: "When the effect produced is no substance or composition of things, the patent can only be for the mechanism, if new mechanism is used, or for the process, if it be a new method of operating, with or without old mechanism, by which the effect is produced. . . . In the list of patents with which I have been furnished, there are several for new methods of manufacturing articles in common use, where the sole merit and the whole effect produced are the saving of time and expense, and thereof lowering the price of the article and introducing it into more general use. Now I think these methods may be said to be new manufactures."

Hall v. *Jarris* (*m*) was decided in 1822, and the patent was upheld, although the subject-matter of the invention was certainly a process. See also *Morgan* v. *Seaward* (*n*).

(*l*) (1795) 2 H. Bl. 463.
(*m*) (1822) 1 W. P. C. 100.
(*n*) (1837) 2 M. & W. 544; 1 W.P.C. 187.

Crane v. Price.

The great case of *Crane* v. *Price* (*o*)—the anthracite and hot blast patent—finally settled all doubts as to the validity of a patent for a process. 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, to the smelting or manufacture of iron from ironstone, mine, or ore. In delivering the judgment of the Court, Tindal, C. J., 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."

Since the time of *Crane* v. *Price* there has been no serious suggestion that a patent cannot be obtained for a process. On the other hand, many such patents have been upheld. Thus, in *Both* v. *Kennard* (*p*), an application was made for a patent for an improvement in the manufacture of gas—viz., for a method of 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 (*q*).

Later cases of processes.

In 1847 Pollock, C. B., upheld a patent for a process, but the explanation he gave for so doing is worthy of note. He said, in the case of *Stevens* v. *Keating* (*r*): "All patents must be for a manufacture. The real invention may be not so much for the

(*o*) (1842) 4 M. & G. 580; 1 W. P. C. 83; 12 L. J. C. P. 81. Few cases have had a greater effect on patent law than this. It may be cited as the turning-point in the matter of "analogous uses;" indirectly, perhaps, it has given us the modern rule relating to "want of invention." It is important in connection with the validity of combination patents, and it establishes the validity of patent for processes. Nevertheless the correctness of the actual decision has not escaped criticism: see *Murray* v. *Clayton* (1872), L. R. 7 Ch. 570; *Rushton* v. *Crawley* (1870), 10 Eq. 522; *Bamlett* v. *Picksley*, Griff. 40.

(*p*) (1856) 1 H. & N. 527; 26 L. J. Ex. 23.

(*q*) Want of novelty, however, was fatal to this patent, 2 H. & N. 54.

(*r*) 2 W. P. C. at p. 182; 19 L. J. Ex. 57.

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 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."

The decision at which the Chief Baron arrived is that which has always been given save in the earlier years of the present century, but the language used is perhaps hardly bold enough to suit the circumstances. It implies that a process alone is patentable if it results in a thing or substance. But this is not the law. Two examples referred to above will suffice to show this, viz.:—

Is a process not resulting in a thing patentable?

In *Forsyth* v. *Riviere* (*s*), the application of a known detonating powder to the discharge of known kinds of firearms, 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 (*t*).

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

See also *Wallington* v. *Dale* (*x*). In none of the cases just cited was there any new product.

An omission of a step may make a process patentable.

It should be observed that omission of a step in a process may be good subject-matter for a patent (*Booth* v. *Kennard* (*y*)); this follows from the fact that a patent may be granted for an improvement in a process (*Electric Telegraph Co.* v. *Brett*, *sup.*); and a combination of processes may be a manufacture within the terms of the Statute of Monopolies (*Booth* v. *Kennard*, *sup.*).

Chemical processes.

Chemical processes have been sometimes placed in a position by themselves, and their peculiarities are considered to a certain extent in the case of *Badische Anilin* v. *Levinstein* (*z*). There is no doubt but that a chemical process is patentable.

(*s*) (1819) 1 W. P. C. 97; 1 Carp. 401.
(*t*) 1 W. P. C. 54.
(*u*) (1851) 10 C. B. 826; 20 L. J. C. P. 123.
(*x*) (1853) 7 Ex. 888; 23 L. J. Ex. 49.
(*y*) (1856) 26 L. J. Ex. 23; 1 H. & N. 527.
(*z*) (1883—1889) 24 Ch. Div. 156; 29 Ch. Div. 366; 52 L. J. Ch. 704; and 12 App. Ca. 710.

Summary.

It seems, then, from the above cases that patents for processes have always been regarded as valid; but that from about the year 1799 to 1840 doubts were expressed as to the correctness of the law. Possibly this doubt was due to the influence of Lord Kenyon, not a judge who favoured patentees (*a*); but so far as can be gathered from the *reported* cases, even during this period of doubt the general inclination was to support such patents.

(B) *Products.*

Can a product be good subject-matter?

Whether a product can of itself be subject-matter of a patent is a question which cannot yet be confidently answered. There are dicta in recent cases in the Court of Appeal which point to the conclusion that products cannot be patented apart from the method of producing them. One judge has stated that a claim for a product would be bad, another has denied this; others, *again, have reserved their opinion.* Text writers have hitherto not given any definite opinion. Under these circumstances it is necessary to consider the whole matter *de novo*.

Meaning of "product."

"Product" means "anything that is produced whether as the result of generation, growth, labour, or thought, or by the operation of involuntary causes" (*b*). Clearly a product is not always patentable. If a product is a manufactured article it should fall within the meaning of the words "any manner of new manufacture," unless the word "manufacture" is used merely in a verbal sense—viz., "any manner of manufactur*ing*." But in this sense, subject-matter would be limited to methods or processes, a limitation which it is submitted it is too late to place on the word "manufacture;" indeed it was at one time a matter of doubt whether methods and processes were within sect. 6 of the Statute of Monopolies at all (see *Processes*, *ante*, p. 24). Such being the case there seems to be nothing in the wording of the statute to exclude such products as fall within the class of things manufactured. To take an example. A celebrated chemist by dint of experimental work produces a new element, thallium, the existence of which he had discovered by means of the spectrum; if this statute is not confined to processes, is not thallium a new manufacture within its meaning? Taking the word "manufacture" in its literal signification,

Examples of products which it is submitted are patentable.

(*a*) See his remarks in *Hornblower v. Boulton* (1799), 8 T. R. 98.

(*b*) Webster's Dictionary.

thallium is a manufacture, and would seem to be good subject-matter for letters patent. It may be urged that the chemist does not make thallium; he merely separates it out from its compounds. Assuming this argument to be sound, it would not apply to the manufacture of a new organic compound, say a new chemical dye. This can be made synthetically, and seems in every respect a manufacture.

Assuming, then, that "any manner of new manufacture" is not confined to methods and processes (and it is worthy of note that it was not until the reign of Anne that a specification of the method employed in a new manufacture was required), there seems no reason to exclude products from sect. 6 of the Statute of Monopolies.

Effect of declaring a product to be subject-matter.

The effect of including it, however, must not be overlooked. If a product be subject-matter, it may be claimed separately, and the patent right would, in such case, be infringed by anybody who made the product by any method whatsoever. If I make a new thing and claim it as a product, and the claim be good, my neighbour may not make that same thing although there be no similarity between his method and mine. But it is a firm rule of patent law that a discovery or a principle cannot be the subject-matter of a patent, though a principle together with the method of putting it in practice may be. And it may be said (though, we think, incorrectly) that to claim a product simply, without any special claim to a method of putting it in practice, is, in effect, to claim a principle. If this be so, products *per se* are not subject-matter.

A claim for every method of making is a claim for a principle.

In *Neilson* v. *Harford* (*c*) counsel said: "We do claim every vessel and every shape of vessel, closed vessels in which air can be heated between the blowing apparatus and the furnace." Then said Baron Alderson: "Then I think that is a principle, if you claim every shape. . . . There is no difference between a principle to be carried into effect in any way you will and claiming the principle itself. You must detail some specific mode of doing it." This statement was made in the course of the argument, but the law as laid down therein has constantly received approval and is beyond question. It is also unquestionable law that a discovery of a natural law cannot be patented.

From this the deduction is made that a product cannot be

(*c*) (1841) 1 W. P. C. at p. 355; 8 M. & W. 806.

subject-matter apart from the means of making it, because so to hold would be to allow the patenting of a principle. Before stating the reason why this should not be accepted the authorities may be dealt with.

In *Ralston* v. *Smith* (*d*) Lord Westbury said that the word "manufacture" would comprehend productions as also the means of producing them. In *Badische Anilin und Soda Fabrik* v. *Levinstein* (*e*) Pearson, J., said: "But there is another principle . . . and that is this, that where a patent is taken out for a process for arriving at a known result (I mean a result known before the patent is taken out for the process *simpliciter*), any other person may take out a patent for another process, or may use another process without taking out a patent, without any infringement of the process first taken out. But 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." The learned judge then refers to *Jupe* v. *Pratt* (*f*) and to *Household Coal Co.* v. *Neilson* (*g*). Finally he quotes Lord Westbury's well-known dictum in *Curtis* v. *Platt* (*h*),

Dictum of Pearson, J., in the *Badische case*.

In *Vorwerk* v. *Evans* (*i*) the question of a product as subject-matter came more directly in discussion. A new waistband was in question. Kekewich, J., said that a claim for the waistband apart from the method of wearing it would make the patent bad. Cotton, L.J. (holding that in fact the waistband was not separately claimed), said: "I decide that, not on the ground that there could not be a patent for a waistband if that was claimed as a new thing, provided that it was new, because it would be going against principle, I think, to say that there could be no claim for such a thing if it were entitled to be protected by a patent." After referring to *Thomson* v. *American Braided Wire Co.* (*k*), he continued: "I think it would be contrary to principle, because if there is a new thing produced, and that is useful and complies with other requirements, then, in my

The Court was divided in opinion in *Vorwerk* v. *Evans*, 1890.

(*d*) (1865) 35 L. J. C. P. 49; 11 H. L. C. 223.
(*e*) (1883) 24 Ch. Div. at p. 171; 52 L. J. Ch. 704.
(*f*) (1836), 1 W. P. C. 145.
(*g*) (1843) 1 W. P. C. 673.
(*h*) (1864) Good. P. C. 102; 11 L. T. N. S. 245.
(*i*) (1890) 7 R. P. C. 265.
(*k*) (1889) 6 R. P. C. 518.

opinion, there could be a thoroughly good patent taken out for that." Bowen, L. J., added: "It is not necessary to adopt, nor do I adopt the view of Mr. Justice Kekewich, that you cannot have a patent for a new article or for a product independent of the mode by which it is produced. I doubt very much whether that is so, both on the true construction of the Statute of Monopolies, and on authority, if authority were needed." Fry, L. J., expressed no opinion.

So far the cases are all one way. But in the *Automatic Weighing Machine Co.* v. *Knight* (*l*), decided in the year before the case last quoted, the Court held that a claim of every combination of coin-receiving mechanism and weighing mechanism, would be a claim for a principle, and unpatentable. Cotton, L. J., said: "Where there is a principle first applied in a machine capable of carrying it into effect, the Court looks more narrowly at those who carry out the same principle, and say they do it by a different mode, and looks to see whether in effect, although the mode is not exactly the same, it is only a colourable difference." Lindley, L. J., quotes with approval the dictum of Alderson, B., in *Neilson* v. *Harford* (*sup.*). This case may go somewhat against the view that a product may be subject-matter, but the next decision is the most serious one against it.

Nobel Explosive Co.'s case.

Nobel Explosive Co. v. *Anderson* (*m*) was heard in the Court of Appeal in 1894. Plaintiff claimed the manufacture from "nitro-glycerine and soluble nitro-cellulose of a horny or semi-horny explosive," &c. Defendant made a substance of very similar properties out of nitro-glycerine and insoluble nitro-cellulose. The Court decided that there was no infringement. It could truly be said that even if the plaintiff did claim the product, defendant had not manufactured it, but had made something altogether different; be this as it may, the plaintiff distinctly claimed the substance as made in a particular specified way, and it was on this fact that the decision was based (*n*). Therefore, but for the dicta of the judges composing the Court, this case would not militate against the view that a product can be patented alone. Lord Esher, however, referring to the passage of the judgment of Pearson, J., in the *Badische case* quoted above, said that the rule laid down there is too large, and equally he condemned Baron

(*l*) 6 R. P. C. 297.
(*m*) 11 R. P. C. 519; in the House of Lords, 12 R. P. C. 164.

(*n*) The same remark applies to *Lancashire Explosive Co.* v. *Roburite Co.* (1896), see 13 R. P. C. 429.

Alderson's dictum in *Jupe* v. *Pratt*; but he approves the same Judge's opinion expressed in *Neilson* v. *Harford*, and adds that, if a new invention (*quære*, does he mean substance?) is claimed, there is no infringement though the same result be produced, unless the defendant has colourably imitated the invention. Kay, L. J., also differs from Pearson, J., and adopts the language of Cotton, L. J., in the *Automatic case*, above quoted, and adds: "I take the law to be clearly settled that, that if the result of the patent is entirely new, and one method of arriving at that result is described on the face of the patent, the patentee cannot say 'that enables me to treat every other method of arriving at that result as an infringement,' but the question is in every case whether the method which he says is an infringement, is so like the method which he has himself described, as to be substantially the same, or in other words, only colourably different." And later on his Lordship says: "When a patentee has invented a new product, or a new result, and describes one mode of making it . . . the Court looks, in a case of that kind, more narrowly at those who carry out the same principle, and if they do it by a different method." The learned Judge then came to a conclusion that defendant, whilst obtaining the same result as the patentee, did so by means of something different to that invented by the patentee; he made a different product (*o*).

Opinion of Kay, L. J.

It is noteworthy that special emphasis was laid on the fact that a special method of producing was claimed, a method not infringed by the defendant. Nothing is said which directly contradicts the proposition that a product may be patented. But it must be admitted that the dicta tend to support the proposition that a patent for a new product would not protect the patentee against every mode of making that product, or, in other words, that a product alone cannot be subject-matter of a patent.

Nevertheless it is submitted that a product may be subject-matter of a patent. In the *Automatic case*, the subject-matter was merely a means of putting into practice a principle, and if so, admittedly not patentable; hence the decision and the dictum are both in accordance with received rules. It will also be observed that Cotton, L. J., who delivered the leading judgment, has since expressed a decided

Semble. A product may be patented.

(*o*) In the House of Lords the point now under consideration was not touched upon.

opinion that a product may be good subject-matter (*Vorwerk* v. *Evans, supra*). *Nobel's case* is more difficult to deal with. But it is submitted that the dicta, if they amount to a statement, that a product cannot be patented, go too far.

They all rest upon the view enunciated by Alderson, B., that a claim for every method of doing a thing is a claim to a principle. But the claim under consideration in *Neilson* v. *Harford*, in which case Alderson, B., stated this opinion, was not a claim to a product. Whilst it will be admitted that every means of carrying out a principle cannot be patented, it is a very different thing to say that a product, independently of the way in which it is made, cannot be subject-matter. A claim involving every means of utilising a speculative discovery would be bad, it would amount to a claim for a principle, and a principle is not a manufacture. But a claim to a product, though involving the right to prevent others making the product by any method, is a claim to a manufacture, to an article which the public require and which is vendible, and is not a claim to every method of making that product, and would seem to be good subject-matter for a patent. This is consistent with the statement in *Neilson* v. *Harford*, and with all the cases and dicta, save perhaps, with the dicta in *Nobel's case*. And inasmuch as those dicta are founded on Baron Alderson's view of the law, they are of less weight so far as they refer to a point not within the ambit of Baron Alderson's remarks. In view of this, and of the opinion of Cotton and Bowen, L. JJ., in *Vorwerk* v. *Evans*, it is submitted that the law allows a patent for a product which consists of a vendible article (*p*).

The following case is peculiar and worthy of observation:—In 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 oxidating just in sufficient quantity; that is, not too much, so as 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

(*p*) See also *Edison* v. *Holland* (1889), 6 R. P. C. 243, and *Thomson* v. *American Braided Wire Co.* (1889), 6 R. P. C. 518; *Taffé* v. *Richardson* (1894), 11 R. P. C. 261.

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" (*q*).

(C) *Combinations.*

Classification of patentable inventions.

Definition of combination.

It may be said generally that every invention is either a combination, or the result of a combination. The term "combination," 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 (omitting processes which have been separately dealt with) may be divided roughly into four classes:—

New compounds.

1. New compounds resulting from the chemical combination of two or more substances, *e.g.*, aniline dyes or nitro-glycerine.

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

(*q*) *Muntz* v. *Foster*, 2 W. P. C. 96 *et seq.*

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" (*r*).

Mechanical union of materials.

3. A mechanical union of two or more particles—*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 it is submitted the product itself, if new and useful, might be claimed.

4. Machines (*s*).

A combination which is new, useful, and shows a sufficient amount of invention is good subject-matter for a patent although each principle, process, or material part in it is old (*t*). Such an invention comes under the words of Tindal, C. J., in *Crane* v. *Price* (*u*): "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-matter of a patent." Whether the combination in that case was in fact a new manufacture has been doubted, but the principle upon which the decision was formed has not been questioned (*x*).

The criterion for a patentable combination given in *Crane* v. *Price*.

(*r*) Imray on "Combination" (Transactions, I. P. A. i. 135). This is a very interesting paper, from which much useful information may be obtained.

(*s*) See "On Combinations as Subjects of Patents Claims," by J. Imray, in Transactions, I. P. A., vol. i. p. 135. 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.

(*t*) *Crane* v. *Price* (1840–42), per Tindal, C. J., 1 Web. P. C. at p. 406; *Cannington* v. *Nuttall* (1871), L. R. 5 H. L. 205; 40 L. J. Ch. 731; *Automatic Weighing Machine Co.* v. *Knight* (1889), 6 R. P. C. 297.

(*u*) 1 W. P. C. 408; (1892) 1 W. P. C. 393; 4 M. & G. 580; 12 L. J. C. P. 31.

(*x*) *Murray* v. *Clayton* (1872), 7 Ch. 570, 584; *Bamlett* v. *Picksley* (1873), Griff. 40, 43.

Many decisions and dicta could be quoted showing that a combination might be the subject-matter of a patent. In *Boulton* v. *Bull* (*y*), Buller, J., said: "Mechanical and chemical discoveries all come within the description of manufactures; and it is no objection to either of them that the articles of which they are composed were known and were in use before, provided the compound article, which is the subject of the invention, is new." In *Huddart* v. *Grimshaw* (*z*), Lord Ellenborough said: "I suppose it will not now be disputed that a new combination of old materials, so as to produce a new effect, may be the subject-matter of a patent." In *Brunton* v. *Hawkes* (*a*), the Court stated that a machine, each part of which was in use before, but which as a combination was new, is good subject-matter for a patent. And to come to more recent times: in *Lister* v. *Leather* (*b*), Lord Campbell, C. J., said: "A patent for a combination is not a claim that each part thereof is new. On the contrary each part may be old, and yet a new and useful combination of such old parts may be valid, as has been often decided." In *Murray* v. *Clayton* (*c*), the Court of Appeal decided that where a machine, for which a patent had been granted, was shown to produce work more expeditiously, more economically, and of a better quality than any previous machine, the patent could not be invalidated on the ground that the machine was formed of the mere arrangement of elementary mechanical materials, producing results of the same nature as those previously accomplished by other mechanical arrangements (*d*).

Cases on combinations on the subject-matter of patents.

Where the use of soap and water in a felting process and the use of rollers were both old, it was decided that a patent for the application of soap and water in combination with rollers was good subject-matter (*e*).

In another case, a patent was granted for improvements in pavement lights. The inventor used a well-known form of prism to direct the light, and made his pavement light itself in an old way; but it was held that the combination was good subject-matter (*f*).

The Pavement Light case.

(*y*) (1795) 2 H. Bl. 463.
(*z*) (1803) Dav. P. C. 267; 1 W. P. C. 85.
(*a*) (1821) 4 B. & Ald. 550.
(*b*) (1858) 8 E. & B. 1004; 27 L. J. Q. B. 295.
(*c*) (1872) 7 Ch. 570.
(*d*) Cf. *Hill* v. *Thompson* (1817), 1 W. P. C. at p. 237; 3 Mer. 622; *Thomson* v. *American Braided Wire Co.* (1889), 6 R. P. C. 518, 528. See also *Cornish* v. *Keene* (1837), 1 W. P. C. at p. 517; 3 Bing. N. C. 570; 16 L. J. C. P. 225; *Hayward* v. *Hamilton* (1881), Griff. P. C. 115; *Morcley* v. *Victoria Rubber Co.* (1887), 4 R. P. C. 241.
(*e*) *Allen* v. *Rawson* (1845), 1 C. B. 551.
(*f*) *Hayward* v. *Hamilton* (1881), Griff. 115.

In *Boyd* v. *Horrocks* (*g*), an invention was held good subject-matter, as being a new method of adapting in a practical and useful form something well known by itself with something equally well known by itself, but so as in the combination to make something new and useful.

A patentable combination must produce a new and useful result.

But a patentee cannot, by merely calling a thing a combination, make it a combination sufficient to be subject-matter. A combination in point of law must be a combination producing a new and useful result (*h*).

(D) *Improvements and Additions.*

Improvements are patentable.

At one time it was doubted whether a patent could be validly granted for an addition or improvement to an already known process, machine, &c. Assuming that the improvement is, in fact, a distinct invention compared with the original one, and is otherwise fit subject-matter for a patent, it seems difficult to see why a good patent for it should not be granted. And inasmuch as nearly every invention is, when carefully looked into, but an improvement upon other things already known, public policy requires that improvements should, as such, be regarded as within the exceptions to the Statute of Monopolies. And such is now the law, notwithstanding a decision quoted with evident approval by no less an authority than Coke.

Decision in *Bircot's case* not followed.

In *Bircot's case* (*i*) it was resolved, that "if the substance was *in esse* before, and a new addition thereunto, though that addition make the former more profitable, yet is it not a new manufacture in law." And it was said, that "that was to put but a new button to an old coat, and it is much easier to add than to invent" (see Coke, 3 Inst. 184).

Whether this decision was right on the facts, we have no materials for judging; but so far as it attempts to lay down a rule, it has been overruled. In 1795, in the case of *Boulton* v. *Bull* (*k*), Buller, J., said: "That a patent for 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

Boulton v. *Bull.*

(*g*) (1888) 5 R. P. C. at p. 578. The case was reversed on another ground, 6 R. P. C. 152.

(*h*) *Bamlett* v. *Picksley* (1875) Griff. 40, 44. And see *Newsum* v. *Mann* (1890), 7 R. P. C. 307.

(*i*) Ex. Ch. Pasch. 15 Eliz. 3 Inst. 184.

(*k*) *Boulton* v. *Bull* (1795), 2 H. Bl. 489.

Exchequer Chamber. What were the particular facts of that case we are not informed, 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 ater 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. *Bransom*, which was tried at the sittings after Easter Term, 1776, the patent was for making eyelet-holes or 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, that 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 machine too."

Morris v. *Bransom.*

In *Hornblower* v. *Boulton* (*l*), Grose, J., refers to the same subject, and says that "Lord Coke's opinion, therefore, seems to have been formed without due consideration, and modern experience shows that it is not well founded."

(*l*) (1799) 8 T. R. at p. 104.

This view, it may be noted, was foreshadowed by Buller, J. in *The King* v. *Arkwright* (*m*). And since the beginning of the present century any doubt as to the validity of patents for new and useful improvements has quite vanished. In *Ex parte Fox* (*n*), Lord Eldon decided that the fact that the subject-matter was an addition to or improvement of an invention already patented was no ground for refusing a patent for the improvement.

A patent for an improvement is not necessarily in derogation of a prior grant.

It might be argued that, as no patent is valid which is in derogation of a grant already made to another, therefore a patent for an improvement on a prior invention, the patent for which is still in force, must be bad. But this is not so. The second patent is not in derogation of the former one, because as long as the former one subsists, the patentee of the improvement is debarred from using his rights in infringement of the prior patentee's rights. In *Ex parte Fox* (*o*), Lord Eldon said: "If the petitioners have invented certain improvements upon an engine for which a patent has been granted, and their improvements could not be used without the original engine, at the end of fourteen years the petitioners could make use of a patent taken out upon their improvements; though, before that period expired, they would have no right to make use of the other's substratum" (*p*).

Amount of improvement necessary.

The amount of improvement is in some respect an important consideration, but a slight improvement may be the subject-matter of a patent. "It is sufficient if it is an improvement at all," said Alderson, B., in *Morgan* v. *Seaward* (*q*); but this (in modern times) must be taken the limitation that there must be the requisite amount of ingenuity in the improvement; of course the improvement must have the qualities of novelty and utility.

Omission of a step in a process may bear improvement of a patentable nature.

The omission of a step in a process, or of a portion of a machine, may be a very valuable improvement. In *Russell* v. *Cowley* (*r*) the Court of Exchequer decided that an invention to manufacture tubes by welding them without the use of a maundril was sufficiently good subject-matter to enable the patent to be supported. In *Arnold* v. *Bradbury* (*s*) Lord Hatherley said that if an inventor "produced a machine, and dispenses

(*m*) (1785) 1 Web. P. C. at p. 71.
(*n*) (1812) 1 Ves. & B. 67; 1 W. P. C. 431.
(*o*) (1812) 1 Ves. & B. 67; 1 W. P. C. 431.
(*p*) And see per Tindal, C. J., in *Crane* v. *Price* (1842), 4 M. & G. 580; 12 L. J. C. P. 81; 1 W. P. C. 393; *Fox* v. *Dellestable* (1866), 15 W. R. 194, and see also *Wenham Gas Co.* v. *Champion Gas Co.* (1892), 9 R. P. C. 49, which is to the same effect.
(*q*) (1836) 1 W. P. C. 170.
(*r*) (1835) 1 W. P. C. 463; 1 C. M. & R. 864.
(*s*) (1871) 6 Ch. 706, 714.

with a process which is avowed to be injurious, I cannot, in the absence of evidence, take on myself to say that that would not be subject-matter of a patent." His Lordship meant, in the absence of evidence relating to anticipations (*t*).

Mere change of size may be an improvement entitling the inventor to a patent. Such was the case in *Edison and Swan Co.* v. *Woodhouse* (*u*), an action for the 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 combined with great durability. It was held by Fry and Bowen, L. JJ. (Cotton, L. J., on some points, dissenting), that the subject-matter of the plaintiffs' patent was good.

Edison v. *Woodhouse.*

In *Wright* v. *Hitchcock* (*x*) an action for the infringement of a patent for improvements in the method of manufacturing frills, ruffles, and such like things, and the machinery or apparatus employed therein, it was proved that until the invention in question had been discovered and had been patented, articles such as frills, ruffs, etc., had been invariably 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 that they could be kept permanently in their place. The plaintiff's invention was admitted to be novel, and to produce the result more cheaply and conveniently than the method previously known. It was held that the improvement sufficed to make the invention good subject-matter for letters patent.

In *Herrburger* v. *Squire* (*y*) it was held by Fry, L. J., that the

(*t*) See also *Wallington* v. *Dale* (1852), 7 Ex. 888; 23 L. J. Ex. 49.

(*u*) (1887) 4 R. P. C. 79, 92. And see *Moss* v. *Malings* (1886), 3 R. P. C. 373.

(*x*) (1870) L. R. 5 Ex. 37; 39 L. J. Ex. 97.

(*y*) (1889) 6 R. P. C. 194.

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, *United Horsenail Co.* v. *Swedish Horsenail Co.* (*z*).

In the course of the argument, viz., *Vickers* v. *Siddell* (*a*), Lord Herschell said that there might be a patent for an improved mechanical equivalent for an old thing.

Cases of improvements.

Amongst cases in which additions have been supported may be mentioned, *Lister* v. *Leather* (*b*) (in the course of which Lord Campbell said that the assertion that all patents for improvements on existing patents must be void, is obviously untenable); *Ralston* v. *Smith* (*c*) where it was said that the word "manufacture" comprehends an improvement on an old process; and *Electric Telegraph Co.* v. *Brett* (*d*). See also *Foxwell* v. *Bostock* (*e*), a leading case on the way to shape a specification of invention relating to an improvement.

(E) *Application of Old Things to New Uses.*

This part of the law is inextricably mixed up with "amount of invention," and is best considered under that head. In *Losh* v. *Hague* (*ee*), Lord Abinger said that an application of a well-known thing to an exactly analogous operation was not good subject-matter. The following is the present condition of patent law. The application of an old invention to a new purpose is not patentable unless there is some novelty in the method of using it as distinguished from novelty of purpose (*f*), unless the new application lies so much out of the track of the former use as not naturally immediately to suggest itself to the mind of a person turning his thoughts to the subject (*g*). But a patent for a new use of a known contrivance is good, if the discovery of the new use

(*z*) (1889) 6 R. P. C. 1.
(*a*) (1890) 7 R. P. C. at p. 303; 15 App. Cas. 496.
(*b*) (1857) 8 E. & B. 1004.
(*c*) (1865) 11 H. L. C. 223; 35 L. J. C. P. 49.
(*d*) (1851) 20 L. J. C. P. 123; 10 C. B. 838.
(*e*) (1864) 4 De G. J. & S. 298; 12 W. R. 723.
(*ee*) 1 W. P. C. at p. 208.
(*f*) *Brook* v. *Aston* (1859) per Campbell, C. J., 8 E. & B. at p. 485; 27 L. J. Q. B. 145; *Lane-Fox* v. *Kensington and Knightsbridge Electric Lighting Co.* (1892), 9 R. P. C. 413, 416; L. R. 3 Ch. 424.
(*g*) *Penn* v. *Bibby*, 1866, L. R. 2 Ch. 127, per Lord Chelmsford; 36 L. J. Ch. 455. Cp. *Harwood* v. *G. N. Ry. Co.* (1860–65), per Cockburn, C. J., 2 B. & S. 208; 29 L. J. Q. B. 193. 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.

involves practical difficulties which the patentee has been the first to see and overcome by some ingenuity of his own (*h*).

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 (*i*).

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 (*k*).

Again, *Bush* v. *Fox* (*l*) was an action for the infringement of a patent for improvements in the means of, and in the apparatus for, building and working under water, the invention consisting in the use of a caisson or hollow cylinder, so constructed that the workpeople might be supplied with compressed air; 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 the two 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 Railway Co.* (*m*), a patent for the application of "fishes," 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. This case is dealt with in detail, *post*, p. 81.

(*h*) Lindley, L. J., in *Gadd* v. *Mayor of Manchester* (1892), 9 R. P. C. at p. 525; *Lane Fox* v. *Kensington, &c., Electric Lighting Co.* (*supra*).

(*i*) (1863) 32 Beav. 570; cp. *Parkes* v. *Stevens* (1869), L. R. 8 Eq. 358; 38 L. J. Ch. 627; affirmed on appeal, L. R. 5 Ch. 36; *Hushton* v. *Crawley* (1870), L. R. 10 Eq. 522.

(*k*) *Reg.* v. *Cutler* (1847), 14 Q. B. 372, n.; Macr. P. C. 124; *Slazenger* v. *Feltham* (1889), 6 R. P. C. 130; *Cole* v. *Saqui* (1889), 6 R. P. C. 41; reversing decision of Kekewich, J. (1888), 5 R. P. C. 489. Webster styles this a "double use." See Web. on Subject-matter, pp. 10, 11.

(*l*) (1852–56) Macr. P. C. 164—166, 178; 35 L. J. Ex. 251.

(*m*) (1860) 2 B. & S. 194; 11 H. L. C. 654; 35 L. J. Q. B. 27. 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; 31 L. J. C. P. 255.

In *Ormson* v. *Clarke* (*n*), 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 (*o*), 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 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 (*p*). In *Thomson* v. *Batty* (*q*), 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.

Material variation of element of combination.

In *Edison and Swan Co.* v. *Woodhouse* (*r*), an action for the infringement of patents for improvements in electric lamps and in the method of manufacturing the same, the plaintiffs' second

(*n*) (1862, 1863) 13 C. B. 339; 14 C. B. N. S. 490; 32 L. J. C. & S. 291. Cp. *Williams* v. *Nye* (1890), 7 R. P. C. 62.

(*o*) *Jordan* v. *Moore* (1866), L. R. 1 C. P. 624; 35 L. J. C. P. 268. Cp. *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 R. P. C. 503; *Longbottom* v. *Shaw* (1888), *ib.* 497; 6 R. P. C. 510; 8 R. P. C. 333; L. R. 43 Ch. D. 46; *Tickelpenny* v. *Army and Navy Co-operative Society* (1888), 5 R. P. C. 405.

(*p*) *Siddell* v. *Vickers* (1888), 5 R. P. C. 430.

(*q*) (1889) 6 R. P. C. 84.

(*r*) (1887) 4 R. P. C. 79. Cp. *Moss* v. *Malings* (1886), per North, J., 3 R. P. C. at pp. 378, 379; 33 Ch. Div. 603.

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., in some respects, dissenting), that the subject-matter of the plaintiffs' patent was good.

Immaterial variations of element of combination.

In *Rowcliffe* v. *Longford Wire Co.* (*s*), 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.

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

Sect. II.—Novelty.

1. General.

Novelty of subject-matter.

Consideration grant.

"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

(*s*) (1887) 4 R. P. C. 281.

(*u*) *United Horsenail Co.* v. *Swedish Horsenail Co.* (1889), 6 R. P. C. 1.

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" (*x*). This is true whether the patentee believes that his invention is novel or otherwise.

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 (*y*).

The law before Statute of Monopolies.

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 (*z*), is distinctly recognised by the language of that statute, and has uniformly been held by the Courts of Law ever since.

Degree of novelty.

It is difficult 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. Still, it may be

General principle.

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 (*a*), in language approved of and adopted by Lord Blackburn (*b*), "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

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

(*y*) Cp. Hindmarch, p. 115; also *Hill* v. *Thompson* (1818), 2 B. Moo. 457; 8 Taunt. 401; 1 Web. P. C. 249; *Brunton* v. *Hawke* (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), 2 W. P. C. 39; 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 R. P. C. 132; *Pether* v. *Shaw* (1893), 10 R. P. C. 293.

(*z*) *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.

(*a*) Page 33.

(*b*) *Patterson* v. *The Gas Light and Coke Co.* (1875), 3 App. Cas. at p. 244; 47 L. J. Ch. 402. See *infra*, as to publication at international and industrial exhibitions, 79; also as to applications under International Convention, see p. 533.

possessing everything that he could give." This is true whether the alleged invention has been used in public or not (*c*).

"True and first invention" not the same in use as "novelty."

A patent can be granted only to the true and first inventor. But it does not follow that because the true and first inventor applies for a patent, that he will not be met with difficulty in the matter of want of novelty. The two points,—Is the invention new? and, Is the applicant for the patent the first and true inventor?—are not variations of the same issue. A discovery may be new within the meaning of the patent law, yet it may be that the applicant is not the first inventor; or on the other hand the first inventor may have applied for the patent, but the manufacture may have lost its novelty owing to communication of the invention prior to the making an application for a patent (*d*). The claim to be the first and true inventor is not to be attacked under a defence which alleges merely want of novelty (*e*); and the converse holds good. We shall, therefore, not deal in this place with the law relative to the true and first inventor; this will be considered hereafter (*f*).

Division of the subject.

There are two main points to consider in connection with novelty—(1) the amount of disclosure which will vitiate an invention claimed to be new; (2) the method of disclosure. Under the former head we must deal with anticipation, and the state of public knowledge at the time of the alleged invention; under the latter head we deal with publication and user.

2. Anticipation.

Anticipation, (in the strict sense of the term) and the state of public knowledge, are akin but not identical. An alleged invention which is invalid for want of novelty may be to all intents and purposes the same as one which is already known, in which case the latter is an anticipation of the former. Or it may be that, notwithstanding nothing can be pointed out as an anticipation, the information at the disposal of those familiar with the particular class of manufacture covered by the invention, will suffice to enable them to make the alleged invention without further experiment or guidance; novelty would

(*c*) There is an exception to this in the case of certain foreign inventions introduced in the realm before the application is made for a British patent, see sect. 103, *post*, p. 533.

(*d*) *Cornish* v. *Keene* (1835), 1 W. P. C. 501, 507.

(*e*) *Thomson* v. *Macdonald* (1891), 8 R. P. C. 5.

(*f*) *Post*, p. 263.

in such case be impossible, owing to the state of knowledge. The line is often difficult to draw, and the ground upon which a patent is declared invalid is rendered the more difficult of accurate statement owing to a confusion which, it is suggested, is caused by attempting to differentiate novelty and want of invention (*g*). But anticipation and the state of knowledge must be, as far as possible, kept distinct, and as objections to a patent must be pleaded separately (*h*) and be treated differently in drafting particulars of objections (*i*).

Old because "anticipated," and old because of the "state of knowledge" to be pleaded separately.

Identity of purpose, the test.

If identity be proved, of course the patent is invalid; nor is it necessary that an anticipation should be exactly similar to the alleged invention in order to invalidate the patent for want of novelty. And in dealing with these matters, identity of name or shape is not of importance; identity of purpose and of the thing itself is alone to be considered (*k*). Where an invention differs from another only in the substitution of a known equivalent, there is no novelty in the latter of the two. The mere substitution of a hinge for a slide would not render the machine with the hinge a novelty (*l*).

Discovery of an equivalent not known to be such.

But if the equivalent is not known to be an equivalent at the date of the alleged anticipation, the mere fact that the two discoveries differ only in this equivalent will not avoid the novelty of the latter. This is especially to be borne in mind in chemical cases (*m*).

Infringement and novelty not to be tried always by the same tests.

It is said loosely that if an invention would, if used, infringe a former patent, the patent for that invention is bad for want of novelty. This is true to a certain extent, but the statement as it stands is too sweeping (*n*). A patent the use of which is an infringement of a prior patent may itself contain sufficient novelty to be supported. The novelty may be an improvement, but one inseparable in use from the original machine, on which it is an improvement; the novel invention would then be patentable,

(*g*) See the next section, pp. 80 *et seq.*

(*h*) *Phillips* v. *Ivel Cycle Co., Ltd.* (1890), 7 R. P. C. 77. In this case a sketch almost exactly similar to the machine, the subject-matter of the patent, was referred to as an anticipation, the Judge saying that it would be incorrect to use it as part of public knowledge.

(*i*) *Holliday* v. *Heppenstall* (1889), 41 Ch. Div. 109; 58 L. J. Ch. 829; 6 R. P. C. 320.

(*k*) *Re Cutler's Patent* (1839), 1 W. P. C. 418, 427.

(*l*) *Fletcher* v. *Arden* (1888), 5 R. P. C. 46, 54; *Wilson* v. *Union Oil Mills Co.* (1892), 9 R. P. C. 57; and see *Heath* v. *Unwin* (1845), 2 W. P. C. at pp. 227, 241.

(*m*) Pearson, J., in *Badische, &c., Co.* v. *Levinstein* (1883), 24 Ch. Div. at p. 171; 52 L. J. Ch. 704; following *Unwin* v. *Heath* (1850), 2 W. P. C. 302, 314.

(*n*) See, *e.g.*, *Daw* v. *Eley* (1867), 3 Ex. 496; 36 L. J. Ch. 482.

but its use an infringement of the prior patent. Again, if a new combination be invented, it may, though new, be an infringement of the patent rights of others. The copying of a part of an invention may be a piracy, therefore on a question of infringement the various elements of the two inventions are considered; whereas, in determining whether or not a thing is novel, the invention claimed is regarded as a whole (*o*). On the other hand, the fact that an invention does not infringe a prior patented invention obviously is, of itself, no ground for alleging the later invention to be novel; for in determining whether a patent has been infringed the claim chiefly is considered; in considering whether a prior specification discloses a subsequent invention alleged to be novel, the body of the specification, the drawings and the claims are all equally important. Therefore, whilst the decisions on infringement may often be used to illustrate the law on the subject of novelty, they must be applied with care, and the differences between the issues of novelty and of infringement, be borne in mind.

If a thing be manufactured its public existence will render invalid any patent subsequently granted for the manufacture of a like machine, even, perhaps, though the second machine be put to uses which the former machine was capable of, but which were not in contemplation at the time of the production of the earliest machine (*p*).

Rule to be applied in paper anticipations.

In the case of paper anticipations, however, the prior description will not avoid a subsequent patent unless it be sufficiently clear to enable those conversant with the subject, to produce the thing invented without any experiment, or further assistance than can be got from the paper itself. This applies equally to anticipation in books, prior specifications, and to drawings (*q*).

The "workman" test.

The description must be so clear that an intelligent workman reading it will deduce the invention and the way to make it (*r*), otherwise the invention is not anticipated. Therefore a prior specification which contains some information, but does not disclose an important part of the invention, does not anticipate a subsequent invention containing that part (*s*). It is true that

(*o*) *Newton* v. *Grand Junction Railway Co.* (1846), 20 L. J. Ex. 427, n.; 5 Ex. 331.

(*p*) *Otto* v. *Linford* (1882), 46 L. T. N. S. 35. See per Holker, L. J. There seems some doubt about this.

(*q*) *Ehrlich* v. *Ihlee* (1888), 5 R. P. C. at pp. 206, 207.

(*r*) *Neilson* v. *Betts* (1871), L. R. 5 H. L. 1, 15, 24; 40 L. J. Ch. 317.

(*s*) *Lyon* v. *Goddard* (1893–1894), 10 R. P. C. 334; 11 R. P. C. 354.

if a patentee has his mind furnished with the material of his supposed invention by a prior specification, and he has merely put it into a more detailed shape, it would not be a new invention (*t*); but 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 (*u*). And a patentee does not anticipate himself, by merely telling the public before the date of his patent that a particular result is desirable, unless he discloses means of attaining it (*x*). Nor is a patent anticipated by prior specifications dealing with analogous applications of the same subject-matter, but not describing a practical mode of producing the patented article (*y*).

It has been said that, to be an anticipation, the information in the prior publication must be equal to that given in the subsequent specification (*z*), and that the prior disclosure should give the same full and precise information which is required in a specification (*a*).

If further experiment be needed, no anticipation.

It will not suffice to invalidate a subsequent patent, that the prior publication would have enabled the patentee to discover his invention, unless he could have done this without invention or experiment. In *Hills* v. *Evans* (*b*) the law was put thus: in order to invalidate a subsequent patent, an antecedent statement in a prior publication must be such that a person of ordinary knowledge of the subject, would at once perceive, understand, and be able practically to apply it, without making experiments or seeking for further information. Knowledge and the means of knowledge are not the same thing (*c*), and a mere suggestion is not an anticipation, if it be such that it could practically be carried out only after further experiment (*d*).

Unworkable paper anticipations.

An alleged paper anticipation, which proves unworkable in practice, will not be a bar to a patent for a similar idea with a

(*t*) *Muntz* v. *Foster* (1844), 2 W. P. C. 107.

(*u*) *Betts* v. *Menzies* (1862), 10 H. L. C. 117; 31 L. J. Q. B. 233.

(*x*) *Thomson* v. *Batty* (1889), 6 R. P. C. 84.

(*y*) *Thomson* v. *American Braided Wire Co.* (1889), 6 R. P. C. 518; *Winby* v. *Manchester, &c., Steam Tramway Co.* (1891), 8 R. P. C. 61.

(*z*) *Thierry* v. *Rickmann* (1895), 12 R. P. C. 412, 428; in House of Lords, Times, 16 Dec., 1896.

(*a*) *Von Heyden* v. *Neustadt* (1880), 14 Ch. Div. 230; 50 L. J. Ch. 126; *Haslam* v. *Hall* (1888), 5 R. P. C. 1; *Shrewsbury Cab Co.* v. *Sterckx* (1895), 13 R. P. C. 44. A mere experimental production recorded in a chemical journal would hardly be anticipation: *Von Heyden* v. *Neustadt* (*supra*).

(*b*) (1862) 31 L. J. Ch. 457; 4 De G. F. & J. 289. See also *Stoner* v. *Todd* (1876), 4 Ch. Div. 58; 46 L. J. Ch. 32; *Moseley* v. *Victoria Rubber Co.* (1887), 4 R. P. C. 241.

(*c*) *Ibid.*

(*d*) *Hills* v. *London Gas Light & Coke Co.* (1860), 29 L. J. Ex. 409; 5 H. & N. 312

mode of putting it to practical use (*e*). And clearly no publication which is unintelligible can be an anticipation (*f*). On the other hand, if what is disclosed would suffice to enable a competent person to make the article or carry out the process, it is equally an anticipation whether anybody did or did not in fact do so (*g*).

In determining whether a prior publication renders a patent invalid, the prior publication must be read as it appears to a person of competent skill; for it is not because the prior publication does not clearly disclose the invention to the man in the street, that it necessarily is not an anticipation. The question is, can a person conversant with the trade, and of *competent* skill, make the article without further direction than can be obtained from the prior publication (*h*)? Or it may be put this way: can an intelligent mechanic accustomed to the kind of thing in question, ascertain the one invention from reading the other? If yes, the invention has been anticipated (*i*).

The principle laid down in the cases decided upon this point cannot be better stated than in the language of Mr. Justice Grove in *Philpott* v. *Hanbury* (*k*): "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 practise the invention from it, then I am of opinion that there is anticipation."

(*e*) *Betts* v. *Menzies* (1861), 10 H. L. C. 17; 31 L. J. Q. B. 233; *Duckett* v. *Whitehead* (1895), 12 R. P. C. 376.

(*f*) *Washburn & Moen Manufacturing Co.* v. *Floyd Elwy Patterson* (1884), 1 R. P. C. 157.

(*g*) *Neilson* v. *Betts* (1871), L. R. 5 H. L. 1, 15, 16; 40 L. J. Ch. 317, 327; *Betts* v. *Menzies* (1860), 10 H. L. C. 117; 31 L. J. Q. B. 233. But the alleged anticipation must be something more than a mere student's speculation, or philosopher's dream. *Ibid.*

(*h*) *Plimpton* v. *Malcolmson* (1876), 3 Ch. Div. 531, 567, 569; 45 L. J. Ch. 505; *Moseley* v. *Victoria Rubber Co.*, 4 R. P. C. 241; *Bray* v. *Gardiner* (1887), 4 R. P. C. 400, 405; *Gadd* v. *Mayor of Manchester* (1892), 9 R. P. C. 516; *Otto* v. *Linford* (1882), 46 L. T. N. S. 35; *Thierry* v. *Rickmann* (1895), 12 R. P. C. 412; and Times, 16 Dec., 1896.

(*i*) *Neilson* v. *Betts* (1871), L. R. 5 H. L. 11; 40 L. J. Ch. 317.

(*k*) (1885) 2 R. P. C. at p. 43. And see *Shrewsbury Cab Co.* v. *Sterckx* (1895), 13 R. P. C. 44.

Sufficiency of the prior specification not important.

In the case of a specification alleged to be an anticipation, the sufficiency of the specification is not the matter to be considered; the question is, not whether the patent for the invention claimed in the prior specification is good, but where the specification does in fact disclose the subsequent invention (*l*)?

State of knowledge at date of anticipation to be considered.

In considering the novelty of an invention alleged to have been anticipated, the state of knowledge at the date of the publication of the anticipation is to be regarded, not the knowledge acquired subsequently to that date (*m*).

State of general knowledge may avoid a patent.

Though the invention has not been actually anticipated, its novelty may be destroyed owing to the general state of knowledge at the time when the application was made for the patent. It may be impossible to point to any specific thing, or to any particular publication which disclosed the subject-matter of the patent, and yet the information at the disposal of the world at large may be such that obviously the patentee has produced nothing new (*n*).

Proof of general knowledge.

Whether the state of knowledge is such as to negative novelty, is a matter on which evidence may be given; it may be proved by experts, or by the production of standard books, encyclopædias, etc., the conclusion arrived at depending on the balance of evidence (*o*). The burden of proof is on that party who alleges want of novelty as a ground for invalidating the patent (*p*).

The general knowledge of those versed in the particular trade or science with which the invention is connected alone need be considered. "When you say a thing is known to the public and part of common knowledge, of course you do not mean that every individual member of the public knows it. That would be absurd. What is meant is, that if it is a manufacture connected with a particular trade the people in the trade shall know something about it; if it is a thing connected with a chemical invention people conversant with chemistry shall know something about it. And it need not go as far as that. You need not show that the bulk or even a large number of those people know it. If a sufficient number know it, or if the communication is such that a sufficient number may be presumed or assumed to know it, that will do" (*q*).

(*l*) *King* v. *Anglo-American Brush Co.* (1892), App. Ca. 367; 9 R. P. C. 313; and see *Betts* v. *Neilson* (1868), 3 Eq. 429.

(*m*) *Ibid.*

(*n*) *Vorwerk* v. *Evans* (1890), 7 R. P. C. 265; *Thomson* v. *Macdonald* (1891), 8 R. P. C. 5, 8.

(*o*) *Thomson* v. *Macdonald* (1891), 8 R. P. C. 5; *Cassel Gold Co.* v. *Cyanide Gold Co.* (1895), 12 R. P. C. 232.

(*p*) *Westley, Richards* v. *Perkes* (1893), 10 R. P. C. 181, 186.

(*q*) Jessel in *Plimpton* v. *Malcolmson* (1876), 3 Ch. Div. at p. 556; and see *King* v. *Anglo-American Brush Co.* (*supra*).

Though it is necessary that, as a whole, the publication relied on should be such as clearly to point out the invention claimed as the subject-matter of the patent, and to enable the skilled workman, at the date of such publication, to make it from the alleged anticipating publication (*r*), such precision is not required in each of the documents produced to show the state of public knowledge. And the state of public knowledge may be gathered from a variety of publications and sources (*s*). A specification giving a clue may, with the assistance of other public knowledge, be sufficient to prevent the novelty of a subsequent alleged invention (*t*).

Knowledge must be distinguished from means of knowledge.

It must not be readily assumed that a patchwork of information taken together will prove the existence of a state of knowledge fatal to the patent. If a mosaic of extracts from books is required to show want of novelty, the Court will probably conclude that the patent is good (*u*). Putting a man on the road to a place and leaving him to find his way there is not the same as taking him there (*x*). Moreover, diligent study of books ending in a practical result may make that result a novelty, though everything leading to the result be found in the books (*y*); and the case is all the stronger for validity if the publications which are supposed to give the clue are very old (*z*). Though every element of an invention be old, the combination may in itself be a novelty (*a*).

Novelty a question of fact.

Whether the claimed invention be novel or not is a question of fact, and was a question for the consideration of the jury in the days when patent cases were tried before juries (*b*). There seems at one time to have been a doubt whether the law should not be expressed thus: 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

(*r*) See *ante*, p. 49.

(*s*) See (*e.g.*) *Gaulard* v. *Gibbs* (1890), 7 R. P. C. 367.

(*t*) *Gaulard* v. *Gibbs* (*ibid.*).

(*u*) *Von Heyden* v. *Neustadt* (1880), 14 Ch. Div. 230; 50 L. J. Ch. 126.

(*x*) Per Lord Westbury in *Hills* v. *Evans* (1862), 31 L. J. Ch. 457.

(*y*) *Von Heyden* v. *Neustadt* (*supra*).

(*z*) See *Crampton* v. *Patents, &c., Investments Co.* (1888), 5 R. P. C. at p. 399, and 6 R. P. C. at p. 292, for remarks which may throw light on this.

(*a*) *Cannington* v. *Nuttall* (1871), L. R. 5 H. L. 205; 40 L. J. Ch. 739; *Newton* v. *Grand Junction Ry. Co.* (1851), 20 L. J. Ex. 427, n.; 5 Ex. 331.

(*b*) The point is not unimportant now, in view of the decision of Esher, M. R. and of Lopes, L. J.—viz., that in the Court of Appeal the burden of proving the Judge below to have been wrong on the facts lies on the appellant. See *Colonial Securities Trust* v. *Massey* (1896), 1 Q. B. 38; 65 L. J. Q. B. 100. But the remarks of the Law Lords in *Thierry* v. *Rickmann* (15th Dec. 1896) make it possible to say that the Court of Appeal may have construed the scope of its functions too narrowly.

inventions there occur terms of art or commerce, upon which experts must be examined and evidence given, "novelty" is a question of fact, and must be determined by the jury if there be one (*c*). But this is not satisfactory. In *Hills* v. *Evans* (*d*) Lord Westbury put the rule thus: The specification, like any other document, is construed by the Court, provided that the Court understand the terms used in it. But the function of the Court is limited to stating the legal construction of the document; the explanation of technical words or phrases, and the proof and results of processes are matters of fact to be determined on evidence by the jury. It follows that the identity of the invention claimed and of the alleged anticipation must have been properly a question for the jury. This is equivalent to saying that identity is a question of fact, and as such it is now considered. Prior user and prior publication also are matters of fact to be determined after hearing evidence (*e*).

Anticipation may be proved by single witness.

Anticipation and public knowledge may both be proved by evidence in the ordinary way—by books, experts, workmen, etc. And the burden of proof is mainly upon the party alleging want of novelty. He may prove anticipation by means of a single witness, as was actually the case in *Badham* v. *Bird* (*f*). There the owner of a patent for improvements in combined manhole covers and ventilators for sewers brought an action for alleged 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 then dismissed the action.

(*c*) See, *e.g.*, *Bush* v. *Fox* (1856), 5 H. L. C. 707; 25 L. J. Ex. 251; *Booth* v. *Kennard* (1857), 2 H. & N. 84; 26 L. J. Ex. 305; per Blackburn, J., in *Betts* v. *Menzies* (1861), 31 L. J. Q. B. at p. 237; 10 H. L. C. 117.

(*d*) (1862) 31 L. J. Ch. 457. See also in *Betts* v. *Menzies* (1861), 31 L. J. Q. B. at p. 243.

(*e*) See *Pickard* v. *Prescott* (1892), 9 R. P. C. 195, 200; *Gadd* v. *Mayor of Manchester* (1892), 9 R. P. C. at p. 527; *Edison* v. *Holland* (1889), 6 R. P. C. at p. 277; and per Tindal, C. J., in *Cornish* v. *Keene* (1835), 1 W. P. C. at p. 519.

(*f*) (1888) 5 R. P. C. 238. See also *Germ Milling Co.* v. *Robinson* (1886), 3 R. P. C. 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 R. P. C. 489; reversed on questions of subject-matter, 6 R. P. C. 41; cp. *Thomson* v. *Batty* (1889), 6 R. P. C. 84.

But the patentee can at the most make out only a *primâ facie* case of novelty, and show that persons in the way of hearing of similar inventions, and conversant with the class of machine or process dealt with in the specification, did not hear of or know anything which would have led them to make the subject-matter of the questioned patent (*g*). In this respect it may be said that the evidence of skilled persons to the effect that a prior publication did not convey the discovery to their minds, is of greater weight than the evidence of those who depose that, from inquiry made, pending or in view of the action, they conclude that, had their attention been drawn to the prior publication, they would easily have done what the patentee claims to have discovered (*h*).

Lord Hatherley's test of novelty.

A test of novelty for apparatus is given by Lord Hatherley in *Cannington* v. *Nuttall* (*i*). He says: "I take it that the test of novelty is this: Is the product, which is the result of the apparatus for which an invention claims letters patent, effectively obtained by means of your new apparatus, whereas it had never before been effectively obtained by any of the separate portions of the apparatus which you have now combined into one valuable whole for the purpose of effecting the object that you have in view?" (*j*)

Important pieces of evidence to prove novelty.

Amongst matters which may be important the following should be noted: that a considerable period has elapsed since the publication of the alleged anticipation, but that nothing has hitherto been made as claimed in the patent attacked (*k*); failure of the alleged anticipation when attempted to be put in practice (*l*); merit and utility of the invention (*m*); that the invention claimed to be novel has been imitated (*n*); a very large sale (*o*).

Examples.

The following examples may usefully illustrate the above and valid rules and principles:—

Betts v. *Menzies* (*p*). A specification disclosed that lead and tin in any proportions and in ingots or plates of any size

(*g*) *Cornish* v. *Keene* (1835), 1 W. P. C. at p. 509; *Galloway* v. *Bleaden* (1839), 1 W. P. C. 521, 526.

(*h*) *Von Heyden* v. *Neustadt* (1880), 50 L. J. Ch. 126; 14 Ch. Div. 230.

(*i*) (1871) L. R. 5 H. L. at p. 216; 40 L. J. Eq. 739.

(*j*) And see *Haslam* v. *Hall* (1888), 5 R. P. C. at pp. 18, 19.

(*k*) *Moseley* v. *Victoria Rubber Co.* (1887), 4 R. P. C. 241, 252.

(*l*) *Duckett* v. *Whitehead* (1895), 12 R. P. C. 376, 379, 381.

(*m*) *Thierry* v. *Rickmann* (1895), 12 R. P. C. 412; *Gosnell* v. *Bishop* (1888), 5 R. P. C. 151.

(*n*) *Harper* v. *Wright* (1895), 12 R. P. C. at p. 492.

(*o*) *Ehrlich* v. *Ihlee* (1888), 5 R. P. C. 437.

(*p*) (1862) 10 H. L. C. 117; 31 L. J. Q. B. 233.

(capable of being pressed between the rollers of a flattening mill) would, if passed once or more through those rollers, unite, provided that the surfaces of the metal were clean. A patent was subsequently obtained for another alleged invention thus described by Wilde, B.: An ingot of lead, previously rolled out till about one-fourth of an inch thick, if laid upon an ingot of tin previously rolled out to one-twentieth the thickness of the lead, will, if passed through the rollers of a flattening mill, combine and unite into one substance if the tin be brought very evenly into superficial contact with the lead before subjecting them to pressure together. Whether the earlier specification was in fact an anticipation of the later invention was not definitely determined (though in a subsequent case the patent for the latter was upheld (*q*)); but assuming the proportions to have been necessary to the proper carrying out of the latter invention, and to have been claimed as part of it, there would have been little difficulty in deciding against anticipation.

In *Goddard* v. *Lyon* (*r*) it appeared that an apparatus for disinfecting was made and used at Aberdeen. It consisted of an outer and an inner chamber. The outer chamber was intended to be filled by steam, and there was a means provided of introducing the steam into the inner chamber. The main purpose, however, was to use steam in the outer and air in the inner chamber; and in fact steam could not be, and never was, used at *high* pressure in the inner chamber. Plaintiff's apparatus—of later date—was similar, but was designedly constructed that steam at high pressure could be used in the inner chamber, an admitted advantage. The only material difference between the apparatus of plaintiff and the Aberdeen apparatus was that the door in the former would stand high pressure, that in the latter would not. It was decided by the House of Lords that plaintiff's apparatus had not been anticipated by the user at Aberdeen.

In the *Cassel Gold Extracting Co.* v. *Cyanide Gold Recovery Co.* (*s*) the Court of Appeal held that the existence of a specification, wherein a combination of two or more chemical substances to obtain a certain result is claimed, is no anticipation of the discovery that one substance will obtain the result. Also, that though it was known that cyanide of potassium would extract

(*q*) *Neilson* v. *Betts* (1871), L. R. 5 H. L. 1; 40 L. J. Ch. 317.

(*r*) (1894) 11 R. P. C. 354.

(*s*) (1895) 12 R. P. C. 232.

gold from ore, a patent for an invention which showed how to use it so as to extract the gold and leave everything else, is valid.

3. Publication.

An invention may be published in many ways. This part of the subject may be divided into three heads: (i) publication by prior user; (ii) publication in books, specifications, and other documents; and (iii) publication by communication to individuals. No publication of an invention will affect the validity of a patent subsequently obtained, unless the publication took place within the realm. An importer of a thing known abroad is entitled to a patent for the subject-matter of his importation, provided the invention be unknown at the time within the realm (*t*). The public use of an invention in England has been held to be a bar to the validity of a Scotch patent (*u*). In *Rolls* v. *Issacs* (*x*) it was decided that a grant could validly be given to the introducer of an invention already known in Natal, but unknown in England before the application for the patent. It will be observed that the patent extends to Great Britain, Ireland and the Isle of Man (*y*), and the invention must be novel within the limits of the realm as thus defined.

Publication beyond the realm not a bar to a patent for the same invention.

(A) *Prior User.*

Prior user in public of an invention is sufficient to invalidate the grant subsequently obtained for the same invention. The reasons for this rule cannot be better stated than in the language of Hindmarch (*z*): "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."

Nor is it necessary that, to have this effect, the use should

User in public.

(*t*) See per Jessel, M. R., in *Plimpton* v. *Malcolmson* (1878), 3 Ch. Div. 531, 552; 45 L. J. Ch. 505; Bacon, V.-C., in *Rolls* v. *Issacs* (1881), 19 Ch. Div. at p. 275; 51 L. J. Ch. 170.

(*u*) *Brown* v. *Annandale* (1842), 1 W. P. C. 433.

(*x*) (1881) 19 Ch. Div. 268; 51 L. J. Ch. 170.

(*y*) *Post*, p. 669.

(*z*) Page 108.

have been by the public; user in public is all that is needed.

Machinery used at works.

Thus, in *Re Adamson's Patent* (*a*), a contractor, engaged in the erection of a pier, used certain newly-invented machinery on the works for several months before applying for a patent, and during such user it was open to the view of the public; the Lord Chancellor decided that the invention had been publicly used, and refused a patent.

Tricycle ridden on public road.

In *Brereton* v. *Richardson* (*b*), a patent had been taken out for an improved tricycle; one witness stated that prior to the date of the patent he had ridden an identical machine in the public thoroughfare as far as Cheam, Coombe, and Malden, and had used it by day and night; this, it was held, amounted to a publication by user.

Pollock, B., in *Croysdale* v. *Fisher* (*c*), thus expresses himself: "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 way as contradistinguished from a mere experimental user, with a view of patenting a thing which may or may not be existing."

Deposit for purpose of sale is user.

The deposit of articles in a warehouse for the purpose of sale is user, even though no sale actually takes place (*d*).

And publication by user does not turn upon whether, in fact, the article was seen by the public; it has been held to suffice that it was so used that it might be seen.

Carpenter v. Smith.

In *Carpenter* v. *Smith* (*e*), a patent had been taken out for a new lock; a similar lock had been used on a certain gate in a public place for over

(*a*) (1856) 25 L. J. Ch. 456; 6 De G. M. & G. 420.
(*b*) (1884) 1 R. P. C. 165.
(*c*) (1884) 1 R. P. C. at p. 21.
(*d*) *Mullins* v. *Hart* (1852), 3 Car. & K. 297.
(*e*) (1841) 11 L. J. Ex. 213; 9 M. & W. 300; 1 W. P. C. 530.

sixteen years, and Lord Abinger, C. B., laid it down to the jury that the use of a lock in such a situation that the public might see it, is a public use and exercise of the invention sufficient to avoid registration of the alleged new lock. This is a very strong illustration.

User in public.

Stead v. *Williams* (*f*) will further illustrate the statement that user in public is publication. In that case an invention for paving was in question, and it appeared that a pavement, said to be similar to the one in question, had been laid down in a small covered-in portico, a porch to the private house of Sir William Worsley. If the pavement so laid down had been found to be the same as that for which the patent was claimed, the patent would have been avoided by previous user. Cresswell, J., said: "I should say, in point of law, that makes an end of the patent, because that appears to have been introduced by Sir William Worsley, or to have been used by him in public—not concealed—no secrecy about it—made known to all persons who came to his house, so far as their ocular inspection could make them. It was intended to be public, not to be made a matter of merchandise certainly, but merely for his own private use; but the knowledge of it exposed to the public an article in public use, and continued to be used down to the time in question. Therefore, if you think that is the same thing in substance as that which the plaintiff claims, I think that it was publicly used before, and that he cannot have his patent, Whether it had been used by one or used by five, I do not think it makes any difference. If I am wrong in that respect, I have stated my opinion distinctly, and that may be corrected. I know that it has been matter of much controversy, whether that is so or not. I have seen some very sensible observations upon the subject, perhaps not altogether corresponding with the view I now take of it; but, however, that is my opinion, that if you think that pavement made by Sir William Worsley is substantially the same thing as the plaintiff's, then your verdict should be for the defendants upon that issue"(*g*).

Pavement in private house.

Sometimes language has been used by Judges which would lead to the inference that prior user, to be a bar to the validity

(*f*) (1843) 2 W. P. C. 126, 136; 13 L. J. C. P. 218.

(*g*) A new trial was afterwards directed, but the principles stated in the above extract were not impugned. And see *Stead* v. *Anderson* (1846), 2 W. P. C. 147; 16 L. J. C. P. 250.

of a subsequent patent, must have been a general user (*h*); but this is not the law, as the above cases show (*i*).

Prior public sales.

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 (*k*).

Wood v. *Zimmer* (*l*). 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* (*m*). 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. *Somerell* (*n*). 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* (*o*). 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 machines used by them. It was held by Kay, J., that the patent was bad on both grounds.

A patent for an invention is invalidated by the prior public sale of the patented article; it is not necessary to show that an anticipatory article was made for the purpose of sale (*p*).

Disclosure with user.

A secret user is not publication; there is no user in the eye of the law without evidence of both *disclosure* and *actual use*.

(*h*) See per Lord Tenterden in *Lewis* v. *Marling* (1829), 1 W. P. C. 492; 4 C. & P. at p. 52; 10 B. & C. 22.

(*i*) See also *Morgan* v. *Seaward* (1837), 1 W. P. C. at p. 190; 2 M. & W. 553.

(*k*) *Lister* v. *Norton* (1886), 3 R. P. C. 208—210; *Deutsche Nähmaschinen Fabrik, &c.* v. *Pfaff* (1890), 7 R. P. C. 16; *Betts* v. *Menzies*, 1 E. & E. 990.

(*l*) (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 R. P. C. 254, 399.

(*m*) (1838) 1 Web. P. C. 200.

(*n*) (1851) 39 New. Lon. Jour. 153; 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 R. P. C. 208—210; *American Braided Wire Co.* v. *Thomson* (1888), 5 R. P. C. 120.

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

(*p*) *Betts* v. *Neilson* (1868), 3 Ch. 429, 436; 37 L. J. Eq. 321.

Dollond's Patent (*q*). 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. Cases.

Bentley v. *Fleming* (*r*). 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. Cresswell, J., overruled both objections, and as to the latter, which 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* (*s*). 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.

In *Hills* v. *London Gaslight Co.* (*t*), Bramwell, B., said: "If a person has invented anything which is the subject of a patent, and has kept it to himself or communicated it privately to one or two, in fact has not made it public knowledge; if any one else discovers that invention, it is new, that is to say, new in the sense that the first invention has not been published."

A question, to which at present no satisfactory answer can be given, may be asked in connection with secret user. If a man invents something, the production of the thing may or may not suffice to tell a workman how the thing is made. If a new machine is produced, the novelty consisting in the placing of a spring at a particular place, the mechanic can at a glance understand the invention and how to carry it out. But if a new

Difficulties where the invention publicly used, but where the nature of the invention is secret.

(*q*) (1776) cited H. Bl. 470, 487; 1 W. P. C. 43; Parl. Rep. 182. The full name of this case appears to be *Dollond* v. *Champness* (1866). See an article in the Law Journal, 1897, February 13th.

(*r*) (1844) 1 Car. & K. 587; 1 C. B. 479. And see *Hill* v. *Thompson* (1817), 1 W. P. C. 232; 8 Taunt. 402.

(*s*) (1857–62) 1 E. & E. 990, 1008; 30 L. J. Q. B. 81.

(*t*) (1860) 5 H. & N. 312; 29 L. J. Ex. 409. See also *Smith* v. *Davidson* (1857), 19 C. S. 191.

The case of chemical dye.

chemical dye is manufactured, it may well happen that even the expert chemist is unable, either by inspection or by experiment, to discover the method of production. The question then arises, does the exhibition in public, or sale of such an article as the latter, amount to publication by user?

Where the user applies for a patent.

Supposing that one John Smith invents a new alloy, and uses it in the construction of a lamp, and suppose that he does not take out a patent for the invention, but uses the lamp on the desk of an office, where people are accustomed to come; can John Smith himself subsequently take out a patent for his alloy? The wording of the Statute of Monopolies read in their ordinary meaning would seem to be no bar. Nor would the "consideration" theory be against him. The consideration for the grant of a patent is the disclosure of a new manner of manufacture which "others" shall not use; John Smith would be prepared to give this consideration. On the other hand there are authorities which are against the validity of a patent granted under such circumstances. In *Morgan* v. *Seaward* (*w*), Heath, J., says: "If an inventor could sell his invention, keeping the secret to himself, and when it was likely to be discovered by another take out a patent for it, he might have practically a monopoly for a much larger period than fourteen years." But this is not so, for the monopoly would commence with and end with the fourteen years; before and after he would not have a monopoly at law at all, though secrecy might give him a monopoly in fact. In *Heath* v. *Smith* (*x*), Erle, J., said: "If one party only had used the process and had brought out the article for profit, and kept the matter entirely secret, I am not prepared to say that the patent would have been valid." This dictum however is limited to cases where the production is for profit, though there seems no sound distinction between production for profit and any other proceeding, save where it is admitted that the earlier production was experimental; in every case the question to be solved is one of novelty and not motive. See also the *Germ Milling Co., Ltd.* v. *Robinson* (*y*), when upon proof of sale of the patented article before the date of the patent, plaintiff's case collapsed. But the point now under consideration did not arise, or at any rate was not discussed. Then there is another

(*w*) (1836) 1 W. P. C. at p. 194; 2 M. & W. 544.
(*x*) (1854) 2 W. P. C. at p. 278; 23 L. J. Q. B. 166; 3 E. & B. 256; 18 C. B. 522.
(*y*) (1836) 3 R. P. C. 254.

When a person other than the user applies for the patent.

question: if John Smith used the alloy publicly, could another person, having discovered the alloy quite independently of John, have a patent for the discovery? At first glance there seems to be no reason why not. He gives to the public an invention of which the public has no knowledge at the time. But it seems the better opinion, nevertheless, that no patent can be granted to such person. "Others" do use the invention, to wit, John Smith does. Again, a patent for the later invention either would or would not entitle the patentee to prevent John Smith from using a thing or process he had long used. Either result would be absurd (*z*). There are authorities, not very satisfactory ones, which tell against the validity of the patent. *Tennant's case* (*a*) is often cited in this connection; there it appeared that a bleacher had kept his process of preparing a liquor a secret from all but his two partners and two servants engaged in preparing it; subsequently the plaintiff discovered the identical liquor and took out a patent for it; but Lord Ellenborough held the patent to have been anticipated (*b*). The decision is not quite satisfactory for the present purpose, as from the short report it cannot be gathered whether plaintiff ever saw the older liquor; if not, the authorities cited on page 61, *supra*, throw question on the accuracy of this decision. See also the remark of Dallas, J., in *Hill* v. *Thompson* (*c*), and in *Cornish* v. *Keene* (*d*) Tindal, C. J., said: "if the defendants have shown that they practised it, and produced the same results in their factory before the time the patent was obtained, they cannot be prevented from going on with that which they have done" (*e*).

Hancock v. *Somervell*.

On this point *Hancock* v. *Somervell* (*f*) should be consulted. Goloshes were made in America, and were vulcanised by means of sulphur, and sold in England; subsequently a patent was obtained in England for vulcanising india-rubber goods by means of sulphur. It was said by witnesses that the appearance and smell of the articles would enable an expert to tell whether the india-rubber had been manufactured with sulphur. The Judge directed the jury that, if so, the patent was bad, but, if not, the patent was good: "If you should find that the material was in

(*z*) It must be admitted that the same results might arise in the case of any secret user.

(*a*) (1798) 1 W. P. C. 125, n.

(*b*) C. *f. Dollond's Patent*, 1 W. P. C. 43; 2 H. Bl. 469, 470.

(*c*) (1818) 8 Taunt. 402; 1 W. P. C. at p. 239.

(*d*) (1835) 1 W. P. C. at p. 511.

(*e*) *Cheetham* v. *Oldham* (1890), 7 R.P.C. 116, 124, also may be referred to.

(*f*) (1851) 39 New. Lon. Jour. 158.

public use, but that notwithstanding the invention remained still a matter to be discovered, in my opinion the plaintiff's case would not be affected by the circumstance of the material being in public use." But here the manufacture took place beyond the realm; it could hardly be said that "others" used the invention within the realm; they might use the resulting goods without using the invention.

Conclusion. The invention not debarred by user from getting a patent, if user does not disclose the invention.

In conclusion, it is submitted that an inventor who publicly uses his invention, but so as not to disclose it, is not debarred subsequently from taking out a patent; but that others are debarred from so doing. But this will not prevent a patent for making an article, the method of making which has been completely forgotten.

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

Confidential user.

In *Morgan* v. *Seaward* (*g*) it was proved at the trial that before the date of the patent, Galloway, 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.

Bentley v. *Fleming* (*h*). 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.

On the other hand, in *The Lifeboat Co., Ltd.* v. *Chambers* (*i*), letters patent for a boat specially useful for lifeboat purposes were granted in November, 1887; it appeared that the boat had been exhibited before that date at one of the shipbuilding yards

(*g*) (1837) 2 M. & W. 544; 1 W. P. C. 187.

(*h*) (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. 312; 29 L. J. Ex. 409; *Westley, Richards & Co.* v. *Perkes* (1893), 10 R. P. C. 161; *Useful Patents Co.* v. *Rylands* (1885), 2 R. P. C. 255.

(*i*) (1891) 8 R. P. C. 418.

at Glasgow, at the Royal Albert Docks, and at Portsmouth; invitations to the exhibition had been issued, and accounts of the exhibitions appeared in the public press; no precautions were taken to ensure secrecy. It was decided by the Court of Session in Scotland that the invention had been used in public (*k*).

Test of novelty given in *Humpherson* v. *Syer*.

The test is thus given by Fry, L. J., in *Humpherson* v. *Syer* (*l*): 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?

Discontinued user.

A discontinued user will not always be sufficient to invalidate a patent. The law may be stated thus: If the prior user is discontinued as useless, or if it was merely experimental, the patent granted subsequently is not invalidated by the prior user; otherwise notorious prior user of an invention will invalidate subsequent letters patent, although such user has been discontinued before the date of the patent grant (*m*). 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 (*n*), and probably the subsequent patent would be good.

Suppose, for instance, that the patent is granted for a revival by independent discovery of some long-forgotten art—of some art practised by the Romans. The patent would probably be good (*o*). But an invention of an art practised by or within the memory of living man, would not fall in this category (*p*).

There is no need, in order to invalidate the grant, to show user right down to the application for a patent (*q*). On the other hand, James, L. J., said in *Murray* v. *Clayton* (*r*): "I am not aware of any principle or authority upon which the exhibition

(*k*) See also *Saxby* v. *Gloucestershire Waggon Co.* (1883), Griff. A. P. C. 54.

(*l*) (1887) 4 R. P. C. 407. In *Tickelpenny* v. *Army and Navy Co-operative Society* (1888), 5 R. P. C., 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.

(*m*) *The Household Co.* v. *Neilson* (1843), 1 Web. P. C. 709, 710, 717; *Morgan* v. *Windover* (1888), 5 R. P. C. 296; *King* v. *Anglo-American Brush Co.* (1889), 6 R. P. C. 414, 420.

(*n*) 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 R. P. C. 328.

(*o*) See *Household Co.* v. *Neilson* (1843), 1 W. P. C., pp. 713 to 717.

(*p*) *Dick* v. *Tullis* (1896), 13 R. P. C. 149, 157.

(*q*) See some remarks of Patteson, J., in *Jones* v. *Pearce* (1832), 1 W. P. C. 122, that abandonment prior to the patent *per se* suffices to avoid invalidated; but this is not so. See per Alderson, B., in *Carpenter* v. *Smith*, *supra*.

(*r*) (1872) 7 Ch. 581. See also *Barlow* v. *Baylis* (1870), Griff. 44.

Useless machines.

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."

Experimental user.

Experimental user, though made in the presence of others than the inventor, and though continued up to the date of the patent, does not ordinarily amount to publication (*s*), and the coincidence of experiment with actual immediate profit is not *per se* sufficient to make the experimental user a publication (*t*).

In *Newall* v. *Elliott and Glass*, (*t*) Byles, J., said: "Is an experiment performed in the presence of others, which not only turns out to be successful, but actually 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.

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

(B) *Publication in Books and Specifications.*

Difference between publication by user and publication in books.

The meaning of "publication" must be obtained from the decided cases, and, for this purpose, those relating to designs as well as those relating to patents may be referred to. Publication by prior user differs from publication in books, documents, &c. In the former case user in public alone is publication; in the latter, the publication must not only be such that the public (*i.e.*, a sufficient portion of the public (*x*)) may acquire the

(*s*) *Newall* v. *Elliott* (1858) 27 L. J. C. P. 336; 4 C. B. N. S. 293; *Cornish* v. *Keene* (1835), 6 L. J. C. P. 225; 1 W. P. C. 508; *Jones* v. *Pearce* (1832), 1 W. P. C. 122; *Houschill Co.* v. *Neilson* (1843), 1 W. P. C. 673, 708; *Adamson's Patent* (1856), 25 L. J. Ch. 457; 6 De G. M. & G. 420; *Elias* v. *Grovesend Tin Plate Co.* (1890), 7 R. P. C. 466. But see the limits put upon this doctrine by Lord Blackburn in *Saxby* v. *Gloucester Waggon Co.* (1883), Griff. A. P. C. at p. 57. Tindal, C. J., in *Galloway* v. *Bleaden* (1839), 1 W. P. C., at p. 525.

(*t*) *Newall* v. *Elliott* (1858), 27 L. J. C. P. 337; 4 C. B. N. S. 293. See also *Winby* v. *Manchester Steam Tram.* (1889), 6 R. P. C. 359.

(*u*) *Kaye* v. *Chubb* (1888), 5 R. P. C. 641; cp. *Haslam Co.* v. *Hall* (1888), 5 R. P. C., at p. 19; *Barlow* v. *Bayliss* (1879), Griff. P. C. 44; *Bramah* v. *Hartcastle* (1789), 1 W. P. C. 44, n.

(*x*) *Plimpton* v. *Spiller* (1877), 5 Ch. Div. 412, 435; 47 L. J. Ch. 212; *Plimpton* v. *Malcolmson*, *infra*.

knowledge, but such that the invention actually becomes part of the public knowledge (*y*). In an ordinary case, a description in a book published in England will be assumed to be public knowledge (*z*). In *Stead* v. *Williams* (*a*) Tindal, C. J., said, if published in England, "the publication makes the patent bad, but in each case publication is a question of fact—the existence of a single copy of a work, though printed, brought from a depository, where it has long been kept in a state of obscurity, would afford a very different inference from the production of an Encyclopædia or other work in general circulation. The question would be whether, upon the whole evidence, there has been such a publication as to make the description a part of the public stock of information."

Book published in England. Publication always a question of fact.

Publication in a book, then, will be publication sufficient to invalidate a subsequently granted patent (*b*). Thus an alleged invention published in *Emerson's* book on Mechanics before the date of the patent obtained was decided to be not patentable (*c*). The following cases may be referred to :—

Lang v. *Gisborne* (*d*).—A book was written in French, and it appeared that in England four copies at least had been sold, one of them being to the librarian of the University Library, Cambridge. It was decided that the contents of that book had been published in England, so that the information contained in it had become common property. Sir John Romilly, M. R., said that, "a publication, however, takes place when a person who is the inventor of any new discovery, either by himself or by his agents, makes a written description of that, prints it in a book, and sends it to a bookseller to be published in this country. It is not at all necessary to establish the fact that one volume of that book has been sold; as soon as an inventor informs the public of what his invention is, and publishes that in a book which he sends to a publisher to sell, the moment that book is

Illustrative cases.

Four copies of a French book sold, one to librarian, held publication.

(*y*) *Per* Pollock, B., in *Croysdale* v. *Fisher*, 1 R. P. C. 17. And see *Plimpton* v. *Malcolmson* (1875-6), 3 Ch. Div. 531; *Plimpton* v. *Spiller*, *supra*; 44 L. J. Ch. 505; mere lapse of time is no bar to, provided the invention has not been published, *Bentley* v. *Fleming*, 1 Car. & K. 587.

(*z*) *Plimpton* v. *Malcolmson*, *supra*.

(*a*) (1843) 2 W. P. C. 143; 7 M. & G. 818; and see *Stead* v. *Anderson* (1846), 2 W. P. C. 150.

(*b*) *Cornish* v. *Keene* (1835), 6 L. J. C. P. 225; 1 W. P. C. 508.

(*c*) *Rex* v. *Arkwright* (1785), 1 W. P. C. 64, 72; *Hill* v. *Thompson* (1818), 1 W. P. C. 244; 8 Taunt. 375; 1 Carp. P. C. 53; and see *Jones* v. *Berger* (1843), 12 L. J. C. P. 179; 1 W. P. C. 544; *Harris* v. *Rothwell* (1887), 35 Ch. Div. 416; 56 L. J. Ch. 459; 4 R. P. C. 225; *Stead* v. *Anderson* (1846), 2 W. P. C. 151; 16 L. J. C. P. 250.

(*d*) (1862) 31 L. J. Ch. 769; 31 Beav. 133.

exposed in the shop for the purpose of purchase, then that becomes a complete publication in point of law. I wish to state it as broadly as I can, because, in case this matter should go further, it is desirable that there should be no ambiguity as to my opinion with respect to the law. That would be the effect if it were the publication of a book in England by an English inventor, and there is no difference when the inventor is a Frenchman or any other foreigner who publishes a book in his own language, but sends it over to a bookseller in this country for the purpose of being sold. As soon as the book comes to this country to be sold, and is offered for sale in the public shop of a bookseller, then that becomes a publication of the invention, assuming it to be a clear and accurate description of the invention in question. It would be impossible to arrive at any other result without producing the most inextricable difficulties in law. It would be difficult to ascertain how many persons had bought the book, though the purchase of the book would be nothing if they had not read the contents. It would be impossible to say to how many persons the purchaser had lent it, who had read it. In the present case it has been proved that a public library in one of the large universities in England had actually bought the book. It may be that a thousand persons had read it and considered it before this invention had taken place; but how can that by any possibility be proved? The Courts would be involved in inextricable difficulty if the burthen of proof were thrown on a person who had made public an invention as far as he was able to make it public, to shew that the public themselves had appreciated it by buying the book or making it common to other persons."

Offer of books for sale in a public shop said to be publication per Romilly, M. R.

In *Plimpton* v. *Malcolmson* (*c*), a book was deposited in the Patent Office library on July 20, 1865, but in what part was unknown, and it was not catalogued nor entered in the list of donations. It was then taken to a private room, and remained untouched, unread, and unlooked at till 1875. Jessel, M. R., held that the contents had not been published up to 1875. He said: "The case goes to this, that a book must be made public to such an extent as to be generally known among persons practising in such matters. It is, therefore, not merely publication, though, as a general rule, according to the *Household Coal*

What amounts to publication in a book, per Jessel, M. R.

(*c*) (1876) 3 Ch. Div. 531, 558; 44 L. J. Ch. 257.

and Iron Co. v. *Neilson* (1 Webs. P. R. 673, 718, n.), when you say a book is published, and nobody contests it, you assume that several copies have been printed and circulated, unless somebody asserts the contrary. But, as regards the law you must go a step further. Does that doctrine, therefore, apply to a case of this kind? There is one copy of the book, which is all that has ever been printed or published, and that copy of the book was always kept in the back-parlour of the bookseller's shop, and never was seen, as far as the evidence went. Would that satisfy the doctrine? Clearly not. Even although a book was published, and, in the technical sense, published in England, it does not satisfy the conditions; it has not become part of the public knowledge; it is not knowledge in the possession of the public. And, therefore, if in the cases I have cited the patentee had given evidence to shew that the day after the publication in England of 500 copies, 499 had been destroyed, and the remaining one had been put aside by the bookseller in his back-parlour, and never circulated, though if somebody had asked him he would have been willing to sell the book, I am satisfied, from what I have read of the opinion of those learned Judges, they would all have decided that that was not made publicly known, so as to be part of the public possession and part of the public knowledge."

Referring to *Lang* v. *Gisborne* (*f*), he says: "Suppose the bookseller had put one volume in his shop-window as exposed for sale for one day, and the next day, by direction of the author, destroyed all the volumes, that would not do, and I do not think that Lord Romilly intended that it would. These are general observations, not to be read in that strict literal sense, but in this sense: that, if a man publishes a book, that is a large number of copies, and sends them to booksellers for sale, and they are for a reasonable time exposed in the window, so that you may infer that people have known and seen them, and may reasonably so infer, though you do not prove, one has been sold —if the other side cannot prove that one has not been sold, you may reasonably infer that some of those books have been sold. If he means *anything* more than that, I humbly dissent from it; and I say that my decision is supported by the previous decisions to which I have referred, because I am clear that, if it were

(*f*) 31 L. J. Ch. 769; 31 Beav. 133.

shewn that no copy had ever got into the hands of the public, and the public knew no more about it than seeing the back of the book in the bookseller's window, and every copy could be accounted for, and that none had been sold though exposed for sale, that would not be a sufficient publication to avoid a subsequent patent."

Book held not to be accessible to public.

Plimpton v. *Spiller* (*q*). The facts in this case were similar to those in the last-named; but, in addition, it was shewn that a sub-librarian had seen the book in a corridor open to the public, leading into the public room of the old Patent library. When the new Patent Office library was opened, the book was placed in a room upstairs, and not in the principal room. The Court of Appeal decided that the book had never been published in any sense in which it could be construed to be accessible to the public. James, L. J., said: "I should, if it were necessary, desire much further time to consider whether, even if it were proved that the book, one copy of which had been sent over as a present from a gentleman in America, was on the shelf in the library between July 20 and August 25, that would be a sufficient publication, and would be such an addition to the stock of common knowledge in this country as would have prevented a man from being the first and true inventor of this patent; such an addition to the stock of common knowledge as a man was not entitled (to use the language of one of the cases) to deprive the public of." And Brett, L. J., says: "I cannot agree with Mr. Davey when he says that it is sufficient to shew that the thing has been printed in a book, and that the book has been so placed that it might have been known to the public. It must be not only printed in a book, but that book must be placed in such a position and so used that you may fairly infer or assume that the contents of the book have become known to a sufficient number of people. Therefore, when you prove that this book was put in the Patent library, I care not into what part, I do not say that is no evidence of its having become known to the public; but I say that when you have other facts which shew that, although it was put into the Patent library, the proper inference is that nobody ever did see it there or elsewhere, then, although it has been in one sense, if you please, published, or in one sense, if you please, intended to be dedicated to the

(*q*) (1877) 6 Ch. Div. 412; 47 L. J. Ch. 212.

public, all I can say is, that the public have not been able to take advantage of the dedication or the publication, and therefore you do not shew that it was known to the public."

Otto v. *Steel* (*h*). One copy of a French treatise was placed in the British Museum library in 1863, and that one copy was the only one proved to be in England prior to 1876. The catalogue referred to it, and it was placed in its proper place in the library. Readers would find the book in the catalogue only under the author's name, and it was not placed in a part of the library where they could get at it without special assistance. Pearson, J., refused to find that the book had been published in such a manner that there was a reasonable probability that any person might have obtained knowledge from it, and decided, therefore, that the presence of the book in the Museum did not invalidate a patent granted in 1876 (*i*).

Book in British Museum and catalogued.

Harris v. *Rothwell* (*k*). Two specifications in German of German patents were deposited in the Patent Office library some two years before a patent for making the same article was granted in England. Entries of such specifications were duly published in the *Patents Journal* amongst German Patents, and described, a footnote stating that they might be consulted at the Patent Office library. The Court of Appeal, affirming Chitty, J., held, that the German patent had been published in England, and that the subsequent patent was therefore bad. Cotton and Lindley, L. JJ., were of opinion that had the existence of the description of the prior invention been unknown, the invention could not be said to have been previously published, and distinguished the present case from those above, as in the *Plimpton* cases the book was not known to be in the Patent Office library, and in the Otto Case it was not known to be in the Museum library. Lopes, L. J., said: "Can the plaintiff be said to have increased the stock of human knowledge, to have given the public any information which they did not previously possess if, at the time of filing the specification, there existed in the library of the Patent Office, unreservedly open to the public, specifications describing in identical terms the same invention? probably not. *Otto* v. *Steel*, 31 Ch. Div. 245; 55 L. J. Ch. 196; but see Jessel M. R., in *Plimpton* v. *Malcolmson*, 3 Ch. Div. 560.

German specifications at the Patent Office.

(*h*) (1885-6) 31 Ch. Div. 241; 55 L. J. Ch. 196; 3 R. P. C. 109.

(*i*) And see *Heurteloup's Patent* (1836), 1 W. P. C. 553. If a book is in the British Museum, is there a presumption that it has been read?

(*k*) (1887), 35 Ch. Div. 416; 56 L. J. Ch. 459; 4 R. P. C. 225.

The public were then possessed of the information contained in the plaintiff's patent; it was on the shelves of their public library—a library in the Patent Office—the place of all others devoted to information relating to inventions; the place to which anyone wanting information on such subjects would resort. Why should the public be precluded from the right of using the information of which they were then in possession? I think directly the German specifications were deposited in the library of the Patent Office, and became unreservedly accessible to the public, there was a complete publication of the invention in this country, and it became the property of the public. If this case had been tried at Nisi Prius, and the defendant had given evidence of the deposit of these German specifications in the library at the Patent Office in the way mentioned in this case, I think the Judge should have at once told the jury that the evidence of prior publication, if they believed it, was conclusive, and they must find accordingly. In my opinion the depositing the specifications in the library of the Patent Office in the way described was itself a publication of the invention contained in them, and I think that the invention was then dedicated to and became the property of the public."

Other cases of books in foreign language.

Some questions may arise when the book is published in a foreign language. In the cases of *Lang* v. *Gisborne* (*l*) and *Otto* v. *Steel* (*m*) the publication was in French, but no point arose upon that. The same may be said of *Harris* v. *Rothwell* (*n*), where the specification, held to amount to prior publication, was written in German. In *Re Heurteloupe's Patent* (*o*), the deposit of a foreign work in the British Museum invalidated a similar patent subsequently obtained in England. In the *United Telephone Co.* v. *Harrison* (*p*), an invention was described in a paper, written in German, in a scientific journal, and was illustrated by figures. A copy of the journal was in the Patent Office library, and also in the library of the Institute of Civil Engineers, and there open to members and to certain others. It was catalogued only under the title "Journals." A telegraphic engineer saw this journal, and from the technical terms used, and the

(*l*) 31 L. J. Ch. 769; 31 Beav. 133.

(*m*) 31 Ch. Div. 241; 55 L. J. Ch. 196; and see *Pickard* v. *Prescott*, L. R. (1892) A. C. 263; 9 R. P. C. 195.

(*n*) *Supra.*

(*o*) 1 W. P. C. 553.

(*p*) (1882) 21 Ch. Div. 720; 51 L. J. Ch. 705. See also *United Horse Nail Co.* v. *Stewart* (1885), 2 R. P. C. 13[illegible].

illustrations, was able to understand the invention; Fry, L. J., held, that the invention had been published (*r*).

Summary of result of the cases.

The cases are difficult to reconcile, if the question be regarded as one of law. The true rule seems to be that in each case the question is one of fact. The *Plimpton* cases and *Otto* v. *Steel* do not really conflict with *Lang* v. *Gisborne*, or with *Harris* v. *Rothwell*. In the two former cases, the books, though in the libraries, were not accessible; in the latter cases, the books were accessible. All that has to be determined is, whether the public had already the information professed to be given for the first time by the patentee. This was a question to be answered by the jury when patent cases were tried by jury; it is still a question of fact (*s*).

Drawings.

A drawing may be a sufficient publication. In *Herrburger* v. *Squire* (*t*) it was said that 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 could make a machine from that picture alone, then a person cannot take out a patent in respect of a machine substantially the same. This may not always be the case, for in *Ehrlich* v. *Ihlee* (*u*) Kekewich, J., said that a strong *primâ facie* case of novelty, attested by commercial success, will not be defeated by the mere production of models alleged to have been made according to older specifications—no proof being given as to the persons by whom, the knowledge with which, and the purpose for which, such models were made.

Cases on prior publication in specifications.

Jones v. *Berger* (*x*). "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* (*y*). 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.

(*r*) In *Household Co.* v. *Neilson* (1843), 1 W. P. C. 718 n., Lord Brougham said: "It must not be a foreign book," but the meaning of this is clear from the succeeding clause, "but published in England." See also *Soames' Patent*, 1 W. P. C. 733.

(*s*) See 1 W. P. C. 719, n.

(*t*) (1889) 6 R. P. C. 194.

(*u*) (1888) 5 R. P. C., at pp. 206, 207; affirmed at p. 437.

(*x*) (1843), 1 Web. P. C. 544; 12 L. J. C. P. 179; 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 R. P. C. 414.

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

Publication by provisional specification.

Laurence v. *Perry* (*z*). 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 (*a*), 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 *Stoner* v. *Todd* (*b*), 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 in connection with the case of *Harris* v. *Rothwell* (*c*).

(C.) *Publication to Individuals.*

Although an invention has not been published in any book, it may still be unpatentable, on the ground that it has been communicated orally or otherwise to some person who is not in a confidential relation to the inventor. The cases which follow shew that there is a publication whenever it is the fair conclusion from the evidence that some English people, under no obligation to secrecy, arising from confidence or good faith towards the inventor, knew of the invention at the date when the application for a patent was made (*d*). If, however, the person to whom the communication is made is under an obligation to secrecy, the statement to him will not be a bar to novelty unless he breaks the confidence reposed in him (*e*).

Confidential trial of invention.

Brett v. *Electric Telegraph Co.* (*f*). Plaintiffs obtained a patent on February 11. On January 25 M. entered into

(*z*) (1885) 2 R. P. C. 179.

(*a*) At p. 187.

(*b*) (1876) L. R. 4 Ch. Div. 58; 46 L. J. Ch. 32.

(*c*) *Supra*, p. 71. See also *United Horse Nail Co.* v. *Steward* (1885), 2 R. P. C. 133, per Lord Kinnear, distinguishing *Plimpton* v. *Spiller* (1876—77), L. R. 4 Ch. Div. 286, *ante*.

(*d*) See Fry, L. J., in *Humpherson* v. *Syer* (1887), 4 R. P. C. 414.

(*e*) *Ibid.*, p. 416; and cf. *Patterson* v. *Gas Light & Coke Co.*, 3 App. Cs. p. 245; 47 L. J. Ch. 402.

(*f*) Norman on Designs, p. 7; Times 24th May, 1847.

an agreement with the defendant company, authorising the company to use his invention, which was practically identical with that of the plaintiff's. By the terms of the agreement the company was to try the invention by use for a certain time, and then either adopt it, or refuse to use it permanently; in such case the company was to keep the invention secret from all persons whatever. It was decided that the transaction between the company and M. did not amount to publication so as to avoid the plaintiff's patent.

Design exhibited by traveller before registration.

Hunt v. *Stevens* (*g*). This case referred to a design for a gas chandelier, and it appeared that before registration the plaintiffs had been in the habit of placing the designs in the hands of their travellers, who took them about for the purpose of obtaining orders prior to their registration. This was held to be a prior publication of the design.

In *Bentley* v. *Fleming* (*h*), a machine was lent to a second person to have its quality tested; that person used it for some weeks in a public work-room, and the Judge was of opinion that there had been no publication. The report, however, is very short, and the decision, it is submitted, cannot be much relied upon. In *Westley, Richards and Co.* v. *Perkes* (*i*), it appeared that a gun was made in open shop, without any injunctions as to secrecy; it was known to many of the workmen, and was sold. On these facts, Kay, L.J., found that the invention had been published. *Morgan* v. *Seward* (*k*) was distinguished on the ground that in that case the engineer who was instructed to make the wheels there in question had instructions to act secretly, and did so.

Gun made in open shop without any secrecy.

In *Humpherson* v. *Syer* (*l*), prior to the plaintiff's application for a patent, S. sent for Widmer, who was a tradesman making water waste preventers, and instructed him to make an appliance to prevent the waste of water, and he directed Widmer to make it in accordance with a model which had been prepared by a man in the service of the defendant. This was sufficiently like the plaintiff's invention to be an anticipation, if the instructions to Widmer amounted to publication. Widmer caused the appliance to be made in his public warehouse, and it was exposed in his shop. Widmer was not a servant of S.'s, but a tradesman.

(*g*) W. N. (1878) 79.
(*h*) 1 Car. & K. 587.
(*i*) (1893) 10 R. P. C. 181.
(*k*) 1 W. P. C. 170; 2 M. & W. 544.
(*l*) (1887) 4 R. P. C. 407.

Bowen, L. J., said: "I put aside questions of public use, and treat this as a question of whether there has been a prior publication; that is, in other words, had this information been communicated to any member of the public who was free in law or equity to use it as he pleased? Was Widmer a person to whom this communication had been made in a manner which left him free both in law and equity to do what he liked with the information? If so, the information, of course, had been given to a member of the public, and there was nothing further to serve as consideration for any patent. The question is not a very easy one to settle as regards Widmer in my view. It is perfectly true that Mr. Widmer said, and Mr. Syer adopts the view, that there was no secrecy about the employment of Mr. Widmer to make a particular article. But it seems to me one must look at the whole case, and ask oneself, not merely by the light of what they say were the oral instructions which passed between them, but also by the light of the understood relations between the two men, whether Widmer really could, in good faith, have disposed of the information which he received from Syer after he received it—whether he could have used it for his own purposes against the person who gave it him. I think when a man sends a patent to be made to a shop, you must take what passes orally; you must take all the circumstances of the case, and ask yourself whether there was any confidential relation established between the two parties—whether it was an implied term of the employment that the information should be kept by the shopman to himself, or whether he might afterwards, without any breach of good faith, use the matter, and use it as he chose." Fry, L. J., thus deals with the point: after finding on the evidence, that Widmer made the machine without any obligation to secrecy, he proceeded: "But supposing that I am wrong in that, and supposing that Widmer was under an obligation to secrecy, that obligation was broken by him because he made the machine in the open shop. Now, I am at a loss to find any obligation of secrecy which it can be suggested that Widmer had placed upon the workmen of Widmer, and upon all the persons who passed through the shop, and if that is so, though there may have been a breach of confidence in making it in the shop, nevertheless, according to the law, as laid down by Lord Blackburn, if the public have become possessed of the invention by any means

Breach of confidence may amount to publication.

whatever, no such patent can be taken out. Therefore, I think the probability is so strong that it would be seen by the workmen in the shop some time during the interval between the 16th and the 26th, that on that ground again I think there is strong and cogent evidence to lead to the conclusion that there was publication of the very thing itself."

Confidential publication. Communication to agent. Communication by agent to others.

In *Blank* v. *Footman* (*m*), which was a design case, the inventor of a design showed it to and consulted Hummel, his sole agent, and the agent consulted another person, and also showed it to two customers, and asked them for orders; Kekewich, J., decided that a registration subsequent to the date when the design was shown to the customers was invalid. On the other hand, he decided that the communication to the agent would not affect a subsequent registration. He said, after quoting Bowen, L. J., (in *Humpherson* v. *Syer* (*n*)): "The patentee, whether it be a chemical patent or a scientific patent or a machinery patent, frequently (generally I might say) is unable to carry out the manufacture of the patented article in all its details himself personally. He must employ others, and for that purpose the Lord Justice says he is entitled to do so without in the slightest degree damaging his patented rights to claim protection, provided it is done confidentially. It is a step further to say that a man like Mr. Blank is entitled to take into his confidence a man like Mr. Hummel, who is only a commission agent, a man through whom the profits are to be made. He does not occupy, to my mind, a position at all similar to that of the shopman. But I think it is only a fair stretch of the same principle to say, as I have already said, that I think a man in Mr. Blank's position might consult with those through whom he would put goods on the market, particularly, as I say, having regard to the relation existing between them, and doing it confidentially, without avoiding his rights to be obtained by registration."

Publication by delivery of a sample.

In *Winfield & Son* v. *Snow Brothers* (*o*) it appeared that Major, a buyer for Messrs. Olney & Sons, suggested to plaintiffs to produce lace of a certain pattern, and the plaintiffs caused a design to be prepared, from which they manufactured a sample, and showed it to Major. He gave an order for 12,000 yards, and took away a piece as a sample. The design was registered, and

(*m*) (1888) 39 Ch. Div. 678; 57 L. J. Ch. 909; 5 R. P. C. 653. And see *Tickle-penny* v. *Army & Navy Co-operative Society* (1888), 5 R. P. C., at p. 410.

(*n*) (1887) 4 R. P. C. 413.

(*o*) (1891) 8 R. P. C. 15.

subsequently the bulk of the lace was delivered; it was decided by Hawkins, J., that the registration was bad, the disclosure to Major being a publication. The Judge said that the argument for the defendant was "that that which took place between Mr. Winfield and Mr. Major was no publication, but a mere confidential communication with a view to ascertaining from Mr. Major himself whether his suggestion made at their first interview had been carried out by the designer, and whether the specimen of lace manufactured from that design was such as to be likely to suit the spring market, with a view to registration of the design, if his opinion were favourable. Had such been the sole character and object of the communication I should undoubtedly have held that it did not amount to such a publication as to defeat the subsequent registration, for I should, under such circumstances, have looked upon the production of the specimen of lace to Mr. Major as an exhibition of it with a view to seeking the advice of an experienced friend, without any reference to the employment as buyer to the firm with which he was connected, and the more particularly should I have thought so had Mr. Major been made aware of the plaintiffs' intention to register the design." This case is an authority for saying that the fact of dealing commercially with a design or invention amounts to a publication vitiating any subsequent registration of or patent for the same matter (*p*).

Commercial dealing with design.

In *Heinrichs* v. *Bastendorff* (*q*) H., previously to registering his design, and whilst perfecting it, consulted D. (with whom H. had trade relations) and sent him samples for inspection. D. slightly altered the samples, and returned them; eventually, but after registration, D. bought some of the designed goods. Mr. Justice Day held, that there had been no publication under these circumstances.

Sample sent for inspection only.

In *Patterson* v. *Gas Light & Coke Co.* (*r*) plaintiff had been appointed one of three referees to inquire on behalf of the Board of Trade into the purification of gas; they drew up a report, one part of which was said to have been communicated confidentially by plaintiff to his colleagues. The plaintiff obtained a patent for an invention communicated in this report to his colleagues. The House of Lords decided against the

(*p*) And see *Morgan* v. *Seaward* (1836), 1 W. P. C. 170, 194, 195; 6 L. J. Ex. 153; 2 M. & W. 544.

(*q*) (1893) 10 R. P. C. 160.

(*r*) (1817) 3 App. Ca. 239; 47 L.J.Ch. 402.

patent on the grounds that (*a*) when a report by referees specially appointed is made to a public office, the knowledge of the referees is at once public knowledge, though the report be not yet published; and (*b*) the knowledge of one becomes public knowledge when he communicates it to his colleagues, though they agree to treat the communication as confidential.

(D.) *Publication at Public Exhibitions.*

Publication at an industrial or international exhibition is provided for by sect. 39 of the Act of 1883, thus:—

"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 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 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 sect. 3 of the Act of 1886 provides:—

"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."

See notes to these sections, *post*, p. 632, and Forms, pp. 815, 872, in the Appendix. Also Patent Rules, 1890, r. 15, p. 686.

SECT. III.—AMOUNT OF INVENTION.

Broader meaning of the term subject-matter.

The term "subject-matter" of a patent as applied to an invention is used in more senses than one. In its broader and proper meaning it includes everything necessary to bring an invention within the meaning of sect. 6 of the Statute of Monopolies; that is to say, it involves that the invention is a manufacture, is novel, and is useful. A chapter on subject-matter, therefore, should include a section on the meaning of the term "manufacture;" a section on Novelty in its various aspects; and another on Utility; and, therefore, we have headed this entire chapter "subject-matter."

Narrower meaning, equivalent to "invention" or "ingenuity."

But to the term is often given a narrower signification, in which sense it is used as meaning that amount of invention which is sufficient, according to the decision of the Courts, to sustain the patent. For instance, when a defendant pleads as distinct defences that the invention is not subject-matter, and that it has been already anticipated, it is obvious that the term "subject-matter" is not used in its wider sense. And the sense in which it is used becomes more clearly shown when the wording of the former of these pleas is expanded, and reads thus: "That the alleged invention is not subject-matter, inasmuch as it is merely what any person conversant with the matter could have done without ingenuity"—see, *e.g.*, the pleadings in *Sudbury* v. *Lee* (*s*). This restricted use of the term is more usual than its use in the wider signification, but it is submitted that, as a matter of terminology, this is not correct. It would seem that "amount of invention," though a branch, and a very important branch, of the law relating to Letters Patent for Invention, is, nevertheless, but a sub-division of the law of subject-matter. It should take its place alongside of Publication, Prior User, and Utility, and should not appropriate the generic name which includes each of these.

(*s*) (1894) 11 R. P. C. 58; see especially objection (3), where novelty and subject-matter are contrasted.

"Amount of invention" probably a branch of "novelty."

It is by no means certain that "amount of invention" is not in reality but a sub-division of novelty. Take *Newton* v. *Vaucher* (*t*), for instance; would the objection to the patent in that case be nowadays want of invention or want of novelty? In *Vickers* v. *Siddell* (*u*) Lord Herschell said that the objections of want of novelty and want of subject-matter cover to some extent the same ground, but he thought it expedient to deal with them separately. See also the judgments in *Thomson* v. *American Braided Wire Co.* (*x*) and *Blakey* v. *Latham* (*y*): "To be new in a patent sense it is necessary that the novelty must show invention." If an "amount of invention" be not one of the requisites of novelty, it is strange that to within the last twenty years there is probably no reported case in which a patent has been held to fail for want of ingenuity alone, in clear contradistinction to want of novelty. The cases cited below will, it is suggested, bear out these statements.

Moreover, it is difficult in many a modern case to say at first blush whether the Court has decided against an invention on the ground of want of novelty or of want of invention. If "novelty" involves nothing more than that the invention is not identical with another, then, of course, novelty can exist without ingenuity. But this is not the original meaning of novelty in patent law. The leading case of *Harwood* v. *Great Northern Railway Co.* (*z*)—which will be dealt with hereafter—suffices to shew this. Lord Blackburn—then Mr. Justice Blackburn—was called in with the other Judges to advise the House of Lords, and referring to the invention he said: "We quite agree with the Court of Exchequer Chamber that a mere application of an old contrivance in the old way to an analogous subject, *without any novelty or invention* in the mode of applying such old contrivance to the new purpose, is not a valid subject-matter of a patent." More recent cases undoubtedly make a clearer distinction between the two requisites; and a modern Judge would probably change the word "or" in the italicised passage into "and," but even now the language used in the Court does not always imply that "sufficient invention" and "novelty" are distinct requisites. See, *e.g.*, *Goddard* v. *Lyon* (*a*). Referring to the apparatus in question in

Dicta in *Harwood* v. *Great Northern Railway Co.*

(*t*) (1852) 6 Ex. 859; 21 L. J. Ex. 305; see also *Brunton* v. *Hawkes* (1821), 4 B. & Ald. 541.

(*u*) (1890) 15 App. Ca. 496; 60 L. J. Ch. 105; 7 R. P. C. 292.

(*x*) (1889) 6 R. P. C. 518.

(*y*) (1889) 6 R. P. C. 184, 187.

(*z*) (1860) 35 L. J. Q. B. 27; 11 H. L. C. 654.

(*a*) (1894) 11 R. P. C. 121, 354; in the House of Lords (1894), 11 R. P. C. 354.

Opinion of Lord Herschell in *Goddard* v. *Lyon*.

the last-mentioned case and an alleged anticipation of it, Lord Herschell said: "It was indeed said that the difference between the plaintiff's apparatus and the Aberdeen apparatus was so slight that it could not be said to be the subject-matter of a patent." It would be difficult from this to say whether the Lord Chancellor was not stating the point of an argument based on want of novelty. In fact, however, he proceeded to explain that he was referring to an objection of want of ingenuity. But in the Court of First Instance, Wright, J., had treated the objection as one going to the novelty point, and gave little attention to want of invention. The facts of this case are mentioned below. Perhaps as striking an example as is to be found is furnished by *Longbottom* v. *Shaw* (*b*), which reached the House of Lords in 1891. The patentee in that case had obtained a patent for an invention consisting of a row of hooks on a foundation of metal, the row of hooks so formed being then attached to a reel or frame for the purpose of holding pile. Reels or frames with a row of hooks were *admittedly* old; so also was *the idea of attaching* a row of hooks to a strip of metal in such manner that the hooks and the strip might be fixed where required—every row of hooks in a movable hat rack involves the same idea. But the patentee said that though a row of hooks on a movable piece was an old contrivance, and though reels were in common use, nobody had ever before put the row of hooks to the frame for holding piles. The House of Lords had no difficulty in upholding a decision adverse to this patent, and on the ground that the alleged invention was deficient in ingenuity. But it is submitted that in reality there was nothing new. Again, in *Sudbury* v. *Lee* (*c*), it was decided that there was no invention in applying to the heel of a stocking a process which was already in use in connection with other parts. This example could be matched by many another; and, on the whole, logically arranged, the objections raised under the plea of "want of invention" could, in most cases, it is submitted, be dealt with under the heading of "want of novelty."

Longbottom v. *Shaw*.

The modern practice is to treat novelty and subject-matter separately.

Nevertheless, it must be admitted that modern practice treats "amount of invention" as a requisite of a patentable invention distinct from novelty, and more often than not, dignifies it with the name "subject-matter," excluding from that term all other requisites of a valid patent.

(*b*) 8 R. P. C. 333.

(*c*) (1894) 11 R. P. C. 58.

Lord Esher's dictum in *Edison* v. *Smith*.

Lord Esher in *Edison Phonograph Co.* v. *Smith* (*d*), said: "What is the meaning of want of subject-matter? It is not the same thing as want of invention, or rather, I should say, a want of novelty; it is not the same thing as want of utility, but where you cannot maintain either of those propositions, which would be sufficient to destroy the patent, it is something else, which some one or other, at some time, has invented as an idea for destroying patents. And what is it? It really comes to this, that although the invention is new—that is, that nobody has thought of it before—and although it is useful, yet, when you consider it, you come to the conclusion that it is so easy, so palpable, that everybody who thought for a moment would come to the same conclusion; or in more homely language, hardly judicial, but rather business-like, it comes to this,—it is so easy that any fool could do it." Though the opening sentence is somewhat obscurely worded, it is certain that the Master of the Rolls regards want of subject-matter and want of invention as equivalent terms, conveying an idea distinct from want of novelty.

Several cases might be quoted in which the same view has been taken by modern eminent Judges; but it suffices to mention *Cole* v. *Saqui* (*e*), decided by Cotton, Lindley, and Bowen, L. JJ.; *Morgan* v. *Windover* (*f*), decided in the Court of Appeal, but reversed by Lords Halsbury, Watson, Herschell, and Morris; *Vickers* v. *Siddell* (*g*), in the House of Lords; *Gadd* v. *Mayor of Manchester* (*h*), in the Court of Appeal; *Thierry* v. *Rickmann* (*i*); and *Lancashire Explosive Co., Ltd.* v. *Roburite Explosives Co.* (*k*). In *Morris* v. *Young* (*l*), it was pointed out, *arguendo*, that particulars of novelty are required to be given; particulars relating to subject-matter need not.

The extract from Lord Esher's judgment quoted above is of considerable interest on another point connected with this "want of ingenuity" question. He seems to treat want of subject-matter as a somewhat new form of objection to a patent. Want of subject-matter, he says, is something which somebody has at some time invented as a ground for invalidating a patent otherwise good. His lordship does not show any very great

(*d*) (1894) 11 R. P. C. 398.
(*e*) (1889) 6 R. P. C. 41.
(*f*) (1890) 7 R. P. C. 131, and see 449.
(*g*) (1890) 15 App. Cas. 496; 60 L. J. Ch. 105; 7 R. P. C. 292.
(*h*) (1892) 9 R. P. C. 516.
(*i*) (1895) 12 R. P. C. 412, 543. Reversed on the facts in the House of Lords, 15 Dec., 1896.
(*k*) (1895) 12 R. P. C. 470.
(*l*) (1895) 12 R. P. C. 455.

respect for the plea, but what is somewhat important is to observe that he treats it as an objection due to the ingenuity of the lawyer and of somewhat recent origin, not as one of the old objections based on the wording of the Statute of Monopolies (*ll*).

Want of ingenuity a modern objection.

There is reason to believe that Lord Esher's *dictum* conveys a true impression, and that, in fact, want of invention or ingenuity, *so far as it is distinct from the defence of want of novelty*, is a modern defence to an action for infringement, and was introduced as a brake upon the too rapid progress of patents for analogous uses.

Query whether the objection might not formerly have been raised in another form.

In saying this it is not intended to convey the idea that the courts have gone beyond the terms of the Statute in supporting the plea. There seems ample reason for saying (assuming novelty), that when there is a want of ingenuity, the manufacture is not one which can be patented under the exception entertained in sect. 6 of the Statute of Monopolies. If for no other reason, a manufacture which falls within the category of those which (to use Lord Esher's expression) any fool could make, would not be patentable, because it would be "mischievous to the statute .... or generally inconvenient" (*m*). Moreover, it has long been considered that the monopoly is the result of a bargain with the Crown, the consideration for which given by the patentee is the increase to the general knowledge contributed by him. Such consideration would fail were the patentee to disclose nothing but what any member of the community, acquainted with the industry in question would certainly be able to do for himself.

The development of the doctrine of "want of invention."

According to this view, the objection in question might have been taken at any period since the Statute of Monopolies (probably it was so taken in fact), but would then have been merged in the attack upon the novelty of the invention. But circumstances have made it more prominent of late, and have widened the scope of the objection. The history of the matter may be dealt with under three periods:—

1. Up to about 1857.
2. From 1857 to 1884.
3. Since 1884.

1. *From James I. to* 1857.

There is no case of any real importance on the present subject between the year when the Statute of Monopolies was passed

(*ll*) See the remarks of the same Judge in *Hayward* v. *Hamilton*, quoted *post*, at the top of p. 93.

(*m*) Stat. Monopolies, sect. 6.

and the year 1822. In the latter year the case of *Hall* v. *Jarvis* (*n*) was tried before Abbott, C. J., and a jury in the King's Bench, and afterwards came before the Court. The invention related to a means of destroying the furs and fibres of lace by flame glass. Prior to the plaintiff's invention, a flame of charcoal, waste paper, wood, shavings, pit coal, had been used for many years to singe fibres from silk, cotton, or lace sleeves. The apparatus of the plaintiff's was different to that formerly in use; the plaintiff's drew up the air and flame by means of a chimney; the draught hitherto had been caused by means of bellows; this, however, the Chief Justice considered unimportant. Counsel for the defendant urged that the mere doing with gas what had already been done with other kinds of flame, could not be subject-matter. The jury thought otherwise, and the Court refused to interfere with the verdict. Now here was a somewhat vague attempt to set up against the patent what is now known as "want of invention;" but once being convinced that the process was novel, the jury, and with the Judge's approval, rejected the defence. The objection was not one which was pointedly urged nor was it ready for judicial opinion.

Hall v. *Jarvis*.

In 1838 the case of *Losh* v. *Hague* (*o*) came before Lord Abinger and a jury. The patent was for an improvement in the construction of wheels for carriages to be used on railways. In the course of the summing up, the learned Judge, referring to an alleged anticipation by one Paton, said: "The learned counsel has stated to you, and very properly . . . . that Mr. Losh has taken out his patent to use his wheels on railways. Now, he says, the wheels made by Mr. Paton . . . . were never applied to railways at all. That opens this question, whether or not a man who finds a wheel ready made to his hand, and applies that wheel to a railway, shall get a patent for applying it to a railway. There is some nicety in considering that subject . . . . it is a different thing when you take out a patent for applying a new contrivance to an old object, and applying an old contrivance to a new object —that is a very different thing; if I am wrong I shall be corrected. In the case the learned counsel put, he says, if a surgeon goes into a mercer's shop, and sees the mercer cutting velvet or silk with a pair of scissors with a knob to them, he seeing that would have a right to take out a patent, in order to apply the

Importance of Lord Abinger's summing up in *Losh* v. *Hague*.

(*n*) (1822) 1 W. P. C. 100.

(*o*) (1837), 1, W. P. C. 202, 207.

same scissors to cutting a sore, or a patient's skin. I do not quite agree with that law. I think if the surgeon had gone to him and said, 'I see how well your scissors cut, I can apply them as well as a lancet, by putting a knob at the end,' that would be quite a different thing, and he might get a patent for that; but it would be a very extraordinary thing to say, that because all mankind have been accustomed to eat soup with a spoon, that a man could take out a patent because he says that you might eat peas with a spoon. The law on the subject is this: that you cannot have a patent for applying a well-known thing which might be applied to 50,000 different purposes, for applying it to an operation which is exactly analogous to what was done before. . . . . I must own, therefore, that it strikes me, if you are of opinion that this wheel has been constructed . . . . long before the plaintiff's patent, that although there were no railroads then to apply them to, and no demand for such wheels, yet that the application of them to railways afterwards . . . . will not give effect to his patent . . . . that is my opinion on the law, and on that I am bound to direct you substantially."

These remarks are quoted at length, and from them, it is submitted, that much of the modern law relating to "ingenuity" is to be traced. They contain some of the earliest direct statements on the law of "analogous user." But there are one or two other points worthy of notice. In the course of the argument counsel had made use of an illustration referred to by the Judge, which could never have been placed before even a jury, had the law in 1830 been what it is in 1896. The Judge did not express his dissent in any very emphatic language, "I do not quite agree," is all he said. But his own illustration of the spoon and the peas seems to have given him courage, and towards the end of the summing up, he directs the jury definitely, that the application of a known object to a use, "exactly" analogous to one already known, is not patentable. The "nicety" in considering the subject which Lord Abinger refers to, would not be appreciated nowadays.

Losh v. *Hague* was correctly decided.

There cannot be any question but that his Lordship's direction was right. What was the manufacture or manner of manufacture? If it existed at all, it was the particular form of wheel. But this was not novel. The application, which was novel, could not in the then state of the authorities, be styled a manufacture. Webster mentions, as a further example of the same

dilemma, the discovery that a medicine, known to be valuable for one disease, is valuable for another disease. The discovery may have far-reaching consequences; but it is not patentable, the medicine is old; the new use not a manufacture. A double use, merely as such, was unpatentable. But so far, amount of invention is not expressly referred to, nor indeed thought of. If the patent is invalidated, it is either because the invention is not a manufacture, or because it is old.

About the same time, *R.* v. *Cutler* (*p*) was decided, both Denman, C. J., and Wightman, J., holding that the mere application of a known article to a new use could not be the subject-matter of a valid patent. This was Lord Abinger's view as he expressed it in *Losh* v. *Hague*.

Influence of the hot blast cases.

But about this time, two very celebrated inventions were patented, and the grants made in their favour were reviewed by the Court:—the hot blast patents. In the one, *Neilson* v. *Harford* (*q*), the patent in dispute had been granted for an improved means of applying air to produce heat in fires and furnaces. All that the patentee invented was the introduction into the furnace of a hot in the place of a cold blast (the heat to the blast being applied by passing the cold air into a receptacle of any suitable material and shape, intermediate between the bellows and the furnace), and applying heat to the receptacle. The discovery was of immense importance to the smelting industry. Baron Parke started, by telling the jury that patent-rights were not to be construed with a special view to their defeat. The patent was upheld. Subsequently the case of *Crane* v. *Price* (*r*) was fought in connection with an invention consisting of an application of the Neilson's hot blast for the purpose of utilising anthracite beds of coal in the smelting and manufacturing of iron, *i.e.*, the combination of a hot blast and anthracite coal with ironstone for the production of iron.

The results of Crane's discovery can hardly be overrated; the invention was of the greatest utility and merit. But, was it patentable? Was it more than the application to anthracite coal of a known hot blast, previously in use for pit coal? This was the line taken by Serjeant Bompas for the defence: the stone-coal was known as a fuel; the hot blast was known for the

(*p*) (1847) 4 Q. B. 372, n; 3 C. & K. 215.
(*q*) (1841) 8 M. & W. 806; 11 L. J. Ex. 20; 1 W. P. C. 331.
(*r*) (1842) 4 M. & G. 580; 1 W. P. C. 393; 12 L. J. C. P. 81.

manufacture of iron, the using them together in a known manner was not a new manufacture; the anthracite and the hot blast were put together in a way well known for purposes well known. Novelty was not disputed. The argument was, therefore, that the invention was not a manufacture. No suggestion of want of invention could have been made with success, but the principle expounded by Lord Abinger in *Losh* v. *Hague* was pressed in aid—a new use of old contrivances is not subject-matter. The Court upheld the patent. Said Tindal, C. J.: "We are of opinion, that if the result produced by such a combination be either a new article, or a better article, or a cheaper article to the public, than that produced by the old method, that such a combination is an invention or manufacture intended by the statute, and may well become the subject of a patent." And later on he adds: "There are numerous instances of patents which have been granted, where the invention consisted in the use of things already known, and acting with them in a manner already known, and producing effects already known, but producing effects so as to be more economically, or beneficially enjoyed by the public." Then, dealing with a suggestion of counsel, that the degree of invention was so small that it could not be subject-matter, the Chief Justice says that if the invention be new and useful, it is not material whether it be the result of experiment or profound research, or the result of a lucky thought of accident.

Judgment of Tindal, C. J.

A new invention not bad because it resulted from a lucky thought or an accident.

From these "hot blast" cases it may be gathered (1) that the Court was desirous of upholding meritorious patent; (2) that it considered that the application to a new use of old contrivances and substances might be patentable; and (3) that the degree of invention and ingenuity would not be considered. It may also be observed that amount of invention had so far been not a matter for inquiry.

Bush v. *Fox* (*s*) and *The Patent Bottle Enclope Co.* v. *Seymer* (*t*), the one decided in 1853-1855, and the other in 1859, are further examples of the principle that a patent cannot be granted for the application to a new purpose of an old contrivance. "Indeed to hold otherwise," said Willes, J., "might tend to produce oppressive monopolies in the application of old and

(*s*) (1852) 23 L. J. Ex. 275; 25 L. J. Ex. 251; 5 H. L. C. 707. The patent was held to be bad because the subject-matter was not a manner of "manufacture"; it was not invalidated for want of ingenuity.

(*t*) (1858) 5 C. B. N. S. 164; 28 L.J. C. P. 22. And see *Tetley* v. *Easton* (1857), 2 C. B. N. S. 706; 26 L. J. C. P. 269.

well-known implements to new material, without any further novelty or merit than the discovery of the material in that form into which it is to be worked." The conclusion that may be drawn from a review of the cases up to about 1857 is this: that whilst many show that analogous user of a known object is not sufficient to enable the discoverer to get a patent (not because of want of novelty, but because there is no new manufacture given to the public), the Judges were straining to support patents for meritorious discoveries, and were breaking in upon the old rule (*a*). On the other hand, there was an anxiety to protect the public against monopolies where the alleged inventions were not of any real merit. Amount of invention has so far not consciously become a matter of serious consideration.

State of the law in 1857.

2. *From* 1857 *to* 1884.

During this period it will be found that novelty, merit, and amount of invention are all considered in determining whether there is good subject-matter. At first the tendency was to confound them more or less together; later "novelty" becomes distinct whilst merit and ingenuity remain linked together, ingenuity being in the nature of a test of merit; and finally we reach the modern idea, that an analogous application is good subject-matter, if it be ingenious, and not otherwise. Ingenuity, at first the test of merit, becomes finally a matter of importance in itself (*c*).

General idea of the decision up to 1884.

Brook v. *Aston* (*d*) is the first case of importance in this period. A patent had been granted for exposing threads of cotton and linen in a distended state to beaters. Subsequently a patent was obtained for applying the same to wool and hair. The second patent was held to be void from want of subject-matter. Lord Campbell, C. J., said that it might well be that a patent should be obtained for the application of an old invention to a new purpose; but to make it valid, there must be some invention, some "novelty in the application." So said Coleridge, J. It will be observed that the learned Judges speak of invention, which they treat as novelty in the application. In the course of hearing in the Exchequer Chamber (*e*), Baron Bramwell said that the two specifications were "identical." It may be said that "invention,"

Lord Campbell treats the matter as one of novelty.

(*a*) See *Newton* v. *Vaucher* (1852), 21 L. J. Ex. 305; 6 Ex. 859.

(*b*) See *Booth* v. *Kennard* (1857), 26 L. J. Ex. 305; see especially the dictum of Pollock, C. B., at p. 307; 1 H. & N. 84; 2 H. & N. 84.

(*d*) (1857) 8 E. & B. 478; 27 L. J. Q. B. 145.

(*e*) 28 L. J. Q. B. 175.

as a requisite in the modern sense, is the same as "novelty in application," in the sense used by the Court in 1857.

Harwood v. Great Northern Railway.

We now come to the leading authority on "want of invention" —*Harwood* v. *Great Northern Railway* (*z*).

This case—which the House of Lords decided, after consulting the Judges—arose on the following state of facts:—A patent was granted for the purpose of connecting the ends of the rails of railways by means of fishes. It was proved that these fishes had been used before to connect timbers in the construction of bridges, and the question for the decision of the House (according to Lord Westbury) was, whether there could be any invention in taking that thing which was a fish for a bridge and having it applied as a fish to a railway. Blackburn, J., said: "In order to bring the subject-matter of a patent within this exception [*i.e.*, sect. 6 of the Statute of Monopolies] there must be *invention* so applied as to produce a practical result. And we quite agree with the Court of Exchequer Chamber, that a *mere* application of an old contrivance in the old way to an analogous subject, *without any novelty or invention* in the mode of applying such old contrivance to the new purpose, is not a valid subject-matter of a patent . . . . and we think it must always be a question of degree; a question of, more or less, whether the analogy or cognateness of the purpose is so close as to prevent there being an invention in the application" (*a*).

To this statement of the law all the Judges consulted adhered: on the question of fact there was a disagreement; but, in the result the House declared the patent invalid. Lord Westbury adopted the view of the law as just stated, but it would be difficult to find anything in the opinions of the Law Lords showing that they treated want of ingenuity or invention as something altogether different to novelty.

Novelty and ingenuity not clearly distinguished in this case.

Although patent lawyers ordinarily treat this case as the great precedent for saying that want of ingenuity is fatal to a patent, though the invention be novel, it will be found that in the speeches of the Lords the decision was treated as one invalidating a patent for want of novelty (see especially per Lord Wensleydale) (*aa*).

Whilst *Harwood's case* was awaiting the final decision, *Ormson*

(*z*) (1865) 11 H. L. C. 651; 35 L. J. Q. B. 27.

(*a*) The words are italicised as in the Law Journal report.

(*aa*) See also per Cockburn, C. J., in 2 B. & S. 208. And *Thompson* v. *Jones* (1863), 32 Beav. 570.

v. *Clark* (*b*) came before the Common Pleas. In that case, the defendant objected that there was no new invention, *and* no invention to sustain the patent; and he was successful. Invention and novelty were here pleaded distinctly, but the judgments do not throw much light on the subject of present inquiry. In *Horton* v. *Mabon* (*c*) Willes, J., said that "a new combination of old materials, producing a new effect, may be the subject of a patent, but there must be some invention." The other Judges based their decision on the reasoning of the Court in *Losh* v. *Hague*.

Later cases.

Penn v. *Bibby*.

These cases were quickly followed by *Jordan* v. *Moore* (*d*) (in the course of which Grove, Q.C., referring to *Harwood's case*, said that it turned on the question of novelty) and *Penn* v. *Bibby* (*e*). In the course of the latter we get the first clear indication that novelty and sufficient of invention are distinct matters, and that both are requisite. Lord Chelmsford said (*f*): "It is very difficult to extract any principle from the various decisions on this subject, which can be applied with certainty to every case; nor, indeed, is it easy to reconcile them with each other. The criterion given by Lord Campbell in *Brook* v. *Aston* (*ante*) has been frequently cited . . . . that a patent may be valid for the application of an old invention to a new purpose, but to make it valid there must be some novelty in the application. I cannot help thinking that there must be some inaccuracy in the report of his Lordship's words, because, according to the proposition, as he stated it, if the invention is applied to a new purpose, there cannot but be some novelty in the application." After quoting with appreciation Lord Chief Justice Cockburn's dictum in *Harwood's case* (*g*), that the question in every case is one of degree—viz., whether the amount of affinity or similarity which exists between the two purposes is such that they are substantially the same, and that determines whether the invention is sufficiently "meritorious to be deserving of a patent"—the Lord Chancellor proceeds: "In every case of this description, one main consideration seems to be, whether the new application lies so much out of the track of the former use as not naturally

(*b*) (1862) 32 L. J. C. P. 29, and 13 C. B. N. S. 337; affirmed 14 C. B. N. S. 475.

(*c*) (1862) 31 L. J. C. P. 255; 12 C. B. N. S. 437; on appeal 16 C. B. N. S. 141.

(*d*) (1866) L. R. 1 C. P. 624; 35 L. J. C. P. 268.

(*e*) (1866) L. R. 2 Ch. 127; 36 L. J. Ch. 455.

(*f*) P. 135.

(*g*) 2 B. & S. 194; 29 L. J. Q. B. 193.

to suggest itself to a person turning his mind to the subject, but to require some application, thought, and study."

Parkes v. *Stevens* (*h*) and *Murray* v. *Clayton* (*i*) are worth referring to as examples, but do not advance or retard the growth of the law in the direction indicated above.

Jessel, M. R., and the test of merit.

A passage in the judgment of the late Master of the Rolls in *Hinks & Son* v. *Safety Lighting Co.* (*k*), should be observed. He says, referring to an objection of want of novelty, "A new part of a machine is very uncommon indeed; consequently that is an objection which, *per se*, is not of great weight; but, like every combination which is new, it must have merit, and now, how is a Judge to apportion merit? I do not know. As far as I can ascertain from the authorities, the merit very much depends on the result produced. Where a slight alteration turns that which was practically useless into that which is very useful and important, Judges have considered that, though the invention was small, yet the result was so great as fairly to be the subject of a patent; and, so far as a rough test goes, I know of no better." Here, then, we have merit, not ingenuity, given as the test of subject-matter.

The Pavement Light case.

Hayward v. *Hamilton* (*l*) is a remarkable and useful case. The patent was for pavement lights. The frame of the pavement light was glazed, the glass being so moulded that the under side was of prism-like form; one of the sides of the prism was nearly upright, and the other side inclined at such an angle that the light passing through the upper surface might strike the inclined side, and be reflected within the prism, and issue from the upright side in any direction required. Deck lights with prisms were old, but different in many respects to the light in question; there was also an old prism like those constituting part of the pavement light here, but it had not been applied to pavement lights. The Court of Appeal decided that the patent was valid. The present Master of the Rolls showed that want of respect for the defence of "no invention," which he still exhibits; he said: "There was a point raised and discussed, which for a time did seem to me a difficulty, namely, whether although this was new and useful it could be said to be an invention. Now the difficulty that that proposition presented to

(*h*) (1869), 5 Ch. 36; 38 L. J. Ch. 627.
(*i*) (1872) 7 Ch. 570, 587.
(*k*) (1876) 4 Ch. Div. 607, 615; 46 L. J. Ch. 185.
(*l*) (1879–81) Griff. P. C. 115.

me was this: that I did not recollect of myself any case in which, where a thing had been pronounced to be new and useful, the question of whether it was an invention had ever been discussed, or left to a jury for instance. It seemed to me that in all previous cases it had been taken for granted that if the thing were new and useful there must have been invention in order to arrive at a thing that can be so described, and I should say that in 999 cases out of a 1,000 that must be so." So said Lord Esher in 1879. In 1894 he recognized that want of invention (a want of subject-matter as it is now called) could be an objection distinct from want of novelty, but he said: "Whenever I hear the objection taken to a patent which has been used, which has been bought and sold, which has been theretofore treated by men of business as a useful thing, that it is wanting in subject-matter, I look upon it, I confess, with an amused contempt (*m*)."

Hayward v. *Hamilton* proves that in 1879 the plea of "no invention" was considered as a different plea to want of novelty, but that a Judge of the experience of Brett, L. J., could not remember a case where the two had been separated. But since the time of *Hayward* v. *Hamilton*, cases may be found by the score, in which the plea of no ingenuity has been raised, though seldom without an accompanying allegation of no novelty. Since 1880 "want of invention" has been regarded as a separate and distinct bar to the validity of a patent. It may be added that though *Hayward* v. *Hamilton* went, as far as relates to invention, further in favour of the patentee than any other case, with the possible exception of *Thomson v. American Braided Co.* (*n*), the principles upon which it was decided have never been attacked; see *Blakey* v. *Latham* (*o*); *Williams* v. *Nye* (*p*).

3. *Since* 1884.

The Patents Act, 1883, does not affect the law on this subject. It throws us back on the Statute of Monopolies for the meaning of invention: see sects. 5 (2) and 46. In *Williams* v. *Nye* (*q*), Cotton, L. J., said that to maintain a patent, there must be a substantial exercise of the inventive power, though it may be that very slight alterations may have important results, and involve the exercise of ingenuity; and the Court loyally followed *Harwood* v. *Great Northern Railway Co.*

(*m*) *Edison Bell Corporation* v. *Smith*, 11 R. P. C. 389.
(*n*) 6 R. P. C. 518.
(*o*) (1889) 6 R. P. C. 184.
(*p*) (1890) 7 R. P. C. 62, 67.
(*q*) (1890) 7 R. P. C. 62.

The modern law requires a substantial exercise of the inventive power to support a patent.

In *Elias* v. *Grovesend Tinplate Co.* (*r*), Smith, J., says, "to constitute good subject-matter of a patent, besides utility, the process must be new, and there must be invention." The Court of Appeal assented, and Bowen, L. J., in the course of his judgment said, "It seems to me that the law to be applied is tolerably clear, and that there never has been for many years any doubt about it; that the application of a well-known thing to a new and analogous use is not the subject-matter of a patent, unless there is invention in the application or the mode of application." The Lord Justice notes that in Lord Westbury's judgment invention is hardly referred to, but he says that when Lord Westbury said that you cannot have a patent "merely" for a new application of a well-known contrivance, the Lord Chancellor meant "unless there is invention in the adaptation or mode of application." This is the accepted judicial construction of the word merely.

In *Morgan* v. *Windover* (*s*), Lord Halsbury said: "It cannot but be certain that the Statute of Monopolies and the whole hand of the law founded on that statute makes it an absolute condition to the validity of a patent, that there should be what may properly be called invention; and the application of well-known things to a new analogous use is not properly the subject of a patent." This is in accordance with every modern case if the word "mere" be prefixed to the word "application." This the other Law Lords pointed out: the effect of the word "mere" has just been given in the words of Lord Bowen.

Summary of the law by Lindley, L.J., in *Gadd* v. *Mayor of Manchester*.

In 1892 *Gadd and Mann* v. *Mayor, etc., of Manchester* (*t*), came before the Court of Appeal, when Lindley, L. J., summed up the state of the law thus:—(1) "A patent for the mere use of a known contrivance without any additional ingenuity in overcoming fresh difficulties, is bad, and cannot be supported. If the new use involves no ingenuity, but is in manner and purpose analogous to the old use, although not quite the same, there is no invention; no manner of new manufacture within the meaning of the Statute of James. (2) On the other hand, a patent for a new use of a known contrivance is good, and can be supported if the new use involves practical difficulties which the patentee has been the first to see and overcome by some ingenuity of his own. An improved thing produced by a new

(*r*) (1890) 7 R. P. C. 455.
(*s*) (1890) 7 R. P. C. 131.
(*t*) 9 R. P. C. 516.

and ingenious application of a known contrivance to an old thing, is a manner of new manufacture within the meaning of the statute."

This is entirely in accordance with *Longbottom* v. *Shaw* (*u*), decided the year before by the House of Lords, and with *Goddard* v. *Lyon* (*v*), also a House of Lords' case. In the former the patent was held invalid; in the latter it was held to be good; but in both the principles upon which the decision rested were the same as those enunciated by Lindley, L. J.

Invention a question of fact.

Whether or not there be sufficient ingenuity to support a patent is a question of fact to be determined in each case (see *Elias* v. *Gravesend Tinplate Co.* (*y*); *Blakey* v. *Latham* (*z*); *Gadd* v. *Mayor of Manchester* (*a*); *Boyd* v. *Horrocks* (*b*); *Morgan* v. *Windover* (*c*); *Thierry* v. *Rickmann* (*d*)), but *some* ingenuity is requisite to support a patent for the application of an old object to a new use. In *Thierry* v. *Rickmann*, Kay, L. J., said this principle is of "the very essence of patent law."

Merit not sufficient to support a patent.

"Merit" is no longer sufficient to uphold a patent for an analogous use; in *Longbottom* v. *Shaw* (*e*), Lord Herschell said: "You may have an alteration in an existing machine or apparatus which undoubtedly constituted an improvement, and results in the machine being free from some defect which previously existed, but which yet is only the application of known methods to analogous purposes, and cannot be the subject-matter of a patent." So also, the degree of merit will not be too jealously inquired into. An ingenious invention resulting from a happy flash of inspiration and one resulting from long experiment are equally patentable (*Longbottom* v. *Shaw*) (*ee*). Again, invention does not depend upon whether the result is or is not for the public good; *Thomson* v. *American Braided Wire Co.* (*f*).

Conclusions arrived at.

The conclusion arrived at is this:—

(1) Formerly "ingenuity," as distinct from "novelty," was not a requisite to validity. (2) But a patent could not be granted for a new use of an old contrivance (*Losh* v. *Hague* (*g*)). (3) This was found to be detrimental to public policy, and when a really advantageous use for an old object

(*a*) 8 R. P. C. 333.
(*b*) (1894) 11 R. P. C. 354.
(*c*) (1890) 7 R. P. C. 455.
(*d*) (1895) 12 R. P. C. 543; in the House of Lords 15 Dec., 1896.
(*e*) (1891) 8 R. P.C., at p. 336.
(*ee*) *Supra*.
(*f*) (1889) 6 R. P. C. 518.
(*g*) (1897) 1 W. P. C. 200.
(*u*) (1892) 9 R. P. C. 516.
(*v*) (1891) 9 R. P. C. 77.
(*y*) (1890) 7 R. P. C. 131.

was discovered, the Courts struggled to support it; see, e.g. *Crane* v. *Price* (*h*). It may be questioned whether, in principle, this was correct. No *new manufacture* was produced. (4) Under this state of the law many discoveries would be admitted to patent rights which were not within the spirit of sect. 6 of the Statute of Monopolies, and a test between the good and the bad was needed. Novelty and Merit were usually the touchstones, and Ingenuity was a proof of either. Hence meritorious discoveries of analogous uses, especially when the novelty of the use was marked and the difficulty of arriving at it great, were protected, others were rejected. This is the state of affairs between 1857 and 1880. Finally (5) ingenuity or invention is of itself taken as the test of merit that will support a patent for an analogous use. From "analogous users" ingenuity, as a requisite, has spread to every class of alleged invention.

If this be true, it follows that "ingenuity" is a requisite to be treated distinct from novelty, but one which has been added to patent law by modern Judges (*i*). It is a counterpoise, so to speak, to the admission of "analogous use" on the subject-matter of a patent. It is justified by the words of sect. 6 of the Statute of Monopolies, and is now firmly fixed in our law. A comparison of the language of Lord Abinger in *Losh* v. *Hague* and of Lord Justice Lindley in *Gadd* v. *Mayor, etc., of Manchester*, gives an excellent idea of the contrast between the law in the "thirties" and in the year 1892.

Nevertheless, in reality, "ingenuity" is often but a variation of the novelty issue, and in all cases a requisite akin to novelty. The question, when want of ingenuity is alleged, is not whether the discovery or invention is a "*manufacture*," but is it so far out of the track of previous inventions as not to be the mere result suggested by previous effort? In other words, is it a *new* manufacture?

The present state of the law.

The present state of the law was laid down by Lindley, L.J., in *Gadd* v. *Mayor of Manchester* (*k*), as previously stated (*l*).

In *Penn* v. *Bibby* (*m*), Lord Chelmsford stated the test thus:

(*h*) (1842) 1 W. P. C. 393; 4 M. & G. 580; 12 L. J. C. P. 81.

(*i*) But see Kay, L.J., in *Thierry* v. *Rickmann* (Dec., 1895), 12 R. P. C. 543, 548.

(*k*) (1892) 9 R. P. C., at p. 524.

(*l*) *Ante*, p. 94; see also *Morgan* v. *Windover* (1890), 7 R. P. C. 131, a case which was heard in the House of Lords, and which was to the same effect.

(*m*) (1866) 2 Ch. 127, 136; 36 L.J. Ch. 455.

"A main consideration is whether the new application lies so much out of the track of the old, as not naturally to suggest itself to a person turning his mind to the subject, but to require some application of thought and study."

Slight amount of invention may suffice.

But the validity of the patent does not depend upon the *amount* of ingenuity, provided only that there be some real ingenuity. "Where a slight alteration in a combination turns that which was practically useless before into that which is very useful and important, Judges have considered that, though the invention was small, yet the result was so great as fairly to be the subject of a patent" (*n*). Bramwell, L. J., spoke to the same effect in *Haygarth* v. *Hamilton* (*o*), and Lord Herschell in *Vickers* v. *Siddell* (*p*). In short, though to maintain a patent there must be a substantial exercise of the inventive powers, it may be that slight alterations are proof of ingenuity (*q*). Nor does it always matter whether the improvements are the result of a sudden happy idea or of prolonged study and experiment (*r*).

Whether or not an alleged invention is sufficiently ingenious is a question of fact (*s*).

Tests of invention.

Amongst tests may be noted: (1) usefulness (*t*) (of itself not always proof of ingenuity (*u*)), especially when others failed to produce the results (*x*); (2) a demand for the article or process —this is matter for consideration (*y*), especially if the want of the thing was felt before the invention was discovered. That skilled workmen could have made the article in question without much difficulty goes strongly against the ingenuity of the patented invention; though if for many years the want was felt, and yet no skilled workmen, in fact, produced the invention, there is strong evidence in favour of the requisite ingenuity (*z*).

(*n*) Jessel, M. R., in *Hinks* v. *Safety Lighting Co.* (1876), 4 Ch. Div. 607; 46 L. J. Ch. 185.

(*o*) (1879) Griff. P. C. 115.

(*p*) (1890) 15 A. C. 496; 60 L. J. Ch. 105; 7 R. P. C. 292.

(*q*) *Williams* v. *Nye* (1890), 7 R. P. C. 62.

(*r*) *Longbottom* v. *Shaw* (1891), 8 R. P. C. 333, 337.

(*s*) *Gadd* v. *Mayor of Manchester* (1892), 9 R. P. C. 516; *Goddard* v. *Lyon* (1893-4), 10 R. P. C. 334; 11 R. P. C. 354; *Morgan* v. *Windover* (1890), 7 R. P. C. 131; *Cropper* v. *Smith* (1884), 26 Ch. Div. 700; 53 L. J. Ch. 891; 1 R. P. C. 81, 90; *Saxby* v. *Gloucester Waggon Co.* (1883), 7 Q. B. D. 305; 50 L. J. Q. B. 577; Griff. A. P. C. 54.

(*t*) *Elias* v. *Grovesend Tinplate Co.* (1890), 7 R. P. C. 455, 461; *Thierry* v. *Rickmann* (1895), 12 R. P. C. 412.

(*u*) *Morgan* v. *Windover* (1890), 7 R. P. C. 131; *Sudbury* v. *Lee* (1894), 11 R. P. C. 58.

(*x*) *Duckett* v. *Whitehead* (1895), 12 R. P. C. 376.

(*y*) *Longbottom* v. *Shaw* (1891), 8 R. P. C. 333, 336, 337; and see per Lord Herschell in *Thomson* v. *American Braided Wire Co.* (1889), 6 R. P. C. 518.

(*z*) *Dowling* v. *Billington* (1890), 7 R. P. C. 191.

Recent decisions.

The following are some recent decisions which may be useful as illustrating the above statement of law:—

Gadd v. *Mayor of Manchester* (*a*). Plaintiffs were the patentees of improvements relating to gas holders. The object of the invention was to support a rising gas holder in a vertical position without the aid of the vertical framework usually employed. It was alleged that the mechanism employed had previously been used for guiding pontoons, and that there was no invention in applying to gasometers an idea which had already been applied to pontoons. But the Court (Lopes, L. J., *dubitante*) upheld the patent on the ground that, in adapting the method to gasometers which had hitherto been in use for pontoons, there were practical difficulties to be overcome, and that the mode of overcoming them would be by no means obvious to persons of ordinary skill acquainted with gasometers.

Goddard v. *Lyon* (*b*). Plaintiff's patent was for an apparatus for purifying, disinfecting, &c. It consisted of an arrangement of an inner chamber into which steam was admitted, and the surrounding of the inner chamber by a steam jacket, also heated by steam. The steam in the inner chamber, at a certain degree of pressure, penetrated the articles to be disinfected and purified them without damage. A previous disinfector had been made, which closely resembled the plaintiff's invention, but was unsuitable for the use of steam in the inner chamber, save at a much lower pressure than was possible in the plaintiff's chamber. The door of the earlier apparatus would have burst open if the pressure had exceeded a certain measure; the door of the plaintiff's would stand the pressure. High pressure steam was very advantageous for disinfecting processes such as those in point. It was held that, though the actual change was but small, the unquestionable utility of the result and the fact that it had never before been attained was evidence from which the requisite ingenuity could be inferred (*c*).

In *Blakey* v. *Latham* (*d*) the patent was for an improved heel plate for boots and shoes. Formerly the heel plate was attached

(*a*) (1892) 9 R. P. C. 516. A comparison of this case with *Harwood* v. *Great Northern Railway* (1865), 35 L. J. Q. B. 27, 11 H. L. C. 654, shows how entirely the question is one of fact.

(*b*) (1894) 11 R. P. C. 355.

(*c*) Amongst other recent cases in which the Court has supported patents attacked for want of ingenuity, see *Vickers* v. *Siddell* (1890), 15 A. C. 496; 7 R. P. C. 292; *Edison-Bell Phono-graph Co.* v. *Smith* (1894), 11 R. P. C. 389; *Duckett* v. *Whitehead* (1895), 12 R. P. C. 376.

(*d*) (1889) 6 R. P. C. 184.

to the heel of the boot by means of nails driven through holes in the heel plate; the plaintiff made the heel plate and projecting prongs in one piece, so that the prongs could be driven into the boot and then the plate would be fixed. Prior to the date of the patent, toe plates existed with two prongs solidly fastened to the inner surface of the plate. The Court decided that, in view of this, the plaintiff's discovery showed no invention.

Longbottom v. *Shaw* (*e*) has already been referred to (*f*). The invention claimed was the formation of a row of hooks upon a foundation piece of metal, either by stamping the hooks out of the metal or by soldering the hooks on to the metal in a groove, and then attaching the row of hooks so formed to a reel or frame for the purpose of holding pile. Reels or frames with a row of hooks were admittedly old, and the idea of attaching a row of hooks to a strip of metal so that the strip could be applied where required. It was decided that the application of a strip of metal with hooks to reels or frames for the purpose of holding pile lacked ingenuity and was not patentable.

In *Lancashire Explosives Co., Ltd.* v. *Roburite Explosives Co., Ltd.* (*g*), the patent was for an explosive made by mixing solid nitrate of ammonia with dinitrobenzene, when the latter was liquefied by heat, so that on cooling the latter formed round the former a non-hygroscopic coating. A prior specification mentioned the subjects used, another described the coating of a nitrate by a hydrocarbon—not nitrated. The Judge considered, as a result of the evidence, that a chemist conversant with explosives would suppose that the ingredients used would be explosive if mixed as described, and that if solid particles be carefully treated with a liquid substance such as that used they would be completely coated thereby; hence he decided that the plaintiff's patent failed for want of invention. His decision was reversed on appeal.

Shaw v. *Barton* (*h*). Here the patent was for improved wire rings suitable for securing elastic tyres on bicycles, the main feature of the improvement being a particular form of joint. Joints of the kind claimed had been previously used in wirework for lamps and other purposes, but the plaintiff claimed that there was invention in the application to bicycle wheels, as in such

(*e*) (1891) 8 R. P. C. 333.
(*f*) *Ante*, p. 82.
(*g*) 1895, 12 R. P. C. 393, 470; 13 R. P. C. 429.
(*h*) (1895) 12 R. P. C. 282.

wheels the strain on the joint was very great. It was shown, however, that such joints had been used for centrifugal machines revolving at the rate of 1,000 turns a minute; hence Stirling, J., decided that there was not sufficient invention in plaintiff's application to support a patent. He said: "To a person acquainted with the state of knowledge in the wire trade at the time, the only problem that would suggest itself .... was whether materials, such as steel and solder, could be found of sufficient tenacity to make a joint suitable for use in bicycle tyres. This might require experiment, but does not seem to me to call for the degree of invention necessary to support a patent. The explanation of the failure of bicycle-makers to make use of the joints appears to be that they were not aware of what had been done by wire-workers" (*i*).

Sect. IV.—Utility.

Utility necessary to support a patent.

The ground on which patents are granted (*k*), the common law (*l*), and the recorded decisions under the Statute of Monopolies (*m*), make it clear that the subject-matter of a valid patent grant must be "useful and beneficial to the public." The absence of utility will be fatal to the patent (*n*). The statute does not in terms mention this requisite, but utility was necessary to support a patent at common law, and has since the statute been required to satisfy the requirement that the patent shall not be contrary to law or mischievous to the State (*o*).

The term "utility" as used in patent law is difficult satisfactorily to define. In *Young* v. *Rosenthal* (*p*) (an action for the infringement of a patent for improvements in stays and corsets), Mr. Justice Grove charged the jury in the following

(*i*) See also *Cole* v. *Saqui* (1889), 6 R. P. C. 11; *Sudbury* v. *Lee* (1894), 11 R. P. C. 58.

(*k*) See Form of Grant, *post*, p. 667.

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

(*m*) *Darcy* v. *Allin* (1602), Noy, R. 182; *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. 318; *Hill* v. *Thomson* (1817–18), 8 Taunt, 401; 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; 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* (1843), 1 Web. P. C. 623; *Poe* v. *Taunton* (1844), 9 Jur. 1056; *Simpson* v. *Holliday* (1864), 20 New Lon. Jour. N. S. 105. 120.

(*n*) *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 R. P. C. 8.

(*o*) *Elias* v. *Groresend Tin Plate Co.* (1890), 7 R. P. C. 455, 467.

(*p*) (1884) 1 R. P. C. 29, 34.

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.

Lindley, L. J., thus refers to utility (*q*): "The utility of the alleged invention depends not on whether by following the directions in the complete specification all the results now necessary for commercial success can be obtained, but on whether by such directions the effects which the patentee professed to produce could be produced, and on the practical utility of those effects. . . . . To judge of the utility the directions in the amended specification must be followed, and, if the result is that the object sought to be attained by the patentee can be attained, and is practically useful at the time when the patent is granted, the test of utility is satisfied. Utility is often a question of degree, and has always reference to some object. 'Useful for what?' is a question which must be always asked, and the answer must be, useful for the purpose indicated by the patentee" (*r*). In *Wilson* v. *Union Oil Mills* (*s*) Charles, J., stated as the test of utility, does the invention when put into practice by a competent man do what it assumes to do? (*t*).

It is not necessary that a patent should be useful, commercially considered. In *Badische Anilin und Soda Fabrik* v. *Levinstein* (*u*) Lord Halsbury said: "The element of commercial pecuniary success has, as it appears to me, no relation to the question of utility in patent law generally, though of course where the question is of improvement by reason of cheaper production, such a consideration is of the very essence of the patent itself, and the thing claimed has not really been invented unless that condition is fulfilled . . . . if in considering generally the requirement of utility there is an obligation to make it clear that the patent will be commercially successful and so profitable to the patentee, the burden is so great that no patentee could discharge it." Lord Herschell says (*x*): "I do not think it Commercial utility not necessary.

(*q*) *Lane Fox* v. *Kensington, &c., Co.* (1892), 3 Ch. 424; 9 R. P. C. 417.

(*r*) See per Tindal, C. J., in *Cornish* v. *Keene*, 1 W. P. C. at p. 506; *Edison* v. *Holland* (1889), 6 R. P. C. 243; *Badische Anilin* v. *Levinstein* (1887), 12 A. C. 712, 719, 720; 4 R. P. C. 449.

(*s*) 1892, 9 R. P. C. at p. 70.

(*t*) See for an example, *Turner* v. *Winter* (1785), 1 T. R. 602; 1 W. P. C. 77; *Manton* v. *Parker*, Dav. P. C. 337; 1 W. P. C. 192, n.

(*u*) (1887) 12 A. C. 712, 719, 720; 4 R. P.C. 449.

(*x*) P. 719.

is a correct test of utility to inquire, whether the invented product was at the time of the patent likely to be in commercial demand, or capable of being produced at a cost which would make it a profitable speculation to manufacture it" (*y*). In *Edison* v. *Holland* (*z*) Cotton, L. J., said: "I am afraid we cannot consider commercial utility; it is a new term in patent law."

In *Neilson* v. *Harford* (*a*), Parke, B., said that 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 the invention. But the comparison between expense and result must not be pushed too far.

In *Tetley* v. *Easton* (*b*), it was stated that 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.

The relation of utility to cost.

In *Wilson* v. *Union Oil Mills Co.* (*c*), Charles, J., said: "A patent may be a patent for a useful article; it may satisfy the condition of utility although it may be so expensive as to be commercially useless. That is not the test at all. The question is, does it do when put in practice by a competent man what it assumes to do? That is the test of utility" (*d*).

Non-user is consistent with utility.

Utility may be provable though the invention has not actually been used (*e*). The question is, can it be used for the purpose intended? 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 (*f*). 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 (*g*).

Utility in every part not always necessary.

It is not always necessary that there should be utility in every part of the invention (*h*), and where there is general utility in an

(*y*) See also *Siddell* v. *Vickers* (1888), 5 R. P. C. 96.

(*z*) (1889) 6 R. P. C. at p. 257.

(*a*) (1841) 1 W. P. C. at p. 341.

(*b*) (1882) Macr. P. C. 63.

(*c*) (1892) 9 R. P. C. at p. 70.

(*d*) And see *Badische Anilin Co.* v. *Levinstein* (1887), 12 A. C. at p. 719; 4 R. P. C. 449.

(*e*) *Macnamara* v. *Hulse* (1842), Car. & M. 471; 2 W. P. C. 129, n.

(*f*) *Edison* v. *Holland* (1889), 6 R. P. C. 277: *Thompson* v. *Batty* (1889), 6 R.P.C. 84, 100.

(*g*) See *Renard* v. *Levinstein* (1884), 11 L. T. N. S. 505; *Otto* v. *Linford* (1881), 46 L. T. N. S. at p. 41; *United Telephone Co.* v. *Bassano* (1886), 3 R. P. C. at p. 313; *Edison* v. *Holland*, sup.

(*h*) *Lewis* v. *Marling* (1829), 10 B. & C. 22; 1 W. P. C. 493; *Morgan* v. *Seward* (1837), 1 W. P. C. 197; *Fearson* v. *Loe* (1878), 9 Ch. D. 48.

invention, it is necessary to show very little utility to support a second claim, which is only subsidiary; it is not a fatal objection to the patent that one part of the claim is not so useful as the other (*i*).

In *Haworth* v. *Hardcastle* (*k*) (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." The verdict was entered for the plaintiff, and was subsequently supported by the Court of Common Pleas.

But if a part of the invention is separately and distinctly claimed, and as an integral part of the invention, the non-utility of that part may be fatal (*l*); this rule, however, is not construed very harshly against patentees (*m*).

Utility with regard to the purpose of the invention is required.

It will not suffice that an invention is found useful for certain purposes, if it fail to have utility in regard to the purpose for which it is taken out. In *Cornish* v. *Keene* (*n*), Tindal, C. J., 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." This, in effect, is a statement that the invention itself, and not merely the result of the invention, must be useful.

Amount of utility.

The amount of utility necessary to support a patent need not be very large. "It has been decided over and over again that the slightest amount of utility (I will not say an infinitesimal scintilla, but a very slight amount of utility), is sufficient to sustain a patent." So said Grove, J., in *Philpott* v. *Hanbury* (*o*).

(*i*) *Ehrlich* v. *Ihlee* (1888), 5 R. P. C. 203, 455. See also the remarks of Lord Herschell pending the argument in *Vickers* v. *Siddell* (1895), 15 App. Ca. 496; 60 L. J. Ch. 105; 7 R. P. C. 292. Also *Miller* v. *Barker* (1893), 10 R. P. C. 106.

(*k*) (1834) 1 W. P. C. 483; 1 Bing. N. C. 182; 3 L. J. C. P. 311

(*l*) *United Horseshoe and Nail Co.* v. *Swedish Horse Nail Co.* (1889), 6, R. P. C. 1, 8; *Templeton* v. *Macfarlane* 1 H. C. L. 595. And see *Easterbrook* v. *G. W. Railway* (1885-6), 2 R. P. C. 201; 3 R. P. C. 94.

(*m*) *Ehrlich* v. *Ihlee* (1888), 5 R. P. C. 455; *Otto* v. *Linford* (1881), 46 L. T. N. S. 39.

(*n*) (1835) 1 W. P. C. 506.

(*o*) (1895) 2 R. P. C. at p. 37.

Chatterton, V.-C., in *Pirrie* v. *York Street Flax Spinning Co.*(p) said: "A very slight amount of utility will be sufficient, provided it does not appear that the Crown has been deceived as to the extent of the utility of the invention" (q).

But there are limits; and on this point the case of *Easterbrook* v. *Great Western Railway Co.* (r), is instructive. It was an action for the infringement of a patent for "improvements in machinery or apparatus for actuating and controlling railway points or signals," and 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 Leith, 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, the patent should not be invalidated 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. 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."

A question of fact.

The utility of an invention is a question of *fact* (s). Where the Judge of first instance held on the evidence that there was utility the Court of Appeal refused to disturb his judgment (t).

(p) (1893) 10 R. P. C. at p. 39; Affd. 11 R. P. C. 429.

(q) See also per Lord Halsbury in *Badische Anilin, &c., Co.* v. *Levinstein* (1887), 12 A. C. at p. 712; 4 R. P. C. 449.

(r) (1885-6) 2 R. P. C. 201; 3 R. P. C. 94.

(s) *Hill* v. *Thompson* (1817), 3 Mer. 626; 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.

(t) *Siddell* v. *Vickers*, supra et p. 430; *Erhlich* v. *Ihlee* (1888), 5 R. P. C. 25; *Cole* v. *Saqui* (1888), 5 R. P. C. 495.

A large sale is good evidence of utility (*u*). So also is the fact that the patent has been infringed. In *Lucas* v. *Miller* (*x*), Kay, J., said: "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 utility of an invention cannot possibly be had than the fact that the defendant has attempted to infringe it" (*y*).

Pecuniary success, especially where the value of an improvement claimed rests wholly or partially upon increased cheapness in production, is cogent evidence of utility (*z*). But want of pecuniary success is not inconsistent with utility (*a*).

Sect. V.—Miscellaneous.

An invention which is "mischievous to the State, to the hurt of trade, or generally inconvenient," cannot by the very terms of the Statute of Monopolies be the subject-matter of a valid patent. Thus it has been said, a patent taken out so extensively as to deprive mechanics of the materials used in their trades (*b*), or a claim to *methods that may thereafter be discovered* of arriving at the result patented (*c*), or any patent for illegal inventions, such as a housebreaker's implement, would be invalid (*d*).

(*u*) *Moss* v. *Malings* (1886), 3 R. P. C. at p. 378; *Cole* v. *Saqui* (1888), 5 R. P. C. 459.

(*x*) (1885) 2 R. P. C. 155.

(*y*) See also *Miller* v. *Barker* (1893), 10 R. P. C. 106. 111.

(*z*) *Cole* v. *Saqui* (1888), 5 R. P. C. 495: *American Braided Wire Co.* v. *Thomson* (1888), 5 R. P. C. 113: *Ehrlich* v. *Ihlee* (1888), 5 R. P. C. at p. 205: *Siddell* v. *Vickers* (1888), *ibid.* 96; *Edison Co.* v. *Holland* (1889), 6 R. P. C. 257.

(*a*) 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 R. P. C. at p. 313; *Goulard* v. *Gibbs* (1886), 5 R. P. C. 536; see also under Extension of Patents, *post*, p. 496.

(*b*) Godson, p. 87.

(*c*) Cp. *Walton* v. *Potter* (1841), per Tindall, C. J., 1 Web. P. C. 601; 3 M. & G. 411; 11 L. J. C. P. 138; *Crossley* v. *Potter* (1853), Macr. P. C. 215: *Curtis* v. *Platt* (1863), per Lord Westbury, 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), L. R. 3 App. Cas. 34.

(*d*) Hindmarch, p. 142.

CHAPTER IV.

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*).

Petition and declaration lodged at Home Office.

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

(*a*) The account given above is applicable to the practice as it existed prior to the Patent Law Amendment Act, 1852. There is, however, no reason to suppose that the procedure of the sixteenth century, under which the first monopoly patents were granted, differed materially from the above so far as the formal stages were concerned. In the reign of Elizabeth petitions were presented to the Queen either personally, or through some influential friend of the applicant, or again through the State Secretary. The business of the monopolies was largely the work of the Queen and Cecil, according to whose instructions, based upon preliminary agreements with the applicants, the law officers prepared the requisite instruments. The conditions, subject to which the grant was finally issued, differed materially according as the applicant was of native or foreign extraction, or again as the industry proposed to be introduced was of an experimental nature, or new only as regards practice within the realm. It was usual to bind foreigners to come over within a stated period and to take and instruct a certain number of native apprentices in the new industry. In process of time, however, the form of the grant became stereotyped, and the patent issued more or less as a matter of course, provided the applicant was in a position to pay the fees exacted at the various stages. In the eighteenth century the whole theory of patent law was revolutionised by the introduction of the patent specification rendering a corresponding revision of the procedure a matter of necessity. The pitiless criticism of the system by Bentham in his "Manual of Political Economy," Chap. III., and of Dickens in his Poor Man's Tale of a Patent, brought the cause of patent law reform within the sphere of practical politics, and eventually secured the passing of the Patent Law Amendment Act of 1852.

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* (*c*) as an authorization for the preparation of the Queen's Bill. 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* (*d*) to be passed (*e*). 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 (*f*), whose duty it was (*e*) to pass the Queen's Bill on to the *Privy Seal Office* within eight days after its receipt at the Signet Office. 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 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* (*g*), and in due course the impression of the Great Seal was attached to it.

Reference to Attorney-General.
Report of Attorney-General.
Queen's Warrant.
Patent Bill Office.
Queen's Bill.
Signet Office.
Privy Seal Office.
Patent Office.
Lord Chancellor's Office.

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

(*c*) 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.

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

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

(*f*) 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.

(*g*) 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.

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 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 January 1st, 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 Office, no acknowledgment was demanded. (2) After 1 & 2 Vict. c. 94, the Rolls Office became a branch of the Public Record Office, created by the 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 January 1st, 1849, all specifications were, by order of Lord Langdale, M. R., enrolled at the Enrolment Office.

Enrolment Office.

Petty Bag Office.

Office of Rolls Chapel.

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.

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, which resulted in the Patent Law Amendment Act, 1852 (*i*).

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 accordingly they ordered (*k*) that their office should be combined with the Great Seal Patent Office (*l*): 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 for information in all stages of the patent (*l*).

One office for patents.

(*i*) This Bill originally contained a provision for the appointment of examiners, which, however, was struck out in Committee. The question of preliminary examination was apparently left to the discretion of the Commissioners, who at one time had under consideration a proposal to enlist the voluntary services of three experts to be selected from the Royal Society, the Chemical Society, and the Institution of Mechanical Engineers. Cf. *Bramwell, Expediency of Protection for Inventions*, 1875, p. 54. In connection with this vexed question of examination, it may be worthy of note that in the reign of Charles II. "Sir Robert Moray gave an account of His Majesty's favour to the Royal Society in declaring his pleasure that no patent should pass for any philosophical or mechanical invention but what was first put to the examination of the Society" (Birch, "Hist. Royal Society," i., p. 116). Hence the "Philosophical Transactions" and MS. journals of the Society are valuable sources of reference in investigating patents for inventions of the period.

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

(*l*) The offices originally provided were the ground-floor rooms of the

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

Under the Act of 1852, the work of the Patent Office was as follows:—It was divided into several departments: *the front public office*, in which applications, &c., were left, and where office copies might be obtained or specifications inspected; the *registry office*, where documents were registered before being transmitted to the law officers; the *printing department*, under the superintendence 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 prior to sending to the Record Office.

Procedure under Act of 1852.

The procedure consisted of several stages (*m*). 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 the House of Lords to be sealed, and thereafter were returned to the Patent Office, and kept till the agents or patentees called for them. Letters patent were often kept 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 offices. Besides this "forwarding work," as it was called, the Patent Office prepared and published specifications, indexes, and abridgments, and the Commissioners of Patents Journal.

Official Publications.

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 reconstruction of the staff of the Office of the Commissioners of Patents, and as to the formation of a property

offices in Southampton Buildings, Chancery Lane, theretofore occupied by the Masters in Chancery, abolished by 15 & 16 Vict. c. 80. 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.

(*m*) For a tabular statement of the procedure, see p. 309, note (*b*), where an extract from the Register of Patents is given.

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 sects. 82 and 83 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 sect. 3 of the Act (*n*).

Comptroller-general.

The whole Office is under the control of the Comptroller-General of Patents (*o*), 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 (*p*): "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 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 (*q*) 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."

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

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

(*n*) See First 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.

(*o*) Sir H. Reader Lack was appointed, but is about to retire (February, 1897).

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

(*q*) 50*l*.

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. 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 (*r*).

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 through one of the examiners to the letter department, where a letter is drafted from the 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.

(*r*) Under sub-sect. 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 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 claim 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.

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 is 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 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.

In accordance with sect. 41 of the Act of 1883, the Patent Museum and its contents were, on January 1st, 1884, transferred to the Science and Art Department, South Kensington, under whose management it has since remained (*s*). It no longer forms

Patent Museum transferred to Science and Art Department.

(*s*) 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 (Report, &c., 1865, pp. 116 *et seq.*). 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 (Bennet Woodcroft's evidence, *ibid.* at p. 3), at that time Professor of Machinery at University College, had a collection of models, partly belonging to himself and partly

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 (*l*). This power is rarely, if ever, exercised at the present time.

Models.

Publications of the Patent Office.

The publications of the Patent Office, both from their bulk and intrinsic value, deserve some notice. The history of the Old Law Specifications Series (*m*), which ranges from A.D. 1617 to

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*l.* 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.

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

(*m*) Down to the end of 1873 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 volumes of 200 for distribution among public libraries, &c., and each volume 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 1883 Act. The number of these applications which never become patents now exceeds 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* 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 at the cost of the purchaser.

September 30th, 1852, is somewhat curious. The series is based on the calendars of grants kept by an officer with the title of Clerk of the Patents—an office which existed some years prior to 1617, but to which at that date certain additional duties were attached. From these calendars, which were kept at the old Patent Office in Quality Court, and which were afterwards transferred to the Record Office, the first two volumes of chronological indexes, or rather calendars, were prepared. The specifications, or in lieu of these the text of the actual grants, were transcribed from the originals at the Record Office, and were printed with admirable despatch. For historical purposes, however, it is important to remember that the series has been prepared from a calendar of secondary importance, necessitating in case of doubtful grants reference to the original patent rolls, with their respective calendars and name indexes. The petitions, which in many cases are of greater value than the grants themselves, must be sought either in the State Papers or in the Petition Entry Books. So far, however, as the literature of the patent specification is concerned, the official series may claim to be practically complete. The publication of the chronological indexes (*e*) was discontinued in 1868, the information being practically duplicated in the Official Journal (*g*) and elsewhere. The annual

(e) 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.

(g) The following is a list of the journals of the Patent Office, past and present:—

(1) Commissioners of Patents Journal, 1851—1883. 38 vols. imp. 8vo.

(2) Official Journal of the Patent Office, 1881—1888. 10 vols. imp. 8vo.

Continued now in the Illustrated Official Journal (5).

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

Continued now in Illustrated Official Journal (5).

(4) Reports of Patent Cases (after vol. 3. including Reports of Design and Trademark Cases), 1884—1888. 5 vols. imp. 8vo.

Continued now in Illustrated Official Journal (5).

(5) Illustrated Official Journal (Patents), incorporating Nos. (2), (3), and (4). 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 information 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 Report of Patent Cases, *both new publications*, were issued, the latter originally as a supplement to the Official Journal, but subsequently as a separate publication.

name and subject indexes (*z*) have been continued without interruption to date. A fuller account of these and other publications is given below. The attention of the inventor, however, should be drawn to the Key, or reference index to the publications of the Patent Office. This useful guide directs the searcher at once to the specific heading in the current subject-matter indexes and to the Abridgment Class, under which any particular invention is dealt with. These classified abridgments (*a*) being now almost abreast of the current issue, and, moreover, being distributed throughout the leading libraries of the United Kingdom, an inventor is enabled to make a useful, if not an entirely complete, search as to the novelty of his invention with a facility which contrasts favourably with the opportunities afforded him at any previous period in the history of patent law, either in this or any other country.

Sale Office. The Sale Office took the place of the Stationery Office in 1883 as the sole office for the sale of the Patent Office publications. In 1894 the Office was removed from 38, Cursitor Street, to 8

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—(1) a name index of all applications for the year; (2) a *record of all official stages* through which an application has to pass; (3) an illustrated abridgment of accepted complete specifications; (4) reports of all patent cases occurring in the year.

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

(1) Subject-matter Index of Patents of Invention, A.D. 1617—1852, two parts (prepared from titles only).

(2) 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 1871–1873 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.

(3) Subject-matter Index of Applications for Patents, 1884—1888 (discontinued after this date).

(4) Subject-matter Index of Accepted Complete Specifications.

(5) Monthly Consolidated Subject-matter Index.

(*a*) *Abridgments* (in classes and chronologically arranged) of specifications of patented inventions from the earliest enrolled to date. The abridgments (unillustrated) were issued in 12mo size, and are for the most part brought down to the year 1876. The prefaces of the earlier volumes in most cases contain a valuable introduction to the history of the art, and are often of considerable literary and antiquarian value. With the year 1877 the new series of illustrated abridgments commences. The periods 1877—1883 and 1884—1888 are now completed; those for 1889—1892 and 1893—1899 are in course of preparation. The volumes are of imp. 8vo size, and are published at the uniform price of 1*s.*

more convenient site in Quality Court, adjoining the buildings of the Patent Office.

Contents of library.

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

(*b*) In March, 1855, the Commissioners of Patents established a public library of research within the Patent Office. The library contains the most complete collection of English, colonial, and foreign patent literature in existence in any country, besides possessing a valuable selection of works relating to the applied sciences. It is especially rich in its collection of periodical, technical, and scientific literature. The library was removed to its present position on the second floor of the building in 1866. It was again extended in 1886, and thrown open to the public from 10 a.m. to 10 p.m. The annual number of its readers now exceeds 100,000.

CHAPTER V.

OUTLINE PROCEDURE TO OBTAIN A PATENT (*a*).

Scope of chapter.

It is proposed in this chapter to give a general account of the procedure to obtain letters patent, without any detailed 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.

Form of application.

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 at Room No. 6, Inland Revenue Department, Royal Courts of Justice, or through any money order office in the United Kingdom (*b*).

Declaration and Petition.

The application (see Form A to Patents Rules, 1890, Appendix, *post*, p. 805) 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 (*c*).

(*a*) See the Patents, &c., Acts, sects. 4—10, and notes, *post*, pp. 549 *et seq.*, also Patent Rules, *post*, p. 689.

(*b*) The circular of the Patent Office contains an abstract of the procedure referred to in this chapter.

(*c*) In the petitions for patents prior to 1852 a declaration on the part of the applicant of his intention to work the patent and an indication of the beneficial effects anticipated therefrom formed a not uncommon feature of these documents. By the Patent Law Amendment Act, 1852, the form was stereotyped to a declaration by the inventor that the invention claimed would prove "of great public utility." a statement which assumes the inventor's intention to work the grant. By the Act of 1883, however, the inventor is confined to a declaration of novelty. The obligation, therefore, to work the grant has, apparently, disappeared from English patent jurisprudence.

Communications from abroad.

Advantage is often taken of the law as to importation by agents 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.

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 authorised 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 (*d*), 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 for a British patent 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. 807), and must be accompanied by duplicate copies of the specifications, 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. This declaration must be made before a British Minister or person exercising the functions of a British Minister or a consul, vice-consul, or other person exercising these functions or before a notary public, a Judge, or a magistrate.

Provisional or complete specification?

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

(*d*) An official notice draws attention to the fact that in all cases of applications signed on behalf of bodies corporate the seal of the company shall be duly affixed.

(*e*) For forms, see p. 808.

Advantages of filing provisional specification with application.

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

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) through fear of anticipation 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 (*f*), 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

(*f*) See, *e.g.*, *Hearson's Application* (1884), Griff. P. C. 265. (1885), Griff. P. C. 266; *Jones' Patent*

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; nor can he obtain an injunction in respect of past Acts, though these may be treated as evidence of intention to infringe in future, and so be used if an action is brought to protect the patent when granted.

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, and the right to use the words "patent," "patented" (cf. below, pp. 656, 657).

Infringements committed after the acceptance of the complete specification are actionable; and an action may be brought whenever a patent has been sealed.

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 on 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.

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.

Date and number of application.

Communications through post.

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

The application and all subsequent stages are 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. Applications of the same date are co-equal as to priority irrespective of the number.

First reference to examiner. Examiner's report.

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.

No report as to novelty or utility.

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. His report is not binding on the comptroller (*g*).

Refusal of patent.

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.

Amendment required.

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.

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 (*h*).

Acceptance of application, &c.

If 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 invention. If the examiner reports in the affirmative, the comptroller is 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" as they were called.

(*g*) *Re C.'s Application* (1890), 7 R. P. C. 250.

Former notices of interference.

(*h*) See pp. 710, 817. 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

application and the name of the applicant are advertised in the Illustrated Official Journal (*i*).

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 nine months (*k*) 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*. Joint applicants may file a specification agreed upon between themselves, as the comptroller cannot accept two specifications with different words as the same application (*l*).

When provisional specification left in first instance.

Filing of complete specification subsequently.

Extension of time.

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

Abandoned application.

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

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.

The complete specification.

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.

Report of examiner.

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.

Unless a complete specification is accepted within twelve months from the date of application (save in the case of an

Complete specification must be accepted in twelve months.

(*i*) In case of any alteration in the title of the application it is again advertised in full.

(*k*) Calendar months reckoned exclusive of the day of application: *Lucas'l v Ledsam* (1845), 14 M. & W. 574; 14 L. J. Ex. 353; *Williams* v. *Nash* (1859), 28 Beav. 93; 28 L. J. Ch. 886.

(*l*) Application of *Apostoloff and Freudenberg* (1896), 13 R. P. C. 275.

appeal having been lodged against the refusal to accept) the application becomes void.

Extension of time.

The comptroller may, 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 specification not filed.

When an application is accompanied with a complete specification 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.

Acceptance of complete specification.

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.

Specification printed.

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.

Inspection.

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.

Printed copies of complete specifications may be purchased at the Patent Office Sale Branch in Quality Court at the uniform price of 8*d*. These can also be obtained by forwarding through the post patent form C1—*i.e.*, a post-card obtainable at the money order offices, price 8½*d*. each.

Sealing.

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

Opposition:

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:—

(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 (*m*), which 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*.

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. Who may oppose.

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

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. Statutory declarations.

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.

No further evidence may be left on either side except by leave Further evidence.

(*m*) Appendix, *post*, p. 809.

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 (*n*) 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

(*n*) See Form T, *post*, p. 817.

in the matter to which the appeal relates, unless, in his opinion, there is good ground for not making such order.

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 such 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.

Conduct-money.

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.

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.

Enforcement of order for costs.

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 £1.

If no opposition be entered, or if opposition, though entered, be 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.

Sealing of the patent.

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.

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

Delay in sealing patent.

(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, and certain fees paid (*o*).

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 (*p*) 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 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

(*o*) See *post*, p. 711.

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

	£
For an enlargement not exceeding 1 month	1
" " " 2 months	3
" " " 3 months	5

Form F, Patents Rules, 1890 (*q*), 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 (*r*). Any person may give notice at the Patent Office of opposition to the amendment. Such notice should be in Form G, Patents Rules, 1890 (*s*), 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 (*t*).

(*q*) See Appendix, p. 810.

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

(*s*) See Appendix, p. 810.

(*t*) See Appendix, p. 815.

CHAPTER VI.

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) *Sufficiency of Complete Specification.*
(2) *The Claims.*
(3) *The Drawings.*
SECT. 5. CONSTRUCTION OF COMPLETE SPECIFICATION.

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 expiration of the patent (*b*). 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

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

(*b*) "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.).

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 have been absolutely void for want of consideration (*c*).

Introduction of proviso for specification.

The description of inventions which were formerly contained in patents was, however, very meagre and unsatisfactory (*d*), and the old 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. The idea was probably suggested either by the Attorney- or Solicitor-General of the day (*e*), or else by some patentee anxious to state clearly the ambit of the invention, and secure his full rights. According to Webster (*f*), the earliest patent containing the proviso for a specification was that granted October 3rd, 1711 (*g*), to John Nasmyth. The specification or description of a patented invention by instrument enrolled is not required neither by the common law nor by the Statute of Monopolies, but is only a condition or proviso which is contained in the patent itself.

Nasmyth's patent, October 3rd, 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 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

James Lee's Patent Act, 1813.

(*c*) Hindmarch, p. 151.

(*d*) See the form of grant, p. 667.

(*e*) Report, &c., 1829; 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 view when provision was made for the enrolment of a separate deed of specification. See the memorandum at end of Nasmyth's Specification, A.D. 1711, No. 387.

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

(*g*) 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. Nasmyth'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 Nasmyth'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.

fifteen months of their dates respectively. An Act of Parliament was obtained dispensing with these provisoes and substituting others, on the ground that if the specifications should be enrolled in the usual manner, foreign agents might obtain copies of them and send them abroad (*h*).

Lord Eldon on Lee's Patent Act.

Referring to this case (*i*), 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.

(*h*) The substituted conditions are of some interest. 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 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 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 (sect. 8). Cf. Report, &c., 1829. "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." Cf. Booth's Act, 1793 (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).

(*i*) *In re Lacy*, Web. P. C. 491.

Endeavours to avoid enrolment of specification.

No private Act of the same kind appears to have passed subsequently (*k*). 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* (*l*), 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 produced. 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, commencing "To all to whom these presents shall come," &c. Forms are given in the Appendix (*m*).

The old method of enrolling specifications and the law applicable thereto were found, for many reasons, to be objectionable. Amongst these were—(1) the difficulty of preserving inventions from foreign piracy (*n*); (2) the difficulty of search (*o*).

(*k*) 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."

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

(*m*) 818-820 *post*.

(*n*) This 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 in order that they might not be sent abroad. 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. See Act of 1883, sect. 44. See Appendix, p. 179 of the Report, &c., 1829.

(*o*) Specifications were originally enrolled in the Enrolment Office, the Rolls

Provisional protection under Act of 1852.

The Patent Law Amendment Act, 1852, which adopted a practice in force in several Continental countries, 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 (*p*). 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 (*q*).

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 (*r*).

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

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 Committee of 1851: "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 particular 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."

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

(*q*) *Ibid.* sect. 8; and see *Ex parte Bates and Redgate*, L. R. 4 Ch. 578; 58 L. J. Ch. 501 (per Lord Hatherley, L. C.).

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

application, but for the period between the date of application and the date of sealing (*s*), and (2) that if the applicant does not leave a complete specification in the first instance he may leave it at any subsequent time within nine months from the date of application (*t*), 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 (*u*).

Provisional specifications of abandoned application now secret.

Under the Act of 1885 (*x*) 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.

Function of the title.

It is the function of a title to disclose in general terms the subject-matter of the invention. Formerly, when no provisional specification was filed, and when the patent was granted subject to the filing in future of a complete specification, the accuracy of a title was a matter of great importance. It fulfilled to a large extent the function of a provisional specification, and disconformity between it and the invention as subsequently disclosed was dangerous, and often fatal to the patent.

Title no longer of great importance.

Since 1852, and especially since the present Act has been in force, the importance of the title has much diminished. It is still required, but (*semble*) its absence does not invalidate the patent (*y*). As an indication to those searching and for catalogue purposes it is still of use. It is also sometimes of assistance towards the construction of a doubtfully worded claim. But it will no longer be construed with the severity at one time usual.

Even before 1852 the degree of variance between title and the disclosed invention which would invalidate a patent was a matter of fact, and not of law; and, as happens in questions of fact, no rule of anything like universal application can be deduced. The decisions, viewed as legal decisions, are diverse and not easily reconcilable.

(*s*) Act of 1883, sect. 14.
(*t*) 1883, sect. 8 (1).
(*u*) 1885, sect. 3.
(*x*) Sect. 4.
(*y*) *Siddell* v. *Vickers* (1890), 15 A. C. 496; 60 L. J. Ch. 105; 7 R. P. C. 292.

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, subject to appeal to the law officer, whose decision is final, unless and until it is amended (*z*) to his satisfaction.

In *Nuttall* v. *Elliott* (*a*), 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. In *Cook* v. *Pearce* (*b*), a 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 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.

Insufficiency *semble*, a ground for refusing a patent.

These cases, although somewhat old, may be taken as examples of the kind of title to which objection may be taken by the examiners.

Brown's patent.

A more recent case is *Brown's Patent* (*c*). Application was made for a patent, the specification being intituled "Improvements in casks and tubs;" the complete specification stated that the invention was applicable to "barrels or other casks, and also to tubs *and analogous vessels* in which the staves are formed with a croze or groove for receiving the head or bottom." The comptroller-general refused to accept the specification unless the words "and analogous vessels" were added to the title or omitted from the specification, on the ground that the title did not, in view of the words "and analogous vessels" in the specification, sufficiently indicate the subject-matter of the invention. Webster, A.-G., reversed this, basing his decision on the construction of the document before him. He added: "The patentee is entitled to frame his title in his own way provided he does not infringe the rules of the statute, and I think, having regard to the narrow nature of the claims, the present title is

A patentee may frame his title in his own way if he do not infringe statutory rules.

(*z*) 1888, sect. 2.

(*a*) (1864) 13 W. R. 15.

(*b*) (1844) 8 Q. B. 1054; 13 L. J. Q. B. 189. Cf. *Sturtz* v. *De la Rue* (1828), 1 W. 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; *Hills* v. *London Gaslight Co.* (1860), 5 H. & N. 312; 29 L. J. Ex. 409.

(*c*) (1887) Griff. A. P. C. 1.

sufficient. It must, of course, be distinctly understood that I express no opinion as to whether, if the specification comes to be litigated, he can claim anything more than that which is covered by his title and claims, but he has elected to stand upon his title, and his claim being thus specific, I think the title sufficient."

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.

If he has devised too narrow a title, he may find that his claims are construed much more rigidly than he intended when he drew the specification and applied for the patent. This is the danger to which the law officer drew attention in the case last quoted. If the title be so large or indefinite as to be calculated to deceive, the examiners will refuse to pass it.

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 (*d*). But 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 (*e*). And the generality of words in a title may be restricted by the specification (*f*).

Mere generality not fatal to patent.

Insufficiency in the title is not a ground of opposition (*g*).

In view of the present state of the law, the old authorities are not of the greatest importance, but for reference' sake the chief are appended :—

Cochrane v. *Smethurst* (*h*).—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.

Campion v. *Benyon* (*i*).—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

(*d*) Hindmarch, p. 43.
(*e*) *Cook* v. *Pearce* (1844), per Tindal, C. J., 8 Q. B. 1004; 13 L. J. Q. B. 189.
(*f*) *Hornblower* v. *Boulton* (1799), Dav. P. C. 230; 8 T. R. 95; *Newton* v. *Vaucher* (1851), 21 L. J. Ex. 305; 6 Ex. 866; *Lister* v. *Norton* (1896), 3 R. P. C. 199, 203.
(*g*) 1883, sect. 11; 1888, sect. 4.
(*h*) (1816) Dav. P. C. 354.
(*i*) (1821) 6 B. Moo. 71; *Brunton* v. *Hawkes* (1821), 4 B. & Ald. 541.

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* (*k*).—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.

Bainbridge v. *Wigley* (*l*).—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.

Cases.

Neilson v. *Harford* (*m*).—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*.

R. v. *Wheeler* (*n*) 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

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

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

(*m*) (1841) 8 M. & W. 806; 1 W. P. R. 331; cp. *Beard* v. *Egerton* (1846), 3 C. B. 97; 15 L. J. C. P. 270.

(*n*) (1819) 2 B. & Ald. 345.

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. 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.

Variance between title and specification.

In *Rex* v. *Metcalf* (*o*), 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.

In *Fisher* v. *Dewick* (*p*), 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.

In *Croll* v. *Edge* (*q*), a patent had been granted "for certain improvements in the manufacture of gas for the purpose of

(*o*) (1817) 1 Web. P. C. 141, *n.*; 2 Stark. R. 249.

(*p*) (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.

(*q*) (1847–50) 19 L. J. C. P. 261; 9 C. B. 479, 490, 492.

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 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."

In *Oxley* v. *Holden* (*r*), 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 specification of letters patent is clearly dealt with by Sir Richard Webster, A.-G., in *Dart's Patent* (*s*).

Decisions of law officer.

Dart's Patent (*s*).—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

(*r*) (1860) 8 C. B. N. S. 666, 705; 30 L. J. C. P. 68; cp. *Patent Bottle Envelope Co.* v. *Seymer* (1858), 28 L. J. C. P. 22; 5 C. B. N. S. 164; *Parkes* v. *Stevens* (1869), L. R. 8 Eq. 358; 38 L. J. Ch. *Wright* v. 627; *Hitchcock* (1870), L. R. 5 Ex. 37; 39 L. J. Ex. 97.

(*s*) Griff. P. C. p. 307; cp. Trans. I. P. A., vol. v., pp. 52—56, A. V. Newton. And see Jones' Patent, Griff. 313, and generally as to amendment, *post*, p. 219.

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 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" (*t*).

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.

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

(*t*) In this case an incidental question arose respecting the payment of a fee required by the Patent Office on *Dart's Application*. Webster, A.-G., 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."

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 (*u*).

Under the Act of 1883 this process was reversed, and the filing 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 officers' 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*). The rule was stated in similar terms by Smith, L. J., in *Gadd* v. *Mayor, &c., of Manchester* (*z*).

Scope of provisional specification.

The scope of the provisional specification has been clearly defined in several leading cases; and though the statute under which the points arose is now repealed, yet the Act of 1883 (sect. 5, sub-sect. 3) has on this matter practically re-enacted it. The following is still good law: "The office of the provisional specification 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

(*u*) See Transactions of the Inst. of Pat. Agents, vol. iv., p. 155, G. G. M. Hardingham.

(*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 Inst. of Pat. Agents (vol. i., pp. 61 *et seq.*, W. Spence).

(*z*) (1892) 9 R. P. C. 516, 529, and see the judgment of Kekewich, J. (reversed on the facts) at 9 R. P. C. 259 *et seq.*

deliberation" (*a*). This dictum is regarded by Kay, J., as the leading dictum upon this part of patent law (*b*).

In a subsequent case between the same parties (*Newall* v. *Elliott* (*c*)), 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 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."

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" (*d*).

Cases under Act of 1883.

The language of Byles, J., in *Re Newall and Elliott* (*e*), was adopted by Kay, J., in *Lucas* v. *Miller* (*f*); and in *Woodward* v. *Sansum* (*g*) Lopes, L. J., said: "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

(*a*) Byles, J., in *Re Newall and Elliott* (1858), 4 C. B. N. S. 269; 27 L. J. C. P. 337.

(*b*) *Lucas* v. *Miller* (1885), 2 R. P. C. 157, 159. See also remarks of Lord Blackburn in *Bailey* v. *Roberton* (1878), 3 App. Ca. 1055.

(*c*) (1864) 10 Jur. N. S. at p. 955.

(*d*) 10 Jur. N. S. 960; cp. *Penn* v. *Bibby*, *Penn* v. *Jack* (1866), per Lord Chelmsford, L. R. 2 Ch. 134; 36 L. J. Ch. 455.

(*e*) (1858) 4 C. B. N. S. 269; 27 L. J. C. P. 337.

(*f*) (1885) per Kay, J., 2 R. P. C. at p. 159.

(*g*) (1887) 4 R. P. C. 166.

within what I may call the ambit of his invention as disclosed in his provisional specification." It is not necessary that the provisional specification should suffice to enable even a skilled man to understand the method of carrying out the invention (*h*). And Lord Herschell has pointed out that the provisional may be much more general and less detailed in its terms than the complete (*i*). But though it may be a rough description, it must be fairly and honestly framed (*k*).

One of the most recent cases in which the function of the provisional specification has been considered is *The Cassel Gold Extracting Co.* v. *The Cyanide Gold Recovery Syndicate* (*l*), in the course of which A. L. Smith, L. J., delivering the judgment of the Court of Appeal, said: "In a provisional specification, no claim is ever made by the patentee, he has not to state therein what he claims, or how he carries out the invention; but he must state its nature in such a way that the law officers may see what it is, and so that the identity of its subject-matter with that of the complete specification which is to come thereafter may be ascertained."

It may happen that the provisional goes beyond the complete, and that yet the specification is good, for the force of the objection of disconformity depends not upon whether the provisional, but upon whether the complete, is excessive (*m*). A part of the invention included in the provisional may be dropped in the complete (*n*); but if the ambit of the invention in the complete goes beyond that covered by the provisional, there is disconformity which will prove fatal to the patent (*o*). Since the complete may be cut down by the provisional, but cannot be enlarged by it, the drafting of the provisional is of great importance to the inventor. The provisional specification need contain no claims (*p*), and provided that the invention is sufficiently described and identified, there would seem to be an advantage in stating as little as

(*h*) *Stoner* v. *Todd* (1874), 4 Ch. Div. 58; 46 L. J. Ch. 32; *Nuttall* v. *Hargreaves* (1892), 1 Ch. 29; 8 R. P. C. 450; 61 L. J. Ch. 94; *United Telephone Co.* v. *Harrison* (1882), 21 Ch. Div. at p. 720; 51 L. J. Ch. 705.

(*i*) *Vickers* v. *Siddell* (1890), 15 App. Ca. 496; 60 L. J. Ch. 105; 7 R. P. C. 292, 306.

(*k*) Per Fry, J., in *United Telephone Co.* v. *Harrison* (1882), 21 Ch. Div. 720; 51 L. J. Ch. 705; *Stoner* v. *Todd* (*supra*).

(*l*) (1895) 12 R. P. C. at p. 257. The recent cases quoted in the next section (Disconformity) should also be consulted.

(*m*) Kekewich, J., in *Siddell* v. *Vickers* (1888), 39 Ch. Div. 97; 5 R. P. C. 81.

(*n*) *Penn* v. *Bibby* (1866), 2 Ch. App. 36 L. J. Ch. 455.

(*o*) See *Vickers* v. *Siddell* (1888), 15 App. Ca. 505; 60 L. J. Ch. 105; 7 R. P. C. 292. And see Disconformity, *infra*, p. 146.

(*p*) *Lucas* v. *Miller* (1885), 2 R. P. C. 155.

possible; generally speaking, there seems to be no good reason for giving any details of the working in the provisional.

The comparative advantages and disadvantages of filing the provisional and complete specifications at the same or different times have been dealt with *ante* (p. 119 *et seq.*). Suffice it to say here that if the complete be withheld for a time, though some risk of disconformity may be incurred, the inventor gains an opportunity of developing his method without loss of time, and the patent when granted dates back to the application (*q*). Under the present Act, the grant of the patent, though when sealed it dates back to the application (*r*), is not made until the complete has been lodged, and the patent has been sealed (*s*); hence the provisional is not published until the complete is published (*t*). But the inventor is able to use the invention without prejudice to the validity of the patent to be granted for the same (*u*). If eventually part of the invention covered by the provisional be dropped, the provisional is a publication of that part if such part is practically disclosed in the provisional (*x*). But though the inventor is protected against the result of user and publication after the date of the provisional, an action for infringement does not lie until the patent has been granted (*y*), and then only in respect of infringements committed after the acceptance of the complete specification (*z*).

Provisional specification not published separately.

No action for infringement till complete is accepted.

The rules relating to the form of provisional specification and the size of paper upon which it must be written or printed are to be found in the Appendix; see Rules 6 (2), 10 (*a*), and 30—33 (*b*). The provisional specification must commence with the title (*c*), and, if required, be accompanied by drawings (*d*). Every application must be referred to an examiner, who must ascertain whether these requirements have been complied with, but it is for the comptroller to exercise his discretion (*e*). The form provided is Form B in the Appendix to the Rules (*f*). The provisional specification must be signed by the applicant or his agent on the last sheet, the date having been inserted. These regulations

Rules relating to the filing of a provisional specification.

(*q*) Act of 1883, sect. 13.
(*r*) Act of 1883, sect. 13.
(*s*) Act of 1883, sect. 9 (2), (4), and sect. 12.
(*t*) Act of 1883, sect. 8 (1), 10, 13.
(*u*) Act of 1883, sect. 14.
(*x*) *Stoner* v. *Todd* (1876), 4 Ch. Div. 58: 46 L. J. Ch. 32.
(*y*) Act of 1883, sect. 15.
(*z*) Sect. 13, and see *Ex parte Bates and Redgate*, per Hatherley, L. C., 4 Ch. 577: 38 L. J. Ch. 501.
(*a*) *Post*, p. 685.
(*b*) *Post*, p. 694.
(*c*) Act of 1883, sect. 5 (5).
(*d*) Act of 1883, sect. 5 (3).
(*e*) *In the Matter of C.'s Patent* (1890), 7 R. P. C. 250.
(*f*) *Post*, p. 808.

(which are to be found in the marginal note to the form) are directory only; a patent has been granted to two persons, though the complete specification was signed by one only (*g*).

Disconformity between the Provisional and the Complete Specifications.

The office of the provisional specification being to describe the nature of the invention, nothing more is required in it. The office of a complete specification is very different; it must particularly describe the nature of the invention and the manner in which it is to be performed.

It has always been necessary that the invention protected by the patent should be accurately described before the patent was granted. At a time when no provisional specification was requisite, and when the patent was granted before the specification was lodged, the interim guide to the nature of the invention was the title, and disconformity of a material nature between the title and the invention would render the grant invalid. See *ante*, p. 135 *et seq.*

Disconformity under the old law.

When, in 1852, the provisional specification was introduced, the more important functions of the title fell to the lot of the provisional specification, and conformity between the provisional and complete became important. If a man invented a patentable manufacture, which he described in general but sufficient terms in his provisional, he obtained his patent for that invention. When subsequently he came to file his complete specification, he might have included within its terms a totally different manufacture. He would thus have obtained a patent for an invention the full details of which he had not disclosed, or he might, by including in his complete specification an invention not disclosed by the provisional, make his patent cover that which he did not invent. Hence the law was framed so as to enable a patent for an invention to be revoked, if the complete specification went beyond the provisional specification. This defect—to which the name disconformity, or nonconformity, was given—could also be set up by way of defence to an action for infringement, since it rendered the grant void (*h*).

The Act of 1883.

In 1883 a change was made in the procedure for obtaining a patent. It is now provided that the patent shall not be sealed

(*g*) Per Webster, A.-G., in *Grenfell and McEvoy's Patent* (1890), 7 R. P. C. 151.

(*h*) See cases *infra*.

until the complete specification has been left at the Patent Office and accepted (*i*). But as a patent, when granted, dates back to the day of application, the same reasons exist now as formerly for requiring conformity between the two specifications.

Disconformity is still available as a defence in an infringement action.

It has been doubted whether disconformity is any longer a ground either of revocation or defence in an action for infringement. The Act of 1883 (sect. 9) provides that "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*;" and if the conditions are not complied with to the satisfaction of the examiner, the comptroller may refuse to accept the complete specification until it has been amended to his satisfaction: sect. 9 (2).

Upon this it has been argued that if the comptroller accepts the complete specification after its examination by the examiners, there can no longer be any objection on the ground of disconformity (*k*).

It has now been decided, however, that disconformity between provisional and complete is a good answer to an action for infringement, and makes the patent void. In *Siddell* v. *Vickers* (*l*), Cotton, L. J., treated the point as an open one. But when the case came before the House of Lords (*m*), Lord Halsbury, L. C., said:—

"It is suggested that the new machinery of the comptroller and the examiner has superseded the power of raising any objection to the conformity of the provisional and the complete specification. I am unable myself to take that view. I think it is an essential condition of a good patent that the invention described in the provisional should be the same as that in the complete specification; and I think the third sub-section of sect. 26 preserves this as a ground upon which an action for infringement of a patent right may be defended and a ground upon which a patent may be revoked."

This dictum was not necessary to the decision, and was not in

(*i*) Sects. 5 & 12.

(*k*) *Siddell* v. *Vickers* (1890), 7 R. P. C. 292; 15 A. C. 496; 60 L. J. Ch. 105.

(*l*) (1888) 39 Ch. Div. 92; 5 R. P. C. 81.

(*m*) (1890) 15 A. C. 496; 60 L. J. Ch. 105; 7 R. P. C. 292.

terms adopted by the other law lords, though they did not dissent from it. But in subsequent cases it has been assumed by the Judges that disconformity would be fatal, and in practice it is constantly pleaded and argued as a defence open to the party attacking the patent. And, save perhaps in the House of Lords, it can no longer be contested that a patent is invalidated by disconformity between the provisional and complete, for in *Nuttall* v. *Hargreaves* (*n*) Lindley and Bowen and Fry, L. JJ., decided that the law is as stated in the dictum of Lord Halsbury (*o*).

Disconformity as a ground for refusing a grant.

Disconformity is not open as a ground of opposition to the grant of a patent save in the circumstances provided for by the Patents Act, 1888, sect. 4. This provides that any person may oppose under the ordinary conditions (*p*), 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.

Sir Robert Reid, S.-G., has decided in *Edwards's Patent* (*q*) that this section does not prevent an inventor from developing his invention to such extent as he might have done under the old law. In fact, though it may enable an opponent to object to the sealing of a patent on the ground of disconformity, it does not make that disconformity which previously could not have been so regarded; and it would require a clear case to cause the law officer to stop a patent on the ground of disconformity between the specifications (*r*).

Revocation for disconformity.

A patent once granted may be revoked on the ground of disconformity (*s*), but the persons who have a *locus standi* to petition for revocation are limited (*t*).

What amounts to Disconformity.—The question of disconformity is one of fact (*u*). What the Court has to determine is whether a distinct invention is claimed in the complete, which is not covered

(*n*) (1892) 1 Ch. 23; 61 L. J. Ch. 94; 8 R. P. C. 450.

(*o*) In *Haythornethwaite's Application* (1889), 7 R. P. C. 70, Clarke, S.-G., said that he could not, in dealing with an application, consider whether a specification alleged to be an anticipation satisfied the rules as to conformity.

(*p*) *Post*, Act of 1883, sect. 11.

(*q*) (1894) 11 R. P. C. 461.

(*r*) See the remarks of Webster, A.-G., in *Anderson and Anderson* (1890), 7 R. P. C. 323.

(*s*) *Nuttall* v. *Hargreaves* (1892), 1 Ch. 23; 61 L. J. Ch. 94; 8 R. P. C. 451.

(*t*) See *infra*, Chap. XV., and Act of 1883, sect. 26 (4).

(*u*) *Needham* v. *Oxley* (1863), 8 L. T. N. S. 532, 604.

by the provisional. The question is not whether the provisional is defective, but whether the complete is excessive (*x*).

If the complete specification, besides describing the invention foreshadowed in the provisional, sets out and claims an invention independent of that which is in the provisional specification, it is bad. It would be equally bad if the invention described in the complete specification were a wholly different invention from that described in the provisional specification (*y*).

The points to be considered in deciding the question of disconformity.

"In considering whether a complete specification goes beyond the limits allowed by law, two questions only have to be considered: (1) What is the nature of the invention for which the patentee has obtained provisional protection? and (2) is what is described in the complete specification an invention of a different nature from the former? . . . The whole object of provisional protection is to enable a patentee to work at and improve, without risk of his invalidating, his patent by premature publication or user. The only limit set to what he can do in this respect is that the invention as finally specified must not be a different invention from that provisionally protected" (*z*).

Lord Justice Lindley said in *Nuttall* v. *Hargreaves* (*a*) that the patentee need not go into details in the provisional specification. "It is sufficient to describe the nature of the invention, but the nature of the invention there described must be the nature of the same invention as that to which the complete specification relates."

Legitimate development is not disconformity.

There is no disconformity where the inventions described by the two documents are substantially one and the same, or where the excess, if any, in the complete specification is attributable to the legitimate functions of that document (*b*), or where the complete specification is a legitimate development of the provisional (*c*).

The point may be pushed further. If a patentee, when he

(*x*) Kekewich, J., in *Siddell* v. *Vickers* (1888), 39 Ch. Div. 92; 5 R. P. C. 81.

(*y*) *Watling* v. *Stevens* (1886), 3 R. P. C. 147, following the remarks of Lord Blackburn in *Bailey* v. *Roberton* (1878), 3 A. C. at p. 1075. And see per Smith, L. J., in *Lane-Fox* v. *Kensington, &c., Electric Lighting Co.* (1892), 3 Ch. 424; 9 R. P. C. at p. 413. Serious difficulties have arisen when a specification has been amended without due regard to the scope of the provisional; see, e.g., *Lane-Fox* v. *Kensington Electric Lighting Co.*, *supra*; *Gaulard and Gibbs' Patent* (1890), 7 R. P. C. 367; *Moser* v. *Marsden* (1893), 10 R. P. C. 205, 350.

(*z*) Lindley, L. J., in *Gadd* v. *Mayor of Manchester* (1892), 9 R. P. C. at p. 526.

(*a*) (1892) 1 Ch. 23, 29; 61 L. J. Ch. 94; 8 R. P. C. 450.

(*b*) *Moseley* v. *Victoria Rubber Co.* (1887), 4 R. P. C. at p. 251; *Watling* v. *Stevens* (1886), 3 R. P. C. 37, 41, 147.

(*c*) *Horrocks* v *Stubbs* (1886), 3 R. P. C. 233, 236; *Moseley* v. *Victoria Rubber Works*, *supra*.

files his complete specification, has a development or improvement in his mind which is not *per se* a separate invention, he not only may, but is bound to, disclose it to the public; there is no illegitimate variance when the complete specification does no more than disclose the improvement (*d*).

Crampton v. Patents Investment Co.

Improved methods of carrying out the same invention.

In *Crampton* v. *The Patents Investment Co.* (*e*), 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 that 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."

Bailey v. *Roberton.*

To the same effect is *Bailey* v. *Roberton* (*f*), in the course of which Lord Blackburn said: "it becomes pretty clear that when the nature of an invention has been described in the provisional specification in the way which has been mentioned, if something were found out during the six months to make the invention work better or in respect to the mode in which the operations may be performed—a thing which is very likely to happen when, in carrying out his invention, the inventor finds that some particular bit will not work so smoothly as he expected, and it is necessary to add a little supplement to it—still the nature of his invention remains the same, and it is no objection that in the complete specification, which comes afterwards, the invention or application is described more particularly and in more detail, or even if it be shown that there has been more discovery made, and so as to make the invention which he has described in the provisional specification really workable. If nothing more is done than that, I think it is good." . . . This rule has been repeatedly acted upon, *e.g.*, in *Moseley* v. *Victoria Rubber Co.* (*g*), *Woodward* v. *Sansum* (*h*), *Gadd* v. *The Mayor &c.*

(*d*) Bowen, L. J., in *Miller* v. *Searle, Barker & Co.* (1893), 10 R. P. C. at p. 111; and see *post*, p. 165. The rule was the same as regards conformity between title and specification: *Crossley* v. *Beverley* (1829), 9 B. & C. 63; 1 W. P. C. 112.

(*e*) (1888) 5 R. P. C. 382, affirmed 6 R. P. C. 287.

(*f*) (1878) 3 App. Ca. 1055.

(*g*) (1887) 4 R. P. C. 241, 251.

(*h*) (1887) 4 R. P. C. 166.

Manchester (*i*), and *Cassel Gold Extracting Co.* v. *Cyanide Gold Recovery Syndicate* (*k*).

Woodward v. *Sansum.*

In *Woodward* v. *Sansum* (*kk*), Lopes, L. J., said that it is essential that the nature of the invention should be the same, but, "upon principle and upon authority, it is clear that improvements in the arrangement of the mechanism, in the relative position and adaptation of the different 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."

A new invention may not be introduced under colour of an improvement in the original.

But though a patentee is not prevented from including in his complete specification improvements in the means of carrying out the invention disclosed in the provisional specification, he may not, under colour of making an improvement, include a totally different invention (*l*).

It is not an objection that the complete specification does not extend to everything comprehended within the provisional (*m*); but the omitted part cannot be read into the complete merely because it is mentioned in the provisional (*n*).

The following examples may elucidate what does or what does not amount to nonconformity, though it must be remembered that the decision depends in every case mainly on the facts:—

Variance of provisional and complete specifications.

In *Penn* v. *Bibby* (*o*) the provisional specification described the 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

(*i*) (1892) 9 R. P. C. 516.
(*k*) (1895) 12 R. P. C. 257.
(*kk*) (1887) 4 R. P. C. 166.
(*l*) *Gadd* v. *Mayor of Manchester* (1892), 9 R. P. C. 516, 526; *United Telephone Co.* v. *Harrison* (1882), 21 Ch. Div. 720, 746; 51 L. J. Ch. 705.

(*m*) *Thomas* v. *Welch* (1866), L. R. 1 C. P. 192; 35 L. J. C. P. 200; *Penn* v. *Bibby* (1866), 2 Ch. at pp. 130, 135; 36 L. J. Ch. 455.
(*n*) *Mackelcan* v. *Rennie*, 13 C. B. N. S. 52.
(*o*) (1866) 2 Ch. 130; 36 L. J. Ch. 455.

Penn v. *Bibby.* 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 said that there could be no doubt that the claim in the specification must be read with the limitation produced by the words "herein described," and that the question thereupon arose whether this occasioned a departure from the provisional specification so as to render the patent void. He then proceeded:—

"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.

Variance of provisional and complete specifications.

"But it was said that one part of the complete specification 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* (*p*), an action for the infringement of a patent for sewing machines, the provisional specification stated that a certain instrument or *another acting therewith* held 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

(*p*) (1866) L. R. 1 C. P. 192; 35 L. J. C. P. 200.

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 (*q*), I do not think the objection ought to prevail. The difference is a slight one, and injured nobody, and it may be 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* (*r*), 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*.

(*q*) 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.'"

(*r*) (1870) L. R. 5 Exch. 37, 46; 39 L. J. Ex. 97.

Lucas v. *Miller*.

In *Lucas* v. *Miller* (*s*), 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.

Bailey v. *Roberton* (*t*).—The provisional claimed the use of a solution composed of a certain quantity of gelatine mixed with bisulphate of lime; in the complete a claim was made for a solution composed of bisulphite of lime alone, no directions as to the mode of use being given: bisulphite of lime had been used before by a prior patentee. Held, there was "disconformity."

Nuttall v. *Hargreaves*.

Nuttall v. *Hargreaves* (*u*).—The patentee of an invention for tapping barrels had described his invention in the provisional as a plug screwed into the barrel end, with a valve and spring and guide to keep the valve in its place; in the complete he added the description of a gauge strainer to keep impurities from escaping into the tap, and it appeared that the gauge strainer was the only novel part of the invention. It was decided that the patent was invalid (*x*).

To upset a patent, the disconformity must be clear.

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 (*y*); and the Court will not decide against the validity of the patent on the ground of disconformity unless the invention disclosed in the provisional clearly differs from that shown in the complete (*z*).

(*s*) (1885) 2 R. P. C. 155.

(*t*) (1878) 3 App. Ca. 1055. See also *Hutchinson* v. *Pattullo* (1887), 4 R. P. C. 329; 5 R. P. C. 351.

(*u*) (1892) 1 Ch. 23; 61 L. J. Ch. 94; 8 R. P. C. 450.

(*x*) In *Gadd* v. *Mayor of Manchester* (1892), 9 R. P. C. 516, 527, Lindley, L. J., said that the decision in this case went beyond any other and depended on the facts; but so do all these decisions. See also *Re Gaulard and Gibbs' Patent* (1889), 6 R. P. C. 215; 7 R. P. C. 367; *King, Brown & Co.* v. *Anglo-American Brush Corporation* (1889), 6 R. P. C. 367, 414.

(*y*) *Siddell* v. *Vickers* (1888), 39 Ch. Div. 97; 5 R. P. C. 81, 416. But see *Mackelcan* v. *Rennie* (1862), 13 C. B. N. S. 52.

(*z*) Lindley, L. J., in *Gadd* v. *Mayor of Manchester*, *supra*; Romer, J., in *Chadburn* v. *Mechan* (1895), 12 R. P. C. 120, 135.

An objection of variance should be stated in the particulars, and will probably be rejected unless it is so stated (*a*). A mere general allegation of disconformity is not sufficient. Thus, in *The Anglo-American Brush Electric Light Corporation* v. *Crompton* (*b*), 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."

Anglo-American Brush, &c., Co. v. *Crompton.*

Section 4.—The Complete Specification.

1. Sufficiency of the 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 appears to be threefold: (1) to prevent any person from inadvertently infringing the patent right during the term of the monopoly; (2) to put the public in possession of the patentee's secret on the expiry of the patent term; (3) to prevent patents being granted for known inventions.

Objects of complete specification.

The disclosure of the invention is often said to be the consideration for the grant of the patent, and consequently it becomes necessary that the invention should be so described that the public may have the benefit of the consideration on the lapse of the monopoly.

"The object of the specification," said Tindal, C. J., in *Walton*

(*a*) *Watling* v. *Stevens* (1886), 3 R. P. C. at p. 152. The plea of insufficiency of the specification entitles the defendant to raise disconformity: *Penn* v. *Bibby* (1866), 2 Ch. 127; 36 L. J. Ch. 455.

(*b*) (1887) 34 Ch. Div. 152; 56 L. J. Ch. 167; 4 R. P. C. 27.

v. *Potter* (*c*), "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 patent is set up, to say that you have not so described it that it may be understood."

Specification must not be ambiguous.

Utmost good faith requisite.

It is a principle of patent law that there must be the utmost good faith in the specification, which must be fair, full, and unambiguous. The specification should point out in definite, explicit terms what the invention really is and what is claimed (*d*).

"It is incumbent on the patentee," said Ashhurst, J., in *Turner* v. *Winter* (*e*), "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."

The Patents Act, 1883 (sect. 5, sub-sect. 4) provides that a complete specification must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed (*f*), and must be accompanied by drawings if required: and sub-sect. (5) adds that a complete specification must commence with the title and end with a distinct statement of the invention claimed (*g*). As these sub-sections but repeat the law existent before the passing of the Patents Act, 1883, they may be interpreted in the light of the decisions old as well as recent.

Specification must not be vague.

The complete specification must not be vague. It must state clearly both what the invention is, and how it can be carried out (*h*). "Is this specification such that a fair man, willing or wishing to understand the specification, can reasonably gather

(*c*) (1841) 1 W. P. C. 595; 11 L. J. C. P. 138; cf. *Galloway* v. *Bleaden* (1839), 1 W. P. C. 521.

(*d*) *Fairburn* v. *Household* (1886), 3 R. P. C. 263; *Sturtz* v. *De la Rue* (1828), 1 W. P. C. 83; 5 Russ. 322.

(*e*) (1787) 1 W. P. C. 80.

(*f*) These two requisites are distinct, and should be kept so in the specification, per Lindley, L. J., in *Edison* v. *Holland* (1889), 6 R. P. C. 243, 279, 280, also per Grove, J., in *Philpott* v. *Hanbury* (1885), 2 R. P. C. 35, 38.

(*g*) These provisions are only directory: *Vickers* v. *Siddell* (1890), 15 A. C. 696; 60 L. J. Ch. 105; 7 R. P. C. 292.

(*h*) See, *e.g.*, Ashhurst, J., in *Turner* v. *Winter*, 1 W. P. C. 77; 1 T. R. 602.

from it what the patentee considers his invention and what he says he prohibits the public from using?" (*i*). Such is the test.

In *Turner* v. *Winter* (*k*), the specification stated as an ingredient in a certain mixture "fossil salt." The Court found that "fossil salt" was a generic term, including "sal gem" as well as other species, and that "sal gem" would alone answer the purpose. It was decided that the specification was ambiguous and misleading, and therefore bad.

In *Hastings* v. *Brown* (*l*), 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 Bench held that the specification did not unequivocally show that the object was to construct a single windlass capable of holding different chain cables, whatever their size, and that such a windlass was not therefore protected by the patent (*m*).

In *Gandy* v. *Reddaway* (*m*), 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 subdivision, 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 (*n*), the specification was insufficient.

Specification must state plainest way of producing invention.

In *Savory* v. *Price* (*n*), 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

(*i*) Per Grove, J., in *Philpott* v. *Hanbury* (1885), 2 R. P. C. at p. 38.

(*k*) (1787) 1 W. P. C. 77; 1 T. R. 602.

(*l*) (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. 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 R. P. C. at p. 115; 29 Ch. Div. 366, per Bowen and Fry, L. JJ.; cp. *Fairburn* v. *Household* (1886), 3 R. P. C. 128. See *Edison* v. *Holland*, 6 R. P. C. 281.

(*m*) (1885) 2 R. P. C. 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 R. P. C. at p. 172.

(*n*) (1823) 1 Ry. & Mo. 3; 1 W. P. C. 83.

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 *Sturtz* v. *De la Rue* (*o*), 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 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

(*o*) (1828) 1 W. P. C. 83; 5 Russ. 322. See also as another example *Badische, &c.* v. *Levinstein* (1887), 12 App. Ca. 710, 723; 4 R. P. C. 449; *Wegmann* v. *Corcoran* (1879), 13 Ch. Div. 65, 71, 78, 87.

'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."

The method of carrying out the invention must be properly stated in the specification, and the insertion or representation of anything which will not answer the purpose will vitiate the specification for insufficiency.

In *Turner* v. *Winter* (*p*) the specification was so drawn that any ordinarily qualified person attempting to carry out the invention would have used "minium" in a certain process. In fact, "minium" would not answer the purpose, and the inventor himself never used it. The Court decided against the specification on this ground.

Ambiguity in the statement of materials.

In *Ralston* v. *Smith* (*q*), 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."

(*p*) (1787) 1 W. P. C. 77; 1 T. R. 602.

(*q*) (1865) 11 H. L. C. 223; 35 L. J. C. P. 49.

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" (*r*).

Proportions.

If the specification states the articles of which the thing invented is to be composed, but omits the proportions, the specification will ordinarily be insufficient (*s*). But a reasonable latitude in the statement of proportions is permissible, and if there can be no reasonable doubt, the fact that the proportions are not stated in express words will not impair the sufficiency.

Ambiguity in statement of proportions.

In the *Patent Typefounding Co.* v. *Richards* (*t*), 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 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

(*r*) *Bickford* v. *Skewes* (1837–39), 1 W. P. C. 218; 1 Q. B. 938; 10 L. J. Q. B. 302.

(*s*) Per Lord Mansfield; see 1 W. P. C. 54, note (*e*).

(*t*) (1860) 2 L. T. N. S. 359; 1 Johns. N.

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*" (*u*).

Thus in *The British Dynamite Co.* v. *Krebs* (*x*), 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, . . . 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."

Method described must answer.

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* (*y*) 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

(*u*) See also *Betts* v. *Neilson* (1868–71), per Lord Westbury, L. R. 5 H. L. at p. 21; 40 L. J. Ch. 317.

(*x*) (1875–79) Goodeve, P. C. 88; 13 R. P. C. 190; cp. *Otto* v. *Linford* (1881–82), per Jessel, M. R., 46 L. T. 40.

(*y*) (1828) 1 Web. P. C. 83.

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" (*z*).

Simpson v. *Holliday.*

A clear statement of the law on this question is that given in *Simpson* v. *Holliday* (*a*), which shows that if the method does not produce the invention described, innocence of intention to mislead will not avail to support the patent, and that it will not avail that another method, which can be successfully carried out, is specified.

In this case, 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."

(*z*) *S. C.*, 1 Carp. P. C. 462; cp. *Derosne* v. *Fairie* (1835), 1 Web. P. C. at p. 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. C. P. 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 R.P.C. at p. 494, Kekewich, J., said: "I can see no objection to a patentee stating in his specification that what he has invented with reference to some particular machine may be applied to some other machine."

(*a*) (1864–66) Higgins's Dig. p. 45; 20 Newt. Lon. Jour. N. S. 108.

On appeal, however, to the House of Lords, the findings of the Vice-Chancellor were reversed, and Lord Westbury, L. C., said (*b*):

"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."

These cases may be advantageously compared with *Thomson* v. *Batty* (*c*). There, in a specification for improvements in compasses, there was a claim for the employment of a large bowl *filled or partially filled* with a viscous fluid. It was proved that "partially filled" alone gave the proper effect, though "filling" gave some effect. Kekewich, J., refused to say that the specification was not sufficient.

Specifications containing unnecessary details.

Specifications stating certain things as necessary to the invention which, in fact, are unnecessary, have often been held to be bad. But it will probably be found that the unnecessary parts of the specifications either were put in with intent to puzzle, or, in fact, did make the specification vague and ambiguous; *e.g.*, in *R.* v. *Arkwright* (*d*) Buller, J., said: "If those (parts) are of no use, but are thrown in merely to puzzle, I have no difficulty in saying upon that ground alone that the patent is void." It must always be remembered that the necessity of any given thing must be judged according to the state of knowledge at the time of the invention, not at the time when the dispute arose. In *Lewis* v. *Marling* (*e*) Bayley, J., said: "At the period when the

(*b*) *S. C.*, 5 N. R. p. 340; 35 L. J. Ch. 811; L. R. 1 H. L. 315; cp. *Bickford* v. *Skewes* (1841), 1 Web. P. C. 211; *Neilson* v. *Harford* (1841), 11 L. J. Ex. 20; 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; 46 L. J. Ch. 185; *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 R. P. C. 33; *United Horsenail Co.* v. *Stewart* (1885), 2 R. P. C. 122, 132, 133; *Coles* v. *Baylis* (1886), 3 R. P. C. p. 180; *Kurtz* v. *Spence* (1888), 5 R. P. C. at p. 183.

(*c*) (1888) 6 R. P. C. 84.

(*d*) (1785) 1 W. P. C. 66, 69; see *Lewis* v. *Marling*, 1 W. P. C. 493; 10 B. & C. 22.

(*e*) (1829) 10 B. & C. 22; 4 C. & P. 57; 1 W. P. C. 493; and see *Edison* v. *Woodhouse* (1887), 4 R. P. C. 99.

specification was made, the plush was in use, and there was no reason to believe that this patentee did not think it was a useful part of the machine. His patent is for an instrument where something of that kind was always thought material; and I am of opinion that the subsequent discovery that the plush was unnecessary is no objection to the validity of the patent."

Best method of carrying out should be disclosed.

The specification must disclose the best method of carrying out the invention known to the inventor. "It is essential that a patentee, when he is disclosing his invention to the world, should give, not only the way of performing it, but he should explain how best it may be performed" (*f*).

Best method known to patentee to be disclosed.

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*).

The rule is interpreted the more strictly if the invention be of small merit (*h*). In *Liardet* v. *Johnson* (*i*) (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 bad.

Specification must disclose patentee's own way of producing invention.

Again, in *Wood* v. *Zimmer* (*k*), 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

(*f*) *Plimpton* v. *Malcolmson* (1876), 3 Ch. Div. at p. 576: Kekewich, J., in *Thomson* v. *Bally* (1889), 6 R. P. C. 84, 100, 101.

(*g*) *Turner* v. *Winter* (1787), 1 W. P. C. 77, 81; 1 T. R. 602; *Plimpton* v. *Malcolmson* (*supra*).

(*h*) *Hinks* v. *Safety Lighting Co.* (1876), 4 Ch. Div. 607; 46 L. J. Ch. 185.

(*i*) (1778) 1 W. P. C. 53, 81.

(*k*) (1815) 1 W. P. C. 82.

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."

In determining whether the best method known to the patentee has been disclosed, instructions issued by him as to the method of working are material (*l*).

If the inventor describes the best method known to him, the specification is sufficient. An inventor may know of a material the use of which eventually proves to be a great improvement, but the non-disclosure of this material will not invalidate the patent, if the inventor at the time of filing his specification is not aware of the advantage to which it might be put in connection with the invention (*m*).

Since an inventor is not only at liberty, but is bound, to give his specification in the most improved state known to him at the date of the specification, it follows that developments and improvements discovered between the date of the provisional specification and that of the complete may have to be included. Bowen, L. J., in *Miller* v. *Searle, Barker & Co.* (*n*), speaking of a certain improvement, said: "To my mind the patentee when the complete specification was filed, if he had this altered adjustment in his mind, was bound to disclose it to the public, and was bound to give the public the benefit of all that he knew about this mechanical equivalent. . . . It seems to me nothing but a performance of his duty to the public." The law was long ago laid down to the same effect by Bayley, J., and Tindal, C. J. (*o*).

Improvements discovered subsequent to the provisional.

Edison and Swan v. *Woodhouse* (*p*) shows the limits to this doctrine. In that case a patentee left his provisional specification in November, 1879, and filed his complete in May, 1880. He left a provisional relating to another patent in December, 1879.

(*l*) *Pooley* v. *Pointon* (1885), 2 R. P. C. 167, 172.

(*m*) *Thomson* v. *Batty* (1889), 6 R. P. C. 94, 100, 101.

(*n*) (1893) 10 R. P. C. 106, 111.

(*o*) *Lewis* v. *Marling* (1829), 1 W. P. C. at p. 496; 10 B. & C. 26; *Jones* v. *Heaton*, 1 W. P. C. 404, n.

(*p*) (1886) 32 Ch. Div. 520.

The former specification claimed an electric lamp with a carbon filament; the second claimed a method of making the carbon filaments. It was objected that the former specification was insufficient for non-disclosure of the best way of making the carbon filaments, a way evidently known to the patentee at the time when the complete specification was filed. Butt, J., said that, whilst a patentee is not entitled to withhold from the public a discovery of which he is aware forming an important integral part of the patent, yet he is equally not at liberty to put into his final specification a perfectly independent discovery which he had not made at the time of filing the provisional; and the Judge held, on the facts of the case, that the specification was sufficient (*q*).

Summary.

The result seems to be capable of being fairly stated as follows: The inventor must disclose the whole invention. If, therefore, an improvement or development is an integral portion of the invention covered by the provisional or a method of carrying it into effect, the patentee must disclose it in the complete. But if it be an independent invention, especially if it be such as cannot be included in the complete without risk of objection on the ground of disconformity, there is no obligation on the part of the patentee to include it in the complete specification.

The rule being that the patentee must disclose what he knows regarding the way in which the invention may be best carried into effect, it is material to observe that 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 (*r*).

In imported inventions, the importer's knowledge is the test.

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 (*s*).

It is submitted that when the importer is only agent for the foreign inventor, *bonâ fides* both on the part of the foreign inventor and of the importer is requisite, for it cannot be that the agent may be deliberately kept in ignorance of facts which, if communicated to him, would make the specification insufficient.

(*q*) And see *Coles* v. *Baylis* (1886), 3 R. P. C. 178.

(*r*) *Moser* v. *Marsden* (1893), 10 R. P. C. 350, 359.

(*s*) *Wegmann* v. *Corcoran* (1878), per Fry, J., 13 Ch. Div. at p. 77.

When the importer is acting on his own behalf in patenting the invention in England, *bonâ fides* on his part and sufficient information to describe the invention with accuracy are all that is required.

The new and the old to be distinguishable.

It is important that the public should know exactly what the patentee claims, and for this purpose the specification must state what is admitted to be old and what is claimed to be new. This may be done either in the body of the specification or in the claims (*t*). It is not necessary that the new and the old should be pointed out and distinguished in express terms; it suffices if from the specification and claims the distinction can be drawn. If the specification end with claims, that portion of the body of the specification which is not covered by them is impliedly disclaimed; and, as an inventor will not usually fail to claim what is novel, the claim may generally be taken to be an indication of what the applicant considers new, the parts not claimed being those which he considers old. But each specification must be construed according to its own form and contents (*u*).

Reasons for this rule.

Abinger, C. B., in *Carpenter* v. *Smith* (*x*) said: "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.

Macfarland v. *Price*.

Macfarland v. *Price* (*y*) was an action for the infringement of the plaintiff's patent for "certain improvements in the making of

(*t*) *Nordenfelt* v. *Gardner* (1883), 1 R. P. C. at p. 74.

(*u*) See remarks of Lord Selborne in *Harrison* v. *Anderston Foundry Co.* (1876), 1 App. Ca. at p. 578.

(*x*) (1841) 1 W. P. C. 530, 540; 9 M. & W. 300; 11 L. J. Ex. 213.

(*y*) (1816) 1 W. P. C. 74. "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).

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 drawings showed the particular part which had been pirated, and which was the substance of the invention. Lord Ellenborough, C. J., nonsuited 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 (*z*).

Novel elements to be distinguished.

In *Holmes* v. *The London and North-Western Railway Co.* (*a*), 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.

Sir W. M. James, V.-C., expressed himself to the same effect in *Parkes* v. *Stevens* (*b*) :—

"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 commonplace, 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."

Improvements.

In particular in the specification for an improved instrument or invention the improvement must be distinctly pointed out. The earliest authority for this is *Williams* v. *Brodie* (*c*). The plaintiff's invention, which was admitted to be ingenious and

(*z*) Cp. *Burill* v. *Moore* 1816). Dav. P. C. 361 ; *Saunders* v. *Aston* (1832), per Littledale, J., 3 B. & Ad. 881 ; *Kay* v. *Marshall* (1836), 2 Web. P. C. 39, 71.

(*a*) (1852) Mac. P. C. 13; 22 L.J.C.P.57.

(*b*) (1869) 8 Eq. 358 ; 38 L. J. Ch. 627.

(*c*) (1785) 1 W. P. C. 75; cf. *Hornblower* v. *Boulton* (1799), 8 T. R. 95; *Hill* v. *Thompson* (1818), 1 W. P. C. 229; 8 Taunt. 375. When the invention has been imported from abroad, see *Moser* v. *Marsden* (1893), 10 R. P. C. 350, 359.

useful, consisted in the insertion of a pipe into an old stove for conveying the air, 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.

Foxwell v. *Bostock*.

A leading case on this point is *Foxwell* v. *Bostock* (*d*). 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 (*e*) 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."

In *Cartsburn Sugar Refining Co.* v. *Sharp* (*f*) the first claim

(*d*) (1864) 4 De G. J. & S. 298; *cf.* *Parkes* v. *Stevens* (1869), 8 Eq. 358; 38 L. J. Ch. 627, affirmed L. R. 5 Ch. 36; *Rowcliffe* v. *Morris* (1886), 3 R. P. C. 17, 145.

(*e*) But, as regards combinations, see *infra*.

(*f*) (1884) 1 R. P. C. 181.

of the specification was, "In a sugar-moulding machine, the rotatory drum and series of moulds combined with the hopper and distributers, and the packer, *f*, inclined towards and adapted to fill the moulds substantially as described." In fact, the packer alone was novel; therefore Lord Kinnear held that the specification was bad, as the part of the machine in which the improvement was made was not clearly distinguished.

Fairburn v. *Household and Rosher* (*g*) was a case in which a patent for improvements in tramway engines was held insufficient, as it did not indicate with clearness what the patentee claimed as new (*h*).

Combinations.

The dictum of Lord Westbury in *Foxwell* v. *Bostock* (*i*), so far as it deals with improvements, has been fully accepted, and undoubtedly expresses the present law. But though, when carefully considered, it will equally be found a correct exposition of the law relative to combinations, the language is such as to convey the impression that an applicant for a patent for a combination must state what part of the combination is new and what is old. If he is claiming the parts of which the combination is made up, he must specify which of them he says are a novelty. But if he be claiming the combination alone (or even the combination with parts), he must be taken to assert that the combination is new as a whole, and that he claims the combination as the novelty. Hence it becomes unnecessary further to state what is new; he claims the whole as new, and satisfies the requirement mentioned in Lord Westbury's dictum. If anything more was intended by his Lordship, to that extent he went too far. The following bears on the point (*k*):—

Ambiguity of the dictum in *Foxwell* v. *Bostock*.

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

(*g*) (1886) 3 R. P. C. 128, 263.
(*h*) And see *Hill* v. *Thompson*, 1 W. P. C. 229, 247; *Rowcliffe* v. *Morris* (1886), 3 R. P. C. 17, 145; *Leggott* v. *McGeoch* (1894), 10 R. P. C. 429, 434.
(*i*) (1864) 4 De G. J. & S. 298, 313.
(*k*) See *Kelly* v. *Heathman* (1890), 45 Ch. Div. 256, 260; 59 L. J. Ch. 22; 7 R. P. C. 343.
(*l*) (1876) 1 App. Ca. 574.

combination is also the merit, if it be a merit, which remains to be proved by evidence. So also with regard to the discrimination between what is new and what is old. If it is clear that the claim is for a combination, and nothing but a combination, there is no infringement unless the whole combination is used, and it is in that way immaterial whether any or which of the parts are new. If, indeed, it were left open on the specification for the patentee to claim, not merely the combination of all the parts as a whole, but also certain subordinate or subsidiary parts of the combination, on the ground that such subordinate or subsidiary parts are new and material, . . . then it might be necessary to see that the patentee had carefully distinguished those subordinate or subsidiary parts and had not left *in dubio* what claims to parts, in addition to the claim for the combination, he meant to assert."

In a later case (*m*) Lord Hatherley said: "But I apprehend, my lords (and I do not read the decision in the case of *Foxwell* v. *Bostock* as deciding more than I am stating), you must in some way or other inform those whom you are dealing with, by which I mean the general public, . . . you must inform them in some mode or other whether you have subdivided, if I may use the term, your machine into those separate parts and claim for each part the merit of novelty, or whether you are simply making a combination of things *per se* old, but which have never been used before in combination, and which make up, as you say, your machine, for which you claim protection as a novel and useful machine."

Meaning of *Foxwell* v. *Bostock*.

In *Moore* v. *Bennett* (*n*) Lord Selborne said: "It appears to me 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 condescend upon 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,

(*m*) *Clark* v. *Adie* (1877), 2 App. Cas. 315, 328; 46 L. J. Ch. 585.

(*n*) (1884) 1 R. P. C. 129; *Cartsburn Sugar, &c., Co.* v. *Sharp* (1884), per Lord Kinnear, 1 R. P. C. at p. 185.

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 (*o*), 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'" (*p*).

But "where the claim is for a combination (*q*), 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 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" (*r*).

(*o*) Per James, V.-C., in *Parkes* v. *Stevens* (1869–70), L. R. 8 Eq. at p. 365; 38 L. J. Ch. 627; and cp. *Harrison* v. *The Anderston Foundry Co.* (1876), per Lord Hatherley, 1 App. Ca. at p. 583.

(*p*) In *Nordenfelt* v. *Gardner* (1884), 1 R. P. C. 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.

(*q*) Per Lord Selborne, L. C., in *Moore* v. *Bennett*, *ubi supra*.

(*r*) *Rowcliffe* v. *Morris* (1886), 3 R. P. C. at p. 24.

In *Proctor* v. *Bennis* (*s*), Bowen, L. J., says: "When a combination, and nothing more, is claimed, the combination being a novelty, it is immaterial that the patentee should point out how far he claims the novelty for particular portions which go to make up the combination. Those portions are not his claim, but it is the putting them together and combining them that constitutes his claim. That seems to me to be the true law as laid down in *Harrison* v. *Anderston Foundry Co.* (*t*), without a reference to which case *Foxwell* v. *Bostock* (*u*) is liable to be misunderstood" (*x*).

Limitations to rule.

To the rule that a specification must distinguish the new elements in an invention from the old there are several exceptions or limitations.

Immaterial elements.

A patentee need not disclaim matters which manifestly form no part of the invention (*y*).

Elements known to be old.

"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" (*z*).

Specification sufficient if Court can see that only improvement claimed.

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 (*a*).

Specification sufficient if intelligible to ordinary skilled artisan.

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 (*b*).

In *Shaw* v. *Jones* (*c*), 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

(*s*) (1887) 36 Ch. Div. 740, 762, 763; 57 L. J. Ch. 11; 4 R. P. C. 333. Lord Watson in the course of the argument in *Kaye* v. *Chubb* (1888), 5 R. P. C. 649, said, "If you claim a combination you need not say which of the parts are new." And cf. the statement of the same learned lord in *Lyon* v. *Goddard* (1894), 11 R. P. C. 357.

(*t*) 36 Ch. Div. 740.

(*u*) *Supra*, p. 169.

(*x*) See also *Kelly* v. *Heathman* (1890), 7 R. P. C. 343; 45 Ch. Div. 256; *Peckover* v. *Rowland* (1893), 10 R. P. C. 234.

(*y*) *Lister* v. *Leather* (1858), 8 E. & B. 1004; 27 L. J. Q. B. 295; *Watling* v. *Stevens* (1886), 3 R. P. C. 147.

(*z*) *Tetley* v. *Easton* (1853), per Coleridge, J., Macr. P. C. 87; 23 L. J. Q. B. 77.

(*a*) *McAlpine* v. *Mangnall* (1846), 15 L. J. C. P. 298; 3 C. B. 518.

(*b*) *Parkes* v. *Stevens* (1869), per James, V.-C., 8 Eq. at p. 365; 38 L. J. Ch. 627.

(*c*) (1889) 6 R. P. C. 328.

evidence of witnesses who had done the very thing indicated in the specification without other instructions than the specification itself.

In patent for new combination only, specification need not distinguish subordinate elements. *Quære*, if useful and useless need be distinguished.

Where a patentee claims a new combination only, and not the subordinate elements included in that combination, if the combination and the mode of working it are properly described, it is not necessary to specify which of the subordinate integers are new (*d*).

It is often stated that a specification must distinguish between useful and useless elements (*e*). In a sense, this is so. If the useless elements are put in to puzzle, or even if their effect is to make the specification as a whole ambiguous or unworkable, the specification is bad on these grounds. If the useless elements are clearly stated and separable from the others, *e.g.*, if they are the subject of a distinct claim, the patent will be endangered as containing a claim for that which is not subject-matter. It seems, therefore, that it is not merely for want of pointing out the useless and the useful that a specification, otherwise sufficient, will be invalidated.

A specification may describe the invention and the mode of putting it into operation sufficiently clearly to enable one person to understand it, but it may at the same time be utterly incomprehensible to another. "No sort of specification would probably enable a ploughman, utterly ignorant of the whole art, to make a watch" (*f*). There may be three classes of persons: (i.) skilled scientific men, experienced in dealing with the particular kind of manufacture to which the invention belongs; (ii.) workmen accustomed to manufacture things of the class in question; (iii.) persons having no particular skill or knowledge bearing on the matter.

Specification not addressed to persons ignorant of subject-matter.

"It is plain," said Jessel, M. R., in *Plimpton* v. *Malcolmson* (*g*), "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

(*d*) *Moore* v. *Bennett* (1884), 1 R. P. C. 129.

(*e*) See, *e.g.*, in *Badische Anilin* v. *Levinstein* (1885), 29 Ch. Div. at p. 413.

(*f*) Lord Ellenborough in *Harmar* v. *Playne* (1809), 11 East, 101; Dav. P. C. 311.

(*g*) (1875) 3 Ch. Div. 531, 563; 45 L. J. Ch. 505: cp. *Bray* v. *Gardner* (1887), 4 R. P. C. 400.

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 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."

Test of sufficiency.

This is usually cited as containing shortly but clearly an exposition of the law on this point. It is submitted, however, that the statement of the Master of the Rolls as it stands needs qualification. The ordinary workman spoken of by him must be understood to be a workman engaged in the particular class of work to which the invention applies, or be one who in the ordinary course of things might be engaged in the carrying out of the invention. A specification of a patent for roller skates unintelligible to a workman engaged in the making of roller skates would be bad; but if a patent for making a new dye is obtained, the fact that the roller skate manufacturer could not understand the specification, would not prove fatal to the patent.

In *Elliott* v. *Ashton* (*h*), Coltman, J., said "the patentee must give such a description in his specification as will enable a workman of competent skill, conversant with the trade, to carry the invention into effect."

In *Miller* v. *Scarle, Barker & Co.* (*i*), Bowen, L. J., said: "Now nothing is more certain in patent law (I myself and other Judges have had frequently to point it out) that specifications and figures which are attached to them are addressed to persons who are supposed to be competent to understand the subject to which the specification addresses itself, not to a highly skilled person, but to an ordinary person who understands and can appreciate what he is reading."

(*h*) (1840) 1 W. P. C. 222.

(*i*) (1893) 10 R. P. C. 106, 111.

In *British Dynamite Co.* v. *Krebs* (*k*), Cairns, L. C., says: "When the nature of the invention is thus ascertained by the Court as a matter of construction, the Court has then to enquire whether the manner in which the same is to be performed is sufficiently described in the specification to the comprehension of any workman of ordinary skill in the particular art or manufacture."

Specification is insufficient if experiment is required to discover its meaning.

In *Badische Anilin und Soda Fabrik* v. *Lerinstein* (*l*), Lord Halsbury said: "The specification is said not to give sufficient information to enable the operator to obtain the result without fresh experiment and research. If this were true the patent would undoubtedly be bad; but this is in a great measure a question of fact; and Pearson, J., a most careful and competent Judge, heard the witnesses and gave credit to those who, on the part of the plaintiffs, proved that in the hands of a reasonably competent workman acquainted with the dyeing industry, the specification is sufficient to enable him to procure the result. . . . More than once the questions put as to a competent workman possessed of knowledge in the particular industry were answered by a reply about an "ordinary workman," without the essential words, "possessed of knowledge in the particular industry."

The older cases are to the same effect: *Neilson* v. *Harford* (*m*), *Bickford* v. *Skewes* (*n*), *Harmar* v. *Playne* (*o*), and *Heath* v. *Unwin* (*p*), all show that, whilst a description sufficient for the understanding of a highly trained mind does not suffice, the specification is sufficient if it enables a workman of ordinary skill in the particular industry to carry out the invention (*q*). In short, the person upon whose ability to understand the sufficiency of a specification depends is neither simply an uninstructed member of the general public nor an eminent specialist, but the workman of ordinary skill and information on the subject.

Degree of clearness required.

With regard to the amount of information to be given, the following remarks of Lindley, L. J., in *Edison* v. *Holland* (*r*), are instructive: "With reference to the degree of clearness and distinctness of the language necessary to be used in order to

(*k*) (1879) 1 Good. P. C. 88, 91; see now a report of this case in 13 R. P. C. 190.

(*l*) (1887) 12 App. Ca. 710, 713; 4 R. P. C. 449.

(*m*) (1841) 1 W. P. C. 295; 10 L. J. Ex. 493; 11 L. J. Ex. 20.

(*n*) (1841) 1 W. P. C. 211; 10 L. J. Q. B. 302.

(*o*) (1809) Dav. P. C. 311; 11 East, 101.

(*p*) (1852) 2 W. P. C. at p. 245.

(*q*) And see *Hornblower* v. *Boulton* (1799), 8 T. R. 100; *Edison* v. *Woodhouse*, 4 R. P. C. 92; *Edison* v. *Holland*, 6 R. P. C. 243, 280.

(*r*) (1889) 6 R. P. C. at pp. 279, 280.

comply with those conditions, it is obvious that no hard and fast rule can be laid down; the degree of clearness can only be stated in language which itself admits of considerable latitude in its application. On the one hand, the patentee must make the nature of his invention, and how to perform it, clear and intelligible; on the other hand, it is not necessary for him to instruct persons wholly ignorant of the subject-matter to which his invention relates, in all that they must know before they can understand what he is talking about.". . . In complying with their first condition, *i.e.*, in describing the nature of his invention, the patentee does all that is necessary, if he makes the nature of his invention plain to persons having a reasonably competent knowledge of the subject, although from want of skill they could not practically carry out the invention. In complying with the second condition, *i.e.*, in describing in what manner the invention is to be performed, the patentee does all that is necessary, if he makes it plain to persons having reasonable skill in doing such things as have to be done, in order to work the patent, what they are to do in order to perform his invention. If, as may happen, they are to do something the like of which has never been done before, he must tell them how to do it, if a reasonably competent workman would not himself see how to do it on reading the specification or on having it read to him.

The invention and the means of performing it may be described in words, or assistance may be obtained from drawings, and provided that the test suggested in the remarks of Lindley, L. J. (just quoted), is satisfied, the specification gives the proper amount of information. It is a question of fact, no general rule can be laid down to cover what is sufficient. A rule which was framed to meet an inventor's small mechanical improvement, would obviously be inapplicable to such a patent as was in dispute in the *Badische, &c.* v. *Levinstein* (*s*). When the construction of the specification had been arrived at by the Court, the sufficiency used to be a question left to the jury (*t*); and the matter is still one to be determined by evidence (*u*).

Sufficiency is mainly a matter of fact.

(*s*) (1887) 12 A. C. 710; 4 R. P. C. 449.

(*t*) *Macnamara* v. *Hulse*, 2 W. P. C. 128, 129; *Hill* v. *Thompson* (1817), 1 W. P. C. 237; *Bickford* v. *Skewes* (1841), 1 Q. B. 938; 10 L. J. Q. B. 302; 1 W. P. C. 214; *Wallington* v. *Dale* (1852), 7 Ex. 888; 23 L. J. Ex. 49; *Beard* v. *Egerton* (1848), 19 L. J. C. P. 38; 8 C. B. 165; *Parkes* v. *Stevens*, 8 Eq. 358; 5 Ch. 36; 38 L. J. Ch. 627; note (*d*) Ed. 121.

(*u*) Lord Cairns in *British Dynamite Co.* v. *Krebs* (1879), 1 Good. P. C. 88; 13 R. P. C. 190; *Badische Anilin, &c.* v. *Levinstein* (1887), 12 A. C. 710, 713; 4 R. P. C. 449.

Since the specification is deemed to be sufficient if information is given in it enough to enable the competent workman, as above described, to manufacture the article, the case is of an *à fortiori* nature if in fact subject-matter of the invention has actually been made from the specification and from the specification alone (*x*).

But the specification must give information to enable a competent person to carry out the invention without the aid of external information, for "it does not prove that a specification is sufficient because a man from knowledge he has got from three trials, and seeing people immediately employed about it, is able to make use of it" (*y*). If the specification gives sufficient information, but, owing to want of skill, a person possessed of competent knowledge is unable to make the article, nevertheless the specification is good: *Edison* v. *Holland* (*z*), per Lindley, L.J.

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, and a specification need not explain any facts with which an ordinary workman must necessarily be acquainted.

Thus, in *Crossley* v. *Beverley* (*a*), 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.

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 (*b*), and if experiments are necessary in order to produce any beneficial effect from an invention at all, the specification will be bad (*c*).

In *Macnamara* v. *Hulse* (*d*), an action for the infringement of a

(*x*) *Cornish* v. *Keene* (1835), 1 W. P. C. 501; and see *Morgan* v. *Seaward*, 1 W. P. C. 170; *Shaw* v. *Jones* (1889), 6 R. P. C. 328, 335.

(*y*) Buller, J., in *R.* v. *Arkwright* (1785), 1 W. P. C. 66; Dav. P. C. 106. See also *Morgan* v. *Seaward* (1836), 1 W. P. C. 174; *Wegmann* v. *Corcoran* 1879), 13 Ch. Div. 65.

(*z*) (1889) 6 R. P. C. at p. 280.

(*a*) (1829) 1 W. P. C. 106, 112; 3 C. & P. 513; and see *Hopkinson* v. *St. James, &c., Electric Light Co.* (1893), 10 R. P. C. 46.

(*b*) *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.

(*c*) *Neilson* v. *Harford* (1841), per Parke, B., 1 Web. P. C. 371.

(*d*) (1842) 2 Web. P. C. 128, 129.

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 experiment to determine what is the proper angle, it is not good, but if any angle is a benefit, it will do." But the law must not be unduly strained against the inventor (*e*).

In *Edison* v. *Woodhouse and Rawson* (*f*), the specification spoke of a filament but nowhere defined the term, nor drew any distinction between it and a rod. It was objected that consequently the specification was too vague. To this Fry, L. J., replied, that, "in a patent of this description, definition is required only to such an extent as would enable a practical workman to construct the required apparatus; that there is distinct evidence that such a workman could make the required apparatus from the specification, and that no witness of the defendants allege that such a workman would have any difficulty or require any further experiments, and that the specification itself. . . . contains descriptions of six forms of filaments, and the description, it is obvious, would afford material assistance to any workman in doubt."

The law is not to be strained against the sufficiency of the specification

In a subsequent case (*g*), Lindley, L. J., dealing with the same specification said that the meaning of "filament" could be gathered from the rest of the document, and this he considered to be sufficient.

In the same case (*h*) it was objected that the specification did not give sufficient instructions relating to the carbonisation of the filaments; Lindley, L. J., after saying that it is not fatal to a specification to show that even a workman could not carry out the invention as instructed by it without practice, goes on to say: "If a person is told to carbonise a thread, and for want of thought, or practice, he takes a porous crucible for the purpose, and does not protect his thread, and fails, when if he had packed

The fact that a workman cannot at once carry out the invention is not always fatal.

(*e*) Lord Shand in *Lyon* v. *Goddard* (1894), 11 R. P. C. 364.
(*f*) (1887) 4 R. P. C. 79, 92.
(*g*) *Edison* v. *Holland* (1889), 6 R. P. C. at p. 281.
(*h*) *Ibid.*, p. 282.

this crucible, or had taken a non-porous crucible, he would have succeeded, his failure can hardly be said to be the fault of his instructor, if a little thought and consideration would have shown that a packed crucible, or a non-porous crucible, was the right one to employ. The fact that a workman may use a wrong tool when he has a right one, which a little thought will lead him to see ought to be used, does not warrant the inference that a specification is bad if it does not tell him which tool to use. . . . if a patentee says that something must be done, which a reasonably competent man would know how to do, the patentee need not tell him how to do it, nor warn him to be careful, and to exercise such forethought and attention as the delicacy of the process to be used, or the material to be employed, plainly demand"(*i*).

Verbal errors in complete specification. Error which would not mislead does not vitiate.

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 (*k*), nor by a mistake in a matter foreign to the invention, nor by the inaccurate use of 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 (*l*).

And if in a particular figure there is some error of the draughtsman which a skilled workman would at once perceive to be an error, and such an error as he could correct, it is nothing more than like the mere misprint of a word which anybody could read, although it was so misprinted (*m*).

A known or obvious slip need not be mentioned (*n*), and known methods or compounds may be described by general words (*o*). The question comes back to this:—Does the specification as it stands mislead the ordinarily competent man?

What errors are immaterial.

"When it is stated," said Lord Westbury, L. C., in *Simpson* v. *Holliday* (*p*), "that an error in a specification which any workman

(*i*) See also *Plimpton* v. *Malcolmson* (1876), 3 Ch. Div. 531; 45 L. J. Ch. 505: *Simpson* v. *Holliday* (1886), L. R. 1 H. L. 315; 35 L. J. Ch. 811; *Macnamara* v. *Hulse* (1842), 2 W. P. C. 128. n. In *The Lifeboat Co.* v. *Chambers* (1891), 8 R. P. C. 418, it was decided that an omission which an ordinary shipbuilder could obviate or supply by himself, would not, *per se*, vitiate the patent.

(*k*) *Neilson* v. *Harford* (1841), 1 W. P. C. 331, 340; 8 M. & W. 806; 11 L. J. Ex. 20; *Minter* v. *Mower* (1835), 1 W. P. C. 142; 6 A. & E. 735.

(*l*) *Derosne* v. *Fairie* (1835), 1 W. P. C. 154.

(*m*) Per Bowen, L. J., in *Miller* v. *Scarle Barker* (1893), 10 R. Pl. 111.

(*n*) *Morgan* v. *Seaward* (1836), 1 W. P. C. 177; 2 M. & W. 558; *Crossley* v. *Beverley* (1829), 3 C. & P. 513; 1 W. P. C. 106; *Household Co.* v. *Neilson* (1842), 1 W. P. C. 676.

(*o*) There seems some danger in so doing; see *Savory* v. *Price* (1823), 1 W. P. C. 83; 1 Ry. & Mo. 3.

(*p*) (1865) 13 W. R. 578.

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 cannot possibly mislead. 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 perceived by a workman possessed of ordinary knowledge of the subject."

Summary.

In conclusion the general rule may be summed up as follows: A complete specification is, and the Courts must declare it to be, 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.

Honest intention will not sustain an insufficient specification.

If the specification is insufficient, the patent is invalidated, and honesty of purpose is no answer to a deficiency in this respect (*q*). If two inventions are described and claimed in the same specification, the insufficient description of one will avoid the patent granted as regards both (*r*). If two processes are described as efficient and both are claimed as part of the invention, but on trial one is found to be useless, the entire patent will be voided (*s*).

2. The Claims.

Definition of claim.

A claim is a short clause inserted in a specification, wherein the patentee particularly points out what he claims as his invention. It is the part of the specification which defines and limits with precision that which is alleged to have been invented.

Origin of claims.

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* (*t*), 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

(*q*) *Simpson* v. *Holliday* (1864), Hig. Dig. 443.

(*r*) *Morgan* v. *Seaward*, 1 W. P. C. 167, 173; *Hill* v. *Thompson*, 1 W. P. C. 235; 8 Taunt. 375; *Rushton* v. *Crawley* (1870), 10 Eq. 522.

(*s*) *Simpson* v. *Holliday* (1866), 13 W. R. 578.

(*t*) (1858) 8 E. & B. at p. 1033; 27 L. J. Q. B. 295.

Act of 1883, s. 5, sub-s. 5.

there be no claim." The Act of 1883, sect. 5, sub-sect. 5, however, provides that a complete specification "must end with a distinct statement of the invention claimed."

Provided the specification ends with a statement of the invention 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 (*u*). There must, however, be a real statement of the invention claimed, and not merely a colourable compliance with the terms of the statute, nor a mere reference to the previous description, *e.g.* "I claim the invention described in the specification," would not be regarded as sufficient (*x*).

"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 (*y*).

The fact that a complete specification does not conclude with "a distinct statement" as above defined is not made a ground for revocation under sect. 26 of the Act, and cannot be urged as an objection to the validity of a patent (*z*); the section is merely directory (*z*).

Absence of a claim does vitiate the specification.

The result seems to be that the omission of a distinct claim would cause the examiners to report that the specification had not been prepared in the prescribed manner, and would cause the comptroller to refuse the application, or to require an amendment of the specification (*a*). If the patent is granted, the omission

(*u*) *Re Smith*, Griff. 268. *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.

(*x*) *Re Smith*, per Herschell, S.-G., Griffin, P. C. 268.

(*y*) *Siddell* v. *Vickers* (1888), per Lopes, L. J., 5 R. P. C. at p. 433; 39 Ch. Div. 92. 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 herein-before set forth, and as illustrated on the accompanying drawings," not to be "a distinct statement" within this subsection. In the House of Lords the matter did not call for a decision.

(*z*) So decided by the House of Lords affirming the Court of Appeal in *Vickers* v. *Siddell* (1890), 15 App. Ca. 496; 60 L. J. Ch. 105; 7 R. P. C. 292.

(*a*) Act of 1883, sects. 6, 7.

of a claim is neither a ground for revocation, nor is it a defence to an action for infringement (*b*).

Function of a claim.

The function of a claim has been considered on several occasions. The view taken under the former Acts is to be found in *Kay* v. *Marshall* (*c*), where Lord Cottenham said: "It (the claim) is introduced lest in describing and ascertaining the nature of his invention, and by what means it is to be performed (particularly in the case of a patent for an improvement), 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."

Claim is to a large extent a disclaimer.

In *Plimpton* v. *Spiller* (*d*), James, L. J., said: "The real object of what is called a claim . . . is not to claim anything which is not mentioned in the specification, but to disclaim something; . . . having described his invention and the mode of carrying that invention into effect, by way of security he says: 'But take notice, I do not claim the whole of the machine, I do not claim the whole of that *modus operandi* but that which is new, and that which I claim is that which I am now about to state.' That really is the legitimate object of a claim, and you must always construe a claim with reference to the whole context of a specification."

The law under the older Act as stated in *Plimpton* v. *Spiller* has recently been declared still to hold good under the present Act, and the judgments of James, L. J., have been quoted with approval both by Kay, L. J., and Smith, L. J. (*e*). But according to a dictum of Lord Herschell in *Parkinson* v. *Simon* (*f*), the view of the functions of a claim stated in the old cases need modification. On counsel saying that a claim is a disclaimer, and must not be taken to widen the description in the body of the specification, Lord Herschell said: "Since 1883 it is not correct to speak of a claim as a disclaimer, as one can now only protect what is claimed."

But it is more than merely a disclaimer.

To consider whether, before 1883, the negative operation of the claim was not too exclusively considered, would now be

(*b*) *Vickers* v. *Siddell* (*sup*).

(*c*) (1836) 1 My. & Cr. 383; 2 W. P. C. 39.

(*d*) (1877) *Plimpton* v. *Spiller*, 6 Ch. Div. 412; 47 L. J. Ch. 211. And see per Jessel, M. R. in *Hinks* v. *Safety Lighting Co.* (1876), 4 Ch. Div. 607; 46 L. J. Ch. 185; per Kay, J., in *Lucas* v. *Miller* (1855), 2 R. P. C. 155.

(*e*) *Edison-Bell Phonograph Co.* v. *Smith and Young* (1894), 11 R. P. C. 389, at pp. 401, 405.

(*f*) (1895) 12 R. P. C. at p. 406.

unprofitable. Since the coming into operation of the 1883 Act, a claim must not be taken to be merely a disclaimer. It is a disclaimer, but it is something more. The law now requires that the claim shall be "a distinct statement of the invention claimed." When a patentee says: "I claim A.B." he must be taken to mean I claim nothing but A.B., but A.B. I do claim.

This view is supported by the dictum of Lord Herschell, just quoted, and receives indirectly support from the decision of the House of Lords in the case under argument when the late Lord Chancellor made his remark. On the other hand, the adoption, in *Edison* v. *Smith* (*g*), of the dicta of James, L. J., in *Plimpton* v. *Spiller* (*h*), tells against it. It will be observed, however, that Kay, L. J., in quoting the language of James, L. J. (*i*), evidently adopts it only in respect to the particular claim before him at the time. Smith, L. J., certainly goes farther (*k*), but obviously he had in mind the practice which prevailed before the Act of 1883, and not the provisions of that Act itself. It is submitted that the view of the function of a claim which prevailed when a claim was put in only *ex abundantia cautela*, no longer prevails now that the Legislature has directed that a distinct statement of the invention claimed ought to be added to the specification, but that the obiter dictum of Lord Herschell will, when the point calls for decision, be declared to be a correct statement of law.

Office of a claim as stated in *Siddell* v. *Vickers*.

The language of Kekewich, J., in *Siddell* v. *Vickers* (*l*) may be quoted: "Its office [*i.e.* of the claim] is to sum up what has been explained in detail, and to state distinctly, that is, in a manner fairly intelligible to the competent student, what is claimed, and if necessary for distinctness, what is not claimed, so as if, as is likely and usual, the copiousness of explanation and illustration has proved embarrassing, no reasonable doubt may remain as to what is of the essence of the invention, and what is left at large for the ingenuity of subsequent makers in the same field."

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.

The claim must not go beyond the invention.

Thus, a patentee must not claim what someone else has invented. In *Minter* v. *Mower* (*m*), the patent was taken out for "an

(*g*) (1894) 11 R. P. C. 389.
(*h*) (1877) 6 Ch. Div. 412; 47 L. J. Ch. 211.
(*i*) 11 R. P. C. 401.
(*k*) 11 R. P. C. 405.
(*l*) (1888) 39 C. D. 92, 96.
(*m*) (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. 361.

improvement in the construction, making, or manufacturing of chairs." The specification concluded, "what I claim as my invention 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."

Patentee must not claim more than he has himself invented.

Again, the patentee must not claim more than he has himself invented.

In *Bloxam* v. *Elsee* (*n*), 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.

Claim must not be too wide—

A claim must not be so wide, either in itself or upon the evidence, as to include that which, either on account of anticipation, or for other reasons, is not patentable.

In *Wyeth* v. *Stone*, an American case mentioned by Mr. Justice

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. 627, 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. 522.

(*n*) (1827) 6 B. & C. 169; 1 W. P. C. 132, n.

Curtis in his work on *Patents* (*o*), 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* (*p*), "chooses to put forward his claim in so preposterous a form as that, of course he 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."

either apart from the evidence,

Jordan v. *Moore* (*q*) 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 is better as an illustration of the rule that a patentee cannot claim more than he has invented. 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 the course of his judgment in *Edison-Bell Phonograph Corporation* v. *Smith* (*r*), Wright, J., said: "No case has been cited to show that exception can be taken to a claim on the ground of its being too wide or general, without evidence to show that it includes something old or useless;" and the words were quoted with approval by Smith, L. J. (*s*). But if through generality the claim covers something which is not patentable, *e.g.*, a principle, the claim will be bad, though neither old nor useless. The dictum of Wright, J., therefore, must probably be extended to this, that a claim, though wide or general, will not

The validity of wide claims.

(*o*) Sect. 148, and 1 Story, 273.

(*p*) (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.

(*q*) (1866) L. R. 1 C. P. 624; 35 L. J. C. P. 268; see also *Patterson* v. *Gas Light and Coke Co.* (1875), 2 Ch. Div. 812, 834; 45 L. J. Ch. 843.

(*r*) (1894) 11 R. P. C. 163.

(*s*) (1894) 11 R. P. C. 405.

be bad unless it includes something old, useless, or otherwise not the subject of a valid patent.

It may one day be a point whether even this is good law. In *Booth* v. *Kennard* (*t*) the claim ran thus: "I claim for making gas direct from seeds and matter herein named, for practical illumination or other useful purposes, instead of making it from oils, resins, or gums previously extracted from such substances." It was decided that the claim was too large owing to the existence of a prior patent; that, even if the invention had been new, the claim would have been too large and the patent bad (*u*). With the exception of this case, there seems to be no very clear decision which impugns the generality of the law as laid down in the *Edison-Bell case*. But, inasmuch as the claims before the 1883 Act could not extend but only limited the other parts of the specification (*x*), much assistance in coming to a conclusion cannot be derived from the absence of cases. If, as is submitted, the functions of the claim are now of a positive as well as of a negative character, the mere width of a claim may well be a ground for declaring it bad. The dictum of Wright, J.—unnecessary to the decision in the case before him, and not stating the law in very decided terms—will not be much in the way of such a conclusion.

Though a claim to an old process would be bad, the patentee is not debarred from pointing out that the invention is also available for a use in a manner which is not new, provided that he makes no exclusive claim to the old method (*y*). And if a material resulting from a process is claimed, the specification of a particular user of it, comprehended in the general user claimed, will not vitiate the patent (*z*).

Claim to a something useless.

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 (*a*).

Reg. v. *Cutler*.

In *Reg.* v. *Cutler* (*b*), the case of *Lewis* v. *Marling* (*a*) was quoted as establishing the doctrine that if the specification of

(*t*) (1857) 2 H. & N. 84; 26 L. J. Ex. 305. And see, per Malins, V.-C., in *Rushton* v. *Crawley* (1870), 10 Eq. 527.

(*u*) In this case the claim was too wide, because it went beyond what was described in the specification, and no method of carrying the claim into effect was given.

(*x*) See Pollock, C. B., in *Heath* v. *Unwin* (1855), 25 L. J. C. P. at p. 20; 5 H. L. C. 505.

(*y*) *Goddard* v. *Lyon* (1894), 11 R. P. C. 354, 360.

(*z*) *Neilson* v. *Betts* (1871), L. R. 5 H. L. 1, 21; 40 L. J. Ch. 317.

(*a*) *Lewis* v. *Marling* (1829), per Lord Tenterden, C. J.; 10 B. & C. at p. 25.

(*b*) (1849) 14 Q. B. 372, n.; *Beard* v. *Egerton* (1849), per Maule, J., 19 L. J. C. P. 40.

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 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* (*c*), "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* (*d*) is a conclusive authority in favour of the law laid down by the Court of King's Bench in *Reg.* v. *Cutler* (*dd*). 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."

These cases are but illustrations of the principle that no part of a specification may be vague and ambiguous. As applied to claims the law may be gathered to be that if the useless part is claimed as being a necessary part of the invention, or an alternative mode of carrying it out, the claim is bad; the reason being that the public are likely to be misled. If, however, the useless part of

(*c*) (1829) per Lord Tenterden, C. J., 10 B. & C. at p. 25.

(*d*) (1866) 5 N. R. 340.

(*dd*) *Supra*, p. 187,

the claim would neither puzzle nor mislead, the claim will not be invalidated. A claim which is futile, and has no effect upon the monopoly, and which is uselessly added, will not vitiate a patent otherwise good (*e*); unless it makes the rest of the specification vague or misleading.

Claims may cover anything which could be the subject of a patent.

It may be stated as a general rule that claims may include anything which can be the subject of a valid patent, but nothing else. For instance, a new idea coupled with a mode of carrying it out, new combinations or improvements may be claimed. On the other hand, an abstract principle cannot be *per se* the subject of a claim (*f*), nor can the *mere* application of an old thing to an analogous purpose (*g*).

Improvements and combinations.

In claims for improvements it must be specifically pointed out what is the improvement claimed and what is the old part of the article; whereas, in claims for combinations, there is no need specifically to distinguish the new from the old. But if it is desired that the patent should cover the details of the combination, these must be specifically pointed out and claimed (*h*). And in any case, in a specification of a patent for a combination, the claim must be so drawn that the public may know whether what is claimed is a combination alone, or the combination with the parts of which it is made up (*i*).

If the elements are to be covered by the patent they must be specifically claimed.

It is altogether a question of construction of the particular instrument before the Court (*k*). The specification should be viewed as a whole, and keeping in mind the state of knowledge at the date of publication, it must then be decided whether the claim is for a combination, or for the particular parts making up the combination—called the subordinate integers,—or for both (*l*).

The language used in *Lister* v. *Leather* (*m*), to the effect that a valid patent for an entire combination for a process gives

(*e*) And see the concluding part of the speech of Lord Cairns in *British Dynamite Co.* v. *Krebs*, Good. P. C. at p. 94; 13 R. P. C. 190; *Plimpton* v. *Spiller* (1877), 6 Ch. Div. at p. 434.

(*f*) *Neilson* v. *Harford* (1841), 1 W. P. C. at p. 337; 8 M. & W. 806; *Otto* v. *Linford* (1882), 46 L. T. 39.

(*g*) *Harwood* v. *G. N. Ry.* (1860-5), 11 H. L. C. 654; 35 L. J. Q. B. 27.

(*h*) The development of the law in this respect has already been dealt with, *ante*, pp. 170 *et seq.* And see *Foxwell* v. *Bostock* (1864), 4 De G., J. & S. 298, 311; *Moore* v. *Bennett* (1861), 1 R. P. C. at p. 143; *Rowcliffe* v. *Morris* (1886), 3 R. P. C. 17, 145.

(*i*) Per Bristowe, V.-C., in *Rowcliffe* v. *Morris* (*ubi sup.*).

(*k*) *Rowcliffe* v. *Morris* (*sup.*); *Kelly* v. *Heathman*, 45 Ch. Div. 256; 60 L. J. Ch. 22; 8 R. P. C. 343; *Murray* v. *Clayton* (1873), 7 Ch. 570, 578; *Clark* v. *Adie*, 10 Ch. at p. 671; 45 L. J. Ch. 228; *Lister* v. *Leather* (1858), 8 E. & B. 1023.

(*l*) *Westinghouse* v. *Lancs. and Yorkshire Ry.* (1884), 1 R. P. C. 98, 229.

(*m*) (1858) 1 E. & B. 1004, 1023.

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, has been adversely criticised, and is no longer law (*n*). A claim for a combination of three elements is very different from, and does not cover the three elements separately. It is important to bear this in mind when drawing claims. If the subordinate integers are not claimed, infringement of them cannot be complained of; if they are separately claimed, and are not novel, they avoid the whole patent and must be got rid of.

Claim for subordinate integers.

The law as to "subordinate integers" was very clearly put by Lord Cairns, L. C., in *Clark* v. *Adie* (*o*):

"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 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."

(*n*) Per Lord Chelmsford, 1 App. Ca. 581.

(*o*) (1873-75) 2 App. Cas. at p. 321; 46 L. J. Ch. 595; followed by Cotton, L. J., in *Cropper* v. *Smith* (1884), 1 R. P. C. at p. 87.

Claim for subordinate integer *in gross*.

"When one does find in a claim," said Cotton, L. J., in *Cropper* v. *Smith* (*p*), "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 which are introduced into it, and help, together with other things, to make the entire combination."

Integers appendant.

Claims for subordinate integers as appendant.

If the subordinate integers thus claimed are claimed only as appendant to the main invention—if, in fact, it 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. Thus, in *The British Dynamite Co.* v. *Krebs* (*q*), 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. "He does not," said Lord Cairns, "claim the means of explosion *in gross*, but only as *appendant* to the dynamite, and he would not be allowed under this patent to claim them for any other purpose. In other words, he claims in the first claim the dynamite, the substance itself, and in the second claim the only mode of using the dynamite with which he was at the time acquainted. It is possible that, having stated the means by which the dynamite could have been exploded, he might have omitted his second

(*p*) (1884), 1 R. P. C. at p. 88.

(*q*) (1875-9) Good. P. C. 88; 13 R. P. C. 190; followed in *The Pneumatic Tyre Co.* v. *Casnell* (1896), 13 R. P. C. 164, in which it was stated that the addition to valid claims of claims for mere methods of application of the invention, which are surplusages, does not invalidate the patent.

claim, and contented himself with the first. But the second being, as it seems to me, merely a claim to the user of that which is included in the first, I cannot think that the patent should be avoided by the introduction of that which is merely useless."

In this connection it may be more broadly stated, that if there are two constructions, one of which will support and the other invalidate the patent, the Court will construe the specification so as to support the patent. But the proposition cannot be sustained as a general statement of law; it applies only when there is an ambiguity in the language of the claim (*r*).

Plimpton v. *Spiller* explained.

It is said that 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.

Plimpton v. *Spiller* (*s*), an exceptional case, illustrates the above. There 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 (*t*): "If you can say that the subsidiary

(*r*) See per Lord Davey in *Parkinson* v. *Simon* (1895), 12 R. P. C. at p. 411.
(*s*) (1876–77) L. R. 6 Ch. D. at p. 426; 47 L. J. Ch. 211.
(*t*) *S.C.*, L. R. 6 Ch. D. at p. 433; cp. *Betts* v. *Neilson* (1871), L. R. 5

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* (*u*) "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*."

Effect of a bad claim is to invalidate the patent.

The effect of a bad claim is to avoid not only the claim itself, but the patent as a whole goes too (*x*). And *bonâ fides* on the part of the patentee will not save the grant. The patentee may amend his specification by disclaiming the obnoxious claim, but only subject to the restriction imposed by sect. 20, as to which see *infra*, p. 228 and p. 592.

The drafting of claims becomes, therefore, a matter of great difficulty, for if they be too wide they subject the patentee to the danger of invalidation; and if too narrow, it becomes comparatively difficult to show that an infringer has contravened the patent. Especially does the difficulty arise in the case of combinations. Often the general idea as carried out in practice is first claimed, and then follow claims for the subordinate parts, either in combination or otherwise according to circumstances. It is the width of the general claim which in practice is found to be most dangerous, and often, in lieu of a general claim, the particular parts are claimed in combination in as many ways as may occur to the ingenious draftsman, so as to render the path of the infringer difficult. In the result, claims are becoming as numerous and as bulky as the paragraphs of the object clause of a memorandum of association.

The following is a good example of how a meritorious invention

H. L. at p. 21; 40 L. J. Ch. 317. 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."

(*u*) 1884, 1 R. P. C. at p. 90.

(*x*) *British Dynamite Co.* v. *Krebs* (1879), Good. P. C. 93; *Rose* v. *Braby* (1894), 11 R. P. C. 198; *Parkinson* v. *Simon* (1895), 12 R. P. C. at p. 408. See a suggested limitation in *Adamant Stone and Paving Co. Ltd.* v. *Corporation of Liverpool* (1897), 14 R. P. C. at p. 23.

may be defeated:—*Cassel Gold Extracting Co.* v. *Cyanide Gold Recovery Syndicate* (*y*). The patent was for a method of obtaining gold and silver from ore. The first claim was "for the process of obtaining gold and silver from ores and other compounds, consisting in dissolving them out by treating the powdered ore or compound with a solution containing a quantity of cyanogen, or a cyanide, or cyanogen-yielding substances, substantially as hereinbefore described." The Court of Appeal, deciding that it was old knowledge that cyanide of potassium would act as a solvent of finely divided gold, but not that it would act as a solvent of gold to extract it from the ore, nevertheless felt obliged to decide against the patentee, because the first claim claimed the use of any cyanide of potassium in solution (without limitation as to quantity), to extract gold from ore, a claim useless and too wide, it being proved that only a dilute solution would effect the purpose.

"Substantially as described."

It is a common practice to add to the claim the words: "substantially (*z*) as before described," or words to the like effect, the object being to limit the generality of a claim by the description contained in the body of the specification. The claim may, and indeed should, be read in the light of the information contained in the specification (*a*); but the inclusion of the words just stated do not always have the limiting effect intended. The question is one of construction, and depends entirely upon the exact framing of the specification; each case must depend upon its own facts. If this be borne in mind, the following case may carefully be noted:

Cassel Gold Extracting Co. v. *Cyanide Gold Recovery Syndicate* (*b*). It was argued that a general claim for the use of a cyanide was restricted, by the words "substantially as described," to the proportions mentioned in the specification. But a second claim embracing the dilute solution contained the specified amount. The Court of Appeal (affirming Romer, J.), said that the true construction was that the first claim and the second were different, and that consequently the wide interpretation which must be given to the first made the whole bad.

Parkinson v. *Simon*.

Parkinson v. *Simon* (*c*): the patent in this case was for "Improvements in sieves for purifying grain." There were four

(*y*) (1895) 12 R. P. C. 232.

(*z*) In *Young* v. *Rosenthal* (1884), 1 R. P. C. 33, Mr. Justice Grove commented adversely upon the use of the word "substantially." He regarded it as entirely useless.

(*a*) (1895) 12 R. P. C. 232.

(*b*) *Edison* v. *Woodhouse* (1887), 4 R. P. C. at p. 107.

(*c*) (1895) 12 R. P. C. 403.

claims, the last of which was for the combination of a sieve and side deposit surfaces with a deflector. The other three claims did not mention the deflector, *e.g.*, the first claim was "in apparatus such as described a sieve tapering in width towards the delivery or tail end in combination with one or more side deposit surfaces increasing in width towards the delivery or tail end substantially as and for the purpose described and illustrated in the accompanying drawings." The specification itself mentioned and described the deflector and referred to the drawings, and these contained diagrams of the deflector in combination with the general apparatus. For the present purpose it may be taken that the claims—of which the first just quoted is an example—were bad unless they included the combination with the deflector. It was argued for the patentee that the words "in apparatus such as described," and "substantially as and for the purpose described," by reference incorporated in the claim a claim to the combination of deflector and sieve. The House of Lords rejected the contention. Lord Herschell said: "I find it impossible to put that construction upon the words 'in apparatus such as described.' The effect of it necessarily would be to make all the four claims mean exactly the same thing, because, of course, if 'in apparatus such as described' means apparatus containing every one of the parts described, and if you only claim what you do claim in that apparatus, obviously that is a claim to a combination which is precisely the same in each of the four cases referred to . . . I think 'in apparatus such as described,' naturally refers to the general use of the apparatus specified in the first two lines of the specification. 'This invention relates to oscillating sieves used for purifying . . . grain or other substances.'"

A meaning to be given if possible to each claim.

It will be noticed that Lord Herschell based his interpretation of these particular claims on the necessity of giving a meaning to each claim (*d*). This may not always be possible, and, as Lindley, L. J., pointed out in *The Wenham Gas Co.* v. *The Champion Gas Lamp Co.* (*e*), a repetition of a claim, though mere redundancy, does not vitiate a patent. If, however, the claims are susceptible of a different meaning, *Parkinson* v. *Simon* shows that the Court will probably, though not necessarily, so interpret the claims as to give each that different meaning (*f*).

(*d*) See also per Kay, J., in *Longbottom* v. *Shaw* (1888), 5 R. P. C. 502.

(*e*) (1892) 9 R. P. C. at p. 55.

(*f*) See also *Jordan* v. *Moore* (1866),

Edison Bell v. Young.

In *The Edison Bell Phonograph Corporation* v. *Smith and Young* the specification stated: "Having now particularly described and ascertained the nature of this invention and in what way the same is to be performed, I claim (i) in a phonograph, attaching both the recording point and the reproducing point to the same diaphragm; means being provided whereby either of the points may be brought into operative position on the surface of the phonogram." It was urged that this claim was a claim for a monopoly for every form of phonograph in which the two styles are attached to one diaphragm so that each style can be brought to bear on the cylinder, and was therefore too wide. The Court of Appeal (confirming Wright, J.), rejected this contention, and held that the words "Having now particularly described, &c.," had the effect of limiting the claim to the arrangement carried out by any means substantially as described in the specification. It may be pointed out that this case was decided before the *Cassel Gold* (*h*) *case*, and also before *Parkinson* v. *Simon* (*i*). It may, perhaps, also be suggested that the remarks of Bowen, L. J., commenting on *Plimpton* v. *Spiller* (*k*) seem applicable to the Edison Phonograph case: "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 on the true construction of Plimpton's patent" (*l*).

Amongst other cases in which the effect of such words as "substantially as described" was considered are *Penn* v. *Bibby* (*m*); *Easterbrook* v. *Great Western Ry.* (*n*) (in both of which they had a limiting effect); *Laurence* v. *Perry* (*o*), and see also *United Telephone Co.* v. *Bassano* (*p*).

In avoiding too great width, care must be taken to avoid the opposite danger.

Claim for specific improvement.

If a specific mechanical improvement is claimed, the inventor must be held strictly to that particular mechanical device which

L. R. 1 C. P. 624; 35 L. J. C. P. 268 in which it was attempted, without success, to cut down the generality of one claim, by the words "substantially as described" included in another.

(*g*) (1894) 11 R. P. C. 389.

(*h*) *Ante*, p. 194.

(*i*) *Ante*, p. 194.

(*k*) (1877) 6 Ch. Div. 412; 47 L. J. Ch. 211. This case may be referred to as further illustration.

(*l*) *Cropper* v. *Smith*, 1 R. P. C. 90.

(*m*) (1866) 2 Ch. 130, 131; 36 L. J. Ch. 455.

(*n*) (1885) 2 R. P. C. 201.

(*o*) (1885) 2 R. P. C. 179.

(*p*) (1888) 3 R. P. C. 295, 315.

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 (*q*).

Seed v. *Higgins*

Thus, in *Seed* v. *Higgins* (*r*), 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 particular means described in the specification. It was held that the claim was strictly limited thereto.

In *Nobel* v. *Anderson* (*s*), the patent was for an improvement in explosives, and one of the claims was for the "manufacture from nitro-glycerine and soluble nitro-cellulose, of a horny or semi-horny explosive compound, susceptible of granulation, substantially as and for the purposes herein described." The defendant made an explosive using nitro-glycerine and insoluble nitro-cellulose. The Court finding as a fact that the soluble and the insoluble nitro-cellulose are different substances, held that the defendant had not infringed.

Sometimes the patentee claims to carry out his invention by specified means, "or any mechanical equivalent."

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 (*t*).

(*q*) *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. 840; 22 L. J. Ex. 295; 9 Ex. 494; 23 L. J. Ex. 217; *Proctor* v. *Bennis* (1888), L. R. 36 C. D. 740; 57 L. J. Ch. 11; 4 R. P. C. 333; *Ehrlich* v. *Ihlee* (1888), 5 R. P. C. 437, 453.

(*r*) (1860) 27 L. J. Q. B. 148, 411; 8 H. L. C. 550; cp. *Daw* v. *Eley* (1865), 3 Eq. at p. 512; 36 L. J. Ch. 482. When a specification has been the subject of a disclaimer, the specification and disclaimer are to be construed fairly and not strictly. *Hocking & Co.* v. *Hocking* (1888), per Cotton, L. J., 4 R. P. C. at p. 439.

(*s*) (1894) 11 R. P. C. 519; 12 R. P. C. 164.

(*t*) *Curtis* v. *Platt* (1863), per Wood, V.-C., 3 Ch. Div. 137, n. As to the word "substantially," see per Grove, J.,

Construction of a claim.

The construction of a claim is governed by the same rules as are applicable to the construction of a specification generally, or both see *post*, p. 202.

A claim must always be construed with reference to the whole context of a specification (*u*). 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 (*x*).

General claim may be modified by specification,

In *Arnold* v. *Bradbury* (*y*), 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* (*z*), the patentee claimed "the herein described method of preparing the illuminating part of an electric lamp, consisting of electrically heating the 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

in *Young* v. *Rosenthal* (1884), 1 R. P. C. 33; see also *Westinghouse* v. *Lanc. & Yorkshire Ry. Co.* (1884), 229 1 R. P. C.

(*u*) *Plimpton* v. *Spiller* (1876–77), per James, L. J., L. R. 6 Ch. D. at p. 426; 47 L. J. Ch. 211; *Leadbeater* v. *Kitchin* (1890), 7 R. P. C. 235; *Siddell* v. *Vickers* (1888), 39 Ch. Div. 92; 5 R. P. C. 416; *Edison-Bell Phonograph Co.* v. *Smith* (1894), 11 R. P. C. 389.

(*x*) *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; 25 L. J. C. P. 6.

(*y*) (1871) L. R. 6 Ch. D. 706.

(*z*) (1887) 4 R. P. C. 99, 107. In *Newton* v. *Vaucher* (1851), 6 Exch. at p. 864; 21 L. J. Ca. 305, 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.

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* (*a*), 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."

3. Drawings.

At one time drawings were unnecessary, but though unnecessary were very generally employed to explain the specification (*b*).

Act of 1883.

Under the Act of 1883, sect. 5 (3) and (4), the specifications, both provisional and complete, must be accompanied by drawings if required by the comptroller.

Act of 1886.

The Act of 1886, sect. 2, provides that the requirement 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 accompany 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."

The specifications when lodged are referred to an examiner to

(*a*) (1883-85) 2 R. P. C. 52.
(*b*) *Boulton* v. *Bull* (1793), 2 H. Bl. 482; *Bloxham* v. *Elsee* (1825-7), 1 C. & P. 568; *Hastings* v. *Brown* (1853), 1 E. & B. 450; 22 L. J. Q. B. 161.

consider whether they are in order, and one of the matters he must report on is, whether the drawings (if any) have been prepared in the prescribed manner (*c*). If the report is adverse the comptroller may refuse to grant the application until amendment has been made (*d*).

But rule 30 of the Patent Rules, 1890, provides that the provisional or complete specification need not be accompanied by drawings if the specification sufficiently describes the invention without them.

The prescribed rules provide for all details connected with the preparation and lodging of the drawings; see *post*, Patent Rules, 1890, rules 30 to 33.

Specifications without letterpress.

At one time drawings alone might have been a sufficient specification (*e*), provided (probably) that the title was attached. But under the present Act, a claim would be required, and a specification without any letterpress would, to say the least, be very unusual. It will be observed that in sect. 5 of the Act, the specification and drawings are spoken of as distinct.

Effect of drawings.

The law as to the effect of drawings annexed to the specification 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 the aid of drawings (if any) (*f*), which he annexes to his specification (*g*). The drawings are taken as part of the specification (*h*), and are admissible to explain an ambiguity (*i*). But the drawings must be clear themselves (*k*). And if the words of the specification itself be clear, drawings cannot be allowed to alter the meaning (*l*).

Fairburn v. *Household.*

The extent to which drawings can be relied on where there is ambiguity in a complete specification was considered in the case of *Fairburn* v. *Household* (*m*).

The question at issue there was, whether the patentee of an

(*c*) Act of 1883, sect. 6.

(*d*) *Ibid.*, sect. 7.

(*e*) *Brunton* v. *Hawkes* (1820), 1 Carp. P. C. 405; 4 B. & Ald. 541; *Poupard* v. *Fardell* (1869), 18 W. R. 127; *Foxwell* v. *Bostock* (1864), 4 De G. J. & S. 298, 363.

(*f*) This was once doubted; *Ex parte Fox* (1812), 1 V. & B. 67. But see 1 W. P. C. 75, n., note to *Macfarland* v. *Price*.

(*g*) *Bloxham* v. *Elsee* (1825), 1 C. & P. 564; *Daw* v. *Eley* (1867), 3 Eq. 500, n.; *Brown* v. *Jackson* (1895), 12 R. P. C. at p. 324.

(*h*) *Morgan* v. *Seaward* (1836), 1 W. P. C. 173; *Morton* v. *Middleton* (1863), 1 Ct. Sess. 3rd series, 722, 724.

(*i*) *Hastings* v. *Brown* (1853), 1 E. & B. 450; 22 L. J. Q. B. 161; *Daw* v. *Eley* (*sup.*); *Matthews* v. *Parmenter* (1896), 13 R. P. C. 518.

(*k*) *Clark* v. *Adie* (1877), 2 App. Ca. 315; 46 L. J. Ch. 585.

(*l*) *Stewart* v. *Bell's Trustee* (1883), 11 Ct. Sess. Ca., 4th series, 236.

(*m*) (1886) 3 R. P. C. 263.

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."

Drawings should be accompanied by a scale whenever the identity of proportions is in question; and, indeed, a scale is generally a convenience (*n*).

Erroneous drawings.

An error in the drawings, if explained in the specification so as to prevent the ordinary skilled workman from going wrong, will not hurt the patent (*o*). And generally it may be said that if the drawings, though not skilfully drawn, are sufficient to enable the persons of the class who would be expected and entitled to understand the specification to make the thing invented, the drawings will suffice (*p*).

4. Miscellaneous.

Forms, see *post*, p. 818; Acceptance of specification, see pp. 565, 569; Publication of specification, see pp. 572, 580; Time for submitting, see p. 567. And see Patent Rules for details of practice, *post*, pp. 689 *et seq.*

(*n*) Morton v. *Middleton* (1863), 1 Ct. Sess., 3rd series, 721.

(*o*) *Miller* v. *Scarle, Barker & Co.* (1893), 10 R. P. C. 106, 111; *Simpson* v. *Holliday* (1866), 13 W. R. 577.

(*p*) *Bovill* v. *Moore* (1816), Dav. P. C. 361.

Section 5.—Construction of Complete Specification.

Various ideas of construction.

Different views have prevailed, in the development of our patent law, as to the principles on which the specification of an invention ought to be construed. Three doctrines have been advanced: (1) that a patent being a grant of a monopoly must be very strictly construed; (2) that the invention being meritorious, and the patent being a reward, must be benevolently construed; (3) that letters patent must be construed like any other document.

Strict interpretation.

In early times, it was the fashion of the Courts of justice to lean in favour of the public against the patentee (*q*).

Benevolent interpretation.

About the year 1830 (*r*), 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 (*s*).

With regard to this doctrine of "benevolent interpretation," it must be observed that the evidence for its existence rests chiefly on isolated dicta (*t*), and that a strong counter-current of authorities supports the modern theory of construction, which will be dealt with later on.

Thus, in *Haworth* v. *Hardcastle* (*u*), 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 contrary, such construction ought to be made as will, consistently with the fair import of the language used,

(*q*) *Hullett* v. *Hague* (1831), 2 B. & Ad. 370; *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 R. P. C. pp. 90, 91.

(*r*) 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."

(*s*) See the cases in note (*q*), *supra*.

(*t*) In *Sellers* v. *Dickinson* (1850), 20 L. J. Ex. 417; 5 Ex. 312, 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."

(*u*) (1834) 1 W. P. C. at p. 485; 1 Bing. N. C. 182.

make the claim of invention co-extensive with the new discovery of the grantee of the patent."

Again, in *Russell* v. *Cowley* (*x*), Alderson, B., said that 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* (*y*), 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.* (*z*), 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. 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."

"Judicial anxiety" to support a useful invention.

Substantial invention of merit.

In *Plimpton* v. *Spiller* (*a*), 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 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."

(*x*) (1834) 1 Web. P. C. 470.

(*y*) (1845) 15 L. J. C. P. 49; 2 C. B. 446; *cf. Household Co.* v. *Nielson* (1843), 1 W. P. C. 679; *Beard* v. *Egerton* (1848), 8 C. B. 165; 19 L. J. C. P. 36; *Tetman* v. *Wood* (1864), per Willes, J., 16 C. B. N. S. at p. 503; *Simpson* v. *Holliday* (1866), 13 W. R. 578; *Adie* v. *Clark* (1876), per James, L. J., 3 C. D. at p. 142.

(*z*) (1876) L. R. 4 C. D. at p. 612; 46 L. J. Ch. 185.

(*a*) (1876–77) L. R. 4 Ch. D. at p. 423.

These passages should be compared with the language of the same learned Judge in *Otto* v. *Linford* (*b*).

"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 (*c*), 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*.

In *Cropper* v. *Smith* (*d*), 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

Bowen, L. J., on "benevolent construction."

(*b*) (1881–82) 46 L. T. at p. 39. It might be suspected that sometimes benevolence of construction varies directly with the merit of invention. *Fletcher* v. *Glasgow Gas Commissioners* (1887), 4 R. P. C. 386, 388; *Hinks* v. *Safety Lighting Co.* (1876), 4 Ch. Div. 607; 46 L. J. Ch. 185; *Nobel* v. *Anderson* (1890), 11 R. P. C. 525.

(*c*) Cp. *Bickford* v. *Skewes* (1841), 1 Web. P. C. 214.

(*d*) (1884) 1 R. P. C. at pp. 89, 91; *Sugg* v. *Bray* (1885), per North, J., 2 R. P. C. at pp. 230, 231.

old principle of construction, which is not all special to the subject-matter of patents, but applies to all documents and all deeds, which is as old as Coke and Shepherd'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*'(*e*). 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"(*f*).

Present theory of construction.

The leading principles applicable to the construction of a specification have now been clearly settled.

In *Harrison* v. *Anderston Foundry Co.* (*g*), Lord Chelmsford said: "In the construction of a specification it appears to me 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 R. P. C., at p. 307.

(*e*) 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.

(*f*) In *Newton* v. *Grand Junction Rail. Co.* (1845-46), 5 Ex. at p. 335; 20 L. J. Ca. 427, n.; 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

(*g*) 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; 46 L. J. Ch. 585; *Dudgeon* v. *Thomson* (1877), per Lord Blackburn, 3 App. Cas. at p. 53; *Roberts* v. *Heywood* (1879), 27 W. R. 454.

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."

Needham v. *Johnson.*

In *Needham* v. *Johnson* (*h*), 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."

To be construed by the rules applicable to other documents.

In *Leadbitter* v. *Kitchin* (*i*), Esher, M. R., said that the true rule is to construe the specification precisely according to the same rules which are applied to any other document. In *Edison-Bell Phonograph Corporation* v. *Smith* (*k*) the same learned Judge said: "There are certain rules as to the effect of patents, when you have construed them, which are different from other instruments; but as to the rule of construction of a patent, when the question is what is the true construction, I cannot doubt myself that the same rules of construction or the same canons of construction are to be applied to the construction of a patent, or to any part of it, as are used with regard to any other instrument." Kay, L. J., delivered judgment to the like effect (*k*). Again, in *Nobel's Explosives Co.* v. *Anderson* (*l*), Lord Esher said: "I am clearly of opinion that, whether the patent be a pioneer patent, or a master patent, or a patent of the first invention, or whether

(*h*) (1884) 1 R. P. C. at p. 58. See also *Lister* v. *Norton* (1882), 3 R. P. C. 199; *Automatic Co.* v. *Knight* (1889), 6 R. P. C. 297, 307.

(*i*) (1890) 7 R. P. C. 235.
(*k*) (1894) 11 R. P. C. 389.
(*l*) (1894) 11 R. P. C. 519; in the House of Lords, 12 R. P. C. 164.

it be a valuable patent or a patent for the smallest thing, or whether it be for a patent for an improvement, or whatever the patent may be, the canons of construction of the patent are precisely the same. What is more, I am further of opinion that the canons of construction of a patent are the same canons of construction that are to be applied to every written instrument which has to be construed by the Court."

This statement of the principle upon which patents should be construed is that which found favour with the House of Lords in *Parkinson* v. *Simon* (*m*). Lord Halsbury said that the whole instrument must be looked at and the necessary rules of construction must prevail, and he protested against the suggestion that the meaning of the specification should, if possible, be so stretched as to support the patent (*n*).

It may be said, in conclusion, that the specification will not be construed as rigorously as was at one time the practice (*o*), and the Court will not be on the look out for flaws in the document; but the words used will be taken in the sense in which they would be understood at the time of publication by those to whom they are addressed, and the Court will determine the meaning of the specification according to the ordinary rules of construction. But if the language is ambiguous, and fairly capable of more than one construction, the Court will adopt that which supports the patent, unless the ambiguity be intentional (*p*), or *semble* misleading to the public.

If the specification fairly bears two constructions, that which will support it is to be taken.

Thus, a patentee will not be presumed to have claimed what is well known to be old; but if he clearly does claim it, the Court cannot assist him by a benevolent construction (*q*). Absurdity of result is no ground for misconstruing, if the construction be clear (*r*).

The construction of the specification is matter of law, and will be a question for the Judge, its sufficiency is matter of fact, and in a jury trial (*s*) will be for the jury to determine (*t*). The

(*m*) (1895) 12 R. P. C. 403.

(*n*) Even to prevent a man derogating from his own grant: *Hocking & Co.* v. *Hocking* (1889), 6 R. P. C. 69.

(*o*) Per Lord Shand in *Lyon* v. *Goddard* (1894), 11 R. P. C. 354.

(*p*) Per Lord Davey in *Parkinson* v. *Simon* (1895), 12 R. P. C. 403, 411.

(*q*) *Haworth* v. *Hardcastle* (1834), 1 W. P. C. 480; 1 Bing. N. C. 182; *Oxley* v. *Holden* (1860), 8 C. B. N. S. 68; 30 L. J. C. P. 666; *Clark* v. *Adie* (1877), 2 A. C. 423, 437; 46 L. J. Ch. 598.

(*r*) *Cropper* v. *Smith* (1884), 1 R. P. C. 90.

(*s*) Patent actions are now tried without a jury unless the Court otherwise directs: 1883, sect. 28 (1).

(*t*) *Hill* v. *Thompson* (1817), 1 Web. P. C. at p. 237; *Derosne* v. *Fairie* (1835), 1 Web. P. C. 154; *Bickford* v. *Skewes* (1841), 1 Web. P. C. 214; *Neilson* v.

decision of the Court of Appeal on the construction of a specification, being a decision on a point of law, is binding on Courts below (*u*).

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* (*x*) :—"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 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."

Evidence to assist the construction.

But though the Court has to determine the construction, it will often require evidence to assist it in arriving at the true

Harford (1841), 1 Web. P. C. 295; *Beard* v. *Egerton* (1848), 19 L. J. C. P. 38; 8 C. B. 165; *Wallington* v. *Dale* (1852), 7 Ex. 888; 23 L. J. Ex. 49; *Seed* v. *Higgins* (1860), 8 H. L. C. 561; 30 L. J. Q. B. 314; *Nobel's Explosive Co.* v. *Anderson* (1894), 11 R. P. C. at p. 520. *Morton* v. *Middleton* (1863), 1 Ct. of Sess., 3rd ser. 721; *Parkes* v. *Stevens* (1869) L. R. 8 Eq. 358; 38 L. J. Ch. 627.

(*u*) *Otto* v. *Steel* (1886), 3 R. P. C. 109; *Edison* v. *Holland* (1890), 6 R. P. C. 276; *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.* (1890), 6 R. P. C. 370.

(*x*) (1862) 10 H. L. C. 134; 31 L. J. Q. B. 233; cp. *Muntz* v. *Foster* (1843), per Tindal, C. J., 2 Web. P. C. 105; *Allen* v. *Rawson* (1845), 1 C. B. 551; *Tetley* v. *Easton* (1852), Macr. P. C. 48; *Bush* v. *Fox* (1856), 23 L. J. Ex. 257; Macr. P. C. 178; *Booth* v. *Kennard* (1857), 2 H. & N. 84; 26 L. J. Ex. 305; *Thomas* v. *Foxwell* (1858), 5 Jur. N. S. 38; 8 Jur. N. S. 271; *Hills* v. *London Gas Light Co.* (1860), 5 H. & N. 312; 29 L. J. Ex. 409; *Hills* v. *Evans* (1862), 31 L. J. Ch. 457; 4 De G. F. & J. 288; *Pneumatic Tyre Co.* v. *Caswell* (1896), 13 R. P. C. at p. 179.

meaning. Evidence as to the state of knowledge at the date of the patent will be necessary, for specifications are to be construed according to the state of knowledge at the date of the patent (*y*).

And not only must the state of knowledge be taken into account, but also the class of persons to whom the specification is addressed. Evidence, therefore, may be tendered to show the meaning that would be attached to the specification by the skilled workman. "That doctrine [the skilled workman test] is applicable only where a particular description of work mentioned in a specification or something to be done appears to be ambiguous. If you read it without knowledge, it appears to you to be ambiguous, but then it is said, 'It appears to you to be ambiguous, but any workman of ordinary skill in the trade who would have to apply that description would understand it only in one way, and would be able to act upon it.' If that is true, then it is said that, although grammatically or with literal accuracy, there might be a doubt about it, there is no real business doubt about it, and the one meaning and the only meaning which you could attach to it is that which would strike an ordinary workman in the trade who would have to deal with it, and would strike him as the only way in which the work could be done" (*z*). Evidence would be required to enable the Court to determine a matter such as this.

Evidence as to terms of art.

Moreover, nearly every specification contains terms of art and technical expressions as to the meaning of which evidence will be received. In *Hills* v. *Evans* (*a*), Lord Westbury said that, although the construction of the specification belongs to the Court, the explanation of the words or technical terms of art, the phrases used in commerce, and the proof and results of the processes which are described (and in a chemical patent the ascertainment of chemical equivalents) are matters of fact upon which evidence may be given (*b*). See also the extract from *Betts* v. *Menzies* quoted above (p. 208).

The functions of witnesses with regard to the interpretation of the specification have been dealt with on several occasions.

(*y*) See, *e.g.*, Cotton, L. J., in *Edison* v. *Woodhouse* (1887), 4 R. P. C. at p. 94; Lord Herschell in *Boyd* v. *Horrocks* (1892), 9 R. P. C. at p. 82; Kay, L. J., in *Nettlefolds* v. *Reynolds* (1892), 9 R. P. C. 295; and Lord Esher, M. R., in *Nobel's Explosive Co.* v. *Anderson* (1894), 11 R. P. C. 523; also *Badische Anilin, &c.* v. *Levinstein* (1887), 12 App. Ca. 710; 4 R. P. C. 449.

(*z*) Per Esher, M. R., in *Edison-Bell, &c. Co.* v. *Smith* (1894), 11 R. P. C. 396.

(*a*) (1862-3) 31 L. J. Ch. 457; 4 De G. F. & G. 288.

(*b*) And see *Neilson* v. *Harford* (1841), 1 W. P. C. 331, 370; 8 M. & W. 806; 11 L. J. Ex. 20.

Expert evidence.

Lord Watson has said that evidence directed to the meaning of the specification is material only so far as it may supply scientific facts which ought to be taken into account in arriving at the true meaning of the instrument (*e*). The evidence of skilled workmen has been compared to that of handwriting experts: they call attention to particular things, which the Court has then to consider for itself (*d*). This, however, is hardly their function as regards construction of the specification; the business of an expert in such a case is to explain the technicalities of the invention, the meaning of the terms employed, the state of knowledge at the date of publication, and the way in which a skilled workman would read the specification. His opinion as to the construction is of little account. A handwriting expert points out certain facts, and gives his opinion.

A witness may sometimes be asked what he understands by the specification (*e*), and he may be asked what would the specification suggest to a person of ordinary mechanical skill (*f*), though the Court will not attach importance to the answer as a construction of the document. In *United Telephone Co.* v. *Bassano* (*g*), expert witnesses, speaking as to the specification, said that the word diaphragm or tympan must mean a diaphragm capable of being acted upon. Having obtained this assistance, the Court proceeded to construe the specification for itself.

In *Gadd* v. *Mayor of Manchester* (*h*), Smith, L. J., said: "Mr. Davey stated that 'chain and link gearing would be tensional,' that is that it would act by tension as distinguished from torsion, and that a chain passing over pulleys with or without teeth was distinctly an example of the plaintiff's invention. Dr. Hopkinson's opinion was that there were no inventions in the complete specification outside the invention described in the provisional. . . . Mr. Newbiggin said: 'I think that the methods described were fairly within the description of mechanical equivalents in the provisional,' . . . and Sir F. Bramwell . . . stated that there was no difference in the working of links and pitch pulleys and chain and link gearing and cords, and that it was the same, leaving

(*c*) *King, Brown & Co.* v. *Anglo-American Brush Corporation* (1892), App. Ca. 367; 9 R. P. C. 313.

(*d*) *Boyd* v. *Horrocks* (1892), 9 R. P. C. at p. 81, per Lord Herschell.

(*e*) Per Halsbury, L. C., in *Kaye* v. *Chubb* (1888), 5 R. P. C. 650.

(*f*) *Fletcher* v. *Glasgow Gas Commissioners* (1887), 4 R. P. C. 386; and see *Gandy* v. *Reddaway* (1885), 2 R. P. C. 49.

(*g*) (1886) 3 R. P. C. 295, 315; Griff. 220.

(*h*) (1892) 9 R. P. C. at p. 532. And see a statement of the position of expert witnesses made in *Brooks* v. *Stark* (1896), 14 R. P. C. 46.

expense out of the question. In my judgment the evidence of Mr. Davey and Sir F. Bramwell is legal evidence, and that of Dr. Hopkinson and Mr. Newbiggin, in so far as they give their opinion upon the meaning of the specification, is not."

The Lord Justice in the same case refused to read the opinions of experts as to the meaning of the specification, as they were not evidence "except as to the meaning of scientific terms when they occur, or as to the working of mechanical appliances, or as to what such working will bring about."

The whole specification must be read for the purpose of arriving at the true construction.

In determining the meaning of the specification, the entire document must be looked to (*i*). The title (*k*) will sometimes assist in getting at the meaning; the provisional specification, the complete, the claims, and the drawings (*l*) may all be looked at. But the provisional, though it may be looked at to ascertain the meaning of the complete (*m*), cannot supply a defect in it (*n*), nor can the complete extend the provisional, for the complete must itself be within the provisional (*o*). And great weight will be given to the claim (*p*). As regards the effect of the words "substantially as described," "hereinbefore described," "in apparatus such as described," see *ante*, p. 194, also *Penn* v. *Bibby* (*q*), *Lawrence* v. *Perry* (*r*), *Easterbrook* v. *Great Western Railway* (*s*), and *United Telephone Co.* v. *Bassano* (*t*), and per Blackburn, J., in *Betts* v. *Menzies* (*u*).

Decided cases on construction.

As each specification must be construed in accordance with its own wording, decided cases cannot be of any very great assistance in arriving at the meaning of any particular specification; but the following references to decisions delivered since the passing of the Patent Act, 1883, may be of use:—

Edison v. *Woodhouse* (*x*): an apparently general claim construed to be for an element made strictly as described in the specification (per Cotton, C. J.).

(*i*) *Plimpton* v. *Spiller* (1876), 6 Ch. Div. 412; 47 L. J. Ch. 211; *Edison* v. *Woodhouse* (1888), 4 R. P. C. 79, 107; *Edison-Bell Co.* v. *Smith* (1894), 11 R.P.C. at p. 395; *Leadbeater* v. *Kitchin* (1890), 7 R.P.C. 235.

(*k*) *Newton* v. *Vaucher* (1851), 21 L. J. Ex. 305; 6 Ex. 859; *Household Co.* v. *Neilson* (1842), 1 W. P. C. at p. 679.

(*l*) *Ante*, p. 200. And see *Nuttall* v. *Hargreaves* (1891), 8 R. P. C. 276, 450; (1892) 1 Ch. 23; *Pether* v. *Shaw* (1894), 10 R.P.C. 293; *Matthews* v. *Parmenter* (1896), 13 R. P. C. 518.

(*m*) Per Esher, M. R., in *Parkinson* v. *Simon* (1895), 11 R. P. C. at p. 503.

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

(*o*) *Ante*, pp. 146 *et seq.*

(*p*) Blackburn, J., in *Betts* v. *Menzies* (1862), 10 H. L. C. 117; 31 L. J. Q. B. 233, 239.

(*q*) (1866) 2 Ch. pp. 130, 131; 36 L. J. Ch. 455.

(*r*) (1885) 2 R. P. C. 179.

(*s*) (1885) 2 R. P. C. 201, 208.

(*t*) (1886) 3 R. P. C. 295.

(*u*) 10 H.L.C. 117; 31 L. J. Q. B. 233.

(*x*) (1887) 4 R. P. C. 79.

Proctor v. *Bennis* (*y*): Claim held to be for a combination. See also *Elias* v. *Gravesend Tinplate Co.* (*z*); *Kelly* v. *Heathman* (*a*).

Hutchinson v. *Patullo* (*b*): Claim held limited to a method and not to extend to the principle, though the method was not described.

Kaye v. *Chubb* (*c*): Claim construed to be not only for the apparatus described, but for every apparatus of substantially the same construction.

Vorwerk v. *Evans* (*d*): Claim construed to be not for waistbands generally, but for waistbands of the particular formation described.

Nuttall v. *Hargreaves* (*e*): Claim for a method held to be a claim for the thing described in the figures.

Pether v. *Shaw* (*f*): Claim held not limited to the apparatus shown in the drawings, but to include other appliances described in the specification which were old.

Peckover v. *Rowland* (*g*): In a combination, claim held limited to the combination, and not extended to the separate parts. See also *Westinghouse* v. *Lancashire and Yorkshire Railway Co.* (*h*); *Vickers* v. *Siddell* (*i*).

Boyd v. *Horrocks* (*k*): Invention held to be an improvement in a well-known machine, and to be confined to the particular improvement. This construction was disapproved of by the House of Lords.

(*y*) (1887) 36 Ch. Div. 740; 4 R. P. C. 333; 57 L. J. Ch. 11.
(*z*) (1870) 7 R. P. C. 455.
(*a*) (1889) 45 Ch. Div. 256; 60 L. J. Ch. 22; 7 R. P. C. 343.
(*b*) (1887) 4 R. P. C. 329; 5 R. P. C. 351.
(*c*) (1888) 5 R. P. C. 641.
(*d*) (1890) 7 R. P. C. 265.
(*e*) (1891) 8 R. P. C. 276, 450. (1892) 1 Ch. 23.
(*f*) (1893) 10 R. P. C. 293.
(*g*) (1893) 10 R. P. C. 234.
(*h*) (1884) 1 R. P. C. 98, 229.
(*i*) (1890) 15 A. C. 496; 7 R. P. C. 292; 60 L. J. Ch. 105.
(*k*) (1889–91) 6 R. P. C. 159; 9 R. P. C. 77.

CHAPTER VII.

AMENDMENT OF THE SPECIFICATION.

History of Amendment.

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 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 affixing to it as altered the Great Seal, which was in his custody (*a*). Clerical errors in the enrolment of letters patent or specifications were alterable by the Master of the Rolls (*b*).

Alteration of patent.

Alteration of enrolment.

(*a*) Hindmarch, 214 *et seq.*; cf. *Ex parte* Beck (1784), 1 W. P. C. 430; 1 Bro. C. C. 578.

(*b*) *Re Sharp's Patent* (1840), 1 W. P. C. at p. 647; 10 L. J. Ch. 86. 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:—

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 "Hereffordwest," 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."

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

Defect in substance fatal at common law.

According to common law, letters patent were wholly void for 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

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.

Redmund's Case.—July 25th, 1825, letters patent 9th November, 1621, to David Redmund, "for an improvement

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 (*c*). The necessity of providing some mode of escape from the defects which inevitably arose and the costs incurred led to a series of enactments, the first of which (Lord Brougham's Act, 5 & 6 Will. IV. c. 83) was the result of the report of the Select Committee of 1829 (*d*). Legislation.

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. 649, n. (*x*); *Nickel's Patent* (1841), 1 Web. P. C. 650; *Dismore's Patent* (1853), 18 Beav. 538; *Adam's Patent* (1853), 21 L. T. 98. 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. 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), *ibid.* April to June, xiii.; Lawson, 59. See also *Whitehouse's Patent* (1830), 1 W. P. C. 455.

(*c*) Web. Letts. Pat. 17.

(*d*) Subsequent statutes dealing with amendment are 5 & 6 Will. IV. c. 83; 7 & 8 Vict. c. 94; 12 & 13 Vict. c. 109; 15 & 16 Vict. c. 83; 16 & 17 Vict. c. 115. These are all now repealed. 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 enlarge the terms of his specification: *Ralston* v. *Smith* (1865), 11 H. L. C. 223; 35 L. J. C. P. 49, per Lord Chelmsford; *Foxwell* v. *Bostock* (1864), 4 De G. J. & S. 298, 306. The object of the disclaimer was merely to relieve him of insignificant, immaterial, or useless parts of his patent: *In re Derosne* (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; 27 L. J. Q. B. 295; *Thomas* v. *Welch* (1866), L. R. 1 C. P. 192; 35 L. J. C. P. 200.

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, sect. 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. 148, 411; 8 H. L. C. 550; *In re Medlock* (1865), Newton's Lon. Jour. N. S. vol. xxii. p. 69; *Cannington* v. *Nuttall* (1871), L. R. 5 H. L. 205, 227; 40 L. J. Ch. 739.

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, sect. 18, sub-sect. 8. (2) The amendment, in all courts and for all purposes, is deemed to be part of the specification: *ibid.* sub-sect. 9. (3) The amended specification has now a retrospective effect, subject to such conditions as may be imposed on the

In spite of the Acts, the emendation of clerical errors by the Master of the Rolls continued; and how far the power was affected by Lord Brougham's Act is discussed by Lord Langdale, M. R., in *Re Sharp's Patent* (*e*).

The whole procedure is now governed by the Patent Acts, 1883 to 1888.

Amendment of Clerical Errors.

Present jurisdiction of Master of Rolls.

Sect. 18 of the Patents Act, 1883, does not affect the power of the Master of the Rolls to allow amendments verbal or clerical (*f*); nor was that power transferred by the Judicature Act to the High Court of Justice (*g*). 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 any one asking for amendment within that section (*f*).

Correction of errors by the Comptroller.

By sect. 91 (*h*) the comptroller-general is empowered, on request in writing accompanied by the prescribed fee, to correct any clerical error in or in connection with an application for a patent, or any clerical error in the name, style, or address of the registered proprietor of a patent. And Patent Rule 16 (*i*) provides that any document for the amending of which no special provision is made by the Acts may be amended if it can be done without detriment to the interests of any person, and on such terms as the comptroller may think fit.

But for the amendment of the specification special provision is made by sects. 7 and 18.

Amendment under Sect. 7 of the Act of 1883.

Comptroller may require an amendment under sect. 7.

Sect. 7 provides in effect that if the examiner reports against the details of the application or against the general formal sufficiency of the specification, description, drawings, &c., the comptroller, subject to appeal to the law officer, may require

applicant or patentee on his obtaining leave to amend: *ibid.* sub-sects. 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, sect. 39. (5) Every amendment of a specification is advertised.

(*e*) (1840) 1 W. P. C. at p. 646.

(*f*) *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; 46 L. J. Ch. 555. 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. 649; *Re Dixon* (1881), Eng. Rep. Jan. to Mar. 1881, vol. xvi.; Lawson. p. 59.

(*g*) Jud. Act, 1873, sect. 17, sub-sect. 6; *Re Morgan*, 24 W. R. 245.

(*h*) See *post*, p. 647.

(*i*) See *post*, p. 687.

the specifications or drawings to be amended (*k*). But it does not seem clear whether the comptroller can be required to amend at the desire of the applicant. In practice the point would hardly arise. The procedure under sect. 7 is very different from that under sect. 18, and especially in that whatever takes place is done in private, without prior advertisement, and without hearing opposition. It may therefore become of importance to discover whether and at what period the applicant has a right to amend under sect. 7.

No opposition heard under sect. 7.

There are three cases which may throw light on the subject:—

Re Dart's Patent.

Dart's Patent (*l*). Applicants in the title to their complete specification omitted the words "and motors" from the title as it appeared in the provisional specification, and the comptroller-general refused to accept the complete with the restricted title unless leave to amend were applied for and given under sect. 18. Webster, A.-G., said *inter alia*: "Under sect. 7 (1), if the title does not sufficiently indicate the subject-matter of the invention, the comptroller-general may require that the application be amended. . . . It is open to (the applicant) to lodge a complete, omitting the part desired to be left out, and open to the Patent Office, under the powers of sects. 7 and 9, to permit the original application and provisional to be amended by striking out the part which it is no longer desired to retain. This being so, I think the refusal of the Patent Office to accept Messrs. Newton's specification was wrong, and that they should have given the applicants the option either of filing the specification with the original title and inserting a disclaiming clause, or if the applicants were unwilling to adopt that course, should, under the powers of sects. 7 and 9, have amended the original title in the application and in the specification." The Attorney-General added: "In the view 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."

Re Jones's Patent.

In *re Jones's Patent* (*m*), application was made under sect. 18 to amend a complete specification before acceptance and publication. The comptroller-general, in view of the fact that the specification was not open to public inspection, did not require the advertisement of the application. In proceedings taken

(*k*) See Application, *ante*, pp. 122 *et seq.*
(*l*) Griff. 307.
(*m*) *Ibid.* 313.

under sect. 18 this would be improper (*n*), and before the law officer (Webster, A.-G.) the question arose whether sect. 7 was applicable. He 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 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. Under these circumstances, I am of opinion that the fact that the office had not signified its acceptance of the complete specification as lodged is immaterial, and that any proceedings for amendment must be taken pursuant to sect. 18."

Sect. 18 applies after publication, sect. 7 before.

In the course of *C.'s Application* (*o*), Webster, A.-G., pointed out that the comptroller is not fettered by the report of the examiner. Whether the report be unfavourable or not, the comptroller has power to require amendment.

Comptroller is not fettered by the examiner's report.

While from these cases it may be deduced that the comptroller has full power to require proper amendments before acceptance of the complete specification, it is nowhere stated that the applicant can require him to deal with the case under sect. 7, however appropriate the amendment may be in itself. While, on the one hand, *Jones's case* (*p*) tends to show that the comptroller ought to use his powers in a proper case and ought not to drive the applicant to sect. 18, *Dart's case* (*q*) is an authority for saying that when once the complete has been lodged the application to amend must be made under sect. 18. In the last-mentioned case, Webster, A.-G., stated that the application must be under sect. 18 if the specification had become "public property," and his decision can only mean that, when the complete has been lodged, it becomes public property, though not yet accepted by the Patent Office. The law may be summarised as follows:—

Summary of the law under sect. 7.

(1) The comptroller may require amendment under sect. 7, and should do so if the applicant points out a proper amendment which he (the applicant) requires, and which the comptroller approves of (*r*), or if the examiner reports against the specification (*s*), or if the comptroller himself sees that amendment

(*n*) Sect. 18, sub-sect. (2).
(*o*) (1891) 7 R. P. C. 250.
(*p*) See p. 217, *ante*.
(*q*) Griff. 307.
(*r*) *Jones's Patent*, *ibid.* 313.
(*s*) *C.'s Application* (1891), 7 R. P. C. 250.

is desirable (*ss*). (2) This power ceases when the specification has become "public property"; then all application must be made under sect. 18 (*t*).

The cases are reconcilable, and the law clear, if it be borne in mind that amendment under sect. 7 must be, in form at any rate, on the requirement of the comptroller, and if the date when a specification becomes "public property" be the date of acceptance, and not the date when the complete is lodged. This latter supposition, it is submitted, tallies with sect. 10 of the Act, but does not quite fit in with Sir Richard Webster's dictum in *Dart's case* (*t*).

If the comptroller requires an amendment, there is an appeal to the law officer (*u*), and the applicant and the comptroller will be heard on the appeal (*x*), and the law officer will state upon what terms the application will be accepted (*y*). Appeal.

Amendment under Sect. 18.

This section deals with the law and procedure of amendment after publication of the specification, and when no action for infringement nor proceedings for revocation are pending (*z*).

Who may apply.—Sub-sect. 1 provides that a request for amendment may be made by an applicant or a patentee. Therefore a person who has made application for a patent or a person for the time being entitled to a patent (*a*) is entitled to apply for amendment. An applicant is a person who has made application under sect. 5 of the Act of 1883, and whose application has not yet been granted or refused. An assignee, not by way of mortgage (*b*), of the patent can make the application, so can a trustee in bankruptcy or an executor of the patentee. Can a mortgagee of a patent apply alone for amendment? Probably not (*b*). It seems doubtful whether an amendment can be made at the request of a mortgagor alone. If it can there would be nothing to prevent the mortgagor applying to disclaim the most valuable claim. At any rate, the mortgagee should have a right to be heard. The position of co-owners is not dissimilar in this Mortgagee. Mortgagor. Co-owners.

(*ss*) *C's Application* (1891), 7 R. P. C. 250.
(*t*) *Dart's case*, Griff. 307.
(*u*) 1883, sect. 7 (2).
(*x*) *Ibid.* (3).
(*y*) *Ibid.*
(*z*) Sect. 18 (10).
(*a*) Sect. 46.
(*b*) *Van Gelder, Apsimon & Co. v. Sowerby Bridge Flour Co.* (1890), 7 R. P. C. 208; 44 Ch. Div. 374; 59 L. J. Ch. 583.

regard. Each co-owner is for the time being "entitled to the benefit of a patent"; so also in a sense are both mortgagor and mortgagee. It is noteworthy in this connection that the Privy Council declared that the non-joinder of a mortgagee was an irregularity in proceedings for prolongation (*c*), though the section of the Act which authorises a petition for prolongation provides that a "patentee" may present the petition (*d*). The proceedings, however, were not stopped: the petitioners agreed to a course which would safeguard the rights of the mortgagees. There are difficulties in either view, but it is submitted that the mortgagor should not apply without the mortgagee, nor the mortgagee without the mortgagor; also, it is submitted, co-owners must all join. But the comptroller could not be expected to take notice of the absence of interested parties, unless their names were on the register (*e*).

Semble, mortgagor and mortgagee should join.

Procedure.—The application can be made at any time, but second disclaimers are not encouraged (*f*). The applicant must leave a request at the Patent Office. It 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 (*g*).

Request for leave to amend.

Advertisement of application.

The request is advertised, together with the reasons of the amendment, in the Official Journal and in such other papers as to the comptroller may seem fit. The reasons given (*h*) are

(*c*) (1887) Church's Patent, 3 R. P. C. 95.

(*d*) Sect. 25.

(*e*) Sect. 23. Formerly an assignee could disclaim even after he had parted with his patent rights: *Spilsbury* v. *Clough* (1842), 2 Q. B. 466; 1 W. P. C. 255; 11 L. J. Q. B. 109.

(*f*) *Re Haddan* (1885), Griff. A. P. C. 13; two applications for the same amendment will also be discouraged; *Re Arnold* (1887), *ibid.* 5.

(*g*) P. R. 1890, r. 52.

(*h*) 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 6) 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 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.'

advertised, but do not form any part of the amendment itself (*i*). Davey, S.-G., said that the reasons are part of the request, and as such should be advertised, but that he would be very sorry to disallow an amendment merely because the reasons were insufficient (*k*). When the comptroller-general considered that, the specification not having been published, advertisements were unnecessary, objection was taken before the law officer, and with success, to any amendment (*l*). The precise form of amendment must be stated in the request (*m*).

The application to amend must be signed by the applicant or patentee, but subsequent proceedings may be carried on by an agent (*n*). See *post*, forms, p. 810.

Opposition to amendment.—Notice of opposition to a proposed amendment may be given at any time within one month from the first advertisement above referred to (*p*). Opposition to amendments.

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 (*q*), state his address for service, Grounds of opposition.

"The proposed amendments are as follows:—

On p. [illegible]

[illegible] To strike out [illegible]

[illegible]ine 38. To insert [illegible]" &c.

(2) "No. ——, 26th [illegible] 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 [illegible] original mode of [illegible]tion described [illegible] that the aforesaid [illegible] might be considered as [illegible]ription of such parts.'" &c.

(Amendments set out as before.)

[illegible] 6th August, 1884. Improved [illegible] machines for producing stereotype [illegible]rices, 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 do not 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.)

(*i*) *Cunnington* v. *Nuttall* (1871), L. R. 5 H. L. 205, 227; 40 L. J. Ch. 739.

(*k*) *Ashworth's Patent*, Griff. A. P. Cases, 7.

(*l*) *Jones's Patent*, Griff. 313.

(*m*) 1883, sect. 18 (2), and see *Andrew* v. *Crossley* (1892), 1 Ch. 492, 501; 61 L. J. Ch. 437; 9 R. P. C. 165, 171; and see per Field, J., in *Van Gelder's Patent* (1889), 6 R. P. C. 23. On the other hand, see *Fabenfabriken, &c.* v. *Bowker* (1891), 8 R. P. C. 389.

(*n*) Patent Rule 52.

(*o*) Patent Rule 8.

(*p*) 1883, s. 18 (2). The time cannot be extended, as Rule 51 does not apply.

(*q*) Rule 53. In one case the signature was not on the document when filed, but

and be accompanied by an unstamped copy (*r*). The fee is 10*s*.

Statutory declarations.

This copy is forwarded by the comptroller to the applicant (*s*). Within fourteen days after the expiration of one month from the first advertisement of the proposed amendment the opponent may leave statutory declarations in support of his opposition at the Patent Office, and on so doing shall deliver to the applicant a list of such statutory declarations (*t*). The applicant has fourteen days thereafter to lodge at the Patent Office statutory declarations in answer, and to deliver to the opponent a list, and within fourteen days from such delivery the opponent may lodge statutory declarations in reply, which must be confined to matters strictly in reply; and deliver a list to the applicant (*u*). 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 (*x*). Ten days' notice, at least, of the date of hearing is given by the comptroller to the parties (*y*), and the comptroller then hears the parties, their counsel, solicitors, or agents, and decides upon the case subject to an appeal to the law officer (*z*), whose decision is final. By sect. 94 the comptroller is prevented from deciding against an applicant without giving him an opportunity of being heard.

Who may oppose.

In sub-sect. 2 it is provided that *any* person may give notice of opposition. Sub-sect. 4 deals with appeals to the law officer, and provides that he shall hear a person entitled to be heard in opposition to the request for amendment. It would seem, from a comparison of these two sub-sections, that any person may oppose before the comptroller, but before the law officer only such person as is in the law officer's opinion entitled to be heard in opposition. In the case of *Re Bell* (*a*), the comptroller went into the question of the opponents' interest, although it was not directly raised in the issues. In the same case, Clarke, S.-G., decided that the opponents had no right to be heard before him, but their right to be heard before the comptroller was not dealt by him. It is probable that if the point arises it will be decided that the right to oppose before the comptroller is unlimited.

was added afterwards. The comptroller overruled an objection founded on this: *Re Codd*, Griff. P. C. 305.

(*r*) P. R. 1890, r. 53; Form G,, *post*, p. 810.

(*s*) P. R. 1890, r. 54.

(*t*) *Ibid.* r. 55.

(*u*) Rule 38.

(*x*) Rule 39.

(*y*) *Ibid.* r. 41.

(*z*) 1883, sect. 18 (3).

(*a*) (1887) Griff. A. P. C. 11.

Re Bell is no decision to the contrary: it merely decides that on the facts of that case the ground of opposition was not open to the opponents (*aa*).

Grounds of opposition.

The grounds of opposition are not defined; they are practically unlimited.

Where no opposition.

Where no notice of opposition is given, or the person so giving notice does not appear, the comptroller must determine whether, and subject to what conditions, if any, the amendment ought to be allowed; and the applicant may appeal from the comptroller to the law officer (*b*).

Amendment and opposition contemporaneous.

In *Re Cochrane* (*c*), 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 matters 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.

Advertisement of amendment.

The amendment when allowed must be advertised by the comptroller forthwith in the Official Journal of the Patent Office, and elsewhere as to the comptroller seems fit (*d*).

Actual amendment to be made by the officials of the Patent Office.

It is the duty of the officials of the Patent Office to make the amendment when it has been allowed, and the applicant need not any longer trouble about the matter, the clerical part of the procedure not being his business at all (*e*). But the comptroller may require the applicant to leave at the Patent Office a new specification as amended (*f*), or may impose other conditions (*g*) before giving leave to amend. The Patent Office ought not to issue unamended copies of the specification after an amendment has been allowed (*h*).

The printed copies of the amended specification will be headed with a notice that the amendment has been made.

Amendment allowed by way of disclaimer, correction, or explanation.

What Amendments are Allowed.—Under the old practice, amendment by way of disclaimer alone was allowed; the present Act extends the powers to "amendment by way of disclaimer,

(*aa*) See the decisions on sect. 11 of the Act of 1883, viz. *Re Glossop's Patent*, Griff. 295; *Heath and Frost's Patent*, Griff. 288; *Stewart's Application*, 13 R. P. C. 627.

(*b*) 1883, sect. 18 (5) and (6).

(*c*) (1885) Griff. 304.

(*d*) 1883, sect. 21; P. R., r. 59.

(*e*) Per Lindley, L. J., in *Andrew* v. *Crossley* (1892), 1 Ch. 492, 502; 9 R. P. C. 165; 61 L. J. Ch. 437.

(*f*) P. R., r. 57.

(*g*) *Infra*, p. 228.

(*h*) Kay, L. J., in *Andrew* v. *Crossley* (1892), 1 Ch. 492, 505; 61 L. J. Ch. 437.

correction, or explanation" (*i*). But any amendment which makes the specification as amended claim an invention substantially larger than, or substantially different from, the invention claimed originally, must be disallowed (*k*).

Amendment must not enlarge the claim.

In one respect, many an amendment may be said to extend the monopoly—*e.g.*, when one claim is bad, the disclaimer of it may convert a bad patent into a good one. Before amendment there is no monopoly; after amendment there is. But there is no objection to an amendment because of such an extension as this; the section deals only with enlargement of the "invention" protected, not of the protection given (*l*).

The applicant will not be allowed to amend his specification by disclaiming the main part of the original invention, or so altering it as merely to claim an obvious alternative resting on the part which he proposes to omit (*m*).

Again, the insertion of a single word, which introduces, however, an entirely new feature into the original specification, will not be permitted (*n*); and when there is a distinct and specific claim to a whole, without any claim being made to a minor arrangement of the parts, a patentee cannot strike out the claim to the whole and insert an independent claim to a subordinate part (*o*).

Any amendment or disclaimer will in general be allowed which merely removes an ambiguity rather than a defect in the original claim (*p*), or restricts the original claim, or alters part of the description without affecting the claim.

Re Cochrane.

In *Re Cochrane* (*q*), 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."

(*i*) Sect. 18 (1).

(*k*) Sub-sect. 8. And see *Re Johnson's Patent* (1896), 13 R. P. C. 659.

(*l*) The remarks of Lord Chelmsford in *Ralston* v. *Smith* (1865), 11 H. L. C. 223, 35 L. J. C. P. 49, are interesting. But the Act then in force had not the same provisions as the Act of 1883.

(*m*) *Re Heath and Frost* (1886), Griff. 312. And see *Ralston* v. *Smith*, *sup.*

(*n*) *Re Walker* (1886), Griff. A. P. C. 22.

(*o*) *Re Serrell* (1889), 6 R. P. C. 101; *Nairn's Patent* (1891), 8 R. P. C. 444.

(*p*) *Moser* v. *Marsden* (1893), 10 R. P. C. 350; 13 R. P. C. 24.

(*q*) (1885) Griff. P. C. 304, 305; *Re Ashworth* (1886), Griff. A. P. C. 6; *Re Rylands* (1888), 5 R. P. C. 665.

In *Re Nordenfelt* (*r*), 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 Nordenfelt.*

In *Re Lake* (*s*) 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 Lake.*

In *Re Morgan* (*t*) 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 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 he did not allow the addition of the words italicised above. *Re Morgan.*

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. *Kelly* v. *Heathman* (*u*) may be considered almost an extreme case. There the specification claimed—(1) the two ladders occupy the space of only one; (2) the ready means of working by the cord; (3) the simple bracket lever by which the ladder was secured at any required length. The patentee amended by leave, striking out (1), (2), and (3), and substituting the following: "The combination in a telescope ladder, as herein described, of means for raising, lowering, and stopping, all as herein described and shown in the accompanying drawings." North, J., held that the

(*r*) (1887) Griff. A. P. C. 18.
(*s*) (1887) Griff. A. P. C. 16.
(*t*) (1886) Griff. A. P. C. 17.

(*u*) (1890) 45 Ch. Div. 256; 7 R. P. C. 343; 60 L. J. Ch. 22. See also *Allen's Patent*, Griff. A. P. C. 3.

amendment was by way of correction or explanation, and that the original claims were really for a combination, a construction which by the amendment was made clear. This case did not go to the Court of Appeal.

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 (*x*).

Re Nordenfelt (*x*) 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."

That a patentee desires that the principle upon which his invention is based should be better understood, is not a sufficient reason for amendment. It is the duty of the patentee to fulfil the condition of his patent, and to file a proper specification in the first instance (*x*).

Must not give subsequently ascertained knowledge.

It is no reason for allowing an amendment that, subsequently to the date of the original specification, increased knowledge has rendered a change desirable. Thus in *Re Beck and Justice's Patent* (*y*), 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 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.

But an explanation will be allowed which is necessary to

(*x*) (1887) Griff. A. P. C. 18.

(*y*) (1886) Griff. A. P. C. 10.

remove an ambiguity which prevents the real meaning of a patentee from being understood (*z*). So, if a specification is on the face of it clearly capable 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 of them (*a*). In *Bateman's Patent* (*b*), 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.

A statement in an amendment imputing faults to all methods formerly used or patented, will not be allowed (*c*).

In case of doubt it has hitherto been considered the duty of the law officer to lean in favour of an amendment; as there is no appeal, an adverse decision might deprive a patentee of valuable rights, whereas the patentee takes the amendment (if allowed) at his peril (*d*). But, in view of the case of *Moser* v. *Marsden* (*e*), a change may be expected. That case shows that in any action subsequent to the amendment the propriety and validity of the amendment cannot be questioned, and the law officers have already shown a disposition to criticise more closely the scope of the amendment proposed, so that the patent may not thereby be widened (*f*).

The age of the patent is material.

In considering whether an amendment should be allowed, the age of the patent is a fact which may well be considered; but in the case of *Lacy's Patent* (*g*), Clarke, S.-G., stated that the same principle should govern the decision, whatever the age of the patent. So far as principles are to be applied, this is doubtless so, but where the matter is entirely discretionary, the time which has elapsed since the patent was granted is a material circumstance for the law officer's decision.

Grounds of application to amend.

The most usual grounds on which application is made under sect. 18 for the amendment of specifications are, that it is desired to correct sundry errors, clerical and otherwise, which interfere

(*z*) *Re Ashworth* (1886), Griff. A. P. C. 6.

(*a*) *Re Ryland* (1888), 5 R. P. C. at p. 668.

(*b*) (1854) Mac. P. C. 116.

(*c*) *Re Hampton and Facer* (1887), Griff. A. P. C. at pp. 14, 15. But cf. *Re Guest and Barrow* (1888), 5 R. P. C. 313.

(*d*) *Re Lake* (1887), Griff. A. P. C. 16; cf. *Re Bateman, supra.*

(*e*) (1896) 13 R. P. C. 24, and see *post*, pp. 231, 232.

(*f*) *Re Parkinson* (1896), 13 R. P. C. 509; *Re Dellwick* (1896), 2 Ch. 705; 13 R. P. C. 591. And see an article in the Law Journal, 7th November, 1896.

(*g*) (1890) 7 R. P. C. 469.

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.

An amendment will not be disallowed merely because the reasons given for it are insufficient (*h*); the reasons are no part of the disclaimer itself (*i*).

Conditions imposed.

Conditions.—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 (*k*), and he has the same power in this respect as the law officer on appeal (*l*). The comptroller has, however, no power to make the payment of costs, as costs, a condition of allowing an amendment, though he may, perhaps, award pecuniary compensation in a fit case (*m*).

Conditions of amendment before 1883.

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 (*n*),—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 (*o*). Such a condition protects the continued user of articles made by the opponents prior to 1st January, 1884, and also the sale of articles in stock and unsold prior to 1st January, 1884 (*p*). But if the opponents 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 (*q*).

Modern practice.

The 20th sect. of the present Act provides that "where an amendment by way of disclaimer, correction, or explanation has

(*h*) *Re Ashworth* (1886), Griff. A. P. C. 6.

(*i*) *Cannington* v. *Nuttall* (1871), L. R. 5 H. L. 205, 227, 228; 40 L. J. Ch. 739; R. P. C. 213.

(*k*) *Hearson's Patent* (1884), Griff. 309; 1 R. P. C. 213; whether an opponent appears or not, *Andrew* v. *Crossley* (1892), 1 Ch. 492, 497; 9 R. P. C. 265; 61 L. J. Ch. 437; see also *Ainsworth's Patent* (1896), 13 R. P. C. 76, 78.

(*l*) *Re Pietschmann* (1884), Griff. 314.

(*m*) *Re Pietschmann* (1884), Griff. 314, impliedly overruling *Re Codd* (1884), Griff. 305.

(*n*) *Re Haddan* (1885), Griff. A. P. C. 13.

(*o*) *Re Hearson* (1884), 1 R. P. C. 313; *Re Cheesbrough* (1884), Griff. 303; *Re Westinghouse* (1885), Griff. 315; *Re Ashworth* (1888), Griff. A. P. C. 6.

(*p*) *Re Cheesborough, supra.*

(*q*) *Ibid.*; *Re Smith* (1855), Mac. P. C. 232, 234; cf. *Re Harrison* (1883), Mac. P. C. 31.

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" (*r*).

It is, therefore, the practice the case of patents issued since the passing of the Act of 1883 not to impose conditions as to bringing actions for infringement prior to the date of the amendment; in the absence of very special circumstances, the matter is left to sect. 20 (*s*).

It should be observed, however, that sect. 20 does not prevent an action for an injunction, when the amendment is made prior to action brought. But an injunction would not be granted unless there was reason to fear future infringements.

Condition not to sue.

Under the old practice the condition restricting the right to bring an action was not necessarily bounded by the year 1884. Davey, S.-G., in *Re Ashworth* (*t*), said: "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, I should impose the condition that no action should be brought for anything done at any time before the amendment (*u*).

It seems to be the practice when a condition not to sue is imposed to require written undertaking from the applicant to observe the terms of the condition, but such undertaking is not entered on the register. Further, if the condition is not accepted, the applicant must inform the comptroller, and the amendment will then not be made (*x*).

Appeals to the Law Officer.—Whether there be an opponent or

(*r*) See *Wenham* v. *Carpenter* (1888), 5 R. P. C. 68.

(*s*) *Re Allen* (1887), Griff. A. P. C. 3; *Re Ainsworth* (1895), 13 R. P. C. 78.

(*t*) (1886) Griff. P. C. at p. 9.

(*u*) The means of identification of protected articles under this condition must vary with the circumstances of each case; see *Re Haddan* (1885), Griff. A. P. C. 12; *Re Edison*, Lawson, 64.

(*x*) *Andrew* v. *Crossley* (1892), 1 Ch. 492; 9 R. P. C. 165; 61 L. J. Ch. 437.

not, there is a right of appeal to the law officer from the comptroller (*y*). The law officer will then hear the parties, and if the appeal be from a refusal to allow the amendment, the comptroller will also be heard (*z*). But the law officer will hear an opponent only if in his opinion the opponent is a person "entitled to be heard in opposition" (*a*).

Procedure.

The procedure is governed by the Law Officer's Rules (*b*). The notice of intention to appeal must be filed at the Patent Office within fourteen days from the date of the decision appealed against, and the notice must contain a statement of what part of the decision is appealed against. Applicants or opponents are entitled to notice from the opposite appealing party (*c*). The comptroller, or the law officer, may extend the time for the appeal (*d*).

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 (*e*).

There is power to examine on oath (*f*).

There is no appeal from the law officer.

The following cases relate to this part of the subject:—

In *Re Cheesbrough* (*g*), 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., affirmed the action of the comptroller, as the retention of these words had been objected to by the opponents themselves.

In *Re Arnold* (*h*), 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

(*y*) Act of 1883, sect. 18, sub-sect. 6.

(*z*) *Ibid.* sub-sect. (4), (7). The comptroller often appears by one of the examiners.

(*a*) See *ante*, p. 222, as to persons entitled to be heard before the law officer.

(*b*) *Post*, p. 713.

(*c*) *Re Ryland* (1888), 5 R. P. C. 665; *Re Hill*, *ibid.* 599.

(*d*) L. O. R. 5.

(*e*) L. O. R. r. 8; *Re Hampton and Facer* (1887), Griff. A. P. C. 13.

(*f*) Act of 1883, sect. 38.

(*g*) (1884) Griff. 303.

(*h*) (1887) Griff. A. P. C. 5.

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.

Costs.—The comptroller-general has no power to give costs, either directly or indirectly (*i*). The law officer may make such order as to costs as he thinks right (*k*). As a rule the unsuccessful party will bear the costs (*l*). But in *Re Ashworth* (*m*), where the specification was loosely framed, Davey, S.-G., although allowing an amendment, refused to give any costs of the appeal.

In *Re Morgan* (*n*), 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."

Amendment once made to be conclusive, as to power to make.

Effect of an Improper Amendment.—The 9th sub-sect. of sect. 18, provides that "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 shall, in all Courts and for all purposes, be deemed to form part of the specification."

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 this was so appears from the language used by Lord Blackburn in the case of *Dudgeon* v. *Thomson* (*o*), and also from the language of the then Attorney-General, Sir Richard Bethell, in *Bateman's*

(*i*) *Ex Pietschmann* (1884), Griff. 314.
(*k*) 1883, sect. 38.
(*l*) *Haddan's Patent* (1886), Griff. A. P. C. 12.
(*m*) (1886) Griff A. P. C. 6; also in *Re Haddan*, Griff. A. P. C. 12, costs were refused, because the disclaimer allowed by the appeal was a second disclaimer.
(*n*) (1886) Griff. A. P. C. 17.
(*o*) (1874) 3 App. Ca. 34, 55.

Patent (*p*). And sub-sect. 8 of sect. 18 of the Act of 1883, specifically prescribes that *no amendment shall be allowed* if the result would be to make the specification as amended claim an invention that would be substantially larger than or different from that claimed by the original specification.

The difficulty caused by sub-sects. 8 and 9 (which are apparently, if not really, contradictory), was considered in *Re Van Gelder's Patent* (*q*). It was there decided that no prohibition will issue against the law officer on the ground that he has allowed an amendment improperly. The facts were these: 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 prohibit 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, the Court 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.

The Court in the same case expressed the opinion that the true meaning of sub-sect. 9 is that leave to amend is conclusive, if the amendment be consonant to sub-sect. 8, and not otherwise (*r*). But in a subsequent case in the House of Lords, *Moser* v. *Marsden* (*s*), it was objected by the defendant in an action for infringement, that the amendment enlarged the claim; the House decided that this objection was not open to the defendant,

(*p*) (1854) Mac. P. C. 116.
(*q*) (1889) 6 R. P. C. 22.
(*r*) See the decision of Romer, J., in *Fabenfabriken, &c.* v. *Bowker* (1891), 8 R. P. C. 389, which is not quite in accordance with the above.
(*s*) (1896) 13 R. P. C. 24. See also *Re Dellwick's Patent* (1896), 2 Ch. 705; 13 R. P. C. 591.

and that the amendment once made was conclusive as to the right to make the amendment. It was also said that the amended specification must be treated as though it were the original specification.

This decision is in accordance with the *ratio decidendi* of *Lane-Fox* v. *Kensington and Knightsbridge Electric Lighting Co.* (*t*) and *Goulard and Gibbs' Patent* (*u*) in the Court of Appeal and in the House of Lords (*x*). See also *Moser* v. *Marsden* in the Court of Appeal (*y*).

Amendment Pending Action.

Act of 1888.

Sub-sect. 10 of the 18th sect. of the Patents' Act, 1883, provided that the preceding sub-sections do not apply when and so long as any action for infringement or *other legal proceeding in relation to* a patent is pending. Doubts as to what was included in the words italicised arose (*z*); hence the 5th sect. of the Act of 1888 repealed the sub-section, but re-enacted it with the substitution for the italicised words of this expression, "a proceeding for revocation of."

Act of 1888 includes proceedings for revocation.

Disclaimer pending action.

Sect. 19 of the Act of 1883 provides that when any action for the infringement or proceeding for the revocation of a patent is pending (*a*), 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.

Procedure to be the same as under sect. 18.

The exact effect on each other of these sections is not very clear. Taken literally, it would appear that leave may be granted by the Court to apply to the Patent Office for amendment, but that the procedure sketched out in sect. 18 will not in such cases apply. This was not intended, nor, it appears, is that the meaning to be attached to the section. In *Re Hall* (*b*) Care, J., said: "Nothing is said in the Act as to the course of the proceedings upon the application to the comptroller-general for an amendment; but it is clear, notwithstanding the awkward

(*t*) (1892) 9 R. P. C. 413; 3 Ch. 424. See judgment of Lindley, L. J., on the disconformity question.

(*u*) (1889) 6 R. P. C. 215; 7 R. P. C. 367.

(*x*) (1890) 7 R. P. C. 367.

(*y*) (1893) 10 R. P. C. 350, 359; in the House of Lords (1896), 13 R. P. C. 24; see *ante*, p. 232.

(*z*) See *Re Hall* (1888), 21 Q. B. D. 137; 5 R. P. C. 307; 57 L. J. Q. B. 494.

(*a*) Act of 1883, sect. 18, sub-sect. 10; Act of 1888, sect. 5.

(*b*) (1888) 21 Q. B. D. 137; 5 R. P. C. 306; 57 L. J. Q. B. 494.

language of sub-sect. 10 of sect. 18, that the procedure under sect. 18 is meant to apply to cases where leave to make the application is given by the Judge under sect. 19 "(*c*).

Pending action the right to amend is limited to disclaimer.

The first step to take if it is desired to disclaim pending action (and it will be observed that amendment otherwise than by way of disclaimer is not permissible) is to get the leave of the Court or a Judge. The application may be made by summons at Chambers (*d*). The Court means "Her Majesty's High Court of Justice in England" (*e*); but the Palatine Court of Lancaster can entertain the application made in the course of actions heard therein (*f*); the House of Lords probably cannot (*g*).

Steps to be taken.

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 (*h*).

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 (*i*).

Advertisement of amendment.

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 (*k*).

The following points relative to amendment pending an action for infringement or proceedings for revocation are noteworthy:—

1. Leave is not required after judgment, nor can it be given (*l*).

Where several pending actions.

2. Where two actions for infringement, and a proceeding for revocation, are going on at the same time, the comptroller cannot refuse leave to amend merely on the ground that liberty to apply has been obtained in one of them only: *Re Hall* (*m*) overruling impliedly *Re Codd* (*n*). 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

(*c*) And see *Lang's Patent* (1890), 7 R. P. C. 469.

(*d*) *Singer* v. *Stassen* (1884), W. N. 83; 1 R. P. C. 121.

(*e*) Act of 1883, sect. 117 (1). See *post*, p. 663.

(*f*) See Chancery of Lancaster Act, 1890, also *Winter* v. *Baybut* (1884), 1 R. P. C. 76.

(*g*) *Cropper* v. *Smith*, No. 2 (1884), 28 Ch. Div. at p. 152; 54 L. J. Ch. 287; 1 R. P. C. 254.

(*h*) P. R. 1890, r. 58.

(*i*) P. R. 1890, r. 57.

(*k*) P. R. 1890, r. 59.

(*l*) *Cropper* v. *Smith* (*supra*).

(*m*) (1888) 21 Q. B. D. 137; 57 L. J. Q. B. 494; 5 R. P. C. 307.

(*n*) (1884) Griff. P. C. 305.

application for amendment having been refused not on its own merits, but upon a technical point.

Where action discontinued.

3. If the action in which the order is made be discontinued, there is no longer any need to obtain leave, and any order already made lapses. Hence, if leave be granted to apply to make certain amendments and the action be then discontinued, application may be made to make amendments other than those specified in the order (*o*).

Amendment pending an appeal.

4. Pending an appeal, application to amend may be made without leave (*p*).

5. In *Andrew* v. *Crossley* (*q*) the facts were as follows: On 19th May C. applied to the comptroller for leave to amend, and on 9th June leave was granted, but upon a certain condition. To this condition C. assented during the argument. On 11th June C. commenced an action for infringement; on 30th June the Patent Office asked C. for a written undertaking to the effect already agreed; on 9th July C. signed and sent it in; on 26th August the actual amendment was made. The Court of Appeal (affirming Chitty, J.) held that as the condition was accepted during the argument, the amendment was complete so far as C. was concerned on the 9th June, before action brought, and therefore was good, though the leave of the Court had not been obtained.

Date of amendment.

Going behind the amendment.

In the case of *Farbenfabriken, &c., Co.* v. *Bowker* (*r*), an action on an amended specification, the amendment was objected to on the ground that, an action having been commenced, the amendment was vitiated for want of leave of the Court. Romer, J., said that the point was not taken in the particulars, and he was not satisfied that the action was in fact pending at the time of the amendment; but if so, the amendment having been made, he did not think that he ought to go behind the comptroller's amendment (*s*).

The Court will generally impose conditions, and liberty to apply to amend will not be given to one party unless the Court sees that no injustice is done to the other (*t*).

(*o*) *Bell's Application*, Griff. A. P. C. 10.

(*p*) *Cropper* v. *Smith*, 28 Ch. Div. 148; 1 R. P. C. 254. But where the appeal is from an order revoking the patent there will be nothing to amend, unless the order be so framed that pending appeal the patent shall continue. See in this respect *Deeley* v. *Perkes* (1896), App. Ca. 496; 13 R. P. C. 581.

(*q*) (1892) 1 Ch. 492; 61 L. J. Ch. 437; 9 R. P. C. 165.

(*r*) (1891) 8 R. P. C. 389.

(*s*) And see *ante*, p. 216.

(*t*) *Goulard* v. *Lindsay* (1888), 38 Ch. Div. at p. 41; 57 L. J. Ch. 687; 5

Conditions.

No hard and fast rule has been laid down as to the conditions which will be imposed; these are in the discretion of the Court (*u*). And whenever the Court or a Judge exercises discretion upon the particular facts, the Court of Appeal will not interfere unless he was absolutely wrong (*x*).

Amongst the more usual conditions are the following:—

Use of amended specification.

1. A condition that the amended specification shall not be given in evidence at the trial. This is usually imposed in the absence of special circumstances. It was done in *Singer* v. *Stassen* (*y*), *Allen* v. *Doulton* (*z*), *Bray* v. *Gardner* (*a*).

Condition as to costs.

2. Conditions as to costs. The ordinary rule is to make it a condition of leave being granted that (a) the costs of and occasioned by the application for leave to disclaim (*b*); and (b) the costs also of the action up to the time of leave being obtained (*c*), should be paid in any event by the applicant. In *Goulard* v. *Gibbs* (*d*), pending petition for revocation, the patentee applied for leave to disclaim, and leave was given on condition that all costs of the petition, up to and including the petition for revocation, should be paid by the patentee.

Condition as to prior infringements.

3. Conditions as to damages and prior infringements. In *Codd* v. *Bratby* (*e*), liberty to amend an old patent was granted on condition that the amended specification should not be put in evidence at the trial, and that no evidence of any infringement prior to the amendment should be given at the trial. In *Goulard* v. *Lindsay* (*f*), the Court of Appeal imposed the condition that no relief should be given in respect of any infringement before the disclaimer. In *Lang* v. *Whitecross Co.* (*g*) patentees of 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

R. P. C. 192; *Bray* v. *Gardiner* (1887) 34 Ch. Div. 668; 56 L. J. Ch. 497; 4 R. P. C. 40.

(*u*) *Lang* v. *Whitecross Co.*, in the House of Lords, 7 R. P. C. 389.

(*x*) *Allen* v. *Doulton* (1887), 4 R. P. C. 377; *Bray* v. *Gardiner* (*supra*).

(*y*) (1884) 1 R. P. C. 121. This case shows that the 19th sect. is retrospective.

(*z*) (1887) 4 R. P. C. 377.

(*a*) *Ibid.* p. 40, n.; 34 Ch. Div. 668.

(*b*) *Winter* v. *Baybut*, 1884, 1 R. P. C. 76; *Singer* v. *Stassen*, 1884, *ibid.* 121; *Codd* v. *Bratby*, 1884, *ibid.* 211.

(*c*) *Lang* v. *Whitecross Co.* (1890), 7 R. P. C. 389; *Fusee Vesta Co.* v. *Bryant and May* (1887–88), 34 Ch. D. 458; 57 Ch. D. 120; 56 L. J. Ch. 187; 4 R. P. C. 73; *Haslam, &c., Co.* v. *Goodfellow*, (1888), 37 Ch. D. 118, 123; 57 L. J. Ch. 245; 5 R. P. C. 28. 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.

(*d*) (1888) 5 R. P. C. 189.

(*e*) (1884) 1 R. P. C. 209.

(*f*) (1888) 38 Ch. Div. 38; 57 L. J. Ch. 687; 5 R. P. C. 192.

(*g*) (1890) 7 R. P. C. 389.

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 (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 the 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.

By sect. 20, in any event where any amendment has been allowed (whether pending action or not), no damages will 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. It will be noticed that the protection given by this section is not confined to a defendant in the action in the course of which leave to amend is given. But an injunction might be obtained in a proper case, save that in the course of an action the conditions of amendment would probably be a bar to an injunction against the defendant in the same action.

Injunctions on infringements prior to amendment.

Where the conditions render relief in the action impossible.

If in the result the conditions on which leave to amend should be given are such that a pending action would virtually be rendered useless, leave may properly be refused. In *Meyer* v. *Sherwood* (*h*), the plaintiff at close of defendant's case asked for a postponement of the case and for leave to apply at the Patent Office for disclaimer. The application was granted; but after disclaimer, when the plaintiff applied for leave to amend his pleadings, Smith, J., decided that, as he could give leave only on terms of payment of costs up to the time of application and on an agreement to abandon all damages to date, it would be better to dismiss the action. The defendant having given an

(*h*) (1890) 7 R. P. C. 283. As to the right to an injunction, see *post*, p. 432; as regards an injunction already obtained under the old law, see *Dudgeon* v. *Thompson* (1878), 3 App. Ca. 34.

undertaking not to infringe, the Court of Appeal affirmed the decision. Had the undertaking not been given, the order would have been affirmed subject to the addition of the words "reserving to the plaintiffs liberty to bring a fresh action for an injunction, if so advised"(*i*).

Usual conditions summarised.

The general result of the ordinarily imposed conditions may be thus summarised: the patentee must pay the costs up to date of disclaimer, and is debarred from obtaining damages against any person for infringement prior to the disclaimer, unless the Court is satisfied that the specification was originally drawn in good faith and with reasonable skill and knowledge. Against the defendant in the action no damages can be obtained. Injunctions may be obtained against parties other than the defendant in the action, but against him an injunction can generally be obtained only in a fresh action.

(*i*) See also *Haslam* v. *Goodfellow* (1888), 5 R. P. C. 28; 37 Ch. Div. 118.

CHAPTER VIII.

OPPOSITION TO GRANT (*a*).

Opposition may be 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—44 (*c*); and in case of an appeal to the law officer by the Law Officers' Rules (*d*).

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 (*e*). The specifications and drawings being left in duplicate, one set goes to the printer's, and the other set is open to inspection. So soon as the specifications are printed, and the drawings reproduced, they can be purchased (*f*).

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 (*g*) from the date of the advertisement of the acceptance of a complete specification, notice of opposition to the grant of the patent may be given at the Patent Office. The notice must set out the grounds of opposition (*h*).

(*a*) Opposition to the extension of letters patent is fully dealt with at pp. 508 *et seq.*

(*b*) Chap. VII., pp. 222 *et seq.*

(*c*) Pp. 696 *et seq.*

(*d*) Pp. 713 *et seq.*

(*e*) Act of 1883, sect. 10.

(*f*) At the Patent Office (Sale Branch).

(*g*) 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 the date of hearing the opposition.

(*h*) Act of 1883, sect. 11, sub-sect. 1. See also Form D, p. 809.

Grounds of opposition.

The *only* grounds of opposition (*i*) are those given in sect. 11 of Act of 1883, as amended by Act of 1888, sect. 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 (*j*) 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 (*k*).

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 (*l*).

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

(*i*) But see *re Stewart's Application* (1896), 13 R. P. C. 627.

(*j*) Act of 1888, sect. 4, sub-sect. 1.

(*k*) This provision gave rise to, and was probably altered in consequence of, cases of hardship, such as the following:—

Green's Patent (1885, Griffin, P. C. 286).—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 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."

(*l*) P. R. 1890, r. 34.

granted in such prior application are required to be specified in the notice (*m*).

Insufficiency not a fatal defect.

Insufficiency in the notice of opposition is not, however, generally a fatal defect. The Patents Rules provide (*n*) 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.

Amendment by comptroller of documents.

A few cases will serve to illustrate the circumstances under which this power has been exercised.

Cases.

In *Re Airey* (*o*) 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.

In *Re Lake* (*p*) 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 with a prior patent. 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* (*q*) an application for a patent was opposed on the ground "that the invention, *or material parts thereof*, had been

(*m*) *Ibid.* r. 36.
(*n*) *Ibid.* r. 16.
(*o*) (1888) 5 R. P. C. 348; cp. *In re Daniel* (1888), 5 R. P. C. 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 sect. 7, subsect. 6, of the Act of 1883, and rules 11, 12, 13, and 15 of the Patents Rules, 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, 10.
(*p*) (1886) Griff. A. P. C. 35.
(*q*) (1889) Goodeve, 10, 11; cp. *Re Jones* (1885), Griff. 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 see *Re Cumming* (1884), Griff. P. C. 277.

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* (*r*) 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 reopen the case, but suggested that if the opponent appealed the law officer might, under the circumstances, send the case back to him for rehearing. On appeal Webster, A.-G., gave a direction to this effect.

Opposition proceedings before comptroller.

On receipt of the notice of opposition, a copy of the same is transmitted by the comptroller to the applicant (*s*). 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 in support of his opposition, and on so leaving shall deliver to the applicant a list thereof (*t*).

Delivery of declarations in support of opposition;

in support of application;

in reply.

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 (*u*). If the opponent fails 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 (*x*).

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

(*r*) (1885) Griff. A. P. C. 43.

(*s*) P. R. 1890, r. 35.

(*t*) *Ibid.* r. 37. As to the form of such statutory declarations, see r. 17A.

(*u*) *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.

(*x*) See Goodeve, 20.

on the existence of a prior patented invention of which the opponent is patentee, statutory declarations are sometimes dispensed with (*y*).

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 (*z*).

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* (*a*)—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.

In *Re Jones* (*b*)—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."

(*y*) *Re Dundon* (1885), Griff. P. C. 278. The cost of unnecessary declarations will be put upon the party filing them, whatever be the result of the opposition: *Brand's Application* (1895), 12 R. P. C. 102.

(*z*) P. R. 1890, r. 43.

(*a*) (1884) Griff. P. C. 293, 294.

(*b*) (1885) Griff. A. P. C. 34.

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 (*c*). Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application (*d*). 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 (*e*). If neither party applies to be heard, the comptroller will decide the case (*f*).

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 (*g*). Before the law officer, the appellant begins save where fraud is alleged, when the party alleging fraud begins.

On the hearing of the case, no opposition shall be allowed in respect of any ground not stated in the notice of opposition; and where the ground or one of the grounds is that the invention has been patented in this country on an application of prior date, the opposition shall not be allowed upon such ground, unless the title, number, and date of the patent granted on such prior application shall have been duly specified in the notice of opposition (*h*).

Decision of comptroller communicated to parties.

The decision of the comptroller in the case shall be notified by him to the parties (*i*), and may be appealed against to the law officer (*k*).

Costs.

The comptroller has no power to award costs.

Appeals to law officer.

Any person intending to appeal (*l*) to the law officer from

(*c*) P. R. 1890, r. 39.
(*d*) *Ibid.* r. 40.
(*e*) See p. 809.
(*f*) 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.
(*g*) *Luke's Patent* (1896), Griff. P. C. 294.
(*h*) P. R. 1890, r. 42.
(*i*) *Ibid.* r. 44.
(*k*) Act of 1883, sect. 11, sub-sect. 2.
(*l*) The appeal may be against sealing the patent or against sealing it without a reference to prior patents: *Brownhill's Application* (1889), 6 R. P. C. 135.

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*). 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 authorised 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 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*).

Where comptroller requires amendment.

The effect of the Law Officers' 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 is to part only of the comptroller's decision, the person receiving

Appeal limited to terms of notice or counter-notice.

(*m*) L. O. R. r. 1.
(*n*) *Ibid.* r. 2.
(*o*) *Ibid.* r. 3.
(*p*) *Re Anderson and McKinnell* (1886), Griff. A. P. C. 23.
(*q*) (1888) 5 R. P. C. 599, 601.
(*r*) *Re Chandler* (1886), Griff. P. C. 273.

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*).

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;

(*s*) *Re Bairstow* (1888), per Clarke, S.-G., 5 R. P. C. 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 R. P. C. 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. See also *Ex parte Sheffield* (1872), 8 Ch. 257; 42 L. J. Ch. 356.

(*z*) (1884) Griff. P. C. 269. Rules 9 and 10 relate to the attendance, cross-examination, and expenses of witnesses; see p. 592.

(*a*) Act of 1883, sect. 11, sub-sect. 4.

(*b*) (1889) 6 R. P. C. 548.

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 (*d*).

Who may oppose before law officer.

Any person who can allege good grounds of opposition as defined by sect. 11 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 (*e*). The law officer cannot hear persons who could not have opposed before the comptroller (*ee*).

"I shall hesitate very much," said Herschell, S.-G., in *Re Glossop* (*f*), "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 (*g*), Clarke, S.-G., observed, "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. . . . . The only class of persons who are entitled to be heard in

(*c*) (1888) 5 R. P. C. 343.

(*d*) And see *Stuart's Application* (1892), 9 R. P. C. 452.

(*e*) Act of 1883, sect. 11, sub-sect. 3. The same rule holds good in applications for the amendment of specifications. See sect. 18, sub-sect. 4, and *Re Bell* (1885), Griff. A. P. C. 10.

(*ee*) *Re Stewart's Application* (1896), 13 R. P. C. 627.

(*f*) (1884) Griff. P. C. 285.

(*g*) *Re Heath and Frost* (1886), Griff. P. C. 288; cp. *Re Hookham* (1886), per Webster, A.-G., Griff. A. P. C. 32.

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."

Persons held entitled to oppose before law officer.

The following persons have accordingly been held entitled:—the licensee under a prior patent (*h*); the grantee of a prior *expired* patent (*i*); the assignee and manufacturer under a lapsed patent (*k*). In *Hetherington's Patent* (*l*) the applicant falsely stated in his specification that he was the inventor of a contrivance, but he did not claim it; it was decided that the true owner had a *locus standi* to be heard.

Not entitled.

The following have been held not to be entitled:—an agent for the real opponent (*m*), a manufacturer under one of the patents relied on (*n*), and a person who was about to work the invention for which the prior patent had been granted (*o*).

In *Re MacEvoy* (*p*), 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* (*k*) and *Re Heath and Frost* (*q*).

But when a person is properly before the law officer, he may ground his opposition on prior specifications, though he be not interested in them (*qq*).

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. As to the meaning of "application of prior date" where an application has been antedated under international and colonial arrangements,

(*h*) *Re Hill* (1888), 5 R. P. C. 599.

(*i*) *Re Lancaster* (1884), Griff. 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": *Stewart s Application* (1896), 13 R. P. C. 627.

(*k*) *Re Glossop* (1884), Griff. 285.

(*l*) (1890) 7 R. P. C. 419. The law officer would refuse to seal a patent if the specification contained statements known to be false (*ibid.*).

(*m*) *Re Heath and Frost* (1886), Griff. 288. In this case leave to amend by inserting in the notice of opposition the name of the real opponent was refused.

(*n*) *Re MacEvoy* (1888), 5 R. P. C. 285.

(*o*) *Re Bairstow* (1888), 5 R. P. C. 286. As to an applicant whose patent has not been sealed, *quære: Dundon's Patent* (1886), Griff. 278.

(*p*) (1888) 5 R. P. C. 285.

(*q*) Griff. 288.

(*qq*) *Stewart's Application* (1896), 13 R. P. C. 627.

see *Everitt's Patent* (*r*), and *infra*, p. 540. An accepted complete specification is for this purpose a patented invention (*s*).

L'Oiseau and Pierrard's Patent.

This point was decided in *Re L'Oiseau and Pierrard* (*t*). In that case an application for a patent was opposed by the grantee 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 (*u*). The existence of inventions which had received only provisional protection will not suffice to prevent the sealing of a patent for the same subject-matter (*x*).

Description in a prior application not enough unless the applicant's invention is covered by the prior claim.

The mere description of an applicant's invention in a prior specification is not enough (*y*): it must be claimed. "Sect. 11," said Clarke, S.-G., in *Re Von Buch* (*z*), "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."

Again, it is no answer to a *bonâ fide* applicant for a patent to allege that experiments, or even drawings, were being made by

(*r*) (1888) Griff. A. P. C. 28; *Main's Patent* (1891), 8 R. P. C. 13

(*s*) Act of 1883, sect. 15.

(*t*) (1887) Griff. A. P. C. 36.

(*u*) *Re Bailey* (1884), Griff. 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 devise 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), Griff. A. P. C. 33.

(*x*) *Bailey's Patent* (1886), Griff. 269.

(*y*) In order to ascertain the state of knowledge prior specifications may be admitted in evidence: *Jones's Patent* (1885), per Davey, S.-G., Griff. A. P. C. 34.

(*z*) (1886) Griff. A. P. C. 41.

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 (*a*).

In *Brownhill's Patent* (*b*), 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 (*c*), 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 (*d*). Costs are not intended to amount to a full indemnity against the expense of the appeal (*e*).

In Re Ainsworth (*f*) 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 (*g*).

(*a*) *In re Henry's Patent* (1872), per Lord Selborne, L. C., L. R. 8 Ch. 167.

(*b*) (1889) 6 R. P. C. 136.

(*c*) Per Webster, A.-G., *In re Anderton* (1886), Griff. A. P. C. 25; and see *In re Stubbs* (1884), Griff. P. C. 298, per Webster, A.-G.: "I regard these appeals as rehearings. . . . . 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."

(*d*) *Re Fletcher* (1888), Griff. A.P.C. 31.

(*e*) *Stuart's Application* (1892), 9 R. P. C. 452.

(*f*) (1885) Griff. P. C. 269.

(*g*) *Re Knight* (1886), Griff. A. P.C. 35.

In *Re Dietz* (*h*) 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 giving notice of opposition or from a person of whom he is the legal representative."

"Obtained the invention" means "obtained the invention which is purported to be patented." If the invention is identical with what was obtained from the opponent, the opponent has a right to oppose, and the patent will be stopped, though the opponent himself does not desire to obtain a patent for the invention, or even if he would be unable to do so (*i*).

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 (*k*) or in part (*l*) 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* (*l*), "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 important 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

(*h*) (1889) 6 R. P. C. 297.
(*i*) *Thwaites's Application* (1892), 9 R. P. C. 515.
(*k*) *Re Lake* (1888), 5 R. P. C. 415.
(*l*) *Re Edmunds* (1886), Griff. P. C. 281. This case has been followed in *Re Higgins* (1892), 9 R. P. C. 74.

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, sect. 6, and is therefore entitled to a patent, and it is not for the comptroller to inquire into the source of his information (*m*).

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, resident abroad, and where it was clear from the declarations filed that there was no foundation for the applicant's allegation (*n*).

In re Marshall (*o*) 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* (*p*), 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* (*q*), 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 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.

(*m*) Cp. *Abel's Application* (1876), Johns. Pat. Man. p. 178; *Adolph Spiel's Patent* (1868), 5 R. P. C. at p. 282; *Bairstow's Patent* (1888), 5 R. P. C. at p. 287; and *Re Edmunds*, *supra*; *Re Higgins*, *supra*.

(*n*) *Re Fiechter* (1882), Griff. P. C. 284, per James, A.-G.; and see the comments of Webster, A.-G., upon this case in *Re Edmunds*, *ibid.* 283.

(*o*) (1888) 5 R. P. C. 661; cp. *Hadden's Application* (1853), Johns. Pat. Man. 177.

(*p*) (1889) 6 R. P. C. p. 296.

(*q*) (1889) Goodeve, P.C. 33; 6 R.P.C. 104.

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 (*r*).

In *Re Russell* (*s*), it appeared that the applicant *Russell* and the opponent *Muntz* had either contributed to the invention, or arrived independently at the same result. 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, nor that Mr. *Muntz* was the inventor, but that they were both the inventors" (*t*). 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 licence 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."

When applicant and opponent are practically joint inventors.

Terms on which patent sealed.

(*r*) 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), Griff. P. C. 294; *Re Hatfield* (1884), Griff. 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. 8 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), Griff. A. P. C. 25.

(*s*) (1857) 2 De G. & J. 130.

(*t*) 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. 6 Ch. 272.

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* (*u*). This was a case of opposition by *Tatham* to an application by *Luke* for a patent for "improvements in or applicable to machinery 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 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" (*x*).

Terms on which patent sealed.

In *Re Garthwaite* (*y*), 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* (*z*), an application for a patent for

(*u*) (1885) Griff. P. C. 294; *Re Eadie* (1885), Griff. P. C. 279. Here a *material* part only of the applicant's invention had been obtained from the opponents.

(*x*) 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.

(*y*) (1886) Griff. P. C. 284.

(*z*) (1884) Griff. P. C. 279.

"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 the 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 applicants E. and O., on the condition that C. executed an assignment to E. of one half the interest in his patent (*a*).

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 or to cause a patent to the servant to be stopped (*b*).

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 (*c*).

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 (*d*). 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 (*e*).

Meaning of "legal representative."

The words "legal representative" in sect. 11 must be

(*a*) The order contained a direction as to the payment of the renewal fees similar to that in *Re Garthwaite*, cited above.

(*b*) *Re Heald's Patent* (1891), 8 R. P. C. 429.

(*c*) Per Davey, S.-G., in *Re David and Woodley* (1886), Griff. A. P. C. 26.

(*d*) *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 R. P. C. at p. 181.

(*e*) *Saxby* v. *Gloucester Waggon Co.* (1883), per Lord Blackburn, Griff. A. P. C. 57.

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 (*f*), 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 in alleged fraud of that assignment (*g*).

Second ground of opposition.

2. "That the invention has been patented (*h*) in this country on an application of prior date" (*hh*).

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. 248 *et seq.*

Application antedated under Act of 1883, *sect.* 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. It was held that this foreign application was not "an application of prior date" to E.'s, within the meaning of the Act of 1883, s. 11, sub-sect. 1 (*i*).

Re Main's Patent (*k*) was a converse case; the opponent obtained his patent subsequent to the applicant's American application, but prior to the English application; the case fell within sect. 103, and the opposition was overruled on the ground that the applicant had a right to rely on the American date.

Application refused only if identical with that covered by the former patent.

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 (*l*). And in determining this, mechanical equivalents must be taken into consideration (*m*).

"Stopping a patent," said Webster, A.-G., in *Re Stubbs* (*n*), "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

(*f*) *Re Edmunds* (1886), per Webster A.-G., Griff. P. C. 281.

(*g*) *Adolph Spiel's Patent* (1888), 5 R. P. C. 281.

(*h*) As to the meaning of "patented" in this connection, see *ante*, pp. 248 *et seq.*, where the cases bearing upon the subject are fully considered. It is immaterial whether the prior patent be good or bad: *Thornborough and Wilks's Patent* (1896), 13 R. P. C. 115.

(*hh*) Though the patent has lapsed or expired: *Stewart's Application* (1896), 13 R. P. C. 627.

(*i*) *Re Everitt* (1866), Griff. A. P. C. 28.

(*k*) (1890) 7 R. P. C. 13.

(*l*) (1884) Griff. P. C. 298. Cp. *Cumming's Patent* (1884), per James, A.-G., Griff. P. C. 277; *Jones's Patent* (1885), Griff. A. P. C. 34; *Newman's Patent* (1888), 5 R. P. C. 711; *Stuart's Application* (1892), 9 R. P. C. 452. Substantial identity will, however, be sufficient.

(*m*) *Hudd Smith's Application* (1896), 13 R. P. C. 200.

(*n*) (1884) Griff. 298.

must be distinctly understood that I shall not stop the patent, unless I am satisfied that the inventions are identical."

In *Re Jones* (*o*) Davey, S.-G., said: "I am not entitled to express an opinion whether Mr. Jones' 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."

In *Re Webster* (*p*), 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* (*q*), 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 (*r*), 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 india-rubber 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* (*s*), 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 compressing 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.

If after excising what is covered by the opponent's patent, there is clearly nothing left of a patentable nature, the patent will be refused (*t*); not that the law officer has to consider

(*o*) Griff. A. P. C. 33, 34.

(*p*) (1889) 6 R. P. C. 163; *Re Hall and Hall* (1888), 5 R. P. C. 283.

(*q*) (1885) Griff. P. C. 310.

(*r*) *Re Aire and Calder Glass Bottle Works, and Walker's Application* (1888), 5 R. P. C. 345; *Re Wallis and Ratcliff* (1888), 5 R. P. C. 347; *Re Daniel* (1888), 5 R. P. C. 413.

(*s*) (1887) Goodeve, P. C. 57.

(*t*) *Wylie and Morton's Application* (1896), 13 R. P. C. 97; *Boult's Application* (1893), 10 R. P. C. 275; *Hedge's Application* (1895), 12 R. P. C. 136.

whether an invention is good subject-matter (*u*), but because in such cases it may generally be assumed that the invention intended to be patented is the whole, and that is identical with a previously patented invention (*x*).

Application when granted.

When an opposition to an application for a patent merely raises a question of infringement (*y*), where the differences between the interfering inventions are such that they cannot be considered as substantially identical (*z*), 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 (*a*), the application will be granted. But where the applicant's invention differs only colourably from that of the opponent, the patent may be stopped, and the law officer may deal with the question of mechanical equivalents (*b*).

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 (*c*).

A patent will not be stopped where there is a strongly controverted question of anticipation involving difficult questions of fact (*d*).

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.

Claims may be struck out.

In *Hall and Hall's Patent* (*e*), 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.

(*u*) *Todd's Application* (1892), 9 R. P. C. 487.

(*x*) This seems to follow from *Hedge's Application* (*supra*). And see *Hudd Smith's Application* (1896), 13 R. P. C. 200.

(*y*) *Jones's Patent* (1885), Griff. A. P. C. 34; *Sielaff's Application* (1888), 5 R. P. C. at p. 487.

(*z*) *Re Cumming* (1884), per James, A.-G., Griff. P. C. 277; *Re Stubbs* (1884), per Webster, A.-G., Griff. P. C. 298; *Anderson and McKinnell's Patent* (1886), Griff. A. P. C. 23.

(*a*) *Re Lorrain* (1888), 5 R. P. C. 142. The patentee of the later patent frames his specification at his peril, *Ibid.*; *Re Brownhill* (1889), 6 R. P. C. 135.

(*b*) See *Wylie and Morton's Application* (1896), 13 R. P. C. 97; *Haythornethwaite's Application* (1889), 7 R. P. C. 70. And cf. *Stubbs' case*, Griff. 298.

(*c*) Per Herschell, S.-G., in *Re Glossop* (1884), Griff. P. C. at p. 286; *Re Cumming, ubi supra*; *Re Pitt* (1888), per Clarke, S.-G., 5 R. P. C. 343; *Re Brownhill, ubi supra*.

(*d*) *Lake's Patent* (1889), 6 R. P. C. p. 548.

(*e*) (1888) 5 R. P. C. 283.

Form of general disclaiming clause.

In *Re Guest and Barrow* (*f*), 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. . . . 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 (*g*); 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."

Reference to existing knowledge.

General allegation of defect.

General disclaimer.

Purpose of general disclaimer.

The insertion of these disclaimers does 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 (*h*), who are entitled to know what a subsequent patentee may claim, and to have a fair description of the existing state of knowledge (*i*).

In *Atherton's Patent* (*k*), Webster, A.-G., 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.

Special disclaiming clause.

The law officers have always recognised 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 (*l*). 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 wrongly he alleges to exist. The earlier patentees are not bound by this description."

(*f*) (1885) 5 R. P. C. 313; *Re Cooper and Ford* (1885), Griff. P. C. 275; *Re Hill* (1888), 5 R. P. C. 599.

(*g*) 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

(*h*) *Hill's Application* (1888), 5 R. P. C. 599.

(*i*) (1888) 5 R. P. C. 313; *Re Cooper and Ford* (1885), Griff. P. C. 275; *Re Hill* (1888), 5 R. P. C. 599.

(*k*) (1889) 6 R. P. C. p. 547.

(*l*) *Re Newman* (1888), per Webster, A.-G., 5 R. P. C. 271.

prior patented invention everything that is described and claimed therein (*m*).

Forms of special disclaiming clauses.

Thus in *Re Hoskins* (*n*), an application by H. for a patent for "improvements in folding cots and hammock frames," opposed by N., the following order was made:—

"This invention refers to the improvements (*o*) 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* (*p*), 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* (*q*) 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* (*r*), 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 (*s*).

And in *Re Guest and Barrow* (*s*), Webster, A.-G., said: "I

(*m*) In *Re Teague* (1884), Griff. 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 certain parts from the specification.

(*n*) (1884) Griff. P. C. 291.

(*o*) 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.

(*p*) (1888) 5 R. P. C. 279.

(*q*) 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 R. P. C. 597. In *Re Welch* (1884), Griff. P. C. 300, the word "claimed" was omitted. See, however, *Re Newman, ubi supra*; *Re Airey* (1888), 5 R. P. C. 348; *Re Lynde* (1888), *Ibid.* 661; *Re Wallace* (1889), 6 R. P. C. 134.

(*r*) (1888) 5 R. P. C. 663; also see *Re Wallace* (1889), 6 R. P. C. p. 135; *Re Hoffman* (1890), 7 R. P. C. 92.

(*s*) (1888) 5 R. P. C. 313. And he will not get a reference merely to call attention to his patent. *Adam's Application* (1896), 13 R. P. C. 548.

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." This agrees with the views of Clarke, S.-G., expressed in *Anderson and McKinnell's Application* (*t*). See also *Sieliaff's Application* (*u*).

Principles on which the law officers act.

In *Stell's Patent* (*x*), Webster, A.-G., said: "The principles upon which the law officers have acted now for some years in allowing disclaiming clauses are, first, if it appears clear that upon the invention claimed by the prior patentee there will be a repetition of the claim to the earlier invention in the later patent; and, secondly, if it is clear that the public would be misled by the later specification without disclaimer. . . . Many years ago Lord Cairns pointed out that these disclaimers were of no value to the prior patentee, except for the purpose of preventing the public being misled, or of preventing unfair dealing by means of patents which might be subsequently granted. I think that a prior patentee who asks for a disclaimer must satisfy the comptroller or the law officer on appeal that it is necessary for his protection."

In *Welch's Patent* (*y*), the same Attorney-General said: "I do not think that a later patentee ought to be compelled to insert a special reference to the earlier specification of the opponent, unless it is practically admitted by the later applicant that the governing principle was for the first time discovered or disclosed in the opponent's specification."

Sometimes the law officer requires not only a reference to a prior specification, but an express disclaimer (*z*); sometimes a mere reference will suffice to satisfy the requirements (*a*). In a specification relating to a patent for a mere improvement, one or other is often required.

Cases in which disclaimer or reference is required. *Third ground of opposition.*

A reference or disclaimer in the specification should be directed only if the patent without this would have to be refused (*b*).

3. "That the complete specification describes or claims an invention other than that described in the provisional specifi-

(*t*) (1887) 2 Griff. 23.
(*u*) (1888) 5 R. P. C. 485.
(*x*) (1891) 8 R. P. C. 235. And see *Tattersall's Patent* (1892), 9 R. P. C. 150.
(*y*) (1891) 8 R. P. C. 443.
(*z*) *E.g.*, *Welch's Patent* (1891), 8 R. P. C. 443.

(*a*) *E.g.*, *Van Gelder's Application* (1892), 9 R. P. C. 325; *Maxim and Silvermann's Application* (1894), 11 R. P. C. 314.
(*b*) *Marsden's Patent* (1896), 13 R. P. C. 87. And see *Stuart's Application* (1892), 9 R. P. C. 452.

cation, 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."

Disconformity in itself was not under the Act of 1883 (*c*), 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 (*d*).

Generally.

The Act of 1888 does not prevent the inventor who has sent in a provisional specification from developing his invention in the complete unless he thereby makes the invention a different one to that described in the provisional. In the latter case a person who files the subsequent provisional specification covering the enlarged invention will be entitled to stop the patent; otherwise he will not (*e*).

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. The general rule is that the patent will be sealed unless the comptroller (or on appeal the law officer) is quite satisfied that the objection should prevail. In case of doubt the patent should be sealed (*f*).

(*c*) *Newman's Patent* (1888), per Webster, A.-G., 5 R. P. C. at p. 277.

(*d*) The opposition allowed by the Act of 1888 enured to the benefit even of those who filed their provisional specification before 1888: *Anderson and Anderson's Patent* (1890), 7 R. P. C. 323.

(*e*) *Edwards's Patent* (1894), 11 R. P. C. 461. See Disconformity, *ante*, pp. 149, 150.

(*f*) *Russell's Patent* (1857), 2 De G. & J. 130; *Spence's Patent* (1859), 3 De G. & J. 523; *Tattersall's Patent* (1892), 9 R. P. C. 150; *Stuart's Application* (1892), 9 R. P. C. 452; *Todd's Patent* (1892), 9 R. P. C. 487.

CHAPTER IX.

THE GRANT.

I. Persons to whom a Grant may be Made.

A grant cannot be made save to the true and first inventor (or to one or more persons who include the true and first inventor), and not to him if he comes within the class of those persons who are disqualified from making application for patent grants. It will be necessary, therefore, to consider (1) the meaning of "true and first inventor," and (2) who may apply for a grant.

1. *The True and First Inventor.*

The Statute of Monopolies (sect. 6) allows that monopoly grants may be made in certain events to the "true and first inventor"; and the Patents Act, 1883 (sect. 5, sub-sect. 2), provides that the applicant for a patent (or one of them) must declare himself to be the "true and first inventor" of the invention which it is desired to patent (*a*). If the person (or one of the persons) to whom the patent is granted is not the true and first inventor, the grant is invalid.

The determination of the true and first inventor does not involve an inquiry into novelty.

When it is stated that the patentee is the true and first inventor, it is not intended to convey that the invention is novel. The point is, not whether there be an invention, but granted that there be, is the claimant the inventor? Is he the discoverer, or is some one else the discoverer, of that which for the moment is admitted to be an invention? This is the question to be determined. In other words, the objection of want of novelty or of subject-matter does not raise the same issue as the objection that the claimant is not the true and first inventor (*b*).

(*a*) See forms of application, *post*, p. 805.

(*b*) *Thomson* v. *Macdonald* (1891), 8 R. P. C. at p. 9; *Winby* v. *Manchester Steam Trams. Co.* (1891), 8 R. P. C. 61, 66; *Pneumatic Tyre Co.* v. *Caswell* (1896), 13 R. P. C. at p. 187; *Cornish* v. *Keene* (1831), 1 W. P. C. at p. 507; *Gibson* v. *Brand* (1841), 1 W. P. C. 627; *Muntz* v. *Foster* (1844), 2 W. P. C. at p. 102.

A question of fact.

Whether a man is or is not the true and first inventor is a question of fact (*c*).

Undisclosed inventions.

The true and first inventor is not necessarily the first discoverer of the invention. If it had been discovered by another, but the discovery had never been divulged, he who independently discovers the same thing, and is the first to disclose it or to apply for a patent which is eventually granted, is the true and first inventor (*d*). In *Forsyth* v. *Rivière* (*e*) it was decided that if two or more discover the same thing simultaneously, he who first communicates it to the public is the true and first inventor. This follows from the principle that a patent is the reward for bringing new trades to the knowledge of the public.

Effect of assistance of others on claim to be the inventor.

Sometimes the patentee has obtained assistance in putting his ideas into practice. The result may or may not be that he is not the true and first inventor. Thus in *Minter* v. *Wells* (*f*) Alderson, B., dealing with the facts of the case, said: "If Sutton suggested the principle to Mr. Minter, then he would be the inventor; if, on the other hand, Mr. Minter suggested the principle to Sutton, and Sutton was assisting him, then Mr. Minter would be the first and true inventor, and Sutton would be a machine, so to speak, which Mr. Minter used for the purpose of enabling him to carry his original conception into effect."

Illustrations.

In *Bloxham* v. *Elsee* (*g*) an engineer employed by the patentee gave professional assistance, and suggested several mechanical parts of the machine the subject of the patent, but the main invention was exclusively that of the patentee, who was held to be a true and first inventor. But in *Tennant's Case* (*h*) a patent for a bleaching preparation was declared invalid because the patentee had been assisted by a chemist who enabled him to arrive at a main portion of the invention. The chemist had pointed out to the patentee that the end desired would be attained if the limewater in the bleaching liquor were constantly agitated. This proved to be so.

(*c*) *Minter* v. *Wells* (1834), 1 W. P. C. at p. 134; 1 C. M. & R. 505; *Kurtz* v. *Spence* (1888), 5 R. P. C. 161, 57 L. J. Ch. 238.

(*d*) *Dollond's Patent* (1758), 1 W. P. C. 43, cited in *Boulton* v. *Bull*, 2 H. Bl. at pp. 479, 487; *Lewis* v. *Marling* (1829), 1 W. P. C. 493; 10 B. & C. 22.

(*e*) 1 W. P. C. 97, n. See also the remarks of Jessel, M. R., in *Plimpton* v. *Malcolmson* (1876), 3 Ch. Div. at p. 556.

(*f*) (1834) 1 W. P. C. 127.

(*g*) 1 C. & P. 558; 1 W. P. C. 132, n. And see *Barker* v. *Shaw*, 1 W. P. C. 126, n.

(*h*) 1 W. P. C. 125, n.; Dav. P. C. 429.

In *Elias* v. *Grovesend Tin Plate Co.* (*i*) P. had an idea which was susceptible of being utilised to improve certain machinery. This idea he communicated to T., but did not state any means of putting it into practice. T. sent for H. and asked H. to draw a plan, and when the plan was drawn T. showed it to P. T. ordered H. to make the machine as per plan, and T. paid the cost. The Court of Appeal decided that P. was not the first and true inventor (*k*).

If the invention is wholly or in part the work of a servant, the master cannot get a patent alone, if at all (*l*). The case is otherwise when the part of the workman is confined to suggestions as to mere details. If a workman employed by an inventor to make a model for the purpose of carrying out the invention, suggests improvements in details of the machine which are adopted in the machine or model as completed, these suggestions are the property of the employer, and the workman cannot afterwards take out a patent for them (*m*).

Summary of the law relating to the assistance of servants.

The law was thus laid down by Tindal, C. J., in *Allen* v. *Rawson* (*n*) :—"It would be difficult to define how far the suggestions of a workman employed in the construction of a machine are to be considered as distinct inventions by him, so as to avoid a patent incorporating them taken out by his employer. Each case must depend on its own merits. But when we see that the principle and object of the invention are complete without it, I think it is too much that a suggestion of a workman employed in the course of experiments of something calculated more easily to carry into effect the conceptions of the inventor should render the whole patent void."

Servant as an inventor.

A servant, if really the inventor, may often patent his invention, though it be made in his employer's time, with the use of the employer's materials, and at the expense of the employer; for in such case the invention is not necessarily the property of the employer (*o*).

An importer is an inventor.

A person who imports into the realm (*p*) an invention not

(*i*) (1890) 7 R. P. C. 455.

(*k*) See also *Siddell* v. *Vickers* (1888), 39 Ch. Div. 92; 5 R. P. C. 81, 416; *Earle* v. *Spence* (1888), 5 R. P. C. 161; *Re Norwood's Patents* (1895), 12 R. P. C. 24.

(*l*) See, *e.g.*, *Barber* v. *Walduck* (1823), 1 Carp. P. C. 438 (reported as *Barker* v. *Shaw*, 1 W. P. C. 126).

(*m*) Per Davey, S.-G., in *David and Woodley's Application* (1884), Griff. A. P. C. 26.

(*n*) (1845) 1 C. B. 551.

(*o*) Per Clarke, S.-G., in *Heald's Patent* (1891), 8 R. P. C. 429; and see *Saxby* v. *Gloucester Waggon Co.* (1883), Griff. A. P. C. at p. 56.

(*p*) Scotland is within the realm: *Plimpton* v. *Malcolmson* (1876), 3 Ch. Div. at p. 555.

previously in use therein is a true and first inventor. It is stated in *Edgeberry* v. *Stephens* (*q*) that "if the invention be new in England, a patent may be granted, though the thing was practised beyond the sea before, for the statute speaks of new manufactures within the realm, so that, if it be new here, it is within the statute; for the Act intended to encourage new devices useful to the kingdom, and whether learned by travel or by study, it is the same thing."

This was the law prior to the Statute of Monopolies. The reported cases of the time of Elizabeth and James I. relate to imported articles, and not to entirely novel inventions (*r*). And the law has never been different (*s*), for though the wording of sect. 5 of the Patent Act, 1883, compared with the prior Act, might cause some doubt (*t*), the definition of "invention" in the Act is "any manner of new manufacture the subject of letters patents and grant of privilege within the meaning of sect. 6 of the Statute of Monopolies."

Sir George Jessel's criticisms.

In *Marsden* v. *Saville Street Co.* (*u*) Jessel, M. R., said: "It is difficult to say on what principle a person who did not invent anything, but who merely imported from abroad into this realm the invention of another, was treated by the Judges as being the first and true inventor. I have never been able to discover the principle, and although I have often made inquiry of others, ... I could never get a satisfactory answer. The only answer was, 'It has been decided, and you are bound by the decision.' But it is an anomaly, as far as I know, not depending on any principle whatever. It has never been declared by any Judge or authority that there is such a principle, and not being able to find one, all I can say is that I must look upon it as a sort of anomalous decision which has acquired by time and recognition the force of law."

Note on Sir George Jessel's criticisms.

It is submitted that the protection of those who have imported novelties is founded on grounds much less arbitrary than Sir George Jessel seems willing to allow. If it be true that the

(*q*) (1691) 1 W. P. C. 35.

(*r*) See, *e.g.*, *Hastings Case*; *Matthey's Case*; *Darcy* v. *Allin*, *ante*, pp. 6 *et seq.*, and the dicta in *The Clothworkers of Ipswich Case*, 1 Godb. 252, 254.

(*s*) See, *e.g.*, *Walton* v. *Bateman* (1842), 1 W. P. C. 613; *Beard* v. *Egerton* (1846), 15 L. J. C. P. 270; 3 C. B. 97; *Plimpton* v. *Malcolmson* (1876), 3 Ch. Div. at p. 555; 45 L. J. Ch. 505; *Moser* v. *Marsden* (1890), 10 R. P. C. at p. 358.

(*t*) See *Edmunds's Patent* (1886), Griff. P. C. at p. 283.

(*u*) (1878) 3 Ex. D. at p. 205. And see the remarks of the same learned Judge in *Plimpton* v. *Malcolmson* (1876), 3 Ch. Div. at pp. 555—556.

Statute of Monopolies (sect. 6) does but preserve the common law in regard to the grant of monopolies for meritorious inventions (and the reasons for so supposing have already been stated (*x*)), the meaning of "invention" as used in that statute must be sought not in a modern dictionary, but in the old authorities; and the fact that in all the reported cases dated before or about the time of the Statute of Monopolies invention includes importation is reason for supposing that in the statute, as at common law, the importer was always intended to receive the same protection as the new manufacturer. Importers were more important than inventors (using the word in its strict sense). The original object of the Crown in granting monopolies, and the reason which led the common lawyer to recognise the grant, was the introduction here of new trades and of manufactures in use amongst foreigners. This the researches of Mr. Wyndham Hulme (*y*) prove to demonstration. It is the divergence of modern policy from that which governed in ancient times, which has caused the apparent anomaly to which Sir George Jessel refers.

Communicated inventions.

An invention communicated from abroad may be patented, and not infrequently patent agents make applications and take out in their own names letters patent for foreigners. A special form of application (*z*) is prescribed for these cases, though what would be the effect of using the ordinary form of application does not seem to be yet settled (*a*). Probably the patent would be good (*b*). The patent will be good though it be held in trust for the foreigner (*c*).

Use may be made of information acquired from abroad, and a practical way of carrying out a novel foreign idea can be patented, the patentee being in such case a true and first inventor; a man may import a foreign invention and improve it himself (*d*).

(*x*) See *ante*, Chap. II.

(*y*) See some early grants quoted in a paper on "The History of the Patent System" by E. Wyndham Hulme, Law Quarterly Review, April, 1896. It will suffice to quote this statement: "The Elizabethan policy aimed beyond question . . . . at the introduction of those industries the products of which had hitherto figured most prominently in the list of imports, viz. alum, glass, soap, oil, saltpetre, latten, &c., &c. Now the proof of a single sale is held to be destructive of the novelty of the invention."

(*z*) See *post*, p. 806, Form A 1.

(*a*) *Re Avery's Patent* (1887), 36 Ch. Div. 307; 56 L. J. Ch. 586, 1007; 4 R. P. C. at p. 163.

(*b*) See *Moser* v. *Marsden* (1893), 10 R. P. C. at p. 359.

(*c*) *Beard* v. *Egerton* (1846), 15 L. J. C. P. 270; 3 C. B. 97.

(*d*) *Nickels* v. *Ross* (1849), 8 C. B. 679; *Milligan* v. *Marsh* (1856), 2 Jur. N. S. 1083; *Moser* v. *Marsden*, 10 R. P. C. at p. 359.

Communication by one foreigner to another.

In *Re Wirth's Patent* (*c*) it was decided that letters patent could be granted to an alien resident abroad for an invention communicated to him by another alien who was also resident abroad. But now the Form A 1 (*f*) is so drafted as impliedly to prevent a foreign resident from using it. A secret communication by one person in England to another in England does not make the latter an inventor within the meaning of the patent law (*g*).

Invention obtained abroad by fraud.

In *Re Edmunds's Patent* (*h*) it was alleged that the person importing the invention had improperly obtained it abroad. Webster, A.-G., said: "Prior to the passing of the Act of 1883 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."

2. *Persons who may apply for a Patent.*

It is now proposed to consider the question, Who may apply for a patent? (*i*).

Definition of patentee.

Generally any person may be an applicant.

Assuming that the applicant (or if there be several, one of the applicants) is the true and first inventor (*j*), he will seldom find difficulty arising from his status. It may be laid down as a general rule that any person (including a married woman) may be an applicant for letters patent. The following cases are noteworthy:—

Infants.

(1) *Infants.*—Sect. 99 of the Act of 1883 provides for the making of declarations or the doing of other things requisite on behalf of persons who may be incapacitated by infancy (*k*).

Lunatics.

(2) *Lunatics.*—Sect. 99 applies to lunatics as well as to infants.

Aliens.

(3) *Aliens.*—The Patents, &c., Act, 1883 (sect. 4), provides

(*c*) (1879) 12 Ch. Div. 303.
(*f*) *Post*, p. 806
(*g*) *Marsden* v. *Saville Street Co.* (1878), 3 Ex. Div. 203.
(*h*) (1886) Griff. P. C. 281.
(*i*) A person may be a "patentee" within the meaning of the Patents, &c., Acts, although not qualified to apply for a patent, the definition of a "patentee" being "the person for the time being entitled to the benefit of a patent": 1883, sect. 46.
(*j*) See *supra*.
(*k*) See *Cheavin* v. *Walker* (1877), per V.-C. B., 5 Ch. Div. 858; 46 L. J. Ch. 265.

that any person, whether a British subject or not, may make application for a patent; and it has been held that letters patent may be granted to an alien resident abroad for an invention communicated to him by another alien resident abroad (*l*) but this is no longer encouraged (*m*).

Alien enemy.

It is possible that no patent would be granted to an alien enemy. The point was raised in *Bloxam* v. *Elsee* (*n*), but not decided, the patent being held invalid upon another ground. It has been doubted, says Webster (*o*), 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.

Query, whether alien enemy can be patentee.

International and colonial arrangements are dealt with hereafter (at p. 533).

Corporations.

(4) *Corporations.*—The term "person" includes a body corporate (*p*), and therefore a body corporate may make application for a patent. But whether it can be a true and first inventor is another matter. It is generally considered that a corporation can apply only as one of two or more joint applicants, or perhaps also as the recipient of a communication from abroad. It seems that, under sect. 103, foreign corporations may apply for a patent (*q*).

Clergymen.

(5) *Beneficed Clergymen.*—It may be doubtful whether the exercise of a patent privilege by a *beneficed clergyman* would not be a trading, and therefore prohibited. And if that be so, it may be that 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 (*r*).

Personal representatives.

(6) *The legal personal representatives.*—They may apply for letters patent for an invention of which the inventor died

(*l*) *Re Wirth* (1879), 12 Ch. Div. 303.
(*m*) See Form A 1, *post*, p. 806.
(*n*) (1825-27) 6 B. & C. 169; 1 C. & P. 558; and see Webster P. C. 418, n.
(*o*) Letters Patent for Inventions, p. 23.
(*p*) 1883, sect. 117.
(*q*) *Carez' Application* (1889), 6 R. P. C. 552.
(*r*) Hindmarch, p. 35.

possessed without having made application for the patent. But the representative must apply within six months of the decease, and must declare that he believes the deceased to be the true and first inventor (*s*). If the death takes place after application, but before the patent is sealed, a patent may be sealed to the personal representatives at any time within twelve months after the death (*t*). The practice in such cases is prescribed in the Patent Rules, 1890, rule 20 (*u*).

The sovereign.

(7) The sovereign cannot grant a patent to itself, says Hindmarch (*x*); but the Secretary of State may take an assignment under the Patents, &c., Act, 1883 (sect. 44).

Joint applicants.

(8) Two or more persons may make a joint application, and the patent may be granted to them jointly, provided that at least one of them is the true and first inventor (*y*).

(9) A person who has obtained knowledge of an invention whilst acting in a public capacity cannot take out a patent for it (*z*).

II. Nature of the Grant.

Characteristics of a royal grant.

The grant of letters patent is made by the Crown (*a*). Therefore it possesses certain characteristics which are peculiar to royal grants, viz.: (1) if made on a false suggestion by the applicant, though he be acting *bonâ fide*, it is void; (2) the recitals do not bind the Crown (*b*); (3) the grant is not construed most strongly against the grantor, as in ordinary cases: on the contrary, it is construed most favourably to the Crown; (4) if the intention which the Crown has in making the grant be stated, and the grant obviously contradict that intention, the grant is void; (5) the grant is void if it be made upon several considerations, and any one of such considerations fail (*c*): the grant cannot be made if it be contrary to law, whether to the common law or a statute, nor is it good if it be uncertain; (6) the grant must be under seal; in the case of patents for inventions, under seal of the Patent Office (*d*).

(*s*) 1883, sect. 34.

(*t*) 1883, sect. 12 (3) (*b*).

(*u*) *Post*, p. 690; and see notes to sect. 34 of the Act of 1883, *post*, p. 629.

(*x*) P. 34.

(*y*) 1883, sect. 4 (2), and 1888, sect. 5.

(*z*) *Patterson* v. *Gas-light and Coke Co.* (1876), 2 Ch. Div. 812; 3 App. Ca. 239; 45 L. J. Ch. 843; 47 L. J. Ch. 402.

(*a*) It has recently been decided that the grant of a patent for an invention is a franchise: *R.* v. *Halifax County Court Judge* (1891), 1 Q. B. 793; 2 Q. B. 263; 60 L. J. Q. B. 550; 8 R. P. C. 338; but there are strong arguments against this view.

(*b*) *R.* v. *Bushopp* (1600), Co. Rep. Part I. 40.

(*c*) *Hill* v. *Thompson* (1818), 8 Taunt. 375; 1 W. P. C. 239.

(*d*) Sect. 12.

The Crown cannot derogate from any previously made valid grant: it cannot, when a patent has been granted to one person, grant a patent for the identical subject-matter to others. Under the Act of 1852 this principle was the cause of some difficulty. In *Ex parte Bates and Redgate* (e) an inventor left a provisional specification; a second independent inventor of a similar invention within six months did the same, and obtained his patent before the earlier inventor. The Lord Chancellor refused a patent to the earlier applicant, on the ground that to do so would be to derogate from the grant already given to the later applicant; the former applicant should have opposed the sealing of the later applicant's patent (*f*). This decision was criticised by Lord Cairns in *Re Dering's Patent* (*g*). Under the present Act every patent shall be dated and sealed as of the day of application; and it is further provided that in the 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 (*h*). And another section provides that 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 (*i*).

The Crown cannot derogate from its own previous grant.

Patents date back to application.

Hence if an application be made, and prior to the publication of the specification another inventor applies for a patent for the same invention, the former applicant's patent, if his application be not abandoned, will eventually bear a date anterior to that of the latter applicant; and so far as such latter patent covers the same subject-matter as that covered by the former grant, it will be bad, as being in derogation of the former grant.

The patent grant is incorporeal personal property, and as such devolves on the executors or administrators on the death of the patentee (*k*). It is sometimes seized in execution under a *fi. fa.*; and at the request of the sheriff, and on his responsibility, the register is altered accordingly. Whether in law the sheriff is entitled to seize seems very doubtful (*l*). He is directed to seize

A patent is personal property.

(e) (1869) 4 Ch. 577; 38 L. J. Ch. 501.

(f) See also *Ex parte Bailey* (1872), 8 Ch. 60.

(g) (1879) 13 Ch. Div. at p. 395. See also *Kurtz* v. *Spence* (1880), 5 R. P. C., per Kekewich, J., at p. 178.

(h) 1883, sect. 13.

(i) Ibid. sect. 35. See, under the old Act, *Ex parte Scott and Young* (1870), 6 Ch. 274.

(k) The patent is by its terms a grant to the patentee, his executors, administrators, and assigns. As to application by executors, &c., see *supra*. p. 269.

(l) *Coleman* v. *Rawlinson* (1858), 1 F. & F. 330; *Harley* v. *Harley*, 11

the goods and chattels of the debtor, and *semble* a patent right is not a chattel (*m*). It is assignable by the terms of the grant itself; but for this, it would be merely a personal licence (*n*).

Devolution on bankruptcy of grantor.

In the event of the bankruptcy of the patentee, the grant devolves upon his trustee in bankruptcy (*o*). The reputed ownership clause cannot apply: patents are not goods (*p*).

III. Form and Terminology of the Grant.

Every patent must be under seal (*q*), and may be in the form in the First Schedule to the Patents, &c., Act, 1883 (*r*). It may be granted for one invention only, though the specification may contain more than one claim (*s*).

Forms of grant.

Variations in the form of patent.

The use of the form given is not obligatory; and inasmuch as it is only applicable to the case of a single inventor, 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. It has, however, always been customary to vary the formal parts of the patent in the Office as required; and several forms are printed for use, which meet all the commoner cases. To meet rarer cases, one of the printed forms is altered in ink. There are kept in the Patent Office in stock eight forms, viz.: grants to (1) single inventors; (2) joint inventors; (3) importers; (4) joint applicants of whom some or one only

Ir. Ch. Rep. 451, are cited as authorities, though they are not directly in point. But the patent grant is in practice available under an execution for the creditor.

(*m*) See remarks of Lord Herschell in *Steers* v. *Rogers* (1893), App. Ca. at p. 235; 62 L. J. Ch. 671; 10 R. P. C. 245.

(*n*) *Duvergier* v. *Fellows* (1830), 10 B. & C. 826; 1 C. & F. 39.

(*o*) *Hesse* v. *Stevenson* (1803), 3 B. & P. 565; *Bloxham* v. *Elsee* (1827), 6 B. & C. 169. As to estoppel between the bankrupt and an assignee from the trustee, see *Cropper* v. *Smith* (1885), 10 App. Ca. 249; 2 R. P. C. 17; 55 L. J. Ch. 12. As to the trustee's rights to royalties on an invention patented after bankruptcy, but before discharge, see *Re Graydon* (1896), 1 Q. B. 417; 65 L. J. Q. B. 328.

(*p*) See per Lord Herschell in *Steers* v. *Rogers* (1893), App. Ca. at p. 235; 62 L. J. Ch. 671; 10 R. P. C. 245.

(*q*) Formerly the Great Seal, now the seal of the Patent Office: 1883, sect. 12 (1).

(*r*) *Post*, p. 667.

(*s*) It is not competent for any person in an action or other proceeding to object to a patent on the ground that it comprises more than one invention: 1883, sect. 33.

are inventors; (5) deceased inventors; (6) executors of an inventor; (7) female inventor; (8) joint applicants one of whom dies between application and grant. The main point in which these various forms differ from the scheduled form will be found *post*, pp. 670 *et seq.* Several old forms are set out in the Appendix, *post*, pp. 883 *et seq.*

Observations on the various clauses of the grant will be found in the notes to the form, *post*, pp. 670 *et seq.* In this place it will suffice to mention the following:— Observations on some clauses in the grant.

Letters patent commence in the name of the sovereign, because, although issued formerly from the Court of Chancery and now from the Patent Office, 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 (*t*). They are directed to all persons to whom they shall come, are public records, and all persons are bound to take notice of the grants which they contain.

The recitals are important. They show that the patent is granted at the request of the inventor, and on the understanding that the invention described in the specification is one for the public good. The recitals are (1) a recital that the patentee has represented that he is in possession of an invention, that he is the true and first inventor, and that, to the best of his knowledge and belief, the same is not in use; (2) a recital that the inventor hath "humbly prayed" for a patent; (3) a recital that the inventor has particularly described the invention in his complete specification; and (4) a recital that the Crown grants the request, "being willing to encourage all inventions which may be for the public good." Recitals.

After the recitals comes the grant, expressed to be made of "our especial grace, certain knowledge, and mere motion." These words were introduced to enable the grant to be construed more favourably to the grantee than would be the case ordinarily in view of the fact that the Crown was the grantor. The words "of our especial grace" import that the grant proceeded solely from the grace and bounty of the Crown, and not from any right or The terms of the actual grant. "Especial grace."

(*t*) Hindmarch, p. 40.

"Certain knowledge."

"Mere motion."

title inherent in the grantee (*u*). The words "certain knowledge" imply that the sovereign has knowledge of the subject-matter of the grant (*x*); but their scope is limited and almost annihilated by the clause in the recital making the grant dependent on the representations of the grantee (*x*). The words "mere motion" import that the grant proceeded from the bounty of the sovereign, without any suggestion or suit by the grantee (*y*). It is, however, the duty of every applicant for letters patent to see that the sovereign is correctly informed respecting the subject-matter of the grant (*z*); and the recital in the patent showing that the grant was made upon the petition of the patentee diminishes the force of the words of grace, and prevents a patent from being reduced to the same standard of construction as the grant of a subject (*a*). What, then, is the practical effect of the words of grace and bounty? It seems they may cure many defects and irregularities which would otherwise vitiate the grant (*b*). Possibly, 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 (*c*). They do not, and did not, however, cure a false suggestion on the part of the grantee (*d*), nor have they ever authorised any construction against the plain intent and purpose of the grant (*e*). In modern times, it would appear that these words limit the effect of immaterial mistakes (*f*).

The sealing.

Before 1878, all letters patent for inventions as well as for other matters (*g*) were issued under the Great Seal. The Crown

(*u*) *Brunton* v. *Hawkes* (1821), 4 B. & Ald. 541.

(*x*) At one time the Crown, in fact, had this knowledge: the Crown ordered the introduction of industries on its own motion. See Mr. E. W. Hulme's paper in Law Quarterly Review, April, 1896.

(*y*) 10 Co. 112 b; Vin. Abr. Prerog.; Bac. Abr. Prerog. This often was so at one time; see preceding note.

(*z*) 1 Co. R. 52 a.

(*a*) *R.* v. *Capper* (1817), 5 Price, 217; 1 Co. R. 46 a, 46 b.

(*b*) Webster's Letters Patent for Inventions, Practical Forms, p. 76, n. (*d*), and 1 Web. P. C. at p. 41; *R.* v. *Mussary* (1738), *ibid.*; 1 Co. R. 53 a.

(*c*) Hindmarch, pp. 72, 73. But now the specification must contain a proper description.

(*d*) *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.

(*e*) *Allen Wood's case*, 1 Co. R. 49 a, 52 b, 53 a.

(*f*) "The deed of grant swells with imposing terms which are but the shadows of majesty. The 'certain knowledge and mere motion' turns out to be *clausula clericorum*, the prohibition useless to the infringer, the proviso for favourable construction useless to the patentee" (Turner, Remarks upon Patent Law, 19). This sweeping criticism appears to have been unjust. See, however, *Needler* v. *Bishop of Winchester*, Hob. 221, 222.

(*g*) As to these "other matters," see note, pp. 1 and 2.

Office Act, 1877 (sect. 5) (*h*), 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 (*i*), 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 (*k*).

Time within which patent must be sealed.

A patent is sealed as soon as may be, and not after the expiration of fifteen months (*l*) 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 before the expiration of the fifteen months aforesaid (*l*). 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 from the applicant's death (*m*).

Sealing a duplicate on loss of original.

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 (*n*).

IV. Extent of the Grant.

Geographical area.

The patent when sealed is to have effect in the United Kingdom and the Isle of Man (*o*). The present Act does not extend the monopoly to the Channel Isles; but grants already

(*h*) 40 & 41 Vict. c. 41.

(*i*) These rules came into operation on March 1, 1878, and are published in the "London Gazette" for March 5, 1878.

(*k*) Act of 1883, sect. 12, sub-sects. 1 and 2.

(*l*) 1883, sect. 12 (3). The Act of 1885, sect. 3, empowers the comptroller to grant an extension of four months.

(*m*) Act of 1883, sect. 12 (3).

(*n*) *Ibid.* sect. 97.

(*o*) 1883, sect. 16. Letters patent in England prior to 15 & 16 Vict. c. 83, frequently included 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. Patents for Ireland and Scotland had to be taken out under the Great Seal of those countries respectively. 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

made at the commencement of the Act and prolonged, extend to and have effect in the Channel Islands (*p*).

Duration of the grant.

The normal period of duration is fourteen years from the date of the patent (*q*), that is, from the day of application (*r*); and it has been decided that the actual day of application is to count (*s*). If the grant be made in pursuance of the international arrangements provided for by sect. 103, the fourteen years count from the date of application in the foreign state (*t*). Sect. 104 makes similar provisions in colonial cases.

A patent may be avoided by non payment of fees.

But, notwithstanding the above, every patent will cease if the patentee fail to make the prescribed payments (*u*) within the prescribed times (*u*), or within such period—not exceeding three months—to which the comptroller may enlarge the time on proof that the non-payment was caused by accident, mistake or inadvertence (*x*). The application for enlargement of time must state in detail the circumstances, and the comptroller may require the applicant to substantiate the statements by such proof as the comptroller may think necessary (*y*). In calculating the time for payment of the fees, the day of date of the patent is excluded (*z*), the fees being payable at the end of the years "from" the date of the patent.

Enlargement of time for paying fees.

Prolongation of time.

On the other hand, the period may be prolonged beyond the period of fourteen years; this is dealt with in Chap. XVI., and see sect. 25, *infra*.

of Man, *and, in case Her Majesty, by warrant under her royal sign manual so directed, to her colonies and plantations abroad* (sect. 18). 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. 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.

(*p*) 1883, sect. 113; and see *In Brandon* (1884), 1 R. P. C. 154. The 116th section might enable the Crown to grant a patent to cover the Channel Islands.

(*q*) 1883, sect. 17.

(*r*) 1883, sect. 13.

(*s*) *Russell* v. *Ledsam* (1845), 14 M. & W. 574, 582; 14 L. J. Ex. 359.

(*t*) 1883, sect. 103; 1885, sect. 6.

(*u*) P. R. 1892, Schedule. When the time ends on Christmas Day, Good Friday, Saturday, Sunday, &c., see 1883, sect. 98.

(*x*) 1883, sect. 17.

(*y*) P. R. 1890, r. 49.

(*z*) *Williams* v. *Nash* (1859), 28 L. J. Ch. 886; 28 Beav. 93.

V. Co-owners.

As has already been pointed out (*a*), a grant may be made to several persons jointly; or the patent originally granted to one person may become by subsequent assignment or devolution vested in several co-owners. The position of co-owners requires some consideration.

Rights of co-owners generally.

The law as to the rights in ordinary cases of co-owners of a patent is laid down in Lindley on the Law of Partnership (*b*). 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, "in the case of a patent belonging to several persons in common, each co-owner can assign his share and sue for an infringement, and can also work the patent himself and give licences to work it, and sue for royalties payable to him for its use; and it is now settled that even if he be a mortgagee of the other share, he is entitled to retain for his own benefit whatever profit he may derive from the working. although it is still, perhaps, open to question whether he is not liable to account for what he receives in respect of the licences" (*c*).

In *Mathers* v. *Green* (*c*), 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

(*a*) *Ante*, p. 270.
(*b*) 6th ed. p. 36.
(*c*) *Mathers* v. *Green* (1866), 1 Ch. 29; 35 L. J. Ch. 1; *Steers* v. *Rogers* (1893), App. Ca. 232; 62 L. J. Ch. 671; 10 R. P. C. 245. Contrast Copyright Law: *Powell* v. *Head* (1875), 12 Ch. Div. 686.

point has never been overruled, had decided that the co-patentee was so liable.

Steers v. *Rogers*.

In *Steers* v. *Rogers* (*d*) the decision was that where a patentee assigns to each of two persons a moiety of his patent rights, each assignee can work the patent without being liable to account to the other for profits; and none the less if one of the assignees be mortgagee of the other's moiety. Lord Herschell said, in the course of his speech: "I will for a moment deal with the case, as though the defendant had not been mortgagee at all, but had been only the owner of one-half of the patent right, the ownership of the other being vested absolutely in the plaintiff, the appellant. The appellant must establish that, where letters patent are thus vested in two assignees, if either of them makes use of the invention in his business, he is bound to account to the other for a share of the profits derived from the articles manufactured according to the invention. In the case of *Mather* v. *Green* (*e*) . . . it was held that 'Where a patent for an invention is granted to two or more persons in the usual form, each one may use the invention without the consent of the others; and if he so uses it is not bound to account to the others for any share of the profits which he makes by its use.' Lord Cranworth says: 'There is no principle, in the absence of contract, which can prevent any persons, not prohibited by statute, from using any invention whatever. Is there, then, any implied contract, where two or more persons jointly obtain letters patent, that no one of them shall use the invention without the consent of the others, or, if he does, that he shall use it for their joint benefit? I can discover no principle for such a doctrine . . .' The learned counsel for the appellant maintained, as he was entitled to do in your Lordship's House, that that decision was not good law; but it appears to me to be both good law and good sense when the nature of patent rights is regarded. What is the right which a patentee has or patentees have? It has been spoken of as though a patent right were a chattel, or analogous to a chattel. The truth is that letters patent do not give the patentee any

(*d*) (1893) App. Ca. 232; 62 L. J. Ch. 671; 10 R. P. C. 245. See also *Dunnicliffe* v. *Mallett* (1859), 29 L. J. C. P. 70; 7 C. B. N. S. 209; *Walton* v. *Lavater* (1860), 29 L. J. C. P. 275; 8 C. B. N. S. 162; *Sheehan* v. *G. E. Railway* (1880), 16 Ch. Div. 59; 50 L. J. Ch. 68; *Re Russell's Patent* (1857), 2 De G. & J. 130; *Hancock* v. *Bewley* (1860), Johns. 601; *Re Horsley and Knighton* (1869), 5 Eq. 475; 39 L. J. Ch. 157.

(*e*) (1866) 1 Ch. 29; 35 L. J. Ch. 1.

right to use the invention—they do not confer upon him a right to manufacture according to the invention. That is a right which he would have equally effectually if there were no letters patent at all. What the letters patent confer is the right to exclude others from manufacturing in a particular way, and using a particular invention. When that is borne in mind, it appears to me very clear that it would be impossible to hold, under these circumstances, that where there are several patentees, either of them, if he uses the patent, can be called upon by the others to pay to them a portion of the profits which he makes by that manufacture, because they are all of them entitled, or perhaps any one of them is entitled, to prevent the rest of the world from using it."

Co-owners must not prejudice the rights of each other.

But neither of two joint patentees is entitled to cause to be made in the Register any entry which purports to affect or prejudice the rights of the other; he may but sell his share, and create an interest *pro tanto* (*f*). Either may use the patent, but neither may dispose of the right of the other (*f*), nor can one co-owner release an infringer from liability to damages to the other co-owners (*g*). On the subject of apportionment of damages see *Dent* v. *Turpin* (*h*).

If the patent has been granted to more than one person, parol evidence that one or more of the nominal patentees has not an interest in the patent will not be admitted (*i*).

The inability of one of several joint patentees profitably to use the invention without the consent of his co-patentees who are 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 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 (*k*).

It seems that in all cases where the application is made by

(*f*) *Re Horsley and Knighton's Patent* (1869), 8 Eq. 475; 39 L. J. Ch. 157. As to right of survivorship in relation to an action of infringement, see *Smith* v. *L. & N. W. Railway* (1853), 2 E. & B. 69. And see *Walton* v. *Lavater* (1869), 8 L. J. C. P. 275; 8 C. B. N. S. 162.

(*g*) *Re Horsley and Knighton's Patent* (1869), 8 Eq. at p. 477.

(*h*) 30 L. J. Ch. 495; 2 J. & H. 139.

(*i*) *Mathers* v. *Green* (1866), 1 Ch. 29; 35 L. J. Ch. 1.

(*k*) *Mathers* v. *Green* (1866), 1 Ch. 29; 35 L. J. Ch. 1. And see *Steers* v. *Rogers* (1893), App. Ca. 232.

Agreement advisable.

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 (*l*).

Partnership and co-ownership.

If the arrangement between the co-owners amounts to a partnership, different considerations come into being. And it may be that co-ownership in a patent may be brought about by partnership. For instance, in *Kenny's Button-holing Co.* v. *Somerville* (*m*), 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.

(*l*) See Trans. Inst. P. A. vol. viii., a paper "On certain features of joint proprietorship in patents." C. M. Owen.

(*m*) (1878) 26 W. R. 787.

CHAPTER X.

ASSIGNMENTS AND LICENCES.*

As to the position of assignees and licensees in actions affecting letters patent see, generally, Chapter XIII., pp. 359 et seq.

As to compulsory licences see sect. 22 of the Act, p. 593, and Rules 60—66, p. 702.

As to registration see, generally, Chapter XI.

I. Assignments.

Power to Assign.

A patent is made assignable by the express terms of the grant in the form which is now always employed. This is Form D of the first schedule to the Act of 1883, the second recital of which states that the patentee, his executors, administrators and assigns, or any of them, are referred to in the form as "the said patentee," and in the operative part of the form the grant is made to "the said patentee . . . 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."

Grant is to patentee and his assigns.

It is provided by sect. 33 that this form *may* be followed, but it is submitted that in so far as matters of substance are concerned, an applicant who is entitled to a patent at all is entitled to have it followed as of right. In particular he appears to be entitled to a grant of an assignable interest in the patent. Other sections of the Act show that patents are treated, as in fact they invariably are, as being assignable. Thus sect. 87 provides for the registration of assignments generally, and sect. 36 makes assignments for particular places lawful (*a*).

(*a*) "All monopolies are illegal unless allowed by a patent, which cannot be assigned at all unless power to that effect is given by the Crown" (per Littledale, J.), in *Duvergier* v. *Fellows* (1830), 10 B. & C. 836. In the case cited there was a patent containing a proviso making it void upon assignment to or

* The whole of this chapter has been written by D. M. Kerly, Esq., Barrister-at-Law.

No right of property in an unpatented invention.

The inventor or his assignee has no right of property in the invention (*b*) other than that conferred by the patent, if there is any patent, or the right of applying for a grant, if there is none.

Disclosure of secret in breach of confidence.

He may, however, have a personal remedy by injunction (*c*), or an action for damages (*d*) against any person who has acquired a knowledge of his invention, while it remains a secret, under circumstances such that its disclosure would be a breach of confidence or of contract (*e*).

"Invention" usually assigned.

Notwithstanding that the assignment of an invention is equivalent to no more than the assignment of the benefit of any patent granted in respect of it, it is usual in all assignments of patents to include an express grant of the invention as well as of the patent (*f*). But the addition appears to be mere conveyancing verbiage.

Right to future patent may be assigned.

The beneficial interest in the right to apply for a patent can be assigned (*g*), but the application itself must be made in the name of the inventor or his personal representative, applying either alone or with other applicants (*h*). So the right to future patents may be assigned (*i*). Upon the assignment of a particular patent, it is very common to provide that the assignor shall assign any future patents he may acquire for improvements, or for analogous inventions, and such a provision is operative, and is not void as being either in restraint of trade or contrary to public policy (*k*). A covenant to assign a future patent when granted becomes operative as an actual assignment so soon as the grant of the patent is made to the covenantor (*l*).

Applications in fraud of the inventor.

The right of applying for a patent in respect of an invention is protected against applications in fraud of the "true and first

in trust for more than five persons. For some reason the Judges treated an assignment of the patent to a company of numerous persons as illegal. The practice of limiting the number of persons to whom a patent might be assigned was abandoned in 1852. And by sect. 36 of the Act of that year limiting provisions in grants of earlier date were rescinded.

(*b*) Hindmarch, 233.

(*c*) *Yovatt* v. *Winyard* (1820), 1 Jac. & W. 394; *Morison* v. *Moat* (1851), 9 Ha. 241, 10 Ha. 248.

(*d*) *Robb* v. *Green* (1895), 2 Q. B. 1, 315.

(*e*) *Smith* v. *Dickenson* (1804), 3 Bos. & P. 630, and see further the chapter on "Trade-Secret" in Kerly on Trade-marks.

(*f*) See Morris, p. 113.

(*g*) *Knowles* v. *Bovill* (1870), 22 L. T. N. S. 70.

(*h*) See the notes to sects. 4 and 5, *post*, pp. 550 *et seq.*

(*i*) *Parnell's Patent* (1888), 5 R. P. C. 126.

(*k*) *Printing and Numerical Registering Co.* v. *Sampson* (1875), L. R. 19 Eq. 462.

(*l*) *Cartwright* v. *Amatt* (1799), 2 Bos. & P. 43. See generally as to covenants to assign future property, *The Official Receiver* v. *Tailby*, 13 App. Ca. 523, and *Holroyd* v. *Marshall*, 10 H. L. C. 191.

inventor" by sect. 35 (*m*), and against the risk of the death of the inventor by sect. 34 (*n*), which enables the personal representative of any "person possessed of an invention" who dies without applying for a patent, to apply for and obtain the grant.

After his death.

Mortgages and assignments of the patent rights in undeveloped or unpatented inventions are very common, and by means of them inventors not infrequently obtain the means necessary to enable them to work out or complete, or to protect their inventions. It is usual, for the protection of the lender or purchaser who advances money upon the security of, or purchases an interest in an unpatented invention, to stipulate that he or his nominee shall be a co-patentee with the inventor, and shall join in the application for the patent. By sect. 5 of the Act of 1885 this practice is recognised and sanctioned. The section provides that "whereas doubts have arisen whether under the principal Act (*o*) 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."

Assignments of patent rights in undeveloped inventions.

Purchaser to be co-patentee.

The agreement under which the advance of money, or the purchase is made, should provide that the inventor shall proceed with and perfect the invention, apply for or concur in applying for a patent, and do all things requisite in order to obtain the grant of a valid patent to himself and the agreed co-patentees. Terms providing for keeping the invention a secret until the provisional specification is filed, for the payment of fees on the application, the employment of a patent agent, and for the working and enjoyment of the patent rights, when the patent is granted, and in particular for the granting of licences and an account and division of profits, will also be usually inserted in the agreement (*p*).

Suggestions as to the contents of agreement for an interest in future patent.

An agreement to assign an interest in a patent, although made before the patent itself is granted, may probably be properly entered upon the Register so soon as the patent has come into existence (*q*).

Registration of the agreement.

(*m*) *Post*, p. 629.
(*n*) *Post*, p. 629.
(*o*) Sect. 4 of the Act of 1883.
(*p*) A form of agreement is given in Davidson's Precedents, vol. ii. pt. 1, p. 19, which, though of earlier date than the present Acts, may usefully be consulted. Modern forms and clauses will be found in Morris, pp. 59—66. See further "contents of agreement," *post*, p. 290, and "contents of assignment," *post*, p. 294.
(*q*) *Parnell's Patent* (1888), 5 R. P. C. 126.

What may be assigned.

The patent grants to the patentee the sole privilege by himself, his agents, or licensees, to make, use, exercise and vend the invention. The patentee accordingly can assign his privilege wholly or in part, or grant licences under it. An exclusive licence is of the nature of an assignment of the privilege.

The discussion of licences both exclusive and non-exclusive is postponed to the second division of this chapter (*r*).

The assignment of future patents has already been discussed (*s*).

Mortgage.

The patent may be assigned absolutely, or by way of mortgage (*t*), and any part or interest in it may be assigned. Thus an undivided share (*u*), or the whole patent right so far as regards a particular place, or a particular part of the invention (*x*) may be assigned separately.

Assignment of a share.

As to the position of co-owners of a patent, see p. 277, *ante* (*y*).

Assignment for a district.

The assignment of a patent for a particular place is authorised by sect. 36, which provides 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."

Exclusive licence for a district.

Such an assignment is more beneficial to the assignee than an exclusive licence for the district, inasmuch as goods manufactured or sold outside the district, whether under licence from the patentee posterior in date to the assignment, or manufactured or sold without such licence, cannot be sold within the district without infringing the patent (*z*). And the assignee can sue

(*r*) *Post*, p. 300.

(*s*) *Ante*, p. 282.

(*t*) *Steers* v. *Rogers* (1892), 2 Ch. 13; (1893), A. C. 232; 62 L. J. Ch. 671, is an instance. There the owner of one moiety assigned it to the owner of the other. The assignment was shown to be by way of mortgage only, but the mortgagee was held to be not liable to account for the profits of working because as owner of a moiety he was entitled to work the patent without accounting.

(*u*) This was settled by *Walton* v. *Lavater* (1860), 29 L. J. C. P. 275; 8 C. B. N. S. 162, where it was unsuccessfully argued that the franchise granted by the patent was indivisible. In the earlier case of *Dunnicliff* v. *Mallett* (1859), 7 C. B. N. S. 209, it had already been held that the assignee of a separate invention comprised in the patent was not a mere licensee, and could sue alone for infringement.

(*x*) See *Dunnicliff* v. *Mallett*, last note. The patent now comprises one invention only, sees ect. 33.

(*y*) The chief point to be noted is that each co-owner can work the patent without accounting for profits, in the absence of any agreement to the contrary, the effect of the patent being merely to prevent those who are not owners or licensees from working it: *Steers* v. *Rogers* (1892), 2 Ch. 13; (1893), A. C. 232, approving *Mathers* v. *Green* (1865), 1 Ch. 29.

(*z*) In *Betts* v. *Willmott* (1871), 6 Ch. 239, the owner of an English patent

for infringement in his own name. If an exclusive licence only were granted for the district, in order to protect the licensee, it would be necessary for the patentee to covenant not to sell goods manufactured *according to the patent except under condition* that they should not be used or resold within the district (*a*). For if the patentee merely covenants not to sell the goods for use or resale in the district, the purchaser will be restrained from using or reselling the goods in contravention of this covenant only if he has notice of the covenant when he buys (*b*). The reason of this distinction is that in the absence of any agreement or stipulation to the contrary at the time of the sale, or notice that the vendor has no right in equity to sell the goods without restriction, the sale of goods manufactured under a patent by any one who has power to grant such a licence, confers a licence to use or resell them anywhere notwithstanding the patent (*c*). In the same way a licence to make the goods implies a licence to the licensee and purchasers from him to use or resell them (*d*).

Sale of patented goods, or licence to make them, imports licence to use or resell.

An equitable interest in the patent or any part of it may be created by an assurance or agreement, which does not operate to make the person entitled an "assign" within the meaning of the recital *in the patent, so as to enable him to sue in his* own name for infringement, without joining the patentee or his assigns. An assignment of future patent rights, or of an interest in the profits of working a patent, are instances in which the subject of the transaction is not capable of being assigned at law. More often an assignment is an equitable assignment only because it is not made by deed (*f*).

Equitable assignments.

Any agreement, whether verbal or by writing, to transfer an interest in a patent is sufficient to constitute an equitable assign-

filed in an action for infringement because he could not prove that the articles sold by the *defendant had not* been manufactured and sold in France under a patent which also belonged to the plaintiff. Lord Hatherley distinguished the case of an assignment of the English patent to a third person, and the subsequent importation of goods manufactured under the French patent. "No doubt the importer would be required, because the licence to sell, which belonged originally to the patentee, would then be vested in the assignee; and therefore no licence in England given by the original patentee after he had sold the patent could authorise the use of the article so as to defeat the *right of the assignees in England.*"

(*a*) Such a condition might be made binding upon the purchaser: *Incandescent Light Co., Ltd.* v. *Cantelo* (1895), *12 R. P. C. 262.*

(*b*) See last case, *Heap* v. *Hartley* (1889), 42 C. D. 461; *Société des Glaces* v. *Tilghman's Co.* (1883), 25 C. D. 1. As to binding an assignee by the covenants of his assignor of which he has notice, see *post*, p. 300.

(*c*) See cases last cited.

(*d*) *Thomas* v. *Hunt* (1864), 7 C. B. N. S. 183.

(*f*) *Bond* v. *Rosling* (1861), 1 B. & S. 371; *Parker* v. *Taswell* (1858), 2 De G. & J. 559; *Tidey* v. *Mollett* (1864), 33 L. J. C. P. 235.

ment provided that the intention of the parties to give and receive a definite interest is clear (*h*). And it is sufficient to confer a good title against all persons having a conflicting legal title who had notice of it before acquiring their respective legal titles (*i*). Questions of title between claimants under inconsistent equitable assignments are determined according to the ordinary rules governing such assignments (*j*).

Registration of equitable assignments.

The question as to what amounts to an equitable assignment of an interest in a patent has been several times raised in connection with the right of the person benefited to have an agreement affecting patent rights entered upon the register under sect. 87 (*k*). It has been decided that a document which is put forward as an equitable assignment must show a concluded agreement (*l*) intended to pass a definite interest in the patent (*m*), and capable of specific performance at the time when it is relied on as an assignment (*n*).

Advantages of getting in the legal interest.

The position of an equitable assignee is less beneficial than that of a legal assignee not only because of the possible risk of an assignment of the legal interest in the patent to a purchaser without notice, but also because the equitable assignee cannot sue for infringement in his own name without joining the legal owner as a party.

Action for threats.

It follows from this that he has no defence to an action for threats under sect. 32 (*o*).

Title.

Executors and administrators.

The patent passes to the executors and administrators of the patentee or his assignee (*p*). And the executor is entitled to

(*h*) *E.g.*, a letter agreeing to give the person addressed one-third in consideration of his services in working the patent: *Stewart* v. *Casey* (1891), 9 R. P. C. 9.

(*i*) Thus in *Morey's Patent* (1858), 25 Beav. 581, a patentee made an equitable assignment of a moiety to one, and afterwards assigned the patent to another. The subsequent assignee registered his assignment first, but he was held to have had constructive notice of, and to be bound by, the earlier assignment.

(*j*) See the notes to *Ryall* v. *Rowles*, 2 W. & T. L. C.

(*k*) *Post*, p. 642, and see Chap. XI. on the Register.

(*l*) *Fletcher's Patent* (1893), 10 R. P. C. 252. An agreement for an exclusive licence at a royalty "to be mutually agreed" was held not to be capable of registration, it being in dispute whether the royalty had ever been agreed.

(*m*) *Parnell's Patent* (1889), 5 R. P. C. 126.

(*n*) In *Haslett* v. *Hutchinson* (1891), 8 R. P. C. 457, the patentee had agreed to give a company promoter an interest in the proceeds of an intended sale to a company. The agreement had been varied, and so could not be specifically performed as it stood, and it was held that it ought not to be registered as an assignment. Cf. *Swain* v. *Ayres*, 21 Q. B. D. 289 (an agreement for a lease), and see *Lewin* v. *Brown* (1866), 14 W. R. 640.

(*o*) *Kensington Electric Lighting Co.* v. *Lane-Fox Co.* (1891), 2 Ch. 573.

(*p*) See form of grant, *post*, p. 667.

register the probate, but can assign before doing so (*q*). It passes also to the trustee in bankruptcy of the patentee or other person entitled (*r*). Lord Eldon appears to have thought that where a patentee, after having mortgaged the patent, "continued in the notorious use of the invention," it passed to his assignees in bankruptcy (*s*), but a patent would not appear under any circumstances to come within the reputed ownership clause of the present Bankruptcy Act (*t*).

Bankruptcy.

Reputed ownership.

A co-owner of a patent can assign his share so as to entitle the assignee to work the invention without accounting (*u*), to give licence to work it, and to sue for infringement (*x*), or to recover royalties (*y*).

Co-owner.

If any agreement for the joint working of the patent has been made between the co-owners which constitutes a partnership (*z*) between them, the assignment of one co-owner's interest in the patent may amount to an assignment of his interest in the partnership. In such case the assignee becomes entitled only to the share of the profits to which his assignor would but for the assignment have been entitled, and is not, during the continuance of the partnership, entitled to interfere in the management or administration of the partnership business, or to require accounts of the partnership transactions, or to inspect the books (*a*). The other co-owners may treat the assignment as a cause of dissolution of the partnership (*b*).

Partnership.

In the absence of notice (*c*) of any conflicting equity, a purchaser from the grantee of a patent, his executors, administrators, or assigns, will obtain a good title to the patent or the interest in it which purports to be assigned to him, subject to any other assignment made by the registered proprietor for the time being to another purchaser without notice of his right.

Equitable assignment without notice.

(*q*) *Elwood* v. *Christie* (1864), 17 C. B. N. S. 754.

(*r*) *Hesse* v. *Stevenson* (1803), 3 Bos. & P. 565, where Lord Alvanley said that the interest in an unpatented invention would not pass. It was held in *Bloxam* v. *Elsee* (1826), 6 B. & C. 169, and *MacAlpine* v. *Mangnall* (1846), 15 L. J. C. P. 298, that a patent was not avoided under the old law because it became vested in more than twelve persons by reason only of a bankruptcy or an assignment for creditors.

(*s*) *Ex parte Granger* (1812), Godson on Patents, 2nd edit. p. 225.

(*t*) Sect. 44 (3) of the Bankruptcy Act, 1883.

(*u*) *Steers* v. *Rogers* (1893), A. C. 232.

(*x*) *Anderson* v. *Patent Oxonite Co.* (1886), 3 R. P. C. 279; *Sheehan* v. *G. E. Ry. Co.* (1880), 16 C. D. 59, approving the passage in Lindley on Partnership, 6th edit. p. 36.

(*y*) *Bergmann* v. *Macmillan* (1881), 17 C. D. 423.

(*z*) See p. 280.

(*a*) Partnership Act, 1890, sect. 31.

(*b*) Lindley on Partnership, 6th edit. p. 575.

(*c*) As to this, see below, pp. 288, 300.

Power of the registered proprietor to assign.

The Act provides that the person for the time being entered in the register as proprietor of a patent shall (subject to the provisions of the Act (*d*) and to any rights appearing from the register to be vested in any other person) have power absolutely to assign, grant licences as to, or otherwise deal with the patent, and give effectual receipts for any consideration for such assignment, licence, or dealing, provided that any equities in respect of such patent may be enforced in like manner as in respect of any other personal property (*e*).

Notice of *prior equity.*

The effect of this section appears to be to make the registration of any dealing with his interest by a registered proprietor, so far as regards a subsequent purchaser from him, equivalent to notice of the dealing, inasmuch as the power of the registered proprietor is expressly limited by the rights appearing on the register (*f*).

Notice of a dealing with the patent is generally notice of the actual dealing (*g*). Thus where an assignment recited that the assignor had granted a licence, and what he had granted was, in fact, an assignment, it was held that the subsequent assignee had notice of and was bound by the earlier assignment (*h*).

The unexplained absence of the grant from the patentee's possession at the time when he purported to make an assignment would probably be held to be notice that he had assigned it to some other person (*i*).

Investigation of title.

Upon the purchase of an interest in a patent, therefore, the actual letters patent should be inquired for, and all documents entered on the register in respect of it should be perused. If the assignor or his predecessors are known to have entered into any arrangements for working the patent, these should be investigated: and if the assignor is a part owner only, inquiry should be made

(*d*) This exception appears to relate only to trade-marks, which by sect. 70 are assignable only together with the goodwill. It is submitted that it cannot be construed to refer to sect. 85, so as to exclude from the "rights" mentioned immediately afterwards, rights arising under trusts (of which the assignee has notice) which by sect. 85 ought not to be entered upon the register.

(*e*) Sect. 87.

(*f*) A public register relating to land is not, unless so made by statute, notice of anything appearing therein unless a search is in fact made. See *Kettlewell* v. *Watson* (1884), 26 C. D. 501, and the cases there cited.

(*g*) See the notes to *Le Nere* v. *Le Nere* in 2 W. & T. L. C. The Court of Appeal has recently declared in the case of shipping documents that the doctrine of constructive notice has no application to mercantile transactions: *Manchester Trust* v. *Furness* (1895), 2 Q. B. 539.

(*h*) *Morey's Patent* (1858), 25 Beav. 581.

(*i*) See *Farrand* v. *Yorkshire Banking Co.* (1888), 40 C. D. 182, and the cases (relating to real estate) there cited; but see also the last note but one.

of the other co-owners as to what interest they claim in the patent. If licences have been granted, the counterpart licences should be examined.

Form of Assignment.

By deed.

The legal interest in a patent can only be conveyed by a deed (*k*), for it can only be created by deed (*l*), and therefore can only be assigned by deed (*m*). But an assignment not under seal purporting to pass the patent right is effective to pass the immediate equitable interest in it if made for consideration (*n*), and is properly registered as a document affecting the proprietorship of the letters patent (*o*).

Even at the common law, an assignment not under seal for which the consideration had passed would not have been wholly void. It would, subject to any question as to revocation, at the least have amounted to a licence to work and vend the invention. Thus in *Chanter* v. *Dewhurst* (*p*) an action to recover the price paid for a licence which had been granted by writing only failed, and the Court expressed an opinion that the licence was not void.

Assigment by an agent.

Since the legal interest in the patent can only be assigned by deed, it follows that it can only be assigned by an agent if he is authorised by deed to assign it (*q*).

Future patent rights.

Assignments of future patents are discussed elsewhere (*r*).

Agreement to assign.

Before the assignment is executed an agreement to assign is very commonly entered into, and this course is generally adopted either because the patent has not yet been granted, or because it is intended that the purchaser shall have an opportunity of testing the validity of the patent or the value of the invention. Sometimes the object of the agreement is to provide funds for

(*k*) *Re Casey's Patents* (1892), 1 Ch. 104; *Power* v. *Walker* (1814), 3 M. & S. 7 (a copyright case).

(*l*) Co. Litt. 9 b, 172 a; Shep. Touch. 224–231.

(*m*) *Lincoln College case*, 3 Co. Rep. 61 a.

(*n*) This is material, because the question of the equitable assignment depends upon its being, or being evidence of, an agreement to assign which is capable of specific performance. See as to equitable interests in patents *ante*, p. 286.

(*o*) *Re Casey's Patents* (1892), 1 Ch. 104, where the assignment was a letter: "In consideration of your services, . . . we hereby agree to give you one-third share of the patents, the same to take effect from this date."

(*p*) (1844) 13 L. J. Ex. 198; 12 M. & W. 823.

(*q*) *Hazlehurst* v. *Rylands* (1891), 9 R. P. C. at p. 7.

(*r*) *Post*, p. 295; *ante*, p. 282.

developing and completing the invention or for preparing the specification and taking the steps preliminary to the grant of the patent (*s*).

Suggestions as to contents of the agreement.

The chief matters to be considered in preparing an agreement are, *first*, what is to be assigned and what covenants the assignment is to contain, and, *secondly*, whether, in the event of the patent proving to be invalid before the assignment is completed, the consideration is to be paid to or retained by the vendor.

Application for patent.

If the patent has not been granted, it is, of course, material to stipulate that the inventor shall proceed to take all steps necessary to ensure the grant of a valid patent; if the invention

Completion of invention.

is not completed, the inventor should undertake to complete it. Sometimes the making of models or of practical tests or experiments is provided for.

Foreign patents.

If foreign patents are to be applied for, the inventor should give a power of attorney to the purchaser to apply for the grant in his name in the countries where the patents are to be taken out. This is sometimes done with reference to the English patent also, although, as specific performance of the agreement to apply can be obtained, it does not appear to be necessary.

The purchaser frequently stipulates that he shall be a co-patentee with the inventor (*t*).

Patent agent.

Fees.

Sometimes the employment of a particular patent agent is stipulated for, and the payments for fees and for the work to be done in obtaining the patent are arranged to be made to him direct.

Form of specification.

It should be provided that, if any question arises between the vendor and purchaser upon the form of the provisional or of the complete specification, it should be settled by reference to the opinion of an expert or in such other manner as is determined upon.

Arbitration.

A general arbitration clause is often adopted.

Disclosure of invention.

If the invention has not been disclosed to the purchaser, the vendor should undertake to make a full disclosure and to give all necessary information and assistance to the purchaser and his advisers in order to enable him and them to understand the invention and to prepare, or to be advised upon, the necessary documents for obtaining the patent.

Purchaser to keep invention secret.

And the purchaser should agree to keep the matters disclosed secret until the grant of the patent, and if the sale should fall

(*s*) See "Agreement for an Interest in a Future Patent," *ante*, p. 282.

(*t*) See *ante*, p. 270.

through without any patent being granted, then to keep them secret altogether, and not to work or to attempt to work the invention after the determination or rescission of the agreement.

The terms of the proposed assignment should be definitely determined by the agreement. Suggestions are made below as to the matters which these should deal with (*u*).

No warranty of validity implied.

The payment of the price for the sale of a patent is not dependent upon the validity of the patent or upon its value unless the agreement makes it so, for the contract will be construed, in the absence of any term, express or implied, to the contrary, to be for the sale of the patent as it is (*x*). Of course, the price may be recovered or payment resisted on the ground of fraud (*y*).

Where, therefore, an agreement provided that the purchasers should take out the foreign patents for an invention already patented by the vendor in England, and that the vendor should sell to them one-half of the foreign patents when obtained and one-half of the English patent, and that the purchasers should pay the vendor 2,500*l.* "in such manner as shall be mutually agreed upon," and also a royalty, a plea to an action for the 2,500*l.* that the invention was not new in England and was worthless, and that the vendor was not the first inventor, was held to be bad (*z*). In *Hall* v. *Conder*, just cited, the case of an agreement to sell the *exclusive use* of an invention for which, it turned out, no valid patent could be obtained, was distinguished (*a*). In such a case, as the vendor would have agreed to sell what he could not transfer, he could not recover the price.

Action for price where patent invalid.

Agreement to be rescinded if the purchaser dissatisfied as to validity.

If the price is not to be paid should the patent turn out to be invalid, the purchaser will probably be unwilling to be put to the necessity of contesting the validity of the patent if he is advised, or if the Court, in an action to which he and the vendor are not parties, determines that it is invalid. If it is intended that his opinion or that of his advisers is to be conclusive, this must be clearly stated, as the contrary will be presumed. Thus in *Hazlehurst* v. *Rylands* (*b*) the purchaser had agreed to pay

(*u*) "Contents of Assignment," *post*, p. 294. See also "Contents of Licence," *post*, p. 301.

(*x*) Per Willes, J., in *Smith* v. *Scott* (1859), 28 L. J. C. P. 325; 6 C. B. N. S. 771; *Liardet* v. *Hammond Electric Light Co.* (1883), W. N. 96; 31 W. R. 710.

(*y*) *Lovell* v. *Hicks*, 2 Y. & C. 46, 472; 6 L. J. Ex. 85.

(*z*) *Hall* v. *Conder* (1857), 26 L. J. C. P. 138, aff. 288; 2 C. B. N. S. 22; *Smith* v. *Neale* (1857), 26 L. J. C. P. 143; 2 C. B. N. S. 67.

(*a*) Citing *Chanter* v. *Leese*, where in such a case a plea of invalidity was held to be good: 4 M. & W. 295; 5 M. & W. 698.

(*b*) (1890) 9 R. P. C. 1.

the balance of the price immediately he should have satisfied himself that the patents were valid and of full force and effectual in law. In an action for the balance he pleaded that he had satisfied himself that the patents were invalid. The Court of Appeal, however, held that the question was not whether he was satisfied, but whether the patents were in fact invalid, and particulars of objections to validity were ordered to be delivered.

Where one of several patents lapsed.

At the trial it appeared that one of the patents had lapsed for non-payment of fees, and Fry, L. J., dismissed the action on that ground, and also on the ground that the same patent had been anticipated.

The agreement should accordingly clearly determine who is to take the risk of the patent being invalid (*c*), and how its invalidity is, for the purposes of the agreement, to be ascertained.

Agreement to determine if patent declared invalid.

A common term with regard to this matter is that if at any time the patent should be held by any court in Great Britain or Ireland to be invalid any part of the price then unpaid should cease to be payable, and the agreement should be annulled, but that neither party to it should have any claim against the other in respect of anything done under the agreement, before the judgment of the Court, and that if the judgment should be reversed upon appeal, otherwise than by consent, so far as it declared the patent invalid, then the right to payment and the agreement should revive as if they had never ceased or been annulled.

Option for purchaser to rescind agreement.

A clause is sometimes adopted allowing the purchaser to determine the agreement and all future payments at his option at any time.

Sale to a limited company.

In recent years agreements for the sale of patents to companies formed for the purpose of buying them and working the inventions have become very common. They present some special features (*d*), on the one hand arising from the fact that the patentee's rights are necessarily of uncertain value, owing to the practical impossibility of estimating the risk of anticipation, and on the other to the necessity the patentee is under of promptly disposing of the patent or of bringing it into use without delay, and of stopping infringements, if he is to reap any benefit from

(*c*) *King* v. *Oliver* (1884), 1 R. P. C. 23, 42, is an example of an assignment contingent upon the payments of fees being kept up.

(*d*) For ordinary forms of agreement with intending companies see Palmer's Company Precedents.

his invention before the term of the patent expires. It appears to be a fair arrangement that he should share the risk of the patent proving of small or no value by taking part of his purchase-money in shares or debentures. But if this is done, as he retains through the company an interest in the patent, it is material for the patentee to make certain that his property shall not pass away from him unless the company obtains sufficient capital to work the invention and to protect the patent against infringers. These ends are usually sought to be attained by a term making the agreement void unless an agreed number of shares are applied for and allotted (*e*), and the payments due upon application for them received by the company within a fixed time

Assignment to a promoting syndicate.

In some cases the agreement is made with, or the patent is assigned to, a small company or syndicate in the first instance, who provide the funds for developing the invention and taking out the patent or for starting and advertising the business intended to be carried on (*f*). If this plan is adopted, the agreement or assignment should determine what is to happen to the patent right if the syndicate fails to bring out the intended company successfully.

Inventor to enter into the company's employment.

The patentee's agreement with the company frequently stipulates that he shall enter into the service of the company, shall not engage in any rival business, and shall communicate all further inventions. An elaborate example of such an agreement came before the Court in *Nordenfelt* v. *The Maxim Gun Co.* (*g*).

Body corporate may be registered.

A body corporate may be registered as the proprietor of a patent in its corporate name (*h*).

Time of the essence of the contract.

Where an agreement for the assignment of a patent stipulates for steps to be taken within fixed times, it should be clearly stated whether or not time is to be of the essence of the contract (*i*).

Stamp.

The agreement should be stamped with an *ad valorem* duty stamp (*k*).

(*e*) Since the underwriting of shares has become very common, such a provision is little more than a security that the sums due on application for the stipulated number of shares shall be received by the company.

(*f*) An example of a promoting agreement is given in the report of *Haslett* v. *Hutchinson*, 8 R. P. C. 457.

(*g*) (1893) 1 Ch. 630; (1894) A. C. 535. Some of the covenants are set out from the report below (p. 296).

(*h*) P. R. 1883, r. 70.

(*i*) This may be implied by the nature of the agreement. Thus where the object was to enable the patentee to take steps which had to be taken within a limited time the times for making certain payments were held to be of the essence: *Payne* v. *Banner* (1843), 15 L. J. Ch. 227.

(*k*) Stamp Act, 1891, sect. 59: cf. *Smelting Co. of Australia* v. *Commissioners of Inland Revenue* (1896), 2 Q. B. 179.

Registration. The agreement may be registered if it is capable of specific performance and passes a definite interest in the patent (*l*).

Contents of Assignments.

Suggestions as to contents of assignments. The principal matters to be considered in determining what shall be comprised in an assignment are—(1) the assignor's title (unless he is the patentee himself); (2) the validity of the patent; (3) foreign patents, improvements, and extensions; (4) the consideration; (5) payment of fees; (6) legal proceedings against infringers; (7) the grant of licences; (8) conditions as to working; (9) use of trade or other marks on the goods manufactured; (10) keeping books and rendering accounts; (11) applications for amendment or disclaimer; and (12) the relation of the parties to each other when the patent or the interest of either party in it shall have determined (*m*). If the assignment is an absolute transfer of all the assignor's interest in the patent, the first four only of these matters will usually be material.

Title. 1. As to the investigation of title see p. 286, above.

Covenants for title. The assignor usually enters into the common vendor's covenants implied by a conveyance as beneficial owner, that is to say covenants (*n*) for right to convey, quiet enjoyment, and freedom from incumbrances—all limited to the acts of the assignor and persons through whom he claims otherwise than by purchase for value—and a covenant for further assurance.

Recitals. The grant of the patent and the chain of assignments to the assignor, as well as any dealings with the patent to which the grant in the assignment is made subject, are usually recited.

Validity. 2. The assignment does not of itself constitute or imply any warranty of validity (*o*), but it estops the assignor from derogating from his grant by himself disputing the validity of the patent (*p*).

Assignor cannot dispute it.

Recitals as to validity. Sometimes there are recitals that the patentee is the true and first inventor, and that the invention is useful. These recitals

(*l*) See pp. 285, 313.

(*m*) See further "Agreement to assign," *ante*, p. 289, and "Licences," *post*, p. 300.

(*n*) Conveyancing Act, 1881, sect. 7 (1 A). It has been suggested that these covenants would not be implied in a *licence* or any other deed which is not a "conveyance" by the use of the words "beneficial owner": Key & Elphinstone, 4th edit. vol. ii. p. 375. But it is submitted that this is not so, since the intention of the parties would be clear, and, moreover, conveyance in the Conveyancing Act includes "any dealing with any property": sect. 2 (1) (v.). In *Guyot* v. *Thompson* (1894), 3 Ch. at p. 398, however, Lindley, L. J., expressed an opinion that a licence is not a "conveyance" within the meaning of the Act.

(*o*) *Ante*, p. 291.

(*p*) *Oldham* v. *Longmead* (1789), 3 T. R. 439, 441.

would operate to estop the grantor from disputing the facts, if it were otherwise open to him to do so. If the grantee executes the deed, they estop him also (*q*), unless they are framed as statements that the grantor has represented that the facts are as recited (*r*). The recitals appear to be of no value.

Warranty by assignor.

If it is intended that the assignor shall warrant the validity of the patent either absolutely or in any respect, an express covenant must be inserted. Such a warranty is unusual, except in mortgages.

Instalment or royalties to cease if patent invalid.

Provision, however, is commonly made for the determination of liability in respect of any unpaid part of the consideration, for instance for the non-payment of future instalments, the cessation of royalties, and the discharge of obligations as to working, &c., if the patent is judicially declared to be invalid, unless and until the judgment is reversed on appeal upon the point (*s*).

Foreign patents.

3. If the assignment comprises any foreign patents or the right to apply for such, it may be proper to introduce covenants as to taking the necessary steps and as to the payment of the necessary fees to obtain the patents, and a power of attorney to make any proper application in the name of the inventor. A covenant to keep foreign patents on foot is not now necessary for the protection of the English patent (*t*).

To communicate improvements

and to assign future patent.

The assignor, if he is the inventor, usually covenants to communicate to the assignee all improvements of the invention within his knowledge or afterwards discovered by him as soon as possible, and to take or concur in taking all necessary steps for the protection of the further inventions by letters patent, and for the vesting of the patents in the assignees (*u*). The value of such a covenant to the proprietor of the patent is obvious, since not only are improvements, which the inventor is the most likely person to discover, likely to add to the value of the original invention and possibly to enable the proprietor to effectively extend the term of his monopoly by bringing them into use, but in other hands they may lead to serious questions whether a

(*q*) *Bowman* v. *Taylor*, 4 Nev. & Man. 264; *Doe* v. *Shelton* (1835), 4 L. J. (N. S.) K. B. 167; 3 A. & E. 265.

(*r*) Morris, p. 112. And see *post*, p. 376 *et seq.*

(*s*) See *ante*, p. 299. A reversal by consent, unless it is otherwise agreed, avoids the effect of the judgment: *Cheetham* v. *Nuthall* (1893), 10 R. P. C. 321.

(*t*) By American law a patent for an invention previously patented abroad still expires with the foreign patent. See *Muirhead* v. *Commercial Cable Co.* (1894), 11 R. P. C. 317; 12 R. P. C. 39.

(*u*) See "Future Patents," *ante*, p. 283.

similar and possibly more useful "manufacture" is an infringement or not.

Inventions of a like nature.

In order to extend the protection as far as possible and to avoid questions as to what is an "improvement," and what a new and independent invention, the covenant is sometimes extended to inventions and discoveries for "manufactures" which are similar, or which are useful in the business for which the invention covered by the patent is designed, or manufactures of a like nature (*x*) to that which is the subject of the patent.

For an example of a carefully settled deed of assignment the report of the *Maxim Nordenfelt Co.* v. *Nordenfelt* may be referred to (*y*). There a business was assigned as well as certain patents, and Mr. Nordenfelt, the inventor, was appointed a managing director of the purchasing company. He entered into a covenant not to trade, and also into the following covenant:—

Example of covenant by inventor

"That, so long as the company or any successor to or assignee of the business of the company shall continue to carry on the business of the company, the company or such successor or assignee shall be entitled to the full and exclusive benefit of

to convey future patents,

all new inventions or improvements now made or discovered or that may hereafter be made or discovered by him in connection with guns, gun mountings, or carriages, gunpowder, explosives, or ammunition, and with that object that he will with all con-

to communicate particulars

venient speed communicate to the company particulars of any such new invention or improvement made or discovered by him and will give to the company full information and details thereof,

and mode of working,

with all models, plans, drawings and designs as to the exact mode of working and using the same, and from time to time, at the expense in all things of the company, will execute and do all such documents and things as may be requisite for the purpose

to enable assignee to take out patents,

of enabling the company to obtain in its name or in the name of any nominee any British, colonial, or foreign patent for such inventions and improvements, and will from time to time and at

to give advice and assistance.

all times give all such advice, explanations, and instructions to the company and its employés as may be necessary to enable them effectually to exercise and work such inventions and

(*x*) *E.g.*, see *Printing and Numerical Registering Co.* v. *Sampson* (1875), 19 Eq. 462; *Bewley* v. *Hancock* (1856), 6 De G. M. & G. 391.

(*y*) (1893) 1 Ch. 630.

improvements." And it was further provided that the term "patent" in this agreement should mean and include *brevets d'invention* or any other form of protection for invention or design that can be obtained in the United Kingdom or any British colony or dependency, or in any foreign country.

Unless the covenant is relied upon only to prevent the patentee working further inventions himself or communicating them to trade rivals, some consideration for the assignment of future discoveries should be agreed to be paid as a stimulus to his invention. This is sometimes done by framing the covenant so as to require the inventor to give notice of the discovery, and thereupon to provide that the assignee shall have an option to purchase it at a price to be fixed by arbitration.

Consideration for further discoveries.

Assignee to have option to purchase.

In the absence of an express covenant, the assignor cannot be restrained from assisting a trade rival or an infringer who is seeking to upset the patent or from giving information to enable any person to do so (*z*). Probably he could not by any means be restrained from giving evidence against the owner of the patent if subpœnaed to do so in an action (*z*).

Inventor not to give information to other persons.

He cannot be restrained from giving evidence against patent.

It should be clearly indicated whether or not the covenant is limited to the period of the existence of the patent.

The proprietor of the patent for the time being is the person entitled to apply for a prolongation, but the application is not at all likely to be successful unless the inventor concurs and is to obtain a benefit from it.

Prolongation

4. As to the return of the consideration in the event of the patent being declared invalid, and the non-payment of so much of it as remains unpaid, see above, pp. 291 and 292.

Return of price of patent invalid.

5. There is no obligation, apart from agreement, binding the assignee of the patent to pay the fees necessary to keep the patent alive (*a*).

No obligation to pay fees.

6. The terms providing for the protection of a patent in which the several parties to the assignment retain an interest by legal proceedings, and determining who is to take, direct, and control

Taking proceedings to restrain infringements.

(*z*) *London and Leicester Hosiery Co.* v. *Griswold* (1886), 3 R. P. C. 251. The plaintiffs covenanted to communicate improvements to the plaintiffs and to render them available for the plaintiffs' benefit. A motion for an interlocutory injunction to restrain him from communicating any like invention to certain persons or assisting them as a scientific witness in a patent action against the plaintiffs failed. A licensee cannot be compelled to give inspection in an action against his licensor: *Germ Milling Co.* v. *Robinson* (1886), 3 R. P. C. p. 14.

(*a*) *Re Railway and Electric Appliances Co.* (1888), 38 C. D. 597.

the proceedings, and who is to pay the cost, are very important, and should be carefully considered and framed (*b*).

An assignee of the legal interest can take such proceedings in his own name (*c*). If it is intended that any other party interested (*d*) should have power to sue infringers or to recover royalties from licensees, a covenant by the owner of the legal interest to allow him to use the latter's name upon an indemnity against costs, or a power of attorney subject to the like indemnity will be proper and necessary.

Licences.

7. If provision is made for the grant of licences, it is useful to attach an agreed form of licence to the deed.

Working agreements with co-owner.

8. Conditions as to working are important where a share in a patent is assigned, for in such case, apart from agreement, each co-owner can work for his own benefit. They are also material when any party interested is to be paid by a share of profits or by royalties. In the latter case a minimum rent is sometimes stipulated for (*e*).

No obligation on assignee to work.

Apart from agreements to the contrary, the sale of a patent for a royalty imports no obligation to work the invention (*f*).

Agreement may constitute a partnership.

Working agreements between co-owners cannot (probably) be so constructed as not to constitute a partnership between them (*g*).

Covenants to push the invention; to manufacture according to specification; to use trade-marks and labels.

Covenants to use the best endeavours of the covenantor to develop and extend the business in the patented "manufacture" are sometimes inserted (*h*).

As to covenants to manufacture exclusively according to the specification, see *post*, p. 305.

9. The use of a trade-mark or trade name in connection with patented goods is often important as an advertisement of the patent, and also because it may operate in practice to extend the monopoly of the persons who are manufacturing under the patent beyond the date of its expiration. The name under which goods manufactured or sold by one trader in the market exclusively are sold during the existence of the patent right is

(*b*) See below, "Licences," p. 300.

(*c*) See *post*, p. 361.

(*d*) As to the position of an equitable assignee, see *ante*, p. 285.

(*e*) As to the stamp in such case, see the end of this chapter.

(*f*) Cf. "Payment of Fees," *ante*, p. 297, and cases there cited.

(*g*) See Lindley on Partnership, 5th edit. p. 38 *et seq.*; Partnership Act, 1890, sects. 2 and 46; *Badeley* v. *Consolidated Bank* (1888), 38 C. D. 238, and the cases there cited; *Davis* v. *Davis* (1894), 1 Ch. 393. As to agreements for licences see *Ridgway* v. *Philip* (1834), 1 C. M. R. 415.

(*h*) *E.g.*, *Wilson* v. *Barbour* (1888), 5 R. P. C. 245, where the defendants, who had invented what they claimed to be an independent invention to serve the purpose of the patented machinery and had pushed the sale of it, were held to have broken their covenant.

apt to become the name of the goods themselves, and consequently open to all the world so soon as the patent runs out (*i*). It is often advisable, therefore, to use the patentee's or some other firm or personal name with the trade name of the goods, so that the public may become accustomed to the combination, and to stipulate in any working agreements for such use.

Sometimes assignees or licensees are required to covenant to place particular labels (*k*) or marks on all goods manufactured under the patent.

To keep books. Inspection. Accounts.

10. Covenants for keeping books, inspection, and the rendering of accounts are necessary where there are joint working arrangements, or where a party interested is to be paid by royalty or share of profits (*l*).

Amendment and disclaimer.

11. Application to amend the specification (*m*) or for leave to disclaim (*n*) should also be the subject of covenants where there are several parties interested in the patents, or one co-owner may attempt to alter the common property without the consent of the others, or may unreasonably refuse to concur in an application for a beneficial amendment or disclaimer.

Determination of liability.

12. The effect of a judgment declaring the patent to be invalid, and of the expiration of patent should be considered in relation to each of the covenants and provisions inserted in the deed.

If an option is given to an assignee to reassign or to surrender his interest in the patent, it will usually be proper to stipulate that, if he exercise it during the term of the patent right, he shall cease to manufacture or to deal in the goods described in the specification.

Winding-up of company assignee.

If the assignee is a limited company, the event of a winding-up must in particular be provided for.

Sub-assignee to be bound by covenants.

The assignee of one who has entered into obligations respecting the patent will usually be required to indemnify his assignor against the breach of them. And it is sometimes provided that upon a second assignment the first assignee shall require his sub-assignee to enter into covenants with the assignor to the same effect as his own covenants. The assignor may more effectually protect himself against sub-assignments by making

Licence to assign.

(*i*) See *The Linoleum Co.* v. *Nairn* (1878), 7 C. D. 834, and Kerly on Trade-marks, p. 43.

(*k*) See *Crossthwaite* v. *Steel* (1889), 6 R. P. C. 190, cited *post*, p. 205.

(*l*) See further under "Licences," *post*, p. 306.

(*m*) See p. 585.

(*n*) See p. 585.

the interest of the assignee liable to determine upon assignment without a licence to assign.

Sub-assignee with notice may be bound.

A sub-assignee may be held to be bound by covenants to which the assignment is made subject, if after acquiring the patent with notice of the covenants he works the invention. Thus in *Werdermann* v. *Société Générale d'Electricité* (*o*) an assignee covenanted to pay the assignor a royalty, and that he and his assigns would render accounts. He subsequently reassigned to the defendant company, who worked the invention. It was held that the assignor could sue the company for an account, upon the ground that the covenant amounted to a contract with the owners of the patent for the time being.

II. Licences.

Power to grant licences.

Power to grant licences is conferred by the grant of the patent, which is "by himself, his agents or licensees, and no others to make, use, and vend" the invention. The grant also contains a prohibition forbidding the use of the invention "without the consent, licence, or agreement of the said patentee in writing under his hand and seal," and it provides that "nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted" (*p*).

Nature of licence. Whether a "licence coupled with a grant."

A licence is essentially an excuse from the prohibition in the grant of the patent (*q*). It does not belong to the class of "licences coupled with a grant," but it is not therefore necessarily revocable at will. Whether it is so revocable depends upon the intention of the parties, to be gathered from the terms of their agreement (*r*).

Different kinds of licences.

Licences are of various kinds. They may be co-extensive with the patent right in area or in duration or both, or limited to particular districts or for shorter periods. They may be exclusive or not exclusive. An exclusive licence for the whole area of the patent closely resembles an assignment, and such a licence for a district similarly resembles an assignment for a district, but the

(*o*) (1881) 19 C. D. 246. It will be noticed that this goes beyond the "rule in *Tulk* v. *Moxhay*," 2 Ph. 774, under which an injunction to restrain the assignee of property, which is subject to restrictions binding upon the assignor, who buys with notice, is restrained from using the property in contravention of them. As to the scope of this rule see *Austerberry* v. *Corporation of Oldham*, 29 C. D. 750, and *Mander* v. *Falcke* (1891), 2 Ch. 554.

(*p*) See *post*, p. 667.

(*q*) See *Heap* v. *Hartley* (1889), 42 C. D. 461; 6 R. P. C. 495.

(*r*) See *post*, pp. 303, 307.

interests conveyed are not the same. A material difference is constituted by the fact that a licensee cannot sue as such for infringement (*s*).

Further the licence may extend only to part of the new manufactures comprised in the invention.

A licence to make goods under the patent implies a licence to the manufacturer and his vendees to sell them (*t*). And the sale of goods made under a patent imports, in the absence of notice of a more limited licence, a licence to use and resell them (*u*).

Licence to make implies licence to sell.

Sale implies licence to use and resell.

Form of Licence.

The terms of the grant which are set out above (*x*) would suggest that a deed is necessary, but as an agreement to license in any form would estop the patentee and persons claiming under him from suing for infringement (*y*), the sealing and delivery are of no importance (*z*). The licence should be registered; and a verbal agreement may be equivalent to a licence (*a*), and a memorandum of it signed by the parties subsequently may be registered (*b*).

Whether a deed is required.

Contents of Licence (*c*).

The principal matters to be considered in determining what shall be comprised in an assignment are—(1) the licensor's title; (2) the validity of the patent; (3) to what things and to what district the licence is to extend, and what is to be the term of it; (4) whether further patents for improvements or prolongations of the patent are to be affected by the licence; (5) whether it is to be exclusive, or there is to be any restriction upon the grant of further licences; (6) the consideration, royalties, and provisions requiring the licensee to work only according to the specification; (7) conditions as to working and pushing the invention;

Suggestions.

(*s*) *Post*, p. 362, and *Heap* v. *Hartley* (1889), 42 C. D. 461; 6 R. P. C. 495.

(*t*) *Thomas* v. *Hunt* (1864), 17 C. B. N. S. 183. There would be no such implication from a licence to make for private use.

(*u*) See *The Incandescent Light Co.* v. *Cantelo* (1895), 12 R. P. C. 262, where the company sold its mantles with an express restriction that they should be used only on burners sold by it.

(*x*) Page 300.

(*y*) See per Maule, J., in *Bower* v. *Hodges* (1853), 22 L. J. C. P. 198.

(*z*) *Post-card Automatic Supply Co.* v. *Samuel* (1889), 6 R. P. C. 560; cf. "Equitable Assignments," *ante*, p. 285.

(*a*) *Crossley* v. *Dixon* (1863), 10 H. L. C. 293.

(*b*) 1883, sect. 23; *Fletcher's Patent* (1893), 10 R. P. C. 252.

(*c*) Cf. the suggestions made at p. 294, *ante*, as to the contents of an assignment, and at p. 290 as to the contents of an agreement for sale.

(8) inspection, use of marks and labels, accounts; (9) who is to take legal proceedings for the protection of the patent; (10) payment of fees; (11) whether the licensee is to have power to assign; and (12) provisions for determining the licence or the obligations arising under the covenants.

Most of these provisions and covenants are obviously useful or necessary only where the licensor retains an interest in the working of the invention under the licence.

1. As to title, and in particular as to employing covenants for title by the use of the words "beneficial owner," see above, p. 294.

2. As to the validity of the patent see above, p. 294.

Licensee cannot dispute validity.

A licensee cannot during the term of the licence dispute the validity of the patent unless the licence authorises him to do so. This rule was formerly in doubt, but is now well settled. The relation of patentee and licensee of itself (if it is not got rid of before the action) raises an estoppel of the licensee from disputing the validity of the patent (*d*). But it is open to the licensee to show that the licensor's title has determined since the licence (*e*).

Plea of invalidity in action for royalties.

So where a defendant in an action for infringement pleaded alternatively (1) that he had manufactured the goods under a licence, and (2) that the patent was invalid, he was ordered to elect between these defences (*f*); and in an action for royalties a plea that, if the patent were construed to include the goods in respect of which royalties were claimed, it was invalid, was struck out as embarrassing (*g*).

Covenant not to dispute validity.

Right to do so reserved.

Sometimes the licensee expressly covenants not to dispute the validity of the patent; on the other hand, he sometimes reserves the right to do so. Unless provision is made to determine the licence and all obligations under it in case the patent is judicially determined to be invalid (*h*), if the licensee proposes to go to a large expense in establishing works or starting a business, such a reservation is reasonable, for without it the licensee may find himself the only person in the trade who cannot use the invention without paying a royalty.

(*d*) Per Lord Esher, M. R., in *Mills* v. *Carson* (1892), 10 R. P. C. 9.

(*e*) *Muirhead* v. *Commercial Cable Co.* (1894), 11 R. P. C. 317 and 323. *E.g.*, if the licence is under an American patent by showing that, an earlier English patent for the invention having determined, the American patent has expired.

(*f*) *Post-card Automatic Supply Co.* v. *Samuel* (1889), 6 R. P. C. 560.

(*g*) *Ashworth* v. *Law* (1890), 7 R. P. C. 231.

(*h*) See *post*, p. 307.

3. As to licensees for a district, and the difference between an exclusive licence for a district and an assignment, see above, pp. 284, 300.

Licence for a district.

If an exclusive licence is granted for a royalty, the licensor must generally be protected by a covenant on the licensee's part to work or to pay a minimum yearly rent, and by a provision enabling him to determine the licence for breach of these covenants by the licensee.

Covenant to work invention.

Minimum royalty.

An exclusive licence is generally held to be an obstacle to the grant of an extension of the term of the patent (*i*).

Exclusive licence an objection to prolongation.

Unless the licence restricts the licensee to a particular place, he can use it wherever he likes within the area the patent covers, and it will not be construed to be for the purposes of a particular business only (*k*). But a licence under a foreign patent will not authorise the introduction of the goods made into England if the licensor has an English patent also (*l*).

Licensee not restricted to one place or to one business.

Licence under foreign patent.

In the absence of any express stipulation, it appears to be a matter of construction whether the term of the licence and of the licensee's covenants is to be that of the duration of the patent or to continue till put an end to by one party, and which, if either, party has the right in the latter event to end it (*m*).

Duration of licensee covenants.

Option to determine.

If the terms of the licence throw no light on the matter, the licence is revocable at the will of either party (*n*).

Revocation.

But a licence for a lump sum will be presumed to have been intended not to be revocable by the licensor (*o*). Similarly it will be presumed that a person who has undertaken obligations under the licence cannot get rid of them at his pleasure by revoking it (*o*).

It was suggested in *Ward* v. *Livesey* (*p*) that the revocation of a licence under seal must be by notice under seal, but this would appear to be erroneous. If the term of the licence is limited by the will of either party, it will expire when notice of determination is given to the other.

Must revocation be under seal?

(*i*) *Darby's Patent* (1891), 8 R. P. C. 380; *Shone's Patent* (1892), 9 R. P. C. 435; *Lyon's Patent* (1894), 11 R. P. C. 537.

(*k*) *Bown* v. *Humber & Co.* (1888), 6 R. P. C. 9.

(*l*) *Société des Glaces* v. *Tilghman's Co.* (1883), 25 C. D. 1.

(*m*) See *Mills* v. *Carson* (1892), 10 R. P. C. 9; *Cheetham* v. *Nuthall* (1893), 10 R. P. C. 321, and the cases next cited.

(*n*) In *Redges* v. *Mulliner* (1892), 10 R. P. C. 21, Collins, J., treated this as decided by *Crossley* v. *Dixon*, 10 H. L. C. 232. The judgment of Bristowe, V.-C., in *Ward* v. *Livesey* (1888), 5 R. P. C. at p. 102, appears to be in conflict with this. See also *Cutlan* v. *Dawson and Sons* (1896), 13 R. P. C. 710.

(*o*) *Guyot* v. *Thompson* (1894), 3 Ch. 388. Royalties were payable also. The fact that the licensor licensed as "beneficial owner" was treated as material to show that he could not revoke.

(*p*) (1888) 5 R. P. C. 102.

Determination of one of several patents.

Where several patents are the subject of a licence, if the term is measured by or dependent upon the continuance of the patents, it should be clearly shown whether the lapse of one or some of them is to affect the licence (*q*).

Licence before patent.

So, if the licence is granted before the patent is obtained, provision should be made for the possibility of the patent being granted for part of the invention only (*r*).

Further inventions and improvements.

4. As to further inventions, improvements, and prolongations, see above, pp. 295 to 297.

Licensee to communicate improvements.

As the licensee is likely to discover improvements or inventions for attaining the end to which the invention he is licensed to use is directed, it is often stipulated that he shall communicate all such improvements and inventions to the patentee, and stipulations are made determining to whom they are to belong and on what terms (*s*).

5. As to exclusive licences see above, p. 300.

Licensee to have most favourable terms.

Where a non-exclusive licence is granted, it is sometimes *provided that* if the licensor grants better terms to any other person, the licence shall be determined, or else that the licensee shall thereafter hold upon the same terms (*t*).

6 and 7. As to the consideration.

Failure of consideration.

If there is a total failure of consideration—for example, if payment is made in consideration that the payee shall apply for a patent, and grant a licence under it when it is obtained, and no application is made—then the price paid can be recovered (*u*).

Action for royalties.

But a licence or an agreement to grant a licence imports no warranty of the validity of the patent (*x*). And a plea of invalidity is consequently no defence to an action for royalties (*y*), in the absence of something in the licence making it so (*z*) or of fraud (*a*).

(*q*) In *Siemens* v. *Taylor* (1892), 9 R. P. C. 393, it was held that, although some of the patents had expired, the royalties must be paid in respect of all the inventions; cf. *Hazlehurst* v. *Rylands* (1890), 9 R. P. C. 1.

(*r*) See *Otto* v. *Singer* (1889), 7 R. P. C. 7.

(*s*) See "Assignment," p. 295 *et seq.*

(*t*) *E.g.*, see *Cheetham* v. *Nuthall* (1893), 10 R. P. C. 321.

(*u*) *Knowles* v. *Bovill* (1870), 22 L. T. N. S. 70; *Besseman* v. *Wright* (1858), 6 W. R. 719.

(*x*) *Ante*, p. 291.

(*y*) *Ante*, p. 291.

(*z*) *Cutler* v. *Bower* (1848), 11 Q. B. 973, 17 L. J. Q. B. 217; *Hills* v. *Laming* (1853), 9 Exch., 23 L. J. Ex. 60; *Lawes* v. *Purser* (1856), 6 Ell. & B. 930; 26 L. J. Q. B. 25.

(*a*) *Lovell* v. *Hicks* (1836), 5 L. J. N. S. Ex. 101; *Hall* v. *Jarvis* (1822), 1 Web. P. C. 103. In *Begbie* v. *Phosphate Sewage Co.* (1875), L. R. 10 Q. B. 491, 1 Q. B. D. 679, the plaintiff sued for the price paid for an "exclusive right" which the defendant company knew was no exclusive right at all. He failed because he himself had known the fact, and had bought it only for the purpose of promoting a company.

Defence that licensee is not using the invention.

An action for royalties can be defended on the ground that the defendant is not using the invention (*b*). And for the purpose of showing the ambit of the specification, evidence of the state of public knowledge at the date of the patent is admissible (*c*), unless the specification is too clear for doubt (*d*).

Covenant to manufacture only according to the specification.

To avoid the discussion of difficult questions of infringement, therefore, and to secure the payment of royalties notwithstanding improvements or changes in the manufacture, it is a common precaution for the licensee to be required to covenant to manufacture according to the specification, and not otherwise (*e*).

A covenant not to make any goods the subject of the invention without applying the invention to them is not void as being in restraint of trade, and is binding although the goods so made are unsaleable (*f*).

Covenant to push the invention.

A covenant by the licensee to use the best endeavours of the covenantor to extend the use of the invention is broken by the licensee if he works and pushes the sale of an independent competing invention instead (*g*).

Licensor not to stop sales.

The licensor does not usually enter into any such covenant, but without doing so he is bound not to derogate from his own grant by endeavouring to prevent customers from purchasing the patented goods of the licensee (*h*).

Licence for share of profits does not create partnership.

A licence in consideration of a share in the profits to be made by the licensee does not of itself create a partnership between the licensee and the licensor (*i*).

Licensee repudiating licence not to pretend to sell under it.

A licensee who repudiates his obligations under the licence and refuses to pay the agreed royalties will not be allowed to advertise his goods as "manufactured under the patent" (*k*).

(*b*) *Clark* v. *Adie* (1877), 2 App. Ca. 423; *Useful Patents Co.* v. *Rylands* (1885), 2 R. P. C. 255; *Young* v. *Hermand Oil Co.* (1891), 8 R. P. C. 285; 9 R. P. C. 373; *Ashworth* v. *Roberts* (1892), 9 R. P. C. 309.

(*c*) *Young* v. *Hermand Oil Co.*, last note.

(*d*) *Crossthwaite* v. *Steel* (1889), 6 R. P. C. 190. See also the next note.

(*e*) If the royalty is to be paid on every article manufactured, this will be taken to mean manufactured so as to be within the patent, unless the contrary is expressed or clearly implied. See *Goucher* v. *Clayton* (1865), 11 Jur. N. S. 462; 13 L. T. N. S. 115. See also as to the ambit of the licence *Peden* v. *The London Small Arms Co.* (1876), 46 L. J. Q. B. 213.

(*f*) *Jones* v. *Lees* (1856), 1 H. & N. 189; 26 L. J. Ex. 9.

(*g*) *Wilson* v. *Barbour* (1888), 5 R. P. C. 245. See also *Guyot* v. *Thompson* (1894), 11 R. P. C. 541.

(*h*) *Clark* v. *Adie* (1873), 21 W. R. 456, 764. In that case the licensor was restrained from publishing advertisements. In *Guyot* v. *Thompson* (1894), 11 R. P. C. 541, the patentee was restrained from advertising that the goods made by the licensee were not according to the patent.

(*i*) *Elgie* v. *Webster* (1839), 5 M. & W. 518; *Ridgway* v. *Phillip* (1834), 1 C. M. & R. 415.

(*k*) *Post-card Automatic Supply Co.* v. *Samuel* (1889), 6 R. P. C. 560. In this case the defendant disputed the validity of the patent, but continued to sell his goods as manufactured under a licence from the patentee. He elected to defend an action for infringement, and

Licensor to inspect factory.

8. The object of provisions enabling the licensor to inspect the factories where the invention is worked, and all the books and accounts used, and the stock, and articles made or employed by the licensee in the business in which he is working the invention, is to enable the licensor to check the accounts rendered to him and also to see whether or not the goods are manufactured according to the specification.

Licensee to keep books and render accounts.

The licensee usually covenants to keep all ordinary and proper books and accounts and duly to make entries in them, so as to show what goods have been manufactured under the licence and what have been sold, and to deliver accounts at stated intervals. Power is reserved to the licensor or his assigns to cause the books and accounts to be inspected by an accountant. And the licensee covenants to verify the entries in the books and accounts by statutory declaration, if so required.

Marks and labels.

As to the use of marks and labels (*l*) see p. 298.

Proceedings against infringers.

9. The determination who is to take and pay the costs of legal proceedings against infringers is of great importance (*m*). Usually it will be the person most interested—that is, the patentee if a limited or non-exclusive licence is granted, but the licensee if there is an exclusive licence at a small royalty. In the latter case the patentee must authorise the licensee to use his name upon being indemnified against costs (*mm*). The licensor sometimes covenants not to sue without the licensee's consent (*n*).

Covenant to sue.

An absolute covenant to sue all infringers or to stop infringements is unusual, because the costs entailed may be ruinous, but it is sometimes entered into (*o*). It is only broken by a neglect to sue after notice of an infringement (*o*). More commonly, where the licensor is to sue, it is provided that the royalties shall cease if he does not stop infringements (*p*), and they then cease upon notice to him of infringements, and after a reasonable time has elapsed for taking proceedings (*o*).

Payment of fees.

10. The payment of fees should be provided for. Where a licence stipulated that if the patent became void by reason that

was restrained from labelling his goods as above: *Grover Co.* v. *Millard* (1862), 8 Jur. N. S. 714.

(*l*) In *Crossthwaite* v. *Steel* (1889), 6 R. P. C. 190, the defendant had covenanted to stamp on each of the grates made under the licence the words "Crossthwaite's Patent, No. 2,496," in a prominent position. He stamped them on the backs. An injunction was granted.

(*m*) See *ante*, p. 297.

(*mm*) As to indemnity, see *Evans* v. *Rees* (1842), 2 Q. B. 334.

(*n*) *E.g.*, *Guyot* v. *Thompson* (1894), 11 R. P. C. 541.

(*o*) *Henderson* v. *Mostyn Copper Co.* (1868), L. R. 3 C. P. 202.

(*p*) *Mills* v. *Carson* (1892), 9 R. P. C. 338; 10 R. P. C. 9.

the patentee did not take proceedings, or because the invention was not novel, and the patentee covenanted for quiet enjoyment by the licensee, after the patent had lapsed because the fees were not paid, it was held that the royalty continued to be payable even though covenant for quiet enjoyment had been broken by the non-payment of the fees, since the payment of the royalties was not conditional upon the performance of the covenant (*q*).

In the absence of any agreement, either express or to be implied from the licence, there is no obligation on either party to pay the fees (*r*).

Assignment of licence.

11. A licence is not assignable without leave, unless made so by agreement (*s*) or by its terms, as if, for example, it is made to the licensee and his assigns (*s*).

Determination of licence and licensee's obligations.

12. It is commonly provided that the licence or the obligations cast upon the licensee shall cease or be suspended if the patent is declared to be invalid. If there is such a provision, a judgment declaring the patent invalid is ineffective to determine the licence if it is reversed on appeal, even though, it appears, the reversal be by consent, as part of a compromise (*t*).

Option to determine.

Sometimes an option is given to the licensee to determine the licence if the sales do not amount to an agreed number or if the profits do not reach a standard ascertained in some other way, or to the licensor if the royalties do not amount to a specified sum (*u*).

Determination on breach of covenant.

If the patent is a valuable one, and the licence imposes onerous obligations on the licensee, the licensor usually stipulates for power to determine it on any breach of covenant by the licensee. Where there is no such stipulation, it will be a matter of construction whether the obligations of any of the parties are independent or conditional upon the performance of other obligations arising out of the terms of the licence (*x*).

Whether the obligations are interdependent.

Stamps on licences.

When the licence is made by deed, it must bear a 10*s.* deed-stamp, unless it is stamped with *ad valorem* duty. But it appears,

(*q*) *Mills* v. *Carson*, last note.

(*r*) *Railway Electric Appliances Co.* (1888), 38 C. D. 597; *Mills* v. *Carson*, *supra*. In the latter case the Divisional Court held the patentee was not bound to pay the fees. In the Appeal Court it was suggested, but not decided, that he was, by reason of the covenant for quiet enjoyment.

(*s*) *Bower* v. *Hodges* (1853), 22 L. J. C. P. 194.

(*t*) *Cheetham* v. *Nuthall* (1893), 10 R. P. C. 321.

(*u*) *E.g.*, *Tielens* v. *Hooper* (1850), 5 Exch. Rep. 830, where an agreement that the licensee should make up the royalty to 2,000*l.*, or the plaintiff might determine the licence, was held not to bind the licensee to pay the 2,000*l.*

(*x*) See *Mills* v. *Carson* (1892), 9 R. P. C. 338; 10 R. P. C. 9.

according to the recent case of *The Smelting Co. of Australia* v. *The Commissioners of Inland Revenue* (*y*), to be chargeable with *ad valorem* duty as a "conveyance on sale." It was formerly supposed not to be so chargeable, even though it be exclusive (*z*), for it is (not for purposes other than those of the Stamp Acts) a conveyance of property (*a*).

And the duty must be paid although the patent is a foreign one, and the licence is for a foreign country (*y*).

If it reserves a fixed rent or is granted in consideration of a sum payable by instalments, it appears to be chargeable with the 2*s.* 6*d.* *ad valorem* duty as a security for money (*z*). This would also be the case where a fixed minimum royalty is reserved.

(*y*) (1896) 2 Q. B. 179.

(*z*) *Limmer Asphalte Co.* v. *Commissioners of Inland Revenue* (1872), 7 L. R. Ex. 211; *Newby* v. *Harrison*, No. 1 (1861), 1 J. & H. 393; *Charter* v. *Johnson* (1845), 14 M. & W. 411.

(*a*) Per Fry, L. J., in *Heap* v. *Hartley*, 42 Ch. Div. p. 470. It is not a "conveyance" within the meaning of the Conveyancing Act, 1881: *Guyot* v. *Thompson* (1894), 11 R. P. C. 541, per Lindley, L. J.

CHAPTER XI.

THE REGISTER OF PATENTS (*a*).

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 the 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 example is given in the foot-note (*b*), and also a

(*a*) The author desires to acknowledge his indebtedness to Mr. E. Towers for information in connection with this chapter.

(*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 1s. 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.

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 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 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

The file.

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, the documents themselves being set out in the Register of Proprietors.

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*).

Rectification of the register.

Any person deeming himself aggrieved by any entry made under colour of the Act in the Register of Proprietors might have applied 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 (*d*).

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 (*e*); it could also correct any entry which purported to affect the rights of persons not parties to the document registered (*f*).

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 (*g*).

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 (*h*).

The Register of Patents under the Act of 1883 (*i*).

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 (*k*), wherein are entered the names and addresses of grantees, notifications of assignments

(*c*) Sect. 114.

(*d*) Act of 1852, sect. 38.

(*e*) *Re Morey's Patent* (1858), 25 Beav. 581.

(*f*) *Re Horsley and Knighton's Patent* (1869), L. R. 8 Eq. 475; 39 L. J. Ch. 157.

(*g*) *Ellwood* v. *Christy* (1864), 34 L. J. C. P. 130; 17 C. B. N. S. 754; 10 Jur. N. S. 1079.

(*h*) *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, 56.

(*i*) 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 the comptroller's 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 Patent Rules, 1890, rr. 67—79.

(*k*) Sect. 23.

and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may be from time to time prescribed (*l*). The Register of Patents is to be *primâ facie* evidence of any matters directed to be inserted therein (*m*).

The person for the time being entered in the Register of Patents as proprietor of a patent has, subject to the provisions of the Patents Acts and to any right appearing to be vested in any other person, power absolutely to assign, grant licences, or otherwise deal with the same, and can give effectual receipts for any consideration for such assignment, licence, or dealing (*n*).

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 (*o*), 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

(*l*) 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 contents of the documents registered: *Heap* v. *Hartley* (1888), 5 R. P. C. 603; and see the same case on appeal, 42 Ch. Div. 461; 6 R. P. C. 495.

(*m*) Certified copies are receivable in evidence: 1883, sect. 89.

(*n*) 1883, sect. 87; 1888, sect. 21.

(*o*) Sect. 85. As to the former practice, see Johns. Pat. Man., 4th edit. p. 221.

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 (*p*).

The patent is not registered until after sealing, and until that time no property is recognised 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 apparently being the difficulty of identifying the application with the invention dealt with.

Parnell's Patent.

In *Parnell's Patent* (*q*), 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) could 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.

(*p*) *Parnell's Patent* (1888), per North, J., 5 R. P. C. 126.

(*q*) (1888) 5 R. P. C. 126.

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 (*r*) 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 the grantee and the title of the invention (*s*). A patent granted under the international and colonial arrangements is entered in the register as of the date of the first foreign application (*t*).

Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, the comptroller, on request and on proof of title to his satisfaction, must cause the name of such person to be entered as proprietor of the patent in the Register of Patents (*u*).

Entry of subsequent proprietorship.

A request for the entry of subsequent matters requiring registration must be addressed to the comptroller, duly signed, and left at the Patent Office (*x*).

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 (*y*).

A body corporate may be registered as proprietor in its corporate name (*z*).

The applicant must produce to the comptroller, together with the request above mentioned, his documents of title, not being matters of record (*a*), and such other proof of title as may be required, and also an official, certified, or attested copy of the documents aforesaid (*b*).

(*r*) P. R. 1890, rr. 67—79.

(*s*) *Ibid.* r. 67.

(*t*) *Ibid.* r. 29.

(*u*) 1883, sect. 87. If a company is a patentee and changes its name, or if the patentee is a lady and she marries, the comptroller may, under this section, put the patentee's new name on the register: *Ex parte New Ormonde Cycle Co., Ltd.* (1896), 2 Ch. 520; 65 L. J. Ch. 785; 13 R. P. C. 475.

(*x*) See sect. 87; P. R. 1890, r. 68, 69; Forms L and M, p. 746.

(*y*) P. R. 1890, r. 69, 70.

(*z*) *Ibid.* r. 73.

(*a*) An official or certified copy of such documents is sufficient: r. 71.

(*b*) Rules 71, 72.

Entry of licence.

Substantially the same procedure is necessary in order to obtain the registration of a licence (*c*).

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 (*d*).

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 (*e*).

Entry of failure to pay renewal fees.

The failure of a patentee to make any prescribed payment is duly entered in the register (*f*).

Restrictions on registration.

There will not be entered on the Register of Patents any notice of any trust, express, implied, or constructive (*g*). But equitable assignments may be entered on the register, not as in themselves legal assignments, but as documents which affect proprietorship (*h*). A. and B., joint owners of certain patents, wrote to C.: "In consideration of your services as ———, we hereby agree to give you a one-third share of the patent, the same to take effect as from this date." A. and B. then deposited the letters patent with C., who registered the letter above set out; and the Court of Appeal held that the letter was an immediate equitable assignment of an interest in the patent and was properly entered on the register (*h*). But the documents must be a complete record in themselves, for a parol agreement will not be entered on the register (*i*).

Inspection of and extracts from the register.

The Register of Patents is open to the inspection of the public on every week-day from 10 a.m. to 4 p.m., with certain exceptions (*k*).

Certified copies.

Certified copies of every entry in the register may be furnished by the comptroller on payment of the prescribed fee (*l*).

Rectification of clerical error in register by comptroller.

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 (*m*).

(*c*) Rule 77.
(*d*) Rule 74.
(*e*) Rule 75.
(*f*) Rule 76.
(*g*) Sect. 85.
(*h*) *Stewart* v. *Casey* (1892), 1 Ch. 104; 61 L. J. Ch. 61; 9 R. P. C. 9. The case of *Haslett* v. *Hutchinson* (1891), 8 R. P. C. 457, and the remarks of Kekewich, J., at p. 463, should be observed; but *Stewart* v. *Casey* is later in date and was decided by the Court of Appeal.

(*i*) *Fletcher's Patent* (1893), 10 R. P. C. 252.

(*k*) 1883, sect. 88. See Rule 78.

(*l*) P. R. 1890, r. 79; sects. 88 and 89. For the fee, see No. 33, p. 711.

(*m*) 1883, sect. 91. And see *Ex parte New Ormonde Cycle Co.* (1896), 2 Ch. 520; 65 L. J. Ch. 785; 13 R. P. C. 475.

It is provided by sect. 90 of the Act of 1883, as amended by sect. 23 of the Act of 1888, that "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* (*n*) 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 costs of the proceeding as the Court thinks fit."

From this it will be seen that the grounds upon which the register may be rectified include the omission without sufficient cause of the name of any person, but this provision will not enable a person whose application for a patent has been refused by the comptroller to appeal to the Court. An appeal of such a kind must be to the law officer, and from him there is no appeal (*o*), and this provision cannot be evaded under cover of an application to rectify the register (*p*). Rectification may be ordered on the ground that the entries in the register have been caused by fraud (*q*) or by misrepresentation (*r*). Change of name is not a ground of rectification ordered under this section (*s*).

The Court may expunge any entry or may rectify by varying the entry (*t*). An improper entry should be expunged, and not rectified (*u*). And there seems to be no power to substitute one name as registered proprietor for another, except under the rules governing assignments, transmissions, &c. (*x*). In *Re Rivière's Trade-mark* (*y*), Cotton, L. J., said: "In my opinion, whatever might be the result of striking off the name of Rivière & Co., yet the application to substitute that of the applicants could not be acceded to, because, in my opinion, even without going so far as to say that in no case where the name of a person improperly on the register as owner of a mark is struck off the

Substitution of one name for another not usually ordered.

(*n*) These words were inserted by the Act of 1888.

(*o*) 1883, sect. 11.

(*p*) *Re the Trade-mark Normal* (1886), 35 Ch. Div. 231; 56 L. J. Ch. 519; 56 L. T. N. S. 250; 35 W. R. 464; 4 R. P. C. 123. Sect. 90 of the Act of 1883 applies to patents, designs, and trade-marks alike; therefore assistance in construing it may be obtained from cases on all three subjects.

(*q*) *Green's Patent* (1857), 24 Beav. 145; *Morey's Patent* (1858), 25 Beav. 581.

(*r*) *Baker* v. *Rawson* (1889), 45 Ch. Div. 519.

(*s*) *New Ormonde Cycle Co.*, *infra*.

(*t*) An example of this is to be found in the trade-mark case *Baker* v. *Rawson* (1889), 45 Ch. Div. 519.

(*u*) Per Kekewich, J., in *Haslett* v. *Hutchinson* (1891), 8 R. P. C. 457, 461.

(*x*) *New Ormonde Cycle Co.* (1896), 2 Ch. 520; 65 L. J. Ch. 785; 13 R. P. C. 475. *Ante*, p. 314.

(*y*) (1885) 55 L. J. Ch. 545; 53 L. T. N. S. 237.

name of the person properly entitled to the mark may be substituted, yet in my view, as a rule (and I do not know a case where there would be an exception), where any one applies in the first instance to be publicly registered as the proprietor of a trade-mark, the prescribed formalities should be adopted." In *Rust & Co.'s Trade-mark* (*z*), Arthur Rust by mistake registered a trade-mark of his firm in the name of "Arthur Rust, trading as T. W. Rust & Co.," and the firm of T. W. Rust & Co. moved successfully to rectify the register by cancelling the name of A. Rust and inserting in the register the names of all the partners trading under the firm's name. Here, it will be observed, the registered proprietor had applied in the firm's name as well as his own. In *Re Farina's Trade-mark* (*a*) the partner applied in his own name only, and substitution, by way of rectification, of the firm's name was refused. In *Re Greenlees's Trade-marks* (*b*), *Farina's case* was followed, and Stirling, J., stated that the right course would be for the partner whose name was upon the register to assign to the firm (*c*). In *Re Guiterman's Design* (*d*) an agent for a company owning designs was wrongfully registered as proprietor; the Court expunged the agent's name from the register, but refused to substitute the name of the company for that of the agent.

Change of name of owners.

Where there is a change, not of ownership, but of the name of the owners, variation by way of addition of the new name has been allowed even in the case of a trade-mark (*e*).

The power to rectify is discretionary (*f*).

Costs.

Costs of comptroller.

The costs are in the discretion of the Court; and there seems to be no fixed rule as to the order to be made in this regard. The party who is unsuccessful will generally have to pay them. The comptroller will usually be allowed his costs of any necessary appearance.

Damages on rectification of register.

Sub-sect. 2 of sect. 90 gives power to the Court to award damages to the party aggrieved. Judging from the reported cases, this has seldom, if ever, been done. In a recent case under a similar section of the Companies Act, 1862 (*g*), Lindley, L. J.,

(*z*) (1880) 44 L. T. N. S. 98; 29 W. R. 393.
(*a*) (1881) 44 L. T. N. S. 99; 29 W. R. 391.
(*b*) (1892) 9 R. P. C. 93.
(*c*) 1883, sect. 87.
(*d*) (1886) 55 L. J. Ch. 309.
(*e*) *Re Patent Plumbago Crucible Co.'s Trade-mark* (1890), 7 R. P. C. 282. But see *New Ormonde Cycle Co. supra*, note.
(*f*) *Re Trade-mark of La Société Anonyme des Verreries de L'Etoile* (1893), 10 R. P. C. at p. 441.
(*g*) Sect. 35; *Ottos Kopje Diamond Mines* (1893), L. R. 1 Ch. 618; 62 L. J. Ch. 166.

said that it appeared to him that the Court had no jurisdiction to make the company pay damages under the section, except in cases where an order for rectification is made.

Person entitled to apply for rectification, "any person aggrieved."

The person entitled to demand rectification, if there be due cause, is "any person aggrieved." There has been at different times much discussion as to who falls within this description.

In the case of *Rivière's Trade-mark* (*h*), Selborne, L. C., says: "The first observation which I have to make is, that I do not find on the face of the Act of Parliament itself any particular limitation of the sense in which the word 'aggrieved' is to be understood when a person alleging himself to be aggrieved undertakes to bring the case within any one of the conditions on which a right to apply to rectify the register is given to a person aggrieved. Of course if it could be shown *à priori* that in point of law persons in a certain situation could not be aggrieved, then the conclusion would be right that the Court must refuse to hear them on the merits; but, unless that can be demonstrated, I find nothing in the Act of Parliament which limits and defines the kind of grievance which may entitle a man to apply. I entirely agree with what has been said, that it must be a legal grievance; it must not be a *stet pro ratione voluntas*; the applicant must not come merely saying, 'I do not like this thing to be done'; it must be shown that it tends to his injury or to his damage in the legal sense of that word."

In *Re Apollinaris Co.'s Trade-marks* (*i*) the Court of Appeal (per Fry, L. J.) laid down that the object of limiting the power of application to the Court to a person aggrieved is to exclude the common informer and those desiring to interfere from sentimental motives only; and whilst a grievance in the sense intended by the Act does not mean mere annoyance, yet it is not necessary that the applicant should prove that he is suffering serious damage.

Persons aggrieved.

One of the latest cases dealing with the meaning of "aggrieved" is *Re Powell's Trade-mark* (*k*), in the course of which Bowen, L. J., said: "Persons who are aggrieved are persons who are in some way or other substantially interested in having the mark removed from the register or persons who would be sub-

(*h*) (1884) 26 Ch. Div. 48; 53 L. J. Ch. 455, 578.

(*i*) (1891) 2 Ch. 186; 61 L. J. Ch. 625.

(*k*) (1893) 2 Ch. 388; 10 R. P. C. 195; 62 L. J. Ch. 848; 69 L. T. N. S. 60; 41 W. R. 627; affirmed by the House of Lords (1894), A. C. 8; 11 R. P. C. 4.

stantially damaged if the mark remained. It is very difficult to frame a nearer definition than that." In the House of Lords (*l*) Lord Watson said: "Any trader is, in the sense of the statute, 'aggrieved' whenever the registration . . . operates in restraint of what would otherwise have been his legal rights."

In *Horsley and Knighton's Patent* (*m*) one of two joint patentees was enabled as an aggrieved party to move to expunge an entry prejudicial to him and entered on the initiative of his co-patentee (*n*).

Procedure on application for rectification.

To rectify it is necessary to make application to the Court, *i.e.* to the High Court of Justice in England (*o*). This will be so even when the registered proprietor is domiciled in Scotland or Ireland (*p*). The Court may in any proceeding in this regard decide any question necessary or expedient, and may direct an issue to be tried for the decision of any question of fact (*q*). It would ordinarily be an abuse of the process of the Court to bring an action for rectification (*r*), nor will the Court grant the relief on a counterclaim (*s*).

? By motion or summons.

The proper method of procedure is either by motion or by summons. The latter is not always the cheaper, and if it be obvious that the case must eventually be adjourned to Court, it will often be better to proceed by motion (*t*). An appeal lies from the decision of the High Court to the Court of Appeal; and for the purposes of procedure the order is treated as an appeal from a final order (*u*). If there be no action pending, the application, if made by summons, will be made by originating summons (*x*).

Notice to be given.

As a rule the persons who are affected should be served in the ordinary way prescribed for motions (*y*) or summons (*z*). As no special procedure is prescribed by the Acts or rules as to service on parties of notices of application to rectify, it has been said (in a trade-mark case) that if such notice of the intended application

(*l*) (1894) App. Ca. 8; 63 L. J. Ch. 152. See also *Re Trade-mark of La Société Anonyme des Verreries de L'Etoile* (1893), 10 R. P. C. 436.

(*m*) (1869) 8 Eq. 475; 39 L. J. Ch. 157.

(*n*) And see *Green's Patent* (1857), 24 Beav. 145; *Morey's Patent* (1858), 25 Beav. 581; 6 W. R. 612.

(*o*) 1883, sect. 117. The Court of the County Palatine of Lancaster has jurisdiction: 53 & 54 Vict. c. 23.

(*p*) *Re King & Co.'s Trade-mark* (1892), 2 Ch. 462; 62 L. J. Ch. 153; 9 R. P. C. 350.

(*q*) Sect. 90 (2).

(*r*) Per Bowen, L. J., in *Pinto* v. *Badman* (1891), 8 R. P. C. 181, 187.

(*s*) *Ibid.*

(*t*) The form of a notice of motion is given *post*, p. 821.

(*u*) See *Re Rivière's Trade-mark* (1884), 26 Ch. Div. 48, 53; 53 L. J. Ch. 455; and on this subject generally cf. sect. 35 of the Companies Act, 1862.

(*x*) 1893, Order LIV. rule 4 (b), (c), (d); Forms App. K, Nos. 1a, &c.

(*y*) R. S. C. 1883, Order LII.

(*z*) R. S. C. 1893, Order LIV. rule 4 (e).

be given as natural justice requires it will suffice (*a*). Thus where the registered proprietor of a trade-mark was domiciled in Ireland, and could not be served with notice of motion, it was held sufficient to send him a copy of the notice, with a letter informing him that proceedings had been commenced which might affect his interest (*b*). Kay, L. J., said: "The Act has left, and I think designedly left, as free a hand as possible to the Courts which have to entertain these applications under the Act in respect of procedure" (*c*). Service of notice of motion to rectify on a foreign company a person out of the jurisdiction will not be allowed; in a trade-mark case it was said that the notice should be served on the comptroller, and when a day had been fixed for the hearing, the foreigner should be informed by letter of the fact and of the purport of the application (*d*).

Notice of rectification to comptroller.

An order of the Court rectifying a register directs due notice of the rectification to be given to the comptroller (*e*). A copy of the order, decree or other authority for the rectification must be served on the comptroller, and he must rectify the register accordingly (*f*).

Falsification of the register or of documents purporting to be copies of the register, or using such documents, is a misdemeanour (*g*).

(*a*) *Re King & Co.'s Trade-mark* (1892), 2 Ch. 462; 62 L. J. Ch. 153; 67 10 R. P. C. 350.
(*b*) *Ibid.*
(*c*) *Ibid.* p. 490.
(*d*) *In the matter of the Trade-mark of La Compagnie Générale D'Eaux Minérales et de Bains de Mer* (1891), 8 R. P. C. 446.
(*e*) 1883, sect. 90 (3).
(*f*) 1883, sect. 111 (2).
(*g*) 1883, sect. 93.

CHAPTER XII.

THE INFRINGEMENT OF LETTERS PATENT.

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 Chap. XIII.

Prohibitory clause in letters patent.

The form of letters patent now in use (*a*), which does not in this respect differ materially from those which have preceded it (*b*), 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 command 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

(*a*) See Form of Patent, pp. 615 *et seq.*

(*b*) *Walton* v. *Bateman* (1842), 1 W. P. C. 613, 615.

(*c*) Subject to sections 13, 15, 17 (4 *b*), 19 and 20 of the Act of 1883. See *post*, p. 442.

may be brought, and an injunction and damages obtained (c). The ways in which a patent may be infringed are clearly pointed out 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 of 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 (frequently styled the ambit of the 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.

Summary of the 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 without the assent of the patentee;

(3) By making for use or sale or vending articles which counterfeit, imitate, or resemble articles made in pursuance of the invention, and which differ only colourably from the invention patented (d).

Intention of infringer immaterial.

In the case of *Heath* v. *Unwin* (e), Parke, B., held that a defendant could not be considered guilty of an indirect infringement unless he had intended to commit it. This doctrine was, however, disapproved of in *Stead* v. *Anderson* (f), 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* (g), and is now clearly overruled (h). In a later stage

(d) See also Hindmarch, p. 487.

(e) (1845) 2 W. P. C. at p. 227; 13 M. & W. 583.

(f) (1847) 16 L. J. C. P. 250; 2 Web. P. C. 151.

(g) (1847–55) 15 Sim. 552, 553; 25 L. J. C. P. 19.

(h) *Stevens* v. *Keating* (1848), 2 W. P. C. 227, n.; *Walton* v. *Lavater* (1860), 29 L. J. C. P. 275; *McCormick* v. *Gray* (1861), 7 H. & N. 25; 31 L. J. Ex. 42; *Newall* v. *Elliott* (1864), 10 Jur. N. S. 954; 13 W. R. 11; *Curtis* v. *Platt* (1864), 3 Ch. Div. 136, n.; 11 L. T. N. S. 245.

of *Heath* v. *Unwin* (*i*), 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 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.

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."

Knowledge immaterial.

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."

Intention no part of infringement.

"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*).

As to the responsibility of employers for the acts of infringement of their servants or agents, see next Chapter (*p*).

By servants or agents.

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

Importation.

(*i*) (1855) 25 L. J. C. P. 19.

(*k*) See also *Curtis* v. *Platt*, *supra*.

(*l*) (1880-82) L. R. 17 Ch. D. 721; 50 L. J. Ch. 582.

(*m*) (1884) 1 R. P. C. at p. 29.

(*n*) (1845) 2 W. P. C. 227, n. (*d*).

(*o*) *Newall* v. *Elliott* (1864), 10 Jur. N. S. 804.

(*p*) Pp. 364 *et seq*.

(*q*) *Walton* v. *Lavater* (1860), 29 L. J. C. P. 279, 280; *Elmslie* v. *Boursier* (1869), L. R. 9 Eq. 217; 39 L. J. Ch. 328; *Wright* v. *Hitchcock* (1870), 39 L. J. Ch. 103, 104, 106; L. R. 5 Ex. 37; *Cartsburn Sugar Refining Co.* v. *Sharp* (1884), per Lord Kinnear, 1 R. P. C. 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 when 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 R. P. C. at p. 31.

rationale of this rule is very clearly explained by James, L. J., in *Von Heyden* v. *Neustadt* (*s*):—

Importation.

"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."

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 manufacture, 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.

Transhipment.

In *Vavasseur* v. *Krupp* (*x*), a foreign sovereign bought in Germany shells made there, but alleged 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 applied to be, and was, made a defendant to the suit. An order

Rights of foreign sovereigns.

(*s*) (1880) L. R. 14 Ch. D. at p. 233; 50 L. J. Ch. 126.

(*t*) (1869) L. R. 9 Eq. 217; 39 L. J. Ch. 328.

(*u*) (1870) L. R. 5 H. L. 1; 40 L. J. Ch. 317; see also 3 De G. J. & S. 87.

(*x*) (1870) L. R. 9 Ch. D. 351.

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.

In *Nobel's Explosives Co.* v. *Jones* (*y*), a patent having been 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 patented 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 persons acting as Custom House agents without control over the goods for an importing firm were not infringers of an English patent, although the importation might have been an infringement.

Foreign vessels in British waters.

The Act of 1883 (*z*) 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 (*a*). It was decided in *Feather* v. *Regina* (*b*) 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 was not because the Crown was 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 (*c*).

(*y*) (1880-82) L. R. 17 C. D. 721; 50 L. J. Ch. 582.

(*z*) Sect. 43. This is a re-enactment of Act of 1852, sect. 26, and was necessitated by the decision in *Caldwell* v. *Vanvlissigen* (1851), 21 L. J. (N. S.) Ch. 71. 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.

(*a*) *Dixon* v. *London Small Arms Co.* (1875), L. R. 1 App. Cas. 632; 46 L. J. Q. B. 617; *Feather* v. *Regina* (1865), 35 L. J. Q. B. 200; 6 B. & S. 257.

(*b*) *Suprà.*

(*c*) *Dixon* v. *London Small Arms Co.* (1875), L. R. 1 App. Cas. 632; 46 L. J. Q. B. 617.

Crown contractors.

In *Dixon* v. *London Small Arms Co.* (*d*), 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 behind the rights of the Crown, even though manufacturing for the Crown (*e*).

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 (sect. 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* (*f*), 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 the 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 *Muntz* v. *Foster* (*g*)—an action for the infringement 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

(*d*) *Supra*.

(*e*) 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; 50 L.J.P.C. 40; *Lancaster's Patent* (1864), 2 Moo. P. C. N. S. 189; and *Hughes's Patent*, L. R. 4 App. Cas. 174; 48 L. J. P. C. 20; also *Petit Smith's Patent*, 7 Moo. P. C. 133. See also Prolongation, Chap. XVII.

(*f*) (1878) L. R. 9 C. D. at p. 66, 67. See also *Higgs* v. *Goodwin* (1858), 27 L.J. Q. B. 145, affirmed p. 421; E. B. & E. 529; *Brereton* v. *Richardson* (1883-84), Griffin, P.C. 54; 1 R.P.C. 165; *Guilbert-Martin* v. *Kerr* (1887), 4 R. P. C. 18.

(*g*) (1844) 2 Web. P. C. 93.

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 is an infringement of the patent (*h*).

In one 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, and pull them to pieces or experiment 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.' I am asked to say that that was not a user in this country. What does the word pupil mean? The defendant says that the pupils are persons who do not pay anything for being taught, but, on the contrary, that those of them who have been a certain time, or certain classes of them, receive some payment; but whether these pupils, these young persons who are admitted into this business for the purpose of learning it, do or do not pay for their instruction, 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

(*h*) *United Telephone Co.* v. *Sharples* (1885), L. R. 29 C. D. 164; 54 L. J. Ch 633.

business. They are admitted upon the terms that part of the remuneration they shall get for their services shall be instruction in the business, and 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 to which I cannot accede. . . . 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 this very obvious case: suppose, for example, if the Singer sewing machine were protected by a patent, a man should buy a cheaper instrument which he knows is made in infringement of the patent, for some member of his household, who uses, let us say for amusement simply, would that be a user in this country or not? Without any doubt it would, although it did not produce to or save him one farthing."

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.

Use of patented invention for a purpose *different from* that for which the patentee intended it.

The use of a patented invention for a purpose other than that specifically pointed out by the patentee in his claims will not always be an infringement. In *Edison* v. *Holland* (*i*) a claim was for a material for the manufacture of the illuminating conductors of electric lamps, produced by electrically heating carbon in a carbon gas. Kay, J., said: "That does not prevent any one from making the same material and using it for other purposes."

In the case of *Higgs* v. *Goodwin* (*k*), the defendant used 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 to purify water, the Court held that he was not infringing, though if a patent for a combination is originally directed to one purpose, and a person afterwards adopts it in order to make it minister to another *and additional* purpose, that person infringes (*l*).

(*i*) (1888) 5 R. P. C. 459, 482; and see *Newton* v. *Vaucher* (1851), 6 Ex. 859; 21 L. J. Ex. 305; *Lister* v. *Eastwood* (1864), 9 L. T. N. S. 766.

(*k*) (1858) E. B. & E. 529; 27 L. J. Q. B. 421. But see remarks of Romer, J., in *Pneumatic Tyre Co.* v. *East London Rubber Co.* (1897), 14 R. P. C. at p. 103. See also *Fletcher* v. *Glasgow Commissioners* (1887), 4 R. P. C. 386.

(*l*) Lord Westbury in *Cannington* v. *Nuttall* (1871), L. R. 5 H. L. 205; 40 L. J. Ch. 739.

What is user?

In the case of *Minter* v. *Williams* (*m*), 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* (*n*), 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. Mr. 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 (*o*).

Where certain patented articles were given to a tradesman for the purpose of being repaired, and were lent by his wife to a third party, without any intention of selling them or evading the patent, it was held that there had been no infringement (*p*).

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 (*q*).

The user in this country of a patented article made abroad is an infringement of the patent (*r*).

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* (*s*) 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

(*m*) (1835) 5 L. J. K. B. 60; 1 Web. P. C. 135.

(*n*) (1860) 8 C. B. N. S. 666; 30 L. J. C. P. 68.

(*o*) An injunction might have been obtained to restrain the threatened infringement: *Frearson* v. *Loe* (1878), 9 Ch. Div. 48, 65; *Adair* v. *Young* (1879), 12 Ch. Div. 13; *Dowling* v. *Billington* (1890), 7 R. P. C. 191; *Shoe Machinery Co.* v. *Cutlan* (1895), 12 R. P. C. at p. 357.

(*p*) *United Telephone Co.* v. *Henry & Co.* (1885), 2 R. P. C. 11; and see *United Telephone Co.* v. *Nelson* (1887), W. N. 193.

(*q*) *Betts* v. *Neilson* (1868–71), 34 L. J. Ch. 537.

(*r*) *Betts* v. *Neilson* (1865), 34 L. J. Ch. 537; 3 De G. J. & S. 22; L. R. 5 H. L. 1; 40 L. J. Ch. 317.

(*s*) (1879) L. R. 12 Ch. D. 13.

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.* (*t*), 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 (*u*).

Infringement by sale.

In *Townsend* v. *Haworth* (*x*) 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* (*y*). It is a necessary deduction from the proposition 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; but if component parts are sold in such manner that they could be put together without difficulty, the patent will probably have been infringed (*z*).

(*t*) (1884) 1 R. P. C. 117.

(*u*) *Russell* v. *Ledsam* (1845), 14 M. & W. 574; 14 L. J. Ex. 353; affirmed 16 L. J. Ex. 145; 16 M. & W. 641.

(*x*) (1875) L. R. 12 Ch. D. 831 (n).

(*y*) (1878) L. R. 12 Ch. D. at p. 833; cp. *Briggs* v. *Lardeur* (1884), 1 R. P. C. 126; 2 R. P. C. 13.

(*z*) *United Telephone Co.* v. *Dale* (1884), 25 Ch. Div. 778. See also *Newall* v. *Elliot* (1864), 10 Jur. N. S. 954.

It is not an infringement innocently to make articles in themselves not within the patented invention, though the person for whom they are made intends to utilise them in a combination which is an infringement (*a*).

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 (*b*).

It must be observed that though the sale of a patented article is an infringement, the buyer has no remedy on an implied warranty that the article may be used against the person who sold the article as a patent to him (*c*).

Sub-purchaser's position.

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 (*d*).

Effect of the grant of a licence.

But the mere fact that the grantors of a licence to manufacture articles in Belgium and not elsewhere had a monopoly of the invention in England would not import, as a matter of construction, into the Belgian licence, the grant of a right to interfere with the English monopoly by selling in England when there was no express grant of a right to sell in England (*e*).

A licence to manufacture an article is an authority to purchasers to sell again without the consent of the patentee (*f*). Sometimes the licensee has power to sell only in a given district; in such case a purchaser from the licensee has full power to use the article or even to resell, at any rate unless he had notice of the restriction when the article was sold to him (*g*). It has been decided by the Supreme Court of the United States that the sub-purchaser may use and resell the article anywhere, though he had notice of the limited nature of the licensee's right (*h*). In *Heap* v. *Hartley* (*i*) an exclusive licensee for sale for a limited

(*a*) *Savage* v. *Brindle* (1896), 13 R. P. C. 266.

(*b*) *Cole* v. *Saqui* (1888), 5 R. P. C., per Kekewich, J., at p. 493.

(*c*) *Montford* v. *Marsden* (1895), 12 R. P. C. 266.

(*d*) *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.

(*e*) *Ibid.*

(*f*) *Thomas* v. *Hunt* (1864), 17 C. B. N. S. 183.

(*g*) *Incandescent Gas Co.* v. *Cantelo* (1895), 12 R. P. C. 262; *Betts* v. *Willmott* (1870), L. R. 6 Ch. 239.

(*h*) *Keeler* v. *Standard Folding Bed Co.*, 157 U.S. 659, 8th April (1895). See an interesting article in 10 Harvard Law Review, p. 1.

(*i*) (1888) 5 R. P. C. 603. See also, in the Court of Appeal, 42 Ch. Div. 461; 6 R. P. C. 495; 58 L. J. Ch. 790.

district failed to recover against a person who bought the patented articles and introduced them to the district without notice of the licence.

The partner of one who has a personal right to manufacture or sell cannot manufacture or sell without infringing, for he is something more than a mere agent (*k*).

Procuring manufacture of intringing 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 (*l*).

Offers to execute orders for articles which might or might not be infringements.

In the case of *Gwynne* v. *Drysdale* (*m*) a curious point was raised. The pursuer, being patentee of an invention of "improvements 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 (*n*), 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.

It is not the duty of the patentee to inform persons that they are infringing the patent, nor by abstaining from so doing is the patentee estopped from alleging the infringement on the ground of standing by (*o*); but he cannot send an agent to purchase the infringing article, and then proceed on the sale (*p*). And where the patentee's agent went to the defendants to buy an infringing article and succeeded only in getting the loan of it, an action for infringement by sale was dismissed (*q*).

(*k*) *Howard and Bullough* v. *Tweedale* (1895), 12 R. P. C. 519.

(*l*) *Gibson* v. *Brand* (1842), 1 Web. P. C. 631, per Tindal, C. J., and see note (*d*).

(*m*) (1885) 2 R. P. C. 160; 3 R. P. C. 65.

(*n*) (1886) 3 R. P. C. 65.

(*o*) *Proctor* v. *Bennis* (1887), 36 Ch. Div. 740; 57 L. J. Ch. 11; 4 R. P. C. 333.

(*p*) *Kelly* v. *Batchelar* (1893), 10 R. P. C. 289.

(*q*) *United Telephone* v. *Henry* (1885), 2 R. P. C. 11.

As regards infringement by repairing a patented article, see *United Telephone Co.* v. *Nelson* (*r*).

Ordering the making of an infringing article.

The person who orders an infringing article to be made is guilty of infringement (*s*), but one who licenses another to infringe a patent is not necessarily himself an infringer (*t*).

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 (*u*).

One or two general illustrations may be given.

In *Cornish* v. *Keene* (*x*), 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.

Novelty and infringement are not to be determined by similar evidence.

In *Newton* v. *Grand Junction Railway Co.* (*y*), 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

(*r*) (1887) W. N. 193.

(*s*) *Gibson* v. *Brand* (1842), 1 W. P. C. 631; 4 M. & G. 179.

(*t*) *Montgomerie* v. *Peterson* (1894), 11 R. P. C. at p. 237.

(*u*) See *post*, p. 350, under Combinations.

(*x*) (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), *Ibid.* 270; 9 C. & P. 336; *Newton* v. *Grand Junction Railway Co.* (1846), 20 L. J. Ex. 427, n.; 5 Exch. 334; *Sellers* v. *Dickinson* (1850), 20 L. J. Ex. 417; 5 Exch. 312, 326; *Electric Telegraph Co.* v. *Brett* (1851), 20 L. J. C. P. 123; 10 C. B. 838; *Smith* v. *London and North-Western Railway 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. 164; *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; 38 L. J. Ch. 627; *Wright* v. *Hitchcock* (1870), L. R. 5 Ex. 37; 39 L. J. Ch. 97; *Hinde* v. *Osborne* (1885), 2 R. P. C. 64; *United Horsenail Co.* v. *Stewart*, *Ibid.* 122.

(*y*) (1846) 5 Exch. 334; 20 L. J. Ex. 427, n. See also *Murray* v. *Clayton* (1870), 7 Ch. 570; *Caldwell* v. *Van Vlissingen* (1851), 9 Hare, 415; 21 L. J. Ch. 97.

jury are of opinion that the difference is merely colourable, it is an infringement."

In *Sellers* v. *Dickinson* (*z*), 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" (*z*). 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 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" (*a*).

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 (*b*).

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 licence 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 (*c*). 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 (*d*).

Infringement question of fact.

Whether there has or has not been infringement, is to be determined according to the circumstances of each case. In a

(*z*) 5 Exch. 312; *Hills* v. *Liverpool Gas Co.* (1863), 32 L. J. Ch. 28.

(*a*) *Ibid.*, 326.

(*b*) *Ehrlich* v. *Ihlee* (1888), 5 R. P. C. 437: *Neilson* v. *Harford* (1841), 1 Web. P. C. 310, 328.

(*c*) *Ex parte Fox* (1812), 1 Web. P. C. 431; *Harmer* v. *Playne* (1807), 14 Ves. 130; *Lewis* v. *Davis* (1829), 1 Web. P. C. 489; *Crane* v. *Price* (1842), *Ibid.* 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.

(*d*) Sect. 22.

measure the question of infringement is a mixed question of law and fact, for where everything in the nature of fact 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 (*e*). 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" (*f*). 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, which the Judge is bound to submit to the jury if there be one (*g*). 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 (*h*).

What are questions of fact and what of law.

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.

Must clearly ascertain subject-matter.

This point, of which the importance can hardly be over-estimated, will be best explained by a reference to a few decided cases.

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 courses of unequal lengths. In the complainers' machine, the needles

(*e*) *Seed* v. *Higgins* (1860), 30 L. J. Q. B. 314; 8 H. L. C. 550; *Curtis* v. *Platt* (1866), 35 L. J. Ch. 852.

(*f*) *De la Rue* v. *Dickinson* (1857), per Campbell, C. J., 7 E. & B. at p. 755; *Westinghouse* v. *The L. & Y. Railway Co.* (1884), per Grove, J., 1 R.P.C. 237, 238.

(*g*) *Curtis* v. *Platt* (1866), L. R. 1 H. L. 337; 35 L. J. Ch. 852; *Benno Jaffe, &c.*, *Fabrik* v. *Richardson* (1894), per Kay, L. J., 11 R. P. C. 265.

(*h*) *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 Railway Co.* (1846), 20 L. J. Ex. 427, n.; 5 Exch. 331; *Stevens* v. *Keating* (1847), 2 Web. P. C. 191.

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 (*i*).

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 (*k*).

(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 counterbalance to the pressure against the back of such chair." Any application of that principle to the same subject producing this effect, and nothing short of that, is an infringement of the patent (*l*).

Importance of construction of the specification.

The exact meaning of the specification, and especially of the claims, is the most important matter to be determined when a dispute as to infringement occurs. In *Boyd* v. *Horrocks* (*m*) the House of Lords reversed the decision on infringement of the Court of Appeal, a result caused solely by the different interpretation put upon the claims by the two Courts. As Romer, J., said in *Nobel's Explosives Co.* v. *Anderson* (*n*): "In order to make out an infringement, it must be established, to the satisfaction of the Court, that the alleged infringer, dealing with what he is doing as a matter of substance, is taking the invention claimed by the patent, not the invention which the patentee might have claimed if he had been well advised or bolder, but that which he has in fact and substance claimed on a fair construction of the specification."

(*i*) *Mackie* v. *Berry* (1885), 2 R. P. C. 146.

(*k*) *Gosnell* v. *Bishop* (1888), 5 R. P. C. 41, 151. See also *Barber* v. *Grace* (1847), 17 L. J. Ex. 122; 1 Ex. 339.

(*l*) *Minter* v. *Wells* (1834), 1 Web. P. C. 134; cp. *Couchman* v. *Greener* (1884), 1 R. P. C. 197; *Nordenfelt* v. *Gardner* (1884), *ibid.* 61; *Walker* v. *Hydro-Carbon Syndicate* (1885), 2 R. P. C. 8; *Sugg* v. *Bray* (1885), *ibid.* 223–239; *Richardson* v. *Castrey* (1887), 4 R. P. C. 265; *Ellington* v. *Clark* (1888), 5 R. P. C. 319; *Garrard* v. *Edge* (1889), 6 R. P. C. 563; *Boyd* v. *Horrocks* (1889), *ibid.* 152; *Automatic Weighing Co.* v. *Combined Co.* (1889), 6 R. P. C. 367.

(*m*) (1891) 9 R. P. C. 77.

(*n*) (1894) 11 R. P. C. 128.

Infringement a question of fact.

Having got the true meaning of the claims, and having determined the acts done by the alleged infringer, it is a question of fact whether these acts are within the claims. If the alleged infringing article and the invention covered by the patent are identical, the solution is simple. This is seldom the case. But if it appear that though the infringer has not slavishly copied the patentee's invention, yet that he has taken the substance of it, infringement will have been proved (*o*). "If the pith and marrow of the invention is taken it is no excuse to say that you have added something or omitted something, even if the addition or omission be useful and valuable" (*p*).

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 known mechanical equivalents (*q*).

Cases.

In *Hayward* v. *Pavement Light Co.* (*r*), 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 in the shape of a curve; it was held, that the defendants had infringed.

In *Shoe Machinery Co.* v. *Cutlan* (*s*) the defendant's machine for lasting boots differed from that covered by the plaintiffs' patent, in that defendant's machine could not be used for the intended purpose without a separate tool, which tool was well known and old. But the Judge, holding that the tool was intended to be used, not as an ordinary hand-tool, but to be incorporated with the machine, and that when so used the defendant's machine was the same as the plaintiffs', decided that there had been an infringement, none the less because the tool

(*o*) The Court may take the evidence of experts as to the relative importance of the different parts of the invention, in order to determine whether the substance has been taken: *Incandescent, &c., Co.* v. *De Mare Incandescent Syndicate* (1896), 13 R. P. C. 301, 559.

(*p*) Bowen, L. J., in *Wenham Gas Co.* v. *Champion Gas Co.* (1892), 9 R.P.C.49, 56; *Incandescent Gas Light Co.* v. *De Mare Incandescent Gas Light Syndicate* (1896), 13 R. P. C. 301, 559.

(*q*) *Dudgeon* v. *Thomson* (1877), per Lord Cairns, C., 3 A. C. 34; cp. *Morgan* v. *Seaward* (1836), per Alderson, B., 1 Web. P. C. 171; *Walton* v. *Potter* (1841), 1 Web. P. C. 586; *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. Div. 13; *Muirhead* v. *Commercial Cable Co.* (1895), 12 R. P. C. at p. 63.

(*r*) (1884), 1 R. P. C. 207; *Hinde* v. *Osborne, ibid.* 221; 2 R. P. C. 64.

(*s*) (1895) 12 R. P. C. 342.

and the defendant's machine were severable, and when apart showed no obvious infringement.

In *United Telephone Co.* v. *St. George* (*t*), 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 plaintiffs' 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* (*u*), 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* (*x*), the grantee of a patent for improvements in mechanical musical instruments brought an action for alleged infringement. The defendants denied infringement. It was held

(*t*) (1886) 3 R. P. C. 321.
(*u*) (1887) 4 R. P. C. 303.
(*x*) (1888) 5 R. P. C. 437; *Winby* v. *Manchester, &c., Steam Tramways Co.* (1889, 1890), 6 R. P. C. 365; 7 R. P. C. 30; *Shaw* v. *Jones*, 6 R. P. C. 328; *Automatic Co.* v. *Combined Co.*, *ibid.* 120.

at the trial, that the plaintiff's combination was new; and that the 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.

Colourable evasions in chemical cases.

A similar rule holds when the patent is for a chemical process. Thus in *Stevens* v. *Keating* (*y*) the specification 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* (*z*), 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

(*y*) (1847) 2 W. P. C. 181; cp. *Talbot* v. *La Roche* (1854), 15 C. B. 310.

(*z*) (1852) Johns. Pat. Man. 6th ed. 254.

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 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* (*a*), 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."

"Colourable" imitation.

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 (*b*).

The word "colourable" is often used when the difference between the infringing and infringed manufacture is apparent and not real. The word "colourable" is not the best possible, inasmuch as it may convey the idea that an invention may be infringed without being identically copied. This is not so; the identity may be hidden, but there can be no infringement unless the identity exists (*c*).

(*a*) (1844) 2 Web. P. C. 95.

(*b*) See *Patent Type Founding Co.* v. *Richards* (1859), 1 Johns. 381, which throws light on this point.

(*c*) *Dudgeon* v. *Thompson* (1877), 3 App. Ca. 34. And cf. two recent cases: *Tweedale* v. *Ashworth* (1892), 9 R. P. C. 121; *Henser* v. *Hardie* (1894), 11 R.P.C. 421.

Production of same results by different methods.

A difficulty arises when the alleged infringement produces the same result as that produced by the patented method, but by a different method. If the patentee has claimed the product, and such claim is good (as to which see *ante*, p. 29), of course there is an infringement; but otherwise the law may be thus expressed:—

(1) Where the invention is of something not before known, and not merely of a new method of carrying out a known result, that is, where the result is new, the Court looks very narrowly and very jealously upon any other machines for effecting the same object, to see whether or not they are merely contrivances for evading the patent (*d*). A patent of this kind is often called a "master" or "pioneer" patent, and cannot be evaded by the substitution of known equivalents for producing the same results.

Infringement of pioneer or master patents.

(2) But 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 (*e*).

Whilst, therefore, there is doubt whether the patentee even of a pioneer invention is entitled to prevent others from attaining the same results by any and every different method (*f*), it is clear that in the matter of degree, the Court will more severely examine an alleged infringement of such a patent than an alleged infringement of an invention which merely aims at an improved method of attaining an already known result. In the former case equivalents for parts of the invention, or rather, contrivances known to be equivalents, will not differentiate the infringer's method from that of the patentee; in the latter more latitude is allowed, provided that the alleged infringer has not taken the actual means employed by the patentee. In neither case is there infringement unless the actual invention has been taken; but in

Use of equivalents.

(*d*) *Proctor* v. *Bennis* (1887), 36 Ch. Div. 740; 57 L. J. Ch. 11; 4 R. P. C. 333; *Automatic Weighing Machine Co.* v. *Knight* (1889), 6 R. P. C. 297; *Ibid.* v. *National Exhibitions Association* (1892), 9 R. P. C. 41; *Nobel's Explosives Co.* v. *Anderson* (1894), 11 R. P. C. 519; *Incandescent Gas Light Co.* v. *De Mare Incandescent Syndicate* (1896), 13 R. P. C. 301, 559. Especially see judgment of Kay, L. J.; also in the House of Lords, 12 R. P. C. 164.

(*e*) *Curtis* v. *Platt* (1863), 3 Ch. Div. 135, n., and cases in the last note; also *Brown* v. *Jackson* (1895), A. C. 446; 12 R. P. C. 311, 324.

(*f*) See *ante*, p. 29 *et seq.*, and cf. Pearson, J., in *Badische, &c.*, v. *Levinstein* (1883), 24 Ch. Div. 52 L. J. Ch. 704; 2 R. P. C. 73, at p. 671, with Kay, L. J., in *Nobel Explosives Co.* v. *Anderson*, *supra*.

the former case the result is part of the invention; in the latter it is not (*g*).

Illustrations.

Curtis v. *Platt*.

The following cases are illustrative of the above:—

In *Curtis* v. *Platt* (*h*) 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, that there had been an infringement of the plaintiff's patent. Wood, V.-C., said, in language which has often been quoted with approval: "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 before done. When the object itself is one which is not new, but the means only are new, one is not inclined to say that a person who invents a particular means of doing something that has been known to all the world long before, has a right to extend very largely the interpretation of those means which he has adopted for carrying it into effect. . . . In such a case it may be said that the means taken are simply mechanical equivalents for the means previously adopted for arriving at the same object. One looks more jealously at the claims of inventors seeking to limit

Judgment of Wood, V.C.

(*g*) *Ticket Punch Register Co.* v. *Colley's Patents* (1896), 12 R. P. C. 172. See also *Howes* v. *Webber* (1895), 12 R. P. C. 468; *Incandescent Gas Light Co.* v. *De Mare Incandescent Co.* (1896), 13 R. P. C. 301, 559.

(*h*) (1863) 3 Ch. Div. 135, n.; in the House of Lords, 35 L. J. Ch. 852.

the rights of the public at large for effecting that which has been commonly known to all the world long ago. . . . I think it extremely important to follow the rule laid down in the House of Lords, in *Seed* v. *Higgins* (*i*), that if you find a specific mechanical improvement claimed, then you must hold the person 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."

Proctor v. *Bennis.*

This decision may most usefully be compared with *Proctor* v. *Bennis* (*k*). The patent in question had for its object "improved and self-acting mechanism for supplying to and distributing 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. Cotton, L. J., said, referring to *Curtis* v. *Platt* (*l*): "The principle alleged to have been laid down was that where an invention is claimed for improvements in machinery consisting only in a combination, there the patentee must be held to the description which he gives of the particular means by which his invention is to be carried into effect, and that the doctrine of mechanical equivalent cannot apply. In my opinion that case does not apply to the present, because the observations there made were applied to the case where the patent was for an improvement in a machine which had been long in use for producing a certain result. There was no novelty in the results to be produced, and the only novelty which could be claimed was the application and

(*i*) (1860) 8 H. L. C. 550; 30 L. J. Q. B. 314.

(*k*) (1887) 36 Ch. Div. 740; 57 L. J. Ch. 11; 4 R. P. C. 333.

(*l*) *Supra.*

use of certain mechanical means in order to produce in a known machine the same result which in that known machine had been produced by other mechanical means. That, to my mind, distinguishes the case from the present. . . . In my opinion, therefore, the opinions expressed by the Judges with reference to mere improvements in an old machine for an old purpose, cannot apply to a case like this, where there was not only novelty in the machine, but novelty in the result to be produced by that machine."

Automatic Weighing Machine v. *Knight.*

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 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. The defendant attained the same result as the patentee, but he did it by a different method, and as this method was not a mere colourable imitation, nor brought about by the mere substitute of known equivalents for the parts as used by the patentee, he was held not to have infringed. This case shows that though a machine be a combination to produce a new result, yet that the patentee is not entitled to protection unless the actual invention claimed by him has been taken. The Court will look with great care to find if the invention has in reality been infringed, but it will not hold every method of attaining the result to be an infringement.

The last mentioned case may be compared with *Automatic Weighing Machine Co.* v. *National Exhibitions Association* (*n*), when the Court, dealing with the same patent, decided that an infringement had been committed. The defendants had taken the invention of the patentee, and had given effect to it in a different way, substituting mechanical equivalents for the details used by the patentee. The patentee's machine being a new one and accomplishing new results, the doctrine of *Proctor* v. *Bennis* (*o*) applied, and the infringement was proved.

Mechanical equivalents.

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 equivalents applies in such a case.

(*m*) (1889) 6 R. P. C. 297; cp. *United Horse Nail Co.* v. *Swedish Horse Nail Co*, *ibid.* 1; *Boyd* v. *Horrocks*, *ibid.* 152.

(*n*) (1892) 9 R.P. C. 41.

(*o*) 36 Ch. Div. 740; 57 L. J. Ch. 11; 4 R. P. C. 333.

Thomson v. *Moore*.

This point was decided in *Thomson* v. *Moore* (*p*). 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 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

(*p*) (1889) 6 R. P. C. 426; and in the House of Lords on appeal, 7 R. P. C. 325.

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 (Ireland) 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 (Ireland), 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 an infringement. This judgment was upheld by the House of Lords.

Ticket-Punch Co. v. Colley's Patents.

A recent case—*The Ticket-Punch Register Co.* v. *Colley's Patents* (*q*), shows the application of the principles above set out. The patent related to ticket-punching machines, and the patentee was aware that ticket-punches had been contrived with the intention of preventing the operation of the punch until a ticket is inserted. He invented an improvement consisting of an apparatus in which the punch was set fast and had to be released, the mechanism for holding or fastening the punch back he called the locking device, and its ingenuity was not denied. It was so contrived that the punch was held back until released by the rising of a pin in it, and the rising was caused by the insertion of the ticket. The fundamental idea and essence of the invention was first to hold back the punch, and then to

(*q*) (1895) 12 R. P. C. 171. See also *Jardine* v. *King, Mendham & Co.* (1896), 13 R. P. C. 411; *Birch* v. *Harrap* (1896), 13 R. P. C. 615.

release it. The defendants arrived at the same end by different means. Their punch was always free to move, it was not held back or locked at all. But they availed themselves of the idea of having a movable punch accompanied by a pin prevented by the ticket from descending when the punch came down and made a perforation. Having decided that the locking device was an essential part of the plaintiff's patent, the Court decided that there had been no infringement. Lindley, L. J., said: "The same result is obtained, but the whole combination is in substance quite different, and the variations are so great, and are occasioned by so different a conception of the problem to be solved, that they cannot be said to be slight, or to be mechanical equivalents for mechanism adopted by the plaintiffs."

Later on he says: "Before any question of mechanical equivalents can arise, the conclusion must be arrived at that the substance of the invention has been taken. Then, if the differences are really immaterial, from that point of view, they ought to be neglected. But if two persons solve the same mechanical problem in two substantially different ways, starting from different conceptions, and both succeed, neither method of solution can be considered as the mechanical equivalent of the other, although each method may involve the use of well-known contrivances, and much may therefore be common to both." Smith, L. J., said the case fell within *Curtis* v. *Platt* (*r*) and not within *Proctor* v. *Bennis* (*s*).

Older cases.

The older cases are to the same effect. Thus, Pollock, C. B., in delivering the judgment of the Court in *Bovill* v. *Pimm* (*t*), 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.

Bovill v. *Pimm.*

Again, in *Seed* v. *Higgins* (*u*), the plaintiff claimed by his

Seed v. *Higgins.*

(*r*) (1866) 3 Ch. Div. 135, n.; 35 L. J. Ch. 852.

(*s*) (1887) 36 Ch. Div. 740; 57 L. J. Ch. 11; 4 R. P. C. 333.

(*t*) (1856) 11 Ex. 718.

(*u*) (1860) 8 H. L. C. 550; 30 L. J. Q. B. 314. See also *Wilson* v. *Barbour* (1888), 5 R. P. C. 245, 675.

amended specification 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.

In the cases the equivalents referred to were mechanical equivalents. But it is submitted that, when once the facts are fully understood, the same rules apply to chemical equivalents.

Same principles apply to chemical equivalents.

It is true that 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 (*x*). And in *Heath* v. *Unwin* (*y*), 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.

There is in this nothing to differentiate chemical from mechanical equivalents. The substitution of a mechanical equivalent may be sufficient to prevent infringement, if at the time of the application for the patent it was not known to be such. In the course of advising the House of Lords in *Unwin* v. *Heath* (*z*), Williams, J., said; "I fully agree with the doctrine which has been repeatedly laid down in the course of the discussion of this cause, that though the use of a chemical or mechanical substitute which is a known equivalent to the thing pointed out by the specification, and claimed as an invention, amounts to an infringement of the patent; yet if the equivalent

(*x*) Per Pearson, J., in *Badische, &c.* v. *Levinstein* (1883), 24 Ch. Div. at p. 171; 52 L. J. Ch. 704.

(*y*) (1855) 2 W. P. C. 236.

(*z*) (1855) 5 H. L. C. 545; 25 L. J. C. P. 8.

were not known to be so at the time of the patent and specification, the use of it is no infringement."

It will be observed that the learned Judge treats alike of chemical and mechanical equivalents, and does not differentiate between them; and a servile imitation or colourable evasion of a chemical process or product will be as much an infringement of a patent for that process or product (*a*).

Colourable evasion of a chemical process.

Again, in *Mantz* v. *Foster* (*b*), 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."

The use in a manufacture of an equivalent, not known to be such, will not be an infringement even of a pioneer patent if the patent be for a process. In *Nobel's Explosive Co.* v. *Anderson* (*c*), the patentee claimed "the manufacture from nitro-glycerine and soluble nitro-cellulose of a honey or semi-honey explosive compound." The defendant made the explosive with insoluble nitro-cellulose, and it was urged that there was the mere substitute of one chemical equivalent for another. The defendant succeeded in all the Courts. In the House of Lords Lord Herschell said: "No doubt there may well be cases where a chemical compound patented would protect against the manufacture of the compound in which one of the ingredients differed, where there had been a substitution for one chemical ingredient of that which was known to all chemists to be a mere chemical substitute for the other, producing the same reactions, it might be, or in some other way recognized as the equivalent of the other, so that any chemist would know that merely to change this particular ingredient and substitute the other for it would make no real difference in the

(*a*) See, *e.g.*, *Stevens* v. *Keating* (1847), 2 W. P. C. 181. But the Judge 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.

(*b*) (1844) 2 W. P. C. at p. 95.

(*c*) (1894) 11 R. P. C. 519; affirmed in the House of Lords, 12 R. P. C. 164.

compound. There might well be such a case I quite admit. . . . But what is the evidence that in 1888 any chemist would have known that wherever 'soluble' was mentioned in this patent, 'insoluble' might be understood as a substitute in its action in all respects equivalent to the other? The evidence seems to me to be the other way."

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* (*d*): "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?" Or, as it has otherwise been said: To infringe a patent for a combination, it is not enough that a part or even a material part has been taken; the combination must have been taken (in a reasonable sense) as a whole. And, on the contrary, it is not necessary that the entire combination should have been taken; if, making allowance for all due differences, the pith and marrow has been taken, that suffices (*e*).

A collusive imitation of the invention may be effected, though some detail of the combination may be omitted or changed (*f*). But an infringement of a combination does not take place merely where the details are copied into a new combination—unless, indeed, the subordinate integers are themselves the subject of a special claim (*g*).

The following cases are illustrative (*h*):—

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 (*i*). Thus in *Clark* v.

(*d*) (1887) 36 Ch. Div. 740; 57 L. J. Ch. 11; 4 R. P. C. 333.

(*e*) *Incandescent Gas Light Co.* v. *De Mare Incandescent Gas Light System* (1896), 13 R. P. C. 301, 559. *Miller* v. *Clyde Bridge Steel Co.* (1891), 8 R. P. C. 198; 9 R. P. C. 470. See also, per Vaughan Williams, J., in *Automatic Weighing Machine Co.* v. *National Exhibitions Association*, 8 R. P. C. at p. 350.

(*f*) *Incandescent, &c., Co.* v. *De Mare, &c., Co.* (*see last note*); Lord Penzance, in *Harrison* v. *Anderston Foundry Co.* (1876), 1 App. Ca. at p. 593; *Benno Jaffé, &c., Fabrik.* v. *Richardson* (1894), 11 R. P. C. 261.

(*g*) *Foxwell* v. *Bostock* (1864), 4 De G. J. & S. 298; *Clark* v. *Adie, infra*, note (*i*).

(*h*) Many of the cases quoted in this chapter *supra* illustrate the law governing infringement of combinations.

(*i*) *Curtis* v. *Platt* (1866), 3 Ch. Div. 135, n; 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; cp. *Dudgeon* v.

Adie (*k*) 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 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 patent did not protect the subordinate combination.

Again, in *Parkes* v. *Stevens* (*l*), 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?" (*m*).

Question is, Has essence of combination been adopted?

In *Flower* v. *Lloyd* (*n*) 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,

Thomson (1877), L. R. 3 A. C. 34; *Clark* v. *Adie* (No. 1, 1875), L. R. 10 Ch. 667; 45 L. J. Ch. 228; *Townsend* v. *Haworth* (1875), 12 Ch. D. 831, n.; *Harrison* v. *Anderston Foundry Co.* (1876), L. R. 1 A. C. 574; *Incandescent, &c. Co.* v. *De Mare, &c. Syndicate* (1896), 13 R. P. C. 301.

(*k*) (1877) 2 A. C. 315 (a mechanical case), followed in *Incandescent Gas Light Co.* v. *De Mare Incandescent Co.* (1896), 13 R. P. C. 301, 559 (a chemical case).

(*l*) (1869) L. R. 8 Eq. 358; on appeal, 5 Ch. 36; 38 L. J. Ch. 627; *Saxby* v. *Clunes* (1869–74), 43 L. J. Ex. 228.

(*m*) Cp. *Walton* v. *Potter* (1841), 1 Web. P. C. 586, 587; *Thorn* v. *Worthing Skating Rink Co.* (1876), L. R. 6 Ch. D. 415, n.

(*n*) (1877) W. N. 132; and see *S. C. ibid.* 71; *Burnett* v. *Tate* (1883), Johns. Pat. Man. 260; *Mason* v. *Goodwin* (1889), 6 R. P. C. 235.

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* (*o*) 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.

(*o*) (1882) 21 Ch. D. 720; 51 L. J. Ch. 705.

CHAPTER XIII.

THE ACTION OF INFRINGEMENT.

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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

Vindication of patent privilege entirely dependent upon the law.

extent be vindicated by the physical means at the command of the owner; but with respect to an incorporeal right, such as a patent privilege, which is a mere creature of the law, the proprietor must depend almost entirely upon the law itself for vindication and support (*a*).

Star Chamber.

The infringement of patent rights was a wrong for which neither the common nor the early statute law of England provided any remedy (*b*). 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 be 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 recognised to be the proper remedy for the infringement of patent rights.

Damages at common law against infringers.

Fuller remedy in equity Courts.

Injunction in Chancery.

In addition to an action at law, the owner of an invaded patent was entitled 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. But the Court of Chancery, by means of its process of injunction, could protect the patentee against the future invasion of his privilege.

Again—and here the language of Hindmarch (*e*) may be quoted

(*a*) Hindmarch, p. 248.
(*b*) Coryton, 262.
(*c*) Webster, Letts. Pat. p. 42, n. (*y*).
(*d*) Coryton, *ubi supra*, and authorities there cited.
(*e*) Page 306.

"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.

How Court of Chancery obtained jurisdiction.

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 (*f*). 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 the property of the patentee until his legal right could be ascertained by the jurisdiction to which it properly belonged (*g*).

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 (*h*). 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

(*f*) *Calcraft* v. *West* (1845), 2 Jones & Lat. 128.

(*g*) *Harman* v. *Jones* (1841), per Cottenham, L. C., 1 Cr. & Ph. 299: *Sparrow* v. *Oxford, Worcester and Wolverhampton Rail. Co.* (1851), 9 Hare, 441.

(*h*) *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.

validity of the grant, the claim of the plaintiff to the property it conferred, and the fact of infringement" (*i*).

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* (*k*), 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* (*l*), 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* (*m*), 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 (*n*), "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 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 (*o*).

Act of 1852.

The Patent Law Amendment Act, 1852, made the first advance towards the fusion of law and equity.

But limited view of these powers taken.

Although it was held in the judicial construction of this statute (*p*), that "the intention of the Legislature was to vest in the Courts of common law the power to order an injunction,

(*i*) Coryton, p. 320. See Foub. Eq. 43.

(*k*) (1715) 2 Dick. 647; cp. *Soltau* v. *De Held* (1851), 2 Sim. N. S. 133, and cases there cited.

(*l*) (1794) 2 Ves. jun. 486.

(*m*) (1841) 1 Web. P. C. 730, n. (*a*): cp. *Universities of Oxford and Cambridge* v. *Richardson* (1802), 6 Ves. 689.

(*n*) Page 307.

(*o*) See *post*, pp. 370, 431.

(*p*) *Patent Type Founding Co.* v. *Lloyd* (1860), per Martin, B., 5 H. & N. 192; 29 L. J. Ex. 207; cp. *Holland* v. *Fox* (1854), 23 L. J. Q. B. 357; 3 E. & B. 977.

inspection and account (therefore) 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 (*q*). Thus it was decided in *Gittins* v. *Symes* (*r*), that the injunction which a Court of law might grant under 15 & 16 Vict. c. 83, s. 42, was, like the injunction under sect. 82 of the Common Law Procedure Act, 1854, a rule to show cause only, in the first instance: and in *Vidi* v. *Smith* (*s*), 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).

The Judicature Acts and the Rules of the Supreme Court apply to actions for infringement of letters patent for inventions, unless the wording of the Patent Act in any particular provides otherwise (*t*). Therefore, what follows in this chapter will, in the main, be confined to those matters in which the practice in patent cases differs from that followed in other litigations, or to illustrations from patent cases of the ordinary rules of practice.

SECT. 2.—COMMENCEMENT OF ACTION.

(1.) *General.*

Provisions of Act of 1883, sects. 13, 15.

Under the Patents Act, 1883 (*u*), 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,

(*q*) Lawson, p. 189.

(*r*) (1854) 24 L. J. C. P. 48; 15 C. B. 362.

(*s*) (1854) 23 L. J. Q. B. 342; 3 E. & B. 969; cp. *Patent Type Founding Co.* v. *Lloyd*, *supra*, and *Patent Type Founding Co.* v. *Walter*, 29 L. J. Ex. 207; Johns 727.

(*t*) See, *e.g.*, *Re Haddan's Patent* (1884), 54 L. J. Ch. 126; *Shoe Machinery Co.* v. *Cutlan* (1896), 1 Ch. 108; 65 L. J. Ch. 314; 13 R. P. C. 315.

(*u*) Sects. 13 and 15.

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" (*x*).

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 (*y*), besides laying himself open to a charge of laches (*z*). 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 *Borill* v. *Crate* (*a*), 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 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 (*b*), or to discontinue

(*x*) Sect. 17, sub-sect. 4 (b).

(*y*) *Borill* v. *Goodier* (1865-67), per Romilly, M. R., 2 Eq. p. 199; 35 L. J. Ch. 432.

(*z*) *Bridson* v. *Benecke* (1849), 12 Beav. 1; *Borill* v. *Crate* (1865), 1 Eq. 388.

(*a*) (1865) L. R. 1 Eq. at p. 391. The course here suggested is referred to with approval in *North British Rubber Co.* v. *Gormully and Jeffery Manufacturing Co.* (1895), 12 R. P. C. at p. 21.

(*b*) *Cooper* v. *Whittingham* (1880), L. R. 15 Ch. D. 501; 49 L. J. Ch. 752; *Upmann* v. *Forester* (1883), 24 Ch. D.

proceedings upon the defendant admitting and promising not to repeat the infringement (*c*).

Costs of unnecessary action disallowed.

In the case of *Nunn* v. *D'Albuquerque* (*d*), 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. See also *Lyon* v. *Mayor of Newcastle* (*e*), where an injunction was refused.

(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 (*f*).

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 (*g*).

Action by one of several co-owners.

One of several co-owners of a patent has a right to sue alone (*h*) for an injunction and for his proportionate share of damages (*i*).

231; 52 L. J. Ch. 946; *Goodhart* v. *Hyett* (1883), 25 Ch. D. 182; *United Telephone Co.* v. *London, &c., Telephone Co.*, 32 W. R. 870; 26 Ch. Div. 766; *Nicols* v. *Pitman* (1884), 26 Ch. D. 374; *Wittman* v. *Oppenheim* (1884), 54 L. J. Ch. 56; 27 Ch. D. 260; 28 S. J. 499; *Upmann* v. *Elkan* (1871), L. R. 12 Eq. 146; 41 L. J. Ch. 246; *Burgess* v. *Hills* (1859), 26 Beav. 244, 247; 28 L. J. Ch. 356; *Burgess* v. *Hately* (1859), 26 Beav. 249; *Edelsten* v. *Edelsten* (1863), 1 D. J. S. 203; *Davenport* v. *Rylands* (1865), L. R. 1 Eq. 305; 35 L. J. Ch. 294. As to costs, see *post*, p. 462.

(*c*) *Losh* v. *Hague* (1837), 1 Web. P. C. 200; *Geary* v. *Norton* (1846), 1 De G. & S. 9; but see *Proctor* v. *Bayley* (1889), 42 Ch. D. 390; 59 L. J. Ch. 12; 6 R. P. C. 106.

(*d*) (1865) 34 Beav. 395.

(*e*) (1894) 11 R. P. C. 218. And see *American Tobacco Co.* v. *Guest* (1892), 1 Ch. 360; 61 L. J. Ch. 242; 9 R. P. C. 218.

(*f*) Hindmarch, 308.

(*g*) *Bergmann* v. *Macmillan* (1881), 17 Ch. Div. 423.

(*h*) *Sheehan* v. *G. E. R. Co.* (1880), 16 Ch. Div. 59, 63; 50 L. J. Ch. 68. Cp. *Steers* v. *Rogers* (1893), App. Ca. 232; 62 L. J. Ch. 671; 10 R. P. C. 245.

(*i*) *Dent* v. *Turpin* (1861), 2 J. & H. 139; 30 L. J. Ch. 495.

But if the partial owner desires more than an injunction, if he desires damages or an account of profits, the alleged infringer is entitled to have joined all parties interested, so as not to make him liable to several actions and several accounts. "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" (*k*).

Assignees.

An action for infringement may be brought by the assignees of the patent infringed (*l*).

Assignee of bankrupt.

The assignees or trustee of a bankrupt patentee may bring it (*m*).

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 (*n*), 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

(*k*) *Bergmann* v. *Macmillan* (1881), 17 Ch. Div. 423, per Fry; *Dent* v. *Turpin* (1861), 2 J. & H. 139; 30 L. J. Ch. 495; see also *Davenport* v. *Richards* (1860), 3 L. T. N. S. 503; *Westhead* v. *Keene* (1838), 1 Beav. 287; 8 L. J. Ch. 89.

Electric Telegraph Co. v. *Brett* (1851), 10 C. B. 838; 20 L. J. C. P. 123; and see *Boulton* v. *Bull* (1795), 2 H. Bl. 464. See also Act of 1883, sect. 46.

(*m*) *Bloxam* v. *Elsee* (1827), 6 B. & C. 169.

(*n*) *Dunnicliff* v. *Mallett* (1839), 7 C. B. N. S. 209, 227; 29 L. J. C. P. 70; see also per Cotton, L. J., in *Van Gelder, &c., Co.* v. *Sowerby Bridge Flour Society* (1890), 44 Ch. Div. 374; 59 L. J. Ch. 583; 7 R. P. C. 208.

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 (*o*).

Assignee may sue original grantee.

The assignee of a patent may maintain an action for an infringement, 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 infringement since the defendant has received notice that the entire interest in the patent has become vested in the assignee (*p*). If the assignment has not yet been registered, the action is nevertheless maintainable (*q*). If the plaintiff assigns pending action, the Court may give leave to add the assignees as partners, but will not necessarily do so (*r*). Probably leave would be refused save on stringent terms.

In *Walton* v. *Lavater* (*p*), 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

(*o*) *Smith* v. *L. & N. W. Rail. Co.* (1853), 2 E. & B. 69.

(*p*) *Walton* v. *Lavater* (1860), 8 C. B. N. S. 162; 29 L. J. C. P. 275; see *Anderson* v. *Patent Oxonite Co.* (1886), 3 R. P. C. 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. *Spilsbury* v. *Clough* (1842), 2 Gale & Dav. 17: a partial assignee was allowed to sue after disclaimer by the patentee.

(*q*) *Chollett* v. *Hoffman* (1857), 7 E. & B. 686; 26 L. J. Q. B. 249, to the contrary was decided on a different statute; and see *Hassall* v. *Wright* (1870), 10 Eq. 509; 40 L. J. Ch. 145.

(*r*) Cp. *Ruston* v. *Tobin* (1878), 49 L. J. Ch. 262, with *Nobel's Explosive Co.* v. *Jones* (1879), 42 L. T. N. S. 754.

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 (*s*).

Actions by mortgagors.

A mortgagor of a patent may sue for infringement. In the case of *Van Gelder* v. *Sowerby Bridge Flour Society* (*t*), 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, but his decision was reversed on appeal.

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* (*u*), 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 Webster (*x*) 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 *Dicrosne* v. *Fairie* (*y*) and *Newby* v. *Harrison* (*z*), 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

(*s*) *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; 50 L. J. Ch. 68.

(*t*) (1890) 44 Ch. Div. 374; 59 L. J. Ch. 583; 7 R. P. C. 41; on appeal, p. 208. And see *Fairclough* v. *Marshall* (1878), 4 Ex. D. 37.

(*u*) (1815) 27 Rep. Art. 2nd Ser. 252; Carp. P. C. 295.

(*x*) Letts. Pat. p. 24, and n. (*o*).

(*y*) (1835) 1 Web. P. C. 155.

(*z*) Before Lord Campbell, cited 2 H. & M. 628.

to other persons, and consequently an infringement is an injury to himself, and not to the licensee.

Exclusive licensee.

In *Renard* v. *Levinstein* (*a*) there is some authority for the statement that an exclusive licensee can sue for infringement of the patent of which he alone has an exclusive licence. In *Heap* v. *Hartley* (*b*), 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 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. (*c*), "is only a licence in one sense. . . . It is a leave to do a thing, and a contract not to give leave to anybody else to do the same thing; but it confers, like any other licence, no 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."

Licensor.

Upon the other hand, there appears to be no doubt that a patentee who has granted merely an exclusive licence 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 patent are vested as trustee may

(*a*) (1864–65) 2 H. & M. 628, 631.

(*b*) *Heap* v. *Hartley* (1888), 42 Ch. D. 461; 58 L. J. Ch. 790; 5 R. P. C. 603; (1889) 6 R. P. C. 495.

(*c*) 42 Ch. D. at p. 470.

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 (*d*).

A mere agent for sale cannot bring the action; whether a person is a mere agent or not depends on the facts (*e*).

The defendants.

The actual infringer of a patent is, of course, a necessary defendant to an action for infringement.

In *Denley* v. *Blore* (*f*) 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.

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 (*g*).

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 (*h*).

A person who prepares materials which are intended to be used in making an article which proves an infringement of the patent is not a proper defendant, if the materials as they leave his hands are not an infringement (*i*).

Although the ordinary form of injunction against a master or principal restrains his servants or agents also, each 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

(*d*) R. S. C. 1883, Ord. XVI. r. 8. According to a case reported in *The Times* of 13th March, 1894, a *cestui que* trust may sue, though the patent be registered in the name of the trustee.

(*e*) *Adams* v. *North British Railway Co.* (1873), 29 L. T. N. S. 367.

(*f*) (1851) 38 Lond. Jour. 224.

(*g*) *Betts* v. *De Vitre* (1868), L. R. 3 Ch. 429; 37 L. J. Ch. 325.

(*h*) *Sykes* v. *Howarth* (1878), 12 Ch. D. 826.

(*i*) *Savage* v. *Brindle* (1896), 13 R.P.C. 266.

pay the costs of it, and it is no justification for him to say that he was carrying out his master's orders (*k*). *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 (*l*).

In one case the defendant, after action brought, sold the business to a company, and sought to join the company as co-defendant, but Pearson, J., refused leave (*m*).

Custom-house agents.

In the case of *Nobel's Explosives Co.* v. *Jones* (*n*), 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 agency," said Lord Selborne, L. C. (*o*), "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 (*p*), ... "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 against the danger that the article would explode and do mischief. How, in any sense, taking those

(*k*) *Betts* v. *De Vitre* (1868), per Wood, V.-C., 11 Jur. 11; 34 L. J. Ch. 289; *Betts* v. *Neilson* (1868–71), 6 N. R. 221; *Barker* v. *Shaw* (1823), Holr. Pat. 60.

(*l*) *Adair* v. *Young* (1879), per Cotton, L. J., 12 Ch. D. at p. 18.

(*m*) *Briggs* v. *Lardeur* (1884), 2 R. P. C. 13.

(*n*) (1880–82) L. R. 17 Ch. D. 721; 50 L. J. Ch. 582; 8 App. Cas. 5; 52 L. J. Ch. 339.

(*o*) 8 App. Cas. at p. 8.

(*p*) 8 App. Cas. at p. 13.

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 (*q*). A manufacturer, and purchasers from him, may be made defendants in one action (*r*), and the patentee may have an account of profits against the manufacturer and damages against the purchaser (*s*).

Third party. Notice.

In the case of *Edison and Swan Co.* v. *Holland* (*t*) an interesting point was raised as to the construction of the third party rule (*u*). 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, 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

(*q*) *Penn* v. *Bibby* (1866), L. R. 3 Eq. 308, per Wood, V.-C.; 36 L. J. Ch. 277.
(*r*) *Proctor* v. *Bennis* (1887), 36 Ch. D. 740; 57 L. J. Ch. 11; 4 R. P. C. 333.
(*s*) *Penn* v. *Bibby*, *ubi supra*.
(*t*) (1886) 33 Ch. Div. 497; 3 R. P. C. 396—397; *United Telephone Co.* v. *Fleming* (1886), 3 R. P. C. 268.
(*u*) R. S. C. 1883, Ord. XVI. r. 48.

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" (*x*).

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 Order XVI. rule 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 (*y*).

A third party cannot insist upon being joined, though his interests may be in his opinion affected by the litigation (*z*).

Infringement by foreigners.

Foreigners coming into this country are subject to actions for injuries done by their infringing the sole and exclusive right granted by the Crown to patentees of inventions (*a*); 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 (*b*).

Foreign sovereigns.

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

(*x*) 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."

(*y*) *Edison and Swan Co.* v. *Holland* (1889), L. R. 41 Ch. D. 28; 6 R. P. C. 243. 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.

(*z*) *Moser* v. *Marsden* (1892), 1 Ch. 487; 9 R. P. C. 214.

(*a*) *Caldwell* v. *Van Vlissingen* (1851), 21 L. J. Ch. 97; 9 Hare, 415. For a case in which an injunction was granted against infringement by post from abroad, see *Badische Anilin und Soda Fabrik* v. *Johnson* (1897), Times, Jan. 28th.

(*b*) *Varasseur* v. *Krupp* (1878), L. R. 9 Ch. D. 351.

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" (*a*).

But for the existing provisions as to *foreign vessels*, see *post*, p. 634.

Varasseur v. Krupp.

In *Varasseur* v. *Krupp* (*b*), 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 shells, which were his property, out of the jurisdiction of the Court.

A patent is effective against the Crown; but the officers or authorities administering any governmental department, may by themselves, their agents, or contractors (*c*), use the invention on certain terms (*d*).

(3.) *The Writ.*

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.

Service out of the jurisdiction.

In *Washburn and Moen Co.* v. *Cunard Co.* (*e*), the owners of a patent commenced an action to restrain infringement of their

(*a*) *Caldwell* v. *Van Vlissingen* (1851), 21 L. J. Ch. 97; 9 Hare, 415.
(*b*) *Supra.*
(*c*) *Dixon* v. *London Small Arms Co.* (1876), 1 App. Ca. 632; 46 L. J. Q. B. 617, 632, as to their extent inapplicable now.
(*d*) See Act of 1883, sect. 27.
(*e*) (1889) 6 R. P. C. 398.

patent against a steamship company, who had brought certain 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* (*f*), they were rightly made parties though out of the jurisdiction; and that in exercise of the discretion given by R. S. C. Order XI. rule 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 (*g*). A form of indorsement is given *post*, p. 828.

(4.) *The Court.*

Action must be brought in one of the divisions of the High Court of Justice.

Since the Judicature Act, 1873, came into force, the action for infringement may be commenced and carried on in the Chancery Division or in the Queen's Bench Division; and inasmuch as patent cases are not usually tried by jury, the choice of division will depend almost entirely upon the wish of the litigants, and especially of the plaintiff. The only special advantage of starting in the Chancery Division is the possibility of trying the case on a motion for injunction. In the Queen's Bench Division the application would be by summons, and would be disposed of in Chambers, where any result leading to a settlement of the whole action would be practically impossible. But an appeal could be

(*f*) (1888) L. R. 21 Q. B. D. 330.

(*g*) A more recent case is *Badische Anilin, &c.* v. *Johnson* (1896), 1 Ch. 25; 65 L. J. Ch. 174; 12 R. P. C. 535. See also *Marshall* v. *Marshall* (1888), 38 Ch. Div. 330; *Re Burland's Trade-mark* (1889), 41 Ch. Div. 542; *Kinahan* v. *Kinahan* (1890), 45 Ch. Div. 78; 59 L. J. Ch. 705; 58 L. J. Ch. 591; *Speckhardt* v. *Campbell Achnach* (1884), W. N. 24. But a petition cannot be served out of the jurisdiction; *Re Cliff* (1895), 2 Ch. at p. 25; 64 L. J. Ch. at p. 425; *Re King & Co.'s Trade-mark* (1892), 2 Ch. 462; 62 L. J. Ch. 153; 9 R. P. C. 350.

had (without leave) to the Court of Appeal; and, moreover, it is seldom that a motion in a patent action can be treated on the trial of the action. In effect, therefore, no rule even of moderately wide application can be laid down as to the choice of the division of the Court in which the writ should be issued.

Palatine Court of Lancaster.

The Palatine Court of Lancaster has jurisdiction (*h*).

County Court has no jurisdiction.

The County Courts have no jurisdiction to try an action for infringement of a patent when the validity of the patent is disputed (*i*).

Sect. 3. Interlocutory Injunction.

What is interlocutory injunction.

An interlocutory injunction in a patent action, by which the defendant is commanded to refrain from infringing the plaintiff's patent until the hearing or the further order of the Court (*k*), may be obtained if the Court thinks it just or convenient to make the order (*l*). The application may be made to the Court or a Judge (*m*). A Master cannot make the order (*n*). The Court may restrain a threatened infringement (*o*).

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* (*p*):—

"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.

First ground. I. "*Where the patent is an old one, and the patentee has been in long and undisturbed enjoyment of it*" (*q*).

(*h*) See 53 & 54 Vict. c. 23.

(*i*) *R.* v. *County Court Judge of Halifax* (1891), 2 Q. B. 263; 60 L. J. Q. B. 550; 8 R. P. C. 338.

(*k*) Cp. Hindmarch, p. 312. See forms, Seton's Decrees, pp. 547 *et seq.*

(*l*) Jud. Act, 1873, sect. 25 (8).

(*m*) R. S. C. Ord. L. r. 6. The practice relating to applications for injunctions may be found in the Annual Practice, notes to Ord. L. r. 6.

(*n*) R. S. C. Ord. LIV. r. 12 (8).

(*o*) *Pearson* v. *Loe* (1878), 9 Ch. Div. 48; *Proctor* v. *Bailey* (1888), 42 Ch. Div. 390; 6 R. P. C. 106, 538; 59 L. J. Ch. 12.

(*p*) (1877) 30 L. T. N. S. at p. 244.

(*q*) Cp. also *Universities of Oxford and Cambridge* v. *Richardson* (1802), 6 Ves. 689; *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. *Catts* (1839), 8 L. J. Ch. 184; 2 Coop. C. C.

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 (*r*).

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 (*s*).

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 (*t*). 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* (*u*), "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 principally, because . . . there is no comparison between the evil of an error in refusing

Effect of long enjoyment.

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), Johns P. Manual, 254; *Betts* v. *Menzies* (1857), 3 Jur. N. S. 358; *Davenport* v. *Jepson* (1862), 1 N. R. 173, 307; *Renard* v. *Levinstein* (1864), 10 L. T. N. S. 94; *Plimpton* v. *Malcolmson* (1875), L. R. 20 Eq. 37; 44 L. J. Ch. 257.

(*r*) *Stevens* v. *Keating*, *ubi supra*, per Lord Cottenham, C.

(*s*) Cp. Hindmarch, p. 312. See forms, Seton's Decrees, pp. 343, 344.

(*t*) *Caldwell* v. *Van Vlissingen* (1851), per Turner, V.-C., 9 Hare, at p. 424; 21 L. J. Ch. 97. Cp. *Electric Telegraph Co.* v. *Nott* (1847), 2 Coop. 41; *Davenport* v. *Jepson* (1862), per Turner, L. J., 4 De G. F. & J. 446.

(*u*) *Davenport* v. *Jepson* (1862), 1 N. R. 307.

an injunction, and the evil of an error in granting an injunction" (*x*).

Characteristic of long enjoyment.

Duration of enjoyment.

The enjoyment referred to by Sir George Jessel, in *Dudgeon* v. *Thomson* (*y*), must, before the Court can recognise it, be shown to have been long, uninterrupted, and active. The periods of enjoyment which have been held sufficient range from thirteen (*z*) to three (*a*) years.

Undertaking to keep account.

In *The British Tanning Co.* v. *Groth* (*b*) 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 (*c*); but if defendant does not appear, and so an undertaking to keep an account cannot be obtained, an injunction may be granted (*d*).

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

(*x*) Per Lord Cottenham, C., *Electric Telegraph Co.* v. *Nott*, *ubi supra*, at p. 47.

(*y*) (1877) 30 L. T. N. S. 244.

(*z*) *Harmer* v. *Playne* (1807), 14 Ves. 130. See the cases enumerated in Lawson, p. 194.

(*a*) *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*, 20 Eq. 37; 44 L. J. Ch. 257; *Renard* v. *Levinstein* (1864), 10 L. T. N. S. 94.

(*b*) (1890) 7 R. P. C. 1.

(*c*) *Jackson* v. *Needle* (a case under the Patent Law Amendment Act, 1852) (1884), 1 R. P. C. 174.

(*d*) *Clarke* v. *Nichols* (1895), 12 R. P. C. 310.

working the invention, but it was proved that a competent workman 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 (*e*).

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 licence 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 (*f*).

Prior substratum patent.

In *Heugh* v. *Magill* (*g*), 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 (*h*).

Question of validity, how far entered into.

The Court will ordinarily 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 (*i*). 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 (*k*). Upon the other hand, it is not a mere matter of course, because a patent is recent, to

(*e*) *Coles* v. *Baylis* (1886), 3 R. P. C. 178.

(*f*) *Curtis* v. *Cutts* (1839), 8 L. J. Ch. 184; 2 Coop. C. C. 60. It is not necessary for the plaintiff to allege that his patent has never been disputed: *Read* v. *Andrew* (1865), per Bacon, V.-C., 2 R. P. C. 119, 122.

(*g*) (1877) W. N. 62.

(*h*) *Plimpton* v. *Malcolmson* (1875), 20 Eq. 37; 44 L. J. Ch. 257.

(*i*) *Briggs* v. *Lardeur* (1884), per Pearson, J., 1 R. P. C. 129; *Shillito* v. *Larmuth* (1885), 2 R. P. C. 2.

(*k*) *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), 1 W. P. C. 211; *Muntz* v. *Foster* (1843), 2 Web. P. C. 93, 95.

call on the patentee to establish his rights at law before he can obtain relief by injunction (*l*).

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 (*m*) 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 *Bovill* v. *Goodier* (*n*).

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. If, however, the validity was established in an action terminated by consent, the Court will be less likely to grant an interlocutory injunction (*o*).

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 (*p*). And the fact that the defendant in the old and the new action though nominally different are really the same, will probably induce the Court to grant an interlocutory injunction (*q*).

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

(*l*) *Clark* v. *Ferguson* (1859), per Stuart, V.-C., 1 Giff. 184; cp. *Gardner* v. *Broadbent* (1856), 4 W. R. 767; 2 Jur. N. S. 1041.

(*m*) *Crosskill* v. *Every* (1848), 10 L. T. 459.

(*n*) (1866) 35 L. J. Ch. 174; 35 Beav. 427; cp. *Davenport* v. *Jepson* (1862), 4 De G. F. & J. 446; *Davenport* v. *Goldberg* (1865), 2 H. & M. 282; *Bovill* v. *Smith* (1867), W. N. (1867), 240; 2 Eq. 459; *Dudgeon* v. *Thomson* (1874), 30 L. T. N. S. 244; *Thorn* v. *Worthing Skating Rink Co.* (1876), 6 Ch. D. 415, n.; *Hayward* v. *Pavement Light Co.* (1884), 1 R. P. C. 207.

(*o*) *Farbenfabriken*, &c. v. *Dawson* (1891), 8 R. P. C. 397.

(*p*) *Newall* v. *Wilson* (1852), 19 L. T. 161; 2 De G. M. & G. 472.

(*q*) *Farbenfabriken*, &c. v. *Dawson*, *supra*; *Moser* v. *Sewell* (1893), 10 R. P. C. 365.

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 (*r*).

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's Acts, granted him an injunction as a matter of course (*s*).

In *Boulton* v. *Bull* (*t*), 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 (*u*) or obtained a rule *nisi* for (*x*) a new trial, or tendered a bill of exceptions (*y*), the Court usually, but not necessarily (*z*), ordered the matter to stand over till the result of such application or proceeding was known. If the *bonâ fides* of the defendant in the second action be doubtful the interlocutory injunction may be granted, notwithstanding an appeal in the former action (*a*).

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 (*b*).

Position of licensee.

A licensee may be estopped from disputing the validity of a patent where (1) the licence, being by deed, contains a recital necessarily involving an assertion of the validity of the patent (*c*);

(*r*) *Lister* v. *Eastwood* (1855), 26 L. T. 4.

(*s*) *Russell* v. *Cowley* (1834), 2 Coop. C. C. 59, n.; 1 W. P. C. 471; *Neilson* v. *Harford* (1841), 1 Web. P. C. 373.

(*t*) (1796) 3 Ves. 140.

(*u*) *Hill* v. *Thompson* (1817), 3 Mer. 631; 1 Web. P. C. 235, 238.

(*x*) *Collard* v. *Allison* (1839), 4 My. & Cr. 487.

(*y*) *Bridson* v. *McAlpine* (1845), 8 Beav. 229.

(*z*) *Bridson* v. *Benecke* (1849), 12 Beav. 1.

(*a*) *Moser* v. *Sewell* (1893), 10 R. P. C. 365.

(*b*) The law relating to licences and licensees will be found *ante*, p. 300.

(*c*) *Bowman* v. *Taylor* (1834), 2 Ad. & E. 278; 1 Web. P. C. 292; *Smith* v.

(2) the licence, not being by deed (*d*) or being merely verbal (*e*), is still in force, and the licensee is using the invention under it (*f*).

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 (*ff*).

Co-partners.

Thus in *Muntz* v. *Grenfell* (*g*), 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* (*h*), although apparently contradictory of, is in reality distinguishable from, this case. In the former the plaintiff and the defendant had, during the subsistence of the partnership, taken and prosecuted legal proceedings against infringers. In the latter such proceedings had been taken, but were abandoned by the co-partners on advice that the specification was bad.

The above applies 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 (*i*).

Effect of defendant having submitted to judgment in previous action.

The fact that in a previous action at law for the infringement of 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 (*k*).

Patentee may not derogate from his own grant.

A patentee may not derogate from his own grant (*l*). This proposition requires some explanation and qualification. It

Scott (1859), 28 L. J. C. P. 325; *Cutler* v. *Bower* (1848), 17 L. J. Q. B. 217; 11 Q. B. 973.

(*d*) *Lawes* v. *Purser* (1856), 26 L. J. Q. B. 25; 6 E. & B. 930.

(*e*) *Crossley* v. *Dixon* (1863), 10 H. L. C. 293, 308, 310; 32 L. J. Ch. 617.

(*f*) *Norton* v. *Brooks* (1861), 7 H. & N. 499.

(*ff*) See the somewhat conflicting cases of *Hayne* v. *Maltby* (1789), 3 T. R. 438; *Neilson* v. *Fothergill* (1841), 1 W. P. C. 287; *Taylor* v. *Hare* (1805), 1 N. R. 260.

(*g*) (1842) 2 Coop. 61, n.

(*h*) (1874) L. R. 18 Eq. 330; 43 L. J. Ch. 655.

(*i*) *Goucher* v. *Clayton* (1864-66), 34 L. J. Ch. 239; *Hough* v. *Chamberlain* (1877), 25 W. R. 742.

(*k*) *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. So an injunction may be granted if the defendant has already admitted the validity of the patent; see (*e.g.*) *Dircks* v. *Mellor* (1845), 26 Lond. Jour. 268.

(*l*) *Chambers* v. *Crichley* (1864), 33 Beav. 374.

holds good in such cases as *Oldham* v. *Langmead* (*m*). 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 (*n*).

In the case of *Cropper* v. *Smith* (*o*), 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 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 (*o*).

Refusal of interlocutory injunction.

An interlocutory injunction will be refused—

1. If there be any substantial doubt whether the acts complained of constitute an infringement of the plaintiff's patent (*p*);

2. If the application for it be made only after unnecesary and unexplained delay (*q*);

3. If there has been, on the part of the plaintiff, acquiescence in the wrong of which he complains (*r*);

(*m*) (1789) 3 T. R. 439, 441.

(*n*) *Cropper* v. *Smith* (1884), 10 A. C. 249; 26 Ch. Div. 700; 1 R. P. C. 81, 254.

(*o*) *Otto* v. *Steel* (1886), 3 R. P. C. at p. 114. But he runs a chance of having to pay costs as between solicitor and client if his defence is not successful: *Ibid.*; and see Act of 1883, sect. 31, *post*, p. 620.

(*p*) *Electric Telegraph Co.* v. *Nott* (1846–47), 16 L. J. C. P. 174; 2 Coop. 41.

(*q*) *Bridson* v. *Benecke* (1849), 12 Beav. 1.

(*r*) *Neilson* v. *Thompson* (1840), 1 Web. P. C. 275, 283.

4. If the balance of convenience be against granting it (*s*).

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 (*t*); or if the alteration made by the defendant on the plaintiff's patent is "not merely colourable, but *primâ facie* a decided improvement" (*u*); or when it appears that there is a material difference between the process of the defendant and that of the plaintiff (*x*).

On an application for an interlocutory injunction, the plaintiff's affidavit should state particularly in what the alleged infringement of the patent consisted (*y*).

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 (*z*).

Where there is one question whether a patent is valid and another question whether it has been infringed (*a*), 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 (*b*). If there is a serious question to be tried, and the patent is a recent one, though defendant refuses to keep an account, the interlocutory injunction has been refused (*c*).

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 (*d*).

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

(*s*) *Electric Telegraph Co.* v. *Nott*, *supra*; *Mitchell* v. *Henry* (1880), 15 Ch. Div. 181; 43 L. T. N. S. 186.

(*t*) *Electric Telegraph Co.* v. *Nott*, *ubi supra*, per Lord Cottenham, C.

(*u*) *Morgan* v. *Seaward* (1835), per Shadwell, V.-C., 1 Web. P. C. at p. 168.

(*x*) *Muntz* v. *Vivian* (1840), 2 Web. P. C. at p. 88.

(*y*) *Hill* v. *Thompson* (1817), per Lord Eldon, L. C., 1 Web. P. C. 230.

(*z*) *Frearson* v. *Loe* (1878), per Jessel, M. R., 9 Ch. D. 48.

(*a*) *Wood* v. *Cockerell* (1819), per Lord Eldon, C., 2 Coop. 58, n.

(*b*) *Bridson* v. *McAlpine* (1845), 8 Beav. 229.

(*c*) *British Tanning Co.* v. *Groth* (1890), 7 R. P. C. 1.

(*d*) *Bridson* v. *Benecke* (1849), per Lord Langdale, M. R., 12 Beav. 3; *Greer* v. *Bristol Tanning Co.* (1885), 2 R. P. C. 268.

party (*e*). But laches in dealing with a person not a party to the action has been held not to disentitle the plaintiff to an injunction against the defendant (*f*).

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 (*g*), and failure to give such notice may be fatal (*h*).

A patentee is entitled to spend some time in making inquiries as to whether a defendant is a man of substance (*i*), or is really infringing (*k*).

In the case of *Osmond* v. *Hirst* (*l*), 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 (*m*).

Although a motion for an injunction is refused on the ground of delay, an account may be ordered (*n*).

"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 view to unnecessary expense,' it is better,

(*e*) *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; *North British Rubber Co.* v. *Gormully, &c., Co.* (1895), 12 R. P. C. 17.

(*f*) *Pneumatic Tyre Co.* v. *Warrilow* (1896), 13 R. P. C. 284.

(*g*) *Hancock* v. *Moulton* (1852), John. Pat. Man. 254; cp. *Bovill* v. *Smith* (1867), W. N. (1867), 240.

(*h*) *Smith* v. *L. and S.-W. Railway Co.* (1854), 23 L. J. Ch. 562; Kay, 408.

(*i*) *United Telephone Co.* v. *Equitable Telephone Association* (1888), 5 R. P. C. 233.

(*k*) *S. C.*, and *Losh* v. *Hague* (1837), 1 Web. P. C. 201.

(*l*) (1885) 2 R. P. C. 267.

(*m*) *Newall* v. *Wilson* (1852), 2 De G. M. & G. 282.

(*n*) *Bovill* v. *Crate* (1865), 1 Eq. 388.

then, to order the motion to stand to the trial without prejudice to any question" (*o*).

Acquiescence in infringement.

3. The leading case on the doctrine of acquiescence in the infringement of a patent is *Neilson* v. *Thompson* (*p*).

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 (*q*).

"Mere delay to enforce a legal right is no bar to an action, unless the delay is such as to cause a statutory bar" (*r*).

"But acquiescence may be a ground for refusing an account of profits (*s*), or for limiting it to the date of commencing the action (*t*), or for granting damages instead of an injunction" (*u*).

In *Proctor* v. *Bennis* (*x*), 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

(*o*) *Lister* v. *Norton* (1884), per Chitty, J., 1 R. P. C. at p. 116.

(*p*) (1841) 1 Web. P. C. 278; *Thomson* v. *Hughes* (1890), 7 R. P. C. 71.

(*q*) *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; 57 L. J. Ch. 11.

(*r*) *Three Towns Banking Co.* v. *Maddever* (1884), 27 Ch. D. 523.

(*s*) *Crossley* v. *Beverley* (1829), 1 Web. P. C. 112, 120; *Harrison* v. *Taylor* (1865), 11 Jur. N. S. 408.

(*t*) *Sayers* v. *Collyer* (1884), 28 Ch. D. 103, per Fry, L. J.

(*u*) *Beard* v. *Turner* (1866), 13 L. T. N. S. 746; *Ford* v. *Foster* (1872), L. R. 7 Ch. 627.

(*x*) (1887) 36 Ch. D. 740; 57 L. J. Ch. 11; 4 R. P. C. 333.

that time consider it to be so, and intended to take legal proceedings when he was in funds.

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 (*y*).

In *Neilson* v. *Thompson* (*y*), the facts of which are set forth above at p. 380, 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 patent was twelve years old, and the defendants' a new company with a small capital, the Court made an order for an interlocutory injunction (*z*).

If the defendant undertakes to keep an account, and the Court thinks that this will be a sufficient protection for the plaintiff, the interlocutory injunction will probably be refused (*a*). Sometimes the Court has required the defendant to deposit a sum of money in Court roughly equivalent to the royalties which would be required from a licensee, and has refused an interlocutory injunction if the money is then deposited (*b*).

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

(*y*) *Neilson* v. *Thompson* (1840), per Lord Cotterham, L. C., 1 Web. P. C. 286.

(*z*) *Bracher* v. *Bracher & Co.* (1890), 7 R. P. C. 420.

(*a*) *Thompson* v. *Hughes* (1890), 7 R. P. C. 71.

(*b*) *Edison-Bell Phonograph Co.* v. *Hough* (1894), 11 R. P. C. 594; *North British Rubber Co.* v. *Gormully, &c., Co.* (1895), 12 R. P. C. 17.

an account; thus forcing the plaintiff to commence a multitude of actions against the purchasers (*c*).

In two cases (*d*) 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. *Bailey* (*e*), the plaintiff, the owner 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

(*c*) *Plimpton* v. *Spiller* (1876–77), per Brett, L. J., 4 Ch. D. 291.

(*d*) *Copeland* v. *Webb* (1862), 11 W. R. 134; cp. *Boskell* v. *Cunningham* (1762), 2 Eden. 137.

(*e*) (1889) 6 R. P. C. 538; 42 Ch. Div. 392. In this case it was also held that as the Palatine Court had, under Lord Cairns' Act, and at the date of the action 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.

the wrongful act, and, therefore, an injunction ought not to be granted (*f*).

Application *ex parte*.

A plaintiff making application, whether *ex parte* (*g*) or after notice (*h*), 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 (*i*). The validity of the patent must be set out (*k*).

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 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 plaintiff (*i*). Leave to serve notice of motion for an injunction with the writ and before appearance may be obtained.

A summons for an interlocutory injunction is a matter of practice and procedure within the meaning of the Judicature Act, 1894, and an appeal from an order or such a summons must be made direct to the Court of Appeal (*k*).

Sect. 4.—The Consolidation of Actions.

Consolidation of actions.

Order XLIX. rule 8, of the R. S. C. 1883, provides that causes or matters pending in any 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 consolida-

(*f*) In *Lyon* v. *Mayor, &c., of Newcastle* (1894), 11 R. P. C. 218, the Court thought that an undertaking already given should have satisfied the plaintiff, and refused an injunction pending the trial of the action. Cp. *Jenkins* v. *Hope* (1896), 13 R. P. C. 57; *Upmann* v. *Forrester* (1883), 24 Ch. Div. 231; 52 L. J. Ch. 946. And see *Costs*, *post*, p. 462.

(*g*) *Hill* v. *Thompson* (1817–18), per Lord Eldon, L. C., 3 Mer. 622, 626.

(*h*) *Starte* 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.

(*i*) Daniell's Chanc. Prac. 1611. If the plaintiff is domiciled abroad, security for the damages may be required: *Moser* v. *Jones* (1893), 10 R. P. C. 368.

(*k*) *McHarg* v. *Universal Stock Exchange* (1895), 2 Q. B. 81; 64 L. J. Q. B. 498.

tion order could be made as soon as the defendants had appeared, and before declaration (*l*). 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 (*m*). 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* (*n*)—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 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 (*o*). Now, here the plaintiff has filed 134 bills against 134 different persons, who he

(*l*) Lush's Practice, 3rd edit. 965. Since the above was in type, the Court of Appeal has decided that a consolidation order may be made at the instance of the plaintiff: *Martin* v. *Martin & Co.* (1897), L. J. N. C. 72.

(*m*) *Amos* v. *Chadwick* (1877), 4 Ch. D. 869; 9 Ch. D. 459; *Bennett* v. *Lord Bury* (1880), 5 C. P. D. 339.

(*n*) (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.

(*o*) 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."

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 (*p*) 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, 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 (*q*).

Sect. 5.—Pleadings.

(1.) *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 (*r*), contains the following material allegations, viz., the

(*p*) (1863) 4 De G. J. & S. at p. 81.

(*q*) Where by order of the Court all the defendants in several actions are bound by the result of one test action, and the defendant in the test action refuses to appeal, the Court may substitute another one to prosecute the appeal; *Briton, &c., Life Insurance* v. *Jones* (1889), 60 L. T. N. S. 637.

(*r*) Appendix C. Sect. VI. No. 6; and see p. 782. And see R. S. C. Order XIX. for rules relating to pleading generally.

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. Forms of statement of claim will be found in the Appendix (*s*).

Unnecessary allegations.

It is not necessary to allege the novelty of the invention (*t*), nor that the patentee has duly paid the instalments of stamp duties necessary to keep the patent alive (*u*), nor is any reference to the specification required as formerly (*x*). The statement of claim must state such a case, however, as will justify the Court in granting the injunction asked for (*y*).

In *Edison and Swan Electric Light Co.* v. *Holland* (*z*), 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 indorsed on the writ should not be set out in the statement of claim. An action (*a*) 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, 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 Order XIX. rule 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

(*s*) *Post*, pp. 828, 829.

(*t*) *Amory* v. *Brown* (1869), L. R. 8 Eq. 663—664; 38 L. J. Ch. 593; 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." The form prescribed by the R. S. C. does not contain any allegation as to the validity of the patent.

(*u*) *Sarazin* v. *Hamel* (1863), 32 Beav. 145.

(*x*) *Kay* v. *Marshall* (1836), 2 Web. P. C. 39; *Westhead* v. *Keene* (1838), 1 Beav. 289; 8 L. J. Ch. 89; 2 Web. P. C. 36, n., per Lord Langdale, M. R.

(*y*) *Curtis* v. *Cutts* (1839), 8 L. J. Ch. 184.

(*z*) (1888) 5 R. P. C. at p. 483.

(*a*) *United Telephone Co.* v. *Tasker* (No. 2) (1889), 6 R. P. C. 38.

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 Order XVIII. rule 1, or Order XIX. rule 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.

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 (*b*); 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 (*c*). The law relating to particulars of breaches is considered, *post*, p. 392. If the plaintiff is claiming costs as between solicitor and client on the ground that the patent has already been tested by the Court and a certificate of validity granted, this should be pleaded (*d*).

(2.) *Defence.*

The rules regulating the mode of pleading are to be found in the Rules of the Supreme Court, Orders XIX. and XXI. In addition to what is required in ordinary actions, particulars of objection must be delivered pursuant to sect. 29 of the Patents Act, 1883. The law as to particulars will be dealt with hereafter, meanwhile the general outline of a defence may be treated of.

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; and, *secondly*, he may deny that the plaintiff has any title to the privilege stated in the claim, a defence based 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 (*e*). And every defendant may avail himself of both or either of these different lines of defence to a patent action.

Particular pleas.

In the form of defence to an action for infringement, given in

(*b*) 1883, sect. 29 (1).
(*c*) 1883, sect. 29 (4).
(*d*) *Pneumatic Tyre Co. v. Chisholm* (1896), 13 R. P. C. 488.
(*e*) See Hindmarch, p. 262.

the Appendix to the Rules of the Supreme Court, 1883 (*f*), 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.

A very common form of defence is still shorter, and yet is sufficient: 1. The defendant denies infringement. 2. The plaintiff's letters patents are invalid for the reason appearing in the particulars of objection.

The various defences may be considered under the following heads:—

Denial of infringement.

(1) *Denial of Infringement.*—As to what is an infringement, see Chapter XII.

Before the pleading rules, made in pursuance of the statute 3 & 4 Will. IV. c. 42, s. 1, the only plea used in patent actions was the comprehensive plea of "not guilty," under which the defendant might have taken any objection to the validity of the patent he pleased. The Rules of 1834 (*g*), 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, nor anything alleged in the declaration, except the breaches. In the case of *Stead* v. *Anderson* (*h*), 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 (*i*), the general issue cannot now be pleaded in an action for infringement; but the specific denial of infringement has the same scope as "not guilty" under the pleading rules of 1834.

An objection to the subject-matter of a patent cannot be properly raised under a plea denying infringement (*k*).

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,

(*f*) App. D. Sect. VI., and see Appendix, p. 786.

(*g*) Reg. Gen. H. T. 4 Will. 4, 1834.

(*h*) (1847) 16 L. J. C. P. 250; 2 W. P. C. 147.

(*i*) Order XIX. rules 13—17; and Order XXI. rule 19.

(*k*) *Russell* v. *Crichton* (1837), 1 Web. P. C. 677, n. (*e*); *Household Co.* v. *Neilson* (1843), *ibid.*

the patent was void for want of novelty, as having been anticipated by certain other specifications mentioned. The plaintiff took out a summons under Order XIX. rule 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 exercise of his discretion, had thought fit not to strike it out, his discretion ought not to be interfered with (*l*).

(2) *Leave and Licence.*—See *ante*, Chapter X., and *Henser* v. *Hardie* (*m*), *Guyot* v. *Thompson* (*n*).

(3) *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* (*o*), 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* (*p*), 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* (*q*) 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 that 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." Not now.

Under a plea of want of novelty, the following issues cannot be raised: Want of utility (*r*), no subject-matter (*s*), insufficiency of

(*l*) *Hocking & Co.* v. *Hocking* (1886), 3 R. P. C. 291.

(*m*) (1894) 11 R. P. C. 421.

(*n*) (1894) 3 Ch. 388; 11 R. P. C. 541.

(*o*) (1841) 1 Web. P. C., per Tindal, C. J., at p. 601; per Maule, J., at p. 611. See also *ibid.* n. (*q*), p. 596.

(*p*) (1852–56) Macr. P. C. 166, 179.

(*q*) (1862) 3 De G. J. & S. 346.

(*r*) *Walton* v. *Bateman* (1842), 1 Web. P. C., per Cresswell, J., at p. 623.

(*s*) *Walton* v. *Potter* (1841), 1 Web. P. C. 598, n. (*g*).

specification (*t*), or a denial that the patentee is the true and first inventor (*u*).

Not true and first inventor.

(4) *A Denial that the Plaintiff was the true and first Inventor.*—This plea is, as has already been pointed out (*x*), distinct from the issue as to the novelty of the invention. The two objections are perfectly distinct and different from each other. The objection that the patentee was not the true and first inventor is something more than the objection that the invention is not new, for it raises the point that the patentee did not make the invention, and this should be remembered in drawing the pleadings (*y*).

Objection "not true and first inventor" wider than objection "not new."

Importer.

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 (*y*).

Not useful.

(5) *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"(*z*). In the case of *Morgan* v. *Seaward* (*a*), 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* (*b*) 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 seems to have been the almost invariable practice, both at common law and in equity, merely to deny the utility of the invention in general terms; and the form of stating 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 *Morgan* v. *Seaward* (*c*), and *Bedells* v. *Massey* (*d*), it was held that a plea denying the utility of an invention was quite

(*t*) *Bateman* v. *Gray* (1853), 22 L. J. Ex. 290.
(*u*) *Houschill Co.* v. *Neilson* (1843), 1 Web. P. C. at p. 689.
(*x*) *Supra*, p. 263.
(*y*) *Ibid.* See *post* under "Particulars of Objection," p. 403.
(*z*) See also Chap. III., p. 100.
(*a*) (1836) 1 Web. P. C. 187—197; 2 M. & W. 544.
(*b*) (1837) 1 Web. P. C. 146.
(*c*) (1836) 2 M. & W. 544.
(*d*) (1844) 2 Dowl. & Low. 322.

different from a plea alleging that the plaintiff had falsely alleged his invention to be improvements.

No subject-matter

(6) *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" (*e*).

As to this, however, see Chapter III. on the subject-matter of patents.

Specification insufficient.

(7) *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 (*f*); but this objection, having been at the commencement of the new Act a ground for *scire facias* (*g*), is, in the case of patents granted thereunder, available by way of defence to an action for the infringement.

Variance; insufficiency.

Under the plea of insufficiency the following issues may be raised—that there is a fatal variance between the complete and the provisional specifications (*h*); 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 (*i*).

It is not, however, competent for a defendant to set up under this plea the defences of "no subject-matter" (*k*), nor that the patent is for an abstract principle only, and therefore invalid (*l*).

(*e*) 1 W. P. C. 598, n. (*g*).

(*f*) See *infra*, p. 667.

(*g*) Webst. Lett. Pat. 42, n.; *infra*. sect. 26, sub-sect. 3, p. 607.

(*h*) *Penn* v. *Bibby* (1866), L. R. 2 Ch. 127.

(*i*) *Siddell* v. *Vickers* (1888), 39 Ch. Div. at p. 106.

(*k*) *Walton* v. *Potter* (1841), 1 W. P. C. 598.

(*l*) *Jupe* v. *Pratt* (1837), 1 W. P. C. 145.

(3.) *Reply and subsequent Pleadings.*

See R. S. C. 1883, Order XXIII. There is nothing peculiar to the action of infringement. It is usual merely to join issue.

(4.) *Default of Pleadings.*

The result of these are the same as in other classes of action. As to this see R. S. C. 1883, Order XXVII. But where some of the defendants have put in a defence attacking the validity of the patent, and others have not put in any defence, the Court refused to allow judgment to be signed against the latter before the trial of the action (*m*).

Sect. 6.—Particulars.

(*a*) *Particulars of Breaches.*

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*). 5 & 6 Will. IV. 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.

Under Act of 1852.

The Patent Law Amendment Act, 1852, sect. 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 (*o*) and Sir John Rolt's Act (*p*) enabled that Court to try by itself, or with

(*m*) *Actien Gesellschaft, &c.* v. *Remus and Burgon* (1895), 12 R. P. C. 94.

(*n*) *Perry* v. *Mitchell* (1840), 1 W. P. C. 269; *Electric Telegraph Co.* v. *Nott* (1847), 4 C. B. at p. 471; 16 L. J. C. P. 174.

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

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

a jury, questions of fact, and required it to try all questions of law arising in a cause, particulars of breaches as well as notices of objections were ordered when issues were directed (*q*). And in *Finnegan* v. *James* (*r*), 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.

Patents Act, 1883.

And now the Patents, &c., Act, 1883 (*s*), provides that *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.*

Nature of the particulars.

At no time have the Acts of Parliament in force prescribed the exact nature of the particulars of breaches which a plaintiff must furnish. It is submitted that the practice is as follows:—

Summary of the law.

(1) Particulars of breaches need not necessarily 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 (*t*). 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 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?

(2) In considering the sufficiency of particulars of breaches the Court will not be so strict as when dealing with particulars of objection. When the plaintiff is told that the invention is not novel, the facts are possibly not within his knowledge, and he requires full information to enable him to deal with the case. But when a defendant is told that he has infringed, the alleged

(*q*) *Curtis* v. *Platt* (1863), 35 L. J. Ch. 853.
(*r*) (1874) 19 Eq. 72; 44 L. J. Ch. 185.
(*s*) Sect. 29, sub-sect. 1.
(*t*) See remarks of Grove, J., in *Church Engineering Co.* v. *Wilson* (1886), 3 R. P. C. 123.

infringement is generally within his own knowledge. *Ledgard* v. *Bull* (*u*). A plaintiff is often not 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 (*x*). When the infringement complained of is vending, the defendant is entitled to better particulars than when the complaint is of manufacturing according to the protected invention (*y*).

Particulars "by way of example."

(3) 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. But when the infringing article can be made in one way only, and a simple instance is representative, and there is little probability of the defendant being taken by surprise, the Court may relax the severity of this rule, but is not inclined to do so. *Patent Type Founding Co.* v. *Richards* (*z*); *Church Engineering Co.* v. *Wilson* (*a*); *Haslam* v. *Hall* (*b*).

(4) A plaintiff may say that he mentions certain cases of infringement, and may mention any article as a type of the one complained of, but he may add that he does not confine himself to these; or may add that until he has obtained discovery he is not in a position to give better particulars. The Court, however, will prevent the plaintiff from taking the defendant by surprise, and will require the plaintiff to give particulars of such infringement as he is acquainted with. *Talbot* v. *La Roche* (*c*); *Batley* v. *Kynoch* (*d*); *Tilghman's Patent Sand Blast* v. *Wright* (*e*).

References to lines and pages.

(5) A plaintiff should specify, by a reference to page and line, the parts of his specification in respect of which the alleged breaches have been committed. This rule is not always binding if the case is a simple one; and if the plaintiff's process is clearly identified with the defendant's, or if there is a general allegation of infringement with a reference to the claiming clauses alleged to have been infringed, or if the thing alleged to

(*u*) (1887) 11 App. Ca. 648; reported as *Petman* v. *Bull*, 3 R. P. C. 390. See also *Cheetham* v. *Oldham* (1888), 5 R. P. C. 617.

(*x*) *Talbot* v. *La Roche* (1854), 15 C. B. 310. But the modern practice is stricter than this Act, a matter to be borne in mind in dealing with old authorities.

(*y*) *Mandelberg* v. *Morley* (1893), 10 R. P. C. 256.

(*z*) (1860) 2 L. T. N. S. 359; 1 Johns. 381.

(*a*) (1886) 3 R. P. C. 123.

(*b*) (1887) 4 R. P. C. 203.

(*c*) (1884) 15 C. B. 310.

(*d*) (1874–75) 19 Eq. 229; 44 L. J. Ch. 219.

(*e*) (1884) 1 R. P. C. 103.

be an infringement has been made an exhibit in the cause. *Lamb* v. *Nottingham Manufacturers' Co.* (*f*); *Batley* v. *Kynoch* (*g*); *Church Engineering Co.* v. *Wilson* (*h*); *Cheetham* v. *Oldham* (*i*).

(6) If the plaintiff's specification describes two processes wholly distinct from one another, the particulars of breaches should point out clearly which the defendant's article infringes. *Cheetham* v. *Oldham* (*k*). But plaintiff is not bound to put an interpretation upon his specification (*l*).

(7) It may be necessary, when the defendant's article consists of many parts, to state in which part of the infringing article the infringement is to be found (*m*); though, if the plaintiff has not had inspection, this may not be required.

The following cases illustrate the above:—

Illustrative cases.

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 a large number of slits and adjustments. The declaration assigned as breaches the making, &c., pens and nibs, in imitation of parts 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 of the number of the pens of 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 specifications, referred to in the declaration, are as follows" (setting forth the number and figures of the diagrams).

Talbot v. *La Roche* (*o*) 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

(*f*) Seton, 557.
(*g*) (1874-75) 19 Eq. 229; 44 L. J. Ch. 219.
(*h*) (1886) 3 R. P. C. 123.
(*i*) (1888) 3 R. P. C. 624.
(*k*) (1888) 5 R. P. C. 624.
(*l*) *Wenham Gas Co.* v. *Champion Gas Co.* (1891), 8 R. P. C. 22.
(*m*) *Jones* v. *Lees* (1856), 25 L. J. Ex. 241.
(*n*) (1840) 1 W. P. C. 269.
(*o*) (1854) 15 C. B. 310, 320; cf. *Russell* v. *Hatfield*, 2 R. P. C. 144.

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 processes 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 (*p*).

Whether instances should be specified.

In *Jones* v. *Lees* (*q*), 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

(*p*) Cp. *Tilghman's Patent Sand Blast Co.* v. *Wright* (1884), 1 R. P. C. 103; and *Patent Type Founding Co.* v. *Richards* (1860), 2 L. T. N. S. 359.

(*q*) (1856) 25 L. J. Exch. 241.

to which his invention had been applied. It was held, that the defendant was entitled to such particulars as would 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 (*r*).

Instances by way of example.

The Patent Type Founding Co. v. *Richards* (*s*) was an action for the infringement of a patent for "improvements in the manufacture of type." Upon an order for the delivery of further particulars 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* (*ss*), and *Tilghman's Patent Sand Blast* v. *Wright* (*t*), 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* (*u*) was a suit to restrain from infringement 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

(*r*) Cp. *Elsey* v. *Butler* (1884), 1 R. P. C. at p. 189.

(*s*) (1860) 2 L. T. N. S. 359. See this case distinguished from *Tilghman's Patent* (1884), 1 R. P. C. 104, per Pearson, J.

(*ss*) 15 C. B. 310.

(*t*) *Supra*.

(*u*) (1863) 1 H. & M. 248, 251. Cp. the language of Mr. Justice Grove in the *Walter C. Church Engineering Co.* v. *Wilson* (1886), 3 R. P. C. 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."

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.

In *Batley* v. *Kynock* (*x*) 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 refusiug the motion, said: "Here the very thing in dispute, which is no bigger than one's 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 *Ledgard* v. *Bull* (*y*), 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

(*x*) (1874–75) L. R. 19 Eq. 229; 44 L. J. Ch. 89.

(*y*) (1886) A. C. 649, reported as *Pelman* v. *Bull* in 3 R. P. C. 390.

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, sect. 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* (*z*), 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 Stephen, J., on appeal, held that the words "in particular, by way of illustration," were too wide, and ought to be omitted (*a*). "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* (*b*).—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

(*z*) (1886) 3 R. P. C. 123.

(*a*) Cp. *Ehrlich* v. *Ihlee* (1888), 5 R. P. C. at p. 40, where the words "by way of illustration" were struck out by consent.

(*b*) (1887) 4 R. P. C. 203. Cp. *Elsey* v. *Butler* (1884), 1 R. P. C. 189; *Cheetham* v. *Oldham* (No. 3) (1888), 5 R. P. C. 624; *Lamb* v. *Nottingham Manufacturers' Co.*, Seton, 557.

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.

Sometimes the plaintiff will be permitted to postpone the delivery of full particulars, until he has had discovery (*c*).

(*b*) *Particulars of Objections.*

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, 1834, limited the scope of the plea of "not guilty." The statute 5 & 6 Will. IV. 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 (*d*).

Rules, 1834.

Lord Brougham's Act requiring particulars.

Decisions on precision in objections.

The degree of precision required in a notice of objections under the Act was the subject of considerable judicial discussion. Perhaps, the only general proposition that could have been laid down upon this subject is that stated by Hindmarch (*e*), in terms based upon the language of Tindal, C. J., in *Fisher* v. *Dewick* (*f*):—"Although plaintiffs always profess to apply for further and

(*c*) *Russell* v. *Hatfield* (1885), 2 R. P. C. 144.

(*d*) It was held under this Act that, while the notice of objections should not disclose the evidence on which the defendant relied (*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), it was not a sufficient compliance with the statute merely to specify every objection in general terms, as in a plea: *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. 208; 1 W. P. C. 544; *Reg.* v. *Mill*, *sci. fac.* (1850), 1 L. M. & P. 695; 20 L. J. C. P. 16; *Betts* v. *Walker* (1850), 14 Q. B. 363. On the other hand, the defendant was not entitled to go beyond his plea: *Macnamara* v. *Hulse* (1842), 2 Web. P. C. 128, n., per Lord Abinger, C. B.

(*e*) Page 291.

(*f*) (1838) 1 Web. P. C. at p. 267.

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" (*g*). Object of Act of 1835.

The Patent Law Amendment Act, 1852, s. 41, repeated in substance the provisions of 5 & 6 Will. IV. 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." The requirements of this statute, it should be observed, were 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 (*h*). Act of 1852. Additional particulars. Construction of Act of 1852, s. 41.

And now, by sect. 29 of the Patents Act, 1883, sub-sects. (2) Act of 1883.

(*g*) 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: *Walton* v. *Bateman* (1842), per Cresswell, J., 1 Web. P. C. 268, n. (*d*). 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: *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* (1814), 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.* The following objections were held insufficient:—That the invention was more extensive than, and did not correspond with, that described in the specification; that there was a discrepancy between the drawings and the specification; that an extension of the patent term had been obtained by fraud, covin, and misrepresentation; that the plaintiff had not caused *any specification* sufficiently describing the nature of the supposed invention to be duly enrolled in Chancery: *Fisher* v. *Dewick* (1838), 1 Web. P. C. 551, n.; *Russell* v. *Ledsam* (1843), 11 M. & W. 647; *Lecf* v. *Topham* (1845), 14 M. & W. 146. 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."

(*h*) *Chollet* v. *Hoffman* (1857), 7 E. & B. 686; 26 L. J. Q. B. 249. An order for further and better particulars of objection, made under the Patent Law Amendment Act, 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: *Flower* v. *Lloyd* (1876), 45 L. J. Ch. 746.

and (3), it is provided that *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. Also, that 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.*

Changes in law.

It will be found that 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 in sub-sect. (4) (*post*, p. 613) 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.

Except in these particulars, and, perhaps, it should be added, 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.

Particulars should not go beyond the pleadings.

Particulars of objection should not go beyond the pleadings (*i*), but must usually give more information than is contained in the defence (*k*). They should be drawn with care, so as to disclose precisely what the points are which are intended to be raised; stating a series of objections as a matter of common form will not be encouraged (*l*).

General rule as to sufficiency of objections.

Subject to the special requirements of the Act, in the case of notices affecting the validity of letters patent (*m*), particulars of objection, like particulars of breaches, were generally sufficient if precise enough to prevent surprise at the trial of an action of infringement. "It is incumbent," said Coltman, J., in *Fisher* v. *Derick* (*n*), "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

(*i*) *Macnamara* v. *Hulse* (1842), 2 W. P. C. 128, n.; *Gillett* v. *Wilby* (1839), 1 W. P. C. 270; 9 C. & P. 334.

(*k*) *Jones* v. *Berger* (1843), 1 W. P. C. 544; 5 M. & G. 208; 12 L. J. C. P. 179.

(*l*) Kekewich, J., in *Morgan* v. *Windover* (1890), 7 R. P. C. 446; and see *post*, p. 452, as to costs of objections.

(*m*) Sect. 29, sub-sect. (3).

(*n*) (1838) 1 W. P. C. at p. 268.

defendant is not precluded from bringing forward any number of objections, but he must state with precision what they are" (*o*).

But 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 (*p*); though if the particulars be framed honestly, the Court will hesitate to tie the hands of the defendant (*q*).

The particulars required will vary with the objections set out. The most usual are the following :—

1. *That the patentee was not the true and first inventor* (*r*).— This raises the issue whether the patentee was in truth the person who invented the subject-matter of the patent, and does not raise the question of novelty. This objection is commonly put in the particulars, but Kekewich, J., has on more occasions than one stated that it should not be included unless it is really intended to raise the objection at the trial (*s*). If it be pleaded, the plaintiff should properly be entitled to particulars of the person alleged to be the true and first inventor; whether he is so or not is somewhat doubtful (*t*). It is submitted that if the defendant intends at the trial to allege that a certain person other than the alleged inventor is the true inventor, and is in a position to give the name, he ought to do so.

Not true and first inventor.

2. *That the alleged invention is not new*.—This objection may resolve itself into three heads: (a) that the invention has been anticipated by a prior user; (b) that the state of public knowledge at the date of the invention was such as to prevent novelty; (c) that the invention has been anticipated by prior publication in specification, books, &c., or by communication to individuals.

Want of novelty.

Taking these in order :—

(a) That the invention has been anticipated by prior user.

Prior user.

Cases on thes points are :—

Flower v. *Lloyd* (*u*).—This was an action of infringement, in which the defendant relied, *inter alia*, upon prior user and

Order in *Flower* v. *Lloyd*.

(*o*) See *Holliday* v. *Heppenstall* (1889), 42 Ch. Div. 109; 6 R. P. C. 320; *Nettlefolds* v. *Reynolds*, *infra*.

(*p*) *Thomson* v. *Batty* (1889), 6 R. P. C. 84.

(*q*) *Nettlefolds* v. *Reynolds* (1891), 8 R. P. C. 410.

(*r*) See *ante*, Chap. IX.

(*s*) *Thomson* v. *Macdonald* (1891), 8 R. P. C. at p. 9; *Morgan* v. *Windover* (1890), 7 R. P. C. 416; *Pneumatic Tyre Co.* v. *Caswell* (1896), 13 R. P. C. at p. 187.

(*t*) See *Russell* v. *Ledsam* (1843), 12 L. J. Ex. 439; 11 M. & W. 647; a case decided under Lord Brougham's Act; particulars were not ordered. But see also remarks of Kekewich, J., in *Morgan* v. *Windover* (1890), 7 R. P. C. at p. 449.

(*u*) (1876) 45 L. J. Ch. 746.

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 addresses 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 the particulars being struck out.

Birch v. *Mather* (*x*).—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.

Present residence of prior users.

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" (*y*).

General user at a place.

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 of the Act of 1852 to state that the invention was used by manufacturers generally at a particular place, without naming any person or specifying any manufactory. The justification of this rule was thus expressed by Mr. Baron Alderson in *Palmer* v. *Wagstaffe* (*z*): "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 statement, for the more general it is the more the defendant

(*x*) (1883) 22 Ch. Div. 629; 32 L. J. Ch. 292; *Finnegan* v. *James* (1874), 19 Eq. 72; 44 L. J. Ch. 185; *Crossley* v. *Toney* (1876), 2 Ch. Div. 533. "At N. or elsewhere" is too indefinite: *Jones* v. *Berger* (1843), 1 W. P. C. 544.

(*y*) *Palmer* v. *Cooper* (1853), per Alderson, B., 9 Exch. at p. 236; 23 L. J. Ex. 82.

(*z*) (1853) 22 L. J. Ex. 295; 8 Exch. 840, 842.

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" (*a*), "by persons engaged in finishing lace at Nottingham" (*b*). 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 (*c*).

Thus, in a suit to restrain the infringement of a patent for improvements in the construction of carriages (*d*), 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 (*d*). 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. It is questionable, however, whether the objections of "general user" should not come under the next sub-head, viz., common knowledge. If under user, names and address should properly be given (*e*).

In *Smith* v. *Lang* (*f*) the particulars alleged publication by the "manufacture, &c., by J. B. W. from 1832 to 1862"; but the Court considered this too indefinite; the time of the user not being sufficiently stated.

In *Siemens* v. *Karo* (*g*) defendants stated in the particulars of objection that the invention had been anticipated by the general use of the "Wenham lamp," but submitted to give further particulars of the lamp referred to.

In *Boyd* v. *Horrocks* (*h*) it was held that "wholly or in part used previously, &c.," was not enough; it should have been stated whether the invention had been anticipated wholly or in part, and if in part which part.

(*a*) *Palmer* v. *Wagstaffe* (1853), 8 Ex. 340. 342; 22 L. J. Ex. 295.

(*b*) *Jones* v. *Berger* (1843), 5 M. & G. 208; 12 L. J. C. P. 179; 1 W. P. C. 544.

(*c*) *Palmer* v. *Cooper* (1853), 9 Ex. at p. 236; 23 L. J. Ex. 82.

(*d*) *Morgan* v. *Fuller* (1866), 2 Eq. 297.

(*e*) See *Alliance Pure White Lead Syn.* v. *MacIvor* (1893), 39 W. R. 487; 8 R. P. C. 321.

(*f*) (1890) 7 R. P. C. 148.

(*g*) (1891) 8 R. P. C. 376.

(*h*) (1886) 3 R. P. C. 285.

In *Boyd* v. *Farrar* (*i*) the plaintiff's specification was complicated, and contained seventeen claims; the nineteenth of defendant's particulars of objection alleged prior publication by exhibition of articles made according to the invention. Kay, J., decided that the defendant must state what particular machines were alleged to have been anticipations, but need not say which part of the invention was anticipated.

In *Sidebottom* v. *Fielden* (*k*) Bristowe, V.-C., refused further particulars of certain anticipations where the particulars stated the name of the maker and place and date when the alleged prior user took place, and there being nothing to show that the persons who used the articles would refuse to allow plaintiff to see them.

Such expressions as "amongst others" have been allowed; but the Court will do its best to guard the plaintiff against surprise (*l*).

State of knowledge contradicting invention.

(b) State of public knowledge at the time of the alleged invention such as to prevent novelty.

The objection should be stated separately to the objection raising anticipation (*m*). And whereas under a defence of anticipation, particulars of books, specifications, &c., must be given, it is improper to give any such details in the particulars setting up that the state of knowledge prevented novelty or invention (*n*). But if a specification standing by itself is the evidence of common knowledge, it should be mentioned in the particulars of objection (*o*); though, as a general rule, a specification will not be allowed to be used as evidence of common knowledge (*p*).

(c) Anticipation by specifications, books, and other publications.

Particulars of prior publication.

It was formerly the law that where the evidence relied on by a defendant was prior publication, he must state the particular work, specification, or document, and the volume of the work. In the case of a specification, it was at one time the rule that the particular pages and lines where the alleged prior publication was to be found should be set out (*q*). The modern practice is

(*i*) (1889) 5 R. P. C. 33.
(*k*) (1891) 8 R. P. C. 266.
(*l*) *Curtis* v. *Platt* (1863), 8 L. T. N. S. 657; 3 Ch. Div. 135, n.; *Penn* v. *Bibby* (1866), 1 Eq. 548.
(*m*) *Phillips* v. *Ideal Cycle Co.* (1890), 7 R. P. C. 77.
(*n*) *Holliday* v. *Heppenstall* (1889), 41 Ch. Div. 109; 6 R. P. C. 320; *Cassel Gold Co.* v. *Cyanide Gold Co.* (1895), 12 R. P. C. 303; *Morgan* v. *Windover* (1890), 7 R. P. C. 446.
(*o*) *English & American Shoe, &c., Co.* v. *Union Boot, &c., Co.* (1894), 11 R. P. C. 367.
(*p*) See, *e.g.*, *Soho Laundry Co.* v. *Mackie* (1893), 10 R. P. C. 68; *Palover* v. *Rowland*, 10 R. P. C. 118.
(*q*) *Fowler* v. *Gaul* (1887), 3 R. P. C. 247.

not to require in every case a statement of the pages and lines of the specifications. The defendant must give such particulars as he is able, and such as will prevent surprise, and each case must depend upon its own special circumstances (*r*). Where the defendant mentioned fifteen specifications as anticipations, some with many claims, North, J., ordered particulars as to lines and pages.

If the defendant really does rely on the whole specification, and he states so with *bona fides*, the Court will allow him to do so, and will not order particulars of the pages and lines (*s*). Also when the specification is short, and such that a person conversant with the subject would be able to discover the part relied on, the Court has allowed the specification as a whole to be placed in the particulars (*t*).

Examples.

In *Boyd* v. *Harrar* (*u*), Kay, J., ordered particulars stating which of the parts of the plaintiff's specification was anticipated by the various specifications mentioned in the particulars of objection; in that case the specifications were complicated.

In *Holliday* v. *Heppenstall* (*x*), the Court of Appeal, whilst not ordering defendant to specify pages and lines, required him to state what the anticipation was, where it could be found, and to connect it with the plaintiff's specification.

In *Harris* v. *Rothwell* (*y*) the Court required defendant to say which of the claims had been anticipated by each specification mentioned in the particulars. The particulars contained specifications, the whole and more particularly certain parts of which were relied on; the reference to "the whole" was struck out. The invention in question related to matters of considerable intricacy and complication; Chitty, J., said: "I think that though these objections would be good in ordinary course, yet inasmuch as there are six claims, and having regard to the nature of the particulars in each claim, and the nature and intricacy of the invention, it will be right for the defendant to show, in his particulars of objections, to which of the said six claims he intends to address the objection."

Anticipation in books, &c.

In the case of anticipation in books or similar documents, the

(*r*) *Siemens* v. *Karo* (1891), 8 R. P. C. 376; *Heathfield* v. *Greenway* (1894), 11 R. P. C. at p. 19; Weekly Notes (1893), 170.

(*s*) *Siemens* v. *Karo*, *supra*; *Nettlefolds* v. *Reynolds* (1891), 8 R. P. C. 410.

(*t*) *Sidebottom* v. *Fielden* (1891), 8 R. P. C. 266, 270.

(*u*) (1888) 5 R. P. C. 33.

(*x*) (1889) 41 Ch. Div. 109; 6 R. P. C. 320. The particulars in this case were, in the opinion of the Court, shocking.

(*y*) (1886) 3 R. P. C. 243; Griff. 109.

particulars should suffice to enable the plaintiff to find where the alleged anticipation is to be found. In *Harris* v. *Rothwell* (*y*) the defendant referred to a whole book, and in particular to certain pages; the Court required the reference to the whole book to be struck out. So also in *Plimpton* v. *Spiller* (*z*), where 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."

No subject-matter.

3. *That the alleged invention is not subject-matter for letters patent, as it does not involve the exercise of invention or ingenuity.*—Particulars of this need not be given (*a*).

Want of utility. Insufficiency of the specification.

4. *Want of Utility.*—No further particulars seem necessary.

5. *Insufficiency of the Specification.*—On this the following may be raised:—

(a) That the complete specification contains an invention which the provisional did not disclose; this is, in other words, the objection of disconformity. Particulars must be given of the disconformity alleged (*b*).

(b) That the specification does not sufficiently describe how the invention is to be carried out. Particulars will be ordered which will enable the plaintiff to know in what respect the specification fails (*c*).

Pleading insufficiency of specification.

In the case of *Crompton* v. *Anglo-American Brush Electric Corporation* (*d*)—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."

(*y*) (1886) 3 R. P. C. 243; Griff. 109.
(*z*) (1877) 20 S. J. 860.
(*a*) See *Morris* v. *Young* (1895), 12 R. P. C. at p. 460.
(*b*) *Boyd* v. *Horrocks* (1886), 3 R. P. C. 285; *Anglo-American Brush Co.* v. *Crompton* (1887), 34 Ch. Div. 152; 56 L. J. Ch. 167: 4 R. P. C. 27.
(*c*) *Heathfield* v. *Greenway* (1894), 11 R. P. C. 17; (1893) W. N. 170.
(*d*) (1887) 35 Ch. Div. 283; 56 L. J. Ch. 802; 4 R. P. C. 197.

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 as so amended in its amended form, was insufficient, and that if the defendants knew exactly where the defect was they were bound to point it out

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 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* (*e*), 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 enabled them to display what appeared an objection from merely looking at the two documents.

(c) It may be desired to raise the objection that the specification does not distinguish what is new from what is old; particulars must, if possible, be given.

(d) Ambiguity in the specification; particulars of the points where the specification offends in this respect are necessary (*f*).

Other objections.

Amongst other points which may be raised in the particulars of objection, and which must be so raised if the defendant intends to rely on them, may be mentioned: (1) That the letters patent lapsed prior to the alleged infringements in consequence of the termination of the period of protection, or in consequence of the non-payment of fees; (2) that the patent is void apart from a former grant (*g*); (3) that the patent was obtained by fraud—here the particulars of the fraud are essential (*h*); (4) that the defendant has not infringed; though this would be set up in the statement of defence.

(e) 7 Ch. Div. 152, and see *supra*.

(f) *Heathfield* v. *Greenway* (1894), 11 R. P. C. 17; (1893) W. N. 170.

(g) See *Rothwell* v. *Macintosh* (1894), 11 R. P. C. 274; also *Hill* v. *Adams* (1893), 10 R. P. C. 102, an extraordinary case.

(h) *Russell* v. *Ledsam* (1843), 11 M. & W. 647; 12 L. J. Ex. 439.

Particulars of objection filed by one defendant when available to co-defendants.

If there are several defendants, and the acts complained of by the plaintiff are the common acts of the defendants, the particulars of objection delivered by one of the defendants are available to the other defendants (*i*). But if the defendants are persons whose cases are wholly distinct, and who were solely responsible for their own acts, acts in which the other defendants had no interest, it is not clear whether such co-defendants can avail themselves of each other's particulars (*k*).

(c) *Amendment of Particulars.*

The Patents Act, 1883, provides by sub-sect. 5 that particulars delivered may be from time to time amended, by leave of the Court or a Judge.

Power of Court of Appeal to amend.

It has been doubted whether the Court of Appeal could give leave to amend, the argument being that the words "the Court or a Judge" must after trial be limited in meaning to the Court or Judge before whom the action was tried. There is good reason to suppose that this is the correct construction of the same words as used in sub-sect. 6; see per Cotton, L. J., in *Cole* v. *Saqui* (*l*). But in *Cropper* v. *Smith* (*m*) Bowen, L. J., was prepared to grant leave to amend in the Court of Appeal. And the question has now been set at rest, for in *Shoe Machinery Co.* v. *Cutlan* (*n*) the Court of Appeal decided that it has power to allow the particulars to be amended even after judgment, with a view to the hearing of new evidence on the appeal, but that the power will be used with great caution. In the last-mentioned case it was decided that the powers of amendment given by R. S. C. Order LVIII. Rule 4, are exercisable in patent actions.

Powers of amendment are wide, but discretionary.

The powers of amendment are very wide. In *Cropper* v. *Smith* (*m*), Bowen, L. J., stated: "It does not seem to me material to consider whether the mistake of judgment was accidental or not. There is no such law as that it is only slips or accidental errors which are to be corrected." The power is discretionary. Therefore when the defendant applied for leave to amend by adding new objections at the trial of the action, but did not produce an affidavit showing that he could

(*i*) *Smith* v. *Cropper* (1885), 10 A. C. 249; 2 R. P. C. 17; 55 L. J. Ch. 12.
(*k*) *Ibid.* pp. 253, 254.
(*l*) (1888) 40 Ch. Div. 132; 58 L. J. Ch. 237; 6 R. P. C. 41.
(*m*) (1884) 26 Ch. Div. 700; 53 L. J. Ch. 891; 1 R. P. C. 81.
(*n*) (1895) 12 R. P. C. 530; (1896) 1 Ch. 108; 65 L. J. Ch. 44. This accords with the Irish case of *Pirrie* v. *Iris Street Flax Spinning Co.* (1894), 11 R. P. C. 429.

not have discovered the new matter earlier, North, J., refused leave (*o*). But in other cases the Court has allowed amendments to be made very late in the day or even at the trial when satisfied that the evidence the particulars are intended to foreshadow had come to the defendant's knowledge recently (*p*).

Time and procedure.

The application to amend may be made at any time (*p*), even at the trial (*q*) or after judgment and pending appeal (*r*). It should be made by summons, or in the Chancery Division by motion; but when the application is made after the hearing and pending appeal it must be made by motion in the Court of Appeal.

Terms on which amendment is allowed.

The amendment is usually allowed only on certain terms. The party amending will generally have to pay the consequent costs. And, as regards particulars of objections, there is a well-settled practice that a defendant, on being allowed to amend his particulars of objections, will be put upon terms to allow the plaintiff to elect to discontinue the action, and on so doing to get the costs incurred between the time of the delivery of the original particulars and the date of the discontinuance. This order was made in *Edison Telephone Co.* v. *India-rubber Co.* (*s*), following an unreported case: *Baird* v. *Moule's Patent Earth Closet Co.* (*t*). Chitty, J., said that he would, as a rule, make such an order as a condition of giving leave to amend (*u*).

The practice, however, is not invariable, and each case must depend upon its merits. In *Pascall* v. *Toupe* (*x*) the trial was ordered to be adjourned to enable the defendant to amend his particulars, but Kay, J., refused to make the order according to *Edison* v. *India-rubber Co.*; and the Court of Appeal, in *Wooley* v. *Broad* (*y*), stated that there was no general rule on the subject.

(*o*) (1886) *Moss* v. *Mallings*, 33 Ch. Div. 603; 56 L. J. Ch. 126; 3 R. P. C. 373. See also *Shrewsbury and Talbot Cab Co.* v. *Morgan* (1896), 13 R. P. C. 75.

(*p*) *Renard* v. *Levinstein* (1864), 11 L. T. N. S. 505; *Daw* v. *Eley* (1865), 1 Eq. 38; *Holste* v. *Robertson* (1876), 4 Ch. Div. 9: 46 L. J. Ch. 1; *Parker* v. *Maignen's Filtre Rapide Co.* (1888), 5 R. P. C. 207; *Otto* v. *Steel* (1885), 2 R. P. C. 139; *United Telephone Co.* v. *Bassano* (1885), *ibid.* 70; 3 R. P. C. 295.

(*q*) Cf. *Otto* v. *Steel* (1888), 3 R. P. C. 139; *Bakey* v. *Latham* (1889), 6 R. P. C. 29; *Allen* v. *Horton* (1893), 10 R. P. C. 412.

(*r*) *Shoe Machinery Co.* v. *Cutlan* (1895), 12 R. P. C. 530; (1896) 1 Ch. 108; 65 L. J. Ch. 44. On a new trial, see *Bovill* v. *Goodier* (1867), 36 L. J. Ch. 360.

(*s*) (1881) 17 Ch. Div. 137.

(*t*) (1880) 17 Ch. Div. 139, n. See also *Aveling* v. *Maclaren* (*ibid.*).

(*u*) *Ehrlich* v. *Ihlee* (1887), 4 R. P. C. 115. North, J., usually follows the same practice in designs cases: *Morris* v. *Coventry Machinery Co.* (1891), 3 Ch. 418; 60 L. J. Ch. 524; 8 R. P. C. 353. See also *Darrah* v. *Purser* (1889), 6 R. P. C. 365; *Soho Laundry Co.* v. *Mackie* (1893), 10 R. P. C. 68.

(*x*) (1890) 7 R. P. C. 125.

(*y*) (1892) 2 Q. B. 317; 61 L. J. Q. B. 808; 9 R. P. C. 429—a designs case. See also *Lang* v. *Whitecross Wire, &c., Co.* (1890), 7 R. P. C. 389.

Amongst other cases in which the Edison order was not made are *Otto* v. *Sterne* (*z*) and *Allen* v. *Horton* (*a*).

(*d*) *Particulars and Evidence.*

Evidence to be confined to matter raised in the particulars.

By sect. 29, sub-sect. 4, it is provided that no evidence shall, except by leave of the Court or a Judge (*b*), be admitted in proof of any alleged infringement or objection of which particulars are not delivered pursuant to the statute. The Court of Appeal may hear fresh evidence (*c*), and *semble* may give leave for its admission, though it be not within the particulars (*d*), if special application be made (*c*).

It does not follow because the particulars are vague that therefore evidence or matters which are covered by the particulars will be excluded. Therefore, 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 (*e*).

Full particulars should be obtained before trial.

"In my opinion," said Mellish, L. J., dealing with this point in *Sugg* v. *Silber* (*f*), "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 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* (*g*)—an action for the infringement of a patent for a millstone—the particulars of objections delivered under the Act of 1852, sect. 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

(*z*) (1885) 2 R. P. C. 139.

(*a*) (1893) 10 R. P. C. 412. See also *Penn* v. *Bibby* (1866), 1 Eq. 548.

(*b*) This was done, *e.g.*, in *Britain* v. *Hirsch* (1889), 5 R. P. C. 226; *Hill* v. *Adams* (1893), 10 R. P. C. 102.

(*c*) R. S. C. Order LVIII. rule 4.

(*d*) *Shoe Machinery Co.* v. *Cutlan* (1895), 12 R. P. C. 530; (1896), 1 Ch. 108; 65 L. J. Ch. 44; and R. S. C. Order LVIII. rule 4.

(*e*) *Hull* v. *Bollard* (1856), 25 L. J. Ex. 304; 1 H. & N. 134.

(*f*) (1874–77) 2 Q. B. D. 493, 495; 45 L. J. Q. B. 460.

(*g*) (1856) 25 L. J. Ex. 304; 1 H. & N. 134.

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 (*h*); and if the particulars delivered are insufficient, the party delivering them may be ordered to pay the costs of the application for better particulars (*i*).

(*e*) *General.*

Time for pleading after delivery of particulars.

By the Rules of the Supreme Court, 1883 (*k*), 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.

(*f*) *Costs of Particulars.*

Sect. 29, sub-sect. 6, provides that 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. This sub-section is dealt with *post*, under the heading "Costs."

Sect. 7.—Inspection.

Former practice as to.

"There is no use in this Court," said Lord Eldon in 1815 (*l*), "directing an action to be brought, if it does not possess the power to have the action properly tried." Therefore, if the plaintiff was otherwise unable to obtain clear and satisfactory

(*h*) *Flower* v. *Lloyd*, 20 S. J. 860.
(*i*) *Penn* v. *Bibby* (1866), 1 Eq. 548; *Grover, &c.*, v. *Wilson* (1870), W. N. 78.
(*k*) Order XIX. rule 8.
(*l*) *Bovill* v. *Moore* (1815, 1816), 2 Coop. C. C. 56, n., reported as *Brown* v. *Moore*, 3 Bligh, 178.

evidence of infringement, the Court would, other circumstances being favourable, permit an inspection on behalf of the plaintiff.

Such orders were, in fact, chiefly made by the Court of Chancery till 1852.

In that year the Patent Law Amendment Act (sect. 42) extended this equitable jurisdiction to the Courts of Common Law. 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 (*m*). These, however, were dealt with by the Common Law Procedure Act, 1852.

Sect. 30 of the Patents, &c., Act, 1883, permits the Court or a Judge in an action of infringement on the application of either party to make such order for inspection, and to impose such terms and give such direction respecting the same and the proceedings thereon, as the Court or a Judge may see fit.

Practice under R. S. C. 1883.

Under the Rules of the Supreme Court, 1883, Order L. rule 3, the widest powers of ordering an inspection are conferred on the various divisions of the High Court. The Court may make any

Detention, preservation, or inspection.

order for the detention, preservation, or inspection of any property or thing being the subject of such cause or matter, or as to which any question may arise therein, and for all or any of the purposes aforesaid may authorize any persons to enter upon or into any land or building in the possession of any party to such cause or matter, and for all or any of the purposes aforesaid to authorize any samples to be taken, or any observation to be made or experiment to be tried, which may be necessary or expedient for the purpose of obtaining full information or evidence. The only practical limit to the discretion of the Court is the necessity of the information claimed for the purposes of the trial. The Court itself has power to inspect any property or thing concerning which any question may arise (*n*).

Samples, &c.

Samples may now be taken, observations made, and experiments conducted (*o*). But the Court has refused to order that one party shall work his machines in the presence of the other party (*p*).

(*m*) *Vidi* v. *Smith* (1854), 23 L. T. 231; *Saxby* v. *Easterbrook* (1872), L. R. 7 Ex. 207, 41 L. J. Ex. 113; *Amies* v. *Kelsey* (1852), 22 L. J. Q. B. 84.

(*n*) R. S. C. 1883, rule 4.

(*o*) Order L. rule 3; cp. *Badische Anilin, &c.* v. *Levinstein*, 24 Ch. D. 156; 52 L. J. Ch. 704; 2 R. P. C. 73; *Germ Milling Co.* v. *Robinson* (1886), 3 R. P. C. 11. 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: Order XXXI. rule 30.

(*p*) *Drake* v. *Muntz Metal Co.* (1886), 3 R. P. C. 43; Griff. 78. But see *Rylands* v. *Ashby's Bottle Co.* (1890), 7 R. P. C. at p. 181.

An application for inspection in a very exceptional case has been granted *ex parte* (*q*). It may be made at any time during the progress of an action, even before the delivery of statement of claim (*r*). The terms of Order L. rule 6 leave no doubt that an adverse order for inspection may be made upon the plaintiff in an action for infringement (*s*). The Court may, of its own accord, order inspection by an expert, pending action. Pearson, J., did so in *Badische, &c., Co.* v. *Levinstein* (*t*); see also *North British Rubber Co.* v. *Macintosh & Co.* (*u*). Application for, how made.

Inspection may be granted to both parties (*x*).

The application in the Chancery Division should be made by motion to the Court, or by summons, and notice should be given.

In the Queen's Bench Division the application is to a master in chambers, or to a district registrar.

The application for inspection should, if possible, be included in the general summons for directions (*y*).

Where a plaintiff alleged that defendant was dealing in machines which were an infringement of his patent, defendant was ordered to verify on affidavit the various kinds of machine he had sold or exposed for sale, and to produce for inspection one machine of each class (*z*). There should be no order to inspect the stock as a whole (*z*).

Laches sufficient to defeat the plaintiff's right to an interlocutory injunction is not necessarily a bar to an order on the same motion for inspection and samples (*a*). Laches.

Inspection is not a matter of right, but is in the discretion of the Court (*b*), and the Court may refuse inspection, or may order a preliminary question to be tried, or may allow inspection (*c*).

In order to succeed on an application for inspection, the applicant must show by affidavit :—

(*q*) *Hennessy* v. *Bohmann*, W. N. 1877, 14.

(*r*) Dan. Prec. Ch. (1454); R. S. C. 1883, Order L. rule 6.

(*s*) *Germ Milling Co.* v. *Robinson* (1886), 55 L. J. Ch. 287; 3 R. P. C. 11; 55 L. J. Ch. 287; *Cheetham* v. *Oldham* (1888), 5 R. P. C. 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; Johns. 727. *Davenport* v. *Jepson* (1862), 1 N. R. 307; 4 De G. F. & J. 446.

(*t*) (1883) 24 Ch. Div. 156; 52 L. J. Ch. 704.

(*u*) (1894) 11 R. P. C. 477.

(*x*) *Germ Milling Co.* v. *Robinson*, *supra*; *Rylands* v. *Ashby's Bottle Co.* (1890), 7 R. P. C. 175.

(*y*) Order XXX. rule 2.

(*z*) *Singer Sewing Machine Co.* v. *Wilson* (1865), 5 N. R. 505; 13 W. R. 560.

(*a*) *Patent Type Founding Co.* v. *Walter* (1860), Johns. 727; 29 L. J. Ex. 207.

(*b*) *Macdougall* v. *Partington* (1890), 7 R. P. C. 357.

(*c*) *Rawes* v. *Chance* (1890), 7 R. P. C. 275, in which it was decided that Order XXXI. rule 20 is merely enabling.

Evidence to support motion for inspection.

1. That he is the patentee of an invention, and must state its nature (*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*). If defendant has several processes, the inspection will be limited to those only as to which a case of infringement is made out (*g*). *Primâ facie* evidence of infringement will be sufficient (*h*).

3. That the inspection sought for is material to his case (*i*). 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 (*k*).

If the *primâ facie* evidence above referred to be satisfactory, an order for inspection will be made, almost of course (*l*).

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 (*m*);

(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 (*n*). But an objection that an order for inspection would lead to the disclosure of trade secrets will not generally prevail if the case for inspection is otherwise satisfactory. The Court will, at the proper time, protect the defendant from an

Objection that inspection will lead to disclosure of trade secrets.

(*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 R. P. C. 217.

(*g*) *Cheetham* v. *Oldham* (1888), 5 R. P. C. 617.

(*h*) *Shaw* v. *The Bank of England*, *ubi supra*; *Singer Co.* v. *Wilson* (1865), 13 W. R. 560; *Batley* v. *Kynock* (1874–75), L. R. 19 Eq. 90, 92; 44 L. J. Ch. 89.

(*i*) *Piggott* v. *Anglo-American Telegraph Co.* (1868), 19 L. T. N. S. 46. And see *Meadows* v. *Kirkman* (1860), 29 L. J. Ex. 205.

(*k*) *Shaw* v. *Bank of England*, *ubi supra*.

(*l*) *Singer Manufacturing Co.* v. *Wilson* (1865), 13 W. R. 560.

(*m*) *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 R. P. C. at p. 618.

(*n*) *Singer Manufacturing Co.* v. *Wilson*, *supra*; *Cheetham* v. *Oldham* (1888), 5 R. P. C. 617. The Court is reluctant to order inspection if it would be injurious to one of the parties, particularly if the infringement or the validity of the patent be in doubt: *Macdougall* v. *Partington* (1890), 7 R. P. C. 351, 472.

improper disclosure of his secret (*o*). In *Badische, &c.* v. *Levinstein* (*p*), Pearson, J., caused a secret process to be disclosed pending action, but *in camera*, and he impounded the notes of the evidence so far as it related to the secret process.

(3) If the articles which it is desired to inspect are not under the control of the party against whom inspection is asked, the Court will not make the order (*q*); but where, although the party is not owner, he is in a position to allow inspection (*r*).

Form of order.

The order for inspection (*s*) usually specifies the number of inspections allowed (*t*), the names of the inspectors (the plaintiff being not always an inspector (*u*)), and the notice to which the person against whom the order is made shall be entitled (*x*). See Form of Order, *post*, p. 838.

Sect. 8.—Discovery and Interrogatories.

Generally.

Discovery.—There is nothing peculiar to patent action in the rules governing the right to discovery and production of documents. The Rules of the Supreme Court, 1883, are applicable. Order XXXI. rule 12, relates to affidavits of documents; rules 14 and 15 deal with production of documents; rule 25 prescribes the deposit required; and rule 19A modifies practice relative to inspection of business books, and the conclusiveness of a claim of privilege, and empowers the Court to require a party to state whether or not any party has a specific document or specific documents in his possession, or whether he has parted with them, and what has become of them (*y*). The cases on these matters are dealt with in the Annual Practice, notes to Order XXXI.

Privileged documents.

The following cases occurred in the course of patent litigation: *Haslam* v. *Hall* (*z*) (document not to be disclosed which had come into existence merely to be communicated to the solicitor for the

(*o*) *Renard* v. *Levinstein* (1864–65), per Wood, V.-C., 10 L. T. N. S. 95; *Cheetham* v. *Oldham* (1888), 5 R. P. C. 617. See also *Russell* v. *Crichton* (1837), 15 Dec. Court of Sess. 1st Ser. 1270. For an instance where special precautions were taken to prevent disclosure of a secret process, see *Plating Co.* v. *Farquharson* (1879), Griff. 187.

(*p*) (1883) 24 Ch. Div. 156; 52 L. J. Ch. 704; 2 R. P. C. 73.

(*q*) *Garrard* v. *Edge* (1889), 58 L. J. Ch. 397; 6 R. P. C. 372; *Sidebottom* v. *Fielden* (1891), 8 R. P. C. 266, 270.

(*r*) *Rylands* v. *Ashby's Bottle Co.* (1890), 7 R. P. C. 175.

(*s*) See Seton, 350.

(*t*) *Heathfield* v. *Braby*, Seton, 1661. But see *Germ Milling Co.* v. *Robinson* (1886), 3 R. P. C. 11.

(*u*) *Flower* v. *Lloyd* (1876), W. N. 169, 230.

(*x*) Pemberton, p. 236.

(*y*) See the former rule applied in *Edison* v. *Holland* (1888), 5 R. P. C. 213; W. N. 31.

(*z*) (1887) 5 R. P. C. 1.

purpose of litigation, actual or intended, and either as materials for briefs or for his advice or consideration); but see *Westinghouse* v. *Midland Railway Co.* (*a*) (reports and letters obtained from their officers by a company which had been warned but not threatened with litigation in respect of an alleged infringement of a patent, were held not to be privileged); *Moseley* v. *Victoria Rubber Co.* (*b*) (communications between a litigant and his patent agent are not always privileged, though the patent agent is also the solicitor; the communications are privileged only if they were made to the solicitor as a solicitor); *De la Rue* v. *Dickinson* (*c*) (defendant cannot be compelled before trial to give discovery not material to the issue at the hearing (*d*)).

In *Bown* v. *Sansom* (*e*), the defendant pleaded that plaintiff's patent was invalid by reason of a certain anticipation; the same anticipation had been set up by a defendant in another action brought by the plaintiff, and in that previous action the plaintiff's solicitor had put upon the file affidavits alleging the anticipation to be fraudulent. The affidavits were eventually taken off the file under an arrangement which resulted in a consent order. In the present action the plaintiff scheduled in his affidavit of documents the consent order, and he referred elsewhere to the affidavits which alleged the fraudulent nature of the anticipation. The Court of Appeal decided that the affidavits alleging fraud in connection with the anticipation set up by the prior defendant were relevant in the later action, the same point being raised in it, and as the plaintiff had omitted these, ordered him to make a further and better affidavit of documents.

Documents used in previous litigation.

In *Thompson* v. *Hughes* (*f*), the affidavits and notes of evidence in a prior infringement action in which the plaintiff had been engaged, were, with the approval of the Court of Appeal, produced.

After judgment.

After judgment ordering an inquiry as to damages, discovery is more freely ordered in certain particulars. Thus in *American Braided Wire Co.* v. *Thomson* (*g*), Kekewich, J., ordered the defendants to produce documents disclosing the names of the defendant's customers to whom were sold articles made in

(*a*) (1883) 48 L. T. N. S. 98, 462.
(*b*) 55 L. T. N. S. 482; 3 R. P. C. 351.
(*c*) (1857) 3 K. & J. 388.
(*d*) See also *Rawes* v. *Chance* (1890), 7 R. P. C. 275.
(*e*) (1888) 5 R. P. C. 510.
(*f*) (1889) 7 R. P. C. 187; W. N. 212.
(*g*) (1888) 5 R. P. C. 975. And see *Murray* v. *Clayton* (1872), 15 Eq. 115; 42 L. J. Ch. 191. Before order, see *Smith* v. *G. W. Railway* (1854), 3 W. R. 69.

infringement of the plaintiffs'; also the documents disclosing the price of such sales.

Interrogatories.

The rules which govern the administration of interrogatories in actions generally, apply to the action for infringement of a patent; and the right to interrogate exists notwithstanding that the information required could be obtained as particulars under sect. 29 of the Patents Act, 1883 (*h*). The existing law as to discovery is contained in Order XXXI. of the Rules of the Supreme Court, 1883, as altered by the Rules of November, 1893. Its chief provisions, so far as relate to actions of infringement, are as follows:—

The plaintiff or defendant in an action may, 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 (*i*). Interrogatories which do not relate to any matters in question shall be deemed irrelevant, notwithstanding that they might have been admitted on cross-examination (*k*). On an application for leave to deliver interrogatories, the particular interrogatory proposed to be delivered shall be submitted to the Court or Judge. In deciding upon such application, the Court or Judge shall take into account any offer which may be made by the party sought to be interrogated, to deliver particulars, or to make admissions, or to produce documents relating to the matters in question, or any of them, and leave shall be given as to such only of the interrogatories submitted as the Court or Judge shall consider necessary either for disposing fairly of the cause or matter or for saving costs (*l*). The Court or a Judge has power to prevent premature discovery, as also to prevent premature inspection (*m*). Interrogatories will not usually be allowed till after defence, but the rule is by no means invariable (*n*).

The costs of discovery, by interrogatories or otherwise, must be secured in the first instance by the applicant (*o*).

A defendant against whom an order for discovery is made must answer categorically every question which can assist the plaintiff in making out his title to relief (*p*).

(*h*) *Birch* v. *Mather* (1883), 22 Ch. Div. 629; 52 L. J. Ch. 292; but see now Order XXXI. rule 2, quoted above.

(*i*) Rule 1.

(*k*) Rule 1.

(*l*) Order XXXI. rule 2, allowing the interrogatory, does not take away the right to object to answer it; see Order XXXI. rule 6; and *Peek* v. *Ray*, 63 L. J. Ch. 647; 70 L. T. N. S. 769; 42 W. R. 498.

(*m*) Rule 20.

(*n*) See, *e.g.*, *Mercier* v. *Cotton*, 1 Q. B. D. 424; 46 L. J. Q. B. 184; *Harbord* v. *Monk*, 9 Ch. Div. 616; *Beal* v. *Pilling*, 38 L. T. N. S. 486.

(*o*) Rule 25.

(*p*) *Swinborne* v. *Nelson* (1852–5), 22 L. J. Ch. 331; 16 Beav. 416, 417; *Elmer* v. *Creasy* (1873), 9 Ch. 69; 43 L. J. Ch. 166. As to the grounds on which

A defendant denying infringement must answer everything tending to show the fact of infringement, but not questions which assume that infringement has taken place, and answers to which may be obtained at the hearing, provided that infringement be then established (*q*).

Questions as to infringement.

The plaintiff may take the defendant step by step through the specification and ask whether he has carried out any of the steps. *E.g.*, he may (1) ask whether defendant used each particular process; (2) require him to state whether, if he had ever used any of the said processes, he had, in using or employing the same, adopted the same means with the same object, and by use of an apparatus made as described in the plaintiff's specification; (3) ask defendant to say what step or thing other or additional to that declared in the plaintiff's specification he took or used in carrying out his process (*r*); (4) ask whether the defendant used the materials mentioned in the plaintiff's specification, whether he added anything else, and whether the additions made any difference in the process (*s*), 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 (*t*); (5) ask the names and addresses of those alleged by the particulars of objection to have used the invention claimed by him at the places named (*u*). He may also interrogate as to the dates and places of the user (*x*). But where the allegation is not of a specific anticipation, but of general user and knowledge, the interrogatory will not usually be allowed (*y*).

Names and addresses of infringers.

Interrogation with a view to an account usually not allowed before judgment.

Before judgment plaintiff cannot ask (1) 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; nor (2) for an account of articles alleged to be infringements manufactured by any machine used by

discovery may be resisted, see Annual Practice, note to Order XXXI.

(*q*) *De la Rue* v. *Dickinson* (1857), 3 K. & J. 388; *Lister* v. *Norton* (1885), 2 R. P. C. 68; *Lea* v. *Saxby* (1875), 32 L. T. N. S. 731.

(*r*) *Ashworth* v. *Roberts* (1890), 45 Ch. Div. 623; 60 L. J. Ch. 27; 7 R. P. C. 451; *Benno Jaffe, &c., Co.* v. *Richardson* (1893), 10 R. P. C. 136; 62 L. J. Ch. 610.

(*s*) *Renard* v. *Levinstein* (1864), 10 L. T. N. S. 94; but see *Rolls* v. *Isaacs* (1878), W. N. 37.

(*t*) *Bovill* v. *Smith* (1866), 2 Eq. at p. 461.

(*u*) *Birch* v. *Mather* (1883), 22 Ch. Div. 629; 52 L. J. Ch. 292.

(*x*) *Alliance Pure White Lead, &c., Co.* v. *MacIvor's Patent Co.* (1891), 8 R. P. C. 321; cf. *Crossley* v. *Tomey* (1876), 2 Ch. Div. 533.

(*y*) *Palmer* v. *Wagstaffe* (1853), 8 Ex. 840; 22 L. J. Ex. 295.

the defendants and discovery of the persons to whom such articles had been sold; nor (3) for accounts of the sales of articles, the profits made by defendants, the stock in hand of such articles, and an account of moneys received by and due to the defendants in respect thereof (*z*).

Nor, where anticipation is alleged by the defendant, can he ask what the alleged anticipation actually did (*a*). But a defendant, in order to prove want of novelty, may interrogate as to the inventions described in previous patents, and may ask in what respect they differ from plaintiff's patent (*b*).

Interrogatories as to want of novelty.

When 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 will not be compelled to answer interrogatories as to sales to particular customers (*c*) until after judgment.

In short, 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 discovery required is such that the giving of it may be prejudicial to the defendant, the Court takes into consideration the special circumstances of the case, and whilst, on the one hand, it takes care that the plaintiff obtains all the discovery which can be of use to him, on the other, it is bound to protect the defendant against undue inquisition into his affairs (*d*).

Principles on which Court acts in allowing inspection.

A plaintiff has no right to inquire by interrogatories into the defendant's case, nor to ask for the names of the witnesses whom defendant intends to produce, nor the names of persons to whom he has sold articles similar to the machine alleged to be infringed, nor to require a description of all machines similar to the plaintiff's made or used by him prior to the patent (*e*).

There is this difference: A plaintiff is not entitled to discovery of defendant's case; a defendant may ask any question tending to destroy the plaintiff's case (*f*). But if an answer has to be given, it must be fairly and fully given (*f*). And the fact that the

The difference as to right to interrogate between plaintiff and defendant.

(*z*) *De la Rue* v. *Dickinson* (1857), 3 K. & J. 388.

(*a*) *Delta Metal Co.* v. *Maxim Nordenfeldt Gun, &c., Co.* (1891), 8 R. P. C. 169.

(*b*) *Hoffmann* v. *Postill* (1869), 4 Ch. 673.

(*c*) *Lister* v. *Norton* (1885), 2 R. P. C. 68; and cf. *Crossley* v. *Tomey* (1875), 2 Ch. Div. 533.

(*d*) *Moore* v. *Craven* (1872), L. R. 7 Ch. 94, 96, n.; *Daw* v. *Eley* (1865), 2 H. & M. 725.

(*e*) *Daw* v. *Eley*, *supra*.

(*f*) *Hoffmann* v. *Postill* (1869), 4 Ch. 673; 17 W. R. 901.

interrogatory may expose others to an action for infringement, is not *per se* any reason for not answering it (*g*).

Secret process cases.

It is sometimes objected that the answer ought not to be given, as it would disclose a secret process to the plaintiff. The Court will in such cases do what it thinks just to protect the secrecy of the process (*h*). But the plaintiff may even then put his specification to defendant step by step, and ask him whether the steps in his process are the same, and he may be asked what additions he makes, though interrogatories as to the proportions have been disallowed (*i*).

After judgment.

After judgment, when the question of an account arises, or when an inquiry as to damages is being to be taken, defendant may be interrogated as to the persons he has supplied with the infringing article, and may be asked for their names and addresses (*k*).

Power to refuse discovery pending trial of particular issues.

Under R. S. C. Order XXX. rule 20, the Court can refuse discovery or interrogatories pending the trial of any issue on the determination of which the right to discovery, &c., may depend. But the Court will not refuse leave to interrogate as to infringement until the validity of the patent has been tried (*l*). The rule is merely enabling, and the discretion of the Court in this respect is unfettered (*m*).

Sect. 9.—The Trial.

Judge and jury.

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 (*n*). The unfitness of this tribunal for the trial of patent actions 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 (*o*).

(*g*) *Tetley* v. *Easton* (1856), 18 C. B. 643; 25 L. J. C. P. 293; *Jourdain* v. *Palmer* (1866), L. R. 1 Ex. 102.

(*h*) See the course followed in *Badische, &c.* v. *Levinstein* (1883), 24 Ch. Div. 156. The case was heard *in camera*: 52 L. J. Ch. 704; 2 R. P. C. 73.

(*i*) *Renard* v. *Levinstein* (1864), 3 N. R. 665; 10 L. T. N. S. 94; *Ashworth* v. *Roberts* (1890), 45 Ch. Div. 623; 7 R. P. C. 451; 60 L. J. Ch. 27. See also *Rylands* v. *Ashby's Bottle Co.* (1890), 7 R. P. C. 175, where an interrogatory which might have caused a disclosure of a secret modification was considered.

(*k*) *Murray* v. *Clayton* (1872), 15 Eq. 115; 42 L. J. Ch. 191; *Crossley* v. *Stewart* (1863), 1 N. R. 426; *How* v. *M'Kernan*, 30 Beav. 847.

(*l*) *Benno Jaffe, &c.* v. *Richardson* (1893), 10 R. P. C. 136; 62 L. J. Ch. 610.

(*m*) *Rawes* v. *Chance* (1890), 7 R. P. C. 275.

(*n*) Report, &c. (1865), Ans. 1274.

(*o*) Cp. evidence of Mr. Grove, Report, 1865, Ans. 1077: "I have always had a very strong feeling in favour of

The objections to a jury as the tribunal for the trial of patent cases were forcibly stated by Lord Selborne in *The Patent Marine Inventions Co.* v. *Chadburn* (*p*) :—

Lord Selborne on objections to trial of patent cases by jury.

"It is to be observed that such cases almost always involve questions of law and fact, not only mixed, but mixed in such a way as to render the extrication of them extremely difficult; secondly, that very often much must depend upon the construction of documents as to which a jury must take their direction entirely from the Judge; thirdly, that much of the evidence, or that which is to be permitted to be given as evidence, in such cases is argumentative and relative to matters of opinion, so as to make it extremely hard, even for the Judge himself, to keep it under proper control; and, lastly, that even the questions of fact are often, to a very great extent, questions of science, which, to say the least, are as likely to be as well decided by a Judge as by any jury. It very rarely happens, if it ever does, 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" (*q*).

Trial without a jury the usual procedure.

Assessors.

The Patents Act, 1883, sect. 28, provides that in any action or proceeding for infringement of a patent the action shall be tried without a jury unless the Court shall otherwise direct; but that 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 shall try and hear the case wholly or partially with his assistance.

Though the ordinary way of trying an infringement action is before a Judge alone, this is not the only possible method of trial. A jury may still be had on application in a fit case, or, as above stated, assessors may be brought in to assist. But, in

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."

(*p*) (1873) L. R. 16 Eq. 447.

(*q*) 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?

addition to these modifications, it is possible to try the case under the provisions of the Arbitration Act, 1889.

Arbitration.

That Act provides for references or arbitrations both by private arrangement and by order of the Court.

That the parties may assent to have their differences settled by a private arbitration is clear. If the submission to arbitration be in writing, it will be irrevocable without leave of the Court (*r*), and any action brought in connection with the matter agreed to be referred may be stayed by the Court (*s*). Such a tribunal as this is not bound by any special rules of procedure, but it cannot give certificates of validity nor exercise any of the powers specially given by the Patents Acts to the Court or a Judge. The powers of a private arbitrator and the regulations applying to an arbitration are to be found in the Arbitration Act, 1889, sects. 1—12 and 18—23, and in Schedule I. to that Act.

Compulsory references.

Independently of private arrangement, the same Act gives certain powers to the Court to refer either issues or the whole case and either to a special or to an official referee. This can always be done if the parties consent (*t*). Any special question arising in the cause may be sent for inquiry or report to any such referee (*u*), and the report may be adopted wholly or partially by the Court (*x*) or a Judge, and if so adopted may be enforced as an order or judgment to the same effect (*y*). The power given by this section will be found useful when an inquiry as to damages or an account of profits has to be taken (*z*).

A still more important power is that given by sect. 14. It is provided that "in any cause or matter (*t*), ... if all the parties interested who are not under disability consent, or if the cause or matter requires any prolonged examination of documents or any scientific or local 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 other ordinary officers, or if the question in dispute consists wholly or in part of matters of account, the Court or a Judge may at any time order the whole cause or matter, or any question of fact or issue arising therein, to be tried before a special referee or

(*r*) Arbitration Act, 1889, sect. 1.
(*s*) *Ibid.* sect. 4.
(*t*) Sect. 14 (a).
(*u*) Sect. 13 (1).
(*x*) See *Badische, &c.* v. *Levinstein* (1883), 24 Ch. D. 156; 52 L. J. Ch. 704; 2 R. P. C. 73.
(*y*) Sect. 13 (2).
(*z*) See R. S. C. 1883, Order XXXVI. rules 54, 55.

arbitrator, respectively agreed upon by the parties, or before an official referee or officer of the Court."

Sect. 15 of the same Act provides that in all cases of reference to an official or special referee or arbitrator under an order of the Court or a Judge in any cause or matter the official or special referee or arbitrator shall be deemed to be an officer of the Court, and shall have such authority and shall conduct the reference in such manner as may be prescribed by rules of Court, and subject thereto, as the Court or a Judge may direct. The report or award, unless set aside by the Court or a Judge, is equivalent to the verdict of a jury (*a*).

Difficulties in referring the main dispute in a patent action.

Under the 57th section of the Judicature Act, 1873—which is in substance the same as the section of the Arbitration Act just quoted—Hawkins, J., compulsorily referred a patent action to an official referee as a case requiring scientific investigation, and the Court of Appeal refused to disturb his decision (*b*). Such a course has, however, many inconveniences. Notably it might prevent the plaintiff from getting his certificate of validity, and complications might arise over the incidence of the costs of particulars. Moreover, the Patents Act, 1883, sect. 27, clearly points to trial by a Judge without a jury, and the other provisions of the Patents Acts bear this out.

The rules relating to trial before referees are to be found in R. S. C., Order XXXVI. rule 43, *et seq.*; for discovery and production of documents see Order XXXVI. rule 50; entry of judgment, Order XXXVI. rule 50. As to questioning or setting aside the award see rule 52, also Order XL. rule 6.

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 (*c*). There have been several decisions under this rule.

Cases.

In *United Telephone Co.* v. *Mottishead* (*d*), 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

(*a*) Power to refer is given also by R. S. C., Order XXXVI. rule 7 a.

(*b*) *Saxby* v. *Gloucester Waggon Co.* (1880), W. N. 28.

(*c*) R. S. C. 1883, Order XXXIV. rule 2.

(*d*) (1886) 3 R. P. C. 213.

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* (*e*), 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* (*f*), 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 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 leave on such terms, if any, as shall appear just (*g*).

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. The

Reference of provisional specification to expert.

Act of 1852, sect. 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 patent, the Court may, if it thinks fit, and shall, on the request

(*e*) (1887) 4 R. P. C. 265.

(*f*) (1888) 5 R. P. C. 238. It has been suggested that the sufficiency of the specification might be tried in advance as a question of law; *Bolivian Republic* v. *Bolivian Navigation Co.*, 34 W. R. 361.

(*g*) R. S. C., Order XL. rules 7, 8.

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 (*h*). 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 (*h*), 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 (*h*).

This power of trying with an assessor has been practically in abeyance, and there seems little likelihood of its coming into common practice (*hh*).

Position of assessors.

The rule laid down by Lord Esher in the case of *The Beryl* (*i*), 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 should a necessity for deciding this point arise.

Procedure in an action of infringement.

The procedure in an action of infringement of a patent follows that of any other action. The burden of proof is generally, though not always, on the patentee (*k*), and he has the right of reply if defendant calls evidence. It may be that though he has closed his case he will get leave to call evidence in reply before the defendant sums up. Thus in *Penn* v. *Jack* (*l*) Page Wood, V.-C., said: "I think the plaintiff is entitled to adduce evidence in reply for the purpose of rebutting the case set up by the defendant; and for this reason, that it is quite impossible for him to know what is the nature of the evidence which will be produced. The defendants, who contest the validity of the invention, have in effect put in a plea denying the novelty of the plaintiff's patent, and the affirmative issue thus in reality rests with the defendants, who are not obliged to give the names of their witnesses. How can the plaintiff possibly meet such a case until he hears the evidence for the defence, and knows what the witnesses will prove?"

(*h*) Sect. 28; see also R. S. C., Order XXXVI. rule 7 a.

(*hh*) The Judge may direct an expert to make a special report to the Court: *e.g.*, as in *Badische, &c.* v. *Levinstein* (1884), 24 Ch. Div. 156; *British Rubber Co.* v. *Macintosh* (1894), 11 R. P. C. 447; see form of order, *post*, 839.

(*i*) (1884) 9 P. D. 137, 141.

(*k*) *E.g.*, *Westley* v. *Perkes* (1893), 10 R. P. C. 181, the defendant was made to prove his case early in the day. It may be noted that in revocation proceedings the defendant begins; see Patent Act, 1883, sect. 26.

(*l*) (1866) 2 Eq. at p. 317.

When defendant does not appear.

If the defendant does not appear it will ordinarily suffice to put in the patent, prove the specification, and the infringement (*n*).

The patent is proved by production of the patent, with the seal of the Patent Office attached (*o*). If the letters patent be held by an assignee a sealed certified copy of the entry in the register will prove the plaintiff's title (*p*), and will throw the burden of disproving it upon the defendant.

Evidence.

If subject-matter be attacked, it is allowable to give evidence of experiments, showing the difficulty of arriving at the invention (*q*).

Evidence of validity need, in the first instance, be but slight (*r*), the burden of proof of identity being on the defendant (*s*).

Evidence as to the meaning of the specification is allowed only to explain terms of art, or to explain the processes referred to (*t*). It is not allowable even for the patentee to say what the specifications mean, or what he meant by the words he used, when the Court is satisfied that it understands the document (*u*).

Evidence that a given article *must* have been made according to the plaintiff's invention has been allowed as proof of infringement, but something stronger than this is usually wanted (*x*).

Scientific evidence.

Scientific evidence is valuable for the purpose of explaining and pointing out things which would possibly be passed over but for the assistance given by experts (*y*); but the Court is not bound by their opinions (*z*); and indeed it is not right to give in evidence the opinion of expert witnesses as to whether one thing is or is not an infringement of another (*a*). They may give evidence as to the state of knowledge, and they may be asked what are and what are not mechanical equivalents (*b*). The opinion of the law officer dealing with a patent should not be read at the trial of an action for infringement of that patent (*c*).

(*n*) *Peroni* v. *Hudson* (1884), 1 R. P. C. 261.

(*o*) Act of 1883, sects. 12 (2) and 84.

(*p*) Sects. 23 (2), 40, and 89.

(*q*) *Thierry* v. *Rickmann* (1895), 12 R. P. C. 417.

(*r*) *Turner* v. *Winter* (1787), 1 W. P. C. 77; 1 T. R. 602.

(*s*) *Muirhead* v. *Commercial Cable Co.* (1895), 12 R. P. C. at p. 56.

(*t*) See *ante*, p. 209.

(*u*) This is dealt with *ante*, pp. 209, 210; and see *Badische, &c.* v. *Levinstein* (1888), 12 App. Ca. at p. 717; *Kaye* v. *Chubb* (1887), 4 R. P. C. 297, 298.

(*x*) Cf. *Huddart* v. *Grimshaw* (1803), 1 W. P. C. 85; *Cartsburn* v. *Sharpe* (1884), 1 R. P. C. 181.

(*y*) See per Lord Herschell in *Boyd* v. *Horrocks* (1892), 9 R. P. C. at p. 81; Smith, L. J., in *Gadd* v. *Mayor of Manchester* (1892), 9 R. P. C. 530.

(*z*) Lord Esher in *Leadbeater* v. *Kitchin* (1890), 7 R. P. C. at p. 247.

(*a*) *Seed* v. *Higgins* (1860), 8 H. L. C. 565; 30 L. J. Q. B. 314; *Westinghouse* v. *Lancashire, &c., Railway* (1894), 1 R. P. C. 229; per Esher, M. R., in *Parkinson* v. *Simon* (1894), 11 R. P. C. at p. 506.

(*b*) *Ticket Punching Co.* v. *Colley's Patents* (1895), 12 R. P. C. 186.

(*c*) Per Cotton, L. J., in *Siddell* v. *Vickers* (1888), 5 R. P. C. at p. 436.

Evidence specially prepared for the trial.

The Court looks with suspicion upon evidence brought into existence with a special view to the trial, and on drawings or experiments designed to prove that the alleged invention is or is not practicable (*d*). But it will sometimes order special evidence to be prepared by an independent expert (*e*).

In connection with evidence the following provisions of the Patents Acts and Rules are of importance:—

Seal of the Patent Office.

(1) The impression of the seal of the Patent Office shall be judicially noticed and received in evidence (1883, sect. 84). A patent sealed with such seal shall have the same effect as if it were the great seal of the United Kingdom (1883, sect. 12 (2)).

Register of patents.

(2) The register of patents shall be *primâ facie* evidence of any matters decided and authorized by the Patents Acts to be inserted therein (1883, sect. 23 (2)). This has been interpreted to mean that if a document is passed by the proper officer and entered in the register, there is *primâ facie* evidence that the document is a proper one to register, and that the registration has been properly effected; but there is no inference that notice of the contents of the document has been given to the world at large (*f*).

Patent Office copies and certificates.

(3) Specifications, disclaimers, and other documents or extracts from them in the Patent Office may be proved by printed or written copies purporting to be certified by the Comptroller and sealed with the seal of the Patent Office (1883, sect. 89).

(4) Copies or extracts of or from registers and other books may be proved in the same manner (1883, sect. 89) (*g*).

(5) A certificate purporting to be under the hand of the Comptroller, as to any entry, matter, or thing which he is authorized to make or do under the Act and rules, is *primâ facie* evidence of the entry having been made, and of the contents thereof, and of the thing having been done or left undone (1883, sect. 96).

(6) Orders made by the Board of Trade may be proved *primâ facie* by the production of documents, if purporting to be sealed with the seal of the Board of Trade, or to be signed by a

(*d*) *Betts* v. *Neilson* (1868), 3 Ch. 429; 37 L. J. Ch. 321; *Plimpton* v. *Malcolmson* (1876), 3 Ch. Div. 576.

(*e*) This was done in *Badische, &c.* v. *Levinstein* (1883), 24 Ch. Div. at p. 156; and in *North British Rubber Co.* v. *Macintosh & Co.* (1894), 11 R. P. C. at p. 484.

(*f*) *Heap* v. *Hartley* (1888), 5 R. P. C. at p. 608; see also 42 Ch. Div. 461; 6 R. P. C. 495.

(*g*) As to Scotland and Ireland, see 1883, sect. 100. For method of obtaining these, see Patent Rule 79, *post*, p. 707.

secretary or assistant secretary of the Board, or by any person authorized in that behalf by the President of the Board (Act of 1883, sect. 102 (2); 1888, sect. 25).

Board of Trade certificates.

(6) A certificate signed by the President of the Board of Trade to the effect that any order made or act done is the order or act of the Board is conclusive evidence of the fact so certified (Act of 1883, sect. 102 (3); 1888, sect. 25).

(7) General rules made under the Act of 1888, sect. 101 (3), are to be judicially noticed.

Miscellaneous Points connected with the Trial.

Expedition of the Trial.—The fact that the trade with which the patent is connected was temporary, and that an application for an interlocutory injunction was standing over to the trial, was held to be no ground for giving preference to the action over actions which had been set down before it (*h*).

Postponement of the Trial.—Sometimes a trial has been postponed pending revocation proceedings. There is no binding rule (*i*).

Venue.

Venue.—Relating to trial at assizes: See *Edmunds's Patent* (*k*), in which an action commenced in the Chancery Division was sent to trial at Birmingham, and *Fairburn* v. *Household* (*l*), in which it was decided that pressure of business at the assize town was no reason for remitting a patent action to a Chancery Division Judge sitting in London.

Hearing in Camera.—Where the defendant alleged that he used a secret process entirely different from plaintiff's, the Court allowed the defendant to describe the process *in camera*, and the notes of the evidence were impounded (*m*).

Exhibits.

Exhibits and Models.—An example of a class of machine may be handed up to enable the Court properly to appreciate counsel's argument, though it be not put in evidence (*n*). Admitted models are evidence of a nature similar to documents (*o*). In *The Shoe Machinery Co.* v. *Cutlan* (*p*), Romer, J., refused to admit exhibits referring to alleged infringements, but on the ground

(*h*) *Farbenfabriken, &c., Co.* v. *Bowker* (1891), 8 R. P. C. 136.

(*i*) See, *e.g.*, *Smith* v. *Upton* (1843), 6 M. & G. 251; *Muntz* v. *Foster* (1844), 2 W. P. C. 93, n.; *Patteson* v. *Holland* (1845), Hig. Digest, p. 354.

(*k*) (1889) 6 R. P. C. 355.

(*l*) (1885) 2 R. P. C. 195.

(*m*) *Badische Anilin, &c., Co.* v. *Levinstein* (1883), 24 Ch. Div. 156; 52 L. J. Ch. 704; 2 R. P. C. 73.

(*n*) *Boyd* v. *Horrocks* (1889), 6 R. P. C. 152.

(*o*) *Westinghouse* v. *Lancashire and Yorkshire Railway* (1884), 1 R. P. C. at p. 245.

(*p*) (1895) 12 R. P. C. 358.

that they referred to machinery used by the defendant after action brought and because the action was in respect of past infringements, and not of threats of future infringements.

Effect of previous judgment.

In *Slazenger* v. *Feltham* (*q*), 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* (*r*) 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 was 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 (*s*).

In *The Shoe Machinery Co.* v. *Cutlan* (*t*), the Court upheld the validity of a patent attacked on the ground of anticipation, but infringement was not proved. In a second action, the defendant again sought to impeach the patent, on the ground of anticipations other than those set up in the former action. Held, he was estopped, the validity of the patent being *res judicata*.

In *Moore* v. *Thomson* (*u*), it was stated that a defendant who has submitted to an injunction cannot, on being sued for a second infringement, attack the validity of the patent either directly or indirectly.

Sect. 10.—Remedies.

(*a*) *Perpetual Injunction.*

When granted.

After a patentee has conclusively (*x*) established the validity of his patent, he may obtain a perpetual injunction against the defendant, 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

(*q*) (1889) 6 R. P. C. 130.

(*r*) (1889) 6 R. P. C. 243; cp. *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*, *Ibid.* 367.

(*s*) *S. C.* p. 120, *ubi supra*. But see *Shaw* v. *Day* (1894), 11 R. P. C. 189.

(*t*) (1896) 1 Ch. 667; 65 L. J. Ch. 314; 13 R. P. C. 345.

(*u*) (1890) 7 R. P. C. 325.

(*x*) *Hills* v. *Evans* (1862), 31 L. J. Ch. 457; 4 De G. F. & J. 289.

modes in which the patent privilege may be violated (*y*). But if the patentee amends his specification, an injunction obtained prior to the amendment will no longer hold good (*z*). There seems to be no reason why the plaintiff who amends pending action should not proceed against others than the defendant for an injunction. As regards the defendant in the pending action, see *Mayer* v. *Sherwood* (*a*). In the absence of special conditions under sect. 19, there seems no reason why the injunction should not be granted, unless after the amendment defendant declares that he has no intention of infringing. An injunction will not be granted against a third party (*b*).

Grounds for refusing injunction.

An injunction will be granted when the plaintiff's legal right has been infringed, unless: (1) the injury to the plaintiff's legal right is small and (2) capable of being estimated in money, and (3) can be adequately compensated by a small payment, and (4) it would be oppressive to the defendant to grant an injunction (*c*).

Grounds on which an injunction will be granted.

Where there is no future threatened danger to the plaintiff's rights, an injunction may be refused (*d*). Though the infringement usually implies an intention to infringe in future (*e*), yet if the person who infringes undertakes not to repeat his infringement, or if there is reason to suppose on any other ground that the defendant will not infringe in future, the Court will usually not make an order for injunction. In *Geary* v. *Norton* (*f*) an injunction was granted against tradesmen selling articles which infringed the plaintiff's design, though the defendants promised to commit no infringement in future. In *Millington* v. *Fox* (*g*) the defendant innocently used the plaintiff's trade-mark, and did not intend to use it again, but the Court granted an injunction. These two last-named cases were explained by Cotton, L. J., in *Proctor* v. *Bayley* (*h*), where he says that the injunctions in *Geary* v. *Norton* (*f*) and *Millington* v. *Fox* (*g*) were granted because there was some reason to fear at the date of the filing of the bills that the plaintiffs were not safe. In *Proctor* v. *Bayley* (*h*) the Court decided that where a valid patent is

Effect of undertaking not to repeat infringement.

(*y*) Hindmarch, p. 361.

(*z*) *Dudgeon* v. *Thompson* (1879), 3 App. Ca. 34.

(*a*) (1890) 7 R. P. C. 283.

(*b*) *Edison* v. *Holland* (1889), 41 Ch. Div. 28; 58 L. J. Ch. 524; 6 R. P. C. 243.

(*c*) See *Shelfer* v. *City of London Electric Light Co.* (1895), 1 Ch. 287; 64 L. J. Ch. 216.

(*d*) See *Proctor* v. *Bayley* (1889), 42 Ch. Div. 390; 39 L. J. Ch. 12; 6 R. P. C. 538.

(*e*) *Losh* v. *Hayne* (1837), 1 W. P. C. 200.

(*f*) (1846) 1 De G. & S. 9.

(*g*) (1838) 3 My. & Cr. 338.

(*h*) (1889) 42 Ch. Div. 390; 6 R. P. C. 538.

infringed there is a *primâ facie* right to an injunction, but in this case came to the conclusion that, though the defendant had infringed the patent, it could not be inferred that he had any intention to infringe again, and that with proper inquiry the plaintiff might have known this; therefore an injunction was refused. Fry, L. J., added that a "foolish attempt to justify a past act does not raise any presumption that they intend to repeat it."

See also *Lyon* v. *Mayor of Newcastle* (*i*), *Jenkins* v. *Hope* (*k*), and cases under *Costs*, *post*, pp. 462 *et seq.*

Injunction may be granted though patent is expiring.

An injunction has been granted though the patent was about to expire in a few days, the intention being to prevent the manufacture of pirated goods with a view to throwing them on the market the moment the patent should expire (*l*). But as a rule an injunction will not be granted when the patent has expired or is about to expire (*m*).

Injunction to restrain a threatened infringement.

An injunction may be granted though there has been no infringement, if infringement be threatened. In *Frearson* v. *Loe* (*n*) Jessel, M. R., said: "Now I am not aware of any suit or action in the Court of Chancery which has been successful on the part of a patentee without infringement having been proved; but in my opinion, on principle, there is no reason why a patentee should not succeed in obtaining an injunction without proving actual infringement. I think so for this reason. Where the defendant alleges an intention to infringe, and claims the right to infringe, the mischief done by the threatened infringement of the patent is very great, and I see no reason why a patentee should not be entitled to the same protection as every other person is entitled to claim from the Court from threatened injury where that threatened injury will be very serious. . . . . It seems to me when you consider the nature of a patent right, and where there is a deliberate intention expressed and about to be carried into execution to infringe certain letters patent under the claim of a right to use the invention patented, the plaintiff is entitled to come to this Court to restrain that threatened injury."

(*i*) (1894) 11 R. P. C. 218.
(*k*) (1896) 13 R. P. C. 57.
(*l*) *Crossley* v. *Beverley* (1829), 3 C. & P. 513; 1 W. P. C. 119; *Sheriff* v. *Coates* (1830), 1 Russ. & My. 159.

(*m*) *Betts* v. *Gallais* (1870), 10 Eq. 392, and cases cited there throw light upon this.
(*n*) (1878) 9 Ch. Div. 48.

The above applies if it be clear that what is threatened to be done will, if done, be an infringement.

In a more recent case, *Dowling* v. *Billington* (*o*), the Irish Court, following Sir George Jessel's opinion, granted an injunction restraining a threatened infringement. But in *The Shoe Machinery Co.* v. *Cutlan* (*p*) Romer, J., refused an injunction for threatened infringement when the plaintiff had shaped his action on past infringements and had failed to prove them.

The validity of a patent may have been established at the trial, or the patentee may move for judgment on admissions in the pleadings (*q*), or the defendant may, as to the whole or any part (*r*) of the plaintiff's case, submit to a perpetual injunction on terms of paying the costs of the action (*s*).

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 if it has been given in consequence of 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 (*t*).

As to stay of proceedings or execution, see *infra*, p. 466. The Court has allowed the operation of the injunction to be suspended for a definite period in order to convenience the public, whom defendant was serving, the defendant undertaking to keep an account of profits meanwhile (*u*). For forms of orders for perpetual injunctions, see Appendix, pp. 841, 844.

Breach of injunction.

If a defendant continues the infringement after an order granting an injunction has been (*a*) served upon him (*x*) or (*b*) brought to his knowledge with notice that the plaintiff intended to enforce it (*y*), a motion for his committal may be made.

The continuance of an infringement after injunction is a

(*o*) (1890) 7 R. P. C. 191. See also *Adair* v. *Young* (1879), 12 Ch. Div. 13.

(*p*) (1895) 12 R. P. C. at p. 357.

(*q*) R. S. C. 1883, Order XXXII. Rule 6.

(*r*) *Curtis* v. *Pape* (1888), 5 R. P. C. 150; *United Telephone* v. *Donohoe* (1886), 31 Ch. Div. 399; 55 L. J. Ch. 480; 3 R. P. C. 45.

(*s*) *Hume* v. *Beale*, Seton, p. 630.

(*t*) *Elsas* v. *Williams* (1884), 1 Times R. 145.

(*u*) *Hopkinson* v. *St. James's and Pall Mall Electric Light Co.* (1893), 10 R. P. C. 46. Sometimes a stay of the operation of an injunction is granted pending appeal, as in the case of *The North British Rubber Co.* v. *Macintosh* (1894), 11 R. P. C. at p. 489. *National Opalite Glazed Brick and Tile Syndicate* v. *Ceralite Syndicate* (1896), 13 R. P. C. at p. 658. But there is no right to any such suspension: *Lyon* v. *Goddard* (1893), 10 R. P. C. 334.

(*x*) *Clayton* v. *Percy* (1854), Higgins's Dig. 1044.

(*y*) *United Telephone Co.* v. *Dale* (1883–84), 25 Ch. Div. 778; 53 L. J. Ch. 295.

contempt of Court, even although the defendant thought he was not infringing (*z*).

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 (*a*). Motion to commit for.

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 for documentary evidence of anticipation (*b*).

The mere making, using, or vending of the elements which afterwards enter into a patent consisting of a combination, is not necessarily prohibited by and is not an infringement of the letters patent (*c*).

If, however, there were a patent for a knife of a particular construction, and an injunction were granted restraining a defendant from selling knives made according to the patent, and he were to 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 (*d*).

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 (*e*). Determination of patent a defence to motion to commit.

A technical breach of injunction may in some cases be lawful. Technical breach of injunction, when 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 has no power to take a pump out of a ship, he had nothing to do with putting it there, and he is not wrong in allowing it to remain there, for he cannot lawfully remove it. Whatever

(*z*) *Plimpton* v. *Spiller* (1876-77), 4 Ch. Div. 286.

(*a*) *Plating Co.* v. *Farquharson* (1881), 17 Ch. Div. 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 R. P. C. at p. 445.

(*b*) *Plating Co.* v. *Farquharson*, *supra*.

(*c*) *Townsend* v. *Haworth* (1875), per Jessel, M. R., 12 Ch. Div. 831, n.; cp. *McCormick* v. *Gray* (1861), 7 H. & N. 25; 31 L. J. Ch. 42; *Sykes* v. *Howarth* (1878), 12 Ch. Div. 826; 48 L. J. Ch. 769.

(*d*) *United Telephone Co.* v. *Dale* (1883-84), per Pearson, J., 25 Ch. Div. 782.

(*e*) *Daw* v. *Eley* (1867), L. R. 3 Eq. 496.

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 (*f*).

Solicitor and client costs.

On a motion to commit, costs as between solicitor and client may be given to a successful plaintiff (*g*), but not to a successful respondent (*h*).

In *Spencer* v. *The Ancoats Vale Rubber Co.* (*i*), 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.

The injunction usually restrains the defendant, his servant, and agents from infringing; such being the case, the injunction may be useful, though the defendant be a foreigner (*k*).

(*b*) *Damages.*

Election between damages and profits.

A patentee whose patent has been infringed may get damages, but he may not have both damages and an account of profits against the same defendant (*l*). He may get an account of profits against one and damages against another; for instance, he may have an account of profits against the manufacturer, and damages against the user (*m*).

Measure of damages.

The damages awarded must be such as naturally and directly flow from the defendant's infringement, or, as it is sometimes put, the measure of damages is the loss sustained by reason of defendant's wrongful acts (*n*). The question is, how would the

(*f*) *Adair* v. *Young* (1879), per James, L. J., 12 Ch. Div. 20.

(*g*) *Plating Co.* v. *Farquharson* (1879–83), 17 Ch. Div. 49, 57; *Steele* v. *Hutchings* (1879), W. N. 18.

(*h*) *Plating Co.* v. *Farquharson*, *ubi supra*.

(*i*) (1889), 6 R. P. C. 46, 68.

(*k*) On this point see *Elmslie* v. *Boursier* (1869), 9 Eq. 217; 39 L. J. Ch. 328; *Von Heyden* v. *Neustadt* (1880), 14 Ch. Div. 230; 50 L. J. Ch. 126; *Marshall* v. *Marshall* (1888), 38 Ch. Div. 330; *Re Burland's Trade Mark* (1889), 41 Ch. Div. 542; *Badische und Soda Fabrik* v. *Henry Johnson* (1896), 1 Ch. 25.

(*l*) *De Vitre* v. *Betts* (1873), L. R. 6 H. L. 319; *Neilson* v. *Betts* (1871), L. R. 5 H. L. 1; 40 L. J. Ch. 317; *American Braided Wire Co.* v. *Thompson* (1890), 7 R. P. C. 152; 44 Ch. Div. 274.

(*m*) *United Telephone Co.* v. *Walker* (1887), 4 R. P. C. 63, 67; *Boyd* v. *Tootal, &c., Co.* (1894), 11 R. P. C. 175.

(*n*) *United Horseshoe and Nail Co.* v. *Stewart* (1888), 13 App. Ca. 401; 5

position of the patentee have differed if there had been no infringement (*o*)?

The following propositions, it is submitted, are deducible from the decided cases:—

General rules as to damages.

(1) The measure of damage is not the profit made by the infringer (*p*), though this may be some guide to the amount of the patentee's loss (*q*).

Reduction of price.

(2) If the patentee reduces his prices, the loss caused by the reduction is recoverable as damages only if it was caused entirely by the competition of the infringer (*r*). If the reduction in price was caused by general competition, the damages cannot include compensation for this, at any rate, in full; but if the reduction in price was the immediate result of the competition caused by the defendant's infringement, the loss caused thereby is recoverable as damages (*s*).

Where patentees grant licences.

(3) 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 article during the entire period from the time when it came into the possession of the infringer, until the assessment of damage or the date of delivering up, whether it has been in use or not the whole time (*t*). If, however, the patentee was in the habit of manufacturing himself, the ordinary measure of damage would not be the money which the patentee would have obtained from the defendant had a licence been taken out (*u*). In any case, the patentee may refuse to grant a licence to an infringer with whom he is litigating on terms equal to those given to persons who apply for a licence in regular course; and in estimating damages he will be entitled to take this right into account, and calculate his damages on the basis of a higher royalty (*x*).

(4) The damages may be considerable, though the infringer

R. P. C. 260; *Ledgard* v. *Bull* (1886), 11 App. Ca. 648, 654; 3 R. P. C. 390; *American Braided Co.* v. *Thompson* (1890), 44 Ch. Div. 274; 7 R. P. C. 47, 153.

(*o*) *Boyd* v. *Tootal, &c., Co.* (1894), 11 R. P. C. 175; *Penn* v. *Jack* 1867), 5 Eq. 81; 37 L. J. Ch. 136.

(*p*) *United Horseshoe and Nail Co.* v. *Stewart, supra.*

(*q*) *American Co.* v. *Thompson, supra.*

(*r*) *American Co.* v. *Thompson, supra*; *United Horseshoe and Nail Co.* v. *Stewart, supra.*

(*s*) This seems to be the result of the cases quoted in the last note.

(*t*) *United Telephone Co.* v. *Walker* (1887), 4 R. P. C. 63.

(*u*) *Penn* v. *Jack* (1867), 5 Eq. 81; 37 L. J. Ch. 136.

(*x*) *Penn* v. *Bibby* (1866), 3 Eq. 310; *Penn* v. *Jack. supra*; *Boyd* v. *Tootal, Broadhurst, Lee, & Co.* (1894), 11 R. P. C. 175.

has used but a small, and that perhaps the least useful, part of the invention (*y*).

(5) If a patentee who is accustomed to issue licences and not to make and sell himself, obtains royalties from the users, he cannot obtain damages from the manufacturers in respect of the infringements on which royalty has been paid by the users (*z*); he has suffered no loss. But he may proceed against users and manufacturers, or both, if he can prove damage against either or both (*a*). And the damages recoverable against users will not necessarily be merely nominal (*b*).

Remarks of Kekewich, J., in *Alexander* v. *Henry*.

In *Alexander* v. *Henry* (*c*), a recent case on this point, Kekewich, J., thus laid down the law. Referring to *The Leather Cloth Co.* v. *Hirschfeld* (*d*), he said: "What I understand to be the meaning of that is this, as construed by other cases, and as understood by the light of other cases: you may have an article of fashion for which there is a great demand, and a patent for it, such as the bustles in the *American Braided Wire Co.* v. *Thompson*. They can only be sold by the patentee. If an infringer comes into the market and sells, say, a hundred, and there be a great demand, an unsatisfied demand, the conclusion, and the necessary conclusion, is that the patentee has thereby lost the sale of those hundred articles which were sold by the infringer. But where you have not that or some equivalent fact, you must not jump to the conclusion that because an infringer—whether of a patent, or any other infringer—has sold a certain number of articles, if he had not intervened, therefore the manufacturer would have sold the same number of articles. A very little common sense shows that that is a rule of experience which would commend itself to all persons who are at all conversant with the way in which things are bought and sold, which is the question of supply and demand, which governs commerce in this as in other things. That seems to me to be perfectly settled by that case, and confirmed by the other cases which follow. But if you can find a good reason, such as I have suggested in the case of the patentee—a great demand, particularly if it is an unsatisfied demand—and if you can find any other good reason

(*y*) *United Horseshoe and Nail Co.*, 13 App. Ca. at p. 413; 5 R. P. C. 260.

(*z*) *Penn* v. *Jack*, *supra*.

(*a*) *Penn* v. *Bibby*, *supra*; *United Telephone Co.* v. *Walker* (1887), 4 R. P. C. 63, 67; *Boyd* v. *Tootal*, *&c.*, *Co.*, *Ltd.*, *supra*.

(*b*) *Boyd* v. *Tootal*, *&c.*, *Co.*, *Ltd.*, *supra*.

(*c*) (1895) 12 R. P. C. 360.

(*d*) (1866) 1 Eq. 299, a trade-mark case.

for your conclusion, a reason which would satisfy ordinary persons of experience, then you do not presume, but you conclude, that the sale of the infringer has kept out of the market the same number, or a similar number, of articles which would otherwise have been sold by the original manufacturer. It is a mere question in each case whether the evidence justifies the conclusion or not. Again, in Lord Macnaghten's judgment in the case of the House of Lords, as also in the case of the *American Braided Wire Co.* v. *Thompson*, we find the rule laid down that, because a trader has reduced the prices of the article which he is offering to the public, you must not therefore assume, notwithstanding that there is an infringer in the market, that he is really injured by the reduction of prices. He may have done it merely as a matter of policy; he may have been influenced by many reasons; and to jump to the conclusion that because a manufacturer has thought fit to reduce his prices, therefore the reduction—that is to say, the difference between the original price and the reduced price—is an injury caused to him by the infringer, to be measured by that difference in money, is really coming to a conclusion without premises, ignoring possible and even probable facts which might influence the result. Again, if you find facts, from which a reasonable man might conclude that the reduction in price was the result of the infringement, then you at once get on entirely different lines, and you then come to the conclusion that, as in the other case which I suggested of the unsatisfied demand for the patented article, the loss is the natural consequence of the infringement, and is caused to the manufacturer directly by what the infringer does. Then you have no difficulty in measuring the damage by the loss in money, and visiting that on the head of the infringer. That seems to me to dispose of all the cases, and to apply them sufficiently to the present case."

Bona fides and damages.

In *Arkwright* v. *Nightingale* (*e*), 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 that parties had acted on the faith of it. In *Smith* v. *London and North-Western Railway Co.* (*f*) the patentee stood by whilst the

(*e*) (1785) 1 W. P. C. 60.

(*f*) (1853) Mac. P. C. 188; 2 E. & B. 69.

defendants openly used the invention; the Court refused to assess the damages at the sum which it would have cost the defendants to purchase every article at the patentee's price.

Set-off of damages against the articles delivered up is not allowed.

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 (*g*). 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 (*h*).

The amount of damages cannot be accurately assessed; it must be roughly got at, but on the other hand must not be merely guessed (*i*).

Differences. Inquiry as to damages, patent and trade-mark cases.

The inquiry is in the form "what damage," and not "what damage, if any." In *Davenport* v. *Rylands* (*k*), Vice-Chancellor Page-Wood said: "The inquiry will be in the form, 'what damage the plaintiff has sustained,' and not 'what damage, if any,' he has sustained, as it would be in the case of a trade-mark. There is this difference between the case of a trade-mark and that of a patent: 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."

An inquiry as to damages will not be granted where no damage or only nominal damage has been proved (*l*).

(*g*) *United Telephone Co.* v. *Walker* (1887), 4 R. P. C. 63; 56 L. T. N. S. 508.

(*h*) *Ibid.* And see *Penn* v. *Jack*, 5 Eq. 81; 37 L. J. Ch. 136; *Penn* v. *Bibby*, 3 Eq. 310; 36 L. J. Ch. 277.

(*i*) Cp., for instance, *Ungar* v. *Sugg* (1892), 9 R. P. C. 113; *United Horseshoe, &c., Co.* v. *Stewart*, *supra*.

(*k*) (1865) 1 Eq. 302, 338: 35 L. J. Ch. 204; *United, &c., Co.* v. *Stewart* (1888), 13 App. Ca. 401; 5 R. P. C. 260.

(*l*) *Dicks* v. *Brooks* (1880), 15 Ch. Div. 22, 39; 49 L. J. Ch. 812; *United Telephone Co.* v. *Sharples* (1885), 2 R. P. C. 28; *Cole* v. *Saqui* (1888), 5 R. P. C. 489, 496.

Damages and pleadings.

Damages may be awarded although not specifically claimed in the pleadings (*m*). In one case (*n*), 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 the damages.

In *Davenport* v. *Rylands* (*o*), 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.

Future damages.

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 (*p*).

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 (*q*).

Damages by whom ascertained.

The ascertainment of damages, where it is substantially a matter of calculation, may be referred to an official referee (*r*) or to another officer of the Court (*s*). 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 (*t*), unless application is made at the time of judgment. Even then there is a doubt whether the inquiry can be taken by a jury. Before judgment the matter may be sent to a jury (*u*). Whether the inquiry be made by a chief clerk or by an official referee under Ord. XXXVI. rule 57a, or under the Arbitration Act, sect. 13, the inquiry is made on behalf of the Judge; the Judge is not bound to accept the decision of the referee, but if that decision has

(*m*) *Betts* v. *Neilson* (1868), 18 L. T. N. S. 159; L. R. 3 Ch. 429. And see *Needham* v. *Oxley* (1863), 8 L. T. N. S. 604.

(*n*) *Edison* v. *Holland* (1888), 5 R. P. C. at p. 483.

(*o*) *Davenport* v. *Rylands* (1865), per Wood, V.-C., L. R. 1 Eq. 308; 35 L. J. Ch. 204; *United Horseshoe and Nail Co.* v. *Stewart*, *ubi supra*.

(*p*) *Fritz* v. *Hobson* (1880), 14 Ch. D. 543, a case under Lord Cairns's Act, now repealed.

(*q*) Order XXXVI. rule 58.

(*r*) *Ibid.* rule 57a. And see Arbitration Act (1889), sects. 13 & 14.

(*s*) *Ibid.* rule 57. In *Ungar* v. *Sugg* (1892), 9 R. P. C. 114, a threats action, Lord Esher said that the Judge ought to have assessed the damages.

(*t*) *American Braided Wire Co.* v. *Thomson* (1888), 5 R. P. C. 538, 696; cp. *Westinghouse* v. *Lancashire and Yorkshire Railway Co.* (1884), 1 R. P. C. 229. Under the Chancery Acts, 1852 and 1858, the question of damages was left to be decided by a jury, or where there was extreme difficulty in their assessment by the Court itself; *Betts* v. *De Vitre* (1864), 11 Jur. N. S. 9.

(*u*) *Fennessy* v. *Rabbits* (1887), 56 L. T. N. S. 138.

been arrived at on oral testimony, he will hesitate to disagree with it (*x*).

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 (*y*).

Though the patent expires during the litigation, the patentee is entitled to damages for infringement (*z*).

In one case the defendant admitted certain infringements in his defence, and the plaintiffs signed judgment. It was decided that the plaintiffs were entitled to an inquiry as to damages, limited however to the admitted infringements (*a*).

Discovery of documents.

The defendant must, for the purpose of the inquiry, make an affidavit disclosing the documents relating to the inquiry, and must produce them. The names of the customers who bought the infringing articles, and the prices, must be given, but not the names of the agents through whom the articles were sold (*b*).

Cases in which no damages can be recovered.

It should be observed that in the following cases no damages can be recovered: (1) for infringement prior to amendment of the specification, unless the Court is satisfied that the original claim was framed in good faith and with reasonable skill and knowledge (*c*); (2) for infringement prior to publication of the complete specification (*d*); or (3) when the infringement took place after failure by the patentee to pay a fee within the prescribed time, and before the enlargement of the time, if the Court thinks fit not to give damages (*e*).

The costs of taking the account will generally be reserved for further consideration (*f*).

(*e*) *Account of Profits.*

There are two points in which modern practice differs from the old practice.

(*x*) *Alexander* v. *Henry & Co.* (1895), 12 R. P. C. at p. 365.

(*y*) *Plimpton* v. *Malcolmson* (1876), Seton, 565; *Cunningham* v. *Colling* (1864), *ibid.* 567; *Betts* v. *Noel*, *ibid.* 507; *Hocking* v. *Fraser* (1886), 3 R. P. C. at p. 7.

(*z*) *Davenport* v. *Rylands* (1866), 1 Eq. 302; 35 L. J. Ch. 204; *Fox* v. *Dellestable* (1866), 15 W. R. 194; but see *Betts* v. *Gallais* (1870), 10 Eq. 392.

(*a*) *United Telephone Co.* v. *Donohoe* (1886), 31 Ch. Div. 399; 3 R. P. C. 45.

(*b*) *Murray* v. *Clayton* (1872), 15 Eq. 115; 42 L. J. Ch. 191; *American Braided Wire Co.* v. *Thompson* (1889), 5 R. P. C. 375. And see *Powell* v. *Birmingham Vinegar Co.* (1897), 14 R. P. C. 1.

(*c*) Act of 1883, sect. 20; and see *ante*, p. 288.

(*d*) Act of 1883, sect. 13.

(*e*) *Ibid.* sect. 17, sub-sect. 4 (b).

(*f*) *United Telephone Co.* v. *Fleming* (1886), 3 R. P. C. 268; *ditto* v. *Patterson* (1889), 6 R. P. C. 140.

1. The account was formerly an adjective remedy to an injunction.

"Whenever the plaintiff," says Mr. Hindmarch (*g*), "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 (*h*) or during (*i*) 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 improper labour in making it (*k*).

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 (*l*)) 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 (*m*).

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 (*n*).

2. A plaintiff might formerly obtain both an account and an inquiry as to damages against the same defendant (*o*).

The case of *Neilson* v. *Betts* (*p*), however, most undoubtedly decided the general principle that upon a decree against a party

(*g*) P. 361; and cp. *Bailey* v. *Taylor* (1825), 1 R. & M. 73; *Smith* v. *L. and S.-W. Railway 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 R. P. C. 3.

(*h*) *Smith* v. *L. and S.-W. Railway Co.*, *ubi supra*.

(*i*) *Price's Patent Candle Co.* v. *Bauwen's Patent Candle Co.*, *ubi supra*; *contrâ*, however, in *Fox* v. *Dellestable* (1866), 15 W. R. 194.

(*k*) *Crossley* v. *Derby Gas Co.* (1834, 1838), per Lord Brougham, L. C., 4 L. J. Ch. at p. 26.

(*l*) *Betts* v. *Gallais* (1870), L. R. 10 Eq. 392, per James, V.-C.

(*m*) *Davenport* v. *Rylands* (1865), L. R. 1 Eq. 302, per Wood, V.-C.; 35 L. J. Ch. 204.

(*n*) R. S. C. 1883, Order XV. rule 1; *York* v. *Stowers* (1883), W. N. 1883, 174.

(*o*) *Elmslie* v. *Boursier* (1869), L. R. 9 Eq. 217; 39 L. J. Ch. 328; cp. *Hills* v. *Evans* (1862), 4 De G. F. & J. 288, 309; L. R. 6 H. L. 321, n. (2); 31 L. J. Ch. 457.

(*p*) (1871) L. R. 5 H. L. 1; 40 L. J. Ch. 317.

for the infringement of a patent the patentee is not entitled both to an account of profits and an inquiry into damages. That principle applies to every case of infringement, and therefore it must be taken to have settled conclusively 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 (*q*). And in general he will elect to have damages (*r*).

To what profits account extends.

An account extends to all the direct or collateral profit which the defendant has made (*s*), and to any saving he has effected (*t*), by infringing the plaintiff's patent privilege. The question is, What profit is fairly attributable to the use of the plaintiff's invention? If the defendant had not used the plaintiff's invention, what would he have lost thereby? This is the amount recoverable by the plaintiff as profit (*u*).

It does not include the entire loss which the plaintiff sustained by reason of the infringement (*x*). The only question is 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 (*y*).

An order for money payable as the result of an account is a debt provable in the infringer's bankruptcy (*z*).

An account will not be ordered when the evidence shows either that no profits have been made at all (*a*), or that the sales have been insufficient to make it worth while (*b*).

A plaintiff's right to an account, as well as to an injunction, may be barred by delay or acquiescence (*c*).

(*q*) *De Vitre* v. *Betts* (1873), L. R. 6 H. L. 321; *American Wire Co.* v. *Thompson* (1890), 44 Ch. Div. at p. 287; 7 R. P. C. at p. 158.

(*r*) Per Lindley, L. J., in *Siddell* v. *Vickers* (1892), 9 R. P. C. 152.

(*s*) *Crossley* v. *Derby Gaslight Co.* (1834), 3 My. & Cr. 428.

(*t*) *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.

(*u*) *Siddell* v. *Vickers* (1892), 9 R. P. C. 152.

(*x*) *Ellwood* v. *Christy* (1865), 18 C. B. N. S. 494; 34 L. J. C. P. 130; overruling *Walton* v. *Lavater* (1860), per Byles, J., 8 C. B. N. S. 190; 29 L. J. C. P. 275. For other decisions under the Act of 1852, see *Holland* v. *Fox* (1854), 3 E. & B. 977; *Vidi* v. *Smith* (1854), *ibid.* 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 App. Ca. 401, 417; 5 R. P. C. 260.

(*y*) *United Horseshoe and Nail Co.* v. *Stewart* (1886), 3 R. P. C. 143, per Lord Kinnear; and American case, *Mowry* v. *Whiteley*, cited by him *ubi supra*; and 14 Wall. N. S. 620.

(*z*) *Watson* v. *Holliday* (1881), 20 Ch. Div. 780.

(*a*) *Bergmann* v. *Macmillan* (1881), L. R. 17 Ch. D. 423.

(*b*) *Sanitas Co.* v. *Condy* (a trade-mark case) (1887), 4 R. P. C. 533.

(*c*) *Crossley* v. *Derby Gas Light Co.* (1834), 1 Web. P. C. 120; 4 L. J. Ch. 25

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* (*d*), 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.

The plaintiff is entitled to discovery in aid of taking the account (*e*). The costs of taking the account may be, and generally are, reserved (*f*). The inquiry may be made by the chief clerk or a master, or may be sent to a referee, special or official.

(*d*) *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 (*g*), the infringing articles shall, if possible (*h*), be ascertained, and either destroyed (*i*) or delivered up to the plaintiff (*k*), or marked (where the patentee's invention is com-

(*d*) (1889) 6 R. P. C. 464.

(*e*) *Saxby* v. *Easterbrook* (1872), L. R. 7 Ex. 207; 41 L. J. Ex. 113. In that case discovery was ordered, notwithstanding the pending of an appeal. And see cases quoted *ante*, p. 442, n. (*b*).

(*f*) *Slack* v. *Midland Railway* (1880), 16 Ch. Div. 81; *Cole* v. *Saqui* (1888), 5 R. P. C. 489, 497; *Siddell* v. *Vickers* (1888), 5 R. P. C. 101. In *Ellwood* v. *Christy* (1865), 18 C. B. N. S. 494, 495; 34 L. J. C. P. 130. The order was that if plaintiff did not succeed in surcharging the admitted profits by one-sixth the plaintiff should pay the costs of the inquiry.

(*g*) *Washburn and Moen Manufacturing Co.* v. *Patterson* (1884), 1 R. P. C. 191; *Otto* v. *Steel* (1886), 3 R. P. C. 109, 120.

(*h*) *Chadburn* v. *Mechan* (1895), 12 R. P. C. 135.

(*i*) *Betts* v. *De Vitre* (1864), 34 L. J. Ch. 289, 291; *Emperor of Austria* v. *Day* (1861), 3 De G. F. & J. 217; *Howe* v. *Webber* (1895), 12 R. P. C. 470.

(*k*) *Tangye* v. *Stott* (1865), 14 W. R. 386; *Young* v. *Fernie*, Pemberton, 236; *Washburn*, &c., *ubi supra*, 158, 162, 191.

posite, and the various parts may be innocently used for other purposes) so as to prevent a continuation of the infringement (*l*).

In *Edison-Bell Phonograph Co.* v. *Smith* (*m*), the Court of Appeal, varying the order of Wright, J., limited the order for delivery up to the infringing parts of the defendant's machine. The right of property in the infringing articles remains in the infringer (*n*).

Sect. 11.—Costs.

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 (*o*) 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 (*p*).

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 infringe-

(*l*) *Needham* v. *Oxley* (1863), 8 L. T. N. S. 532; *Westinghouse* v. *Lancashire and Yorkshire Railway Co.* (1884), 1 R. P. C. 229; *Plimpton* v. *Malcolmson*, Seton, 565; *Badische Anilin, &c.* (1884), 24 Ch. D. 156.

(*m*) (1894) 11 R. P. C. 389; and see *Automatic Weighing Machine Co.* v. *Fearby* (1893), 10 R. P. C. 442.

(*n*) See *Varasseur* v. *Krupp* (1878), 9 Ch. Div. 351.

(*o*) 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. 475, the jury gave 200*l.* damages; and in *Newton* v. *Grand Junction Railway Co.* (1845), 5 Exch. 331, they were assessed at 1,000*l.* Coryton, p. 307.

(*p*) *Gillett* v. *Green* (1841), 10 L. J. Ex. 124; 7 M. & W. 347.

ment 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 at three times the taxed costs* (*q*).

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 before him. 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 (*r*). The Judge could deprive a successful plaintiff of costs if he thought fit.

Conditions necessary to obtain 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.

Abuse of rule as to treble costs.

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 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

Under the Act of 1852.

(q) 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 Stats. p. 37, n. (*o*).

(*r*) *Ibid.* p. 302; and see *Stocker* v. *Rogers* (1843), 1 C. & K. 99; *Gillett* v. *Wilby* (1839), 9 C. & P. 334; 1 W. P. C. 270; *Newall* v. *Wilkins* (1851), 17 L. T. 20.

Collusion. Unnecessary action. Compromise. Validity not questioned.

in an action tried by collusion for the purpose of obtaining it (*s*), or where the second action appeared to be a harsh or unnecessary proceeding, or ended in a compromise (*t*), 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 (*u*).

Effect of Act of 1852.

Any doubt 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 (*x*).

Certificate of validity.

Costs under the present practice.

The ordinary rules as to costs are those to be found in R. S. C. Order LXV. When any action, cause, matter or issue is tried with a jury the costs follow the event, unless the Judge shall for good cause otherwise order (*y*). In other cases the costs are awarded in the discretion of the Court (*y*). The County Courts Act, 1888, limits the costs in certain cases. But as infringement actions cannot be tried in the County Court (*z*) this will not affect the costs in an infringement action.

The rules relating to costs may be found in the R. S. C. 1883,

(*s*) *Davenport* v. *Rylands* (1865), L. R. 1 Eq. 302; 35 L. J. Ch. 204.

(*t*) *Betts* v. *De Vitre* (1864), 11 Jur. N. S. 9.

(*u*) Cp. *United Telephone Co.* v. *Patterson* (1889), 6 R. P. C. 140.

(*x*) 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: *Badische Anilin, &c.* v. *Levinstein* (1885), 29 Ch. D. 366, per Bowen, L. J., at p. 419.

(2) It was necessary that the certificate of validity should be given in evidence at the subsequent trial.

(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: *Bovill* v. *Goodier*, Griff. 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;" see *Otto* v. *Linford* (1880), 46 L. T. N. S. 35.

(5) It was necessary that the decree or order should contain an express direction to the taxing master that the costs be so taxed: *Lister* v. *Leather* (1858), 4 K. & J. 425.

(*y*) R. S. C. Order LXV. rule 1.

(*z*) *Queen* v. *County Court Judge of Halifax* (1891), 2 Q. B. 263; 60 L. J. Q. B. 550; 8 R. P. C. 342.

Order LXV., and in the notes to that order in the "Annual Practice." But the following need special attention: (a) Costs where a certificate of validity has previously been given. (b) Costs of particulars of breaches and objections. (d) Apportionment of costs of issues. (d) Costs on higher scale. (e) Costs where defendant submits.

(a) *Certificate of Validity and Costs.*

Act of 1883.

Under sect. 31 of the present Act a certificate of validity may be granted by the Court (*i.e.*, by the High Court of Justice (*a*) or, perhaps, the Court of Appeal (*b*)) or a Judge, *i.e.*, may be given in Chambers (*c*).

Vice-Chancellor of Lancaster.

There was a question whether the Vice-Chancellor of the County Palatine of Lancaster was within the meaning of the words "Court or a Judge" in this section (*d*). But under the Chancery of Lancaster Act, 1890 (*e*), undoubtedly the Vice-Chancellor has the power to give a certificate.

Provisions of Act of 1883.

The section provides that, in an action for infringement of a patent the Court or a Judge may certify (*f*) 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.

Cases.

The following decisions under this section may be mentioned, though they must be read with this qualification, that the power of granting or of refusing solicitor and client costs is discretionary, notwithstanding the certificate.

Solicitor and client costs.

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, though it be tried after the certificate has been given in the other action (*g*).

(*a*) Cp. sect. 117, sub-sect. 1.

(*b*) R. S. C. 1883, Order LVIII. rule 4; *Cole* v. *Saqui* (1889), 40 Ch. Div. 132: 6 R. P. C. 41. But see *Incandescent Gas Light Co.* v. *De Mare, &c., Syndicate* (1896), 13 R. P. C. at p. 579.

(*c*) Jud. Act, 1873, sect. 39.

(*d*) Day, J., decided in the negative in *Proctor* v. *Sutton Lodge Chemical Co.* (1888), 5 R. P. C. at p. 185.

(*e*) 53 & 54 Vict. c. 23.

(*f*) A certificate under this section is not a judgment, decree, or order within the meaning of the Judicature Act, 1873, sect. 19, and is not therefore appealable: *Haslam Co.* v. *Hall* (1888), 20 Q. B. D. 491; 5 R. P. C. 144.

(*g*) *Automatic Weighing Co.* v. *International Hygienic Society* (1889), 6 R. P. C. 475. Solicitor and client costs were not given on a breach of an injunction where what was done by the

Uncontested action.

It is doubtful whether a certificate of validity will be granted in an uncontested action. Kay, J., refused to certify in *Peroni* v. *Hudson* (*h*), where the defendant did not appear at the trial; but in a similar case, *Haydock* v. *Bradbury* (*i*), Kekewich, J., granted 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."

In *Delta Metal Co., Ltd.* v. *Maxim-Nordenfelt Guns and Ammunition Co.* (*k*), defendant consented to judgment. Collins, J., gave a certificate that validity had come in question, but gave no opinion on the point himself.

Certificate of validity where patent not really contested.

The objection to granting a certificate where there has been no contest is thus expressed, in *Stocker* v. *Rogers* (*l*), by Erle, J.: "I think 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 sect. 3 of the statute, to use it afterwards to the injury of a third party who was really contesting the validity of the patent."

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 (*m*).

If a certificate be granted, and in a subsequent action a defendant does not attack the validity of the patent, but relies on non-infringement, it is doubtful whether plaintiff will get solicitor and client costs; there are cases both ways (*n*).

defendants was not done vexatiously or improperly, but in the erroneous belief that they were entitled so to do: *Spencer* v. *Ancoats Vale Rubber Co.* (1889), 6 R. P. C. 46.

(*h*) (1884) 1 R. P. C. at p. 263.

(*i*) (1887) 4 R. P. C. at p. 75. See also *Edison-Bell Phonograph Co.* v. *Edison Phonograph Co.* (1894), 11 R. P. C. 33.

(*k*) (1891) 8 R. P. C. 247.

(*l*) (1846) 1 C. & K. 99.

(*m*) *Edison Co.* v. *Holland* (1889), 6 R. P. C. at p. 287.

(*n*) In *Automatic Weighing Machine Co.* v. *International Hygienic Society* (1889), 6 R. P. C. 475, and in *Boyd* v. *Tootal & Co.* (1894), 11 R. P. C. 175, solicitor and client costs were refused. To the contrary, see *United Telephone Co.* v. *Townshend* (1886), 3 R. P. C. 10: *United Telephone Co.* v. *Patterson* (1889), 6 R. P. C. 140: *United Telephone Co.* v. *St. George* (1889), 3 R. P. C. 33, 321. In *Automatic Weighing Machine Co.* v. *Fearby* (1893), 10 R. P. C. 42, a very slight attack on the patent resulted in an order for solicitor and client costs. And see *Davenport* v. *Rylands* (1866), 1 Eq. 302; 35 L. J. Ch. 204.

In *United Telephone Co.* v. *Patterson* (*o*), 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 inquiry 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.

Action for threats.

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* (*p*), Mr. Justice Kekewich held that it was not. In *Crampton* v. *The Patents Investment Co.* (*q*), 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 (*r*), applies only to a second action for infringement.

Only applies to second action.

In *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.* (*s*), 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.

(*o*) (1889) 6 R. P. C. 140. But see next case.
(*p*) (1888) 5 R. P. C. at p. 184.
(*q*) (1888) *Ibid.* at p. 404.
(*r*) *Penn* v. *Bibby* (1866), L. R. 3 Eq. 308; 36 L. J. Ch. 277.
(*s*) (1889) 6 R. P. C. 121; and see *Bovill* v. *Hadley* (1864), 10 L. T. N. S. 650; 17 C. B. N. S. 435.

Validity impeached on new grounds.

When the validity of a patent was 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 were not 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 (*t*).

In *Haslam Co.* v. *Hall* (*u*), 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 perhaps be granted, although the plaintiff has failed on the issue of infringement (*x*); but it cannot be granted to a defendant, though successful (*y*).

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; but *primâ facie* the holder of the certificate is entitled to his solicitor and client costs (*z*).

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 (*a*). And where validity was not questioned, and the infringement was innocent, the ordinary costs alone were granted (*b*).

Full costs where validity not disputed a second time.

(*b*) *Costs of Particulars* (*c*).

By the Act of 1852, sect. 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

(*t*) *Otto* v. *Steel* (1886), 3 R. P. C. at p. 120.

(*u*) (1888) 5 R. P. C. at p. 27.

(*x*) *Automatic Weighing Machine Co.* v. *Knight* (1889), 6 R. P. C. 113, 126; *Tweedale* v. *Ashworth* (1890), 7 R. P. C. at p. 436; *Birch* v. *Harrap* (1896), 13 R. P C. 615. But Lord Herschell did not encourage this in *Morris* v. *Young* (1895), 12 R. P. C. at p. 465.

(*y*) *Badische, &c.* v. *Levinstein* (1885), 29 Ch. Div. 366, 419; 2 R. P. C. 94.

(*z*) *United Telephone Co.* v. *Patterson* (1889), 6 R. P. C. 140.

(*a*) *Proctor* v. *Sutton Lodge Chemical Co.* (1888), 5 R. P. C. 184.

(*b*) *Boyd* v. *Tootal, Broadhurst Lee Co.* (1894), 11 R. P. C. 175.

(*c*) 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. 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*."

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 (*d*). "With respect to the costs of the issues," said Pollock, C. B., in *Honiball* v. *Bloomer*, "there is no doubt that where the plaintiff is nonsuited, 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* (*e*), 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 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 (*f*).

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

(*d*) *Honiball* v. *Bloomer* (1854), 24 L. J. Ex. 11; 10 Exch. 538; *Parnell* v. *Mort* (1884–85), L. R. 29 Ch. D. 325.

(*e*) (1874–75) 20 Eq. 635.

(*f*) *Greaves* v. *Eastern Counties Railway Co.* (1859), 28 L. J. Q. B. 290; 1 E. & E. 961, but distinguish *Curtis* v. *Platt* (1864), 10 Jur. N. S. 823.

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, sect. 43, in the addition of the words "or to have been reasonable and proper."

"Court or a Judge" means a Judge of the High Court, whether sitting in Court or Chambers, and includes the Court of Appeal (*g*); and now includes the Vice-Chancellor of the County Palatine of Lancaster (*h*). If the application for the certificate is not made at the trial, it may be made within a reasonable time after (*i*).

Costs of particulars when defendant not called on.

In *Griffin* v. *Weaver* (*k*), 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.

In *Germ Milling Co.* v. *Robinson* (*l*) 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.

In *Young* v. *Rosenthal* (*m*) Grove, J., granted a certificate of

(*g*) *Cole* v. *Saqui* (1889), 40 Ch. Div. 132; 6 R. P. C. 41.

(*h*) 53 & 54 Vict. c. 23, s. 3.

(*i*) *Rowcliffe* v. *Morris* (1886), 3 R. P. C. 145.

(*k*) (1889) 6 R. P. C. 396; cp. *Slazenger* v. *Feltham*, *ibid.* 130.

(*l*) (1886) 3 R. P. C. 254; cp. *Rothwell* v. *King* (1887), 4 R. P. C. 397; *Albo-Carbon Light Co.* v. *Kidd*, *ibid.* 539; *Longbottom* v. *Shaw* (1888), 5 R. P. C. 497, and (1889) 6 R. P. C. 147; *Oddy* v. *Smith* (1888), 5 R. P. C. 503; *Cole* v. *Saqui* (1888), 5 R. P. C. 489; *Boyd* v. *Horrocks* (1889), 6 R. P. C. 152, 162.

(*m*) (1884) 1 R. P. C. at p. 41.

breaches where the patent was invalid, but infringement was proved. This was also done in *Badische, &c.* v. *Levinstein* (*n*).

Practice of Court of Appeal and House of Lords.

The Court of Appeal has power to give a certificate of particulars of objections, if it has sufficient material on which to determine that they are reasonable and proper, where it reverses the judgment of the Court below by which the patent was found valid (*o*). The House of Lords may do the same (*p*).

But 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 (*q*). Nor can it give a certificate unless it has sufficient material on which to found an opinion (*r*).

If the appeal is dismissed, a difficult point arises, and it is doubtful whether the Court above has power to make any order as to the particulars differing from what the Judge has ordered (*s*). Order LVIII., rule 4, authorises the Court of Appeal to make orders that *ought* to have been made, so that when the Court of Appeal reverses the Court below it may certify for particulars on the ground that the Court ought to have done so, but the case is different if it affirms the order of the Judge. There is no appeal from the granting or withholding of the certificate (*t*).

Not always necessary to prove particulars if they were reasonable.

The application for a certificate may be granted, although the particulars have not been proved, if the Court is of opinion that the particulars were reasonable and proper (*u*).

In *Cassel Gold Co.* v. *Cyanide Recovery Co.* (*x*), the patentee was defeated in the Court below; on appeal his patent was declared invalid on the ground that the first claim was bad, but the Court decided that the invention was new, useful, and good subject-matter. The defendants had pleaded want of novelty and invention, and in support of their pleas had delivered particulars of objections, which the Judge below had certified to have been reasonably and properly delivered. The Court of Appeal refused to disturb the certificate, for (assuming that

(*n*) *Badische, &c., Fabrik* v. *Levinstein* (1885), 29 Ch. Div. at p. 419; 2 R. P. C. at p. 118; 52 L. J. Ch. 704. And see a converse case, *Jardine* v. *King-Mendham & Co.* (1896) 13 R. P. C. 411.

(*o*) *Cole* v. *Saqui* (1889), 40 Ch. Div. 132; 6 R. P. C. 41.

(*p*) *Morris* v. *Young* (1895), 12 R. P. C. at p. 465. In *Morgan* v. *Windover* (1890), 7 R. P. C. 446, the matter went back to the Judge.

(*q*) *Boyd* v. *Horrocks* (1889), 6 R. P. C. 162; *Longbottom* v. *Shaw* (1889), *ibid.* 143.

(*r*) *Ibid.*

(*s*) See per Lindley, L. J., in *Cassel Gold Co.* v. *Cyanide Recovery Co.* (1895), 12 R. P. C. 303.

(*t*) *Haslam* v. *Hall* (1888), 20 Q. B. D. 491; 57 L. J. Q. B. 352; 5 R. P. C. 144.

(*u*) *Phillips* v. *Ivel Cycle Co.* (1890), 7 R. P. C. 77.

(*x*) (1895) 12 R. P. C. 303.

it had power) it considered that the defendants had acted reasonably and properly in using them, and were entitled to have them allowed, though they were not proved.

The Court must be satisfied that particulars are reasonable and proper.

The Court has no power to give a certificate as to particulars unless it is satisfied that they were reasonable and proper. And as the Court cannot go through the particulars and try bye-issues merely to determine the question of costs, it frequently happens that the successful party fails to get the costs of particulars through no fault of his own. The following cases illustrate the law on this point:—

Longbottom v. *Shaw* (*y*).—An action for infringement was dismissed with costs, the defendant not being called upon; the Judge refused to certify for the particulars of objection, and they were disallowed on taxation. Kay, J., said: "There might well be a case when the matter was decided against the plaintiff without calling on the defendant's counsel, and yet the Court, relying upon the evidence obtained by the defendant by cross-examining the witnesses (*z*), might think it right to look at the particulars of objections and allow the costs of such particulars of objections as were, in fact, made out by the cross-examination. I can quite understand that case occurring, and therefore I do not say that there might not be in such a case as this, or in a similar case, like that which I have just described, propriety in the Court looking into the particulars of objections and saying whether they were reasonable or not, having regard to the specification. But in this case, right or wrong, the Court came very clearly to the conclusion that it was not bound to do that, because the thing had been decided absolutely on the words of the specification itself. Therefore it seems to me that the Act of Parliament is quite express."

Court will not go into the case merely to try the propriety of the particulars.

In the same case (*a*) it had been determined by the Court of Appeal that the Court should not go into the particulars merely to decide whether they were reasonable and proper, and with a view to giving a certificate for the costs.

In *Mandelberg* v. *Morley* (*b*), the plaintiffs at the trial sub-

(*y*) (1889) 43 Ch. Div. 46; 58 L. J. Ch. 734; 6 R. P. C. 510. See also *Dairy* v. *Bailey* (1891), 8 R. P. C. at p. 168. The fact that defendant does not appear will not *per se* deprive plaintiff of his certificate: *Pneumatic Tyre Co.* v. *Carr*, Law Journal (1896), 15 Aug.

(*z*) In *Badham* v. *Bird* (1888), 5 R. P. C. 238, the plaintiff's case broke down, but only those particulars used in cross-examination were certified for.

(*a*) (1889) 6 R. P. C. 143; and cf. *Boyd* v. *Horrocks* (1889), ibid. 152.

(*b*) (1895) 64 L. J. Ch. 245; 12 R. P. C. 35.

mitted to have their action dismissed with costs before the completion of the trial. Stirling, J., refused a certificate as to those particulars which had not been in evidence; and not being satisfied that those on which he had some materials to form a judgment were reasonable and proper, he refused the certificate also for them.

In *Middleton* v. *Bradley* (*c*), plaintiff had discontinued the action. It was decided that there could be no certificate for the particulars of objection, and therefore no costs could be allowed for them, as the Court had no materials on which it could form a judgment as to their propriety. But the Court may look at affidavits or other evidence used in any interlocutory proceedings, in order to determine whether the particulars are reasonable and proper.

Boake, Roberts & Co. v. *Stevenson* (*d*) is a case of a different character. The plaintiff applied for leave to discontinue, and the Court gave leave upon certain terms, one of which was the payment of the costs of particulars of objections. This decision, therefore, does not in any way affect the rule to be derived from the cases last quoted. Nor do the decisions in *Germ Milling Co.* v. *Robinson* (*e*); *Albo-Carbon Light Co.* v. *Kidd* (*f*); *Nuttall* v. *Hargreaves* (*g*). See also *Newsum* v. *Mann* (*h*) (no certificate); *Lees* v. *West London Cycle Stores* (*i*) (certificate granted); *Willoughby* v. *Taylor* (*k*) (certificate granted in a threats action).

Successful party not bound to pay costs of particulars unless they are disallowed by order.

If a certificate is not granted, the taxing master cannot look into the particulars, but unless they are specially disallowed, the successful party (*l*), though he cannot get the costs of the particulars, cannot be made to pay the costs of them to his opponent (*m*).

If the patent is upheld, costs of particulars going to the validity will usually be disallowed, though they affect the constructions put on the claims by the Court (*n*).

(c) *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

(*c*) (1895) 2 Ch. 716; 12 R. P. C. 390.
(*d*) (1895) 12 R. P. C. 228.
(*e*) (1886) 3 R. P. C. 254, *supra*.
(*f*) (1887) 4 R. P. C. 535.
(*g*) (1891) 8 R. P. C. 273. See an interesting article in the Law Journal (1895), at p. 405.
(*h*) (1890) 7 R. P. C. 307.
(*i*) (1892) 9 R. P. C. 301.
(*k*) (1894) 11 R. P. C. 55.
(*l*) R. S. C. Order LXV., rule 27 (29).
(*m*) *Garrard* v. *Edge* (1890), 44 Ch. Div. 224; 59 L. J. Ch. 379; 7 R. P. C. 139.
(*n*) *Shoe Machinery Co.* v. *Cutlan* (1895), 12 R. P. C. 343. But see *Cassel Gold Co.* v. *Cyanide Recovery Co.* (1895), 12 R. P. C. 303.

fact, unless otherwise ordered, follow the event (*o*). 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* (*p*): "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 will be 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."

General principles, Bowen, L. J.

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 (*q*), but also where a defendant, while failing on the issue of infringement, had succeeded on that of validity (*r*).

In *Phillips* v. *Ivel Cycle Co.* (*s*), a defendant succeeded on the issue of validity, but failed on the issue of infringement; he was allowed no costs of the infringement issue, but was not ordered to pay any. In other cases (*t*), the costs of the infringement issue have been given to an unsuccessful plaintiff who proved infringement. On the other hand, seeing there can really be no infringement of an invalid patent, the Court has refused to make a successful defendant pay the costs of an infringement issue (*u*).

(*o*) R.S.C. (1883), Order LXV., rule 2.

(*p*) (1885) 29 Ch. D. at p. 419; 2 R. P. C. at p. 418; 52 L. J. Ch. 704. In the same case the Court of Appeal decided that apportionment of costs will apply to the costs of an appeal: *ibid.* 420.

(*q*) *Simmonds* v. *Hitchman* (1881), Lawson, 174; 29 Ch. D. 417, n. (4); *Needham* v. *Johnson* (1884), 1 R. P. C. 49, 59; *Nordenfelt* v. *Gardner* (1884), *ibid.* 61; *Westinghouse* v. *Lancashire and Yorkshire Railway Co.* (1884), *ibid.* 229; *Shoe Machinery Co.* v. *Cutlan* (1895), 12 R. P. C. 343.

(*r*) *Wegmann* v. *Corcoran* (1878–79), 27 W. R. 357, 362; *United Telephone Co.* v. *Harrison* (1882–83), 21 Ch. D. 747; 51 L. J. Ch. 705; *Hocking* v. *Fraser* (1886), 3 R. P. C. 7; *Edison, &c., Co.* v. *Woodhouse* (1886), *ibid.* 167; *Young* v. *Rosenthal* (1884), 1 R. P. C. 29, 41; Cp. *Pooley* v. *Pointon* (1885), 2 R. P. C. 167; *Laurie* v. *Baker* (1885), *ibid.* 213; *Laurence* v. *Perry* (1885), 2 R. P. C. 179; *Lister* v. *Norton* (1886), 3 R. P. C. 199, 211; *Badham* v. *Bird* (1888), 5 R. P. C. 238.

(*s*) (1890) 7 R. P. C. 77.

(*t*) *Binnington* v. *Hill* (1891), 8 R. P. C. 326; *Blakey* v. *Latham* (1889), 6 R. P. C. 29, 184.

(*u*) *Guilbert-Martin* v. *Kerr* (1887), 4 R. P. C. 18; *Westley-Richards* v. *Perkes* (1893), 10 R. P. C. 194.

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 (*x*).

In *Sugg* v. *Bray* (*y*), 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* (*z*), 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 infringment. The House of Lords 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* (*a*), 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 (*b*).

(*x*) *Kaye* v. *Chubb* (1887), 4 R. P. C. 300, 302; Cp. *Edison, &c., Co.* v. *Holland* (1888), 5 R. P. C. 483; *Blakey* v. *Latham* (1889), 6 R. P. C. 38, 186, 190.

(*y*) (1885) 2 R. P. C. at p. 248, per North, J.

(*z*) (1884) 1 R. P. C. at p. 148.

(*a*) (1889) 6 R. P. C. 528.

(*b*) Cf. cases under the Designs sec-

In *Vorwerk* v. *Evans* (*c*), a litigant was allowed the costs of proving an assignment to himself which had been denied on the pleadings for the purpose of causing a certain witness to be called.

Sometimes two or more patents are sued on, and it may be that one is upheld whilst another is declared invalid, or the infringement issue may result differently in each case. The costs will then be apportioned according to the results (*d*). Thus where the Court decided that there had been no infringement, but that the attack on the patent failed, the costs of establishing validity were given to the plaintiff nevertheless (*d*).

(*d*) *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 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 (*e*).

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 (*f*).

Costs of action for injunction not allowed on higher scale on ground that defendant submitted to an injunction (*g*), nor merely on the ground that important questions were raised (*h*).

tions: *Winfield* v. *Snow* (1891), 8 R. P. C. 15; *Blank* v. *Footman* (1888), 39 Ch. Div. 678; 57 L. J. Ch. 909; 5 R. P. C. 653; *Cooper* v. *Symington* (1893), 10 R. P. C. 264.

(*c*) (1890) 7 R. P. C. 167.

(*d*) *Shoe Machinery Co.* v. *Cutlan* (1895), 12 R. P. C. 343; *Wegmann* v. *Corcoran* (1879), 27 W. R. 357, 362.

(*e*) R. S. C. Order LXV., rule 9.

(*f*) *Fraser* v. *Brescia Steam Tramways Co.* (1887), 56 L. T. 771.

(*g*) *Hudson* v. *Osgerby* (1884), W. N. 83; 32 W. R. 566.

(*h*) *Grafton* v. *Watson* (1884), 51 L. T. 141. See also *Cardiff Steamship Co.* v. *Barwick* (1885), 53 L. T. 56.

Costs on the higher scale will sometimes be allowed in patent cases where scientific witnesses are necessarily called (*i*); but the rule is not invariable, and it must not be assumed that costs on the higher scale will usually be allowed in patent cases. Exceptional circumstances are requisite to entitle the successful party to costs on the higher scale (*k*).

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 (*l*).

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 (*m*).

Where the action was one requiring special knowledge on the part of those concerned in it, costs on the higher scale were allowed (*n*).

In *Automatic Weighing Co.* v. *Combined Weighing Machine* (*o*), 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.

In cases involving long examinations, preparation of models, and the calling of expert evidence, costs on the higher scale have been allowed against unsuccessful litigants (*p*). The fact, however, that a defendant submits to an injunction is not a "special ground" within the meaning of Order LXV., rule 9 (*q*). The amount of money in question may have some

(*i*) *Ellington* v. *Clark* (1889), 58 L. T. 818.

(*k*) *Tweedale* v. *Howard* (1896), 13 R. P. C. 522; *Gadd* v. *Mayor of Manchester* (1892), 9 R. P. C. 516; *Farbenfabriken, &c., Co.* v. *Bowker* (1891), 8 R. P. C. 389. Costs on the higher scale were refused in *Westley-Richards* v. *Perkes* (1892), 9 R. P. C. 181; *Wenham Gas Co.* v. *Champion Gas Co.* (1891), 8 R. P. C. 313; *American Braided Wire Co.* v. *Thomson* (1890), 7 R. P. C. 152, and granted in *Automatic Weighing Machine Co.* v. *Hygienic Co.* (1889), 6 R. P. C. 475; *Otto* v. *Steel* (1886), 3 R. P. C. 120; *Edison* v. *Holland* (1888), 5 R. P. C. 459; *Blakey* v. *Latham* (1889), 6 R. P. C. 29; *Tweedale* v. *Ashworth* (1890), 7 R. P. C. 426; *Farbenfabriken Co.* v. *Bowker*, *supra*.

(*l*) *Davies* v. *Davies* (1887), 56 L. J. Ch. 481.

(*m*) *Fraser* v. *Brescia Tramways Co.* (1887), 56 L. T. 771.

(*n*) *Moseley* v. *Victoria Rubber Co.*, 4 R. P. C. 241. See too *Farrar* v. *Farrar*, 59 L. T. 619.

(*o*) (1889) 6 R. P. C. 372.

(*p*) *Wenham* v. *May* (1888), 5 R. P. C. 310.

(*q*) *Peroni* v. *Hudson* (1884), 1 R. P. C. 261.

effect in determining whether costs on the higher scale shall be allowed (*r*).

In *Peroni* v. *Hudson* (*s*), where the defendant did not appear at the trial, costs on the higher scale were refused to the plaintiff.

In *Grafton* v. *Watson* (*t*) costs on appeal against an interlocutory injunction were allowed only on the lower scale, although an important question was raised.

In *Ellington* v. *Clark* (*u*). 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.* (*v*) 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.

(*e*) *Costs when Defendant offers to submit.*

Costs when the defendant submits to an injunction.

If the defendant offers to submit to an injunction or promises no longer to infringe, it will depend upon circumstances whether he will be ordered to pay the costs incurred subsequently to his submission. The real point for determination is whether the plaintiff must go on with his proceedings or whether he is already sufficiently protected by the surrender of his opponent. This is practically the same as whether the acts of the defendant have disentitled him to an injunction (*x*). The plaintiff is generally entitled to go on if there be any doubt, at any rate until he has obtained his injunction (*y*), but the Court will use its discretion on the facts of each case.

The following cases are illustrative:—

Cases.

Cooper v. *Whittingham* (*z*). Here defendants were sued for infringement under the Copyright Act, 1842, and an injunction was asked for to restrain a sale; defendants pleaded that when they received the copies they at once recognised the piracy, and determined not to sell. Jessel, M. R., made them pay the costs

(*r*) *Muirhead* v. *Commercial Cable Co.* (1895), 12 R. P. C. 39, 64.

(*s*) *Peroni* v. *Hudson* (1884), 1 R. P. C. 261.

(*t*) (1884) 51 L. T. N. S. 141.

(*u*) (1888) 5 R. P. C. 319.

(*v*) (1888) 5 R. P. C. 404.

(*x*) *Proctor* v. *Bailey* (1889), 42 Ch. Div. 390; 59 L. J. Ch. 12; 6 R. P. C. 538; *Upmann* v. *Elkan* (1871), 7 Ch. 130; 41 L. J. Ch. 246; *Millington* v. *Fox* (1838), 3 My. & Cr. 338.

(*y*) *Colbourne* v. *Sims* (1843), 12 L. J. Ch. 338; 2 Ha. 543; *Nunn* v. *D'Albuquerque* (1865), 34 Beav. 595; *Geary* v. *Norton* (1846), 1 De G. & Sm. 9; and see *Fradella* v. *Weller* (1831), 2 Russ. & My. 247.

(*z*) (1880) 15 Ch. Div. 501; 49 L. J. Ch. 752.

of the motion. He said: "As I understand the law as to costs it is this, that where the plaintiff comes to enforce a legal right, and there has been no misconduct on his part—no omission or neglect which would induce the Court to deprive him of costs—the Court has no discretion, and cannot take away the plaintiff's right to costs."

Upmann v. *Forester* (*a*). The defendant (a china merchant) purchased abroad, for his own private use, some cigars, which were consigned to him at the docks; they bore a spurious brand, purporting to be that of the plaintiffs. When plaintiffs issued their writ and served a notice of motion for an injunction, the defendant stated to them that he had no intention of selling the cigars, offered all relief asked for by the writ, and, when the motion came on, agreed to an undertaking in the terms of the writ. Chitty, J., decided that the defendant must pay the costs, but added: "The result of my decision, however, will not be, as the defendant has suggested, that every purchaser of a small parcel of spurious goods incurs a liability to pay the costs of an action in the Chancery Division for infringing a patent or trade-mark. I cannot pass over the fact that there is in the present case a large consignment of goods—5,000 cigars is rather a large order for personal consumption—and the plaintiffs were justified in suspecting that so large a consignment was intended for distribution."

Wittmann v. *Oppenheim* (*b*). This was an action to restrain infringement of copyright in a registered design, and plaintiffs moved for an injunction. Defendant stated that he sold the lamps innocently, and that he received no notice that he was infringing until issue of the writ. Pearson, J., ordered the defendant to pay the costs. He said: "I should be very willing to make an order as to costs, but, looking at the decision in *Upmann* v. *Forester* (*c*), and to the rule there stated by Chitty, J., with which I entirely agree, I am afraid I have no choice. It is said that the plaintiffs issued their writ without notice to the defendant, and that the defendant, as soon as he had notice of the plaintiff's title, did his best to undo what he had done. But, at the same time, I cannot say that the plaintiffs were wrong in

(*a*) (1883) 24 Ch. Div. 231; 52 L. J. Ch. 946; and see *Grace* v. *Newman*, 19 Eq. 623; 44 L. J. Ch. 298.

(*b*) (1884) 27 Ch. Div. 260; 54 L. J. Ch. 56.

(*c*) (1883) 24 Ch. Div. 231; 49 L. J. Ch. 752.

issuing their writ without notice, and after that the only offer which the defendant could properly make was to submit to an injunction and to pay the costs."

American Tobacco Co. v. *Guest* (*d*). In this case the owner of a registered trade-mark moved for an injunction to restrain infringement. The defendant, who had at one time made purchases from the plaintiff, bought a few articles from another firm, believing them to be the plaintiff's, and they offered to abide by any order made by the Court. Stirling, J., granted the injunction, but refused the plaintiff his costs. He said (referring to *Upmann* v. *Forester* (*e*): "In that case, there being that large amount of goods, Mr. Justice Chitty made an order for payment of the costs. Here there are only 500 cigarettes, valued at 17*s.* 6*d.*, and I think that under those circumstances I am justified in excepting, as I think Mr. Justice Chitty would have excepted, this case from the operation of the rule which he laid down in *Upmann* v. *Forester*, by saying that there ought to be no costs."

In *Lyon* v. *Mayor, &c., of Newcastle-upon-Tyne* (*f*), plaintiff discovered that the Corporation of Newcastle were in possession of a machine made in infringement of his patent; the town clerk stated to the plaintiff that the Corporation did not dispute the patent, had never used the machine, and did not intend to use it, and undertook not to use it. The plaintiff's solicitors would not accept this nor any other undertaking, and moved for an injunction. On the undertaking being given to the Court, the motion was dismissed with costs (*g*).

(*f*) *Miscellaneous.*

Shorthand Notes.—The costs of the notes of the judgment are frequently allowed, but it is not the practice to allow notes of the evidence unless in unusual circumstances (*h*). The parties,

(*d*) (1892) L. R. 1 Ch. 630; 61 L. J. Ch. 242; 9 R. P. C. 218.

(*e*) *Supra.*

(*f*) (1894) 11 R. P. C. 218.

(*g*) A late case, much to the same effect, is *Jenkins* v. *Hope and others* (1896), 13 R. P. C. 57. See *Losh* v. *Hayne*, 1 W. P. C. 200; *Geary* v. *Norton* (1846), 1 De G. & Sm. 9; *United Telephone Co.* v. *London and Globe Telephone Co.* (1884), 1 R. P. C. 117; 26 Ch. Div. 766; 53 L. J. Ch. 1158; in all of which plaintiff obtained his costs; also *Nixey* v. *D'Albuquerque* (1865), 34 Beav. 595; *Fletcher* v. *Glasgow Gas Commissioners* (1887), 4 R. P. C. 386, in which the plaintiffs did not get their costs.

(*h*) *Morris* v. *Young* (1895), 12 R. P. C. 455; *Automatic Co.* v. *Knight* (1889), 6 R. P. C. 297; *American Braided Wire Co.* v. *Thomson* (1890), 7 R. P. C. 152; *Ungar* v. *Sugg* (1892), 9 R. P. C. 113.

however, may make what arrangement they think fit, and this course is frequently pursued (*i*).

Costs of Inquiry as to Damages.—Chitty, J., refuses to make any order as to these at the trial, but leaves the matter for subsequent consideration (*k*). This seems to be the usual practice.

Costs of three counsel are not usually allowed; see, *e.g.*, *Smith* v. *Buller* (*l*), *Leonhardt* v. *Kallé* (*m*). In the same case it was stated that ten guineas a day was a fee ordinarily allowed to an eminent expert for qualifying and giving evidence, but that each case must be determined by its own circumstances.

The costs of drawings of exhibits put in the margin of counsel's brief were disallowed in *Smith* v. *Buller* (*l*).

Costs as against Third Parties.—See *Edison* v. *Holland* (*n*).

Costs in the Court of Appeal.—See R. S. C. Order 58.

Sect. 12.—Stay of Execution.

Rules as to stay of execution.

Under the Rules of the Supreme Court, 1883, Order LVIII., rule 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. No general rules can be laid down as to the circumstances under which the Court will exercise its discretion, and each case will be judged on its own merits. The following points have, however, been decided, and it may be useful to note them.

As a general rule, an appeal is no reason to stay proceedings (*o*).

Where judgment is given for a defendant with costs, execution will generally not be stayed, if the defendant's solicitors give their personal undertaking to repay any costs received by them, if the judgment should ultimately be reversed (*p*).

An order for the delivery up of infringing machines has been suspended on the defendants undertaking that neither they nor any articles made by them should be removed out of or used in

(*i*) *Vorwerk* v. *Evans* (1890), 7 R. P. C. 169; *Bown* v. *Centaur Cycle Co.* (1891), 8 R. P. C. 109.

(*k*) *United Telephone Co.* v. *Fleming* (1886), 3 R. P. C. 282; *United Telephone Co.* v. *Patterson* (1889), 6 R. P. C. 140.

(*l*) (1874) 19 Eq. 473; 45 L. J. Ch. 880.

(*m*) (1895) 12 R. P. C. 306; and see as to experts *Batley* v. *Kynoch* (1875), 20 Eq. 632. 44 L. J. Ch. 565; as to three counsel, *Smith* v. *Buller*, *supra*.

(*n*) (1889) 41 Ch. Div. 28; 58 L. J. Ch. 524; 6 R. P. C. 243.

(*o*) *Edge* v. *Johnson* (1892), 9 R. P. C. at p. 142.

(*p*) *Easterbrook* v. *G. W. Railway Co.* (1885), 2 R. P. C. 212; *Merry* v. *Nickalls* (1873), 8 Ch. 205; *Morgan* v. *Elford* (1876), 4 Ch. D. 287; *Ticket Punch Co.* v. *Colley's Patents* (1895), 12 R. P. C. 10; *Deeley's Patent* (1895), *ibid.* 75.

this country pending an appeal (*q*). The order for destruction of infringing articles has been suspended pending an appeal (*r*).

Where a defendant moved for a stay of proceedings pending an appeal to the House of Lords, and it appeared that, as the defendant 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 (*s*).

The operation of an injunction (*t*) and [or (*u*)] of an order for an account (*x*) 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 (*y*).

But it is unusual to stay either an injunction or an account (*z*). Sometimes injunctions have been suspended in regard to orders already taken in hand by the defendant (*a*).

Sect. 13.—Appeals.

The Court of Appeal may hear appeals from judgments, orders, decrees, or rules (*b*), but not from the granting or refusal of certificates (*c*) nor from any order simply as to costs (*d*). An appeal from any interlocutory judgment or order can be brought only if the Judge or the Court of Appeal gives leave (*e*). But where an application has been made to appoint a receiver or to grant an injunction, there is an appeal from the decision to the Court of Appeal without leave (*f*). If leave is required it must be made in the first instance to the Judge below (*g*).

The procedure relating to appeals is governed by R. S. C.

(*q*) *Washburn and Moen Manufacturing Co.* v. *Patterson* (1884), 1 R. P. C. 191.

(*r*) *Howes* v. *Webber* (1895), 12 R. P. C. 470.

(*s*) *Proctor* v. *Bennis* (1887), 4 R. P. C. 363; cp. *Adair* v. *Young* (1879), 11 Ch. D. 136; *Nordenfelt* v. *Gardner* (1884), 1 R. P. C. 63; *Otto* v. *Steel* (1886), 3 R. P. C. 109, 121.

(*t*) *Hocking* v. *Fraser* (1886), *ibid.* 7.

(*u*) *Woodward* v. *Sansum* (1886), *ibid.* 366. But in *Humpherson* v. *Syer* (1887), 4 R. P. C. 184, Kekewich, J., refused to suspend the injunction, pointing out that the orders in the previous cases might have been made without opposition.

(*x*) *Kaye* v. *Chubb* (1887), 4 R. P. C. 23.

(*y*) *S. C.*

(*z*) *Otto* v. *Steel* (1886), 3 R. P. C. 121; *Chadburn* v. *Mechan* (1895), 12 R. P. C. at p. 135; *Edison* v. *Woodhouse* (1886), 3 R. P. C. 178; *Saxby* v. *Easterbrook* (1872), L. R. 7 Ex. 207; 41 L. J. Ex. 113.

(*a*) *Lyon* v. *Goddard* (1893), 10 R. P. C. 135; *Duckett* v. *Whitehead* (1895), 12 R. P. C. 191. But see *Lyon* v. *Goddard* (1893), 10 R. P. C. 348.

(*b*) Judicature Act, 1873, sects. 19 and 100.

(*c*) *Haslam* v. *Hall* (1888), 20 Q. B. D. 491; 57 L. J. Ch. 352; 5 R. P. C. 144.

(*d*) Judicature Act, 1873, sect. 45.

(*e*) Judicature Act, 1894, sect. 1. See *Boake* v. *Stevenson* (1895), 12 R. P. C. at p. 231.

(*f*) *Ibid.*

(*g*) R. S. C. 1883, Order LVIII., rule 17.

1883, Order LVIII. See particularly Order LVIII., rule 4, and the remarks of Smith, L. J., on it in *Shoe Machinery Co.* v. *Cutlan* (*h*).

New trials.

Applications for new trials must be made direct to the Court of Appeal (*i*), and the procedure is prescribed by R. S. C. 1883, Order XXXIX. Where a case tried by a Judge without a jury comes before the Court of Appeal, the Court presumes that the decision of the Judge on the facts is right, and will not disturb it unless the appellant satisfactorily makes out that it is wrong; Kay, L. J.'s view, does not go so far as this (*k*).

There is an appeal from the Court of Appeal to the House of Lords. See Appellate Jurisdiction Act, 1876.

Appeals, how brought.

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.

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 (*l*).

Bankrupt appellants.

A novel point as to the position of bankrupt appellants was raised and decided in *United Telephone Co.* v. *Bassano* (*m*). 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.

The Court is 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 (*n*).

(*h*) (1896) 1 Ch. 108; 65 L. J. Ch. 314.

(*i*) Judicature Act, 1890. For some grounds for a new trial see *King* v. *Oliver* (1884), 1 R. P. C. 32, 44.

(*k*) *Colonial Securities Trust Co.* v. *Massey* (1896), 1 Q. B. 38: 65 L. J. Q. B. 100: *Savage* v. *Adam* (1895), W. N. 109; *Penn* v. *Bibby* (1866), 2 Ch. 127; 36 L. J. Ch. 455.

(*l*) *Ibid.*, rule 6.

(*m*) (1886) 31 Ch. D. 630.

(*n*) *Ibid.*, rule 4.

Further evidence on appeal.

The Court of Appeal has full discretionary power to allow amendments and to receive further evidence upon questions of fact (*o*); 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 (*p*). The term "special grounds" was judicially considered in *Hinde* v. *Osborne* (*q*). "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 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."

Further evidence.

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 (*r*).

(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

(*o*) R. S. C. Order LVIII., rule 4; and see *Shoe Machinery Co.* v. *Cutlan* (1896), 1 Ch. 108; 65 L. J. Ch. 314; 13 R. P. C. 141, 345.

(*p*) *Ibid.* Cp. *Edison Co.* v. *Shippey* (1887), 4 R. P. C. 471; *Walker* v. *Hydrocarbon Syndicate, Ltd.* (1886), 3 R. P. C. 253.

(*q*) (1885) 2 R. P. C. 47.

(*r*) *Hinde* v. *Osborne* (1885), 2 R. P. C. 47.

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 (*s*).

In *Nordenfelt* v. *Gardner* (*t*), 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 the general powers to amend and admit further evidence (*u*).

In *Blakey* v. *Latham* (*x*), 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 diligence have discovered before. The Court of Appeal gave liberty (*y*) 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.

If the Court of Appeal is able to determine the matter on one point, it will not consider others for the purpose of certifying for costs (*z*).

(*s*) *Walker* v. *Hydro-carbon Syndicate* (1886), 3 R. P. C. 253.

(*t*) (1884) 1 R. P. C. at p. 73.

(*u*) R. S. C. 1883, Order LVIII., rule 4.

(*x*) (1889) 6 R. P. C. 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, Order LVIII., and further evidence can be admitted on appeal: *Spencer* v. *Ancoats Vale Rubber Co.* (1889), 6 R. P. C. 46.

(*y*) *Britain* v. *Hirsch* (1888), 5 R. P. C. 226. See also *Deutsche Näthmaschinen Fabrik, &c.* v. *Pfaff* (1889), 6 R. P. C. 251.

(*z*) *Ante*, p. 456; *Longbottom* v. *Shaw* (1889), 6 R. P. C. 143.

CHAPTER XIV.

ACTION TO RESTRAIN THREATS.

Prior to the Act of 1883.

Origin of action to restrain threats.

At least as early as the year 1869 (*a*) it had been recognised 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 *bonâ 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 *bonâ 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 follow up threats.

In the cases of *Rollins* v. *Hinks* (*c*) and *Ormann* v. *Lund* (*d*), however, Malins, V.-C., held that a patentee is not entitled to publish statements of his intention to institute legal proceedings if he has no *bonâ fide* intention to follow up his threats by taking

(*a*) *Wren* v. *Weild*, L. R. 4 Q. B. 730, 737; 38 L. J. Q. B. 327. The burden of proving falsity of the threats is on the plaintiff: *Barnett* v. *Tak* (1882), 45 L. T. N. S. 743; *Anderson* v. *Liebig's Meat Co.* (1881), 45 L. T. N. S. 757, 759.

(*b*) (1880-81) L. R. 15 Ch. D. 514; 19 Ch. D. 386; 49 L. J. Ch. 786; 51 L. J. Ch. 233; Cp. *Sugg* v. *Bray*, an action brought before but tried under the Patents Acts, 1883-1885, 1 R. P. C. 45; 2 R. P. C. 224.

(*c*) (1872) L. R. 13 Eq. 355; 41 L. J. Ch. 358.

(*d*) (1874) L. R. 18 Eq. 330; 51 L. J. Ch. 170.

such proceedings, and that the Court will in such case restrain him from making such publication.

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."

Evidence necessary if injunction claimed.

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.

Summary of law prior to 1883.

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 available 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 *mala fide*. Failure on the part of a defendant to follow up his threats by raising an action for infringement did not *per se* 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.

Under Act of 1883.

Patents Act, 1883, sect. 32.

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 section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent."

(*e*) (1880-81) 15 Ch. Div. 514; affirmed 19 Ch. Div. 386; 49 L. J. Ch. 786; 51 L. J. Ch. 233. But false statements of facts may make the issuer liable: *Dicks* v. *Brooks* (1880), 15 Ch. Div. at p. 40; 49 L. J. Ch. 812.

Alterations introduced by Act of 1883.

This section has altered the earlier law in several respects, of which the chief are these: (a) The *bonâ fides* of the patentee threatening legal proceedings or liability is immaterial if (1) the acts of the plaintiff are not in fact an infringement of his patent right; and (2) he fails with due diligence to commence and prosecute an action for infringement (*f*). (b) The doctrine laid down in *Rollins* v. *Hinks* (*g*) and *Axmann* v. *Lund* (*h*), but dissented from in *Halsey* v. *Brotherhood* (*i*), that a person giving notice that his rights are being infringed, and threatening with legal proceedings, 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.

I. *The Threat.*

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 (*k*). Threats do not fall within this definition if they are mere general 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 true gist of what he has

(*f*) *Skinner* v. *Shew* (or *Perry*) (1893), 1 Ch. 413; 62 L. J. Ch. 196; 10 R. P. C. 1; *Herrburger* v. *Squire* (1888), 5 R. P. C. 581; 6 R. P. C. 194.

(*g*) (1872) L. R. 13 Eq. 355; 41 L. J. Ch. 358.

(*h*) (1874) L. R. 18 Eq. 330; 51 L. J. Ch. 170.

(*i*) (1879) L. R. 15 Ch. D. 514; 19 Ch. D. 386; 49 L. J. Ch. 786; 51 L. J. Ch. 233.

(*k*) *Challender* v. *Royle* (1887), 36 Ch. Div. at p. 441; 56 L. J. Ch. 995; 4 R. P. C. 363.

done is to apply that threat to a particular person and to a particular act" (*l*).

A threat regarding the future is within the section.

These remarks must, however, be read in the light of subsequent cases. In *Kurtz* v. *Spence* (*m*) Kekewich, J., said: "I understand the Lord Justice 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 understand the Lord Justice to say that if a patentee says, 'You have sold so many hundredweights or tons of the patented article, and I tell you I shall proceed against you if you sell any more,' that that is not a threat within the meaning of the section. I hardly know what would be the use of a threat if it were simply with reference to something which is past. Lord Justice Bowen does not seem to me to mean that it must refer only to something which is past. As I understand his language, it must not be only with reference to something in the future, but a threat expressed only in the way I have suggested would be held to be a threat within the meaning of the section as interpreted by the Lord Justice."

The point was considered by the Court of Appeal in *Johnson* v. *Edge* (*n*). Lindley, L. J., then said (*o*) that this section might apply to an intended infringement provided that it could be shown that the intended infringement, if carried out, would be in fact an infringement—*e.g.*, if a person issues notices of intention to make a thing which would be made in infringement of another's alleged patent, and if that latter threatens, he would bring himself within this section. Kay, L. J. (*p*), after stating that a general warning, not pointed against any particular person, would not be within the section, goes on to say: "I can conceive one case of future infringement which would come entirely within the mischief which this section was intended to provide against. Suppose a man issued a circular saying, 'I have a patent for such and such an article. I understand that Messrs. A. & Co. have recently erected a large manufactory for the purpose of manufacturing articles which, if made, will be an infringement of my patent.' Can it be said that a case like that

General warning not necessarily a threat.

(*l*) *Challender* v. *Royle* (1887), 4 R. P. C. at pp. 374, 375; 36 Ch. Div. at p. 441; 56 L. J. Ch. 995.

(*m*) (1889) 5 R. P. C. at p. 171; 57 L. J. Ch. 238.

(*n*) (1892) 2 Ch. 1; 9 R. P. C. 142; 61 L. J. Ch. 262.

(*o*) Page 9.

(*p*) At p. 12.

would not come within the mischief intended to be provided against by this section (*q*)? Could not Messrs. A. & Co. bring an action against the person who issued that circular for an injunction? I should wish at least to suspend my opinion on that subject until that point comes before the Court of Appeal to be tried."

Difficulties when the threat is aimed at an intended infringement.

The Lord Justice would probably have to hold that the "manufacture, use, sale, or purchase" spoken of in the section includes "*intended* manufacture, use, sale, or purchase." This is of itself an objection to his view. But there is a further difficulty. The section clearly shows that the threat must refer to something complained of which entitles the threatener to issue his writ for infringement. But, taking the above example, if A. & Co. bring their threats action, the threatener could hardly bring an action for infringement, and could therefore not get within the proviso. Neither could they justify their threats on the ground that A. & Co. had actually infringed. It would seem, therefore, *bonâ fide* being no defence (*r*), that the mere issue of the threat would entitle A. & Co. to succeed, even though A. & Co. did actually intend to infringe; and though they would obtain no damages, they might get an injunction. Could this be the intention of the section? To support the view to which Kay, L. J., inclines, not only would the words "or intended" have to be read into the section before the words "manufacture, use," &c., but the words "or intended infringement" would have to be added to the word "infringement," and the proviso would need to have read into it at the end the words "or an action to restrain intended infringement." These difficulties are serious, and any decision will be received with interest (*s*).

Ejusdem generis construction does not apply.

The section refers to threats made by circular, advertisement, or "otherwise." It is now absolutely settled that the *ejusdem generis* construction does not apply to the word "otherwise" (*t*). Threats are within this section, whether made at interviews (*u*), by private letter (*x*), by a solicitor's letter (*y*), and whether or not

(*q*) It might, and yet not come within the words of the section. The intention of the Legislature is not very clearly brought out.

(*r*) *Skinner* v. *Shew* (1893), 1 Ch. 413; 10 R. P. C. 1; 62 L. J. Ch. 196.

(*s*) The judgment of Day, J., in *Willoughby* v. *Taylor* (1894), 11 R. P. C. 45, throws little light on the point in question here.

(*t*) *Skinner* v. *Shew* (1893), 1 Ch. 413, 425; 10 R. P. C. 1; 62 L. J. Ch. 196.

(*u*) *Kurtz* v. *Spence* (1888), 5 R. P. C. at p. 172; 57 L. J. Ch. 238.

(*x*) *Kurtz* v. *Spence*, *supra*.

(*y*) *Driffield & Co.* v. *Waterloo & Co.*

made to plaintiff in the threats action or to another person (*z*) (provided always that the plaintiff is a party aggrieved—see below), or by advertisement or circular (*a*). Though the threats are in answer to an inquiry, the result is the same (*b*).

Threats without prejudice.

In *Kurtz* v. *Spence* (*c*), 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., held the plaintiff entitled to an injunction with costs.

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 be so framed as to make it clear that the use by the third parties and not the invention itself is complained of (*d*).

A threat of legal proceedings contained in a letter which has never been qualified or withdrawn, is held to be continued (*e*).

A few examples of the threats on which decisions have been given may elucidate the matter.

(1) "It having come to our knowledge that certain of our patents are being infringed, notably . . . we hereby caution our numerous friends against purchasing these imitation goods. It cannot be too generally known that all parties who handle a patent article, from the maker to the user . . . are liable to the patentee. Our patent solicitor has instructions to take proceedings against all infringers." Bowen, L. J., doubted whether there was a threat upon which action could be founded (*Challender* v. *Royle*) (*f*).

(2) "Notice to grocers and others. Information of extensive violation of Mr. Edge's patent rights has been received. All

(1886), 31 Ch. Div. 638; 55 L. J. Ch. 391; 3 R. P. C. 46; *Combined Weighing, &c., Co.* v. *Automatic Weighing, &c., Co.* (1889), 42 Ch. Div. 665; 58 L. J. Ch. 769; 6 R. P. C. 502.

(*z*) *Douglass* v. *Pintsch's Patent Lighting Co., Ltd.* (1896), 13 R. P. C. 673; *Barrett* v. *Day* (1889), 43 Ch. Div. 435; 7 R. P. C. 51.

(*a*) See the words of the section; also *Johnson* v. *Edge* (1892), 2 Ch. 1; 9 R. P. C. 142; 61 L. J. Ch. 262.

(*b*) *Skinner* v. *Shew* (1893), 1 Ch. 413; 10 R. P. C. 1; 62 L. J. Ch. 196.

(*c*) (1888) 5 R. P. C. 161.

(*d*) *Burt* v. *Morgan* (1887), 4 R. P. C. at p. 280.

(*e*) *Driffield, &c., Co.* v. *Waterloo, &c., Co.* (1886), 31 Ch. Div. 638; 55 L. J. Ch. 391; 3 R. P. C. 46.

(*f*) (1887) 36 Ch. Div. 425; 56 L. J. Ch. 995; 4 R. P. C. 363.

parties are warned not to infringe these rights. R. and R. C. Winder, Solicitors, &c." Held (on the facts), to be a threat within the section (*Johnson* v. *Edge*) (*g*).

(3) "We beg to confirm our opinion previously expressed that the camera in question is an infringement of our patent. . . . We have taken further advice in the matter, and are prepared to stop the sale of this camera if placed on the market." Held a threat (*Skinner* v. *Shew*) (*h*).

(4) "We understand that your house is being supplied with electric light by the . . . Co., which company, as you are doubtless aware, is being sued for damages for infringement of our patent system of electric distribution. We have been advised that you, as one of the users of this said system of distribution, are liable for infringement. We beg, therefore, to caution you of this fact, and to offer you an indemnity upon the terms contained in the enclosed circular." Held to be a threat (*Kensington, &c., Electric Lighting Co.* v. *Lane-Fox Electrical Co.*) (*i*).

(5) "I am afraid this matter will lead to a great deal of difficulty and unpleasantness, and you must not be surprised if my Company applies for an injunction against Mr. D. to restrain," &c. (*Douglass* v. *Pintsch's Patent Lighting Co.*) (*j*).

II. *The Action.*

The Parties.—The plaintiff may be any "person aggrieved," *i.e.*, the person threatened or any person injuriously affected by the threats. In *Johnson* v. *Edge* (*k*), the plaintiff was a manufacturer of similar goods to the defendant's, into the hands of whose customers defendant's circular had come. See also *Kensington, &c., Co.* v. *Lane-Fox Electric Light Co.* (*l*), *Colley* v. *Hart* (*m*), *Skinner* v. *Shew* (*n*).

The Pleadings.—If it is intended to rely upon the common law, *mala fides* must be alleged in the statement of claim. Forms of claim and defence thereto will be found in the Appendix, *post*, pp. 847, 848. Speaking generally, the plaintiff should allege: (a) the threats; (b) that the defendant's patent is invalid; (c) that plaintiff has not infringed.

(*g*) (1892) 2 Ch. 1; 61 L. J. Ch. 262; 9 R. P. C. 142.
(*h*) (1893) 1 Ch. 413; 62 L. J. Ch. 196; 10 R. P. C. 1.
(*i*) (1891) 2 Ch. 573; 8 R. P. C. 277.
(*j*) (1896) 13 R. P. C. 673.
(*k*) See the threat set out *supra*.
(*l*) (1891) 2 Ch. 573; 8 R. P. C. 277.
(*m*) (1890) 44 Ch. Div. 179, 186; 7 R. P. C. 101.
(*n*) (1893) 1 Ch. 413; 62 L. J. Ch. 196; 10 R. P. C. 1.

Invalidity of the patent may be raised.

It was at one time doubted whether want of validity of the defendant's patent could be raised in a threat action, but it may now be taken to be decided that this is permissible (*o*).

Defence.

The defendant may set up: (a) he did not threaten; (b) he commenced and prosecuted an action for infringement with due diligence, and so brings his case within the proviso (see below); (c) the plaintiff in fact infringed his patent.

Procedure when an infringement action is pending.

Should the defendant have started his infringement action, and in the threats action plead both (b) and (c), it seems probable that two actions will be proceeding at the same time in which the same point is being tried. To avoid the unnecessary expense such a course would entail, the defendant should either counterclaim, or arrangements should be made for one of the actions to stand over until the decision in the other has been given (*p*). It may be convenient to try the existence or non-existence of a threat before proceeding with the more complicated points in the action (*q*).

Particulars.—If the plaintiff alleges want of validity of defendant's patent, he must give such particulars of objection as would be given in an infringement action; but the plaintiff is entitled first to know the patents on which the threats were based. Should there be but one patent, and this well known to plaintiff, he should give particulars of objection forthwith; in other cases he may await the production of the list of patents on which defendant relies (*r*). Particulars of objection may be required before delivery of defence (*s*). Other particulars to which a defendant is entitled are: particulars of the threats complained of (*s*), but not of the names of customers whom plaintiff had agreed to indemnify in consequence of the threats, unless perhaps where the amount of damage is to be assessed at the trial (*t*). He is also entitled to particulars of the agents through whom it is alleged the threats were made (*u*).

(*o*) Dicta of the L. JJ. in *Challender* v. *Royle* (1887), 36 Ch. Div. 425, 443; 56 L. J. Ch. 995; 4 R. P. C. 363; *Kurtz* v. *Spence* (1887), 36 Ch. Div. 770; 4 R. P. C. 427; practically overruling *Kurtz* v. *Spence* (1886), 33 Ch. Div. 579; 55 L. J. Ch. 919. See also *Herrburger* v. *Squire* (1888), 5 R. P. C. 581; 6 R. P. C. 194.

(*p*) *Combined Weighing, &c., Co.* v. *Automatic Weighing, &c., Co.* (1889), 42 Ch. Div. 665, 674; 58 L. J. Ch. 709; 6 R. P. C. 502.

(*q*) *Kurtz* v. *Spence* (1888), 57 L. J. Ch. 238; 5 R. P. C. 161, 169.

(*r*) *Union Electrical Power, &c., Co.* v. *Electrical Power Storage Co.* (1888), 38 Ch. Div. 325; 5 R. P. C. 329; *Law* v. *Ashworth* (*supra*), at p. 89.

(*s*) *Law* v. *Ashworth* (1890), 7 R. P. C. 86.

(*t*) *Law* v. *Ashworth* (*supra*), at p. 88.

(*u*) *Dowson Taylor* v. *Drosophore Co.* (1894), 11 R. P. C. 536; 12 R. P. C. 95.

The defendant must give particulars of infringement (*x*), if infringement be relied upon.

Quære, whether sect. 29 of the Act of 1883 applied.

Sect. 29 of the Patents, &c., Act, 1883, regulates particulars in actions for infringement, but does not deal with threats actions (*y*). In *Willoughby* v. *Taylor* (*z*), Day, J., gave a certificate that the particulars of objection were reasonable and proper, but *semble*, the application was unnecessary, the matter being one for taxation. If the certificate was required at all, it could only have been because sect. 29 was considered to apply, and in such case the learned Judge could not have given the certificate unless the particulars were proved to him to have been reasonable (*z*).

The Trial.—The case may be tried before a jury, as sect. 29 does not refer to a threats action; but leave must be obtained as provided by R. S. C. Order XXXVI. rules 2 *et seq.* The plaintiff, the burden of proof being to a certain extent on him (*a*), would have the right to begin, save where the only issues are infringement or on the proviso. In *Kurtz* v. *Spence* (*b*), the Court of Appeal, as a condition of allowing an amendment setting up invalidity of the defendant's patent, gave defendant the right to begin and reply.

Defendant must support patent as in action for infringement if patent is attacked.

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. If the patent is attacked he is bound to support it as if he were plaintiff in an action for infringement (*c*).

Certificate that validity of patent was in question should not be given.

Certificate that Validity of the Patent came in Question.—Field, J., in one case gave a certificate to this effect for what it was worth, but it is submitted that its worth was very little. Sect. 31, which deals with such certificates, refers only to actions for infringement. In *Herrburger* v. *Squire* (*d*), Charles, J., was about to make a declaration that defendant's patent was invalid, but he stopped short of so doing. It is submitted that he had no power to make such a declaration.

(*x*) *Wren* v. *Weild* (1869), L. R. 4 Q. B. 213; *Willoughby* v. *Taylor* (1894), 38 L. J. Q. B. 327; 11 R. P. C. 45. The latter case is peculiar because the defendant did not at the trial nor even by his pleadings allege that there had been infringement; *Quære*, whether particulars should in such case have been ordered.

(*y*) See per Chitty, J., in *Kurtz* v. *Spence* (1886), 33 Ch. Div. at pp. 383—4.

(*z*) (1894) 11 R. P. C. 45.

(*a*) *Challender* v. *Royle* (1887), 36 Ch. Div. 425, 435; 4 R. P. C. 363; 56 L. J. Ch. 995.

(*b*) (1887) 36 Ch. Div. 770; 4 R. P. C. 427.

(*c*) *Kurtz* v. *Spence* (1888), 5 R. P. C. at p. 177; 57 L. J. Ch. 238.

(*d*) (1888) 5 R. P. C. 581.

Remedies.

The remedies to which a threatened person is entitled are: (1) an injunction, interim or perpetual; and (2) damages. These remedies are concurrent.

Injunction.

Injunction.—In considering a motion (which should not be made *ex parte* (*e*), for an interlocutory injunction under sect. 32, the Court looks not so much to the balance of convenience and inconvenience, but requires the applicant to make out at least a *primâ facie* case (*f*) that the act complained of is not an infringement. And where the defendant expressed his intention of not threatening pending the action, and undertook to proceed diligently with his action for infringement, the Court refused an injunction, but gave plaintiff liberty to apply, if necessary (*g*).

Balance of convenience looked to.

In a class of case not dissimilar to a threats action it is usual to grant the interlocutory injunction without insisting on the ordinary undertaking as to damages (*h*).

If the threats are of old standing, and the plaintiff has not bestirred himself, though acquainted with the threats, the Court will hardly grant an injunction (*i*).

Damages when awarded.

Damages.—Damages will be awarded only where substantial injury has been sustained.

Thus in *Driffield, &c., Co.* v. *Waterloo, &c., Co.* (*k*), 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 granting of damages was out of the question.

Damages where the threats were made without prejudice.

In *Kurtz* v. *Spence* (*l*), 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

(*e*) *Wilson* v. *Church, &c., Engineering Co.* (1885), 2 R. P. C. 175.

(*f*) *Challender* v. *Royle* (1887), 36 Ch. Div. 435; 4 R. P. C. 363; *Colley* v. *Hart* (1889), 6 R. P. C. 17; cp. *Société Anonyme des Manufactures des Glaces* v. *Tilghman's Patent Sand Blast Co.*, 25 Ch. D. 1; 55 L. J. Ch. 1; *Barney* v. *United Telephone Co.* (1885), 28 Ch. D. 394; 2 R. P. C. 173; where evidence of no infringement was held to be a condition precedent to the grant of an interlocutory injunction; *Walker* v. *Clarke* (1888), 4 R. P. C. 111; 56 L. J. Ch. 239; where this extreme view was dissented from.

(*g*) *Mackie* v. *Soho Laundry Co.* (1892), 9 R. P. C. 465.

(*h*) *Fenner* v. *Wilson* (1893), 2 Ch. 656; 62 L. J. Ch. 984; 10 R. P. C. 283.

(*i*) *Edlin* v. *Pneumatic Tyre Co.* (1893), 10 R. P. C. 311; *Colley* v. *Hart* (1889), 6 R. P. C. 20, 21.

(*k*) (1886) 31 Ch. Div. 638; 55 L. J. Ch. 391; 3 R. P. C. 46.

(*l*) (1887) 5 R. P. C. 177; 57 L. J. Ch. 238.

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.

Damages usually assessed after judgment.

On the other hand, substantial damages may often be recovered. In *Ungar* v. *Sugg* (*m*) the Court of Appeal, being of opinion that a rough guess could be made at the amount of loss, thought that the Judge should have assessed the damages at the trial. But this is not the course usually followed. Thus in *Johnson* v. *Edge* (*n*), Matthew, J., referred the damages to an official referee.

A plaintiff may recover damages if, owing to the threat, a contract is lost (*o*).

III. *The Proviso.*

Although the defendant has threatened, and although the plaintiff has not infringed, nevertheless the defendant may be entitled to judgment, with the attendant costs, if he bring himself within the proviso. This runs as follows: "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." Thus it may happen that a plaintiff who at the time of issue of the writ has a good cause of action, may at the time of the trial cease to have a cause of action at all. See *Combined Weighing, &c., Co.* v. *Automatic Weighing Co.* (*p*); *Colley* v. *Hart* (*q*).

A discontinued or abortive action may bring the threatener within the proviso.

It is not necessary that in order to protect the defendant the action for infringement should have been carried to a successful result. In the former of the cases just mentioned, the threatener failed in his action for infringement; in the latter, he discontinued it as hopeless. Nevertheless, in both, the threatener's position came within the terms of the proviso, and consequently won his threats action.

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 (*r*).

(*m*) (1889) 9 R. P. C. 113.

(*n*) (1892) 2 Ch. 1; 61 L. J. Ch. 262; 9 R. P. C. 142.

(*o*) *Skinner* v. *Shew* (or *Perry*) (1894), 2 Ch. 581; 11 R. P. C. 406; 64 L. J. Ch. 826.

(*p*) (1889) 42 Ch. Div. 665; 58 L. J. Ch. 709; 6 R. P. C. 502.

(*q*) (1890) 44 Ch. Div. 179; 59 L. J. Ch. 308; 7 R. P. C. 101.

(*qq*) On threats subsequent to a discontinuance, see *Fusee Vesta Co.* v. *Bryant and May* (1887), 56 L. T. N. S. 136.

(*r*) *Combined Weighing, &c., Co.* v. *Automatic, &c., Co.* (1889), 42 Ch. Div. 665; 58 L. J. Ch. 709; 6 R. P. C. 502, 507.

To enable the defendant to avail himself of the proviso, the parties to the infringement action must be the threatener himself (not his assignee) as plaintiff (*s*), and as defendant either the plaintiff in the threats action, or some third person against whom the threats complained of were directed; probably no other defendant will suffice to bring the case within the proviso (*t*).

But the infringement action may be within the proviso, whether brought before or after the threats action (*u*), provided it be commenced and prosecuted with due diligence. In determining the question of diligence the date of the utterance of the threats will be considered (*x*).

Action for infringement not brought with *bonâ fides* will not protect.

It is only a *bonâ fide* action for infringement which can have the effect of bringing the threatener within the proviso (*y*); a collusive action, or an action brought after the threats action merely for the purpose of evading the latter, will not avail (*z*). But discontinuance of the infringement action is not *per se* evidence of *mala fides* (*a*).

The *bonâ fides* of the infringement action is thus a question which may be raised. The *bonâ fides* on the part of the threatener is no answer to a threats action brought under this section (*b*).

Due diligence a question of fact.

An infringement action is not an answer to an action for threats, unless the former be commenced and prosecuted "with due diligence." Whether in any given case due diligence has been shown is a question of fact (*c*).

The abandonment of the action is not necessarily proof of want of due diligence; see *English and American Machine Co.* v. *Gare* (*d*), *Colley* v. *Hart* (*e*).

Examples.

The following examples will show what has been considered due diligence, though it has to be borne in mind that the facts of every particular case have to be separately considered:—

(*s*) *Kensington, &c., Electric Light Co.* v. *Lane-Fox Electric Light Co.* (1891), 2 Ch. 573; 8 R. P. C. 277.

(*t*) *Challender* v. *Royle* (1887), 36 Ch. Div. 425, 439, 442; 4 R. P. C. 363; 56 L. J. Ch. 995; *Combined Weighing, &c., Co.* v. *Automatic, &c., Co.*, *ubi infra*.

(*u*) *Barrett* v. *Day* (1889), 43 Ch. Div. 435; 7 R. P. C. 54.

(*x*) *Challender* v. *Royle*, *supra*.

(*y*) *Challender* v. *Royle* (1887), *supra*; *Barrett* v. *Day* (1893), *supra*.

(*z*) *Johnson* v. *Edge* (1892), 2 Ch. 1; 9 R. P. C. p. 142; 61 L. J. Ch. 262.

(*a*) *English and American Machine Co.* v. *Gare Machinery Co.* (1894), 11 R. P. C. 627.

(*b*) *Skinner* v. *Shew* (1893), 1 Ch. 413; 62 L. J. Ch. 196; 10 R. P. C. 1; *Herrburger* v. *Squire* (1888), 5 R. P. C. 581; 6 R. P. C. 194; *Johnson* v. *Edge* (1892), *supra*.

(*c*) *Combined Weighing, &c., Co.* v. *Automatic, &c., Co.* (1889), 42 Ch. Div. 665; 58 L. J. Ch. 709; 6 R. P. C. 502; *Colley* v. *Hart* (1890), 44 Ch. Div. 179; 59 L. J. Ch. 308; 7 R. P. C. 101.

(*d*) (1894) 11 R. P. C. 627.

(*e*) *Ubi supra*.

Challender v. *Royle*(*f*).—March, 1887, threats uttered; June 11, writ at threats action; June 15, action for selling goods made by the plaintiff within threats action in alleged infringement of the threatener. The Court of Appeal held that the threatener had proceeded with due diligence, and had brought himself within the proviso.

Herrburger v. *Squire* (*g*).—October, 1886, threats, the threatener being at the time aware of infringements; September, 1887, threats repeated; November 12, 1887, threats action; November 14, infringement action against third partner; December 23, counterclaim in threats action. Charles, J., considered that the defendant had not shown due diligence.

Combined Weighing and Advertising, &c., Co. v. *Automatic, &c., Co.*(*h*).—September 21, threats; September 27, threats action; September 30, action for infringement. The Court of Appeal considered the latter to have been brought with due diligence.

Colley v. *Hart* (*i*).—September, 1888, threats; September 22, 1888, threats action; December 6, 1888, infringement action; February 8, 1889, statement of claim in the threats action; May 13, statement of claim in the infringement action. The parties in both actions had asked for and had been granted extension of time for pleading. November 6, 1889, an expert reported that the threatener's patent was bad; November 7, 1889, the threatener discontinued his infringement action. Held (by North, J.), that the infringement action had been prosecuted with due diligence and that the proviso applied. A threatener is entitled to keep back his statement of claim in the infringement action, as by so doing he may be able to raise the point by counterclaim in the threats action.

Edlin v. *Pneumatic Tyre Co.* (*k*).—In this case the threats were uttered three years before the infringement action, but under the peculiar circumstances of the case, Chitty, J., said that he could not decide that the defendants had not shown due diligence in bringing their infringement action, and he refused an interlocutory injunction in the threats action.

English and American Machine Co. v. *Gare Machinery Co.* (*l*).—November 9 and November 18, 1893, threats; November 23,

(*f*) (1887) 36 Ch. Div. 425; 4 R. P. C. 363; 56 L. J. Ch. 995.
(*g*) (1888) 5 R. P. C. 581; 6 R. P. C. 194.
(*h*) (1889) 42 Ch. Div. 665; 58 L. J. Ch. 709; 6 R. P. C. 502.
(*i*) (1890) 44 Ch. Div. 179; 59 L. J. Ch. 308; 7 R. P. C. 101.
(*k*) (1893) 10 R. P. C. 311.
(*l*) 11 R. P. C. 627.

threats action; December 4, infringement action; January 24, 1894, statement of claim in the infringement action; March 22, defence in the infringement action; both parties required extension of time, the particulars of objection requiring careful examination. It was decided by Chitty, J., that due diligence had been shown in prosecuting the infringement action, and that the proviso applied.

Forms of pleadings, &c., see *post*, pp. 847 *et seq.*

CHAPTER XV.

REVOCATION OF PATENTS.

Scire facias before Act of 1883.

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 authorised 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 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.

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 (*b*); 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.

R. v. *Butler*.

Magdalen College case.

Legat's case.

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. This was laid down by the Judges in the House of Lords in the case of *R.* v. *Butler* (*c*), and there are several old authorities to the same effect (*d*). In the *Magdalen College case* (*e*), 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* (*f*), it was said, that "When upon false insinuations or pretences the King makes any

(*a*) See a full account of the practice in proceedings by *scire facias* in Hindmarch, pp. 376 *et seq*. The cumbrous nature of the procedure is there demonstrated.

(*b*) *Ante*, pp. 387 *et seq*.

(*c*) 3 Lev. 220, 221.

(*d*) See Staund. Prerog. 34, 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.

(*e*) 11 Co. R. 74, b.

(*f*) 10 Co. R. 109.

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*"(*g*).

Former grounds for *scire facias*.

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"(*h*).

Fraud and false suggestion.

Fraud and false suggestion may be considered together (*i*).

Cases.

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 (*k*).

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 (*l*).

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 (*m*).

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 recital was not made by way of suggestion at all (*n*). 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.

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 (*o*).

(*g*) This and the third previous paragraph are adapted from Hindmarch, pp. 377–79.

(*h*) Webs. Lett. Pat. p. 32.

(*i*) See *R.* v. *Mussary* (1738), 1 Web. P. C. 41, n. 2.

(*k*) *Morgan* v. *Seaward* (1835–37), 2 M. & W. at p. 561.

(*l*) 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.

(*m*) *Lewis* v. *Marling* (1829), 1 Web. P. C. 496; cp. *Morgan* v. *Seaward* (1837), 1 Web. P. C. 197, per Alderson, B.

(*n*) 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* (1829), 5 Bing. 340, cited by Parke, B., in *Morgan* v. *Seaward*, *ubi supra*, at p. 196.

(*o*) *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.

Want of novelty and utility.

A patent was granted for "improvements in fire-grates 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 (*p*).

The *defects* in the proceeding by *scire facias* were in many ways objectionable. (1) It was cumbrous. (2) It was costly (*q*). (3) No interest in the repeal was necessary. (4) 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.

Revocation under Act of 1883.

Proceedings under the Act of 1883.

The proceedings 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 (*r*).

Letters patent for inventions assigned to the Secretary of State for War are not revocable (*s*).

The Court.

The "Court" means the High Court of Justice in England (*t*), the Court of Session in Scotland (*u*), and the High Court of Justice in Ireland (*x*).

Lancaster Palatine Court.

Petitions for revocation could not formerly 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

(*p*) *R.* v. *Cutler*, *ubi supra*.

(*q*) 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.

(*r*) Act of 1883, sect. 26, sub-sects. 1, 2, 3.

(*s*) sect. 44, sub-sect. 9.

(*t*) *Ibid.* sect. 117.

(*u*) *Ibid.* sect. 109.

(*x*) *Ibid.* sect. 111, sub-sect. 1.

purpose expressly set forth in sect. 112 (a) (*y*). But see now the Lancaster Palatine Court Act, 53 & 54 Vict. c. 23, 1890.

Jurisdiction to repeal patent in England where patentee domiciled abroad.

A petition cannot be served on a patentee resident abroad (*z*), but where a petition was presented for the revocation of a patent belonging to a domiciled Scotchman to whom a copy of the petition was personally delivered, and who 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 left open to the patentee, if he appeared, to dispute the jurisdiction (*a*). This course was suggested by North, J., in *Goerz case* (*z*). In *Kay's Patent* (*b*) one of the patentees had not been served, he being abroad. Stirling, J., refused to hear the petition, put it in the witness list, but directed that it should not come on for hearing without leave of the Judge, unless the absent patentee should appear. In a trade-mark case, *Re King & Co.'s Trade Mark* (*c*), the Court heard an application to rectify the register, on proof that a domiciled Irishman had received written notice of the proceedings.

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 (*d*) 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 (*e*).

The fact that the patentee has declared his willingness to abandon his patent and does not defend revocation proceedings, is no ground for refusing to give the petitioner the costs of the proceedings (*f*).

Who may petition.

A petition for revocation may be presented by any of the following persons (*g*):—

(*y*) *Proctor* v. *Sutton Lodge Chemical Co.* (1888), 5 R. P. C. at p. 185.

(*z*) *Re Goerz and Hoegh's Patent* (1895), 12 R. P. C. 370.

(*a*) *Drummond's Patent* (1889), 6 R. P. C. 576; L. R. 43 Ch. D. 80; 59 L. J. Ch. 102.

(*b*) (1894) 11 R. P. C. 279.

(*c*) (1892) 2 Ch. 462; 62 L. J. Ch. 153; 9 R. P. C. 350, and see *La Compagnie D'Eaux Minerales et des Bains de Mer* (1891) 3 Ch. 451; 8 R. P. C. 446; *Re Cliff* (1895) 2 Ch. 21.

(*d*) Either under R. S. C. 1883, Order XXXVI. rule 1; or Order XXX. rule 1.

(*e*) *In re Edmonds' Patent*, W. N. 1888, p. 234; (1889) 6 R. P. C. 355.

(*f*) *Re Wallace's Patent* (1895), 12 R. P. C. 444. See also *Simmons' Patent* (1895), 12 R. P. C. 446; *Rendell's Patent* (1894), 11 R. P. C. 277.

(*g*) Patents Act, 1883, sect. 26, sub-sect. 4. 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. (1883) Sect. 109, sub-sect. 1. It appears, therefore, that a petitioner before the Court of Session for revocation of letters

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

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

(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.

Notwithstanding that the petitioner for revocation has been sued for infringement and unsuccessfully attacked the validity of the patent, he may proceed with the petition. Also if the defendant successfully attacked the validity, the plaintiff may set up validity in subsequent proceedings for revocation started by the defendant. In other words, the matter is not made *res judicata* by the decision in the infringement action; the parties may be the same, but they do not appear in the same capacity; in revocation proceedings the petitioner acts, in form at least, for the public (*h*).

Fiat of Attorney-General, how obtained.

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 authorised 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 able to pay the costs of all proceedings in connection with the petition, if unsuccessful.

patent, is required to have both an interest in the patent which he seeks to repeal and the concurrence of the Lord Advocate.

(*gg*) A paragraph in the petition should recite the authorisation: *Glazbrook* v. *Gillatt* (1840), 9 Bear. 492.

(*h*) *Re Deeley's Patent* (1895), 1 Ch. 687; 64 L. J. Ch. 480; 12 R. P. C. 192; *Shoe Machinery Co.* v. *Cutlan* (1896), 1 Ch. at p. 113; 65 L. J. Ch. 44; 12 R. P. C. at p. 533.

Fiat not issued as of course.

The fiat of the Attorney-General has never been, and is not now, issued as a matter of course.

Although it was laid down in *Butler's case* (*i*) 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*" (*j*), 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 (*k*). In *Reg.* v. *Newall* (*l*), 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. The fiat may be granted even after the petition has come on for hearing, but before judgment (*m*).

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

(*i*) 2 Vent. 344.

(*j*) *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*."

(*k*) 1 Web. P. C. 671, 672.

(*l*) *Ibid.* n. (*i*).

(*m*) *Re Dege's Patent* (1895), 12 R. P. C. 448.

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 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 (*n*).

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 (*o*).

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 (*p*).

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 (*q*).

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. (*r*).

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

(*n*) *Young's Patent*, Pract. Mech. Jour., 2nd series, vol. vi. p. 98. See also vol. vii. p. 44; and Lawson, p. 105.

(*o*) *Bell and Coleman's Patent*, Griffin, P. C. 320.

(*p*) *Siddell's Patent, ibid.* In *Martin's Patent, ibid.*, James, A.-G., after consultation with Herschell, S.-G., held that, where an application for fiat authority had been eventually abandoned, he had no power, under sect. 35, to give costs.

(*q*) *Watling's Patent, ibid.*

(*r*) *Gaulard and Gibbs's Patent, ibid.*

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. (*s*).

Meaning of "in fraud of the rights of another."

A patent will not be held to have been obtained in fraud of the rights of another unless the patentee has been guilty of dishonest and culpable acts in obtaining it (*t*). Cotton, L. J., said, speaking of an allegation against an agent: "To be in fraud of his rights it must be either done with the intention of depriving the principal of his rights, or must be insisted on so as to deprive the principal of his rights" (*u*).

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 it hold for the benefit of A. It was held, affirming 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 (*x*).

The question still remains, said Mr. Justice Stirling in this case (*y*), 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. We have not to deal with a statute 300 years old, like the Statute of Monopolies, nor

(*s*) *Rothwell's Patent, ibid.*

(*t*) *Avery's Patent* (1887), per Stirling, J., 4 R. P. C. at p. 165; and see also Cotton, L. J., 36 Ch. Div. at p. 324.

(*u*) *Ibid.*; and see *Norwood's Patent* (1895), 12 R. P. C. 214.

(*x*) *Avery's Patent* (1887); 36 Ch. Div. 307; 56 L. J. Ch. 1007; 4 R. P. C. 152, 322. For an example of what would be fraud within the meaning of this sub-section, see *Re Norwood's Patent* (1895), 12 R. P. C. 214; *Gates' Patent* (1891), 8 R. P. C. 439; *Edge* v. *Harrison* (1891), 8 R. P. C. 74.

(*y*) *Avery's case*, 36 Ch. Div. at p. 319.

is there any current of decision to fix the sense in which the word therein is used, and in Mr. Justice Stirling's judgment it would be wrong to construe the word, occurring as it does in an Act recently passed, and in the absence 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.

Where a patent is revoked on the ground of fraud, the comptroller may grant the true inventor 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 (*z*). The comptroller is not bound to do this (*a*).

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 (*b*).

True inventor of invention included in claim of patentee.

The case of *Walker* v. *Hydro-carbon Syndicate, Ltd.* (*c*), 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* :—

Judgment of Bacon, V.-C.

"There was a common universal knowledge that petroleum, dangerous in itself, inapplicable in itself, could by means which

(*z*) (1883) sect. 26 (8).

(*a*) *Norwood's Patent* (1895), 12 R. P. C. at p. 219.

(*b*) *Re Avery* (1887), 36 Ch. Div. pp. 310, 311; 56 L. J. Ch. 1007; *Re Haddan's Patent* (1885), 2 R. P. C. 218.

(*c*) (1885) 2 R. P. C. p. 3. An appeal was lodged against the decision in this case, but subsequently abandoned. Preliminary applications—(a) that the appeal 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 R. P. C. 259.

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 petroleum alone 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."

Prior user.

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 (*d*).

Where *locus standi* patent may be impeached on all grounds.

A petitioner qualified to present a petition in the manner pointed out in clauses (c). (d). and (e). above. may impeach the patent on any other ground when he has established his *locus standi* (*e*). He may do so though he has already raised the same issues as defendant in an infringment action. Conversely, a decision against the patent in an infringement action does not prevent the patentee from alleging validity when the patent is attacked in revocation proceedings (*f*).

If. however. the petitioner has no *locus standi*, and 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 (*g*).

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

(*d*) *Haddan's Patent* (1885). 2 R. P. C. 218.

(*e*) *Morgan's Patent* (1887). 5 R. P. C. 186; *Doe's Patent* (1895). 12 R. P. C. 118.

(*f*) *Re Decley's Patent* (1895). 1 Ch. 687; 64 L. J. Ch. 180; 12 R. P. C. 102; *Shoe Machinery Co. v. Cutlan* (1896). 1 Ch. at p. 113; 65 L. J. Ch. 44; 12 R. P. C. 533.

(*g*) *Avery's Patent* (1887). 36 Ch. D. at p. 323. per Cotton, L. J.; 56 L. J. Ch. 1007; 4 R. P. C. 322.

of any objection of which particulars are not so delivered (*h*). Disconformity is still a ground for revocation (*i*).

Certificate as to particulars proved, &c.

In the matter of *Goulard and Gibbs's Patent* (*j*), Mr. Justice Kekewich held (*k*) that he had no power to grant a certificate as to particulars of objections delivered (*l*) 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 (*m*).

Contrary to the rule which prevailed in the action of *scire facias* (*n*) 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 (*o*).

Subject to sect. 26, ordinary practice on petition holds.

Subject to the provisions contained in the Patents Act, 1883, sect. 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 (*p*). The Court has the same power as to costs as in an ordinary action (*q*). But a respondent resident abroad will not on that account be made to give security for costs; he is not in the position of a plaintiff (*r*).

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 (*s*). Respondents who desire it may have a petition for revocation tried on *viva voce* evidence (*t*).

Fraud of opponent's right.

Revocation on the ground of prior user by the petitioner, or a person through whom he claims (*u*), is in form apparently new,

(*h*) Sect. 26, sub-sect. 5. See form of particulars of objection, *infra*, pp. 788—790; and *Haddan's Patent* (1885), 2 R. P. C. 219.

(*i*) *Vickers* v. *Siddell* (1890), 15 App. Ca. 496; 60 L. J. Ch. 105; 7 R. P. C. 292; *Nuttall* v. *Hargreaves* (1892), 1 Ch. 23, 28; 61 L. J. 94; 8 R. P. C. at p. 454.

(*j*) (1888) 5 R. P. C. 526; affirmed (1889) 6 R. P. C. 215.

(*k*) Upon a consideration of sects. 26, 28, sub-sect. 1, and 29, sub-sects. 2, 4, and 6.

(*l*) Under sect. 26, sub-sect. 5.

(*m*) *Ibid.* sub-sect. 6.

(*n*) Hindmarch, p. 412.

(*o*) Sect. 26, sub-sect. 7.

(*p*) *Haddan's Patent* (1884-85), 54 L. J. Ch. 126; Griff. 108.

(*q*) *Re Edmonds's Patent* (1889), 6 R. P. C. at p. 358.

(*r*) *Re Miller's Patent* (1894), 63 L. J. Ch. 324; 11 R. P. C. 55.

(*s*) 1883, sect. 26 (7). If the trial be on affidavit evidence, the defendant should file his evidence before petitioner files his: *Gale's Patent* (1891), 8 R. P. C. 438.

(*t*) *Gaulard and Gibbs's Patent* (1887), per North, J., 34 Ch. D. 396. This is the better method of trial: *Gale's Patent* (1891), 8 R. P. C. 438.

(*u*) Sect. 26, sub-sect. 4, clause (*e*).

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 (*x*).

That a specification does not end with a distinct statement of the invention claimed is not a ground of revocation (*y*).

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 (*z*).

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, sect. 18, whilst a petition for revocation is pending, but under sect. 19 the Court or a Judge may, subject to such terms as to costs and otherwise 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 (*a*).

In *Dudley* v. *Perkes* (*b*) a difficult question arose. The Court of Appeal declared one claim of a patent to be good, but the other bad, and revoked the patent; the patentee appealed to the House of Lords. The House after argument deferred judgment to enable the patentee to apply at the Patent Office for leave to disclaim the obnoxious claim. But the comptroller declined jurisdiction, basing his decision on the ground that by the judgment of the Court of Appeal the patent was revoked, that there was nothing to amend. It was stated by the Lord Chancellor that the Court of Appeal should have ordered that the patent be revoked unless within a time fixed by the Court the patentee should obtain leave to disclaim the bad claim.

(*x*) P. R. 1890, rule 74.

(*y*) *Vickers* v. *Siddell* (1888), 15 App. Ca. 496; 60 L. J. Ch. 105; 7 R. P. C. 292.

(*z*) Sect. 26, sub-sect. 8.

(*a*) See *ante*, p. 233.

(*b*) (1896) App. Ca. 496; 13 R. P. C. 581. And see *Re Dellwik's Patent* (1896), 2 Ch. 705; 13 R. P. C. 591; 65 L. J. Ch. 905.

CHAPTER XVI.

PROLONGATION OR EXTENSION OF PATENTS (*a*).

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 cases mentioned in note (*b*) illustrate the kind of circumstances under which a statutory prolongation of a patent could be obtained (*b*).

Lord Brougham's Act.

The frequency of 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

(*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*) 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).

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 into use without a new grant. It was, therefore, renewed for fourteen years from 1st August, 1750 (23 Geo. II. c. 33, 1749). See also *Cookworthy's case* (1738) (materials for porcelain) (15 Geo. III. c. 52); *Liardet's case* (1773) (16 Geo. III. c. 29).

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 the King's ships of war without licence from the patentee (17 Geo. III. c. 6, 1777).

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

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—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 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 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 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."

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. The privilege was not to be assigned to more than five persons (32 Geo. III. c. 72, 1792).

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

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* (*c*), 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 (*d*), 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 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 (*e*).

2 & 3 Vict. c. 67.

The statute 2 & 3 Vict. c. 67, s. 2—under which Bodmer's Patent was subsequently extended (*f*)—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

(*c*) 15 Lond. Jour. Arts.
(*d*) J. C. Rules, rule 2, *infra*, p. 718.
(*e*) Web. Letts. Pat. p. 58, n. (*s*); also 1 Web. P. C. 740.
(*f*) For a term of seven years. The new patent bore date 18th July, 1849. 1 Web. P. C. 740.

or default of the petitioner. The same section also provided that no extension would be granted upon petitions presented after the 30th November, 1889, "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 (*g*), and the petition for extension must be presented at least six months before the expiration of the original term (*h*).

Act of 1883.

The Act of 1883, s. 25, leaves the law and procedure relating to prolongation practically unaltered (*i*). As 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 at present suspended, or at any rate so far suspended as rights or privileges accrued prior to 1st January, 1884, are concerned, notwithstanding the repeal of the statutes regulating the law and practice of prolongation at the time when the Act of 1883 was passed (*k*). This was the opinion of the Judicial Committee in *Brandon's Patent* (*l*).

In *Brandon's Patent* (*l*), 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 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 sect. 113 of the statute of 1883. The provisions of sub-sect. (a) of that section must be read distributively, and so read they declare that

(*g*) Sub-sect. 5.
(*h*) Sub-sect. 1.
(*i*) A different term is used in this Act—viz., *extension*, instead of *prolongation*.
(*k*) See schedule to that Act.
(*l*) (1884) 9 App. Ca. 589; 53 L. J. P. C. 84; 1 R. P. C. 154.

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." See also *Jablochkoff's Patent* (*m*), *Marshall's Patent* (*n*), and *Semet and Solray's Patent* (*o*).

No new rules relating to petitions for prolongation have been made by the Privy Council, and it is understood that it is not yet 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

(*m*) (1891) App. Ca. 293; 8 R. P. C. 281; 60 L. J. P. C. 61.
(*n*) (1891) App. Ca. 430.
(*o*) (1895) App. Ca. 78; 64 L. J. P. C. 41; 12 R. P. C. 10.

said Act, shall, *in the advertisements* (*p*) 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 (*q*) must be entered." The time may be extended, but no extension will be granted if the intending opponent's sole excuse for not entering his caveat in time is that he did not see the petitioner's advertisement (*r*). Caveats.

Where the patentee resides abroad, and the invention is carried on under licences, the advertisements should be inserted in papers circulating in places where the manufacture is actually carried on (*s*). "The statute," said Lord Brougham (*s*), "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" (*s*).

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 (*t*). "If the statute requires anything to be done which is not done, the Crown has no power to grant a prolongation" (*u*).

The Petition.—The next (*x*) step is the presentation of a petition (*y*) 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. The petition.

As we have already pointed out, in *Brandon's Patent* (*z*), it appears that the petition need not be presented six months before Time when to be presented.

(*p*) 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. 853.

(*q*) For form of caveat, see Appendix, p. 854. All persons entering a caveat, or *caveators*, are entitled to be served with the petition, and to appear at the hearing.

(*r*) *Hopkinson's Patent* (1896), 13 R. P. C. 114.

(*s*) *Derosne's Patent* (1844), 2 Web. P. C. 2.

(*t*) *In re Noble's Patent* (1850), 7 Moo. P. C. 191.

(*u*) Per Lord Brougham, *ibid.* p. 194

(*x*) See sect. 25, sub-sect. 1, *infra*, p. 598.

(*y*) See Forms, Appendix, pp. 856–8.

(*z*) (1884) 1 R. P. C. p. 154; 9 App. Ca. 589.

the expiration of the patent. The old rule prevails, and provided a petition be "*prosecuted with effect*" (*a*) before the expiration of the term, a petition can be presented at any time, if there be time to proceed with it, before the expiration of the patent (*b*). 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 (*c*).

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 (*d*).

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* (*e*) fatal to the application (*f*). Forms of petition are given in the Appendix (*g*).

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

(*a*) 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.

(*b*) *Marshall's Patent* (1891), App. Ca. 430.

(*c*) 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.

(*d*) See *Macintosh's Patent*, 1 Web. P. C. 739.

(*e*) 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.

(*f*) *In re Pitman's Patent* (1871), *ubi supra*; *In re Johnson's Patent* (1871), L. R. 4 P. C. 75; cp. also *In re Clark's Patent* (1870), L. R. 3 P. C. 421; 7 Moo. P. C. N. S. 255; *In re Horsey's Patent* (1884), 1 R. P. C. 225.

(*g*) At pp. 856, 858.

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 (*h*).

A petition was presented nominally by one company, but really was for the benefit of another company, to which the shares of [illegible]rmer had been transfer[illegible]d. [illegible]tement of the fact appe[illegible]d in the petition, and the real facts were only brought forward by the Attorney-General. Petition dismissed (*i*).

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 (*k*).

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 [illegible]mation in the accounts that any other manufacture excepting that of the patented article was so carried on. Extension refused (*l*).

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. [illegible] importer, however, being less

(*h*) *In re Pitman's Patent* (1881), *ubi supra*. "It is desirable that those who 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 App. Ca. 176; 50 L. J. P. C. 68. The remuneration which a patentee has obtained from foreign patents, as well as from his English patent, should be stated.

(*i*) *Reece's Patent*, Eng. Rep. January to March, 1881, XIV.

(*k*) *Re Horsey's Patent* (1884), 1 R. P. C. 225.

(*l*) *In re Yates and Kellett's Patent* (1887), L. R. 12 App. Ca. 147; 4 R. P. C. 150.

than that of an inventor (*m*), the Judicial Committee regards such applications with jealousy, and will carefully consider the merit of the invention imported (*n*).

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 (*o*).

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" (*p*).

Executor, &c.

2. The *executor* (*q*) or *administrator* (*r*) 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.

(*m*) *Soames' Patent* (1843), 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.

(*n*) *Claridge's Patent* (1851), 7 Moo. P. C. 394; cp. *Bell's Patent* (1846), 2 Web. P. C. 159.

(*o*) *In re Berry's Patent* (1850), 7 Moo. P. C. 187.

(*p*) *Claridge's Patent* (1851), 7 Moo. P. C. 394.

(*q*) Cp. *In re Bodmer's Patent* (1849), 6 Moo. P. C. 469.

(*r*) *In re Downton's Patent* (1839), 1 Web. P. C. 565; *In re Heath's Patent* (1853), 2 Web. P. C. 247.

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 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 (*s*).

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 (*t*).

The following extract from the judgment of Lord Romilly, M. R., in *Norton's Patent* (*u*), 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* (*x*): "Their Lordships have always been used to consider that by taking into their view and favourably listening to the application of the assignee,

(*s*) *In the matter of Willacy's Patent* (1888), 5 R. P. C. 690.

(*t*) *Russell* v. *Ledsam* (1845), 14 M. & W. 574; 12 L. J. Ex. 439; judgment affirmed in Exch. Ch. 16 M. & W. 633; 14 L. J. Ex. 353; and in H. of L. 1 H. L. Cas. 687.

(*u*) (1863) 1 Moo. P. C. N. S. 339; 11 W. R. 720.

(*x*) (1843) 1 Web. P. C. 737.

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."

In *Bower-Barff Patent* (*y*), it was stated that no extension should be made to an assignee unless the inventor would directly or indirectly obtain an advantage from it, and the circumstances are such that, if the application were made by the inventor himself, it would be granted.

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 (*z*).

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 (*a*).

Petitioners were a company who bought a patent and made a considerable sum of money by selling their shares at a premium

(*y*) (1895) App. Ca. 675; 12 R. P. C. 383. The position of an assignee was discussed in a later case, *Re Hopkinson's Patent* (1896), 14 R. P. C. 5.

(*z*) *Houghton's Patent* (1871), L. R. 3 P. C. 461.

(*a*) *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."

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 (*b*).

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 (*c*).

An assignee petitioning for the extension of the term of a patent was required to secure to the inventor an annuity (*d*), or a share of the profits (*e*).

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 (*f*).

If there be a mortgagee of the patent sought to be prolonged, he should be a party to the application (*g*).

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 (*h*). 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 (*i*). 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 (*j*). The petition may be presented pending an appeal from the decision of a Court declaring the patent invalid (*k*).

By the Rules the petition must be presented within one week

(*b*) *Sillar's Patent* (1882), Goodeve, P. C. 581; cp. also *Electric Telegraph Co.*, per Lord Langdale, M. R., cited in Goodeve, P. C. 554.

(*c*) *Norton's Patent* (1863), 1 Moo. P. C. N. S. 339.

(*d*) *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; 14 L. J. Ex. 353.

(*e*) *Hardy's Patent* (1849), 6 Moo. P. C. 441; *Morton's Patent*, Eng. Rep. April to June, 1881, VII.

(*f*) *Bodmer's Patent* (1849), 6 Moo. P. C. 468; *Napier's Patent* (1861), 13 Moo. P. C. 543.

(*g*) *Church's Patent* (1887), 3 R. P. C. at p. 100.

(*h*) Patents Act, 1883, sect. 25, subsect. 1.

(*i*) *Brandon's Patent* (1884), 9 App. Ca. 589; 53 L. J. P. C. 84; 1 R. P. C. 154. Subject to sect. 25 of the Act of 1852; see *Jablochkoff's Patent* (1891), A. C. 293; 60 L. J. P. C. 61; 8 R. P. C. 281.

(*j*) See *Marshall's Patent* (1891), App. Ca. 430.

(*k*) *Lane-Fox's Patent* (1892), 9 R. P. C. 411.

from the insertion of the last of the advertisements required to be published in the *London Gazette* (*l*).

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 (*m*).

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 (*n*), any person may enter at the Council Office a cavoat (*o*) addressed to the Registrar of the Council, against the extension prayed for in the petition (*p*).

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 (*q*), or the amendment of specifications (*r*).

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 oppose the extension of an English patent which would interfere with that in which he was interested (*s*).

Grounds of objections.

The caveat must be entered in the name of the opponent himself, and not in that of a patent agent (*t*). 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 (*u*).

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 (*x*). The present Act

(*l*) J. C. Rules, rule 3, *infra*.
(*m*) J. C. Rules, rule 4.
(*n*) J. C. Rules, rule 2.
(*o*) See Form, Appendix, p. 854.
(*p*) Patents Act, 1883, sect. 25, sub-sect. 2.
(*q*) *Ibid.*, sect. 11, sub-sects. 1 and 3.
(*r*) *Ibid.*, sect. 18, sub-sects. 2 and 4.
(*s*) *In re Schlumberger's Patent* (1853), 9 Moo. P. C. 1.
(*t*) *Lowe's Patent* (1852), 8 Moo. P. C. 1.
(*u*) J. C. Rules, rules 5 and 6. For forms of objections, see Appendix, p. 864.
(*x*) *Ball's Patent* (1879), L. R. 4 App. Cas. 171; 48 L. J. P. C. 24.

contains no provision altering this practice, and in a recent case (*y*) 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 (*z*).

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 (*a*); 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 (*b*).

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 (*c*).

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 (*d*).

In *Re Bell's Patent* (*e*), 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 (*f*).

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

(*y*) *Stewart's Patent* (1886), 3 R. P. C. 7.

(*z*) *Ball's Patent*, *ubi supra*; *Stewart's Patent* (1886), 3 R. P. C. 7; *Church's Patent* (1886), 3 R. P. C. 101.

(*a*) J. C. Rules, rule 2. But the time may be extended.

(*b*) Lawson, p. 444.

(*c*) It has of recent years been customary to lodge eight copies of the balance-sheets.

(*d*) J. C. Rules, rule 9.

(*e*) (1846) 2 Web. P. C. 159.

(*f*) *Chatwood's Patent* (1873), L. R. 5 P. C. 88, n.; and *Johnson and Atkinson's Patent* (1873), L. R. 5 P. C. 87.

section was not repealed by the Patents Act, 1883. Under sect. 28 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* (*g*)—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 (*h*).

In *Pettit Smith's Patent* (*h*), 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 (*i*).

Subject to two qualifications—viz., that the advertisements must be proved first in the case (*k*), and that when the accounts are *primâ facie* unsatisfactory, the petition will be dealt with without reference to the merits (*l*), the Judicial Committee follows as closely as possible the rules of evidence in courts of law (*m*).

Grounds of extension.

The Grounds of Extension.—Speaking generally, the applicant must prove two things: that the invention has unusual merit, and that he has been insufficiently remunerated for his work (*n*). 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*

(*g*) (1835) 1 Web. P. C. 557, n. (*a*); and see *Whitehouse's Patent* (1838), *ibid.* p. 474.

(*h*) *Pettit Smith's Patent* (1850), 7 Moo. P. C. 133.

(*i*) *In re Woodcroft's Patent* (1841), 3 Moo. P. C. 172, n.

(*k*) *Perkin's Patent* (1845), 2 Web. P. C. 6.

(*l*) *Saxby's Patent* (1870), L. R. 3 P. C. 292; 7 Moo. P. C. N. S. 82; *In re Clark's Patent* (1870), *ibid.* 421; *ibid.* 255.

(*m*) *Erard's Patent* (1835), 1 Web. P. C. 557, n. (*a*).

(*n*) *Livet's Patent* (1892), 9 R. P. C. 327.

degree, and that they are invested with somewhat similar powers of discretion to those exercised formerly by Parliament (*o*).

The extension of letters patent has never been granted as a matter of course (*p*).

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 (*q*).

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 (*r*). 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 (*s*).

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* (*t*).

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 Act (*u*).

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 (*x*).

Invention meritorious.

(a) It is, of course, impossible to define strictly the degree of merit which will induce the Judicial Committee to extend the

(*o*) *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.

(*p*) *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. 378; *Cardwell's Patent* (1856), 10 Moo. P. C. 488.

(*q*) 1 Web. P. C. 557, n. (*a*).

(*r*) *In re Morgan's Patent, ubi supra.*

(*s*) *In re Soames' Patent, ubi supra.*

(*t*) Patents Act, 1883, sect. 25, sub-sect. (4).

(*u*) *Newton's Patent* (1884), L. R. 9 App. Cas. 592; 1 R. P. C. 177.

(*x*) *Markwick's Patent* (1860), 13 Moo. P. C. 310.

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 (*y*).

"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* (*y*); "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 (*z*).

On the other hand, the Judicial Committee would probably refuse an extension of letters patent for a comparatively worthless or trivial invention, however ingenious (*a*). It has already been shown (*b*) that the importer of a highly meritorious invention may petition successfully for the prolongation of letters patent which he 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,

(*y*) *Stoney's Patent* (1888), 5 R. P. C. at p. 521, per Sir William Grove; *Swaine's Patent* (1837), 1 Web. P. C. 559.

(*z*) *Derosne's Patent* (1844), 4 Moo. P. C. 416; *Beanland's Patent* (1887), 4 R. P. C. at p. 491, per Lord Hobhouse.

(*a*) *Beanland's Patent*, *ubi supra*.

(*b*) See *supra*, p. 503.

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 (*c*).

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 (*d*).

That such improvements on the original invention had been made *by the patentee* (*e*) 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 (*f*).

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 (*g*).

That the working of the invention under the original patent has been altered during the term (*h*).

Circumstances which do.

The following circumstances weigh against the merit of an invention :—

That it has not been brought into public use (*i*). 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 ; but non-user is not necessarily fatal ; it may be explained (*k*).

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

(*c*) *In re Bett's Patent* (1862), 7 L. T. N. S. 577 ; 1 Moo. P. C. 49, 61 ; cp. *Woodcroft's Patent* (1846), per Lord Brougham, 2 Web. P. C. at p. 23.

(*d*) *Soames' Patent* (1843), 1 Web. P. C. 735.

(*e*) *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.

(*f*) *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.

(*g*) *Borill's Patent* (1863), 1 Moo. P. C. N. S. 348.

(*h*) *Heath's Patent* (1853), 2 Web. P. C. 247.

(*i*) *Allan's Patent* (1867), L. R. 1 P. C. 507 ; *Normand's Patent* (1870), L. R. 3 P. C. 193.

(*k*) *Southby's Patent* (1891), App. Ca. 432 ; 8 R. P. C. 433.

Sillar's Patent (*l*) 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 (*m*).

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 (*n*). 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 (*o*).

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 (*p*).

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 becoming flat-chested was to be attributed to the one in ordinary use. Some hundreds had been expended on it by

(*l*) (1882) Goodeve's Patents, 581; cp. *McDougall's Patent* (1867), L. R. 2 P. C. 1; 5 Moo. P. C. N. S. 1; *McInnes's Patent* (1868), L. R. 2 P. C. 54; 37 L. J. P. C. 23; 5 Moo. P. C. N. S. 78.

(*m*) *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), *ibid.* 486; *Pieper's Patent* (1895), 12 R. P. C. 292; *Dolbear's Patent* (1896), 13 R. P. C. 203.

(*n*) *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), *ibid.* 300; L. R. 1 P. C. 399; *Hughes's Patent* (1879), 4 App. Ca. 174; 38 L. J. P. C. 20.

(*o*) *Ibid.*; 48 L. J. P. C. 20; *Southby's Patent* (1891), App. Ca. 432; 8 R. P. C. 433.

(*p*) *Jones's Patent* (1840), 1 Web. P. C. 577.

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 (*q*).

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 (*r*).

That, from circumstances beyond the control of the patentee, the merits of the patent had not been appreciated (*s*).

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 (*t*).

(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 (*u*).

(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 (*x*).

(*q*) *Berrington's Patent* (1852), cited by Coryton, p. 225.

(*r*) *Stoney's Patent* (1888), 5 R. P. C. 520.

(*s*) *Kollman's Patent* (1839), 1 Web. P. C. 564.

(*t*) *Payne's Patent* (1854), cited in Higgins's Digest, p. 111.

(*u*) *Bakewell's Patent* (1862), 13 Moo. P. C. 385.

(*x*) *Roper's Patent* (1887), 4 R. P. C. 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 (*y*).

(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 (*z*). 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 (*a*). Negligence on the part of a patentee in restraining infringement is a good ground of opposition for extension (*b*).

That he has at all times been ready to give the public the benefit of his invention (*c*).

That the circumstances have ceased which prevented the patent from being lucrative, and that it is really coming into use (*d*).

Remuneration insufficient (*e*).

(*e*) 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 has properly expended in working it (*f*). In one case it was pointed out that patentees who had received over 200,000*l*. could hardly expect prolongation; hitherto prolongation has not been allowed in any case where the patentee has obtained 20,000*l*. from his invention (*g*), but there is no binding rule.

The chief difficulty which the petitioner has to overcome is to present accounts showing, in a manner which admits of

(*y*) *Robert's Patent* (1839), 1 Web. P. C. 573; cp. *Stafford's Patent* (1838), *ibid.* 563.

(*z*) *Pettit Smith's Patent* (1850), 7 Moo. P. C. 133; *Heath's Patent* (1853), 2 Web. P. C. 217.

(*a*) *Patterson's Patent* (1849), 6 Moo. P. C. 469.

(*b*) *Simister's Patent* (1841), 1 Web. P. C. 724.

(*c*) *Stewart's Patent* (1886), 3 R. P. C. 7, 10.

(*d*) 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.

(*e*) Forms of account in a recent case, which were considered satisfactory by the Judicial Committee, are given in the Appendix, p. 861.

(*f*) *Bate's Patent* (1836), 1 Web. P. C. 739; *Southworth's Patent* (1837), *ibid.* 486; *Downton's Patent* (1839), *ibid.* 565; *Derosne's Patent* (1844), 2 Web. P. C. 1; *Nussey and Leachman's Patent* (1890), 7 R. P. C. 22; *Lake's Patent* (1891), App. Ca. 240; 8 R. P. C. 230; 60 L. J. P. C. 57.

(*g*) *Thomas's Patent* (1892), 9 R. P. C. 367.

no controversy, the amount of remuneration which in every point of view the invention has brought to him (*h*).

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 (*h*). In one or two cases (*i*) 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 (*k*). And in one case where the accounts were imperfect, but a dead loss had clearly been incurred, prolongation was granted (*l*).

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 (*m*).

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 (*n*).

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 (*o*). The actual expenses and receipts must be shown. It is not sufficient to show generally that there

(*h*) *Saxby's Patent* (1870), per Lord Cairns, 7 Moo. P. C. N. S. at p. 85; L. R. 3 P. C. 292. *Re Williams and Robinson's Patent* (1896), 13 R. P. C. 550. 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.

(*i*) *Ibid.* at p. 17; *Heath's Patent* (1853), *ibid.* at p. 256.

(*k*) *Clark's Patent* (1870), 7 Moo. P. C. N. S. 255; L. R. 3 P. C. 421.

(*l*) *Darby's Patent* (1891), 8 R. P. C. 380.

(*m*) *Newton's Patent* (1884), 1 R. P. C. 177; 9 App. Ca. 592.

(*n*) *Clark's Patent, ubi supra; Houghton's Patent* (1871), 7 Moo. P. C. N. S. at p. 311, per James, L. J.; L. R. 3 P. C. 461. 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; L. R. 4 P. C. 89; *Johnson's and Atkinson's Patents* (1873), L. R. 5 P. C. 87; *Willacy's Patent* (1888), 5 R. P. C. 690.

(*o*) *Hill's Patent* (1863), 9 L. T. N. S. 101; 1 Moo. P. C. N. S. 258; cp. *Bett's Patent* (1861), *ibid.* 49.

has been no profit (*p*), nor will it be safe to lump items together (*q*).

The applicant must show what profits have been derived from any foreign patents he may have for the invention (*r*), and also from sales for exportation (*s*).

Licensees.

The profits derived by licensees from the working of the patent should sometimes also appear in the accounts of a petitioner for prolongation (*t*). Whether they should or not will depend on the particular circumstances of the case (*u*).

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 (*x*). This rule was not, however, insisted upon in the case of a patent of great merit and usefulness (*y*).

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 (*z*).

In the matter of *Willacy's Patent* (*a*) 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* (*b*) the grantees of a patent

(*p*) *Quarrill's Patent* (1840), 1 Web. P. C. 740.

(*q*) *Thomas's Patent* (1892), 9 R. P. C. 367.

(*r*) *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; L. R. 1 P. C. 514; *Adair's Patent* (1881), L. R. 6 A. C. 178; *Newton's Patent* (1884), 1 R. P. C. 177; 9 A. C. 592; *Pieper's Patent* (1895), 12 R. P. C. 293.

(*s*) *Hardy's Patent* (1849), 6 Moo. P. C. 441.

(*t*) *Trotman's Patent* (1866), L. R. 1 P. C. 118; 3 Moo. P. C. N. S. 488.

(*u*) *Thomas's Patent* (1892), 9 R. P. C. 367.

(*x*) *Deacon's Patent* (1887), 4 R. P. C. 119; *Lawrence's Patent* (1892), 9 R. P. C. 85.

(*y*) *Ibid.*

(*z*) *Adair's Patent* (1881), L. R. 6 App. Ca. 176; 50 L. J. P. C. 68; *Lake's Patent* (1891), App. Ca. 240; 8 R. P. C. 230; *Bett's Patent* (1861–62), 1 Moo. P. C. N. S. 49, per Lord Chelmsford.

(*a*) (1888) 5 R. P. C. at p. 695.

(*b*) (1887) L. R. 12 App. Ca. 147; 57 L. J. P. C. 1; 4 R. P. C. 150; cp. *Duncan and Wilson's Patent* (1884), 1 R. P. C. 257.

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 destroys his books, destroy the very case on which he must rely for a renewal of the patent." In the absence of books, things are viewed in a light most unfavourable to the patentee (*c*).

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 (*d*). 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 (*e*). An allowance may be claimed by a patentee, who is also a manufacturer, for his personal superintendence of the working of his invention (*f*).

But where the petitioner did not manufacture the patented articles, but only granted licences, a charge for his personal

(*c*) *Lawrence's Patent* (1892), 9 R. P. C. 85.

(*d*) *Carr's Patent* (1873), L. R. 4 P. C. 539; cp. *Bate's Patent* (1836), 1 Web. P. C. 739; *Roberts's Patent* (1839), *ibid.* 575; *Galloway's Patent* (1843), *ibid.* 724; *Newton's Patent* (1861), 14 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; 36 L. J. P. C. 76; 4 Moo. P. C. N. S. 452.

(*e*) *Furness's Patent* (1885), 2 R. P. C. at p. 177.

(*f*) *Roberts's Patent*, *ubi supra*; *Perkins's Patent* (1845), 2 Web. P. C. 6, 17.

allowance and subsistence money while visiting and overlooking the works of the licensees was disallowed (*g*). "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 (*h*).

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 (*i*).

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 (*k*).

A deduction may be allowed for profits made by the patentee as manufacturer, but not due to his monopoly (*l*).

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" (*m*).

"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

(*g*) *Trotman's Patent* (1866), L. R. 1 P. C. 118.

(*h*) *Bate's Patent, ubi supra; Roberts's Patent, ubi supra; Kay's Patent* (1839), 1 Web. P. C. 568; *Galloway's Patent, ubi supra; Bett's Patent* (1861), 1 Moo. P. C. N. S. 49; *Davies's Patent* (1894), 11 R. P. C. 28.

(*i*) *Hill's Patent* (1863), 1 Moo. P. C. N. S. 258.

(*k*) *Wield's Patent* (1871), L. R. 4 P. C. 89; 8 Moo. P. C. N. S. 300.

(*l*) *Galloway's Patent* (1843), 1 Web. P. C. 724; *Bett's Patent* (1862), 1 Web. P. C. N. S. 49.

(*m*) *Hill's Patent* (1863), 1 Moo. P.C. N. S. 258, per Lord Chelmsford.

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" (*n*).

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 (*o*).

Where, however, the profits made by the patentee as manufacturer are not the profits of the monopoly, but simply the profits 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 (*p*).

The test above stated will be applied to profits arising from the manufacture of the materials out of which the patented articles are made (*q*), and from the sale of the patented articles (*r*).

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 (*s*).

The practice where patentee has allowed foreign patents for the same invention to lapse.

The Committee will always have regard to the interests of the public. Therefore when the patentee has foreign patents for the same inventions, which he has allowed to lapse, the Committee will take into consideration the fact that British subjects may be unduly handicapped if prolongation is granted (*t*). Under the Act of 1852 a patent for an invention obtained after the date of a foreign patent would not have continued in force when the foreign patent expired (*u*). This Act is repealed. Therefore if application be made to prolong a patent, and at least six months remain before the original patent expires, the application may be under sect. 25 of the Act of 1883, and therefore in such case the Act of 1852 will not hamper the discretion of the Privy Council in granting or refusing an extension. But if the application be

(*n*) *Saxby's Patent* (1870), per Lord Cairns, L. R. 3 P. C. 292.

(*o*) *Muntz's Patent* (1846), 2 Web. P. C. 113.

(*p*) *Galloway's Patent* (1843), 1 Web. P. C. 724.

(*q*) *Newton's Patent* (1881), Eng. Rep. Jan. to Mar., 1881, xvi.; Lawson, p. 90.

(*r*) *Bailey's Patent* (1884), 1 R. P. C. 1.

(*s*) *Ibid.*

(*t*) *Semet and Solvay's Patent* (1895), App. Ca. 78; 64 L. J. Ch. 41; 12 R. P. C. 10.

(*u*) *Pieper's Patent* (1895), *ibid.* 293; 1852, sect. 25.

made within six months of the termination of the original fourteen years, then the right to prolongation exists only where the patent was granted before 1884 and is preserved by sect. 113; and if this section be prayed in aid, the Act of 1852 applies, and sect. 25 of that Act will prevent a prolongation where a foreign patent has lapsed which was granted for the invention prior to the English grant (*x*).

Where the English patent was prior in date to the foreign one, the Committee may exercise the ordinary discretionary powers (*y*).

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 it will of course abstain in any case from prolonging a patent which is manifestly bad; it is for the petitioner to make out a case of *primâ facie* validity (*z*).

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 (*a*).

S., being the patentee of an invention for "improvements in sugarcane 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 anticipations by machines made by W., and by the publication in England of the American specification of H. Extension refused (*b*).

A petition for prolongation stated that various legal proceedings

(*x*) *Jablochkoff's Patent* (1891), App. Ca. 293; 8 R. P. C. 281; 60 L. J. P. C. 61.

(*y*) *Semet and Solvay's Patent* (1895), App. Ca. 78; 64 L. J. P. C. 41; 12 R. P. C. 10; *Livet's Patent* (1892), 9 R. P. C. 327; *Marshall's Patent* (1891), App. Ca. 430.

(*z*) Per Lord Cairns in *Saxby's Patent* (1870), L. R. 3 P. C. 294; cp. *Erard's Patent* (1835), 1 Web. P. C. 557, n. (*a*); *Hill's Patent* (1863), 1 Moo. P. C. N. S. 258; *Stoney's Patent* (1888), 5 R. P. C. at p. 522; *Kay's Patent* (1839), 1 Web. P. C. 568; *Galloway's Patent* (1843), *ibid.* 725; *Woodcroft's Patent* (1846), 2 Web. P. C. 18; *Pinkus's Patent* (1848), 12 Jur. 234; *Bett's Patent* (1862), 1 Moo. P. C. N. S. 49; *McDougal's Patent* (1867), 5 Moo. P. C. N. S. 1; L. R. 2 P. C. 1; *McInnes's Patent* (1868), *ibid.* 72; L. R. 2 P. C. 54.

(*a*) *Cocking's Patent* (1885), 2 R. P. C. 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 R. P. C. 95.

(*b*) *Stewart's Patent* (1886), ibid. 7.

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 (*c*).

Period of extension: generally seven years, but ten or even fourteen years under special circumstances.

The Judicial Committee does not usually recommend extensions for periods of more than seven years, the usual practice being to extend the period either for five or seven years. But in exceptional cases the seven years' limit has been exceeded, and ten or even fourteen years' extension has been granted. *Moncrieff's Patent* for gun-carriages was extended fourteen years, and *Stoney's Patent* (*d*) 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 (*e*).

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 (*f*).

It is now (*g*) the practice of the Judicial Committee to prolong letters patent by ordering a new grant to be made for the extended term (*h*).

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 (*i*).

(*c*) *Kay's Patent* (1839), 1 Web. P. C. 568; cp. *Heath's Patent* (1853), 2 Web. P. C. 247.

(*d*) (1888) 5 R. P. C. 518.

(*e*) *Goucher's Patent* (1865), 2 Moo. P. C. N. S. 532.

(*f*) Patents Act, 1883, sect. 25, subsect. 5.

(*g*) As to extension of a patent for an invention patented abroad, see *Bodmer's Patent* (1853), 8 Moo. P. C. 282; *Aube's Patent* (1854), 9 Moo. P. C. 43; *Bett's Patent* (1861), 1 Moo. P. C. N. S. 49.

(*h*) *Cocking's Patent* (1885), 2 R. P. C. at p. 152; *Stoney's Patent* (1888), 5 R. P. C. at p. 524. For the form of new grant in *Stoney's Patent* see Appendix, p. 866.

(*i*) *Russell* v. *Ledsam* (1845), 14 M. & W. 574, decided under 5 & 6 Will. IV. c. 83, s. 4.

As a matter of fact, the new letters patent are ordered to be sealed by the comptroller-general with the date of expiration of the original patent. The order in Council (*k*) 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 (*l*). It appears that no renewal fees are payable.

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 (*m*).

In the case of *Bovill* v. *Finch* (*n*) 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 (*o*).

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 (*p*).

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 (*q*).

(*k*) Appendix, p. 865.

(*l*) *Wasteney Smith's Patent* (1885), 2 R. P. C. 14.

(*m*) *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), *ibid.* 189.

(*n*) (1870) L. R. 5 C. P. 523; L. J. C. P. 277.

(*o*) See also *In re Bovill's Patent* (1863), 1 Moo. P. C. N. S. 348.

(*p*) *Ledsam* v. *Russell*, 1 H. L. Ca. 687.

(*q*) *Lee's Patent* (1856), 10 Moo. P.C. 226; cp. *Bodmer's Patent* (1853), 8 Moo.

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 (*r*);

(b) Valuable consideration had been given for the assignment, and the assignee had sustained considerable loss. Prolongation was granted unconditionally (*s*).

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 (*t*).

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, licences 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 licences as was provided by the deed of dissolution; but refused to allow J. to substitute new licences for those granted under the original letters patent in the event of the original licensees declining to renew their licences from him under the new grant (*u*).

Prices.

Disclaimer.

A successful petitioner for prolongation has been required (a) to grant licences to the public upon terms similar to one already granted by him (*x*); (b) to sell the patented article at a certain fixed price (*y*); (c) to disclaim all the parts of the original

P. C. 282; *Church's Patent* (1886), 3 R. P. C. at p. 102; Joy's Patent (1893), 10 R. P. C. 89. See also *Metford's Patent* (1879). 48 Engineer, 15.

(*r*) *Whitehouse's Patent* (1838), 1 Web. P. C. at p. 476; *Russell* v. *Ledsam* (1845–48). 14 M. & W. 574; *Hardy's 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: L. R. 1 P. C. 399; *Pitman's Patent* (1871), L. R. 4 P. C. 87; *Morton's Patent* (1881), Eng. Rep. April to June, 1881, vii.

(*s*) *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.

(*t*) *Schlumberger's Patent* (1853), 9 Moo. P. C. 1.

(*u*) *Normandy's Patent* (1855), *ibid.* 452.

(*x*) *Mallet's Patent* (1866), L. R. 1 P. C. 308; 4 Moo. P. C. N. S. 175; *Lyon's Patent* (1894), 11 R. P. C. 537.

(*y*) *Hardy's Patent* (1849), 6 Moo. P. C. 441.

patent not worked out (*z*); (d) to procure the surrender of an exclusive licence (*a*); (e) to undertake to give security over the prolonged patent to his mortgagee (*b*).

In *Dixon* v. *London Small Arms Co.* (*c*) 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, where the invention was likely to be of use in the Government service (*d*).

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 (*e*).

Costs.

Costs.—In dealing with the question of costs, the Judicial Committee acts upon the principle that *bonâ fide* opposition ought rather to be encouraged than discountenanced (*f*).

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 (*g*).

Again, costs of opposition will in general be allowed when the petitioner abandons his application for extension (*h*).

(*z*) *Bodmer's Patent* (1853), 8 Moo. P. C. 282.

(*a*) *Shone's Patent* (1892), 9 R. P. C. 438; *Lyon's Patent* (1894), 11 R. P. C. 537; and see *Darby's Patent* (1891), 8 R. P. C. 380.

(*b*) *Church's Patent* (1896), 3 R. P. C. 95.

(*c*) (1875) L. R. 1 App. Ca. 632; 46 L. J. Q. B. 617.

(*d*) 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's 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."

(*e*) Patents Rules, 1890, rule 74, *infra*.

(*f*) *Wield's Patent* (1871), 8 Moo. P. C. N. S. at p. 304; L. R. 4 P. C. 89; cp. *Westrupp and Gibbins's Patent* (1836), 1 Web. P. C. 556.

(*g*) *Muntz's Patent* (1846), 2 Web. P. C. 113; *Honiball's Patent* (1855), 9 Moo. P. C. 378.

(*h*) *Macintosh's Patent* (1837), 1 Web. P. C. 739; *Bridson's Patent* (1852), 7 Moo. P. C. 499; *Hornby's Patent* (1853), *ibid.* 503; *Milner's Patent* (1854), 9 Moo. P. C. 39; *Morgan Brown's Patent* (1886), 3 R. P. C. 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*.

In a doubtful case, which caused the Judicial Committee great difficulty, no costs were given to the successful petitioner (*i*).

Costs will be given to a successful petitioner where there was no ground for opposition (*k*).

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 (*l*). Upon the other hand, where the objections of several opponents are quite distinct, separate costs may be awarded to each (*m*). It is not unusual to grant a lump sum for costs, in which case a taxation is avoided.

(*i*) *Church's Patent* (1886), 3 R. P. C. 95.

(*k*) *Downton's Patent* (1839), 1 Web. P. C. 567.

(*l*) *Milner's Patent* (1854), 9 Moo. P. C. 39; *Jones's Patent* (1854), *ibid.* 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.

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

CHAPTER XVII.

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 has 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 person who shall have obtained letters patent for

(*a*) *In re Card's Patent* (1848), per Lord Campbell, 6 Moo. P. C. 212; 2 W. P. C. 161.

(*b*) Mr. Benjamin Rotch.

(*c*) Pp. 113, 114.

(*d*) See *infra*, pp. 752, 753.

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*).

(*e*) *In re Westrupp and Gibbins's Patent* (1836), 1 Web. P. C. 555.

(*f*) *In re Stead's Patent* (1846), 2 Web. P. C. 147.

(*g*) *In re Honiball's Patent* (1855), *ibid.* 201; *In re Card's Patent* (1848), *ibid.* 161.

(*h*) *Ibid.*

(*i*) *In re Lamenaude's Patent* (1850), *ibid.* 164.

(5) Where it appeared on a petition for confirmation that part 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 confirmation may still be applied for so far as patents obtained under the Act of 1852 are concerned (*n*), provided that, if a previous patent for the same invention has been obtained in a foreign country, application for confirmation must be made before the foreign protection expires (*o*).

Brandon's Patent.

The decision in *Brandon's Patent* (*p*), which has already been referred to (*q*), 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.

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

(*k*) *In re Heurteloup's Patent* (1836), 1 Web. P. C. 553.
(*l*) Hindmarch, p. 201.
(*m*) *Wells's Patent*, 1 Web. P. C. 554.
(*n*) 1883, sect. 113.
(*o*) *Re Jablochkoff's Patent* (1891), App. Ca. 294; 8 R. P. C. 281; 60 L. J. P. C. 61.
(*p*) (1884) 1 R. P. C. 154; 9 App. Ca. 589.
(*q*) See previous chapter.

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 (*r*).

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 (*s*).

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 (*t*).

Recommendations of Committee.

Previous to 1887 there were three confirming Acts in 1884 (*u*), and one in 1885 (*x*); 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 reported 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

(*r*) *Westhead's Patent*, where the specification was enrolled five days late. The 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 House of Lords on Potter's Patent Bill, &c., in 1887, at p. 43.

(*s*) 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.

(*t*) Report of Select Committee on Potter's Patent Bill, Skrivanow's Patent Bill, and Gilbert and Sinclair's Patent Bill, House of Lords, 1887.

(*u*) Wright's Patent Act, Boult's Patent Act, and Bradbury and Leman's Patent Act.

(*x*) Auld's Patent Act.

of the patent after it has been announced as void in the Official Journal (*y*).

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.

Since this date, several Bills have been before the House, and the rules above set out have been followed, though their application has not been characterised with extreme rigidity. In 1891, Worms and Bale's Act (*z*) was passed to confirm a patent and to allow it to be antedated, so as to avoid the effect of the prior publication in this country of an abridged American edition of the specification. The case seems to have been one which fell within the equity of sect. 103, though outside the letter; hence probably the special indulgence.

In 1892 came a batch of statutes confirming several patents which had lapsed owing to non-payment of fees. The default was caused by the fraud of a patent agent, to whom the requisite money had been given by the respective inventors, and who had failed to use it for the purpose of paying the fees. Special provisions will be found in all these Acts for the protection of those who, acting under *bona fides* after the patent had lapsed, had infringed the patent, or had spent money on preparations to infringe it (*a*).

(*y*) The clauses suggested are set out in Potter's Patent Act, 1887, sect. 2, Appendix, p. 869.

(*z*) 54 & 55 Vict. c. 182.

(*a*) See Nussey and Leachman's Act, 55 & 56 Vict. c. 115; Horsfall's Act, *ibid.* c. 114; Whitehead's Act, *ibid.* c. 116; Simpson and Fawcett's Act, *ibid.* c. 129.

CHAPTER XVIII.

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 civilised countries of the world, and that her Majesty's Government should be requested to inquire of foreign and colonial Governments how far they were ready to concur in international arrangements in relation thereto.

Circular to British colonies.

A circular, dated August 31st, 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 to prepare succinct reports upon the patent laws of the countries to which they were severally

(*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 civilised world is, sooner or later, made known by the public journals in every other part; and it ought not, therefore, to 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.

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 patent law considerably further; and on March 20th, 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 6th, 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 antedating 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.

(*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*) Organised during the Exhibition of 1878.

(*f*) See the text of the Convention, pp. 723 *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), Griff. A. P. C. at p. 39.

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*).

No action for infringement till complete specification accepted.

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*).

Publication during the seven months.

The application for the grant of a patent under these provisions must be made in the same manner as the ordinary application for the British patent (*n*).

Application, how to be made.

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 (*o*).

Order in Council.

Her Majesty's Government acceded to the Convention (*p*), 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 (*q*), Channel Islands, or any of her Majesty's possessions. The accession was accepted (*r*) on the 2nd April following. By an Order in Council (*s*) dated the 26th June, 1884, the provisions of the Patents Act, 1883, s. 103, were applied to the countries then signatories to the Convention, and the Order took effect from the 7th July, 1884.

There have been subsequent accessions to and withdrawals from the Convention (*t*).

Subsequent withdrawals and accessions.

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 the Act of 1883 (*u*) 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

Colonial arrangements.

Provision for colonies and India.

(*l*) Sect. 103, sub-sect. 1.

(*m*) *Ibid.* sub-sect. 2.

(*n*) *Ibid.* sub-sect. 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, rules 24—29. See p. 691.

(*o*) *Ibid.* sub-sect. 4. Orders in Council have been issued.

(*p*) For text of Convention, see pp. 723 *et seq.*

(*q*) 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.

(*r*) See p. 619.

(*s*) See pp. 620, 621.

(*t*) Art. XVI. of the Convention provided for subsequent adhesions, Art. XVIII. for subsequent withdrawals.

(*u*) Sect. 104.

for her Majesty from time to time by Order in Council to apply the provisions of sect. 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.

The position of Great Britain with regard to arrangements made under sects. 103 and 104 may be presented most conveniently in tabular form:—

Foreign State or Colony.	Date of Order in Council.
Belgium	26 June, 1884.
Brazil	26 June, 1884.
Denmark (including the Faroe Islands)	20 Nov., 1894.
Dominican Republic	21 Oct., 1890.
France	26 June, 1884.
Italy	26 June, 1884.
Mexico	28 May, 1889.
Netherlands	26 June, 1884.
Netherlands (East Indian Colonies)	17 Nov., 1888.
Netherlands (Curaçao and Surinam)	17 May, 1890.
New Zealand	8 Feb., 1890.
Norway	See below.
Paraguay	24 Sept., 1886.
Portugal	26 June, 1884.
Queensland	17 Sept., 1885.
San Domingo	27 Jan., 1885.
Servia	26 June, 1884.
Spain	26 June, 1884
Sweden and Norway	9 July, 1885
Switzerland	26 June, 1884
Tasmania	30 April, 1894.
Tunis	26 June, 1884.
United States	12 July, 1887.
Uruguay	24 Sept., 1886.
Western Australia	11 May, 1895.
Zanzibar	16 May, 1893.

[An international office in connection with the Convention has been established at Berne, where a monthly periodical, entitled "La Propriété Industrielle," is published.]

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 (*x*).

(*x*) Art. XIV.

The first meeting took place in Rome in April and May, 1886 (*y*), 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 (*z*).

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 (*a*).

Exhibitions.

3. Temporary protection is accorded by each of the contracting states to patented articles exhibited at official or officially recognised international exhibitions (*b*).

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

(*y*) 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 twenty-six in 1887, and to seventy-one in 1888.

(*z*) Art. IV.

(*a*) Art. V.

(*b*) Art. XI. The Act of 1886 gave her Majesty power, by Order in Council, to declare the provisions of Act 1883, sect. 39, applicable to foreign exhibitions. For the Order in Council in case of Paris Exhibition, 1889, see p. 872.

agreement between them, and it publishes a monthly periodical entitled *La Propriété Industrielle* (*c*).

Legal effect of Orders in Council under sect. 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 (*d*).

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 (*e*) 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. It must be made in Form A2.

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.

(*c*) The yearly subscription (including postage) for all countries within the Postal Union is 5 francs 60 cents, payable to MM. Jent & Reinert, Imprimeurs, Berne.

(*d*) 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 it 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 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.

(*e*) "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:" Patents Rules, 1890, rule 24.

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 (*f*).

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 (*g*), 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 (*h*).

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 (*i*).

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 (*k*).

Further proceedings same as in other cases.

All further proceedings in connection with the application are taken within the times and in the manner prescribed by the Acts or rules for ordinary applications (*l*).

Renewal fees.

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

(*f*) *Ibid.* rule 25.
(*g*) *Infra*, p. 807.
(*h*) Patents Rules, 1890, rule 26.
(*i*) *L'Oiseau and Pierrard* (1887), per Webster, A.-G., Griff. A. P. C. at p. 37; *Main's Patent* (1890), 7 R. P. C. 13.
(*k*) Patents Rules, 1890, rule 27.
(*l*) *Ibid.* rule 28.

expiration of the patent are reckoned from the date of the first foreign application (*m*).

Decisions under sect. 103.

There have been several recent decisions under sect. 103, to which it is necessary to allude.

Position of applicant where previous foreign patent not disclosed.

L'Oiseau and Pierrard (*n*).—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.

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 (*o*).

In a subsequent case (*p*), however, it was held that the

(*m*) *Ibid.* rule 29.

(*n*) (1887) Griff. A. P. C. 36.

(*o*) "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 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 rules 25 and 26, Patents Rules, 1890.

(*p*) *Re Everitt* (1888), per Webster, A.-G., Griff. A. P. C. at p. 29.

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* (*q*), 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 antedate 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 the applicant was so entitled to antedate 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* (*r*) 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 (*s*).

A patent under the International Convention can only be granted to the person (*t*) who has made the foreign application (*u*).

In *Re Van de Poele* (*x*) an important point was 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

(*q*) (1890) 7 R. P. C. 13.
(*r*) *Supra.*
(*s*) *Re Shallenberger* (1889), per Webster, A.-G., 6 R. P. C. 550.
(*t*) *Semble*, a corporation can apply under sect. 103: *Re Carez* (1889), per Webster, A.-G., *ibid.* 552; *Re Shallenberger, supra.*
(*u*) *Re Carez* (1889), 6 R. P. C. 552; *Re Shallenberger* (1889), *ibid.* 550.
(*x*) (1890) 7 R. P. C. 69.

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.

Position of a person protected abroad.

A person applying for an English patent who has previously obtained a patent in a country with which the Convention has been made has an option. He can apply for a patent in the ordinary way, or he may apply under sect. 103. If he applies under sect. 103, his patent dates back to the application in the foreign country (*y*), whilst if he applies in the ordinary way, it dates from application in England. In the former case he gets a shorter term of protection, but he may avoid anticipations which would be fatal to a patent obtained in the ordinary course (*z*). Whether the patentee has elected the one course or the other will appear from the date of the patent (*a*). Though a patent has been granted abroad, the comptroller may refuse to seal the patent, if there then exist reasons which would prevent the sealing of a patent on an ordinary application of the date of the foreign application (*b*).

The terms of the Convention may not be used as a guide to the meaning of the section (*c*).

(*y*) 1883, sect. 103 (1).

(*z*) Per Romer, J., in *British Tanning Co.* v. *Groth* (1891), 8 R. P. C. at p. 121; 60 L. J. Ch. 235. See also *Re Shallenberger* (1889), 6 R. P. C. 550, and Transactions of the Institute of Patents Agents, vol. xiii., p. 35.

(*a*) 1883, sect. 103 (2).

(*b*) Cf. *Carter's T. M.* (1892), 9 R. P. C. 401.

(*c*) *Californian Fig Syrup Co.* (1889), 40 Ch. Div. 620; 58 L. J. Ch. 341; 6 R. P. C. 126.

CHAPTER XIX.

OFFENCES AND PENALTIES.

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, sect. 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 (*b*).

In *Myers* v. *Baker* (*c*), 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."

Patents Act, 1883, sect. 105.

Under the Patents Act, 1883 (*d*), 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.

Use of words, "patent," "patented," &c.

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.

The false representation of an expired patent as being still subsisting, would not be an offence under the present Act; at any rate if the article is marked with the year and number of the patent (*e*).

(*a*) Hindmarch, p. 367.

(*b*) By that statute 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 in 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.

(*c*) (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.

(*d*) Sect. 105.

(*e*) See *Gridley* v. *Swinborne*, quoted in the "Law Journal" for 1894, at p. 683, and cf. *Cheavin* v. *Walker* (1877), 5 Ch. Div. at p. 863; *Marshall* v. *Ross* (1869), 8 Eq. 651. In a recent case, *Pharmaceutical Society* v. *Fox* (1896), Wills, J., speaking of a patent medicine, said, that a patent medicine was one for which there is a

The sale of an article as "patented," which is merely the subject of provisional protection, is an offence against the Act (*f*).

Marking between acceptance of complete and sealing.

It is difficult to say whether the offence is committed if the article is marked "patent" after acceptance of the complete specification, and before the patent is sealed. It will be observed that the offence is representing the article to be a patented article when "no patent has been granted." Before sealing no patent has been granted, and as the grant may be successfully opposed after acceptance of the complete specification, it may be that no patent ever will be granted in the particular case. Nevertheless it is the opinion of some that no offence is committed if the article is not marked till after the complete specification has been accepted, and this opinion is based on sect. 15 of the Act of 1883. There are no authoritative decisions available on this point. At the Mansion House on November 19th, 1894, a conviction was obtained under the circumstances in question (*g*); whilst in *Davies* v. *Townsend* Mr. Bushby, in a similar case, refused to convict. Until the point is definitely settled, it is unwise to mark the article until the patent is sealed.

The section is not to be used as a substitute for an infringement action.

This section is framed for the benefit of the public, and not for the protection of a rival trader. If, therefore, one man makes an article according to another's patent, it is submitted that he does not commit an offence under this section if he marks the article so made "patent." The point arose in a case heard at the Mansion House in June, 1895. It appeared that A. had manufactured an article in alleged infringement of B.'s patent, and had marked it "A.'s patent." The Lord Mayor, hearing that A. had no patent, was inclined to convict, but eventually, owing to extraneous circumstances, the case was not pressed. It is submitted that under this section he would have had no power to convict.

In *Cochrane* v. *Macnish* (*h*) the words, "manufactured in Ireland by H.M. Royal Letters Patent," were printed on the label of bottles of soda-water; the soda-water was not made by a patent process, but it being proved that the words referred to patented machinery with which the water was made, the Court considered them unobjectionable.

patent, not one for which there had been a patent. But the case was not one tried under this Act.

(*f*) *Reg.* v. *Wallis* (1886), 3 R. P. C. 1; *Reg.* v. *Crampton* (1886), *ibid.* 367.

(*g*) See "Law Journal" (1894), p. 683; xiii. Transaction, I. P. A., p. 67; also an article in "Commerce," Dec. 12th, 1894.

(*h*) (1896) App. Ca. 225.

Penalty on unauthorised assumption of the royal arms.

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 (*i*).

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 (*k*).

Summary proceedings in Scotland.

In Scotland, any offence under the Act of 1883 may be prosecuted in the Sheriff's Court (*l*).

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 (*m*).

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*. (*n*).

(*i*) Act of 1883, sect. 106.
(*k*) Act of 1883, sect. 93.
(*l*) Sect. 108.
(*m*) Sect. 112, sub-sects. 2 and 3.
(*n*) Act of 1888, sect. 1.

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. [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. [25th June, 1886.] — Act of 1886.

51 & 52 Vict. c. 50.—An Act to amend the Patents, Designs, and Trade Marks Act, 1883. [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.

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.

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.

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. 689.
Outline procedure on applications, Chap. V., p. 118.
Rival applicants, sect. 7, sub-sect. 5, p. 566.
Application to true inventor where patent revoked on ground of fraud, sect. 26, sub-sect. 8, p. 607.
Application in fraud of first inventor, sect. 35, p. 629.
Deceased inventors, sect. 34, p. 629.
Correction of clerical errors in application, sect. 91, p. 629.
Amendment of application, sect. 7, p. 569; sect. 91 (a), p. 647;
General form of application, Patents Rules, 1890, Form A, p. 805.
Form of application by importer, Patents Rules, 1890, Form A1, p. 806.
Applications sent by post, sect. 97, sub-sect. 1, p. 648.
Applications under International and Colonial Arrangements, Chap. XVIII., p. 533; sect. 103, p. 653; and Patents Rules, 1890, p. 691.
Form of application under Patents Rules, 1890, Form A2, p. 807.

2 *Grant of patent:*

Grant and its effect, Chap. IX., p. 270.
The effect of grant on Crown, sect. 27, p. 610.
Opposition to grant, sect. 11, p. 572; Chap. VIII., p. 239; Patents Rules, 1890, p. 696.
Date of grant, sect. 13, p. 580.

Sect. 4.

Extent, sect. 16, p. 583.
Term, sect. 17, p. 583.
One invention only, sect. 33, p. 628.
Assignment of grant, sect. 36, p. 630, and Chap. X., p. 281.
Variations in form of grant, under this Act, p. 670.

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, or lunacy—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. Sect. 99 provides for certain difficulties which may arise.

Corporation.

A body corporate, which is expressly (sect. 117, sub-sect. 1) included in the definition of a "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: *Re Carez* (1889), 6 R. P. C. 552.

Importers.

As to communications from abroad, and the position of importers, see note to sect. 5, sub-sect. 2.

Persons possibly incapacitated. Sovereign. Clergymen. Alien enemy.

The only persons as to whose capacity there still appears to be some doubt are the Sovereign, who cannot, says Hindmarch, make a grant to herself; a beneficed clergyman, under the provisions of 1 & 2 Vict. c. 106, sects. 28–30, Hindmarch, p. 35; and perhaps an alien enemy.

Member of official commission, when disqualified.

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: *Patterson* v. *Gas Light & Coke Co.* (1877), 3 A. C. 239; also 2 Ch. Div. 833.

Official in Patent Office.

Probably no official in the Patent Office would be allowed to apply for or hold any interest in a patent.

Aliens.

4 *Whether a British subject or not.*—An *alien amy* (a) resident in this country, or (b) resident abroad, may obtain a patent. The dictum of Lord Cairns, C., however, in *Re Wirth's Patent* (1879), 12 Ch. Div. at p. 304, that a patent might be granted to an alien *resident abroad for an invention communicated to him* by another alien, also resident abroad, must be read in connection with Form A1, Patents Rules, 1890, which contemplates a resident applicant only in such cases.

Joint applicants.

5 *Joint application.*—For form of application, see Patents Rules, 1890, Form A, or Form A1, pp. 805, 806.

This part of the sub-section is declaratory of the existing law.

As to filing specification on a joint application, see *Apostoloff's Application* (1896), 13 R. P. C. 275.

Joint grantees.

6 *Joint grantees.*—As to joint grantees, see pp. 277 *et seq.*; form of grant, p. 671.

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: *Mathers* v. *Green* (1865–66), 1 Ch. 29; 35 L. J. Ch. 1; *Steers* v. *Rogers* (1893), App. Ca. 232; 10 R. P. C. 245.

Powers of co-grantees.

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* (*supra*), 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*, 34 Beav. 170, Lord Romilly held that one of several co-grantees 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 company or other capitalist may obtain an immediate interest in the 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[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[5a] or complete specification.[5b]

Specification.

Sect. 5.

Act 1885, s. 2. 5 & 6 Will. IV., 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, sect. 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.

(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, rule 5, &c., p. 682, and Forms A, A1, A2, *ibid.* pp. 805–7 *et seq.* But this is directory only, an observation which applies to the greater portion of this section. See *Siddell* v. *Vickers*, per Fry, L. J., 39 Ch. Div. 108, 109; 5 R. P. C. 416; and in the House of Lords 15 App. Ca. 496; 7 R. P. C. 292.

The application must be signed by applicant: Patents Rules, 1890, rule 8, p. 684; *Grenfell and McEvoy's Patent* (1890), 7 R. P. C. 151.

2 *Prescribed manner.*—See Patents Rules, 1890, *infra*, pp. 689 *et seq.*

Applications by post, sect. 97, sub-sect. 2, p. 689.

3 *A declaration.*—For form of declaration, see Patents Rules, 1890, rule 6 (3), and note thereto, p. 684, also Forms, *infra*, pp. 805 *et seq.*

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 2s. 6*d.*, chargeable on statutory declarations under the Stamp Act, 1870.

For declaration by representative of deceased inventor, sect. 34, p. 629.

For declaration on behalf of infant, lunatic, &c., sect. 99, p. 649.

4 *True and first inventor.*—The meaning of these words is fully considered *ante*, p. 263. The definition of invention under the present Act is the same as it was under the Statute of Monopolies. See sect. 46, *infra*, p. 639.

If novelty is proved, this will not suffice to show that the patentee is the true and first inventor; novelty and subject-matter show *an* invention; the patentee must be prepared to go further and show that he is *the* inventor: *Thomson* v. *Macdonald* (1891), 8 R. P. C. at p. 9; *Cornish* v. *Keene* (1838), 1 W. P. C. at p. 507; and see *ante*, p. 263. Whether a patentee is the true inventor is a question of fact: *Minter* v. *Wells* (1834), 1 W. P. C. at p. 134; *Kurtz* v. *Spence* (1888), 5 R. P. C. 161. This is peculiarly the case when it has to be determined whether the master or his servant is the inventor. See, *e.g.*, *Heald's Patent* (1891), 8 R. P. C. 429; *David and Woodley's Application*, Griff. A. P. C. 26.

If the invention is in use at the time the grant is made, the applicant 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, per Lord Lyndhurst, C., in *The Householl Co.* v. *Neilson* (1843), 1 W. P. C. 719. He is not called the inventor who has in his closet invented it, but who does not communicate it; the first person who discloses that invention to the public is considered as the inventor: *Ibid.* And see *Dollond's Patent* (1776), 1 W. P. C. 43.

First importer.

By the common law (*Hastings Patent* (1567), 1 Web. P. C. 6; *Matthey's Patent*, Eliz., 1 Web. P. C. 6; *Humphrey's Patents*, 1 Web. P. C. 7; *Darcy* v. *Allin* (1602), 1 Web. P. C. 6, affirmed by the Statute of Monopolies and a series of judicial decisions (*e.g.*, *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 Lamenude'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), a patent might be granted to the first importer into this realm of a foreign invention. Scotland is "within the realm" in the sense of sect. 6 of the Statute of Monopolies: *Plimpton* v. *Malcolmson* (1876), 3 Ch. Div. 555. The words "within the realm" were not, however, reproduced in sect. 5, sub-sect. 2, of the Patents, &c., Act, 1883; and as the form of application originally prescribed by the Act (Form A, *infra*, p. 805) drew no distinction between an original and a communicated invention, it seemed as if the right of the first

Importers.

Sect. 5. 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, might be making a false suggestion, which 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 sect. 46 of the present Act, which defines an invention to be any manner of new manufacture, the subject-matter of letters patent, 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 (rule 6), provide that "an application for a patent containing the declaration mentioned in sub-sect. 2 of sect. 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 *Re Avery's Patent* (1887), 36 Ch. Div. 307; 4 R. P. C. 163, Stirling, J., appears to have considered that such a patent would be valid, and *Moser* v. *Marsden* (1893), 10 R. P. C. at p. 359, points to the same result; but the point has not been expressly decided.

An inventor does not cease to be such because he employs assistance in carrying out his invention; if in the result the main invention is his, he remains the inventor although his employés may have made suggestions as to details. See and compare these cases: *Minter* v. *Wells* (1834), 1 W. P. C. 127; *Bloxham* v. *Elsee*, 1 W. P. C. 132, n.; *Kurtz* v. *Spence* (1888), 5 R. P. C. 161; *Elias* v. *Grovesend Tin Plate Co.* (1890), 7 R. P. C. 455. But if another gives him an important part of the invention, he is not the true and first inventor; see, *e.g.*, *Tennant's Case*, 1 W. P. C. 125, n.

A communication made in England by one British subject to another British subject cannot be patented by the receiver of the communication, so as to make the receiver the true and first inventor within the meaning of the patent laws: *Marsden* v. *Saville St., &c., Co.* (1878), 3 Ex. D. 204.

The fraud of the importer is not *per se* sufficient to make him not an inventor: *Edmunds's Patent* (1886), Griff. P. C. 281.

A foreigner abroad who has received the invention by communication from another foreigner abroad might have applied for a patent as true and first inventor: *Re Wirth's Patent* (1879), 12 Ch. Div. 303; but see now Form A1 (*post* p. 806), which has to be used, and which is so framed as to make this difficult.

5 *Must be accompanied by, &c.* :—

At common law no specification was required, but the patent contained a description defining the nature of the invention. Probably the grant would have been void for uncertainty otherwise: Hindmarch, 151. Frequently a clause was inserted requiring the patentee to take apprentices and teach them the invention.

The Statute of Monopolies made no change in this respect. In the reign of Anne the practice arose of inserting a proviso in patents that the patentee should specify in a written, sealed instrument the exact nature of his invention. See, *e.g.*, *Nasmyth's Patent*. A certain time was allowed in which this should be done. If not done in the time, the grant was null and void. This instrument, to which the name "specification" was given, could have been enrolled in one of the three offices in Chancery, but for these one was substituted in 1847.

Under some circumstances the specification could be dispensed with; the last time this happened was in the case of *Lee's Patent* in 1813.

Forms of specifications, Appendix, pp. 809, 818 *et seq.*

As to relative advantages and disadvantages of leaving complete specification in first instance, see pp. 119–121.

Publication of specifications, sect. 13, p. 580.

Indexes of, sect. 40, p. 634; sect. 101, sub-sect. 1, p. 650.

5a The provisional specification was introduced in 1852, which gave a certain protection for a period of six months. The nature of the invention alone had to be mentioned. The present Act allows the provisional and complete specifications to be filed at the same time (sect. 5, sub-sect. 4).

5b A complete specification is now a condition precedent; no patent is granted till it is accepted; the patent then dates back to the application.

For further information as to the history of the specification, see *ante*, Chap. VI.

6 *Statutory Declarations Act*, 1835.—5 & 6 Will. IV. c. 62.

Sect. 11 of this statute was repealed by sect. 113 of the Act of 1883.

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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*, but afterwards formed *part of the application.*

There is now no *statutory* declaration in an application for a patent. It is a simple declaration. But see Patents Rules, 1890, rules 24—29, as to applications under international and colonial arrangements.

7 *A provisional specification, &c.:—*

As to essentials of provisional, see *ante*, p. 141.

Since the present Act has been in force, the patent is not granted until the final specification has been accepted, but the grant, when made, dates back to the application: sect. 13.

The object of the provisional is to state and identify the invention. It must do this distinctly and intelligibly, and its whole nature must be disclosed: *Penn* v. *Bibby* (1866), 2 Ch. 127; 36 L. J. Ch. 455.

The principle which underlies the invention must be plainly and specially stated; the details and the method of carrying out the invention need not be included: *Penn* v. *Bibby* (1866), 2 Ch. 127; *Newall* v. *Elliott*, 4 C. B. N. S. 269; 27 L. J. C. P. 337; 52 L. J. Ex. 120; *Woodward* v. *Sansum* (1887), 4 R. P. C. 166; and see *Siddell* v. *Vickers* (1888), 39 Ch. Div. 92. The provisional specification must not be framed with a view to hide the invention; it must be framed fairly and honestly: per Fry, J., in *United Telephone Co.* v. *Harrison* (1882), 21 Ch. Div. 747. The provisional specification need not claim anything: *Lucas* v. *Miller* (1885), 2 R. P. C. 159. Its function is not to define or show clearly what the patentee claims, but merely to identify the invention.

After the provisional has been filed, the inventor may perfect his details, modify, supplement, and develop, provided that he keeps within the ambit of the invention as described in the provisional specification: *Woodward* v. *Sansum* (1887), 4 R. P. C. 166, 178; *Siddell* v. *Vickers* (1888), 39 Ch. Div. 92; 5 R. P. C. 426.

One object of the provisional is to give the inventor an opportunity to improve the means of putting his discovery into operation. There is nothing to prevent the addition to the provisional of the method, but the tactical reasons against such a course are obvious.

The inventor may in his complete specification include less than in the provisional. He may drop part of his invention as there described: *Penn* v. *Bibby* (1866), 2 Ch. 134.

It is not an objection to the draughtsmanship of the provisional that

an intelligent workman accustomed to the class of work to which the invention relates is unable from it to construct the thing invented; for the provisional is not intended to show how the invention is carried out, but to state what it is: *Stoner* v. *Todd* (1876), 4 Ch. Div. 58. Moreover, as the public may not use the invention, they are not prejudiced by not being informed of the method of so doing.

The advantage given by the acceptance of a provisional specification is styled provisional protection, and is limited to protection against the consequences of use and publication of the invention: Act of 1883, sect. 14. No proceedings shall be taken in respect of any infringement committed before the publication of the complete specification: Act of 1883, sect. 13.

An inventor may abandon his application and make a fresh one, as the provisional is not a bar on account of prior publication. In fact, the provisional is not published save with the complete. The examiner must ascertain and report to the comptroller whether the nature of the invention has been fairly described (sect. 6, *infra*), but the report of the examiner is intended to assist, and not to fetter, the comptroller. If, therefore, upon the face of the specification and apart from the report of the examiner, it is clear that the specification is insufficient, the comptroller must deal with it and refuse the application or require an amendment: *In the Matter of C.'s Patent* (1890), 7 R. P. C. 250.

A defect in the provisional specification will not render the patent bad; but care must be taken that it covers what is intended to be claimed, as the invention as disclosed in the complete specification must not travel beyond limits laid down in the provisional. See below, notes to sect. 9, under heading "Substantially the same." If, however, there be no variance between the complete and the provisional, the former may be explained by the latter: *Siddell* v. *Vickers*, 39 C. D. 92, 97; 5 R. P. C. 426; and see *Neilson* v. *Harford* (1841), 1 W. P. C. 331, a case relating to the analogous question of interpretation of the title of the specification. The size, &c., of the paper on which the provisional is to be written or printed and the formalities connected with the application are dealt with by rule 10. See *post*, p. 685. Drawings must sometimes accompany the application. See next note and rules 30—33, *post*. Duplicates, documents, and drawings are required by the comptroller. See Form B, *post*, p. 808. The provisional specification need not be stamped. The applicant (or his agent) must affix the date and sign the provisional on the last sheet. If there be several joint applicants, the specification need not be signed by them all: *In the Matter of Grenfell's and McEvoy's Patent* (1890), 7 R. P. C. 151.

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Reference to examiner, sect. 6, p. 563.
Amendment of sect. 7, sub-sect. 1, p. 565; Chap. VIII. sect. 5, p. 213.
Comparison of, with complete, sect. 9, sub-sect. 1.
Variance between provisional and complete, sect. 11, sub-sect. 1, also *ante*, p. 146.
Advertisement of acceptance is not required. See rule 21 p. 690, and notes, *post*.
Drawings.—See p. 694, and next note.
Form.—See *post*, p. 808.

Drawings.

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, rules 30—33, *post*, p. 694.

The words *if required* are new, the use of drawings having formerly been permissive, not compulsory (*Boulton* v. *Bull* (1795), 2 H. Bl. 481, per Buller, J.; *Bloxam* v. *Elsee* (1825), 1 C. & P. 564, per Abbott, C. J.), and mean if required by the comptroller-general.

A specification could consist simply of a drawing, and a description of it, provided that the invention was distinctly described and claimed: *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.

In view of the wording of sub-sects. 3 and 4, it is very doubtful whether the comptroller could pass a specification consisting solely of drawings.

Drawings are taken to be part of the specification: *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 C. R. & S. 3rd Ser. 722—724; *Daw* v. *Eley* (1867), L. R. 3 Eq. 500, n.; 14 W. R. 126.

As to the extent to which drawings will amplify or explain the rest of the specification, see *Macfarlane* v. *Price* (1816), 1 Web. P. C. 74; *Fairburn* v. *Household* (1886), 3 R. P. C. 266. See also *supra*, p. 200.

As to erroneous drawings, see *Miller* v. *Searle, Barker & Co.* (1893), 10 R. P. C. 106, 111; *Simpson* v. *Holliday* (1866), 13 W. R. 578.

9 *Whether left on application or subsequently.*

On a joint application the comptroller cannot accept more than one specification; therefore the parties must agree as to its form: *Apostoloff's Application* (1896), 13 R. P. C. 275.

10 *Complete specification* :—
Reference to examiner, sect. 9, p. 568.
Time for leaving, sects. 8, 9, pp. 567, 568.
Acceptance of, sect. 9, sub-sect. 4, p. 569.
Comparison with provisional, sect. 9, sub-sect. 1, p. 568, and notes thereto.
Protection under, sect. 15, p. 582.
Amendment of, sect. 18, p. 585; and *ante*, p. 213.
Transmission of copies of, sect. 100, p. 650.
Board of Trade may require duplicates of, sect. 101, sub-sect. 1 (e), p. 650.
Forms of, see pp. 808, 818 *et seq.*

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 things material to the particular invention within the knowledge of the patentee at the time of specifying? *Carteright* 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 Russ. 324, per Lord Lyndhurst, L. C.; *Coles* v. *Baylis* (1886), 3 R. P. C. 180, per Bacon, V.-C.

The two requisites of a complete specification mentioned in this sub-section must be kept separately and distinctly in mind. The specification must show (1) what the invention is, and (2) how it is to be carried out.

A specification may be insufficient if ambiguous, *e.g.* if a generic term is used, and a particular species alone will avail: *Turner* v. *Winter* (1787), 1 W. P. C. 77; *Wegmann* v. *Corcoran* (1879), 13 Ch. Div. 65; *Gandy* v. *Reddaway* (1885), 2 R. P. C. 49.

When the specification omits proportions of the ingredients, the specification is sometimes bad, sometimes not. See *Patent Type-founding Co.* v. *Richards* (1859), 1 Johns. 381; *British Dynamite Co.* v. *Krebs* (1879), Good. P. C. 88.

A specification which does not disclose improvements discovered by the inventor since the provisional was filed, and which relate to the invention, is bad, if the improvements are really but improved means of carrying out the invention disclosed in the specification. If the improvements amount to an invention which goes beyond the invention disclosed in the provisional, the applicant not only need

Sect. 5. not, but must not (on account of disconformity), include them in the complete. See and cf. *Edison* v. *Woodhouse* (1886), 32 Ch. Div. 521; *Miller* v. *Searle Barker* (1893), 10 R. P. C. 106, 111; *Crossley* v. *Beverley* (1829), 1 W. P. C. 117.

The specification should distinguish what is old and what is new; but this need not be stated in express terms, and if from the specification can be gathered what is claimed as the novelty, this requisite is satisfied. See *Carpenter* v. *Smith* (1841), 1 W. P. C. 532. This applies to a patent for improvements: *Foxwell* v. *Bostock* (1864), 4 De G. J. & S. 298. It applies equally to patents for combinations, but when the combination is claimed without the subordinate integers, the claim for the combination alone suffices, for it may be gathered that the combination as a whole is the novelty, and that the parts are not claimed to be new. See *inter alia Harrison* v. *Anderston Foundry Co.* (1876), 1 App. Ca. 577, 583; *Clark* v. *Adie* (1877), 2 App. Ca. 315; *Moore* v. *Bennett* (1884), 1 R. P. C. 143; *Proctor* v. *Bennis* (1887), 36 Ch. Div. 740, 762; 4 R. P. C. 333; *Kelly* v. *Heathman* (1890), 45 Ch. Div. 256; 8 R. P. C. 343; *Lyon* v. *Goddard* (1894), 11 R. P. C. 357.

The following is a test of the sufficiency of the description: Is the description of the invention sufficiently accurate to enable a careful and competent workman, accustomed to the kind of manufacture forming the matter of the patent, to make the invention without any further experiment or aid than that which his practical knowledge and the specification afford him? *British Dynamite Co.* v. *Krebs* (1879), 1 Good. P. C. 88, 91; *Miller* v. *Searle, Barker & Co.* (1893), 10 R. P. C. 106, 111; *Badische Anilin and Soda Fabrik* v. *Levinstein* (1887), 12 A. C. 710, 713; 4 R. P. C. 449; and per Lindley, L. J., in *Edison* v. *Holland*, 6 R. P. C. 281.

For a fuller discussion of this subject, see *ante*, p. 173.

11 *The title.*—The House of Lords has decided that the part of the section requiring a claim is directory only (*Vickers* v. *Siddell*, 15 App. Ca. 496). Sect. 7 (*infra*, p. 565) makes insufficiency of title a ground for refusing a patent, and practically, therefore, the title is still a necessity.

Nature of title.

The law as found in the older cases stands thus:—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 for convenience of search the title is still useful, and its accuracy is matter of importance, as it may have an important bearing on the construction of the claim when the sufficiency of the specification or the novelty of the invention is in question.

The objection to the title may be taken by the Crown when the patent is applied for; but probably nowadays a patent once granted will not be invalidated merely on the ground of insufficiency of title. It will be observed that amongst the grounds of opposition to the grant of a patent insufficiency of title is not named. See *infra*, sect. 11.

The generality of the title may be restricted by the specification, and in some cases the converse holds good. The title and specification are to be read together: *Hornblower* v. *Boulton* (1799), 8 T. R. 95; *Neilson* v. *Harford* (1841), 1 W. P. C. 295, 331; *Lister* v. *Norton*, 3 R. P. C. 203. But the specification has never been allowed to extend the meaning of the title so as to make the grant include that which could not fairly come within it: *Croll* v. *Edge* (1850), 9 C. B. 479; 19 L. J. C. P. 261. The title should not be too narrow, as it may in such case restrict the grant: *Wright* v. *Hitchcock* (1870), L. R. 5 Ex. 37.

The title may be amended by excision under sects. 7 and 9: *Dart's Patent*, Griff. P. C. 307. If the specification has already been made public property, the application should be made under sect. 18: *Jones's Patent*. Griff. P. C. 313.

As to the title generally, its nature, variance between title and specification, &c., see *ante*, Chap. VI., p. 135.

Report of examiner upon the title, sect. 7, sub-sect. 1.

Amendment.—See sects. 7, 9, 18.

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: *Siddell* v. *Vickers* (1888), 39 Ch. Div. 92; 5 R. P. C. 428; 15 App. Ca. 496.

The claims.

13 *The claim.*—The important subject of claims is fully dealt with *ante*, p. 18.

This provision is directory only. A specification without a claim should not be passed by the comptroller; but if by any chance it were, the patent would not, therefore, be bad: *Siddell* v. *Vickers* (1890), 15 A. C. 496; 60 L. J. Ch. 105; 7 R. P. C. 292.

Under the old law it has been stated that a claim is in fact a disclaimer. See, *e.g.*, per James, L. J., in *Plimpton* v. *Spiller* (1877), 6 Ch. Div. 426; also *Hinks* v. *Safety Lighting Co.* (1876), 4 Ch. Div. 612; *Easterbrook* v. *G. W. Railway* (1885), 2 R. P. C. 208; *Lucas*

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v. *Miller* (1885), 2 R. P. C. 159. Under the present Act the claim still performs to some extent the function of a disclaimer, but it is no longer correct to look upon it merely as performing that function. "Since 1883 it is not correct to speak of a claim as a disclaimer, as one can now only protect what is claimed:" per Herschell, L. C., in *Parkinson* v. *Simon* (1895), 12 R. P. C. 406; but see dicta of Kay, L. J., and Smith, L. J., in *Edison Phonograph Corporation* v. *Smith and Young* (1894), 11 R. P. C. 401, 405.

The claim should not be too wide, as it may then include within its scope that which is not patentable. In such case the claim is bad, and with it the patent falls: *Rose* v. *Braby* (1894), 11 R. P. C. 198; *Parkinson* v. *Simon* (1895), 12 R. P. C. 408. Whether a claim which is too wide, in view of the invention specified, would be bad if the excess is new and otherwise patentable, *quære*. Wright, J. (supported by Smith, L. J.), thought not. See *Edison and Bell Phonograph Corporation* v. *Smith* (1894), 11 R. P. C. 163, 408; and see *ante*, pp. 186, 187. But the patentee may disclaim a bad claim. See sects. 18 to 20.

If the claim is too narrow there is danger that in an action for infringement the defendant may be able to show that his manufacture keeps outside the claims of the plaintiff. See especially *Cassel Gold Extracting Co.* v. *Cyanide Gold Recovery Syndicate* (1895), 12 R. P. C. 232; *Parkinson* v. *Simon* (1895), 12 R. P. C. 408.

The effect of the words "substantially as described," "in apparatus such as described," was considered in the following, amongst other, cases: *Young* v. *Rosenthal* (1884), 1 R. P. C. 33; *Plimpton* v. *Spiller* (1876), 6 Ch. Div. 426; *Cassel Gold, &c., Co.* v. *Cyanide Gold, &c., Co.* (1895), 12 R. P. C. 232; *Parkinson* v. *Simon* (1895), 12 R. P. C. 408; *Edison-Bell, &c., Corporation* v. *Smith* (1894), 11 R. P. C. 389. The general result seems to be that such words must be given a full meaning, and generally will throw those construing the claim back to the body of the specification, but if this cannot be done consistently with giving a proper construction to the rest of the claim the words will not have this effect. And though mere redundancy or repetition will not invalidate a claim (*Wenham Gas Co.* v. *Champion Gas Lamp Co.* (1892), 9 R. P. C. at p. 98), an interpretation which would give an identical meaning to several separate claims would *primâ facie* be the wrong interpretation: *Parkinson* v. *Simon* (1895), 12 R. P. C. 408.

If two modes of performing are claimed, and one will not work, see and contrast *Lewis* v. *Marling* (1829), 10 B. & C. at p. 25, *R.* v. *Cutler* (1849), 14 Q. B. 372, n., and *Simpson* v. *Holliday* (1866), 5 N. R. 340.

A claim must be very wide to justify any Court in saying that

a patent cannot be supported based upon it: Cotton, L. J., in *Arnold* v. *Bradbury* (1871), 6 Ch. 711. But "I claim every mode of cutting ice except by human power" would be bad: *Ibid.* **Sect. 5.**

It is allowable to point out that the invention can be utilised for a known process provided it be clearly pointed out that the old process is not claimed: *Goddard* v. *Lyon*, 11 R. P. C. 354.

Claims for improvements are allowable, but the improvement must be specified in accordance with the doctrine of *Foxwell* v. *Bostock* (1864), 4 De G. J. & S. 298; and see *ante*, p. 189.

The combination may be claimed alone without the subordinate integer. In that case there is no need to disclaim the separate parts: *Clark* v. *Adie* (1875), 2 A. C. 320; *Moore* v. *Bennett* (1884), 1 R. P. C. 129, 143; and see *ante*, p. 189 *et seq.* Hence if each of the parts be old, but the combination be new and patentable, the claim for the combination will be good, *e.g.*, *Hayward* v. *Hamilton* (1879), Griff. P. C. 115 (pavement lights case); *Kelly* v. *Heathman* (1890), 45 Ch. Div. 256; 8 R. P. C. 343 (telescopic ladder case); *Peckover* v. *Rowland* (1893), 10 R. P. C. 224 (apparatus for softening water in boilers, &c.).

Claims for the subordinate integers may be joined with claims for the whole combination. In such case the claims for the integers, if claimed as independent inventions, or, as it is styled, *in gross*, are treated as substantive claims, and if they are bad the patent is invalid until the bad claims are got rid of. If, on the other hand, the subordinate integers are but part of the main invention, if they are *appendant*, want of novelty in them will not affect the patent. As to *integers in gross*, see *Clark* v. *Adie* (1875), 2 App. Ca. 320; as to integers appendant, see *British Dynamite Co.* v. *Krebs* (1879), Good. P. C. 93, 94; also *Plimpton* v. *Spiller* (1877), 6 Ch. Div. 426 (roller skate case).

The construction of a specification of claims is considered *ante*, p. 202. Stated shortly and generally, the rule with regard to claims is as follows: The claims must be construed as any ordinary documents would be construed, and if the meaning is clear, that meaning must be given to them; but if the "language of a claim be ambiguous, and it be fairly capable of two constructions, the Court would be disposed to adopt that construction which would uphold the patent, and not that which would render it invalid:" Lord Davey in *Parkinson* v. *Simon* (1895), 12 R. P. C. at p. 411.

Reference 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

Sect. 6. 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; his duties are best considered under the various sections in which his name occurs.

As regards the Patent Office and the comptroller's connection with it, see *ante*, p. 110.

2 *The examiners.*—As to examiners generally, *ante*, p. 111.

Appointment of, sect. 83, sub-sect. 1.

Reference of specifications to, sect. 9, sub-sect. 1.

Reports by, sects. 7—9, sub-sect. 2.

3 *Reports of examiners.*—These reports are private, and are only liable to production under sect. 9, sub-sect. 5. The comptroller is not bound by the report; he must use his own judgment: *C.'s Patent* (1890), 7 R. P. C. 250.

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.

Whether the invention is contrary to law or morality.

4 *Fairly described.*—See note *supra*, sect. 5, sub-sect. 4.

5 *Prescribed manner.*—Cp. Patents Rules, 1890, pp. 689, 694 *et seq.*

6 *The title.*—See note *supra*, sect. 5, sub-sect. 5. The provisional specification "must describe the nature of the invention." It is now sufficient for the title to indicate its subject-matter.

Power of comptroller to refuse application or require

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.

Sect. 7. amendment. Repealed. Act 1888, sect. 2.

(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, sect. 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.

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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 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."[7]

1 See note to sect. 6, *supra*.

2 Though the examiner does not report that an amendment is requisite, it is the comptroller's duty to require one if he thinks fit. The examiner's report does not fetter; it assists the comptroller to form a judgment: *C.'s Patent* (1890), 7 R. P. C. 250.

3 *The comptroller may require that the application, &c., be amended.* In determining what amendment is requisite the comptroller is not fettered by the report of the examiner; he must use his own judicial discretion: *C.'s Application* (1891), 7 R. P. C. 250.

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 on the ground that 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. He has not to decide what the amendment is to be: *C.'s Application* (1891), 7 R. P. C. 250.

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* (1887), Griff. A. P. C. 2, lends colour to this view of the character of the examiner's duty.

Semble, any amendment under this section must in form be at the requirement of the comptroller or of the law officer. As to voluntary amendment by the patentee, see notes to sect. 18.

Proceedings to amend a specification which has not yet been published are taken under this section, or under sect. 9. After the

specification has become public property the procedure of sect. 18 must be used: *Jones's Patent*, Griff. P. C. 313. But *quære*, does it become public property before it is *accepted* by the Patent Office: see *Jones's Patent*, *supra*, which is not very satisfactory on this point. Cf. *Dart's Application*, Griff. 307.

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.

Appeals to, against refusal of comptroller-general to accept complete specification, sect. 9, sub-sects. 2, 3.

Appeals to, on opposition, sect. 11, sub-sects. 2, 3.

Appeals in regard to amendment of specifications, sect. 18, sub-sects. 3—7.

Costs in proceeding before, sect. 38.

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. 713.

5 *Notice of acceptance.*

The application is accompanied by a provisional or a complete specification.

The acceptance is to be advertised in the Official Journal of the Patent Office, (Patent Rules, 1890, rule 21, p. 690).

6 *Sealing.*—As to sealing, see sects. 12, 13, p. 577.

Seal of Patent Office see sect. 84, p. 641.

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 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.

Act 1885, sect. 3.

A complete specification may be left within such extended time,[3] not exceeding one month after the said nine months, as the comptroller may on payment of the prescribed fee allow.[4]

Sect. 8. (2.) Unless a complete specification is left within that time the application shall be deemed to be abandoned.[5]

1 *Complete specification with application.*—As to leaving complete specification in first instance, see sect. 5, sub-sect. 2, *ante*, p. 541.

2 *Nine months.*—Month here means calendar month: 13 & 14 Vict. c. 21, s. 4. The day of application is excluded in the reckoning: *Williams* v. *Nash* (1859), 28 L. J. Ch. 886; 28 Beav. 93; *Russell* v. *Ledsam* (1845), 14 M. & W. 574, 582. In the event of the last day falling on Christmas Day, Good Friday, Saturday, Sunday, or Bank Holiday, an extra day is allowed; see 1883, sect. 98, and Patents Rules, 1890, rule 7.

3 *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.

4 *Prescribed fee.*—The fee is £2, see p. 712.

5 *Abandonment of application.*—Under the Act of 1852 it was held that the abandonment of a provisional specification did not amount to a publication of it, so as to invalidate a patent upon a subsequent application for the same invention: see *Oxley* v. *Holden* (1860), 30 L. J. Ch. 68; 8 C. B. N. S. 666.

In *Lister* v. *Norton* (1886), 3 R. P. C. 200, 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.

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, sect. 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 specifica-

tion is substantially the same[4] as that which is described in the provisional specification.[5] **Sect. 9.**

(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.

(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]

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] **Act 1885, sect. 3.**

(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, sect. 3.**

1 *Complete left after provisional.*—Cp. sect. 5, sub-sect. 2, and *ante*, pp. 119, 120.

2 *Examiner.*—See note to sect. 6.

The examination is not conclusive on the question of nonconformity of the provisional and complete specifications, and the patent is liable to be revoked if the specifications do not conform: *Nuttall* v. *Hargreaves* (1892), 1 Ch. 23; 8 R. P. C. 450, and see *infra*, note 4.

3 *Whether the complete specification has been prepared in the prescribed manner.*—Cp. Patents Rules, 1890, rules 30—33, pp. 695, 696.

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Effect of variance under present Act.

4 *Substantially the same.*—From the language of Lord Halsbury, in *Siddell* v. *Vickers* (1888), 15 A. C. 496, quoted under sect. 5, sub-sect. 5, it appeared 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 Court of Appeal has accepted this dictum: *Nuttall* v. *Hargreaves* (1892), 1 Ch. 23; 8 R. P. C. 450.

The complete should not contain as a part of the invention anything not within the ambit of the provisional: *Woodward* v. *Sansum* (1887), 4 R. P. C. 166. It may not contain a different invention, whether alone or in conjunction with one fairly within the scope of the provisional: *Bailey* v. *Roberton* (1878), 3 App. Ca. 1055; *Watling* v. *Stevens* (1886), 3 R. P. C. 147, 151; *Gadd* v. *Mayor of Manchester* (1892), 9 R. P. C. 526; *United Telephone Co.* v. *Harrison* (1882), 21 Ch. Div. 720.

But an improvement or better means of carrying the invention into effect may, and generally must, be included in the specification, without danger of conformity: *Miller* v. *Searle, Barker & Co.* (1893), 10 R. P. C. 111; *Bailey* v. *Roberton, ubi supra*; *Gadd* v. *Mayor of Manchester, ubi supra*; *Woodward* v. *Sansum, ubi supra*; *Penn* v. *Bibby* (1866), 2 Ch. 127; *Crossley* v. *Beverley* (1829), 1 W. P. C. 112. An entirely new invention cannot be included under the guise of an improvement: *Gadd* v. *Mayor of Manchester* (1892), 9 R. P. C. 526.

Matters of detail may be added to the complete, though not in the provisional: *Lucas* v. *Miller* (1885), 2 R. P. C. 155.

If the provisional contains more than the complete, this alone is no ground for declaring the patent invalid: *Thomas* v. *Welch* (1866), L. R. 1 C. P. 192; *Penn* v. *Bibby, ubi supra*.

Whether the provisional and complete are in such conformity as is required by law is a question of fact: *Needham* v. *Oxley* (1863), 8 L. T. N. S. 532; 1 H. & M. 248.

In an action the plea of insufficiency of the specification entitles the defendant to set up the invalidity of the patent on the ground of disconformity: *Penn* v. *Bibby, ubi supra*. But the defendant must give particulars: (1886) *Watling* v. *Stevens*, 3 R. P. C. 153, 154.

The provisional is not published until the acceptance of the complete specification, but this does not affect the rule relating to nonconformity: per Lindley, in *Cassel Gold Extracting Co.* v. *Cyanide Gold Recovery Co.* (1895), 12 R. P. C. 249.

It has been decided that the Court must not be too severe in judging of questions of nonconformity; the specifications must be read as meaning what they say, but unless there is clearly a different invention included in the final, the Court will hesitate to declare the patent invalid on this ground: per Lindley, L. J., *Gadd* v

Mayor of Manchester (1892), 9 R. P. C. 527; per Romer, J., in *Chadburn* v. *Mechan* (1895), 12 R. P. C. 120.

For right to oppose on ground of nonconformity, see Act of 1888, sect. 4, *infra*.

For effect of amendment in causing nonconformity, see *Lane-Fox* v. *Kensington Electric Lighting Co.* (1892), 3 Ch. 424; 9 R. P. C. 222, 413; *Goulard and Gibbs' Patent* (1889), 6 R. P. C. 215.

Revocation for nonconformity: see *infra*, sect. 26.

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: see above quoted cases and *Lucas* v. *Miller* (1885), 2 R. P. C. 155; *Horrocks* v. *Stubbs* (1886), 3 R. P. C. 223; *Moseley* v. *Victoria Rubber Co.* (1887), 4 R. P. C. 241, 248; *Anglo-American Brush* v. *Crompton* (1887), 4 R. P. C. 27 and (1888) 5 R. P. C. 398; *Hutchison* v. *Patullo* (1887-8), 4 R. P. C. 332 and 5 R. P. C. 351.

On the whole subject of variance between the specifications, and for a consideration of the cases, see *ante*, p. 146.

5 The language of the statute would seem more clear if it ran, "As the invention, the general nature of which is described," &c.

6 *Examiner's report.*—See note to sect. 6.

7 *Refusal of comptroller.*—The formal letters from comptroller were published in the first edition of this work; it has not been thought necessary to reproduce them in this edition. No specified forms are provided.

8 *Unless and until the same shall have been amended.*—There must be no variance between the amended complete specification and the provisional: *Goulard and Gibbs's Patent* (1888), 5 R. P. C. at p. 532. When the specification has been published, amendment may be made only as provided in sect. 18: *Jones's Patent*, Griff. P. C. 313.

9 *Appeal to law officer* :—

For rules regulating such appeals, see *infra*, p. 713.

See also note to sect. 7, sub-sect. 2.

Acceptance of complete specification not conclusive of sufficiency.

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. Cp. *infra*, sect. 26, sub-sect. 3, and *Goulard and Gibbs's Patent*, *supra*, where a patent was revoked on this ground.

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11 *Date of application.*—The day of the date is excluded. See note to sect. 8, sub-sect. 2.

12 *Notice of appeal.*—Form T, *infra*, p. 817.

13 *Application void.*—As to abandonment of application and its effect, see note to sect. 8, sub-sect. 2.

A list of abandoned and void applications is published weekly in the "Illustrated Official Journal."

14 *Comptroller may allow.*—As to letters from comptroller, see note (7), *supra*.

Fee, No. 38, p. 712.

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.

Unless the Court . . . shall certify.—No such order appears to have been made.

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, rule 21, p. 690.

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, rule 22, p. 691.

For list of applications open to inspection, but not continued to sealing stage, see Report for 1889, p. 9.

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*

Repealed. Act 1888, sect. 4.

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.[6]

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Act 1888, sect. 4.

(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]

(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.[12]

(4.) The law officer may, if he thinks fit, obtain the assistance of an expert,[13] who shall be paid such remuneration as the law officer, with the consent of the Treasury,[14] 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-sect. 1, and Chap. VIII.), (2) to the amendment of a specification (sect. 18, sub-sect. 2, and Chap. VII.), and (3) to the extension of the term of a patent (sect. 25, sub-sect. 2, and Chap. XVI.).

The law relating to each of these subjects is fully discussed in the several chapters above referred to.

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, rule 34, p. 696, and Law Officers' Rules, *infra*, p. 713. Note that in sub-sect. 3 the words are "Any person . . . entitled to be heard." See note *post*.

2 *Notice of opposition.*—Form D, p. 808.

Who entitled to oppose.

Opposition before the law officer to the grant of a patent, or to the

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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-sect. 3, and sect. 18, sub-sect. 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.

There is no restriction imposed by sect. 25, sub.-sect. 2, upon the persons who may enter a caveat against the extension of letters patent.

Grounds of opposition.

3 *The applicant having obtained the invention from him.*—Invention here means the *entire* invention. It means an invention identical with the invention purported to be intended to be patented, and does not involve that the opponent must have a patentable invention: *Thwaites's Application* (1892), 9 R. P. C. 515.

Applicant having obtained invention from opponent.

Where *part* of an invention only was communicated by the opponent to the applicant the usual practice has been to seal a patent to them *jointly*: *Eadie's Patent* (1885), Griff. P. C. 279; *Garthwaite's Patent* (1886), Griff. P. C. 284.

Under sect. 11, sub.-sect. 1, the comptroller-general or the law officer cannot inquire into the circumstances under which an invention was *imported* into this country, *e.g.*, whether there was fraud on the part of the person making the communication from abroad: *Edmunds's case* (1886), Griff. 281; *Higgins's case* (1892), 9 R. P. C. 74.

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: *Huth's Patent* (1884), Griff. P. C. 292.

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: *Edmunds's Patent* (1886), Griff. P. C. 282.

The *assignee* of a prior patent is not "the legal representative" of the patentee within the meaning of this sub-section: *Adolph Spiel's Patent* (1888), 5 R. P. C. 282.

Meaning of "patented."

5 *Has been patented*:—

The word "patented" is construed strictly (*Cumming's Patent* (1884), Griff. P. C. 277; *Stubbs's Patent* (1884), Griff. P. C. 298; *Welch's Patent* (1884), Griff. P. C. 301), 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. But it is not necessary to show that the patent is a valid one: *Thornborough's case* (1896), 13 R. P. C. 115. **Sect. 11.**

It will not do for him to produce merely a provisional specification (*Bailey's Patent* (1884), Griff. P. C. 269); but in *L'Oiseau and Pierrard* (1887), Griff. A. P. C. 36 (cp. *Dundon's Patent* (1885), Griff. P. C. 278), 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: *Lancaster's Patent* (1884), Griff. 294; *Re Stewart's Application* (1896), 13 R. P. C. 627.

Where the applicant's invention is simply an improvement on a prior invention the specification should state this, and a reference or disclaimer will be required showing that the patent is granted for the improvement only: *Hoskins's Patent* (1884), Griff. 291; *Welch's Patent* (1884), Griff. 200; *Van Gelder's Patent* (1892), 9 R. P. C. 325; *Tattersall's Patent* (1892), 9 R. P. C. 150.

The law officers are unwilling to refuse to seal the patent applied for unless there is a tolerably clear case of identity between the invention covered by it and that covered by the old patent: *Stuart's Application* (1892), 9 R. P. C. 452. They do not consider whether the invention claimed is subject-matter: *Todd's Application* (1892), 9 R. P. C. 487. Want of invention may be an element to be considered when there is doubt whether the prior patent is the same as that before the law officer. If, *e.g.*, after eliminating from the applicant's invention everything in the prior invention, there be nothing patentable left, the patent will be refused. See *Wylie and Norton's Application* (1896), 13 R. P. C. 97; *Hedge's Patent* (1895), 12 R. P. C. 136.

Where two inventions are *clearly identical*, it is no defence for an applicant to allege that his opponent has included in his complete 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: *Green's Patent* (1885), Griff. 287. Indeed, before the law officer complete specifications only are considered, except in case of opposition on the ground mentioned in the next note. Where the field of invention is narrow the applicant will be tied down very closely to what is foreshadowed in the provisional.

6 *Or on the ground that the complete specification describes, &c.*— This clause, which was enacted by the Patents Act, 1888, sect. 4, Act of 1888, sect. 4.

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meets and resolves a doubt expressed by Sir Richard Webster, A.-G., in *Newman's Patent* (1888), 5 R. P. C. 278. As to its effect on applications under international arrangements, see *Main's Application* (1890), 7 R. P. C. 13.

The clause does not cause that to be nonconformity which was not so before; it merely entitles parties to object to a grant of a patent who previously had no *locus standi*: *Edwards's Application* (1894), 11 R. P. C. 461. As to how far this is retrospective see *Anderson* v. *Anderson* (1891), 8 R. P. C. 323.

7 *Notice of opposition to applicant.*—As to procedure, see Patents Rules, 1890, rules 34 *et seq.*, p. 696.

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: *Chandler's Patent* (1886), Griff. 273.

The patent should be stopped only in a clear case: *Todd's Application* (1892), 9 R. P. C. 487.

9 *Subject to appeal.*—An appeal to the law officer is a re-hearing; but, apart from special circumstances, costs follow the event: *Stubbs' Patent* (1884), Griff. P. C. 298.

Practice where applicant failed to appear.

10 *Hear the applicant.*—*In the matter of Ainsworth's Patent* (1885), Griff. 269, 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.*—*In the matter of Heath and Frost's Patent* (1886), Griff. P. C. 290, 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."

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: *Glossop's Patent* (1884), Griff. 286; not so a

person who had merely manufactured articles under a prior patent: *Bairstowe's Patent* (1888), 5 R. P. C. 286.

In the matter of Heath and Frost's Patent (1886), Griff. 288, 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. The grantee of a prior expired patent was heard: *Re Lancaster* (1884), Griff. 293; and see *Re Stewart* (1896), 13 R. P. C. 627.

It would appear that any member of the public can, on the stated grounds, oppose before the comptroller. In *L'Oiseau and Pierrard* (1887), Griff. 36, however, the comptroller went into the question of interest.

If a person is before the law officer he may rely upon specifications in which he is not interested, provided he have a *locus standi*: *Stewart's Application* (1896), 13 R. P. C. 627.

The grounds of opposition before the law officer are the same as those before the comptroller: *ibid.*

12 It wants a clear case to stop a patent; see note 8. A reference to a former patent should be ordered only if without it the sealing would necessarily be refused: *Marsden's Patent* (1896), 13 R. P. C. 87. It is not usual to insert a reference merely to call attention to a prior patent: *Adams's Application* (1896), 13 R. P. C. 548. As to special references, see *Heald's Patent* (1891), 8 R. P. C. 429; *Stell's Patent* (1891), 8 R. P. C. 235; *Welch's Patent* (1891), 8 R. P. C. 442.

Power of law officer to summon expert.

13 *Power of law officer to call in expert.*—Under the Patent Law Amendment Act, 1852, sect. 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. 612.

14 *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

Sect. 12. 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 of application, except in the cases hereinafter mentioned, that is to say—

(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]

Act 1885, sect. 3. *Extension of time for leaving and accepting complete specification and sealing.*

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.

1 *A patent.*—See Form of Patent, annotated at pp. 665 *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*, Skin. 225, 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. Cp. Hindmarch, 36, 37.

Seals formerly in use.

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.

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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: Hindmarch, p. 36.

For the purposes of letters patent, however, the seals of the three kingdoms were in one sense distinct: 6 Ves. 708.

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": Webs. 67, n. (*e*).

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.

Former practice as to time of sealing.

5 *Sealing of patent:*

Under the Patent Law Amendment Act, 1852, sects. 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;

Sect. 12. Or, the comptroller has, under sect. 3 of the Act of 1885, allowed an extended time for leaving and accepting the complete specification, in which case a further extension of four months after the said fifteen months is granted.

6 *As to appeals in opposition cases*, see *ante*, p. 244.

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, rules 49 and 50, pp. 699, 700.

9 *Prescribed fee.*—See p. 712.

Date of patent.

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]

Act 1885, sect. 4. Specifications, &c., not to be published unless application accepted.

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 connection with such application, shall not at any time be open to public inspection or be published by the comptroller.[4]

Former practice.

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.*

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 ante-dated: 1 W. P. C. 430, n. (*c*).

15 & 16 Vict. c. 83, s. 23, provided that letters patent might (the Act of 18 Hen. 6, 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

made a condition of sealing a patent that it should bear a particular date. Cp. *Ex parte Bates and Redgate* (1869), L. R. 4 Ch. 577; *Ex parte Bailey* (1872), L. R. 8 Ch. 60; *Ex parte Harrison* (1874), L. R. 9 Ch. 632.

Act of 1883.

The Act is imperative upon this point.

As to date of patents granted under International and Colonial Arrangements, see Chap. XVIII., pp. 533 *et seq.*

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. See *Ex parte Bates*, *supra*. Cp. *Saxby* v. *Hennett*, 1873, L. R. 8 Ex. 210; *Ex parte Scott and Young*, 1871, L. R. 6 Ch. 274.

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]

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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. The period of provisional protection is that between the date of application and the actual date of sealing of the patent.

This is a re-enactment, with modifications, of sect. 8 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. 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.

It does not entitle him to sell his articles with the word "patent" on them: *R.* v. *Wallis* (1886), 3 R. P. C. 1; *R.* v. *Crampton* (1886), 3 R. P. C. 367.

It may be taken that provisional protection dates from the day of the application, but that when obtained it is obtained only after the official acceptance of the provisional by the Patent Office. An applicant, therefore, runs some risk in exhibiting or vending his invention prior to this date, the comptroller having power to cause an application to be post-dated in case of insufficiency of the application and of the accompanying specification. In case of application with a complete in the first instance, the same caution has to be observed.

PROTECTION BY COMPLETE SPECIFICATION.

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:[1] 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.[2] Sect. 15.

1 Does this entitle him to mark articles sold with the word "patent," and yet avoid the penalty prescribed by sect. 105? The answer to be given is not certain. See notes to sect. 105, *post*, p. 656; and see *ante*, p. 544.

2 *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.

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. There is at present no patent right for inventions in the Channel Islands.

Prior to 15 & 16 Vict. c. 83, s. 18, a British patent could be extended to the Colonies also, if the patentee desired it.

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[3a] 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.

Sect. 17. (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.[7]

1 *Duration of Patent:*

The term given by a patent commences on *the day of the date* of the letters patent; Patent 1st January, 1890, expires 31st December, 1904: *Russell* v. *Ledsam* (1845), 14 M. & W. 574, 582.

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: *Ibid.*

2 *Fourteen years.*—Cp. 21 Jac. 1, c. 3, s. 6.

3 *From its date.*—The patent is dated as of the day of application; so it is really ante-dated. As to this, see *ante*, p. 580.

As to date of patent under International and Colonial Arrangements, see p. 653.

3a If the prescribed time, or the prescribed time as extended, has elapsed, there is yet a means of getting the patent supported, viz., to apply to Parliament to pass a bill to confirm the patent. But special circumstances must be shown; see *ante*, Chap. XVII.

4 *The patentee* is the person who is for the time being entitled to the benefit of a patent: sect. 46.

5 *Prescribed payment within the prescribed times.*—For the prescribed payments and times, see the Patents Rules, 1892, p. 709.

A payment is within the prescribed time if made before midnight on the anniversary of the day of the date of the patent: *Williams v. Nash* (1859), 28 Beav. 93; 28 L. J. Ch. 886. **Sect. 17.**

6 *Application for enlargement of time.*—For form of application, see Patents Rules, 1890, Form K., p. 813.

As to contents of application, see Patents Rules, 1890, rule 49, p. 699.

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]

Amendment of specification.

18. (1.) An applicant or a patentee[2] may from time 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.

(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,[12a] and shall determine whether and subject to what conditions,[13] if any, the amendment ought to be allowed.

(5.) When 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 comp-

Sect. 18. troller, 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,[13a] 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[16a] be deemed to form part of the specification.

Repealed. Act 1888, sect. 5. (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.*

Act 1888, sect. 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]

1 *Amendment of specifications.*—See on the whole subject Chap. VII., p. 211. For the practice under this and the following section, see Patents Rules, 52 *et seq.*, *post*, p. 700, also Law Officers' Rules, *post*, p. 713.

After publication of the specification proceedings to amend under sects. 7 and 9 are improper: *Jones's Patent* (1816), Griff. P. C. 313.

True reading of sects. 18–21. The true reading of sects. 18—21 was given by A. L. Smith, J., *In the matter of Hall and Others* (1888), 21 Q. B. D. 137; 5 R. P. C. 312:—"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."

2 *An applicant or a patentee* :—

For practice under this section, see Patents Rules, 1890, rule 52, p. 700.

For definition of "patentee," see note to sect. 46. Under that definition a grantee who had wholly parted with his interest in a patent could not, it would seem, apply under sect. 18, sub-sect. 1, for leave to disclaim or amend any part of his specification. As to the position of a mortgagee and a co-owner, see *ante*, p. 219.

3 *From time to time.*—Second disclaimers are therefore permissible, but are not encouraged: *Re Haddan*, Griff. A. P. C. 13. Nor should a disclaimer be unnecessarily brought before the comptroller twice: *Re Arnold*, Griff. A. P. C. 5.

4 *By request in writing* :—

Cp. sect. 97, *infra*, and Patents Rules, 1890, rule 52, p. 700.

For form of application, see Form F, *post*, p. 810.

5 *His specification.*—This must mean his complete specification after acceptance, before which there is no publication from the Patent Office. Cp. sect. 10; but see remarks of Webster, A.-G., in *Re Jones*, Griff. 313.

6 *Disclaimer, correction, or explanation* :—

The power to amend by way of correction or explanation is new. It will be observed that the same power is not given in sect. 19.

When it is probable that a combination alone is claimed, though the language be ambiguous, it is permissible so to amend as to make it clear that a combination alone is claimed: *Allen's Patent* (drain-pipes), Griff. A. P. C. 3; *Kelly* v. *Heathman* (folding ladders) (1889), 45 Ch. Div. 256; 8 R. P. C. 343.

But if an improved method is claimed apart from particular means, the patentee cannot amend so as to insert all particular means: *Nairn's Patent* (1891), 8 R. P. C. 445; *Beck and Justice's Application*, Griff. A. P. C. 10; *Nordenfelt's Patent*, Griff. A. P. C. 18, even though the

Sect. 18. principal part be struck out: *Serrell's Patent* (1889), 6 R. P. C. 101. But if every means of carrying out the invention is claimed, and one only is stated in the specification, the generality of the claim may be restricted: *Re Ashworth*, Griff. A. P. C. 6.

The function of an explanation is to say what the patentee meant at the time of sending in his specification; it is not allowable to amend a specification in order to make it keep pace with newly discovered facts: *Re Beck and Justice*, *supra*.

If the original specification amply describes the invention, amendment by way of explanation will not usually be allowed: *Re Nordenfelt*, Griff. A. P. C. 21.

Amendment by disclaimer is not allowed as a means of turning an insufficient into a sufficient description: *Re Johnson's Patent* (1896), 13 R. P. C. 659.

The reasons are no part of the amendment.

7 *Shall be advertised in the prescribed manner*:—

Advertisement in the Official Journal of the Patent Office is required (Patents Rules, 1890, rule 52, p. 700).

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.

Want of advertisement was one of the grounds upon which the amendments were disallowed in *Re Jones*, Griff. 313.

In *Fabenfabriken* v. *Bourker* (1891), 8 R. P. C. 389, Romer, J., refused to upset an amendment on the ground of non-advertisement, saying that he could not go behind the comptroller-general's amendment.

8 *Any person*:—

In *Bell's case*, Griff. A. P. C. 10, the comptroller seems to have decided that this means a person who has an interest in opposition, but *quære*; and contrast the language of sub-sect. 4.

9 *Notice of opposition, &c.*:—

Cp. Patents Rules, 1890, rule 53, p. 701.

There is no limitation upon the *grounds* of opposition.

The notice should be signed.

10 *The comptroller shall give notice.*—For practice, see Patents Rules, 1890, rule 53, p. 701.

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: *Hearson's Patent* (1884), Griff. 309. It is better to give leave than to refuse in doubtful cases, as the amendment is taken at the applicant's peril: *Re Bell*, Griff. A. P. C. 10; *Re Lake*, *ibid.* 16. Evidence may be heard; the regulations as to declarations will be found in Patents Rules, 1890, rules 56, &c., *post*, p. 702. The evidence before the law officer should be the same as that used before the comptroller: Law Officers' Rules, rule 8. The law officer may compel attendance for cross-examination. See Law Officers' Rules, rule 9, *post*, p. 716. It is not obligatory to file declarations: *Re Rylands*, 5 R. P. C. 665. Unnecessary declarations will be discouraged: per Lockwood, S.-G., 12 R. P. C. 102.

The comptroller cannot, however, give costs. See *ante*, p. 231.

The law officer can give costs. See *infra*, sect. 38. He usually makes the unsuccessful party pay costs: *Re Haddan*, Griff. A. P. C. 13; but he neither gives costs to the comptroller nor makes him pay them, either directly, or by way of condition; but he may impose a pecuniary condition otherwise than by way of costs: *Re Lake*, Grift. A. P. C. 17.

12 *The law officer shall, if required, &c.*—For practice under this sub-section, see the Law Officers' Rules, *infra*, p. 713.

12a It is not every person who may oppose before the law officer, *aliter* before the comptroller. See sub-sect. 2.

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. In view of sect. 20, this is not usually imposed unless the patent was one granted before 1884; and even then *quære: Re Ashworth*, Griff. A. P. C. 6; *Re Allen*, Griff. A. P. C. 3. In *Re Ainsworth* (1895), 13 R. P. C. 76, Finlay, S.-G., refused to make the amendment conditional on the patentee undertaking neither to bring action nor to threaten in respect of acts done prior to amendment, but he thought he had power to do so.

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?

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Had there been a long prior user? Had manufacturers embarked capital in making and dealing with it? Cp. *Harrison's Patent* (1853), Macr. P. C. 31; *Smith's Patent* (1855), *ibid.* 232, 234; *Tranter's Patent* (1873), Johns. P. M. 191. As to time whence amendment dates when condition is accepted, practice as to recording of the condition, &c., see *Andrew* v. *Crossley* (1892), 1 Ch. 492; 9 R. P. C. 165; also for refusal of condition (1892), 1 Ch. 498.

13a The comptroller may appear, but will ordinarily neither get nor pay costs.

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.

An amendment which merely removes ambiguity is unobjectionable: *Moser* v. *Marsden* (1894), 10 R. P. C. 350. See note 6 above.

At one time the tendency was to allow an amendment at the patentee's risk, but the decision in *Moser* v. *Marsden* (13 R. P. C. 24; and see note 16a, *infra*) has caused the law officers to be more difficult to satisfy. And see *Re Parkinson* (1896), 13 R. P. C. 509.

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. Does it debar the Court from inquiring whether the amendment claims an invention substantially larger than, or different from, that claimed in the original specification? See *Farbenfabriken Co.* v. *Bowker* (1891), 8 R. P. C. 389; *Van Gelder's Patent* (1890), per Esher, M. R., 6 R. P. C. at p. 27. It has been said that the Attorney-General cannot make a valid amendment if the effect is to substantially enlarge the invention, or make it a different invention. That is by virtue of sect. 18, sub-sect. 8. Now, however, it is clear that an amendment, when once allowed by the law officer, is conclusive. See *Moser* v. *Marsden*, in the House of Lords, 13 R. P. C. 24; and see *ante*, pp. 231, 232.

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: *Re Berdan's Patent* (1875), 20 Eq. 346.

16a "For all purposes" must now be taken to mean that an amendment once made by the law officer is unimpeachable: *Moser* v. *Marsden* (1896), 13 R. P. C. 24.

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? *Cochrane's Patent* (1885), Griff. P. C. 305.

(2) Did they include only actions for infringement and proceedings for revocation? *Cropper* v. *Smith* (1884), 1 R. P. C. 254; and *In re Hall and Others* (1888), 21 Q. B. D. 137; 5 R. P. C. 306.

As to the construction of sects. 18—21, see general note above, p. 586.

18 *Pending.*—This means action before judgment in the High Court of Justice. See definition of "Court," sect. 117, sub-sect. 1. Therefore the provisions of sect. 18 apply after judgment pending appeal: *Cropper* v. *Smith*, 28 Ch. D., per Chitty, J., at p. 151. In *Farbenfabriken, &c., Co.* v. *Bowker* (1891), 8 R. P. C. 389, Romer, J., refused to go into the question whether an action was pending when leave to amend was granted. He said he could not go behind the comptroller-general's amendment. If the comptroller gives leave to amend upon a condition accepted at the hearing, see *Andrew* v. *Crossley* (1892), 1 Ch. 492; on the question of the pendency of the amendment when action is commenced, *ante*, pp. 233 *et seq.*

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[2a] 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.

If leave is obtained the procedure of sect. 18 applies so far as possible: Cave, J., in *Re Hall* (1888), 21 Q. B. D. 137; 5 R. P. C. 312; *Lang* v. *Whitecross Co.* (1890), 7 R. P. C. 389.

1 *Action for infringement.*—See Chap. XIII.

2 *Proceeding for revocation.*—See sect. 26 and Chap. XV. It seems doubtful if an amendment pending appeal can be made if the patent was revoked in the Court below, unless time for appeal was given in the judgment: *Deeley's Patent* (1896), App. Ca. 496; 13 R. P. C. 581.

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2a This means the High Court of Justice. See *post*, sect. 117. But the Palatine Court of Lancaster has jurisdiction: *Winter* v. *Baybut* (1884), 1 R. P. C. 76. The application may be made at Chambers: *Singer* v. *Stassen* (1884), W. N. 83; 1 R. P. C. 121.

3 *Disclaimer pending action.*—As to disclaimer pending action, see p. 233.

Only a power of amendment by *disclaimer* is given under this section. Cp. sect. 18, sub-sect. 1.

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, rule 58, p. 702.

The Judge has an absolute discretion in imposing terms under sect. 19: *Lang* v. *Whitecross Co.* (1890), 7 R. P. C. 389. The usual conditions imposed relate to costs, previous infringements, and using the amended specification in the action; viz., plaintiff (1) pays costs of amendment and all costs of action up to amendment (*e.g.*, *Goulard* v. *Lindsay* (1888), 5 R. P. C. 194); (2) undertakes to claim no relief for damage suffered prior to amendment (*e.g.*, *Lang* v. *Whitecross Co.* (1890), 7 R. P. C. 389); (3) agrees not to use the amended specification in the action (*e.g.*, *Singer* v. *Sassen* (1884), 1 R. P. C. 121; W. N. 83). His right to an injunction for threatened future proceedings is left to him.

Restriction on recovery of damages.

20. Where an amendment by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages[1] 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.[2]

1 An injunction would not be affected by this.

2 *Where an amendment by way of disclaimer, &c.*—For examples, see *Wenham* v. *Carpenter* (1888), 5 R. P. C. 68; *Hopkinson* v. *St. James's and Pall Mall Electric Light Co.* (1893), 10 R. P. C. 46. This section does not appear to affect the law officer's power to impose conditions under sect. 18, sub-sects. 4, 7.

Advertisement of amendment.

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

Every amendment, &c. (sect. 21).—Cp. Patents Rules, 1890, rule 59, p. 702. The amendment is advertised in the Official Journal of the Patent Office, and in such other manner, if any, as the comptroller may direct. **Sect. 21.**

COMPULSORY LICENCES.[1]

Power for Board to order grant of licences.

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 licences[2a] on reasonable terms—

(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

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

the Board may order the patentee to grant licences on such terms as to the amount of royalties, security for payment or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just,[4] and any such order may be enforced by mandamus.

1 *Compulsory licences.*—As to voluntary licences and assignments, see *ante*, p. 300.

The provisions of this section are new, and apparently only refer to patents applied for since January 1st, 1884.

For practice under it, see Patents Rules, 1890, rules 60—66 inclusive.

History of the compulsory licence 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 1864.

The Committee of 1864 reported against compulsory licences, apparently on two grounds: (1) that the exceptional instances in which patentees were unwilling to grant licences 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

Sect. 22. 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 advised the insertion of a compulsory licence 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.

The difficulty is not to compromise the rights of the owner in his invention, and at the same time to obviate the objection commonly raised against patent right in inventions, that it gives an opportunity for the acquisition of patents for obstructive purposes. But for this section a patent might be thus used to prevent a subsequent patentee of an improvement making use of his invention.

Results of compulsory licence clause.

This section has not justified the hopes of its framers, and has been practically inoperative. Up to the end of the year 1887 there was only one informal application for a compulsory licence, 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 licences rather than be forced to appear before the Board of Trade.

Scope of section.

This section does not apply to patents granted, or applications pending, *before* the commencement of this Act (sect. 45, subsect. 2); but it applies to a new patent granted after the Act by way of extension of the term of an existing patent: *Wasteney Smith's Patent* (1885), 2 R. P. C. 14. But it is difficult to understand this decision in the face of decisions under sect. 113 of Act of 1883. Of course the Judicial Committee in recommending an extension may make any conditions with regard to the patent, and among others may be liability to the compulsory licence provisions of this 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 H 1, and I, *infra*, pp. 811, 812.

2a Suppose an exclusive licence has been granted to some person, then *quære* can the Board of Trade make an order for a licence to another person? It would seem that this could be done. The holder of the exclusive licence must be presumed to know of this risk. If the exclusive licence operated as an assignment, then the application ought to be against exclusive licensee.

Proof of default in granting licences on reasonable terms is a condition precedent to order for compulsory licence. **Sect. 22.**

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 sect. 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 could 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 licence could successfully lodge a petition, according to any one of the sub-sections (a), (b), (c), without having to bring himself in any way within the other two. Meaning of working.

4 This would be a difficult matter, and would probably necessitate a reference to one of the conveyancing counsel to the Court.

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 licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed. Register of Patents.

(2.) The Register of Patents shall be *prima facie* evidence[2] of any matters by this Act directed or authorised to be inserted therein.

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

1 *Register of Patents.*—See Chap. XI., p. 309.
Inspection of and extracts from register, sect. 88.
Falsification of register, sect. 93.

Sect. 23. Powers of Board of Trade over, sect. 101, sub-sect. 1 a.

Under the Act of 1852, 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, licences, 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-sect. 1, and sect. 114, sub-sect. 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-sect. 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 under sects. 85 and 87, the documents, notification of which may now be entered on the register, must confer a legal interest. Nevertheless an equitable assignment of a patent or a share in it may be registered: *Stewart* v. *Casey* (1892), 1 Ch. 104; 9 R. P. C. 9. But the documents must be complete in themselves, and must show the assignment, otherwise they will not be registered: *Fletcher's Patent* (1893), 10 R. P. C. 252. As to the registration of mortgages, see *Van Gelder* v. *Sowerby Bridge Flour Co.* (1890), 7 R. P. C. 208; 44 Ch. Div. 374.

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* (1888), 5 R. P. C. p. 126, "to decide, and in deciding I should feel some 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, rules 67—79, *infra*, pp. 704 *et seq.*

2 *Prima facie evidence.*—The registration of a document is *prima 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: *Heap* v. *Hartley* (1888), 5 R. P. C. 609, and 42 Ch. Div. 461.

3 *Copies of deeds, &c.*—As to size of documents, see Patents Rules, 1890, rules 10, 30—33, pp. 685, 694. 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; 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.

(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. 710.

Sect. 25.

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]

(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[10] 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. **Sect. 25.** Costs.

1 As to prolongation or extension of patents generally, see Chap. XVI. pp. 496 *et seq.*

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 sect. 113. See also *Brandon's Patent* (1884), 9 App. Ca. 589; 1 R. P. C. 154, and *ante*, p. 499. 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 (*Church's Patent* (1886), 3 R. P. C. 95), 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: *In re Willacy's Patent* (1888), 5 R. P. C. 690.

An assignee will not get an extension unless the result will be directly or indirectly to the advantage of the inventor, and only then in a case when the inventor himself has been entitled: *Re Barff-Bower* (1895), App. Ca. 675; 12 R. P. C. 383; *Re Hopkinson's Patent* (1896) 14 R. P. C. 5.

3 *After advertising.*—See form of advertisement, p. 853; affidavit of advertisement, p. 854. The advertisement.

The advertisement must be proved before the application is heard: *Perkin's Patent* (1845), 2 W. P. C. 8.

In the matter of Derosne's Patent ((1844) 2 W. P. C. 1), the petitioner resided in France, but had granted licences to persons

Sect. 25. 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 with 5 & 6 Will. IV. c. 83, are still in force.

The petition.

5 *The petition.*—See forms of petition *infra*, pp. 856-8.

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 (*Clark's Patent* (1870), L. R. 3 P. C. 421); 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: *Pitman's Patent* (1871), L. R. 4 P. C. 84; *Johnson's Patent* (1871), L. R. 4 P. C. 75; *Adair's Patent* (1881), L. R. 6 A. C. 176. If he knows of a prior specification which might affect the question he should produce it: *Liret's Patent* (1892), 9 R. P. C. 327.

Time of presentation.

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. 2 & 3 Vict. c. 67, s. 2, provided that where the failure to comply with the requirement of the earlier statute was shown not to have arisen from neglect or default of the petitioner, the term of letters patent might be extended, if a petition has 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, sect. 40, adopted the provisions of the above mentioned Acts in regard to the extension of letters patent.

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: *Brandon's Patent* (1884), 9 App. Ca. 589; 1 R. P. C. 154. But in such case if his patent is posterior in date to a foreign patent granted to him for the same invention, he cannot obtain prolongation if his foreign patent has lapsed: *Jablochkoff's Patent* (1891), App. Ca. 293; 8 R. P. C. 281. *Aliter*, if the foreign patent was the later: *Semet and Solvay's Patent* (1895), App. Ca. 78; 12 R. P. C. 10.

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7 *Any person.*—There is no limitation on the right of opposition to the extension of a patent. Cp. *supra*, sect. 11, sub-sects. 1, 3; sect. 18, sub-sects. 2, 4.

Who may oppose

The Crown may adduce evidence against a patent, irrespective of the objections (*Church's Patent* (1886), 3 R. P. C. at p. 101; citing *Re Ball's Patent* (1879), L. R. 4 A. C. 173), and in *Erard's Patent* ((1835) 1 Web. P. C. 557)—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.

The Crown.

In *Re Baxter's Patent* ((1849) 13 Jur. 593), 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.

8 *Caveat.*—See form of caveat, p. 854; form of notice of objection, p. 864.

The caveat.

It appears that the caveat must be entered by the actual opponent and not by a patent grant: *Lowe's Patent* (1852), 8 Moo. P. C. 1.

Particulars of objection.

The present Act, like the repealed Acts, 5 & 6 Will. IV. c. 83, and 2 & 3 Vict. c. 67 (*Ball's Patent* (1879), L. R. 4 A. C. 171), does not require particulars of objections in extension cases, but in the matter of *Stewart's Patent* ((1886) 3 R. P. C. 7), where the opposition succeeded upon the ground of an anticipation not mentioned in the objections, the opponent's costs were disallowed.

9 *The said Committee shall proceed to consider.*—By sect. 28, sub-sect. 2, the Judicial Committee may call in the aid of an assessor, and determine his remuneration.

Judicial Committee.

The books of account produced by a patentee will be *minutely* examined by the Judicial Committee: *Perkin's Patent* (1845), 2 Web. P. C. 6. See form of accounts, *infra*, p. 861.

10 *By counsel:*

Unless parties opposing have distinct and separate interests, not more than two counsel will be heard to oppose: *In re Woodcroft's Patent* (1841), 3 Moo. P. C. 172, n.

Counsel.

In all petitions for the extension of letters patent, whether opposed or not, the Attorney-General attends on behalf of the Crown (*In re Erard's Patent* (1835), 1 Web. P. C. 557); and he so far represents the Government and the public generaliy, 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: *Pettit Smith's Patent* (1850), 7 Moo. P. C. 133.

Position of Attorney-General.

Sect. 25.

Nature and merits of invention.

11 *The nature and merits of the invention in relation to the public.*—On this subject, see Chap. XVI., p. 511.

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. They will hear a petition though an appeal be pending from the decision of a Judge declaring the patent invalid: *Lane-Fox's Patent* (1892), 9 R. P. C. 411.

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: *In re Stewart* (1886), 3 R. P. C. 9, 10; cp. also *In re Bailey's Patent* (1884), 1 R. P. C. 1; *Re Cocking's Patent* (1885), 2 R. P. C. 151, 153; also citing *Saxby's Patent*, L. R. 3 P. C. App. 294; *Beanland's Patent* (1887), 4 R. P. C. 491; *Livet's Patent* (1892), 9 R. P. C. 327. But a patent which is clearly bad will not be prolonged: *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.

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: *Re Willacy's Patent* (1888), 5 R. P. C. 690.

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: *Pieper's Patent* (1895), 12 R. P. C. at p. 293; *In re Newton's Patent* (1884), 1 R. P. C. 177; 9 A. C. 592. A licensee's profits should generally be shown; certainly if the licensee is a free licensee: *Thomas' Patent* (1892), 9 R. P. C. 367. The profits of an assignee or part assignee should be taken into the account: *Ibid.*; *Barff-Bower Patent* (1895), App. Ca. 675; 12 R. P. C. 383.

Accounts.

Under the Judicial Committee Rules, rule 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 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: *Re Bailey's Patent* (1884), 1 R. P. C. 1. Where the patentee had made a complete loss, accurate accounts were dispensed with: *Darby's Patent* (1891), 8 R. P. C. 380.

In *Re Yates and Kellett's Patent* ((1887) 4 R. P. C. 150; 12 A. C. 147; cp. *Johnson's and Atkinson's Patents* (1873), L. R. 5 P. C. 87), the petitioner failed to file his accounts within the time fixed by the

Judicial Committee Rules, rule 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: *In the matter of Deacon's Patent* (1887), 4 R. P. C. 122.

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. The absence of books tells heavily against the petition: *Lawrence's Patent* (1892), 9 R. P. C. 85. 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: *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 App. Ca. 176: *Williams* v. *Robinson* (1896), 13 R. P. C. 350. The Committee cannot be asked to undertake a minute investigation: *Lake's Patent* (1891), App. Ca. 240; 8 R. P. C. 230.

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: *Bett's Patent* (1862), 1 Moo. P. C. N. S. 49; *Trotman's Patent* (1866) L. R. 1 P. C. 118; *Lake's Patent* (1891), A. C. 240; 8 R. P. C. 230.

In estimating a patentee's expenditure, the Judicial Committee may take account of (a) the *reasonable* cost of working the patent: *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.; (b) the value of the patentee's *time* properly expended upon working his invention: *Roberts's Patent, ubi supra; Trotman's Patent* (1866), L. R. 1 P. C. 118; *Carr's Patent* (1873), L. R. 4 P. C. 539; (c) exceptional loss by litigation: *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; (d) manufacturer's profits *not due to the monopoly conferred by the patent: Galloway's Patent* (1843), 1 Web. P. C. 724; *Muntz's Patent* (1846), 2 Web. P. C. 113; and (e) costly experiments in connection with the invention: *Davies' Patent* (1894), 11 R. P. C. 28.

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

Sect. 25. be deducted: *Saxby's Patent* (1870), L. R. 3 P. C. 292; cp. also *Hills' Patent* (1863), 1 Moo. P. C. N. S. 258.

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 from deriving an adequate remuneration from the working of his patent? 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.

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 *Perkin's Patent* ((1845) 2 W. P. C. 6) "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.

Has the introduction of the patent been slow? If so, was this to be expected from its nature and the circumstances of the case (*Woodcroft's Patent* (1846), 2 Web. P. C. 18; *Carr's Patent* (1873), L. R. 4 P. C. 539), or is it in evidence of want of utility? (*Simister'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); or want of energy? *Re Pieper* (1895), 12 R. P. C. 293.

Is the public interest opposed to an extension? *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.* Is the prolongation likely to handicap English as against foreign manufacturers: see as to this *Semet and Solvay's Patent* (1895), App. Ca. 78; 12 R. P. C. 10; *Pieper's Patent* (1895), 12 R. P. C. 293.

14 *To extend the terms of the patent*—or part of it: *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 R. .P C. 102.

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 : *In re Stoney's Patent* (1888), 5 R. P. C. 519.

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 extension. 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, 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.

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. 865.

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. No fees are payable on sealing the new patent.

17 *Containing any restrictions, conditions and provisions, &c.*—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 : *Pettit Smith's Patent* (1850), 7 Moo. P. C. 133; *Hughes' Patent* (1879), L. R. 4 App. Ca. 174; *Napier's Patent* (1881), L. R. 6 App. Ca. 174.

A condition requiring the patentee to grant licences to the public was inserted in *Mallet's Patent* (1866), L. R. 1 C. P. 308; but see sect. 22 of the present Act.

In *Hardy's Patent* (1849), 6 Moo. P. C. 441, a condition to prevent

Sect. 25. 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.

Rules of practice.

18 *Rules of procedure and practice.*—No rules have yet been made. For the old rules still in force, see p. 718.

19 *Costs.*—Where there was ground for opposition, and the case was doubtful and difficult, the Judicial Committee made no order as to costs: *Church's Patent* (1886), 3 R. P. C. at p. 102.

It is unnecessary for opponents to give notice of their intention to apply for costs (*Bridson's Patent* (1852), 7 Moo. P. C. C. 499), and these will, in general, follow a successful opposition: *Westrupp and Gibbins' Patent* (1836), 1 Web. P. C. 554.

In *Wield's Patent* ((1871), L. R. 4 P. C. 89), 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: *Hornby's Patent* (1853), 7 Moo. P. C. C. 503. In *Milner's Patent* ((1854) 9 Moo. P. C. C. 39), an alternative was offered to the petitioner of paying a fixed sum for costs.

A vexatious opposition will be punished with costs: *Dournton's Patent* (1839), 1 Web. P. C. 565.

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: *Johnson's Patent* (1871), L. R. 4 P. C. 75.

In *Johnson's Patent* ((1871), L. R. 4 P. C. 75), 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 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 authorised 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,[12] 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[13] 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. XV., p. 484.

2 *Revocation.*—See Chap. XV., p. 484.

For order of revocation, see p. 852.

For order dismissing petition, see p. 853.

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-sect. 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-sect. 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*, p. 850.

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, 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: Hindmarch, p. 431.

Court.

5 *The Court.*—"Court" means, in England, the High Court of Justice for England (sect. 117, sub-sect. 1); in Scotland, the Court of Session (sect. 111, sub-sect. 1); and in Ireland, the High Court of Justice for Ireland (sect. 117, sub-sect. 1). Service of the petition cannot be made on a person domiciled abroad, but notice of the proceedings should be given him; and the Court, if satisfied that injustice will not be done by proceeding, will allow the petition to go on: see *Drummond's Patent* (1889), 43 Ch. Div. 80; 6 R. P. C. 576:

Re Goerz's & Hoegh's Patent (1896), 12 R. P. C. 370; *King & Co.'s Trade Mark* (1892), 2 Ch. 462; 9 R. P. C. 350; *Re Kay's Patent* (1894), 11 R. P. C. 279; *Re La Compagnie Générale d'Eaux Minerales, &c.* (1891), 3 Ch. 451; 8 R. P. C. 441. The defeated party may appeal to the Court of Appeal and thence to the House of Lords, as was done in *Re Deeley's Patent* (1896), App. Ca. 496; 13 R. P. C. 581. **Sect. 26.**

6 *Grounds of scire facias.*—An action of *scire facias* lay in three cases.

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 (4 Inst. 88).

7 *Authorization of petition:*

When it is desired to obtain the Attorney-General's authority under this sub-section, it is necessary to send certain papers to the Patent Clerk, at the Royal Courts of Justice, London, and these are set out *ante*, p. 488.

The Attorney-General sometimes gives or refuses his authority *ex parte*. He may give it after revocation proceedings have been actually started: *Re Dege's Patent* (1895), 12 R. P. C. 448.

In some cases he directs notice to be given to the patentee, and directs the parties to be heard before him.

The principles upon which the Attorney-General acts are stated *ante*, p. 489.

The authorization should be recited in the petition: *Glazbrook* v. *Gillatt* (1840), 9 Beav. 492.

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: *Re Avery's Patent* (1887), 36 Ch. D. 307; 4 R. P. C. 158, 159.

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 a patent, such as variance, *Vickers* v. *Siddell* (1890), 15 App. Ca. 496; 7 R. P. C. 292; *Nuttall* v. *Hargreaves* (1892), 1 Ch. 23, 28; 8 R. P. C. 450; or that the invention was not proper subject-matter:

Sect. 26. *Re Morgan's Patent* (1888), 5 R. P. C. 187; *Re Dege's Patent* (1895), 12 R. P. C. 448. But he must, as a preliminary, prove his right to a *locus standi*: *Re Dege's Patent, supra.*

9 *In fraud of his rights.*—For an example see *Re Norwood's Patent* (1895), 12 R. P. C. 214.

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: *Re Avery's Patent* (1887), 36 Ch. Div. 307; 4 R. P. C. 327.

10 *Particulars of objections.*—See notes to sect. 29, sub-sects. 2—5.

11 *The defendant shall be entitled to begin.*—If the defendant intends to take advantage of this, and if the trial be on affidavit evidence, he must file the evidence before the petitioner files his evidence: *Re Gale's Patent* (1891), 8 R. P. C. 438. But though entitled to begin, a respondent is not in the position of a plaintiff, and therefore cannot be ordered to give security for costs on the ground of foreign residence: *Re Miller's Patent* (1894), 63 L. J. Ch. 324; 11 R. P. C. 55.

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., Order XXXI. rule 1, means "petitioner," and that rule applies to petitions for the revocation of a patent: *Haddan's Patent* (1884-5), 54 L. J. Ch. 126; Griffin P. C. 109.

12 The comptroller is not bound to grant the patent under any circumstances: *Re Norwood's Patent* (1895), 12 R. P. C. 214.

13 Cf. sect. 35, *infra.*

Amendment of specification.—During revocation proceedings this is governed by sect. 19, *ante*, p. 591. But if the decision is against the patent, there would be a difficulty in amending pending an appeal, for so long as the decision remains unreversed, the patent has gone. A judgment for revocation should therefore declare the patent revoked only if notice of appeal be not given within a certain time: see *Re Deeley's Patent* (1896), App. Ca. 496; 13 R. P. C. 591.

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]

(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: sect. 45, sub-sect. 2. Such patents, are, therefore subject to the former law, which it may be interesting to trace.

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." Former law.

Now the proviso had one grave defect: 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.

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

Sect. 27. decision in *Feather* v. *Reg.* ((1865), 35 L. J. Q. B. 200; 6 B. & S. 257), 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.* ((1876), 1 App. Ca. 632), it was held that the doctrine of *Feather* v. *Reg.* did not extend to *contractors* for the public service, a decision which still holds good in the case of those patents to which sub-sect. 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.

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 It is to be observed that the majority of the powers given to the Court already exist under the R. S. C. 1883. See action of infringement, at p. 353.

2 See revocation of patents, p. 484.

3 *An assessor specially qualified, &c.:*

Scientific assessors. This power of calling in an assessor has been very rarely exercised.

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.

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 may be that this clause deprives the Court of the right to remit an action of infringement, although involving a prolonged scientific examination, to an official referee.

5 *And the action shall be tried without a jury.*—The reasons why patent cases should be tried without a jury were well summarized by Lord Selborne, L. C., in *Patent Marine Inventions Co.* v. *Chadburn* (1873), L. R. 16 Eq. 447. See p. 423.

Trial without a jury, why advisable.

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]

(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

Sect. 29. unless the same is certified by the Court or a Judge[11] to have been proven or to have been reasonable and proper,[12] without regard to the general costs of the case.[13]

1 *Action for infringement.*—See Chap. XIII. p. 353.

2 *The plaintiff.*—As to who may or should be plaintiffs, see *supra*, p. 359.

Statement of claim.

3 *Statement of claim.*—The subject is treated of under "Action of Infringement," at p. 385.

For forms of statement of claim, see Appendix, pp. 828, 829.

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.

In *Sarazin* v. *Hamel* (1863), 32 Beav. 145, 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 now required.

It may be said, generally, that a statement of claim must contain all the material allegations (with the exception of the particulars) on which the plaintiff relies: R. S. C. 1883, Order XIX. rule 4.

Particulars of breaches.

4 *Particulars of breaches.*—See *supra*, p. 392.

Form of particulars, *infra*, p. 829. There is no prescribed form.

The object of requiring particulars is to prevent surprise and avoid expense; if this be attained, the particulars will generally suffice: *Church Engineering Co.* v. *Wilson* (1886), 3 R. P. C. 127.

As regards particulars of breaches, a vendor infringer requires more particulars than a manufacturer: *Mandelberg* v. *Morley* (1893), 10 R. P. C. 256. Usually particulars "by way of example" are not allowed, but there are exceptions: See *Patent Type-Founding Co.* v. *Richards* (1860), 1 Johns. 381; *Church, &c., Co.* v. *Wilson*, *supra*; *Haslam* v. *Hall* (1887), 4 R. P. C. 203.

Generally plaintiff should state lines and pages of his specification which he says is infringed; but where the thing said to be infringed is actually exhibited in the cause, or where the case is a simple one, this may not be required: *Cheetham* v. *Oldham* (1888), 5 R. P. C. 634; *Church, &c., Co.* v. *Wilson*, *supra*; *Lamb* v. *Nottingham Manufacturers' Co.*, Seton, 557.

These matters are fully dealt with, *ante*, p. 393, &c.; for forms, see *post*, pp. 830, 833.

5 *The defendant.*—As to who may and ought to be defendants, see *supra*, p. 364.

6 *Statement of defence.*—See p. 387.

For forms of defence, see pp. 832, 833.

As to object, see above, note 4. But relatively better particulars of objections are required than of breaches, for the breaches are probably within the defendant's knowledge: *Ledgard* v. *Bull* (1887), 11 App. Ca. 648; 3 R. P. C. 390.

7 *Particulars of objections.*—For a form of particulars, see p. 833; there is no prescribed form. Particulars of objections.

For particulars of objections generally, see p. 400. The following points are noteworthy:—

They do not take the place of pleadings, and may not go beyond the defence: *Macnamara* v. *Hulse* (1842), 2 W. P. C. 128, n.; *Jones* v. *Berger* (1843), 1 W. P. C. 544. Particulars should be drafted with care, so as not to put in mere formal defences: *Morgan* v. *Windover* (1890), 7 R. P. C. 446; *Thomson* v. *Batty* (1889), 6 R. P. C. 84; but if pleading honestly, the defendant must not be hampered in setting up what he thinks right: *Nettlefolds* v. *Reynolds* (1891), 8 R. P. C. 410.

(a) *First and true inventor*: To be used when alleged plaintiff obtained the invention from somebody: *Morgan* v. *Windover* (*supra*). *Quære*, whether name of alleged true inventor can be demanded by plaintiff: *Russell* v. *Ledsam* (1843), 11 M. & W. 647.

(b) *Novelty.*—(i) Prior user; names and addresses of users and places of users are generally ordered: *Flower* v. *Lloyd* (1876), 45 L. J. Ch. 746; *Birch* v. *Mather* (1883), 22 Ch. Div. 629; 52 L. J. Ch. 392. But when general user is alleged, the particulars need not be so full: *Palmer* v. *Wagstaffe* (1853), 22 L. J. Ex. 295; *Jones* v. *Berger* (1843), 5 M. & G. 208. Date of user must be mentioned with sufficient definiteness: *Smith* v. *Lang* (1890), 7 R. P. C. 148. Also the objections should state whether the invention has been anticipated wholly or in part and which part: *Boyd* v. *Horrocks* (1886), 3 R. P. C. 285. See also *Boyd* v. *Farrar* (1888), 5 R. P. C. 33.

(ii) *Public knowledge.*—This should be alleged separately from anticipation: *Phillips* v. *Ivel Cycle Co.* (1890), 7 R. P. C. 77; books and specifications used to prove general knowledge should not be particularized: *Holliday* v. *Heppenstall* (1889), 41 Ch. Div. 109; 6 R. P. C. 320. A specification will not ordinarily be allowed as evidence of common knowledge: *Solvo Laundry* v. *Mackie* (1893), 10 R. P. C. 68.

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(iii) *Books and persons.*—References to volume, page, name of individual, &c., generally required; but see *ante*, p. 406.

(c) *Insufficiency of specification.*—(*a*) Disconformity; particulars required: *Boyd* v. *Horrocks* (1886), 3 R. P. C. 285; *Anglo-American Brush Co.* v. *Crompton* (1887), 4 R. P. C. 27. (*b*) If it is alleged that the specification does not describe the invention or method of working it, particulars will be required if they can be given: *Crompton* v. *Anglo-American Brush Co.* (1887), 35 Ch. Div. 283; 4 R. P. C. 197. (*c*) Ambiguity, if alleged, must be accompanied by particulars: *Heathfield* v. *Greenaway* (1894), 11 R. P. C. 17.

If there are several defendants the particulars given by one may be used by the other (*Smith* v. *Cropper* (1885), 10 App. Ca. 249; 2 R. P. C. 1), but not always: *Ibid.*, pp. 253, 254.

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. As to meaning of "the Court or a Judge," see *Cole* v. *Saqui* (1888), 40 Ch. Div. 132; 5 R. P. C. 489; *Shoe Manufacturers' Co.* v. *Cutlan* (1896), 1 Ch. 108; 12 R. P. C. 530.

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: *Daw* v. *Eley* (1865), 1 Eq. 38. Though where the particulars are sufficiently wide to include the new evidence tendered, it will be admitted: *Sugg* v. *Silber*, 2 Q. B. D. 493, 495; 45 L. J. Q. B. 460; *Hull* v. *Bollard* (1856), 1 H. & N. 134, 137; *Curtis* v. *Platt* (1866), 35 L. J. Ch. 852.

Amendment of particulars.

9 *Amendment of particulars.*—See p. 410, and note the following:—The Court of Appeal has power to allow amendment of particulars: *Shoe Machinery Co.* v. *Cutlan* (1896), 1 Ch. 108; 12 R. P. C. 530. Any amendment may be allowed, if the other side can be compensated by costs: *Cropper* v. *Smith* (1884), 26 Ch. Div. 700; 1 R. P. C. 96. The application may be made at any time, even at the trial: *e.g.*, *Allen* v. *Horton* (1893), 10 R. P. C. 412. The Court may, and generally will, refuse leave to a defendant unless he agrees to allow plaintiff to elect to discontinue, and to pay plaintiff's costs incurred since the delivery of the unamended particulars if the action is discontinued: *Edison Telephone Co.* v. *India Rubber Co.* (1881), 17 Ch. Div. 137; *Ehrlich* v. *Ihlee* (1887), 4 R. P. C. 115. But the rule is not invariable: *Wooley* v. *Broad* (1892), 2 Q. B. 317; 9 R. P. C. 429.

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 If the Court of Appeal reverses the Judge below it may grant the certificate: *Cole* v. *Saqui* (1888), 40 Ch. Div. 132; 5 R. P. C. 41. In the House of Lords, see *Morris* v. *Young* (1894), 12 R. P. C. 455. See also R. S. C. 1883, Order LVIII. rule 4. If the Court dismisses the appeal, there seems a question whether it has power to make the order; *semble*, there is no jurisdiction to interfere with the order of the Judge below as to particulars allowed by him: *Cassel Gold Co.* v. *Cyanide Recovery Co.* (1895), 12 R. P. C. 303. The Palatine Court of Lancaster may give the certificate: 53 & 54 Vict. c. 23, s. 3.

12 It is not necessary that the particulars should have been actually proved; the certificate may be given if they are reasonable and proper: *Phillips* v. *Ivel Cycle Co.* (1890), 7 R. P. C. 77; *Cassel Gold Co.* v. *Cyanide Recovery Co.*, *supra*. The Court cannot grant the certificate unless it has materials on which it may form an opinion that the particulars are reasonable and proper: *Longbottom* v. *Shaw* (1889), 43 Ch. Div. 46; 6 R. P. C. 510 (plaintiff's case broke down before particulars of objection could be brought before the Court; certificate refused); *Mandelbery* v. *Morley* (1895), 64 L. J. Ch. 245; 12 R. P. C. 35 (plaintiffs at trial elected to have action dismissed; particulars of objection not certified); *Middleton* v. *Bradley* (1895), 2 Ch. 716; 12 R. P. C. 390 (plaintiff discontinued; particulars of objections not certified). But if the cross-examination shows the particulars to be reasonable (*Longbottom* v. *Shaw*, *supra*), or interlocutory proceedings have enabled the Court to form an opinion (*Middleton* v. *Bradley*, *supra*), the particulars may be allowed. The Court will not undertake inquiry unnecessary to the decision, merely to see whether the particulars are reasonable: *Boyd* v. *Horrocks* (1889), 6 R. P. C. 162; *Longbottom* v. *Shaw* (1889), 6 R. P. C. 143. See also *Germ Milling Co.* v. *Robinson* (1886), 3 R. P. C. 254; *Albo-Carbon Light Co.* v. *Kidd* (1887), 4 R. P. C. 539. See also *Boake* v. *Stevenson* (1895), 12 R. P. C. 228, in which discontinuance was allowed on terms that plaintiff should pay the costs of particulars of objections.

13 *Without regard to the general costs of the case.*—According to Stephen, J., in *Haslam Co.* v. *Hall* ((1888), 5 R. P. C. 26), 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.

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,

Sect. 30. and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a Judge may see fit.

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* (1874). 30 L. T. N. S. 244.

"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."

But an interlocutory injunction will be refused (1) if there be substantial doubt as to infringement; or (2) if there be unnecessary delay in the application for an injunction; or (3) if the plaintiff has acquiesced in the infringement; or (4) if the balance of convenience is against it, especially if defendant offers to keep an account. These propositions are dealt with *ante*, p. 370.

A plaintiff must apply promptly after discovery of an alleged infringement, in order to obtain an interlocutory injunction to restrain it: *Thomson* v. *Batty* (1889), 6 R. P. C. 84.

Perpetual injunction.

A perpetual injunction may be granted by the Court (but not against a third party: *Edison* v. *Holland* (1889), 41 Ch. Div. 28; 6 R. P. C. 233), where the plaintiff has established the validity of his patent and the fact of infringement (*Hill* v. *Evans* (1862), 31 L. J. Ch. 457; 4 De G. F. & J. 289), and may be obtained by motion in Court (*Morrell* v. *Pearson* (1849), 12 Beav. 284), or by order in Chambers (Judicature Act, 1873, sect. 39; see *Frearson* v. *Loe* (1878), L. R. 9 Ch. D. 48; 26 W. R. 138; cp. also R. S. C. 1883, Order LIV. rule 12; and Order LV. rule 15) where the defendant is willing to submit to the plaintiff's demands without bringing the action to trial.

If, however, there be no threatened danger to plaintiff's rights the injunction is often refused. If the patentee amends his specification, he cannot enforce an injunction already obtained: *Dudgeon* v. *Thompson* (1879), 3 App. Ca. 34; nor will he usually be allowed to continue a pending action to get an injunction: see *Mayer* v. *Sherwood* (1890), 7 R. P. C. 283; and cf. R. S. C. 1883, Order L. rules 3 to 6.

If the plaintiff is unable to prove an infringement, but proves a *clear* intention on the part of the defendants to infringe, he is entitled to an injunction: *Frearson* v. *Loe* (1878), 9 Ch. Div. 65; *Dowling* v.

Billington (1870), 7 R. P. C. 191. But see *Shoe Machinery* v. *Cutlan* (1896), 12 R. P. C. at p. 358; whence it appears that to enable the plaintiff to succeed on this ground the claim must clearly be for an injunction for threatened future breaches, and not merely for past breaches.

8 *Inspection.*—See *supra*, p. 413.
Form of order for inspection, p. 838.

Inspection, when ordered by.

Before ordering inspection the Court must be satisfied (1) that there is a *primâ facie* case to be tried (*Piggott* v. *Anglo-American Telegraph Co.* (1868), 19 L. T. N. S. 46); and (2) that the inspection demanded will probably, and not merely possibly (*Smith* v. *London and Great Western Railway Co.* (1854), Macr. P. C. 223; *Germ Milling Co.* v. *Robinson* (1886), 3 R. P. C. 13) yield something material to the case of the party demanding it (*Piggott* v. *Anglo-American Telegraph Co.*, *ubi supra*), and (3) will not be oppressive to the other party: *Singer Manufacturing Co.* v. *Wilson* (1865), 5 N. R. 505.

Inspection of trade secrets.

That an inspection will lead to the disclosure of trade secrets is not a sufficient ground for refusing it (*Renard* v. *Levinstein* (1884), 10 L. T. N. S. 94); but the Court will take steps to prevent the inspection being used to the prejudice of the defendant (*Russell* v. *Crichton* (1837), Ct. Sess. 1270), 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 (*Howe* v. *Lloyd* (1876), W. N. 230. Sometimes the Court causes a secret process to be disclosed *in camera*: *Badische, &c.* v. *Levinstein* (1884), 24 Ch. Div. 156.

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-sect. 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: *Drake* v. *Muntz's Metal Co.* (1886), 3 R. P. C. 43; Griff. 79.

Inspection can only be ordered when the property is under the control of the party, or can be produced for inspection by him: *Garrard* v. *Edge*, 50 L. J. Ch. 397; 6 R. P. C. 372; *Ryland* v. *Ashley's Bottle Co.* (1890), 7 R. P. C. 175. The order is discretionary: *Race* v. *Chance* (1890), 7 R. P. C. 275. It is often mutual: *Germ Milling Co.* v. *Robinson* (1885), 55 L. J. Ch. 287; 3 R. P. C. 11.

The application should not be *ex parte*, and should, in the Queen's Bench Division at any rate, be made in the general summons for directions; see Order XXX. rule 2. But the application may be

Sect. 30. made at any time after the issue of the writ, or by a defendant after appearance: R. S. C. 1883, Order L. rule 6.

The Court may order an expert to make a report to the Court itself: *e.g.*, *Badische, &c.* v. *Levinstein* (1884), 24 Ch. Div. 156; 2 R. P. C. 73; *British Rubber Co.* v. *Mackintosh and Co.* (1894), 11 R. P. C. 447.

Account of profits.

3 *Account.*—See above, p. 442.

Any Division of the High Court of Justice may order an account of profits against a person infringing patent rights: R. S. C. 1883, Order XVI. rule 1; but the plaintiff must elect between such an account and damages: *Neilson* v. *Betts* (1871), 2 L. R. 5 H. L. 1. 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.

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*, 5 R. P. C., at p. 436.

4 *Terms.*—Inspection was allowed in one case on payment of the costs in any event: *Michell* v. *Darley Colliery Co.* (1883), 10 Q. B. D. 457; 52 L. J. Q. B. 394.

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.

1 *Quære* in a threats action: *Kurtz* v. *Spence* (1888), 5 R. P. C. 184; *Crampton* v. *The Patents Investment Co.* (1888), 5 R. P. C. 404.

2 The application may be made in Chambers, or more properly at the trial. The Court of Appeal may grant the certificate: see *Cole* v. *Saqui* (1889), 40 Ch. Div. 132; 6 R. P. C. 41. Also see *Incandescent Light Co.* v. *De Mare, &c., Syndicate* (1896), 13 R. P. C., at p. 579.

3 The certificate is discretionary; there is no appeal from a refusal: *Haslam* v. *Hall* (1888), 20 Q. B. D. 491; 5 R. P. C. 144.

[4] If there is no defence it is an open question whether the Court should grant a certificate: see *Peroni* v. *Hudson* (1884), 1 R. P. C. 263 (refused); *Haydock* v. *Bradbury* (1887), 4 R. P. C. 75 (granted). And see other cases quoted *ante*, p. 449.

[5] A second action was held not to be a subsequent action within this section, so as to entitle the plaintiff to solicitor and client costs, where it was commenced before the certificate was given in a former action: *Automatic Weighing Co.* v. *International Hygienic Society* (1889), 6 R. P. C. 480.

See form of certificate of validity, p. 841.

[6] If the only question in the second action is infringement, the certificate will not always entitle to solicitor and client costs: *Automatic, &c.* v. *International, &c.*, *supra*. And see cases *ante*, p. 450, n. If validity is impeached on different grounds to those set up in the first action, solicitor and client costs are often not allowed: *Otto* v. *Steel* (1886), 3 R. P. C. at p. 120. As to granting certificate where validity is upheld, but plaintiff fails on the question of infringement, see *Automatic Weighing Co.* v. *Knight* (1889), 6 R. P. C. 120; *Morris* v. *Young* (1895), 12 R. P. C. at p. 465.

A certificate is not given to a successful defendant: *Badische, &c.* v. *Levinstein* (1885), 29 Ch. Div. 366, 419.

Remedy in case of groundless threats of legal proceedings.

32. Where any person[1] claiming to be the patentee[2] of an invention, by circulars, and advertisements, or otherwise[3] threatens any other person[4] with any legal proceedings or liability in respect of any alleged manufacture, use, sale or purchase[5] of the invention, any person or persons aggrieved[6] thereby may bring an action against him, and may obtain an injunction[7] against the continuance of such threats, and may recover such damage[8] (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[9] of any legal rights[10] of the person making such threats:[11] Provided[12] that this section shall not apply[13] if the person making such threats[14] with due diligence[15] commences and prosecutes[16] an action for[17] infringement of his patent.

See *ante*, Chap. XIV., p. 470, and for forms see *post*, Appendix, pp. 847 *et seq.*

Sect. 32. This section is not retrospective: *Sugg* v. *Bray* (1885), 2 R. P. C. 223.

The law as it existed independently of this section was thus stated in *Halsey* v. *Brotherhood* ((1881) 15 Ch. Div. 514, affirmed 19 Ch. Div. 386; 49 L. J. Ch. 514):—"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 generally lie: *Dicks* v. *Brooks* (1880), 15 Ch. Div. p. 39. See also *Wren* v. *Wield* (1869) L. R. 4 Q. B. 730; 38 L. J. Q. B. 327.

Construction of present section.

This section contemplates final judgment. This appears from the circumstance that it speaks of damages which could not be obtained on an interlocutory application: *Challender* v. *Royle* (1887), 36 Ch. Div., at p. 434; 4 R. P. C. at p. 371.

1 "Person" includes a body corporate. See sect. 117.

2 "Patentee" means the person for the time being entitled to the benefit of a patent: sect. 46.

3 The word "otherwise" is not to be cut down in accordance with the *ejusdem generis* rule of construction: *Driffield and East Riding Pure Linseed Cake Co.* v. *Waterloo Mills Cake Co.* (1886), 31 Ch. Div. 636; 3 R. P. C. 46; *Crampton* v. *Patents Investment Co.* (1888), 5 R. P. C. 393; *Skinner* v. *Shew* (1892), 1 Ch. 413; 10 R. P. C. 1. Thus a private interview or a letter from the alleged patentee may be a threat: *Willoughby* v. *Taylor* (1894), 11 R. P. C. 45; though it be marked "without prejudice:" *Kurtz* v. *Spence* (1888), 5 R. P. C. 161, 173; so may a solicitor's letter: *Combined Weighing and Advertising Machine Co.* v. *Automatic Weighing Machine Co.* (1889), 42 Ch. Div. 665; 6 R. P. C. 502; and a letter in reply to an inquiry may be enough to found a threats action under this section: *Skinner* v. *Shew* (1892), 1 Ch. 413; 9 R. P. C. 406; 10 R. P. C. 1. The threat has the same legal effect whether it be addressed to the party alleged to be infringing or to third parties: *Skinner* v. *Shew*, *supra*; see also the threats in *Taylor* v. *Willoughby*, *supra*.

But a patentee is entitled to issue a warning not to infringe,

provided there be no threat which can be pointed to as affecting any particular person or transaction. The threats alleged in the following actions should be read and compared and from the decisions the limits which cannot safely be passed can be deduced: *Challender* v. *Royle* (1887), 36 Ch. Div. 425, 434, 441; 4 R. P. C. 363; *Johnson* v. *Edge* (1892), 2 Ch. 1; 9 R. P. C. 142. In the former case, as reported in 4 R. P. C., Bowen, L. J., said: "Supposing 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 whole gist of what he has done is to apply that threat to a particular person and a particular act." And see below, note 5 to this section.

4 See note 1, *supra*. A solicitor's letter to one person has been treated as a threat by another person: *Barrett* v. *Day* (1889), 43 Ch. Div. 435; and threats addressed to a plaintiff or to a third party may both be within the section: *Skinner* v. *Shew* (1892), 1 Ch. 413; 10 R. P. C. 1.

5 These words have caused difficulty, and have given rise to the idea that the threats cannot be within the section if they are not such as refer to infringements which have actually taken place; the section does not here refer to intended acts. The law may be stated thus: a threat comes within this section if the threat refers to an alleged actual infringement, or to an intention which, if carried out, would be an actual infringement, assuming for this purpose the validity of the patent. Whether a threat is a threat within the meaning of this section, or a mere warning, is a difficult question of fact. In *Challender* v. *Royle* (1887), 36 Ch. Div. 425; 4 R. P. C. 371, Bowen, L. J., used words which might bear the interpretation that threats against future acts cannot be within this section; but these remarks have been explained in subsequent cases: see *Kurtz* v. *Spence* (1888), 5 R. P. C. at p. 171, and *Johnson* v. *Edge* (1892), 2 Ch. 1; 9 R. P. C. 142, 149.

But even if the words literally construed refer only to future or contingent events, in reality they are "threats" within the meaning of this section if they refer to acts already done or immediately intended to be done: *Challender* v. *Royle*, *supra*; *Willoughby* v. *Taylor* (1894), 11 R. P. C. 45.

6 A person other than the person threatened may be a person aggrieved; *e.g.*, A. threatens B. that if B. uses C.'s goods he will proceed for infringement; C. can bring the action against A. under this section: *Johnson* v. *Edge* (1892), 1 Ch. 1; 9 R. P. C. 142;

Sect. 32. *Willoughby* v. *Taylor* (1894), 11 R. P. C. 45; *Kensington, &c., Electric Lighting Co.* v. *Lane-Fox Electric Light Co.* (1891), 2 Ch. 573; 8 R. P. C. 277. If the threat is general in its nature, it would seem that any person who can show that the trade would take it that the threat was aimed at such person would be a person aggrieved. The limit case in this respect so far is *Johnson* v. *Edge*, *supra*. Cf. *Apollinaris Co.'s Trade Marks* (1891), 2 Ch. 186; 8 R. P. C. 137; and see *Re Powell's Trade Mark* (1894), A. C. 8; 11 R. P. C. 4.

7 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: *Challender* v. *Royle* (1886), 36 Ch. Div. 425, 436; 4 R. P. C. 371. (*Walker* v. *Clarke* (1887), 4 R. P. C. 11, *contrâ*, is no longer law.)

If an interim injunction be granted, it will not necessarily be on the condition of an undertaking as to damages: see *Fenner* v. *Wilson* (1893), 2 Ch. 656; 62 L. J. Ch. 984. Where there was no intention of repeating the threats, an interlocutory injunction was refused: *Mackie* v. *Solvo Laundry Co.* (1892), 9 R. P. C. 465.

A perpetual injunction will usually be granted at the trial if the plaintiff proves his case, but it is not a matter of absolute right; the ordinary considerations as to the granting of injunctions will be regarded: *Edlin* v. *Pneumatic Tyre, &c., Co.* (1893), 10 R. P. C. 311, 316.

If the threats are long continued, and the threatened party stands by and does nothing, the right to an interlocutory injunction is difficult of attainment: *Ibid.*

8 Damages are allowed only when actual damage has been sustained: *Driffield Linseed Cake Co.* v. *Waterloo Mills Cake Co.* (1886), 31 Ch. Div. 638, 644; 3 R. P. C. 46. The amount will be a rough estimate: *Ungar* v. *Sugg* (1892), 9 R. P. C. 113. In *Kurtz* v. *Spence* (1888), 5 R. P. C. 173, 40*s.* was awarded. In *Skinner* v. *Shew* (1894), 2 Ch. 581; 11 R. P. C. 406, the loss of a contract lost owing to the threats was taken into account.

If possible, the damages should be estimated by the Judge who tries the action: *Ungar* v. *Sugg*, *supra*. But in *Johnson* v. *Edge* (1892), 2 Ch. 1; 9 R. P. C. 142, Matthew, J., referred the calculation to an official referee; usually this is the more convenient course.

9 In order to grant relief at the trial, the Court must be satisfied that, in fact, what is 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: *Challender* v. *Royle* (1887), 36 Ch. Div. 425, 435; 4 R. P. C. 363; the burden of proof will *primâ facie* be on

the plaintiff, though it may easily be thrown on to the defendant in most cases: *Ibid.*; and see *Barney* v. *United Telephone Co.* (1885), 28 Ch. Div. 394; 2 R. P. C. 173.

10 If the threatener has no valid patent he has no legal right that can have been infringed. On this it has been said—though not absolutely decided—that if the patent is invalid the plaintiff in the threats action will succeed, unless the threatener brings himself within the proviso. Chitty, J., in *Kurtz* v. *Spence* (1886), 33 Ch. Div. 579, decided that "validity" could not be raised in a threats action; this has never been actually overruled, but the opinions expressed by Cotton, Bowen and Fry, L. JJ., in subsequent cases have virtually made an end of Mr. Justice Chitty's decision. See *Challender* v. *Royle* (1887), 36 Ch. Div. 425, 435, 443; 4 R. P. C. 371; *Kurtz* v. *Spence* (1887), 36 Ch. Div. 770; 4 R. P. C. 427; also see *Herrburger* v. *Squire* (1888), 5 R. P. C. 581.

11 If one man is the legal owner of the patent, but has assigned it by equitable assignment to another, *quære* the latter cannot safely threaten: *Kensington and Knightsbridge Electric Light Co.* v. *Lane-Fox Electric Light Co.* (1891), 2 Ch. 573; 8 R. P. C. 277, does not altogether settle the point. See sect. 87 as to equitable rights, and note the definition of a patentee in sect. 46.

12 This proviso has been described as a legislative puzzle: per Kekewich, J., in *Combined, &c., Co.* v. *Automatic, &c., Co.* (1889), 42 Ch. Div. 665; 6 R. P. C. 502. The effect of it is peculiar; see next note.

13 A person aggrieved commences his action, and at the date of writ may have a very good cause of action under the section; but if subsequently with due diligence the defendant commences and prosecutes his action for infringement, the plaintiff's right of action disappears, and *semble* he will have to pay the costs of an action properly started, even though in substance he may succeed, *e.g.*, if the defendant abandons his infringement action as hopeless: *Colley* v. *Hart* (1890), 44 Ch. Div. 179; *Combined Weighing and Advertising Co.* v. *Automatic Weighing Co.* (1889), 42 Ch. Div. 665; *English and American Machinery Co.* v. *Gare Machinery Co.* (1894), 11 R. P. C. 627. And see the difficulty as expressed by Pearson, J., in *Barnett* v. *Barrett's Screw Stopper Co.* (1884), 1 R. P. C. 10.

14 Action brought by an assignor in whom the legal title to the patent still resides, is no answer if the threats are issued by the assignee: *Kensington and Knightsbridge Electric Light Co.* v. *Lane-Fox Electric Light Co.* (1891), 2 Ch. 573; 8 R. P. C. 277.

Sect. 32.

15 "Due diligence is a question of fact, and no case is a reliable guide to the decision of another on this point: *Combined Weighing, &c., Co.* v. *Automatic, &c., Co.* (1889), 42 Ch. Div. 665; 6 R. P. C. 502; *Colley* v. *Hart* (1890), 44 Ch. Div. 179; 7 R. P. C. 101. In *Herrburger* v. *Squire* (1888), 5 R. P. C. 581, the threats were issued in October, 1886; the threats action commenced November 12th, 1887; the infringement action commenced November 14th, 1887; held: not due diligence. In *Combined Weighing, &c., Co.* v. *Automatic Weighing Co.* (1889), 42 Ch. Div. 665; 6 R. P. C. 502, we find: threats, September 21st; threats action, September 27th; infringement action, September 30th; held: due diligence. See also *Challender* v. *Royle* (1887), 36 Ch. Div. 425; 4 R. P. C. 363; *Colley* v. *Hart* (1890), 44 Ch. Div. 179; 7 R. P. C. 101. In *Edlin* v. *Pneumatic Tyre Co.* (1893), 10 R. P. C. 311, three years elapsed between threat and infringement action, but the circumstances were exceptional. Where proceedings for infringement are started after the commencement of a threats action, manifestly for the purpose of getting within the proviso, the Court will not be inclined to regard the action as brought with due diligence: *Johnson* v. *Edge* (1892), 2 Ch. 1; 9 R. P. C. 142.

The infringement action may bring the case within the proviso, whether the infringement action be brought before or after the threats; the only point to be determined is, was it started and prosecuted with due diligence: *Barrett* v. *Day* (1889), 43 Ch. Div. 435; 7 R. P. C. 54.

A person against whom an action for threats is brought may sometimes wait to see if he can counter-claim for infringement, and will not run any great risk of losing the benefit of the proviso, if in fact he does counter-claim for infringement: *Colley* v. *Hart* (1890), 44 Ch. Div. 179; 7 R. P. C. 101.

Bonâ fides will not of itself bring the threatener within the proviso: *Herrburger* v. *Squire* (1888), 5 R. P. C. 581. Nor can "privilege" be set up: *Skinner* v. *Shew* (1892), 1 Ch. 413; 9 R. P. C. 406; 10 R. P. C. 1.

16 It is not requisite that the action should be carried to a successful result. In *Colley* v. *Hart*, 44 Ch. Div. 179; 7 R. P. C. 101, the threatener abandoned his infringement action, nevertheless he was held to be within the proviso. In that case, moreover, the pleadings were not hurried on by either side. In *Combined Weighing, &c., Co.* v. *Automatic, &c., Co.* (1892), 42 Ch. Div. 665; 6 R. P. C. 502, the threatener lost his infringement action, but was held to be within the proviso. But threats made after a discontinuance may be restrained: *Fusee Vesta Co.* v. *Bryant and May* (1887), 56 L. T. N. S. 136.

An action may be prosecuted with due diligence, though the length of time between each pleading appears long at first glance; *e.g.*, whether the matters in issue are complicated and the particulars numerous: *English and American Machinery Co.* v. *Gare Machinery Co.* (1894), 11 R. P. C. 627. But see *Household* v. *Fairburn* (1884), 1 R. P. C. 109; 2 R. P. C. 140.

But the action must be an honest one, really brought to test the question, and not brought collusively: *Challender* v. *Royle* (1887), 36 Ch. Div. 425, 442; 4 R. P. C. 363; *Barrett* v. *Day* (1889), 42 Ch. Div. 435; 7 R. P. C. 54. Discontinuance does not prove *mala fides*: *English and American Machinery Co.* v. *Gare Machinery Co. (supra).*

17 An infringement action against a party other than the plaintiff in the threats action may bring the threatener within the proviso; but *quære*, when none of the persons against whom the infringement action is brought were amongst the persons threatened: *Combined Weighing, &c., Co.* v. *Automatic, &c., Co.* (1889), 42 Ch. Div. 665; 6 R. P. C. 502; *Challender* v. *Royle* (1887), 36 Ch. Div. 425, 439, 442; 4 R. P. C. 367.

Practice.—Particulars of objection must be given when the validity of the patent is attacked: *Law* v. *Ashworth* (1890), 7 R. P. C. 86. The threatener must state on which patents he relied when making his threats, unless the point be clear: *Union Electric Power Co.* v. *Electrical Power Storage Co.* (1888), 38 Ch. Div. 325; 5 R. P. C. 329.

Particulars of the names of plaintiff's agents who are alleged to have been threatened may be demanded: *Dowson, Taylor* v. *Drosophore Co., Ltd.* (1894), 11 R. P. C. 536; 12 R. P. C. 95.

When an infringement and a threats action is in existence between the same parties, unless the points are raised by way of claim and counter-claim, the proper course is to stay one action by consent: *Combined Weighing, &c., Co.* v. *Automatic Weighing, &c., Co.* (1889), 42 Ch. Div. 665; 6 R. P. C. 502.

If the threatener succeeds in upholding his patent, *quære*, can he be given a certificate of validity? It should seem not, but Field, J., gave such a certificate (subject to all objections) in *Crampton* v. *Patents Investment Co.* (1889), 5 R. P. C. 382. The point was not dealt with when the case came before the Court of Appeal.

In *Willoughby* v. *Taylor* (1894), 11 R. P. C. 45, Day, J., gave a certificate that the plaintiff's particulars of objection were reasonable. *Quære*, whether this is not a matter of taxation. If the practice in actions for infringement is to be followed, it is submitted in that case the plaintiffs ought not to have had the costs of the particulars; they were not proved.

Sect. 32. For form of statement of claim, see *post*, p. 847.
For form of defence, see *post*, p. 848.
For form of order for injunction, &c., see *post*, p. 849.

MISCELLANEOUS.

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.*—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 *post*, p. 667.

Rule as to one invention.

2 *One invention only.*—Cp. Patents Rules, 1890, rule 19, p. 689. 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 (sect. 7, sub-sect. 1), nor allows an appeal to the law officer from such a refusal (sect. 7, sub-sect. 1). In fact, however, the comptroller-general does exercise this power, and appeals to the law officers have been taken from his decision. There should be no technical difficulty in this, as the comptroller can at any time take the opinion of the law officers; see sect. 95 of the Act of 1883.

The *test* by which the question of one invention is decided is "the general object of the invention:" *Jones's Patent*, 3 Griff. P. C. 265; *Hearson's Patent* (1885), *ibid.* 266; *Robinson's Patent*, *ibid.* 267.

"If you have a particular general object of an invention," said Herschell, S.-G., in *Jones's Patent*, "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." **Sect. 33.**

3 *One claim.*—The claim appears in the specification, not in the patent. 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* (1878), 3 Ex. D. 203.

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, rule 20, p. 690. Application by representative of deceased inventor.

If the applicant dies before sealing, a patent may be sealed to his executor or administrator; sect. 12, sub-sect. 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.

Sect. 35. This is substantially a re-enactment of 15 & 16 Vict. c. 83, s. 10. In the case of *Re Vincent's Patent* ((1867), L. R. 2 Ch. 341), 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. X. p. 281.

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*l*., Form N., *infra*, p. 815.

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.[5]

Law officer.

1 *The law officer* means her Majesty's Attorney-General or Solicitor-General for England; sect. 117, *infra*.

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 *viva voce* at the hearing of a petition for the Great Seal to be affixed to letters patent: *Re Gething* (1874), 9 Ch. 633. The oath is administered by the law officer himself.

Law Officers' Rules.

3 *And may from time to time make . . . . rules.*—See the Law Officers' Rules, *infra*, p. 713.

Sect. 38.
Costs.

4 *Power of law officer over costs.*—The Comptroller-General has no power over costs; the law officers have. See Opposition to Grant, p. 250. See also Law Officers' Rules, p. 713. The law officers award in general a lump sum for costs, and there is no taxation.

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, nor ordinarily to him: *Re Lake*, Griff. A. P. C. 17. Under exceptional circumstances the law officer has recommended the fees payable on appeal to be returned: Griff. P. C. 16, n. In one case (*Newman's Patent* (1888), 5 R. P. C. 279), 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 (*Aire and Calder Works and Walker's Application* (1888), 5 R. P. C. 347) the opponent, successful on appeal to the law officer, was allowed costs to cover the stamp on the notice of appeal.

The unsuccessful party is usually made to pay the costs: *Re Haddan*, Griff. A. P. C. 13. The costs allowed are usually a lump sum. The largest sum ever yet allowed on proceedings before the law officer is twenty guineas. It is not intended that they should be a complete indemnity to the successful party: *Stuart's Application* (1892), 9 R. P. C. 452. Where an application made to the Attorney-General to authorize revocation proceedings is abandoned, the law officer cannot give costs: *Martin's Patent*, Griff. 320.

5 The object of making the order a rule of Court is to enable the party obtaining an order for costs to enforce payment by any of the usual processes of execution available on orders of the High Court of Justice.

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 patent in respect of the invention or the validity of any

Sect. 39. 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, sect. 3.

It shall be lawful for her Majesty, by Order in Council,[3] from time to 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: see Form, in Appendix, p. 872. 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 (Patents Rules, 1890, rule 15, p. 686, and Form O., p. 815), 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. 872.

2 *Prescribed Notice.*—An intending exhibitor of an unpatented invention must (1) give the comptroller seven days' notice (Form O., *infra*, p. 815) 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, rule 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. 872.

Publication of illustrated journal, indexes, &c.

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]

(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.

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. These reports commence with commencement of the principal Act, Jan. 1st, 1884.

3 *Any other information.*—*E.g.*, Patent Office circular.

Abandoned application.

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 application, 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

Sect. 40. 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. 114.

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 *supra*, Chap. IV.

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.

(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] **Sect. 43.**

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: *Caldwell* v. *Vanvlissengen* (1851), 21 L. J. Ch. 97; 9 Hare 415.

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,[1] 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

Sect. 44. Secretary of State, he may at any time before[2] the application for a patent for the invention, or before publication of the specification or specifications,[3] 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[4] 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. **Sect. 44.**

(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.

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. 873.

There have been very few assignments to the Secretary of State for War under the provisions of this section. The following are instances:—12,883 of 1884, 6,168 of 1886, 3,503 of 1888, 5,614 of 1889, all of which were kept secret. But assignments where the specifications are not kept secret are more common. An example is 15,792 of 1887. 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.

[1] Apart from this section, it is perhaps doubtful if the Sovereign

Sect. 44. could take an assignment of his own grant, as it would be equivalent to a grant to himself. Hence the necessity of this provision.

2 In which case the specifications are not examined by an examiner, and the patent appears to be granted without any inquiry by the Patent Office.

3 Where the provisional specification only has been left, or before acceptance of the complete specification, the Secretary of State for War can step in when the benefit of the invention has been assigned to him.

4 Such secret specifications are kept by the comptroller personally, and not placed in the usual way on the file.

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 licences.[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-sect. 1.

1 *Existing patents.*—This section—especially sub-sect. 3 thereof—must be read to a certain extent with sect. 113, *infra*. In *Brandon's Patent* ((1884), 1 R. P. C. 154; see also *Singer* v. *Slasick*, (1884) 1 R. P. C. 121) 9 A. C. 589, where this matter was discussed

Sect. 45.

2 *Applications.*—The applications under the Act of 1852, pending at the time of the commencement of the Act of 1883, were completed under the procedure laid down in the earlier Act.

Sub-sect. 2.

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 January 1st, 1884.

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. See now schedule to rules of 1892, *post*, p. 710.

Sub-sect. 3.

5 *General effect of Act of* 1883.—This sub-section must be read with sect. 113, and, apparently, in subordination thereto.

In *Singer* v. *Stassen* ((1884), R. P. C. 121), 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 sect. 18 as to amendment, and sect. 19 as to disclaimer pending action, apply to all existing patents applied for under the Act of 1852: *Singer* v. *Stassen*, *supra*.

As to the effect of sect. 25 of the Act of 1852, providing for the filling of a British patent with any prior foreign patent, see *Blake's Patent* (1873), L. R. 4 P. C. 535; and *Winan's Patent* (1872), L. R. 4 P. C. 93.

DEFINITIONS.[1]

Definitions of patent, patentee, and invention.

46. In and for the purposes of this Act—

"Patent"[1a] 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.

Sect. 46. In Scotland "injunction" means "interdict."

1 For other definitions, see sect. 117, at p. 663.

1a *Patent.*—As to other grants by letters patent, see p. 1.

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. III.

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. See *ante*, Chap. III.

PART III.

DESIGNS.

PART IV.

TRADE MARKS.

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.

(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. Sect. 82.

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 *ante*, Chap. IV.

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.

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.*—Sir H. Leader Lack was appointed comptroller-general on the new Act coming into force.

2 *Examiners.*—See *ante*, Chap. IV.

3 As to salaries of such officers and clerks, see Comptroller-General's Reports.

Seal of Patent Office.

84. There shall be a seal for the Patent Office, and

Sect. 84. 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,[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, see Chap. XI., *ante*.

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. As regards patents, it has been decided that an equitable assignment of a patent, or share in it, may be put upon the register: *Stewart* v. *Casey* (1892), 1 Ch. 104; 61 L. J. Ch. 61; 9 R. P. C. 9. And see *Haslett* v. *Hutchinson* (1891), 8 R. P. C. 457. If the assignment is not to be found in documents complete in themselves it will not be registered: *Re Fletcher's Patent* (1893), 10 R. P. C. 252.

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 rules 11—14, *post*, p. 686. See also sect. 94, *post*.

It is stated that under this section a patent has been refused for an apparatus for a lottery: Griff. P. C. p. 30.

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[1a] 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** to any rights appearing from such register to be vested in

Act 1888, sect. 21.

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.[3]

1 *Assignment, &c.*—As to assignments and licences, see *ante*, Chap. X., and sect. 36. As to assignments to the Secretary of State for War, see *ante*, p. 635.

As to the Register, see sect. 23, and *ante*, p. 309.

See also Rules, 1890, rules 67 *et seq.*, &c., *infra*, p. 704, and Forms, p. 822.

The stamp is the same as for an original registration: see Schedule of Fees, *post*, p. 710.

Assignments should be under seal: *Re Casey's Patents* (1892), 1 Ch. 104. As to equitable assignments, see *ante*, p. 286.

1a There is jurisdiction under this section to change the name on the register when the registered owner changes his name: *Ex parte New Ormonde Cycle Co., Ltd.* (1896), 2 Ch. 520; 13 R. P. C. 475.

2 *The Register of Patents.*—See *ante*, pp. 309 *et seq.*, and note to sect. 23.

3 Trusts are not entered on the register, see *ante*, sect. 85, and note thereto. Mortgagees may be entered on the register as such; as to the effect of this, see *Van Gelder* v. *Sowerby Bridge Flour Mills* (1890), 44 Ch. Div. 374; 7 R. P. C. 208.

Under the Act a right of assignment for particular districts is given (sect. 36); but the right to assign at all depends entirely on the words of the patent. An assignee, whether of a share or of the entirety, takes the legal interest, and is not to be considered merely as a licensee: *Walton* v. *Lavater* (1860), 29 L. J. C. P. 275; 8 C. B. N. S. 162.

"In the case of a patent belonging to several persons in common," says Lindley, L. J., in his work on Partnership, "each co-owner can assign his share, and sue for an infringement, and can also work the patent himself, and gives licences to work it; and it is now settled that he is entitled to retain for his own benefit whatever profit he may derive from the working, although it is perhaps still open to question whether he is not liable to account for what he receives in respect of the licences."

Sect. 87.

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: *Chollett* v. *Hoffman* (1857), 26 L. J. Q. B. 249.

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: *London and Leicester Hosiery Co.* v. *Griswold* (1886), 3 R. P. C. 251. 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: *Briggs* v. *Lardeur* (1885), 2 R. P. C. 13.

Inspection of and extracts from registers.
Act 1888, sect. 22.

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;[1] 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 See sect. 23 and rule 78, *post*, p. 706.

2 *And certified copies.*—See sect. 96 and rule 79.

3 *Prescribed fee.*—The fee for a copy is 4*d.* per folio, but not less than 1*s.* in all. A certified copy is necessary when it is proposed to put a copy in evidence: Kekewich, J., in *Haslett* v. *Hutchinson* (1891), 8 R. P. C. 457.

If the copy is to be certified, the fee is 1*s.* for certifying, plus the cost of copying. See *post*, p. 711.

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.

The register is *prima facie* evidence of any matters by this Act directed or authorized to be inserted therein: sect. 23, sub-sect. 2.

Sect. 90.

Rectification of registers by Court.

Act 1888, sect. 23.

90. (1.) The Court[1] may, on the application of any person aggrieved[2] by the omission without sufficient cause of the name of any person[3] **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,[4] 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[5] 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[6] 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.

This section applies to all the subjects comprised in the present Act, and much information may be obtained from the cases on Designs and Trade Marks. As to costs, see *La Compagnie Générale, &c.* (1891), 3 Ch. 458.

1 The High Court of Justice in England has jurisdiction (sect. 117. *post*), even though the registered proprietor be domiciled in Scotland or Ireland: *Re King & Co.'s Trade Mark* (1892), 2 Ch. 462; 62 L. J. Ch. 153; 9 R. P. C. 356. Whether the Scotch or Irish Courts have a concurrent jurisdiction, *quære: Ibid.*

Orders made under this section can be appealed against like any other orders of Court. The order is for the purpose of notice of appeal a final one.

Service of the notice or summons on a person domiciled abroad will not be allowed; but, notice of the proceedings having been given to such persons, the Court may make the order. See *Drummond's Patent* (1889), 43 Ch. Div. 80; 6 R. P. C. 576; *Kay's Patent* (1894), 11 R. P. C. 279; *King & Co.'s Trade Mark, supra; La Compagnie Générale D'Eaux, &c.* (1891), 3 Ch. 451; 8 R. P. C. 446; and *Re Cliff* (1895), 2 Ch. 21; 64 L. J. Ch. 423. See remarks of North, J., in *Goerz's case* (1895), 12 R. P. C. 370.

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2 For those falling under the class of "persons aggrieved," see *Re Rivière's Trade Mark* (1884), 26 Ch. Div. 48; 53 L. J. Ch. 455, 578; *Re Apollinaris Co.'s Trade Marks* (1891), L. R. 2 Ch. 186; 8 R. P. C. 137; *Re Talbot's Trade Marks* (1894), 63 L. J. Ch. 264; 11 R. P. C. 77; and *Re Powell's Trade Mark* (1893), 2 Ch. 388, and (1894), A. C. 8; 10 R. P. C. 195; 11 R. P. C. 4. The whole subject is dealt with *ante*, p. 318.

The following cases under the Patent Law Amendment Act, 1852, sect. 38, will illustrate the practice :—

A patentee having assigned his patent to persons who omitted to register the assignment, afterwards *fraudulently* assigned the patent to another person, who registered it on the same day. 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: *Re Green's Patent* (1857), 24 Beav. 145.

A patentee assigned half his patent to A., and afterwards he assigned the whole to B. by deed, reciting that he had already granted a licence 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 licence referred to in B.'s assignment was the deed of assignment to A. subsequently entered: *Re Morey's Patent* (1858), 25 Beav. 581; 6 W. R. 612. 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.

One of two joint patentees 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 Horsley and Knighton's Patent* (1869), L. R. 8 Eq. 475; 39 L. J. Ch. 157.

3 This will not of itself enable a person to appeal to the Court from the refusal of the comptroller or of the Board of Trade to make an entry: *Re the Trade Mark "Normal"* (1886), 35 Ch. Div. 231; 4 R. P. C. 123.

4 Apparently this does not empower the Court to substitute the name of the true proprietor for the name of the person improperly on the register: *Re Guiterman's Design*, *infra;* and see *ante*, p. 643. North, J., said that where a registered owner of a trade mark changed

his name and desired to have the register altered so that the trade mark should stand in the new name, application might be made under sect. 87: *Ex parte the New Ormonde Cycle Co., Ltd.* (1890), 2 Ch. 520; 13 R. P. C. 475.

The costs would ordinarily have to be paid by the unsuccessful party (*e.g.*, *Guiterman's Design* (1886), 55 L. J. Ch. 309), unless that party is the comptroller, but the matter is discretionary.

6 *Ante*, p. 317.

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, 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-section relates only to trade marks.]

(d) [This relates only to designs or trade marks.]

Act 1888, sect. 24.

1 *Request in writing.*—See Form P *infra*, p. 815.

2 *Prescribed fee.*—Fee No. 34, *post*, p. 711.

92. [This section relates only to trade marks.]

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 misdemeanour.

As to punishment of misdemeanours in Isle of Man, see sect. 112, *post*.

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

Sect. 94. 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.

1 Cp. rules 11—14, *infra*, p. 686.

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-sect. 3, the comptroller acts under the superintendence of Board of Trade.

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.

See Rules, 1890, rule 79; *infra*, Form Q, p. 816.

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.

In *Trotter* v. *Maclean* ((1879), L. R. 13 Ch. D. 574; 49 L. J. Ch. 256), 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.

As to enlargement of time: Patent Rules, 1890, rule 51.

As to hours of inspection: Patent Rules, 1890, rule 78.

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

Sect. 99.

manner there is nothing to prevent the grant 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 registration. 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 Rules, 1890, rule 80, *post*, p. 707, 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.

See sect. 40.

This section re-enacts, with modifications, 16 & 17 Vict. c. 115, sect. 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, 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

Sect. 101. 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.

And see the Rules Publication Act (56 & 57 Vict. c. 66). For a discussion of the question whether the Court has power to declare the rules *ultra vires*, see *Institute of Patent Agents* v. *Lockwood* (1894), L. R. App. Ca. 347; 11 R. P. C. 374.

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.

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 prolongation to Privy Council, applications to Board of Trade for compulsory licences, &c. **Sect. 102.**

An account of the receipts and expenditure of the office.

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. Proceedings of Board of Trade. Act 1888, sect. 25.

(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 arrangements for protection of inventions, designs, and trade marks.

103. (1.) If Her Majesty is pleased to make any arrangements 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, sect. 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

Sect. 103. 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:

(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. 536.

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: *Re Carez* (1889), 6 R. P. C. 552, and see sect. 117, *infra*.

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A patent under the International Convention and sect. 103 can be granted only to the person who has made the foreign application: *Re Carez* (*supra*). A communicatee of an invention from abroad cannot claim any rights under this section: *Re Shallenberger* (1889), per Webster, A.-G., 6 R. P. C. at p. 551.

"Person" includes citizen and foreigner alike: *Re Shallenberger* (*supra*).

In *Main's Patent* (1890), 7 R. P. C. 13, Webster, A.-G., held that an applicant was entitled to have his English application antedated, although his foreign application was made before the country in which it was made had come under sect. 103.

4 *In priority to other applicants.*—See *L'Oiseau and Pierrard*, Griff. A. P. C. 36.

This section does not give a foreign applicant any right of opposing, under sect. 11, the grant of a subsequent patent: *Re Everitt* (1888), Griff. A. P. C. 28.

5 *Date of the application.*—These words were, at the instigation of Lord Herschell (*L'Oiseau and Pierrard, ubi supra*), substituted for the words in italics by sect. 6 of the Act of 1885. In one case where the foreign application was a renewed application, the seven months were allowed to date from this renewed and not from the original application: *Van Poele's Application* (1890), 7 R. P. C. 69.

6 See the International Convention, Art. 4, *post*, p. 727.

But the statute is not to be interpreted by the Convention: *Re Californian Fig Syrup Co.* (1889), 40 Ch. Div. 620; 6 R. P. C. 126.

7 See the Convention, Art. 4. The section protects against prior publication, but not against any other objection to the sealing of a patent: *Carter's Trade Mark* (1892), 9 R. P. C. 401.

Protection to this extent is granted only if the application is made under this section, in which case the patent dates back to the foreign application. If application in ordinary form is made, the patent dates from the English application, but then the protection of this section is lost; the dates will be an index to the course intended to have been pursued: *British Tanning Co.* v. *Groth* (1891), 8 R. P. C. 113.

8 See the procedure to be followed under this section in the Patents Rules, 1890, rules 24—29, pp. 691 *et seq.*

9 See table of these Orders in Council, *supra*, p. 536.

The general effect of this section and its relation to the International Convention are discussed in Chap. XVIII.

Sect. 104. 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-sect. 1.

2 *Order in Council.*—See list of such Orders in Council, *supra*, p. 536.

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 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.

A person cannot mark his invention "patented," although he has (a) applied for a patent (*Reg.* v. *Crampton* (1886), 3 R. P. C. 367), or (b) obtained provisional protection (*Reg.* v. *Wallis* (1886),

3 R. P. C. 1), unless or until a complete specification has been accepted, in which case it may be that under sect. 15 the applicant is entitled to do so. **Sect. 105.**

This section does not apply to a case of false representation of an expired patent as still subsisting: *Gridley* v. *Swinborne* (Law Journal, 1894, p. 683). Cp. *Cheavin* v. *Walker* (1877), 5 Ch. Div. 850; 46 L. J. Ch. 686; *Marshall* v. *Ross* (1869), 8 Eq. 651.

Penalty on unauthorized assumption of Royal arms.

106. Any person who, without the authority of her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connection with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

SCOTLAND, IRELAND, ETC.

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. 612.

United Horse Shoe and Nail Company v. *Stewart* (1885), 2 R. P. C. 127, and *Mackie* v. *Berry* (1885), 2 R. P. C. 146, were tried before a Lord Ordinary of the Court of Session (Lord Kinnear) and an assessor—the late Mr. Fleming Jenkin, Professor of Engineering in Edinburgh University

Sect. 108. 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. XIX.

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[1] only.

1 *Ireland.*—Prior to the Act of 1852, an English patent did not extend to Ireland or Scotland.

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 *Borill* v. *Finch* (1870), L. R. 5 C. P. 523, 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. Sect. 111.

(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 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. 465, and pp. 316 *et seq.* This section does not confer an exclusive jurisdiction on the Scotch or Irish Courts, though the registered owner be resident in Scotland or Ireland: *Re King and Co.'s Trade Mark* (1892), 2 Ch. 462; 10 R. P. C. 350.

Isle of Man.

112. This Act shall extend to the Isle of Man,[1] 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 misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court;

(3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted,

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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.

1 A patent granted under the International Convention does not extend to the Isle of Man.

Jurisdiction of Lancashire Palatine Court. Act 1888, sect. 26.

112a. [This section relates only to trade marks.]

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, sect. 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.

See also sect. 45, *supra*, and the notes thereto.

Sect. 113.

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 grantee before or at the commencement of this Act: *Brandon's Patent* (1884), 1 R. P. C. 154; 9 A. C. 589. But the patentee must take his rights subject to such limitations as prior Acts have put on them; he cannot claim the rights under a repealed Act and claim to have the advantage of the repeal of a statute which would, before 1883, have limited his right: *Re Jablochkoff's Patent* (1891), App. Ca. 293; 8 R. P. C. 281; and contrast *Semet and Solvay's Patent* (1895), App. Ca. 78; 12 R. P. C. 10.

In *Singer* v. *Stassen* ((1884) 1 R. P. C. 121 (cp. also *Hearson's Patent* (1884), Griff. P. C. 310)), 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 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., summarized 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*, 54 L. J. Ch. 1003, and *Jackson* v. *Napper*, 35 Ch. Div. 162. See also *Wittman* v. *Oppenheim*, 27 Ch. Div. 260.

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.

Sect. 114.

(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 *ante*, p. 310, 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 referred to.

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.

See Patents Rules 1890, rule 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.

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.

As to effect of patent against Crown, see sect. 27, *supra*, p. 610.

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. It would also seem to imply that a patent granted under this Act is merely

a matter of grace and not of right, even if all the provisions of the Act are complied with. Sect. 116.

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:

"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.

Sect. 117.

Register of patent agents.

Act 1888, sect. 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,[1] 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]

(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 bonâ 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[6] 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.

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, rule 73.)

2 The Court of Chancery of the County Palatine of Lancaster has jurisdiction: 53 & 54 Vict. c. 23.

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. (See an interesting paper by Mr. A. V. Newton, Fellow C. I. P. A., in Transactions C. I. P. A., vol. 1892.)

A communication with a patent agent is not privileged, though he is a solicitor: *Moseley* v. *Victoria Rubber Co.* (1886), 3 R. P. C. 355.

It is hardly necessary to add that a patent agent is liable to his principal for fraud or negligence: *Lee* v. *Walker* (1872), L. R. 7 C. P. 121.

As to lien of patent agents see Coote on Mortgage, p. 656.

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 entrusted, 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. 881 *et seq.* The rule requiring the payment of certain fees is not *ultra vires*: *Institute of Patent Agents* v. *Lockwood* (1894), App. Ca. 347; 11 R. P. C. 374.

The Institute of Patent Agents was incorporated as the "Institute of Patent Agents," as an association limited by guarantee, on the 14th August, 1882, under the Companies Acts, 1862 to 1880; and the use of the word "limited" was dispensed with by licence of the Board of Trade under the Companies Act, 1867, sect. 23.

A royal charter of incorporation has recently been applied for, in which it is proposed that Fellows 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.

6 Signing a complete specification "agent for ——," is not necessarily an offence under this section: *Graham* v. *Fanta* (1892), 9 R. P. C. 164.

SCHEDULES.

The First Schedule.

FORMS OF APPLICATION, &c.

FORM A.

Sect. 5.

£1 Stamp. Form of Application for Patent.

(This Form is replaced by Forms A, A1, Patents Rules, 1890. See pp. 805, 806.)

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 authorized 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.* 808.*)*

*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.* 808.*)*

*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.

FORM D.

Sect. 33.

FORM OF PATENT.[1]

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] Style and address (*a*).

Whereas *John Smith, of* 29, *Perry Street, Birmingham,* in the county of *Warwick, Engineer,* hath *by his solemn* Recital of declaration and invention.

(*a*) These side-notes do not appear in the Queen's Printers' copy.

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:

Petition of inventor.

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:

Recital of specification of invention.

And whereas the said inventor hath by and in his complete specification particularly described the nature of his invention:

Recital of motive.

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]

The grant to patentee, &c.

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] 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

Extent of grant.

Term 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, 1835, which was contemplated by the original forms of this schedule. By the new forms of the Patents Rules and the Act of 1883, sect. 2 (see *post*, p. 793), there is now no *solemn* declaration, if *solemn* means something beyond a simple declaration.

sole use and exercise and the full benefit of the said invention, We do by these presents for us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland and the Isle of Man that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom,. whereby to pretend themselves the inventors thereof, without the consent, licence, or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command and of being answerable to the patentee according to law for his damages thereby occasioned :[16] Provided that these our letters patent are on this condition, that if at any time during the said term it be made to appear to us, our heirs or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything hereinbefore contained :[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 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

Prohibition against infringement.

Proviso for revocation by Crown or Privy Council.

Proviso avoiding patent if renewal fees not paid.

Proviso in connection with Act of 1883, s. 27, sub-sect. 2.

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 licences 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 as to licences.

Favourable construction.

Date.

Seal.

Seal of Patent Office.[21]

Variations in the form of patent

1 *Form of patent.*—The form here given is only applicable to the case of a single inventor. It will be observed, that by the Act of 1883, sect. 33, a patent *may* be in this form. To meet rarer cases, one of the printed forms is altered in 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, as the declaration is not now made under the Statutory Declarations Act, 1835. See examples of older forms of patents, *post*, p. 883.

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.

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 B. Joint applicants.

C is the form of grant of a patent of communication, and the recitals are different. The patent runs— Form C. Importers.

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.

D is the form of grant to several applicants. It is in the plural throughout, and the recitals are slightly different. It runs— Form D. Several applicants some inventors.

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.

Form EE. Grant to executors.

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 F. Feminine.

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 G. An applicant deceased.

G.—This applies to the case of several joint applicants where one of the applicants dies. It runs—

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. For the *styles* formerly used by the kings of England in letters patent, see Co. Litt. 7 a, 7 b: 2 Inst. 1.

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.

Prior to the time of Richard II., the direction of letters patent was

as follows:—"*Omnibus archiepiscopis ducibus marchionibus comitibus episcopis, &c.*": 2 Inst. 1.

Letters patent are under seal, formerly the Great Seal, now (sect. 12, sub-sect. 1, p. 448) the seal of the Patent Office.

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. The recitals.

The words "by his solemn declaration" are now (1885, sect. 2) omitted in the form of grant, as the declaration is not now made under the Statutory Declarations Act, 1835.

Consideration for grant.

An inventor is not entitled to a patent as of right, but only by the grace and favour of the Crown. See sect. 116 of the Act of 1883. 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. Cp. *Hill* v. *Thompson* (1818), 2 B. Moo. 424, per Dallas, J.; *Brunton* v. *Hawkes* (1821), 4 B. & Ald. 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.

Utility.

An invention being "any manner of new manufacture the subject of letters patent and grant of privilege" within the meaning of the Statute of Monopolies, sect. 6, it is not necessary 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. 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. 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. 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" and to the proviso for favourable construction.

Prerogative of Crown in trade matters.

The words "our royal letters patent for the sole use and advantage of his 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.

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, 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 Crown will have been deceived by false suggestions, and the letters patent will be void.

4 *Know ye, therefore, that we, of our especial grace, certain knowledge, and mere motion.* . These words are considered *ante*, p. 273.

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: Hindmarch, 52. It seems, however, that these words are not necessary in order to make the grant binding upon the Queen's successors: Com. Dig. Grant G 3.

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: Shep. Touch. 228.

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 of letters patent, unnecessary.

Especial licence.

8 The words "especial licence, 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. 671 *et seq.* As to the position of co-owners of a patent, see pp. 277 *et seq.*

Make.

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.

11 The word *vend* has given rise to some difficulty. By sect. 1 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 sect. 6 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 sect. 1 of the statute. It seemed, therefore, that a grant of the sole right to *vend* an invention was contrary to sect. 1 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: see Hindmarch, p. 55, and cp. *Minter* v. *Wells* (1835), 4 A. & E. 251.

12 *United Kingdom of Great Britain and Ireland, and Isle of Man.*—Prior to the Patent Law Amendment Act, 1852, sect. 18, 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. Patents for Scotland and Ireland were required to be taken out under the Great Seals of these countries respectively. Extent of grant.

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, are omitted from sect. 16 of the present Act. Channel Islands.

13 In the form of letters patent which was in use before, and under 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 the invention.

Mr. Hindmarch (p. 56) 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.

Saving of rights of Crown.

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. 593), a grant of letters patent might probably be avoided as "prejudicial and inconvenient" to the Sovereign's "subjects in general," if it were made to appear to the Privy Council that the patentee was not exercising his privilege.

14 *Fourteen years.*—Patents are now always granted for fourteen years, as provided by Act of 1883, sect. 17, sub-sect. 1. But it seems the Sovereign might grant a patent for a less time. The term of a patent includes the day of its date: *Russell* v. *Ledsam* (1843-8), 14 M. & W. at pp. 574, 582.

15 *Date.*—A patent is sealed as of the day of application (1883, sect. 13). 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.

Habendum.

After the clause defining the extent of letters patent, there was formerly inserted in the grant what was technically called the *Habendum* 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.

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, *ante*, Chap. XII.

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. 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 (*Caldwell* v. *Vanvlissingen* (1851), 21 L. J.

(c. 97), 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: *Minter* v. *Williams* (1835), 4 A. & E. 251. 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. In addition to his equitable and common law remedies of injunctions and damages, a patentee was enabled by 5 and 6 Will. IV. c. 83, s. 7, to recover a penalty of 50*l.* against any person who had made an unauthorized use of his name. This statute was, however, repealed by the present Act.

See sect. 105 and notes thereon.

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. The reason for this clause being inserted is thus explained by Hindmarch. "All monopolies, except those preserved by the provisos 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.

If *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 instance of its exercise is on record, and it is difficult to see how it could be exercised. In *Reg.* v. *Eastern Archipelago Co.* (1853), 12 L. T. 35, 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 (p. 431): "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 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 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 (Shep. Abr. Prerog. sects. 6, 7), corroborated by the Statute of Monopolies 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.

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. 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 if the Sovereign by his letters patent granted the same thing to several persons, a *scire facias* would lie for the repeal of the last patent: Hindmarch, 65. As to the effect of this rule on patents for improvements see *R.* v. *Lister* (1826), Web. Lett. Pat. 80; *R.* v. *Russell*, *ibid.*

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.* This proviso applied only to assignments by act of party, and not to assignments by operation of law (*Bloxam* v. *Elsee* (1825), 6 B. & C. 169), and any number of licences, exclusive or common, might be

granted, in spite of it (*Protheroe* v. *May* (1839), 1 Web. P. C. 414). 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.

As to the fees payable by a patentee, see *infra*, p. 710. Proviso as to fees.

"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.

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 (*Ex parte Pering* (1836), 4 A. & E. 949; Cp. *Walker* v. *Congreve* (1816), 1 Coop. P. C. 356); 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.

18 As to the effect of the proviso for favourable construction, see *supra*, pp. 202 *et seq.* Favourable construction.

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: 2 Inst. 78. Name "letter patent."

Patents for inventions were always tested in the name of the Sovereign.

20 *Date.*—In *Lord Zouch and More's Case* (Godbolt, 416) 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. 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. Date.

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: 2 Inst. 555, 556; 8 Co. Rep. 186.

At the bottom was written the name of the Clerk of Patents, 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-sect. 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 (see *London Gazette*, 5th March, 1878) 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.

Sect. 47.

[Form E and Form F apply to Designs and Trade Marks.]

Sect. 24.

THE SECOND SCHEDULE

Deals with Fees on Instruments for obtaining Patents and Renewal. These are now regulated by the scale published in 1892. *See* post, *p.* 709.

Sect. 113.

THE THIRD SCHEDULE.

Enactments repealed.

21 James 1, c. 3 ... [1623.]	The Statute of Monopolies. In part; namely,— Sections ten, eleven, and twelve.
5 & 6 Will. 4, c. 62... [1835.] In part.	The Statutory Declarations Act, 1835. In part; namely,— Section eleven.
5 & 6 Will. 4, c. 83... [1835.]	An Act to amend the law touching letters patent for inventions.
2 & 3 Vict. c. 67 ... [1839.]	An Act to amend an Act of the fifth and sixth years of the reign of King William the Fourth, intituled "An Act to amend the law touching letters patent for inventions."
5 & 6 Vict. c. 100... [1842.]	An Act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
6 & 7 Vict. c. 65 ... [1843.]	An Act to amend the laws relating to the copyright of designs.
7 & 8 Vict. c. 69 ... [1844.] In part.	An Act for amending an Act passed in the fourth year of the reign of his late Majesty, intituled "An Act for the better administration of justice in his Majesty's Privy Council and to extend its jurisdiction and powers." In part; namely,— Sections two to five, both included.

Enactments repealed—continued.

13 & 14 Vict. c. 104 [1850.]	An Act to extend and amend the Acts relating to the copyright of designs.
15 & 16 Vict. c. 83... [1852.]	The Patent Law Amendment Act, 1852.
16 & 17 Vict. c. 5... [1853.]	An Act to substitute stamp duties for fees on passing letters patent for inventions and to provide for the purchase for the public use of certain indexes of specifications.
16 & 17 Vict. c. 115 [1853.]	An Act to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act.
21 & 22 Vict. c. 70... [1858.]	An Act to amend the Act of the fifth and sixth years of her present Majesty, to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
22 Vict. c. 13 ..... [1859.]	An Act to amend the law concerning patents for inventions with respect to inventions for improvements in instruments and munitions of war.
24 & 25 Vict. c. 73... [1861.]	An Act to amend the law relating to the copyright of designs.
28 & 29 Vict. c. 3... [1865.]	The Industrial Exhibitions Act, 1865.
33 & 34 Vict. c. 27... [1870.]	The Protection of Inventions Act, 1870.
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 sect. 65."
38 & 39 Vict. c. 91... [1875.]	The Trade Marks Registration Act, 1875.
38 & 39 Vict. c. 93... [1875.]	The Copyright of Designs Act, 1875.
39 & 40 Vict. c. 33... [1876.]	The Trade Marks Registration Amendment Act, 1876.
40 & 41 Vict. c. 37... [1877.]	The Trade Marks Registration Extension Act, 1877.
43 & 44 Vict. c. 10... [1880.]	The Great Seal Act, 1880. In part; namely,— Section five.
45 & 46 Vict. c. 72... [1882.]	The Revenue, Friendly Societies, and National Debt Act, 1882. In part; namely,— Section sixteen.

PATENTS RULES, 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.

Short title.

1. These rules may be cited as the Patents Rules, 1890.

For the rules repealed by these rules, see notes to rule 81.

Commencement.

Commencement.

2. These rules shall come into operation from and immediately after the 31st day of March, 1890.

Interpretation.

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.

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.

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.

Fees.—For schedule of fees, see p. 710. They are prescribed by the schedule to the Patents Rules, 1892, which replace those prescribed by this rule. See 1892, rules 4 and 5.

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 forms may also be obtained, if ordered, by post from the Controller of Stamps, Room 7, Inland Revenue Office, Somerset House, London, W.C. Certain of the forms are also usually kept on sale at certain other places.

Forms.

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. Alterations.

The forms should be used, but they are not intended to be absolutely the only forms in use: *Re Grenfell and MacEvoy* (1890), 7 R. P. C. 151. Therefore the fact that only one of two applicants signs the specification is no bar to its acceptance: *Ibid.*

Forms in Schedule to Act of 1883.—These forms are given at pp. 665 *et seq.*

Patents Rules, 1890.—These forms are given at pp. 805 *et seq.*

6. (1.) An application for a patent containing the declaration mentioned in sub-sect. 2 of sect. 5 of the Act of 1883 and sect. 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. Application.

(*b*) See sect. 24 of the Act of 1883; Patents Rules, 1890, rules 45—48.

(*c*) Cp. sect. 45, p. 638.

Specification. (2.) The Form B in such schedule of provisional specification and the Form C of complete specification shall respectively be used.

Other forms. (3.) The remaining forms 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.

Under the Patents Rules, 1883, rule 6 (1), application for a patent was made by a statutory declaration. The Patents Act, 1885, sect. 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, will not lie, as the declaration is not to be made under that Act.

General.

Hours of business. 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:—

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, sect. 98.

As to days when the Register of Patents is open to public inspection, see rule 79.

The library is open from 10 a.m. to 10 p.m. daily.

Agency. 8. An application for a patent must be signed by the applicant, but all other communications between the applicant and the comptroller, and all attendances by the applicant upon the comptroller, may be made by or through an agent duly authorized to the satisfaction of the comptroller, and, if he so require, resident in the United Kingdom.

As to patent agents, see p. 664.

For practice on applications, see also notes to sects. 4, 5, *supra*, pp. 549 *et seq.*, and chapter on Applications, p. 118.

As to applications under the International and Colonial Arrangements, see rules 24—29.

When an applicant desires to change his agent, the words, "And I hereby cancel all previous authorizations," should be inserted in the authorization of the new agent (Griff. P. C. p. 322).

For a form of authorization of agent, see p. 806.

An authorization to an agent can be given at any time during the progress of an application for a patent. The agent need not be a patent agent: *Graham* v. *Fanta* (1892), 9 R. P. C. 164.

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 thirteen inches by eight 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 rules 30—33.

Duplicates of specifications and drawings are required by the comptroller.

Exercise of discretionary power by comptroller.

Notice of hearing.

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 specification, the comptroller shall give ten days' notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before the comptroller. Statutory declarations and affidavits shall be in the form for the time being in use in the High Court of Justice.

This is practically a repetition of Act of 1883, sect. 94. See also rules 17 and 17a, *infra*.

Notice by applicant.

12. Within five days from the date when such notice would be delivered in the ordinary course of post, or such longer time as the comptroller may appoint in such notice, the applicant shall notify in writing to the comptroller whether or not he intends to be heard upon the matter.

See form of notice by applicant, Form E, *infra*, p. 809. No fee is payable.

Comptroller may require statement, &c.

13. Whether the applicant desires to be heard or not, the comptroller may at any time require him to submit a statement in writing within a time to be notified by the comptroller, or to attend before him and make oral explanations with respect to such matters as the comptroller may require.

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.

Decision to be notified to parties.

14. The decision or determination of the comptroller in the exercise of any such discretionary power as aforesaid shall be notified by him to the applicant, and any other person affected thereby.

Industrial or international exhibitions.

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 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, sect. 39; and as to foreign exhibitions, see Act of 1885, sect. 3.

Form of notice, *infra*, p. 815. The fee is 10*s*..

Form of certificate by Board of Trade, *infra*, p. 872.

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 (Act of 1883, sects. 18–21);

An application for a patent so far as clerical errors are concerned (*Ibid.* sect. 91 (a));

Drawings (*Ibid.* sects. 7 and 9);

The register (*Ibid.* sect. 91 (b));

as to all of which the comptroller-general has a special jurisdiction.

The Act gives no power for the amendment of *letters* patent, unless possibly in Act of 1883, sect. 23 (1).

In *Re Airey* ((1888) 5 P. O. R. 348), 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* ((1887) Griff. A. P. C. 35), where the notice of opposition had been signed by the opponent's agent, who died before the hearing, the name of the real opponent was allowed to be substituted.

16A. Any application, notice, or other document authorized or required to be left, made, or given at the Patent Office, or to the comptroller, or to any other person under these rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given 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 declation 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 authorized by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;

(b) In any other part of her Majesty's dominions, before any Court, Judge, justice of the peace, or any officer authorized by law to administer an oath there for the purpose of a legal proceeding; and

(c) If made out of her Majesty's dominions, before a British Minister or person exercising the functions of a British Minister, or a consul, vice-consul, or other person exercising the functions of a British consul, or a notary public, or before a Judge or magistrate.

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.

Exhibits to declarations may be retained by the declarant's agent or solicitor, but should be open to inspection of opposing party. Country agents often deposit the exhibits at the Patent Office.

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 Chap. V.

As to joint applications, see sect. 4, p. 550.

As to applications under sect. 103, see p. 653, and Rules 24—29, *infra*.

The form must be signed by the applicant, and not by an agent (Rule 8).

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, sect. 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. 119, 120.

Application for separate patents by

19. Where a person making application for a patent includes therein by mistake, inadvertence, or otherwise,

way of amendment.

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 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. 628.

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, sects. 34 and 12, sub-sect. 3 b.

As to form of grant in such cases, see p. 672.

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.

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, sect. 2, and Act of 1883, sect. 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, sect. 10. The Act of 1885, sect. 4, provides that publication shall only take place in the event of acceptance; see *ante*, p. 580. The fee for inspection is 1*s*.

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 A1 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 R. P. C. 551.

International and Colonial Arrangements.

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. 663.

Order in Council.—See list of such Orders and the States to which they are applicable, *supra*, at p. 536.

On International and Colonial Arrangements generally, see sects. 103 and 104, *supra*, at pp. 653 *et seq.*, and also at Chap. XVIII.

Foreign application.—See *Re Van de Poele* ((1890) 7 R. P. C. 69).

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 applications have been made and the official date or dates thereof respectively. The application must be made within seven 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 representatives of such dead person, as well as by the other applicants, if any.

1 *Application.*—See Form A2, *infra*, p. 807.
As to who may apply, see Rule 23.

2 *Shall specify.*—See the case of *Re L'Oiseau and Pierrard* (Griff. A. P. C. 36), and *supra*, at p. 540.

3 *Seven months.*—See International Convention, 1883, Art. 4, and Chap. XVIII.; also Act of 1883, sect. 103, p. 653.

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 Possession 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 foreign application was made, and if the specification[2] or document corresponding thereto be in a foreign language, a translation thereof shall be annexed tc and verified by such statutory declaration.

1 *Statutory declaration.*—As to manner in which, and persons before whom, such declarations may be taken, see Rule 17, *supra*, p. 688.

2 *Specification.*—The foreign and British specification need not be in the same terms if they are in substance identical (*Re L'Oiseau and Pierrard* (1887), Griff. A. P. C. 37).

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, sect. 11, sub-sect. 1 (*Re Evcritt* (1888), Griff. A. P. C. 28).

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 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 half 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 require-

ment (*b*). Reference figures and letters must be bold, distinct, not less than one-eighth 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 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.

(*b*) This drawing is not given here, but is issued with the Patents Rules, which may be purchased at the Patent Office Sale Branch. Price 6*d*.

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*, p. 199.

Opposition to Grants of Patents (*c*).

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, subject to Act of 1883, sect. 99, 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 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 in support of

(*c*) For this subject generally, see Chap. VIII.

his opposition, and on so leaving shall deliver to the applicant a list thereof.

The comptroller may extend the time under Rule 51.

Statutory declarations.—See Rule 17, *supra*, p. 688. Unnecessary declarations will have to be paid for by those who file them: *Brand's Application*, 12 R. P. C. 102.

Applicant's evidence.

38. Within fourteen days from the delivery of such list 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 fourteen 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 Rules 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

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.

Cases are heard in vacation as well as in term time.

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 therewith.

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.

Payment of fees of 50*l.* and 100*l.* for

45. *If a patentee intends at the expiration of the fourth or eighth year from the date of his patent 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 of 50*l.* *or* 100*l.* *as the case may be.* continuance of patent.

Repealed by the Patents Rules, 1892.

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."* As to patents granted before commencement of Act.

Repealed by the Patents Rules, 1892.

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* 13*th year thereof, pay the prescribed fee.* Payment of annual fees in lieu of 50*l.* and 100*l.*.

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.

Repealed by the Patents Rules, 1892.

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. Certificate of payment.

See form of certificate, *infra*, p. 813.

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.

49. An application for an enlargement of the time for making a prescribed payment shall state in detail the circumstances in which the patentee by accident, mistake, or inadvertence has failed to make such payment, and the comptroller may require the patentee to sub- Enlargement of time for payments.

stantiate by such proof as he may think necessary the allegations contained in the application for enlargement.

Cp. Patents Rules, 1883, Rule 46.
See form of such application, *infra*, p. 813.
An enlargement of time for payment may be made, subject to the following penalties:—

Not exceeding one month, 1*l.*
Not exceeding two months, 3*l.*
Not exceeding three months, 5*l.*

No enlargement is granted after three months: Act of 1883, sect. 17, sub-sect. 4 (a).
See prescribed payments, Schedule of Fees, *infra*, p. 710.

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 was new in 1890.

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. 649, as to the days for leaving documents, &c., at the Patent Office in the case of Sunday, holidays, &c.

Amendment of Specification.

Request for leave to amend.

52. A request for leave to amend a specification must 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, sects. 18–21; and Act of 1885, sect. 5; also Chap. VII.

For form of request, see p. 810.

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.

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. Notice of opposition.

See Act of 1883, sect. 18, sub-sect. 2, p. 585. 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, with a fee of 10*s*. It must be signed by the opponent, who must be "a person entitled to be heard" under Act of 1883, sect. 18, sub-sect. 4. But if the signature is not attached when the notice is sent to the comptroller, the comptroller may allow it to be added afterwards: *Re Codd*, Griff. 306.

54. On receipt of such notice the copy thereof shall be transmitted by the comptroller to the applicant. Copy for the applicant.

55. Within 14 days after the expiration of one month from the first advertisement of the application for 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. Opponent's evidence.

To the applicant, i.e., to the applicant or his authorized agent (Rule 8).

See Rule 37, *supra*, p. 696.

A party filing unnecessary declarations will be made to pay the cost in any event: *per* Lockwood, S.-G. (1895), 12 R. P. C. 102.

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, sect. 19, *supra*, p. 591.

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, sect. 21, *supra*, p. 592.
The advertisement is in the Illustrated Official Journal.

Compulsory Licences (*d*).

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 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. 811. For fees, see schedule, p. 710.

(*d*) See Act of 1883, sect. 22.

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. To be left with evidence at Patent Office.

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. Directions as to further proceedings unless petition refused.

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. Procedure. Petitioner'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. Patentee's evidence.

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. Evidence 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 (*c*).

Entry of grant.

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.

There is no entry upon the register until the patent is sealed.

Request for entry of subsequent proprietorship.

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.

Forms of request, Appendix, Form L, p. 814.

Signature of request.

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 authorized to the satisfaction of the comptroller, and in the case of a body corporate by their agent, authorized in like manner.

A body corporate may be registered as proprietor by its corporate name: Rule 74.

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. 814.

(*c*) See Chap. XI., on the Register of Patents.

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 or of the Court.

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.

As to extension of letters patent, see Act of 1883, sect. 25, *supra*, p. 598; and chapter on Extension, pp. 496 *et seq.*

As to revocation of patents, see Act of 1883, sect. 26, *supra*, p. 606; and chapter on Revocation, at p. 484.

As to rectification of register, see Act of 1883, sect. 90, *supra*, pp. 645 *et seq*.

Order in Council for extension, see form of, at p. 865.

Order of Court for revocation, see form of, at p. 852.

Entry of payment of fees on issue of certificate.

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.

See form of certificate of payment, *infra*, p. 813.

As to fees, see Act of 1883, second schedule, p. 710.

Entry of failure to pay fees.

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.

1 *Prescribed payment.*—See Schedule of Fees, 14—25, *infra*, p. 710.

2 *Prescribed times.*—See Act of 1883, sect. 17, sub-sects. 2, 3, 4, *supra*, p. 583.

3 *Enlargement.*—See Rules 49—51.

Entry of licences.

77. An attested copy of every licence granted under a patent shall be left at the Patent Office by the licensee, with a request that a notification thereof may be entered in the register. The licensee shall cause the accuracy of such copy to be certified as the comptroller may direct, and the original licence shall at the same time be produced and left at the Patent Office if required for further verification.

As to licences generally, see p. 300.

See form of request, Form M, p. 814.

For fee, see p. 711.

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 1*s.*, *infra*, p. 711, besides the cost of copying, at 4*d.* 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, sect. 99, *supra*, p. 649, as to declarations by infants, lunatics, &c.

Repeal (*f*).

Repeal. 81. All general Rules heretofore made by the Board of Trade under the Patents Designs and Trade Marks Acts, 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.

(*f*) The Patents Rules, 1890, consolidated in one set the Patents Rules of 1883, 1885, 1886, and 1888, and made 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 abolished the necessity of notice by a patentee who intends to pay annual fees in lieu of the fees of 50*l.* and 100*l.* The Rule of 1892 replaced this rule, and also revised the list of fees.

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.

PATENTS RULES, 1892.

(SECOND SET.)

By virtue of the provisions of the Patents, Designs and Trade Marks Acts, 1883–88, the Board of Trade do hereby make the following Rules:—

Short Title.

1. These Rules may be cited as the Patents Rules, 1892 (Second Set).

Commencement.

2. These Rules shall come into operation from and immediately after the 30th day of September, 1892.

Certificates of Payment or Renewal.

3. Rules 45, 46, and 47 of the Patents Rules, 1890, are hereby repealed.

Payment of Annual Fees for Continuance of Patent.

4. If a patentee intends at the expiration of the fourth year from the date of his patent to keep the same in force, he shall, before the expiration of the fourth and each succeeding year during the term of the patent, pay the prescribed fee. The patentee may pay the whole or any portion of the aggregate of such prescribed annual fees in advance.

The Form J in the Second Schedule, duly stamped, should be used for the purpose of this payment.

Fees.

5. For the fees specified in the First Schedule to the

Patents Rules, 1890, shall be substituted the fees specified in the Schedule hereto.

M. E. HICKS-BEACH,
President of the Board of Trade.

4th July, 1892.

SCHEDULE.

List of Fees Payable on and in connection 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
	On application to amend specification :—		
7.	Up to sealing. By applicant.....		1 10 0
8.	After sealing. By patentee		3 0 0
9.	On notice of opposition to amendment. By opponent		0 10 0
10.	On hearing by comptroller. By applicant and by opponent respectively		1 0 0
11.	On application to amend specification during action or proceeding. By patentee		3 0 0
12.	On application to the Board of Trade for a compulsory licence. By person applying		5 0 0

		£	s.	d.
13.	On opposition to grant of compulsory licence. By patentee	5	0	0
	On certificate of renewal :—			
14.	Before the expiration of the 4th year from the date of the patent and in respect of the 5th year.....	5	0	0
15.	Before the expiration of the 5th year from the date of the patent and in respect of the 6th year.....	6	0	0
16.	Before the expiration of the 6th year from the date of the patent and in respect of the 7th year.....	7	0	0
17.	Before the expiration of the 7th year from the date of the patent and in respect of the 8th year.....	8	0	0
18.	Before the expiration of the 8th year from the date of the patent and in respect of the 9th year.....	9	0	0
19.	Before the expiration of the 9th year from the date of the patent and in respect of the 10th year	10	0	0
20.	Before the expiration of the 10th year from the date of the patent and in respect of the 11th year	11	0	0
21.	Before the expiration of the 11th year from the date of the patent and in respect of the 12th year	12	0	0
22.	Before the expiration of the 12th year from the date of the patent and in respect of the 13th year	13	0	0
23.	Before the expiration of the 13th year from the date of the patent and in respect of the 14th year	14	0	0
	On enlargement of time for payment of renewal fees :—			
24.	Not exceeding one month	1	0	0
25.	,, two months.....	3	0	0
26.	,, three months	5	0	0
27.	For every entry of an assignment, transmission, agreement, licence, or extension of patent.....	0	10	0
28.	For duplicate of letters patent .....each	2	0	0
29.	On notice to comptroller of intended exhibition of a patent under section 39	0	10	0
30.	Search or inspection fee .....each	0	1	0
31.	For office copies, every 100 words (but never less than one shilling)	0	0	4
32.	For office copies of drawings, cost according to agreement.			
33.	For certifying office copies, MSS. or printed, each	0	1	0
34.	On request to comptroller to correct a clerical error :—			
	Up to sealing.....	5	0	0
	After sealing	1	0	0

		£	s.	d.
35.	For certificate of comptroller under section 96	0	5	0
36.	For altering address in register	0	5	0
37.	For enlargement of time for filing complete specification, not exceeding one month	2	0	0
38.	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.

4th July, 1892.

Approved :
SYDNEY HERBERT,
HERBERT EUSTACE MAXWELL,
Lords Commissioners of Her Majesty's Treasury.

LAW OFFICERS' RULES (*a*).

Rules regulating the Practice and Procedure on Appeals to the Law Officers (*a*).

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 fourteen days from the date of the decision appealed against file in the Patent Office a notice of such his intention. Notice of appeal.

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. Appeals are usually held at the Royal Courts of Justice. But the law officer sometimes takes the hearing at his private room in the House of Commons.

(*b*) Act of 1883, sect. 7, sub-sect. 2.
(*c*) *Ibid.* sect. 7, sub-sect. 6.
(*d*) *Ibid.* sect. 9, sub-sect. 2.
(*e*) *Ibid.* sect. 11, sub-sect. 2.
(*f*) *Ibid.* sect. 18, sub-sect. 3.
(*g*) *Ibid.* sect. 18, sub-sect. 6.
(*h*) *Ibid.* sect. 17.
(*i*) *Ibid.* sect. 86.
(*j*) Act of 1885, sect. 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, sect. 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. 817. The fee is £3, *supra*, p. 710.

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 Rule XIV., *infra*.

(*k*) *Re Chandler* (1886), Griff. P. C. at p. 273; *Re Cooper and Ford* (1885), *ibid.* 276.

(*l*) *Re Anderson and McKinnell* (1887), Griff. A. P. C. at p. 24.

(*m*) *Re Bairstow* (1888), per Clarke, S.-G., 5 R. P. C. at p. 286.

(*n*) *Re Hall and Hall* (1888), 5 R. P. C. 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 R. P. C. 665.

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. Transmission of papers to law officer.

V. No appeal shall be entertained of which notice is not given within fourteen days from the date of the decision appealed against, or such further time as the comptroller may allow, except by special leave upon application to the law officer. Extension of time for appealing.

The time for appealing has been extended by the comptroller-general in cases in which the parties were resident abroad. Time for appealing.

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. Notice of hearing of appeal.

The law officer does not as a rule hear appeals in vacation time.

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. To whom notice of hearing to be given.

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 Evidence before law officer.

(*o*) (1887) Griff. A. P. C. 24.

(*p*) (1888) 5 R. P. C. 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 (*q*). 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 (*r*).

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" (*s*).

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 amount

(*q*) *Re Bailey* (1884), Griff. P. C. 269.
(*r*) *Re Huth* (1884), Griff. P. C. 293; cp. *Re L'Oiseau and Pierrard* (1887), Griff. A. P. C. 36.
(*s*) Griff. P. C. p. 319.

thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained.

The law officer usually gives his decision by word of mouth at the termination of the hearing.

As to the law officer's power over costs, see Act of 1883, sect. 38, and note thereto, *supra*, p. 630. Costs.

The law officer *makes costs follow the event* in appeals if he possibly can (*t*).

The law officer usually orders a lump sum to be paid on account of costs; it is not intended that costs should be a complete indemnity against the expense incurred: *Stuart's Application* (1892), 9 R. P. C. 452.

XII. If any costs so ordered to be paid be not paid within 14 days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment under the provisions of section 38 of the Act. 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, sect. 97, *supra*, p. 648.

(*t*) *Re Anderton* (1886), Griff. A. P. C. 25; *Re Fletcher* (1887), Griff. 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.-sect. 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 immediate intention of issuing new rules. Apparently the procedure on prolongation is unaltered. 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 advertisements state the object of such petition, and give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which

day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day, notice must be given of any opposition intended to be made to the petition; and any person intending to oppose the said application shall lodge notice to that effect at the Council Office, on or before such day so named in the said advertisements, and having lodged such notice shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

This Rule relates to the 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 XVII.

In *Re Hopkinson's Patent* (1896), 13 R. P. C. 114, an intending opponent did not give notice of opposition in time, because he had not seen the advertisements, and the Board refused to extend his time.

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 specification, 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 licences, the advertisements should be inserted in papers circulating in places where the manufacture is actually carried on" (*a*).

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 (*b*).

The advertisements should be proved before the case is heard (*c*).

In *Macintosh's Patent*(*d*), 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 mean time 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, &c., see Appendix, pp. 853 *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(*e*), and in *Reece's Patent* (*f*), a supplementary statement to correct errors in a petition was allowed to be delivered before the hearing.

For forms of petition, see Appendix, pp. 856 *et seq.*

(*a*) *Derosne's Patent* (1844), 2 Web. P. C. 2. "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.*

(*b*) *In re Noble's Patent* (1850), 7 Moo. P. C. 191.

(*c*) *In re Perkins' Patent* (1845), 2 Web. P. C. 8; *Bell's Patent* (1846), *ibid.* p. 160.

(*d*) (1837) Web. P. C. 739, n.

(*e*) *In re Hutchinson's Patent* (1852), 14 Moo. P. C. 364.

(*f*) Cited by Lawson, p. 259, from Eng. Rep., Jan. to Mar. 1881, xiv.

Affidavits of advertisements.

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.

Caveats.

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.

For form of caveat, see Appendix, p. 854.

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 (*g*).

Grounds of objection.

RULE VI.—All parties served with petitions shall lodge at the Council Office, within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions.

Under this rule, it is sufficient to state the grounds, without the particulars, of the objections (*h*).

Copies.

RULE VII.—Parties may have copies of all papers lodged in respect of any application under the said Act, at their own expense.

Costs.

RULE VIII.—The registrar of the Privy Council, or other officer to whom it may be referred to tax the costs incurred in the matter of any petition presented under the said Act, shall allow or disallow in his discretion all

(*g*) *In re Hutchinson's Patent* (1861), 11 Moo. P. C. 364.

(*h*) *Ball's Patent* (1879), L. R. 4 App. Cas. 171.

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* (*i*), 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 (*k*), and is intended to enable the Attorney-General to inspect the accounts, and to make inquiries before the hearing of the petition.

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 (*l*).

In *Ball's Patent* (*m*), it was observed by Sir Barnes Peacock that the Attorney-General might introduce evidence impeaching a patent irrespective of the notice of objections.

(*i*) (1846) 2 Web. P. C. 159.

(*k*) *Johnson's and Atkinson's Patents* (1873), L. R. 5 P. C. 87; *Yates and Kellett's Patent* (1887), 4 R. P. C. 151; 12 A. C. 147.

(*l*) *Hughes' Patent* (1879), 4 A. C. 174.

(*m*) (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,

Being equally animated with the desire to secure, by mutual agreement, complete and effectual protection for the industry and commerce of their respective subjects and citizens, and to provide a guarantee for the rights of inventors, and for the loyalty of commercial transac- Recital of objects of Convention.

(a) "Industrial property" includes patents, industrial designs and models, trade marks and trade names. See, however, Clause I. of the Protocol.

We are here concerned with the Convention only in so far as it deals with designs, although the text is given in full.

(b) The original Convention was published in French, which, under Art. 6 of the Final Protocol, is the official language of the International Office. The authorized 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.

tions, 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, Sanator, 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. Sima 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 Permanent 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, Union for protection

of industrial property.

and Switzerland constitute themselves into a Union for the 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.

Date of the Convention.

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.

"Industrial property."

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.)

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.

Legal remedies.

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.

Les sujets ou citoyens de chacun des Etats Contractants jouiront, dans tous les autres Etats 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 Etat.

"Patents." Under the word "patents" are comprised the various kinds of industrial patents, recognized by the legislation of each of the Contracting States, such an 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 Etats Contractants les sujets ou citoyens des Etats ne faisant pas partie de l'Union qui sont domiciliés ou ont des établissements industriels ou commerciaux sur le territoire de l'un des Etats 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 Etats Contractants, jouira, pour effectuer de dépôt dans les autres Etats, 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 Etats 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'outremer.

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 the 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, sect. 6, substituted "*date of application*" for "*date of the protection obtained.*"

See Patents Act, 1885, sect. 103, sub-sect. 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 Etats 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 ccuntries, 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 in 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 marquee de fabrique ou de commerce régulièrement déposée dans le pays d'origine sera admise au dépôt et protégée telle quelle dans 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.

Nature of goods to be no obstacle to registration of trade mark.

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.

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.

Protection of trade names.

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.

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, sect. 3.

The form of an Order in Council granting temporary protection to designs exhibited at the Paris Universal Exhibition of 1889 is given *post*, p. 872.

ARTICLE XII.

Government Office.

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.

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.

International Bureau.

An international office shall be organized 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).

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 de l'Union.

See the Final Protocol, 5 and 6.

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.

The present Convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the Union. Conferences.

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.

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. Special arrangements between contracting parties.

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.

ARTICLE XVI.

States which have not taken part in the present Convention shall be permitted to adhere to it at their request. Adherence of other States.

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 importera, 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. 536.

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 sect. 103 of Patents Act, 1883, 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. 743, 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, sect. 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 authorized 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'Etat 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.

Article XIX.

Ratification.

The present Convention shall be ratified,[1] and the ratifications exchanged in Paris, within one year at the latest.

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-NUÑEZ.
(L.S.) P. CHALLEMEL-LACOUR.
(L.S.) CH. HÉRISSON.
(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:

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.). "Industrial property."

2. Under the word "patents" are comprised the various kinds of industrial patents recognized by the legislation of each of the Contracting States, such as importation patents, improvement patents, &c. "Patents."

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 administration of the office, which shall be communicated to all the members of the Union.

The official language of the International Office will be French.

Final Protocol to be read with Convention.

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.

In witness whereof the undersigned Plenipotentiaries have drawn up the present Protocol.

(Signed) BEYENS.
VILLENEUVE.
Duc DE FERNAN-NUÑEZ.
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 authorized 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 authorized, 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, sect. 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. 536.

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.

Sect. 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.

21 Jac. I. c. 3. [A.D. 1623 (*a*).]

An Act concerning Monopolies and Dispensations with Penal Laws, and the Forfeitures thereof. 21 Jac. I. c. 3.

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 (*b*) in print to the whole realm, and to all posterity, that all grants of monopolies (*c*), and of the benefit of any penal laws (*d*), or of power to dispense with the law (*e*), or to compound for the forfeiture (*f*), are contrary to your

(*a*) 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*)).

(*b*) 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 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.

(*c*) A monopoly is an institution or allowance by the King, by his grant, commission, or otherwise, to any person or persons, or 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*).

(*d*) 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*).

(*e*) 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."

(*f*) 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*).

Majesty's laws, which your Majesty's declaration is truly consonant and agreeable to the ancient and fundamental laws of this realm (*g*): 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 (*g*) 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 (*h*) 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 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 (*i*); or of any grant or promise (*k*) 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

(*g*) The Statute of Monopolies was simply declaratory of the common law.

(*h*) 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, *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.

(*i*) 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.

(*k*) 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.

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 use 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 (*l*).

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 now are or hereafter shall be, shall stand and be disabled and incapable to have (*m*), 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

(*l*) 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. 43, n. (*y*).

(*m*) *I.e.*, take. 3 Inst. 183.

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 saying 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 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 (*n*).

He that delayeth an action grounded upon this statute incurs a præmunire.

(*n*) 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, sect. 1.

The concluding clause of this section extends to the Judges of the Courts, and is more general than the one immediately

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 (*o*).

Letters patent heretofore granted for twenty-one years for new manufactures, saved.

[*Repealed by Stat. Law Rev. Act*, 1863.]

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 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 (*p*).

Letters patent hereafter to be granted for fourteen years, for new manufactures, saved.

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.

This Act not to extend to grants sanctioned by Parliament.

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 on Common Pleas, and barons of the

Warrants granted to justices, saved.

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.

(*o*) 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. 118.

(*p*) This proviso is very fully dealt with in Chap. III., on the Subject-matter of Patent.

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, gunpowder, great ordnance, shot, or offices, saved.

[*Repealed by Act of* 1883, s. 113.]

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 heretofore 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 (*q*).

(*q*) 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 boast-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.

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 (*r*).

This Act shall not extend to commissions for alum-mines.

[*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 heretofore 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 (*r*).

Nor to the liberties of Newcastle-upon-Tyne, nor to licences of keeping taverns.

[*Repealed by Stat. Law Rev. Act*, 1863.]

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 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 (*s*), 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.

Nor to letters patent for glass making.

[*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

Nor to grants for making smalt.

[*Repealed by Stat. Law Rev. Act*, 1863.]

(*r*) See note (*q*) on p. 750.

(*s*) 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*).

Or melting iron ore.

Baker (*t*); 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 (*u*); 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 (*v*).

5 & 6 WILL. IV. c. 83.

[This and the two succeeding sections are contained in repealed statutes, but are set out here on account of their bearing on the prolongation of letters patent.]

Prolongation of a patent.

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 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 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,

(*t*) 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 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*).

(*u*) 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 sect. 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*).

(*v*) 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. (*r*)). The importer of an invention *from abroad* is, however, its true and first inventor.

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 authorised 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.*

Repealed by 2 & 3 Vict. c. 67.

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7 & 8 Vict. c. 69.

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.

If extension of a patent term may be granted for fourteen years in certain cases.

[*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.

Less term than prayed may be granted.

15 & 16 Vict. c. 83.

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 patent shall (notwithstanding any term in such letters patent limited) cease and be void immediately upon the expiration or other determination of the term during which the patent or like privilege obtained in such foreign country shall continue in force, or 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,

Letters patent obtained in United Kingdom for patented foreign inventions not to continue in force after the expiration of the foreign patent.

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.

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

[N.B.—The words in italics have been repealed by later Acts.]

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

PART I.

PRELIMINARY.

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.

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.

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.

(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.

(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, the comptroller may require that the application, specification, or drawings be amended before he proceeds with the application.*

Repealed.

(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 applicant 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.*

Time for leaving complete specification.

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

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

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.

(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.

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*].

Repealed.

(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.

Date of patent.

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

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.

Protection by Complete Specification.

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.

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 in being 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.*]

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

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 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 Licences.

Power for Board to order grant of licences

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

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

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

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

the Board may order the patentee to grant licences on such terms as to the amount of royalties, security for payment, or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

Register of Patents.

Register of patents.

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

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

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

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 a 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 impeaching the validity of the patent, the defendant shall be entitled to reply.

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

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.

30. In an action for infringement of a patent, the Court or a Judge may on the application of either party make such order for an injunction, inspection, or account, and impose such terms and give such directions respecting the same and the proceedings thereon, as the Court or a Judge may see fit. Order for inspection, &c., in action.

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. Certificate of validity questioned and costs thereon.

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. Remedy in case of groundless threats of legal proceedings.

Miscellaneous.

33. Every patent may be in the form in the first schedule to this Act, and shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention. Patent for one invention only.

34. (1.) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative. Patent on application of representative of deceased inventor.

(2.) Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

Patent 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 to prejudice patent rights.

39. The exhibition of an invention at an industrial or international exhibition certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely:—

(*a*) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice of his intention to do so; and

(*b*) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

Publication of illustrated journal, indexes, &c.

40. (1.) The comptroller shall cause to be issued periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that the comptroller may deem generally useful or important

(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 henceforth 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 licences.

(3.) In all other respects (including the amount and time of payment of fees) this Act shall extend to all patents granted before the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

(4.) All instruments relating to patents granted before the commencement of this Act required to be left or filed in the Great Seal Patent Office shall be deemed to be so left or filed if left or filed before or after the commencement of this Act in the Patent Office.

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 sect. 6 of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter 3, 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.

(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 *prima 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.

Legal Proceedings.

Penalty on piracy of registered design.

58. During the existence of copyright in any design—

(*a*) It shall not be lawful for any person without the licence or written consent of the registered proprietor to apply such design or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale to any article of manufacture or to any substance artificial or natural or partly artificial and partly natural; and

(*b*) It shall not be lawful for any person to publish or expose for sale any article of manufacture or any substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor.

Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract debt by action in any court of competent jurisdiction.

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 56).

"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*].

(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.

Limit of time for proceeding with application.

63. Where registration of a trade mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant [*the application shall be deemed to be abandoned*].

Conditions of registration of trade mark.

64. [(1.) *For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:*

(a) *A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or*

Repealed.

(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.*]

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.

67. A trade mark may be registered in any colour, and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour.

Advertisement of application.

68. Every application for registration of a trade mark under this part of this Act shall as soon as may be after its receipt be advertised by the comptroller.

Opposition to registration.

69. (1.) Any person may within [*two months*] of the [*first*] advertisement of the application, give notice in duplicate at the Patent Office of opposition to registration of the trade mark, and the comptroller shall send one copy of such notice to the applicant.

(2.) Within [*two months*] after receipt of such notice or such further time as the comptroller may allow, the applicant may send to the comptroller a counter statement in duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

Repealed.

[(3.) *If the applicant sends such counter statement, the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall require him to give security in such manner and to such amount as the comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement*

was made or such further time as the comptroller may allow, the opposition shall be deemed to be withdrawn.

(4.) If the person who gave notice of opposition duly gives such security as aforesaid, the comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court.]

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.) The comptroller shall not register with respect to the same goods or description of goods a trade mark [*so nearly resembling*] a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive.

Further restriction on registration.

73. It shall not be lawful to register as part of or in combination with a trade mark any words the [*exclusive*] use of which would by reason of their being calculated to deceive or otherwise be deemed disentitled to protection in a court of justice, or any scandalous design.

Saving for power to provide for entry on register of common marks as additions to trade marks.

74. (1.) Nothing in this Act shall be construed to prevent the comptroller entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade mark—

(*a*) In the case of an application for registration of a trade mark used before the thirteenth day of August, one thousand eight hundred and seventy-five—

Any distinctive device, mark, brand, heading, label, ticket, letter, word or figure, or combination of letters,

words, or figures, though the same is common to the trade in the goods with respect to which the application is made;

(*b*) In the case of an application for registration of a trade mark not used before the thirteenth day of August, one thousand eight hundred and seventy-five—

Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made;

[(2.) *The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register.*]

(3.) Any device, mark, brand, heading, label, ticket, letter, word, or 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.*]

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.

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*] next after the date of such removal, be deemed to be a trade mark which is already registered.

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, seachers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company) and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers, and assistants of that Company, the following provisions shall have effect:—

(1.) The Cutlers' Company shall establish and keep at Sheffield a new register of trade marks (in this Act called the Sheffield register):

[(2.) *The Cutlers' Company shall enter in the Sheffield register, in respect of cutlery, edge tools, or raw steel and the goods mentioned in the next sub-section all the trade marks entered before the commencement of this Act in respect of cutlery, edge tools, or raw steel and such goods in the register established under the Trade Marks Registration Act*, 1875, *belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such register, in respect of the same goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the register established under the Trade Marks Registration Act*, 1875:]

(3.) An application for registration of a trade mark used [on *cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge*] shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company:

(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 comptroller by the Cutlers' Company, save and except that the provisions of this sub-section shall not prejudice or affect any life, estate, and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register:*]

(8.) Where the comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used [*on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge*], he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company:

(9.) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' register of corporate trade marks, and thereupon all marks entered therein shall, unless entered in the Sheffield register, be deemed to have been abandoned.

(10.) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of two or more trade marks:

(11.) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of a trade mark or trade marks:

(12.) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the comptroller, who shall have power to confirm, reverse, or modify the decision, but the decision of the comptroller shall be subject to a further appeal to the Court;

(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.

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.

(2.) Until a new patent office is provided, the offices of the commissioners of patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the Patent Office within the meaning of this Act.

(3.) The Patent Office shall be under the immediate control of an officer called the comptroller-general of patents, designs, and trade marks, who shall act under the superintendence and direction of the Board of Trade.

(4.) Any act or thing directed to be done by or to the

comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorized by the Board of Trade.

Officers and clerks.

83. (1.) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller-general of patents, designs, and trade marks, and so many examiners and other officers and clerks with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

Seal of Patent Office.

84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence.

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 such regulations as may be prescribed; and certified copies, sealed

with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

Sealed copies to be received in evidence.

89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Rectification of registers by Court.

90. (1.) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry as the Court thinks fit; 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 connection 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.

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 authorised by this Act or any general rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made and of the contents thereof, and of the matter or thing having been done or left undone.

Applications and notices by post.

97. (1.) Any application, notice, or other document authorised or required to be left made, or given at the Patent Office or to the comptroller, or 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.

Provisions 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 abstract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Power for Board of Trade to make general rules for classifying goods and

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: regulating business of Post Office.

(*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.

102. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him Annual reports of comptroller.

of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

International and Colonial Arrangements.

International arrangements for protection of inventions, designs, and trade marks.

103. (1.) If her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such state, shall be entitled to a patent for his invention or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants; and such patent or registration shall have the same date as the [*date of the protection obtained*] in such foreign state.

Provided that his application is made, in the case of a patent within seven months, and in the case of a design or trade mark within four months, from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

(2.) The publication in the United Kingdom, or the Isle of Man, during the respective periods aforesaid, of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent, which may be granted for the invention, or the registration of the design or trade mark:

(3.) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act: provided that, in the case of trade marks, any trade mark, the registration of which has

been duly applied for in the country of origin, may be registered under this Act:

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

Provision for Colonies and India.

104. (1.) Where it is made to appear to her Majesty that the Legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for her Majesty from time to time, by Order in Council to apply the provisions of the last preceding section, with such variations or additions, if any, as to her Majesty in Council may seem fit, to such British possession.

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the order, take effect as if its provisions had been contained in this Act; but it shall be lawful for her Majesty in Council to revoke any Order in Council made under this Act.

Offences.

Penalty on falsely representing articles to be patented.

105. (1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

(2.) A person shall be deemed, for the purposes of this enactment to represent that an article is patented or a design or a trade mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

Penalty on unauthorized assumption of Royal arms.

106. Any person who, without the authority of her Majesty, or any of the royal family, or any government department, assumes or uses in connection with any trade, business, calling, or profession, the royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession

by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

Scotland, Ireland, &c.

Saving for Courts in Scotland.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts.

For the purposes of this section "Court of Appeal" shall mean any Court to which such action is appealed.

Summary proceedings in Scotland.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

Proceedings for revocation of patent in Scotland.

109. (1.) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the 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 jurisdiction of Courts.

111. (1.) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term "the Court," shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of the said Court; and with reference to any such proceedings in Ireland, the terms "the Court," and "the Court of Appeal" respectively mean the High Court of Justice in Ireland, and her Majesty's Court of Appeal in Ireland.

(2.) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court of 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.

Repeal, Transitional Provisions, Savings.

Repeal and saving for past operation of repealed enactments, &c.

113. The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

(*a*) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or

(*b*) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or

(*c*) Take away or abridge any protection or benefit in relation to any such action or proceeding.

Former registers to be deemed continued.

114. (1.) The registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act.

(2.) The registers of designs and of trade marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of designs and the register of trade marks kept under this Act.

Saving for existing rules.

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed, 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.

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. IV. c. 62.

3. Whereas under the principal Act, a complete specification is required (by section eight) to be left within nine months, and

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

(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.]

46 & 47 Vict. c. 57.

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:

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. 46 & 47 Vict. c. 57. 48 & 49 Vict. c. 63.

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.

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 comptroller 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 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.

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.

Sect. 7, as to applications.

2. For section seven of the principal Act the following section shall be substituted, namely:—

"7.—(1.) If the examiner reports that the nature of the invention is not fairly described, or that the application, specifi-

cation, 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 of applications.

12. In section sixty-eight of the principal Act after the word 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.

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."

Sect. 79, as to removal of trade mark from the register.

(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 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

38 & 39 Vict. c. 91.

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 assignments, &c.

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."

Sect. 88, as to inspection.

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. 90, as to rectification of register.

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. 91, as to correction of errors.

24. To section ninety-one of the principal Act the following sub-section shall be added; namely,

"(*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."

Proceedings of Board of Trade.

25. After section one hundred and two of the principal Act the following section shall be added and numbered 102A; namely,

"(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."

Jurisdiction of Lancashire Palatine Court.

26. After section one hundred and twelve of the principal Act the following section shall be added and numbered 112A; namely,

"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.

PATENT.

Form A.

(To be accompanied by two copies of Form B or Form C.)

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.

The marginal notes are directory only: *Grenfell and McEvoy's Application* (1890), 7 R. P. C. 737.

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.

PATENT.

Form A1.

(To be accompanied by two copies of Form B or 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.

PATENT.

Form A2.

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.

PATENT.

Form D.

FORM OF OPPOSITION TO GRANT OF PATENT.

(To be accompanied by an unstamped copy.)

*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.

PATENT.

Form E.

FORM OF APPLICATION FOR HEARING BY THE COMPTROLLER.

In Cases of Refusal to Accept, Opposition, or Applications for Amendment, &c.

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, *e.g.*, that the parts to be disclaimed are of doubtful novelty (*Ainsworth's Patent* (1896)); 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 hereinafter 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.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

PATENT.

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.

Letters Patent No. —— of 18—.

PATENT.

—— 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 sect. 17 of the Patents, Designs, and Trade Marks Act, 1883.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

PATENT.

Form K.

FORM OF APPLICATION FOR ENLARGEMENT OF TIME FOR PAYMENT OF RENEWAL FEE.

SIR,

I hereby apply for an enlargement of time for —— month—in which to make the —— payment of £ —— upon my Patent No. —— of 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. 699.
† 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.

Form N.

APPLICATION FOR DUPLICATE OF PATENT.

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.

Form O.

NOTICE OF INTENDED EXHIBITION OF AN UNPATENTED INVENTION.

PATENT.

* —— 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.

Form P.

FORM OF REQUEST FOR CORRECTION OF CLERICAL ERROR.

PATENT.

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 5s. 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 appiication.

—— 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. 699.

† To be signed by applicant or applicants, or his or their agent

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Form V.

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. 699.
† 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.—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., 1887.

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 purposes 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.

III.—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.

Order Expunging Entry in Register of Patents.

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 into 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 —— day 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.

IV.—ASSIGNMENTS, &c. (*b*).

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. Now this Indenture witnesseth, and in consideration of the sum of £—— paid to the said A. B. (the receipt whereof he doth hereby acknowledge),

Assignment. 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:

Covenant as to validity. 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

(*b*) For very full forms of assignments, licences, mortgages, agreements, and other conveyancing matters connected with patents, see Morris's Patents Conveyancing, 1887. The clauses which may be usefully included in any assignment are set out *ante*, p. 294.

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.

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.) 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. NOW THIS INDENTURE WITNESSETH that in pursuance of the said request and in consideration of the premises, the assignor 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. Patent of communication. Assignment.

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; Date. Parties. Recitals.

and —— carrying on business at ——, hereinafter called the said company, of the third part.

Letters patent. WHEREAS the said —— is the grantee of letters patent for [*title*], dated the —— day of —— 18— No. ——.

Communication. 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 ——.

Request to assign. AND WHEREAS the said —— has requested the said —— to assign the whole interest in the said letters patent to the said company.

Consideration. 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,

Assignment. 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.

Covenant as to validity. 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 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 (*b b*).

Date. MEMORANDUM OF AGREEMENT made this —— day of —— 18—

Parties. 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

(*b b*) And see *ante*, p. 289.

agreement; £—— in nine months from the date hereof; and £—— in fully paid up shares 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 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.

Licences.

Improvements.

Covenant as to title.

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.

As witnesseth the hand of the said —— the day and year first above written.

THE SCHEDULE above referred to.

V.—LICENCES.

(i) A Non-Exclusive Licence.

AN INDENTURE made the —— day of ——, 1895, between A. B., of, &c., hereinafter called the licensor, of the one part, and C. D., of, &c., hereinafter called the licensee, of the other part. WHEREAS, by Letters Patent No. —— of 1897, granted unto A. B., the licensor aforesaid, and dated —— the sole and exclusive licence and authority of making, using, and vending in the United Kingdom and the Isle of Man, an invention was granted to the said A. B. AND WHEREAS the licensor has agreed to grant the licensee a licence to use the said invention [so far as relates to the manufacture of —— for the purposes of sale in the district of ——]. NOW THIS INDENTURE WITNESSETH that in pursuance of the said agreement, and in consideration of the royalties hereby agreed to be paid to the licensor by the licensee, and of the covenants on the part of the licensee hereinafter contained, the licensor doth hereby grant unto the licensee full leave to make, use, exercise and vend ——, have been so made during the term of —— years [or, during the residue of the unexpired term for which the patent has been granted to the licensor]; YIELDING AND PAYING unto the licensor on the first day of every October and on the 1st day of every April for every article manufactured by the licensee under the patent the sum of £——. And the licensee doth hereby covenant with the licensor and his assigns that he, the licensee, will, during the term hereby granted, pay to the licensor, his executors, administrators, or assigns, on the 1st day of October and and April respectively, the royalties on all articles manufactured under the said patent during the preceding six months, AND ALSO that he will during the said term keep all proper books of account, and make such true entries therein of all particulars necessary or convenient for the purposes, showing the amount which may be or become due by way of royalty to the licensor hereunder, and will produce the said books at all reasonable times to the licensor, his executors, administrators, or assigns, or to his agent or agents duly appointed for this purpose in writing, for the purpose that the said licensor, his executors, administrators, assigns, or agents may inspect and take copies and extracts from the said books, and will at his own expense obtain and give all reasonable information as to any item in the said books of account as may reasonably be required. AND ALSO that he will at the end of each half-year on the dates aforesaid deliver or send to the licensor, his executors, administrators, or assigns, a statement in writing of the particulars of the manufacture made of articles under the said patent, and of the sale of articles within the last half-year. And the licensee further agrees that during the continuance of the licence he will not, during the continuance of the patent, without the consent, in writing, of the licensor, manufacture any article aforesaid without the application of the said invention as described in the specification, and in case he shall do so he shall [here insert the penalty]. And the licensor doth hereby covenant with the licensee that he, the licensee or his assign will, during the

continuance of this licence, duly pay all fees necessary for the renewal of the letters patent, —— days at least before the latest time appointed for the said payments, and will, if required of the licensee or his assign, produce the official evidence of such payments or permit the licensee and his assigns to pay the said fees and deduct the amount thus paid from the royalties payable hereinunder. And that neither the licensor nor his assigns will at any time during the continuance of the licence amend the specification without the written consent of the licensee, such consent not to be arbitrarily withheld, provided always that if any royalties payable by the licensee or his assigns, shall for the space of —— days after the same shall have become payable be unpaid, or if the licensee shall have broken any other covenant, and shall for the space of —— days after written notice served upon him have failed to make the same good of it, the licensee or his assigns shall have a receiving order made against him [or in the case of a company shall have gone into liquidation] the licensor shall have power of notice in writing forthwith to revoke the licence without prejudice to the recovery by the said licensor or his assigns of any money already due or to any right of action which has already accrued for past breaches hereunder. [Add proviso entitling the licensor to put an end to the licence if the letters patent shall at any time during the pending of the licence be declared void.]

In witness, &c.

[Amongst other clauses which may be inserted in a licence agreement are the following: (a) licensor to defend the patent at the cost of the licensee; (b) power for either party to determine the licence on giving notice; (c) licensee not to assign or charge the licence without the licensor's consent; (d) power to grant sub-licences; (e) express covenant not to dispute the validity of the patent; (f) option to purchase; (g) covenant to grant licence for improvements; (h) covenant not to grant more favourable licence to any other person.]

(ii) An Exclusive Licence.

THIS INDENTURE made the —— day of —— 18— between A. B., of —————— hereinafter called the licensor of the one part and X. Y., of —————— hereinafter called the licensee of the other part. WHEREAS [*recite patent and agreement to grant a licence*] NOW THIS INDENTURE WITNESSETH that in pursuance of the said agreement and in consideration of the royalties to be paid and covenants to be observed by the licensee as hereinafter mentioned, the licensor does hereby grant to the licensee and his assigns the full sole and exclusive liberty, licence, and authority [*limits of space, if any*] to use, exercise, and vend the said invention, *To hold, exercise, and enjoy* the said premises unto and by the licensee and his assigns for and during [*here insert the time limit*]. And the licensor doth hereby covenant . . . And the licensee doth hereby covenant . . . [*covenant as in the last-mentioned precedent.*] [Add also covenants of licensor to defend the patent and prevent infringements at licensee's request and cost; that there are

no subsisting licences with the district to be covered by third licence; no further licences to be granted.] Forms of licence in considerable variety will be found in Morris's Patents Conveyancing, to which the reader is referred, and see *ante*, pp. 300 *et seq*.

VI.—ACTION OF INFRINGEMENT.

Indorsement on Writ (*c*).

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).

Injunction. 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.

Damages. 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.

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.

4. Costs.

Statement of Claim.

1. The plaintiff is the patentee and registered legal owner of letters patent No. 2266 of the year 1888, granted for an invention of "Improvements in anchors and in the process of riveting, which improvements are applicable to other articles."

2. The defendant has infringed the said letters patent in manner by the particulars of breaches herewith delivered appearing.

The plaintiff claims:—

1. An injunction restraining the defendant, his servants, and agents from manufacturing, selling, offering for sale, or in any manner dealing with any hollow studs or plates constructed in infringement of the plaintiff's letters patent No. 2266 of the year 1888.
2. Damages or an account of profits.

(*c*) R. S. C., 1883, Appendix A., Part III., Sect. IV.

3. Delivery up or destruction of all articles in the defendant's possession constructed in infringement of the plaintiff's patent.
4. Costs.
5. Such further or other relief as the circumstances of the case may require.

Particulars of breaches are delivered herewith pursuant to the Statute in that case made and provided.

Delivered, &c.

Statement of Claim (Another Form).

(Including a Claim for Threatened Infringement.)

1. The defendants have infringed the plaintiffs' 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. Infringement.

2. The defendants have, by letter dated the 17th Nov., 1894, threatened to continue the said infringement, and by advertisement in the *Morning Post* of the —— and by circulars have offered to make articles which, if made by defendants, would be an infringement of the plaintiffs' patent.

3. The said letters patent have been duly vested in the plaintiffs.

The plaintiffs claim—

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. Injunction.
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. Damages or account.
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. Costs.

Particulars of breaches are delivered herewith.

Delivered, &c.

Particulars of Breaches.

Delivered with statement of claim in this action on the —— day of —— 1896, by ——

The following are the particulars of breaches complained of by the plaintiff in this action :—

The defendant, trading as H. Jones & Co., has infringed the plaintiff's patent by the manufacture and sale at Birmingham of —— similar to those shown in fig. 6 of the drawings attached to the complete specification of the plaintiff's letters patent in the statement of claim referred to.

The manufacture and sale of the said studs and plates is an infringement of the first claim of the plaintiff's patent.

The plaintiff is unable to give further and better particulars of the manufacture and sale of the said studs and plates by the defendant until he has obtained discovery from the defendant, but the plaintiff will claim to recover compensation in respect of all infringements by the defendant of the plaintiff's patent.

Particulars of Breaches (Another Form).

1. The defendants have, since the date of the patent No. 9214 of 1885, manufactured or caused to be manufactured and sold dye stuffs the same, or substantially the same, as the plaintiff's naphtol black.

2. The dye stuffs complained of are those sold by the defendants under the name of naphtol black O.D.

3. The dye stuffs complained of are made according to the process described and claimed in the plaintiff's specification in all respects.

Particulars of Breaches (Another Form).

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 —— 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 —— 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 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 (*d*).

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.

Patents invalid. 2. The defendants deny that the said letters patent are good or valid or of any force or effect.

Infringement denied. 3. The defendants deny that they have infringed the said letters patent.

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 ——.

Title denied. 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.

Patents invalid. 2. The defendants deny that the said letters patent are good or valid or of any force or effect.

(*d*) R. S. C., 1883, Appendix D., Sect. XII.

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.

Another Defence.

The defendants say that :—

1. The defendants have not infringed the plaintiffs' letters patent in the statement of claim mentioned. Infringement denied.

2. The defendants do not admit that the said letters patent have been duly vested in the plaintiffs. Title denied.

3. The plaintiffs' letters patent are invalid on the grounds stated in the particulars of objections delivered herewith. Patent invalid.

Particulars of Objections.

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 :—

1. That —— was not the true and first inventor of the alleged invention comprised in the said letters patent. Not true and first inventor.

2. That the said alleged invention was not new at the date of the said letters patent. Not new.

3. That the alleged invention is not the proper subject-matter of letters patent. No subject-matter.

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. Specification insufficient.

5. That the alleged invention is not of any public utility. Not useful.

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, Anticipation by—

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.

Particulars of Objections (General Form).

Analogous user.

The invention is not subject-matter for a patent inasmuch as the means described in the specification for hoops had been in ordinary and common use for the purpose of rings for forty years prior to the date of the patent by manufacturers, &c.

Ambiguity.

The specification is ambiguous and misleading in that it does not state —— and does not sufficiently describe ——.

Disconformity.

The complete specification describes and claims inventions not comprised within the provisional specification.

No subject-matter owing to want of public knowledge.

The invention is not subject-matter for a patent having regard to the state of public knowledge at the date of the patent.

The specification does not sufficiently distinguish which of the matters therein described the said J. claimed to have invented, and which he admits to be old.

Now not distinguished from old.

The bustles complained of in 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 the patent No. 10,191 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. 10,191 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.

The plaintiff in his specification points out and claims no sufficient improvement to be subject-matter.

The title and the specifications are false, ambiguous, and misleading.

The plaintiff by his said alleged invention made no useful addition to the stock of public knowledge at the date of the said letters patent.

The invention claimed by the plaintiff in claim 1 is useless and unworkable.

Order for further and better Particulars of Objections.

(Insufficiency of Specification.)

Crompton and Kapp v. *The Anglo-American Brush Light Corporation, Limited.* Kay, J. 18th 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
Costs. plaintiffs' costs of and consequent upon the said application be his costs in any event.

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. 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

Costs. event.

Order for leave to amend Particulars of Objections.

The American Braided Wire Company v. *Thompson.* 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 colourably differing from the same, and from in any manner infringing the said letters patent Motion, &c.

or either of 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., Limited, 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, Messrs. 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., Limited, 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

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Order of Reference to an independent Chemist for Report pending Hearing of Action.

Badische Anilin and Soda Fabrik v. *Levinstein*, R. P. C. 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 Company, Limited. 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 year 18— by striking out the second claim thereof and by making such other alterations (if any) as will be rendered necessary

Leave to apply at Patent Office.

Amendment of statement of claim.

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.

Costs.

Order for Leave to amend Specification pending Action.

G., G., and the N. Co. for the Distribution of Electricity by Secondary Generators, Limited v. *L. & Co. Limited, 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, Limited, 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 think fit to make any order upon the said motion. And it is ordered that the plaintiffs do pay to the defendants, L. & Co., Limited, and F., their costs of the said motion (such costs to be taxed by the taxing master).

No order.

Judgment after Trial of Action.

Morgan & Co., Limited v. *Windover & Co., Limited.* Stirling, J. 11th July, 1887.

Recital of evidence.

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.

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 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 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. & C., 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 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).

Injunction awarded.

Affidavit to infringing articles.

Account.

Costs on higher scale.

THE SCHEDULE.

[*Name of Witness.*	*Date 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 4847, 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.

Motion to stand for judgment.

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.

Part of judgment reversed.

Injunction granted.

Delivery up on oath of infringing instruments.

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.

Inquiry as to damages.

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 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.

Payment of amount found due.

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' reamended 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 reamended 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 referred to the taxing master to tax upon the higher scale the costs of

Evidence, &c.

Action dismissed.

Costs.

Particulars of objections.

the defendants of this action, except so much as relates to the objections 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 at Trial of Action.

Siddell v. *Vickers*. Kekewich, J. 21st December, 1887.

Evidence.

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.

Stands for judgment. Injunction.

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 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 colourably 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 colourably 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.

And it is ordered that the following account be taken :— Account.

1. An account of all iron or steel forgings manufactured by the defendants by the use of the plaintiffs' 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.

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. Account suspended pending appeal.

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.

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 defendants' works, such costs to be taxed by the taxing master on the higher scale. Costs.

And this Court doth reserve the subsequent costs of this action.

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. Certificate of validity.

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.

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 and the evidence of the following persons taken orally before this Court, on the ——, namely, —— and the exhibits —— produced to Evidence.

—— 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. ——.

Judgment reversed.

This Court doth order that the said appeal be allowed, and that the said judgment dated the —— be reversed. And it is ordered

Injunction.

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 plaintiff's 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.

And it is ordered that the following inquiry be made, that is to say:—

Inquiry as to damages, &c.

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.

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.

Delivery up of infringing articles.

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.

Costs.

And it is ordered that the defendants, T. & Co., do pay to the plaintiffs, the A. B. W. Co. and the W. and 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.

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.

1. Indorsement on Writ.

The plaintiff's claim is:—

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). Injunction.
2. For damages for injury accrued to the plaintiff in respect of the said threats. Damages.

2. Statement of Claim.

1. The plaintiff is a manufacturer of ——, and carries on business at ——; and the defendant is a rival manufacturer carrying on business at ——.

2. In or about the month of —— the defendant threatened and has continued to threaten the plaintiff, his agents and customers, with legal proceedings for infringement of certain letters patent which the plaintiff claims to have vested in him, the said alleged infringement being the sale of ——.

3. In particular the defendant caused to be issued to customers of the plaintiff a circular in terms following:—

"*Re S.'s Patent.*

"It having come to the knowledge, &c."

4. Each and all the letters patent granted to the plaintiff or to persons of whom he is assignee, and purporting to cover the articles to which the said threats relate, were invalid and of no force whatever, as the defendant well knew.

The plaintiff claims—

1. An injunction to restrain the defendant, his servants or agents from threatening any customer of the plaintiff or any other person with legal proceedings in respect of any manufacture, use, sale, exhibition, or offering for sale or purchase —— manufactured by the plaintiff constructed in the manner alleged by the defendant to be an infringement of his patent.
2. Damages

3. Particulars given by Plaintiff.

1. Particulars of invalidity of the letters patent No. —— of 18—.

[See particulars of objection in an action for infringement.]

2. The following are the particulars of the threats :—

Date.	*Person to whom made.*	*How made.*
(a) 10th June, 1893.	James & Co., of ——.	Letter from defendant's solicitor.
(b) 13th June, 1893.	General.	Advertisement in the —— *Gazette*.
(c) 12th Aug., 1893.	Plaintiff.	Verbally by the defendant.
(d) 15th Sept., 1893.	Henry & Co., of ——.	Verbally by one ——, traveller for the defendant.

4. Defence.

1. The defendant does not admit that he threatened the plaintiff or others, as alleged. If any of the notices, circulars, or advertisements, or verbal statements, referred to in the particulars of threats were in fact issued or uttered by him, the same are not threats within the meaning of the 32nd section of the Patents, &c., Act, 1883.

2. Any threats which were made by the defendant were made with the *bonâ fide* intention of protecting from infringement the letters patent No. —— of 189—, of which the defendant is the owner. The said letters patent are valid and subsisting.

3. The plaintiff [or ——, the person threatened] in fact did infringe the defendant's letters patent referred to in the last paragraph hereof. The particulars of such infringement are as follows :—

4. On the —— day of —— the defendant commenced an action for infringement of the said letters patent against the plaintiff in this action or [*and*] against one ——. Such action is still pending, and the defendant will rely upon it as an answer to this action.

[N.B.—The defendant may counterclaim for infringement.]

5. Reply.

1. The plaintiff joins issue.
2. [The invalidity of the defendant's patent may be set up here if this has not already been done in the statement of claim.]
3. [Defence to a counterclaim for infringement would follow the rules relating to defence in an action for infringement.]

6. An Order for Particulars.

"It is ordered that the plaintiffs do within fourteen days deliver to the defendants particulars in writing of (1) the batteries which the plaintiffs in their statement of claim allege to have been the subjects of the threats, and of all other matters, if any, in respect of which the plaintiffs allege that the threats were made; (2) the damage which the plaintiffs allege to have been suffered by them and of the business which the plaintiffs in the 7th par. of the statement of claim allege they were prevented from properly carrying out. And upon the defendants giving to the plaintiffs a list of letters patent upon which they intend to rely, it is ordered that the plaintiffs do, within three weeks after giving such list of letters patent as aforesaid, deliver to the defendants particulars in writing of (3) the objections which the plaintiffs propose to make at the trial of their action to the validity of the letters patent to appear in such list as aforesaid, provided that no particulars of objection to the validity of the letters patent of J. W. S. (No. —— of ——) if contained in such list as aforesaid shall be delivered by the plaintiffs until fourteen days after the statement of claim shall have been delivered in an action brought by defendants against plaintiffs and L., or until fourteen days after such action shall have been discontinued." [North, J. and C. A. in *Union Electrical Power and Light Co.* v. *Electrical Power Storage Co.*, 1888, 38 Ch. Div. 325; 5 R. P. C. 329.]

7. Interim Injunction.

Upon motion made, &c., and upon hearing, &c., let the defendants, their officers, servants, and agents be restrained until judgment in this action or further order from threatening the plaintiffs, their customers, or any other person or persons, with legal proceedings or liability in respect of an alleged infringement of the letters patent No. —— of 18—. [Stirling, J. in *Kensington and Knightsbridge Electric, &c., Co.* v. *The Lane-Fox Electric Co.*, 1891, 2 Ch. 573; 8 R. P. C. 277.]

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 ——

I hereby authorize the presentation to the High Court of Justice of the above written petition. Fiat of Attorney-General.

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 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 power of attorney to act as his agent in England in

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.

Petition. 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 Evidence. 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 order that the Letters Patent No. —— A.D. —— in the petition mentioned granted to G. and G. be revoked. Order revoking patent.

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.

Upon the petition of A. of —— on the 24th day of November, 1886, preferred into 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. Petition. 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.

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 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.

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.

Merits of 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.

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.

Advertisements.

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.

Prayer.

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.

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 hereinfter 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 ——, notwitstanding 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 telegraphic 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 affected 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.

Term asked for.

27. That your petitioners humbly submit that, under the circumstances of the case, an exclusive right of using and vending the said invention for the further period of seven years will not sufficiently reimburse and remunerate your 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.

Form of Petitioner's Accounts.

——'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, &c., IN SIMILAR FORM TO FIRST YEAR.

Summary of Petitioner's Accounts.

IN THE PRIVY COUNCIL.

——'s PATENT, No. ——, 18—.

IMPROVEMENTS IN ——.

SUMMARY OF PETITIONER'S ACCOUNTS.

LOSS.		PROFIT.
£ s. d.		£ s. d. £ 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.		£ s. d.
[*Patented articles*] manufactured and sold from —— to ——, 18—:		Sale of [*patented articles*] as per contra—	
10 [*patented articles*] — cwts. — qrs. — lbs.		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. — qrs. — lbs.			
Discounts and commissions.....			
	£		£

MANUFACTURER 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—:		Sale of [*patented articles*] as per contra—	
21 [*patented articles*] — cwts. — qrs. — lbs.		21 [*patented articles*] — cwts. — qrs. — lbs.	
Royalties			
Railway and other carriages—			
£— per ton on quantity invoiced, viz., — tons, — cwts. — qrs. — lbs.			
Discount and commissions			
	£		£

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 prayer of the above-mentioned petition.

Novelty. 1. The alleged invention was not new at the date of the said letters patent or useful.

Small merit. 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 date, 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.

Full reward already received. 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.

If reward insufficient due to laches of petitioners. 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.

Conduct of petitioners. 5. The petitioners have never brought actions to restrain alleged infringments of their patent, though they have continually threatened so to do.

Some foreign patents expired. 6. In consequence of the expiry of the patents in —— and ——, the alleged invention can be now freely worked in those countries.

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 ——, ——, and trading there under the style of —— to the granting of the prayer of the above-mentioned petition —— are as follows:—

1. That the said alleged invention was not and is not of great advantage or benefit to the public. Merit denied.

2. That the said inventor has already received a full and adequate remuneration for the alleged invention. Adequate remuneration.

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— Invention not novel.

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.

Recitals.

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 licence, 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 licences, 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 of the date

(*a*) Signature of Clerk to Privy Council.

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.

Petition for prolongation.

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.

Reference to and report of Privy Council.

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. ——.

New letters patent for ten years.

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.

Grant,

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 licence, full power, sole privilege and authority that the said patentee, by himself, his agents or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention 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.

includes Channel Islands.

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 directly or indirectly, make use of or put in practice the said invention or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof without the consent, licence, or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our royal command, and of being answerable to the patentee according to law for his damages thereby occasioned: PROVIDED THAT THESE OUR LETTERS PATENT ARE ON THIS CONDITION, that if at any time during the said term it 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 licences in such manner and for such considerations as they may by law be granted. And lastly, we do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee. IN WITNESS whereof we have caused these our letters 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.)

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

Grant of patent.

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 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;

Assignment.

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;

Further 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

(*a*) For a form of petition to the Privy Council for confirmation, see Hindmarch, pp. 642, 643.

(*b*) See Chap. XVII.

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;

Non-payment of stamp duty.

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;

Patent declared void in consequence.

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;

Omission discovered.

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;

Application to Parliament.

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;

Merits.

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;

Omission to pay duty due to illness of petitioner.

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;

Amount of stamp duty deposited with comptroller.

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;

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.

2. No action or other proceeding shall be commenced or prosecuted nor any damage recovered : Saving rights of other parties.

(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.

3. This Act may be cited as Potter's Patent Act 1887. Short title.

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

(c) See Act of 1883, sect. 39, at p. 631.
(d) This is given as an example.
(e) See Act of 1886, sect. 3, at p. 632.

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.

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 in 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,
1*st 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. 635.

(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 recognized 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.

(5.) 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.—ADMIRALTY CIRCULAR.

By Section 27 of the Patents, Designs, and Trade Marks Act, 1883, it is enacted as follows:— Interest in patents or inventions.

"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."

2. All officers or subordinates holding staff appointments, or who may be now or hereafter employed in any administrative, instructional, manufacturing, or experimental department under the Admiralty, or appointed to any of H.M. Ships for service, either in such department, or in any steam reserve, are to understand that one of the conditions subject to which they hold such appointment or employment, is that they shall not take out a patent, nor seek for provisional protection for an invention, without first obtaining the approval of the Admiralty by application through their respective Commanding Officers or heads of their departments.

Each application must contain a general description of the invention for which protection is desired.

3. Permission to patent will not be granted as a matter of course, but each application will be dealt with according to the circumstances of the case. Should permission be granted it will be subject to the following conditions, from which there shall be no appeal by the patentee, either to the Treasury under the above-quoted Section of the Patents Act, 1883, or otherwise:—

a. That if it be at any time desired by the Admiralty the patent shall be absolutely assigned to the Secretary of State for War on such terms as the Admiralty may decide upon, after full consideration of all the circumstances of the case.

b. That the invention may be used by or for the Admiralty, and that the terms of payment, if any, for such use shall be decided by the Admiralty.

c. In settling terms either for assignment or use, regard shall be had by the Admiralty to any facilities in originating, working out, and perfecting the invention, which the inventor may have enjoyed by reason of his official position; and all payments will be subject to the approval of the Treasury.

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.

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

(*g*) See Act of 1888, s. 1.

(*h*) See Patents Acts, 1885-88, p. 664, and notes thereon.

(*i*) The side notes are not in the original.

(*k*) The Institute have appointed their Secretary, Mr. Howgrave Graham, registrar.

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 time to time insert in the register any alteration which may come to his knowledge in the name or address of any person registered.

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.

(*l*) This rule gives the Institute practically complete control over the admission of persons to the profession of patent agent.

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. In 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 (*m*).

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 the 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. The rules may be cited as the Register of Patents Agents Rules, 1889.

By the Board of Trade,

COURTENAY BOYLE,

Assistant Secretary, Railway Department.

The 11th day of June, 1889.

(*m*) This rule is not *ultra vires*: *Institute of Patent Agents* v. *Lockwood* (1894), App. Ca. 347; 11 R. P. C. 374.

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 (*a*).

FEES.

Nature of Fee.	When to be Paid.	To whom to be Paid.	Amount.
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 s. 5 d. 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 qualifiying examination.	At time of entering name.	Do. do.	2 2 0

Patents, Designs, and Trade Marks Act, 1888.

REGISTER OF PATENT AGENTS RULES, 1891.

WHEREAS by the Register of Patent Agents Rules, 1889, it is provided, amongst other things, that the Register of Patent Agents established by the said Rules shall be kept, and certain duties in reference thereto and to the examination and registration of and otherwise in relation to Patent Agents shall be performed, by the Institute of Patent Agents referred to in the said Rules:

And whereas the said Institute of Patent Agents has been dissolved and ceased to exist, and in place thereof the Chartered Institute of Patent Agents has, by Royal Charter dated the 11th day of August, 1891, been incorporated:

Now, therefore, for the purpose of giving effect to the provisions of the Patents, Designs, and Trade Marks Act, 1888, 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:—

Transfer of powers and duties of Institute of Patent Agents to Chartered Institute.

1. From and after the commencement of these Rules all the duties and powers of the Institute of Patent Agents under the Register of Patent Agents Rules, 1889 (hereafter in the present Rules referred to as "the Rules of 1889"), shall be transferred to and vested in the Chartered Institute of Patent Agents, and the Rules of 1889 shall, where applicable, and save so far as they are altered by the present Rules, have effect, with the following modifications:—

(1.) For the words "The Institute of Patent Agents" there shall be substituted the words "The Chartered Institute of Patent Agents."

(*a*) See *Institute of Patent Agents* v. *Lockwood* (1894), App. Ca. 347; 11 R. P. C. 374.

(2.) The Registrar shall be the person who, for the purposes of the duties of the Registrar under the Rules of 1889 and the present Rules, shall be continued in office or appointed by the Chartered Institute of Patent Agents.

Saving rights, privileges, acts, appointments, and regulations under Rules of 1889.

2. Nothing contained in the present Rules shall affect any right, privilege, obligation, or liability acquired, accrued, or incurred, any act done, or appointment or regulation made under the Rules of 1889; and any regulation made by the Institute of Patent Agents under the Rules of 1889 prior to the commencement of the present Rules shall be subject to alteration and revocation by subsequent regulations to be made by the Chartered Institute of Patent Agents under Rule 27 of the Rules of 1889, as amended by the present Rules.

Publication of register.

3. So much of Rule 3 of the Rules of 1889 as provides that the correct copy of the Register therein referred to shall be printed and published in every year subsequent to the year 1889 on the 31st day of January is hereby annulled, and instead thereof the following Rule shall have effect:—

In the month of February in each year, and at such other times, as the Chartered Institute of Patent Agents may think desirable, the said Chartered Institute shall cause a correct copy of the Register to be printed under their direction, and placed on sale.

Alteration of Appendix B.

4. Instead of Appendix B. to the Rules of 1889 there shall be substituted the Appendix to the present Rules, which may be cited as Appendix B.

Commencement and citation.

5. The present Rules shall commence and come into operation on the 19th day of November, 1891, and, together with the Rules of 1889, may be cited as the Register of Patent Agents Rules, 1889 to 1891.

By the Board of Trade,

COURTENAY BOYLE,

Assistant Secretary.

Dated the 18th day of November, 1891.

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 first public examination before Moderators at Oxford.
4. The previous examination at Cambridge.
5. The examination in Arts for the second year at Durham.
6. The examination for first-class certificate of the College of Preceptors (40 & 41 Vict. c. 25, s. 10).
7. The examination resulting in the obtaining of a Whitworth Scholarship.

XV.—EXAMPLES OF ANCIENT PATENT GRANTS.

The First Monopoly Patent. A.D. 1561.

De licencia pro Stephano Groyett et Antonio le Leurier.

Elizabeth by the grace of God, etc. To all our Justices officers Ministers and subjectes whatsoever greating. Knowe ye that we for dyverse weightie causes vs moving of our speciall grace and of certen knowledge and mere mocyon have geven and by thes presentes graunted vnto Stephen Groyett and Anthony le Leuryer full priviledge and auctorities that they and every of them and the survivor of them and not any other by them solves and there servauntes whereof tow at the least shalbe of our leges and subjectes borne within our Realme of Englond for the space of tenne yeares next ensuyng the date hereof in place and places convenient within this our realme of England not beinge within our Citie of London nor nere to anie the places or mansion houses of vs our heires and successors or of any our nobilitie or Councell at thes present builded to the annoyance of the same shall and may worke and make within this our realme of England white harde sope aswell in greate as in small cakes to be like of goodnes fynes and puritie as the sope is which is made in the sope house at Triana or Syvile in Andelizoi And therefore wo do by these presentes straightly charge and comaunde and also prohibitte all other our subjectes aswell denizens as not denizens at theis presentes not vsing within this our Realme the makinge of the saide whitte harde sope that they nor any of them during the said terme of tenne yeares shall within this our realme make or attempte to make any white harde sope upon payne of imprisonment and forfeiture of all suche sope as shalbe made by them or any of them contrary to the tenor hereof The one moitie of whiche forfeiture shalbe to the vse of vs our heires and successors And the other moitie thereof to the partie that will seaze the same or sue for the same in any our Courtes of recorde by informacon writte bill playnte or otherwise Provided alwayes and our pleasure is that all suche sope as by vertue of this our graunte or privilege shalbe made within three Miles of our Citie of London shall and made be viewed and tried from tyme to tyme by the order and appointement of the Mayor and Aldermen of London for the Tyme being And that all suche sope as by vertue hereof shalbe made in any other place of this our Realme more then three myles distaunt from the said Citie of London shall and may be viewed and tryed from tyme to tyme by the order and appointement of suche as the Lorde Chauncellor or keeper of the grete seale of this our realme for the tyme being shall assigne and appointe And if any of the said sope made and offered to sale shalbe founde defectyve vntruly or deceitfully made or wrought contrary to the entent of these presentes that then and from thencefurth this our graunte and privilege shall furwith cease determine and be voide anie thinge before mencioned to the contrary hereof in anie wise notwithstanding Wherefore we will and straightly charge all our said justices officers Ministers and subjects to be ayding and asisting for the due obseruacion of this our graunte and privilege in all things according to the tenor of the same In witness whereof etc. Witness the quene at Westm the third day of Januarie.

per breve de privato sigillo etc.

[Patent Roll. 3 Eliz., part 13, memb. 34.]

The patent being the first of its kind, the consideration of the grant is inadequately expressed—*for divers causes as moving.* The state of the art, however, may be gathered from other sources. The best English soap was the soft mottled Bristol soap; the consistency of which may be gathered from the fact that it was packed in barrels. The hard soda soap of Spain was therefore preferred for the fine laundry work then coming into fashion.

> "Some may present thee with a pound or twain
> Of Spanish soap to wash thy linen white."

The grantees being foreigners, the instruction of the native apprentice is insisted upon; and the manufacture is further subjected to the trial of experts appointed by the municipal authorities. Nothing further is known of the history of this grant, which is reproduced from "Engineering," 22nd June, 1894.

Hastings' Patent. A.D. 1569.

De licencie pro Johanne Hastinges.

Elizabeth by the grace of god Quene of England, ffrance and Ireland defendor of the faith &c. To all people to whom theis presentes shall come gretinge Whereas the arte and knowledge of makinge of certen kindes of Draperye or Wollen cloth comonlye called ffrezeadowes of all sortes suche as have ben or are nowe accustomablye made in Harlem Leyde Roterdam Amsterdam or Dirgowd in Holland or elles wheare in any other place or places of beyonde the seas is nowe of late by the procurement care deligence greate travaile and expences of our lovinge servaunt John Hastinges Esquire attayned vnto erected and sett upp within this our Realme of England which said wollen clothes comonly called ffrezeadowes contayninge in leingh the double pece xxiiij yardes and the single pece xij yardes and in bredth a yarde three quarters di do varie in makinge and workemanshipp from all sortes of clothes heretofore vsuallye made within our Realme of England but yet for divers respectes and chieflie for the perfecte and true makinge and dyinge of the same have ben had and ben nowe had in great estymacion to the great benefytt of the comon weale of the said Townes of Harlem Leyd Roterdam Amsterdam and Dirgowd in Holland aforesaid We therefore earnestly desiringe as mouche as in us lyeth to advaunce the comon weale of this our Realme of England and to the entent that all sortes of clothes called ffrezeadowes hereafter to be made within our said Realme of England may be truelye and in all respectes perfectlye made and wrought and thereby growe to be of greate estimacon in forreyn Realmes knowe ye that we of our especiall grace certen knowledge and mere mocion and for other good consideracions vs movinge have gyven and graunted and by theis presentes for vs our heires and successors do gyve and graunte vnto the said

John Hastinges to his heires executors [and admynistrators and assignes and to every suche other person and persons as the same John Hastinges his heires executors admynistrators and assignes or any of them shall name assigne or appointe] full and free libertie lycence power and auctoritie that he and they [by hym and them selves and his and theire deputes factors servauntes and workemen and every of them] at theire owne charges shall and may at all and every tyme and tymes and from tyme to tyme duringe the terme of twentie and one yeres next after the date of theis presentes within our Realmes of England and Ireland and within all other our domynions and within every parte of the same at his and their libertie and pleasure use exercyse *practyse practize* [*sic*] erect sett up and put in use the said devise arte and feate of makinge dressinge dyinge and perfytinge of the said wollen clothes comonlye called ffrezeadowes of all sortes suche as have byn or are nowe accustomablie made in Herlein Leyde Roterdam Amsterdam and Dirgowd in Holland or elles where in any other place or places beyonde the seas and from tyme to tyme duringe the said terme to bye aswell woole as woole felles with all other thinges necessarie to the provision makinge dyinge dressinge and perfytinge of the same clothes And the same clothes so made to utter sell retaile and do awaye at his and theire free will and pleasure and to his and theire best commoditie and proffytt from tyme to tyme duringe all the said terme of twentie and one yeres savinge alwayes to us our heires and successors all customes subsidies and duties to be due unto us our heires and successors for the same or any parte thereof And fourther of our speciall grace certen knowledge and mere mocion and for the considerations before expressed our will and plesure ys and we for us our heires and successors do by theis presentes fourther graunt to the said John Hastinges his heires executors .... full power and auchoritie from tyme to tyme duringe all the said terme of twentie and one yeres at his and theire libertie and pleasure make ordeyne devise establishe alter and chaunge by his and theire discrecions good and reasonable orders rules and ordinaunces aswell for the true and perfect makinge workinge dyinge dressinge and perfytinge of the said wollen clothes comonlye called ffrezeadowes as for the good rule and governamente of suche persons borne in the parties of beyonde the Seas as are or shalbe brought into this our realme of England by the said John Hastinges to the intent to practize and put in use the said arte and feate of makinge of ffrezeadowes and of all other people that shall have to deale or meddle with the makinge workinge dyinge or dressinge of the said clothes comonlye called ffrezeadowes or any of them or any thinge tendinge or appertayninge thereunto and to put the said orders rules and ordynaunces in due execucion in all pointes from tyme to tyme duringe the said terme of xxj yeres so alwayes that the same orders rules and ordynaunces tend not to the prejudice of our prerogative royall or to the losse hurte damage of us our heires or successors And fourther we will and for us our heires and successors do straightlye chardge enjoyne prohibite and commaunde that no person or persons our naturall Subjectes Denyzens or any other person or persons either borne within our Realmes of England and Ireland or elles where within any other of our Domynions or in any other forreyne Realme or Countrey whatsoever of what estate condicion or degree soever they be or shalbe (other then the said John Hastinges his heires executors admynistrators and assignes or suche as shalbe by hym or them sett on worke lycensed or auchoryshed) shall or maye hereafter duringe the said terme of xxj yeres practize exercise or by any meanes directlye use or put in worke the said arte feate or devise of makinge dyinge or dressinge of the said Clothes called ffrezeadowes within our said Realmes and domynions or within any parte of the same upon payne that whosoever contrarye to the tenor and meanynge of theis our letters patentes shall practize exercise or sett in work the said arte feate and devise in makinge dyinge or dressinge of ffrezeadowes shall for every tyme of his or theire so doinge forefeyte and lose all and every the same clothes and ffrezeadowes so made together with one hundreth poundes of lawfull money of England th'one half of the which forfeyture shalbe to us our heires and successors and th'other moytie to the said John Hastinges his executors admynistrators and assignes and besydes that shall incurre our indignacion and grevous displeasure and suffer such fourther ymprisonment and punysshment as we are heires and successors or our or theire previe Councell shall thinke mete Wherefore we charge and commaund all and singuler Justices of peace Mayours Baylyffes Counstables Offycers Mynisters Wardens Artyficers and Subjectes to whom in this behaulf it shall appertayne that they and every of them be aydinge helpinge and assistinge to the said John Hastinges his heires executors admynistrators and assignes Deputies Servauntes and workemen in all reasonable thinges wherein they shall have nede of theire help and assistaunce touchinge the accomplishment of the effect of theis our letters patentes or of any parte or parcell of the same as they and every of them tender our pleasure and will avoyde our indignacion and aunswere for the contrarye at theire uttermoste perilles and theis our letters patentes shalbe heire suffycient warrant and dyscharge in this behaulf any statute acte ordinaunce proviso &c. In witnes &c. witnes our self at Westm the twentie and sixthe daye of Maye.

per ipsam Reginam.

[Patent Roll. 11 Eliz., part 2.]

Hastings' case is of great constitutional importance. The grant, which should have been drawn so as to confine the patentee to the sole exercise of the dyeing and finishing certain cloths known as frizadoes, but practically indistinguishable from the broad baizes of the Essex and other weavers, afforded the patentee or his agents a pretext to molest the older industry on the ground that it was included in this patent. The Court of Exchequer appears to have decided in favour of the Coxhall weavers, who proved that the manufacture of baize had existed thirty years before the date of the letters patent; also, that so far as the manufacture of this cloth was concerned, Hastings had actually adopted the methods of the Essex weavers in preference to those imported from abroad. Notwithstanding the adverse decision, Hastings continued to harass the trade—relying, apparently, upon the support of the Crown, which was indirectly concerned in the patent. It had been estimated by the Dyers' Company that if all the cloth sent abroad to be finished were dyed in this country an increased revenue would accrue to the Crown of at least £10,000 per annum. In 1584 an action for trespass was brought in the Lord Mayor's Court, and the defendant was fined for interfering with a weaver within the jurisdiction of the City of London.

MATHEW'S GRANT. A.D. 1571.

ELIZABETH by the grace of god &c. To all &c greetinge Whereas We vnderstand that our welbeloued Iuante Richarde Mathewe our Cutler and Citezen of our Citie of London hath with his travaile and charges atteyned to the skill of makinge of certain haftes called Turkye haftes for knyves weapons and other things by hym lately devised in our Realme who doubtinge lest some other pson mighte practise and counterfayte the like to his hindraunce after his greate chardgs therein expended hathe made humble peticon to vs to puyde for the same We let you wit that of our especiall grace certen knowledge and mere mocyon We have geven and graunted and by those psents for vs our heires and successors do geue and graunte vnto the said Richarde Mathewe lycence and aucthorytie by hym self his Iuaunts and such as he shall set aworke to make the said haftes called Turky haftes for knyfes or for any other weapon or thinge whiche he can devise to be made of dyvers peces of horne of one or of sondry colours mixed and garnished betwene those peces with yellowe or white plate and for his marke to have vpon the blade and hafte of the same knyfes and other things to be so made by hym a half Moone The same to be vttered solde or otherwise disposed as he can agree with the byers fforbiddinge and phibitinge all other psons with'n this our Realme our subiects borne or straungers from hensforth to make the like Turkye haftes for knyves or any other thinge made or to be made by hym or his pcurement of the fashion here expressed nor of peces of horne of that fourme alone without those plates duringe all the tymes of Sixe yeres next folowinge twentie daies after the date hereof nor to sell or vtter any haftes or other things of that makinge other then those that are or shalbe made by the said Richarde or by his pcurement for hym vppon paine that euy pson herein offendinge to forfaite to the behoofe of the said Richard Mathewe all and euy the haftes and other things of that fashion which any other shall make or cause to be made or counterfayte at any tyme of duringe the said terme without his consent And also vpon payne of forfayture to vs our heires or successors for euy tyme of such offence tenne pounds Willinge and comaundinge aswell all and euy our Officers and namely the Maior and Aldermen of our Cittie of London to be aydinge and assistinge vnto the said Richard Mathewe as nede shall requier that accordinge to this our pleasure and graunte he may quyetly enioy theffecte thereof as also all other our lovinge subiects to suffer hym quyetly to enioy the benefyt of the same as they tender our pleasure and will answer to the contry at their vtmost pills In witnes whereof &c Witnes our self at Gorhamburye the xxxth day of July.

p bre de priuato sigillo &c. — p Rico Mathewe de licen sp̃ali.

[Patent Roll. 13 Eliz., part 7, memb. 11 (34).]

Stowe gives the following biographical account of this patentee:—"Richard Mathewe, at Fleetbridge, was the first Englishman that attained the perfection of making of fine knives and knife hafts, and in the 5th Eliz. [5 Eliz. cap. 7] he obtained a prohibition against all strangers and others for bringing any knives into England from beyond the seas, which until that time, were brought into the land by shippes lading from Flanders and other places. Albeit at that time and for many hundred yeeres before there were made in divers parts of this kingdom many coarse and uncomely knives, and at this day the best and finest knives in the world are made in London. Note he attained his skill by travelling and residing in divers nations. His knives were marked with the halfe moone according to his letters patent." There is little to add to Stowe's narrative.

The patent was successfully resisted by the Cutlers' Company before the Privy Council on the plea "that it hath been and will be the overthrow of the cutlers within the City." It was also represented that the enhancement of price was prejudicial to the Queen's subjects (*Lansd. MSS.*). Coke, generally, confirms this version. The case proves that the validity of patents of addition was not at this period firmly established. It is ridiculous to cite the case in support of the maxim that a grant of a known trade is illegal. The common law regarded with great jealousy grants made in respect of a pre-existing trade, although the grant professedly covered the improvement only.

Shortly after this case the Privy Council was invested with the right of summary revocation in case a grant should prove prejudicial or inconvenient—a clause still retained in the modern patent grant—although these functions have long ceased to be exercised by that body.

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.

JAMES, by the grace of God King of England, Scotland, France, and Ireland, 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. — Style. Address.

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 — Recitals.

(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.

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, 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 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, 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 law 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 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,

Grant,

for twenty-one years.

Exclusive monopoly to make maps, &c., of certain cities.

Prohibition.

Power of entry and search in ships and other places,

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, 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 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 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 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.

and seizure.

Proviso.

Command to all persons to assist patentees.

In witness whereof, &c. Witness ourself at Westminster, the eleventh day of March.

By Writ of Privy Seal.

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