LETTERS PATENT FOR INVENTIONS.

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THE

LAW AND PRACTICE

RELATING TO

LETTERS PATENT FOR INVENTIONS.

BY

THOMAS TERRELL, Q.C., F.C.S.,
BARRISTER-AT-LAW.

THIRD EDITION

REVISED BY

WILLIAM PETER RYLANDS, B.A.,
BARRISTER-AT-LAW.

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LONDON:
SWEET & MAXWELL, LIMITED, 3, CHANCERY LANE,
Law Publishers.
1895.

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LONDON
BRADBURY, AGNEW, & CO. LD., PRINTERS, WHITEFRIARS.

Rec. Oct. 1, 1896

PREFACE.

In this Edition I have endeavoured to bring the subject of Letters Patent up to date. Recent decisions before the Courts and the Law Officers have cleared up so many important but hitherto obscure points in the Law and Practice that the 1889 Edition of this work has become incomplete and unreliable. I have had the advantage of the assistance of the Author on many points of difficulty, and I trust that it will be found that the result of my labours is as reasonably free from error and imperfection as a legal text book is expected to be.

W. PETER RYLANDS.

New Court, Temple.

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THE LAW AND PRACTICE

RELATING TO

LETTERS PATENT FOR INVENTIONS.

CHAPTER I.

LETTERS PATENT.

Letters patent for inventions are granted by the Crown by virtue of its common law prerogative. Letters patent are franchises, being a branch of the royal prerogative vested in the hands of a subject. In *Reg.* v. *County Court Judge of Halifax* (*a*), Baron Pollock, in giving the judgment of the Court, said: "It was contended on behalf of the defendant that 'franchise' includes the right or privilege which is granted by a patent for a new invention. The primary meaning of the word 'franchise,' as its origin denotes, is a freedom; but it has been used in the language of the law in a wider sense as including a liberty or privilege. In Termes de la Ley, tit. 'Franchise,' the only meaning given to it is 'an immunity or exemption from ordinary jurisdiction.' The various rights, however, which it aptly describes are dwelt upon at great length in the Digests of Viner and Comyn, and in Bacon's Abridgement; and in Blackstone's Commentaries, Vol. II. p. 7, it is said: 'Franchise and liberty are used as synonymous terms, and their definition is, a royal privilege, or branch of the king's prerogative, subsisting in the hands of a subject. Being, therefore, derived from the Crown, they must arise from the king's grant; or in some cases may be held by prescription, which, as has been frequently said, presupposes a grant. The kinds of them are various and almost

(*a*) L. R., 1891, 1 Q. B. 793, 797; rmed by C. A., L. R., 1891, 2 Q. B. 263.

infinite.' In Chitty's Prerogative of the Crown, p. 119, a franchise is defined to be a royal privilege, or branch of the royal prerogative, subsisting in the hands of a subject by a grant from the king; and for this he refers to Finch's Law, p. 164. In Comyn's Digest, tit. 'Prerogative,' D. 30, it is said: 'The king may grant to another to have any franchise or liberty as privileges of trade;' and under the head of 'Trade' (B), instances are given of grants by the king's patent for the sole printing of certain books. In *Darcy* v. *Allen* (*b*), the Court said, in dealing with the first question—viz., whether the said grant to the plaintiff of the sole making of cards within the realm was good or not—'Also such charter of a monopoly, against the freedom of trade and traffic, is against divers Acts of Parliament, as 9 Edw. III. cc. 1 & 2, which for the advancement of trade and traffic extends to all things vendible, notwithstanding any charter of franchise granted to the contrary, or usage or custom, or judgment given upon such charters, which charters are adjudged by the same Parliament to be of no force or effect.' These words are inapplicable to the 'first question,' unless the Court intended to assume that the grant of the sole making of cards within the realm was a 'charter of franchise'; and, although the charter of franchise mentioned in the statute cited apparently referred to charters which had been granted to corporations or towns, it seems to be a fair inference that the Court considered such charter of a monopoly as a charter of franchise; and that this would be none the less true when the monopoly answered to the description which the Court declared to be lawful, *i.e.*, 'where any man by his own charge and industry, or by his own wit or invention, doth bring any new trade into the realm, or any engine tending to the furtherance of a trade that never was used before, and that for the good of the realm.' The result of these authorities is, in our opinion, that 'franchise' does include such a right as was put in issue by the proceedings in the county court."

By the creation of monopolies to first and true inventors in the right of using their inventions, a species of property is created in favour of inventors, as a reward for the benefits which they have conferred on humanity, by the exercise of their thought, know-

(*b*) 11 Rep. 84.

ledge, and industry. It is to the interests of the community that persons should be induced to devote their time, energies and resources in furtherance of the development of arts and manufactures, and this was recognised in England from the earliest periods which can pretend to be described as civilized.

It was to the advantage of the whole community that inventors should be rewarded, and no measure of reward can be conceived more just or equitable, and bearing a closer relation to the benefit conferred by the particular inventor than to grant him the sole right of making, using and vending his invention for a limited period of time.

In the corrupt ages of the Stuarts, it is not to be wondered at, that the prerogative of the crown to grant monopoly rights to first and true inventors, should have been made a lever for assuming a prerogative to grant monopoly rights in trade generally. In the reign of James the First, to such an extent had this abuse been carried, that it was deemed advisable by the legislature that the rights of the crown in respect of letters patent should be declared by legislative enactment—this was the origin of the Statute of Monopolies.

It has been supposed that the prerogative of the crown to grant letters patent for inventions was created by this statute, but the most cursory perusal of its enactments and of the authorities which preceded it, shows clearly that, so far from the statute giving to the crown any right which it did not possess before it was passed, it has as its intention the limiting the right of the crown, and the declaring that, which had always been the common law upon the subject. In the first section of this Act, for instance, we find it recited "that all grants of monopolies and of the benefit of any penal laws, or of power to dispense with the law, or to compound for the forfeiture, are contrary to your Majesty's laws, which your Majesty's declaration is truly consonant and agreeable to the ancient and fundamental laws of this your realm. . . . . That all monopolies, and all commissions, grants, licenses, charters, and letters patent heretofore made or granted or hereafter to be made or granted . . . . are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in no-wise to be put in use or execution."

Section 6 saved the granting of letters patent to inventors in the following words:

"Provided also, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patent and grants of privilege for the term of fourteen years or under, hereafter to be made of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patent and grants shall not use, so as also they be not contrary to the law, nor mischievous to the State by raising of prices of commodities at home, or hurt of trade, or generally inconvenient; the said fourteen years to be accounted from the date of the first letters patent or grant 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."

It will thus be seen that the Statute of Monopolies creates no statutory rights, but merely saves the common law rights of the crown; and by section 116 of the Patents Designs and Trade Marks Act, 1883, it is enacted, "*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 the grant thereof.*" By section 46 of the same Act the word "*invention*" is defined as meaning "*any manner of new manufacture the subject of letters patent and grant of privilege within section 6 of the Statute of Monopolies . . . . and includes an alleged invention.*"

So it is that in the present day, notwithstanding the various statutes which have been passed in relation to letters patent for inventions, these monopolies are still granted upon the mere motion of the sovereign, in the exercise of her royal prerogative, and that all that has been done, has been declaratory of the limits within which that prerogative should be exercised, and of the method of procedure to be adopted in obtaining letters patent for inventions.

For the purpose of supporting the validity of the letters patent it is necessary that the patentee should conform to certain requisites, and these requisites are indicated in the 6th section of

the Statute of Monopolies. In the first place, he must be the true and first inventor of a new manufacture; the new manufacture must not be contrary to law, nor must it be mischievous to the State, by raising the prices of commodities at home; it must not be hurtful to trade, nor generally inconvenient. The Act of 1883 has adopted this definition of an invention, and anything that does not conform with all these requisites is not entitled to be called an invention. The host of important decided cases as to the construction of the 6th section of the Statute of Monopolies, and the enormous expense, and labour and learning, which have been devoted to obtaining these decisions, no doubt induced the legislature to adopt a definition which had in some respects obtained a correct judicial meaning; but it is doubtful whether it was wise to re-enact it in a form which had, we may say, centuries ago, already become to some extent obsolete.

The protection of trade by means of guilds, and by all those various schemes which were elaborated in the middle ages, has been found to be fallacious. Industries in this country are no longer protected by the artificial process of law, and therefore it is difficult to understand the correct meaning which would be given to the words in the 6th section of the Statute of Monopolies, which refer to an invention having a tendency to raising the prices of commodities at home, or to hamper trade, or to be generally inconvenient, terms exceedingly vague in themselves, and which the Courts have not had occasion to consider for a very great number of years.

These matters, and the construction which is to be placed upon the word "*invention*," will have to be dealt with hereafter, when we consider the cases which have been decided upon the subject.

Thus we see that the same essentials must be proved by an applicant for the grant of letters patent to-day as were necessary at the date of the Statute of Monopolies; he must be the first to introduce into this realm the manufacture for which he seeks a patent, whether by enterprise in importing it from abroad, or by the exercise of his own inventive faculty. The Patents, &c., Acts, 1883–1888, deal merely with points of procedure and

practice, adopting, as has been already pointed out, the definition of an invention contained in the sixth section of the Statute of Monopolies; the Act of 1883 consolidated all the provisions of previous acts on the subject, at the same time introducing some few innovations, the effect of which will be dealt with in detail in the course of the consideration of the various branches of the subject as they arise.

CHAPTER II.

THE PATENTEE.

By sect. 46 of the Act of 1883, the word "**patentee**" is construed as meaning "the person for the time being entitled to the benefit of the patent," consequently it may mean the original grantee, his executors and administrators, or any assignee.

A **mortgagee** is the legal owner of the patent, but if not registered in "The Register of Patents" *as proprietor*, he is not the person for the time being entitled to the benefit of it so as to constitute him "patentee," and it is not necessary that he should be joined as a party in an action for infringement (*a*), and semble this would be the case, even if he was so registered (*b*).

An **exclusive licensee** has not such an interest in the patent as to enable him to maintain an action for infringement, he may, however, sue in the name of the grantor of the license (*c*).

Lord Justice Cotton in the Court of Appeal said: "All that is contended is that an exclusive license is equivalent to a grant, and that the licensee may, without the concurrence of the patentee, or without there having been any violation of the agreement between the patentee and himself, sue the person who is infringing the rights conferred by the license. In my opinion that is wrong. That is turning that which is merely a license into something very different, namely a grant of the whole letters patent" (*d*).

(*a*) *Van Gelder Apsimon & Co.* v. *Sowerby Bridge Flour Co.*, L. R., 44 Ch. D. 374.

(*b*) Ib. p. 389.

(*c*) *Heap* v. *Hartley*, L. R., 42 Ch. D. 461; *Derosne* v. *Fairie*, 1 Web. P C. 154; *Renard* v. *Levinstein*, 2 Hem. & M. 628.

(*d*) *Heap* v. *Hartley*, L. R., 42 Ch. D. 469; *Guyot* v. *Thomson*, 11 P. O. R. 541, 554.

By sect. 4 of the same Act it is enacted: (1) *Any person, whether British subject or not, may make an application for a patent.*

It will be observed that there is no limitation whatever preventing a person under incapacity, either by reason of infancy or otherwise, from obtaining a patent.

There does not appear to have ever been a question as to whether an **infant** or a **married woman** might under the old law have become a grantee of letters patent. The new law, however, is perfectly clear, and sweeps away any doubt that might have been entertained on the subject.

Before this Act it was competent for an **alien** to obtain a patent; Lord Cairns in the matter of *Wirth's Patent* (*e*), went even further than this: "I am quite clear that letters patent may be granted to a foreigner who is resident abroad for an invention communicated to him by another resident abroad" (*f*).

But quære if letters patent could be obtained by an **alien enemy** (*g*).

In *Patterson* v. *Gas Light and Coke Co.*, James, L.J., in the Court of Appeal, said: "Although it is not necessary for the determination of this suit to pronounce any final decision on this point, we deem it right to say that we think it at the least very questionable whether it can be competent for a member of an official commission or committee to take out a patent for the subject-matter of their official investigation (*h*).

It has been thought doubtful whether a beneficed **clergyman** could become the grantee of letters patent, since the exercise of an invention would probably amount to trading within the meaning of 57 Geo. III. c. 99 (*i*).

Rule 73 of the P. O. Rules, 1890: "**A body corporate** may be registered as proprietor by its corporate name." It could, however, only become proprietor as assignee of the letters patent, or as co-grantee with the original inventor, since

(*e*) *Wirth's Patent*, L. R., 12 Ch. D. 303; 28 W. R. 329.

(*f*) See also *Chappell* v. *Purday*, 14 M. & W. 318.

(*g*) *Bloxam* v. *Elsee*, 1 C. & P. 558.

(*h*) L. R., 2 Ch. D. 832.

(*i*) Hindmarch on Patents, p. 35 *Hall* v. *Franklin*, 3. M. & W. 259.

a corporation, being without a mind, lacks that which is obviously an essential to invention (*k*).

By sect. 4 (2) it is enacted "*Two or more persons may make a* **joint application** *for a patent, and a patent may be granted to them jointly.*"

Only one of the applicants need make the **declaration**, a capitalist or other person or persons may join an inventor and obtain a valid joint patent (*l*).

A grant of letters patent confers on the patentee "a right to exclude others from manufacturing in a particular way and using a particular invention" (*m*), it does not affect his right of manufacturing according to his invention, which he would have had if there were no letters patent at all; consequently, 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 without affording an account of his profits to his **co-patentees** (*n*), and this is the case whether they are co-grantees or co-assignees.

As to rights of such co-patentees to the profits made by granting licenses, quære (*o*).

A co-owner of letters patent is entitled to work the invention without accounting for profits, even though he may be mortgagee of the share of the other co-owner (*p*).

By sect. 5 (1) "**An application** *for a patent must be made in the form set forth in the 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*" (*q*). (2) "*An application must contain a* **declaration** *to the effect that the applicant is in possession of an invention thereof 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*

(*k*) Hindmarch on Patents, p. 34.

(*l*) 48 & 49 Vict. c. 63, s. 5.

(*m*) Per Lord Chancellor in *Steers* v. *Rogers*, L. R., 1893, App. Cas. 235; 10 P. O. R. 251.

(*n*) *Steers* v. *Rogers*, 9 P. O. R. 177; L. R., 1892, 2 Ch. 13; 10 P. O. R. 245; L. R., 1893, App. Cas. 232; *Mathers* v. *Green*, L. R., 1 Ch. 29; 35 L. J., Ch. 3; *Hancock* v. *Bewley*, 1 Johns. 604; Good P. C. 219.

(*o*) *Mathers* v. *Green*, L. R., 1 Ch. 33; 35 L. J., Ch. 3.

(*p*) *Steers* v. *Rogers*, supra; see Chap. XII., post.

(*q*) See Appendix, Forms A, A1, A2.

for which he or they desire or desires to obtain a patent, and must be accompanied by either a provisional or complete specification.

By sect. 99 of the Act, due provision is made for enabling infants, and people under incapacity to take the requisite steps for obtaining letters patent.

Sect. 34 makes provision for the granting of letters patent to the **legal representatives** of a deceased inventor, provided application be made within six months from the decease of the inventor; the application must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

We have now to deal with the construction of the words "first and true inventor."

The reason that the common law has created a prerogative of the Crown to grant letters patent to first and true inventors is, that the public benefit by the consideration which the inventor gives in return for the monopoly privilege which is granted to him. That consideration may be divided into three parts.

In the first place the patentee must be **the actual inventor**, that is, the consideration must move from him.

Secondly, he must have invented a **new and useful invention.**

Thirdly, he must **publish his invention.**

CHAPTER III.

THE CONSIDERATION—BEING THE ACTUAL INVENTOR.

An actual inventor is a person who, either by accident or design, produces or discovers an art or manufacture. The process of invention may be divided into two parts. The operation of the mind, and the carrying out the results of that operation by the hands. It is true that when an invention is the result of pure accident the physical production may precede the operation of the mind in perceiving its applicability, still, as a general rule, it will be observed that the operation of the mind will precede the physical production. The operation of the mind must, in all cases, be that of the mind of the inventor. The carrying out of the results of the operation of the mind may be done by the hands of the inventor or by those of anyone else whom he may employ for the purpose.

In *Tennant's Case* (*a*) a material portion of the invention claimed was found to have been suggested by a chemist at Glasgow. Lord Ellenborough held, that the patent was bad because the plaintiff was not the inventor. It will be observed in this case, that although it is possible that the plaintiff was the first person to use the particular method for making bleaching liquor, still, inasmuch as that method of producing this bleaching liquor was thought out by someone else and communicated to the plaintiff, he was held not to be an inventor. In considering this question, we must not confuse the idea of first manufacturer with that of first inventor.

It is evident that cases may arise where the operation of one man's mind may have assisted the operation of another's mind.

(*a*) *Tennant's Case*, 1 Web. P. C. 125.

In this case it will be a question for the jury as to which was, so to speak, the **dominant mind** and which the servient **mind**, the dominant mind will be entitled to the patent. In *Allen* v. *Rawson* (*b*), Tindal, C.J., said: "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 upon its own merits. But when we see that the principal objects of the invention are complete without it, I think it is too much that a suggestion of a workman, employed in the course of the experiments, of something calculated more easily to carry into effect the conceptions of the inventor, should render the whole patent void."

In *Cornish* v. *Keene* (*c*) Tindal, C.J., said: "Sometimes it is a material question to determine whether the party who got the patent was the real and original inventor or not, because these patents are granted as a reward, not only for the benefit conferred upon the public by the discovery, but also the **ingenuity of the first inventor**; and although it is proved that it is a new discovery, so far as the world is concerned, yet if anybody is able to show that although that was new with the party who got the patent, he was not the man whose ingenuity first discovered it, that he borrowed it from A. or B., or had taken it from a book that was printed in England, and which was open to all the world—then, although the public had the benefit of it, it would be an important question whether he was the first and original inventor of it." There is no doubt that under the circumstances stated by the Chief Justice, the patentee would not be the original inventor.

We do not propose to deal at length with the cases that succeed *Cornish* v. *Keene*. The principle laid down in those cases we have cited has been invariably followed. In *Gibson* v. *Brand* (*d*), Tindal, C.J., said: "A man may publish to the world that which is perfectly new in all its use, and has not before been enjoyed, and yet he may not be the first and true inventor, he may have borrowed it from some other person or book. The legislature

(*b*) *Allen* v. *Rawson*, 1 C. B. 574.
(*c*) *Cornish* v. *Keene*, 1 Web. P. C. 507.
(*d*) *Gibson* v. *Brand*, 1 Web. P. C. 628.

never intended that a person, who had taken his knowledge from the art of another, from the labours and assiduity of another, should be the man who was to receive the benefit of another's skill." The same judge in *Walton* v. *Potter* (*e*): "If the subject-matter of the patent has been published in a dictionary, for example, and if a man merely adopts it, the merit is so small that his patent for it would be worth nothing."

In *R.* v. *Wheeler* (*f*), Abbott, C.J., delivering the judgment of the Court said: "If the patentee has not invented the matter or thing of which he represents himself to be inventor, the consideration of the royal grant fails, and the grant consequently becomes void. And this will not be the less true, if it should happen that the patentee has invented some other matter or thing, of which, on due representation thereof, he might have been entitled to a grant of the exclusive use."

In *Bloxam* v. *Elsee* (*g*), the patentee had worked out the principle of his invention in his own mind, the mechanical details and arrangements requisite for carrying the principle into practice so as to realize the idea were extremely numerous and complicated, and Mr. D. was employed professionally to assist in these arrangements. Mr. D. had suggested several parts of the machine to the patentee. An objection was taken that the patentee was not the inventor, the objection was overruled. It will be seen in this case that the patentee's mind conceived the invention, and that Mr. D. was only, so to speak, the intellectual hands employed by the patentee to carry out that which he had previously conceived in his mind. The summing-up of Baron Alderson, in the case of *Minter* v. *Wells* (*h*), is instructive on this point: "The patentee," said the learned judge, "claims under the patent, stating, in his petition to the Crown, that he is the true inventor of the machine in question, and if it could be shown that he was not the true inventor, but that someone else had invented it, the Crown is deceived in that suggestion, which was the foundation on which it granted the patent, and then the

(*e*) *Walton* v. *Potter*, 1 Web. P. C. 592.

(*f*) *R.* v. *Wheeler*, 2 B. & Ald. 345.

(*g*) 1 C. & P. 558; 1 Web. P. C. 132, n.

(*h*) *Minter* v. *Wells*, 1 Web. P. C. 127.

law is, that the patent obtained under such circumstances would be void, and no action could be maintained against the party for the infringement of the patent. If Sutton suggested the principle to Minter, then he, Sutton, would be the inventor; if, on the other hand, Minter suggested the principle to Sutton, and Sutton was assisting him, then Minter would be the first and true inventor, and Sutton would be a machine, so to speak, which Minter uses for the purpose of enabling him to carry his original conception into effect."

Exactly to what extent the man who conceives an idea is entitled to improvements suggested by the person he employs to work out that idea, is difficult to define, and must depend upon the facts of each case in which the question may arise; but the guiding principle is, Is it the mere idea, or is it the method of carrying it into effect that constitutes the pith of the invention?

In *Elias* v. *Grovesend Tinplate Co.* (*i*), the facts were as follows: In the year 1867, and subsequently, one Morewood took out patents for machines for removing the superfluous tin from tinplates, this he effected by the immersion of the tinplate in a grease-pot by means of a cradle, with an adjustable guide at each end, so that the plate, upon immersion, was sent down into the grease-pot in a perpendicular position, and so brought under the rollers therein, these rollers raised the plate to the surface in a like perpendicular position having in the meantime squeezed or compressed from the plate any superfluous tin adhering to it; by means of what was practically a duplicated machine of this description Morewood was able to treat two plates at a time, but when the "double Morewood" was at work it brought up the plates alternately and not simultaneously. In 1885 it occurred to the plaintiff that saving in time and labour would be effected if a similar machine were constructed to bring up the two plates simultaneously. In 1886 he communicated his idea to Mr. Glyn Thomas, of whose works he was the manager, describing it "to work two sheets at a time, side by side, on the Morewood principle, with rollers lengthened." The patent was held invalid for want of subject-matter, but the Master of the Rolls in the Court

(*i*) *Elias* v. *Grovesend Tinplate Co.*, 7 P. O. R. 455.

of Appeal said (*k*): "Supposing there is an invention in that which is claimed—the carrying out of an idea in a machine—was the whole of that invention Mr. Elins', the plaintiff's, or was not part of it the invention of Karrop the machinist? Upon the assumption that there must be more than the idea, and that the machine is part of the invention—I mean the mechanism is part of the invention—was the whole of that done by Elins? The evidence seems to me to be clear as to this, that he had the idea in his mind of doubling Morewood's pot lengthways, that is of making a pot of Morewood's twice the size of Morewood's, so that the two plates might be put in side by side. That was his idea. If that was all, it was not patentable; but it is to be done in a machine. Did he have anything in the world to do with the construction of the machine which upon the assumption is part of the invention? . . . . If it is an invention Karrop has invented part of it."

The above quoted cases (*l*) all seem to show that the man who conceives the idea has no right to the inventions of the man whom he employs to carry it out other than mere improvements in mechanical details, whether that man be his immediate servant or an independent mechanic, and the relationship of master and servant gives to the master no rights to the invention of his servant (*m*).

A. may have invented something, it may have pleased him to try a few experiments with his invention, and then to abandon it without publication. B. may subsequently have invented the same thing altogether independently of A. If B. applies for letters patent he is at law the first inventor; but should it be shown that the process of invention was not carried on in B.'s mind at all, but that A. communicated his ideas to B., although

(*k*) Ib. pp. 465, 466.

(*l*) *Allen* v. *Rawson*, 1 C. B. 551, 574; *Minter* v. *Wells*, 1 Web. P. C. 127; *R.* v. *Wheeler*, 2 B. & Ald. 349; *Elias* v. *Grovesend Tinplate Co.*, 7 P. O. R. 455; see also *David & Woodley's Patent*, Griff. L. O. C. 26.

(*m*) *Barker* v. *Shaw*, 1 Web. P. C. 126, n.; *In re Lowe's Patent*, 25 L. J., Ch. 456; *R.* v. *Arkwright*, Dav. P. C. 61; *Homan's Patent*, 6 P. O. R. 104; *Barber* v. *Walduck*, 1 Carp. P. C. 438; *Re Russell's Patent*, 2 De G. & J. 130; *Scott* v. *Young*, L. R., 6 Ch. 274; *Saxby* v. *Gloucester Waggon Co.*, Griff. L. O. C. 56; *In re Heald's Patent*, 8 P. O. R. 429; but see *Kurtz* v. *Spence*, 5 P. O. R. 180.

with the full intention of abandoning them, B. will not be the first inventor. Take, for instance, the case of *Dollond's Patent* (*n*): this was an improvement in the manufacture of object-glasses for teloscopes. Dr. K. had made and used identically similar object-glasses for his own purposes, but he had in no way published his invention. Dollond, without any communication from Dr. K., had re-invented these object-glasses; held that Dollond's patent was good.

In *Lewis* v. *Marling* (*o*), Mr. Justice Bailey said: "If I discover a thing for myself, it is no objection to my claim to a patent that another also has made the discovery, provided I first introduce it into public use." The suggestion in that case having been that the patentee had acquired his invention by seeing a model of a similar machine which had been brought from America; it was disproved that he had seen the model, and consequently he was held to be the first and true inventor.

In dealing with this branch of the subject, and showing that one of the essential portions of the consideration for the grant of letters patent is the labour of the mind of the inventor, we may cite the case of *Patterson* v. *Gas Light and Coke Company* (*p*). In that case certain referees had been appointed under the City of London Gas Act to inquire into the subject of the purification of gas. The plaintiff was one of those referees. The referees drew up a report on the 31st January, 1872. The report contained a description of the subject-matter of the plaintiff's patent. Subsequently to the making of the report, but before its delivery to the Board of Trade, the plaintiff, who had really discovered the invention, obtained provisional protection. The action was brought against the Gas Light and Coke Company for infringing his patent. The company alleged that the invention was not new, and also denied the title of the plaintiff to take out a patent in respect of it, on the ground presumably, that he had no consideration to offer to the public in return for the grant of letters patent, he having already disposed to the public of his knowledge upon the subject for other considerations. In the judgment of the House of Lords, Lord Blackburn said: "It seems to me

(*n*) 1 Web. P. C. 43. 433.
(*o*) 10 B. & C. 27; 1 Web. P. C. (*p*) L. R., 3 App. Cas. 239, 243.

clear that the duty of the referees under the Act was to ascertain how far the gas could be practically purified by each company. If they found that gas containing not more than a certain limited amount of impurity could be practically produced by any means, they were to prescribe the maximum amount accordingly, and they were by obvious implication, though it is not expressly enacted, to make public how this degree of purity could practically be obtained. It was not material to them to inquire whether these were means previously known, which the companies had failed to make use of from parsimony, negligence or ignorance, or whether there was some new idea which had been developed during the course of their enquiries, which made these old means practically valuable when before they were not. They were not at all required to distinguish new from old. In all these respects the report was quite different from a specification. But, as soon as they became aware that the gas could be practicably brought to this degree of purity, their duty was to fix the maximum accordingly, and to make known to the public the means by which this could practicably be done. The report of the 31st January, 1872, is drawn up as it ought to have been. It shows that, by some means there explained, purity to a great extent could practicably be obtained, it makes no attempt to show how much of this was previously known though neglected, and it nowhere states that any part of what was now disclosed was invented by one of their own body." In the Court of Appeal James, L.J., had said (*q*): "Although it is not necessary for the determination of this suit to pronounce any final decision on this point, we deem it right to say that we think it at the very least very questionable whether it can be competent for a member of an official commission or committee to take out a patent for the subject-matter of their official investigation . . . It is to be borne in mind that the report then made belonged absolutely to the State. Every fact and figure in it had been ascertained, and obtained at the public expense, every hour of every referee and of the secretary employed in the production of it was public time . . . the consideration for every patent is the communication of useful information to the public. What con-

(*q*) L. R., 2 Ch. D. 832.

sideration is there when the information was already the property of the State?"

These judgments, although going to a point which was not absolutely necessary for the decision of the case (for the case was decided upon the ground of want of novelty in the invention), tend to show that it was in the minds of the judges that the mental labour of making the discovery being an essential element for the consideration of the grant, if that mental labour had already been paid for by the State, it failed as a consideration to support the patent.

By sect. 35 of the Act of 1883, "*A patent granted to the true and first inventor shall not be invalidated by an* **application in fraud** *of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.*" This clause is only a re-enactment of that which had been decided to be the law previous to the Act. In *Ex parte Scott and Young* (*r*), the servant had filed a provisional specification of an invention, after which the master filed a specification for a similar invention, and subsequently filed a complete specification, and obtained letters patent. It was held that, under the circumstances, the Great Seal might be affixed to the letters patent of the servant's invention, and that the patent might bear the date of his provisional specification.

In the case of *Ex parte Bates and Redgate* (*s*), it was held, that leaving a provisional specification, and obtaining a provisional protection, does not prevent a second applicant from leaving a specification of a similar invention, and obtaining valid letters patent for the invention before six months have elapsed from the time when the first provisional specification was left, and in such a case letters patent will not be granted to the first applicant for any part of his invention, which is covered by the letters patent already obtained by the second applicant, but in this case there was no suggestion of fraud on the part of the second applicant. This decision has, however, been doubted in *Re Dering's Patent* (*t*), by Lord Cairns, who said: "I may

(*r*) L. R., 6 Ch. 274.
(*s*) L. R., 4 Ch. 577.
(*t*) L. R., 13 Ch. D. 395.

however, state my objections to that decision" (*Bates and Redgate*), "which I never could thoroughly understand; it has always seemed to me that if Parliament hold out to inventors the advantage they could get from provisional protection, the inventor should have the enjoyment of that advantage for the six months granted to him. Parliament intended the six months to be for the completion of the invention, and for perfecting the specification, and never said that the applicant should be deprived of or lose that privilege for want of any due diligence on his part."

The difficult questions, however, which arise in these cases, seem to be set at rest by the 14th section of the Act of 1883: "*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.*"

The general question of concurrent applicants, where there is no fraud, that is, where each applicant is in a position to offer the consideration of mental labour, will be considered in a subsequent Chapter. It is only material here so far as concurrent application is brought about by reason of one man fraudulently appropriating the invention of another.

The right of the Crown to grant letters patent to true and first importers of inventions appears to have been a common law right. We find that so far back as 1567 a patent had been granted to one Hastings (*u*) for the making of frisadoes in consideration of his having *imported the skill of manufacturing them from abroad.* So in Mathey's case, "It was granted unto him the sole making of knives with bone hafts and plates of lattice, because, as the patent suggested, he brought the first use thereof from beyond the seas." This was in the reign of Elizabeth. In the *clothworkers of Ipswich* case we have this (*x*) said, "The king granted unto B. that none besides himself should make ordnances for battery in the time of war: such grant was adjudged void.

(*u*) 1 Web. P. C. 6.

(*x*) 1 Web. P. C. 6; 1 Godb. 252 254.

But if a man hath brought in a new invention and a new trade in the kingdom in peril of his life and consumption of his estate or stock, &c., or if a man hath made a new discovery of anything, in such cases the king, of his grace and favour in recompense of his costs and travail, may grant by charter unto him that he only shall use such a trade or trafique for a certain time; because at first the people of the kingdom are ignorant, and have not the knowledge or skill to use it. But when that patent is expired the king cannot make a new grant thereof." This was in 1615.

Then came the Statute of Monopolies, and we have seen that the 6th section of that Act carefully excepted "the sole working or making of any manner of new manufactures **within this realm**, to the true and first inventor or inventors of such manufactures, which others at the time of making such letters patents and grants shall not use."

Afterwards came the decisions of *Darcy* v. *Allin* (*y*), and *Edgebury* v. *Stevens* (*z*), where it is said, "for the statute speaks of new manufactures **within this 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." See the remarks of Eyre, C.J., in *Boulton* v. *Bull* (*a*).

In the early days of manufacturing enterprise, when true inventors were so exceedingly rare as scarcely ever to be heard of, the word inventor had not acquired the meaning which it has at present, and seems to have been used to designate a **first introducer** rather than a first inventor. In the early reports shortly succeeding the Statute of Monopolies we do not find the judges in any difficulty in dealing with the words "true and first inventor," showing that the word **inventor** had not the precise meaning which it has since acquired.

In *Marsden* v. *Saville Street Co.* (*b*) in the Court of Appeal, Jessel, M. R., said, speaking of imported inventions, "It has been argued that before the Statute of James such patents were valid and were allowed by the judges, and that the statute

(*y*) 1 Web. P. C. 6.
(*z*) 1 Web. P. C. 35 : 2 Salk. 447.
(*a*) 2 H. Bl. 491.
(*b*) L. R., 3 Ex. D. 203.

merely restricts the duration of the patent and does not destroy the right as it previously existed. Even supposing that were so, the statute defines who are considered to be worthy recipients of the grant of such a monopoly, as it was then called, and the definition so given has been followed ever since. It is difficult to say *à priori* 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 enquiry of others, and of some who are more familiar with the patent law than even I am, although I cannot pretend not to possess a considerable familiarity with it, I could never get a satisfactory answer. The only answer was, 'It has been so decided and you are bound by the decisions.' 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 on it as a sort of anomalous decision which has acquired by time and recognition the force of law."

The practice of granting letters patent to the first importers of manufactures and inventions new within this realm has been uniformly sustained by our Courts of law (*c*).

In *Milligan* v. *Marsh* (*d*) it was held by Vice-Chancellor Page-Wood that a person taking out a patent and making a declaration that he is a first inventor, when, in truth, he is only an importer of a communicated invention, makes a false suggestion, and the patent is void.

When the Act of 1883 was passed, doubts were expressed as to whether the effect of sect. 5, sub-sect. 2, was not to do away with the granting of patents for what are known as communications from abroad, these doubts were shared by the author, particularly with reference to the case of *Milligan* v. *Marsh* (*supra*). The question has since been in a manner touched upon in the

(*c*) *Plimpton* v. *Malcolmson*, L. R., 3 Ch. D. 555; *Chappell* v. *Purday*, 14 M. & W. 318; *Nichels* v. *Ross*, 8 C. B. 723; *Carpenter* v. *Smith*, 1 Web. P. C. 530, 535; *Edmunds' Patent*, Griff. P. C 283; *Moser* v. *Marsden*, 10 P. O. R. 359.

(*d*) 2 Jur. N. S. 1083.

case of *In re Avery's* patent (*e*), where, although in no way deciding the point, it appears to have been considered that such a patent might be granted. Stirling, J. (subsequently affirmed by the Court of Appeal) in giving judgment, said, "The rules which have been framed by the Board of Trade under the power conferred upon them by sect. 101 of the statute contain provisions which the statute itself does not contain, in reference to an application for a grant for an invention which has been communicated from abroad. Rule 27 provides that the application for such a grant shall be in the form 'A' in the 2nd schedule, and that form is different from that which is prescribed by the statute and from the terms in which Lindsay made the application" (his Lordship read the form, and continued:) "That form has been framed so as to fit in with sect. 5, sub-sect. 2, of the statute, which enacts that an application must contain a declaration . . . . that the applicant is in possession of an invention, whereof, he . . . . claims to be the true and first inventor. That form has not been followed in this case. There is no decision that a patent taken out as for an original invention, when in fact the invention patented was communicated from abroad, is void, though there is in the case of *Milligan* v. *Marsh* (*supra*) what appears to be a dictum of Vice-Chancellor Sir W. Page-Wood, to that effect, nor is there any decision that where an invention is partly original and partly communicated from abroad, the part communicated from abroad ought to be distinguished in the specification; but in the case of *Renard* v. *Levenstein* (*f*), the Lord Justice Knight Bruce expressed great doubt upon the point." . . . . And at p. 318: "That being so notwithstanding that the invention was founded on a communication received from abroad it appears to me that it well might be held that the statutory declaration made by the applicant was true in point of law."

Lindley, L.J., in the case of *Moser* v. *Marsden* (*g*), in his judgment in the Court of Appeal, said: "Then it was suggested that, as the English patentee had himself improved *Grosselin's* inven-

(*e*) *In re Avery's Patent*, L. R., 36 Ch. D. 316.

(*f*) 10 L. T., N. S. 177.

(*g*) 10 P. O. R. 359.

tion, the specification ought to have shown this on its face; and that, as the whole invention was not communicated to the plaintiff by Grosselin, as stated by the plaintiff, the patent is bad. This point has been raised before, but as yet it has not found favour in any Court. Nor ought it; there is no substance in it. The patentee is the true and first inventor within the meaning of the patent laws, whether he invents himself or whether he simply imports a foreign invention. I cannot see how he is anything but a true and first inventor if he does both; that is, if he both imports a foreign invention and improves it himself."

A patent granted to a British subject, in his own name for an invention communicated to him by a foreigner, the subject of a state in amity with this country, is not void, although such patent be in truth taken out and held by the grantee in trust for such foreigner (*h*).

The person who takes out the patent need **not** be a **meritorious importer**, he may be merely the clerk or agent to whom the communication was made for any special purpose by the foreign inventor, as for the purpose of enabling him to take out the patent for the benefit of such foreigner (*i*).

The importer of a new manufacture or invention will be considered the true and first inventor, even though he is not the assignee of the foreign inventor, and he may be the foreigner himself, if the Crown chooses to grant him a patent (*k*).

Sect. 23 of the Act of 1883 provides for the **registration** of owners of patents. Sect. 85 prohibits the registration of any trust. This does not abolish trusts, but merely prohibits the registration of trusts.

The importer of an invention need not have acquired the information from a foreigner resident abroad, but may have done so from a British subject abroad (*l*).

But a communication made in England by one British subject to another, of an invention, does not make the person to whom the communication is made the first and true inventor within the

(*h*) *Beard* v. *Egerton*, 3 C. B. 129; 15 L. J., C. P. 274; 10 Jur. 613.

(*i*) Ib. 15 L. J., C. P. 274.

(*k*) See remarks of Pollock, C.B. in *Chappell* v. *Purday*, 14 M. & W. 318; see also *Beard* v. *Egerton*, 3 C. B. 130.

(*l*) *Nickels* v. *Ross*, 8 C. B. at p. 710, per Wilde, C.J.

meaning of 21 Jac. I. c. 3, so as to enable him to take out letters patent for the invention (*m*).

It was decided in *In re Wirth's Patent* (*n*) that a patent could be granted to a foreigner resident abroad for an invention communicated to him by another foreigner also resident abroad. This, however, will no longer be the case, a direction having been made that only persons resident in the United Kingdom may apply for a grant of letters patent in Form A 1, this regulation being expressly intended to prohibit agents living abroad from making the declaration in Form A. 1 (*o*).

"The merit of an importer is less than of an inventor . . . . and it is an argument against the patent, that it was imported and not invented. I do not say it takes away the merit, but it makes it much smaller." Per Lord Brougham in *In re Soames' Patent* (*p*).

It is provided by 46 & 47 Vict. c. 57, s. 103, as amended by 48 & 49 Vict. c. 63, s. 6, that any person who has applied for protection for any patent in any foreign state with whom we have entered into international arrangements for mutual protection of inventions, shall be entitled to a patent for his invention in this country in priority to other applicants, and such patent, on registration, shall have the same date as the date of the protection obtained in such foreign state, provided that his application is made within seven months from his applying for protection in the foreign state with which the arrangement is in force.

In an application for a patent in respect of an invention communicated from abroad, the circumstances under which the invention was obtained by the importer will not be inquired into (*q*), and the object of sect. 103 is to preserve to the foreign inventor a priority for a certain period over persons who might otherwise have anticipated him by filing an application for a patent for his invention without authority to do so.

The rights under this section are purely personal to the

(*m*) *Marsden v. Saville Street Co.*, C. A., L. R., 3 Ex. D. 203.

(*n*) L. R., 12 Ch. D. 393; 28 W. R. 329.

(*o*) P. O. J., 9th May, 1884.

(*p*) 1 Web. P. C. 733.

(*q*) *Edmund's Patent*, Griff. P. C. 283; *Re Lake*, 5 P. O. R. 415; *Re Bairstow's Patent*, 5 P. O. R. 283.

applicant in the foreign country himself, and cannot be enjoyed by the agent of such applicant or by any person to whom he has communicated his invention (*r*).

Where the foreign inventor had made two applications in his own country, the first of which applications was abortive, and further, the foreign patentee made a declaration that the proceedings under the second application were in all respects the same as if no prior application had been made, it was held by the L.O. that the seven months mentioned in sect. 103 should run from the date of protection obtained upon the second application, and he directed that the English patent should be sealed as of that date (*s*).

Where a foreign inventor was resident in a country with which international arrangements for the mutual protection of inventions was made after an application had already been lodged in this country by another for letters patent in respect of a similar invention, it was held by the L.O. that such foreign inventor was entitled to apply in priority over other applicants for so much of the seven months as remained after the Order in Council declaring such foreign country to be "one of the contracting states" (*t*).

We have now shown what is meant when it is said that the consideration must move from the patentee personally.

(*r*) *Re Shallenberger*, 6 P. O. R. 550; *Re Carez*, 6 P. O. R. 552

(*s*) *Re Van de Poele*, 7 P. O. R. 69.

(*t*) *In re Main's Patent*, 7 P. O. R. 13.

CHAPTER IV.

A NEW AND USEFUL INVENTION.—SUBJECT MATTER.

Sect. 6 of the Statute of Monopolies defines a new **invention** as "any manner of new manufacture which others at the time of making such letters patent shall not use."

We have seen that the Act of 1883 has adopted this definition of an invention. We have now to consider the legal meaning which has been placed upon the words "New Manufactures."

A new manufacture does not mean, as it is erroneously sometimes supposed, only a new article of manufacture, but it also means a new process or method of manufacturing something new or old; it does not mean a new **principle** of manufacturing, but it means a new application of principles. No man can claim an invention in a principle (*a*), for that would be to invent the laws of nature, which have always existed.

Man merely discovers the principle, and if, when he discovers a principle he can discover a method of utilizing the principle so as to make it applicable to the production of a new manufacture, he can obtain a patent for the method, and to a large extent will be protected in the application of the principle itself.

Mr. Justice Wills in *Easterbrook* v. *The Great Western Railway Co.* said (*b*): "Although there cannot be a patent for an idea or principle apart from its physical embodiment in adequate apparatus, yet, that if the specification discloses the idea, shows a method by which it can be carried out and does not limit the claim of the patentee, any apparatus which by different mechanical means carries out the same idea is an infringement of the patent

(*a*) *Boulton* v. *Bull*, 2 H. Bl. 479; Dav. P. C. 196, 212; *Hornblower* v. *Boulton*, 8 T. R. 101; *Jupe* v. *Pratt*, 1 Web. P. C. 146; *Neilson* v. *Harford*, 1 Web. P. C. 342; 8 M. & W. 806; *The Houschill Co.* v. *Neilson*, 1 Web. P. C. 673; *Crossley* v. *Potter*, Macr. P. C. 240; *Patterson* v. *The Gas Light Co.*, L. R., 3 App. Cas. 246.

(*b*) 2 P. C. R. 207.

though the method and even the purpose to which the principle or idea is applied be different from those embodied in the specification."

Lord Justice Clark Hope in directing the jury in the case of *The Household Co.* v. *Neilson* (c), said:—"I state to you the law to be that you may obtain a patent for a mode of carrying a principle into effect; and if you suggest and discover, not only the principle, but suggest and invent how it may be applied to a practical result by mechanical contrivance and apparatus, and show that you are aware that no particular sort or modification, or form of the apparatus, is essential in order to obtain benefit from the principle; then you may take out your patent for the mode of carrying it into effect, and are not under the necessity of describing and confining yourself to one form of apparatus . . . . You may generally claim the mode of carrying the principle into effect by mechanical contrivance, so that any sort of apparatus applied in the way stated will more or less produce the benefit, and you are not tied down to any form."

In the Court of Appeal, Lord Justice Cotton, speaking on this subject, 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—a mechanical equivalent for a substantial part of the patentee's invention being looked upon as a mere colourable difference" (*d*).

In *Otto* v. *Linford* (*e*), claim 1 of the plaintiff's specification ran as follows:—"Admitting to the cylinder a mixture of combustible gas or vapour with air, separate from a charge of air or incombustible gas, so that the development of heat and the expansion or increase of pressure produced by the combustion *are*

(c) 1 Web. P. C. 685.

(d) *The Automatic Weighing Machine Co.* v. *Knight*, 6 P. O. R. 304; see also *Badische Anilin und Soda Fabrik* v. *Levinstein*, 2 P. O. R. 91, 92, 93; L. R., 24 Ch. D. 156, 171, et seq.; *Proctor* v. *Bennis*, L. R., 36 Ch. D. 740; 4 P. O. R. 333; *Thomson* v. *Moore*, 6 P. O. R. 426; *Gadd & Mason* v. *The Mayor, &c., of Manchester*, 9 P. O. R. 525.

(e) 46 L. T., N. S. 35.

rendered gradual substantially as and for the purposes set forth."

Jessel, M.R., in the Court of Appeal, said (*f*):—"It is said that what is claimed is a principle . . . . or, as it is sometimes termed, the 'idea' of putting a cushion of air between the explosive mixture and the piston of the gas motor engine, so as to regulate, detain, or make gradual, what would otherwise be a sudden explosion. Of course, that could not be patented. I do not read the patent so; I read the patent as being to the effect that the patentee tells us that there is the idea which he wishes to carry out; but he also describes other kinds of machines which will carry it out; and he claims to carry it out substantially by one or other of these machines. That is the subject of a patent . . . . One of the strongest illustrations that I know of is the patent for the hot blast in the iron manufacture (*g*), where there was nothing new at all except the idea that the application of hot air instead of cold air to the mixture of iron ore and fuel, would produce most remarkable results in the shape of economy in the manufacture of iron. The inventor or discoverer could not patent that, but what he did was this, he said: 'I will patent that idea in combination with the mode of carrying it out, that is, I tell you that 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."

So in *The Edison Bell Phonograph Co.* v. *Smith* (*h*), where the plaintiffs claimed in their specification:—"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 pleaded by the defendants that this was a claim for the principle of attaching both the points to the same diaphragm; Wright, J., held that it was not so, deciding it to be "a claim for a particular arrangement of essential parts of a machine, which arrangement has obvious advantages, but has never before been made practicable, and which has now been found practicable in a way disclosed by the specifica-

(*f*) At page 39.
(*g*) 1 Web. P. C. 295; 8 M. & W. 806; 11 L. J., Ex. 20.
(*h*) 11 P. O. R. 148.

tion. Such a claim ought probably to be construed as a claim of monopoly for that arrangement carried out by any means substantially similar to those disclosed in the specification" (*i*).

A claim of every method of application of a principle is a claim of the principle itself, and is not subject-matter of a grant of letters patent (*k*).

The **novel application** of an **old principle** is subject-matter of a grant, if invention is disclosed, and provided that such novel application constitutes a new and useful improvement in manufacture (*l*), but the patentee is strictly tied down to the **method of application** disclosed in his specification, and valid patents may be taken out by others for different methods of carrying the same principle into effect (*m*).

In *Barber* v. *Grace* (*n*), the patentee's invention related to improvements in the finishing of hosiery and similar goods, and consisted in submitting them to the pressure of hot boxes or surfaces heated by steam, water, or other fluid. At the trial it appeared that the alleged infringement consisted in pressing goods between cylindrical revolving rollers heated by steam, it was held by Pollock, C.B., that the use of such rollers was not a mere colourable evasion of the patent, and that the defendants had not infringed.

In *Boulton* v. *Bull* (*o*), the Lord Chief Justice Eyre said: "When the effect produced is some new substance or composition of things, it should seem that the privilege of sole working or making ought to be for such new substance or composition, without regard to the mechanism or process by which it has been

(*i*) At page 163; see also *Boulton* v. *Bull*, Dav. P. C. 162; *Hornblower* v. *Boulton*, 8 T. R. 95; *Electric Telegraph Co.* v. *Brett & Little*, 10 C. B. 838; 20 L. J., C. P. 123; *Minter* v. *Wells*, 1 Web. P. C. 127; *Cannington* v. *Nuttall*, L. R., 5 H. L. 205.

(*k*) *Neilson* v. *Harford*, 1 Web. P. C. 355; *Booth* v. *Kennard*, 2 H. & N. 95; 26 L. J., Exch. 335; *Automatic Weighing Machine Co.* v. *Knight*, 6 P. O. R. 297, 308.

(*l*) *Dangerfield* v. *Jones*, 13 L. T., N. S. 142; *Cannington* v. *Nuttall*, L. R., 5 H. L. 205; 40 L. J., Ch. 739.

(*m*) *Automatic Weighing Machine Co.* v. *Knight*, 6 P. O. R. 113; *Seed* v. *Higgins*, 8 H. L. Ca. 550; *Curtis* v. *Platt*, L. R., 3 Ch. D. 135 (n.); *Needham* v. *Johnson*, 1 P. O. R. 49; *Bovill* v. *Pim*, 11 Ex. R. 718, 739; *Fletcher* v. *The Glasgow Gas Commissioners*, 4 P. O. . 388.

(*n*) 1 Ex. R. 339; 17 L. J., Ex. 122.

(*o*) 2 Bl. 463; Dav. P. C. 162.

produced, which, though perhaps also new, will be only useful as producing the new substance. 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." Mr. Justice Heath said, "What then falls within the scope of the proviso? such manufactures as are reducible to two classes: the first class includes machinery, the second, substances, such as medicines formed by chemical and other processes, where the vendible substance is the thing produced, and that which operates preserves no permanent form; in the first class the machine, and in the second the substance produced, is the subject for the patent. 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." With reference to this judgment, we may point out that a new chemical substance is not a new manufacture, as the words "new manufacture" are understood in modern times, but that in the case of manufacturing a new chemical substance, the process of making that substance is the subject of the patent, and not the substance when made.

Upon perusing the cases which we propose to quote, it will be seen that the more modern view of the construction of the words "new manufacture" has been the result of a great deal of development. At first the judges seemed to be inclined to limit the **subject-matter** of letters patent to new articles produced; but as the arts and manufactures of the country progressed and increased, it was seen that by far the most important inventions were inventions in the **process** of making old and well-known articles of commerce, and so it became evident that should the construction of the words "new manufactures" be entirely limited to the production of new articles, to the exclusion of the process of manufacturing old articles by cheaper, better and improved methods, the inducement which the common law intended to give to inventors would be curtailed to the narrowest possible limits.

Hall v. *Jarvis* (*p*) was an action for the infringement of a patent for the improvement of the manufacture of lace by the use of the flame of gas for the purpose of singeing the fluffy ends of the surface of lace manufactured from cotton. For the defendants it was contended that the process was not new. Fire and flame had been applied for similar purposes before the plaintiff's invention. The mere doing that with the flame of gas could not be the subject-matter of a patent. The patent, which was clearly only for a process, was supported. In *Jones* v. *Pearce* (*q*) the patentee had used the principle of suspension to the manufacture of wheels; the patent was supported because, although the principle could not be patented, the method of applying that principle to the manufacture of wheels was properly the subject of a patent. In *Russell* v. *Cowley* (*r*) the patent, which was for an improved process of manufacturing iron tubes, was supported. Lord Lyndhurst, in giving judgment, said: It is an invention to manufacture tubes for gas and other purposes by welding them without the use of any mandril or internal support, by which certain advantages are produced."

In *Walton* v. *Potter* (*s*) Chief Justice Tindal said: "Now there can be no doubt whatever that, although one man has obtained a patent for a given object, there are many modes open for a man of ingenuity to obtain a patent for the same object; there may be many roads leading to one place, and if a man has, by dint of his own genius and discovery, after a patent has been obtained been able to give to the public without reference to the former one, or borrowing from the former one, a new and superior mode of arriving at the same end, there can be no objection to his taking out a patent for that purpose." In this case the learned judge by the word "object" must have meant the method of producing an article.

The same judge, in *Gibson* v. *Brand* (*t*), said: "The patent is taken out 'for a new or improved process for the manufacture of

(*p*) 1 Web. P. C. 100; see also *Booth* v. *Kennard*, 1 Hurl. & N. 527; *Higgs* v. *Godwin*, 27 L. J., Q. B. 421; *Hills* v. *London Gas Light Co.*, 29 L. J., Ex. 409; *Young* v. *Fernie*, 12 W. R. 903; *Newall* v. *Elliot*, 13 W. R. 11.

(*q*) 1 Web. P. C. 122.

(*r*) 1 Web. P. C. 459.

(*s*) 1 Web. P. C. at p. 590.

(*t*) 1 Web. P. C. 633.

silk, and silk in combination with certain other fibrous substances,' taken out therefore strictly for a process . . . . . undoubtedly there is a very strong reason to suppose if the specification is carefully and properly prepared, so as to point out with great distinctness and minuteness what the process is, that such a patent may be good in law. Such certainly was the opinion of Chief Justice Eyre, in *Boulton* v. *Wall* (*u*), and such also appears to have been the opinion (carefully guarding against any abuse of that doctrine) of Lord Tenterden in the case of *The King* v. *Wheeler* (*x*), who said that 'the subject-matter of letters patent, *i.e.*, the word "manufacture," as used in the Statute of James, is generally understood to denote either a thing made, which is useful for its own sake, and vendible, 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 . . . . or it may perhaps extend also to a new process to be carried out 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 to a better or more useful account.'"

Since the date of these earlier decisions the law seems to have been considered as settled upon the subject. In *Beeley* v. *Hancock* (*y*) Lord Cranworth said: "A discovery that the mixture of two or more simple substances in certain definite proportions will form a compound substance valuable for medical or other qualities, would be a good ground for a patent. A discovery of some machine by which by such a mixture might be more quickly and effectually accomplished, might be the foundation of another patent." In *Simpson* v. *Holiday* (*z*) the specification said, "I mix aniline with dry arsenic acid and allow the mixture to stand for some time, or I accelerate the operation by heating it to, or nearly to, its boiling point until it assumes a rich purple colour." The patentee claimed "the manufacture or preparation of red or purple dyes by heating aniline dyes with arsenic acid as hereinbefore described." Lord Chelmsford, in

(*u*) 2 H. Bl. 468; Dav. P. C. 207.
(*x*) 2 B. & Ald. 349.
(*y*) 6 De G., M. & G. 402.
(*z*) L. R., 1 H. L. 315.

giving judgment, said: "There is nothing on the face of the specification to show that the invention described is not, in every part of it, the subject of a patent." It is obvious that there may be many different processes of accomplishing the same object: if some of the processes are old, and that which is claimed is merely a new method, the subject of the invention will be confined to that method (*a*).

Where the **object** of a patent is old, and the means to effect it only are new, the court will construe the invention strictly, as it looks jealously at the claims of inventors seeking to limit the rights of the public to a well-known object (*b*).

But where a patent is for a **new process** to effect a **new object** which had been sought after but not previously attained, the doctrine of mechanical equivalents will apply, and a man will be held to have infringed who has arrived at the same result by means of a process bearing a substantial resemblance to the invention of the patentee (*c*).

There appears to be some doubt as to whether a patent could be granted for a mere **product**, irrespective of the means by which it was made. Cotton, L.J., has expressed an opinion that a product would be proper subject-matter. In his judgment in the case of *Vorwerk & Son* v. *Evans & Co.* (*d*) he 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 it was now, 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

(*a*) *Bovill* v. *Pimm*, 11 Exch. 739.

(*b*) *Curtis* v. *Platt*, L. R., 3 Ch. D. 135 (n.); *The Patent Bottle Envelope Co.* v. *Scymer*, 5 C. B. N. S. 164; *Horton* v. *Mabon*, 12 C. B. N. S. 437; *Ormson* v. *Clarke*, 14 C. B. N. S. 475; *Jupe* v. *Pratt*, 1 W. P. C. 146; *Barber* v. *Grace*, 1 Exch. 339; 17 L. J., Ex. 122; *Bovill* v. *Pimm*, 11 Exch. R. 718, 739; *Seed* v. *Higgins*, 8 H. L. C. 550; *Rushton* v. *Crawley*, L. R., 10 Eq. 522; *The Badische Anilin und Soda Fabrik* v. *Levinstein*, 2 P. O. R. 91; *Proctor* v. *Bennis*, 4 P. O. R. 333; L. R., 36 Ch. D. 740; 57 L. J., Ch. 11; *Gosnell* v. *Bishop*, 5 P. O. R. 158; *Nettlefolds* v. *Reynolds*, 9 P. O. R. 270.

(*c*) *Jupe* v. *Pratt*, 1 W. P. C. 145; *Houschill Co.* v. *Neilson*, 1 W. P. C. 673, 685; *Curtis* v. *Platt*, L. R., 3 Ch. D. 136, n.; L. R., 1 H. L. 337; *The Badische Anilin und Soda Fabrik* v. *Levinstein*, 2 P. O. R. 91; *Proctor* v. *Bennis*, 4 P. O. R. 333; L. R., 36 Ch. D. 740; 57 L. J., Ch. 11; *Thomson* v. *Moore*, 6 P. O. R. 426. This subject is treated at length in Chap. XVII. on Infringement.

(*d*) 7 P. O. R. 271.

be protected by a patent, and I think it would be contrary to principle, because if there is a new thing produced, then, in my opinion, there could be a thoroughly good patent taken out for that" (*e*).

Hereafter, in considering the specification, we shall have to discuss the limitations within which a patent for a new process will be held valid, and the cases which have been decided upon the point.

Any addition to or subtraction from any known machine or process causing the old machine or process to accomplish an object in a more speedy, perfect or economical manner, is evidently the subject of a patent. In *Hornblower* v. *Boulton* (*f*) Mr. Justice Grose said: "A doubt is entertained whether there can be a patent for the addition of an old manufacture, this doubt rests altogether upon *Bircot's case* (*g*), if that were to be considered as law at this date (1799) it would set aside many patents for many ingenious inventions . . . . . if, indeed, a patent could not be granted for the addition it would be depriving the public of one of the best benefits of the Statute of James." In *Lister* v. *Leather* (*h*) Lord Campbell said: "The assertion that all patents for improvements of existing patents must be void, is obviously untenable" (*i*). In *Fox* v. *Dellestable* (*k*) Malins, V.-C., said: "No doubt a man may make an invention which is partly covered by an existing patent, but he cannot use it without the licence of the patentee. He may wait for the expiration of the patent and take out one himself. If his invention be novel, that patent will be valid" (*l*).

During the argument in *Vickers* v. *Siddell*, Lord Herschell suggested that if a man used a mechanical equivalent, and

(*e*) See also Bowen, L. J., ib. p. 274; also *American Braided Wire Co.* v. *Thomson*, 5 P. O. R. 113; 6 P. O. R. 518; *Nobel's Explosive Co.* v. *Anderson*, 11 P. O. R. 530.

(*f*) 8 T. Rep. 104.

(*g*) 3 Inst. 184.

(*h*) 8 E. & B. at p. 1017.

(*i*) See also *Russell* v. *Cowley*, 1 Cr. M. & R. 864; *Booth* v. *Kennard*, 1 H. & N. 531; *Morris* v. *Branson*, 1 Web. P. C. 51; 1 Carp. P. C. 30; Bull. N. R. 76; *Bovill* v. *Moore*, 2 Coop. Ch. Ca. 56; Dav. P. C. 361; 2 Marsh. R. 211; *Moser* v. *Marsden*, 10 P. O. R. 361.

(*k*) 15 W. R. at p. 195.

(*l*) See also *Lister* v. *Leather*, 8 E. & B. 1017; *In re Fox's Patent*, 1 Web. P. C. 431, n.

produced a superior result, such improvement would be patentable (*m*).

An application of an old machine or an **old material for a new purpose**, may be the subject of a patent; for instance, *Muntz* v. *Foster* (*n*) was an action for an infringement of a patent for the manufacture of metal plates to be used for sheathing the bottoms of ships. The improvement consisted of using an alloy of zinc and copper in certain proportions for the manufacture of the plates, and for this purpose copper alone had hitherto been used. The alloy of zinc and copper was to produce an old and well-known material, still the application of that old material to sheathing of ships had not before been discovered, and upon its being shown that such an application was a great improvement on the old method of sheathing with copper, it was held that the patent could be sustained.

The application of a **known instrument or machine to a new purpose** will not support a patent unless the means or method of application is also new and discloses the exercise of a certain amount of ingenuity. Exactly what degree of invention is requisite is difficult to define, and it is impossible to formulate a rule capable of applying to every case that might arise, the question being one that must be decided upon the facts of each particular case.

Lord Esher, M.R., in *Lyon* v. *Goddard* said (*o*):— "I know that a case before the House of Lords has been cited, *Morgan* v. *Windover* (*p*), which, it is said, lays down a rule that would oblige us in this case to say that there is no invention. I have a very strong feeling myself that that case in the House of Lords was decided from this view of it: that the patentee there did not claim the combination of the springs at the back of the carriage and the springs at the front, but what he did claim was the mode of attaching each of those springs to the bed of the carriage, and although I am not obliged to say that I should have agreed with them as to the fact they found, they found that that was not

(*m*) 7 P. O. R. 303.

(*n*) 2 Web. P. C. 103; see also *Hayward* v. *Hamilton*, Griff. P. C. 115; *Lister* v. *Norton*, 3 P. O. R. 199; *Penn* v. *Bibby*, L. R., 2 Ch. App. 127; 36 L. J., Ch. 455.

(*o*) 10 P. O. R. 344; see also *Lister* v. *Norton*, 3 P. O. R. 205; *Morgan* v. *Windover*, 4 P. O. R. 426.

(*p*) 7 P. O. R. 131.

sufficient invention. They thought so, and therefore I suppose in that case, as there is no contradicting them, we may take it that they were right; but because there was no invention in that case, how can that be an authority for saying that there is no invention in this?"

In *Morgan* v. *Windover* Lord Halsbury, in the House of Lords, said (*q*): "Whether that invention is to be ascertained by considering something originally discovered or by considering a combination producing a new result, still it cannot but be certain that the Statute of Monopolies, and the whole branch of the law founded on that statute, make 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-matter of a patent."

In that case the patent consisted in the application of C springs, which previously had only been employed on the back of a carriage, to the fore part, and arranged so as not to interfere with the fore wheels and their motion in turning the carriage. This contrivance was new, and was admitted to give greater ease and comfort in the motion of the carriage to which it was attached. The patent was upheld in the lower courts, but these decisions were reversed by the House of Lords, where it was held *nem. con.* that there was not sufficient ingenuity disclosed to support a grant of letters patent. Lord Herschell in his judgment said (*r*): "Now, my Lords, if it had required mechanical ingenuity and skill to adapt the composite springs which had heretofore been used in the hind part of a carriage to the fore part of a carriage, so that it was not the mere substitution in front in substantially the same way as the substitution had taken place at the back, but that it needed some skill and ingenuity to adapt to the front part of the carriage that which had been applied to the back, I should have thought that there was sufficient subject-matter, and that the patent could have stood. But when once it is admitted that all that can be claimed as new is the idea of putting it in the front instead of at the back, *and that when once that idea was entertained, any workman told to do it would, without*

(*q*) Ib. at p. 144.

(*r*) Ib. at p. 157.

any instructions or any special mechanical skill, be able at once to do it, it seems to me that that really concludes the case against the respondents."

In *Penn* v. *Bibby* (*s*) Lord Chelmsford, L.C., recognised the difficulty of stating any definition which should be applicable to every case. He said: "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 to each other." He then proceeds to dissent from the definition given by Lord Campbell in *Brook* v. *Aston*, doubting the accuracy of the report, and proceeds to say: "Lord Chief Justice Cockburn approaches much nearer to the enunciation of a principle, or at least of a rule for judging in these cases, in *Harwood* v. *G. N. R.* (*t*), where he says, 'although authorities established the proposition that the same means, apparatus, or mechanical contrivance cannot be applied to the same purpose, or to purposes so nearly cognate and similar as that the application of it in one case naturally leads to the application of it when required in some other, still the question in every case is one of degree, 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 so sufficiently meritorious as to be deserving of a patent.'" The case of *Harwood* v. *G. N. R.*, quoted above by the Lord Chancellor, was carried to the House of Lords, where Lord Chelmsford, then Lord Chancellor, said: "The question is, whether there can be any invention of the plaintiff in having taken that thing, which was a fish for the bridge, and having applied it as a fish for the railway. Upon that I think the law is well and rightly settled . . . . . viz., that you cannot have a patent for a well-known mechanical appliance, merely because it is applied in a manner or to a purpose which is analogous to the manner or purpose in or by which it has hitherto been notoriously used" (*u*).

(*s*) L. R., 2 Ch. App. 127.

(*t*) 29 L. J., Q. B. 193.

(*u*) 11 H. L. Cas. 654; see also *Horton* v. *Mabon*, 12 C. B., N. S. 437; 16 C. B., N. S. 141; 31 L. J., C. P. 255; *White* v. *Toms*, 37 L. J., Ch. 204; *Ralston* v. *Smith*, 11 H. L. Cas. 223; *Jordan* v. *Moore*, L. R., 1 C. P. 624; *Parkes* v. *Stevens*, L. R. 8 Eq. 367; L. R., 5 Ch. 36; *Losh* v. *Hague*, 1 Web. P. C. 200; *Ormson* v. *Clark*, 32 L. J., C. P. 8; *Brunton* v. *Hawkes*, 4 B. & Ald. 541;

In *Reg.* v. *Cutler* (*x*) Lord Denman said: "With regard to the third and fourth claims, in which the defendant claims the application of tubes in the construction of tubular flues, it appears to me that he has no right to take out a patent for the mere application of particular things to any particular purpose. If he had made a new combination, that would have been a new discovery, and a proper subject for a patent. . . . I think that the application of an article to produce any particular result, the party having no claim either to the mode of producing the article, or to the mode of applying it for attaining that result, forms no ground for a patent." Lord Denman's distinction between the mere application of an old instrument to a new purpose and a new combination, appears to have been followed, and to be a correct exposition of the law.

In *Jackson* v. *Needle* (*y*) North, J., said: "The plaintiff's first witness seemed to have an idea that because the parcels post was new, therefore a thing to be sent through the parcels post was new: there is no foundation for that."

In *Bush* v. *Fox* (*z*) Chief Baron Pollock graphically illustrated the point we are now discussing. He said: "I think if one man invents a new mode of looking at the moon, somebody else cannot take out a new patent for looking at the sun. If a man were to take out a patent for a telescope to be used to make observations on land, I do not think anyone could say, 'I will take out another patent for another telescope to be used for taking observations on the sea.'" That case was ultimately confirmed in the House of Lords (*a*). In *Brook* v. *Aston* Baron Martin said (*b*): "The application of a well-known tool to work pre-

Saxby v. *Gloucester Waggon Co.*, L. R., 7 Q. B. D. 305; *Britain* v. *Hirsch*, 5 P. O. R. 226; *Blakey* v. *Latham*, 6 P. O. R. 184; *Deutsche Nähmaschinen Fabrik vorm., Wertheim* v. *Pfaff*, 7 P. O. R. 251, 258; *Williams* v. *Nye*, 7 P. O. R. 62; *Elias* v. *Grovesend Tinplate Co.*, 7 P. O. R. 455; *Leadbeater* v. *Kitchin*, 7 P. O. R. 235; *The Embossed Metal Plate Co.* v. *Saupe*, 8 P. O. R. 355; *Lane Fox* v. *Kensington & Knightsbridge Lighting Co.*, L. R., 1892, 3 Ch. 424; 9 P. O. R. 413; *Sudbury* v. *Lee*, 11 P. O. R. 58; *Rose's Patents Co.* v. *F. Braby & Co.*, 11 P. O. R. 198.

(*x*) 3 C. & K. 215; see also *Tatham* v. *Dania*, Griff. P. C. 213.

(*y*) Griff. P. C. at p. 134.

(*z*) Macr. P. C. 164.

(*a*) 5 H. L. C. 707.

(*b*) 28 L. J., Q. B. 176.

viously untried materials, or to produce new forms, is not a subject of a patent."

The border line between a sufficient and an insufficient amount of **ingenuity** to support a patent for a new use of an old machine is exceedingly fine. The above cited cases give instances where the Courts have held that no invention was disclosed; we now propose to quote a few examples of patents which have been supported as exhibiting an adequate amount of invention.

In *Gadd* v. *The Mayor, &c., of Manchester* (*c*), the object of the plaintiff's patent was to keep gasometers vertical without having recourse to the external guiding frames generally used; this object was not in itself new, but had never been attained by any method resembling that employed by the patentees. The principle employed by them was one which had previously been described in specifications of inventions for keeping floating docks and pontoons in a horizontal position. It was held by the Court of Appeal, reversing the decision of the Court below, that in the application of that principle to gasometers there were practical difficulties to be overcome which required a considerable degree of ingenuity, and was good subject-matter for a patent.

In *Lane Fox* v. *Kensington and Knightsbridge Electric Lighting Co.* (*d*), Lindley, L.J., said: "On the one hand, the discovery that a known thing—such, for example, as a Planté battery—can be employed for a useful purpose for which it has never been used before is not alone a patentable invention; but, on the other hand, the discovery how to use such a thing for such a purpose will be a patentable invention if there is novelty in the mode of using it, as distinguished from novelty of purpose, or if any new modification of the thing, or any new appliance is necessary for using it for its new purpose, and if such mode of user, or modification, or appliance involves any appreciable merit. It is often extremely difficult to draw the line between patentable inventions and non-patentable discoveries, but I have endeavoured to state the distinction as I understand it, and so far as is necessary for the purposes of the present case."

In *Lyon* v. *Goddard* (*e*), Bowen, L.J., said: "When you see

(*c*) 9 P. O. R. 516.
(*d*) L. R., 1892, 3 Ch. 424, 429; 9 P. O. R. 413, 416
(*e*) 10 P. O. R. 334, 346.

that the point of this invention is that it enables a process which has been discovered since, to be carried out in a machine which alone is adapted for that purpose and process, and when you observe the marked and beneficial effect, and the commercial and the scientific success of the new machine, you can only answer the question whether there has been ingenuity in one way. I think, not only that there has been ingenuity, but I think myself that there has been very great ingenuity in it, and none the less because it is easy afterwards, as has been pointed out, to say other people might have seen the result."

In the case of *Steiner* v. *Heald* (*f*), in the Exchequer Chamber, the head-note is inexplicable and erroneous. If the case itself is read, it will be found to be in accordance with the other decided cases on this subject: In the ordinary process of dyeing, by means of madder, the colouring matter was obtained from fresh madder by the application of hot water; the refuse, after boiling, was called spent madder. It had long been known to dyers, that a portion of the colouring remained in the spent madder, but it was not known how to extract it, as it remained in combination with the plant; recently it was discovered that by means of acid and hot-water the pure colouring matter of madder, called garancine, could be obtained from fresh madder, and that this process extracted the colouring matter of the plant. The plaintiff obtained a patent for the new manufacture of garancine, by applying the same process of acid and hot water to the spent madder; since his invention the spent madder, which was previously worthless, became valuable.

At the trial Chief Baron Pollock directed the jury to find a verdict for the defendant, upon the ground apparently that there was no subject for a patent; in reversing this decision Mr. Justice Pearson said: "Now spent madder might be a very different thing from fresh madder in its properties, or it might be in effect the same thing as fresh madder in its properties, chemical and otherwise, with the difference only that part of its colouring matter had been already extracted. Again, the properties, chemical and otherwise, might or might not have been known to chemists and other scientific persons, so that they could

(*f*) 20 L. J. Exch. 410.

find out whether fresh madder and spent madder were different or substantially the same things. The points appear to us to be questions of fact, and materially to affect the validity or invalidity of a patent." It will appear, therefore, that the Court were of opinion that it was a question of fact whether spent madder and fresh madder were the same thing in their chemical properties; if they were, no patent; if they were not, the validity of the patent would be sustained, but the fact must be decided by the jury.

In *Bamlett* v. *Picksley* (*g*), Blackburn, J., said: "There may be cases in which a thing is used which would be identically the old one to produce a new product altogether, but applied to something so totally different that there is an obvious invention in it. Take this example. It was discovered that by taking flour and making it into tough dough by means of machinery you could spin it into a pipe known as macaroni pipe. An ingenious man knowing how to spin flour into a pipe, it occurred to him to take red-hot iron, and spin that into pipes by machinery in the same way as flour was spun into a pipe for macaroni. That was not an invention as it turned out, but had that been so, and had he been able to spin the iron in the same way as flour was spun into pipes for macaroni, few men I think would deny that there was an invention there, it being a product so completely new, and that it would be an invention for making a new manufacture which others did not make, because the result was so totally different, even although in fact the machinery which was used for the purpose, except that it was made stronger, would be identically the same as the machinery originally used for the purpose of making the macaroni."

Lindley, L.J., in *Gadd* v. *The Mayor, &c., of Manchester*, after an elaborate review of the authorities, expressed the law

(*g*) Griff. P. C. at p. 42; see also *Hayward* v. *Hamilton*, Griff. P. C. 115; *Dangerfield* v. *Jones*, 13 L. T., N. S. 142; *Hall* v. *London Gas Co.*, 5 H. & N. 312; 29 L. J., Ex. 409; *Penn* v. *Bibby*, L. R., 2 Ch. 127, 136; *Ehrlich* v. *Ihlee*, 5 P. O. R. 137; *Thomson* v. *The American Braided Wire Co.*, 5 P. O. R. 113; 6 P. O. R. 518; L. R. 44 Ch. D. 274; *Moser* v. *Marsden*, 10 P. O. R. 350; *Legge* v. *Wakelam*, 10 P. O. R. 379; *Pirrie* v. *York Street Spinning Co.*, 10 P. O. R. 34; 11 P. O. R. 429.

upon this subject by the two following propositions: "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 and ingenious application of a known contrivance to an old thing, is a manner of new manufacture within the meaning of the Statute (*h*)."

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

And, in *Hinks* v. *Safety Lighting Co.* (*k*), Jessel, M.R., said: "Where a **slight alteration** in a combination turns that which was practically useless before into that which is very useful and very 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, as far as a rough test goes, I know of no better."

In the case of *Longbottom* v. *Shaw* (*l*), Lord Herschell said: "Great reliance is placed upon the fact that when this patent was taken out and frames were made in accordance with it, there was

(*h*) 9 P. O. R. 524.

(*i*) 5 P. O. R. 158; see also *Moss* v. *Mellings*, 3 P. O. R. 378; *The American Braided Wire Co.* v. *Thomson*, 5 P. O. R. 125.

(*k*) L. R., 4 Ch. D. 615.

(*l*) 8 P. O. R. 336; see also *Blakey* v. *Latham*, 6 P. O. R. 187; *Gosnell* v. *Bishop*, 5 P. O. R. 153.

a large demand for them . . . . I do not dispute that that is a matter to be taken into consideration; but, again, it is obvious that it cannot be regarded in any sense as conclusive. I think that its value depends very much upon certain other circumstances. If nothing be shown beyond the fact that the new arrangement results in an improvement, and that this improvement causes a demand for an apparatus made in accordance with the patent, I think that it is of very little importance."

In *Dowling* v. *Billington* (*m*) the patent in question was one for a method as distinguished from a patent for a machine to carry out the method, or for the manufactured article. It was admitted that the "method" required no novel machinery, but consisted in the use, by the workman, of an existing machine in a way which was novel and the result useful, it was held that this was good subject-matter.

A new combination is an invention consisting of the discovery that two or more, new or old, processes, materials, or implements, when used together, will become applicable to a new purpose, or will effect an old purpose in a better, cheaper, or more expeditious manner than it had before been done.

In *Huddart* v. *Grimshaw* (*n*), 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 of a patent." There may be a valid patent for a new combination of materials previously in use for the same purpose (*o*).

In *Foxwell* v. *Bostock* (*p*), Lord Westbury said: "If a combination of machinery for effecting certain results has previously existed and is well known, and an improvement is afterwards discovered, consisting, for example, of the introduction of some new parts, or an altered arrangement in some particulars of the

(*m*) 7 P. O. R. 191.

(*n*) Dav. P. C. 267; 1 Web. P. C. 86; see also Tindal, C.J., in *Crane* v. *Price*, 1 Web. P. C. 408; 4 M. & G. 580; *Vickers* v. *Siddell*, 7 P. O. R. 292.

(*o*) *Hill* v. *Thompson*, per Lord Eldon, 1 Web. P. C. 237.

(*p*) 12 W. R. 725; see also *Harrison* v. *The Anderston Foundry Co.*, L. R. 1 App. Cas. 574; *Hayward* v. *Hamilton*, Griff. P. C. 115; *Moore* v. *Bennett*, Griff. P. C. 158; *Wenham Gas Co.* v. *Champion Gas Lamp Co.*, 8 P. O. R. 320; *Boyd* v. *Horrocks*, 9 P. O. R. 77.

existing constituent parts of the machine, an improved arrangement or improved combination may be patented."

Bovill's patent consisted of a combination of a blast with an exhaust of air to millstones, for the purpose of preventing the heat generated in grinding corn and saving the dust generated. It was proved that a blast and an exhaust had been used separately, but that the combination was a substantial improvement. The patent was held good (*q*).

In *Crane* v. *Price* (*r*), the patentee, in his specification, after specifically disclaiming the use of the hot blast or the use of anthracite coal, proceeded: "What I do claim as my invention is, the application of anthracite or stone coal or culm *combined* with the using of hot air blast in the smelting and manufacture of iron from ironstone, mine or ore as above described." The patent was held valid for the combination.

In his judgment in this case, Lord Chief Justice Tindal said: "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 a combination is an invention or manufacture intended by the statute to, and may well, become the subject of a patent" (*s*).

This exposition of the law has been approved of by the Court of Appeal in the cases *Murray* v. *Clayton* (*t*) and *Lyon* v. *Goddard* (*u*).

A combination may be patented which consists in the omission from an old process or machine of some part which had previously been considered to be essential (*x*), or in the substitution for some part of an old process or machine of a mechanical equivalent which was not known before to be a mechanical equiva-

(*q*) *Bovill* v. *Keyworth*, 7 E. & B. 725; 29 L. T. 194; *Brunton* v. *Hawkes*, 4 B. & Ald. 550; *Lewis* v. *Davis*, 1 Web. P. C. 488; 3 C. & P. 502; 1 Carp. P. C. 471; *Carpenter* v. *Smith*, 1 Web. P. C. 538; *Allen* v. *Rawson*, 1 C. B. 551; *Lister* v. *Leather*, 8 E. & B. 1004; 27 L. J., Q. B. 295; *Daugerfield* v. *Jones*, 13 L. T., N. S. 142.

(*r*) 1 Web. P. C. 377; 12 L. J., C. P. 81; 4 M. & G. 580.

(*s*) 1 Web. P. C. 408.

(*t*) L. R., 7 Ch. 584.

(*u*) 10 P. O. R. 334, 346.

(*x*) *Booth* v. *Kennard*, 1 H. & N. 527; 2 H. & N. 84; 26 L. J., Ex. 23, 305; *Russell* v. *Cowley*, 1 Web. P. C. 457; 1 Cr. M. & R. 864.

lent (*y*), provided that a substantial improvement is effected thereby; but a patent will not be upheld which consists merely in substitution of a well known mechanical equivalent for some part of an old process or machine (*z*).

In *Williams* v. *Nye* (*a*), Cotton, L.J., said: "In order to maintain a patent, there must be a substantial exercise of the inventive power or inventive faculty. Sometimes very slight alterations will produce very important results, and there may be in those very slight alterations very great ingenuity exercised and shown to be exercised by the patentee."

A combination of two well-known contrivances without ingenuity will not support a grant of letters patent.

A patent was granted in 1870 for railway signalling apparatus; in 1871 another patent was granted for other improvements in railway signalling apparatus; in 1874 the plaintiffs obtained a patent for a combination which, in effect, was constituted of the improvements in the 1870 and 1871 patents; any person with ordinary knowledge of the subject would, by placing the two inventions of 1870 and 1871 side by side, be able to effect the desired combination without making any further experiment or gaining any further information. Field, J., held the 1874 patent void (*b*).

The mere fact that the improvement was the result of

(*y*) *Heath* v. *Unwin*, 2 Web. P. C. 228, 302; 5 H. L. Cas. 505, 522, 545; *The Badische Anilin und Soda Fabrik* v. *Levinstein*, 2 P. O. R. 90.

(*z*) *Thompson* v. *James*, 32 Beav. 570; *Horton* v. *Mabon*, 12 C. B., N. S. 437; 16 C. B., N. S. 141; 31 L. J., C. P. 255; *Rushton* v. *Crawley*, L. R., 10 Eq. 522; *Murray* v. *Clayton*, L. R. 7 Ch. 570; *Jensen* v. *Smith*, 2 P. O. R. 249; *Fletcher* v. *Arden*, 5 P. O. R. 46; *Tickelpenny* v. *Army & Navy Cooperative Society*, 5 P. O. R. 405; *United Horseshoe Co.* v. *Swedish Horse-nail Co.*, 6 P. O. R. 1; *Winby* v. *Manchester Steam Tramways Co.*, 8 P. O. R. 61.

(*a*) 7 P. O. R. 67; see also *Hayward* v. *Hamilton*, Griff. P. C. 115, 117; *Hinks* v. *Safety Lighting Co.*, L. R., 4 Ch. D. 615; *Moss* v. *Malings*, 3 P. O. R. 373, 378; *Edison* v. *Woodhouse*, 4 P. O. R. 79, 92.

(*b*) *Saxby* v. *Gloucester Waggon Co.*, L. R., 7 Q. B. D. 305; see also *White* v. *Toms*, 37 L. J., Ch. 204; *Ormson* v. *Clarke*, 13 C. B., N. S. 337; 14 C. B., N. S. 475; *Jackson* v. *Needle*, 2 P. O. R. 191; *Sharp* v. *Bauer*, 3 P. O. R. 193; *Rowcliffe* v. *Longford Wire Iron Co.*, 4 P. O. R. 281; *Haslam* v. *Hall*, 5 P. O. R. 22; *Longbottom* v. *Shaw*, 5 P. O. R. 497; 6 P. O. R. 143; *Herburger* v. *Squire*, 6 P. O. R. 194; *Morgan* v *Windover*, 7 P. O. R. 131; *Williams* v. *Nye*, 7

accident (*c*), or was one that appeared obvious after it had been made (*d*), is of no importance, provided that the result is the production of a cheaper or better article than had been produced before, by some new combination that had not previously occurred to any one else (*e*).

In *Cannington* v. *Nuttall* (*f*), it was held that the patent could be sustained, although each principle or process in it was previously well known, provided that the mode of combining these processes was new and produced a beneficial result, and provided also that the specification claimed not the old processes or any other, but only the new combination. This case is very instructive, as clearly demonstrating what is meant by a "new combination."

To summarise the law upon "subject-matter," a patent may be granted for:—

(1) A new principle, coupled with a method of application, though the principle by itself would not be subject-matter.

(2) The novel application of an old principle, if invention is disclosed and a substantial improvement effected, but the patentee is strictly tied down to his method of application.

(3) A new machine, material, or process for a new purpose.

(4) A new machine, material, or process for an old purpose, but the Courts will construe the invention strictly.

(5) An old machine for a new purpose will be subject-matter only where the novel application obviously demanded the exercise of inventive power, but no patent will be granted for the application of an old machine to a purely analogous purpose.

(6) A new combination of new and old, or new, or old processes or materials, so as to effect an old purpose in a better, cheaper, or more expeditious way than had been done before, coupled with the exercise of ingenuity.

(7) An improvement by the omission of a part of an old

P. O. R. 62; *Newsum* v. *Mann*, 7 P. O. R. 307; *In re Gaulard & Gibbs' Patent*, 7 P. O. R. 367, 380; *Tucker* v. *Kaye*, 8 P. O. R. 58, 234.

(*c*) *Crane* v. *Price*, 1 Web. P. C. 410; *Boulton* v. *Bull*, Dav. P. C. 198; *Liardet* v. *Johnson*, 1 Web. P. C. 54.

(*d*) *Lyon* v. *Goddard*, 10 P. O. R. 343; *Benno Jaffé* v. *Richardson*, 11 P. O. R. 111; *Edison* v. *Smith*, 11 P. O. R. 308.

(*e*) *Crane* v. *Price*, 1 Web. P. C. 408; *Murray* v. *Clayton*, L. R., 7 Ch. 584; *Lyon* v. *Goddard*, 10 P. O. R. 346; 11 P. O. R. 354.

(*f*) L. R., 5 H. L. 205.

machine which was previously thought essential, or by the addition of a new part, or by the substitution for an old part of a new piece of mechanism, or even of a mechanical equivalent which was not previously known to be such, provided that a substantial improvement is thereby effected, and provided that the improvement required the exercise of ingenuity.

(8) A new product.

(9) A new method of using an old machine, by which a new and useful result is attained.

CHAPTER V.

NOVELTY.

HAVING now considered the interpretation which has been placed by the Courts upon the word "manufacture," we next examine what has been held to be a "**new manufacture**," that is to say, to what extent prior user is an answer to an action for the infringement of a patent. It is evident, that, if the alleged new manufacture can be shown to have been in the possession of the public before the application for the grant of letters patent, that there is no consideration for the grant. The patentee offers to the public, in return for the monopoly privilege, his information and knowledge respecting a new manufacture; if the public is already possessed of the information or knowledge, the supposed inventor has nothing to give (*a*). We shall see hereafter, when we discuss the practice of the Courts in actions for the infringement of patents, that the **burden of proof** lies on the alleged infringer when he sets up a defence of **prior user**, *i.e.*, of want of novelty in the alleged manufacture at the date of the patent; and it is as well to keep this in mind in reading the cases which have been decided as to what amounts to prior user.

We have seen that the Statute of Monopolies is a mere declaration of that which was the law before it was passed; it was always held by the Courts that the principle of a patent grant was not an arbitrary advantage granted by the Crown to one subject in detriment to the rest, but that it was an advantage granted by the Crown to persons who introduced a new manufacture, and that it was granted upon principle, not for the benefit of the patentee but for the benefit of the public: it being con-

(*a*) *Patterson* v. *Gas Light & Coke Co.*, L. R., 3 App. C. 239; *Morgan* v. *Seaward*, 2 M. & W. 544, 561; *Humpherson* v. *Syer*, 4 P. O. R. 407, 414.

sidered to the benefit of the public that reasonable encouragement should be given to inventors to induce them to devote their time, energies and resources to the improvement of the arts and manufactures of the realm.

In the case of *Hasting's Patent* (*b*), decided in 1567, the patent was in consideration of the patentee having brought into the country the making of frisadoes as they were made in Haarlem, in Amsterdam, being not used in England. The infringers defended the patentees' bill in the Exchequer Chamber, on the ground that they had made baies very like to Mr. Hasting's frisadoes, prior to the date of Mr. Hasting's patent; they were therefore not restrained from making baies like his frisadoes. A patent was granted to "one Humphrey, of the Tower, 'for the sole and only use of a sieve or instrument for melting of lead, supposing it was his own invention, and therefore prohibited all others to use the same for a time'; and because others used the like instrument in Derbyshire, contrary to the intent of his patent, therefore he did sue them in the Exchequer Chamber by English bill, in which Court the question was whether it was newly invented by him, whereby he might have the sole privilege, or else used before at Mendip, in West country, which if it were there before used then the Court were of opinion that he should not have the sole use thereof" (*c*).

The general question in disputed patents is whether the invention was known and in use before the patent? In *Rex* v. *Arkwright* (*d*), decided in 1785, Buller, J., gave a definition of "*novelty*" which now would be considered too wide. "Thus the case stands as to the several component parts of this machine, and if upon them you are satisfied that none of them were inventions unknown at the time this patent was granted, or that they were not invented by the defendant, upon either of these points the prosecutor is entitled to your verdict."

In *Cannington* v. *Nuttall* (*e*), Lord Hatherley, L.C., said: "It

(*b*) 1 Web. P. C. 6.

(*c*) 1 Web. P. C. 7; *Darcy* v. *Allin*, 1 Web. P. C. 6; *Mitchell* v. *Reynolds*, 19 Mod. R. 130; *Liardet* v. *Johnson*, 1 Web. P. C. 52, 53.

(*d*) 1 Web. P. C. 64.

(*e*) L. R., 5 H. L. 216; see also *Pirrie* v. *York Street Flax Spinning Co.*, 10 P. O. R. 37, 39.

is quite apparent, my Lords, that the cooling thing, the current of air, was nothing new—it is as old as the fables of Æsop—it is as old as the man blowing his soup in order to make it cool. But so it is with every invention—the skill and ingenuity of the inventor are shown in the application of well-known principles. Few things come to be known now in the shape of new principles, but the object of an invention generally is the applying of well-known principles to the achievement of a practical result not yet obtained. And I take it that the test of novelty is this: Is the product which is the result of an apparatus for which the inventor 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 you have in view?"

Pollock, C.B., treating with this subject in his judgment in *Newton* v. *The Grand Junction Railway Co.* (*f*), 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 new matter, by any new combination, or by a new application, it is a novelty entitled to a patent."

When we speak of an invention being new, we mean that it must be new so far as the public are concerned, that is, so far as the means of information of the public goes. If a man had invented a machine and made it and used it secretly, so that no one but himself had access to it, and the general public had no means of information upon it, there is no doubt that a subsequent inventor, re-inventing, so to speak, the same machine, and disclosing his knowledge to the public in his specification, would be entitled to a valid patent (*g*). A machine made by the person who kept it secret would not amount to such a public knowledge as would anticipate the invention of the patentee, but if the first-made machine had been used in such a manner that other persons had been enabled to acquire the knowledge of its use and applica-

(*f*) 5 Exch. R. 334; 20 L. J., Ex. 429.

(*g*) Dollond's Patent, 1 Web. P. C. 43.

tion, there would be a prior user to void the subsequent patent. Lord Chief Justice Tindal said, in *Cornish* v. *Keene* (*h*): "If it was known at all to the world publicly, or practised openly so that any other person might have the means of acquiring a knowledge of it as well as the inventor, then the patent would be void." In *Carpenter* v. *Smith* (*i*), Lord Abinger, C.B., analyzed the meaning of the words "public use." "Public use does not mean a use or exercise by the public, but a use or exercise in a public manner." Taking that as a definition of the meaning of the words "public use," it will be apparent that the question of prior user is one of fact, and one which will have to be considered by a jury or a judge sitting as a jury upon the facts of each particular case (*k*).

The law on this point was laid down by Lord Blackburn in *Patterson* v. *The Gas Light and Coke Co.* (*l*), in the words of Mr. Hindmarsh: "If the public once become possessed of an invention *by any means whatever*, no subsequent patent can be granted for it, either to the true or first inventor himself, or to any other person, for the public cannot be deprived of the right to use the invention, and a patentee of the invention could not give any consideration to the public for the grant, the public already possessing everything that he could give" (*m*).

The public become possessed of an invention if, before the inventor has applied for a grant of letters patent, it has been used by, exhibited, or published to any person (*n*) without reserve and without injunction to secrecy (*o*), and that too whether

(*h*) 1 Web. P. C. 508.

(*i*) 9 M. & W. 304; see also *Betts* v. *Neilson*, 3 De G. J. & S. 82; L. R., 3 Ch. 429; *Heath* v. *Smith*, 3 E. & B. 256; *Harwood* v. *G. N. Ry. Co.*, 29 L. J., Q. B. 193; 2 B. & S. 194; *Croysdale* v. *Fisher*, 1 P. O. R. 17, 21; *Lister* v. *Norton*, 3 P. O. R. 199, 210.

(*k*) *Pickard* v. *Prescott*, 9 P. O. R. 200.

(*l*) L. R., 3 App. Cas. 244; see also *Lister* v. *Norton*, 3 P. O. R. 211; *Humpherson* v. *Syer*, 4 P. O. R. 414; *Westley Richards* v. *Perkes*, 10 P. O. R. 193.

(*m*) Hindmarch on Patents, p. 33.

(*n*) *Losh* v. *Hague*, 1 Web. P. C. 200; *Stead* v. *Williams*, 2 Web. P. C. 126; *Humpherson* v. *Syer*, 4 P. O. R. 407, 415; *Harris* v. *Rothwell*, 5 P. O. R. 225, 230.

(*o*) *Stead* v. *Williams*, 2 Web. P. C. 126; *Morgan* v. *Seaward*, 2 M. & W. 544, 559; *Winby* v. *Manchester Steam Tramways Co.*, 8 P. O. R. 61, 66; *Lifeboat Co.* v. *Chambers*, 8 P. O. R. 413; *Gadd* v. *Mayor, &c., of Manchester*, 9 P. O. R. 249, 527.

but one sample of the invention was used (*p*), or the information was obtained from one whom the inventor had placed under the bond or seal of confidence (*q*), or if the anticipating machine was made simply for the purpose of export (*r*).

An offer to sell, although no sale is effected, constitutes a prior publication of the invention, and will vitiate a subsequent patent (*s*).

Whether the mere **manufacture** of an article will or will not amount to a "public user" depends upon the circumstances under which it was carried on (*t*).

In *Betts* v. *Neilson* (*u*) Lord Cholmsford said: "If the evidence which I am about to examine establishes the fact that lead coated with tin by mechanical pressure, and capable of useful application, has upon any occasion been manufactured openly, not by way of experiment, but in the course of business, although not a single piece of the material was actually sold, I should hold that Betts' patent was invalidated."

In *Morgan* v. *Windover* (*x*) Cotton, L.J., in his judgment in the Court of Appeal, said: "If, in truth, we were satisfied that a carriage, in accordance with that which is claimed by *Mr. Morgan* as his invention, was then made, and made in a practical working shape, it would not be material that it had never been used from that time to this, because there would have been a prior use of that which is claimed by *Mr. Morgan* as his invention; but, as was pointed out by Lord Brougham in *The Householl Co.* v. *Neilson* (*y*), although, if there is a complete anticipation by prior user, the abandonment of it is nothing, yet

(*p*) *Honiball* v. *Bloomer*, 2 Web. P. C. 200; *Hollins* v. *Capper*, 5 P. O. R. 289.

(*q*) *Humpherson* v. *Syer*, 4 P. O. R. 407, 416; *Useful Patents Co.* v. *Rylands*, 2 P. O. R. 255; *Kurtz* v. *Spence*, 5 P. O. R. 161.

(*r*) *Carpenter* v. *Smith*, 1 Web. P. C. 530; *Westley Richards* v. *Perkes*, 10 P. O. R. 181, 192.

(*s*) *Oxley* v. *Holden*, 8 C. B., N. S. 666; *Wood* v. *Zimmer*, 1 Holt N. P. C. 58; 1 Web. P. C. 82, n.; *Mullins* v. *Hart*, 3 Car. & K. 237.

(*t*) *Moss* v. *Malings*, 3 P. O. R. 373, 378; *Lewis* v. *Marling*, 4 C. & P. 57; *Betts* v. *Menzies*, 8 E. & B. 923; *Betts* v. *Neilson*, L. R., 3 Ch. 436; *Morgan* v. *Seaward*, 1 Web. P. C. 167; *Bramah* v. *Hardcastle*, Holroyd, 81.

(*u*) L. R., 3 Ch. 436; see also *Humpherson* v. *Syer*, 4 P. O. R. 407; *Westley Richards* v. *Perkes*, 10 P. O. R. 192.

(*x*) 5 P. O. R. 302, 303.

(*y*) 1 Web. P. C. 673; see also *King, Brown & Co.* v. *The Anglo-American Brush Co.*, 6 P. O. R. 414, 424.

when it is a question of whether, really, there was a carriage perfected in accordance with the plans of *Mr. Morgan*, the fact that it had never been used for 36 years, or something of that sort, before he took out his patent is most material, as leading to the conclusion that that which was made in the year 1848 was not a perfect carriage in accordance with the invention of *Mr. Morgan*."

Where the anticipating machine was **incomplete** and practically **useless** for the purpose for which it was intended, or merely experimental, and abandoned as being unsatisfactory (*z*), or what was nothing more than a **scientific curiosity** of no practical value (*a*), it has been held that a subsequent patent for a workable and efficient machine is not vitiated thereby.

In *Smith* v. *Davidson*, a Scotch case (*b*), the Lord President said: "In order to invalidate letters patent on the ground of previous use it is necessary not only that the use shall have been prior to the date of letters patent, but that it should be a public and not a secret use." The remarks of Lord Bramwell, in *Hills* v. *London Gaslight Co.* (*c*), on this subject were as follows: "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 anyone else discovers that invention it is new, that is to say, new in the sense that the first invention has not been published."

As further illustrating the distinction between "public use" and "secret use" we may quote the words of Mr. Justice Williams in *Hancock* v. *Somervell*, which is quoted in "Newton's London Journal," Vol. XXXIX., p. 158. "The defendants say that the invention had been substantially published and was in use, not in secret use, but in public use, in England before the

(*z*) *Murray* v. *Clayton*, L. R., 7 Ch. 570; *Hills* v. *London Gas Light Co.*, 5 H. & N. 312; *Jones* v. *Pearce*, 1 Web. P. C. 121; 2 Coop. Ch. Ca. 58; *Galloway* v. *Bleaden*, 1 Web. P. C. 521, 525; *Walton* v. *Bateman*, 1 Web. P. C. 613, 619; *Cornish* v. *Keene*, 1 Web. P. C. 501, 508; *Barlow* v. *Bayliss*, Griff. P. C. 44; *Lyon* v. *Goddard*, 10 P. O. R. 121, 134; 11 P. O. R. 354.

(*a*) *Young* v. *Fernie*, 4 Giff. 577, 611; see also *Benno Jaffé* v. *Richardson*, 11 P. O. R. 93.

(*b*) 19 C. S. 691.

(*c*) 5 H. & N. 336; see also *Morgan* v. *Seaward*, 2 M. & W. 544; *Gadd* v. *Mayor, &c., of Manchester*, 9 P. O. R. 516; *Westley Richards* v. *Perkes*, 10 P O. R. 181.

date of the patent, and if that is so it would entitle the defendants, no doubt, to a verdict upon this novelty issue. Upon that part of the case the view that it seems to me ought to be taken by you is this: you will first consider whether the material was before the public; it is not necessary that it should be used by the public if it is in public use, not in secret use . . . . I should here say that I do not think it necessary the use should be actually for sale; if it were in public use it need not be sold; it would be sufficient, for instance, if it were in use, handed about the country for the purpose of attracting customers. If you should think that the material being so in use, it was so palpable that you could make it when you got the material, that substantially the disclosure of the material was a disclosure of the means of making it, that would be a public use."

In *Stead* v. *Anderson* (*d*) Baron Parke placed some considerable limitation on the meaning of the words "public use" in saying, "If the mode of forming and laying blocks at Sir W. Worsley's had been precisely similar to the plaintiff's, that would have been sufficient user to destroy the plaintiff's patent, though put in practice in a spot to which the public had not free access."

It is difficult to draw the line precisely between public and secret use; we do not suppose that for the purpose of showing that some use was secret use it would be necessary to show an intention of secrecy, but in all cases it will be a matter of fact whether the use was so private and so secret as to make it practically impossible that the public should become acquainted with the manufacture.

Erle, J., in *Heath* v. *Smith* (*e*), cast a doubt even upon whether secret use would not amount to anticipation. He said: "If one party only had used the process and had brought out the article for profit and kept the method entirely secret, I am not prepared to say that then the patent would have been valid." But this seems to be in direct contradiction to the decision in *Dollond's Case* (*f*). In that case the objection to Dollond's patent was that he was not the inventor of the method of making

(*d*) 2 Web. P. C. 149; see also *Stead* v. *Williams*, 2 Web. P. C. 126, 136.

(*e*) 8 E. & B. 256; 23 L. J., Q. B. 166, 171.

(*f*) 1 Web. P. C. 43.

new object-glasses, but that Dr. Hall had made the same discovery before him; but it was held that, inasmuch as Dr. Hall had confined it to his closet, and the public were not acquainted with it, Dollond was to be considered the inventor (*g*).

In *Betts* v. *Neilson* (*h*) it is said, "There may be public use of a patented article, without actual sale of the goods manufactured."

There are some conflicting cases on the subject of secret use. It does not appear to be open to much doubt that purely secret use, without publication, even if accompanied with the sale of the article manufactured, provided the article itself, by its appearance or other qualities, does not disclose the invention (*i*), ought not to invalidate the letters patent granted to a subsequent inventor, since he is in the position to, and does give to, the public the full consideration required by the Statute of Monopolies and the common law, for the patent grant which he applies for. On the other hand, if the secret use has been by himself, and he only applies for letters patent when he has any fear of his invention being discovered, then, probably, the previous secret use of the inventor would be held to invalidate his patent.

This branch of the subject is surrounded with considerable difficulty, for bearing in mind that the consideration which the inventor gives for the patent is the information which he is in a position to give to the world, it is difficult to understand upon what principle, if he keeps that information to himself and manufactures an article which of itself does not disclose his invention, he should not have a patent; since he is always in a position to give the information to the public, and to give a valid consideration for the grant. Unless indeed we regard the grant of letters patent, as not only the result of a contract between two parties, the state and the inventor, but also as somewhat after the nature of a reward for invention, which is only given for merit. There is, as we have pointed out before, no merit in

(*g*) See also remarks of Buller, J., in *Boulton* v. *Bull*, 2 H. Bl. 463 to 470; and Dallas, J., in *Hill* v. *Thompson*, 1 Web. P. C. 244.

(*h*) L. R., 3 Ch. 429.

(*i*) *Hancock* v. *Somervell*, 39 Newton's London Journal, 158.

publishing an invention which you find it difficult to keep any longer secret. Of course it would be otherwise where the article itself, by its appearance or by its properties, discloses the invention; the Courts, in their decisions, seem to have recognized the difficulty of this question. Baron Parke, in *Morgan* v. *Seaward* (*l*) said: "For if the inventor could sell his invention, keeping the secret to himself, and, when it was likely to be discovered by another, take out a patent, he might have practically a monopoly for a very much longer period than fourteen years." It does not seem to have been expressly decided that if an article sold did not disclose the invention, the use of the invention, if kept secret, would invalidate a subsequent patent by the inventor. Baron Parke as we have seen seems to have thought that it would; on the other hand the cases which have been cited above clearly lay down as law that a patent will only be anticipated if the subject of it has been made public, either by being disclosed to or practised by any person without reserve or in a place to which the public could have access, and consequently if the original inventor manufactured articles but kept the invention secret so that no one else could practise it, it is evident upon the authority of those cases, and particularly of *Dollond's Case* and *Hills* v. *The London Gaslight Co.*, that if someone else should re-invent the same matter subsequently, the secret use of the invention by the first inventor would not invalidate the patent of the second inventor; and if not the patent of the second inventor, why, upon principle, should one person from whom the consideration would move personally be in a worse position than another? It may be said, perhaps, that the common law contemplated *bona fides* on the part of the inventor, and a *bonâ fide* discovery of the invention to the public within a reasonable time, and that the working of the invention in secret and subsequent application for the patent was strong evidence of *mala fides*, and consequently would avoid the patent on the ground of a constructive fraud upon the public (*m*).

(*l*) 2 M. & W. 544.

(*m*) As to publication by sale, see *Wood* v. *Zimmer*, 1 Web. P. C. 44; *Losh* v. *Hague*, 1 Web. P. C. 205; *Gibson* v. *Brand*, 1 Web. P. C. 628; *Carpenter* v. *Smith*, 1 Web. P. C. 536; *Mullins* v. *Hart*, 3 Car. & K. 297; *Heath* v. *Smith*, 3 E. & B. 256; 2 Web.

More **experiments** with a view to discovery have been frequently held not to invalidate a subsequent patent; few inventions could be made without trial, and there are some things of such magnitude that the trials cannot practically be conducted in private; hence it has been held that the mere making of experiments, with a view to invention, does not invalidate a patent whether made by the inventor himself (*n*), or by others to whom he has lent his machine for that purpose (*o*), nor will the fact that **pecuniary profit** resulted from such experiments necessarily avoid a subsequent patent (*p*).

Whether the experiments may be fairly so regarded, or whether they amount to such an open use of the machine as to constitute a publication, is a question to be decided upon the facts of each particular case (*q*).

Lord Esher, M.R., speaking on this subject in *Elias* v. *Grovesend Tinplate Co.* (*r*), said, "The patent law about that is, that so long as you are experimenting upon the thing in the hands of people who ought not to disclose it, you must have people to assist you, and you cannot do everything yourself in your own private room, but so long as you are only doing it with people who are to assist you, and who ought not to tell, that is experimenting, and it is no publication; it does not make it public property. But if you go on with all that you have been in doubt about, to erect or make your patent—if it is a

P. C. 268; *Horniball* v. *Bloomer*, 2 Web. P. C. 200; *Oxley* v. *Holden*, 8 C. B., N. S. 666; *Lister* v. *Norton*, 3 P. O. R. 199.

(*n*) *Newall* v. *Elliot*, 4 C. B., N. S. 269; *Hills* v. *London Gas Light Co.*, 29 L. J., Ex. 409; see also *Jones* v. *Pearce*, 1 Web. P. C. 122; *Bramah* v. *Hardcastle*, Holroyd, 81; *Cornish* v. *Keene*, 1 Web. P. C. 508; *Galloway* v. *Bleaden*, 1 Web. P. C. 525; *Steed* v. *Williams*, 2 Web. P. C. 135; *Household Co.* v. *Neilson*, 1 Web. P. C. 673; *Edison & Swan Electric Light Co.* v. *Woodhouse*, Griff. P. C. 90; *Elias* v. *Grovesend Tinplate Co.*, 7 P. O. R. 455, 466

(*o*) *Bentley* v. *Fleming*, 1 Car. & K. 587; *Useful Patents Co.* v. *Rylands*, 2 P. O. R. 262; *Humpherson* v. *Syer*, 4 P. O. R. 407, 411; *Elias* v. *Grovesend Tinplate Co.*, 7 P. O. R. 455, 466.

(*p*) *Newall* v. *Elliot*, 4 C. B., N. S. 269; *Morgan* v. *Seaward*, 2 M. & W. 544.

(*q*) *Cornish* v. *Keene*, 1 Web. P. C. 501, 507; *In re Adamson's Patent*, 6 De G., M. & G. 420; 25 L. J., Ch. 456; *Brereton* v. *Richardson*, Griff. P. C. 54; 1 P. O. R. 165; *Elias* v. *Grovesend Tinplate Co.*, 7 P. O. R. 455, 462.

(*r*) 7 P. O. R. 466.

machine, to make your machine—if all that is over, and you put it up in a public workshop or in a place where other people would come who are not bound by any rule of secrecy or faith—who are not bound to keep the secret—if you put it up in a place which they are to frequent and where they can see it, you have published it, and if you have published it, it becomes public property—it becomes the property of all the world immediately."

The manufacture and sending out of samples for the purpose of experimenting as to the satisfactory character of the invention has been held not to amount to a publication (*s*).

There is another description of anticipation which is capable of invalidating a patent besides that of public use, and that is prior publication. Prior publication means the printing, writing, or publishing of some document to which the public have access, containing such a description of the invention as will enable a practical man to carry it out from the description given. Vague hints or descriptions of experiments, incomplete, or imperfect, are not sufficient to invalidate a subsequent patent (*t*). It is not necessary that that which is described in the book or publication should have been carried out in practice, it equally anticipates the patent (*u*). The question will always be one of fact, depending on the circumstances of each particular case, and the point which should be left to the consideration of the jury is, whether upon the whole evidence there has been such a publication as to make the description part of the public stock of information (*v*).

It is necessary that the description in the publication which is relied upon as evidence of prior publication, should be such as will when carried out produce the patented article; otherwise, however similar the description may be, if

(*s*) *The Useful Patents Co.* v. *Rylands*, Griff. P. C. 234; 2 P. O. R. 255.

(*t*) *Betts* v. *Menzies*, 1 E. & E. 1038; 3 Jur., N. S. 358; 10 H. L. Cas. 154, 157; *Stoner* v. *Todd*, L. R., 4 Ch. D. 58; *Thomson* v. *Batty*, 6 P. O. R. 84.

(*u*) *The Househill Co.* v. *Neilson*, 1 Web. P. C. 718, n.

(*v*) *Stead* v. *Williams*, 2 Web. P. C. 142; 8 Scott 472; *Stead* v. *Anderson*, 2 Web. P. C. 147; 4 C. B. 806; *Plimpton* v. *Malcolmson*, L. R., 3 Ch. D. 531.

it will not produce the alleged invention it will not amount to anticipation (*w*).

Vice-Chancellor Wood, in *Betts* v. *Menzies* (*x*), said, "I think that if a man sits down and takes out a patent from his own conjectures without ever having tried the experiments set forth in it, that will not invalidate a subsequent patent taken out and practically worked, especially when it turns out that the method prescribed by the earlier patent is practically useless." This remark of the learned Vice-Chancellor indicates how difficult a thing it is to lay down a general rule which shall bind every case; indeed no such general rule has ever been framed. It is evident that if a man were to describe an invention in a book or in a specification, and describe it so minutely and accurately that any practical person could from the description produce the invented matter, it would be immaterial whether the writer had tried experiments or had ascertained whether his invention would work in practice or not. If it should afterwards turn out to work in practice, and work as described, without any further inventive power and without any further invention being necessary, the description in the book or specification would be sufficient to invalidate any subsequent patent for the same invention.

In *Betts* v. *Menzies* (*supra*) the Vice-Chancellor had before him a case where the method described in the earlier publication was practically useless. In that event there is no doubt that the description would not invalidate a subsequent patent, because further invention would be necessary to bring the matter to a successful issue.

When *Betts* v. *Menzies* (*y*) came before the House of Lords, Lord Westbury said: "To effect a new patent, it must be clear that the antecedent specification disclosed a practical mode of

(*w*) *Muntz* v. *Foster*, 2 Web. P. C. 94; *Hills* v. *London Gas Light Co.*, 29 L. J., Ex. 409; *Hills* v. *Evans*, 31 L. J., Ch. 457; *Betts* v. *Neilson*, L. R., 5 H. L. 15; *Plimpton* v. *Malcolmson* L. R., 3 Ch. D. 531; *Otto* v. *Linford*, 46 L. T., N. S. 39; *Philpot* v. *Hanbury*, 2 P. O. R. 33, 43; *Lawrence* v. *Perry*, 2 P. O. R. 179; *Barlow* v. *Baylis*, Griff. P. C. 44; *Erhlich* v. *Ihlee*, 5 P. O. R. 437; *Gadd* v. *Mayor, &c., of Manchester*, 9 P. O. R. 516, 533; *English and American Machinery Co.* v. *Union Boot Co.*, 11 P. O. R. 137, 367, 378.

(*x*) 8 Jur. N. S. 358.

(*y*) 10 H. L. C. 117.

producing the result which was the object and effect of the subsequent discovery; a barren general description therefore, though containing some **suggestive information** or involving some **speculative theory**, could not be treated as avoiding for want of novelty a subsequent specification or invention, unless it was ascertained that the antecedent publication involved the same amount of **useful information.**" In the same case the opinion of the judges having been taken by the House of Lords as to whether the Court could pronounce Betts' patent to be void simply on the comparison of two specifications without evidence to prove identity of invention, and also without evidence that Dobbs' specification disclosed a practical mode of producing the result, or some part of the result described in Betts' patent; Blackburn, J., subsequently Lord Blackburn, gave it as his opinion, "that **to avoid a patent on the ground of want of novelty**, it is necessary to show that part of what the patentee claimed as a new invention was at the date of the patent already a publicly-known invention; this may be shown by proving that the invention was already disclosed in a publication accessible to the public . . . . it is not necessary to show that the invention thus made publicly known had already been put in actual use . . . . as soon as it has been ascertained that the description in the book makes known an invention, that is to say, that it adds to the public stock of knowledge what would without any further discovery enable a person to produce a result in the nature of a new manufacture. . . . . If Dobbs had made it part of the public knowledge how to produce a new material as a practical result, and Betts had afterwards claimed to have a patent for, amongst other things, producing that result, he would have claimed that which was not new, and if Dobbs had not made it part of the public knowledge how to produce the result, then Betts would not have claimed anything already known. The Court cannot tell without evidence whether what Dobbs disclosed would produce a result, and, therefore, as it seems to me, cannot pronounce the first patent void without evidence. I therefore answer your lordships' question in the negative (z)."

(z) See also *Betts* v. *Neilson*, L. R., 3 Ch. 429; L. R., 5 H. L. 1.

The cases which have been decided have generally been upon the subject of antecedent publication by means of a specification, but it is evident that the publication of a book or newspaper, or in any other form which gives the public a means of information, is equally potent as an anticipation of a subsequent patent (*a*). *Hills* v. *London Gas Light Company* (*b*) illustrates very clearly the principle laid down by Lord Westbury in *Betts* v. *Menzies*. The plaintiff obtained a patent for the employment of hydrated oxide of iron in purifying coal gas. A specification was put in evidence as published some ten years prior to the plaintiff's patent by one Croll, in which he said that coal gas could be purified by using the oxide of manganese, the oxide of zinc, or the oxide of iron. Now there are two descriptions of oxide of iron, hydrated and anhydrous. Anhydrous oxides of iron will not purify coal gas. It was held, therefore, that inasmuch as further experiments were required to discover that the action of hydrated oxide of iron was different from that of anhydrous oxide of iron in the purification of coal gas, that the antecedent specification did not anticipate the plaintiff's specification.

In *Hills* v. *Evans* (*c*) Lord Westbury said: "The antecedent statement must, in order to invalidate the subsequent patent, be such that a person of ordinary knowledge of the subject would at once perceive and understand and be able practically to apply the discovery without the necessity of making further experiments."

In *Philpott* v. *Hanbury* (*d*), however, Grove, J., said: "What I am going to say now is an expression of opinion that is rather obiter. . . . . As a matter of fact my opinion is . . . . that there is not the same necessity for accurate description of how an invention shall be carried into effect, for the purpose of anticipating an invention, as there is for the purpose of sustaining a patent in the hands of a patentee, because in the latter case a description ought to be given which ought not to

(*a*) *Young* v. *Fernie*, 12 W. R. 901; *Carpenter* v. *Smith*, 1 Web. P. C. 530; *Gibson* v. *Brand*, 1 Web. P. C. 628; *The Household Co.* v. *Neilson*, 1 Web. P. C. 718, n.; *Plimpton* v. *Spiller*, L. R., 6 Ch. D. 412; *Patterson* v. *Gas Light & Coke Co.*, L. R., 3 App. Cas. 239; *United Telephone Co.* v. *Harrison*, L. R., 21 Ch. D. 720.

(*b*) 29 L. J., Ex. 409.

(*c*) 31 L. J., Ch. 403.

(*d*) 2 P. O. R. 43.

merely inform the minds of every skilled person or scientific person in the trade, but should inform the minds of ordinary people who are accustomed to work at the trade. Therefore I think that there is a distinction; but 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."

In *King, Brown & Co.* v. *The Anglo-American Brush Co.*, Lord McLaren in his judgment said that the proposition of prior publication "may be proved by showing that the invention was previously described, not necessarily in language sufficient as a direction to a mechanic, but in language clear and intelligible to educated men, conversant with the subject, and capable of giving the necessary directions to the hypothetical workman" (*e*).

In *Kaye* v. *Chubb* Lord Esher, M.R., said (*f*): "I quite agree with what has been stated as to the law by Lord Westbury. If in the first patent which is thus alleged there is a general statement which gives no clear intimation either by its own construction or by that mode of putting construction upon patents—namely, by considering what would be the effect of it upon a hypothetical workman of ordinary skill—if it is so general that, neither by its own construction nor that adapted mode of construction, it would lead to any clear conclusion at all either as to the result or as to the means, and if some other person coming with great skill and great care should, out of the general words, really produce something not inconsistent with them, but which is not disclosed by them, I quite agree that he can take out a patent,

(*e*) 7 P. O. R. 443; see also *Betts* v. *Neilson*, L. R., 5 H. L. 15; *Plimpton* v. *Malcolmson*, L. R., 3 Ch. D. 531; *Bray* v. *Gardner*, 4 P. O. R. 405; *American Braided Wire Co.* v. *Thomson*, 5 P. O. R. 122; *Dowling* v. *Billington*, 7 P. O. R. 204.

(*f*) 4 P. O. R. 298; see also *Benno Jaffé* v. *Richardson*, 11 P. O. R. 111, 261.

and he cannot be defeated, because that which is really his invention can be got within general words which describe nothing."

It is not necessary that the book containing the description of the invention should be sold so as to constitute an anticipation. Mere exhibition in a bookseller's window for sale is sufficient publication, or sending it to a bookseller's in this country to be published (*g*). "There is no difference between a foreign inventor and an English one if, when the inventor is a foreigner, he publishes the book in a foreign language and sends it over to the booksellers in this country for the purpose of being sold (*h*)." Prior publication in a foreign journal and in a foreign language will invalidate an English patent if it can be shown that a single copy was deposited in England in a public place, and was open to public inspection (*i*).

In *Otto* v. *Steel*, where a French treatise was placed in the British Museum library in 1863, it was held by Pearson, J., that having regard to the arrangements of the library there was no prior publication in England of matter contained in the treatise so as to avoid a patent taken out in 1876. The library arrangements were as follows: There was no access to the public to any part of the library of the British Museum beyond the reading room. The public had access to the general catalogue and to books of reference kept in the reading room. In the general catalogue of the British Museum the printed books were referred to under the names of their authors. The treatise in question was entered in the catalogue under the name of Beau de Rochas, and in no other place. It was itself kept in an inner room, and it could only be obtained by one of two means, either by some person knowing of the book and writing the name of the book on a piece of paper and requesting that the book might be furnished to him; or if a reader wanted to find something on a particular subject, and went to the superintendent and asked what books there were that he had better read. The superintendent, if not able

(*g*) *Lang* v. *Gisborne*, 31 Beav. 133.

(*h*) Per M. R. in *Lang* v. *Gisborne*, 31 Beav. 135; see also *Harris* v. *Rothwell*, L. R., 35 Ch. D. 416; 56 L. J., Ch. 459; 56 L. T. 552; 3 P. O. R. 383; *Pickard* v. *Prescott*, 7 P. O. R. 361; 9 P. O. R. 195.

(*i*) *United Telephone Co.* v. *Harrison*, L. R., 21 Ch. D. 720; *Stead* v. *Williams*, 8 Scott N. R. 449.

to give the information, would direct one of the assistants to take him to that section of the library where such books were likely to be found, and would desire him to let the reader look over the titles of those books, and select what book he pleased out of that section of the library.

In *Harris* v. *Rothwell* (*k*), Lord Justice Lindley, reading the judgment of Lord Justice Cotton and himself, after an elaborate review of the authorities, said: "The conclusion at which I have arrived, and which in my judgment is most in accordance with the authorities, and the principles which underlie them, may be thus expressed. *Primâ facie*, a patentee is not the first inventor of his patented invention if it be proved that before the date of his patent an intelligible description of his invention, whether in English or in any other language commonly known in this country, was known to exist in this country, either in the patent office or in any other library to which the public are admitted, and to which persons in search of information on the subject to which the patent relates, would naturally go for information. But if, as in the Plimpton cases (*l*) and in *Otto* v. *Steel* (*m*), it be proved that the foreign publication although in a public library, was not in fact known to be there, the unknown existence of the publication in this country is not fatal to the patent."

A patent for a machine may be anticipated by a **drawing** of it unaccompanied by explanatory letterpress if published in a book or elsewhere so that it could become generally known, provided that any mechanist would understand it, and could make the machine from the drawing without any further information, and without the exercise of ingenuity (*n*).

An inventor may invalidate his own invention by previous publication in a **specification.** For instance, if an inventor

(*k*) 4 P. O. R. 225, 232; see also *Stead* v. *Williams*, 7 M. & G. 818; *Lang* v. *Gisborne*, 31 Beav. 133; *United Telephone Co.* v. *Harrison*, L. R., 21 Ch. D. 720; *The United Horsenail Co.* v. *Stewart*, 2 P. O. R. 133.

(*l*) *Plimpton* v. *Malcolmson*, L. R., 3 Ch. D. 531; 44 L. J., Ch. 257; 45 L. J., Ch. 505; *Plimpton* v. *Spiller*, L. R., 6 Ch. D. 412; 47 L. J., Ch. 211.

(*m*) *Otto* v. *Steel*, L. R., 31 Ch. D. 241; 55 L. J., Ch. 196; 3 P. O. R. 109.

(*n*) *Herrburger* v. *Squire*, 6 P. O. R. 198.

applies for letters patent and files a complete specification, and after the publication of the specification abandons it and begins again, applying for letters patent for the same invention, the previous publication of the specification will invalidate a subsequent patent.

Under the Act of 1883 it is clear that if he only filed a provisional specification there would be no publication, since **provisional specifications which are subsequently abandoned are not published.** In *Oxley* v. *Holden* (*o*) it appeared that on the 17th March, 1858, the plaintiff obtained provisional protection for an invention of indiarubber pads to be applied to the windows of carriages. On the 10th April, 1858, he obtained a second provisional protection for three heads of invention, whereof one comprised the above-mentioned indiarubber pads. The first application was abandoned, and the second carried to completion —*there was no evidence that between the date of the first application and the second the invention had in any way been put in practice or published:* hold, that the first application did not invalidate the patent.

Erle, C.J., in the course of his judgment said: "Although the first provisional specification may afford an objection either to receiving a second patent for the same invention, or to granting a patent for the invention after the first specification has expired, there is no principle of law, and no enactment making the patent void if it is so granted; and, on the contrary, sect. 24 (of the Act of 1852) enacts that the patent, dated as of the day the provisional specification was delivered in, shall be of the same force and validity as if it had been sealed on that day. This patent is dated as of the 10th of April. On that day the protection given under the specification of the 17th of March existed; and the patent is valid by the operation of this section" (*p*).

In *Lister* v. *Norton* (*q*) the same question arose, but there the patentee had publicly used the invention between the dates of the two provisional specifications. Chitty, J., held that the

(*o*) 8 C. B., N. S. 666.

(*p*) Ibid. at p. 708; cf. 46 & 47 Vict. c. 57, ss. 13 and 14; also 48 & 49 Vict. c. 63, s. 4.

(*q*) Griff. P. C. at pp. 151, 153.

reasoning of *Oxley* v. *Holden* applied to this case, and said: "But reverting to the point of law, I think that this user in public is covered by the grounds on which the Court of Common Pleas decided *Oxley* v. *Holden*. The Court hold that the protection of the first provisional specification extended down to the grant of the patent, and made this one of the grounds of their decision. A provisional specification was the creature of the Act of 1852. That Act, after providing for the filing of such a specification which is to describe the nature of the invention, and for the grant of the certificate, proceeds in the 8th sect. to enact that 'Thereupon the invention therein referred to may during the term of six months from the date of the application for letters patent for the said invention be used and published without prejudice to any letters patent to be granted for the same.' The phrase 'to be granted for the same' obviously means in this section, and in the 9th sect. (which relates to the filing of a complete specification in the first instance) for the same invention, and cannot be construed as referring to the application or petition. . . . . There is no express condition in the Act avoiding the protection conferred in reference to the first provisional specification by the filing of a second provisional specification in relation to the same invention, and having regard to the decision in *Oxley* v. *Holden* (*supra*), it is not open to me to say that there is any such implied condition."

So far as the author can ascertain this judgment was not appealed from, nor does it appear to have been discussed in any subsequent cases. Should the decision be upheld the results will be curious.

If, however, a provisional specification containing a sufficiently clear description of the nature of an invention be published, it will amount to an anticipation so as to avoid a subsequent patent granted for the same invention (*r*).

In *Von Heyden* v. *Neustadt* the defendants pleaded anticipation, and put in evidence a mass of paragraphs extracted from a large number of publications. James, L.J., in his judgment, said (*s*): "We are of opinion that if it requires this

(*r*) *Lawrence* v. *Perry*, 2 P. O. R. 187; *Stoner* v. *Todd*, L. R., 4 Ch. D. 58

(*s*) 50 L. J., Ch. 128; see also *Moseley* v. *Victoria Rubber Co.*, 4 P. O. R. 252.

mosaic of extracts from annals and treatises spread over a series of years, to prove the defendants' contention, that contention stands thereby self-condemned. . . . . And even if it could be shown that a patentee made his discovery of a consecutive process by studying, collating and applying a number of facts discriminated in the pages of such works, his diligent study of such works would as much entitle him to the character of an inventor as the diligent study of the works of nature would do."

A patent will be upheld where the result of the invention for which it was granted is the production of an article in abundance and suitable for economic and commercial purposes, which previously had been but a scientific curiosity and of no practical value whatever (*t*).

The consideration for a grant of letters patent is entire and indivisible, consequently where two or more mechanisms or processes are claimed in one specification the want of novelty of one will avoid the whole (*u*), but where one of the claims is but subsidiary to the rest and does not in any way increase or enlarge the monopoly claimed by the remainder of the specification, the Courts have held want of novelty in such a claim to be no objection to the patent (*x*).

In *Hopkinson* v. *St. James and Pall Mall Electric Light Co.*, Mr. Justice Romer said: "I think it is not a fair objection to the novelty of a process which is intended to be, and which is, of great use, when applied to a system comprising many things, to say that the case of one has not been expressly excluded by the inventor, and that, as the application of the process to the case of the one, so far as it could be applied to the one, was known, therefore the process has been anticipated, though the utility of

(*t*) *Young* v. *Fernie*, 4 Giff. 577, 611; *Edison and Swan Electric Light Co.* v. *Woodhouse*, Griff. P. C. 93; 4 P. O. R. 106; *Von Heyden* v. *Neustadt*, L. R., 14 Ch. D. 230; 50 L. J., Ch. 126.

(*u*) *Hill* v. *Thompson*, 8 Taunt. 375; 1 Web. P. C. 239; *Brunton* v. *Hawkes*, 4 B. & Ald. 541; *Morgan* v. *Seaward*, 2 M. & W. 544; *Kay* v. *Marshall*, 2 Web. P. C. 71; *Bloxam* v. *Elsee*, 6 B. & C. 178; *Turner* v. *Winter*, 1 Web. P. C. 77; 1 T. R. 602; *Bramah* v. *Hardcastle*, 1 Carp., P. C. 168; *Patterson* v. *Gas Light & Coke Co.*, L. R., 2 Ch. D. 812, 833; *Cropper* v. *Smith*, 1 P. O. R. 87; *The United Horsenail Co.* v. *Stewart*, 2 P. O. R. 132.

(*x*) *Plimpton* v. *Spiller*, L. R., 6 Ch. D. 412.

the invention practically disappears when the case of the one is considered (*y*)."

Mr. Justice Kekewich, in *Ehrlich* v. *Ihlee* (*x*), said: "If within a short time of the first manufacture and sale, an article of commerce commands a ready and extensive sale, that fact, which is proof of utility, must be accepted as **evidence**, not conclusive, but **cogent of novelty.**"

By sect. 39 of the Patents, &c., Act of 1883, it is enacted 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 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*" (*a*).

By sect. 103 of the same Act, as amended by 48 & 49 Vict. c. 63, s. 6, it is enacted as follows:—

"(1) *If Her Majesty is pleased to make any arrangements 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 shall have the same date as the date of the application in such foreign State.*

(*y*) 10 P. O. R. 60.

(*z*) 5 P. O. R. 205, 453; see also *The American Braided Wire Co.* v. *Thomson*, 5 P. O. R. 113, 125.

(*a*) See Appendix, p. 449, post; note effect of 49 & 50 Vict. c. 37, s. 3; also P. R., 1890, r. 15.

"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 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.

"(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" (*b*).

A foreign patentee has a double right, he may either take advantage of the Act and apply for a patent, antedated to the date of his foreign application, and thereby shorten the period of protection to that extent, or he may obtain a patent for the full period in the ordinary way, the date of the patent being conclusive to show which course he has pursued, but after having obtained a patent for the full period in the ordinary way, he may not avail himself of the provisions of sect. 103 to escape the result of a publication of his invention during the period that elapsed between his foreign application and his application in this country (*c*).

The fact of an invention having been practised previously in a **British Colony,** will not affect the power of the Crown to grant letters patent for its exercise in this country (*d*).

(*b*) See also International Convention, 1883, p. 411, post.

(*c*) *The British Tanning Co.* v. *Groth*, 8 P. O. R. 113.

(*d*) *Rolls* v. *Isaacs*, L. R., 19 Ch. D. 268.

CHAPTER VI.

UTILITY.

We now come to the consideration of the question of **utility**, for not only must the invention be new, but it must be new and useful. The 6th section of the Statute of Monopolies does not refer to the necessity of utility in the invention, but saving, as it does, the common law prerogative of the Crown in respect of inventions, it refers us back to what had previously been held to be the necessary elements of an invention. In *Darcy* v. *Allin* (*a*), decided in 1602, it was held, the invention must tend to the furtherance of trade, and be for the good of the realm, and that the monopoly was granted in consideration of the good that the inventor doth bring by his invention to the commonwealth, otherwise not. Consequently an essential element of a valid grant is, that it should be for something which is for the good of the realm; that is, it must be useful (*b*).

In *Boulton* v. *Bull* (*c*), Rooke, J., said: "The public have a right to receive a meritorious consideration in return for the protection granted." In the same case Buller, J., said: "The invention professes to lessen the consumption of steam, and to make the patent good the method must be capable of lessening the consumption to such an extent as to make the invention useful." And in the case of *The King* v. *Arkwright* (*d*) the same judge, in leaving the matters to the jury, said: "There is another question, whether the stripe in it makes a material alteration, for

(*a*) Noy, R. 182.

(*b*) *Edgebury* v. *Stephens*, 1 Web. P. C. 35; *R.* v. *Arkwright*, 1 Web. P. C. 72; *Turner* v. *Winter*, 1 Web. P. C. 80; *Morgan* v. *Seaward*, 2 M. & W. 544; *Manton* v. *Parker*, Dav. P. C. 327; 1 Web. P. C. 192, n.; *The Badische Anilin und Soda Fabrik* v. *Levinstein*, 4 P. O. R. 462.

(*c*) 2 H. Bl. 478.

(*d*) 1 Web. P. C. 72.

if it appears, as some of the witnesses say, to do as well without the stripes, and to answer the same purpose if you suppose the stripes never to have been used before, that is not such an invention as will support the patent."

It will always be a question for the consideration of the jury, whether the invention is useful; that is, whether that which is now is a sufficient advance or improvement upon what was already known by the public as to add to a material extent to the public stock of knowledge (*e*). It does not mean that there must necessarily be a great deal of invention, or an extensive operation, to support the patent, but that the invention when carried out in some way materially improves the process or manufacture, either by cheapening the article produced, or by improving its quality, or by improving the method of producing, or the uses to which it can be put.

Each of the cases which have been decided upon the question of utility deal, and necessarily must deal, with an independent state of facts; and, consequently, no case can be said to be an authority for another case; but they go to show the general principle that "utility" means a **substantial improvement**, and not necessarily an **extensive improvement**; for instance, a man might invent a large and complicated machine for the manufacture of boots, which, when completed, would do nothing which was not done before, and would not make them any quicker or any cheaper than they were made before. Such a machine would not form the subject of a patent. On the other hand, a man might discover a new needle for stitching boots, which would economise half-an-hour in the manufacture of each boot; such a needle would be the subject of a patent, although the whole improvement might consist of a bend.

In *Crane* v. *Price*, Tindal, C.J., said: "If the invention be new and useful to the public, it is not material whether it be the result of long experiments and profound research, or whether by some sudden or lucky thought, or mere accident of discovery" (*f*).

The test of utility of an invention, is that, when put in practice by a competent man, it should really do what it assumes to do,

(*e*) *Hill* v. *Thompson*, 1 Web. P. C. 237; *Bloxam* v. *Elsee*, 1 C. & P. 565; *Cornish* v. *Keene*, 1 Web. P. C. 506.

(*f*) 1 Web. P. C. 411.

and be practically useful at the time when the patent is granted for the purposes indicated by the patentee (*g*).

Utility to support a grant of letters patent does **not depend** at all upon the amount of **commercial success** that may result from the invention (*h*), nor is it affected by the fact that it may be enormously expensive when put in practice (*i*), provided that cheapness of production is not the main point of the inventor's claim, in which case commercial failure will be taken into consideration as evidence of the uselessness of the invention.

In *The Badische Anilin und Soda Fabrik* v. *Levinstein*, before the House of Lords, Halsbury, L.C., 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" (*k*).

The fact that a patent was **never put into practice** is no proof of the uselessness of the invention. In *Edison* v. *Holland* (*l*), Lindley, L.J., said: "The utility of the patent must be judged by reference to the state of things at the date of the patent; if the invention was then useful, the fact that subsequent improvements have replaced the patented invention and rendered it obsolete and commercially of no value, does not invalidate the patent" (*m*); and Cotton, L.J., in the same case,

(*g*) Per Lindley, L.J., in *Lane Fox* v. *Kensington and Knightsbridge Electric Lighting Co.*, 9 P. O. R. 417; *Cornish* v. *Keene*, 1 Web. P. C. 507; Per Grove, J., in *Young* v. *Rosenthal*, 1 P. O. R. 41; *The Badische Anilin und Soda Fabrik* v. *Levinstein*, 4 P. O. R. 462, 466; L. R., 12App. Cas. 712, 719, 720; *Edison* v. *Holland*, 6 P. O. R. 283; see also *Wilson* v. *Union Oil Mills Co.*, 9 P. O. R. 70.

(*h*) *The Badische Anilin und Soda Fabrik* v. *Levinstein*, L. R., 12 App. Cas. 712, 719, 720; 4 P. O. R. 462, 466; *Otto* v. *Linford*, 46 L. T., N. S. 41; *United Telephone Co.* v. *Bassano*, 3 P. O. R. 313; *Ehrlich* v. *Ihlee*, 5 P. O. R. 450; *Kurtz* v. *Spence*, 5 P. O. R. 182; *Edison* v. *Holland*, 6 P. O. R. 257, 277, 283; *Lane Fox* v. *Kensington & Knightsbridge Electric Lighting Co.* 9 P. O. R. 417; *Wilson* v. *Union Oil Mills Co.*, 9 P. O. R. 69, 70; *Hopkinson* v. *St. James & Pall Mall Electric Light Co.*, 10 P. O. R. 62.

(*i*) *Wilson* v. *Union Oil Mills Co.*, 9 P. O. R. 69, 70; *The Badische Anilin und Soda Fabrik* v. *Levinstein*, 4 P. O. R. 462, 466.

(*k*) 4 P. O. R. 462.

(*l*) 6 P. O. R. 243.

(*m*) Ib. p. 283.

said (*n*): "A patent is not to be defeated simply because subsequent inventions improved the patented article, or because, in consequence of subsequent improvements, no article was, in fact, made in accordance with the specification."

In *Otto* v. *Linford*, Lord Jessel, M.R., said: "It is quite true that it has been said that it is *prima facie* evidence of want of utility (*o*) if you do not make and vend your machine; but that is subject to this observation, that you may make and vend an improvement upon it, and if you have found out immediately after you have patented your invention that it can be improved, it does not by any means show that the first invention was useless" (*p*).

A very slight **amount of utility** will be sufficient to support a patent. Alderson, B., in *Morgan* v. *Seaward*, said (*q*): "I think if it was of different construction from any other steam engine, and of *any use* to the public, then that is sufficient." Again, Lord Jessel, M.R., in *Otto* v. *Linford*, said (*r*): "And, as to this question of utility, very little will do."

"The law does not require any definite amount of utility, and 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" (*s*).

Utility, however great it may be, cannot by itself support a grant of letters patent, and the application of an old contrivance to an analogous purpose, however useful the result may be, will not constitute a patentable invention (*t*).

(*n*) 6 P. O. R. p. 277.

(*o*) *Morgan* v. *Seaward*, 1 Web. P. C. 186; *Tetley* v. *Easton*, Macr. P. C. 63.

(*p*) 46 L. T., N. S. 41; *Galloway's Patent*, 1 Web. P. C. 724; *Renard* v. *Levinstein*, 11 L. T., N. S. 505; *United Telephone Co.* v. *Maclean*, Scotch Session Cases, 4th Series, 710; see also *United Telephone Co.* v. *Bassano*, 3 P. O. R. 313; *Thompson* v. *Batty*, 6 P. O. R. 100.

(*q*) 1 Web. P. C. 186; see also per Baron Halsbury, L.C., in *The Badische Anilin und Soda Fabrik* v. *Levinstein*, 4 P. O. R. 462.

(*r*) 46 L. T., N. S. 41; see also *Philpott* v. *Hanbury*, 2 P. O. R 37; *Ehrlich* v. *Ihlee*, 5 P. O. R. 450; *Pirrie* v. *York Street Flax Spinning Co.*, 10 P. O. R. 39.

(*s*) Per Chatterton, V.-C., in *Pirrie* v. *York Street Flax Spinning Co.*, 10 P. O. R. 39; see also *Easterbrook* v. *Great Western Railway Co.*, 2 P. O. R. 201, 210.

(*t*) Per Lord Watson in *Morgan* v. *Windover*, 7 P. O. R. 136.

Utility, like novelty, is part of the consideration for a grant of letters patent, and if a material portion of the invention be useless, there is a **failure of consideration**, and the patent is altogether void (*u*), so, too, where a specification claims ability by means of one process to produce two or more things or effect two or more results, and fails in any one of them. The patent is void for falsity of suggestion, the Crown having been deceived in the grant (*x*); but want of utility in an immaterial part of a machine, which is not claimed as essential, will not vitiate a patent.

Lord Tenterden, C.J., in *Lewis* v. *Marling*, said: "I agree that if the patentee mentioned that as an essential ingredient in the patent article, which is not so, nor even useful, and whereby he misleads the public, his patent may be void; but it would be very hard to say that the patent should be void because the plaintiffs claim to be the inventors of a certain part of the machine not described as essential, and which turns out not to be useful" (*y*).

Tindal, C.J., in *Haworth* v. *Hardcastle*, said: "If the jury think it useful in the general, because some cases occur in which it does not answer, we think it would be much too strong a conclusion to hold that patent void" (*z*).

In that case part of the patentee's claim was for the application of the machinery described for drying calicoes, the said machinery being adapted for taking up and removing the said calicoes after being dried. At the trial it appeared that the machine failed in taking up certain cloths stiffened with clay.

Where an invention is as a whole useful, a very small amount of utility will be sufficient to support a second and **subsidiary**

(*u*) *Simpson* v. *Holliday*, L. R., 1 H. L. 315, 322; *Templeton* v. *Macfarlane*, 1 H. L. Ca. 595; *Turner* v. *Winter*, 1 Web. P. C. 77; *Morgan* v. *Seaward*, 2 M. & W. 544; *Bloxam* v. *Elsee*, 6 B. & C. 169; *Hill* v. *Thompson*, 1 Web. P. C. 232; 3 Mer. 622; *Lawrence* v. *Perry*, 2 P. O. R. 179; *The United Horsenail Co.* v. *Stewart*, 2 P. O. R. 132; *United Horseshoe & Nail Co.* v. *Swedish Horsenail Co.*, 6 P. O. R. 8.

(*x*) *Turner* v. *Winter*, 1 Web. P. C. 77; *Bloxam* v. *Elsee*, 6 B. & C. 169, 178.

(*y*) 10 B. & C. p. 25; see also *Morgan* v. *Seaward*, 2 M. & W. 544; *Haworth* v. *Hardcastle*, 1 Bing. N. C. 182; *United Horsenail Co.* v. *Stewart*, 2 P. O. R. 132; *United Horseshoe & Nail Co.* v. *Swedish Horsenail Co.*, 6 P. O. R. 8.

(*z*) 1 Bing. N. C. 190.

claim (*a*), and it does not show that the patent is bad because one of the methods claimed is preferred to the others (*b*).

Commercial success is strong and almost conclusive evidence of utility (*c*), though, as has been pointed out above, its absence is no proof of want of utility (*d*).

Kay, J., in *Lucas* v. *Miller* (*e*), said: "Better evidence of the utility of an invention cannot possibly be had than the fact that the defendant has attempted to infringe it."

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

(*b*) *Miller* v. *Scarle*, 10 P. O. R. 110; *Ehrlich* v. *Ihlee*, 5 P. O. R. 437, 455.

(*c*) *Cole* v. *Sequi*, 5 P. O. R. 495; *Ehrlich* v. *Ihlee*, 5 P. O. R. 205; *American Braided Wire Co.* v. *Thomson*, 5 P. O. R. 113; *Pirris* v. *York Street Flax Spinning Co.*, 10 P. O. R. 39.

(*d*) See ante, p. 72.

(*e*) 2 P. O. R. 160; see also *Morgan* v. *Windover*, 4 P. O. R. 422; *Miller* v. *Scarle*, 10 P. O. R. 111.

CHAPTER VII.

THE SPECIFICATION.

The third condition which supports the consideration for a valid patent is **that the patentee must publish his invention**, that is to say, that in the specification which he files, and which forms the basis of the description of the subject-matter of his patent, he must give such an account of his invention, of the way of working it, and of what he particularly claims, as to enable an ordinary skilled person to carry out the invention without further assistance or discovery. By the 5th section of the Act of 1883 it is provided :—

"(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* (a).

"(3) *A provisional specification must describe the nature of the invention, and be accompanied by drawings if required.*

(a) "Whereas sub-sect. 2 of s. 5 of the principal Act requires a declaration to be made by an applicant for a patent to the effect in that sub-sect. 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-sect. 2 of s. 5 of the principal Act may be either a statutory declaration under the Statutory Declarations Act or not, as may be from time to time prescribed." Patents, &c., Act, 1885, s. 2.

"(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* (*b*).

"(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.*"

Such are the provisions of the new Act in respect of the requirements of the specification. It leaves the law respecting the necessary disclosures to be made in the specification very much as it was before; and the changes which are made are more changes of practice than anything else.

The regulations dealing with the manner and the time in which a specification must be lodged, and the practice generally upon an application for a grant of letters patent, will be reserved for consideration in a subsequent chapter (*c*); for the present it is proposed to treat merely with the internal requirements of the specification, that is to say, the amount of disclosure which is required by the Crown, and which constitutes an important part of the consideration given by the patentee to the public in return for the monopoly granted to him.

The specification is the means which is provided by the state, whereby a patentee publishes his invention, that is, dedicates it to the public. We have observed that two descriptions of specifications are provided for, one called "provisional," and the other "complete"; the applicant for letters patent may, if he so pleases, in the first instance, file a complete specification, or he may file a specification which, for want of a better word, has been described as provisional; subsequently, and within the prescribed time, filing a complete specification, which particularly describes

(*b*) By the Patents, &c., Act, 1886, s. 2, it is provided: "The requirement of sub-sect. 4 of s. 5 of the Patents, &c., 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."

(*c*) Chap. VIII.

and ascertains his invention. It is only necessary, however, that the provisional specification should describe the nature of the invention; and although it is not absolutely necessary that full details should be given as to the method of working the invention, care should be taken to ascertain to what extent and in what direction the invention goes.

There are three things in the specification which must agree with each other—the title, the provisional specification, and the complete specification.

THE TITLE.

The title of the specification must disclose the object of the invention (*d*).

The title is a part of the specification, and should be read into it so that it may limit the patentee's claim, which otherwise would be too large (*e*).

In the case of *Rex* v. *Else* (*f*), the title of the patent was held to contain the claim, there being no other claim.

The title must not be inconsistent with the specification, that is to say, it must not embrace an invention substantially different, neither more nor less extensive than that disclosed by the specification. For instance, a man who had invented a new street lamp, and described his invention in the title as being "a method or methods of more completely lighting cities, towns and villages," was held to have vitiated his patent by going too far in his title. His claim should have been for a new or improved street lamp (*g*). So care must be taken that an improvement in buttons, for instance, is not described as an improvement in the manufacture of buttons; if the improvement is in the article, it must be so stated, and if in the process, likewise. In *Campion* v. *Benyon* (*h*) the title was "a new and improved method of making and manufacturing double canvas

(*d*) *Household Co.* v. *Neilson*, 1 Web. P. C. 678.

(*e*) *Newton* v. *Vaucher*, 21 L. J., Ex. 308; *Neilson* v. *Harford*, 1 Web. P. C. 312, 373; *Oxley* v. *Holden*, 8 C. B., N. S. 666; 30 L. J., C. P. 68; *Lister* v. *Norton*, 3 P. O. R. 203.

(*f*) 1 Web. P. C. 76.

(*g*) *Cochrane* v. *Smethurst*, Dav. P. C. 354; 2 Coop. Ch. Cas. 57; 1 Stark. R. 205.

(*h*) 6 B. Mo. 71.

and sail cloth with hemp and flax, without any starch whatever;" the title, therefore, described an invention, the novelty and utility of which was to omit the use of starch, but upon reading the specification we find that the real invention was an improved mode of twisting the threads to be applied to the making of unstarched cloth, the patent was held bad. In the case of *Bloxam* v. *Elsee* (*i*) the title for the invention was for a machine for "making paper in single sheets without seam or joining from 1 to 12 feet and upwards wide, and from 1 to 45 feet and upwards in length." It was found that to vary the width of the paper it was necessary to have a different machine, and that consequently the title did not correspond with the invention, and the title was held bad. In *Felton* v. *Greaves* (*k*), the title was "a machine for an expeditious and correct mode of giving a fine edge to knives, razors, scissors and other cutting instruments." The machine would not sharpen scissors:—Held bad.

In *Croll* v. *Edge* (*l*) the title was for "improvements in the manufacture of gas for the purpose of illumination, and in apparatus *used therein*, and when transmitting and measuring gas," an important part of the patentee's claim consisted in a new mode of manufacturing clay retorts, an apparatus used in the manufacture and not in the transmitting and measuring of gas:—Held, that there was fatal inconsistency, the specification being substantially wider than the title.

These cases seem to have been decided upon the ground that an incorrect or too extensive title is evidence of fraud upon the Crown. For instance, in *Brunton* v. *Hawkes* (*m*), Best, J., said: "That the patent was taken out for more than the patentee was entitled to, that, in my opinion, avoids the patent *in toto*, for the king is deceived."

Mere vagueness in the title is not a fatal objection to a patent, provided that it is sufficiently explained by the specification.

(*i*) *Bloxam* v. *Elsee*, 6 B. & C. 169.

(*k*) 3 C. & P. 611; see also *Rex* v. *Wheeler*, 2 B. & Ald. 345; *Rex* v. *Metcalf*, 2 Stark. R. 249.

(*l*) 9 C. B. 479; 19 L. J., C. P. 261.

(*m*) 4 B. & Ald. 558; see also *Rex* v. *Wheeler*, 2 B. & Ald. 345; *Morgan* v. *Seaward*, 2 M. & W. 544; 6 L. J., Ex. 153; *Bloxam* v. *Elsee*, 1 Car. & P. 558; 6 B. & C. 169; 3 L. J. (O. S.), Q. B. 93.

In *Cook* v. *Pearce* (*n*), Tindal, C.J., in the Exchequer Chamber, said: "This was an action on the case against the defendant for the infringement of a patent taken out by the plaintiff for improvements in carriages. The 6th plea, after setting out the specification, averred that 'although the said alleged invention in the declaration of letters patent respectively mentioned is therein styled and described as improvements in carriages, yet the said invention in truth, and in fact, is not an invention of improvements of carriages generally, but certain alleged improvements in the fixing and adapting of German shutters in those carriages only in which German shutters are used, and that German shutters cannot be used in divers and very many carriages, to wit, coaches, &c.,' and so the defendants say that the title of the said invention is too large and general, and by reason thereof the said letters patent are void and of no force. . . . . It has been observed that the decision (in the Court below) does not proceed upon the ground that the title of this patent must be held of necessity to claim more than the invention as explained by the specification, as if the title had been 'an invention and improvement of *all* carriages,' and the specification had limited the invention to the improvement of one or more species of carriages only, or if the title had been for the invention of two things, and the specification had shown it to be an invention of one only out of the two; in such cases it may be readily admitted that the patent would be void, in the first, because there was no specification enrolled agreeing with the title, and in the second, upon the principle laid down by Mr. Justice Bayley, in his judgment in *Brunton* v. *Hawkes*: 'that the entire discovery of all the things for which the patent was taken out may be held to be the consideration upon which the patent was granted by the Crown;' but such an objection would not apply to the case now before us, for the words 'improvements in carriages' do not necessarily imply in all carriages, but in their ordinary use may well be held to be satisfied by an invention for improvements in some carriages only, but the ground of the decision is as before stated confined to the vagueness and

(*n*) 8 Q. B. 1054, 1062.

generality of the title, and to that only. Now the mere vagueness of the title appears to us to be an objection that may well be taken on the part of the Crown before it grants the patent, but to afford no ground to avoid the patent after it has been granted. If such title did not agree with the specification when enrolled, or if there had been any fraud practised on the Crown in obtaining the patent with such title, the patent in those cases might undoubtedly be held void. . . . . We think it would be unsafe to lay down the rule in terms so large as it appears to have been adopted by the Court below, for that it would endanger the validity of very many patents which had hitherto been free from exception, if every patent must be held to be void simply on the ground that its title was conceived in such terms as to be capable of comprising some other invention besides that contained in the specification in the absence at the same time of any proof of an intention to commit any fraud upon the Crown, or of deceiving or misleading the public" (*o*). It will be seen, therefore, that although variance between the title and the specification is held to vitiate the patent as in *Felton* v. *Greaves*, that mere excess and generality in the title will not vitiate the patent in the absence of any evidence of fraud upon the Crown (*p*).

In *Neilson* v. *Harford* (*q*), Abinger, C.B., said: "If the specification is consistent with the title, that would be sufficient;" and Baron Parke said, "The title of the patent is for the improved application of air, though that is ambiguous. It is sufficiently explained by the specification, and is not at variance with it."

Purely technical objections to a title have been held not to affect a patent; in *The Electric Telegraph Co.* v. *Brett* (*r*) the

(*o*) This decision was followed in *Crossley* v. *Potter* by Pollock, C.B. See Macr. P. C. 242.

(*p*) *Nickels* v. *Haslam*, 7 M. & G. 378, 385; *Slurtz* v. *De La Rue*, 5 Russ. 322; *Neilson* v. *Harford*, 1 Web. P. C. 295; *Morgan* v. *Seaward*, 1 Web. P. C. 196; *Stead* v. *Williams*, 2 Web. P. C. 137; *Hills* v. *London Gas Co.*, 5 H. & N. 312.

(*q*) 1 Web. P. C. 333.

(*r*) 10 C. B. 838; see also *Fisher* v. *Dewick*, cited 8 Q. B. 1056; *Derosne* v. *Fairie*, 5 Tyr. 393; *Beard* v. *Egerton*, 2 Car. & K. 667; 3 C. B. 97; *Pirrie* v. *York St. Flax Spinning Co.*, 10 P. O. R. 45.

title of the plaintiff's patent was an "Invention of improvements in giving signals and sounding alarums in distant places *by means of electric currents transmitted through metallic circuits.*" Subsequently to the date of this patent it was discovered that the earth would complete the circuit and render a return wire unnecessary; this was the method employed by the defendants in working their apparatus, and it was argued by them that so long as they did not employ a metallic circuit throughout, they could not infringe the patent of the plaintiffs; metallic circuits, although mentioned in the title, were not a condition necessary to the existence of the improvements claimed by the plaintiffs in their specification, and it was held that this objection could not be sustained.

Cresswell, J., in his judgment in the Court of Common Pleas, said (*s*): "It appears to us reasonable to hold that a claim for a patent for improvements in the mode of doing something by a known process is sufficient to entitle the claimant to a patent for his improvements, when applied either to the process as known at the time of the claim, or to the same process altered and improved by discoveries not known at the time of the claim, so long as it remains identical with regard to improvements claimed and their application."

The question of variance between the title and the specification is one upon which the decided cases can have but little bearing. All that can be gleaned from previous decisions of the Courts is that variance is a fatal blemish; but in the immense variety of inventions it is evident that the same variance will never occur in any two cases, and it will be a question for the Court in each individual case that comes before it to decide whether, in that case, the specification and the title vary or differ from each other; and although the decided authorities will be of assistance to the Court in showing to what extent variance has been held in prior cases to vitiate the patent, no prior decision will be absolutely binding (*t*).

(*s*) 10 C. B. 881.

(*t*) *Bainbridge* v. *Wigley*, Higgins' Digest, 155; *Hill* v. *Thompson*, 1 Web. P. C. 239; *Nickels* v. *Haslam*, 13 L. J. C. P. 146; *Croll* v. *Edge*, 9 C. B. 479; *Wright* v. *Hitchcock*, L. R., 5 Ex. 37.

THE PROVISIONAL SPECIFICATION.

It was found that application for letters patent, being made merely upon the title of an invention, caused a great deal of inconvenience and uncertainty, therefore, by the Patent Law Amendment Act, 1852, the provisional specification was created. Prior to the passing of that Act, applicants for letters patent, when they made their application, merely deposited the title of their invention. By sect. 6 of that Act a provisional specification was required, which should give some more definite information as to the nature of the invention for which protection was sought than could be possibly given in a mere title.

"The whole object of provisional protection is to enable a patentee to work at and improve his invention without risk of invalidating his patent by premature publication or user (see 46 & 47 Vict. c. 57, s. 14). 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" (*u*)

It is very difficult to clearly define the distinction between that which is absolutely necessary in the provisional specification and that which is absolutely necessary in a complete specification. In *Woodward* v. *Sansum* (*x*) the Court of Appeal held that all a patentee need do in his provisional specification is to describe his invention. He need not go on therein to describe any method of carrying out the invention, but, whether he do so or not, if a different or further mode of carrying out the invention is described in his complete specification that will not invalidate the patent so long as such new method of carrying out is fairly within the invention as described in the provisional specification. In *Moseley* v. *Victoria Rubber Co.* (*y*), Chitty, J. laid it down that the object of a provisional specification is only to describe generally and fairly the nature of the invention, and not to enter into all the minute details of the complete specification.

(*u*) Per Lindley, L.J., in *Gadd* v. *Mayor, &c., of Manchester*, 9 P. O. R. 526; see also *Stoner* v. *Todd*, L. R., 4 Ch. D. 59; *Ex parte Bates and Redgate*, L. R., 4 Ch. 577.

(*x*) 56 L. T. 347; 4 P. O. R. 166, 174.

(*y*) 4 P. O. R. 241, 251; 57 L. T. 142.

Sect. 8 of the Act of 1852, to which we have referred, says that "the law officer must be satisfied that the provisional specification describes the nature of the invention," and we have seen that the exact words of that section are retained in sub-sect. 3 of sect. 5 of the Act of 1883; and probably the Legislature had in view the desirability of retaining the effect of the numerous valuable decisions of the Courts of law upon the construction which should be placed upon what is a sufficient description of the nature of the invention. It will be observed that the complete specification to which we shall refer at greater length hereafter must not only describe the nature of the invention, but must also *ascertain* the nature of the invention and in what manner it is to be performed; but both a provisional specification and a complete specification must commence with a title, and the complete specification must conclude with a distinct statement of the invention claimed (*z*).

The cases which we have quoted, and which were decided prior to the year 1852, as to the fatal nature of a variation between the title and the specification, will apply equally to the consideration of a variance between a provisional and a complete specification. It is evident, however, that the object of the Legislature in creating a provisional specification, and founding upon it a period of provisional protection, was to enable the inventor in that interval to improve and perfect his invention, and to clearly ascertain what was new and what was old in that which he proposed to patent. That being so, it is obvious that it could not have been the intention of the Legislature that, when framing a complete specification, the inventor should be bound to follow implicitly every detail which he had given in his provisional specification, or that he should be prevented from adding to or subtracting from his invention; for, in that case, the object of the Legislature would be defeated.

In *Newall* v. *Elliott* (*a*), Pollock, C.B., said: "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 a patent, to give some

(*z*) Post, p. 90, *et seq.*

(*a*) 10 Jur., N. S. 955.

notion of what his invention is; that has been followed by Act of Parliament, requiring it to be done; but the object in both cases is to ascertain the identity of the invention, and 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." Baron Channell in the same case, at p. 960, describes a provisional specification as a "short note or minute of that which was ultimately disclosed in the full specification." It will be observed that in the cases to which we drew attention upon the subject of variance between title and specification, the point always was as to whether the title and the specification varied in the description of the **nature** of the invention; and the same principle holds good when considering the variation between the provisional and complete specification, the question always is, Do they differ in their description of the nature of the invention? In *Newall* v. *Elliott* (*b*), Byles, J., said: "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" (*c*).

Lord Chelmsford, in *Penn* v. *Bibby* (*d*), said: "The relation which the provisional specification bears to the complete specification is much the same as that which before the Patent Law Amendment Act a title bore to the specification . . . . . the only objection then which is open upon the complete specification, is whether it is sufficient in itself, and whether it agrees with the provisional specification. Now, by 'agreement' is not meant a

(*b*) 4 C. B., N. S. 269, 293.

(*c*) See also *Siddell* v. *Vickers*, 5 P. O. R. 99, 416, 426; 7 P. O. R. 292; L. R., 39 Ch. D. 92, 97; L. R., 15 App. Cas. 496; *Stoner* v. *Todd*, L. R., 4 Ch. D. 58, 59; *United Telephone Co.* v. *Harrison*, L. R., 21 Ch. D. 720 746.

(*d*) L. R., 2 Ch. 127, 133.

perfect correspondence, but merely that there shall be nothing in the complete specification at variance with the provisional." The learned Lord Chancellor then proceeds to quote *Newall's case*, to which we have referred, and proceeds: "Nor is it at all necessary that the specification should extend to everything comprehended in the provisional specification. Perhaps a better illustration of this proposition could not be given than that which was offered in the course of the argument. If the patentee were to introduce into his complete specification everything which was warranted by the terms of the provisional specification, and afterwards found that a part of that which he had claimed would invalidate his patent for want of novelty, or for any other reason, he might afterwards cure the objection by a disclaimer. Now if he would be allowed to disclaim in such a case, which is a matter of indulgence, he must have a right to waive his claim to any portion of the grant which the allowance of the provisional specification had entitled him to demand. It is clear, therefore, that unless a complete specification in this case claims something *different* from the provisional specification, the objection to the patent under consideration cannot prevail."

In the absence of fraud, any part, whether in the description or the claim of the provisional specification, may be omitted in the complete specification without the necessity of any disclaimer (*e*). In *Stoner* v. *Todd* (*f*), Jessel, M.R., said: "I must consider first the nature of a provisional specification, and the effect of a provisional specification on a final specification of the same invention. A provisional specification was never intended to be more than a mode of protecting an inventor, until the time of filing a final specification; it was not intended to contain a complete description of the thing so as to enable any workman of ordinary skill to make it, but only to disclose the invention, fairly no doubt, but in its rough state; until the inventor could perfect its details, the provisional specification as such is not and cannot be known to the public. It is never

(*e*) *Thomas* v. *Welch*, L. R., 1 C. P. 192; see also the remarks of Lord Chelmsford in *Penn* v. *Bibby*, quoted above; *Re Everitt's Patent*, Griff. L. O. C. 27.

(*f*) L. R., 4 Ch. D. 58.

published unless with the final specification, when they become parts of the same document."

Lord Justice Lopes, in *Woodward* v. *Sansum* (*g*), 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 within what I may call the ambit of his invention as disclosed in his provisional specification. Provided that this is done, it is no objection that in the complete specification an invention is described more particularly and in more detail, nor to use the words of Lord Blackburn in *Bailey* v. *Roberton* (*h*), '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.' It is essential that the nature of the invention shall 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."

In the same case, Cotton, L.J., said (on p. 175): "A patentee putting in a provisional specification showing the nature of his invention is not bound to describe the way in which that can be carried into effect and operation, but if he does describe a way of doing it, and before he files his complete specification, he either finds out improvements in that way or a different way of carrying

(*g*) 4 P. O. R. 178; see also per Fry, L.J., in *Crampton* v. *The Patents Investment Co.*, 6 P. O. R. 294, 295; also *Lucas* v. *Miller*, 2 P. O. R. 155; Griff. P. C. 156; *Watling* v. *Stevens*, 3 P. O. R. 147, 151; *Moseley* v. *Victoria Rubber Co.*, 4 P. O. R. 248; *Siddell* v. *Vickers*, 5 P. O. R. 99, 426, 427; *Gadd* v. *Mayor, &c. of Manchester*, 9 P. O. R. 526; *Miller* v. *Scarle*, 10 P. O. R. 111.

(*h*) L. R., 3 App. Cas. 1055, 1075.

into effect that which is described as his invention in the provisional specification, he is bound to give the public the benefit of what he has discovered as regards the mode of carrying the invention, the nature of which must be described in the provisional specification, into effect, *even although there may be improvement, and even invention which was not known to him at the time*" (*i*).

But if the improvements discovered by the inventor between the dates of filing his provisional and complete specifications are of such a character as to amount to a new invention a fresh patent must be taken out, since, should the patentee incorporate such improvements in his complete specification, his patent would be rendered void on the ground of variance (*k*).

In the case of *Bailey* v. *Roberton* (*l*), decided in the House of Lords, the provisional specification stated the object of the invention to be the preserving of animal substances in the fresh state, and the patentees claimed the use of a solution composed of a certain quantity of gelatine mixed with bisulphite of lime, but in the complete specification they claimed as solution No. 1 a solution composed of bisulphite of lime alone, and gave no direction how this solution was to be used. Bisulphite of lime had been used by a prior patentee. In the action for infringement against the defendants who had used bisulphite of lime pure and simple, it was held that the complete specification, if large enough to cover the employment of bisulphite of lime for the preservation of animal substances as practised by the defenders, would claim an invention larger than and different from that disclosed in the provisional specification. It will be observed that in this case the invention, which was described in the provisional specification, was the coating of animal substances with a film of a mixture of gelatine and bisulphite of lime; the complete specification claimed the dipping of the animal substance into a solution of bisulphite of lime in water; it is apparent,

(*i*) See also *Crampton* v. *The Patents Investment Co.*, 5 P. O. R. 397; *Crossley* v. *Beverley*, 9 B. & C. 64; *Moseley* v. *Victoria Rubber Co.*, 4 P. O. R. 248; 57 L. T. 142; *Miller* v. *Scarle*, 10 P. O. R. 111.

(*k*) *Edison* v. *Woodhouse*, L. R., 32 Ch. D. 520; *Penn* v. *Bibby*, L. R., 2 Ch. 127, 133.

(*l*) L. R., 3 App. Cas. 1055.

therefore, to anyone acquainted with the action of antiseptic substances upon animal decomposition, that the operation of a film of gelatine with bisulphite of lime is entirely different from the operation of a solution of bisulphite of lime; it is a totally different idea, and therefore a different invention; the complete specification, therefore, was not an extension, curtailment or modification of the provisional specification, but was a description of a totally different invention, and so it was held bad for variance (*m*).

Thus we see that the **provisional specification is a mere extension of the title**; but since variance between the title and the specification vitiated the patent before the inauguration of the provisional specification, variance between the provisional and complete specification also vitiates a patent (*n*), but it is quite open to a patentee to extend, improve or curtail the claim which he has made in his provisional specification when he comes to file his complete specification. A patent is not rendered invalid by the fact that the complete specification describes something different from anything specifically referred to in the provisional specification, provided that what is so described comes within the nature of the invention described in general terms in the provisional specification (*o*).

In *Gadd* v. *Mayor, &c., of Manchester* (*p*), Lindley, L.J., said: "Even under the present law the Court may be driven to hold a patent invalid on the ground that the invention described and claimed in a complete specification is not the same as that provisionally protected; but having regard to the provisions made for the comparison of the two documents by an official

(*m*) See also *Nuttall* v. *Hargreaves*, 8 P. O. R. 450; L. R., 1892, 1 Ch. D. 23; *Foxwell* v. *Bostock*, 4 De G. J. & S. 298; *United Telephone Co.* v. *Harrison*, L. R., 21 Ch. D. 720; *Horrocks* v. *Stubbs*, 3 P. O. R. 221, 233, 236; *Hutchison* v. *Pattullo*, 5 P. O. R. 351, 362; *King* v. *The Anglo-American Brush Co.*, 6 P. O. R. 414; 7 P. O. R. 436; *In the Matter of Gaulard and Gibbs Patent*, 6 P. O. R. 215; 7 P. O. R. 367; *Lane Fox* v. *Kensington and Knightsbridge Electric Lighting Co.*, 9 P. O. R. 221, 238, 413, 420; L. R., 1892, 2 Ch. 66, 88; L. R., 1892, 3 Ch. 424; *Cera Light Co.* v. *Dobbie*, 11 P. O. R. 10, 16.

(*n*) *Nuttall* v. *Hargreaves*, 8 P. O. R. 456; L. R., 1892, 1 Ch. 23.

(*o*) *Siddell* v. *Vickers*, L. R., 39 Ch. D. 92.

(*p*) 9 P. O. R. 527.

examiner (see 46 & 47 Vict. c. 57, s. 9, and 51 & 52 Vict. c. 50, s. 4), the Court ought not to decide against the validity of a patent on the ground in question, unless the two inventions are unmistakeably different. If a case is on the border line, the patent ought to be held good rather than bad."

THE COMPLETE SPECIFICATION.

We now come to the more important subject of the requirements of a complete specification. The complete specification is, as we have seen, one of the essential considerations which the patentee gives for the grant which is made to him. **It is the disclosure of his invention, and of the mode of performing it.** It contains the information which he is bound to give to the public. That information must be *bonâ fide*, full, complete, and unambiguous; it must disclose the invention, the nature of it, the intention of it, the way of performing it, and an exact statement of what is claimed by the patentee (*q*).

These conditions are imposed by the common law; they were maintained intact by the Statute of Monopolies, by the Patent Law Amendment Act, 1852, and are now specifically re-enacted in the Act of 1883.

The specification must be **sufficient**—that is, it must give a sufficient description of the invention to enable a person skilled in the art to which it refers to perform the invention from the description which it gives. It must be *bonâ fide*—there must be no reserve on the part of the inventor. He must disclose what he knows; he must conceal nothing, and thus he must give to the public the full benefit of his invention.

As has been pointed out above (*r*), an inventor is bound to disclose in his complete specification any improvement that he may have discovered relating to his invention during the period of provisional protection; but if such fresh discoveries amount to another invention or consist merely in a **better way of using his invention** as described in his provisional specification, he is not

(*q*) As to required conformity between provisional and complete specification, see "The Provisional Specification," supra.

(*r*) See "The Provisional Specification," supra.

required to give the public this further information in his complete specification.

In *Edison and Swan Electric Light Co.* v. *Woodhouse* (*s*), a patent dated as to its provisional specification, November, 1879, and as to its final specification, 10th May, 1880, claimed an electric lamp with a carbon filament for its illuminating conductor. The patentee took out a subsequent patent, dated as to its provisional specification, December, 1879, for a method of making carbon filaments for electric lamps. Objection was taken that inasmuch as at the time of filing the complete specification of the first patent the patentee knew the subject-matter of the second, he should have included it in the first, and that therefore the first patent was bad by reason of concealment. This objection was overruled.

In *Coles* v. *Baylis* (*t*), the invention was for "Improvements relating to the preparation of lithographic printing surfaces." It was alleged by the defendant that the plaintiff was acquainted with an improved method of using the lithographic printing surfaces after they had been prepared by the patented process, but that he had not disclosed the same in his specification, and that therefore the patent was bad. Bacon, V.-C., overruled the objection, and said:—"It is to be said that the specification . . . . is bad because he knew a mode by which a stone prepared according to the specification may be more conveniently or more usefully worked than anybody but himself knew, that he was bound to put that into the specification. I know no authority for saying that."

In *Harmar* v. *Playne* (*u*), Lord Ellenborough said:—"The object of requiring the specification to be enrolled seemed to be to enable persons of reasonable intelligence and skill in the subject-matter to tell from an inspection of the specification itself what the invention was for which the patent was granted, and how it was to be executed." In *Morgan* v. *Seaward* (*x*), Baron Alderson said:—"The patentee ought to state in his specification the precise way of doing it (referring to the invention); if it

(*s*) L. R., 32 Ch. D. 520.
(*t*) 3 P. O. R. 178; Griff. P. C. 57.
(*u*) Dav. P. C. 316.
(*x*) 1 Web. P. C., at p. 182.

cannot completely be done by following the specification, then a person will not infringe the patent by doing it. If this were an infringement, it would be an infringement to do that perfectly, which, according to the specification, requires something else to be done to make it perfect. If that be correct, you would prevent a man from having a perfect engine. He says, practically speaking, the difference in the length of the rods would not be very material, the difference being small. But the whole question is small, therefore it ought to have been specified, and if it could not be ascertained fully it should have been so stated." We quote this decision at length, because the exposition of the law which it contains is still absolutely correct. The subsequent cases have implicitly followed the judgment of Baron Alderson (*y*).

In *Cartwright* v. *Eamer* (*z*), Lord Eldon said:—"The patent is to be considered as a bargain with the public, and the specification, therefore, is to be construed on the same principle of good faith as that which regulates all other contracts. If, therefore, the disclosure be such that the invention can be communicated to the public, the statute is satisfied."

In the case of *The King* v. *Arkwright* (*a*), Mr. Justice Buller said:—"The public have a right to a fair, full, and true description of the invention in the specification."

It is incumbent on a patentee to give a specification of his invention in the fairest and most unequivocal terms of which the subject is capable (*b*). In the same case, Mr. Justice Buller said:—"Many cases upon patents have arisen within our memory, most of which have been decided against the patentees upon the ground of their not having made a full and fair discovery of their inventions. Whenever it appears that the patentee has made a fair disclosure I have always had a strong bias in his favour, because in that case he is entitled to the protection which the law gives him." In *Newbery* v. *James* (*c*), Lord

(*y*) See *Neilson* v. *Thompson*, 1 Web. P. C. 278.

(*z*) Cited 14 Vesey, 131, 136.

(*a*) 1 Web. P. C. 72; Dav. P. C. 61.

(*b*) Per Ashurst, J., in *Turner* v. *Winter*, Dav. P. C. 151; 1 Web. P. C. 80.

(*c*) 2 Mer. 451; see also *Sturtz* v. *De La Rue*, 5 Russ. 322; 7 L. J., O. S., Ch. 47.

Eldon said:—"In order to support a patent, the specification should be so clear as to enable all the world to use the invention as soon as the term for which it was granted was at an end."

We have next to consider the bearing of the different decisions upon the question of **what amounts to sufficiency** in a specification. It is always a question of fact whether the specification is sufficient or not, taking care to distinguish between sufficiency of description and an attempt to cover too much—it is for the jury (that is, it is a question of fact) to say whether from the description given the invention could be carried out. It is for the Court to determine whether the inventor has claimed that which is not new among that which is new (*d*). The question of the sufficiency of the specification is a question for the jury (*e*).

The **intelligibility** of the specification is a question for the jury (*f*). The **construction** of the specification is in the same manner as the construction of all documents—a question of law. The duty of the judge at Nisi Prius is to tell the jury the specification says so-and-so, placing a meaning upon the different words used and the different sentences used in the specification. It is then for the jury to say it is intelligible or it is not, it is sufficient or it is not sufficient, but the Court will determine in all cases whether or not the patent is defective by reason of the patentee having endeavoured to describe or to claim too much (*g*).

We will deal with these different heads in their natual order, first, as to **construction**, next as to intelligibility, and then as to sufficiency.

The leaning of the Courts is invariably in favour of the patentee, and specifications will **not be construed astutely** so as to overthrow a patent. Sir George Jessel, in the case of *Hinks* v. *The Safety Lighting Co.* (*h*), said "I am anxious, as I believe

(*d*) *Hill* v. *Thompson*, 3 Mer. 626; *Seed* v. *Higgins*, 8 H. L. C. 561.

(*e*) *Bickford* v. *Skewes*, 1 Q. B. 938; *Wallington* v. *Dale*, 7 Exch. 888; *Parkes* v. *Stevens*, L. R., 8 Eq. 358.

(*f*) *Neilson* v. *Harford*, 1 Web. P. C. 295; *Walton* v. *Bateman*, 1 Web. P. C. 613, 619.

(*g*) *Hill* v. *Thompson*, 3 Mer. 626; *Beard* v. *Egerton*, 19 L. J., C. P. 38; *Hills* v. *Evans*, 31 L. J., Ch. 460; *Seed* v. *Higgins*, 8 H. L. C. 565; *Neilson* v. *Harford*, 1 Web. P. C. 370.

(*h*) L. R., 4 Ch. D. 612.

every judge is who knows anything of patent law, to support honest *bond fide* inventors who have actually invented something novel and useful, and to prevent their patents being overturned on mere technical objections or on more cavillings with the language of their specifications, so as to deprive the inventor of the benefit of his invention; that is sometimes called a benevolent mode of construction, perhaps that is not the best term to use, but it may be described as construing the language of the specification fairly, with a judicial anxiety to support a really useful invention, if it can be supported by a reasonable construction of a patent; beyond that the benevolent mode of construction does not go." And the same judge, in *Plimpton* v. *Spiller* (*i*), adopted the remark that "the judge is not to be astute to find flaws in small matters in a specification with a view to overthrow it."

In *Needham* v. *Johnson* (*k*), 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."

In *Otto* v. *Linford* (*l*), Jessel, M.R., said, "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, 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."

Lord Esher, M.R., in *Nobel's Explosive Co.* v. *Anderson*, said (*m*): "It is quite true that the Court has in this specifica-

(*i*) L. R., 6 Ch. D. 422.
(*k*) 1 P. O. R. 58.
(*l*) 46 L. T., p. 39.
(*m*) 11 P. O. R. 524; see also on this point *Russell* v. *Cowley*, 1 Web. P. C. 457; 1 Cr. M. & R. 864; *Hallett* v. *Hague*, 2 B. & Ad. 377: *Palmer* v. *Wagstaffe*, 9 Exch. 494, 501; *Thomas*

tion, as in every other, to put upon it the most favourable construction which it honestly can in favour of the patentee. What does that involve? If the Court does not take care to confine the patentee's patent within its legitimate limits the Court will hold the patent to be such as would render it void. Therefore they must take care not to stretch his claim, otherwise they may by their construction make the patent void. They must not diminish the claim, limit it too tightly, or they may make his patent worthless. Then they have to come to really what is the honest business conclusion of the meaning of what is written down. That is what they have to do."

In the same case Lord Esher said (p. 523): "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 it be a valuable patent or a patent for the smallest thing, or whether it be 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."

Lord Chelmsford, in *Harrison* v. *Anderston Foundry Co.* (*n*), said: "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." In *Clark* v. *Adie* (*o*) it was held that the words used in the specification must be construed like the words in any other instrument, in their natural sense, according to the general purpose of the instrument in which they are found.

When two documents such as specifications are before the Court for comparison, the Court must interpret the meaning of

v. *Foxwell*, 6 Jur., N. S. 272; *Binney* v. *Feldtman*, Griff. P. C. at p. 50; *Cropper* v. *Smith*, Griff. P. C. 62; 1 P. O. R. 88; *Automatic Weighing Machine Co.* v. *Knight*, 6 P. O. R. 307; *Edison* v. *Smith*, 11 P. O. R. 400.

(*n*) L. R., 1 App. Cas. 581.

(*o*) L. R., 2 App. Cas. 423; *Dudgeon* v. *Thompson*, L. R., 3 App. Cas. 53; *Wegmann* v. *Corcoran*, L. R., 13 Ch. D. 77.

the words, but the jury must say if they are identical (*p*). It is evident that, inasmuch as technical expressions are used in different trades and businesses, and that it is impossible for one person to be acquainted with every trade and every business, and every technical expression used in such trade and business, it is not necessary that the specification should be intelligible to any one, it is sufficient that it should be intelligible to a person reasonably skilled in the trade to which it particularly refers, and it must be intelligible to them without the necessity of their making new inventions of their own or additions to the specification or experiments (*q*).

The Court will receive evidence for the purpose of determining the exact sense in which the patentee made use of words and technical terms in his specification (*r*), but it will not consider what the patentee says he meant or intended, if a competent person of ordinary intelligence would on reading the specification understand the language and words in a different sense, since it is to such that the specification is addressed and upon the interpretation of such persons that it is to be construed (*s*); except as to the meaning of scientific terms or as to the working of mechanical appliances or as to what will be the result of working mechanical appliances, or for the purpose of ascertaining the state of public knowledge at the date of the patent, expert evidence is inadmissible in determining the construction of a specification (*t*).

There are numerous authorities which bear out the general rule of construction which has been laid down, viz., that a specification of an invention must be construed by the same rules and

(*p*) *Betts* v. *Menzies*, 10 H. L. C. 117; *Muntz* v. *Foster*, 2 Web. P. C. 107; *Tetley* v. *Easton*, Macr. P. C. 68; but see *Bush* v. *Fox*, 5 H. L. C. 707; *Booth* v. *Kennard*, 2 H. & N. 84; also *Hills* v. *Evans*, 31 L. J., Ch. 457.

(*q*) *R.* v. *Arkwright*, 1 Web. P. C. 66; but see *The Badische Anilin und Soda Fabrik* v. *Levinstein*, 4 P. O. R. 467; L. R., 12 App. Cas. 710; *Edison* v. *Holland*, 6 P. O. R. 282.

(*r*) *Elliott* v. *Turner*, 2 C. B. 446; *Neilson* v. *Harford*, Web. P. C. 295, 313; *Hills* v. *Evans*, 31 L. J., Ch. 457; *British Dynamite Co.* v. *Krebs*, Good. P. C. 92; *Gadd* v. *Mayor, &c., of Manchester*, 9 P. O. R. 530.

(*s*) *Kaye* v. *Chubb*, 4 P. O. R. 289, 302; *Edison* v. *Woodhouse*, 4 P. O. R. 108.

(*t*) *Gadd* v. *Mayor, &c., of Manchester*, 9 P. O. R. 530; *Parkinson* v. *Simon*, 11 P. O. R. 506.

upon the same principles that are applied to other written documents, and if, on the one hand, minute cavilling at the words of a specification is not to be allowed as against a patentee, so, on the other hand, the interpretation must not be strained in favour of a patentee.

The patentee is to be presumed not to claim things which he must have **known** perfectly well **were not new** (*x*), but if upon a fair construction of the specification it is clear that he has claimed such old contrivance the patent will be void upon that ground.

In *Adie* v. *Clark* (*y*) Lord Blackburn said: "When it is attempted . . . . to say that inasmuch as these specifications show, or are alleged to show, that matters which upon a fair construction of the specification are claimed by the patentee, were old at the time that the patent was taken out, and were generally known to be old, therefore the specification must be so construed as not to include them; that seems to me both contrary, as far as I know, to the course of decision and contrary to principle."

A patent may be, as we have seen, for the application of a newly-discovered principle of manufacture or, for that of an old principle to a new object or, for a new method of carrying out an old principle applied to an old object. It frequently becomes a matter of construction upon the specification as to which of these branches of invention the specification is intended to apply, and there have been several cases upon the subject. It is evident that inasmuch as the patent will be valid provided a fair description of a new invention in either branch is given, that, in construing the specification of a patent a decided case upon some other specification will be of very little value. We do not propose, therefore, to discuss at length the constructions which have been placed upon specifications in particular cases. The words "improvements . . . . in the manner hereinafter mentioned," followed by a claim concluding with the words, "as above described," have been held to limit the claim to the particular machine described in the specification or to the particular method of carrying out the process and not to include

(*x*) *Haworth* v. *Hardcastle*, 1 Web. P. C. 484; *Oxley* v. *Holden*, 8 C. B., N. S. 666; *Cropper* v. *Smith*, 1 P. O. R. 85; *Lyon* v. *Goddard*, 10 P. O. R. 133.

(*y*) L. R., 2 App. Cas. 423, 437.

the principle of the process or any other method than that described of carrying it out (*z*).

In the case of *Hills* v. *London Gaslight Co.* (*a*), it was held, that where the meaning of a document depends upon its terms and not on matters of fact, dehors the document, the question will be for the judge, even although the terms are technical or scientific; and where an ambiguity is raised by evidence, dehors the document, which is plain upon the face of it, the ambiguity being as to a term which imports one thing in a scientific sense, and another in a commercial sense—Query, whether it is for the judge or the jury. We should venture to say, that it would undoubtedly be for the jury. The question not being one at all as to the construction of the document, but being as a matter of fact, did the writer of the specification use the scientific term or the commercial term? A specification is to be construed with reference to the state of knowledge at the time it is published (*b*).

In the construction of a specification, as in the construction of any other document, the Court **will read the whole** and endeavour to place an interpretation upon it which will be consistent with each part (*c*), and further, the Court will even look at the provisional specification for the purpose of ascertaining the real object of the invention disclosed in the complete; "for the object of the complete is to carry out in detail that which is more generally expressed in the provisional specification (*d*)."

The claims in specifications frequently claim the invention in a general manner with the words added "as herein described." It has been held that the meaning of the words "as herein described" is not limited where the invention is for a mode of

(*z*) *Barber* v. *Grace*, 1 Exch. 339; *The Plating Co.* v. *Farquharson*, Griff. P. C. 187.

(*a*) 27 L. J., Exch. 60.

(*b*) *Heath* v. *Unwin*, 22 L. J., C. P. 7; *The Badische Anilin und Soda Fabrik* v. *Levinstein*, L. R., 12 App. Cas. 710, 4 P. O. R. 449; *Ellington* v. *Clark*, 5 P. O. R. 325; *British Dynamite Co.* v. *Krebs*, Goodeves P. C. 91; *Nobel's Explosive Co.* v. *Anderson*, 11 P. O. R. 519, 523.

(*c*) *Newton* v. *Vaucher*, 6 Exch. 864; *Oxley* v. *Holden*, 8 C. B., N. S. 666; *Lister* v. *Norton*, 3 P. O. R. 203; *Edison* v. *Woodhouse*, 4 P. O. R. 107; *Parkinson* v. *Simon*, 11 P. O. R. 493, 507.

(*d*) Per Lord Esher, M.R., in *Parkinson* v. *Simon*, 11 P. O. R. 503.

construction or manufacture, and not for a particular method of carrying out the principle which is described in the specification. In *Betts* v. *Menzies* (*e*) Mr. Justice Blackburn, giving his opinion to the House of Lords, said, "I agree with what was said by Mr. Justice Crompton in the Court below that, if a general claim for the use of an invention were cut down and limited to the use of the invention in the particular way pointed out by reason of the words 'as herein described,' it will be a narrow rule of construction, generally working to the detriment of patentees, and, what weighs more with me, generally giving an effect to specifications different from what the persons drawing them intended or those reading them understand."

Another rule of construction is that the Court must give an effective meaning to every part of it, if it can.

Lord Esher, M.R., in *Parkinson* v. *Simon* said: "Now when you find a patent with several claims in it, you must, if you can, so construe those claims as to give an effective meaning to each of them. If there are several claims in the patent which are identical with each other, then some of them have no effect at all. It follows from the ordinary rule of construction that you must construe the different claims so as to make them effective if possible, to be different from each other in some respects, or else they are not effective (*f*)."

When a specification has once received a judicial construction the Court, in a subsequent action in respect of the same invention, will hold itself bound on that point by such previous decision (*g*), but fresh evidence may be adduced at the second action for the purpose of showing that that which before was not regarded as an anticipation, is so in fact (*h*).

In *Arkwright* v. *Nightingale* (*i*), Lord Loughborough, in charging the jury, said: "The clearness of the specification must be according to the subject-matter of it; it is addressed to the

(*e*) 10 H. L. C. 140.

(*f*) *Parkinson* v. *Simon*, 11 P. O. R. 502.

(*g*) *Edison* v. *Holland*, 6 P. O. R. 243, 276; *The Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*, 6 P. O. R. 367, 370.

(*h*) *Shaw* v. *Day*, 11 P. O. R. 189; see also *Edison* v. *Holland*, 6 P. O. R. 243, 277.

(*i*) 1 Web. P. C. 61.

persons in the profession having skill in the subject, not to men of ignorance, and if it is understood by those whose business leads them to be conversant in such subjects, it is intelligible." And in *Hornblower* v. *Boulton* (*k*), to which we have previously referred, Mr. Justice Grose said: "If the specification be such as to enable artists to adopt the invention and to make the manufacture, it is sufficient."

In *Harman* v. *Playne* (*l*), Lord Ellenborough graphically puts it: "No sort of specification would probably enable a ploughman utterly ignorant of the art to make a watch." But it is necessary that the specification should be in such terms as to enable persons of ordinary ability to understand it, and it will not be sufficient to show that one individual of extraordinary ability or of very exceptional technical knowledge is enabled to understand the specification (*m*). In *Neilson* v. *Harford* (*n*), Baron Parke puts it to the jury: "You are not to ask yourselves the question whether persons of great skill, a first-rate engineer, or a second-class engineer, as described by Mr. Farey, whether they would do it, because generally these persons are men of great science and philosophical knowledge, and they would, upon a mere hint in the specification, probably invent a machine which would answer the purpose extremely well; but that is not the description of persons to whom this specification is supposed to be addressed: it is supposed to be addressed to a practical workman, who brings the ordinary degree of knowledge, and the ordinary capacity, to the subject (*o*)."

Lord Justice Lindley, in *Edison* v. *Holland*, said (*p*): "In complying with the first condition, i.e., in describing the nature

(*k*) Dav. P. C. 228.

(*l*) Dav. P. C. 318.

(*m*) *Sturtz* v. *De La Rue*, 5 Russ. 327.

(*n*) 1 Web. P. C. 314.

(*o*) See also *Morgan* v. *Seaward*, 2 M. & W. 544; 1 Web. P. C. 167; 6 L. J., Ex. 153; *Gibson* v. *Brand*, 1 Web. P. C. 627; *Wallington* v. *Dale*, 7 Exch. 888; 23 L. J., Exch. 49; *Plimpton* v. *Malcolmson*, L. R., 3 Ch. D. 568; *Badische Anilin und Soda Fabrik* v. *Levinstein*, 4 P. O. R. 449; L. R., 12 App. Cas. 710; *Edison* v. *Woodhouse*, 4 P. O. R. 79; *Bray* v. *Gardner*, 4 P. O. R. 406; *Miller* v. *Scarle*, 10 P. O. R. 111.

(*p*) 6 P. O. R. 280; see also *Arkwright* v. *Nightingale*, 1 Web. P. C. 60; *Beard* v. *Egerton*, 8 C. B. 165, 206; *Otto* v. *Linford*, 46 L. T., N. S. 35, 40.

of his invention, the patentee does all that is necessary, if he makes the nature of his invention plain to persons having a reasonable competent knowledge of the subject, although from want of skill they could not themselves 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."

In the case of the *Badische Anilin Fabrik* v. *Levinstein* (*q*), the patentee claimed, "First, the production of red and brown colouring matters, which in chemical language may be termed the sulpho acids of oxyazo-naphthaline by the action of the diazo compounds, which may be prepared from naphthylamine or from the sulpho acids of naphthylamine upon any of the isomeric naphthols, or of mixtures of the same, or upon any of the sulpho acids which may be prepared from either alpha naphthol or from beta naphthol, or from mixtures of the same substantially by the process above described." It appeared that the patent was dated 1878; that there were two descriptions of naphthylamine, one called alpha naphthylamine and the other beta naphthylamine; that the substance alpha naphthylamine had been known for a considerable period of time, but that beta naphthylamine had only been discovered in 1876; that at the date of the patent beta naphthylamine was very little known and very rare; that up to the year 1880 it was only used in laboratory experiments and that it was very costly; and that until beta naphthylamine was known, the alpha compound only was known and was called naphthylamine. Objection, that it was not stated what naphthylamine it was intended to be used. Pearson, J., said (*r*): "I come to the conclusion that the word 'naphthylamine' in the patent means that which was generally known in the year 1878 as naphthylamine, namely, what is now described as alpha naphthylamine . . . . . although beta naphthylamine was invented in 1876 and would at once be called

(*q*) L. R., 24 Ch. D. 156.

(*r*) At p. 161.

beta naphthylamine to distinguish it from the naphthylamine which had been known for at least fifteen years before, it does not follow that that naphthylamine would all of a sudden acquire the name of alpha naphthylamine; it would remain in all the books printed up to that time as naphthylamine only, and I am satisfied that at the date of the patent and subsequently to the date of the patent any person ordering naphthylamine simply, would have been supplied with the old naphthylamine, and nobody would have thought of asking him whether he wanted 'beta naphthylamine.' Under these circumstances I think it would be improper to come to the conclusion that any naphthylamine was meant in this patent except that which was known simply as 'naphthylamine,' that is, that which is now properly described as 'alpha naphthylamine.'"

In the Court of Appeal (*s*), Baggallay, L.J., differing from Fry and Bowen, L.JJ., said: "If the language of the specification can be fairly construed, so as in the one case put, to support the validity of the patent, if challenged on the ground that the use of beta naphthylamine would lead to failure, and in the other to protect the patentee against an infringement by the use of that substance, it would be fatal to the plaintiff's case in the present action whether the language had been adopted *per incuriam* or of set design. Though the term 'the literature' has been conveniently applied to the documentary evidence admitted in the present case, it is clear that publications of this nature must be regarded as of two classes—those addressed to the scientific world, and those addressed to working or practical men, a distinction which cannot, in my opinion, be more simply and clearly illustrated than it was by Dr. Odling, who being asked by Pearson, J., when the body, as alpha naphthylamine, but formerly known as naphthylamine without any prefix, first acquired its present name, replied as follows: 'My Lord, there are two distinct forms of literature upon the subject. There is the systematic scientific literature, and there is the technical literature, and in the technical literature it is called naphthylamine up to the present day, but in the more scientific literature you may

(*s*) L. R., 29 Ch. D. 366, 370, 384.

find the distinction although it is very rare.' The distinction between the information given by scientific literature and that given by technical literature is one very important to be borne in mind when we are dealing with questions such as that now under consideration. Publications having reference to chemical science and intelligibly expressed will always be enquired after and studied in their laboratories by scientific chemists, ever on the alert to make themselves acquainted with the newest compounds, with a view of putting them to some useful purpose; but, speaking generally, it is not the fact that such publications are sought after and studied by practical working chemists, whose labours for the most part commence after the useful purpose has been ascertained."

In the House of Lords, Lord Herschell, upon the same point, said (*t*), "I am satisfied that after 1875 and down to the time of the patent, alpha naphthylamine was still sometimes spoken of as 'naphthylamine,' and that if anyone had ordered 'naphthylamine' of a manufacturer, he would without hesitation have supplied alpha naphthylamine. Under these circumstances, I entertain no doubt that any reader of the specification would understand by the word 'naphthylamine' occurring in it, the known commercial article, which, until recently at all events, had always borne that name, and not beta naphthylamine, to which the term 'naphthylamine' alone had never been applied. I am, therefore, of opinion that the specification is not in this respect open to the charge of ambiguity."

If in the process of the invention it is necessary to use some old or well-known apparatus, it is not necessary in the specification to describe the apparatus, save in such terms as it is generally known by, in the particular business to which it belongs (*u*).

In *Heath* v. *Unwin* (*x*), Baron Alderson said: "Every specification is to be read as if by persons acquainted with the general facts of the mechanical or chemical sciences involved in such invention; thus, if a particular mechanical process is specified, and there are for some parts of it, as specified, other

(*t*) L. R., 12 App. Cas., at p. 723.

(*u*) *Crossley* v. *Beverley*, 3 C. & P. 513; *Houschill Co.* v. *Neilson*, 1 Web. P. C. 676.

(*x*) 2 Web. P. C. 245

well-known **mechanical equivalents**, the specification in those parts is in truth the specification of the well-known equivalent also, to those to whose general knowledge we refer: viz., mechanics and readers of specifications; and so it is with chemical equivalents also, in a specification which is to be read by chemists. But it may be that there are equivalents, mechanical and chemical, existing, but previously unknown to ordinary skilful mechanics and chemists. These are not included in the specification, but must be expressly stated there."

An error in a specification which may be said, in a sense, to be a technical error, will not vitiate a specification, although it be an error in description, provided it be such an error that an ordinary skilled workman would at once observe and be in a position to correct; provided it is not such an error as would require experiments to show that it was an error (*y*).

In *Edison and Swan Electric Light Co.* v. *Woodhouse* (*z*), Lindley, L.J. said: "The next objection that requires notice is, that it is contended that the evidence shows that it is essential to success to increase the temperature gradually, and that the specification is **insufficient** because it does not point this out. Now the evidence certainly shows that the maintenance of a high temperature is that which distinguishes Cheesebrough's process from Despretz's experiment, and although Professor Dewar points out the importance of a gradually increasing current, neither he nor any other witness says that the temperature ought to be low to begin with, and be gradually raised. Their evidence only comes to this: that the temperature must be kept up and the electric current must be increased, or the temperature will fall. But the patentee himself tells you this. He says that the temperature must be as high as 7,000° F., and the sentence in the specification, 'as the carbon increases in size more current is required to maintain the temperature,' is shown by the evidence

(*y*) Per Lord Westbury, *Simpson* v. *Holliday*, 13 W. R. 578; see also *R.* v. *Metcalf*, 2 Stark. R. 249; *Bainbridge* v. *Wigley*, Parl. Rep. 197; *Morgan* v *Seaward*, 1 Web. P. C. 174; *Otto* v. *Linford*, 46 L. T., N. S. 40; *Badische Anilin und Soda Fabrik* v. *Levinstein*, 4 P. O. R. 467; *Miller* v. *Clyde Bridge Steel Co.*, 8 P. O. R. 201; *Hopkinson* v. *St. James & Pall Mall Electric Light Co.*, 10 P. O. R. 61; *Miller* v. *Scarle*, 10 P. O. R. 106, 111.

(*z*) Griff. P. C. at p. 95.

to be useless, and an obvious truism to those who understand the subject, unless the sentence is understood to be a direction to keep up the temperature; and when we find that in fact no difficulty is experienced by reason of defective instructions on this point, the Court cannot hold as a matter of law that the specification is not sufficiently explicit. If the defendants had shown that the directions as to temperature were not practically sufficient to enable a competent person to make the patented articles, the case would be very different; but they have not attempted to do this; they rely on the words used, and on the evidence as to temperature already alluded to. This, in our opinion, is not sufficient for their purpose. If the language of a specification is clear enough to guide a competent workman, and enable him to obtain the desired result, we cannot see how a Court can hold the language insufficient in point of law. No doubt it is for the Court and not for a workman to construe the specification; but if a workman says it is a sufficient guide to him, and the Court believes him, the Court must hold that, as regards clearness of description, the specification is in point of law sufficient."

In *Plimpton* v. *Malcolmson* (*a*), Sir George Jessel said: "It is plain that the specification of a patent is not addressed to people who are ignorant of the subject-matter. It is addressed to people who know something about it; but there are various kinds of people who know something about it, if it is a mechanical invention, as this is; you have, first of all, scientific mechanicians of the first class, eminent engineers; then you have scientific mechanicians of the second class, managers of great manufactories, great employers of labour, persons who have studied mechanics—not to the same extent as the first class, the scientific engineers, but still to a great extent—for the purpose of conducting manufactories of complicated and unusual machines, and who therefore must have made the subject a matter of very considerable study; 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 from

(*a*) L. R., 3 Ch. D. 568.

imperfect description, 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—that is what I would say of the two first classes, which I would call the scientific classes. 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. Now, as I understand it, to be a good specification it must be **intelligible to the third class** I have mentioned, and that is the result of the law." This judgment very precisely lays down the law upon the subject of intelligibility generally.

The next question, as to what is a **sufficient** specification, is by far the most important branch of the subject.

We have seen that part of the consideration for the grant of letters patent is, that the inventor shall particularly describe and ascertain the nature of his invention, and in what manner it is to be performed; consequently for a specification to be sufficient it must particularly ascertain—(1) What the invention itself is; (2) How the invention is to be carried out. Under the first head the inventor must describe exactly and accurately what he has invented, and if in the course of the description of his invention it should be necessary for him to describe something which is old but which he wishes to use in the process of his invention, he must be careful to say, "This is old and I do not claim it as a part of my invention." There are two reasons why the inventor should be called upon to particularly state what he has invented; one is, that the public may be placed in a position to use the invention so soon as the period of protection has elapsed; and the other is, that the public may be protected by being carefully informed what it is that during the period of protection they are not to use. In *Macfarlane* v. *Price* (*b*), Lord Ellenborough said: "The patentee in his specification ought to inform the person who consults it what is new and what is old; he should

(*b*) 1 Web. P. C. 74.

say, 'my improvement consists in this . . . .' A person ought to be warned by the specification against the use of the particular invention, but it would exceed the wit of man to discover from what he is warned in a case like this." And the same judge, in *Harmar* v. *Playne* (*c*), maintained the same opinion.

In the case of *Holmes* v. *London and North-Western Railway* (*d*), A. obtained a patent for an improved turning-table for railway purposes, and in his specification gave a description of the machinery, of which no part was new except certain suspending rods; the combination, however, was both new and useful. In the specification the patentee claimed as his invention "An improved turning table hereinbefore described, such my invention being, to the best of my knowledge and belief, entirely new." It was held, that no construction of the claim could be put upon it as including a combination of the various parts which were old, but that it must be construed as meaning that the patentee claimed the several parts of the invention as being new, and the combination being the only part which was new, the patent was held void.

Where a patent is for a **combination** of old or new parts, or for an improved arrangement of old mechanism, the specification need not discriminate between the new and old parts of such combination or improved apparatus (*e*) unless any of those subordinate parts are specifically claimed (*f*). Since it is the new combination or improvement alone that constitutes the novelty and merit of the invention, but it is necessary for the patentee to particularly ascertain and define what his improvement consists of, or what are the exact parts of his new combination, so that any person of ordinary knowledge of 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.

In *Foxwell* v. *Bostock* (*g*), Lord Westbury, L.C., said: "I must therefore lay down the rule, which is consistent with and in

(*c*) Dav. P. C. 311; see also *Carpenter* v. *Smith*, 1 Web. P. C. 532; *Tetley* v. *Easton*, 2 E. & B. 968.

(*d*) 22 L. J., C. P. 57.

(*e*) *Kaye* v. *Chubb*, 5 P. O. R. 649; *Watling* v. *Stevens*, 3 P. O. R. 41; *Moore* v. *Bennett*, 1 P. O. R. 129, 143; *Kelly* v. *Heathman*, 7 P. O. R. 348.

(*f*) *Lister* v. *Leather*, 8 El. & Bl. 1004; *Harrison* v. *Anderston Foundry Co.*, L. R., 1 App. Cas. 578; *Rowcliffe* v. *Morris*, 3 P. O. R. 23.

(*g*) 4 De G. J. & S. 298, 318: see also *Rowcliffe* v. *Morris*, 3 P. O. R. 23.

reality a mere sequence from the decided cases, that in a patent for an improved arrangement or new combination of machinery, the specification must describe the improvement and define the novelty otherwise, and in a more specific form than by the general description of the entire machine; it must, to use a logical phrase, assign the *differentia* of the new combination."

Sir W. M. James, V.C., while commenting upon this case in his judgment in *Parker* v. *Stevens* (*h*), said: "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."

The **degree of sufficiency** which is required by the law is very aptly and accurately put by Eyre, C.J., in *Boulton* v. *Bull* (*i*): "Suppose a newly-invented chemical process and the specification should direct that some particular chemical substance should be poured upon gold in a state of fusion, it would be necessary that, in order to carry out this operation, the gold should be put in a crucible, and should be melted in that crucible, but it would be hardly necessary to state in the specification the manner in which, or the utensils with which, the operation of putting gold in a state of fusion was to be performed. These are mere incidents, with which every man acquainted with the subject is familiar." In taking this distinction as a guide, however, we must be careful to remember that could it be shown that the chemical process would only be successful when the gold was melted in a particular kind of crucible, or at a particular temperature, that then, unless the description was given of the temperature and of the crucible, the specification would be insufficient.

In *Turner* v. *Winter* (*k*), Ashurst, J., said: "It is incumbent on the patentee to give a specification of the invention in the clearest and most unequivocal terms of which the subject is capable. And if it appear that there is any **unnecessary**

(*h*) L. R., 8 Eq. 365; see also *Harrison* v. *Anderston Foundry Co.*, L. R., 1 App. Cas. 574, 578; *Moore* v. *Bennett*, 1 P. O. R. 129, 143; *Philpot* v. *Hanbury*, 2 P. O. R. 33.

(*i*) 2 H. Bl. 498; see also *Badische Anilin und Soda Fabrik* v. *Levinstein*, 4 P. O. R. 469.

(*k*) 1 Web. P. C. 80; see also *Gibson* v. *Brand*, 1 Web. P. C. 627.

ambiguity affectedly introduced into the specification, or anything which tends to mislead the public, in that case the patent is void."

If a patentee **suppresses** anything, or if he **misleads**, or if he does not communicate all he knows, his specification is bad.

In *Crompton* v. *Ibbotson* (*l*), the specification stated: "My invention consists in conducting paper by means of a cloth against a heated cylinder, which cloth may be of *any suitable* material, but I *prefer* it to be made of linen warp and woollen weft." It appeared that the plaintiff had tried several things but was unable to discover anything that would answer the purpose with the exception of the material which he said "he preferred." Lord Tenterden held that the specification was misleading, and therefore bad.

Jessel, M.R., in *Plimpton* v. *Malcolmson* (*m*), said: "You must not give people mechanical problems and call them specifications."

In *R.* v. *Wheeler* (*n*), Abbott, C.J., said: "A specification which casts upon the public the expense and labour of experiment and trial is undoubtedly bad."

But where the ambiguity is of such a character that it would be cleared up by a workman of ordinary ability and information in his trade, such ambiguity will not avoid the patent (*o*).

Lindley, L.J., in *Edison* v. *Holland* (*p*), in his judgment in the Court of Appeal, said: "I feel the great difficulty of

(*l*) D. & L. 33; see also *Savory* v. *Price*, 1 Web. P. C. 83; *Lewis* v. *Marling*, 1 Web. P. C. 493; *Hastings* v. *Brown*, 22 L. J., Q. B. 161; *Wegmann* v. *Corcoran*, L. R., 13 Ch. D. 65.

(*m*) L. R., 3 Ch. D. 576.

(*n*) 2 B. & Ald. 354; see also *Stevens* v. *Keating*, 2 Exch. R. 778; *British Dynamite Co.* v. *Krebs*, Good. P. C. 90; *Wegmann* v. *Corcoran*, L. R., 13 Ch. D. 65.

(*o*) *Morgan* v. *Seaward*, 1 Web. P. C. 176; *British Dynamite Co.* v. *Krebs*, Good. P. C. 93; *Edison* v. *Woodhouse*, 4 P. O. R. 107, 108; *Badische Anilin und Soda Fabrik* v. *Levinstein*, 4 P. O. R. 463; *Thomson* v. *Batty*, 6 P. O. R. 84, 97; *Lifeboat Co.* v. *Chambers*, 8 P. O. R. 421; *Miller* v. *Clyde Bridge Steel Co.*, 8 P. O. R. 201; *Hopkinson* v. *Pall Mall Electric Light Co.*, 10 P. O. R. 61; *Miller* v. *Scarle*, 10 P. O. R. 111.

(*p*) 6 P. O. R. 282; see also *Macnamara* v. *Hulse*, 2 Web. P. C. 128, n.; *Otto* v. *Linford*, 46 L. T., N. S. 35; *Simpson* v. *Holliday*, L. R., 1 H. L. 315; *Plimpton* v. *Malcolmson*, L. R., 3 Ch. D. 531.

describing in words the distinction between an amount of practice, without which failure is probable, but the necessity for which does not destroy a patent, and an amount of experiment and invention without which failure is certain, and the necessity for which destroys a patent. The test, however, by which to decide such a question is, I think, to be found by asking whether anything now has to be found out by a person of reasonably competent skill, in order to succeed, if he follows the directions contained in the specification. If yes, the patent is bad; if no, it is good so far as this point is concerned."

There is a head note to the case of *Betts* v. *Neilson* (*q*), which is apt to mislead; it runs as follows: "Whether a specification contains a sufficient description can only be ascertained by experiments, and in making an experiment knowledge and means may be employed which have been acquired since the date of the patent." It is evident that this head-note is incorrect, and if the case be read it will be found that the judgment of Lord Chelmsford was, not that the specification of the plaintiff could be held sufficient or insufficient upon experiments tried on the specification itself, with the assistance of subsequently-acquired knowledge, but that the specification, which was alleged to anticipate the plaintiff's patent, might be read for the purpose of determining whether there was anticipation or not, or whether there had been prior publication or not in the light of knowledge acquired by the general public since the date of the specification. This would be undoubtedly correct, because the question always is, in dealing with matters of prior publication, Was the supposed invention of the plaintiff's, at the time when he obtained his patent, already part of the public stock of knowledge or not? The public stock of knowledge consisted of the specification, which is put forth as anticipating the patent, together with all knowledge on the subject which can be proved to have been published or used prior to the date of the plaintiff's patent, and so in reading a specification with a view to ascertaining whether it anticipates a subsequent patent you must read into that specification all subsequently-acquired knowledge of the subject prior

(*q*) L. R., 3 Ch. 429.

to the date of the patent; but in discussing the sufficiency of the specification which is actually in dispute, you cannot make use of information which has been acquired since the publication, for otherwise it would be held that the patent, which was void at first for insufficiency of specification, might become valid at some subsequent date by further discovery, which is obviously absurd.

So if a patentee says that there are many modes of doing a thing, when, in fact, only one will do, this will also avoid the patent (*r*), though the distinction must be noted between a claim of something useless and a merely false and inaccurate description of a method, which will not always avoid a patent. In *Lewis* v. *Marling*, Lord Tenterden said: "I agree that if the patentee mentioned that as an essential ingredient in the patent article, which is not so, nor even useful, and whereby he misleads the public, his patent may be void; but it would be very hard to say that this patent should be void because the plaintiffs claim to be the inventors of a certain part of the machine not described as essential, and which turns out not to be useful" (*s*).

The object of the patent is to benefit the world, and not to obstruct a subsequent invention; consequently, if the specification is worded in such a manner as to grasp at more than the patentee has actually invented, and to endeavour to cover, so to speak, wholesale problematic inventions, the patent will be void (*t*).

The question of the sufficiency of a specification is one which must be dealt with on each particular case as it arises; a single word added to a specification may make that which was insufficient sufficient, and that which would be a sufficient description of one invention would be found to be an insufficient description of another, consequently there can be no absolutely fixed rules of construction in dealing with specifications.

In *Wegmann* v. *Corcoran* (*u*) it was held that the specification of a patent was bad if one of the materials to be used was

(r) Per Bailey, J., in *Lewis* v. *Marling*, 1 Web. P. C. 496; see also *Beard* v. *Egerton*, 19 L. J., C. P. 40; *Kurtz* v. *Spence*, 5 P. O. R. 184; *Pether* v. *Shaw*, 10 P. O. R. 297.

(s) 10 B. & C. 25; see also *R.* v. *Cutler*, 14 Q. B. 372, n.; Macr. P. C. 124; *Neilson* v. *Harford*, 8 M. & W. 806; 1 Web. P. C. 295, 313, 371.

(t) *Crossley* v. *Potter*, Macr. P. C. 245.

(u) L. R., 13 Ch. D. 65.

described by a generic comprising a variety of species, the majority of which would be unsuitable. The specification of a patent is bad if a skilled mechanic would not, without performing a series of experiments, be able to construct the machine from the description.

The specification (*x*) of a machine for crushing meal, described the rollers as "to have a surface consisting of material containing so much silica as not to colour the meal or flour. I prefer to make them of iron, coated with china, and finally turned with diamond tools;" and the claim was, *inter alia*, for the use of material "of the hardness required." It appeared that the rollers must be made of very hard china, such as had scarcely been made in Europe during this century, and specially tough, and must be fixed in a peculiar manner to an iron core or spindle, which carried them; and, according to the evidence, a miller or a skilled mechanic would not, without making a series of experiments, discover of what china the rollers must be made, or how they must be fixed to the spindle. Held by the Court of Appeal, confirming the judgment of Fry, J., that the specification was insufficient and the patent invalid. Fry, J., had said: "Though the grantee of a patent for an invention communicated to him by a foreign resident abroad is only bound to tell the public what he himself knows, yet if the original inventor has not told him enough to enable him so to describe the invention as that it could be constructed by the aid only of the specification, the patent will be invalid.

It will be seen that the last-mentioned case is distinguishable from the case of *Plimpton* v. *Malcolmson* (*y*). There the question was whether the patentee, having disclosed a useful invention, was bound to disclose something more, which he himself did not know, but which was within the knowledge of the person communicating from abroad; in that case it was properly held that he was not so bound, but it is obvious that he was bound to describe an invention in his specification which of itself was useful, and that he was bound to tell all that he himself knew, and to give a sufficient description to work the invention.

(*x*) *Wegmann* v *Corcoran*, supra.

(*y*) L. R., 3 Ch. D. 531. Judgment of Jessel, M.R., at p. 582.

We have seen that *bona fides* in the description of the invention is one of the essential elements of the consideration for the grant. The patentee must say not only that which is sufficient to carry out the invention, but he must say all he knows, and he must give every improvement which is within his knowledge at the time and which assists the process or manufacture. *Wood* v. *Zimmer* (s), decided so far back as 1815, gives a very clear idea of the law upon this branch of the subject. In this 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 verdigris, but that Zinck had been accustomed, clandestinely, to put aquafortis into the boiler, whereby the metallic copper was dissolved more rapidly, but the verdigris produced was neither better nor cheaper than that made according to the specification. 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 out that invention in the most beneficial manner, must disclose the means of producing it in equal perfection and with as little expense and labour as it costs the inventor himself. The price that he pays for his 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 the aquafortis as with it, still, inasmuch as it would be made with more labour by the omission of aquafortis, it is prejudicial concealment and a breach of the terms which the patentee makes with the public."

In this case it must have been proved that the patentee, at the time when he obtained his letters patent and filed his specification, knew of the benefit to be derived by the use of aquafortis. It is evident that if he did not know it at the time, but discovered it subsequently during the currency of the patent, that then it would form an improvement upon his invention, and not one

(s) 1 Web. P. C. 82, n.

which he could possibly have disclosed at the time he filed his specification, and therefore there would be no *mala fides* on his part in not describing it.

The remarks of Gibbs, C.J., in *Borill* v. *Moore* (*a*), go to the same extent; and in *Crossley* v. *Beverley* (*b*), Bailey, J., said: "It is the duty of the inventor if, between the period of taking out the patent and enrolling the specification, he makes discoveries which will enable him better to effect the thing for which the patent was obtained, not only that he is at liberty to introduce them into his patent, but that it is his bounden duty so to do, and it is not sufficient for him to communicate to the public the knowledge which he had at the time he obtained the patent, but he ought to communicate to the public the knowledge he had obtained before the specification." In *Morgan* v. *Seaward* (*c*), Alderson, B., said: "If the patentee is acquainted with any particular mode by which his invention may be most conveniently carried into effect he ought to state it in his specification: that was laid down in a case before Lord Mansfield; there the question arose on a patent for steel trusses. It appeared that the patentee in some parts of his process used tallow to facilitate the invention for which he had obtained a patent, and in his specification he made no mention of the use of tallow. The court held the specification to be bad, because they said: 'You ought not to put people to find out that tallow is useful in carrying into effect the invention of steel trusses. You ought to tell the public so if that is the best mode of doing it, for you are bound to make a *bona fides* full and candid disclosure.'" The case referred to by the learned judge was the case of *Liardet* v. *Johnson* (*d*).

In *The Badische Anilin und Soda Fabrik* v. *Levenstein* the patentee in his specification described four processes whereby he could produce sulpho-acids of oxyazo-naphthaline applicable to dyeing and printing, varying in colour from brown to red. All these processes he claimed, although only one of them was proved

(*a*) Dav. P. C. 400.
(*b*) 1 Web. P. C. 117.
(*c*) 1 Web. P. C. 174; see also *Turner* v. *Winter*, 1 Web. P. C. 81; *Sturtz* v. *De la Rue*, 5 Russ. 322; *Coles* v. *Baylis*, 3 P. O. R. 180.
(*d*) 1 Web. P. C. 53; and Bull, N. P. 78.

to have any practical value, and it was argued that the patent was bad on the ground that no specific directions were disclosed how to produce that particular shade of colour; it was held by the House of Lords, reversing the decision of the Court of Appeal, that to require such discrimination was to insist upon what was really impracticable; for, in the words of Lord Halsbury, L. C., "Upon the principle contended for, each shade must not only be shown, but its excellence or popularity must be distinguished separately by the patentee. This, as it appears to me, reduces the obligation supposed to press upon the patentee to an absurdity" (*e*).

In *Tetley* v. *Easton* (*f*) Pollock, C. B., said: "A man has no right to patent a principle and then give to the public the humblest instrument that can be made from his principle, and reserve to himself all the better part of it;" and in *Heath* v. *Unwin* (*g*) Coleridge, C. J., said: "If the inventor of an alleged discovery, knowing two equivalent agents for effecting the end, could, by the disclosure of one, preclude the public from the benefit of the other, he might, for his own profit, force upon the public an expensive and difficult process, keeping back the simple and cheap one, it would be directly contrary to the good faith required from a patentee in his communication to the public."

Upon the same ground of *mala fides* it has been held, in a large number of cases, that if the patentee in his specification gives details which are not necessary to the invention, which of themselves do not constitute an invention, and which are merely put in for the purpose of misleading the public as to either what is the nature of the invention or how it is to be carried into effect, then the patent will be void. Bailey, C.J., in *Lewis* v. *Marling* (*h*), said: "If the party knew that it was unnecessary the patent would be bad, on the ground that this was deception; but if he thought it was proper, and only by a subsequent discovery finds out it is not necessary, I think that it forms no ground of objection."

(*e*) 4 P. O. R. 464; L. R. 12 App. Cas. 716; *Otto* v. *Linford*, 46 L. T., N. S. 35; *Thomson* v. *Batty*, 6 P. O. R. 97.

(*f*) Mac. P. C. 76.

(*g*) 2 Web. P. C. 243.

(*h*) 1 Web. P. C. 496.

If the extraneous matter is put into the specification, *bonâ fide* thinking that it was necessary, the patent will not be held to be void; if it was put in *malâ fide*, with the intention of deceiving, or knowing it was extraneous and useless, the patent would be void. If the extraneous matter is in itself misleading, and would prevent a skilled workman from successfully carrying out the invention, whether it is put in *malâ fide* or *bonâ fide*, the patent will be void (*i*). It will be seen that in the latter case the specification is insufficient, and in the former two cases the question is one simply of *bona fides* on the part of the inventor (*k*).

We now come to that portion of the specification which is described as "the claim." By sect. 5, sub-sect. 5, of the Act of 1883, it is provided that "*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.*" This is, perhaps, emphasizing, in a more distinct manner than had been provided before the passing of this Act, the necessity of the inventor making a distinct and unambiguous claim. He must not claim too much, and yet he must claim sufficient to show a useful manufacture, and he must distinguish in his claim what it is that is new in the process which he has described and what is old. So far as this goes, there is no doubt that the old law provided for similar declarations on the part of the inventor.

In *Bovill* v. *Moore* (*l*), Gibbs, C.J., said: "If the plaintiff has in this specification asserted to himself a larger extent of invention than belongs to him, if he states himself to have invented that which was well known before, then the specification will be bad, because that will affect to give him, through the means of this patent, a larger privilege than could be legally given to him." In the case of *Gibson* v. *Brand* (*m*), Tindall, C.J.,

(*i*) *Savory* v. *Price*, Ry. & M. 1; 1 Web. P. C. 83; *Turner* v. *Winter*, 1 Web. P. C. 77; 1 T. R. 602.

(*k*) *Simpson* v. *Holliday*, 20 Newton's Journal, N. S. 108. *Crompton* v. *Ibbotson*, 1 Web. P. C. 83; Dan. & L. 33; *Bickford* v. *Skewes*, 1 Web. P. C. 218; *Neilson* v. *Harford*, 8 M. & W. 806.

(*l*) Dav. P. C. 404.

(*m*) 1 Web. P. C. 634; see also *Minter* v. *Mower*, 6 A. & E. 735, 1 Web. P. C. 138.

said: "Looking at the specification in the case, it appears to me that this patent cannot be supported at law, because the plaintiffs have in the course of it claimed more than they are entitled to."

The Court must be taken to distinguish between describing too much and claiming too much. In the course of a well-drawn specification it is frequently necessary to describe something which is old, and if, provided the claim says that the old parts do not constitute a portion of the invention, the description of the old parts in the specification will not invalidate the patent. But if two methods of doing a thing are described, one of which will answer and the other will not, it will be interpreted, unless one of them is specifically disclaimed, that both parts are claimed as being new and useful, and one of them not being useful the patent will be invalidated, because it is said there is a false suggestion in the specification (*n*). In *Rushton* v. *Crawley* (*o*), Malins, V.-C., said: "The public must be told in very distinct language in every specification what are the articles they may use and what they may not use. Therefore, if a man makes a discovery, and instead of limiting himself in his specification to that which properly is a discovery (if it be one), makes his specification too extensive, and claims more than he is entitled to claim, that is calculated to embarrass the public; that is, I apprehend, a fatal objection to the patent."

In reading specifications, one frequently comes across a claim in these words: "I claim as my invention the appliances and combinations hereinbefore described." This claim is perfectly good (*p*), provided there is nothing described in the patent which is old. If there be anything old, the claim should proceed: "I do not claim so-and-so, and so-and-so, as part of my invention."

The object of the claim is to crystallize the invention as described in the specification into one or more clauses, so as to render it quite clear what is and what is not the object of the patent. In *Kay* v. *Marshall* (*q*), Lord Cottenham, L.C., said:

(*n*) *Simpson* v. *Holliday*, 13 W. R. 578; L. R., 1 H. L. 315, per Lord Westbury, affirmed in House of Lords.

(*o*) L. R., 10 Eq. 527.

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

(*q*) 2 Web. P. C. 39; see also

"It is introduced (particularly in the case of a patent for an improvement) lest 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."

If the invention be for an **improvement upon an old process** very great care should be taken that the improvement alone is made the subject of the claim; so if it be for a **combination of well-known parts**, care must be taken that it be clearly shown that the patentee claims the combination, and not the parts. James, V.-C., in *Parkes* v. *Stephens* (*r*), said: "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 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 artizan, but of a patent lawyer or agent."

In *Gandy* v. *Reddaway* (*s*), the claim was "constructing belts or bands for driving machinery of cotton canvas or duck 'woven hard' and stitched and saturated or soaked with oil, such as linseed oil or any combination thereof, as herein described or set forth, or any modification thereof." It was proved that cotton canvas woven hard was in the trade divided into classes numbered 1—10. Of these, only 2, 3, and 4, would practically answer to carry out the invention; anyone attempting to use the other numbers would fail; certain numbers would crack if used on small pulleys. Mr. Justice Pearson dismissed the action and was affirmed by the Court of Appeal on the ground that the claim was too large. And where a patent is taken out for a combination, it is not material to its validity that the specification should point out what parts are old and what are new, though, if an

Plimpton v. *Spiller*, L. R., 6 Ch. D. 426; *Easterbrook* v. *Great Western Railway Co.*, 2 P. O. R. 208; *Lucas* v. *Miller*, 2 P. O. R. 155, 159.

(*r*) L. R., 8 Eq. 365.

(*s*) 2 P. O. R. 49; Griff. P. C. 101.

alleged infringement consists only in taking part of the combination, it is necessary that the patentee should in his specification have claimed the part so taken as now (*t*). If the whole combination constitutes the novelty of the invention the whole combination alone should be claimed, and subject to the substitution of equivalents and evasion, there will be no infringement unless the whole combination is taken; but if there is *merit and novelty* in *subordinate integers* or *subordinate combinations* they should be specially claimed, otherwise there will be no infringement in taking them. But in the case where there is *novelty in the result* of using the whole combination, and only the whole combination is claimed, then the Court will protect the patentee from infringement by taking the essence of the combination. *Proctor* v. *Bennis* (*supra*).

In *Harrison* v. *The Anderston Foundry Co.* (*u*), it was finally held by the House of Lords that if **the combination and application of old machinery** be new and beneficial the invention of this combination may be protected by a patent. The specification commenced: "The invention consists of a new or improved simple and most efficient mode of and arrangement of mechanism for connecting the set or sets of compound or multiple shuttle-boxes of looms for weaving stripe, check or other ornamental or figured fabrics requiring two, three or more shuttle-boxes in each set." The specification then described in detail and by reference to drawings the arrangement of mechanism in question, and then continued: "What we believe to be novel and original, and therefore claim as the invention secured to us by letters patent, is—(1) The construction and arrangement of the parts and portion of the mechanism, and (2) a shuttle-box moving and holding mechanism as herein distinguished generally for actuating the shuttle-boxes of power-looms, all substantially in the new or improved manner herein described and shown in the drawings or any mere modification thereof." A great number of the parts of the machine were admittedly old, and one of the questions in this case was, whether the first claim above set forth was a sufficient claim to a combination. Lord Cairns, in giving judg-

(*t*) *Proctor* v. *Bennis*, 36 Ch. D. 740.

(*u*) L. R.; 1 App. Cas. 574.

ment, said: "It is as I read it a claim for a combination, that is to say, a combination of all the movements going to make up the whole mechanism described; it must, for the present at least, be assumed that this combination, as a combination, is novel, that it is, to use the words of the Lord President, a new combination of old parts to produce a new result or to produce a known result in a more useful and beneficial way; it is not doubted that a combination such as this is may be the subject of a patent. What, then, are the objections to the first claim viewed as a claim for the combination? The first is an objection said to be founded upon the case of *Foxwell* v. *Bostock* (*x*), decided by the late Lord Westbury. It is said to be 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, this is or was meant to be the effect of the decision in *Foxwell* v. *Bostock*. If there is a patent for a combination the combination itself is *ex necessitate* the novelty, and the combination is also the merit, if it be a merit, which remains to be proved by evidence."

In the same case Lord Hatherley said: "The judges extended as it appears to me with great respect, the doctrine of *Foxwell* v. *Bostock* in their application of it in this case; it was there held, and that I think was all that was held, that it is not competent to a man to take a well-known existing machine, and, having made some small improvement, to place that before the public and say, 'I have made a better machine: there is this sewing-machine invented by so-and-so, I have improved upon that. That is mine! it is a much better machine than his;' that will not do; you must state clearly and distinctly what it is in which you say you have made an improvement. To use an illustration which was adopted, I think, by Lord Justice James in another case, 'I think it will not do if you invented the gridiron pendulum to say, I have invented a better clock than anybody else, not telling the public what you have done to make it better than any other clock which is known.'"

(*x*) 4 De G. J. & S. 298.

In *Moore* v. *Bennett* (*y*), Selborne, L.C., in giving judgment in the House of Lords, said: "Your lordships have not at all to consider whether in the case of *Foxwell* v. *Bostock* the decision arrived at was correct or not; nor have you to consider whether, when interpreted with reference to the facts of that case, the language used by the very eminent and able judge who decided it may not be susceptible of an interpretation which would make that language correct in point of law. But, my lords, I feel that your lordships cannot refuse to regard the decision in *Foxwell* v. *Bostock* in the light in which you have already explained, and interpreted, and commented upon it by your own decision in the case of *Harrison* v. *The Anderston Foundry Co.*, and so explained, 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.** . . . . The case of *Foxwell* v. *Bostock* was qualified or explained in *Harrison* v. *The Anderston Foundry Co.* It was treated as an authority in such a way as to make it impossible to apply it to the present case, where, looking at the specification and at the evidence, it is perfectly clear that no such general combination as this had been at any time used, and where the material and important parts of the two arrangements and combinations, which are described, are clearly, plainly and intelligibly described. It would, in my judgment, be in direct contradiction to the decision in *Harrison* v. *The Anderston Foundry Co.* to hold the specification bad."

In *Clark* v. *Adie* (*z*), Lord Hatherley said, speaking of *Foxwell* v. *Bostock*: "You must in some way or other inform those whom you are dealing with, by which I mean the general public, who you wish to exclude for a certain limited number of years from using your invention; you must inform them in some mode or other whether you have sub-divided, if I may so term it, your machine into these separate parts and claim for each the merit of

(*y*) Griff. P. C. 158.

(*z*) L. R., 2 App. Cas. 328.

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 ... hine."

A claim for every method of applying a principle is a claim for the principle itself and will not be supported (*a*).

The claim will be construed with reference to the entire patent and although at first sight there may be some appearance of obscurity in it, if it can be made clear by the consideration of the whole specification, the patent will not be thereby avoided (*b*).

As has been pointed out above **each subordinate part** of an invention must be claimed specifically in order to be protected (*c*), for everything that is not claimed is considered to be disclaimed, and should a man describe ten inventions in his specification and claim only one of them, he thereby presents to the public the remaining nine (*d*).

Comprehensive words employed in a specification cannot have the effect of extending the scope of the patent beyond that which is substantially described (*e*).

A claim to "The apparatus as fully set forth and described in the above specification and drawings," has been held to be a claim for the combination of the constituent parts of that apparatus (*f*).

The fact that one of the claims is practically a **repetition** of another will not vitiate a patent; in the *Wenham Gas Co.* v. *The Champion Gas Lamp Co.*, Lindley, L.J., said: "I think the true construction of the fourth claim is pointing out the import-

(*a*) *Neilson* v. *Harford*, 1 Web. P. C. 355.

(*b*) *Beard* v. *Egerton*, 8 C. B. 165, 215, 216; *Arnold* v. *Bradbury*, L. R., 6 Ch. 706, 712; *Plimpton* v. *Spiller*, L. R., 6 Ch. D. 427; *Nordenfelt* v. *Gardner*, 1 P. O. R. 61, 69; *Edison* v. *Woodhouse*, 4 P. O. R. 107; *Leadbeater* v. *Kitchin*, 7 P. O. R. 244; *Elias* v. *Grovesend Tin Plate Co.*, 7 P. O. R. 463; *Edison* v. *Smith*, 11 P. O. R. 395; *Parkinson* v. *Simon*, 11 P. O. R. 493, 507.

(*c*) *Clark* v. *Adie*, L. R., 2 App. Cas. 315, 321; *Cropper* v. *Smith*, 1 P. O. R. 87.

(*d*) *Harrison* v. *Anderston Foundry Co.*, L. R., 1 App. Cas. 580; *Hinks* v. *Safety Lighting Co.*, L. R., 4 Ch. D. 612.

(*e*) *Binney* v. *Feldtman*, Griff. P. C. 52; *Miller* v. *Clyde Bridge Steel Co.*, 9 P. O. R. 480.

(*f*) *Peckover* v. *Rowland*, 10 P. O. R. 234, 237.

ance of the perforated tube in claim 3—a repetition in fact of claim 3—I do not think it is anything more. If so, it does not vitiate the patent. It may be open to the criticism that it is redundant; but if it is nothing more than pointing out what is a valuable operation, and what has been claimed in clause 3, it does not thereby vitiate the patent" (*g*).

So too where one of the claims in a specification, although strictly it may be for something old, is purely subordinate to the main invention and merely amounts to a declaration of one of the merits and advantages of the contrivance disclosed in the specification, it has been held that a patent is not void on that account.

In *British Dynamite Co.* v. *Krebs*, the specification concluded thus: "I claim as the invention secured to me the mode herein set forth of manufacturing the safety powder or dynamite herein described, and also the modes of firing the same by special ignition as herein set forth." Earl Cairns, L.C., after assuming that the modes of firing by special ignition, or some of them, were known before the date of the patent, said: "He does not, as it seems to me, claim the means of explosion *in gross*, but only as *appendant* to 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 be exploded, he might have omitted his second 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" (*h*).

But the above must be carefully distinguished from the case of a claim for something old which, although subordinate to the main invention, tends to enlarge the scope of the patent.

In *Plimpton* v. *Spiller*, *supra*, Brett, L.J., said: "If this

(*g*) 9 P. O. R. 55.

(*h*) Good, P. C. 88, 93; see also per James, L. J., in *Plimpton* v. *Spiller*, L. R., 6 Ch. D. 427, 428; per y, J., in *United Telephone Co.* v. *Harrison*, L. R. 21 Ch. D. 741; also *Neilson* v. *Betts*, L. R., 5 H. L. 21.

second claim had been in a form which would have applied to the runner of any other skate than that which is patented here, I should have thought it would have been bad, and that therefore the whole patent would have been bad, and that the plaintiff could never recover" (*i*).

It has been decided in the House of Lords that the enactment in sect. 5 of the Act of 1883, that a complete specification must end with a distinct statement of the invention claimed is **directory** only, and when letters patent have been granted, they will not be invalid because it has not been complied with (*k*), consequently the same rules will apply in cases where no distinct claim is appended to the specification as applied before the passing of that Act. Under the old law if no claim was inserted the patentee was taken to claim everything that was described in the specification, although disclaimer was not necessary in matters which manifestly formed no part of the invention (*l*).

As has been noticed above, sect. 5, sub-sect. 4 of the Act of 1883, enacts that the complete specification must be accompanied by **drawings** if required.

Before the Act, drawings were quite optional on the part of patentee (*m*), and the above section opens up a question as to how far absence of drawings will now affect a patent, it is submitted that the same interpretation should be placed upon it as that which the House of Lords have placed upon sub-sect. 5 of the same section (*n*), although the words of sect. 2 of the Act of 1886, by which the above sub-section of the principal Act is amended—"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"—would seem to imply that if drawings accompanied neither the provisional nor the complete, the patent might be held to be invalid on that account.

(*i*) See also *British Dynamite Co.* v. *Krebs*, per Cairns, L. C. Good, P. C. 93; *Cropper* v. *Smith*, 1 P. O. R. 81, 88, 90, 91.

(*k*) *Vickers* v. *Siddell*, 7 P. O. R. 292, 303, 308; L. R. 15 App. Cas. 496, 500, 505.

(*l*) *Lister* v. *Leather*, 8 E. & B. 1004; *Tetley* v. *Easton*, 2 C. B., N. S. 706.

(*m*) *Boulton* v. *Bull*, Dav. P. C. 188; *In re Fox's Patent*, 1 Web. P. C. 431, n.

(*n*) *Vickers* v. *Siddell*, supra.

The drawings are for the purpose of elucidating the text, and are to be read in with the specification in order to obtain a correct interpretation (*o*), but it is doubtful if drawings can be made use of for the purpose of extending the scope of the patent beyond the obvious meaning of the words used in the letter-press (*p*).

(*o*) *Bloxam* v. *Elsee*, 1 Car. & P. 558; *Lawrence* v. *Perry*, 2 P. O. R. 180, 186; *Pickard* v. *Prescott*, 7 P. O. R. 365; *Miller* v. *Scarle*, 10 P. O. R. 111.

(*p*) *Clark* v. *Adie*, L. R., 2 App. Cas. 330; *Fairburn* v. *Household*, 3 P. O. R. 267; but see *Pickard* v. *Prescott*, 7 P. O. R. 365.

CHAPTER VIII.

APPLICATION AND ACCEPTANCE.

In a previous chapter the question as to who is entitled to apply for a grant of letters patent has already been considered, and in the present chapter it is proposed to deal with the law and practice relating to the **application** for a grant, and the **acceptance** of the complete specification by the Comptroller.

Sect. 5 of the Act of 1883, as amended by the Acts of 1885 and 1888, enacts:—

(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.*"

Applications for patents for inventions made in Great Britain and Ireland and Isle of Man must be made in Form A, for inventions communicated abroad in Form A 1, and applications for patent under International and Colonial arrangements must be in Form A 2 (*a*). Quaere, if the wrong form were used, would the patent be thereby invalidated. The applicant must himself sign the application, but for the purpose of all other communications with, and all other attendances upon the Comptroller he may employ an agent (*b*), such agent need not be a "patent agent," but he must be an agent duly authorised to the satisfaction of the Comptroller (*c*). In the case of an application by two or more persons, the application must be signed by all those persons, but it is not absolutely essential that complete specification should be signed by more than one of them (*d*).

(*a*) See appendix p. 440.
(*b*) P. R. 1890, r. 8, p. 424, post.
(*c*) Ibid; see also *Graham* v. *Fanta*, 9 P. O. R. 164; for forms of authorisation see appendix, p. 441.
(*d*) McEvoy's patent, 7 P. O. R. 151.

A document sent to the Patent Office by post is deemed to have been left at the time when the letter containing the same would be delivered in the ordinary course of post, and it is sufficient to prove that the letter was properly addressed and posted (*e*).

Rules 9 and 10 of Patent Rules, 1890, contain formal regulations with regard to applications and other communications sent to or left at the Patent Office (*f*).

If a person possessed of an invention dies without having made an application for a patent, application may be made by, and a patent for the invention granted to his legal representative, but such application must be made within six months of the decease of the inventor (*g*).

Sect. 5, sub-sect. 2 enacts: "An application must contain a **declaration** *to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or complete specification.*

"The declaration may be either a statutory declaration under the Statutory Declarations Act, 1835, *or not, as may be from time to time prescribed."*

The form of such declaration and the manner in which it is to be made is regulated by Rules 17 and 17*a* of the Patent Rules, 1890. Where the inventor is incapable, by reason of infancy, lunacy, or other inability, of making any declaration or doing anything required or permitted by the Act, such declarations may be made and such things may be done on his behalf by the guardian or committee of such incapable person, or by any person appointed by the Court (*h*).

Statutory declarations made in conformity with this Act are exempt from the stamp duty of two shillings and sixpence charged on a statutory declaration made under the Statutory Declarations Act, 1835, by the Stamp Act, 1870 (*i*).

(*c*) Sect. 97 of the Act of 1883; see also P. R. 1890, r. 16, a.

(*f*) See p. 424, post.

(*g*) Sect. 34; see also P. R. 1890, r. 20, p. 427, post.

(*h*) Sect. 99.

(*i*) 47 & 48 Vict. c. 62, sect. 9.

Only one invention may be the subject of an application, but it is not 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 (*k*). In *Jones' Patent*, Herschell, S.-G., said (*l*):—"I should always allow alternative devices for producing a particular object as one invention. But if you say I have invented six different kinds of railway sleepers, each of which has its own merits and purposes and objects distinct, then there are six inventions. . . . You may get in one patent the combination, and you may get all subordinate parts of that combination, so far as you claim to use them for one main purpose, but if you are going to claim a subordinate part, or one of the elements of the combination for a purpose independent of the purpose of the combination, then you have got an extra invention, and it is not all one (*m*)."

In *Hearson's Application* the provisional specification intimated that the invention was applicable to "*other purposes*"; those words were struck out by the Comptroller on the ground that it amounted to more than one invention, and this decision was affirmed by the Solicitor-General (*n*).

Where a person, by inadvertence or otherwise, includes in his application more than one invention, he may, after the refusal of the Comptroller to accept such application, apply for separate patents for each of his inventions, which applications shall, if the applicant notify his desire to that effect to the Comptroller, bear the date of the first application (*o*).

The meaning of the words true and first inventor, and the requisites of provisional and complete specifications, have already been dealt with in previous chapters.

Sect. 6 of the Act of 1883 enacts that:—"*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.*"

(*k*) 46 & 47 Vict. c. 57, sect. 33.
(*l*) Griff. P. C. 265.
(*m*) See also Hearson's Patent, Griff. P. C. 266; Robinson's Patent, Griff. P. C. 267.
(*n*) Griff. P. C. 26
(*o*) P. R., 1890, r. 19.

Sect. 2 of the Act of 1888 repeals sect. 7 of the principal Act, and enacts that :—

(1) "*If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject matter of the invention, the comptroller may refuse to accept the application, or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with.*"

(2) "*Where the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer.*"

(3) "*The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions (if any) the application shall be accepted.*"

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

(5) "*If, after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made, accompanied by a specification bearing the same or a similar title, the comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application, or allow the surrender of the patent, if any, granted thereon.*"

The **report of the examiner** is not to bind the judgment of the comptroller, but merely to assist him in making his decision as to whether the application and specifications fulfil the requirements of the Act (*p*). It is difficult to define exactly what is the meaning of the words "whether the nature of the invention has been fairly described," and there is no direct decision on the point, but it is to be presumed that the duty of the comptroller and examiner does not extend to a minute criticism of specifications, but amounts in fact to deciding whether on the face of it

(*p*) *In re C.'s Application*, 7 P. O. R. 250.

the specification appears to be for the invention for which the application is made (*q*). In *Re Smith's Patent* (*r*), Herschell, S.-G., said:—"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. I should only guard myself by saying this, that if the statement of the invention claimed were such as 'I claim the invention described in the specification,' that would be regarded as a mere colourable compliance with the terms of the statute, and not as a distinct statement of the invention claimed, because it would merely refer back to the previous description."

Sect. 9 expressly throws upon the comptroller the duty of deciding whether the provisional and complete specifications describe substantially the same invention, but this section can hardly mean that the comptroller must go into fine questions of construction, but must merely amount to a direction to the comptroller that an application shall not be accepted if the two specifications on the face of them describe inventions which are substantially different (*s*), since it is always the rule in the Patent Office and of the law officer in questions of doubt to accept an application and leave the sufficiency of the specifications and the other points that arise in that connection for the consideration of the courts, should the question ever come before them (*t*).

Under the provisions of sect. 86, the comptroller may refuse to grant a patent for an invention, of which the use would, in his opinion, be **contrary to law or morality.**

Before exercising any discretionary power **adversely** to the applicant, the comptroller must give him ten days' notice, so that he may be heard personally or by his agent on the point in question (*u*).

The subject of **appeal** to the law officer from decisions of the

(*q*) *In re C.'s Application*, 7 P. O. R. 250.

(*r*) Griff. P. C. 268.

(*s*) *In re Anderson's Patent*, 7 P. O. R. 323, 325; but see per Lindley, L.J. *Gadd* v. *Mayor of Manchester*, 9 P. O. R. 527; also per Lord Herschell in *Vickers* v. *Siddell*, 7 P. O. R. 306.

(*t*) *Re Chandler's Patent*, Griff. P. C. 274; *Re Cumming's Patent*, Griff. P. C. 277; *Edmunds' Patent*, Griff. P. C. 283.

(*u*) Sect. 94 of the Act of 1883; see also P. R. 1890, r. 11.

comptroller will be dealt with in the chapter relating to opposition to a grant of letters patent.

Sect. 8 of the Act of 1883, as amended by the sect. 3 of the Act of 1885, enacts:—

"(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. A complete specification may be left within such extended time, not exceeding one month after the said nine months, as the comptroller may, on payment of the prescribed fee, allow.*"

"(2) *Unless a complete specification is left within that time the application shall be deemed to be abandoned.*"

The **nine months** allowed by this section for the filing of the complete specification are calendar months (*x*), and are reckoned exclusive of the day of application (*y*), and in the event of the last day of such nine months falling on Christmas Day, Good Friday, or on a Saturday or Sunday, or on any Bank Holiday or day of public fast or thanksgiving, the specification may be filed on the day succeeding such excluded day or days (*z*).

An application for **enlargement of time** for leaving a complete specification must state in detail the grounds upon which such extension is applied for, and the applicant must produce such evidence in support of his application as the comptroller may require (*a*); the prescribed fee is £2 (*b*).

In the event of an application being abandoned, the specifications and drawings which were left in connection with the application are not published, nor are they at any time open to public inspection (*c*).

Sect. 9 of the Act of 1883, as amended by the Acts of 1885 and 1888, enacts:—

"(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 applica-*

(*x*) 13 & 14 Vict. c. 21, sect. 4.

(*y*) *Russell* v. *Ledsam*, 14 M. & W. 574, 582; *Williams* v. *Nash*, 28 Beav. 93; 1859, 5 Jur. N. S. 696.

(*z*) Sect. 98 of the Act of 1883; see also P. R. 1890, r. 7.

(*a*) P. R. 1890, rr. 50, 51.

(*b*) P. R. 1892; schedule of fees.

(*c*) 48 & 49 Vict. c. 62, s. 4; see ante, Chap. V., p. 65.

tion shall, at the expiration of those twelve months, become void. 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" (*d*).

"(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, 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.*"

Sect. 10 of the principal Act enacts:—

"*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.*"

The **advertisements** are published in the *Illustrated Official Journal*, which is issued every Wednesday (*e*).

Sect. 14 enacts:—"*Where an application for a patent in respect of an invention has been accepted, the invention may, during the period between the date of the application and the date of sealing such patent, be used and published without prejudice to the patent to be granted for the same; and such protection from the consequences of use and publication is in this Act referred to as provisional protection.*"

Provisional protection exists for the purpose of enabling an inventor to work at and improve his invention without thereby avoiding the patent subsequently granted to him on the ground of want of novelty (*f*); it does not afford him the perfect rights which he obtains when his patent is sealed, since he cannot bring an action in respect of any infringement committed before the publication of his complete specification (*g*), and further he may not style the invention which is provisionally protected as "patent," but he may make use of such words as "patent applied for" (*h*).

(*d*) See schedule of fees, Appendix p. 453, post.

(*e*) P. R. 1890, rr. 21 & 22.

(*f*) Per Earl Cairns, L.C., in *In re Dering's Patent*, L. R. 13 Ch. D. 395.

(*g*) Sect. 13 of the Act of 1883.

(*h*) Sect. 105; see *R.* v. *Wallis*, 3 P. O. R. 1; *R.* v. *Crampton*, 3 P. O. R. 367.

"The phrase 'to be granted for the same' obviously means in this section . . . . for the same invention, and cannot be construed as referring to the application or petition" (*i*).

Sect. 15 enacts:—"*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.*"

The effect of sects. 13, 14, and 15 is that no **proceedings for infringement** may be taken before the patent is sealed, after which time proceedings can only be taken with reference to infringements committed after the acceptance and publication of the complete specification.

It has been mentioned above that an inventor may not **use the word "patent"** with reference to the subject of his invention until his patent is sealed, but it is no offence under the Act to continue to use the word "patent" after the period of protection has expired (*k*), unless such representation amounts to a suggestion that it is an existing patent.

In *Cheavin* v. *Walker* (*l*) the plaintiff's filters bore a tablet which consisted of the words "G. Cheavin's Improved Patent Gold Medal Self-cleaning Rapid Water Filter, Boston, England," above which was a medallion containing the Royal Arms, surrounded by the words "By Her Majesty's Royal Letters Patent." This was held to amount to a representation that the filter was the subject of an existing patent, and disentitled the plaintiff to relief.

The effect of the provisions of the Patents, &c., Acts to prevent **fraudulent applications**, and also of those for the protection of **foreign inventors**, has already been discussed in an earlier chapter (*m*).

(*i*) Per Chitty, J. in *Lister* v. *Norman*, 3 P. O. R. 207.

(*k*) *Cheavin* v. *Walker*, L. R. 5 Ch. D. 850, 862.

(*l*) L. R. 5 Ch. D. 850, 863, 864; see also *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. Cas. 523.

(*m*) See Cap. III., ante.

CHAPTER IX.

OPPOSITION.

Section 10 of the Act of 1883 provides that upon acceptance of the complete specification, but before sealing the patent, the comptroller shall advertise the acceptance, and that then the application and specifications, with the drawings, if any, shall be open to public inspection.

Section 11, as amended by the Patents, &c., Act, 1888, is as follows:—(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 to 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 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.**"

Prior to the passing of this Act any ground was available for the purpose of opposition which would have been available for the purpose of destroying the validity of the patent. Prior user was a frequent ground of opposition (*In re Samuda* (*a*)), so also was an alleged dedication to the public by the inventor himself (*In re Adamson's Patent* (*b*)), but it was always considered necessary

(*a*) Hindmarch, at page 534.

(*b*) 6 De G., M. & G. 420; 25 L. J., Ch. 456; 4 W. R. 473.

that the ground of the opposition should be proved beyond the shadow of a doubt (*In re Tolhausen's Patent* (c), and also *In re Vincent's Patent* (d)). If there was any doubt the patent ought to be sealed, so as to give the inventor the benefit of an exhaustive trial. These two latter cases indicate the course the law officer should take, where the ground of opposition is **an allegation that the applicant has obtained the invention from the opposing party.** Such a question might very frequently raise questions of fact of great delicacy, and the question of the credibility of witnesses. Such questions should be left for trial in open court, more particularly as it will be observed that any such opposing party has an ample and unfettered remedy by petition to revoke the patent under sect. 26. In *Edmunds' Patent* (e), Sir R. Webster, A.-G., said:—"I am clearly of opinion that under the circumstances the comptroller-general was right in declining to stop the patent in the present case. Had he done so, or if I were now to do so, there would be no means of reviewing our decision, whereas if the patent is sealed the question can be raised either in the proceedings to which I have already referred, or it may be in proceedings for revocation, should the parties be advised to institute any such proceedings."

In *In re Stuart's Application* (f), Sir E. Clarke, S.-G., said: "I think that the law officer is only entitled to stop the issue of a patent, having examined all the evidence given on one side or the other, if he is so clearly of opinion that the opponent has made out his case that he would, if a jury were to find in favour of the applicant, refuse to accept it and overrule the decision on the ground that it was perverse and contrary to the obvious weight and effect of the evidence."

Under sect. 11, sub-sect. 1, there are **three grounds** upon which a grant of letters patent may be opposed and three only, and provided that the opponent relies upon one or other of these three grounds it does not appear upon the face of that sub-section that the C. G. has any jurisdiction to inquire into the question as to the right or title of the opponent to be heard in opposition,

(c) 14 W. R. 551.
(d) L. R., 2 Ch. 341.
(e) Griff. P. C. at page 233; see also *Fletcher's Patent*, Griff. P. C. 294; *In re Todd*, 9 P. O. R. 488.
(f) 9 P. O. R. 452.

although in *In re Bell* (*g*), the C. G. refused to hear the opponent on that ground.

The **notice of opposition** must state the grounds upon which the opponent intends to oppose the grant and must be signed by him (*h*); a copy of such notice is delivered by the comptroller to the applicant (*i*). Within 14 days after the expiration of two months from the date of the advertisement of the acceptance of the complete specification, the opponent may file **statutory declarations** in support of his opposition, and must deliver to the applicant a list thereof (*k*); within 14 days from the delivery of such list the applicant may leave statutory declarations in reply, a list of which must be sent to the opponent; the opponent may leave further declarations at the Patent Office, a list of which must be delivered to the applicant; such last-mentioned declarations must be confined to matters strictly in reply (*l*). No further evidence may be left on either side except by leave of the comptroller (*m*).

In the case of an opposition upon the **first ground**, it frequently happens that the law officer is of opinion that both the applicant and the opponent contributed materially to the invention. In such case terms will be imposed giving both parties an interest in the patent (*n*).

In *David and Wodley* (*o*), upon the question of **workman and master**, Sir H. Davey said:—"I am of opinion that 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 detail of the machine, 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."

The words "**obtained the invention**" do not necessarily imply that the person from whom the invention had been obtained had

(*g*) Griff. L. O. C. 10.
(*h*) P. R. 1890, r. 34.
(*i*) Rule 35.
(*k*) Rule 37.
(*l*) Rule 38.
(*m*) Rule 39.
(*n*) *Russell's Patent*, Good, P. C. 589; *Luke's Patent*, Griff. P. C. 294; *Re Hatfield*, Griff. P. C. 288; *Re Eadie*, Griff. P. C. 279; *Evans* v. *Otway*, Griff. P. C. 279; *Re Garthwaite*, Griff. P. C. 284.
(*o*) Griff. L. O. C. 26; see also *Re Heald*, 8 P. O. R. 429.

taken out or even intended to take out a patent for it; it refers to the identity of the invention, not the right of the person from whom it was obtained to be regarded as the first and true inventor (*p*).

Where it appeared that a part of the subject of the application had been obtained from the opponent, the law officer struck out that portion and allowed the remainder to go on (*q*).

In *In re Edmunds* (*r*), the comptroller was of opinion that the words "**legal representative**" in sect. 11 meant the executor or administrator of a deceased person and would not include a person holding a power of attorney.

In the case of inventions **communicated from abroad** neither the comptroller nor the law officer will enquire into **what happened outside the United Kingdom**, the importer is the true and first inventor, and the means by which he may have obtained the invention are of no importance and will not be considered since the merit of the invention consists in its importation into this country (*s*).

The other two grounds of opposition are such as can readily be proved or disproved, hence the power of the law officer can be exercised with less prejudice to the interests of justice. In *Cummings' Patent* (*t*), Sir Henry James, although of opinion that the applicant's invention and that which formed the ground of opposition were very nearly the same, thought there was just sufficient difference (although a very slight difference) to justify him in affirming the comptroller-general's decision. He felt, too, that if he refused a patent his decision would be final. It will make no difference in the exercise of the discretion of the law officer, upon the report of the comptroller, if the specification appears to him to comprise the same invention as is comprised in a previous application, that the validity of the first patent is in dispute (*u*).

(*p*) *Re Thwaite's Application*, 9 P. O. R. 515.

(*q*) *Re Thwaite's Application*, 9 P. O. R. 515.

(*r*) Griff. P. C. 281; see also *Re Adolph Spiel*, 5 P. O. R. 282.

(*s*) *Re Edmunds*, Griff. P. C. 281; *Re Lake*, 5 P. O. R. 415; *Re Higgins*, 9 P. O. R. 74.

(*t*) Griff. P. C. 277; see also *Jones' Patent*, Griff. L. O. C. 33.

(*u*) *In re Manceaux's Patent*, L. R. 6 Ch. 272.

"**On the ground that the invention has been patented in this country**" will not give a *locus standi* for opposition where only provisional protection has been granted for the previous invention (*x*); but it is otherwise where the opponent has brought himself within the terms of sect. 15 (*y*). If the invention, the subject-matter of applicant's specification, is fully described in the specification relied on in opposition, the patent will not be allowed to go, notwithstanding that it is not made the subject of claim in the opposing specification (*z*).

In *Stubbs' Patent* (*a*), Sir R. Webster said:—"As this is the first case I have had to deal with, I should like to explain what I mean to do in these cases. Of course I need not remind you that **stopping a patent is a very serious step**, because there are no means whatever of an applicant getting that which he applies for if I stop it, and it must be distinctly understood that I shall *not stop the patent unless I am satisfied that the inventions are* identical. I shall not hesitate to stop it if I can see clearly they are identical. . . . I shall, as a rule, allow **costs to follow the event.**"

In *Re Lorrain* (*b*), Sir R. Webster, A.-G., said: "By allowing a specification in any particular form no harm is done to persons who have a prior patent; but, on the other hand, the law officer is bound to protect the public so that they may not be misled by any specification which, upon 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. The patentee of the later patent frames his specification at his peril."

Where it appears to the C. G. or law officer that the applicant's specification is too general and calculated to deceive the public, or appears to overlap the invention of the opponent, the patent will only be granted on condition of the

(*x*) *Bailey's Patent*, Griff. P. C. 269; *Dundon's Patent*, Griff. P. C. 278.

(*y*) *L'Oiseau and Pierrard*, Griff. L. O. C. 36.

(*z*) *Von Buch's Application*, Griff. L. O. C. 40.

(*a*) *Re Stubbs*, Griff. P. C. 298; see also *Re Todd*, 9 P. O. R. 487; *Re Tattersall*, 9 P. O. R. 150; *Re Griffin*, 6 P. O. R. 296; *Re Cumming*, Griff. P. C. 277.

(*b*) 5 P. O. R. 142; see also *Re Guest & Barrow*, 5 P. O. R. 313.

insertion of **a disclaiming clause**; such clause may be **general or special**, that is, either a general reference to common knowledge or a special reference to the opponent's specification.

Sir R. Webster, in *Re Stell's Patent* (*c*), 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."

The law officer is always reluctant to allow the insertion of **special disclaimers**, as disclaimers are considered to be made in the interest of the public, and are inserted on the ground that the public are entitled to know what a subsequent patentee may claim, and to have a fair description of the existing state of knowledge (*d*).

Sir R. Webster, A.-G., in *Re Guest & Barrow* (*e*), said: "I have never considered that a prior patentee has any right to be specially named, unless the applicants are willing to name him, and unless it is clear there is no other publication except the one that is mentioned." *In re Welch's Patent* (*f*), Sir R. Webster 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."

In an opposition on the second ground the law officer will take into consideration the **question of mechanical equivalents** in comparing the applicant's specification with the specification relied upon by the opponent (*g*), but he will not consider the **question of disconformity** between the opponent's provisional and complete specifications (*h*).

(*c*) 8 P. O. R. 236; see also *Re Guest & Barrow*, 5 P. O. R. 313.

(*d*) Per Sir R. Webster, in *Re Guest & Barrow*, 5 P. O. R. 315; see also *Re Siclaff*, 5 P. O. R. 484; *Re Hill*, 5 P. O. R. 599.

(*e*) 5 P. O. R. 315; see also *Re Tattersall's Patent*, 9 P. O. R. 150, 152; *Re Hoffman*, 7 P. O. R. 92.

(*f*) 8 P. O. R. 443.

(*g*) *Re Haythornthwaite*, 7 P. O. R. 70.

(*h*) Ibid.

The law officer will not allow the **question of fraud** to be raised for the first time upon appeal (*i*).

Where the **opponent's complete specification was filed between the dates of the filing by the applicant** of his provisional and complete specifications, the opponent will not succeed in his opposition unless his complete specification was clearly foreshadowed by his provisional and the invention described thereby, identical with that described in the complete specification of the applicant (*k*).

Under this section it will make no difference whether the patent upon which the opposition is founded has expired or not (*l*).

A question has arisen as to whether, when a patent is antedated, pursuant to the provisions of sect. 103, and when an application is made for letters patent for the same invention by another applicant, between the date to which such patent is antedated and the actual date of application, such antedated patent should, for the purpose of opposition, be treated as of the antedated date or the actual date. Sir R. Webster, on January 17th, 1888, held in the matter of *Everitt's Patent* and *L'Oiseau and Pierrard's* opposition (*m*), that although the opponent's patent would override the applicant's by reason of the antedating, still that for the purpose of opposition the opponents had no locus standi. Sir R. Webster had, on December 7th, 1887, allowed L'Oiseau and Pierrard's patent to be amended by antedating it, pursuant to the 103rd section and to the Convention, notwithstanding that such antedating would have the effect of overriding *Everitt's Patent* (*n*).

The **third ground of opposition** was introduced by sect. 4 of the Act of 1888, for the purpose of preventing an applicant from claiming in his complete specification an improvement on his invention, which was contained in the provisional of the opponent filed after the date of the applicant's provisional specification and thereby depriving the opponent of the benefit of his

(*i*) *Re Huth*, Griff. P. C. 292.

(*k*) *Re Bartlett's Application*, 9 P. O. R. 511; but see also *Re Green*, Griff. P. C. 286.

(*l*) Per Gorst, S.-G., in *Lancaster's Patent*, Griff. P. C. 293.

(*m*) Griff. L. O. C. 28.

(*n*) Griff. L. C. C. 36

invention; but an applicant is not thereby deprived of his old right to include fair developments of his patent in his complete specification (*o*).

The second sub-section provides:—"*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.*"

Notice of appeal must be filed within fourteen days from the date of the decision appealed against (*p*), and must state the nature of such decision (*q*). The evidence used on appeal to the law officer shall be the same as that used at the hearing before the comptroller, save as to matters that have occurred or come to the knowledge of either party in the meanwhile, except with the leave of the law officer (*r*). The law officer shall, at the request of either party, order the attendance at the hearing of the appeal, for the purpose of being cross-examined, of any person who has made a declaration in the matter in question, unless, in the opinion of the law officer, there is good ground for not making such an order (*s*).

In *Heath and Frost's Patent* (*t*), Sir E. Clarke said: "It appears to me that by sect. 11 it is quite clear that 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."

In that case the opponent was an agent for the patentee, and although it had been common in opposition cases, for the sake

(*o*) *Re Edwards' Patent*, 11 P. O. R. 461.
(*p*) L. O. Rules, rr. 1 and 5.
(*q*) L. O. Rules, rr. 2—4.
(*r*) L. O. Rules, r. 8.
(*s*) L. O. Rules, r. 9.
(*t*) Griff. P. C. at p. 290.

of simplicity, for patent agents acting on behalf of clients, to oppose grants of patents in their own names, the law officer decided that the opponent had not such an interest as to be entitled to be heard, and furthermore refused to grant leave to amend the notice of opposition.

It is not sufficient that the opponent has manufactured under the patent which he relies upon in opposition, he must have a direct interest in that very patent (*u*).

Where the opponent dies before the day fixed for hearing the opposition, the notice of opposition may be amended by inserting the name of another opponent (*x*).

(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.*"

Sect. 38 of the Act gives power to the law officers to examine witnesses on oath, to make rules from time to time regulating references and appeals, together with the practice and procedure before them, and in such proceedings they may make such orders as to costs as they may deem just, such orders to be enforceable as rules of Court.

In the absence of opposition, or in the event of any opposition being decided in favour of the patentee, the patent will be sealed. (Sect. 12.)

(*u*) *Re Macevoy's Patent*, 5 P. O. R. 286; see also *Glossop's Patent*, Griff. P. C. 285; *Re Hookham*, Griff. L. O. C. 82; *Re Bairstow*, 5 P. O. R. 289.

(*x*) *Re Lake*, Griff. L. O. C 35.

CHAPTER X.

THE GRANT.

SECT. 12 of the principal Act provides that :—

"(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.*"

Sect. 13 enacts that :—

"*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.*"

Prior to the Act of 1883 letters patent were issued under the great seal of England, and, consequently, by the Lord Chancellor,

as keeper of the great seal. The process of sealing a patent was surrounded with all the formalities and expense which surrounds an important Act of State. Letters patent derived their authority from the fact that the great seal was attached to them, for "all the king's subjects are bound to take notice of the king's great seal" (*a*). Sect. 84 of the Act provides: "*There shall be* a seal for the Patent Office, *and impressions thereof shall be judicially noticed and admitted in evidence.*"

Form D in the first schedule to the Act gives the form in which letters patent are to be issued (*b*).

Letters patent consist of six material parts:—

1st. The address.
2nd. The recitals.
3rd. The grant.
4th. The prohibition.
5th. The conditions.
6th. The construction of the grant.

THE ADDRESS.

The address is a public address from the sovereign to "all to whom these presents shall come." Mr. Hindmarch gives the reason for this as being, that it contains bargains made between the public and patentee (*c*).

THE RECITALS.

The recitals are four in number. The first recites the patentee's name and address, that he has made a declaration that he is in possession of an invention and is followed by the title of the invention. That he has declared that he is the true and first inventor of the invention, and that the same is not in use by any other person to the best of his knowledge and belief.

This recital contains the "suggestions" which have been made to the sovereign prior to the patent being granted and the representations upon which it has been granted. If either of these suggestions or representations be untrue the patent is void. We cannot do better to illustrate the exact meaning of a false

(*a*) *East India Co.* v. *Sandys*, Skin. 225.

(*b*) See Appendix, p. 894, post.

(*c*) Page 40.

suggestion than to quote the language of Parke, B. in *Morgan* v. *Seaward* (*d*). In that case the false suggestion complained of was in the title of the specification, which it was alleged did not disclose the true nature of the invention. "This brings me to the question," said the learned judge, "whether this patent, which suggests that certain inventions are improvements, is avoided if there be one which is not so; and upon the authorities we feel obliged to hold that the patent is void upon the ground of fraud on the Crown, without entering into the question whether the utility of each and every part of the invention is essential to a patent, where such utility is not suggested in the patent itself as the ground of the grant. That a false suggestion of the grantee avoids an ordinary grant of lands or tenements from the Crown is a maxim of the common law, and such a grant is void, not against the Crown merely, but in a suit against a third person (*e*). It is on the same principle that a patent for two or more inventions, when one is not new, is void altogether, as in *Hill* v. *Thompson* (*f*); *Brunton* v. *Hawkes* (*g*); for, although the statute invalidates a patent for want of novelty, and, consequently, by force of the statute the patent would be void, so far as related to that which was old, yet the principle on which the patent has been held to be void altogether is, that the consideration for the grant is the novelty of all, and the consideration failing, or in other words the Crown being deceived in its grant, the patent is void, and no action maintainable upon it. We cannot help seeing on the face of this patent, as set out in the record, that an *improvement* in steam-engines is suggested by the patentee, and is part of the consideration for the grant, and we must reluctantly hold that the patent is void for the falsity of that suggestion. In the case of *Lewis* v. *Marling* (*h*), this view of the case, that the patent was void for a false suggestion, does not appear by the report to have been pressed on the attention of the Court or been considered by it. The decision went upon the ground that the brush was not an essential part of the machine, and that want of utility did not

(*d*) 2 M. & W. 544; 1 Web. P. C. 187; 6 L. J. Ex. 153.

(*e*) *Travell* v. *Carteret*, 3 Levinz, 135; *Alcock* v. *Cooke*, 5 Bing. 340.

(*f*) 8 Taun. 375.

(*g*) 4 B. & Ald. 541.

(*h*) 10 B. & C. 22.

vitiate the patent, and besides, the improvement by the introduction of the brush is not recited in the patent itself, as one of the subjects of it which may make a difference." It will be observed here that the learned judge draws a careful difference between an insufficient description in the specification and a false suggestion. In the cases cited below letters patent were held void for false suggestion (*i*). And the following cases are illustrations of the distinction drawn by Parke, B.:—*Lewis* v. *Marling* (*supra*) and *Haworth* v. *Hardcastle* (*k*). Also *Bainbridge* v. *Wigley* (*l*); *Hill* v. *Thompson* (*m*).

The second recital deals with the prayer of the application for the grant.

The third recital recites that a complete specification has been filed, particularly describing the nature of the invention. Here, again, a **false suggestion** will avoid the patent, so that if the complete specification is imperfect, the patent will be void upon two grounds, the one being the failure of consideration, and the other the false suggestion; and a false suggestion is equally fatal whether it is wilfully false or otherwise.

The fourth recital gives the common law motive for the grant, which is the encouragement of inventions for the public good. There will be something analogous to a false suggestion if the subject-matter of the patent be immoral or illegal, and hence the patent will at common law be void. By sect. 86 of the Act the comptroller may refuse to grant a patent for an invention of which the use would, in his opinion, be contrary to law or morality. A serious oversight in the Act appears to be that there is no appeal from the comptroller when he exercises the power given by this section.

THE GRANT.

"Know ye, therefore, that we of our especial grace, certain knowledge, and mere motion do by these presents, for us, &c., give and grant unto the said patentee our especial licence, full power, sole privilege, and authority, that the said patentee by

(*i*) *Jessop's Case*, 2 H. Bl. 490; *R.* v. *Wheeler*, 2 B. & Ald. 345; *Felton* v. *Greaves*, 3 C. & P. 611.

(*k*) 1 Bing. N. C. 182.

(*l*) 1 Carp. P. C. 270.

(*m*) 1 Web. P. C. 239.

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 . . . . in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention, during the term of fourteen years from the date hereunder written of these presents."

This language is intended to preserve intact the **royal prerogative** to grant or withhold a patent—which right was by the common law absolute and undoubted. We have seen that this prerogative is carefully preserved by sect. 116 of the Act.

It is the granting portion of the letters patent which creates the property in the invention. We have seen that this species of property is purely artificial in its nature; it is the most equitable and natural method which the state can devise for the reward and encouragement of inventors; it is merely a right yielding nothing until the invention is made practically useful to humanity. **A trade mark** is also an exclusive right, but it **differs from a patent**, insomuch that it has not merit and the benefit of mankind as its consideration. Its object is to indicate the source from which an article comes; not to restrain others from manufacturing such articles. It merely prevents them from using the mark in connection with particular goods. A patent prevents the public from making the article or using the invention. There is no property which partakes of the nature of an exclusive right save that of a patent, copyright, or trade mark. There is no exclusive right in a secret. A man may only use a secret to his own profit so long as no one is in a position, by reason of knowing the secret, to use it. But the original possessor of a secret cannot, by any process of law, prevent a person from acquiring the knowledge of his secret, or, having acquired it, from making such use of it, by publication or otherwise, as he may think proper (*n*). In *Newbury* v. *James* (*o*), although an agreement had been made to preserve a secret, the Court refused to grant an injunction on the ground that there was no means of enforcing it. Lord Eldon, L.C., said in *Williams* v.

(*n*) *Canham* v. *Jones*, 2 Ves. & B. 218.

(*o*) 2 Mer. 446.

Williams (*p*), "So far as the injunction goes to restrain the defendant from communicating the secret upon general principles, I do not think that the Court ought to struggle to protect this sort of secret in medicine. The Court is bound indeed to protect them in cases of patents to the full extent of what was intended by the grant of the patent, because the patentee is a purchaser from the public, and bound to communicate his secret to the public."

If the plaintiff's secret, however, be one which he intends to patent, and the defendant has acquired the information during the progress of experiments, or from the confidence of the plaintiff, he will not be allowed to make such use of the knowledge so acquired as to subsequently invalidate the plaintiff's patent, or to take out a patent for the invention himself, and if he do, he will be liable in damages to the plaintiff (*q*). It will be observed that the word "patentee" is used in the grant; the old form was, "to the said John Smith, his executors, administrators or assigns;" a "patentee" is, under the 46th section, construed as being "*the person for the time being entitled to the benefit of a patent;*" we shall see presently that this includes assignees, executors and administrators, together with receivers and trustees in bankruptcy, but the subject of the devolution of patent rights is too extensive and important to be dealt with under this head.

THE PROHIBITION.

The prohibition in the patent commands "all our subjects, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use 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."

(*p*) 3 Mer. 157.

(*q*) *Smith* v. *Dickenson*, 3 B & P. 630.

It is very difficult to understand the form of letters patent which is appended to the Act of 1883. It is presumed that the Act was intended to amend, simplify and codify the law of patents. The form above quoted is an imitation of forms previously in use. It is not easy to understand what the "penalties" referred to in the prohibition are, and how they are to be put in force or recovered. The Act certainly does not mention penalties as a form of punishment for infringers.

THE CONDITIONS.

We find in the "conditions" that the grant is to be avoided "if it should appear to us, &c., or six or more of our Privy Council, that this our grant is contrary to law or prejudicial or inconvenient to our subjects generally, 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 patentee is not the first and true inventor thereof within this realm as aforesaid." This proviso raises some questions of importance. The only proceedings mentioned in the Act for the repeal of letters patent are proceedings in the High Court of Justice. What is the proceeding before "six of our Privy Council"? It can scarcely be believed that reference is here made in a new codifying Act to the old prerogative claim of power to revoke, which has not been put in practice for two hundred and fifty years. If it be intended to have such a system of avoiding patents, surely it would be well to provide for it in a more certain manner than merely to mention it as one of the conditions in the patent itself. In the next place we find here, for the first time, an intimation that "**novelty**" means novelty within the kingdom; in the recitals of the patent it is recited as being novelty universally, and throughout the Act itself we find that "novelty" is not limited to novelty within the kingdom. Again, we find here for the first time the inventor described as "the first and true inventor **within this realm.**" In the Act and in the recitals of the patent he is described as the "first and true inventor." We have shown that the omission of the words "within this realm" makes an immense difference not only in the class of persons who may be grantees of letters patent,

but also in the nature of the evidence of "prior user" which may be given in an action either for infringement or revocation. The ambiguity of the form of letters patent which is given, and the by no means clear provisions of the Act upon these matters, will in all probability result in a plentiful crop of litigation (*r*).

The next proviso is one for the determination of the patent in the event of the prescribed **fees not being paid**, and the last provides for the supply of the patented article for the use of the public service on reasonable terms. This proviso in no way binds the Crown if the patented article should be required for the public service to purchase it from the patentee upon reasonable terms and conditions.

Prior to the Act of 1883 letters patent did not operate as against the Crown. The Crown might make use of the invention without in any way recognising any rights of the inventor or patentee (*s*). But should the Crown have employed **a contractor**, as distinguished from a servant, to manufacture the patented article, the usual proceedings for infringement might be brought against the contractor, since he is the person using the patent, and not the Crown. There are two methods of infringing; first, making and vending; and secondly, using, consequently the contractor infringes by doing the first, and it makes no difference that the Crown also infringes by using the invention (*t*).

This case was subsequently affirmed in the House of Lords. Lord Hatherley said, "The Crown has no right to authorize others who are not their officers, servants, or agents, to use a patented invention without a license from the patentee;" and Lord Selborne added, "I agree with the Court of Queen's Bench that this decision (*Feather* v. *R.*) is not to be extended by any reasoning from the convenience of the Crown, or of the public service, or from any idea that it practically comes to the same thing, whether the Crown manufactures itself or gives orders to other manufacturers."

The right of the Crown to use a patented invention for the

(*r*) See *Marsden* v. *The Saville Street Foundry Co.*, L. R., 3 Ex. D. 203; *Rolls* v. *Isaacs*, L. R., 19 Ch. D. 268.

(*s*) *Feather* v. *R.*, 6 B. & S. 257.

(*t*) *Dixon* v. *The London Small Arms Co.*, L. R., 10 Q. B. 130; L. R., 1 App. Cas. 641.

public service without being under any obligation to remunerate the inventor has been abolished by sect. 27 of the Act of 1883.

(1) "*A patent shall have to all intents the like effects 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* (*u*), *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.*"

Sect. 44 deals with the acquisition by the Secretary of State for War of any inventions dealing with instruments or munitions of war, and with the non-publication of specifications describing such inventions, and generally with the preservation for the public benefit of the secret of them.

THE CONSTRUCTION.

"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." These words are inserted in the patent for the purpose of preventing the common rule of construction of grants of the Crown when founded upon a petition being read most strongly against the grantee. This favourable construction will not, however, in any way save the validity of the patent if it can be shown to have been granted upon a false suggestion.

(*u*) *Dixon* v. *The London Small Arms Co.*, supra.

CHAPTER XI.

AMENDMENT OF SPECIFICATIONS.

The Patents, &c., Act, 1883, provides for the amendment of specifications in two ways, **compulsorily** and **voluntarily.** We have seen that sect. 6 directs that the comptroller shall refer the specification to an examiner. Sect. 7 as amended by sect. 2 of the Patents, &c., Act, 1888, provides that (1), "*If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the comptroller may refuse to accept the application or require that the application, specification, or drawings be amended before he proceeds with the application, and in the latter case the application shall, if the comptroller so direct, bear date as from the time when the requirement is complied with.*" Sub-sects. 2, 3, 4, provide for an appeal to the law officer; and sub-sect. 5 gives directions as to what should be done when there are two applications for substantially the same invention.

Sect. 9, sub-sect. 1, requires that the examiner shall report to the comptroller as to "*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.*" If the examiner reports that these conditions have not been complied with, the comptroller *may* refuse to accept the complete specification until it has been amended to his satisfaction, subject to appeal to the law officer.

Sub-sect. 3: The law officer shall, if required, hear the applicant and the comptroller, and may make an order deter-

mining whether, and subject to what conditions, if any, the complete specification shall be accepted. By sub-sect. 4 the application is rendered void, except in the case of an appeal, unless a complete specification is "*accepted*" within twelve months from the date of application. Sect. 94 provides: "*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 . . . . without (if so required within the prescribed time by the applicant) giving the applicant the opportunity of being heard personally or by his agent* (*a*)."

These provisions of the law were novel at the date of the Act of 1883. It will be particularly observed that **compulsory amendment is strictly limited to matters of form.** The comptroller has no power to order an amendment on the ground that too much is claimed, or that there is want of novelty, or that the invention is not subject-matter for a patent. It is difficult to predicate what judicial interpretation will be put upon the words "that the nature of the invention is not fairly described." Is the examiner to be in the position of an expert witness, and to decide whether or not the description is sufficient to enable a skilled artizan to carry the invention into effect within the meaning of Jessel, M.R., in *Plimpton* v. *Malcolmson* (*b*)? or is he merely to see that the language is correct, and that, without going technically into the matter, the specification *appears* to fairly describe the invention? If the former is his province, it is difficult to see how it is to be carried into effect, since there is no machinery in the Act for the receiving of skilled evidence, such as would be necessary for the purpose of arriving at a satisfactory conclusion upon such a point. The applicant or his agent are alone to be heard. It is true that by sect. 38, where the applicant *appeals* he may call witnesses before the law officer, but surely the statute does not contemplate that questions should be gone into which, it is evident, can only be decided on appeal, and even then not satisfactorily without the procedure and care of a regular formal trial.

Under such circumstances, it may fairly be presumed that the

(*a*) See also P. R. 1890, rr. 11—14.

(*b*) L. R., 3 Ch. D. 563.

meaning of the section is, that the examiner shall report whether the specification, on the face of it, appears to fairly describe the invention (*c*).

In construing sect. 9, it will probably be held that a minute and scientific inspection of the specification is not within the contemplation of the statute.

It is the duty of the examiner to report whether the specification contains a full and fair description of the invention, but it is not within his province to decide what the amendment is to be, in cases where amendment is necessary (*d*).

Sect. 18 provides for the amendment of the specification by the applicant or patentee. There are several reported cases showing that at common law mere clerical errors in a specification might formerly be amended by the Master of the Rolls and the Lord Chancellor upon petition, but these amendments were strictly limited to verbal or clerical errors arising from mistake or inadvertence (*e*). *In re Gare's Patent* in 1884 (*f*), Brett, M.R., allowed amendments of clerical errors in a specification filed under sects. 27 and 28 of the Patents, &c., Act, 1852, and said: "The Master of the Rolls is of opinion that sect. 18 of the Patents, &c., Act, 1883, does not affect the power of the Master of the Rolls to allow amendments in a patent specification filed in pursuance of sects. 27 and 28 of the Patent Act, 1852, *or which is otherwise to be considered as a record under the authority of the Master of the Rolls.* So long as the specification is in the Patent Office, and before the patent is sealed, the Master of the Rolls considers that the proceedings of sect. 18 should be the only proceedings taken by anyone asking for amendment under that section."

It would appear from the words printed in italics that the jurisdiction of the Master of the Rolls is still intact with reference to amendments after sealing.

(*c*) *Brown's Patent*, Griff. L. O. C. 1.

(*d*) *In re C.'s application*, 7 P. O. R. 250.

(*e*) *In re Sharp's Patent*, 1 Web. P. C. 641; *In re Nickel's Patent*, 1 Web. P. C. 650; *In re Redmund's Patent*, 1 Web. P. C. 649 (*n*); *In re Whitehouse's Patent*, 1 Web. P. C. 649, note (*m*); *In re Rubery's Patent*, 1 Web. P. C. 649 (*n*); *In re Dismore's Patent*, 18 Beav. 538; *In re Adams' Patent*, 21 L. T. 38; *Re Johnson's Patent*, L. R., 5 Ch. D. 503.

(*f*) L. R., 26 Ch. D. 105.

In re Bordan's Patent (*g*), it was held that where a disclaimer had been filed without the consent of the patentee, the Master of the Rolls had jurisdiction without bill filed, to order it to be taken off the file.

Sect. 91 gives to the comptroller power to correct any clerical error in or in connection with an application for a patent on payment of the prescribed fee (*h*).

We have seen that a patent for a very meritorious invention may be utterly vitiated by the patentee claiming something which is not new; so, also, a patent might be rendered void by reason of innocent misdescription or misrepresentation.

The common law power of amendment being found insufficient for the purposes of justice in such cases, the Act 5 & 6 Will. IV. c. 83, was passed, enabling "*any person who as grantee, assignee, or otherwise, hath obtained, or shall hereafter obtain, letters patent*, &c.," with the leave of the law officer, might disclaim any part of the "title of the invention or of the specification, stating the reason for such disclaimer;" or might, with such leave as aforesaid, "enter a memorandum of any alteration in such title or specification (not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent), &c., &c." The case of *Spilsbury* v. *Clough* (*i*) having very much limited the meaning of the words of the statute, printed above in italics, the Act 7 & 8 Vict. c. 69, was passed, giving power to the original patentee, or his assignees, or both jointly, in the event of any interest in the patent remaining in the original patentee, to file a disclaimer or memorandum of alteration.

It will be observed that prior to the Act of 1883 any disclaimer or amendment made by the patentee was entirely at his own peril, and that in any subsequent action involving the validity of the patent objection might be taken to the disclaimer or amendment on the ground that it really extended the patent beyond its original limits.

The provisions of sect. 18 of the Act of 1883, as amended so

(*g*) L. R., 20 Eq. 346.
(*h*) See also P. R. 1890, r. 16.
(*i*) 2 Q. B. 466.

far as sub-sect. 10 is concerned by sect. 5 of the Patents, &c., Act, 1886, are as follows:—

"(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.*"

When the comptroller-general has not required an amendment, **all amendments by the applicant or patentee from the date of lodging the complete specification must be made under section 18.**

"The patentee," as has been pointed out in a previous chapter, means the person for the time being entitled to the benefit of the patent, while "the applicant" means the person whose patent has not yet been sealed, but whose complete specification has been lodged.

In *Jones' Patent* (*k*), an application to amend was made subsequent to filing the complete specification, but prior to its acceptance by the Patent Office, and the point whether the application was rightly made under sect. 18 of the Act was taken before the Attorney-General, Sir R. Webster, who, in his decision, 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 section 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 in pursuance of sect. 18."

The words "public property" in this decision clearly mean the date of lodging the specification in a public office; it cannot mean open to the public, as in this case that time had not arrived; in that case the comptroller-general did not require the application for leave to amend, and the nature of the amendment to be advertised, on the ground that the specification

(*k*) Griff. P. C. 313.

was not open to public inspection, and it does not appear clear, from the decision of the Attorney-General, whether, in proceedings for amendment before the acceptance of a complete specification taken under sect. 18, the application should be advertised in accordance with the provisions of sub-sect. 2, in spite of the fact that the complete specification is not open to public inspection at that time.

"**Correction or explanation**" does not include amendment by the insertion of subsequently ascertained knowledge; it is only allowed for the purpose of explaining more clearly the meaning of the patentee at the time when he patented his invention, that is to correct and explain the enunciation of his invention as he intended originally to give it (*l*).

Under this section there is **power neither to amend the title nor the provisional specification.** When a complete specification is filed with a narrower title than the provisional, the proper course for the C. G. to adopt is to amend the title of the provisional under sect. 7, or to give the applicant liberty to insert a disclaiming clause in the complete specification and assimilate the title of the complete to that of the provisional (*m*) (this latter course, it appears to the author, would be dangerous).

Under the Act of Will. IV., when a patentee sought to disclaim it was necessary that he should give his **reasons** for the proposed disclaimer, but he was not compelled to state reasons for a proposed alteration. Under the present statute he must give his reasons for any amendment whatever the form of the amendment may be. The reasons will, of course, vary with each case—either that the patentee has discovered that parts of the invention claimed are not new, or are useless, or are not sufficiently described, or that they will not work.

The reasons for an amendment form no part of the amendment itself (*n*).

If the reasons do not disclose any ground on which the amendment ought to be allowed, the application will be dismissed (*o*),

(*l*) Per Sir R. Webster, in *Beck* v. *Justice*, Griff. L. O. C. 10.

(*m*) Per Sir R. Webster, in *Dart's Patent*, Griff. P. C. 307.

(*n*) *Cannington* v. *Nuttall*, L. R., 5 H. L. 205, 227, 228.

(*o*) *Re Nordenfelt's Patent*, Griff. L. O. C. 18.

but the amendment will not be refused merely on the ground that the reasons given for it are insufficient (*p*).

Sir E. Clarke, S.-G., in *Re Lang's Patent* (*q*), summed up the jurisdiction of the L. O. under the 18th section in the following words: "I do not doubt that I have power to allow any amendments, whether of the letterpress of the specification, or of the drawings, or by way of adding drawings, if drawings have not in the first instance been appended to the specification, necessary to define the disclaimer which it is desired to make."

Prohibition will not lie to the law officer in the exercise of his discretion under this section: *Ex parte Simon*, Times, Aug. 6, 1888, C. A. (*r*).

"(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.*"

In *Ashcorth's Patent*, Sir H. Davey, S.-G., said: "The sect. 18 (2) does not in terms say the reasons are to be advertised, but probably the reasons are a part of the request" (*s*).

This sub-sect. enacts that **any person may oppose**; wherefore it would appear that the C. G. has no power to consider the title of the opponent, although the C. G. decided against an opponent on the ground that he was not entitled to be heard in the case of *Bell's Patent* (*t*).

Rule 53 of the Patent Rules of 1890, provides that:

"**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 (*u*). Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy."

Rule 54. "On receipt of such notice the copy thereof shall be transmitted by the comptroller to the applicant."

(*p*) Per Sir H. Davey, S.-G., *Re Ashworth's Patent*, Griff. L. O. C. 7.

(*q*) 7 P. O. R. 469, 471.

(*r*) *In re Van Gelder's Patent*, 6 P. O. R. 22, 27.

(*s*) Griff. L. O. C. 7.

(*t*) Griff. L. O. C. 10.

(*u*) For form of notice of opposition, see Appendix, p. 445, post.

Rule 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."

Rule 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."

"(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.*"

The comptroller exercises the power to impose conditions given in express terms to the law officer under sub-s. 4 (*x*). In *Codd's Patent* (*y*), he ordered as a condition of allowing an amendment (1), that no proceedings be taken against opponent A. in respect of infringements committed prior to the 1st January, 1884; (2), that the applicant pay to opponent A. 10 *guineas as and for his costs* of and incident to his opposition to the abortive application of 10th July, 1884. It is however clear that the C. G. has no power to give costs as a condition of amendment (*z*).

In *Cochrane's Patent* (*a*), the opposition to the amendment and the opposition to the grant were fixed for hearing before the C. G. on the same day; the C. G. elected to hear the amendment case first on the ground that if the application were successful, the sting would be taken out of the opposition to the grant.

"(4) *The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether and* **subject to what conditions**, *if any, the amendment ought to be allowed.*"

Any person who would be injuriously affected by a void patent becoming valid is a person entitled to be heard (*b*).

(*x*) *Peitschmann's Patent*, Griff. P. C. 314; *Hearson's Patent*, Griff. P. C. 309; *Andrew* v. *Crossley*, 9 P. O. R. 168.

(*y*) Griff. P. C. at p. 307.

(*z*) *Pietschmann's Patent*, Griff. P. C. 314.

(*a*) Griff. P. C. 304.

(*b*) See the conditions imposed in *Re Medlock's Patent*, Newton's London

In *Allen's Patent* (*c*), application was made to amend a specification dated 1885. The opponents asked that a condition should be imposed that Allen should not bring any action or bring any proceedings whatever against them or any of their customers, &c., in respect of any *pipes* which had been sold or contracted to be sold prior to the amendment. Sir E. Clarke, S.-G., having consulted Sir R. Webster, A.-G., gave the following decision: "I have carefully considered the question whether in allowing this amendment I ought to impose any condition as to the bringing of actions for infringement prior to the date of the amendment. This appears to be the first case in which that question has come up for decision in respect of patents issued since the passing of the Act of 1883. In several cases which came before the law officer shortly after the passing of this Act, I find that they imposed, as a condition of the amendment, that no action should be brought for infringements prior to 1st January, 1884. An examination of these cases, as reported in Griffin's P. C., shows that the reason for their so doing, and in each case (whatever its date) referring back to the 1st January, 1884, was, that they doubted whether sect. 20 would avail to protect persons who were sued for infringements alleged to have been committed prior to the passing of the Act (*d*). No such question arises here. This patent was dated 20th October, 1885, and if after amendment an action is brought for a prior infringement, it is clear that the Court will have to decide whether the matters referred to in sect. 20 have been established to its satisfaction. I do not think that I am entitled to substitute my opinion for that of the Court. Again, I do not think that I could in strictness attach this as a condition to the allowance of this amendment. I could only require an undertaking from the applicant as was required by Sir H. James, A.-G., in the *Westinghouse Case*. If he were to refuse to give such an undertaking, I

Journal, new series, vol. 22, p. 69; also *Re Smith's Patent*, Macr. P. C. 232, in which cases great care was taken to protect the vested interests of persons who had acquired rights by reason of the imperfect condition of the original specification.

(*c*) Griff. L. O. C. 3.

(*d*) *Re Hearson*, 1 P. O. R. 213; *Re Haddan*, Griff. L. O. C. 12; *Re Cheesebrough*, Griff. P. C. 303; *Re Westinghouse*, Griff. P. C. 315; *Andrew* v. *Crossley*, 9 P. O. R. 168.

do not feel myself entitled by that refusal to deprive him of the opportunity of protecting the real invention described in his specification, by a disclaimer of that which I am satisfied he does not mean to claim. I therefore do not think I can properly impose this condition."

In *Cheeseborough's Patent* (*e*), the conditions were that no action should be brought with reference to any lamps *made* sold or used before the date of the amendment, and that any lamps so made might be used or sold after the date of the amendment without infringing. In the case of a second disclaimer the law officer will be disinclined to give costs to the patentee even if successful (*f*).

In the case of applications for leave to amend patents granted under the Act of 1883, the law officer on allowing the application will not impose any conditions except under special circumstances. In *Ashworth's Patent* (*g*), Sir H. Davey, S.-G., 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 wire hardened and tempered in a mode different from that which is 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" (*h*).

The specification is considered to be amended from the moment that leave to amend is given, and the conditions imposed, if any, agreed to (*i*), no written undertaking by the applicant is necessary although it is the practice in the patent office to require some such undertaking as conclusive evidence of the agreement (*k*),

(*e*) Griff. P. C. 303; see also the terms imposed in *Westinghouse's Patent*, Griff. P. C. 315.

(*f*) *Haddan's Patent*, Griff. L. O. C. 12.

(*g*) Griff. L. O. C. 9.

(*h*) See also *Re Allen's Patent*, Griff. L. O. C. 3; *Re Haddan*, Griff. L. O. C. 13.

(*i*) *Andrew* v. *Crossley*, 9 P. O. R. 165.

(*k*) Ibid. at p. 168.

since the written assent precludes the patentee from alleging that he did not accept the condition (*l*).

The power of the law officer to grant costs is expressly conferred by the 38th sect. of the Act of 1883 (*m*).

In *re Ashcorth's Patent* (*n*), the law officer refused to grant costs to the applicant although successful, on the ground that the specification was so loosely framed it was natural that rival traders should oppose an application for leave to amend.

In *re Lake's Patent* (*o*), which was an unopposed application for leave to amend, the applicants appealed to the law officer against the decision of the C. G., Sir R. Webster, A.-G., allowed the appeal on the ground that a doubtful amendment ought to be allowed, but refused to give costs. "In fact," he said, "I may say that I think it would be better, as a matter of practice, that in the absence of very special circumstances the C. G. should neither give nor receive costs."

In *re Morgan's Patent* (*p*), which was a successful appeal to the law officer from the decision of the C. G., application was made for the return of the stamp on the notice of appeal, Sir R. Webster, A.-G., refused this application on the ground that he considered the case to be one in which the C. G. was quite right in declining to allow the amendment in the first instance and to leave it to the law officer.

"(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.*"

The exercise of discretionary power vested in the C. G. by the Patents and Trade Marks Acts is regulated by sect. 94, of the Act of 1883, and Patent Office Rules, 1890, rr. 11—14.

"(6) *When leave to amend is refused by the comptroller, the person making the request may appeal from his decision to the law officer.*"

A notice of appeal must be filed in the Patent Office within

(*l*) *Andrew* v. *Crossley*, 9 P. O. R. at p. 169; see also *Re Berdan*, L. R., 20 Eq. 346.

(*m*) See also L. O. R. r. xi. Appendix C.

(*n*) Griff. L. O. C. 9.

(*o*) Griff. L. O. C. 17.

(*p*) Griff. L. O. C. 17.

14 days from the date of the decision appealed against, in every case where appeal to the law officer from a decision of the C. G. is allowed under the Acts (*q*); the practice on appeal is regulated by the Law Officers' Rules.

"(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.*"

It will be observed that the amendments under the new Act are to be by disclaimer, correction or explanation, provided the amendment does not cause the specification to claim an invention substantially larger or different. The Act of Will. IV., after using the words "disclaimer" and "alteration," provided that no extension should take place in the "exclusive right" granted by the letters patent.

It was always a question of great difficulty whether or not a disclaimer or alteration extended the "exclusive right" of the patentee. For instance, if in his original specification, after describing several improvements in a process of manufacture, he proceeded to claim them all, and it should turn out that one of his improvements was old, the whole patent was bad and the patentee had no exclusive right at all; if he then disclaimed the objectionable portion, his patent became good as to all the rest. There was clearly, therefore, an extension of the exclusive right, notwithstanding that this was the very case the statute was passed to meet. Mr. Justice Maule's view of the Act of Will. IV. was: "Whereas there were previously many small and trifling objections by which, if they were sustained against any one of many important inventions, the whole was avoided. In such cases amendments may now be made by means of a disclaimer" (*r*).

Romilly, M.R., in the same case (*s*), at the Rolls, said: "It is

(*q*) L. O. Rules, r. i.; p. 455, post.
(*r*) *R.* v. *Mill*, 20 L. J., C. P. at page 24; 10 C. B. 379; 15 Jur. 59
(*s*) 14 Beavan, at page 315.

proper they (patentees) should be allowed to correct errors in their patents by removing from the specification parts which are not material or substantial, or which they have since discovered not to be new inventions; but this power ought to be exercised with great care and discretion." There is a case reported in Macrory's Patent Cases at page 116, where Sir Richard Bethell, when Solicitor-General, allowed a patentee to enter a disclaimer, the effect of which was to enable him to claim for a combination, the original claim being for the several parts of the described invention. When afterwards he became Lord Westbury he described the words of this statute as vague and indefinite, and said: "Possibly they mean that the patent must not, by the operation of the disclaimer, be made to include or comprehend something which was not originally contained in the patent. The invention claimed may be reduced or diminished, but it must not be extended or enlarged" (*t*).

The case of *Ralston* v. *Smith* (*u*), shows the difficulty which the Courts had in reconciling a disclaimer which might make a patent valid which was void *ab initio*, with the prohibition against extending the exclusive right. The judgment of Lord Chelmsford, as reported, is remarkable for its cautious vagueness, and the care which seems to have been exercised not to lay down anything approaching to a general principle. Under the Act of 1883 it is not the exclusive right which must not be extended, but the invention must not be substantially larger or different.

The decision of the law officer is final, and cannot be appealed against (*x*), consequently in cases of doubt leave to amend will be granted (*y*) since if the amendment is bad under sub-sect. 8 it can be questioned when the point comes before the Court (*z*). Although no one case upon this subject can well be authority for the decision of another, a consideration of a few of the decided

(*t*) *Foxwell* v. *Bostock*, 4 De G. J. & S. at page 306; 12 W. R. 723; 10 L. T., N. S. 144.

(*u*) 11 H. L. C. 223; 20 C. B., N. S. 28; 13 L. T., N. S. 1.

(*x*) *Bateman & Moore's disclaimer*, Macr. P. C. 116; *Re Lake's Patent*, Griff. L. O. C. 16.

(*y*) *Re Lake's Patent*, Griff. L. O. C. 16; *In re Bateman & Moore's Patent*, Macr. P. C. 116.

(*z*) *Re Van Gelder's Patent*, 6 P. O. R. 22.

cases will show the lines upon which the law officers go in granting or refusing leave to amend a specification.

Where no reason was shown by the patentee for requiring the amendment, in the case of a specification which on the face of it was sufficient without it, the law officer refused the application (*a*).

In *Hampton & Facer* (*b*) the applicants desired to insert a statement in their specification imputing disadvantage to former patents, the Solicitor-General refused the application on the ground that he was not at all satisfied that the faults imputed to those patents did in reality exist.

In *Beck & Justice* (*bb*) Sir R. Webster, A.-G., said: "My idea of the function of an explanation within sect. 18 is to explain more clearly what is necessary to understand the meaning of the patentee at the time he patented the invention. I do not think it is intended that he should put in subsequently ascertained knowledge."

An amendment which in effect amounts practically to the re-writing of the whole specification will not be allowed (*c*), nor an amendment which abandons the original substantive claim and limits the invention to a subordinate and unimportant alternative (*d*).

The law officer will allow an amendment which upon a fair interpretation tends to limit the scope of the original specification (*e*), and where a specification is clearly capable of two constructions the patentee by amendment can limit himself to one of them (*f*).

In *Re Bateman & Moore's Patent* (*g*) there was evidence upon the face of the specification that the patentees intended their invention to comprise an entire apparatus, at the end of the specification they claimed the several parts of the apparatus,

(*a*) *Re Morgan*, Griff. L. O. C. 17; *Re Nordenfelt*, Griff. L. O. C. 18.

(*b*) Griff. L. O. C. 15.

(*bb*) Griff. L. O. C. 10.

(*c*) *Re Nairn*, 8 P. O. R. 444.

(*d*) *Re Heath & Frost's Patent*, Griff. P. C. 311; *Re Serrell*, 6 P. O. R. 101.

(*e*) *Re Nordenfelt*, Griff. L. O. C. 20; *Cochrane's Patent*, Griff. P. C. 304.

(*f*) *Re Rylands*, 5 P. O. R. 665; see also other instances, *R.* v. *Mill*, 10 C. B. 379; *Seed* v. *Higgins*, 8 H. L. C. 550.

(*g*) Macr. P. C. 116.

Botholl, S.-G., allowed the disclaimer the effect of which was to convert the claim into one for the combination.

The law officer will not in the absence of satisfactory explanation permit repeated applications to be made for the same proposed amendment (*h*).

(9) "*Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in the case of fraud* (*i*), *and the amendment shall in all Courts and for all purposes be deemed to form part of the specification.*"

Leave to amend, although conclusive as to the right of the party to *make* the amendment, will not give validity to an amendment which is invalid by reason of the provisions of subsect. 8.

In *Foxwell* v. *Bostock* (*k*), which arose under the similar provisions of 5 & 6 Will. IV. c. 83, the amended specification claimed an invention substantially different from that described in the original specification for which the patent was granted. Lord Westbury, L.C., in his judgment, said: "The question then arises, Is the patent void or is the disclaimer void? And to this question it is not easy to find an answer. There is no express enactment in statute 5 & 6 Will. IV. c. 83, that the disclaimer, if it transgresses the statutory limit, by extending the exclusive right, shall be void to all intents and purposes; and unless it be so, it must remain enrolled with and always accompany the letters patent in the specification. It might be proper to hold that the disclaimer is inoperative for the excess only, where that excess is clearly distinguishable; and this is the course which I have been most anxious to take in the present case."

In *Dudgeon* v. *Thomson*, Lord Blackburn, in his judgment in the House of Lords, said: "But when we take, as I apprehend we are entitled to take, *the old specification* before the disclaimer in order to see what it means, that becomes still clearer. I say we are entitled to take it, for the object of a disclaimer is merely to take out and renounce part of what had been claimed before, *and it would vitiate the new specification* if by striking out that

(*h*) *Arnold's Patent*, Griff. L. O. C. 5.
(*i*) *Re Berdan*, L. R. 20 Eq. 346.
(*k*) 4 De J. G. & S. 298.

part you gave an extended and larger sense to what is left so as to make it embrace something which it did not embrace before" (*l*).

In the *Matter of Van Golder's Patent* (*m*), which was a petition for a writ of prohibition to issue against the law officer on the ground that he had allowed a disclaimer which extended the scope of the patent and consequently *ultra vires* under sub-sect. 8, Lord Esher, M.R., in his judgment in the Court of Appeal, said: "In my judgment these two sub-sections have not altered the law in the least. The *Attorney-General* cannot make a valid amendment if it is to substantially enlarge the invention, or make it a substantially different invention. He cannot do it effectively. That is by virtue of sub-sect. 8. Then, if that be so, sub-sect. 9 has not the effect of making that which he has done invalidly, conclusive, and if what he has done is invalid by reason of sub-sect. 8, whenever anybody attempts to put in force that amendment for any purpose, the Court could say that what the *Attorney-General* has done has not really altered the original specification. Then the matter must be determined according to the original specification. **The amendment would be held to be invalid** (*n*)." Lord Justice Lindley in the same case said: "The amendment referred to (in sub-sect. 9) is not only an amendment made, but an amendment which could be properly made under the Act—an amendment which complies with sub-sect. 8—'such an amendment.' If such an amendment as that is made, then such an amendment becomes, in the language of sub-sect 9, for all purposes, part of the specification. It does not mean any amendment whether authorised by the Act or unauthorised by the Act; that is not the scope of the legislation" (*o*).

The above cited cases all lead to the conclusion that where an amendment substantially enlarges the patent or makes the specification as amended substantially different from the original specification, the defence of **disconformity between provisional specification and complete as amended**, cannot be relied on in an action

(*l*) L. R., 3 App. Cas. 55.
(*m*) 6 P. O. R. 22.
(*n*) At p. 27.
(*o*) At p. 28; see also *In re Sharp's Patent*, 1 Web. P. C. 643; *In re Bateman & Moore's Patent*, Macr. P. C. 116.

for infringement, since the amendment is void and the complete specification must be read as it stood prior to amendment.

But in *Gaulard & Gibbs' Patent*, Lord Justice Lindley said: "We are satisfied that no other construction is worth contending for, and it is, in our opinion, the true construction of the specification as amended. . . . . But this construction of the amended specification renders the patent hopelessly bad in law, for (1) on this construction the invention is not the same as that described in the provisional specification, but an entirely different invention; and (2) on this construction the amendment of the complete specification has greatly extended the scope of the patent. As already shown, the essence of the invention, as described in the complete specification in its original shape, and as set forth in the provisional specification, lay in the use in combination of a specially-constructed electrical generator which the patentees believed to be superior to all others, and, in fact to have magical powers; and if they throw this over, they so far depart from their invention as described in those documents as to render the patent they have obtained for it worthless and incapable of being supported" (*p*).

In *Moser* v. *Marsden* the same Lord Justice said: "An ambiguity of expression is cleared up, but still, if the claim is thereby enlarged so as to make that to be an infringement which would not have been so before, *the amendment will avoid the patent*" (*q*).

In *The Farbenfabriken* v. *Bowker* (*r*), the defendants raised the objections, that the comptroller had allowed certain amendments of the specification which had not been properly advertised, and further that when the application was made for amendment there was an action for infringement pending, and that therefore under sect. 18, sub-sect. 10 of the Act of 1883, no amendment ought to have been allowed, Mr. Justice Romer refused to go behind the order of the comptroller.

From the above cases it would seem that it is not yet clearly

(*p*) 6 P. O. R. 225; see also the same case in the House of Lords, 7 P. O. R. 367, 387.

(*q*) 10 P. O. R. 359; see also *Lane Fox* v. *Kensington and Knightsbridge Electric Lighting Co.*, 9 P. O. R. 221, 239, 413, 419, 421.

(*r*) 8 P. O. R. 389, 397.

settled, whether, when an amendment extends the scope of the patent, the amendment alone is bad, or whether the whole patent is thereby rendered invalid.

The fact of an amendment being required by the patentee does not necessarily imply that the original patent was void (*s*), and Lord Cairns, L.C., in *Dudgeon* v. *Thomson*, said: "The original specification may have complied with all the exigencies of the law, and been such as is requisite in the case of every patent, but the amended specification may be wanting in all those qualities which are required by the statute" (*t*).

(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.*"

In *Cropper* v. *Smith* (*u*) the comptroller having declined leave to amend a specification by reason of the 10th sub-sect. of sect. 18 on the ground that an appeal was pending to the House of Lords from a decision of the Court of Appeal, declaring the patent in question invalid, and that such appeal was "an action for infringement or other legal proceeding." Application was made to the Court under sect. 19. Chitty, J., held that the words "other legal proceedings" applied to a petition for revocation, and that the words "action for infringement" referred to an action before judgment, and consequently that the appeal to the House of Lords did not deprive the comptroller of the power of amending the specification under sect. 18.

In *Codd* v. *Bratby* (*x*), liberty to amend under sect. 19 was given upon terms by the Court after a previous refusal by the comptroller under sect. 18, but the applicant was ordered to pay the costs of the application to the comptroller.

Should a petition for revocation be instituted while an application for leave to amend is pending, the proceedings before the Comptroller General are thereupon suspended by virtue of the sub-sect., and can only be revived by leave of the Court under sect. 19 (*y*).

(*s*) Per Tindal, C. J., in *Stocker* v. *Warner*, 1 C. B. 165; 9 Jur. 138.

(*t*) L. R., 3 App. Cas. 38.

(*u*) 1 P. O. R. 254; L. R., 28 Ch. D. 148; see also *Lawrence* v. *Perry*, 2 P. O. R. 179, 188.

(*x*) Griff. P. C. 56; 1 P. O. R. 209.

(*y*) *Re Deeley's Patent*, 11 P. O. R. 72, 76.

Sect. 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 or 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.*"

Where more than one action is pending, the leave of the Court must be obtained under this section in each action, otherwise the amendment will not be allowed, and each order must be filed under rule 58 (*infra*) (*z*).

"**The Court**" as defined by sect. 117 of the Act, means the High Court of Justice, so would not include the House of Lords (*a*), and "**a judge**," of a Court, which, though not a High Court, has jurisdiction to try actions for infringement of a patent, can grant leave under this section, consequently the Vice-Chancellor of the Palatine Court can grant leave under this section while an action is pending within his jurisdiction (*b*).

It is to be noticed that while an action is pending the amendments made with the sanction of the Court are **limited to disclaimer.**

Sect. 19 acts as a limitation upon the general words of sub-sect. 10 of sect. 18, and when permission to apply has been granted under sect. 19 the provisions of sub-sect. 10 cease to have effect (*c*), and the procedure in such application is governed by the remaining provisions of sect. 18 (*d*).

Sect. 19 gives an absolute discretion to the Court or judge in imposing conditions upon which leave to apply to amend will be granted and the Court of Appeal "will not interfere with the exercise of that discretion unless they can clearly come to the opinion that in their view that discretion was exercised absolutely wrongly" (*e*).

(*z*) *Codd's Patent*, Griff. P. C. 305.

(*a*) *Cropper* v. *Smith*, 1 P. O. R. 256.

(*b*) *Winter* v. *Baybut*, 1 P. O. R. 76 ; see also p. 316, *post*.

(*c*) *Singer* v. *Stassen*, 1 P. O. R. 121, 123, 124 ; *In re Hall*, 5 P. O. R. 312.

(*d*) *In re Hall*, 5 P. O. R. 310 ; *Lang* v. *The Whitecross Co.*, 7 P. O. R. 392.

(*e*) Per Lord Esher, M.R., in *Allen* v. *Doulton*, 4 P. O. R. 384 ; see also *Bray* v. *Gardner*, 4 P. O. R. 40 ; *Lang*

In *Bray* v. *Gardner* Lord Justice Lindley said (*f*). "I do not understand that there is any form of order which is invariably to be followed in all cases when application is made under sect. 19. It appears to me that whenever leave is given to amend under sect. 19 of this Act, care ought to be taken that no injustice is done to the defendant by reason of the amendment, if amendment is made, or if leave to apply for it is granted. Adequate protection may be given to the defendant in various cases in various forms."

It is usually one of the **terms upon which the Court grants applications** under this section, that the amended specification should not be used as evidence in the action (*g*), but the words at the end of the section—"and may direct that in the meantime the trial or hearing of the action shall be postponed"—clearly suggest the possibility of cases arising in which the Court would consider it right that the amended specification should be received in evidence at the trial (*h*).

In *Codd* v. *Bratby* (*i*), in giving liberty to amend under this section, Chitty, J., said, "It is conceded for the applicant, first, that the amended specification is not to be put in evidence at the trial; secondly, that no evidence is to be given of any infringement prior to the amendment of the specification. Besides that, it is conceded that the applicant must pay the costs of this application and all the costs that have been thrown away in the action;" then as to the contention that a condition should be imposed on the plaintiff that he should not sue the defendants on the amended specification for future infringements, his Lordship said, "The result of my acceding to this part of the argument would be, that I should be giving to the defendants practically and substantially a licence to infringe the plaintiff's patent when amended . . . . in the circumstances of this case,

v. *Whitecross Wire and Iron Co.*, 6 P. O. R. 570, 574; 7 P. O. R. 389, 394.

(*f*) 4 P. O. R. at p. 44; see also *Lang* v. *Whitecross Co.*, 6 P. O. R. 570, 575; *Meyer* v. *Sherwood*, 7 P. O. R. 283, 285.

(*g*) *Gaulard & Gibbs* v. *Lindsay*, 5 P. O. R. 196; see also *Lang* v. *Whitecross, Co.*, 7 P. O. R. 393.

(*h*) *Bray* v. *Gardner*, 4 P. O. R. 42; *Fusee Vesta Co.* v. *Bryant & May*, 4 P. O. R. 71; *Re Hearson's Patent*, 1 P. O. R. 213.

(*i*) Griff. P. C. 56; 1 P. O. R. 209.

that would be going too far. . . . . There may be cases in which it would be right to impose such a term. I am not satisfied in the case before me on the evidence, that the defendants are right in their attempt to impute knowledge to the plaintiff many years ago of the invalidity of his patent; if that point were made out, I think the case might stand on a different footing, because then I should have the case of a patentee with knowledge of a defect in his patent, lying by until a very few months of the expiration of his patent; and I should have on the other side the defendants saying that they were aware of the invalidity of the patent, that they were advised that the patent was invalid, and that they set up a trade and incurred great expenditure on the faith that the patent was invalid" (*k*).

Liberty to apply under this section will not be given after judgment (*l*).

Sect. 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.*"

Under the Statute of Will. IV., no disclaimer or amendment could be given in evidence in any action or suit (save and except in any proceeding by *scire facias*) pending at the time the disclaimer or amendment was enrolled. The object of this was obvious. It would have been unjust that a defendant should be held guilty of infringing a patent when at the time the action was brought against him the patent was void. The saving clause relating to *scire facias* was always exercised subject to just provision as to costs, and was inserted with a view to prevent a

(*k*) See also as to terms imposed under this section: *Singer* v. *Stassen*, 1 P. O. R. 121; 50 L. T. 326; Griff. P. C. 207; *Fusee Vesta Co.* v. *Bryant & May*, L. R. 34 Ch. D. 458; 56 L. J., Ch. 187; 56 L. T. 110; 4 P. O. R. 71; *Bray* v. *Gardner*, L. R., 34 Ch. D. 668; 56 L. J., Ch. 497; 56 L. T. 292; 4 P. O. R. 40; *Haslam Foundry Co.* v. *Goodfellow*, L. R., 37 Ch. D. at p. 121; *Gaulard* v. *Lindsay*, 5 P. O. R. 192; *Lang* v. *Whitecross Co.*, 6 P. O. R. 570.

(*l*) *Lawrence* v. *Perry*, Griff. P. C. at p. 148.

patent being repealed on account of some trifling error which might have been cured by disclaimer or alteration. The entry of a disclaimer under the old Act did not make a void patent valid *ab initio*, "so as to make any person a wrongdoer by relation," and in *Perry* v. *Skinner* (*m*) it was held, that the words "from thenceforth" must be read into the specification. Proceedings by *scire facias* are abolished by sect. 26 of the Act of 1883, and a petition to the Court is substituted, the grounds for the petition being the same as heretofore in *scire facias*. Although we have seen that sub-s. 10 of sect. 18 prohibits any amendment *under that section* pending legal proceedings (including proceedings by way of revocation), sect. 19 provides machinery for saving a patent in the event of the Court or judge being of opinion that a disclaimer should be allowed upon such terms as may appear just (*n*). It will be observed that the Court or judge have no power to permit amendment by "correction or explanation" under this section.

Sects. 19 & 20 must be read together (*o*), and if an application under sect. 18 or 19 is granted without the imposition of terms, the amendment on being made will be retrospective only, if the patentee can show that his original claim was framed in good faith and with reasonable skill and knowledge (*p*).

In *Hopkinson* v. *St. James and Pall Mall Electric Light Co.* (*q*), judgment was given for plaintiff with the usual relief, the defendants referred to sect. 20, and asked that the account of profits should be kept only from the date of the amended specification; Romer, J. refused the application and said that "he thought it was clear from the evidence which was before him, that the plaintiff's original claim was framed in good faith and with reasonable skill and knowledge."

(*m*) Hindmarch, p. 207; 2 M. & W. 471; 1 Web. P. C. 250; 6 L. J., Ex. 124.

(*n*) As to what are just terms, see supra, and *In re Smith's Patent*, Macr. P. C. 232; *In re Medlock's Patent*, Newton London Journal, new series, vol. 22, p. 69.

(*o*) *Lang* v. *Whitecross*, 7 P. O. R. 391.

(*p*) *Wenham* v. *Carpenter*, 5 P. O. R. 68; see also *Lucas' Patent*, Macr. P. C. 235.

(*q*) 10 P. O. R. 46, 62; see also *Meyer* v. *Sherwood*, 7 P. O. R. 283, 286.

In *Dudgeon* v. *Thomson* (*r*), an interdict granted prior to the amendment was refused to be enforced after the amendment, on the ground that the amendment materially altered the patent, and that it was quite possible that there was no infringement of the patent as altered.

Section 21. "*Every amendment of a specification shall be advertised in the prescribed manner.*"

P. R. 1890, r. 59, provides that such advertisement shall be in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may direct.

The effect of sections 18—20 of the Act is summed up in the judgment of A. L. Smith, J., in *Re Hall and Others* (*s*): "Sect. 18 gives power to a patentee, when he finds out the blunder in the 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-sects. showing what the comptroller is to do; how notice is to be given; what has to be done, and how other parties may come in and object; and the last sub-sect. it seems to me, is most natural: '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' (*t*). That means this, that where a patent 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 had 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,' but only liberty . . . . to the patentee to apply

(*r*) L. R., 3 App. Cas. 34.
(*s*) 5 P. O. R. at p. 312.
(*t*) This sub-sect. is amended b sect. 5 of Act of 1885.

at the Patent Office for leave to amend his specification by way of disclaimer."

It has already been noticed that where leave to apply has been granted and the amendment allowed, without a term being imposed that the amendment shall not be retrospective, then the specification must be tested by the provisions of sect. 20, and the amendment will only be retrospective in its action if it can be clearly shown that the original claim was framed in good faith and with reasonable knowledge.

CHAPTER XII.

THE DEVOLUTION OF A PATENT.

We have seen that a "**patentee**" is "the person for the time being entitled to the benefit of a patent." This includes the first inventor and any person or persons in whom the patent may have become vested by operation of law or by assigment.

The property of a patent passes, **by operation of law**, when the patentee dies or becomes **a bankrupt**. Upon the **death of a** patentee his interest in the property passes to his executors or administrators as the case may be in the like manner to the rest of his personal estate. Any step which in the Act is required to be taken by the patentee, may be taken by the executor or administrator, and sect. 34 of the Act provides that—"(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.*" This undoubtedly, seeing the terms of the grant itself, will mean his legal **personal representative** (*a*). Some letters patent of the Crown (not for inventions) have a limitation to heirs or heirs male, such, for instance, as patents of nobility.

If the patentee becomes bankrupt the property in the patent will pass to his receiver, trustee or assignee in bankruptcy (*b*). It is doubtful whether the doctrine of apparent possession can be said to affect a patent right. The Lord Chancellor, in 1812, seems to have thought that it did (*c*). This, however, can hardly be quoted as an authority. The persons in whom the patent

(*a*) See *Re Edmund's Patent*, Griff. P. C. 281.

(*b*) *Hesse* v. *Stevenson*, 3 B & P. 565; see also *Bloxam* v. *Elsee*, 9 D. & R. 215; *McAlpine* v. *Mangnall*, 15 L.J., C. P. 298.

(*c*) See *Ex parte Granger*, Godson on Patents, 2nd ed. p. 225.

vests, by reason of bankruptcy, are placed in all respects in the position of the original patentee, and may sue in respect of infringements (*d*).

The second method of devolution is by assignment *inter vivos*. This may be done either by absolute assignment of the whole of the patent, or by absolute assignment of the patent right for a limited area, or by assignment by way of mortgage, or by the grant of licences.

The right of the original inventor to assign the exclusive right which has been granted to him is recognised in the patent itself, which is granted to the said A. B., his executors, administrators or assigns. Without those words of limitation the property in the patent right would be merely personal, attaching to the person of the first inventor and becoming extinguished by his his death.

By sect. 36 of the Act, "*a patentee may* assign *his patent* for any place *in or part of the United Kingdom or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.*"

The patent itself being a deed the assignment must also be by deed (*e*); but a parol agreement to assign will operate as an equitable assignment of the patent (*f*), and specific performance of such an agreement will be enforced (*g*).

Assignment may be made to any person, or to any two or more persons as tenants in common, or to a body corporate.

Executors may assign a patent after the grant, but prior to registration of the probate (*h*).

The assignment of a patent with no express warranty incorporated in the contract, like the assignment of an ascertained chattel, carries with it no implied warranty of its quality (*i*), and the question to be decided in each case is: "Did the defendants buy a good and indefeasible patent right, or was the contract

(*d*) *Bloxam* v. *Elsee*, supra.

(*e*) Co. Lit. 9 b, 172 a; *Stewart* v. *Casey*, 9 P. O. R. 9, 13.

(*f*) *Stewart* v. *Casey*, 9 P. O. R. 9.

(*g*) *Lewin* v. *Brown*, 14 W. R. 640.

(*h*) *Ellwood* v. *Christy*, 10 Jur., N. S. 1079.

(*i*) *Hall* v. *Conder*, 26 L. J., C. P. 138, 142; *Smith* v. *Neale*, 26 L. J., C. P. 143, 148; see also 56 & 57 Vict. c. 71, sect. 14, ss. 1.

merely to place the defendants in the same situation as the plaintiff was in, with reference to the alleged patent?" (*k*).

Where the plaintiff purports to assign the **exclusive right of** selling certain things for the manufacture of which a patent had been obtained, there is in such case an implied warranty that the patent is a valid one, since otherwise it would be impossible to assign such exclusive right (*l*).

Upon **assignment** of a patent **without a warranty** the assignee may not, in an action upon the contract of assignment, set up the invalidity of the patent as a defence; the cases and considerations which arise upon this point will be left to be dealt with in the succeeding chapter under the head of "Estoppel."

In *Re Railway and Electric Appliances Co.* (*m*), the patentees made an absolute assignment of their patent to the company on the terms that the company should pay to them a royalty upon every article "which should be manufactured or sold by the company" under the patent "while subsisting," and also a share of the profits; through inadvertence the renewal fee at the end of five years from the date of the patent was not paid by the assignors, and it was held by Kay, J., that there was no term in the contract, express or implied, whereby the assignees could be held liable on account of the lapse of the patent and consequent loss of royalties to the assignors.

An assignee of a **distinct part** of a patent is entitled to sue for an infringement of that part without joining the persons who are interested in the remaining part or parts (*n*).

Where an assignee of a patent covenants with the assignor for himself and his assigns that he will work the patent and pay certain royalties thereon to the assignor, a **subsequent assignee with notice** takes the patent subject to those covenants (*o*); so too an assignee can maintain a suit against subsequent licensees of the assignor with notice of the assignment, to restrain them from using the patent (*p*).

(*k*) Per Cresswell, J., in *Hall* v. *Conder*, 26 L. J., C. P. 143.

(*l*) *Chanter* v. *Leese*, 5 M. & W. 698; *Hall* v. *Conder*, 26 L. J., C. P. 143.

(*m*) L. R., 38 Ch. D. 597.

(*n*) *Dunnicliff* v. *Mallett*, 7 C. B., N. S. 209; 29 L. J., C. P. 70.

(*o*) *Werderman* v. *Société Générale D'Electricité*, L. R., 19 Ch. D. 246.

(*p*) *Hassall* v *Wright ht*, L. R., 10 Eq.

An **agreement** by the vendor of a patent **to assign** to the purchaser, all patent rights that he may subsequently acquire of a like nature to the patent then sold, is not contrary to public policy and will be upheld (*q*); so too a covenant by a licensee for the residue of a term of 14 years, of patented improvements in machinery for slubbing fibrous substances, not to make or vend any slubbing frames whatever without the invention applied to them, was held not to be void as a covenant in restraint of trade, and although the licensee subsequently discovered that the patent was useless and no one could be induced to purchase frames to which it was applied, the Court held that this was no answer to the action (*r*).

Where a grant of letters patent has been made to two or more persons, or has been assigned by the original patentee to two or more persons, each of the **co-grantees** or **co-assignees**, has the right to put the invention into practice without incurring the liability to account to his co-owners for the profits which he may make. In *Steers* v. *Rogers*, Lord Herschell, in delivering the judgment of the House of Lords, said (*s*): "Letters patent do not give the patentee any right to use the invention; they do not confer a right to manufacture according to his invention. That is a right which he would have equally effectually if there were no letters patent at all; only in that case all the world would equally have the right. 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 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 of them entitled, to prevent the rest of the world from using it" (*t*).

The **rights of co-owners** *inter se* are summed up by Lindley,

(*q*) *Printing & Numerical Registering Co.* v. *Sampson*, L. R., 19 Eq. 462; 44 L. J., Ch. 705; 32 L. T. 354; 23 W. R. 463.

(*r*) *Jones* v. *Lees*, 26 L. J., Ex. 9; 1 H. & N. 189; 2 Jur., N. S. 645.

(*s*) 10 P. O. R. 251; L. R., 1893, A. C. 235.

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

L.J., in his book on Partnership (*u*): "In the case of a patent belonging to several persons in common, each co-owner can assign his share, and sue for an infringement (*x*); and can also work the patent himself, and give licences to work it, and sue for royalties payable to him for its use (*y*); 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 "(*z*).

The **grounds upon which one co-owner can sue** for infringement of the patent without joining the other co-owners are clearly set out in the judgment of Page-Wood, V.-C., in *Dent* v. *Turpin* (*a*); the law as therein expressed is that although he may sue alone, the Court will not grant a decree for further relief than that which is purely personal to himself, that is to say, he may have an injunction against the infringer, but he will only receive that portion of the damages to which the Court may think he is entitled; this would seem to show that he is only entitled to such portion of the damages as bear a relation to his interest in the patent.

In *Smith* v. *L. & N. W. Ry. Co.* (*b*), it was decided that the right of co-owners to damages for infringement was a joint right and on the death of one the survivor was entitled to recover the whole.

Where a sole patentee worked the patent in **partnership** with another for some years during which time they were extensively advertised as joint patentees, it was held that the partner of the sole patentee thereby acquired such an interest in the patent as to enable him to work it independently after the partnership had expired (*c*), but this would not be the case if it were a term of the

(*u*) 5th ed. p. 62.

(*x*) *Dunnicliffe* v. *Mallett*, 7 C. B., N. S. 209; *Dent* v. *Turpin*, 2 J. & H. 139; 30 L. J., Ch. 495; *Sheehan* v. *Great Eastern Railway*, L. R., 16 Ch. D. 59, 63.

(*y*) *Sheehan* v. *Great Eastern Railway*, L. R., 16 Ch. D. 59.

(*z*) *Mathers* v. *Green*, L. R., 1 Ch. 29; *Russell's Patent*, 2 De G. & J. 130.

(*a*) 2 J. & H. 139; 30 L. J., Ch. 495, 496.

(*b*) 2 El. & Bl. 69, 74; 17 Jur. 1071; Macr. P. C. 188, 207.

(*c*) *Kenny's Patent Button-Holeing Co.* v. *Somervell*, 38 L. T. 878; 26 W. R. 786.

partnership that the patent rights in the invention should belong exclusively to one of them (*d*).

A mortgagee registered as such at the Patent Office has not such an interest in the patent as to be a necessary party to an action for infringement, since the mortgagor and not the mortgagee is the person for the time being entitled to the benefit of the patent, and consequently in the same position as the mortgagor of any other property whether real or personal (*e*).

Fraudulent agreements for the assignment of patents, such, for instance, as bubble patents, will be set aside (*f*). But in the absence of fraud the agreement will be enforced, and it is no defence to the action that the plaintiff has not invented the alleged invention (*g*).

Licences differ from assignments, in that the patentee granting a licence does not part with his whole interest, but grants merely a right to use the patent for the whole term or any portion of the whole term, that is merely a right to do that which without a licence could not be done except by violating the monopoly granted to and still vested in the licensor (*h*).

Sect. 22 of the Act of 1883 provides for the granting of **compulsory licences.**

"*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*

(*d*) *Axmann* v. *Lund*, L. R., 13 Eq. 330, 336.

(*e*) *Van Gelder Apsimon & Co.* v. *The Sowerby Bridge Flour Society*, 7 P. O. R. 208; *Fairclough* v. *Marshall*, L. R. 4 Ex. D. 37.

(*f*) *Lovell* v. *Hicks*, 2 Y. & C. 46.

(*g*) *Smith* v. *Buckingham*, 13 W. R. 314.

(*h*) *Heap* v. *Hartley*, 6 P. O. R. 495, 500; see also *Muskett* v. *Hill*, 5 Bing. N. C. 694, 707; *Thomas* v. *Sorrell*, Vaugh. Rep. 351; *Newby* v. *Harrison*, 1 J. & H. 393; 3 De G. F. & J. 287.

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."

These provisions are entirely novel; (a) and (b) are capable of being reasonably construed; as to "(c)" it is difficult to understand how the Board of Trade will come to a decision as to whether "a person is prevented from working or using, to the best advantage, an invention of which he is possessed." The "invention" must be protected by letters patent (see the construction given in sect. 46).

The proceedings under sect. 22 are regulated by Patent Rules, 1890, rr. 60—66.

A licence granted by the patentee may be **exclusive or otherwise**, that is, it may be a grant of the sole right to put the invention into practice, or of a right limited in time or in area, or of a right only to be exercised in conjunction with others; but as has been pointed out above, a licence, even though it may be exclusive, does not convey such an interest in the patent as to amount to an assignment of it.

Licences should be under seal, the prohibition in the grant itself being "without the consent, licence or agreement of the said patentee in writing under his hand and seal."

A licence granted by a patentee, but not under seal, is, however, not void in the sense that the licensee, having used the patent, is not bound to pay the royalties contracted for. In *Chanter* v. *Dewhurst* (*i*), it was held that the defendants, having obtained the licence they had bargained for, and kept it, were bound to pay for it; and secondly, that the licence was not void as not being under seal. Baron Alderson said: "The defendants, in making the machine in question, are merely acting as agents for the patentee . . . . in my opinion a licence for this purpose need not be under seal."

Although the words of the grant are "under his hand and seal," the document is not a deed, since it need not be delivered as a deed, nor need it be stamped as such (*k*).

In the absence of fraud **money paid by a licensee** for royalties

(*i*) 12 M. & W. 823. 408.

(*k*) *Chanter* v. *Johnson*, 14 M. & W.

cannot be recovered when it is ascertained that the patent was void *ab initio* (*l*). And if the licensees have kept the licence and used it, the licensor can recover from them the agreed royalties, although the patent may have been void and the licence not under seal (*m*); but otherwise, if the licensor knew from the first that the patent was void (*n*). But if the consideration for the money paid is that an application for a patent should be made and a licence to use the patent granted, no application being made for the patent, there is a total failure of consideration, and the price paid may be recovered (*o*). **A licence is not assignable** (*p*). A licence to a man and his assigns means a licence with power to licensee to sub-license (*idem*). A licensee may covenant not to manufacture without applying the patented invention; such a covenant is not in restraint of trade (*q*). A patentee having granted a licence cannot prevent anyone **vending the articles** which have been made in pursuance of the licence (*r*). And an inventor selling the patented article abroad cannot restrain its importation and sale in this country, although an assignee of the patent in this country might restrain the importation of an article made by the original inventor or his assignee abroad (*s*).

An exclusive licensee of an invention for a district cannot maintain an action against one who, having purchased a thing which was the subject-matter of the invention, should bring his purchase within such district without notice of the licence (*t*); registration at the Patent Office does not amount to notice to the whole world (*ibid.*). **A latent ambiguity** in a licence by deed may be explained by parol evidence in the same manner as other deeds (*u*). A licensor may in the licence deed stipulate for a

(*l*) *Taylor* v. *Hare*, 1 B. & P. (N. R.) 260.

(*m*) *Chanter* v. *Dewhurst*, 12 M. & W. 823.

(*n*) *Chanter* v. *Leese*, 4 M. & W. 295.

(*o*) *Knowles* v. *Bovill*, 22 L. T., N S. 70.

(*p*) Per Maule, J., in *Bower* v. *Hodges*, 22 L. J., C. P. 198.

(*q*) *Jones* v. *Lees*, 1 H. & N. 189

(*r*) *Thomas* v. *Hunt*, 17 C. B., N. S. 183.

(*s*) *Betts* v. *Willmott*, L. R., 6 Ch. 239; see also *Société Anonyme* v. *Tilghman*, L. R., 25 Ch. D. 1; 53 L. J., Ch. 1; 49 L. T. 451; 32 W. R. 71; *Heap* v. *Hartley*, 5 P. O. R. 610.

(*t*) *Heap* v. *Hartley*, 5 P. O. R. 603; 6 P. O. R. 495.

(*u*) *Roden* v. *The London Small Arms Co.*, 46 L. J., Q. B. 21

forfeiture in the event of royalties not being paid (*x*), but such forfeiture may be waived (*y*). The licensor may also agree that he will take all necessary steps to support the validity of the patent (*z*).

A licence may be created by parol (*a*), but whether by parol or under seal, if there is no time fixed for its duration (*b*), and no term in the licence which would necessitate a different construction (*c*), it may be determined at will by either party. In *Mills* v. *Carson* (*d*), the patentee granted by deed an exclusive licence to the defendant for the remainder of the term of the patent, in consideration of which the defendant agreed to pay 100*l.* per annum for the remainder of that term, such a condition was held to be totally inconsistent with a licence revocable at will. Express notice to revoke must be given, and the mere plea that the licence has been abandoned is not in itself sufficient (*e*).

A licensee cannot sue alone for infringement of the patent, and this would appear to be so even in the case of an exclusive licensee (*f*), who must sue either in the name of the patentee (*g*), or be joined with the patentee as co-plaintiff.

In *Renard* v. *Levinstein* (*h*), the licensees and the owners of the patent were joined as co-plaintiffs; while the action was pending, the owners parted with their interest to a third party; under these circumstances Wood, V.-C., overruled the objection that the plaintiffs did not show sufficient interest to maintain the action.

(*x*) *Ticlens* v. *Hooper*, 5 Exch. 830.

(*y*) *Warwick* v. *Hooper*, 3 M. & G. 60.

(*z*) *Henderson* v. *Mostyn Copper Co.*, L. R., 3 C. P. 202.

(*a*) *Crossley* v. *Dixon*, 10 H. L. Cas. 293; L. J., 32 Ch. 617, H. L.; *Chanter* v. *Dewhurst*, 12 M. & W. 823; 13 L. J., Ex. 198; *Post Card Automatic Supply Co.* v. *Samuel*, 6 P. O. R. 560.

(*b*) *Crossley* v. *Dixon*, 10 H. L. Cas. 293; *Redges* v. *Mulliner*, 10 P. O. R. 21, 27; *Cheetham* v. *Nuthall*, 10 P. O. R. 321, 333; see also *Wood* v. *Leadbitter*, 13 M. & W. 838; 9 Jur. 187; 14 L. J. Ex. 161.

(*c*) *Ward* v. *Livesay*, 5 P. O. R. 102, 106; *Guyot* v. *Thomson*, 11 P. O. R. 541, 554.

(*d*) 9 P. O. R. 338; 10 P. O. R. 9.

(*e*) *Cheetham* v. *Nuthall*, 10 P. O. R. 321, 333.

(*f*) *Heap* v. *Hartley*, 6 P. O. R. 495, 500; *Renard* v. *Levinstein*, 2 H. & M. 628; *Barnett* v. *Barrett*, 1 P. O. R. 9; see also *Woolley* v. *Broad*, 9 P. O. R. 208.

(*g*) *Heap* v. *Hartley*, at page 501.

(*h*) 2 H. & M. 628.

In *Cheetham* v. *Nuthall* (*i*), it was provided that the licence should determine if the patent was declared invalid; in an action brought by the licensor against a third party for infringement, the patent was held to be invalid, but this judgment was reversed by consent; the defendant after due notice continued to work under his licence, and it was held that he was still liable to pay royalties for the use of the invention.

An assignee of a share of the profits is entitled to an account of the profit from the person by whom they are payable; but the account should be taken once for all in the presence of all the persons interested (*j*).

Sect. 23 of the Act provides:—"(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* prima 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.*"

By sect. 85, "**There shall not be entered in any register** *kept under this Act, or be receivable by the comptroller, any notice of any* **trust,** *express, implied, or constructive.*" Sect. 87, as amended by sect. 21 of the Patents, &c., Act, 1888, provides for the entry in the register, at the request of the person becoming entitled, of any assignment or transmission of interest. The person registered shall have power to deal with such interest as he has registered, absolutely: "*Provided that any equities in respect of such patent, &c., may be enforced in like manner, as in respect of any other personal property.*" Sect. 88, as amended by sect. 22 of the Patents, &c., Act, 1888, deals with the inspection of registers, and the

(*i*) 10 P. O. R. 321. 17 Ch. D. 423.
(*j*) *Bergmann* v. *Macmillan*, L. R.,

obtaining of certified copies. By sect. 89 sealed copies are to be received in evidence.

The effect of these sections is to prohibit the entry upon the register of simple notices of trusts, but any other documents affecting the proprietorship of the patent, whether by creating trusts or otherwise, are not to be excluded (*k*); it has been already noticed that an assignment of a patent should be by deed, but an agreement to assign is an equitable assignment, and consequently may be entered on the register under section 23 (*l*), but the documents containing **the agreement** and entered on the register **must be complete**, and upon which specific performance of the agreement could be enforced, since otherwise no legal or equitable interest in the patent or proprietorship thereof would pass (*m*).

Sect. 90, as amended by sect. 23 of the Patents, &c., Act, 1888, empowers the Court (High Court of Justice) to order the alteration of the registers, upon the application of persons aggrieved, and upon sufficient cause shown. The comptroller may himself correct errors in registers which are merely of a clerical nature, sect. 91.

The comptroller may refuse to enter upon the register of patents a document dated before the patent, upon the ground that it does not contain a sufficient proof of title (*n*).

The regulations affecting registration under the above sections are contained in Patents Rules, 1890, rules 67—79.

Sect. 35 of the **Act of 1852**, after providing for the registration of proprietors, assignments, &c., of patents, proceeded: "Provided always, that, until such entries shall have been made, the grantee or grantees of letters patent shall be deemed and taken to be the sole and exclusive proprietor or proprietors of such letters patent, and of all licences and privileges thereby given or granted."

It will be observed that the Act of 1883, quoted above,

(*k*) *Stewart* v. *Casey*, 9 P. O. R. 9, 11, 15.

(*l*) Ibid., at p. 15; see also *In re Fletcher's Patent*, 10 P. O. R. 252.

(*m*) *In re Fletcher's Patent*, 10 P. O. R. 252, 255; *Haslett* v. *Hutchinson*, 8 P. O. R. 457, 466.

(*n*) *In re Parnell's Patent*, 5 P. O. R. 126.

materially differs from this enactment. Hence *Challett* v. *Hoffman* (*o*), and *Hassall* v. *Wright* (*p*), will not now apply.

Prior to the Act of 1883, the High Court of Justice exercised jurisdiction to alter and amend the register of patents (*q*).

The register should be amended whenever a fraudulent entry has been made. A patentee assigned half a 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:—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 (*r*).

Registration does not amount to notice to the whole world, so where the grant of an exclusive licence for a district had been entered on the register, it was held that this did not amount to notice so as to affect an innocent purchaser outside of that district bringing his purchase within the district in violation of the rights of the licensee (*s*).

A co-owner of a patent has no right to cause an entry to be made in the register, which purports to affect or prejudice the rights of the other, and should he do so, the entry will be expunged at the instance of the injured party (*t*).

(*o*) 7 Ell. & B. 686.

(*p*) L. R., 10 Eq. 509; 40 L. J., Ch. 145.

(*q*) *In re Morgan's Patent*, 24 W. R. 245.

(*r*) *In re Mosey's Patent*, 25 Beav. 581.

(*s*) *Heap* v. *Hartley*, 5 P. O. R. 603; 6 P. O. R. 495.

(*t*) *In re Horsley & Knighton's Patent*, L. R., 8 Eq. 475.

CHAPTER XIII.

ESTOPPEL.

HAVING assigned a patent, the original patentee cannot manufacture the patented article; should he do so and an action for infringement be brought against him by his assignee, he may not set up the defence that the patent is invalid; **he is estopped by his deed** (*a*), that is, by the deed of assignment, but when the assignment is by operation of law there is no such estoppel. In *Cropper* v. *Smith* (*b*), in 1873, letters patent for improvements in lace machines were granted to H., who in 1877 went into liquidation and the patent was sold by the trustee to the plaintiffs. H. afterwards entered into partnership with S., and this action was brought against S. and H. to restrain them from infringing the patent; held that H. was not estopped from disputing the validity of the patent either by matter of record, on the ground that the letters patent were of record; or by deed, by reason of the specification being under his seal; or by matter *in pais*, on the ground of the statements in his petition to the Crown, there being nothing to show that the plaintiffs bought on the faith of those statements. (But see Bankruptcy Act, 1883, sect. 50, sub-sect. 5.) It is probable that there is estoppel by record between the Crown and the grantee of letters patent (*c*), but this would only be against the subject, since **no estoppel operates against the Crown.** In an action brought by the assignor to enforce an agreement for an assignment of letters patent, it is

(*a*) *Oldham* v. *Langmead*, cit. in *Hayne* v. *Maltby*, 3 T. R. 438; *Lainson* v. *Tremere*, 1 A. & E. 792; *Chambers* v. *Crichley*, 33 Beav. 374.

(*b*) L. R., 26 Ch. D. 700; L. R., 10 App. Cas. 249; 1 P. O. R. 81; 2 P. O. R. 17.

(*c*) Per Fry, L.J., L. R., 26 Ch. D at p. 712.

not open to the assignee to challenge the validity of the patent (*d*).

An assignment of patent rights in a partnership dissolution deed will estop the retiring partner from subsequently setting up the invalidity of the patent by way of defence to an action brought by his late partners (*e*). But where the plaintiff and defendant had been partners, and had worked as such the defendant's patent, there being no deed between the plaintiff and defendant which inferred the validity of the patent, held that plaintiff was not estopped from denying the validity of the patent (*f*). And where partners are joined as defendants in an action for infringement, and one is assignor of the patent, the other is not debarred from setting up the pleas of invalidity (*g*).

In *Bowman* v. *Taylor and others* (*h*) the plaintiff sued the defendants for the non-payment of certain royalties due from the defendants to the plaintiff under a licence under seal for the use of the plaintiff's patent. The defendants defended on the grounds (1) that the invention was not a new invention, (2) that the plaintiff was not the first and true inventor, (3) that the specification was not sufficient—pleas which in effect endeavoured to put in issue the validity of the plaintiff's title. Upon demurrer, Taunton, J., said, "The law of estoppel is not so unjust or absurd as it has been too much the custom to represent. The principle is, that where a man has entered into a solemn engagement by deed under his hand and seal as to certain facts, he shall not be permitted to deny any matter which he has so asserted. The question here is, whether there is a matter so asserted by the defendant under his hand and seal that he shall not be permitted to deny it in pleading. It is said that the allegation in the deed is made by way of recital, but I do not see that a statement such as this is the less positive because it is introduced by a 'whereas.' Then the defendant has pleaded

(*d*) *Smith* v. *Buckingham*, 21 L. T. 819; 18 W. R. 314; *Liardet* v. *Hammond Electric Light Co.*, 31 W. R. 710; *Hall* v. *Conder*, 26 L. J., C. P., 138; 3 Jur. N. S. 366; 2 C. B., N. S. 22.

(*e*) *Chambers* v. *Crichley*, 33 Beav. 374.

(*f*) *Axmann* v. *Lund*, L. R., 18 Eq. 330; 22 W. R. 789.

(*g*) *Heugh* v. *Chamberlain*, 25 W. R. 742.

(*h*) 2 A. & E. 278.

that the supposed invention in the declaration and letters patent mentioned was not nor is a new invention. These words 'was not nor is a new invention' must be understood in the same sense as the words 'had invented' in the recital of the deed set out in the declaration, and must refer to the time of granting the patent, and if the invention could not then be termed a new invention, it could not, I think, have been truly said in the deed, that the plaintiff 'had invented' the improvements in the sense in which the deed uses the words. Then the plea directly negatives the deed, and comes within the rule that a party shall not deny what he has asserted by his solemn instrument under hand and seal." The learned judge then proceeds to distinguish *Hayne* v. *Maltby* (*i*), but for some reason does not refer to the element of fraud in that case, which certainly would take it out of the operation of the doctrine of estoppel.

Bessman v. *Wright* (*k*) was decided on the ground of partial as against total failure of consideration, and has no reference to the doctrine of estoppel, although it seems sometimes to have been thought that it had.

In *Adie* v. *Clark* (*l*), James, L.J., said, "A licensee cannot under any pretence whatever bring his licensor into litigation as to the novelty of any part of the patent." This case was afterwards affirmed in the House of Lords (*m*). But it appears that if the licence has been determined prior to the expiration of the term of the patent the ex-licensees may contest the validity of the patent, notwithstanding the covenants or recitals in the licence (*n*). In giving judgment, Lord Cottenham said, "That is exactly coming to the point which I put, whether, at law, the party was estopped from disputing the patentee's right, after having once dealt with him as the proprietor of that right. And it appears from the authority of that case (*Hayne* v. *Maltby* (*o*)), and from the other cases, that from the time of the last payment (*i.e.* expiration of licence), if the manufacturer can successfully resist the patent right of the party claiming the rent,

(*i*) 3 T. R. 438.
(*k*) 6 W. R. 719.
(*l*) L. R., 3 Ch. D. 144.
(*m*) L. R., 2 App. Cas. 423.
(*n*) *Neilson* v. *Fothergill*, 1 Web. P. C. 287.
(*o*) 3 T. R. 438.

that he may do so in answer to an action for the rent for the use of the patent during that year." The language is not clearly reported, but this appears to mean—to an action for the use and occupation, so to speak, of the patent after the expiration of the licence.

The following cases have been decided uniformly, and show that parties to a deed of assignment or licence are estopped from denying the validity of the patent, and that there is no implied warranty on the part of the assignor or licensor. *Cutler* v. *Bower* (*p*), *Smith* v. *Scott* (*q*), *Walton* v. *Lavater* (*r*), *Norton* v. *Brooks* (*s*), *Crossley* v. *Dixon* (*t*).

An assignor of a patent cannot be restrained from giving evidence in an action for infringement brought by the assignee against a third party, although such evidence should tend to prove that the patent is in fact bad (*u*).

If a patentee in granting a licence should expressly warrant the validity of the patent, and thereby confer upon the licensee the right to dispute its validity, the licensee will not be estopped from relying on this defence in an action brought against him by the licensor (*x*).

Mills v. *Carson* (*y*) was an action for royalties due under an indenture made between the patentee *W. Notley* of the one part, and the defendants *J. A. Carson* and *D. Coleman Defries* of the other part, whereby an exclusive licence to use the invention was granted to the defendants. One of the terms of the agreement was that the patentee or his assigns would at the request of the defendants, take proceedings against any person infringing the patent, and it was further agreed that "if the said *W. Notley* should at any time omit or refuse to take such proceedings as aforesaid, and if the said letters patent should become void or ineffectual by reason of any such omission or refusal on the part of the said *W. Notley*, or *by reason of the said invention not being*

(*p*) 11 Q. B. 973.
(*q*) 6 C. B., N. S. 771, and 28 L. J., C. P. 325.
(*r*) 8 C. B., N. S. 162.
(*s*) 7 H. & N. 499.
(*t*) 10 H. L. Cas. 293.
(*u*) *London and Leicester Hosiery Co.* v. *Griswold*, 3 P. O. R. 251.
(*x*) *Wilson* v. *Union Oil Mills Co.*, 9 P. O. R. 57; *Mills* v. *Carson*, 10 P. O. R. 17.
(*y*) 9 P. O. R. 333; 10 P. O. R. 9.

novel, or being an infringement of other letters patent, then the payment of the said annual sum under the indenture should cease and determine." Relying upon this condition the defendants set up the defence that the invention was not new; it was held that they were estopped from doing so, and that the words, "by reason of the said invention not being novel," meant, if it was proved not to be novel in an action brought for infringement by the patentee at the instigation of the defendants (*x*).

But where the defendant took a licence from the plaintiff to work his invention "**subject to the result of an enquiry into the validity of the patent,**" and after the expiration of six months refused to continue to work the plaintiff's process on the ground that the patent was bad, it was held, in an action for royalties under the agreement, that it was open to the defendant to contest the validity of the plaintiff's patent (*a*).

The licensee may refer to the state of public knowledge at the date of the patent for the purpose of showing what is the true ambit of the specification (*b*), and he may, following the analogy of lessor and lessee, show that the patent in question has in fact expired (*c*).

Fraud is practically the only plea which a licensee can put forward in an action brought against him for the recovery of royalties, but this must be distinctly pleaded (*d*), beyond that the only reply that is left to the licensee is that he has not worked the patent in question (*e*).

Where the plaintiff, **fraudulently asserting** that he had **a right to a patent**, induced the defendant to come to terms with him for a licence to use that patent, the defendant, in an action upon that agreement, is not estopped from alleging the want of title in the plaintiff as a defence (*f*). But it would be

(*x*) 10 P. O. R. 17, 18.

(*a*) *Wilson* v. *Union Oil Mills Co.*, 9 P. O. R. 57.

(*b*) *Young* v. *Hermand*, 9 P. O. R. 373; see also *Crosthwaite* v. *Steel*, 6 P. O. R. 190.

(*c*) *Muirhead* v. *Commercial Cable Co.*, 11 P. O. R. 317.

(*d*) *McDougall* v. *Partington*, 7 P. O. R. 223; *Ashworth* v. *Law*, 7 P. O. R. 234.

(*e*) *Clarke* v. *Adie*, L. R., 2 App. Cas. 423, 435.

(*f*) *Hayne* v. *Mallby*, 3 T. R. 438.

otherwise in the absence of fraud and where both parties are innocent, in that case neither the assignee nor licensee would be allowed to set up as a defence the bad title of the assignor or licensor (*g*).

After the termination of the license, the licensee is no longer estopped from denying the validity of the patent (*h*).

Judgment having been recovered against the defendant in an action for infringement, such defendant cannot plead the invalidity of the patent as a defence to a subsequent action brought against him for an infringement of the same patent, he is **estopped by the first judgment**, and this is so, even though the first judgment was entered by consent (*i*); but where the defendants in the second action are not the same as those in the first, there will be no estoppel (*k*), though in such a case, if the patent had been previously upheld by a court of co-ordinate or superior jurisdiction, strong additional evidence will be required in order to reverse the previous finding (*l*).

The Act of 1883 abolished proceedings by *scire facias* to repeal a patent, and substituted therefor petition to the Court. It was at one time thought that since the Crown had ceased to be a party to proceedings to revoke a patent, estoppel would operate as regards question of fact which had been decided in a previous action between the same parties, this point has now been decided by the Court of Appeal in *Re Deeley's Patent* (not yet reported). An action for infringement of that patent had been previously brought by the patentee against the present petitioner (*m*), in which it was held that the first claim had been anticipated by Perkes' patent of 1878; this claim was again attacked on the same grounds in the **petition for revocation**, in which the parties

(*g*) *Taylor* v. *Hare*, 1 Web. P. C. 292, 293.

(*h*) *Axmann* v. *Lund*, L. R., 18 Eq. 337; *Goucher* v. *Clayton*, 11 Jur., N. S. 107; 34 L. J., Ch. 239.

(*i*) *Thomson* v. *Moore*, 6 P. O. R. 426, 431, 441; 7 P. O. R. 325.

(*k*) *Goucher* v. *Clayton*, 11 Jur., N. S. 107; 34 L. J., Ch. 239; *Otto* v. *Steel*, 3 P. O. R. 109, 114.

(*l*) *Bovill* v. *Goodier*, 35 Beav. 427; *Otto* v. *Steel*, 3 P. O. R. 109, 114; *Slazenger* v. *Feltham*, 6 P. O. R. 130; *Automatic Weighing Machine Co.* v. *Combined Co.*, 6 P. O. R. 120, 367; *Edison* v. *Holland*, 6 P. O. R. 243; *Shaw* v. *Day*, 11 P. O. R. 189.

(*m*) *Westley Richards* v. *Perkes*, 10 P. O. R. 181, 190.

were the same as in the action for infringement, the Court of Appeal held that there was no estoppel, on the grounds that a petition for revocation is a petition presented on behalf of the public, and it is immaterial that the person so representing the public should happen to have been a party to a previous action when the same facts were in dispute.

"An estoppel must be certain to every intent and not be taken by argument or inference" (*n*); so where a question of infringement was submitted to an arbitrator, who, in his award found that the letters patent were not illegal or void, in a subsequent action for infringement against the same defendant, it was held that the **arbitrator's award** was not such a decision as to make an estoppel within the above cited rule (*o*).

A licensee cannot take advantage of a judgment obtained by third parties against the patentee declaring the patent bad (*p*). But a licensee, in an action by the patentee, may claim to place the most **favourable construction** on the specification, which will support the validity of the patent, if another construction would make it bad (*q*).

(*n*) Com. Dig. tit. Estoppel (E 4).

(*o*) *Newall* v. *Elliot*, 32 L. J., Ex. 120.

(*p*) *The Grover & Baker Sewing Machine Co.* v. *Millard*, 8 Jur., N. S. 713.

(*q*) *Trotman* v. *Wood*, 16 C. B., N. S. 479.

CHAPTER XIV.

EXTENSION OF TERM OF PATENT.

SECT. 25 of the Act of 1883 provides:

"(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 time; but such petition must be presented at least six months before the time limited for the expiration of the patent.*"

The period of six months limited by this sub-section will not apply to patents granted before the 1st January, 1884. With regard to such patents, the provisions of 5 & 6 Will. IV. c. 83, will apply, and applications for extension may be made at any time prior to the expiration of the patent; this is by reason of the 113th section of the Act of 1883 (*a*). But once a patent is extended it becomes a new patent, and the whole of the Act of 1883 applies to it (*b*).

"(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.*

(*a*) *Brandon's Patent*, L. R., 9 App. Cas. 589; 53 L. J., P. C. 84; 1 P. O. R. 154

(*b*) *Cocking's Patent*, 2 P. O. R. 151.

"(5) *If the Judicial Committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for her Majesty in Council to extend the term of the patent for a further term, not exceeding seven, or, in exceptional cases, fourteen years; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee may think fit.*"

It is the practice to grant a new patent, such new patent being subject to the conditions in the Act of 1883 (*c*).

"(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.*"

These provisions have made **no substantial alteration in the law.** Prior to the Act 5 & 6 Will. IV. c. 83, there was no power in the Crown to extend the duration of letters patent, and should an inventor have desired to apply for an extension of the term of his grant, he could only do so by applying for and obtaining a **special Act of Parliament** in his favour. The Act of Will. IV., and the amending Act of 2 & 3 Vict. c. 67, introduced the method of petitioning and obtaining an extension to the Privy Council.

It had been found that the procedure to obtain an Act upon each occasion, when an extension was sought, was too costly and cumbrous, hence the modern course of procedure was devised.

This being shortly the origin of the jurisdiction of the Privy Council, at first an impression gained ground that the Privy Council were to put themselves in the position of Parliament, and not in that of a court of law, in considering the claims of applicants who appeared before them; that they were to weigh the claims of the **public interest** very heavily in the balance as against the inventor. In *Re Soame's Patent* (*d*), Lord Brougham

(*c*) *Smith's Patent*, Griff. P. C. 263. (*d*) 1 Web. P. C. 729.

said: "If this case were to be disposed of upon the ground which, in arguing such cases, has sometimes been assumed to be the fit one, that there must not only be merit and benefit to the public, and (which is essential) a want of sufficient remuneration in the course of using the patent; but that, moreover, the case is to be tried here as on a bill in parliament introduced to prolong the patent; then, I apprehend, there can really be no doubt whatever that in this case no bill would ever have passed through the two houses of parliament."

The true construction is, however, not so severe as that, although still sufficiently severe. In *Re Morgan's Patent* (*e*), Lord Brougham said: "It is by no means their (the Privy Council) course to put themselves precisely in the situation of the Legislature, and never to grant an extension where an Act of Parliament would not have been obtained. At the same time there are some limits to this. They are to look to a certain degree at the position in which they are placed, and to consider that they here represent the Legislature, and that they are invested with somewhat similar powers of discretion to those exercised formerly by the whole three branches of parliament."

Such is **the spirit in which the Privy Council will approach the subject** of an extension, not benevolently to the applicant, but still with not so stern a regard to the interests of the public as parliament would entertain.

In considering their decision the Privy Council will consider:—

1. The nature and merits of the invention in relation to the public.

2. The adequacy or inadequacy of the profits made by the inventor as such.

3. The circumstances of the case.

In *Re Erard's Patent* (*f*), Lord Lyndhurst said: "In cases of this kind we expect a very strong **case of hardship** to be made out as well as a strong case upon the **utility of the invention**;" and the same privy councillor in *Soame's case* (*g*) said: "We consider the invention as very meritorious, the result of a great deal of labour, care, and science, and that it is extremely useful in its effects. We are satisfied by reasonable evidence that the

(*e*) 1 Web. P. C. 737.
(*f*) 1 Web. P. C. 557.
(*g*) 1 Web. P. C. 729.

party has sustained very **considerable loss**, and under these circumstances we think that the period ought to be extended."

It will be observed that the three considerations for the Privy Council laid down by the Act of 1883 are almost identical to the grounds of extension as given by Lord Brougham in *Re Derosne's Patent* (*h*): "The parties must show in the first place some invention, in the next place a benefit to the public, and in the third place that they have not had adequate remuneration."

It is immaterial whether or not the application is opposed. The Privy Council will require every necessary ground for extension to be **strictly proved** before they advise an extension (*i*), and this even though the Crown through the attorney-general consents (*k*).

"The merit of an **importer** is less than of an inventor. We are sitting judicially, and it is an argument against the patent that it is imported and not invented. I do not say it takes away the merit, but it makes it much smaller" (*l*).

Where it appeared that the imported invention had great commercial value, and that the petitioners had embarked a large capital in bringing the patent into use, whereby they had sustained a loss of nearly £10,000, an extension for six years was granted (*m*).

Extension of the term will be granted to **assignees**, as they have, so to speak, purchased the merit of the original inventor, but the argument against importers will apply with equal force against assignees (*n*).

In *Whitehouse's Patent* (*o*), the inventor was a mechanic in the employ of the petitioner, the petitioner was the assignee of the patent, and had expended large sums of money on the necessary plant and machinery; an extension was granted for six years, on **condition** that the petitioner secured to Whitehouse an annuity of £500 during the term of the patent.

(*h*) 2 Web. P. C. 4.

(*i*) *In re Perkin's Patent*, 2 Web. P. C. 6.

(*k*) *In re Cardwell's Patent*, 10 Moo. P. C. C. 488; see also *Darby's Patent*, 8 P. O. R. 380, 383.

(*l*) Per Lord Brougham, *In re Soame's Patent*, 1 Web. P. C. 729.

(*m*) *Berry's Patent*, 7 Moo. P. C. C. 187.

(*n*) See *In re Napier's Patent*, 13 Moo. P. C. C. 543. See also *Norton's Patent*, 1 Moo. P. C., N. S. 339; *Pitman's Patent*, L. R., 4 P. C. 84; 8 Moo. P. C., N. S. 293.

(*o*) 1 Web. P. C. 473; see also *Hardy's Patent*, 6 Moo. P. C. C. 441.

"Merit" here means the consideration which has been given to the state for the patent; it does not mean the merit of the inventor, but the **merit of the consideration** which he has given. An inventor may have diligently worked for years in a most deserving manner, and yet have produced an improvement of the most trifling nature—the merit of the person in this case will not be considered. On the other hand, the invention, although a great one, may have been handed to him from abroad without thought or trouble on his part. This is what Lord Brougham contemplates when he says that the merit of an importer is less than that of an inventor. Again, the invention may have been a very simple one, produced by an inventor with a moment of thought, and yet of great importance to the world. This latter case would be one of merit—simplicity of an invention being an element of its value (*p*).

In *Bailey's Patent* (*q*), Lord Blackburn said: "What the statute says is that the judicial committee shall, in considering their decision, have regard to the *nature and merits of the invention* before that evidence has been called which shows what can hardly be disputed, viz., that the invention which is the subject of the patent is a beneficial invention; but as to the petitioner showing that there was any *special or peculiar advantage* in the invention in relation to the public to entitle the patentee to the large reward of an extension of his patent, their lordships are of opinion that he has totally failed to do so."

To sustain a petition for prolongation, a greater **degree of merit** must be shown, than that which would be sufficient to support the patent in a court of law (*r*).

The Privy Council will not inquire into the **novelty or utility** of a patent, except in so far as such novelty or utility may form elements in the consideration of the merit of the invention (*s*), unless the patent is clearly invalid (*t*).

(*p*) *In re Muntz's Patent*, 2 Web. P. C. 113.

(*q*) Griff. P. C., at p. 254.

(*r*) Per Sir W. Grove, *In re Stoney's Patent*, 5 P. O. R. 520; see also *Saxby's Patent*, L. R., 3 P. C. 292, 294.

(*s*) *In re Saxby's Patent*, L. R., 3 P. C. 292; *Stewart's Patent*, 3 P. O. R. 7; *Kay's Patent*, 1 Web. P. C. 568; 3 Moo. P. C. C. 24.

(*t*) *Erard's Patent*, 1 Web. P. C. 557; *Woodcroft's Patent*, 2 Web. P. C. 18.

Non-user of the patent creates a strong presumption against the merit of an invention, which presumption can only be rebutted by the strongest evidence (*u*). But the same objection being raised in *Re Hughes' Patent* (*x*), the application was granted after strong and unanswered evidence of merit, though the patent had not been used in England during the whole term (*y*).

In *Re Botts' Patent* (*z*) Lord Chelmsford said: "Dobbs' specification may have given the petitioner the idea of the possibility of uniting the two metals tin and lead, and may thus have deprived him of the merit of originality. But in Dobbs' hands the discovery was barren; the petitioner, however, who followed out his suggestion, and after repeated experiments gave it a practical application, is the **real benefactor to the public**, and is entitled to claim that description of **merit** which constitutes one of the grounds for extending the term of a patent" (*a*).

Where the applicants are a company who have purchased the patent for the purpose of trading with it, and not at all with the view of encouraging or rewarding the inventor, and an extension of the term of the patent would confer no benefit upon the latter at all, the application will be refused (*b*), but otherwise, if the inventor will reap a profit from the extension (*c*).

Where part of the invention is sufficiently meritorious and part not so, an extension of the term will be granted for the meritorious part only (*d*).

Merit is a vague term. Different persons have different ideas as to wherein it consists. Each case that comes before the Privy Council must of necessity, therefore, be decided upon the facts of that particular case. It is otherwise with the other necessary condition for an extension, viz., the inadequacy of the remune-

(*u*) *In re Allan's Patent*, L. R., 1 P. C. 507; 4 Moo. P. C., N. S. 443; *Bakewell's Patent*, 15 Moo. P. C. C. 385.

(*x*) L. R., 4 App. Cas. 174.

(*y*) See also *In re Wright's Patent*, 1 Web. P. C. 575; *In re Herbert's Patent*, L. R., 1 P. C. 399; 4 Moo. P. C., N. S. 300: *Southby's Patent*, 8 P. O. R. 433.

(*z*) 1 Moo. P. C., N. S. 49.

(*a*) See also *In re Hill's Patent*, 1 Moo. P. C., N. S. 258, at p. 265.

(*b*) *Norton's Patent*, 1 Moo. P. C. N. S., 339; *Sillar's Patent*, Good P. C. 581, 582.

(*c*) *Houghton's Patent*, L. R., 3 P. C. 461; 7 Moo. P. C., N. S. 309.

(*d*) *Bodmer's Patent*, 8 Moo. P. C. C. 282; *Lee's Patent*, 10 Moo. P. C. C. 226; *Church's Patent*, 3 P. O. R. 95; *Joy's Patent*, 10 P. O. R. 89.

ration of the inventor. Here figures can be dealt with, and a nearer approach to uniformity of decision obtained. It is possible, therefore, to gather from the various decisions a reasonably accurate set of rules for the guidance of the applicant for an extension on the ground of the inadequacy of the remuneration.

The **sufficiency of the remuneration** will be estimated with a view to the **importance of the invention** and the **benefit the public** have derived from it. That which would be ample remuneration for one patent would be considered inadequate for another. Refining sugar by filtering it through animal charcoal was an invention of great value and importance. The patent was extended for six years on the ground that although there had been a considerable profit it bore no relation to the great merit of the invention (*e*). So in *Re Newton's Patent* (*f*) the Privy Council granted an extension on the ground that there had not been sufficient remuneration considering the value of the invention.

If the patentee is a manufacturer of the patented article, the Privy Council will not endeavour to distinguish accurately **his profits** as a patentee from his profits **as a manufacturer**, but will consider the gross amount of profits (*g*). In this case Lord Brougham said: "We cannot weigh in golden scales the proportions between manufacturers' profits and patentees, but we must take it in the gross, and apply our minds as men of the world, men of business—neither unfairly towards the inventor, nor extravagantly and romantically towards him in his favour—neither against him pressing, nor in his favour straining. We must ascertain whether he has, in the eyes of men of ordinary but enlightened understandings, judging fairly between him and the public, had a sufficient remuneration."

The ground of this view of the case appears to be that the possession of the patent has placed the manufacturer in an advantageous position in obtaining orders (*h*).

(*e*) *In re Derosne's Patent*, 2 Web. P. C. 1.

(*f*) 14 Moo. P. C. C. 156.

(*g*) *In re Muntz's Patent*, 2 Web. P. C. 113.

(*h*) *In re Johnson's Patent*, 8 Moo. P. C., N. S. 282; also *Saxby's Patent*, L. R., 3 P. C. 292; 7 Moo. P. C., N. S. 82.

In the accounts which the patentee must file upon an application for an extension, when he is a **manufacturer of the patented article** he should, so far as possible, distinguish profits as a manufacturer from profits as a patentee (*i*); and in cases where it can be shown that the reasoning in *Johnson's case* (*supra*) does not apply, he will be allowed to deduct his profits as a manufacturer before an estimate is taken of his profits as a patentee (*k*).

But where he ascribed two-thirds of the profits to the manufacturer, and only one-third to the patent, it was held to be unreasonable (*l*).

It will be observed that the cases quoted above appear to conflict with the principles laid down by Lord Brougham in *Muntz' case* (*m*). These words cannot be read as meaning that no regard whatever will be paid to the fact, that a great portion of the patentees' plant, expenditure, or time, is devoted to the business of an ordinary manufacture, from which some profits would be derived, even if no patent were in existence, but that no attempt will be made to go into minute details of figures. The profits will be treated in gross, and then their lordships will apply their general knowledge, as men of the world, in coming to a conclusion as to how much the patentee has received from the profits of his invention.

In estimating profits, a deduction will be allowed for the **expenses of experiments** in bringing the invention to perfection (*n*). And also in respect of the **costs of litigation** necessary to maintain the validity of the patent, and to restrain infringers (*o*). But not where actions have been compromised, improvidently, and costs abandoned without sufficient reason (*p*). The **expenses of taking out the patent** will be allowed as a deduction (*q*). So also will the **expenses incurred in bringing the**

(*i*) *In re Betts' Patent*, 1 Moo. P. C., 739; also *In re Kay's Patent*, 1 Web. N. S. 49.

(*k*) Ib.

(*l*) *In re Hill's Patent*, 1 Moo. P. C., N. S. 258; also *Duncan & Wilson's Patent*, 1 P. O. R. 257.

(*m*) 2 Web. P. C. at p. 120.

(*n*) *In re Bate's Patent*, 1 Web. P. C. P. C. 568.

(*o*) *In re Galloway's Patent*, 1 Web. P. C. 724.

(*p*) *In re Hill's Patent*, 1 Moo. P. C., N. S. 258.

(*q*) *In re Roberts' Patent*, 1 Web. P. C. 573.

invention in general public use (*r*). And a deduction will be allowed in respect of the **personal expenses of the patentee**, and by way of salary for the exclusive devotion of his time in bringing the patent into practical operation and public notice (*s*). A patentee residing in America, for the purpose of getting the patented article into general use in England, employed **an agent** and allowed him half profits. This half was allowed to be deducted (*t*).

But, on the other hand, the patentee must add to his **profits** the profits arising out of the **manufacture** of the patented article, even though intended **for exportation** (*u*).

So also he must add the profits which have been made by any other persons interested in the patent, such as **his licensees** (*x*) or **the assignees** of a part, with free right to use the invention (*y*).

And in *Re Johnson's* patent Lord Justice James said: "Their lordships are of opinion, that where the question to be considered is, whether an invention has been sufficiently remunerated or not, in taking into consideration the remuneration received, they must have regard to the remuneration which the invention has brought in to the patentee, or the person who claims the right of the patentee, *whether it be in one country or another*" (*z*).

We have seen by sub-section 6 of the section of the Act of 1883, now under consideration, the rules of the Privy Council, which have been heretofore in force, are to continue until amended or altered.

Rule 9 is as follows:—"A party applying for an extension of a patent . . . . 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." This must be done within one week of the hearing: rule 10.

(*r*) *In re Galloway's Patent*, supra.

(*s*) *In re Carr's Patent*, L. R., 4 P. C. 539.

(*t*) *In re Poole's Patent*, 4 Moo. P. C., N. S. 452.

(*u*) *In re Hardy's Patent*, 6 Moo. P. C. C. 441.

(*x*) *In re Trotman's Patent*, L. R., 1 P. C. 118; 3 Moo. P. C., N. S. 488; but see *Thomas' Patents*, 9 P. O. R. 367, 373.

(*y*) *Thomas' Patents*, 9 P. O. R. 367.

(*z*) L. R., 4 P. C. 75; 8 Moo. P. C. N. S. 282: see also *Hardy's Patent*, 6 Moo. P. C. C. 441.

The judicial committee will not enter into the accounts in a case for extension unless they have been filed in accordance with this rule (*a*).

But in exceptional cases, the **filing of perfect accounts may be excused** (*b*). Where the estate of a deceased patentee was of little value, and no accounts had ever been kept, the petitioner, the administratrix and widow of the patentee, was examined to prove an allegation in the petition, to the effect that not only had there been no profits, but a considerable loss (*c*).

And where the invention was of **exceptional merit** and it was clear that a loss of about £8,000 had been incurred, it was held that extreme accuracy in the accounts was unnecessary (*d*).

The **account** of profit and loss ought to be **clear and precise** (*e*). The application will be refused if the petitioner's accounts are unsatisfactory (*f*). The accounts furnished by the petitioner not containing sufficiently full and accurate information in respect of the patent, or the remuneration received by him, the judicial committee declined to recommend a prolongation of the term (*g*). In one case, the accounts being *primâ facie* unsatisfactory, the judicial committee directed the question of accounts to be taken before considering the merits of the invention (*h*). And where the accounts were *primâ facie* satisfactory, the petitioners were allowed to prove the merits of the invention before going into the accounts (*i*). The books of the petitioner in respect to profits arising from his patent having been lost during his bankruptcy, the account of profit and loss was taken upon his own evidence (*k*). This was an exception to the general rule, which is, that evidence will not be received from the petitioner; but in the

(*a*) *In re Johnson's & Atkinson's Patent*, L. R., 5 P. C. 87; and see *In re Yates' & Kellett's Patent*, L. R., 12 App. Cas. 147.

(*b*) *In re Lowe's Patent*, 10 Jur. 363.

(*c*) *In re Heath's Patent*, 8 Moo. P. C. C. 217.

(*d*) *In re Darby's Patent*, 8 P. O. R. 380, 384.

(*e*) *In re Betts' Patent*, 1 Moo. P. C., N. S. 49; *In re Saxby's Patent*, 7 Moo. P. C., N. S. 82; *In re Lake's Patent*, 8 P. O. R. 227; but see *In re Deacon's Patent*, 4 P. O. R. 119, 122.

(*f*) *In re Trotman's Patent*, 3 Moo. P. C., N. S. 488.

(*g*) *In re Clark's Patent*, 7 Moo. P. C., N. S. 255.

(*h*) *In re Wield's Patent*, L. R., 4 P. C. 89.

(*i*) *In re Houghton's Patent*, L. R., 3 P. C. 461; 7 Moo. P. C., N. S. 309.

(*k*) *In re Hutchinson's Patent*, 14 Moo. P. C. C. 364.

absence of the books, without reasonable excuse, everything will be taken most strongly against the petitioner (*l*).

Where a patentee, whether English or foreign, has obtained **foreign patents**, they **should be stated** in a petition for prolongation, and the fullest information afforded as to the profits thereof (*m*). A patentee should preserve the clearest evidence of everything which has been paid or received on account of the patent. Whether or not his remuneration has been adequate, his furnishing a satisfactory account is a condition precedent to his obtaining an extension of his term (*n*), and no alteration has been made in this respect by sect. 25, sub-sect. 4 of the Act of 1883 (*o*).

Should the accounts filed in the first instance be unsatisfactory, an adjournment of the hearing will sometimes be granted to allow the petitioner to **amend** (*p*), but good reason must be disclosed, as otherwise the petition will be dismissed (*q*).

The third head of subjects to be inquired into, upon an application for prolongation, consist of the various grounds of objections to an extension which have been allowed hitherto by the committee, and which are included in the general term used in sub-sect. 4, viz., "**All the circumstances of the case.**"

That the invention has **not been brought into public use** is a good ground of objection (*r*), but if the invention is shown to be exceedingly meritorious, and the fact of non-user by the public satisfactorily explained, this will amount to a special circumstance which will be taken into consideration by the committee in support of the petition for extension (*s*). **Negligence** on the part of the patentee **in restraining infringement** is a good ground of objection (*t*). So also that the invention was practically **useless**

(*l*) *In re Lawrence's Patent*, 9 P. O. R. 5 P. C. 87.

(*m*) *Newton's Patent*, 1 P. O. R. 177.

(*n*) *In re Adair's Patent*, L. R., 6 App. Cas. 176.

(*o*) *Newton's Patent*, L. R., 9 App. Cas. 592.

(*p*) *Perkins' Patent*, 2 Web. P. C. 6; *Johnson's & Atkinson's Patents*, L. R., 85; see also *Yates' & Kellett's Patent*, L. R., 12 App. Cas. 147; 4 P. O. R. 150.

(*q*) *Newton's Patent*, 1 P. O. R. 177; L. R., 9 App. Cas. 592; also *Yates' & Kellett's Patent*, L. R., 12 App. Cas. 147; 4 P. O. R. 150.

(*r*) *In re Pinkus' Patent*, 12 Jur. 233.

(*s*) *Roper's Patent*, 4 P. O. R. 201.

(*t*) *In re Simister's Patent*, 1 Web. P. C. 721; also *In re Pinkus' Patent*, supra.

as originally described in the specification, but was subsequently made practicable by subsequent improvements, introduced from abroad (*u*). But, otherwise, where the invention was useful and meritorious, in its original form, subsequent improvements form no ground in support of objection (*x*). When the non-profitable use of the patent has been caused by the fault of the patentee himself, objection will be allowed (*y*). So also where a patentee has delayed, intentionally, putting his invention into practice, unless he can show that shortness of funds, or other reasons, placed it out of his power to avoid the delay (*z*).

False statements made as to profits **in the prospectus of a company** floated for the purpose of manufacturing under the patent will be taken into consideration by the committee (*a*). **Insufficiency of the specification** with regard to disclosure of the method of putting the invention into practice is an objection (*b*). **Where the patentee had an accident**, through the effects of which he was incapacitated for eight years from pushing his invention, the committee considered this to be a special circumstance, and having regard to the other facts of the case granted an extension for a period of seven years (*c*).

A grant by the patentee of an **exclusive license** to work his invention, together with a covenant to continue such exclusive license in the event of a renewal being granted, is a good ground of objection (*d*), but where the licensee had no rights to the exclusive use of the patent during any period of prolongation that might be granted, and it did not appear that the interest of the public had been in any way affected by the grant of the exclusive license, it was held that this was no objection to the petition for extension (*e*), and in *Shone's Patent* (*f*) an extension

(*u*) *In re Woodcroft's Patent*, 1 Web. P. C. 740.

(*x*) *In re Galloway's Patent*, 1 Web. P. C. 724; *In re Southby's Patent*, 8 P. O. R. 433; but see *Nussey & Leachman's Patent*, 7 P. O. R. 22.

(*y*) *In re Patterson's Patent*, 6 Moo. P. C. C. 469.

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

(*a*) *In re Lawrence's Patent*, 9 P. O. R. 332.

(*b*) *In re Livet's Patent*, 9 P. O. R. 332.

(*c*) *In re Roper's Patent*, 4 P. O. R. 201.

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

(*e*) *In re Darby's Patent*, 8 P. O. R. 380.

(*f*) 9 P. O. R. 438.

was granted subject to the condition that the exclusive licensee abandoned all right and benefit under the license.

We have seen that the novelty or utility of a patent will not be inquired into, except so far as they bear upon the merit of the invention. Nor will the validity of the patent be inquired into, excepting in cases where it is **obvious the patent is invalid.** In *Re Hill's Patent* (*g*), Sir J. T. Coleridge said: "Their lordships have not in these cases been in the habit of trying the validity of patents. They will not, of course, recommend the extension of a patent which is manifestly bad; but, on the other hand, they will not generally enter into questions of doubtful validity. They lay aside, therefore, the questions of **want of novelty** and **want of utility,** so far as they affect the validity of the patent. Indeed the learned counsel for the opponents disclaimed, and very properly, any intention of impeaching its validity directly; but they contended that, both with respect to the novelty and the utility of the invention, the degree of merit to be attributed to the petitioner ought to be taken into account; and in their lordships' judgment they are right in that contention. Unless the patent be very clearly invalid, so that it would be altogether nugatory to prolong that patent, the court usually has been rather inclined to assume that the patent may be a good patent, and so leave the question to any legal consideration that may arise in a contest between the parties who are interested in it" (*h*).

An illustration of what is meant by the patent being **clearly bad** is given in *Re M'Innes' Patent* (*i*). The patent was for a metallic soap to be used for the purpose of preserving metals from rust. The specification was very widely worded. Sir W. Earle said, "Their lordships taking into consideration with reference to the public interest that the individual substance for the application of which the patent is sought to be prolonged is not specially defined, every kind of metallic soap being within the limits of the specification, are of opinion that many questions affecting the patent might be raised if any metallic soap was used by the public in ignorance of the specification being as wide as it

(*g*) 1 Moo. P. C., N. S. 258.

(*h*) Per Lord Langdale, M.R., *In re Pinkus' Patent*, 12 Jur. 233.

(*i*) 5 Moo. P. C., N. S. at p. 78; see also *Sillar's Patent*, Good. P. C. 581.

is. On the whole, therefore, their lordships are of opinion that they ought not to recommend her Majesty under such circumstances to grant a prolongation."

In *Re Lane Fox's Patent*, a **Court of First Instance held the patent invalid**; while an appeal from that decision was pending, a petition for prolongation was brought, the committee decided to hear the petition on the ground that it was not their duty to look into the validity of the patent, and the decision of the Court was one which might not be upheld and therefore in no way binding (*k*).

Sect. 25 of the Patent Law Amendment Act, 1852, provided that letters patent obtained in the United Kingdom for patented foreign inventions should not continue in force after the expiration of the foreign patent, and that any prolongation of letters patent should be made subject to that condition, consequently **an inquiry into foreign patents** and their duration was always an essential element of the proceedings before the Privy Council (*l*). The lapse of a foreign patent the date of which was subsequent to the date of protection obtained in England for the same invention did not affect the English patent, and was no objection to its prolongation (*m*).

This Act however is specifically repealed, and by sect. 45, subsects. 2 and 3 of the Act of 1883, it is provided:—

"*Every patent granted* **before** *the commencement of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licenses. 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.*"

(*k*) 9 P. O. R. 411; see also *In re Kay's Patent*, 1 Web. P. C. 568; 3 Moo. P. C. C. 24.

(*l*) *In re Bodmer's Patent*, 8 Moo. P. C. C. 282; *In re Newton's Patent*, 15 Moo. P. C. C. 176; *In re Betts' Patent*, 1 Moo. P. C., N. S. 49; *In re Johnson's Patent*, 8 Moo. P. C., N. S. 282.

(*m*) *In re Betts' Patent*, 1 Moo. P. C., N. S. 49; *In re Poole's Patent*, 4 Moo. P. C., N. S. 452; *In re Adair's Patent*, L. R., 6 App. Cas. 176; 50 L. J., P. C. 68; but see *In re Blake's Patent*, L. R., 4 P. C. 535; 9 Moo. P. C., N. S. 373.

Thus it will be seen that after the commencement of the Act any prolongation of letters patent will be made regardless of foreign patents or their duration, saving with regard to the profits thereof as has been noticed above (*n*).

The Act of 1883 gives a **patentee** the right to petition, and, bearing in mind that the **definition of the word patentee** is by sect. 46, "*Any person for the time being entitled to the benefit of a patent,*" it will be observed that the greatest latitude is given as to persons who may petition.

Prior to the Act of 1883 it had been held, in a series of cases, that **executors and administrators** of a grantee of letters patent might petition for an extension (*o*). So might the assignee of a patent, even though a public company (*p*). So might the executor of an assignee (*q*), so also any person having merely an equitable interest in the patent (*r*), an **unpaid mortgagee** should be joined as a party (*s*).

In *Herbert's Patent* (*t*) the petition was presented by the patentee and the assignees of a part share conjointly, while the petition was pending the **patentee died**, the committee permitted the hearing to proceed without adding a representation of the deceased patentee as a party, and granted an extension subject to a condition that the assignees should hold a moiety on behalf of the representative of the patentee.

In *Re Norton's Patent* (*u*), Sir John Romilly, then Master of the Rolls, said, "Under the late statute, 7 & 8 Vict. c. 69, s. 4, a person is not excluded from applying for an extension of a patent upon the ground of his being the assignee of the patent; but 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

(*n*) But note *In re Jablochkoff's Patent*, 8 P. O. R. 281; *In re Livet's Patent*, 9 P. O. R. 327, 332; *Re Semet's Patent*, 12 P. O. R. 10.

(*o*) *In re Heath's Patent*, 8 Moo. P. C. C. 217.

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

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

(*r*) *In re Noble's Patent*, 7 Moo. P. C. C. 191.

(*s*) *In re Church's Patent*, 3 P. O. R. 95.

(*t*) L. R., 1 P. C. 399; 4 Moo. P. C., N. S., 300.

(*u*) 1 Moo. P. C., N. S. 339.

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."

And in *Re Pilman's Patent* (*x*) Sir J. W. Colvile said: "There are no doubt cases in which their lordships have granted applications by the assignees of the patentee for extension of the term, and have also considered, in some respects, the expenses incurred by the assignee in bringing the patent into notice, and for the merit as it may be said of the assignee in patronizing the patentee, and in pushing the patent into notice; but the general rule which their lordships entertain in applications on the part of assignees is, as was stated by Lord Brougham in *Re Morgan's Patent* (*y*), that by so doing '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.'"

It is difficult to estimate the effect of sect. 36 of the Act of 1883 upon this branch of the subject. Sect. 36 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.*"

Will the Privy Council, on the application of an assignee for a portion of the kingdom, extend the patent for that portion, or must all parties to the patent join in the petition?

It is evident that whilst one district assignee of an electric light patent, for example, may have been amply remunerated, another may not have been remunerated at all, owing to the action of local authorities or other matters entirely beyond the assignee's control. How could the committee in justice refuse the latter an extension? On the other hand, how could they grant it to the other?

(*x*) 8 Moo. P. C., N. S. 293. (*y*) 1 Web. P. C. 737.

Then again, if a patent may be extended for one district and not for another, we shall have the enormous practical difficulties and public inconveniences of an article being patented in one county and free in another, a state of affairs which, we venture to say, would be intolerable to the public.

The **advertisement of the intention of the patentee** to present a petition must be made in the manner prescribed by sect. 4 of 5 & 6 Will. IV. c. 83, that is to say, the petitioner must 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 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 (z).

Where the **petitioner resided in France** but had granted licenses to persons resident and carrying on business in London and Liverpool, advertisements inserted in the Gazette and newspapers published in those places were held to be sufficient (*a*).

The **names of all the parties** who join in presenting the petition must be inserted in the advertisements (*b*).

The advertisements must notify the day on which the petitioner intends to apply for a time to be fixed for hearing the matter of his petition, which day must be not less than four weeks from the date of the last of the advertisements inserted in the *London Gazette* (*c*), and the petition must be presented within one week from the insertion of such last advertisement (*d*), and must be accompanied by affidavits of advertisements having been inserted in accordance with the above provisions (*e*).

The petition must contain **full disclosure**, as "a petitioner seeking the grace and favour of the Crown is bound to strict

(z) For form of advertisement, see Appendix D.

(*a*) *Derosne's Patent*, 4 Moo. P. C. C. 416; 2 Web. P. C. 1.

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

(*c*) Priv. Coun. Rules, r. 2.

(*d*) Ibid. r. 3: see *In re Hutchinson's Patent*, 14 Moo. P. C. C. 364; for form of petition, see Appendix D.

(*e*) Ibid. r. 4.

truth, and to the utmost candour and frankness, to *uberrima fides*, in his statement" (*f*).

Two or more patents if of a similar nature may be the subject of one petition (*g*).

Any person may enter a **caveat against the extension**, and may be heard at the bar in support of their opposition (*h*); and where unreasonable opposition is offered, they will be ordered to pay the petitioner's costs (*i*). But where the opposition is well founded and successful, costs will be allowed to the opposing party (*k*). If the petition be **abandoned, costs will be given to opposers**, and they need not give the petitioner notice of their intended application for the same (*l*). Where the petitioner had fairly and honestly stated his case, both the things against and the things for him in his petition, and the inquiry had been prolonged by the opposition, the costs of the opposition refused, although the petition had been dismissed on the ground of sufficient remuneration (*m*).

Where two or more parties have opposed the petition separately and successfully, the committee will sometimes order a **fixed sum** to be paid by the petitioner to the opponents, to be apportioned between them in lieu of saddling him with several separate sets of **taxed costs** (*n*). We thus see that, whilst on the one hand an unwarranted application for an extension may be very costly, unreasonable opposition may be equally so, although costs are given upon the principle that persons should not be discouraged from coming forward to protect the interests of the public (*o*).

(*f*) Per James, L.J., *In re Clark's Patent*, L. R., 3 P. C. 421, 426.

(*g*) *In re Clark's Patent*, L. R., 3 P. C. 421; *In re Johnson's & Atkinson's Patent*, L. R., 5 P. C. 87; *In re Church's Patent*, 3 P. O. R. 95.

(*h*) *In re Lowe's Patent*, 8 Moo. P. C. C. 1; *In re Schlumberger's Patent*, 2 Eq. R. 1.

(*i*) *In re Downton's Patent*, 1 Web. P. C. 565; *In re Honiball's Patent*, 9 Moo. P. C. C. 394.

(*k*) *In re Westrupp & Gibbins' Patent*, 1 Web. P. C. 554.

(*l*) *In re Bridson's Patent*, 7 Moo. P. C. C. 499. See, however, *In re Milner's Patent*, 9 Moo. P. C. C. 39.

(*m*) *In re Muntz's Patent*, 2 Web. P. C. 122.

(*n*) *In re Jones' Patent*, 9 Moo. P. C. C. 41; also *In re Hill's Patent*, 1 Moo. P. C., N. S. 258; *In re Wield's Patent*, 8 Moo. P. C., N. S. 300; *Newton's Patent*, L. R., 9 App. Cas. 592.

(*o*) *Westrupp & Gibbins' Patent*, 1

The Attorney-General always appears in the interest of the Crown (*p*).

The **advertisements** should be proved before the case is heard (*q*); if the advertisements have not been made in the prescribed manner, no extension will be granted. "If the statute requires anything to be done which is not done, the Crown has no power to grant a prolongation" (*r*).

The Attorney-General can at the hearing adduce prior specifications for the purpose of showing want of novelty in the invention of the petitioner, without having previously given notice of his intention to do so (*s*), and it would seem that it is open for **any opponent** to do the same, since it is the duty of the petitioner to call attention to every fact whether in favour of or against his petition, and therefore he cannot complain of the introduction at the hearing of any objection to the extension of his patent which he ought to have drawn attention to himself (*t*).

The **practice** on petition for prolongation is governed by the Privy Council Rules which were made to regulate the procedure under 5 & 6 Will. IV. c. 83, and are set out at length in the Appendix (*u*).

An extension of a patent having once been granted, the Privy Council have no jurisdiction to entertain a petition for a **further prolongation**, their power being exhausted; and this objection may be taken by an opposing party, even though omitted from the objections filed by them (*x*).

When an order has been made by the Privy Council for an extension of the term of a patent, the person in whose favour such order has been made must leave a copy at the Patent Office, and the order shall thereupon be entered upon the register of patents (*y*).

Web. P. C. 554; *In re Jones' Patent*, 9 Moo. P. C. C. 41; *In re Wield's Patent*, 8 Moo. P. C., N. S. 300; L. R., 4 P. C. 39.

(*p*) *In re Erard's Patent*, 1 Web. P. C. 557; *In re Smith's Patent*, 7 Moo. P. C. C. 133.

(*q*) *In re Perkins' Patent*, 2 Web. P. C. 8.

(*r*) Per Lord Brougham in *Noble's Patent*, 7 Moo. P. C. C. at p. 194.

(*s*) *In re Ball's Patent*, L. R., 4 App. Cas. 171; *In re Stewart's Patent*, 3 P. O. R. 7; *In re Livet's Patent*, 9 P. O. R. 327.

(*t*) Ibid.

(*u*) See p. 457, post.

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

(*y*) P. R. 1890, r. 74.

CHAPTER XV.

CONFIRMATION.

The statute 5 & 6 Will. IV. c. 83, provided a remedy for cases of hardship, such as, where an invention had been invented or used and subsequently abandoned before the date of the patent in a manner unknown to the patentee at the time of his application. There would be a sufficient prior user to invalidate the patent, and yet there would be great merit probably in the patentee, and a great benefit to the public. The patentee might petition the Privy Council to confirm the patent, that is, to declare it valid, notwithstanding such prior user. The proceedings on such a petition were similar to those upon a petition for extension.

The Act of 1883 repeals the statute 5 & 6 Will. IV. c. 83, and with it all proceedings for confirmation; and this method of clothing an invalid patent with validity is abolished. In *Re Jablochkoff's Patent* the Privy Council seemed to be of opinion that the right to confirmation was retained in the case of patents granted prior to the date of the Act of 1883, by virtue of sect. 113 (*a*).

It is not strictly the purpose of a law work to criticise the enactments of the legislature, saving in their construction and application from an administrative point of view, otherwise a great deal might be said as to the advisability of abolishing that which was intended for and operated merely as a relief under very hard and exceptional circumstances.

(*a*) 8 P. O. R. 281, 284; see also remarks of Bowen, L.J., in *Singer* v. *Stassen*, 1 P. O. R. at p. 125.

CHAPTER XVI.

REMEDIES OF THE PATENTEE AND OF THE PUBLIC—ACTION FOR INFRINGEMENT.

An action for infringement is the remedy which the patentee has, and the means which is given to him for enforcing his patent privileges.

The courts are bound to take notice of the patent, and are bound to give legal effect to it, provided it cannot be shown to have been granted contrary to law.

PARTIES TO THE ACTION.

The Act of 1883 gives no directions as to what persons may be **plaintiffs or defendants** in an action for infringement, and therefore leaves the question of the parties to the action as it was before the passing of the Act.

The **original grantee**, it is obvious, so long as he has not parted with the whole of his interest in the patent, may be a plaintiff. And so may the **assignee** of a patent (*a*), even though he has acquired the right by assignment of two separate moieties, and the party sued is the original grantee (*b*).

The **assignee of a portion** of a patent may sue for an infringement of that part. Erle, C.J., in giving judgment in *Dunnicliff* v. *Mallett* (*c*), said: "The question is whether an assignment of part of a patent is valid. I incline to think that it is. It is every day's practice for the sake of economy to include in one patent several things which are in their nature perfectly distinct and severable. . . . Being therefore inclined to think that

(*a*) *Electric Telegraph Co.* v. *Brett*, 10 C. B. 838; 20 L. J., C. P. 123.

(*b*) *Walton* v. *Lavater*, 8 C. B., N. S. 162; 29 L. J., C. P. 275.

(*c*) 7 C. B., N. S. 209; 29 L. C. P. 70, 73.

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." The plaintiff in such an action would not be allowed to sever his part from the rest of the patent, and he would be liable to be defeated if it could be shown that the patent in any of its parts was void. But, on the other hand, he would have to show that his part alone would have been sufficient to support a patent, *i.e.*, that it contains a new and useful invention. Sect. 33, however, of the Act of 1883, provides, "*Every patent . . . . 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.*"

By sect. 36, "*A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.*" The **assignee for a district** will be in a position to bring an action for infringement, but it is obvious that the infringement must be within his district, otherwise he will be unable to prove damage.

One of several joint owners of a patent may bring an action in his own name to restrain infringement, or for damages, without joining his other co-owners (*d*), and he may sue alone for an account of profits, and for payment to the plaintiff of such part of such profits as the plaintiff should be entitled to.

Abinger, C.B., in *Derosne* v. *Fairie* (*e*), said that "a mere licensee could maintain no action against anyone else for the infringement of a patent." He might, however, **use the name of the grantor** of the license for the purpose provided he were an **exclusive licensee** (*f*).

A mere licensee would have no exclusive right to use the invention; he is only a person who is permitted to use it. The grantor of such a license might grant a dozen other such licenses

(*d*) *Sheehan* v. *Great Eastern Railway Co.*, L. R., 16 Ch. D. 59; *Dent* v. *Turpin*, 2 J. & H. 139; see ante, Chap. XII.

(*e*) 1 Web. P. C. 154; see also *Heap* v. *Hartley*, 6 P. O. R. 495.

(*f*) *Renard* v. *Levinstein*, 2 Hem. & M. 628.

without prejudicing the rights of the licensc; but an exclusive licensee has a right of property in the monopoly, and stands very much in the same position as an assignee for a district. The term exclusive, as applied to a licensee, meaning exclusive within an area.

When the exclusive licensee finds it necessary to protect his rights by bringing an action in the name of the licensor he is liable to give the licensor security for the costs (*g*) which, in the event of defeat, the licensor would have to pay. The right, however, to assign for particular districts will make this branch of the subject unimportant, since exclusive licenses were only a scheme for the purpose of, in effect, assigning for districts.

The **assignees or trustees** in bankruptcy of a patentee may maintain action for infringement in their own name (*h*), and so may the **executors or administrators** of a patentee.

A **mortgagee** of a patent is not a necessary party in an action for infringement of that patent (*i*), although, as we have seen, he should be joined on a petition for prolongation (*k*).

A mere agent to introduce, sell, and grant licenses for the use of a foreign patent in this country is not entitled to take proceedings to restrain infringement (*l*).

As defendants, a person physically using a patented invention is liable, such as a **contractor** (*m*). When a person in the position of **a servant** uses a patented invention, the master, in law, is the person who physically uses the invention as well as the servant, and the master may be sued. If a servant uses an invention in the course of his employment the master is liable, even though the master has told the servant to avoid infringing the patent (*n*). The **directors of a company** whose servants infringe an invention are personally liable (*o*).

(*g*) *Evans* v. *Rees*, 2 Q. B. 334; *Spicer* v. *Todd*, 1 D. P. R. 306.

(*h*) *Bloxam* v. *Elsee*, 6 B. & C. 169.

(*i*) *Van Gelder* v. *Sowerby Bridge Flour Co.*, 7 P. O. R. 208.

(*k*) *Church's Patent*, 3 P. O. R. 95.

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

(*m*) *Denley* v. *Blore*, 38 Loud Jour. 224.

(*n*) *Betts* v. *De Vitre*, L. R., 3 Ch. 429; *Sykes* v. *Howarth*, L. R., 12 Ch. D. 826; *Whatman* v. *Pearson*, L. R., 3 C. P. 422.

(*o*) *Betts* v. *De Vitre*, L. R., 3 Ch. 429, 441; *Spencer* v. *Acoutis Rubber Co.*, 6 P. O. R. 46.

An architect specifying the use of a patented invention is not liable (*p*).

Aliens infringing a patent in this country by vending or otherwise are liable if they come within the jurisdiction of the courts (*q*). A person ordering goods to be made in England which are an infringement of a patent, although intended for exportation to him abroad, infringes the patent. "He that causes or procures to be made may be well said to have made himself." Per Tindal, C.J. (*r*).

A company, to whom the business of the defendants was assigned while an action for infringement of a patent was pending against them, cannot be joined as co-defendants in that action (*s*).

But where an **indemnity** was given by a third party to the defendants after the commencement of the action, it was held that the person giving such an indemnity should be joined as a party under R.S.C. Order XVI. r. 48 (*t*), but such third party will only be bound by the decision of the Court so far as such decision falls within the terms of the order by which he was directed to appear (*u*).

An action is properly brought by the patentee against a company who are innocent carriers of infringing articles, to restrain them from dealing with or handing over such articles to other persons, and on the discovery of the name of the consignee, such consignee should be joined as a co-defendant in the action (*x*).

The manufacturer and patentee of a machine, the use of which is claimed to be an infringement of another patent, cannot compel the plaintiff to join him as a co-defendant with the person by whom the machine was used and against whom the action for infringement was brought (*y*).

(*p*) *Denicy* v. *Blore*, 38 Lond. Jour. 224.

(*q*) *Caldwell* v. *Vanvlissengen*, 9 Hare, 415.

(*r*) *Gibson* v. *Brand*, 11 L. J., C. P. 177, 183.

(*s*) *Briggs* v. *Lardeur*, 2 P. O. R. 13.

(*t*) *Edison* v. *Holland*, 3 P. O. R. 395.

(*u*) *Edison* v. *Holland*, 6 P. O. R. 243, 286.

(*x*) *Washburn and Moen Manufacturing Co.* v. *Cunard Steamship Co.*, 6 P. O. R. 398, 403.

(*y*) *Moser* v. *Marsden*, 9 P. O. R. 214.

CHAPTER XVII.

THE CAUSE OF ACTION—INFRINGEMENT.

THE infringement of a patent is the doing that which the patent prohibits from being done (*a*). The words of the Royal Command are as follows: "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, license or agreement of the said patentee in writing under his hand and seal, on pain, &c."

There is no duty cast upon a patentee to inform persons that what they are doing amounts to an infringement of his patent, and he is not estopped by omitting to give such information, although he knew of the infringement, from subsequently bringing his action (*b*).

The question of infringement or no infringement is one of fact, and therefore is for the jury (*c*). But this refers to the mere infringement alone within the meaning of Tindal, C.J., in *Muntz* v. *Foster* (*d*), when he told the jury that "for the purpose of inquiring whether the defendants have infringed the patent or not, we are to assume that it is a good patent, that no objection

(*a*) *Walton* v. *Bateman*, 1 Web. P. C. 613.

(*b*) *Proctor* v. *Bennis*, L. R., 36 Ch. D. 740.

(*c*) *Walton* v. *Potter*, 1 Web. P. C. 585; *De la Rue* v. *Dickenson*, 7 E. & B. 738.

(*d*) 2 Web. P. C. 99.

arises either to the nature of the grant or the specification which has been enrolled by the plaintiff."

If the patent is invalid there can be no infringement in the sense that a patent which has no legal existence cannot be infringed. But assuming that it has a legal existence, the question is for the jury. This explains the apparently contradictory decision in *Curtis* v. *Platt* (*e*), in the House of Lords. The question of infringement was there taken as involving the validity of the patent.

It is equally an infringement whether the defendant acted in ignorance of the plaintiff's patent or not. In *Heath* v. *Unwin* (*f*), Parke, B., delivering the judgment of the Court, said :—"There was therefore no intention to imitate the patentee's invention, and we do not think the defendant can be considered to be guilty of any indirect infringement if he did not intend to imitate at all." This judgment certainly gives an erroneous impression of the law, and Shadwell, V.-C., when the same case came before him (*g*), said :—"The party complaining of the act is not the less prejudiced by it because it was committed unintentionally; and my opinion is that, if a party has done an act that is injurious to the rights of another (though without any intention of doing him injury) he is answerable for the consequences. In *Stevens* v. *Keating* (*h*) the Lord Chancellor disapproved of the case in the Court of Exchequer; and I must decline to act upon the principle which it lays down."

Subsequently, when *Heath* v. *Unwin* came before the House of Lords, the opinion of the judges being taken, Parke, B. (*i*), acknowledged the error into which the Court had fallen, and approved of *Stevens* v. *Keating*.

In *Stead* v. *Anderson* (*k*), Wilde, C. J., tersely puts it :—"The question of infringement depends not on what the defendant intends, but on what he does."

So it is **immaterial whether the defendant was aware** that the thing was patented or not, since in law every person in the realm

(*e*) L. R., 1 H. L. 337; 35 L. J., Ch. 852.
(*f*) 14 L. J., Ex. at p. 156.
(*g*) 15 Sim. 553.
(*h*) 2 Web. P. C. 176.
(*i*) 25 L. J., C. P. at p. 19; 5 H. L. Cas. 505.
(*k*) 2 Web. P. C. 156.

is taken to have notice of a patent in the same way that he is taken to be aware of the law (*l*).

And the converse is also sound—if a person intending to infringe a patent does not in fact do so, he will not be taken to have infringed (*m*).

In *M'Cormick* v. *Gray* (*n*) the specification, after describing several parts of reaping machines, including some cutting blades of peculiar construction, claimed: "The construction of reaping machines according to the improvements before described—that is to say, the constructing and placing of holding fingers, cutting blades, and gathering reels, respectively, as before described, and the embodiment of those parts as so constructed and placed, all or any of them in machines for reaping purposes, whether such machines are constructed in other respects as before described, or however else the same may in other respects be constructed."

The defendant made and sold cutting blades similar to those described by the plaintiff's patent, which were *capable of being used* in the plaintiff's reaping machine. Bramwell, B., in giving judgment, said:—"A man could not make the blade of a knife without infringing this person's patent, because you may intend to put it into a machine, or you may not. I think it is a very clear case, and I am satisfied there is no difference between making a thing with one intent and making it with another, because I always understood that if a man may do a thing, he may do it with whatever intent he pleases." It will be observed, that in this case, to make the knives was no infringement, and there was no evidence of the defendant having applied them to reaping machines (*o*).

Thus we see that infringement, as taken apart from the question of validity, is a matter of fact, and that intention is not material to the conclusion (*p*).

To prove infringement, it must be shown that there is a

(*l*) *Walton* v. *Lavater*, 29 L. J., C. P. 275; *Curtis* v. *Platt*, 11 L. T., N. S. 245.

(*m*) *Newall* v. *Elliott*, 10 Jur., N. S. 954.

(*n*) 31 L. J., Ex. 42.

(*o*) See, however, *Bancroft* v. *Warden*, Romilly's Notes of Cases, 103.

(*p*) See also *Young* v. *Rosenthal*, 1 P. O. R. 29, 39.

substantial resemblance (*q*). The infringement must be of a part for which the patent was granted, and not merely of a part described in the specification (*r*).

The question as to **what will or what will not amount to infringement**, like many other points which arise in the law of letters patent, must depend upon the facts of each particular case, and the decision in one case cannot possibly bind the decision in another; consequently the consideration of decided cases is only useful as showing the principles which underlie the judgments in those cases.

In *Nobel's Explosives Co.* v. *Anderson*, Romer, J., said (*s*): "Several cases were cited to show the canons of construction on which the Courts have acted in different cases relating to infringements. But it is not necessary for me to deal with these cases in detail, for I desire emphatically to state that, in my view, **one principle only governs all the cases**, whether they relate to so-called 'master' patents, or patents dealing with discoveries in matter of principle, or to any other kind of patent; and that principle is this: In order to make out 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."

In the same case, in the Court of Appeal, Kay, L.J., in his judgment, said (*t*): "I think the law now is reasonably well settled. There are two classes of cases; one where a patentee has invented a **new method of producing a known result**, the other where he has **invented a new result, and has described one method of producing it.** According to the *dictum* of Baron Alderson in *Jupe* v. *Pratt* (*u*), which, as has been pointed out in subsequent cases, was a *dictum* during the argument addressed to some argument of counsel which he was then considering, if a

(*q*) *Stead* v. *Anderson*, 2 Web. P. C. 151.

(*r*) *Croll* v. *Edge*, 19 L. J., C. P. at p. 261.

(*s*) 11 P. O. R. 115, 127.

(*t*) 11 P. O. R. 519, 527.

(*u*) 1 Web. P. C. 145.

patentee has invented a new result, and has described one method of obtaining that result, he may prevent anybody else from obtaining the same result by any other method. In my opinion that went much too far, and I need not refer to any authority which more clearly shows that than the subsequent judgment of Baron Alderson in *Neilson* v. *Harford* (*x*), where he pointed out that if that were the law the result of such a patent would be a patent of the principle itself, because when you had discovered a new result, if, by showing one method of producing that result, your patent covers every other method of producing that result, in point of fact you patent the principle which leads to that result; and that is perfectly good criticism upon the earlier *dictum* of Baron Alderson, which I cannot help thinking was only put *arguendo*, and is the proper limitation of the generality of that first *dictum*. Mr. Justice Pearson, in the *Badische Anilin* case (*y*), seems to have adopted the earlier *dictum* of Baron Alderson, without observing the limit put upon it by his subsequent judgment, and respectfully I differ from the statements of the law as stated by Mr. Justice Pearson in that case. The true result, I think, is stated very well by the late Lord Justice Cotton in the case of the *Automatic Weighing Machine Co.* v. *Knight* (*z*). He observes the *dictum* in *Jupe* v. *Pratt*, and he says:—'Those were the expressions used by Baron Alderson during the discussion, probably to meet something that was said by counsel, and did not express his full opinion. You can prevent anyone from using the same method of carrying that principle into effect, and you can prevent anyone from using only the same thing, with a colourable difference. That is what we had to consider in *Proctor* v. *Bennis* (*a*). 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, a mechanical equivalent for a substantial part of the patentee's invention being looked upon as

(*x*) 1 Web. P. C. 295, 355; 8 M. & W. 806, 820.

(*y*) 2 P. O. R. 91.

(*z*) 6 P. O. R. 297, 304.

(*a*) 4 P. O. R. 333.

a mere colourable difference, and, therefore, he being entitled to an injunction against that mode of carrying out his principle, which is only the same in substance as that which he patented, though there are colourable differences.' I take the law as to be clearly settled thus, 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 to the method which he has himself described as to be substantially the same, or, in other words, only colourably different."

In *Curtis* v. *Platt* (*b*), Wood, V.-C., said:—"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 machine 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. Because otherwise that would be to say that the whole world is to be precluded from achieving some desirable and well-known object which everybody has had in view for years. 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."

The result of the decided cases clearly shows that a man will be held to have infringed if he has taken the **pith and essence of the invention** (*c*), and that when the invention is merely for an **improved mode of attaining an old object** the pith of his invention

(*b*) L. R., 3 Ch. D. 136, n.

(*c*) *Clarke* v. *Adie*, L. R., 2 App. Cas. 315, 320; *Proctor* v. *Bennis*, 4 P. O. R. 333, 345; *Wenham Gas Co.* v. *Champion Gas Co.*, 9 P. O. R. 55, 56; *Benno Jaffé* v. *Richardson*, 11 P. O. R. 112.

is that particular improved method, and only by making use of that particular method will a man be held to have infringed (*d*), but when the invention is for a new method of attaining a new result, the novelty of the result itself is part of the merit of the invention and of the consideration given by the patentee in return for the grant (*e*); and, consequently, a man will be held to have infringed if he should have arrived at the same result by means of a process substantially the same as, or only colourably different from, that disclosed in the specification of the original invention (*f*).

If a man has taken the pith of an invention, the fact that he has improved upon it is immaterial (*g*).

The amount of prior user which will be sufficient to invalidate a patent differs considerably from the amount of user which will be held to infringe a patent:—"these are different questions, depending on wholly different considerations, the one upon the extent of previous knowledge, the other upon the effect of the grant" (*h*).

In *Barlow* v. *Baylis* (*i*) the patent was for "improvements in manufacturing metal nuts, and in machinery for stamping, forging, and rolling the same." Action for infringement; defence

(*d*) *Curtis* v. *Platt*, L. R., 3 Ch. D. 135, 136; *Nordenfelt* v. *Gardner*, 1 P. O. R. 61; *Proctor* v. *Bennis*, 4 P. O. R. 333; *Thomson* v. *Moore*, 6 P. O. R. 426; *Vorwerk* v. *Evans*, 7 P. O. R. 265; *Tweedale* v. *Ashworth*, 7 P. O. R. 426; 8 P. O. R. 49; 9 P. O. R. 121; *Miller* v. *The Clyde Bridge Steel Co.*, 8 P. O. R. 198; 9 P. O. R. 470; *Ashworth* v. *Roberts*, 9 P. O. R. 309; *Nettlefolds* v. *Reynolds*, 9 P. O. R. 270; *Preston Davies* v. *Black*, 11 P. O. R. 299, 574.

(*e*) *Proctor* v. *Bennis*, 4 P. O. R. 359.

(*f*) *Curtis* v. *Platt*, L. R., 3 Ch. D. 135, 136; *Proctor* v. *Bennis*, 4 P. O. R. 333; *Ehrlich* v. *Ihlee*, 5 P. O. R. 437, 453; *Thomson* v. *Moore*, 6 P. O. R. 426; 7 P. O. R. 325; *Automatic Weighing Machine Co.* v. *Knight*, 6 P. O. R. 297, 304; *Automatic Weighing Machine Co.* v. *National Exhibitions Association*, 8 P. O. R. 345; 9 P. O. R. 41; *Tweedale* v. *Ashworth*, 9 P. O. R. 121, 126; *Young* v. *Hermand Oil Co.*, 9 P. O R. 373; *Nobel's Explosives Co.* v. *Anderson*, 11 P. O. R. 519, 527; *Benno Jaffé* v. *Richardson*, 11 P. O. R. 93.

(*g*) *Ehrlich* v. *Ihlee*, 5 P. O. R. 454; *Thomson* v. *Moore*, 6 P. O. R. 426; *Wenham Gas Co.* v. *Champion Gas Co.*, 9 P. O. R. 49, 55.

(*h*) Per Turner, V.-C., in *Caldwell* v. *Vanvlissengen*, 9 Hare, 428; *Newton* v. *Grand Junction Railway Co.*, 5 Exch. 331.

(*i*) Griffin, P. C., at p. 44.

anticipated by Berry. It was contended by the plaintiff that Berry's machine would not work. Brett, J., in summing up to the jury, said:—"Now, the first question about Berry's machine which I will ask you is this: Was Berry's ever a machine or invention in this sense, that a workman could, from his specification and drawings, make the machine described by him so that it would, more or less badly, do the work required of it? because in my opinion, if it would not, I do not say perfectly, but if it would not do the work required of it, it was not an invention at all, or a machine in a business sense. . . . I put the words 'more or less badly,' because I do not think that if the only defect in the machine was some defect in the levers which any workman could find out at once, if it would make a nut, though badly, that would not prevent it from being a machine."

The jury found that Berry's machine would not do the work more or less badly. Judgment for plaintiffs. Judgment upheld by the Court of Common Pleas.

In *Brereton* v. *Richardson* (*k*) infringement of a patent for "a new and improved tricycle," alleged prior user by Jackson and his family; reply, that this was merely an experimental user. Field, J., said:—"Their driving to Cheam, Worcester Park, and Malden, going about on business night and day, and for pleasure; and the public notoriety which the thing had excited in the neighbourhood, so that it was called 'Jackson's patent threshing machine,' all satisfy me that, provided I am right in holding that the thing was substantially the same, it was publicly used. A question of difficulty occurred to my mind as to what degree of public user is enough when you have to deal with a thing like that. I quite understand that if there were at this moment an axle running under an omnibus which I could not see, it might or might not be a public user. I think it would be a public user." Action dismissed with costs.

We have seen that by sect. 33 of the Act of 1883, a patent may still contain more than one claim, and in such a case, provided every claim which is made is valid, a patent may be infringed by infringing any one claim. In *Gillett* v. *Wilby* (*l*)

(*k*) 1 P. O. R. 166.

(*l*) 9 C. & P. 336.

Coltman, J., said:—"If they are all new (the parts claimed), and the defendant has infringed any one of them, it will be sufficient to support the action, and it is not necessary that he should have infringed them all." In *Newton* v. *The Grand Junction Rail. Co.* (*m*), Pollock, C.B., said:—"But in considering the question of infringement, all that is to be looked at is, whether the defendant has pirated a part of that to which the patent applies; and if he has used that part for the purposes for which the patentee adapted his invention, and for which he has taken out his patent, and the jury are of opinion that the difference is merely colourable, it is an infringement;" and in *Sellers* v. *Dickenson* (*n*) the same Judge said:—"There may be an **infringement by using so much of a combination as is material** . . . 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."

"Where a patent is for a combination of two, three, or more old inventions, a user of any of them would not be an infringement of the patent; but where there is an invention consisting of several parts, the imitation or pirating of any part of the invention is an infringement of the patent" (*o*).

Speaking of this case in *Clark* v. *Adie* (*p*), James, L.J., said:—"Upon the authority of *Smith* v. *L. & N. W. Railway Co.*, it has been strongly contended before us that whenever there is a patent for a combination, that patent gives protection, not indeed to every distinct thing that enters into the combination, but to every combination, arrangement, and aggregate of two or more of those distinct things, even although such subordinate combination is not expressly or impliedly claimed in the specification. This, in our opinion, is so startling a violation of every principle of patent law, that we doubt whether we could follow any authority, short of the House of Lords, in applying such a doctrine. If a patent for a combination of several parts is in reality a patent, and gives

(*m*) 5 Exch. 331.

(*n*) 5 Exch. 324.

(*o*) Per Campbell, C.J., in *Smith* v. *London & North Western Railway Co.*, 2 E. & B. 76; *The Patent Bottle Co.* v. *Seymer*, 5 C. B. N. S. 172.

(*p*) L. R., 10 Ch. 674.

really a monopoly for every combination of any two or more of those parts, then it follows, from the very first principle of patent law, that if any conceivable combination of any two or more parts was old, the patent would be bad. On the other hand, if the patentees say, 'No, we do not claim to protect every combination of those parts, but only those subordinate combinations, or parts of the combination, which are new and useful,' then such a claim would be entirely inconsistent with the leading case of *Foxwell* v. *Bostock* (*q*), which, we may be permitted to say, is as good sense as it is sound and intelligible law . . . I will state what we conceive to be the real principle which underlies the case of *Lister* v. *Leather* (*r*), and which reconciles it with the other cases and with general principles, and common sense. A patent for a new combination or arrangement is to be entitled to the same protection, and on the same principles, as every other patent. In fact, every, or almost every patent, is a patent for a new combination. The patent is for the entire combination, but there is, or may be, an essence or **substance of the invention** underlying the mere accident of form, and that invention, like every other invention, may be pirated by a theft in a disguised or mutilated form, and it will be in every case a question of fact, whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination."

In *Nordenfelt* v. *Gardner* (*s*), Brett, M.R., said:—"The machine which is challenged may have that combination actually without any variance at all. If so, it is obvious that the challenged machine is an infringement, or it may have that combination with some alteration. The alteration of a combination, as it seems to me, may be by addition, or subtraction, or substitution of parts. Any one of these alters the combination. If the alteration, whether it be by addition, or subtraction, or substitution, be merely colourable, then the two machines are substantially the same; although not mathematically exactly the same, they are substantially the same; and in any case, notwithstanding such colourable alteration, there may be an infringe-

(*q*) 12 W. R. 723; see also *Harrison* v. *Anderston Foundry Co.*, L. R., 1 App. Cas. 574.

(*r*) 8 E. & B. 1004.

(*s*) 1 P. O. R. 65.

ment (*t*). An *alteration by addition* may be an improvement, but then that will leave the whole of the original combination, and add something to it. If such an alteration of the combination be made, it seems to me that no good patent can be made with regard to the new machine except by claiming the invention as an improvement, and by showing distinctly what the addition is, so as to show what the improvement is. An *alteration by subtraction*, if it were more than a colourable subtraction, would, as it seems to me, alter the combination. It would not be a combination of the same things, it would be a combination of different things; and if the combination were altered by a material subtraction, I should think that it was a new combination. But an *alteration by substitution*, that is, by substitution of one of the material elements of the original combination, must to my mind be a new combination. The second combination, then, is a combination of different things from the first. There is a taking away of one of the elements, and a material element of the old combination, and a putting in of a new material element which is different from any of the elements of the former."

Where, however, the **application** by the defendant of a portion of the invention of the plaintiff is **for a different object**, and with a view of carrying out a principle totally newly discovered by the defendant, and which was unknown to the plaintiff, there is no infringement, although at first sight there appears to be some similarity of process (*u*), but if a man, in the course of producing an improved combination, substantially uses a combination which already forms the subject of a patent, he thereby infringes the patent, notwithstanding that the combination he is making has a different end in view than that which has been patented (*x*).

But, on the other hand, where a patent is for a combination, a person who takes a new and material part of the combination, but **not for a similar or analogous purpose** to that to which it was applied in the patent, does not infringe the patent (*y*).

(*t*) See also *Murray* v. *Clayton*, L. R., 7 Ch. 570, 585; *Badische Anilin und Soda Fabrik* v. *Levinstein*, L. R., 24 Ch. D. 156, 175; 2 P. O. R. 93; *Kaye* v. *Chubb*, 5 P. O. R. 641; *Thomson* v. *Moore*, 6 P. O. R. 426.

(*u*) *Newton* v. *Vaucher*, 6 Exch. 859; see also *Morewood* v. *Tupper*, 3 C. L. Rep. 718; *Preston Davies* v. *Black*, 11 P. O. R. 299, 574.

(*x*) *Cannington* v. *Nuttall*, L. R., 5 H. L. 205, 230.

(*y*) *Lister* v. *Eastwood*, 9 L. T. N. S. 766.

We have seen that sect. 5, sub-s. 5, provides that a complete specification must conclude with a distinct statement of the invention claimed; so that, if the invention be a combination, it must be so stated; if for parts, they must be claimed. There is no **infringement** if the defendant cannot be shown to have infringed, directly or indirectly, **a part or parts of the claim** (*z*). In *Lister* v. *Leather* (*a*) it was held that a valid patent for an entire combination, or for a process, gives protection to every part that is new and material, for the purpose of effecting that particular combination or process, without any express claim of particular parts, and notwithstanding that parts of the combination are old. In future, if any parts are desired to be protected, as well as the combination or process, the claim will have to be so drawn as to include those parts.

The jury will always have to consider whether the infringing machine, process, or combination is a **substantial imitation** (*b*). No fine lines can be drawn as to what amounts to substantial imitation. In *Clark* v. *Adie* (*c*), in the House of Lords, Lord Blackburn said:—"I incline to agree with what was said in the Exchequer Chamber in the case of *Lister* v. *Leather* (*d*), that you cannot decide in the abstract whether the using of two parts, A and B, of a combination of A, B, and C is or is not using part of that invention, nor can you decide in the abstract the other question, which was somewhat discussed in the case of the sewing machine (*Foxwell* v. *Bostock*) (*e*), whether or not the specification shows that A or B is sufficiently claimed as a part of the invention or not. I do not think that either of those questions can be decided in the abstract. I would wish, like the Exchequer Chamber in *Lister* v. *Leather*, before deciding it, to have before me the nature of the machine, in order that I may see what A, B, and C are, and what is their relation to each other."

In *Parkes* v. *Stevens* (*f*), James, V.-C., said:—"The authority of that case (*Lister* v. *Leather*) has been pressed upon me as if it really established this, which would be a most

(*z*) *Jackson* v. *Wolstenhulmes*, Griff. P. C. 134.
(*a*) 8 E. & B. 1004.
(*b*) *Thomas* v. *Foxwell*, 5 Jur., N. S. 89.
(*c*) L. R., 2 App. Cas. 335.
(*d*) 8 E. & B. 1004.
(*e*) 12 W. R. 723.
(*f*) L. R., 8 Eq. 358, 366.

startling proposition, that a patent for a combination or arrangement would be a distinct patent for everything that was new and material and that went to make up the combination . . . . the judgment, if read well, will be found to give no warrant whatever for such, I must call it, baseless notion. The law is summed up thus. 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?**" (*g*). This judgment was affirmed on appeal (*h*).

If the invention be for a combination or process whereby an already well-known object is produced, it will be no infringement to make **another combination**, even **of the same materials** (provided they be also old and well-known), for the purpose of attaining the same object, for the patent is for the *means* of attaining the object, and if other means are employed there is no infringement. The patent is also for the *method* of combining the old and well-known materials, and if **another method** is adopted there is no infringement (*i*).

When the defendant has set himself to work to **evade the plaintiff's patent** by fraudulently making a colourable imitation, or substituting a mechanical or chemical equivalent, the cases show that the Courts will look strictly at what he has done, and will take care that he does not overstep the line which he is endeavouring to keep within.

The question of fraudulent evasion is, as we have shown, one of fact. "A slight departure from the specification, for the purpose of evasion only, would, of course, be a fraud upon the patent;

(*g*) See also *Wright* v. *Hitchcock*, L. R., 5 Ex. 37; *Automatic Weighing Machine Co.* v. *National Exhibitions Co.*, 8 P. O. R. 345, 350; 9 P. O. R. 41; *Miller* v. *Clyde Bridge Steel Co.*, 9 P. O. R. 470; *Peckover* v. *Rowland*, 10 P. O. R. 234; see also *White* v. *Fenn*, 15 W. R. 348; *Garrard* v. *Edge*, 6 P. O. R. 563.

(*h*) L. R., 5 Ch. 36.

(*i*) *Curtis* v. *Platt*, in the House of Lords, 35 L. J., Ch. 852; L. R., 1 H. L. 337.

and therefore the question will be, whether the mode of working by the defendant has or has not been essentially or substantially different (*k*).

In *Dudgeon* v. *Thompson* (*l*) Lord Cairns makes strong objection to the use of the term **colourable imitation**, in connection with the infringement of patents, and proceeds:—"If there is a patented invention, and if you, the defendant, are found to have taken that invention, it will not save you from the punishment or from the restraint of the Court, that you have, at the same time that you have taken the invention, dressed it up colourably, added something to it; taken, it may be, something away from it, so that the whole of it may be said, as is said in this injunction, Here is a machine, which is either the plaintiff's machine, or differs from it only colourably. But underlying all that there must be a taking of the invention of the plaintiff. There used to be a theory in this country, that persons might infringe upon the equity of a statute, if it could not be shown that they had infringed the words of the statute; it was said that they had infringed the equity of the statute, and I know there is, by some confusion of ideas, a notion sometimes entertained that there may be something like an infringement of the equity of a patent. My lords, I cannot think that there is any sound principle of that kind in our law; that which is protected is that which is specified, and that which is held to be an infringement must be an infringement of that which is specified. But I agree it will not be the less an infringement because it has been coloured or disguised by additions or subtractions, which additions or subtractions may exist, and yet the thing protected by the specification be taken notwithstanding."

Summing up the cases, therefore, we come to this. Strictly speaking, there is no such thing as a colourable imitation: either the defendant has infringed the thing specified or he has not. At the same time there is an essence or substance to every invention underlying the mere accident of form or words. If the defendant has imitated and adopted the **essence of the invention**, he will not

(*k*) Per Dallas, J., in *Hill* v. *Thompson*, 1 Web. P. C. 242.

(*l*) L. R., 3 App. Cas. at p. 44.

be allowed to escape because he has not adopted the form or words in which the essence of the invention is clothed (*m*).

There is a description of imitation which is produced by the substitution of **chemical or mechanical equivalents.** To the unscientific eye there is a total dissimilarity between the infringing machine or process and the original; but, none the less, it is a mere imitation—it is a robbery of the ideas and intentions of the first inventor, but a robbery conducted in a scientific manner.

We have seen that a patent cannot be granted for the discovery of a mere principle (*n*), but that, if the principle when discovered is at the same time applied, a valid grant may be made for the application of the principle. The essence of the patent is the fact of applying the newly-discovered principle to a particular end. Now, a mechanical or chemical **equivalent is another method** of producing the same result, a method which a skilled mechanic or chemist, having once seen the original invention, could at once suggest and apply without the necessity of any inventive power whatever. Equivalents may be substituted for parts as well as for the whole invention, so that it may happen that a patent is taken out which consists of three parts. An equivalent may be substituted for each part, so that in effect the whole invention may be changed and yet there may be a most flagrant infringement.

Take, for instance, the case of *Stevens* v. *Keating* (*o*). Here the patent was for the manufacture of cement. The cement was made from gypsum (sulphate of lime) by admixing it with pearl-ash (carbonate of potash) and sulphuric acid. Chemically, the

(*m*) *Thorn* v. *The Worthing Skating Rink Co.*, L. R., 6 Ch. D. 415; *Flower* v. *Lloyd*, W. N. 1877, p. 132; *Barrett* v. *Vernon*, 45 L. T., N. S. 755; *Bailey* v. *Roberton*, L. R., 3 App. Cas. 1055. And the older cases, *Bovill* v. *Moore*, Dav. P. C. 405; *Forsyth* v. *Riviere*, 1 Web. P. C. 97; *R.* v. *Lister*, Web. P. L. 80; *Minter* v. *Wells*, 1 Web. P. C. 130; *Morgan* v. *Seaward*, per Alderson, B., 1 Web. P. C. 171; *Walton* v. *Potter*, 1 Web. P. C. 586; *Neilson* v. *Harford*, 1 Web. P. C. 310; *Walton* v. *Bateman*, per Cresswell, J., 1 Web. P. C. 616; *Muntz* v. *Foster*, per Tindal, C.J., 2 Web. P. C. 101; *Russell* v. *Ledsam*, 14 M. & W. 580; *Gamble* v. *Kurtz*, 3 C. B. 425; *Stead* v. *Anderson*, 2 Web. P. C. 156; *Unwin* v. *Heath*, 25 L. J., C. P. 8; *Curtis* v. *Platt*, 35 L. J., Ch. 852; *Murray* v. *Clayton*, L. R., 7 Ch. App. Cas. 585; also *Proctor* v. *Bennis*, L. R., 36 Ch. D. 740, 754; 4 P. O. R. 333, 352; *Thomson* v. *Moore*, 6 P. O. R. 426.

(*n*) *Ante*, p. 26.

(*o*) 2 Web. P. C. 181.

effect was this: Sulphate of potash was produced; this, combined with the sulphate of lime, produced a double salt, which, when submitted to a high temperature and subsequently ground to a fine powder, constituted the cement. The principle of this discovery was that sulphate of lime combined with salts of potash or soda, and when so combined, produced a substance which set very hard. The defendant substituted for the pearlash and sulphuric acid a chemical equivalent, borate of soda (borax), and heated that with gypsum, producing in the same manner a double salt, and with the same resulting property of setting. This was properly held to be an infringement.

In *Russell* v. *Cowley* (*p*) the invention claimed was that of bringing to a welding heat a long piece of iron of the proper quality, after having turned up its edges, and drawing it through a hole of the size of the intended tube, so as to compress together the edges and give it a complete circular form. The defendants turned up the skelp, and, after heating it in the furnace, passed it through two rollers with grooves:—Held, that the two rollers with grooves were a mere mechanical equivalent for the hole through which the iron was passed under the patent (*q*).

But if such other substance or mechanical device have a different or better effect than that which is claimed in the specification, although to a certain extent it may be similar, and was not known to persons familiar with such things at the date of the patent as an equivalent, it will not be treated as an equivalent so as to come within the scope of the patent.

In *Nobel's Explosives Co.* v. *Anderson* (*r*), the object of the invention was the production of an explosive suitable for propelling projectiles, in the use of which perfect combustion was obtained. The patentee in his specification confined his claim to

(*p*) 1 Web. P. C. 463.

(*q*) See also *Jupe* v. *Pratt*, 1 Web. P. C. 146; *The Electric Telegraph Co.* v. *Brett*, 10 C. B. 838; *Hancock* v. *Moulton*, Johnson's Patentees' Annual, 3rd ed. 208; *Bateman* v. *Gray*, Mac. P. C. 102; *Simpson* v. *Holliday*, 20 Newton's Lond. Journ. N. S. 111; *United Telephone Co.* v. *Harrison*, L. R., 21 Ch. D. 720; *Winby* v. *Manchester Steam Tramways Co.*, 6 P. O. R. 359, 365; 8 P. O. R. 61, 68; *Murchland* v. *Nicholson*, 10 P. O. R. 417, 427.

(*r*) 11 P. O. R. 115, affirmed by House of Lords.

powder made from soluble nitro-cellulose and nitro-glycerine. It was not known at the date of the patent that insoluble nitro-cellulose could be used in the place of the soluble to effect the same object in a similar manner, and, in fact, anyone reading the specification of the patentee would be led to the conclusion that he was to avoid the use of insoluble nitro-cellulose. It was held by Romer, J., whose decision was confirmed in the Court of Appeal, that the use of the insoluble nitro-cellulose, although in a similar way and to effect a similar result to that attained by the soluble nitro-cellulose, did not amount to an infringement of the patent. In his judgment he said (*s*) :—"The soluble and insoluble are, in my opinion, distinct substances, having, as I pointed out above, distinct properties, and the insoluble cannot, for the purposes of the plaintiff's patent, be regarded as merely the chemical equivalent of the soluble. The plaintiff's patent and claim show that the patentee regarded the two as distinct for the purposes of his invention."

"Equivalents which are not known at the time of the patent as equivalents and afterwards are found to answer the same purpose, are not included in the specification. They are new inventions." Per Baron Parke (*t*).

Taking out a patent for a process or machine that infringes a prior patent does not in itself amount to infringement (*u*); infringement depends upon what the alleged infringer has done. There are three ways in which a patent may be infringed :—

1. By making the patented article or working the process.
2. By using.
3. By selling.

BY MAKING.

A person may infringe a patent by making the article himself, or by his agent, or by his servants. The agent and servants, it is true, will be considered as equally infringing the patent, and actions may be brought against them individually, but that in no way absolves the person who employs them for that purpose.

(*s*) At p. 127.

(*t*) *Unwin* v. *Heath*, 2 Web. P. C. 314.

(*u*) *Tweedale* v. *Ashworth*, 7 P. O. R. 431.

In *Sykes* v. *Howarth* (*x*) a patent consisted of the application of cards or strips of leather covered with wire to rollers at "wide distances." A person who contracted to clothe rollers and supplied to a "nailer" cards of such width that when applied to the rollers they must of necessity leave wide spaces, and who himself paid the nailer, was held to have infringed the patent, though he alleged that his business was that of a card-maker only, and did not include the nailer's work. In giving judgment, Fry, J., said:—"I have come to the conclusion that the nailer must be deemed to have been the agent, for the purpose of nailing on, of the defendant . . . . there is a contract to clothe in the manner prescribed by the particulars given to the defendant, and that contract was carried into effect by a person paid by the defendant—the defendant himself receiving the total amount for which he contracted. The consequence is that in my judgment all the defences fail."

We have seen that it is an infringement to colourably imitate an invention. It is no infringement to make, use, or vend the elements which afterwards enter into the combination. In *Townsend* v. *Haworth* (*y*), Jessel, M.R., said:—"The chief of these chemical substances are substances which are perfectly well known, and most of them are common substances; they are all old chemical compounds, and there is no claim in the patent at all except for the peculiar use of these chemical compounds for the purpose of preserving the cloth from mildew. No judge has ever said that the vendor of an ordinary ingredient does a wrong if the purchaser, coming to him, says, 'I want your compound because I want to preserve my cloth from mildew. I wish to try the question with the patentee.' No one would doubt that that sale would be perfectly legal. You cannot make out the proposition that any person selling any article, either organic or inorganic, either produced by nature or produced by art, which could in any way be used in the making of a patented article, can be sued as an infringer, because he knows that the purchaser intends to make use of it for that purpose."

(*x*) L. R., 12 Ch. D. 826.

(*y*) L. R., 12 Ch. D. 831, n.; see also *McCormick* v. *Gray*, 7 H. & N. 25; 31 L. J., Ex. 42; *Sykes* v. *Howarth*, L. R., 12 Ch. D. 826, 833.

But making and selling all the constituent parts of a machine, so that they could be easily put together, would probably amount to an infringement of a patent which had been granted for that machine (*z*).

In *Gibson* v. *Brand* (*a*) it was held that an order given by the defendant for the making of silk by a process which infringed the plaintiff's patent, which order was executed in England, was sufficient to satisfy the allegation that the defendant made, used, and put in practice the plaintiff's invention, though the silk was in fact made through the agency of others.

In *Higgs* v. *Godwin* (*b*) the plaintiff's patent was for the precipitation of animal and vegetable matter from sewage water by means of hydrate of lime, with the object of obtaining a product suitable for agricultural purposes. It was held that the use of the same process for the purpose of deodorizing and purifying sewage water and not for the purpose of commercial profit, did not amount to infringement of the plaintiff's patent.

In *Kelly* v. *Batchelar* (*c*) the plaintiff's patent was for a telescopic ladder, being two ladders joined together, the inner being raised or lowered by means of an endless cord. The plaintiff, for the purpose of adducing evidence of infringement, instructed an agent to order from the defendant an adjustable ladder with an endless cord. The defendant made a ladder to this order, but without a cord. The agent of the plaintiff said that it would not do, but must have a cord with pulleys, whereupon the defendant added the cord as instructed. In the action for infringement brought against the defendant, North, J., held that the defendant acted upon the express instructions of the plaintiff's agent, who had power and authority to give such instructions, and, consequently, that making this ladder did not amount to an infringement of the plaintiff's patent.

The working and making must be by way of using the invention, as distinguished from experimenting with it, so as to operate as an infringement. In *Jones* v. *Pearce* (*d*) Patteson, J.,

(*z*) *United Telephone Co.* v. *Dale*, L. R., 25 Ch. D. 778.

(*a*) 4 M. & G. 179.

(*b*) 27 L. J., Q. B. 421; E. B. & E. 529; 5 Jur., N. S. 97.

(*c*) 10 P. O. R. 289; also *Henser* v. *Hardie*, 11 P. O. R. 421.

(*d*) 1 Web. P. C. 124.

said :—"Now, if he did actually make these wheels, his making them would be a sufficient infringement of the patent, unless he merely made them for his own amusement or as a model. In *Frearson* v. *Loe* (*e*), Jessel, M.R., adverting to this branch of the subject, said :—"The other point raised was a curious one, and by no means free from difficulty, and what occurred with regard to that was this: that the defendant at various times made screw blanks, as he said, not in all more than 2 lbs., by various contrivances, by which no doubt screw blanks were made according to the plaintiff's patent of 1870, as well as that of 1875, they seem to have been an infringement of both. He said he did this merely by way of experiment, and no doubt if a man makes things merely by way of *bonâ fide* experiment, and not with the intention of selling and making use of the thing so made for the purpose of which a patent has been granted, but with the view of improving upon the invention, the subject of the patent, or with a view of seeing whether an improvement can be made or not, that is not an invasion of the exclusive rights granted by the patent. Patent rights were never granted to prevent persons of ingenuity exercising their talents in a fair way. But if there be neither using nor vending of the invention for profit, the mere making for the purpose of experiment and not for a fraudulent purpose ought not to be considered within the meaning of the prohibition, and if it were, it is certainly not the subject for an injunction."

To purchase infringing articles for the purpose of instructing pupils and to enable them to pull them to pieces and put them together again, is not mere experimental user, and amounts to infringement (*f*).

It will be remembered that prior to the Act of 1883 letters patent did not operate as against the Crown; questions sometimes arose as to whether persons acting in the service of the Crown might manufacture a patented article or use a patented process.

When the persons using the invention were servants of the

(*e*) L. R., 9 Ch. D. 48; see also *Muntz* v. *Foster*, 2 Web. P. C. 101; *Proctor* v. *Bayley*, 6 P. O. R. 106, 109.

(*f*) *United Telephone Co.* v. *Sharples*, L. R., 29 Ch. D. 164; 2 P. O. R. 28.

Crown, and acting in pursuance of their duty as servants, they were protected; but if they were contractors contracting with the Crown, they were not protected, but stood in exactly the same position as other subjects (*g*).

Sect. 27 of the Act of 1883 provides that a patent should bind the Crown, but that the Crown may use the invention "by agents or *contractors*" on terms to be before or after the use agreed upon.

BY USING.

It frequently occurs that very fine questions arise as to what constitutes using a patented invention. The general rule may be thus stated: That if the defendant has put the invention to the purpose for which it was intended he has used it in this country. In the case of *Neilson* v. *Betts* (*h*), in the House of Lords, the facts were as follows: Betts, the plaintiff in the suit, was the patentee of an invention for the manufacture of capsules for the purpose of covering bottles of liquid (wine, beer, or otherwise), and protecting them from the action of the atmosphere. Betts' patent did not extend to Scotland. Nielson and his co-appellants, defendants in the suit, were persons who bottled beer in Glasgow for the Indian market. They bottled the beer and covered it with capsules, which were made in Germany in pursuance of Betts' specification. The beer was shipped by the appellants in vessels which called at Liverpool to complete their cargoes; on some occasions the beer was transhipped in England, but no cases of beer were opened, nor was any of the beer sold in this country. Held, by the House of Lords, that, inasmuch as the object of Betts' invention was to make a capsule that would preserve the beer, whilst the beer was in England it was being preserved by the use of Betts' invention, and consequently that there was an infringement of the patent. Lord Chelmsford, in giving judgment in the Court below, said:—"It is the employment of the machine or article for the purpose for which it was

(*g*) *Dixon* v. *The London Small Arms Co.*, L. R., 10 Q. B. 130, and L. R., 1 App. Cas. 632, reversing decision of the Court of Appeal, L. R., 1 Q. B. D. 384; also *Feather* v. *R.*, 6 B. & S. 257.

(*h*) L. R., 5 H. L. 1.

designed which constitutes its active use, and whether the capsules were intended for ornament, or for protection of the contents of the bottles upon which they were placed, the whole time they were in England they may be correctly said to be in active use for the very objects for which they were placed upon the bottles by the vendors. If the beer, after being purchased in Glasgow, had been sent to England, and had been afterwards sold here, there can be no doubt, I suppose, that this would have been an infringement, because it would have been a profitable user of the invention, and I cannot see how it can cease to be a user because England is not the final destination of the beer."

The case of *Nobel's Explosives Co.* v. *Jones, Scott & Co.* (*i*) is instructive upon the question of user. The subject of the plaintiff's patent, dynamite, is a mechanical compound of nitro-glycerine and infusorial earth. The compounding of nitro-glycerine in this manner is done for and effects the purpose of rendering it less liable to explosion from concussion. The object of the patent was, therefore, to enable nitro-glycerine to be kept and handled with safety. Held, by Bacon, V.-C., that the mere storage of dynamite made abroad, and only landed in this country for the purpose of transhipment, amounted to an infringement of the plaintiff's patent. This decision was reversed in the Court of Appeal, but upon another point, to be mentioned presently, and without in any manner impugning the correctness of the Vice-Chancellor's decision on this question.

In the case of *Caldwell* v. *Vanvlissengen* (*k*), it was held by Turner, V.-C., that foreign ships coming into British ports, fitted with screw propellers, which were made in pursuance of the specification of an English patent, thereby infringed the patent. If the injunction which was granted be carefully read, it will be found to amount to a restraint from propelling the vessels with the propellers, not from having the ships merely fitted with them. Legally speaking, the user of propellers differs from that of capsules or dynamite in this important respect, that the one is in use only when in motion; the others are at use, the one when

(*i*) L. R., 17 Ch. D. 721; see also *The Universities of Oxford and Cambridge* v. *Richardson*, 6 Ves. 689.

(*k*) 21 L. J., Ch. 97.

merely affixed to the bottles, and the other when merely in possession. Subject to the applicability of the arguments adduced in the case of dynamite, it is submitted that **mere possession**, unaccompanied with user, does not constitute an infringement of letters patent, unless the possession is of such a character as to import **a threat to use**. But in *The United Telephone Co.* v. *The London Globe Telephone Co.* (*l*), Bacon, V.-C., said:—"That the defendants are in possession of instruments made in infringement of the plaintiff's patent is confessed by them and placed beyond the possibility of question, and that of itself gives to the plaintiffs a right to ask for an injunction to restrain the defendants from making use of that which by their own confession is an unlawful possession, and would be, if used, I presume, an unlawful use . . . . the defendants excuse themselves . . . . next on the ground that it is not their intention to use them. If it is not their intention to use the instruments then the injunction asked for can do them no harm. That would not be enough to dispose of the case, but it is the right of the plaintiffs to have an injunction against the defendants who have the means to the extent of 800 machines of injuring their patent rights."

In the case of *Adair* v. *Young* (*m*), certain pumps, which were an infringement of the plaintiff's patent, were fitted on board a British ship. There was no evidence of their having been used. Held, by the Court of Appeal, that there had been no infringement, but as there was **evidence of an intention to use** the pumps, an injunction would be granted against the use of the pumps.

But where the user complained of occurred six years before, and there was no ground for apprehending a repetition of the wrongful act, the Court of Appeal, reversing the decision of the Vice-Chancellor of the Palatine Court, held that it was not a proper case in which an injunction should be granted (*n*).

The use of an invention for a different purpose from that disclosed in the specification, will amount to an infringement of the

(*l*) L. R., 26 Ch. D. 766.
(*m*) L. R., 12 Ch. D. 13.
(*n*) *Proctor* v. *Bayley*, 6 P. O. R. 538.

patent which has been granted for that invention (*o*), but if the patent is for a new way of effecting an old object, and the patentee is in consequence strictly tied down to his particular method of performing it, in such a case the application of the invention to an entirely different object with slight varintions will not amount to an infringement of the patent (*p*).

Sect. 43 of the Act of 1883 provides:—"(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 or exported from the territories of such foreign state.*"

A patent is not infringed by being used on board an English vessel abroad (*q*).

In the case of *Nobel's Explosives Co.* v. *Jones & Scott* (*r*), mentioned above, the Court of Appeal reversed the decision of Vice-Chancellor Bacon, on the grounds that the defendants had not infringed the plaintiff's patent, they having merely acted as Custom House agents for the transhipment of the dynamite, and their functions being confined to obtaining papers necessary for such transhipment, and that they never had any ownership in or exercised any control over the dynamite.

This decision shows that the Courts will not recognize that a

(*o*) *Edison* v. *Holland*, 5 P. O. R. 459, 482; also *Cannington* v. *Nuttall*, L. R., 5 H. L. 205, 230.

(*p*) *Fletcher* v. *Glasgow Gas Commissioners*, 4 P. O. R. 386; *Preston Davies* v. *Black*, 11 P. O. R. 299, 574.

(*q*) *Newall* v. *Elliot*, 10 Jur., N. S. 954.

(*r*) L. R., 17 Ch. D. 721. Affirmed by H. L., L. R., 8 App Cas 5.

person infringes a patent by aiding and abetting, so to speak, another to do so. There must be some actual infringement on the part of the defendant (*s*).

An action may properly be brought against innocent carriers of infringing articles for an injunction to restrain them from dealing with or disposing of such articles in any way (*t*).

SELLING.

A person infringes letters patent who sells the patented article within this realm. It is a putting in practice of the invention within the terms of the grant.

Lending is not selling (*u*).

The purchase of the patented article is not of itself an infringement of the patent, nor is the mere possession, since these do not come within the prohibition in the grant, which is against making use of, or putting in practice, the said invention (*x*).

This is always with exceptions such as in the case of dynamite, where the mere possession involves *ex necessitate* the use; and the importation of the patented article will not of itself amount to an infringement.

The possession of the patented article, combined with exposure for sale, if no sale is in fact effected, is no infringement (*y*).

But the making of the patented article, as we have seen, is an infringement, whether a sale was effected, or attempted or not (*z*).

Where the patent is for a process the manufacture of an article by the process abroad and sale in this country is an infringement. In *Elmslie* v. *Boursier* (*a*), Sir W. M. James, V.-C., said:—"It is said that tinfoil can be made by the plaintiff's process at less cost than by the old method; and it is conceded that nobody in England can use the plaintiff's process of making cast tinfoil as

(*s*) See also *Townsend* v. *Haworth*, L. R., 12 Ch. D. 831, n.; *Sykes* v. *Howarth*, L. R., 12 Ch. D. 826; *Tweedale* v. *Ashworth*, 7 P. O. R. 426, 432.

(*t*) *Washburn & Moen Manufacturing Co.* v. *Cunard Steamship Co.*, 6 P. O. R. 398, 403; see also *Upmann* v. *Elkan*, L. R., 7 Ch. 130.

(*u*) *United Telephone Co.* v. *Henry*, 2 P. O. R. 11, Griff. P. C. 228.

(*x*) See *Minter* v. *Williams*, 1 Web. P. C. 135.

(*y*) Ibid.

(*z*) *Muntz* v. *Foster*, 2 Web. P. C. 101; *Oxley* v. *Holden*, 8 C. B., N. S. 666

(*a*) L. R., 9 Eq. at p. 222.

distinguished from rolled tinfoil without a licence from the plaintiff. If that cannot be done in England, it would be a very strange thing if a person in England could send an order to some one in France, get the same thing manufactured there in exactly the same way, and bring it here so as to compete with the person to whom the Crown has granted 'the whole profit, benefit, commodity, and advantage' arising from the patent. It would be a short mode of destroying 'every profit, benefit, commodity, and advantage' which a patentee could have from such a thing, if all that the man had to do was to get the thing made abroad, import it into this country, and then sell it here in competition with the English patentee."

In *Walton* v. *Lavater* (*b*) Erle, C. J., said:—"But it appears to me that the main purpose of the patent is to give the profit to the patentee, and that the main mode of defeating that purpose would be by selling the patented article; and it seems to me that without proof of the making of the article by the infringer, evidence that he sold the patented article for profit would be good evidence upon which a jury might find that he had infringed the patent. With respect to the defendant not being liable, because the articles were imported from abroad, I should say that, even if it was a simple case of importation, without any proof of knowledge of the article being patented, or of the infringement, it would be sufficient evidence of infringement that the defendant had imported and *sold*" (*c*).

In *The United Telephone Co.* v. *Sharples* (*d*), Kay, J., said:—"It is admitted by counsel for the defendant that if a man buys an instrument which he knows would, if made, sold, or used in this country, be an infringement of a patent in this country, if he buys it abroad, imports it into this country, has it in his possession, and sells it, although to a foreign customer, that would be a user which would be an infringement of the patent. I confess, as at present advised, I should have very little hesitation in saying that that would be so."

(*b*) 29 L. J., C. P. 275, 279.

(*c*) See also *Wright* v. *Hitchcock*, L. R., 5 Ex. 37; 39 L. J., Ex. 97; also *Von Heyden* v. *Neustadt*, L. R., 14 Ch. D. 230; *The Cartsburn Sugar Refining Co.* v. *Sharp*, 1 P. O. R. 181, 186.

(*d*) 2 P. O. R. 28, 31.

Where the defendant has used and sold articles alleged to have been made by the patented process, **the onus of proving** that they were in fact made by that process is on the plaintiff, but where such articles were made abroad, and the plaintiffs, in consequence, could not be afforded full opportunity of inspecting the machinery by which they were made, it has been held that it lies with the defendants to rebut a *primâ facie* case made out by the plaintiffs (*e*).

In *The Cartsburn Sugar Refining Co.* v. *Sharp* (*f*) the alleged infringement consisted in the sale in England of cube sugar manufactured in America by a machine made in accordance with the specification of the plaintiffs' patent, Lord Kinnear, in his judgment, said: "No witness has been examined of sufficient skill as a mechanic to give a detailed description of the machine in question. All that is proved is that it does not correspond in all respects, though in some respects it does correspond, to the description in *Hersey's* patent. It is said that as the manufacture complained of had taken place in America, it was incumbent on the respondents, upon the principle which received effect, in the case of *Neilson* v. *Betts* (*supra*), to prove by negative evidence that it was not manufactured according to the specified process. I think no such onus lies upon the respondents in the present case, because there can be no question on the evidence that such articles as were sold by the respondents may have been produced by machinery which involved no infringement of the complainer's patent. That being so, it lay upon the complainers to prove their case, and as they took a commission to America for the purpose of proving it, there could have been no difficulty in their obtaining a sufficient description of the machine to which it is alleged they have traced the cubes of sugar sold by the respondents, to enable them to establish the infringement, if infringement there was."

Selling known chemical substances with knowledge of and with a view to their being used for the purpose of infringing a patent is no offence, provided the vendor takes no actual personal part in the infringement (*g*).

(*e*) *Neilson* v. *Betts*, L. R., 5 H. L. 1, 11.

(*f*) 1 P. O. R., 181, 186.

(*g*) *Townsend* v. *Haworth*, L. R., 12 Ch. D. 831; *Sykes* v. *Howarth*, L. R., 12 Ch. D. 826; but note *United Telephone Co.* v. *Dale*, L. R., 25 Ch. D. 778.

A patentee selling the patented article sells with it the right of free disposition as to that article, and if he sells the article in France, the purchaser may import and sell it in England. Lord Hatherley, in *Betts* v. *Willmott* (*h*), said:—"Inasmuch as he has the right of vending the goods in France, or Belgium, or England, or in any other quarter of the globe, he transfers with the goods necessarily the licence to use them wherever the purchaser pleases. When a man has purchased an article he expects to have the control of it, and there must be some clear and explicit agreement to the contrary to justify the vendor in saying that he has not given the purchaser his licence to sell the article, or to use it wherever he pleases *as against himself*."

Where the defendants, being owners of patents in Belgium and England for an invention for making glass lamp globes, by a deed executed in Belgium, granted a licence to the plaintiffs to manufacture under their invention in Belgium but not elsewhere, and the plaintiffs under this licence manufactured articles in Belgium and sold them in England, it was held by the Court of Appeal, affirming Pearson, J., that the grant of the licence to use the patent in Belgium did not imply permission to sell the manufactured article in England in violation of the defendants' English patent (*i*).

And when the patentee has assigned his patent in France and kept it to himself in England, the French assignee may not, nor may a purchaser from him import and vend or use the goods made in France in England (*k*). In this case the sale of the article can only imply such licence as the vendor himself has, and the vendor has no right to sell in England.

Conversely, if the patentee had assigned his patent rights in England, he could not manufacture in France and sell in England, and the sale of an article in France would carry with it no implied right to import into or sell in England. But if the rights under the patent are vested in one and the same person for both France and England, or if there are no monopoly rights in France, but only in England, the patentee could not make and

(*h*) L. R., 6 Ch. at p. 245.

(*i*) *Société Anonyme des Manufacturcs de Glaces* v. *Tilghman's Patent Sand Blast Co.*, L. R., 25 Ch. D. 1.

(*k*) See the rule laid down in *Caldwell* v. *Vanvlissengen*, 9 Hare, 415.

sell in France and restrain the purchaser from selling or using the article in England, unless, indeed, there was a special agreement for that purpose; and then such agreement could not be held to attach to the article so as to prevent any person in whose hands it might come from importing it (*l*).

A vendee of a licensee, without an agreement to the contrary, has the same right of disposition with regard to things purchased as was vested in the licensee before (*m*), and where the licensee is restricted in his use of the patented article (*mm*), a purchaser from such licensee will not be affected by the restrictive covenant, unless he has due notice of its existence.

So, in *Heap* v. *Hartley* (*n*), the patentee granted to the plaintiff an exclusive licence for a district; subsequently he sold a machine made in accordance with the patent to the defendant, who brought this machine within the prohibited area. It was held by Bristowe, V.-C., and his decision was affirmed in the Court of Appeal, that the defendants were not affected by the exclusive licence for that district, since they had no notice of its existence.

In the course of his judgment Bristowe, V.-C., said (*o*):—"Where a patentee sells that which he has a perfect right to do abroad to a person who has a perfect right to buy a machine abroad, and to use in England the thing so sold, you must, before you can attach the conscience of any sub-purchaser from that man, have something in the form of notice to that man that there is a restrictive user attachable to the particular machine so bought."

But ignorance in the absence of an implied licence, as in the case we have been discussing, is no excuse, since, as has been pointed out above, infringement does not depend upon what a man intends, but upon what he does.

(*l*) *Betts* v. *Wilmott*, L. R., 6 Ch. 239.

(*m*) *Thomas* v. *Hunt*, 17 C. B., N. S. 183.

(*mm*) For an instance of a limited licence accompanying the sale of a patented article, see *The Incandescent Co.* v. *Cantelo*, 12 P. O. R. 262.

(*n*) 5 P. O. R. 603; 6 P. O. R. 495.

(*o*) 5 P. O. R. 610.

CHAPTER XVIII.

THE REMEDY—INJUNCTION.

The remedy sought or granted in an action for infringement may consist of an injunction, together with an account of sales and profits, or damages.

The Judicature Acts and the Rules which have been made for the governing of the practice of the courts have introduced great changes in the method of procedure. The old practice of moving for an injunction by a suit in the Court of Chancery, and of trying the validity of the patent at common law, has disappeared; and in its place the patentee seeking to enforce his rights commences but **one action in which he claims, and if entitled to, obtains every remedy** which was formerly granted to him by the dual process.

Every patentee proceeding against an infringer must prove the validity of his patent and his title to an injunction; that being so, and the right to the injunction hanging so completely upon the question of validity, it is obvious that the new procedure and the new power of both divisions of the High Court of Justice to grant complete and sufficient remedies and to try every question is of great advantage to persons in possession of patent rights.

The basis of an injunction is the threat actual or implied on the part of the defendant, that he is about to do an act which is in violation of the plaintiff's rights; so that not only must it be clear that the plaintiff has rights, but also that the defendant has done something which induces the Court to believe that he is about to infringe those rights.

The fact that he has been guilty of an infringement of the patent rights will, under circumstances, be evidence that he

intends to continue his infringement, but whether he has actually infringed the patent or not, it will be sufficient if he has **threatened to infringe it.** Actual infringement is merely evidence upon which the Court implies an intention to continue in the same course.

In *Frearson* v. *Loe* (*a*), Jessel, M.R., said:—"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 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. No part of the jurisdiction of the old Court of Chancery was considered more valuable than that exercise of jurisdiction which prevented material injury being inflicted, and no subject was more frequently the cause of bills for injunction than the class of cases which were brought to restrain threatened injury, as distinguished from injury which was already accomplished. It seems to me, when you consider the nature of a patent right, that 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. Of course it must be plain that what is threatened to be done is an infringement."

So in *Dowling* v. *Billington* (*b*), two acts of infringement of the plaintiff's patent were proved, the first of which took place prior to the acceptance of the complete specification by the Comptroller, while the second was committed a few days after the commencement of the action, it was held by Chatterton, V.-C., whose decision was affirmed by the Court of Appeal, that neither of these acts constituted an actionable infringement; but inasmuch

(*a*) L. R., 9 Ch. D. at p. 65. (*b*) 7 P. O. R. 191.

as the conduct of the defendant showed a deliberate intention to infringe, the plaintiffs were entitled to an injunction upon the principle laid down by Jessel, M.R., in *Frearson* v. *Loe* (*supra*).

The actual infringement of the patent is taken by the Court to imply an intention to continue the infringement, notwithstanding any promises not to do so, and an injunction will be granted. Vice-Chancellor Shadwell, in *Losh* v. *Hague* (*c*), said: "If a threat had been used, and the defendant revokes the threat, that I can understand as making the plaintiff satisfied; but if once the thing complained of has been done, I apprehend this Court interferes, notwithstanding any promise the defendant may make not to do the same thing again."

If the fact of actual infringement is relied upon, and not a mere threat, it will be necessary to show very clearly that what has been done amounts to an infringement. In *Hancock* v. *Moulton* (*d*), it was held that the evidence must be so perfect, that if it were a motion to commit for the breach of an injunction, the Court would commit upon it. If the evidence of infringement is conflicting, either by reason that it is denied that the acts complained of were done, or that such acts as were done did not amount to an infringement of the patent, the Court should not grant an interim injunction before the hearing of the action (*e*).

If the evidence relied upon for the injunction is the sale by the defendant of the patented article, and not the manufacture, the plaintiff must show that such patented article was not made by himself or his licensees (*f*).

In the case of *Adair* v. *Young* (*g*), the defendant was the captain of a ship which was fitted with certain pumps which were an infringement of the plaintiff's patent. No act of using the pumps was proved; but it was shown that the ship was not supplied with other pumps. It was held that the possession of the pumps under such circumstances, although not of itself amounting to an infringement, was evidence upon which the Court would act that the defendant intended to use the pumps,

(*c*) 1 Web. P. C. 200.
(*d*) M. Dig. 506.
(*e*) *The Electric Telegraph Co.* v. *Nott*, 2 Coop. Ch. Cas. 41.
(*f*) *Betts* v. *Willmott*, L. R., 6 Ch. 239.
(*g*) L. R., 12 Ch. D. 13.

should occasion require. And the Court, Brett and Cotton, L.JJ., James, L.J., dissenting, granted an injunction.

Lord Justice James, in giving his reasons for dissenting, said: "I think that an injunction ought not to be granted against a man unless he has done something which he ought not to have done, or permitted something which he ought to have prevented. Now, a master who comes on board ought not to be answerable on the ground that, when he takes command, there is on board a pump which infringes the patent. He does not, owing to his qualified possession, become at once an infringer. He had no power to take a pump out of the ship; he had nothing to do with putting it there, and he was not wrong in allowing it to remain there, for he could not lawfully remove it. An injunction, therefore, can only be granted on the principle of *quia timet*, and in applying that principle I think that it would be a right exercise of the discretion of the Court not to grant an injunction against a master who has done nothing wrong when there is no difficulty in finding and suing the owner of the ship."

The Court, however, seem to have been of opinion that the ground upon which an injunction should be granted is not whether the defendant has done anything wrong or not, but whether there was evidence of an intention to use the patented invention. The Court held that the circumstances of the case showed an intention in the captain to use the invention.

The principle upon which the Court grants an injunction was clearly demonstrated in *Proctor* v. *Bayley* (*h*). In that case the infringement complained of took place six years before the trial of the action. It was proved that the user continued only for a few months, after which the machines were abandoned as unsatisfactory. It was held by the Court of Appeal, reversing the decision of Bristowe, V.-C., that it was clear that the defendants had no intention whatever of continuing the wrongful act, and consequently that it was not a proper case in which an injunction should be granted. Cotton, L.J., in his judgment, said (*i*): "There is no doubt that it was a good patent, and we must also take it that the defendants have infringed; but the point is this: Is there any ground here which would justify the Court in

(*h*) 6 P. O. R. 538.

(*i*) Pp. 541, 542.

exercising the extraordinary jurisdiction of the Court of Chancery in granting an injunction? That, I think, has been a good deal lost sight of in the argument. **It is not because a man has done a wrong that an injunction will be granted against him.** If a man has done a wrong which will not be continued, at common law damages may be obtained for the wrong done, which the common law says is sufficient indemnity for that wrong; but then the Court of Chancery says this, in the exercise of its extraordinary jurisdiction: 'We will not be satisfied with that; we will grant an injunction, because a wrongful act has been done, in order to prevent that wrongful act'; and they grant an injunction where a wrongful act has been done and the Court is satisfied of the probability of the continuance of the wrongful act. . . . . But here, although the defendants did infringe the plaintiff's patent, we must consider all the circumstances of the case in order to guide us in the consideration of this: Ought the Court to draw the inference that there will be a continuance of the wrongful act so as to justify the Court in granting the extraordinary interference and the protection which is exercised by the Court of Equity?" (*k*).

On the same principle an action for an injunction may be brought against **innocent carriers of infringing articles**, in *Upmann* v. *Elkan* (*l*), which was a trade mark case, Lord Hatherley, L.C., in his judgment, said: "It has been argued that the plaintiffs were not entitled to an injunction against the defendants, who had been guilty of no offence, being merely carriers receiving goods, which, though fraudulently marked, were not for their own use, nor to be sold by them for their own benefit, but were received merely for the purpose of transmitting them to the persons to whom they were consigned. I cannot conceive a doctrine more dangerous or mischievous, or more fatal to the authority of the Court with respect to trade marks. If that argument prevailed, any persons being abroad, as was the case in this instance, and minded to commit frauds upon an

(*k*) Note also *Millington* v. *Fox*, 3 M. & Cr. 338; *Geary* v. *Norton*, 1 De G. & S. 9.

(*l*) L. R., 7 Ch. 130, 132; see also *Washburn & Moen Manufacturing Co.* v. *Cunard Steamship Co.*, 6 P. O. R. 398, 403.

English trade mark, could easily do so by sending their different consignments together to persons in the position of the defendants, who appear to be respectable agents and warehousemen, thereby committing an injury in a manner most convenient to themselves, and very mischievous to the person entitled to the benefit of the trade marks."

The above reasoning would apply equally well to infringements of letters patent. The carriers, however, will be absolved from all liability if they make full disclosure of the names of the consignors and consignees of the goods complained of (*m*).

No injunction will be granted where the patentee has **not proceeded with reasonable speed** to prosecute infringers (*n*). But in cases where there are several infringers he is not justified in commencing a vast multitude of actions and applying for injunctions in each (*o*). His proper course is to "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 will not object on the ground of delay, I do not mean to file bills against all of you at once. Am I to understand that you make no objection of that kind? If you do not object I shall file a bill against only one of you.' I do not think any court could complain of a patentee for taking the course I am suggesting" (*p*).

There are two forms of injunction, the interlocutory injunction and the perpetual injunction.

The interlocutory injunction stands very much upon the same footing, and will be granted for similar reasons and upon the same conditions that an injunction was formerly awarded by the Court

(*m*) Ibid.

(*n*) *Losh* v. *Hague*, 1 Web. P. C. 201; *Bacon* v. *Jones*, 4 My. & Cr. 438, 439; *Bridson* v. *Benecke*, 12 Beav. 1; *Baxter* v. *Combe*, 1 Ir. Ch. R. 284; *Hancock* v. *Moulton*, M. Dig. 506.

(*o*) *Foxwell* v. *Webster*, 3 N. R. 103, at p. 180.

(*p*) Per Sir W. Page-Wood, V.C., *Bovill* v. *Crate*, L. R., 1 Eq. at p. 391. See also *Hancock* v. *Moulton*, M. Dig. 506; *Smith* v. *L. & S. W. Rail. Co.*, Kay, 408.

of Chancery when an action was directed to be tried at common law.

The perpetual injunction is granted after trial, and binds the parties against whom it is granted during the continuation of the term of the patent.

An interlocutory injunction may be granted **ex parte**, after the issue of the writ, and before service. An ex parte injunction will only be granted when it can be shown that great injury will accrue to the plaintiff by delay, and when he can clearly establish his title and the fact of infringement (*q*).

Notice of motion having been given, an interlocutory injunction will be granted after appearance, or with leave, upon notice of motion to be served with the writ.

By sect. 25 of the Judicature Act, 1871, sub-sect. 8: "A mandamus or an injunction may be granted, or a receiver appointed by an interlocutory order of the Court, in all cases in which it shall appear to the Court to be just or convenient that such order should be made; and any such order may be made either unconditionally or upon such terms and conditions as the Court shall think just; and if an injunction is asked either before, or at, or after the hearing of any cause or matter to prevent any threatened or apprehended waste or trespass, such injunction may be granted if the Court shall think fit, whether the person against whom such injunction is sought is or is not in possession under any claim of title or otherwise, or (if out of possession) does or does not claim a right to do the act sought to be restrained under any colour of title; and whether the estates claimed by both or either of the parties are legal or equitable."

It will be observed that this section confers upon the Court very wide limits within which, in its discretion, it may grant injunctions. It sweeps away a great deal of the technical rules which had been from time to time laid down by the Court of Chancery for the granting of injunctions, and it practically substitutes for them the opinion of the judge trying each particular action as to the balance of convenience upon a consideration of the facts of the case.

(*q*) *Gardner* v. *Broadbent*, 2 Jur., N. S. 1041.

Order L. rule 6, directs that: "An application for an order under sect. 25, sub-sect. 8, or under rules 2 or 3 of this Order, may be made to the Court or a judge by any party. If the application be by the plaintiff for an order under the said sub-sect. 8, it may be made either ex parte or with notice. . . . ."

A master of the Queen's Bench Division has no power to grant an injunction. Order LIV. rule 12.

An interlocutory injunction will be granted whenever there has been such **working, user and enjoyment** of the patent rights by the patentee as will satisfy the Court that there are strong *prima facie* reasons for acting on the supposition that the patent is valid.

Lord Eldon, in the case of the *Universities of Oxford and Cambridge* v. *Richardson* (*r*), said: "It is then said in cases of this sort the universal rule is that if the title is not clear at law the Court will not grant or sustain an injunction until it is made clear at law. With all deference to Lord Mansfield, I cannot accede to that proposition so unqualified. There are many instances in my own memory in which this Court has granted or continued an injunction to the hearing under such circumstances. In the case of patent rights, if the party gets his patent and puts his invention in execution and has proceeded to a sale, that may be called possession under it; however doubtful it may be whether the patent can be sustained, this Court has lately said **possession under a colour of title** is ground enough to enjoin, and to continue the injunction, till it shall be proved at law that it is only colour and not real title."

And in *Gardner* v. *Broadbent* (*s*), Sir J. Stuart, V.-C., said: "I wish it to be understood that the law of the Court is that laid down by Lord Eldon in the *Universities of Oxford and Cambridge* v. *Richardson*."

There having been a trial as to the validity of the patent, which has terminated in favour of the patentee, will be considered by the Court sufficient **reason for granting an interlocutory injunction** (*t*); and where the patentee has worked and enjoyed the

(*r*) 6 Ves. 689, 706.
(*s*) 2 Jur., N. S. 1041.
(*t*) *Dudgeon* v. *Thompson*, 30 L. T., N. S. 244; 22 W. R. 464; *Russell* v. *Cowley*, 2 Coop. Ch. Ca. 59, n.; *United Telephone Co.* v. *St. George*, 3 P. O. R. 33; *Moser* v. *Sewell*, 10 P. O. R. 365.

patent for many years without dispute, an interlocutory injunction will be granted (*u*); so also where the defendant has admitted the validity of the patent (*x*), or is so placed in his relationship to the patentee as to be estopped from denying its validity (*y*).

In *Dudgeon* v. *Thompson* (*z*), Jessel, M.R., said: "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."

So in *Betts* v. *Menzies* (*a*), Wood, V.-C., said:—"The law of this Court is, that where the 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."

What amounts to long enjoyment is difficult to define, but decided cases would appear to suggest that undisturbed enjoyment for six years would be sufficient (*b*); but the user of the invention during that time must be active. The mere possession of a patent for a long period does not of itself give rise to a presumption of its validity (*c*).

An interlocutory injunction is seldom granted **in the case of a new patent** (*d*), unless very strong evidence in support of the motion be adduced (*e*), or where the validity of the patent has

(*u*) *Dudgeon* v. *Thompson*, 30 L. T., N. S. 244; *Curtis* v. *Cutts*, 2 Coop. Ch. Ca. 60, n.; *Davenport* v. *Goldberg*, 2 H. & M. 282; *Penn* v. *Bibby*, L. R. 3 Eq. 308; *Muntz* v. *Foster*, 2 Web. P. C. 95; *Bickford* v. *Skewes*, 1 Web. P. C. 211; *Plimpton* v. *Malcolmson*, 44 L. J., Ch. 257; *Rothwell* v. *King*, 3 P. O. R. 379; *Hayward* v. *Pavement Light Co.*, Griff. P. C. 124.

(*x*) *Dircks* v. *Mellor*, 26 Lon. Journ. 268.

(*y*) *Clarke* v. *Fergusson*, 1 Giff. 184.

(*z*) 30 L. T., N. S. 244.

(*a*) 3 Jur., N. S. at p. 358.

(*b*) *Bickford* v. *Skewes*, 1 Web. P. C. 211; *Rothwell* v. *King*, 3 P. O. R. 379.

(*c*) *Plimpton* v. *Malcolmson*, 44 L. J., Ch. 257.

(*d*) *Caldwell* v. *Vanvlissengen*, 9 Hare, 415, 424; *Renard* v. *Levinstein*, 10 L. T., N. S. 177; *Lister* v. *Norton*, 1 P. O. R. 114; *Jackson* v. *Needle*, 1 P. O. R. 174; *British Tanning Co.* v. *Groth*, 7 P. O. R. 1.

(*e*) *Gardner* v. *Broadbent*, 2 Jur., N. S. 1041.

been tried and uphold (*f*), though where the plaintiffs made out a *prima facie* case, and no substantial defence was put forward, the Court granted an interlocutory injunction (*g*). The usual practice in such cases is to order the motion to stand over to the trial without prejudice to any question, the defendants undertaking to keep an account.

An interlocutory injunction will not be granted in cases where the plaintiff is guilty of **delay** in making his motion (*h*).

The principle which may be gleaned from the decisions in motions for interlocutory injunctions is that the Court will consider the **balance of convenience** in each particular case (*i*).

If it should appear that irremediable injury will be sustained by the defendant if an injunction goes which may afterwards appear unfounded, the Court will require a very strong case to be made out by the plaintiff before granting such an injunction (*k*), and the converse would equally appear.

In *Bickford* v. *Skewes* (*l*), Shadwell, V.-C., said: "I have nothing to do with any other case than the case before me."

The Court will not infrequently **grant or refuse the injunction** until the hearing **upon terms**; the terms on the plaintiff being that he shall be answerable in damages, or on the defendant that he shall keep an account of the material manufactured, or of the articles sold, in pursuance of the patent process, but it is open to the plaintiff to show that if he succeeds the defendant's position is such that he will be unable to pay the damages or the amount of the account (*m*). In considering which course should be adopted, the Court will be influenced chiefly by the balance of convenience and the probability of injury to either side (*n*).

(*f*) *The Farben Fabriken, vorm. F. Bayer & Co.* v. *Dawson*, 8 P. O. R. 397.

(*g*) *Coles* v. *Baylis*, 3 P. O. R. 178.

(*h*) *Bovill* v. *Crate*, L. R., 1 Eq. 388; *Greer* v. *Bristol Tanning Co.*, 2 P. O. R. 268; but note *United Telephone Co.* v. *Equitable Telephone Co.*, 5 P. O. R. 233.

(*i*) *Walker* v. *Clarke*, 4 P. O. R. 111; *Challender* v. *Royle*, 4 P. O. R. 363; *Thomson* v. *Hughes*, 7 P. O. R. 71; *Bracher* v. *Bracher*, 7 P. O. R. 420; *Kensington, &c., Electric Lighting Co.* v. *Lane Fox*, 8 P. O. R. 277; *Moser* v. *Sewell*, 10 P. O. R. 365, 367.

(*k*) *Neilson* v. *Forman*, 2 Coop. Ch. Ca. 61, n.

(*l*) 1 Web. P. C. 213.

(*m*) *Newall* v. *Wilson*, 2 De G. M. & G. 282; *Bracher* v. *Bracher*, 7 P. O. R. 420.

(*n*) *Neilson* v. *Thompson*, 1 Web. P. C. 278; *Bridson* v. *M'Alpine*, 8 Beav. 229; and cases supra.

In *Plimpton* v. *Spiller* (*o*), James, L.J., said:—"The Court, not forming an opinion very strongly either one way or the other whether there is an infringement or not, but considering it is as a fairly open question to be determined at the hearing, and not to be prejudiced by any observations in the first instance, reserves the question of infringement as one which will have to be tried at the hearing and which it will then have to consider. There will always be, no doubt, the greatest possible difficulty in determining what is the best mode of keeping things *in statu quo* —for that is really what the Court has to do, to keep things *in statu quo*—until the final decision of the question; and then, of course, the Court says, 'We will not stop a going trade. We will not adopt a course which will result in a very great difficulty in giving compensation on the one side or on the other. We have to deal with it as a practical question, in the best way we can.' I think, on the whole, that the Master of the Rolls has made the right order, viz., by granting the injunction and putting the plaintiff upon an undertaking to abide by such order (if any) as to damages as the Court may think fit to make if he should ultimately turn out to be in the wrong, and that it would not be right in this case merely to put the defendant upon the terms of keeping an account which, I conceive, might be a very clumsy and inefficient mode of recompensing the plaintiff if he should turn out ultimately to be in the right." In the same case the present Master of the Rolls, Sir W. B. Brett, said (*p*):—"There will be a hardship on the one side or on the other, and the question is on which side does the balance appear to lie? Now, if the trade of a defendant be an old and established trade, I should say that the hardship upon him would be too great if any injunction were granted. But where, as here, the trade of the defendant is a new trade, and he is the seller of goods to a vast number of people, it seems to me to be less inconvenient and less likely to produce irreparable damage to stop him from selling, than it would be to allow him to sell and merely keep an account, thus forcing the plaintiff to commence a multitude of actions against the purchasers."

(*o*) L. R., 4 Ch. D. 289.

(*p*) At p. 292.

The evidence to be used upon an application for an interlocutory injunction is upon affidavit.

The affidavit should clearly point out in what the alleged infringement consists (*q*). If the plaintiff is the first inventor, he must distinctly swear to the fact, as also to the novelty and utility of the invention, and to the due filing of a sufficient specification (*r*). If the plaintiff is an assignee he must swear to the best of his belief (*s*). The affidavits in either case must state the facts as at the time of swearing, and it is not sufficient to swear that the invention was believed to be new when the patent was granted (*t*). An injunction granted prior to statement of claim will be dissolved if the statement of claim when delivered does not agree with the affidavits upon which the injunction was granted (*u*).

In the Chancery Division it is the practice to hear applications for interlocutory injunctions as motions in Court. In the Queen's Bench Division the application is heard by the Judge in Chambers upon a summons.

Forms of injunction upon undertaking as to damages (*x*), and of order refusing injunction upon terms (*y*), will be found in the Appendix.

After trial and judgment, and upon application for a perpetual injunction, when the nature of the infringing matter will permit of it, an order will be made that the articles (machinery or otherwise) **be delivered up to the plaintiff or destroyed** (*z*). This was done in *Plimpton* v. *Malcolmson* (supra); the reference to this cause is M.R., 28th Jan., 1876, B. 381. An inquiry will, when necessary, be directed as to the articles manufactured which are in the defendant's possession, and that they be destroyed, *Betts* v. *De Vitre*, V.-C. W., 1865, A. 119. The

(*q*) *Hill* v. *Thompson*, 3 Mer. 624; *Betts* v. *Willmott*, L. R., 6 Ch. 239.

(*r*) *Hill* v. *Thompson*, 3 Mer. 624; *Sturtz* v. *De la Rue* (per Lord Lyndhurst), 5 Russ. 329; *Whitton* v. *Jennings*, 1 Dr. & S. 110.

(*s*) *Gardner* v. *Broadbent*, 2 Jur., N. S. 1041.

(*t*) *Hill* v. *Thompson*, 3 Mer. 624.

(*u*) *Stocking* v. *Llewellyn*, 8 L. T. 33.

(*x*) Form 4, p. 472, post.

(*y*) Form 5, p. 473, post.

(*z*) *Frearson* v. *Loe*, L. R., 9 Ch. D. at p. 67; but see also *United Telephone Co.* v. *London & Globe Telephone Co.*, L. R., 26 Ch. D. at p. 776; *Siddell* v. *Vickers*, 5 P. O. R. at p. 101.

defendant will also be ordered to make discovery upon oath of the articles or machinery which he may have in his possession, and which infringe the plaintiff's patent, so that they may be delivered up and destroyed; this was done in *Tangye* v. *Stott*, V.-C. W., 12th Feb., 1866, B. 461. **The right of property in the articles which infringe the patent remains in the infringer,** although the Court may order the articles to be destroyed (*a*).

These mandatory orders are never made except after trial, and when the plaintiff has fully established to the satisfaction of the Court the validity of his patent and the fact of the defendant's infringement.

An injunction having been granted to restrain the defendant from infringing a patent for the manufacture of telephones: It was held to be a breach of the injunction to sell the separate parts of the patented telephones which anyone might put together (*b*).

The injunction falls with the **expiration of the patent** (*c*), but where machines have been manufactured or articles made in infringement of patent rights, an injunction will be granted to prevent their use or sale, even after the patent has expired (*d*).

A person against whom an injunction has been granted is liable to be committed should he be guilty of a **breach of such injunction,** but an application for committal, involving as it does the liberty of the subject, will require the strictest proof in its support (*e*).

In *Hopkinson* v. *St. James and Pall Mall Electric Light Co.* (*f*), an injunction was granted but was suspended for six months, the defendants agreeing to keep an account on the ground that **great inconvenience** would be caused **to the public** by suddenly stopping the use of the three wire system.

(*a*) *Vavasseur* v. *Krupp*, L. R., 9 Ch. D. 351.

(*b*) *United Telephone Co.* v. *Dale*, L. R., 25 Ch. D. 778.

(*c*) *Daw* v. *Eley*, L. R., 3 Eq. 496.

(*d*) *Crossley* v. *Beverley*, 1 Web. P. C. 119; *Crossley* v. *The Derby Gas Light Co.*, 4 L. J., Ch. 25; see also *Price's Patent Candle Co.* v. *Bauwen's Patent Candle Co.*, 4 K. & J. 727.

(*e*) *Dick* v. *Haslam*, 8 P. O. R. 196.

(*f*) 10 P. O. R. at p. 62.

DAMAGES.

In addition to an injunction, the defendant may be entitled, when there has been actual infringement as distinguished from an intention to infringe, to either damages or an account of sales and profits.

He is not entitled to both damages and an account, but he must elect which he will take (*g*). An account of sales and profits amounts to a condonation of the infringement (*h*).

The measure of damage is not the profit made by the infringer, but is the loss which the plaintiff has actually sustained (*i*). The question of damages is not synonymous with an account of profits, the basis of calculation being entirely different.

"The loss must be the natural and direct consequence of the respondent's acts" (*k*), consequently the damages will be the estimated loss of profit incurred by the plaintiff by reason of the sale by the defendant of articles which infringed the plaintiff's patent; such a question must be one of considerable difficulty, and can only be decided by a fair businesslike view of all the circumstances of the case.

A probable result of the sale by the defendant, of articles which infringe the plaintiff's patent, is a reduction in price owing to the **commercial competition**, and a consequent loss of profit to the plaintiff; whether this source of damage may or may not be taken into consideration will depend upon the circumstances of the case.

In *The United Horse-shoe and Nail Co.* v. *Stewart* (*l*), loss of profit arising from such competition was not allowed. In that case the patent in question was one for a machine to produce horse-shoe nails more cheaply than had been done before; consequently anyone else could make nails in competition with the plaintiffs, they were only restrained from making them by means of that

(*g*) *De Vitre* v. *Betts*, L. R., 6 H. L. 319; *Neilson* v. *Betts*, L. R., 5 H. L. 1; *Needham* v. *Oxley*, 11 W. R. 852.

(*h*) Per Lord Westbury, *Neilson* v. *Betts*, supra; also *United Horsenail Co.* v. *Stewart*, 3 P. O. R. at p. 143.

(*i*) *United Horsenail Co.* v. *Stewart*, 3 P. O. R. at p. 143; 5 P. O. R. at p. 267; *Petman* v. *Bull*, 3 P. O. R. at p. 393.

(*k*) Per Lord Macnaghten, *United Horsenail Co.* v. *Stewart*, 5 P. O. R. at p. 268; see also *American Braided Wire Co.* v. *Thomson*, 7 P. O. R. 152.

(*l*) 3 P. O. R. 139; 4 P. O. R. 130; 5 P. O. R. 260.

particular description of machine, and further the plaintiffs had always gone a little before the defendants in reducing their prices, and so continually kept the prices lower than that quoted by the defendants.

In *The American Braided Wire Co.* v. *Thomson* (*m*), the patent infringed was one for the manufacture of a particular form of bustle; no one else being able to put a similar bustle on the market without infringing that patent, the plaintiffs did not reduce their prices until compelled to do so by the defendants, and then only reduced them to the level quoted by the defendants; the official referee in his finding said: "But for the defendants' competition and their selling at lower prices the plaintiffs would, subject to the allowances mentioned in paragraphs 2, 3, and 4, have made the sales made by the plaintiffs, and also those made by the defendants at the plaintiffs' original prices." Taking all these circumstances into consideration, the Court of Appeal held that the finding of the official referee was reasonable and fair, and that the plaintiffs were entitled to the full amount so found, including the loss of profit arising from the competition of the defendants.

In estimating damages, the Court will inquire into the extent of infringement and the amount of goods manufactured by the defendant, care being taken to distinguish this inquiry from that as to sales and profits.

In the *United Horse-nail Co.* v. *Stewart* (*n*), a Scotch case, the Lord Ordinary (Kinnear) said:—"It appears to me to be a fair enough ground for estimating their damages to take the whole profits which they would have made upon the sales actually made by the defenders, if the defenders had not interfered so as to prevent the pursuers effecting those sales themselves. That would mean the difference between the cost of manufacture and the prices at which they were selling at the time to their agent."

In *Ungar* v. *Sugg* (*o*), Wright, J., said: "No one can doubt that in this case there was substantial damage, and the difficulty and impossibility of stating the precise ground for assessing it at any particular figure, does not seem to be a

(*m*) 7 P. O. R. 152.

(*n*) 3 P. O. R. 143; see also *Boyd* v. *Tootal Broadhurst Co.*, 11 P. O. R. 175.

(*o*) 8 P. O. R. 385, 388.

sufficient reason for giving only a nominal sum," and Lord Esher, M.R., in the Court of Appeal, said (*p*): "They were problematical damages, and had to be what is called guessed at: that is, not a mere guess, as if you were tossing up for the thing, but it must come to a mere question of what, in the mind of the person who has to estimate them, was a fair sum."

The fact that only part of the machine is an infringement is immaterial, since each thing produced by the assistance of such part is itself an infringement of the plaintiff's patent, and to that extent occasions damage by interfering with the plaintiff's trade (*q*).

Where bills to restrain the infringement of a patent have been filed against both the person who manufactures, and the person who uses the article, and issues of fact have been found for the plaintiff, it is the right of the plaintiff to have, not only an account against the manufacturer, but also damages against the person using the article, wherever it be found (*r*).

The fact that a patentee has recovered judgment and damages against a manufacturer of infringing articles, does not preclude him from taking further proceedings against the purchasers of infringing articles from such manufacturer (*s*).

Where licences have been granted, no account will be taken of profits which have been lost by reason of competition (*t*).

In *Penn* v. *Jack* (*u*) the plaintiff was not in the habit of manufacturing himself under his patent, but granted licences for the use of the invention. Sir W. Page-Wood, V.-C., fixed the amount of damage at the amount which would have been received had the defendant been working under a licence.

In aid of the inquiry as to damages, directed by the judgment for a perpetual injunction, **the defendant must give full discovery,** and will be required to set out the names and addresses of the persons to whom machines, made in infringement of the patent,

(*p*) 9 P. O. R. 113, 117.

(*q*) *United Horse-shoe and Nail Co.* v. *Stewart*, 5 P. O. R. 264.

(*r*) Headnote to *Penn* v. *Bilby*, L. R., 8 Eq. 308.

(*s*) *United Telephone Co.* v. *Walker*, 4 P. O. R. at p. 66.

(*t*) *Penn* v. *Jack*, L. R., 5 Eq. at p. 85.

(*u*) Ibid.; see also *United Telephone Co.* v. *Walker*, 4 P. O. R. 63.

have been sold; but not the names of the agents concerned in the transaction (*x*).

ACCOUNT OF SALES AND PROFITS.

In cases where it is deemed to the advantage of the plaintiff, he may elect, in lieu of damages, to take an account of sales and profits; that is, to condone the infringement upon the footing that the defendant has been acting as the plaintiff's agent in selling or using the invention (*y*).

An **inquiry as to profits** is one which involves many questions of great difficulty (*z*), and in consequence is usually attended by a great expenditure, both of time and money, "therefore, although the law is that a patentee has a right to elect which course he will take, as a matter of business he would generally be inclined to take an inquiry as to damages, rather than launch upon an inquiry as to profits" (*a*).

The plaintiff will not be allowed to claim an account **if he has tacitly permitted the defendant to infringe his patent**, relying upon an ultimate account of profits. In *Crossley* v. *The Derby Gas Light Co.* (*b*), Lord Brougham said:—"It is a principle of equity, that a party who claims a right should not lie by, and by his silence or acquiescence induce another to go on spending his money and incurring risk, and afterwards, if profit has been made, come and claim a share in that profit without having ever been exposed to share in the losses which might have been sustained. Upon this the defendants rely; but it was to be considered, on the other hand, whether the plaintiff did not explain the delay which has taken place, and whether the conduct of the defendants has not been such as to lull the plaintiff's suspicions to sleep."

Where it appears at the trial that the defendant has made no profit, although the plaintiff may be entitled to damages, he will not be entitled to an account (*c*).

(*x*) *Murray* v. *Clayton*, L. R., 15 Eq. 115.

(*y*) *Betts* v. *De Vitre*, L. R., 6 H. L. 319; *United Horsenail Co.* v. *Stewart*, 3 P. O. R. 143.

(*z*) *Siddell* v. *Vickers*, 6 P. O. R. 464, 467; 9 P. O. R. 152.

(*a*) Per Lindley, L.J., in *Siddell* v. *Vickers*, 9 P. O. R. at p. 163.

(*b*) 1 Web. P. C. 120.

(*c*) *Bacon* v. *Spottiswoode*, 1 Beav. 387.

Where the defendant has acted in ignorance of the patent, and before action has offered to submit to an account and to pay to the plaintiff the amount of profits, the Court should exercise its discretion in disallowing costs (*d*), although it may grant the injunction. In such a case the plaintiff will proceed to an account at his peril, running the risk of nothing being found due.

Prior to the Judicature Acts it was held a rule in Courts of Equity, that in consequence of the terms of 21 & 22 Vict. c. 27, no relief could be awarded for damages or an account, unless an injunction could be granted at the same time; all other relief being merely incidental to the injunction (*e*). Thus, where a patent had expired after bill filed, but before an injunction could be granted, the Court declined to consider the question of damages (*f*). But now, in pursuance of sect. 24, sub-sect. 6, of the Judicature Act, 1873, a Court of Equity may give full relief; and so, wherever a court of law would, prior to the passing of the Act, have granted damages or an account, similar orders will be made by either branch of the High Court of Justice, irrespective of the question of injunction.

(*d*) *Nunn* v. *D'Albuquerque*, 34 Beav. 595; *Redges* v. *Mulliner*, 10 P. O. R. 21, 28.

(*e*) *Price's Patent Candle Co.* v. *Bauwen's Patent Candle Co.*, 4 K. & J. 727.

(*f*) *Betts* v. *Gallais*, L. R., 10 Eq. 392.

CHAPTER XIX.

REVOCATION.

We have seen that the patentee has his remedy in an action for infringement. The public has also a remedy by petition for revocation.

Sect. 26 of the Act of 1883 provides:—

"(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 for 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 authorised 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.*"

Practically speaking, scire facias had fallen into desuetude before the passing of this Act; other methods of disputing the validity of patents were found, or thought to be, more to the advantage of persons opposing them. It is presumed, however, that the new procedure will find more favour, being simpler, more speedy, and more similar to the ordinary action for infringement than the old action of scire facias.

The grounds upon which a patent may be revoked are similar to those upon which it might have been cancelled by scire facias (*a*). These are in the Fourth Institute said to be: "*Firstly*, when the king by his letters patent doth grant by several letters patent one and the selfsame thing to several persons, the former patentee shall have a scire facias to repeal the second patent; *secondly*, when the king granteth anything that is grantable upon a false suggestion, the king by his prerogative *jure regio* may have a *scire facias* to repeal his own grant. When the king doth grant anything, which by law he cannot grant, he *jure regio* (for the advancement of justice and right) may have a *scire facias* to repeal his own letters patent."

And it was held in *Sir Oliver Butler's case* (*b*), that "where a

(*a*) 4 Inst. 88. (*b*) 2 Vent. 344.

patent is granted to the prejudice of the subject, the king, of right, is to permit him on his petition to use his name for the repeal of it in a *scire facias* at the king's suit, and to hinder multiplicity of actions upon the case."

Thus it will be seen that formerly any person might, on behalf of the public, proceed by *scire facias* to repeal a patent, although security for costs was required. Sub-sect. 4 of sect. 26 has very considerably narrowed and limited this general right.

Practically speaking, any ground which may be set up as a defence to an action for infringement may be employed as a ground for revocation—such as that the person to whom the letters patent were granted was not the first and true inventor, or that the invention was not new or useful, or that it was not true that the invention had not been practised before, or that the said invention did not come within the meaning of the words "a new manufacture," or that the specification was insufficient and did not disclose the nature of the invention.

The petition is to be presented to the High Court of Justice in England or in Ireland. By sect. 109 it is provided: (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.*" And in respect to Ireland we find that, by sect. 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.*"

Only persons who come within the provisions of clauses c, d, and e, of sect. 26, sub-sect. 4, are entitled to present a petition for revocation as a matter of right; care, however, must be exercised to frame the petition under the proper clause.

In re Avery's Patent (*c*) was a petition for revocation presented under clause c; it was held by Stirling, J., and the Court of Appeal, that this applied only to cases of actual fraud, and would not be extended to questions of mistake, though the consequences might be to deprive the inventor of his patent rights. Cotton, L. J., said:—"If it is made out that the

(c) L. R., 36 Ch. D. 307.

present petitioner Avery is a person who brings himself within that clause, and *satisfies the Court* that the patent was obtained in fraud of his rights, then we should have to go into the other question, namely, whether the patent is or is not good" . . . . (at p. 325), "an act, to be 'in fraud of his rights,' to my mind must involve an attempt by the agent to deprive the principal of something, or to gain for himself something at the expense of his principal." The petition consequently was dismissed, but without prejudice to the right of the petitioner to present a fresh petition framed under clause d.

A person who is entitled to present a petition for revocation without the necessity of first obtaining the fiat of the Attorney-General, may rely upon any lawful ground whereby to impeach the validity of the patent in question, and is not confined to the ground upon which his title to present the petition is based (*d*).

Where a patent is revoked on the ground that it was obtained in fraud of the rights of the petitioner, the Court will decree that a fresh patent for the invention should be granted to the petitioner (*e*).

All persons beneficially interested in the patent must be made parties to the petition (*f*).

No petition for revocation will lie in respect of a patent granted for an invention which the Secretary of State has certified should be kept secret in the interest of the public service (*g*).

Should a person desire to present a petition for revocation, not being entitled to do so under clauses c, d, or e, **he must first obtain the fiat of the Attorney-General**; in order to obtain the fiat the following documents must be lodged with the Attorney-General's clerk:—

1. A memorial drawn up on judicature paper setting out the history of the case and the grounds upon which the application is based; where there have been proceedings taken for infringement, these and their result must be mentioned. This memorial

(*d*) *In re Morgan's Patent*, 5 P. O. R. 186.

(*e*) *In re Gale's Patent*, 8 P. O. R. 438; *In re Avery's Patent*, L. R., 36 Ch. D. 326.

(*f*) *In re Avery's Patent*, 4 P. O. R. 159.

(*g*) 46 & 47 Vict. c. 57, s. 44, sub-s. 9.

must be accompanied by all specifications and documents referred to.

2. A declaration by the petitioner verifying the statements in the memorial; this also should be upon judicature paper.

3. Two copies of the proposed petition on brief paper.

4. Two copies of the particulars of objections.

5. A certificate by counsel on foolscap, that in his opinion the petition is a proper one for the grant of the fiat of the Attorney-General.

6. A certificate by a solicitor that the applicant is a proper person to present the petition, and that he is competent to answer the costs of all proceedings in connection with the petition.

7. A declaration by the applicant that the questions proposed to be raised by the petition, are not, and cannot be raised in any legal proceedings then pending in the United Kingdom (*h*).

The fees payable on lodging these documents amount to 2*l.* 13*s.* 4*d.*

It is submitted that the seventh of the above-mentioned documents, is one which ought not to be insisted upon by the Attorney-General, since if the fiat is to be refused when an action for infringement is pending and the questions proposed to be raised will in consequence be then considered, the public may be deprived of one of the greatest benefits which arise from the provisions of the legislature for the revocation of patents, for although the defendant may be successful in the action brought against him for infringement, it will still remain open to the patentee to amend his specification by abandoning a portion of his claim, and subsequently to bring a fresh action against the same defendant for infringement of the patent as amended; thus if the public are to be deprived of the power to revoke a patent simply because an action for infringement may be pending, in such a case as that stated above, a man against whom the action is brought either will be liable to a succession of actions or at the least will have to incur the expense of two actions, first as defendant in the infringement action, and secondly as

(*h*) For forms of these documents see Appendix D.

petitioner for revocation, to enable him to carry on his business in security (*i*), whereas by replying to an action brought against him by presenting a petition for revocation, the two actions would be consolidated into one, as was done in the recent case of *Weir* v. *Denny* (*k*), and the validity of the patent would be decided once and for all.

The Attorney-General has absolute discretion in granting or refusing his fiat; if the applicant shows sufficient interest, and makes out a good case, the Attorney-General will grant his fiat without hearing the patentee (*l*), but in some cases he will direct notice to be given to the persons interested in the patent, and will hear both parties and give his decision in the ordinary way (*m*); Sir H. James, A.-G., decided that he had no power under sect. 38 to give costs in these cases (*n*).

The form of the fiat of the Attorney-General will be found in the Appendix of Forms.

There are no provisions in the Patents Acts or elsewhere regulating the procedure in a petition for revocation, not even for filing an answer on the part of the patentee.

The practice is to take out a summons for directions, nominally for hearing, whereby the respondent is compelled to appear; a patent may be revoked at this stage when a clear case is made out (*o*), but the usual course is for the judge to give directions as to the filing of an answer, and also as to interrogatories, inspection, discovery, etc., and the manner of trial, after which the petition stands adjourned.

Where the patentee or other person interested in the patent is out of the jurisdiction, notice must be given to such person that

(*i*) This occurred in *Re Deeley's Patent*; for report of the infringement action see *Westley Richards* v. *Perkes*, 10 P. O. R. 181, 382; for proceedings on application for leave to amend the patent, *Deeley's Patent*, 11 P. O. R. 72. The petition for revocation was heard in December, 1894, before Romer, J., in which judgment was given for the petitioner, 12 P. O. R. 65.

(*k*) 11 P. O. R. 657.

(*l*) *Goulard and Gibbs Patent*, Griff. P. C. 320; *Rothwell's Patent*, Griff. P. C. 320.

(*m*) *Bell & Coleman's Patent*, Griff. P. C. 320; *Martin's Patent*, Griff. P. C. 320; *Siddell's Patent*, Griff. P. C. 320; *Walling's Patent*, Griff. P. C. 320.

(*n*) *Martin's Patent*, Griff. P. C. 320.

(*o*) *Vaisey's Patent*, 11 P. O. R. 591.

the petition has been presented (*p*), as the Court will not decree the revocation of a patent without giving all interested parties an opportunity of being heard, but the mere fact that the patentee is out of the jurisdiction will not prevent the institution of proceedings for revocation (*q*).

A respondent residing out of the jurisdiction will not be ordered to give security for costs (*r*).

The practice as to particulars is precisely similar to that in an action for infringement. It will, however, be observed that the judge has no power of certifying under sect. 31 that the validity of the patent came in question, nor will a certificate granted in a previous action for infringement affect the question of costs in proceedings for revocation, the words of sect. 31 being "*in any subsequent action for infringement.*"

Section 100 of the Judicature Act defines "pleading" as including any *petition* or summons, and also as including the statements, in writing, of the claims or demand of any plaintiff, and of the defence of any defendant thereto, and of the reply of the plaintiff to any counter-claim of a defendant.

Order XXXI. r. 1 of the rules of the Supreme Court, gives power to the Court, or a judge, to permit interrogatories "*in any cause or matter*," to be delivered by either party to the other. It is presumed that leave will be given to the respondent (called defendant in the Patent Act, 1883) to deliver interrogatories to the petitioner, and circumstances may arise when it would be just to permit the petitioner to examine the respondent. The rules as to interrogatories will be similar to those in an action for infringement.

Section 28, sub-sect. (1), provides that the mode of trial of a petition for revocation shall be similar to that of an action for infringement.

(*p*) *Drummond's Patent*, 6 P. O. R. 576; L. R., 43 Ch. D. 80; *La Compagnie Générale d'Eaux Minérales Trade Marks*, 8 P. O. R. 446; L. R., 1891, 3 Ch. 451; *F. King & Co.'s Trade Mark*, 9 P. O. R. 350; L. R., 1892, 2 Ch. 462; *Kay's Patent*, 11 P. O. R. 279.

(*q*) Ib.

(*r*) *La Société Anonyme Trade Mark*, 10 P. O. R. 290; *Miller's Patent*, 11 P. O. R. 55.

And the parties are entitled to have the petition heard as *viva voce* evidence (*s*).

The evidence which will be required of the respondent (defendant), in the first instance, will be very slight, and will be similar to that which he would give as to the validity of the patent were he plaintiff in an action for infringement. The petitioner will then have to prove the case he alleges in his petition and particulars, and the respondent has the right of reply. It is merely to preserve this right to reply, that the respondent is made practically plaintiff at the trial.

By virtue of section 19 of the Act of 1883, in a proceeding for revocation of a patent, the patentee may at any time by leave of the Court apply to amend his specification by disclaimer, consequently after a decision has been given in favour of the petitioner in the Court of First Instance, the patentee may, pending appeal, obtain leave of the Court of Appeal to apply at the patent office for leave to strike out any portion of his claim which the judgment of the Court below may have convinced him to be incapable of being supported. But after judgment has been given by the Court of Appeal revoking the patent their power to give leave under section 19 is gone, and in consequence, it is submitted that, although only one claim may have been held invalid, the patent is *ipso facto* revoked and can only be revived by a successful appeal to the House of Lords, who, as we have noticed above, have no jurisdiction to give leave to apply to amend, not being included in the term Court in section 19 of the Act of 1883.

(*s*) *Gaulard & Gibbs' Patent*, L. R., 34 Ch. D. 396; 56 L. J., Ch. 606; 56 L. T. 284.

CHAPTER XX.

ACTION TO RESTRAIN THREATS.

SECT. 32 of the Patents Act, 1883, provides, "*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.*"

Prior to the Act of 1883, the proprietor of a patent might issue threats of proceedings for infringement broadcast without rendering himself liable to account for any of the damage which he might occasion thereby, provided such threats were made *bonâ fide* (*a*), in such a case the only remedy open to an injured person was to apply for an injunction to restrain the patentee from continuing to threaten him, and in this he could only be successful after showing that the statements made were in fact untrue (*b*).

In the case of malicious threats an action for damages lay similar to that of slander of title, when the plaintiff would have to show that the threat made amounted to a "malicious attempt

(*a*) *Halsey* v. *Brotherhood*, L. R., 15 Ch. D. 514, 517; *Wren* v. *Weild*, L. R., 4 Q. B. 730.

(*b*) *Halsey* v. *Brotherhood*, L. R., 15 Ch. D. 520.

to injure the plaintiffs by asserting a claim of right against his own knowledge that it was without any foundation (*c*)."

The object of sect. 32 was to remedy the hardship we have described, namely that of a man whose business is paralysed by the threats of the proprietor of a patent, without any opportunity being afforded him of putting the question to the test, the section is addressed to the case "of a patentee who causes damage by disseminating threats which he dare not or will not justify by an action, who is willing to wound but yet afraid to strike (*d*)."

It is immaterial that the threat was made *bonâ fide*, the question to be considered is what the defendant said or did, and not what he intended, and if damage is occasioned by the circulation of a threat, it is no reply to an action to say that damage was not intended if the threatener does not bring himself within the shelter of the proviso at the end of the section (*e*).

"By circulars, advertisements, or otherwise:"—These words have been held to include any document whatever, which either actually or merely by implication contains a threat of legal proceedings (*f*), whether written by the defendant himself (*g*) or his solicitors (*h*), or in answer to an inquiry made by the plaintiffs (*i*); and the addition of the words "without prejudice" to the document containing the threat will not absolve the person threatening from liability (*k*); it would seem that the word "otherwise" includes verbal threats (*l*).

The publication of a **general warning** to the whole world such as, "I have a patent for such and such a machine, proceedings

(*c*) Per Blackburn, J., in *Wren* v. *Weild*, L. R., 4 Q. B., at p. 737; *Halsey* v. *Brotherhood*, L. R., 15 Ch. D. 519.

(*d*) Per North, J., in *Day* v. *Foster*, 7 P. O. R. 60; see also *Challender* v. *Royle*, L. R., 36 Ch. D. 439, 440; *Skinner* v. *Perry*, 10 P. O. R. 5, 6.

(*e*) *Day* v. *Foster*, 7 P. O. R. 58; *Skinner* v. *Perry*, 10 P. O. R. 8.

(*f*) *Skinner* v. *Perry*, 10 P. O. R. 1; also *Crampton* v. *Patents Investment Co.*, 5 P. O. R. 393.

(*g*) *Walker* v. *Clarke*, 4 P. O. R. 111; *Kensington, &c., Electric Lighting Co.* v. *Lane-Fox Co.*, 8 P. O. R. 277.

(*h*) *Driffield* v. *Waterlow, &c. Co.*, 3 P. O. R. 46; L. R., 31 Ch. D. 638; *Combined, &c. Co.* v. *Automatic, &c. Co.*, 6 P. O. R. 502; *Day* v. *Foster*, 7 P. O. R. 54, 59; *Johnson* v. *Edge*, 9 P. O. R. 142.

(*i*) *Skinner* v. *Perry*, 10 P. O. R. 1, 7; also *Challender* v. *Royle*, L. R., 36 Ch. D. 425.

(*k*) *Kurtz* v. *Spence*, 5 P. O. R. 161, 173.

(*l*) *Ungar* v. *Sugg*, 6 P. O. R. 337.

will be taken against any person who infringes it"—will not be actionable (*m*), but should such warning amount by implication to a suggestion that the manufactures of a certain person are infringements of the patent referred to, and be circulated in the trade to the detriment of such manufacturer, an action will lie under the 32nd section.

In *Challender* v. *Royle*, Bowen, L.J., said:—"Suppose that a manufacturer is making and issuing machines which the patentee considers to be infringements of his patent, and the patentee issued a threat really directed against the manufacture and sale of those machines, I do not think he could escape from the section by wording his notice in such terms that according to the letter it was only a general warning to all persons not to infringe his patent (*n*)."

In the same case the same Lord Justice in his judgment suggested that the language of sect. 32 would not apply to **threats relating to future infringements.** Commenting upon that portion of the Lord Justice's judgment in *Johnson* v. *Edge*, Lindley, L.J., said: "I should like to qualify that a little by saying that I think upon the true construction of this section, the section might apply to an intended infringement, provided that you could make out that the intended infringement, if carried out, would be an actual infringement (*o*)," and Kay, L.J., in the same case said: "I can easily conceive one case of future infringement which would come entirely within the mischief which this section was intended to provide against. For instance, take this case; 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, when made, will be an infringement of my patent.' Can it be said that a case like that would not come within the mischief intended to be provided against by this section (*p*)?"

(*m*) *Johnson* v. *Edge*, 9 P. O. R. 149; also *Challender* v. *Royle*, L. R., 36 Ch. D. 441; *Ungar* v. *Sugg*, 8 P. O. R. 388.

(*n*) L. R., 36 Ch. D. 441; see also *Johnson* v. *Edge*, 9 P. O. R. 142, 148, 149; *The Fusee Vesta Co.* v. *Bryant & May*, 4 P. O. R. 191.

(*o*) 9 P. O. R., at p. 148.

(*p*) Ib., at p. 149; see also *Kurtz* v. *Spence*, 5 P. O. R., at p. 171.

"**Any person or persons aggrieved:**"—The right of action under the section is not limited merely to the person threatened, but any person to whom damage is occasioned by the issue of the threats is entitled to relief; so where circulars were issued to the trade intimating that the articles manufactured and sold by the plaintiff were infringements of the defendants' patent and that proceedings would be taken against any person dealing with such articles, and in consequence injury was done to the plaintiff's business, it was held that the plaintiff was a person aggrieved and could maintain an action although no threats were made to him personally (*q*).

"**If the alleged manufacture, &c.:**"—In an action brought under this section the validity of the patent may be put in issue. In *Challender* v. *Royle*, Cotton, L.J., said: "In my opinion . . . . the question whether the patent of the person making the threats is a valid patent must come into consideration if the plaintiff in the action seeks it, because I cannot see how, if a patent is invalid, there can be any act done in infringement of a legal right when the legal right depends only on the validity of that patent (*r*)."

To constitute a defence to an action under this section, not only must it be shown that the act complained of was an infringement of the patent in question, but also that it was an infringement of the legal rights of the defendant, that is to say, the defendant must be the legal owner of the patent and not merely possessed of a beneficial interest; so in *The Kensington, &c., Electric Light Co.* v. *Lane-Fox Co.* (*s*), where it appeared that an agreement had been entered into whereby the patentee had agreed to assign the patent alleged to have been infringed to the defendant company, but no assignment had in fact been executed, it was held that the defendants having only a beneficial interest in the patent, had no legal right in it capable of being infringed, and consequently the plaintiffs were entitled to judgment without

(*q*) *Kensington, &c. Electric Lighting Co.* v. *Lane-Fox Co.*, 8 P. O. R. 277, 279; see also *Walker* v. *Clarke*, 4 P. O. R. 111, 114; *Burt* v. *Morgan*, 4 P. O. R. 279, 280; *Johnson* v. *Edge*, 9 P. O. R. 142, 145.

(*r*) 4 P. O. R., at p. 371; L. R., 36 Ch. D., at p. 435; see also *Kurtz* v. *Spence*, 4 P. O. R. 427, 430; *Herrburger* v. *Squire*, 5 P. O. R. 581, 589.

(*s*) 8 P. O. R. 277.

entering into the consideration of the validity or invalidity of the patent.

The clause of section 32 now under consideration is a condition precedent to the right of the plaintiff to recover damages in respect of the threats complained of (*t*), consequently, *prima facie*, the burden of proof is on the shoulders of the plaintiff that what he has done is not an infringement of the defendant's patent. As to how far he must establish this will depend upon the facts of each particular case (*u*).

"**Provided that this section shall not apply, &c.:**"—In this proviso lies the most important part of the section, and many points arise in its consideration of considerable difficulty. It is proposed to deal with it first in detail, after which the effect of the proviso as a whole will be more easily understood. To take the last portion first, it is necessary that the person making such threats should commence and prosecute an action for infringement of his patent; it is not clearly provided against whom the action is to be brought, nor whether an action for a different form of an infringement from that complained of would be sufficient, and in the decided cases alone can an interpretation be found. As has been pointed out above, the beneficial owner of a patent cannot shelter himself under the saving clause; for similar reasons an action brought by the legal owner for infringement of his patent will not be such an action as to entitle the beneficial owner to the benefit of the proviso in an action in restraint of threats brought against him by alleged infringers (*x*). The action must be in respect of infringements which were alleged in the threats circulated by the patentee (*y*), and must be brought against some one of the persons threatened (*z*).

In *Day* v. *Foster* (*a*) the plaintiff, after threatening the defendant, who was a licensee under the plaintiff's patent, and also *Messrs. Barrett & Elers*, brought an action against the

(*t*) *Barney* v. *United Telephone Co.*, 2 P. O. R. 174.

(*u*) *Challender* v. *Royle*, 4 P. O. R., at p. 371.

(*x*) *Kensington, &c. Electric Light Co.* v. *Lane-Fox Co.*, 8 P. O. R. 277.

(*y*) *Combined Weighing, &c. Co.* v. *Automatic, &c. Co.*, L. R., 42 Ch. D., at p. 670.

(*z*) *Challender* v. *Royle*, 4 P. O. R., at p. 373; L. R., 36 Ch. D. at p. 439.

(*a*) 7 P. O. R. 54.

defendant for infringement and royalties; he being a licensee, was unable to dispute the validity of the patent, and, consequently, *Messrs. Barrett & Elers* were anxious to be joined as co-defendants to the action. This being refused by the plaintiff, they instituted proceedings under section 32. North, J., held that the action of *Day* v. *Foster* was an action for infringement within the meaning of the proviso, and in accordance with the interpretation laid down by Cotton, L.J., in *Challender* v. *Royle* (*supra*): "That in order to bring the case within the proviso the action must be an honest action, honestly brought in order to test the validity of the patent, or the fact of infringement, whichever may be in question;" and in consequence held that the action was vexatious, and directed that all further proceedings in it should be stayed.

As is pointed out in the judgment of Cotton, L.J., quoted above, the action must be brought bonâ fide (*b*), and the onus of proof rests on the other party to show that the action was not in fact an honest one (*c*).

"**With due diligence commences and prosecutes.**"—In considering whether such an action is brought with due diligence, the time of issuing the threats, and not the time when the party bringing the action first knew of the acts which he alleges to be infringements, is the period to be looked at (*d*), and it is immaterial whether the action is brought before or after the commencement of the threats action (*e*).

Where threats of proceedings were made by the patentee to another for the space of three years, after which continuous negotiations took place between the parties and further complaints made, it was held that an action for infringement brought on the termination of those negotiations by the patentee disclosed no lack of due diligence (*f*).

The section does not require that the action should be prose-

(*b*) *Challender* v. *Royle*, L. R., 36 Ch. D. 438, 439; 4 P. O. R. 373, 375; *Day* v. *Foster*, 7 P. O. R. 60; *Colley* v. *Hart*, 7 P. O. R. 112.

(*c*) *Colley* v. *Hart*, 7 P. O. R. 112.

(*d*) *Challender* v. *Royle*, L. R., 36 Ch. D. 425, 437; *Day* v. *Foster*, 7 P. O. R. 60.

(*e*) *Combined Weighing-Machine Co.* v. *Automatic, &c. Co.*, 6 P. O. R. 502; *Challender* v. *Royle*, supra.

(*f*) *Edlin* v. *Pneumatic Tyre, &c. Agency*, 10 P. O. R. 311.

cuted to a successful termination, the bonâ fide institution of proceedings for infringement being held to be sufficient.

In *Colley* v. *Hart* (*g*) the facts were as follows: On the 15th September, 1888, the defendant issued a circular, threatening proceedings against the plaintiff, amongst others. On the 22nd of the same month the plaintiff commenced an action to restrain the threats of the defendant; on the 6th December the defendant commenced an action for infringement against the plaintiff, and delivered particulars of infringement in February in the following year, and on the 13th May delivered his statement of claim. On the 7th of November, after the close of the pleadings, but before trial, the defendant abandoned his action for infringement. It was held that this action had been prosecuted with due diligence within the meaning of the proviso in section 32. In his judgment, North, J., said: "Under those circumstances, of course, he is exactly in the same position by discontinuing a hopeless action before trial as he would have been in if he had prosecuted it to trial, and had then failed. As failure at the trial would not have prevented the action being one within the proviso, so, in my opinion, the discontinuance before trial does not put him in a worse position than if he had carried it to trial" (*h*).

In *The English and American Machinery Co.* v. *The Gare Machine Co.* (*i*) the facts were very similar to those in *Colley* v. *Hart* (*supra*), but in this case the defendants abandoned their infringement action before delivering their reply. It was held by Chitty, J., approving of the decision of North, J., in the earlier case, and upon the same grounds, that due diligence had been exercised in the prosecution of the action for infringement.

It is difficult to say how far the above reasoning might be carried, whether the mere serving of a writ would be held to amount to prosecuting with due diligence, or is it necessary to deliver a statement of claim? No doubt the circumstances of the case must be the guide. As has been pointed out above, bona fides is required, and if that is shown to be absent, no action would be sufficient; but if, on the other hand, the Court considers that the person making the threats did commence his action

(*g*) 7 P. O. R. 101.
(*h*) At p 111.
(*i*) 11 P. O. R. 627.

bonâ fide, and with due diligence, a very slight amount of prosecution, probably, would take the case out of the operation of the section (*k*).

But where the defendant showed great delay in taking proceedings for infringement, in accordance with his threats, and, further, it appeared that he only took such proceedings in order to escape from the liability to which he had exposed himself by reason of those threats, it was held that such proceedings were not sufficient to satisfy the proviso (*l*).

If an action to restrain threats has been commenced and stayed pending an action for infringement, and the action for infringement is not prosecuted with due diligence, an injunction will be granted upon the first action, and the stay removed (*m*).

In *The Fusee Vesta Co.* v. *Bryant & May* (*n*) the action, which was one for infringement of the plaintiff's patent, was stayed, pending the amendment by the plaintiffs of their specification; during the stay, and prior to amendment, the plaintiffs circulated post-cards among the customers of the defendants, threatening legal proceedings. On a motion by the defendants for an injunction to restrain such threats, Kay, J., granted the injunction applied for to extend to the trial of the action, or further order, the plaintiffs to pay the costs of the motion.

The effect of commencing and prosecuting an action for infringement with due diligence is to nullify the whole of the section, that is to say, its provisions cease to apply, and the rights of the person threatened are confined to those which existed prior to the Act of 1883 (*o*). What those rights were has already been indicated at the commencement of the present chapter; there it was pointed out that damages could only be recovered when the threats were malicious, but since the action to satisfy the proviso must be a bonâ fide one, and, in fact, it has been suggested that that action was required as a sort of test

(*k*) But see *Crampton* v. *Patents Investment Co.*, 5 P. O. R. 382, 393.

(*l*) *Johnson* v. *Edge*, 9 P. O. R. 142, 146; see also *Herrburger* v. *Squire*, 5 P. O. R. 581, 594.

(*m*) *Household* v. *Fairburn*, 2 P. O. R. 140, 142.

(*n*) 4 P. O. R. 191.

(*o*) *Combined Weighing, &c. Co.* v. *Automatic, &c. Co.*, L. R., 42 Ch. D. 665; *Colley* v. *Hart*, 7 P. O. R. 101; *Day* v. *Foster*, 7 P. O. R. 60.

whether the threats were bonâ fide or not (*p*), it would be practically impossible to recover damages upon the plea that the threats were in fact malicious. The result is that in such a case the only course open to persons threatened, where the action for infringement has been dropped, as in *Colley* v. *Hart* (*supra*), and the question of infringement never tested in the Court, is to apply for an injunction to restrain the further issue of threats, but it is doubtful whether such an injunction would be granted under the circumstances, since, it being presumed that the threats were bonâ fide, the abandonment of the proceedings for infringement would imply, of necessity, that those threats would not be continued, and it has already been pointed out (*q*) that injunctions are only granted where there is a probability of the continuance of the acts complained of. Moreover, in the event of the renewal of the threats, the right of action under section 32 would be at once revived.

Where an action for infringement has been commenced after the institution of proceedings under section 32, the proper course for the parties in the latter action to pursue was indicated by Kekewich, J. (*r*). The patentee should take steps to get rid of the threats action, or to put a stay upon it, so that no unnecessary cost should be incurred, and in that case, where it appeared that the patentees had insisted upon having the threats action set down for trial and disposed of, the learned Judge, at the close of his judgment, said: "If I could with propriety make them (the patentees) pay the costs, I should be disposed to do so. I cannot do that. I dismiss the action, but I certainly shall dismiss it without costs."

The effect of section 32, taken as a whole, is not to deprive a patentee of the power, or it may be termed the duty (*s*), of warning infringers before rushing into litigation, but it does limit that power to one class of patentees, that is to say, only a man who is in possession of a patent which he is willing and

(*p*) *Challender* v. *Royle*, L. R., 36 Ch. D., at p. 439.

(*q*) Chap. XVIII.; see also *Sugg* v. *Bray*, 2 P. O. R., at p. 246.

(*r*) *Combined Weighing, &c. Co.* v. *Automatic, &c., Co.*, L. R., 42 Ch. D. 665.

(*s*) Per Jessel, M.R., in *Halsey* v. *Brotherhood*, L. R., 15 Ch. D., at p. 517.

intends to support in a Court of Law may threaten others with legal proceedings in respect of it. A. may be infringing through ignorance, B. through design, but both possibly would desist on receipt of a warning. But when an alleged infringer shows that, in spite of the warnings, he has no intention of desisting from the acts complained of, the patentee must put his threat into execution, by which means alone can he escape liability under the provisions of this section.

In *Challender* v. *Royle* (*t*), upon the subject of an **interlocutory injunction** to restrain threats, Cotton, L.J., said: "I think, however, that before going to the proviso I ought, having regard to the judgment of the Vice-Chancellor, to state my opinion as to how the matter ought to be dealt with in an interlocutory application. As far as I understand the Vice-Chancellor, he seems to have considered that he could not enter, or that he need not enter, at this stage of the cause into the question whether the sale of the plaintiffs' tap-unions was an infringement of the defendant's patent, or whether that patent was a valid patent, and that all he need consider was the balance of convenience and inconvenience as between these parties in granting or refusing the interlocutory injunction. I must express my dissent from that view. It is very true that in all cases of interlocutory injunction the Court does consider and ought to consider the balance of convenience and inconvenience in granting or refusing the injunction. But there is another and very material question to be considered—has the plaintiff made out a *primâ facie* case? That is to say, if the evidence remains as it is, is it probable that at the hearing of the action he will get a decree in his favour? Therefore, though I quite agree that the Court ought not on an interlocutory injunction to attempt finally to decide the question whether the act complained of is an infringement, or (if the question of the validity of the patent is raised) whether the patent is a valid one or not, yet in my opinion it ought to be satisfied that on one or both of these two points the plaintiff in the action has made out a *primâ facie* case, and unless the Court is so satisfied it would be wrong to grant an

(*t*) L. R., 36 Ch. D., at p. 435; see also *Walker* v. *Clarke*, 4 P. O. R. 111.

injunction merely on the ground that it cannot do the defendant any harm."

Where there was a conflict of testimony as to the fact of infringement, the Court refused to grant an interlocutory injunction (*u*).

In *Colley* v. *Hart* (*x*), which was a motion for an interlocutory injunction to restrain threats, North, J., said: "When there is a doubt whether the thing does infringe what he calls his rights or not, the fact that the defendant refrains from bringing an action to assert his rights is a fact I cannot leave out of consideration in forming an opinion as to whether he has such rights or not."

The question of damages generally has already been discussed in an earlier chapter.

The defendant in an action under this section is entitled to particulars of the threats upon which the plaintiff relies (*y*), and if the validity of the patent is put in question the general rules relating to particulars of objections will apply (*z*). Those rules will be considered in detail hereafter.

Where there was a doubt upon which patents the defendants had based their threats, the Court ordered that the defendants should deliver to the plaintiffs a list of such patents (*a*).

And where the plaintiffs alleged that the threats were made by the defendants' agents, it was held that the defendants were entitled to particulars of the names of those agents (*b*).

(*u*) *Barney* v. *United Telephone Co.*, 2 P. O. R. 173.

(*x*) 6 P. O. R., at p. 21.

(*y*) *Law* v. *Ashworth*, 7 P. O. R. 86.

(*z*) *Union Electrical Power Co.* v. *Electrical Power Storage Co.*, 5 P. O. R. 329; *Law* v. *Ashworth*, 7 P. O. R. 86.

(*a*) *Union Electrical Power Co.* v. *Electrical Storage Co.*, 5 P. O. R. 329.

(*b*) *Taylor* v. *The Drosophore Co.*, 11 P. O. R. 536.

CHAPTER XXI.

PRACTICE IN AN ACTION FOR INFRINGEMENT.

An action for infringement is commenced by writ issued out of the High Court of Justice.

Subject to the special provisions of the Patents, &c., Acts, the rules of the Supreme Court apply to actions for infringement of patents and petitions for revocation (*a*).

The writ may be endorsed merely for damages for infringement, *or* for an account of sales and profits, *and* it may be endorsed for an injunction claiming that the defendant may be restrained from continuing to infringe the patent, and for a mandatory order that the defendant may be ordered to deliver up to the plaintiff the articles made in infringement of the patent which are in his custody or power, or in the custody or power of his servants or agents, so that they may be broken up or destroyed (*c*). The plaintiff may not claim both an account of sales and profits and damages for infringement; the two claims being inconsistent, since, if an account is taken, the infringement is condoned (*d*).

Service of a writ in Scotland for an infringement in England will be allowed (*e*).

STATEMENT OF CLAIM.

The Rules of Court of 1883 have rendered the form of pleadings of less importance than hitherto. Ord. XIX. rule 26,

(*a*) *Haddan's Patent*, 54 L. J., Ch. 126; Griffin, P. C. 108.

(*c*) Form, p. 470. See *Tangye* v. *Stott*, 14 W. R. 386; *Betts* v. *De Vitre*, 34 L. J., Ch. 289.

(*d*) Per Lord Westbury in *Neilson* v. *Betts*, L. R., 5 H. L. 1. See also *De Vitre* v. *Betts*, L. R., 6 H. L. 321; *Needham* v. *Oxley*, 11 W. R. 852 But see *Hills* v. *Evans*, 4 De G. F. & J. 288.

(*e*) *Speckhart* v. *Campbell, Achnach & Co.*, Solicitors' Journal, Feb. 2, 1884.

provides: "No technical objection shall be raised to any pleading on the ground of any alleged want of form;" but by rule 27 the power of the Court to strike out pleadings on the grounds that they are unnecessary, scandalous, or embarrassing, is preserved.

Ord. XIX. rule 4, requires all material facts to be pleaded, and prohibits the pleading of evidence. Rule 5 is as follows:—"The forms in Appendices (C., D., and E.), when applicable, and where they are not applicable forms of the like character, as near as may be, shall be used for all pleadings, and where such forms are applicable and sufficient, any longer forms shall be deemed prolix, and the costs occasioned by such prolixity shall be disallowed to or borne by the party so using the same, as the case may be."

The forms mentioned relate to pleadings in an action for the infringement of a patent, but there is no provision made for the case where infringement has only been threatened, nor for the case when a mandatory order or an account of sales and profits is required (*f*).

It will be observed that the statement of claim in patent cases, which is rendered obligatory by Ord. XIX. rule 5, contains no allegation as to the matters going to constitute the validity of the patent, nor does it give the date, time or place of the infringement; but it refers to the particulars of breaches which are delivered "herewith."

PARTICULARS OF BREACHES.

Particulars of breaches were required to be delivered in every action for the infringement of a patent by sect. 41 of the Patent Law Amendment Act, 1852; and now by sect. 29 (1) of the Act of 1883, it is provided:—"*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; (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*

(*f*) See Form, p. 476, et seq.

delivered; (5) *particulars delivered may be from time to time amended by leave of the Court or a judge.*"

Particulars of breaches are particulars of the times, places, occasions, and manner in which the plaintiff says the defendant has infringed his letters patent. The defendant must have full, fair, and distinct notice of the case to be made against him (*g*). In *Batley* v. *Kynock* (*h*), Sir James Bacon, V.-C., said: "All that is required and provided by the Patent Law Amendment Act, 1852, which has made no alteration in the practice to be observed in these cases, is that the defendants shall not be taken by surprise, and it is the duty of the judge to take care that by the particulars of breaches they shall have full and fair notice of the case that they will have to meet."

It had undoubtedly prior to the passing of the Patent Law Amendment Act, 1852, been the practice of the Courts to compel plaintiffs to give particulars of breaches, and the cases which were then decided as to the sufficiency of particulars are applicable now; for then, as now, the object was that the defendant should be warned with reasonable certainty of the case that was to be made against him.

The plaintiff cannot be required to place a construction upon his patent in his particulars of breaches (*i*).

The requirements of particulars of objections differ materially from those of particulars of breaches. In the case of objections taken by the defendant to the plaintiff's patent, it is essential that each objection should be set out in detail and that the defendant should be tied down to the particular instances of anticipation which he discloses in those particulars, since the objections to be taken by the defendant at the trial cannot otherwise lie within the plaintiff's knowledge, whereas in the case of particulars of breaches, to use the words of Bristowe, V.-C. (*k*): "You must always bear this in mind, that the plaintiff,

(*g*) *Needham* v. *Oxley*, 1 H. & M. 248; *Mandleberg* v. *Morley*, 10 P. O. R. 256.

(*h*) L. R., 19 Eq. at p. 231.

(*i*) *Wenham Co.* v. *Champion Gas Co.*, 8 P. O. R. 22.

(*k*) *Cheetham* v. *Oldham*, 5 P. O. R. at p. 626; see also *Talbot* v. *La Roche*, 15 C. B., at p. 321; *Ledyard* v. *Bull*, L. R., 11 App. Cas. 648; *Haslam* v. *Hall*, 4 P. O. R. 206.

asserting his patent, knows what he claims, and he says, I tell the public according to that which I am bound to do by the specification that which I do claim;' and the defendant well knows, or the defendants, as in this case, perfectly well know what they are doing." Consequently to fulfil the object for which such particulars are required, it is only necessary for the plaintiff to indicate what patent or portions of what patent he relies upon, and in what way he considers the defendant to have infringed, and if these two points be made clear without adducing specific instances, that will be sufficient (*l*).

When the patent consists of two or more processes, or distinct and separable inventions, particulars of breaches should distinguish which of the processes it is alleged has been infringed (*m*), and should particularly indicate what parts of the defendant's machine or manufactured article are claimed to constitute an infringement (*n*); but when the process was one entire invention, the Court declined to compel the plaintiff to point out the particular parts of the specification which were alleged to be infringed. Jervis, C.J., said: "If the two processes described in the specification are wholly distinct from each other, and the defendant's process may 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 (*o*)."

As a general rule it is not necessary to state the lines in the letterpress of the specification upon which the plaintiff relies, an indication of the claims being all that is required. In *Church* v. *Wilson*, Grove, J., said (*p*): "It seems to me that the plaintiffs

(*l*) *Talbot* v. *La Roche*, 15 C. B. 310; *Needham* v. *Oxley*, 1 H. & M. 248; *Ledgard* v. *Bull*, L. R., 11 App. Cas. 648; *Egleton* v. *Nichols*, 7 P. O. R. 423.

(*m*) *Church* v. *Wilson*, 3 P. O. R. 123; *Haslam* v. *Hall*, 4 P. O. R. 203; *Cheetham* v. *Oldham*, 5 P. O. R., at p. 628.

(*n*) *Lamb* v. *Nottingham Manufacturers' Co.*, Seton, 4th Ed. 349.

(*o*) *Talbot* v. *La Roche*, 15 C. B. 310; see also *The Electric Telegraph Co.* v. *Nott*, 4 C. B. 462; *Tilghman's, &c.* v. *Wright*, Griff., P. C. 216; 1 P. O. R. 103; *Egleton* v. *Nichols*, 7 P. O. R. 423.

(*p*) 3 P. O. R., at p. 127; see also *Cheetham* v. *Oldham*, 5 P. O. R., at p. 627.

have given more information indeed than is necessary; and merely to evolve the information in some other form of words, or to mark the parts of the specification of which they complain, when there are claims, seems to me quite unnecessary. What it might be where the machines are not given or where the specification has no specific claims, but only a description of the invention and a general claim of novelty, is a very different thing (*q*)."

Where the plaintiff's patent is of a simple nature, such for instance as the manufacture of a particular form of cartridge, and the articles made by the defendants must be infringements in every respect or not at all, it has been held sufficient to give one or two specific instances to denote the type of infringement complained of coupled with general words, so as not to confine the plaintiff to those particular instances at the trial of the action (*r*); but general words will not be allowed should they tend to embarrass the defendant (*s*).

Further particulars of breaches will sometimes be postponed to discovery on the ground that the defendant knows the breaches which he has committed better than the plaintiff (*t*).

In *Elsey* v. *Butler* (*u*), an action for infringement of a patent for "improvements in the manufacture of lace, in twist lace machinery, and in apparatus employed therein," the following particulars of breaches were held by Pearson, J., to be sufficient:—"The defendant has infringed by the production in a twist lace machine, or in twist lace machines, of lace fabrics in the manner described in the specification of the said patent, page 3, line 22 to page 9, line 39, or in a manner only colourably differing therefrom; and by the use of the improved combination of apparatus therein described, and also in particular by the production in a twist lace machine, or in twist lace machines, of fabric known as 'Double tie Swiss Net' in the manner described in the specification of the said patent, page 6, line 57 to page 7,

(*q*) Note *Lamb* v. *Nottingham Manufacturers' Co.*, Seton, 4th Ed. 349.

(*r*) *Talbot* v. *La Roche*, 15 C. B. 310; *Batley* v. *Kynock*, L. R., 19 Eq. 229; *Tilghman* v. *Wright*, 1 P. O. R. 103.

(*s*) *The Patent Type Foundry Co.* v. *Richard*, 2 L. T., N. S. 359; *Church* v. *Wilson*, 3 P. O. R. 123.

(*t*) *Russell* v. *Halfield*, Griff. P. C. 204; 2 P. O. R. 144.

(*u*) Griff. P. C. 96.

line 38, or in a manner only colourably differing therefrom, and by the use of the improved combination of apparatus therein described."

Where an action is brought against the vendor of articles alleged to have been made by a process which infringed the plaintiffs' patent, a greater degree of precision is required in the particulars of breaches than if the defendant was the manufacturer himself.

In *Mandleberg* v. *Morley* (*x*), Stirling, J., said (*y*): "Now if a manufacturer is attacked for infringing a patent by a particular process he does not want to be told in the shape of particulars, or otherwise, what the process is he is using. He knows what the process he is using is. But it is a very different thing with respect to a vendor. The vendor does not know with certainty what process is being used by the person from whom he himself buys, and who manufactures the article."

In that case the particulars of breaches alleged that: "The plaintiffs complain that each of the said letters patent of the plaintiffs have been infringed by the sale and exposure for sale by the defendants of each of the said garments, known as 'The Champion,' and 'The Distingué,' and by the sale and exposure for sale of other waterproof garments made by the manufacturers of 'The Champion,' 'The Distingué,' and 'The Tropical Odourless,' but not bearing their distinguishing names, but which unnamed garments are manufactured by similar processes to the three named garments." It was held that the reference to unnamed garments was not sufficiently specific, as it was not clear that the unnamed garments referred to were substantially the same as those which were specifically mentioned.

If the particulars delivered are too general, the defendant should apply **for further and better particulars.**

If at the trial evidence is tendered which comes within the literal meaning of the particulars it will be admitted, notwithstanding that the particulars are too general, as **the defendant should have objected to the particulars,** and not have waited until the trial to take his objection (*z*).

(*x*) 10 P. O. R. 256.
(*y*) At p. 260.
(*z*) *Hull* v. *Bollard*, 25 L. J., Ex. 304.

The plaintiff having delivered particulars of breaches specifying certain sales by the defendant of rollers, and in particular to Shaw and Smith, the defendant, in answer to interrogatories, admitted sales to Hirst. Fry, J., in giving judgment, said: "In this case I think I must admit the evidence tendered in respect of Hirst's case. It is said that in respect of those cases which are not mentioned by name in the particulars of breaches, the plaintiff cannot give evidence. It may be that the particulars were not sufficient, or tended to embarrass. But the defendant did not apply for amended particulars, according to the case of *Hull* v. *Bollard*. It appears to me I have to inquire what is the meaning of the particulars. I find the case of Hirst is within the literal meaning of the particulars. If I had found that the case of Hirst was likely to create surprise, or likely to introduce any point not raised by *Smith's* or *Shaw's* case, I should probably have given an opportunity to the defendant to bring fresh evidence. I have asked whether there is any witness not here whom the defendants would desire to bring in respect of Hirst's case, and have received no satisfactory answer on that point, and must assume there is no such witness" (*a*).

Conversely where the particulars of breaches complained only of infringement by user, the Court refused to enter into the question as to whether there had been infringement by manufacturing the articles complained of (*b*).

Particulars of breaches, as we have seen, may also be ordered in actions which are not strictly actions for the infringement of patents; this is done under the ordinary jurisdiction of the Court (*c*). In an action charging that the defendant falsely and maliciously wrote and told persons who had bought certain machines of the plaintiffs that the machines were infringements of his, the defendant's patents, the defendant having pleaded not guilty, the court ordered the defendant to deliver particulars, showing in what part the plaintiffs' machines were an infringement of the defendant's patents, and pointing out by reference to the page and line of the defendant's specifications, which part

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

(*b*) *Henser* v. *Hardie*, 11 P. O. R. 421, 427.

(*c*) *Perry* v. *Mitchell*, 1 Web. P. C. 269.

of the inventions therein described he alleged to have been infringed (*d*).

STATEMENT OF DEFENCE.

The statement of defence in patent actions is now, under the rules of the Supreme Court, 1883, a very brief and concise document, giving no particulars or details whatever, and remitting the plaintiff to the particulars of objections and the answers to the interrogatories for information as to the case which is to be made against him. Under Order XIX. rule 5, the form given in Appendix (D.), sect. VI., is rendered obligatory. That form merely gives headings of defence which is all that is to be allowed; for instance:—"(1) That the defendant did not infringe the patent; (2) The invention was not new; (3) The plaintiff was not the first and true inventor; (4) The invention was not useful; (5) The patent was not assigned to the plaintiff." And to these might be added:—That the title did not disclose the nature of the invention (*e*); that the title, the provisional specification, and the complete specification, or any two of them, did not substantially refer to the same invention (*f*); that the specification was not sufficient (*g*); that the claim in the specification was not sufficient to distinguish what was new from what was old (*h*); that the patent was obtained in fraud of the defendant, as, for instance, when a person employed to carry out or assist in experiments, applies for letters patent himself, or where the patentee has obtained the invention from the confidence of the defendant.

It will be observed that any one of these defences will be sufficient to constitute a complete defence to an action; and that the greater portion of them are of a nature to require elaborate and costly evidence to prove or disprove them. Too much care cannot, therefore, be taken in preparing a statement of defence to avoid setting up defences which it is not expected will be satisfactorily proved at the trial, regard being had to the provisions of the rules of 1883 as to costs; otherwise, even if the

(*d*) *Wren* v. *Weild*, L. R., 4 Q. B. 213.

(*e*) *Ante*, p. 78, *et seq.*

(*f*) *Ante*, p. 84, *et seq.*

(*g*) *Ante*, p. 106, *et seq.*

(*h*) *Ante*, p. 116, *et seq*

defendant succeeds in the action, he may be muleted in heavy costs to the other side.

The defence that the plaintiff was not the first and true inventor should not be set up unless it is intended to prove that somebody else was the inventor, as the issue that the invention was not new, and in consequence that it was not invented by the plaintiff, should be raised under the other headings of defence (*i*).

A statement of defence alleged that if the specification were construed so as to make the defendant an infringer, the claims of invention would be bad for want of novelty, as including matters described in certain specifications (stating them). North, J., refused to strike out par. 2 under Order XIX. rule 27; the Court of appeal dismissed the appeal with costs (*k*).

A statement of defence admitted infringement in ten instances and no more, the plaintiffs elected to move for judgment upon such admissions; held that they were entitled to an enquiry as to damages as to these ten instances of infringement and no more, and that all evidence as to any other instances of infringement alleged to have been committed by the defendant must be excluded (*l*).

Where the defendants in an action for infringement have been indemnified by another person or company, such other person or company may be joined as a third party under Order XVI. rule 48, of the rules of the Supreme Court (*m*).

PARTICULARS OF OBJECTIONS.

Section 29, sub-sect. (2) of the Act of 1883, provides:—"*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*

(*i*) *Morgan* v. *Windover*, 7 P. O. R. 449; *Thomson* v. *Macdonald*, 8 P. O. R. 9.

(*k*) *Hocking* v. *Hocking*, Griff. P. C. 129; 3 P. O. R. 291.

(*l*) *United Telephone Co.* v. *Donohoe*, L. R., 31 Ch. D. 399.

(*m*) *Edison* v. *Holland*, L. R., 33 Ch. D. 497.

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."

Order XIX. rule 6, of the Rules of the Supreme Court, 1883, provides: "In all cases in which the party pleading relies on any misrepresentation, fraud, breach of trust, wilful default, or undue influence, and in all other cases in which particulars may be necessary beyond such as are exemplified in the forms aforesaid, particulars (with dates and items if necessary) shall be stated in the pleading: provided that if the particulars be of debt, expenses, or damages, and exceed three folios, the fact must be so stated, and a reference to full particulars already delivered or to be delivered with the pleading."

It is not easy to reconcile the practice under this rule with the language of the 29th sect. of the Patent Act, or, indeed, with the form of defence given in the form to the rules quoted above. Order XIX. rule 6, provides that particulars shall be incorporated with the pleading; on the other hand, the form and the Patent Act seem to indicate a separate document. Hitherto the practice has been to deliver a separate document, and it is apprehended that when the balance of convenience is considered the Courts will hold that in respect of a patent action the practice has remained unchanged.

Where it was a condition precedent to an agreement to assign letters patent, that the assignee should first satisfy himself as to the validity of the patent, in an **action brought for specific performance of this agreement**, and resisted by the assignee on the ground of his right under the condition precedent, it was held that the validity of the patent was at issue and that the plaintiff was entitled to particulars of objections (*n*).

It is not necessary for every one of **two or more defendants** defending in the same interest to deliver particulars of objections (*o*).

(*n*) *Hazlehurst* v. *Rylands*, 9 P. O. R. 1.

(*o*) *Smith* v. *Cropper*, L. R., 10 App. Cas. 249, reversing L. R., 26 Ch. D. 700.

Any of the objections which we have discussed in previous chapters may be taken in order to upset a patent, but the particulars must set out those objections in such terms that the plaintiff may be informed what case he will have to meet at the trial of the action.

When the objection is, that the grantee was not the true inventor, the Court will not require the defendant to say who was the true inventor (*p*). The fact upon which the objection is based, is the want of consideration, not the fact of someone having performed the invention before. The performance of the invention by some one else before the patent would not, of necessity, invalidate the patent. As, for instance, if it were done in secret; but if the invention was communicated to the grantee, the patent would be void for want of consideration. Now the foundation of the objection is, the fact of that communication, and the knowledge of this, and the time and place of it, might be within the patentee's knowledge only, and might not be extracted from him until in the witness box.

The objection that the specification is insufficient is enough without explaining in what way it is insufficient (*q*). A litigant could scarcely be required to argue his case on paper before he went into Court, and the sufficiency or insufficiency of a specification is to a great extent a matter of mere argument.

In *Jones* v. *Berger* (*r*), it was held that objections that the specification "did not sufficiently distinguish between what was old and what was new," and that the inventor "did not disclose the most beneficial method with which he was then acquainted of practising his said invention," were sufficient.

In *Heathfield* v. *Greenway* (*s*), the following objections, viz.: "That the specification does not sufficiently describe and ascertain the nature of the invention, and the manner in which the same is to be performed;" and, "That the said specification is ambiguous and framed in a manner calculated to mislead;" were held to be too vague.

(*p*) *Russell* v. *Ledsam*, 11 M. & W. 647. But see *Jones* v. *Berger*, 5 M. & G. 208; 1 Web. P. C. 544; *Morgan* v. *Windover*, 7 P. O. R. 449; *Thomson* v. *Macdonald*, 8 P. O. R. 9.

(*q*) *Heath* v. *Unwin*, 10 M. & W. 687.

(*r*) 5 M. & G. 208.

(*s*) 11 P. O. R. 17.

When the objection is on the ground of **want of conformity** between the provisional and complete specification, "the defendant 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." Per Cotton, L. J. (*t*), C. A. And when the objection is the insufficiency of the specification, the defendant must condescend to particulars of insufficiency (*u*).

We have seen that Ord. XIX. rule 6, requires **particulars in case of fraud** to be delivered with the statement of defence.

Fraud is a valid objection to a patent. The practice of the Court is to require accurate and detailed particulars of any fraudulent acts alleged. The species of "fraud, covin, or misrepresentation" should be given (*x*).

The objection to a patent which is generally relied upon is want of novelty, either on the ground of prior user, prior publication, or common knowledge.

Prior user.—The objection on the ground of prior user **must state the time and place** when such user occurred; but it will be observed that **the persons by whom used** is not mentioned in sub-sect. (3). The Act, however, does not direct that such particulars shall not be required. The Patent Law Amendment Act, 1852, sect. 41, required that the place of prior user should be given, and was silent as to times or persons. Notwithstanding this, in *Palmer* v. *Cooper* (*y*), Baron Alderson went even further than to require the names of the persons who had used the invention, and the **present addresses** of such persons were ordered to be given, "As otherwise the plaintiff would not know

(*t*) *Anglo-American Brush Light Corporation* v. *Crompton*, L. R. 34 Ch. D. 152; 56 L. J., Ch. 167; 4 P. O. R. 27.

(*u*) *Crompton* v. *Anglo-American Brush Light Corporation*, L. R., 35 Ch. D. 283; 56 L. J., Ch. 802; 57 L. T. 291; 4 P. O. R. 197.

(*x*) *Russell* v. *Ledsam*, 11 M. & W. 647.

(*y*) 9 Ex. 231; see also *Bulnois* v. *Mackenzie*, 4 Bing. N. C. 132; *Galloway* v. *Bleaden*, 1 Web. P. C. 268 (n).

where to go for his evidence." The object of particulars is, in the words of Tindal, C.J. (z), "Not, indeed, to limit the defence, but to limit the expense of the parties, and more particularly to prevent the patentee from being upset by some unexpected turn of the evidence. Under the fifth section (5 & 6 Will. 4, c. 83), therefore, it was intended that the defendant should give an honest statement of the objections on which he means to rely." In *Palmer* v. *Cooper* (*supra*), Parke, B., said: "The defendant's particulars ought to give the plaintiff such information as will enable him to make the necessary inquiries at the place named."

It will be evident, therefore, that there are cases where to omit giving the names and addresses of the persons who are alleged to have anticipated the invention would be to supply the plaintiff with objections which would be practically useless.

There are cases where the names and addresses have been refused. In *Carpenter* v. *Walker* (*a*), the objections stated that the invention had been used by "the defendant and divers persons." It was refused to order the defendant either to give the names and addresses of the "divers persons," or to have those words struck out.

It may be argued that the reason of such refusal was that a disclosure was required of the witnesses and case of the defendant. It is obvious that, although it is a recognized principle that one litigant shall not be permitted to inquire as to what witnesses the other is about to call at the trial, still that by far the more important principle is that neither party should be taken by surprise, and that the plaintiff should have a fair opportunity of critically examining every alleged anticipation which may be attempted to be established against him.

It does not of necessity follow that persons who have anticipated the invention should be the only and necessary witnesses of such anticipation. On the whole, therefore, it is submitted that names and addresses of such persons should be given in particulars of objections.

General words are inadmissible in particulars; for instance,

(z) *Fisher* v. *Dewick*, 1 Web. P. C. 267.

(*a*) 1 Web. P. C. 268 (n.).

expressions such as "and divers other people" (*b*), and "Inter alia at Sheffield, Birmingham, and London" (*c*). But in *Bentley* v. *Keighley* (*d*), Mr. Justice Maule, under special circumstances, allowed the words "and others" to be sufficient.

In *Flower* v. *Lloyd* (*e*), Field, J., said: "I cannot follow the cases which have been cited; we have advanced in our ideas since they were decided (*f*). If the defendants know that their processes have been used by other persons in London and Birmingham, besides those specified, they must know the persons by whom they have been used, and must give more specific information. I do not say that they need give the name and address of every such person, but they must give fair information. If they can give no further information, the words in question are useless, and too indefinite, and must be struck out."

In *Boyd* v. *Farrar* (*g*), the allegation of prior user "by *articles* made according to the supposed invention, being publicly exhibited in use by Messrs. J. H. & S., at their works," was held too general, so in *Siemens* v. *Karo* (*h*), "by the general use of the Wenham regenerative gas lamp for several years prior to the patent," did not sufficiently particularize any variety of lamp, it is not necessary to refer to any particular article, but the defendant should specify the kind of article referred to in express terms, so that there may be no doubt what it is that he alleges to be an anticipation of the plaintiff's patent (*i*).

The time at which the alleged prior user took place should be clearly defined, a general statement that the user continued from 1832 to 1862 was held in 1890 to be too general, and it was ordered that further particulars should be given (*k*).

When the allegation of the defendant is that the patent is void by reason of a portion of the described invention being old, the

(*b*) *Fisher* v. *Dewick*, 1 Web. P. C. 551 (n.); *Galloway* v. *Bleaden*, 1 Web. P. C. 208, (n.); *Boyd* v. *Horrocks*, 3 P. O. R. 285.

(*c*) *Holland* v. *Fox*, 1 W. R. 448; 1 C. L. R. 440; *Morgan* v. *Fuller*, L. R., 2 Eq. 297; *Boyd* v. *Horrocks*, 3 P. O. R. 285.

(*d*) 7 M. & G. 652; see also *Jones* v. *Berger*, 1 Web. P. C. 549.

(*e*) Solicitors' Journal, 1876, p. 860.

(*f*) *Bentley* v. *Keighley*, 7 M. & G. 652; *Palmer* v. *Wagstaff*, 8 Ex. 840.

(*g*) 5 P. O. R. 33.

(*h*) 8 P. O. R. 376; also *Boyd* v. *Horrocks*, 3 P. O. R. 285.

(*i*) *Sidebottom* v. *Fielden*, 8 P. O. R. 266.

(*k*) *Smith* v. *Lang*, 7 P. O. R. 148.

particulars should clearly distinguish which part is alleged to be old, as well as the times and places of prior user (*l*).

Objections on the ground of **prior publication** stand very much upon the same footing as those on the ground of prior user.

If the prior publication is alleged to be in books or newspapers, the plaintiff is entitled to be told the name of the book or newspaper, and to be given such details of the books or newspapers as will enable them to be found and identified by the plaintiff (*m*).

In *Fowler* v. *Gaul* (*n*), the defendants, by their particulars of objections, alleged (inter alia), "5. That the alleged invention was published prior to the patent by certain patents and the specifications thereof (naming them); 8. The plaintiff's specification claims some of the matters specified or patented in certain specifications (naming them)." The District Registrar, affirmed subsequently by the Judge in Chambers and Divisional Court, ordered "better particulars, showing in detail what part or parts of the patents or specifications respectively referred to in the 5th and 8th objections showed prior publication, and what parts were relied on as being claimed by the plaintiff's specification. In default of delivery, objections 5 and 8 to be struck out."

In *Plimpton* v. *Spiller* (*o*), the particulars were—"before the date of the alleged letters patent the alleged invention had been published in England in the 'Commissioners of Patents Journal,' of the 6th February, 1863, and in the 'Scientific American,' of the 24th January, 1863, and in drawings and sketches deposited in the Patent Office library in July, 1865." Mr. Justice Field directed that the defendant should amend his particulars by stating the **date of the American patent**, and in whose name it had been granted. And also by giving the **pages of the publications** mentioned, but not the lines. And also by giving such written details as would enable the drawings mentioned to be identified, and to state whether the drawings were or were not

(*l*) *Heath* v. *Unwin*, 10 M. & W. 684; *Russell* v. *Ledsam*, 11 M. & W. 647.

(*m*) *Jones* v. *Berger*, 5 M. & G. 208; *Palmer* v. *Cooper*, 9 Ex. 231.

(*n*) Griff. P. C. 98; 3 P. O. R. 247; see also *Harris* v. *Rothwell*, Griff. P. C. 109; 3 P. O. R. 243.

(*o*) 20 Solicitors' Journal, 1876, p. 860; see also *Flower* v. *Lloyd*, same reference.

contained in books, and what books. Notice of objections, on the ground that the grantee of the letters patent was not the first and true inventor, does not stand upon the same footing as objections on the ground of prior user or publication. Sect. 29, sub-sect. 3, does not require the defendant to state more than generally on what grounds he objects, and a statement that his objection is that the **plaintiff was not the true inventor**, that is, that the consideration did not move from him, will be sufficient, care being taken to distinguish this objection from that of prior user or publication.

Whether or not a defendant will be required to give particulars of **lines and pages of the specifications** upon which he relies in his objections will depend upon the circumstances of the case and the nature of those specifications (*p*); where it appeared that the defendant had, figuratively speaking, "thrown at the head" of the plaintiff a large number of specifications without any attempt at discrimination, further particulars were required (*q*), but if the defendant *bonâ fide* relies upon the whole of a specification, or any number of specifications in reason, his particulars of objections will not be interfered with. In *Nettlefolds* v. *Reynolds* (*r*), Lindley, L.J., said: "It appears to me, therefore, that the moment the learned Judge came to the conclusion, as he did in fact, that the defendant here had honestly done his best to give to the plaintiff that information that he is entitled to, unless the Court came to the conclusion that there was some grievous or some obvious mistake, he ought to be satisfied with that, and not to say, 'I shall order further particulars, because I know from experience that if you say you rely on the whole of the specification, when you come into court nine-tenths will not be referred to.' If the defendant is to be bound hand and foot to a particular page, and to a particular line, it will be perfectly impossible for him to defend his case, or to impeach the patent to the extent and in the manner in which he is entitled to do it."

The object of particulars of objections is to ascertain the lines

(*p*) *Heathfield* v. *Greenway*, 11 P. O. R. 19.

(*q*) *Sidebottom* v. *Fielden*, 8 P. O. R. 266, 270; *Holliday* v. *Heppenstall*, 6 P. O. R. 320; *Heathfield* v. *Greenway*, 11 P. O. R. 17.

(*r*) 8 P. O. R., at p. 417; see also *Siemens* v. *Karo*, 8 P. O. R. 376.

upon which the plaintiff's patent is to be attacked, and thereby prevent surprise, consequently it is not only necessary to define the objection to the plaintiff's patent upon which the defendant intends to rely, but also, where the patent in question is of some complexity, to define the part of it against which the attack is directed (*s*).

Objections on the ground of **common knowledge** must be carefully distinguished from objections on the ground of prior publication; in the latter case every book or document must be particularized, as no instance of anticipation can be adduced at the trial of which particulars have not been delivered, but when the objection to a patent is based upon common knowledge, no particular instances need be referred to, as this objection can only be proved by the examination of witnesses and reference to well-known standard works upon the subject (*t*). Specifications may not be put in at the trial in proof of common knowledge, but must be specifically mentioned in the particulars (*u*).

Evidence will be admitted at the trial, provided the language of the particulars of objections is large enough to admit it; for instance, if the plaintiff has allowed such words as "and elsewhere" to stand until the trial, the defendant will be allowed to give evidence of prior user **anywhere** (*x*). The proper course for the plaintiff to take should the defendant deliver vague particulars is to issue a summons before a judge in chambers for further and better particulars, or, in the alternative, to have the objectionable words struck out (*y*).

In *Sugg* v. *Silber* (*z*), Mellish, L. J., said:—"The authorities cited by Mr. Cave were cases where objections had been taken to the notices of objection at the time when they were delivered,

(*s*) *Harris* v. *Rothwell*, 3 P. O. R. 243; *Boyd* v. *Farrar*, 5 P. O. R. 33.

(*t*) *Holliday* v. *Heppenstall*, 6 P. O. R. 320; *English and American Machinery Co.* v. *Union Boot Co.*, 11 P. O. R. 367.

(*u*) *Solvo Laundry Co.* v. *Mackie*, 10 P. O. R. 68; *Peckover* v. *Rowland*, 10 P. O. R. 118; *English and American Machinery Co.* v. *Union Boot Co.*, 11 P. O. R. 373.

(*x*) *Hull* v. *Bollard*, 25 L. J., Ex. 304; *Sykes* v. *Howarth*, L. R., 12 Ch. D. 826.

(*y*) *Fisher* v. *Dewick*, 1 Web. P. C. 551 (n.); *Carpenter* v. *Walker*, 1 Web. P. C. 268 (n.); *Holland* v. *Fox*, 1 C. L. R. 440.

(*z*) L. R., 2 Q. B. D. 495.

and further and better particulars were asked for. In my opinion 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. It is perfectly obvious that, if Mr. Cave was right in saying that the two questions are the same, and that 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. Although the objections did not specifically point out that the invention consisted of several claims, yet the objection, that the invention is not the subject matter of a patent, is sufficient to open the objection that the whole, or some particular part of it, is not the subject matter of a patent, and that consequently the patent is bad" (*a*).

In *Britain* v. *Hirsch* (*b*), in the Court of Appeal, Cotton, L. J., said: "In my opinion, under the present Act of Parliament, it is within the **discretion of a judge** who hears evidence in a patent case to allow evidence to go beyond the particulars actually delivered."

The defendant will not be allowed at the hearing of the action to introduce **evidence of prior user, not disclosed in the particulars of objection,** although such evidence may have only come to his knowledge since the delivery of the particulars of objection. His proper course is to obtain leave by summons or by serving short notice of motion **for leave to amend,** when an order will be made upon the terms mentioned below; and with an added term to delay the trial should it appear just that the plaintiff should have time to investigate the new evidence (*c*).

Page-Wood, V.-C., in *Penn* v. *Bibby* (*d*), permitted a defendant in his amended particulars, to preface his statement of the

(*a*) See also *Hull* v. *Bollard*, 1 H. & N. 134; *Neilson* v. *Harford*, 1 Web. P. C. 331; *Bovill* v. *Goodier*, L. R., 1 Eq. 35.

(*b*) 5 P. C. R., at p. 231.

(*c*) *Daw* v. *Eley*, L. R., 1 Eq. 38.

(*d*) L. R., 1 Eq. 548.

specific instances of alleged prior user, with the words "amongst other instances" in order to give him an opportunity to apply for leave to re-amend by inserting any further instances of prior user which he might discover.

Liberty to amend particulars of objections at the trial was given upon terms in *Renard* v. *Levenstein* (*a*); but in *Moss* v. *Malings* (*b*), North, J., refused leave, and said:—"I could only grant it if the defendant showed that he could not, with reasonable diligence, have discovered the new facts sooner. This he has not done. I must, therefore, refuse the application."

In *Allen* v. *Horton* (*c*), the defendant amended his particulars of objections at the trial by leave of the Court; judgment was given for the defendant, but costs refused owing to the late stage at which the amendment was made.

The terms upon which amendment is permitted are, first, that the plaintiff should be at liberty, if he pleases, to discontinue the action, and to be in the same position as to costs, as if the proposed amended particulars had been delivered in the first instance (*d*), and, secondly, that the defendant should be put under such terms as to costs, as to the judge or Court may seem just. The particulars of objections give notice to the plaintiff of the case which is to be made against him; thereupon he may discontinue or not, as he pleases, paying the defendant's costs. The defendant should not be permitted to keep back his most salient objections, and so to entice the plaintiff to proceed and incur costs, and then to amend his particulars at the last moment.

In *Pirrie* v. *York Street Spinning Company* (*e*), leave to amend the particulars of objections was granted pending appeal.

Forms of orders, for delivery of further particulars of objections, and for liberty to amend, will be found in the appendix (*f*).

(*a*) 11 L. T. at p. 506; also *Allen* v. *Horton*, 10 P. O. R. 412.

(*b*) L. R., 33 Ch. D. 603; 3 P. O. R. 375; also *Peckover* v. *Rowland*, 10 P. O. R., at p. 120.

(*c*) 10 P. O. R. 412; note also *Westley Richards* v. *Perkes*, 10 P. O. R. 181, 186.

(*d*) *Baird* v. *Moule's Patent Earth Closet Co.*, L. R., 17 Ch. D. 139 (n.); and *Ateling* v. *Maclaren*, same page; also *Edison Telephone Co.* v. *India-rubber Co.*, L. R., 17 Ch. D. 137; *Parker* v. *Maignen's Filter Co.*, 5 P. O. R. 207.

(*e*) 11 P. O. R. 431.

(*f*) P. 483, post.

INTERROGATORIES.

Order XXXI. rule 1, of the rules of the Supreme Court, 1883, provides that either party to an action, with leave of the Court or a judge, may interrogate the other party.

Interrogatories must be relevant to the issue, and will not be allowed to be used for the purpose of cross-examination. Since it is not possible to say precisely what the issues between the parties are before the statement of defence is delivered, neither party, except under special circumstances, will be allowed to interrogate until that stage of the action has been reached (*g*).

Rule 26 provides that 5*l.* or some further sum, should be brought into Court by the party desiring to interrogate before he shall be at liberty to do so.

The general rules as to interrogatories in ordinary actions apply equally to actions for infringement.

The plaintiff may interrogate the defendant, and the defendant must **answer as to what infringement** he has been guilty of; and he must disclose, if asked, the names and addresses of all persons, whether in England or abroad, from whom he may have received money for the use of articles alleged to be made in infringement of the patent (*h*).

In *Lister* v. *Norton* (*i*), the defendants put in a defence denying infringement, and the plaintiff interrogated the defendants, and asked in one interrogatory whether the defendant's firm had not sold imitation sealskins (the patent being for "Improvements in the manufacture of velvets and of pile fabrics in imitation of sealskin and other similar materials") to certain firms, naming sixteen firms. This interrogatory the defendants declined to answer, on the ground that the information was not *bonâ fide* sought for the purposes of the action. Chitty, J., ordered an answer to the interrogatory, unless within fourteen days the defendant admitted infringement.

(*g*) *Mercier* v. *Cotton*, L. R., 1 Q. B. D. 442.

(*h*) *Crossley* v. *Stewart*, 1 N. R. 426 *How* v. *McKernan*, 30 Beav. 547; *Ashworth* v. *Roberts*, 7 P. O. R. 455.

(*i*) Griff. P. C., at p. 149; 2 P. O. R. 68.

In *Benno Jaffé* v. *Richardson* (*k*) the plaintiff administered interrogatories to the defendant, **framing them upon the statements in his specification,** which he alleged that the defendant had infringed, and thereby asked the defendant if he had used the processes described in the specification, taking them step by step. Some of these interrogatories the defendant refused to answer, on the ground that they were not relevant until the patent was established. It was held by North, J., that the plaintiff was entitled to further answers.

But where the materiality of an interrogatory depends upon the **construction of the patent,** no answer need be given (*l*).

The fact that the defendant's particulars of objections are sufficient will not necessarily preclude the plaintiff from obtaining more detailed information by administering interrogatories. In *Birch* v. *Mather*, Chitty, J., said: "The right to interrogate is conferred by the general orders, and I cannot say as a matter of principle that it can be laid down that the plaintiff is not entitled to interrogate the defendant, and *vice versâ*, with reference to these matters which may be covered by the particulars. I hold, therefore, on the general question, that there is a right to deliver interrogatories, and provided the interrogatories are properly worded, interrogatories with reference to these very matters which ought to be covered by the particulars" (*m*).

The plaintiff is entitled to interrogate as to the names and addresses of the persons by whom the defendant alleges the invention was used prior to the date of the plaintiff's patent, also as to the places where such prior user occurred (*n*).

In a petition for revocation under section 26, interrogatories will be allowed to be administered by the petitioner to the respondent, inquiring into the manufacture, use, and sale of the patented article prior to the date of the patent (*o*).

(*k*) 10 P. O. R. 136; see also *Ashworth* v. *Roberts*, 7 P. O. R. 451.

(*l*) *Delta Metal Co.* v. *Maxim-Nordenfelt Guns Co.*, 8 P. O. R. 169.

(*m*) L. R., 22 Ch. D., at p. 631; see also *Alliance Pure Whitelead Syndicate* v. *MacIvor's Patents*, 8 P. O. R., at p. 322

(*n*) *Finnegan* v. *James*, L. R., 19 Eq. 72; *Crossley* v. *Tonney*, L. R., 2 Ch. D. 533; *Birch* v. *Mather*, L. R., 22 Ch. D. 629; *Alliance Pure Whitelead Syndicate* v. *MacIvor's Patents*, 8 P. O. R. 321.

(*o*) *Haddan's Patent*, 54 L. J., Ch. 126.

Where a defendant alleged that his process was secret, he was bound to answer whether he used the materials mentioned in the specification, and whether he used any additional materials, but not to disclose the proportions in which he used the specified materials, or what the additional materials were (*p*).

"The mere plea of secret process is not sufficient to defeat discovery, but, on the other hand, interrogatories must not be made the means of unfair treatment of a man who is fighting fairly" (*q*).

When there is nothing to show that the defendant has infringed the patent, and he has denied on oath having infringed the patent, the plaintiff will not be permitted to interrogate as to the articles made and sold by the defendant, there being nothing to show that the articles sold infringe the patent. If *Lea* v. *Saxby* (*r*) be read, this proposition will be seen to follow.

Crossley v. *Tomey* (*s*) was an action to restrain infringement. The defendant in interrogatories was required to state whether he was not making articles in all respects identical with those of the plaintiff, and to set forth in what respects they differed, and by what process they were made. It was held that the defendant, who alleged prior user by himself and others, had sufficiently answered by stating that, save so far as the articles manufactured by him before the date of the patent were similar to those of the plaintiff, the articles he now made differed from those made by the plaintiff, but he could not show in what they differed without ocular demonstration.

Communications between a man and his patent agent are not privileged, consequently, where the plaintiff's patent agent also acted as his solicitor, he was ordered to answer interrogatories with reference to documents which passed between them at the time the specification was prepared, such communications having taken place in the relationship of patent agent, and not of solicitor and client (*t*).

In the same case interrogatories which sought to compel the

(*p*) *Renard* v. *Levinstein*, 8 N. R. 665.

(*q*) Per Kekewich, J., in *Ashworth* v. *Roberts*, 7 P. O. R., at p. 455.

(*r*) 32 L. T., N. S. 731.

(*s*) L. R., 2 Ch. D. 533.

(*t*) *Moseley* v. *Victoria Rubber Co.*, 3 P. O. R. 351.

plaintiff to particularise the alleged breaches by stating what parts of the plaintiff's specification were infringed by the defendants (the defendants having in answers to interrogatories disclosed what they had done) were disallowed on the ground that the defendants could for themselves compare the plaintiff's specification with what they admitted they had done.

In *Borill* v. *Smith* (*u*), the following interrogatory was disallowed: "Does not the defendant allege that the plaintiff's invention was publicly used within this realm before the date of the plaintiff's patent? Set forth particularly when, and in what place or places, and in what manner, does the defendant allege that the plaintiff's invention, or any or what part thereof, was publicly used within this realm before the date of the plaintiff's patent." Sir W. Page Wood, V.-C., said that the plaintiff was not entitled to enquire generally into the way in which the defendant shaped his case in order to find out whether some of the persons alleged by him to have used the process before the date of the patent, were the persons against whom the plaintiff had succeeded in other suits, though he might have asked if the process was the same as that used by A. B., or any one person specifically named, who had been a defendant in some former suit.

A defendant who submits to answer must answer fully: he cannot, by denying the plaintiff's title, escape answering. Discovery of title deeds and of professional communications form an exception. The plaintiff and defendant had both patents for making gelatine; the plaintiff interrogated as to the article manufactured by the defendant, and as to the names and addresses of the customers, and as to prices and profits. The defendant denied all infringement. He said he had made his article according to his own, and not according to the plaintiff's, patent, and he declined to give an account of such article. Held, that notwithstanding his denial, he was bound to do so (*x*). It is doubtful whether this case would be followed now, for it is difficult to understand how the question could be relevant to the issue. It might be relevant after judgment, but before judgment the issue

(*u*) L. R., 2 Eq. 459; see also *Daw* v. *Eley*, 2 H. & M. 725.

(*x*) *Swinborne* v. *Nelson*, 16 Beav. 416; but note *Lea* v. *Saxby*, 32 L. T., N. S. 731.

is, infringement or no infringement. The names of the customers could not bear upon this question.

After trial, and in pursuance of the terms of the judgment, if the plaintiff has been successful he is entitled to interrogate the defendant, or to require that the defendant "should make and file an affidavit stating what machines of the same construction as that supplied by him to A. or B., including such machines as are in his possession or power," see *Seton, 4th ed. p.* 352. The answer or affidavit of the defendant must be complete. In *Murray* v. *Clayton* (*y*), a patentee of improvements in brick-cutting machines, who was a manufacturer of the machines by an agent at the agent's works and not a licensor, having obtained a perpetual injunction against the defendants (who were also manufacturers of brick-cutting machines), from infringement, the defendants were ordered to file an affidavit stating the number of machines made by them since the date of the patent, and the names and addresses of the persons to whom the same had been sold, *and of the agents concerned in the transactions.* Upon motion to vary the order, it was held that the plaintiff was entitled to have discovery of the names and addresses of the purchasers, but not of the agents concerned, there being nothing to show that any agents had been employed.

In answering interrogatories filed by a defendant for the examination of the plaintiff, the general rule applies that he who is bound to answer must answer fully (*z*).

Interrogatories for the examination of a plaintiff are on a different footing from those for the examination of a defendant in this respect, that a plaintiff is not entitled to discovery of the defendant's case, but a defendant may ask any questions tending to destroy the plaintiff's claim (*a*).

In determining whether a question is one of fact, and, therefore, to be answered, it makes no difference that it is asked with reference to a written document (*b*).

A defendant in a suit for infringement of a patent in order to prove that there was no novelty in the plaintiff's patent, interro-

(*y*) L. R., 15 Eq. 115.
(*z*) *Hoffman* v. *Posthill*, L. R., 4 Ch. 673.
(*a*) *Hoffman* v. *Posthill.*
(*b*) Ibid.

gated the plaintiff as to the inventions described in the specifications of various patents, and asked him to show in what respects they differed from his. The plaintiff declined to answer these interrogatories on the ground that the questions were **not questions of fact, and that they related to the plaintiff's case**; the defendant excepted to the answer, and the exceptions were allowed (*c*).

A plaintiff in a patent suit was required by interrogatories to set out a correspondence between himself and a third party, and also to state the particulars of the infringement of his patent on which he relied. He refused to answer these questions on the ground that the defendant might obtain an order in chambers to inspect the correspondence: and that he had sufficiently set out the particulars of the infringement in his bill. These answers were held to be sufficient (*d*).

We have set out the effect of this case at length, because it is founded upon and exemplifies in many ways the principle upon which a defendant may examine a plaintiff. Lord Justice Giffard, in giving judgment, said: "As regards the case of *Daw* v. *Eley* (*e*), it must be always remembered that that was the case of a plaintiff exhibiting interrogatories to a defendant, and it was there held that the plaintiff could not call on the defendant to set forth the particulars of his defence. But when you come to the case of a defendant asking questions of a plaintiff, it is a very different thing. It is the defendant's business to destroy the plaintiff's case, and there the defendant has a right to ask all questions which are fairly calculated to show that the patent is not a good patent (*f*), or that what he alleges to be an infringement is not an infringement." Lord Justice Selwyn had said: "Our decision in this case will leave it entirely within the power of the learned Vice-Chancellor to order that all the costs occasioned by the interrogatories, the answer, the exceptions, the hearing the exceptions before him, and the hearing of this appeal, shall be dealt with as he, in his discretion, shall think fit; and if it shall appear that the power which the Court, for the purpose of justice and dis-

(*c*) *Hoffman* v. *Posthill.*
(*d*) Ibid.
(*e*) 2 H. & M. 725.
(*f*) *Rylands* v. *Ashley's Patent Bottle Co.*, 7 P. O. R. 175.

covery, gives to the parties to administer interrogatories to each other has been abused, I have no doubt the learned Vice-Chancellor will take care that justice shall be done, and will make the party who is to blame pay all the costs of the improper exercise of this power."

INSPECTION.

Sect. 30 of the Patents, &c. Act of 1883, provides: "*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.*"

The power to order an inspection was always assumed by the Courts; in *Bovill* v. *Moore* (*g*), Lord Eldon said: "There is no use in this Court directing an action to be brought, if it does not possess the power to have the action properly tried. The plaintiff has a patent for a machine used in making bobbin lace. The defendant is a manufacturer of that article; and, as the plaintiff alleges, he is making it with a machine constructed upon the principle of the machine protected by the plaintiff's patent. Now the manufactory of the defendant is carried on in secret. The machine which the defendant uses to make bobbin lace, and which the plaintiff alleges to be a piracy of his invention, is in the defendant's own possession, and no one can have access to it without his permission. The evidence of the piracy, at present, is the bobbin lace made by the defendant. The witnesses say that this lace must have been manufactured by the plaintiff's machine, or by a machine similar to it in principle. This is obviously in a great measure conjecture. No Court can be content with evidence of this description. There must be an order that plaintiff's witnesses shall be permitted before the trial of the action to inspect the defendant's machine, and to see it work."

"The right to inspection is a right to be given at the discretion of the Court—to be exercised with a judicial discretion and

(*g*) 2 Coop. Ch. Ca. 56 (n.).

with due regard to the interests of the parties concerned in the litigation" (*h*).

The object which the Court has in view in all cases where an inspection is permitted, is to ensure that **the true facts of the case shall be carefully sifted**; but at the same time the Court will take care that the process of the law is not abused, and that an action for infringement shall not be made a means and lever for the discovery of other persons' secrets.

The Court requires, before granting an order for inspection, that a *primâ facie* case shall be made out of infringement (*i*). And when the interests of justice require, the inspection will be granted to scientific witnesses, who will be required to keep any secrets which they may have discovered, and which do not affect the question of infringement (*k*). And in *Flower* v. *Lloyd* (*l*) the Court of Appeal strictly limited the inspection to scientific men, and excluded the plaintiff from being present.

In *Pigott* v. *The Anglo-American Telegraph Co.* (*m*), it was alleged that an inspection would disclose important secrets. Giffard, V.-C., in refusing an order to inspect, said: "Of late years greater readiness has been shown by the equity Courts to allow inspection in patent cases than by the courts of common law. But it has never been considered as a matter of right, nor have the equity Courts considered themselves as precluded from exercising a proper discretion in applications of this description. The Court ought to be satisfied of two things: that there really is a case to be tried at the hearing of the cause, and that the inspection asked for is of material importance to the plaintiff's case *as made out by his evidence.*"

In *Batley* v. *Kynock* (*n*), Sir James Bacon, V.-C., said: "Upon the single point which is raised before me, there can

(*h*) Per Bristowe, V.-C., in *McDougall* v. *Partington*, 7 P. O. R., at p. 357.

(*i*) *Bovill* v. *Moore*, supra; *The Singer Sewing Machine Co.* v. *Wilson*, 12 L. T., N. S. 140; *Shaw* v. *The Bank of England*, 22 L. J., Ex. 26; *Batley* v. *Kynoch*, L. R., 19 Eq. 90; *Germ Milling Co.* v. *Robinson*, 55 L. J., Ch. 287; 1 P. O. R. 217.

(*k*) See *Russell* v. *Crichton*, 1 Web. P. C. 667 (n.); 15 Dec. Ct. of Sess. 1270.

(*l*) W. N. 1876, 169, 230; see also *The Plating Co.* v. *Farquharson*, Griff. P. C. 187.

(*m*) 19 L. T., N. S. 46.

(*n*) L. R., 19 Eq. 92.

be no doubt that the plaintiff in such a suit as this is entitled to an inspection of the means which the defendants employ in the manufacture of the articles alleged to be violations of the plaintiff's patent, when such **inspection is essential for the purpose of enabling the plaintiff to prove his case**; upon the materials before me that is not made out. There is no allegation by the plaintiff that he cannot make out his case without inspection. But there is on the part of the defendants a plain allegation that inspection is not necessary for the purposes of the suit; upon that only I must decide this question. I would rather not go into the other matters which have been referred to. The description in the specification and the allegation in the bill—but as I read both the description in the specification and the allegation in the bill—I find that the charge made by the plaintiff is that the cartridges, the right of manufacturing which is vested in him exclusively, have been imitated and copied by the defendant, and if that fact can be made out the plaintiff's case can be clearly established. The mode of making that out is by examination of the cartridges, the means by which they have been made, whether by a machine or hammer or a screw cannot signify in the least if the cartridges of the defendant when made are made upon the principle of the patent claimed by the plaintiff."

As we have seen, the plea of **secret process** is of no avail for the pu[illegible]f resisting an order for inspection, but in such a case before granting the order the Court will require the plaintiff to make out a strong *primâ facie* case of infringement (*o*).

In *Drake* v. *Muntz Metal Co.* (*p*), before statement of claim application was made to Bacon, V.-C., that the defendants by their proper officer should make an affidavit verifying the machines and processes used by the defendant company in bending metal tubes since the date of the plaintiff's patent and for inspection. The Vice-Chancellor said that sect. 30 (*supra*) did not give him power to direct an affidavit to be made, but ordered inspection of the machines.

The Court, in the case of *The Patent Type Founding Co.* v.

(*o*) *Germ Milling Co.* v. *Robinson*, 1 P. O. R., at p. 219.

(*p*) 3 P. O. R. 43.

Waller (*q*), assumed the jurisdiction to order the defendant to deliver to the plaintiff a **sample of the type made by him so that the plaintiff might have the same analysed**, for the purpose of ascertaining whether the composition was similar to the plaintiff's patented composition.

In that case it was also held that **laches** sufficient to defeat the plaintiff's right to an interlocutory injunction was no bar to an order on the same motion for inspection.

Inspection will only be allowed of that with regard to which a *primâ facie* case of infringement has been made out (*r*).

In some cases where it is necessary, the Court will order the defendant and the plaintiff to give **mutual inspection**, and to show both the patented machine and the alleged infringement at work, and to permit either party to take away any of the work or samples of the work which has been done in their presence (*s*).

Whether the plaintiff will be entitled to see the alleged infringing machine **at work** or not will depend upon the circumstances of the case (*t*).

Where the defendant has delivered to the plaintiff specimens of the alleged infringing articles, the latter is not entitled to see those articles in actual use on the defendant's premises (*u*).

No order will be made for inspection by the plaintiff of articles not within the control of the defendant, nor of **exhibits** which the defendant's witnesses will give in evidence (*x*).

In *McDougall* v. *Parlington* (*y*) the plaintiff's right to inspection depended upon a contract which was the matter in dispute, and since he was unable to show that inspection was necessary to prepare his case, it was held that no inspection should be granted

(*q*) 8 W. R. 353; John. 727; see also *Germ Milling Co.* v. *Robinson*, 3 P. O. R. 11.

(*r*) *Cheetham* v. *Oldham*, 5 P. O. R. 617, 621.

(*s*) *Davenport* v. *Jepson*, 1 N. R. 307; see also *The Singer Sewing Machine Co.* v. *Wilson*, 5 N. R. 505; *The Germ Milling Co.* v. *Robinson*, 55 L. J., Ch. 288; 3 P. O. R. 11.

(*t*) *The Germ Milling Co.* v. *Robinson*, 3 P. O. R. 11; *Drake* v. *Muntz Metal Co.*, 3 P. O. R. 43; *Sidebottom* v. *Fielden*, 8 P. O. R. 266.

(*u*) *Sidebottom* v. *Fielden*, 8 P. O. R. 266.

(*x*) *Garrard* v. *Edge*, 6 P. O. R. 372; also *Sidebottom* v. *Fielden*, 8 P. O. R. 266, 269.

(*y*) 8 P. O. R. 351, 472.

on the ground that the right depended upon the question to be determined at the trial.

The application may be made on motion to the Court or by summons; it is usually made upon the application for an interim injunction, but it is immaterial at what stage of the proceedings the application is made. The evidence in support must be on affidavit, and a *primâ facie* case of infringement must be made out, and that the inspection is material to the plaintiff's case.

Order L. of the Rules of the Supreme Court, 1883, contains some provisions as to inspection which must be noticed.

Rule 3 provides for the inspection of property and the taking of samples, or for "any observations to be made or experiment to be tried which may be necessary or expedient for the purpose of obtaining full information or evidence." Rule 4: "It shall be lawful for any judge, by whom any cause or matter may be heard or tried with or without a jury, or before whom any cause or matter may be brought by way of appeal, to inspect any property *or thing* concerning which any question may arise therein."

This last mentioned rule was introduced by the Rules 1883. Before, the parties must have consented to a view being had. In *Jackson* v. *The Duke of Newcastle* (z), Lord Westbury said: "A judge is bound to pronounce his decision according to the evidence before him, but his inspection of the premises may bring him to a conclusion directly opposite to that which is established by the evidence."

THE TRIAL.

The constitution of the Court which is to hear and determine patent actions is provided for by sect. 28, sub-sect. 1, of the Act of 1883: "*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 hear and try the case wholly or partially with his assistance; the action shall be tried without a jury, unless the Court shall otherwise direct.*"

(z) 33 L. J., Ch. 698.

Under the old statute, either party had an absolute right to have the questions of fact decided by a jury, and the Court had no power to deprive them of this right (*a*).

Under the 57th sect. of the Judicature Act, 1873, the Court had power, without the consent of the parties, "in any such cause or matter requiring any prolonged examination of documents or accounts 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, the Court or a judge may at any time, on such terms as may be thought proper, order any question or issue of fact, or any question of account arising therein, to be tried either before an official referee, to be appointed as hereinafter provided, or before a special referee to be agreed on between the parties; and any such special referee so agreed on, shall have the same powers and duties, and proceed in the same manner as an official referee. All such trials before referees shall be conducted in such manner as may be prescribed by rules of Court, and subject thereto in such manner as the Court or judge ordering the same shall direct."

In the case of *Saxby* v. *The Gloucester Wagon Co.* (*b*), Mr. Justice Hawkins was of opinion that a patent case was a case which required a "prolonged scientific examination," and consequently he remitted the action to that which he considered the most proper tribunal for difficult scientific questions, "*the official referee.*" We are inclined to think that sect. 28 of the Patents &c., Act, does away with this option. The words appear to read: "*The Court may employ an assessor, and shall do so on the application of either party, and* shall *try the case; and the action* shall *be tried without a jury, &c.*"

Ord. XXXVI. rule 5 of the Rules of the Supreme Court provides, "The Court or a judge may direct the trial without a jury, of any cause, matter, or issue, requiring any prolonged examination of documents or accounts or any scientific or local examination which cannot, in their or his opinion, conveniently be made with a jury"; and rule 6: "In any other cause or matter, upon the application of any party thereto, for a trial with a jury." These

(*a*) *Sugg* v. *Silber*, L. R., 1 Q. B. D. 362. (*b*) W. N. 1880, p. 28.

rules, together with the provisions of sect. 28 of the Patent Act, would show that the better opinion probably is that, unless a judge or the Court otherwise orders, the constitution of the Court shall be a judge sitting without a jury, and with or without an assessor.

The grounds of application for a trial by jury would be that the evidence shows a **conflict of testimony** in material parts, or that **grave questions of credibility** are likely to arise, or that a **charge of fraud** is made against either party.

Mr. Hindmarch, at p. 291 of his celebrated work, says: "Few causes require so much care and industry in preparing for trial as patent actions, in which very nice points of law and difficult questions of fact must often be decided between the parties; and it will frequently happen that a party will succeed or fail in obtaining a verdict according to the industry with which he has got up his case for trial. Properly to understand the questions raised in such actions and prepare the necessary proofs, a competent knowledge, not only of law, but also of science in general and the useful arts, is essentially requisite."

Prior to the Act of 1883 the **jurisdiction of the Palatine Court of Lancaster** was "the jurisdiction of the old Court of Chancery within the boundary" (*c*), and its jurisdiction to award damages depended upon the provisions of Lord Cairns' Act (*d*), which limited that jurisdiction to cases where the Court had power to grant an injunction; consequently where it was held that no injunction could under the circumstances be granted, the plaintiffs were unable to recover damages in that Court for the infringement of their patent (*e*).

The Act of 1883 made no mention of the Palatine Court, defining the word "Court" as the High Court of Justice, and by the general repeal of previous Acts relating to letters patent, without excepting their application to proceedings in the Palatine

(*c*) Per Jessel, M.R.; *Re Longdendale Cotton Spinning Co.*, L. R., 8 Ch. D. 152; 26 W. R. 491.

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

(*e*) *Proctor* v. *Bayley*, 6 P. O. R. 538, 545; see also upon this point *Hindley* v. *Emery*, L. R., 1 Eq. 52; *Davenport* v. *Rylands*, L. R., 1 Eq. 302; *Swaine* v. *Great Northern Rail. Co.*, 12 W. R. 391; *Wedmar* v. *Corporation of Bristol*, 11 W. R. 136; *Cory* v. *Thames Iron Co.*, 11 W. R. 589; *Catton* v. *Wyld*, 32 Beav. 266.

Court, confined the jurisdiction of that Court to the general rule relating to proceedings in a Chancery action for the infringement of a right of any description, unless special jurisdiction could be found in the interpretation of the word "judge" in the Act of 1883.

In *Winter* v. *Baybut* (*f*) the Vice-Chancellor held that the words "The Court or a judge" in the 19th sect. meant "The High Court or a judge with power to try actions for infringement," and consequently held that he had jurisdiction to give liberty to the plaintiff to apply for leave to amend his specification while an action for infringement was pending before him. But in *Proctor* v. *Sutton* (*g*) Day, J., held that the same words in the 31st sect. meant "The Court or a judge thereof," and consequently that the Vice-Chancellor had no jurisdiction to grant a certificate of validity under that section.

If the latter be the correct interpretation it would appear that the jurisdiction in patent actions given to the Vice-Chancellor under the provisions of the Acts which were repealed by the Act of 1883, was by that Act taken away.

The Chancery of Lancaster Act, 1890, sect. 3, enacts:—

"*From and after the passing of this Act the Court of Chancery of the County Palatine of Lancaster* (*in this Act called the Lancaster Chancery Court*), *shall, as regards all persons, bodies corporate, and property within or becoming subject to its jurisdiction, have and exercise the like powers and jurisdiction, and in a similar manner, and subject to the same restrictions in all respects, as the High Court in its Chancery Division now has and exercises, or may, under or by virtue of any Act of Parliament hereafter passed, and not expressly enacting to the contrary hereof, have and exercise, in respect of all persons, bodies corporate, and property within its jurisdiction.*"

The effect of this Act is to extend the meaning of the word "Court" in the Patents, &c., Acts, to the Palatine Court so far as it relates to actions for infringement.

A grant of letters patent gives to the patentee a right which extends over the whole of the United Kingdom, and only a small portion of that right lies in the district which is within the jurisdiction of the Palatine Court, consequently the Chancery of

(*f*) 1 P. O. R. 76.

(*g*) 5 P. O. R. 184.

Lancaster Act, 1890, does not give to that Court power to adjudicate upon a petition for revocation of letters patent since the whole of the property which is the subject of the petition does not lie within its jurisdiction.

A **county court** has no jurisdiction to try an action for infringement when the validity of the patent is in dispute (*h*).

It is no ground for **postponing the trial of an action for infringement** that a petition has been presented by the defendant or any other person under sect. 26 to revoke the patent.

We have seen that proceedings for revocation are similar to, and for the same purpose as, *scire facias* prior to the Act of 1883. In *Muntz* v. *Foster* (*i*) it had been held that the fact of a writ of *scire facias* being pending was no ground for staying the action for infringement. Tindal, C.J., said: "As a general rule, a plaintiff has a right to have his cause go on for trial according to the ordinary course of business. Special circumstances may exist upon which the Court may see fit to interfere; but the present does not appear to us to be a case in which we ought to interfere by staying the proceedings in the action."

The ground of this decision was that the plaintiff in the action for infringement, being defendant in the proceedings by *scire facias*, had not the conduct of those proceedings, and that the defendant in the action for infringement might delay them; but where, in *Patteson* v. *Holland* (*k*), an action for infringement had been tried, and a rule *nisi* for a new trial had been obtained and argued, and it appeared that another action was pending in that Court for another infringement of the same patent, and that a *scire facias* had been sued out to repeal the patent, the Court suspended their judgment upon the rule for a new trial, and ordered the trial of the other action to be postponed until after the trial of the *scire facias*.

And where a verdict had already gone for the Crown on *scire facias*, but a new trial was pending, the plaintiff was not permitted to proceed to trial with his action for infringement until

(*h*) *R.* v. *County Court Judge of Halifax*, L. R., 1891, 1 Q. B. 793; L. R., 1891, 2 Q. B. 263; 8 P. O. R. 338.

(*i*) 2 Web. P. C. 93 (n.); 1 Dowl. & Low. 942.

(*k*) Hindmarch, p. 293.

the rule for the new trial in *scire facias* had been disposed of (*l*).

In an action for infringement the plaintiff has the **right of beginning and of replying,** notwithstanding that the burden of proof may really be on the defendant, as, for instance, where the case principally turns upon questions of prior user or prior publication, which are introduced by the defendant. It sometimes happened that this privilege, particularly in cases of conflicting evidence, was of great value, and for the purpose of snatching it from the plaintiff the defendant did not wait for the plaintiff to commence his action, but commenced proceedings himself by *scire facias* to repeal the patent, so as to place himself in the position of plaintiff. But, by sect. 26, sub-sect. 7, of the Act of 1883, it is provided that in cases where it is sought to **revoke a patent,** "*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.*"

In *Westley Richards* v. *Perkes* (*m*) the fact of infringement was admitted, and the case turned upon the validity of the plaintiff's patent. Kay, L.J., stopped the plaintiff's counsel after having made out a *primâ facie* case, the burden of proof as to invalidity being on the shoulders of the defendant, and in that case the learned judge gave leave to the defendant's counsel to reply on the whole case. Probably this was owing to the fact that the point that the alleged anticipation was never published was not taken by the plaintiff's counsel until he replied generally to the defendant's case.

The plaintiff must give evidence of the issues, which he is bound to prove. It is for him to support his patent and to establish its validity. He must prove his patent if the grant be denied. This is done by producing the patent itself, with the great seal—or, under the Act of 1883, the seal of the Patent Office—attached to it. Sect. 12, sub-sect. 2, provides that, "*A patent so sealed shall have the same effect as if it were sealed with the great seal of the United Kingdom*"; or under sect. 89, if it be not convenient or possible to produce the original, "*Printed or written copies or*

(*l*) *Smith* v. *Upton*, 6 M. & G. 251.

(*m*) 10 P. O. R. 181.

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."

If the plaintiff sues as assignee, or under any derivative title, and his title is denied, the entry from the register of patents may be proved in the manner suggested by the 89th section.

Under the 96th section "*a certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be primâ facie evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.*"

For instance, if an entry in the register is denied by the defendant, he may prove its omission by a certificate under the 96th section.

If the fact of infringement is denied, the plaintiff must be ready with evidence that the defendant has made, used, or sold the articles or process, and any one of these Acts, as we have already seen, will satisfy the allegation of infringement, whether intentional or not (*n*).

The burden of proving infringement is strictly on the plaintiff, and if he does not satisfactorily prove it there is no necessity of entering upon the defendant's case on other matters. The plaintiff must always give evidence when the alleged infringement is the sale or use of an article, **that it was not made by himself or his agents** (*o*).

The plaintiff must, if the matter be put in issue, prove that the title, provisional specification and complete specification, correspond and substantially describe the same invention (*p*).

If it is alleged by the defendant that the invention is illegal or useless, the burden of proof is on the plaintiff.

So the plaintiff must be prepared, if he intends to claim

(*n*) See Chap. XVII.
(*o*) *Betts* v. *Willmott*, L.R., 6 Ch. 239.
(*p*) *Ante*, p. 78, *et seq.*

damages, and not an account, to prove the damage which he has sustained (*q*).

When the defendant alleges that there is a **defect or insufficiency in the specification**, the burden of proving that there is no such defect is on the plaintiff.

We have seen (*r*) that it is for the jury to say whether a specification is **sufficient** or **intelligible** or not; it is for the Court to place a **construction** upon the language used in the specification. The plaintiff must therefore be prepared with **evidence** of an expert character as to the sufficiency of the specification; and in selecting this evidence the plaintiff cannot be better guided than by the judgment of Sir George Jessel in *Plimpton* v. *Malcolmson* (*s*); he must not select eminent engineers or celebrated chemists as the persons to whom the specification must be intelligible, but he must choose "ordinary workmen" in the particular branch of trade to which the invention refers—"not a careless man, but a careful man, though not possessed of 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." He may, of course, call eminent engineers, but their evidence can only be, "placing myself in the position of an ordinary workman I think it would or would not be intelligible or sufficient to me." If the specification be not sufficiently clear to be understood by an ordinary workman (a witness for the plaintiff), witnesses will not be allowed to be called to explain the intention of the patentee, and the plaintiff will be non-suited (*t*).

An **expert witness** cannot be asked his opinion as to whether or not there has been infringement. That is a question for the jury, or the Court in the absence of a jury (*u*).

The description of evidence which is admissible in an action for infringement has been considered in an earlier chapter (*v*); questions, however, which may be put to an expert witness in exami-

(*q*) As to measure of damage, see Chap. XVIII., *ante*.

(*r*) *Ante*, p. 93.

(*s*) L. R., 3 Ch. D. 531; see also *ante*, p. 93, *et seq.*

(*t*) *Brooks* v. *Ripley*, 2 Lond. Jour. C. S. 35.

(*u*) Per Lord Wensleydale, in *Seed* v. *Higgins*, 8 H. L. Cas. 550.

(*v*) *Ante*, p. 96.

nation in chief differ to some extent from those which may be put in cross-examination. When the witness has stated in his examination that an ordinary workman would make a certain machine from the description contained in the specification, it is open to the counsel on the other side to cross-examine him upon the specification, taking it line by line for the purpose of showing that what he said in the first instance was incorrect, although that method of questioning would not be permitted on examination in chief.

The Court will consider the circumstances of the case, the behaviour of the witnesses and their credibility, when considering the question of infringement or no infringement.

In *Clark* v. *Adie* (*x*), Lord Blackburn said:—"Whenever a man knowing for the first time of an invention, either by seeing a machine at work or by reading a specification, proceeds to do what he never did before, and takes a part of the invention, it is always a very strong *argumentum ad hominem* to say: You are, by the very fact of taking this, making evidence against yourself that it was a new invention; otherwise, why did you take it? You are making evidence against yourself that at all events the part you took was new, or why did you take it? and whenever there is a case of theft or stealing knowingly, that observation ought to have some weight, although I think in practice it has more weight given to it than it ought to have. But where there is a case of an innocent infringement of property, by an unwitting use of this sort, that observation can have no weight against the party in the slightest degree, and I think it ought not to have any."

Experiments conducted for the express purpose of manufacturing evidence, with a view to litigation, are to be looked at with distrust (*y*).

When the defendant pleads that the grantee of the letters patent was not the true and first inventor, or that the invention was not new, it will be sufficient if the plaintiff gives some *primâ facie* evidence of novelty (*z*). It will be sufficient to call one or

(*x*) L. R., 2 App. Cas. 337.
(*y*) *Young* v. *Fernie*, 4 Giff. 609.
(*z*) *Turner* v. *Winter*, 1 T. R. 606; *Westley Richards* v. *Perkes*, 10 P. O. R. 181, 186.

two persons acquainted practically with the trade to which the invention refers, to say that they never heard of it, or saw or heard of its having been put in practice or published before the date of the patent. Gibbs, C.J., said: "The first witness, a man of considerable experience, had never seen locks with the lips so perforated; *primâ facie* that is good evidence; but when the question is, whether this had existence previous to the patent, fifty witnesses proving that they never saw it before, would be of no avail if one was called who had seen it and practised it (*a*).

The plaintiff having given this *primâ facie* evidence, the burden of proof as to prior user or prior publication is shifted to the defendant, and if he would invalidate the patent he must prove his case.

We have previously discussed what amounts to prior use and prior publication (*b*). The evidence which the defendant brings must be complete and satisfactory, and the question is one of fact.

If the defendant has succeeded in establishing a case against the plaintiff, the latter will be permitted before the defendant sums up, to adduce rebutting evidence. In *Penn* v. *Jack and Others* (*c*), Sir W. 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 defendants; and for this reason that it is quite impossible for him to know what is the nature of the evidence which is to 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 of the issue just raised 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 their witnesses will prove? I should be very sorry to have to put the parties to all the expense and delay of a new trial, which I should have to direct, if this evidence were excluded. Besides which, the witnesses are at hand and ready, and the sensible and obvious course is to examine them now. The practice at common law is stated in Taylor on

(*a*) *Manton* v. *Manton*, Dav. P. C. 350.

(*b*) *Ante*, Chap. V.

(*c*) L. R., 2 Eq., at p. 317.

Evidence; and it appears that where, as here, several issues are joined, the plaintiff may content himself with adducing evidence in support of those issues which he is bound to prove, reserving the right of rebutting his adversary's proofs, in the event of the defendant establishing a *primâ facie* case with respect to the issues which lie upon him. In support of this proposition, *Shaw* v. *Beck* (*d*) is cited, where Parke, B., used the following expression: 'But Abbott, C.J., laid down what appears to me to be a more reasonable rule, by holding that the defendant was bound to prove his plea, and that the plaintiff might answer it by additional evidence.' Other instances are also mentioned, all showing the wide discretion given to the judge in allowing evidence to be given by the plaintiff in reply. The plaintiff has put in his letters patent as formal evidence of his title. The defendants then plead want of novelty, and give, in proof of the issues thus raised by them, special evidence, which the plaintiff is entitled to rebut, by evidence in reply. Regarding this case as one of an affirmative plea, the burden of proving which rests on the defendants, I feel bound to admit the evidence proposed to be given by the plaintiff in reply."

Although the plaintiff may, as of right, rebut the case made by the defendant, upon any issue which rests with the defendant, where the plaintiff has given such rebutting evidence, **the defendant will not be allowed to strengthen the case which he had made by adducing further evidence**; and this will apply with greater force when the defendant's counsel has summed up the evidence which has been offered (*e*).

At the hearing of the action, no objection will be allowed either to the particulars of objections, or to the particulars of breaches, and any evidence will be received which they are wide enough to admit of. If there is any vagueness or insufficiency in the particulars, the party requiring further information must apply for it to a judge in chambers, within reasonable time before the trial of the action; but they will not be allowed to permit the opposite side to go to trial, and then to submit that for want of sufficient particularity in the objection, the evidence is not admissible (*f*).

(*d*) 8 Ex. 392.
(*e*) *Penn* v. *Jack*, L. R., 2 Eq., at p. 318.
(*f*) *Ante*, pp. 290, 301.

Where the defendant alleged a secret process in an action for infringement, the hearing was conducted *in camerâ*, and the short-hand notes of the trial impounded by order of the Court (*g*).

QUESTIONS FOR COURT AND JURY.

We have seen that, as a rule, actions for the infringement of letters patent are directed to be tried before the Court without a jury. Still, under special circumstances, the parties, or either of them, may obtain an order to try before a jury. Under these circumstances it will still be material to consider what are the questions which the Court should leave to the jury, and which are left to the decision of the Court.

As to the specification. **The construction is for the Court** (*h*); and the rules of construction are similar to those which govern the construction of other documents (*i*). In *Hills* v. *Evans* (*k*), Lord Westbury said: "It is undoubtedly true, as a proposition of law, that the construction of a specification, as the construction of all other written instruments, belongs to the Court; but a specification of an invention contains most generally, if not always, some technical terms, some phrases of art, some processes, and requires generally the aid of the light derived from what are called surrounding circumstances. It is, therefore, an admitted rule of law that the explanation of the words or technical terms of art, the phrases used in commerce, and the proofs and results of the processes which are described (and in a chemical patent the ascertainment of chemical equivalents), that all these are matters of fact upon which evidence may be given, contradictory testimony may be adduced, and upon which undoubtedly it is the province and the right of a jury to decide. But when these portions of a specification are abstracted and made the subject of evidence, and therefore brought within the province of the jury, the direction to be given to the jury with regard to the construction of the rest of the patent, which is conceived in ordinary language, must be a direction given only conditionally, that is to say, a direction as to the meaning of the

(*g*) *Badische Anilin und Soda Fabrik* v. *Levinstein*, L. R., 24 Ch. D. 156.

(*h*) *Ante*, p. 93, *et seq.*

(*i*) *Ante*, p. 95.

(*k*) 31 L. J., Ch. 457.

patent upon the hypothesis or the basis of the jury arriving at a certain conclusion with regard to the meaning of those terms, the signification of those phrases, the truth of those processes, and the result of the technical procedure described in the specification. And so the rule is given by Parke, B., in delivering the judgment of the Court of Exchequer in the case, I think, of *Neilson* v. *Harford* (*l*). The language of the learned judge, which I adopt, is in these words: 'The construction of all written instruments belongs to the Court alone, whose duty it is to construe all such instruments as soon as the true meaning of the words in which they are couched and the surrounding circumstances, if any, have been ascertained as facts by the jury; and it is the duty of the jury to take the construction from the Court, either absolutely, if there be no words to be construed as words of art or phrases used in commerce, and no surrounding circumstances to be ascertained, or conditionally, when those words or circumstances are necessarily referred to them.' Now, adopting that as the rule in the comparison of two specifications, each of which is filled with terms of art and with the description of technical processes, the duty of the Court would be confined to this—to give the legal construction of such documents taken independently. But, after that duty is discharged, there would remain a most important function to be still performed, which is the comparison of the two instruments when they have received their legal exposition and interpretation; and as it is always a matter of evidence what external thing is indicated and denoted by any description, when the jury have been informed of the meaning of the description contained in each specification, the work of comparing the two, and ascertaining whether the words, as interpreted by the Court, contained in specification A, do or do not denote the same external matter as the words, as interpreted and explained by the Court, contained in specification B, is a matter of fact, and is, I conceive, a matter within the province of the jury, and not within the function of the Court."

Epitomising this elaborate judgment. When the language used is that which has an ordinary and legal meaning the question is, what has the man said? not what did he intend to

(*l*) 8 M. & W. 806.

say? and, therefore, the Court will place the legal meaning on his words. When the language used is that which has no ordinary legal meaning, or which under different circumstances may have two or more ordinary legal meanings, the question is, as a fact, with what meaning did the writer use the words or expressions which he has used? and that is a question which the Court should require the jury to solve. The matter could not be placed more lucidly than it is by Lord Westbury in the last dozen lines of the judgment which we have quoted.

It is for the jury to say whether the specification is intelligible (*m*) or not, and it is for the Court to direct the jury as to the class of persons to whom it must be intelligible (*n*).

It is for the jury to say whether the specification is sufficient or not, that is, whether it contains a sufficient description of the invention; but it is for the Court to inform the jury the degree of sufficiency which the law requires in specifications (*o*).

The novelty of the invention is a question for the jury. Questions of prior user or prior publication are always questions of fact, and it is for the jury to compare what has been done before and what is set up as being now, and to say whether or not they are identical. And so any document which is said to amount to prior publication must be construed by the Court, but it is for the jury to compare it with the specification and to say whether the described matter is the same or not (*p*).

The utility of the invention is also for the jury, subject to the directions of the Court as to the degree of utility which the law requires for the purpose of supporting the validity of a patent (*q*).

The question of infringement is for the jury. In *De la Rue* v.

(*m*) *Ante*, pp. 93, 99, *et seq.*

(*n*) *Ante*, p. 99, *et seq.*

(*o*) *Hill* v. *Thompson*, 1 Web. P.C. 235; *Bickford* v. *Skewes*, 1 Q. B. 938; *Neilson* v. *Harford*, 1 Web. P. C. 295; *Walton* v. *Bateman*, 1 Web. P. C. 621; *Beard* v. *Egerton*, 19 L. J., C. P. 38; *Wallington* v. *Dale*, 7 Ex. 888; *Parkes* v. *Stevens*, L. R., 8 Eq. 358; L. R., 5 Ch. 36.

(*p*) *Cornish* v. *Keene*, 1 Web. P. C. 519; *Elliott* v. *Aston*, 1 Web. P. C. 222; *Muntz* v. *Foster*, 2 Web. P. C. 107; *Spencer* v. *Jack*, 11 L. T., N. S. 242; also cases quoted *ante*, p. 96.

(*q*) *Hill* v. *Thompson*, 1 Web. P. C. 237; *Bloxam* v. *Elsee*, 1 C. & P. 565; *Cornish* v. *Keene*, 1 Web. P. C. 506; *Morgan* v. *Seaward*, 1 Web. P. C. 186; *Macnamara* v. *Hulse*, C. & M. 471.

Dickenson (*r*), Campbell, C.J., said :—"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. But, if the evidence has a tendency to show that the defendant has used substantially the same means to obtain the same result as specified by the plaintiff, and scientific witnesses have sworn that the defendant actually has used such means, the question becomes one of fact, mixed with law, which the judge is bound to submit to the jury."

In *Seed* v. *Higgins* (*s*), Lord Chelmsford in the House of Lords said :—"What the defendant had done in any case was of course a question of fact, but whether, on proof of certain acts having been done by a defendant, the plaintiff had any case to go to a jury, was a question for the judge" (*t*).

CERTIFICATES.

SECT. 31 of the Patents, &c., Act, 1883, is as follows :—"*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.*"

Similar provisions were contained in 5 & 6 Will. IV. c. 83, and also in the 43rd section of the Patent Law Amendment Act, 1883.

The object of these sections is to prevent patentees of important inventions being ruined by successive actions, which they are bound to bring to restrain infringements, manufacturers banding themselves together to defeat a patentee's rights in this manner.

(*r*) 7 E. & B., at p. 755.
(*s*) 30 L. J., Q. B., at p. 317.
(*t*) See also *Walton* v. *Potter*, 1 Web. P. C. 586; *Macnamara* v. *Hulse*, Car. & M. 471; *Newton* v. *Grand Junction Rail. Co.*, 5 Ex. 331; *Stevens* v. *Keating*, 2 Web. P. C. 101; *Sellers* v. *Dickinson*, 5 Ex. 323; *Curtis* v. *Platt*, 35 L. J., Ch. 852.

The Act of William IV. cited above gave the patentee a right to treble costs, but this was taken away by 5 & 6 Vict. c. 97, which gave him full costs; and now, as we have seen, costs as between solicitor and client are substituted for full costs.

To acquire the protection of the 31st section a certificate is requisite, and this should be applied for at the trial of the action, and the application must be made to the Court or judge who have tried the cause (*u*).

The Court has no power to order full costs upon the first trial in which the validity of the patent came in question, the words of the statute being "in any subsequent action for infringement" (*x*).

When a certificate of validity has once been granted, the Court will not grant another in a subsequent action upon the same patent (*a*).

An action was compromised at the trial by a verdict being entered for the plaintiff in the action for 40*s.* damages and costs, with all usual certificates. Subsequently, upon an *ex parte* application, the judge endorsed on the record a certificate that the record in a certain action, wherein Bovill was plaintiff and Keyworth was defendant, and the certificate thereon endorsed was given in evidence at the trial of this action (*Bovill* v. *Hadley*), it was held that this certificate was improperly granted, the record and certificate in the former action not having been given in evidence, and it not being under the circumstances a "usual certificate" within the contemplation of the parties (*b*). Upon the trial of the second action the record of the first action with the endorsement must be produced, but not before the verdict, in such a manner as to prejudice the second trial (*c*).

It does not appear clear whether or not a certificate might be granted in an action to restrain threats, that the validity of the patent came in question. This point arose in *Crampton* v. *The Patents Investments Co.* (*d*), which was an action under section 32.

(*u*) *Gillett* v. *Green*, 7 M. & W. 347.

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

(*a*) *Edison* v. *Holland*, 6 P. O. R. 243.

(*b*) *Bovill* v. *Hadley*, 17 C. B., N. S. 435.

(*c*) *Newall* v. *Wilkins*, 17 L. T. 20.

(*d*) 5 P. O. R. 382.

In that case it was held that the defendant's patent was valid, and had been infringed; application was made by the counsel for the defendant for a certificate under section 31, Field, J., said: "I entertain great doubt whether I have jurisdiction, and I think the safer course will be for me to give a certificate without prejudice to the validity of it, if it should come into operation (*e*).

In obtaining this certificate the plaintiff and the country are the parties, not the defendant, and the judge is bound to protect the interests of the country and to see that the certificate is not given when the validity of the patent has not, in fact, been proved to the satisfaction of the Court; otherwise, there is nothing to prevent collusive actions being merely brought for the purpose of obtaining this valuable privilege—a privilege which can be used as an enormous lever, preventing persons from incurring the risk of a conflict with the patentee (*f*).

Of late years it would seem that these certificates have been granted somewhat too easily, having regard to the importance of the consequences indicated above.

In *Haydock* v. *Bradbury* (*g*) the validity of the patent was put in issue by the defence, but the defendant not appearing at the trial, the validity of the patent was not seriously contested. Judgment was given for the plaintiff and a certificate of validity granted.

In *The Delta Metal Co.* v. *Maxim Nordenfelt Co.* (*h*), after the trial had been in progress for some days, the parties agreed to a compromise in the following terms: "Judgment for plaintiff on validity of patent. Plaintiffs to be at liberty to ask the judge for a certificate. Judgment for defendants on infringement. Plaintiffs to pay 300*l.* towards the defendants' costs. No other action to be brought on plaintiffs' patent against defendants or their customers."

Judgment was given upon the terms of the compromise. In answer to an application of plaintiffs' counsel for a certificate of validity, Collins, J., said: "I am not asked to pronounce any

(*e*) At p. 404.

(*f*) *Stocker* v. *Rodgers*, 1 C. & K. 99; see also *Peroni* v. *Hudson*, 1 P. O. R. 261.

(*g*) 4 P. O. R. 74; also *United Phonograph Co.* v. *Young*, 11 P. O. R. 492.

(*h*) 8 P. O. R. 248.

opinion, and I do not pronounce any opinion. It has unquestionably been brought in question, and you have arranged between yourselves how it is to be decided. You will hand the terms in —I do not do anything. I simply give judgment in accordance with the terms of your consent, that is all." Certificate granted.

In neither of the above cases was the validity of the patent put to the test, and it must be surmised that the certificates were granted in those cases owing to the fact that the judgment of Erle, J., in *Stocker* v. *Rogers*, referred to above, was not brought under the notice of the judge, owing, in the one case to the absence of, and in the other to the acquiescence by the defendant, and in consequence the *ratio decidendi* of that judgment was not properly taken into consideration by the Court.

In the first of the two cases (*Haydock* v. *Bradbury*), Kekewich, J., said: "Unless there is some authority to the contrary, I do not see why you should not have a certificate where the defendant retires from the contest." The counsel for the plaintiff intimated that he did not know of any authority on the point, and a certificate was accordingly granted.

On the authority of the decision in *Haydock* v. *Bradbury*, a certificate of validity was granted in *The United Phonograph Co.* v. *Young* (*i*), in which the circumstances were precisely similar.

The case of *The Delta Metal Co.* v. *The Maxim Nordenfelt Co.* (*supra*), seems to fall exactly within the evil contemplated by Erle, J., and which he considered it to be so important to avoid.

No appeal will lie from a granting or refusing to grant a certificate that the validity of the patent came in question; such appeal not being from a judgment or order within sect. 19 of the Judicature Act (*k*).

"In any subsequent action for infringement:" A certificate of validity granted in one action will not affect the costs in another, although decided at a later date, provided that the latter proceedings were instituted before the grant of the certificate in the earlier action (*l*).

(*i*) 11 P. O. R. 492.

(*k*) *Haslam* v. *Hall*, L. R., 20 Q. B. D. 491; 5 P. O. R. 144.

(*l*) *The Automatic Weighing Machine Co.* v. *The International Hygienic Soc.*, 6 P. O. R., at p. 480; see also *Penn* v. *Fernie*, L. R., 3 Eq. 808.

It does not appear to be quite clearly settled whether or not solicitor and client costs will be allowed in the second action when the validity of the patent is not put in issue. In *The Automatic Weighing Machine Co.* v. *The International Hygienic Society* (*m*), Charles, J., expressed an opinion that sect. 31 did not apply if the validity of the patent was not disputed in the subsequent action; and in *Otto* v. *Steel* (*n*), solicitor and client costs were refused on the ground that the validity of the patent was disputed upon different grounds to those which were relied upon in the earlier action.

In *The United Telephone Co.* v. *Townsend* (*o*), the validity of the patent was not put in issue, a certificate had been granted in an earlier action, Bacon, V.-C., said: "The policy of the Act is, that if a patentee is put to the trouble of bringing an action after he has established his right, the infringer shall pay solicitor and client costs; and that must be the order here."

And in *The United Telephone Co.* v. *Patterson* (*p*), Chitty, J., said: "The mere fact of the validity of the patent not being called in question in a subsequent action for infringement is no ground, by itself, for the judge exercising his discretion in favour of the defendant."

"**Unless the Court or judge trying the action certifies that he ought not to have the same.**" This clause gives unlimited discretion to the judge, a discretion which is exercised in view of the facts of each particular case; so where the second action was vexatious (*q*), or where litigation was the natural consequence of the vague and lax manner in which the specification had been drawn up (*r*), costs as between solicitor and client were refused (*s*). The burden is on the defendant to show cause why he should not pay solicitor and client costs under this section (*t*).

(*m*) Ibid.

(*n*) 3 P. O. R. 120; but note *The Automatic Weighing Machine Co.* v. *Fearby*, 10 P. O. R. 442.

(*o*) 3 P. O. R. 10; see also *United Telephone Co.* v. *St. George*, 3 P. O. R. 321.

(*p*) 6 P. O. R. 142.

(*q*) *Proctor* v. *Sutton*, 5 P. O. R. 134.

(*r*) *Automatic Weighing Machine Co.* v. *National Exhibitions Association*, 8 P. O. R. 352.

(*s*) See also *Boyd* v. *The Tootal Broadhurst Lee Co.*, 11 P. O. R., at p. 185.

(*t*) *United Telephone Co.* v. *Patterson*, 6 P. O. R. 142; see also *United Telephone Co.* v. *St. George*, 3 P. O. R at p. 339.

Sect. 29 of the Act of 1883, after providing for the delivery of particulars of breaches and objections, enacts:—"(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.*"

Where the plaintiff is successful on some issues, and the defendant on some, the costs should be apportioned (*u*). In *Badische Anilin Fabrik* v. *Levinstein* (*x*), in the Court of Appeal, Bowen, L.J., said: "I am of opinion in this case that the plaintiffs should have the costs occasioned by the issues raised by the particulars of breaches, and that in respect of all the other costs the costs in the action should follow the usual result, and be awarded to the successful party. 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 the 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 with regard to their own interest, and may help them in the conduct of the action, that they should raise issues in which, in the end, they are defeated, but the defendant who does so does it in his own interest, and I think he ought to do it at his own expense. The order, therefore, I think ought to be as I have stated."

Costs will be apportioned both where the patent is held to be invalid and the acts alleged to be infringements proved (*y*), and where the plaintiff fails on the issue of infringement, and suc-

(*u*) *Wegmann* v. *Corcoran*, 27 W. R. 357; *Pooley* v. *Pointon*, 2 P. O. R. at p. 173; *Nordenfelt* v. *Gardner*, 1 P. O. R., at p. 75.

(*x*) L. R., 29 Ch. D., at p. 418; 2 P. O. R., at p. 118.

(*y*) Ibid. See also *Young* v. *Rosenthall*, 1 P. O. R. 41; *Phillips* v. *Irel Cycle Co.*, 7 P. O. R., at p. 85; *Binnington* v. *Hill*, 8 P. O. R., at p. 332; *Cassel Gold Extracting Co.* v. *Cyanide Gold Recovery Syn.*, 11 P. O. R., at p. 653; but note *United Telephone Co.* v. *Harrison*, L. R., 21 Ch. D. 720, 747; and *Blakey* v. *Latham*, 6 P. O. R. 29, 38; also in C. A., 6 P. O. R. 184, 190.

ceeds in upholding his patent (*z*), but in each of these cases the issues must be perfectly distinct (*a*).

Where the act of infringement was admitted before the trial, the plaintiffs were not allowed any costs on that issue, their patent being held to be invalid (*b*).

Where the plaintiffs brought an action for infringement of two patents, but abandoned their case as to one of them at the trial of the action, it was held that the plaintiffs should pay all costs incurred by the defendants so far as occasioned by the claim to the patent so abandoned, although successful in the remainder of their action (*c*).

The certificates granted under this section must not be confused with the certificate under sect. 31. The object of sect. 29 is to provide what costs shall be payable in the action itself, and the object of sect. 31 is to provide for the costs of future actions.

Care must be taken at the trial to ask the Judge to certify as to each particular breach mentioned in the particulars of breaches, and as to each particular objection; and no costs of witnesses, or of, and incidental to, such breach or objection, as is not specially certified for, will be allowed (*d*).

Omission to ask the Judge at the trial for his certificate does not preclude the successful party from obtaining it, provided he makes his application within a reasonable time (*e*).

If an action is not tried out, it is obvious that a difficulty may arise as to costs, since the parties have had no opportunity to prove or disprove their particulars. In *Greaves* v. *The Eastern Counties Railway Co.* (*f*), it was held that where the defendant

(*z*) *Twcedale* v. *Ashcorth*, 7 P. O. R., at p. 435; *Nobel's Explosives Co.* v. *Anderson*, 11 P. O. R., at p. 128; but note *The Automatic Weighing Machine Co.* v. *The Combined Weighing Machine Co.*, 6 P. O. R. 367.

(*a*) *Guilbert-Martin* v. *Kerr*, 4 P. O. R. 18; *Kaye* v. *Chubb*, 4 P. O. R., at p. 300; *Ellington* v. *Clark*, 5 P. O. R. 328; *Parkinson* v. *Simon*, 11 P. O. R. 238, 256.

(*b*) *Westley Richards* v. *Perkes*, 10 P. O. R., at p. 194.

(*c*) *Hocking* v. *Fraser*, 3 P. O. R. 8; see also *Edison* v. *Woodhouse*, 3 P. O. R. 167, 178.

(*d*) *Honiball* v. *Bloomer*, 10 Exch. 538; see also *Losh* v. *Hague*, 5 M. & W. 387; *Parnell* v. *Mort, Liddell & Co.*, L. R., 29 Ch. D. 325; *Longbottom* v. *Shaw*, 6 P. O. R. 510.

(*e*) *Rowcliffe* v. *Morris*, 3 P. O. R. 145.

(*f*) 1 E. & E. 961; *Batley* v. *Ky-*

had delivered particulars of objections, and just before trial the plaintiff had abandoned his action, thus giving the defendant no opportunity of proving or disproving his objections, the defendant was entitled to the costs of the objections and of the witnesses, for the act did not apply, except where the cause came on for trial.

But where the action came on for hearing, and the case breaks down before all the particulars have been tried out, the Court will not go through all those particulars with a view to ascertain whether they are reasonable and proper and can be substantiated, and a certificate will only be granted with respect to those particulars upon which the action was decided (*g*).

The reason of this distinction is that in the first case, that is, when the plaintiff abandons his action before trial, he thereby admits the substantial nature of the objections taken to his patent by the defendant; but in the second case, that is, where judgment is given upon some particular point without the necessity of considering any of the other objections relied on by the defendant, it does not at all follow that the other particulars were proper and could be substantiated, as there is neither judgment of the Court nor admission by the plaintiff to that effect.

No mention is made in sect. 29 to a petition for revocation, so probably in such case the provisions of that section will be held not to apply (*h*).

No costs were allowed a defendant who was successful by reason of anticipations only put in by amendment of his particulars of objections at the trial of the action (*i*).

We have seen that since the Judicature Acts, the Common Law Division and the Chancery Division can either of them grant full relief in an action for the infringement of a patent, granting both an injunction and damages, or an account. In olden times the Common Law Courts merely inquired into damages, and if

noch, L. R., 20 Eq. 632; *Peroni* v. *Hudson*, 1 P. O. R. 261; *Willougby* v. *Taylor*, 11 P. O. R. 45, 55.

(*g*) *Longbottom* v. *Shaw*, 5 P. O. R. 497, 502; 6 P. O. R. 143, 147; *Boyd* v. *Horrocks*, 6 P. O. R. 152, 162; *Garrard* v. *Edge*, 6 P. O. R., 372, 563; 7 P. O. R. 139.

(*h*) *Gaulard* v. *Gibbs' Patent*, 5 P. O. R. 525, 537.

(*i*) *Allen* v. *Horton*, 10 P. O. R. 412.

less than 40s. was recovered a question arose as to whether or not County Court costs should not alone be allowed; but now in every patent case an injunction may be granted, and this removes the case from the operation of 30 & 31 Vict. c. 142, s. 5.

The Rules of the Supreme Court, 1883, provide for cases where the **higher scale and lower scale of costs** are to be allowed; and in future, notwithstanding that an injunction is granted, it will be necessary to ask the judge at the trial to certify for costs on the higher scale.

Order LXV. r. 8, provides: "In causes and matters commenced after these rules come into operation, solicitors shall be entitled to charge and be allowed the fees set forth in the column headed 'lower scale,' in Appendix N. in all causes and matters, and no higher fees shall be allowed in any case, except such as are by this order otherwise provided for; and in causes and matters pending at the time when these rules come into operation, to which the higher scale of costs previously in force was applicable, the same scale shall continue to be applied."

Rule 9.—"The fees set forth in the column headed 'higher scale' in Appendix N. 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 every 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 made upon such special grounds as aforesaid."

Costs on the higher scale are only allowed in cases of exceptional difficulty, where a special class of witnesses was necessary for making clear the points at issue (*k*).

(*k*) *Ellington* v. *Clark*, 5 P. O. R. 319, 328; *The Automatic Weighing Machine Co.* v. *The Combined Co.*, 6 P. O. R. 367, 372; *Farbenfabriken Vorm F. Bayer & Co.* v. *Bowker*, 8 P. O. R. 389, 397; *Hopkinson* v. *St. James' Electric Light Co.*, 10 P. O. R. 46, 62.

In *Gadd* v. *The Mayor, &c., of Manchester* (*l*), Lindley, L.J., said: "I think costs on the higher scale ought only to be given where there are cases of very unusual difficulty and skill—antiquarian research and things of that kind. The idea of giving costs on the higher scale in all patent cases is one that I will not sanction."

The Courts have of late been very reluctant to order costs on the higher scale (*m*).

In *The Wenham Gas Co.* v. *The Champion Gas Co.* (*n*), costs on the higher scale were refused on the ground that the necessity for scientific evidence was largely due to the unfortunate wording of the specification.

Sect. 49 of the Judicature Act, 1873, provides that there shall be no appeal as to costs; but this was held not to apply where the costs were a matter of right, and not discretionary (*o*). Under the Rules of Court, which were in operation prior to the 24th October, 1883, the question of higher or lower scale was a matter of right (*p*). Hence, in *Re Terrell* (*q*), the Court of Appeal hold that there was an appeal, but now it will be observed that the order is in the absolute discretion of the judge, and, therefore, it is submitted there is no appeal.

The directors of a limited company, whose servants have infringed a patent, may be ordered to pay costs personally.

In *Spencer* v. *The Ancoats Vale Co.* (*r*), it was ordered that costs on the higher scale should be paid by the defendant company, and by the directors in the event of the company not paying.

Judgment having been recovered, minutes of judgment should be prepared. The minutes will be in accordance with one or other of the precedents given hereafter. We have drawn attention in previous pages to those points which should be attended to in preparing these minutes. Care should be exercised

(*l*) 9 P. O. R. 516, 535.

(*m*) Ibid. Also *Edison Bell Phonograph Co.* v. *Smith & Young*, 11 P. O. R. 148, 160; *Parkinson* v. *Simon*, 11 P. O. R. 238, 256.

(*n*) 8 P. O. R., at p. 320.

(*o*) *Turner* v. *Hancock*, C. A., L. R., 20 Ch. D. 303.

(*p*) Rules of S. C., 1875.

(*q*) L. R., 22 Ch. D. 473.

(*r*) 6 P. O. R. 46; see also *Betts* v. *De Vitre*, L. R., 3 Ch. 429

when an account is directed to be taken that provision be made for the **payment of costs to the plaintiff up to and including the hearing**, otherwise the payment of all costs will be delayed until the final account has been taken, which in some cases has been known to amount to a delay of years.

A stay will be put upon a judgment pending appeal when the matter at issue is of great importance, and when in the event of the judgment being reversed great injury would otherwise be incurred by the defendant, but in such cases the defendant is ordered to keep an account, and to bring his appeal without delay (*s*).

PRACTICE ON APPEAL.

UNDER Order LVIII. rule 4, the Court of Appeal has all the powers and duties as to amendment and otherwise of the High Court, together with full discretionary power to receive further evidence upon questions of fact, such evidence to be either by oral examination in Court, by affidavit, or by deposition taken before an examiner or commissioner. Such further evidence may be given without special leave upon interlocutory application, or in any case as to matters which have occurred after the date of the decision from which the appeal is brought. 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.

As to further evidence in *Hinde* v. *Osborne* (*t*), Lindley, L.J., said: "The power given to the Court of Appeal to hear fresh evidence is an extremely valuable one, and is given by Order LVIII. r. 4. I cannot 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

(*s*) *The North British Rubber Co.* v. *Macintosh*, 11 P. O. R. 477, 489; see also *Hocking* v. *Fraser*, 3 P. O. R. 7; *Kaye* v. *Chubb*, 4 P. O. R. 27; *Proctor* v. *Bennis*, 4 P. O. R. 363; *Lyon* v. *Goddard*, 10 P. O. R. 135. For form of order see *Lyon* v. *Goddard*, 10 P. O. R., at p. 136.

(*t*) 2 P. O. R., at p. 47; instances where fresh evidence was allowed on appeal, *Britain* v. *Hirsch*, 5 P. O. R. 226; *Spencer* v. *Ancoats Rubber Co.*, 6 P. O. R. 46; *Blakey* v. *Latham*, 6 P. O. R., at p. 186.

get more evidence, which, if he had got it before, would have enabled him to succeed on the trial. That cannot be. 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, therefore, 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 defects which have been disclosed upon the first trial."

As to amendment of pleadings and particulars, in *Cropper* v. *Smith*, Bowen, L.J., said (*u*) :—"Now, I think it is a well established principle that the object of Courts is to decide the rights of the parties, and not to punish them for mistakes they make in the conduct of their cases by deciding otherwise than in accordance with their rights. Speaking for myself, and in conformity with what I have heard laid down by the other division of the Court of Appeal, and by myself as a member of it, I know of no kind of error or mistake which, if not fraudulent or intended to overreach, the Court ought not to correct, if it can be done without injustice to the other party. Courts do not exist for the sake of discipline, but for the sake of deciding matters in controversy, and I do not regard such amendment as a matter of favour or of grace."

On appeal to the House of Lords it was held in a case where the Court of Appeal had held the specification bad and for the defendant on the infringement issue, but the House had reversed the decision on the specification and upheld it on the infringement issue, that each party must pay their own costs of the appeal (*x*).

(*u*) L. R., 26 Ch. D. 710; instance when amendment was allowed, *Pirrie* v. *York Street Spinning Company*, 11 P. O. R., at p. 431.

(*x*) *Moore* v. *Bennett*, 1 P. O. R., at p. 148; Griff. P. C. at p. 161; see also as to costs on reversal of decision of C. A. by House of Lords, *The United Horsenail Co.* v. *Stewart*, 5 P. O. R. 260, 269.

APPENDIX A.

STATUTES.

I.—STATUTE OF MONOPOLIES (1623).

[21 Jac. I. c. 3.]

An Act concerning Monopolies and Dispensations of Penal Laws and the Forfeitures thereof.

For as much 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 1610, publish in print to the whole realm, and to all posterity, that all grants and monopolies and of the benefit of any penal laws, or of power to dispense with the law, or to compound for the forfeiture, are contrary to your Majesty's laws, which your Majesty's declaration is truly consonant, and agreeable to the ancient and fundamental laws of this your realm. 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 of the like in time to come, be it enacted, 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 tole-

All monopolies, &c., shall be void.

ration 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 no wise to be put in use or execution.

Monopolies, &c., shall be tried by the common laws of this realm.

2. That all monopolies, and all such commissions, grants, licences, 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.

All persons disabled to use monopolies, &c.

3. 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, use, 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.

The party grieved by *pretext of a* monopoly, &c., shall recover treble damages and double costs.

4. 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, or 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, licence, power, liberty, faculty, letters patent, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, and will sue to be relieved in or for any of the premises, that then and in every such case the same person and 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 and 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, distrained, taken, carried away, or detained; wherein all and every such person and persons which shall be so hindered, grieved, disturbed, or disquieted, or whose goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained, shall recover three times so much as the damages which he or they sustained by means or occasion of being so hindered, grieved, disturbed or disquieted, or by means of having his or their goods or chattels seized, attached, distrained, taken, carried away, or detained, and double costs: and in such suits or for the staying or delaying thereof, no essoign, 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 action 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 order, warrant, power, or authority, save only by writ of error or attaint; and 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.

What new patents to be good.

6. Provided also, that any declaration before mentioned shall not extend to any letters patent and grants of privilege for the term of fourteen years or under, hereafter to be made, of the sole working or making of any manner of new manufactures within this realm to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patent and grants shall not use, so as also they be not

contrary to the law nor mischievous to the State by raising prices of commodities at home, or hurt of trade, or generally inconvenient: the said fourteen years to be accounted from the date of the first letters patents 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.

Proviso. 7. Provided also, that this Act or anything therein contained shall not in anywise extend or be prejudicial to any grant or privilege, power, or authority whatsoever heretofore made, granted, allowed, or confirmed by any Act of Parliament now in force, so long as the same shall so continue in force.

Warrants granted to justices saved. 8. Provided also, that this Act shall not extend to any warrant or privy seal made or directed, or to be made or directed, by His Majesty, his heirs or successors, to the justices of the Courts of the King's Bench or Common Pleas and barons of the Exchequer, justices of assize, justices of oyer and terminer and gaol delivery, justices of the peace, and other justices for the time being, having power to hear and determine offences done against any penal statute, to compound for the forfeitures of 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, that this Act or anything therein contained shall not in anywise 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 made or granted, or for or concerning any custom or customs used by or within them or any of them; or unto any corporation, 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 or 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; anything before in this Act contained to the contrary in any wise notwithstanding.

II.—PATENTS, DESIGNS AND TRADE MARKS ACTS, 1883—88, CONSOLIDATED.

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.

48 & 49 Vict. c. 63.—An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

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.

51 & 52 Vict. c. 50.—An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

NOTE.—The general text of the Act of 1883 is adhered to. The repealed parts are printed in italics, and the additions in heavier type. The amending Act and section are quoted in the margin.

Be it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords, spiritual and temporal, and Commons, in the present Parliament assembled, and by the authority of the same, as follows :—

PART I.—PRELIMINARY.

1. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1883. Short title.

2. This Act is divided into parts, as follows :— Division of Act into parts.

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

3. This Act, except where it is otherwise expressed, shall Commencement of Act.

commence from and immediately after the 31st day of December, 1883.

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 [p. 8].

Joint application.

(2) Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly [p. 9].

Act, 1885, *s.* 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 [p. 9].

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 (*a*).

Declaration.

(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.

Act, 1885, *s.* 2.

The declaration may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed (*b*).

Provisional specification.

(3) A provisional specification must describe the nature of the invention, and be accompanied by drawings, if required (*c*).

Complete specification.

(4) A complete specification, whether left on application or subsequently, must particularly describe and ascertain the

(*a*) See Chapter VIII.; as to documents accompanying an application, see P. R. 1890, rr. 8—10; as to application under international arrangements, see P. R. 1890, rr. 24—29; and generally P. R. 1890, rr. 18—28.

(*b*) See pp. 9, 127; as to statutory declarations, see P. R., 1890, rr. 17, 17A.

(*c*) pp. 83—90; as to drawings, see p. 124, and P. R., 1890, rr. 30—33.

nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required [pp. 90, 124].

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 (*d*). The same drawings may accompany both specifications. *Act*, 1888, s. 2.

(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 [pp. 78, 116].

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 [p. 128]. Reference of application to examiner.

[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.* Power for comptroller to refuse application or require amendment. Repealed *Act*, 1888, s. 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*

(*d*) See P. R., 1890, r. 33.

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.*]

Power of comptroller to refuse application or require amendment. *Act*, 1888, s. 2.

7.—(1) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject matter of the invention, the comptroller may 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 [pp. 129, 152].

(2) When the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer (*e*).

(3) The law officer shall, if required, hear the applicant and 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.

(*e*) See Law Officers' Rules.

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 [p. 131]. Time for leaving complete specification.

A complete specification may be left within such extended time, not exceeding one month after the said nine months, as the comptroller may on payment of the prescribed fee allow (*f*). *Act*, 1885, s. 3.

(2) Unless a complete specification is left within that time the application shall be deemed to be abandoned. When specification deemed abandoned.

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 [p. 131]. Comparison of provisional and complete 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. Power of comptroller to refuse until amended.

(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. Power of law officer.

(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. When specification void.

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. *Act*, 1885, s. 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 Reports of examiners to be private. *Act*, 1888, s. 3.

(*f*) See P. R., 1890, rr. 49—51.

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 [p. 132 (*g*)].

Opposition to grant of patent.

Time and grounds for.

11.—(1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or on the ground that the invention has been patented in this country on an application of prior date [*or on the ground of an examiner having reported to the comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title and accompanying a previous application*], or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification, but on no other ground (*h*).

Repealed *Act*, 1888, *s.* 4.

Act, 1888, *s.* 4.

After notice comptroller to decide.

(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 [p. 141].

Or on appeal, 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 [p. 141].

Who may obtain expert's assistance.

(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 [p. 142].

Sealing of patent.

12.—(1) If there is no opposition, or, in case of opposi-

When sealed.

(*g*) See P. R., 1890, rr. 21, 22.
(*h*) See Chapter IX., "Opposition," P. R., 1890, rr. 34—44.

tion, 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 [p. 143].

(2) A patent so sealed shall have the same effect as if it were sealed with the great seal of the united kingdom [p. 148]. Great seal abolished for patents.

(3) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of the application, except in the cases hereinafter mentioned, that is to say— Time for sealing. Exceptions to limit.

(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. (a) For legal proceedings.

(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. (b) When applicant dead.

A complete specification may be left and accepted within such extended times, not exceeding one month and three months respectively after the said nine months 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. Extension of time for sealing. *Act*, 1885, s. 3.

13. Every patent shall be dated and sealed as of the day of the application: provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification: provided also, that in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application [pp. 132, 143]. Date of patent.

When 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. Application abandoned, specification not to be published. *Act*, 1885, s. 4.

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 [pp. 19, 88, 182].

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 [pp. 90, 133].

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.

Ceases on failure of payments.

(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 (*i*).

Exception by application to comptroller.

(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.

Extension of time for payment upon terms.

(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) Period of extension.

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

(b) Damages for infringement in the interval.

(b) If any proceeding shall be taken in respect of an in-

(*i*) See P. R. 1890, rr. 45—48.

fringement 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 (*k*).

Advertisement of amendment and notice of opposition to be given.

(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 [p. 158].

Where notice given comptroller decides.

(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 [p. 159].

Appeal to law officer.

(4) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether and subject to what conditions, if any, the amendment ought to be allowed [p. 159].

Where no notice comptroller determines conditions of amendment.

(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 [p. 162].

(6) When leave to amend is refused by the comptroller, the person making the request may appeal from his decision to the law officer [p. 162].

Appeal to 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 [p. 163].

(*k*) See Chapter XI., also P. R., 1890, rr. 52—59.

No amendment allowed so as to enlarge or alter materially specification.

(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 [p. 168].

Leave conclusive except in case of fraud; amendment forms part of specification.

(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 [p. 166].

Repealed *Act*, 1888, *s.* 5.

(10) [*The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending.*]

Proceedings pending. *Act*, 1888, *s.* 5.

(10) The foregoing provisions of this section do not apply when and so long as any action for infringement or proceeding for revocation of a patent is pending [p. 169].

Power to disclaim part of invention during action, &c.

19.—(1) In an action for infringement of a patent, and in a proceeding for revocation of a patent, the court or a judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the court or a judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed [p. 170].

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 [p. 172].

Advertisement of amendment.

21. Every amendment of a specification shall be advertised in the prescribed manner [p. 174].

Compulsory Licences.

Power for Board of Trade 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— [p. 181] (*l*)

(a) The patent is not being worked in the United Kingdom;

or

(*l*) See P. R., 1890, rr. 60—66.

(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. Where to be kept and contents.

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 [p. 185] (*m*).

Is evidence.

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

Copies for filing.

(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 payable.

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.

Power to reduce fees.

(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.

(*m*) See P. R., 1890, rr. 67—79.

Extension of Term of Patent.

Extension of term of patent on petition to Queen in council.

When applied for.

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 [pp. 195 *et seq.*].

Entry of caveat.

(2) Any person may enter a caveat, addressed to the registrar of the council at the council office, against the extension.

Privy Council jurisdiction.

(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.

Powers of judicial committee.

(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 [p. 197].

On their report extension granted on conditions.

(5) If the judicial committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for her Majesty in council to extend the term of the patent for a further term not exceeding seven, or in exceptional cases fourteen, years; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the judicial committee may think fit.

Power to make rules for such proceedings.

(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 [p. 196].

Costs.

(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.

Abolition of scire facias.

26.—(1) The proceeding by scire facias to repeal a patent is hereby abolished [pp. 266 *et seq.*]

(2) Revocation of a patent may be obtained on petition to the court. Revocation of patent.

(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. How revocation obtained. Grounds of revocation.

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

(a) The attorney-general in England or Ireland, or the lord advocate in Scotland: [p. 268].

(b) Any person authorised by the attorney-general in England or Ireland, or the lord advocate in Scotland: [p. 269].

(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: [pp. 268, 269].

(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 [p. 301]. Plaintiff must deliver and be bound by particulars.

(6) Particulars delivered may be from time to time amended by leave of the Court or a judge [p. 302]. Amendment of particulars.

(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 [p. 319]. Patentee though defendant has privileges of plaintiff at trial.

(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 Where patent revoked for fraud, first true inventor may obtain patent.

so granted shall cease on the expiration of the term for which the revoked patent was granted [p. 269].

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 [p. 151].

Exceptions.

(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 [p. 151].

Legal Proceedings.

Hearing with assessor.
By court.

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 [p. 314].

Court of appeal or privy council may sit with assessors.

(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.

Assessors' fees.

(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 of breaches;

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 [p. 286].

of objections.

(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 [pp. 293 *et seq.*].

(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 [p. 294]. Grounds must be stated.

(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 [pp. 290, 301]. Evidence must not go beyond particulars.

(5) Particulars delivered may be, from time to time, amended, by leave of the Court or a judge [p. 303]. Amendment.

(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 [pp. 333 *et seq.*]. Costs.

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 [p. 310]. 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 a 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 [pp. 328 *et seq.*]. Certificate that validity questioned.

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 Remedy in case of groundless threats of legal proceedings.

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 [pp. 274 *et seq.*].

Miscellaneous.

Patent for one invention only.

33. Every patent may be in the form in the first schedule to this Act, and shall be granted for one invention only, but may contain more than one claim ; but it shall not be competent for any person in any action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention [pp. 128, 216].

Patent on application of representative of deceased inventor.

34. (1) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to his legal representative [pp. 10, 176].

Time and contents of application.

(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 [p. 18].

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 [pp. 177, 210, 216].

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 [p. 142 (*n*)].

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,—[p. 68].

Exhibition at industrial or international exhibition not to prejudice patent rights.

(a) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice of his intention to do so; and

Conditions:
(a) Notice;

(b) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

(b) Patent must be applied for.

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 39 and 57 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 condition, 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.

Protection of patents and designs exhibited at international exhibitions. *Act*, 1886, *s.* 3.

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

Publication of illustrated journal, indexes, &c.

(*n*) See Law Officers' Rules.

any other information that the comptroller may deem generally useful or important.

Copies to be on sale.

(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.

Continuation of publication.

(3) The comptroller shall continue, in such form as he may deem expedient, the indexes and abridgements of specifications hitherto published, and shall from time to time prepare and publish such other indexes, abridgements 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 [p. 242].

Exception.

(2) But this section shall not extend to vessels of any foreign state of which the laws authorise 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

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 [pp. 151, 468].

War of certain inventions.

(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.

Extent of assignment.

(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.

Power of secretary of state for war to keep invention secret on certifying that it is in public interest to do so.

(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.

In which case specifications and documents are sealed up.

(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.

For term of patent.

(6) Such sealed packet shall be delivered at any time during the continuance of the patent to any person authorised 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.

Delivery of packet under secretary of state's authority during term.

At expiration.

(7) On the expiration of the term or extended term of the patent, such sealed packet shall be delivered to any person authorised by writing under the hand of the secretary of state to receive it.

Foregoing subsections to apply where patent applied for but specifications not published.

(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.

Where certified by secretary of state no petition for revocation.

(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 [p. 269].

No copy of any secret specifications to be made public.

(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.

Power of secretary of state to waive benefit of section.

(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.

Communication to secretary of state for war not to be deemed publication.

(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 authorised 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 applications made after the commencement of this Act.

(2) Every patent granted before the commencement of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licences [p. 208].

(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 [p. 208].

Documents left at great seal Patent Office deemed left at Patent Office on commencement of this Act.

(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;" "Invention;" "Injunction" in Scotland.

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: [p. 7].

"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 [p. 26].

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 designs 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 ispection except by the proprietor, or a person authorised in writing by the proprietor, or a person authorised 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.

Act, 1888, s. 6.

"Provided that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered."

(2) 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 authorised 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.

Act, 1886, s. 3.

And whereas it is expedient to provide for the extension of this section to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows:—

It shall be lawful for Her Majesty, by Order in Council, from time to time to declare that sections 39 and 57 of the

Patents, Designs, and Trade Marks Act, 1883, or either of those sections shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions specified in the said sections of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to Her Majesty in Council may seem fit.

Legal Proceedings.

58. During the existence of copyright in any design— Penalty on piracy of registered design. *Act*, 1883, s. 7.

(a) It shall not be lawful for any person without the licence or written consent of the registered proprietor to apply, or cause to be applied, such design or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale to any article of manufacture or to any substance artificial or natural, or partly artificial and partly natural; and

(b) It shall not be lawful for any person to publish or expose for sale any article of manufacture or any substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor.

Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract debt by action in any court of competent jurisdiction: Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds. *Act*, 1883, s. 7.

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 Action for damages.

applied, such person knowing that the proprietor had not given his consent to such application.

Definitions.

Definition of "design," "copyright."

60. In and for the purposes of this Act—

"Design" means any design applicable to any article of manufacture, or to any substance artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for a sculpture, or other thing within the protection of the Sculpture Copyright Act of the year 1814 (fifty-fourth George the Third, chapter fifty-six).

"Copyright" means the exclusive right to apply a design to any article of manufacture or to any such substance as aforesaid in the class or classes in which the design is registered.

Definition of proprietor.

61. The author of any new and original design shall be considered the proprietor thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor, and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person or otherwise, and also every person on whom the property in such design or such right to the application thereof shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been so acquired, and to that extent, but not otherwise.

PART IV.—Trade Marks.

Registration of Trade Marks.

Application for registration.

62.—(1) The comptroller may, on application by or on behalf of any person claiming to be the proprietor of a trade mark, register the trade mark.

(2) The application must be made in the form set forth in the first schedule to this Act, or in such other form as may

be from time to time prescribed, and must be left at, or sent by post to, [*the Patent Office in the prescribed manner*] such place and in such manner as may be prescribed. *Act*, 1888, s. 8.

(3) The application must be accompanied by the prescribed number of representations of the trade mark, and must state the particular goods or classes of goods in connection 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.

"(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." *Act*, 1888, s. 8.

Limit of time for proceeding with application.

63. Where registration of a trade mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant [*the application shall be deemed to be abandoned*], "the comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned." *Act*, 1888, s. 9.

Conditions of registration of trade mark.

[64.—(1) *For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:*

(a) *A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or*

(b) *A written signature or copy of a written signature of the* Repealed. *Act*, 1888, s. 10.

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.*]

Act, 1888, *s.* 10

"**64.**—(1) For the purposes of this Act a trade mark must consist of or contain at least one of the following essential particulars:

"(a) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

"(b) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or

"(c) A distinctive device, mark, brand, heading, label, or ticket; or

"(d) An invented word or invented words; or

"(e) A word or words having no reference to the character or quality of the goods, and not being a geographical name.

"(2) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

"(3) Provided as follows:

"(i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof;

"(ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade mark before the thirteenth day of August, one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act."

Connexion of trade mark with goods.

65. A trade mark must be registered for particular goods or classes of goods.

Registration of a series of marks.

66. When a person claiming to be the proprietor of several trade marks which, while resembling each other in the material particulars thereof, yet differ in respect of (a) the statement of the goods for which they are respectively used or proposed to be used, or (b) statements of numbers, or (c) statements of price, or (d) statements of quality, or (e) statements of names of places, seeks to register such trade marks, they may be registered as a series in one registration. A series of trade marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade marks composing a series shall be deemed and treated as registered separately.

Trade marks may be registered in any colour. *Act*, 1888 s. 11.

67. A trade mark may be registered in any colour or colours, and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour or colours.

Advertisement of application. *Act*, 1888, s. 12.

68. Every application for registration of a trade mark under this part of this Act shall as soon as may be after its receipt be advertised by the comptroller, unless the comptroller refuse to entertain the application.

Opposition to registration. *Act*, 1888, s. 13, sub-ss. 1, 2.

69.—(1) Any person may within [*two months*] one month or such further time, not exceeding three months as the comptroller may allow, of the [*first*] advertisement of the application, give notice in duplicate at the patent office of opposition to registration of the trade mark, and the comptroller shall send one copy of such notice to the applicant.

Act, 1888, s. 13, sub-s. 3.

(2) Within [*two months*] one month after receipt of such notice or such further time as the comptroller may allow, the applicant may send to the comptroller a counter-statement in duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

Repealed. *Act*, 1888, s. 13, sub-s. 4.

[(3) *If the applicant sends such counter-statement, the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall require him to give security in such*

manner and to such amount as the comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made, or such further time as the comptroller may allow, the opposition shall be deemed to be withdrawn.

(4) *If the person who gave notice of opposition duly gives such security as aforesaid, the comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court.*]

Act, 1888, s. 13, *sub-s.* 4.

"(3) If the applicant sends such counter-statement the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.

"(4) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court, and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.

"(5) If the applicant abandons his application after notice of opposition in pursuance of this section he shall be liable to pay to the opponent such costs in respect of the opposition as the comptroller may determine to be reasonable.

"(6) Where the opponent is out of the United Kingdom he shall give the comptroller an address for service in the United Kingdom."

Assignment and transmission of trade mark.

70. A trade mark, when registered, shall be assigned and transmitted only in connection 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.

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. Restrictions on registration.

(2) **Except as aforesaid** the comptroller shall not register with respect to the same goods or description of goods a trade mark [*so nearly resembling*] **having such resemblance to a** trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive. *Act*, 1888, s. 14.

73. It shall not be lawful to register as part of or in combination with a trade mark any words the [*exclusive*] use of which would by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a court of justice, or any scandalous design. Further restriction on registration. *Act*, 1888, s. 15.

74.—(1) Nothing in this Act shall be construed to prevent the comptroller entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade mark— Saving for power to provide for entry on register of common marks as additions to trade marks.

(a) In the case of an application for registration of a trade mark used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures, though the same is common to the trade in the goods with respect to which the application is made ;

(b) In the case of an application for registration of a trade mark not used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made ;

[(2) *The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register.*] Repealed, *Act*, 1888, s. 16.

"(2) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, *Act*, 1888, s. 16.

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."

(3) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or were, before the thirteenth day of August one thousand eight hundred and seventy-five, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods.

Effect of Registration.

Registration equivalent to public use. *Act*, 1888, s. 17.

75. [*Registration of a trade mark shall be deemed to be equivalent to public use of the trade mark.*]

"Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been, the date of the registration."

Right of first proprietor to exclusive use of trade mark.

76. The registration of a person as proprietor of a trade mark shall be primâ facie evidence of his right to the exclusive use of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade mark subject to the provisions of this Act.

Restrictions on actions for infringement, and on defence to action in certain cases.

77. A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade mark unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the thirteenth of August one thousand eight hundred and seventy-five, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The comptroller may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused.

77 (a). "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."

Certificate to exclusive use, and costs thereon. *Act*, 1888, s. 18.

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.

Register of trade marks.

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.

Removal of trade mark after fourteen years unless fee paid.

(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 nonpayment 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 nonpayment of the fee or otherwise, such trade mark shall nevertheless for the purpose of any application for registration during [*the five years*] **one year** next after the date of such removal, be deemed to be a trade mark which is already registered, **"unless it is shown to the satisfaction of the comptroller that the nonpayment 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."**

Act, 1888, s. 19, *sub-s.* 1.

Act, 1888, s. 19, *sub-s.* 2.

Fees.

Fees for registration, &c.

80. There shall be paid in respect of applications and registration and other matters under this part of this Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the board of trade; and such fees shall be levied and paid to the account of Her Majesty's exchequer in such manner as the Treasury may from time to time direct.

Sheffield Marks.

Registration by Cutlers' Company of Sheffield marks.

81. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the County of York (in this Act called the Cutlers' Company) and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers and assistants of that company, the following provisions shall have effect:

(1) The Cutlers' Company shall establish and keep at Sheffield a new register of trade marks (in this Act called the Sheffield register):

Repealed. *Act*, 1888, s. 20, *sub-s.* 1.

[(2) *The Cutlers' Company shall enter in the Sheffield register, in respect of cutlery, edge tools, or raw steel, and the goods mentioned in the next sub-section all the trade marks entered before the commencement of this Act in respect of cutlery, edge tools or raw steel and such goods in the register estab-*

lished 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.]

"(2) The Cutlers' Company shall enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade marks entered before the first day of January, One thousand eight hundred and eighty-nine in respect of metal goods either in the register established under the Trade Marks Registration Act, 1875, or in the register of trade marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January, One thousand eight hundred and eighty-four, but which have not been entered in either of the said other registers." *Act*, 1888, s. 20, *sub-s.* 1.

(3) An application for registration of a trade mark used [*on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge*] on metal goods shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company: *Act*, 1888, s. 20, *sub-s.* 2.

(4) Every application so made to the Cutlers' Company shall be notified to the comptroller in the prescribed manner, and unless the comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner:

(5) If the comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court:

(6) Upon the registration of a trade mark in the Sheffield register the Cutlers' Company shall give notice thereof to the comptroller, who shall thereupon enter the mark in the register of trade marks; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the comptroller on that day.

Repealed, *Act*, 1888, *s.* 20, *sub-s.* 3.

[(7) *The provisions of this Act, and of any general rules made under this Act, with respect to 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:*]

Act, 1888, *s.* 20, *sub-s* 3

(7) The provisions of this Act and of any general rules made under this Act with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade marks on metal goods by the Cutlers' Company, and to all matters relating thereto; and this Act and any such general rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutler's 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.

(8) Where the comptroller receives from any person not carrying on business in Hallamshire or within six miles

thereof an application for registration of a trade mark used [*on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge*], on metal goods, he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company : *Act*, 1888, s. 20, sub-s. 2.

(9) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' register of corporate trade marks, and thereupon all marks entered therein shall, unless entered in the Sheffield register, be deemed to have been abandoned :

(10) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of two or more trade marks :

(11) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of a trade mark or trade marks :

(12) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the comptroller, who shall have power to confirm, reverse, or modify the decision, but the decision of the comptroller shall be subject to a further appeal to the Court :

(13) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Company's Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield register.

(14) For the purposes of this section the expression "metal goods" means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal. *Act*, 1888, s. 20, sub-s. 4.

(15) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield register, a certificate under the hand of the master of the Cutlers' Company shall have the same effect as the certificate of the comptroller.

PART V.—GENERAL.

Patent Office and Proceedings thereat.

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 authorised 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 [p. 144].

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 [pp. 23, 185].

Refusal to grant patent,

86. The comptroller may refuse to grant a patent for an in-

vention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality [p. 130]. &c., in certain cases.

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 licenses 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 [p. 185]. Entry of assignments and transmissions in registers. *Act*, 1888, s. 21.

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; 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 [p. 185]. Inspection of and extracts from registers. *Act*, 1888, s. 22.

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 [p. 186]. Sealed copies to be received in evidence.

90.—(1) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person, or of any other particulars from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging or varying the entry, as the Court thinks fit; or the Rectification of registers by court. *Act*, 1888, s. 23.

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 [p. 186].

(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.

91. The comptroller may, on request in writing accompanied by the prescribed fee [p. 186],

(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.

Act, 1888, *s.* 24.

(d) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the design or trade mark to be registered.

Alteration of registered mark.

92.—(1) The registered proprietor of any registered trade mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

Notice to be given.

(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.

Comptroller to alter in accordance with order.

(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 [p. 130] (*o*).

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 direction 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 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 [p. 320].

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 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.

Proof.

(2) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Provision as to days for leaving documents at office.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the Patent Office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a

(*o*) See P. R., 1890, r. 11.

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 [p. 131] (*p*).

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 [pp. 10, 127].

Transmission of certified printed copies of specifications, &c.

100. Copies of all specifications, drawings, and amendments, left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh museum of science and art, and to the enrolments office of the chancery division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Power for board of trade to make general rules for classifying 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 [p. 182]:

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

(b) For classifying goods for the purposes of designs and trade marks:

(*p*) See P. R., 1890, r. 7.

(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.

Alteration of forms.

(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 :

General rules ;

(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.

to be laid before parliament and advertised

(4) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

Annual reports of comptroller.

102. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under

him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

Proceedings of Board of Trade. *Act*, 1888, *s.* 25.

102A.—(1) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the president, or a secretary or an assistant secretary of the Board.

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

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

International and Colonial Arrangements.

International arrangements for protection of inventions, designs, and trade marks.

Act, 1885, *s.* 6.

103.—(1) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such state shall be entitled to a patent for his invention, or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants; and such patent or registration shall have the same date as the [*date of protection obtained*] **date of the application** in such foreign state [pp. 24, 68].

Time.

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.

No protection prior to specification or registration.

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 of a 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 : Publication at or use in exhibition not to invalidate patent 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 : Application under this section to be made in same manner as ordinary application.

(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. Application of this section.

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. Provision for colonies and India.

(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. Effect of order in council.

Offences.

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 Penalty on falsely representing article to be patented

liable for every offence on summary conviction to a fine not exceeding five pounds.

Definition of, false representation under this section.

(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 unauthorised assumption of royal arms.

106. Any person who, without the authority of Her Majesty, or any of the royal family, or of any Government department, assumes or uses in connection with any trade, business, calling, or profession, the royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable, on summary conviction to a fine not exceeding twenty pounds.

Scotland, Ireland, &c.

Saving for courts in Scotland.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts.

Definition of "court of appeal."

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 [p. 268].

Service in Scotland.

(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.

Rectification of register.

(2) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly.

Isle of Man.

112. This Act shall extend to the Isle of Man, and—

Jurisdiction of courts.

(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:

Punishments.

(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:

Offences and penalties treated as in England under this act.

(3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Jurisdiction of Lancashire Palatine Court. *Act*, 1888, s. 26.

112A. "The Court of Chancery of the county palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks the registration whereof

is applied for in the Manchester office, have the like jurisdiction under this Act as her Majesty's High Court of Justice in England, and the expression 'the Court' in this Act shall be construed and have effect accordingly.

"Provided that every decision of the Court of Chancery of the county palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases" [p. 316].

Repeal; Transitional Provisions; Savings.

Repeal and saving for past operation of repealed enactments, &c. Exceptions.

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."

"Person" includes a body corporate;

"Court."

"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."

"Law officer" means her Majesty's attorney-general or solicitor-general for England:

"Treasury."

"The Treasury" means the commissioners of her Majesty's treasury:

"Comptroller."

"Comptroller" means the comptroller-general of patents, designs, and trade marks:

"Prescribed."

"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."

"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."

"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.

"Summary conviction" as applied to Ireland.

In the application of this Act to Ireland, "summary conviction" means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin metropolitan police

district the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

Register of patent agents. *Act*, 1888, s. 1.

1.—(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.

SCHEDULES.

THE FIRST SCHEDULE.

FORMS OF APPLICATION, &c.

Forms A, B and C of this first schedule are altered by the substitution of those given in the second schedule to the Patent Rules, 1890 (*post*).

Section 33.

FORM D.

FORM OF PATENT.

The address.

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:

First recital.

Whereas *John Smith*, of 29, *Perry Street, Birmingham*, in the county of *Warwick, engineer*, hath by his solemn declaration represented unto us that he is in possession of an invention for "*Improvements in Sewing*

Machines," that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief:

And whereas the said inventor hath humbly prayed that we would be graciously pleased to grant unto him (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our royal letters patent for the sole use and advantage of his said invention: Second recital.

And whereas the said inventor hath by and in his complete specification particularly described the nature of his invention: Third recital.

And whereas we being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request: Fourth recital.

Know ye, therefore, that we, of our especial grace, certain knowledge, and mere motion, do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial licence, full power, sole privilege, and authority, that the said patentee by himself, his agents or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our united kingdom of Great Britain and Ireland and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention, during the term of fourteen years from the date hereunder written of these presents: And to the end that the said patentee may have and enjoy the sole use and exercise, and the full benefit of the said invention, we do by these presents, for us, our heirs and successors, strictly command all our subjects whatsoever within our united kingdom of Great Britain and Ireland and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years, either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof without the consent, licence, or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our royal command, and of being answerable to the patentee according to law for his damages thereby occasioned: Provided that these our letters patent are on this condition, that, if at any time during the said term it be made to appear to us, our heirs or successors, or any six or more of our privy council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our united kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything hereinbefore contained: Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times, and in manner

The grant.

The prohibition.

The conditions

for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything hereinbefore contained: Provided also, that nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted: And lastly, we do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee. In witness whereof we have caused these our letters to be made patent this 18 and to be sealed as of the 18 .

The construction.

[Seal of Patent Office.]

Section 113.

THE THIRD SCHEDULE.

Enactments Repealed.

21 James 1, c. 3 (1623).—The Statute of Monopolies. In part; namely, sections 10, 11 and 12.

5 & 6 Will. 4, c. 62 (1835) [In part].—The Statutory Declarations Act, 1835. In part; namely, section 11.

5 & 6 Will. 4, c. 83 (1835).—An act to amend the law touching letters patent for inventions.

2 & 3 Vict. 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 2 to 5, both included.

13 & 14 Vict. c. 104 (1850).—An act to extend and amend the acts relating to the copyright of designs.

15 & 16 Vict. c. 83 (1852).—The Patent Law Amendment Act, 1852.

16 & 17 Vict. c. 5 (1853).—An act to substitute stamp duties for fees on passing letters patent for inventions, and to provide for the purchase for the public use of certain indexes of specifications.

* *Note.*—Sects. 6 and 7 of this act are repealed by the Statute Law Revision (No. 2) Act, 1874.

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 65, and in the schedule the words and figures, "Certificate of the registration of a design . . £5 0 0. And see section 65."

38 & 39 Vict. c. 91 (1875).—The Trade Marks Registration Act, 1875.

38 & 39 Vict. c. 93 (1875).—The Copyright of Designs Act, 1875.

39 & 40 Vict. c. 33 (1876).—The Trade Marks Registration Amendment Act, 1876.

40 & 41 Vict. c. 37 (1877).—The Trade Marks Registration Extension Act, 1877.

43 & 44 Vict. c. 10 (1880).—The Great Seal Act, 1880. In part; namely, section 5.

45 & 46 Vict. c. 72 (1882).—The Revenue, Friendly Societies, and National Debt Act, 1882. In part; namely, section 16.

III.—PATENTS, ETC., ACT, 1885.

48 & 49 VICT. c. 63.

An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

BE IT ENACTED by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :

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, sub-sect. 2.

2. Whereas sub-section 2 of section 5 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 2 of section 5 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.

Amendment of sects. 8 and 9.

3. Whereas under the principal Act, a complete specification is required (by section 8) to be left within nine months, and (by section 9) to be accepted within twelve months, from the date of application, and a patent is required by section 12 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 the 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.

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 connection with such application, shall not at any time be open to public inspection or be published by the comptroller. Abandoned application.

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. Joint patent.

6. In sub-section 1 of section 103 of the principal Act, the words "date of the application" shall be substituted for the words "date of the protection obtained." Amendment of sect. 103, sub-sect. 1.

IV.—PATENTS, ETC., 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.*

Whereas by section 5 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:

Title. 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.

Explanation of sect. 5, subsect. 4 of principal Act. 2. The requirement of sub-section 4 of section 5 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.

Extension of sect. 39 of principal Act. 3. Whereas by section 39 of the Patents, Designs, and Trade Marks Act, 1883, as respects patents, and by section 57 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 39 and 57 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.

V.—PATENTS, DESIGNS, ETC., ACT, 1888.

An Act to amend the Patents, Designs, and Trade Marks Act, 1883. [24th December, 1888.]

WHEREAS it is expedient to amend the Patents, Designs, and Trade Marks Act, 1883, hereinafter referred to as the principal Act:

46 & 47 Vict. c. 57.

Be it therefore enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

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 [see Register of Patent Agents Rules, p. 459].

(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 101 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.

S. 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, specification, or drawings has not, or have not, been prepared in

the prescribed manner, or that the title does not sufficiently indicate the subject matter of the invention, the comptroller may refuse to accept the application, or require that the application, specification or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with.

"(2) Where the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer.

"(3) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions (if any) the application shall be accepted.

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

"(5) If, after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made accompanied by a specification bearing the same or a similar title, the comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon."

S. 9, as to disclosure of reports of examiners.

3. In sub-section 5 of section 9 of the principal Act the words "other than an appeal to the law officer under this Act" shall be omitted.

S. 11, as to opposition to grant of patent.

4. In sub-section 1 of section 11 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."

S. 18, as to amended specifications.

5. For sub-section 10 of section 18 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."

S. 52, as to inspection of designs.

6. After sub-section 1 of section 52 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."

S. 58, as to piracy of registered designs.

7.—(1) In section 58 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."

S. 62, as to application for registration.

8.—(1) In sub-section 2 of section 62 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."

S. 63, as to limit of time for proceeding with application.

9. In section 63 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."

S. 64, as to fancy words.

10.—(1) For section 64 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."

S. 67, as to colours of trade marks.

11. In section 67 of the principal Act the words "or colours" shall be added after the word "colour" in each place where that word occurs.

S. 68, as to advertisement of applications.

12. In section 68 of the principal Act after the word "comptroller" shall be added the words "unless the comptroller refuse to entertain the application."

S. 69, as to opposition to registration.

13.—(1) In subsection 1 of section 69 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 2 of the same section for the words "two months" shall be substituted the words "one month."

(4) For sub-sections 3 and 4 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."

S. 72, as to restrictions on registration.

14. *Sub-section two of section 72 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."

S. 73, as to restriction on registration.

15. In section 73 of the principal Act the word "exclusive" shall be omitted.

S. 74, as to additions to trade marks.

16. For sub-section 2 of section 74 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."

S. 75, as to effect of registration.

17. For section 75 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 77 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.

S. 79, as to removal of trade mark from the register.

19.—(1) In sub-section 5 of section 79 of the principal Act, for the words "the five years" shall be substituted the words "one year."

(2) To the same sub-section the following words shall be added; namely, "unless it is shown to the satisfaction of the comptroller that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark."

S. 81, as to Sheffield marks.

20.—(1) For sub-section 2 of section 81 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 register, in respect of metal goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January, one thousand eight hundred and eighty-four, but which have not been entered in either of the said other registers."

38 & 39 Vict. c. 91.

(2) In sub-sections 3 and 8 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 7 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 registrar 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."

S. 87, as to entry of assignments, &c.

21. In section 87 of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to."

S. 88, as to inspection.

22. In section 88 of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to."

S. 90, as to rectification of register.

23. In section 90 of the principal Act, after the words "of the name of any person," shall be added the words "or of any other particulars."

S. 91, as to correction of errors.

24. To section 91 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 connection with which he has desired the design or trade mark to be registered."

Proceedings of Board of Trade.

25. After section 102 of the principal Act the following section shall be added and numbered 102A; namely,

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

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

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

Jurisdiction of Lancashire Palatine Court.

26. After section 112 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 B.

INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

SIGNED AT PARIS, MARCH 20, 1883.

[*Ratifications exchanged at Paris, June* 6, 1884.]

I.—*International Convention.*

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 transactions, have resolved to conclude a convention to that effect, and have named as their plenipotentiaries, that is to say :—

His Majesty the King of the Belgians : the Baron Beyens, Grand Officer of His Majesty's Royal Order of Leopold, Grand Officer of the Legion of Honour, his Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ;

His Majesty the Emperor of Brazil : M. Jules Constant, Count de Villeneuve, member of his Majesty's Council, his Majesty's Envoy Extraordinary and Minister Plenipotentiary at the Court of his Majesty the King of the Belgians, Commander of the Order of Christ, Officer of his Majesty's Order of the Rose, Chevalier of the Legion of Honour, &c. ;

His Majesty the King of Spain : his Excellency the Duke

de Fernan-Nuñez, de Montellano et del Arco, Count de Cervellon, Marquis de Almonacir, Grandee of Spain First Class, Chevalier of the Distinguished Order of the Golden Fleece, Grand Cross of the Order of Charles III., Chevalier de Calatrava, Grand Cross of the Legion of Honour, Senator of the Kingdom, his Majesty's Ambassador Extraordinary and Plenipotentiary at *Paris*, &c. ;

The President of the French Republic : M. Paul Challemel-Lacour, Senator, Minister for Foreign Affairs ; M. Hérisson, Deputy, Minister of Commerce ; M. Charles Jagerschmidt, Minister Plenipotentiary of the First Class, Officer of the National Order of the Legion of Honour, &c. ;

The President of the Republic of Guatemala : M. Crisanto-Medina, Officer of the Legion of Honour, his Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.

His Majesty the King of Italy : M. Constantin Ressman, Commander of his Majesty's Orders of Saints Maurice and Lazarus, and of the Crown of Italy, Commander of the Legion of Honour, Councillor of the Italian Embassy at Paris, &c. ;

His Majesty the King of the Netherlands : the Baron de Zuylen de Nyevelt, Commander of his Majesty's Order of the Netherlands Lion, Grand Cross of his Majesty's Grand Ducal Order of the Oaken Crown, and of the Golden Lion of Nassau, Grand Officer of the Legion of Honour, his Majesty's Envoy Extraordinary and Minister Plenipotentiary at *Paris*, &c. ;

His Majesty the King of Portugal and the Algarves : M. Jose da Silva Mendes Leal, Councillor of State, Peer of the Realm, Minister and Honorary Secretary of State, Grand Cross of the Order of St. James, Chevalier of the Order of the Tower and Sword of Portugal, Grand Officer of the Legion of Honour, his Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ; M. Fernand de Azevedo, Officer of the Legion of Honour, First Secretary of the Portuguese Legation at Paris, &c. ;

The President of the Republic of Salvador : M. Torres-Caïcedo, corresponding member of the French Institute, Grand Officer of the Legion of Honour, his Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ;

His Majesty the King of Servia : M. 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 :—

Article I.

The Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland constitute themselves into a union for the protection of industrial property.

Article II.

The subjects or citizens of each of the contracting states shall, in all the other states of the union, as regards patents, industrial designs or models, trade-marks and trade names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Consequently they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each state.

Article III.

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.

Article IV.

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.

Article V.

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.

Article VI.

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.

Article VII.

The nature of the goods on which the trade-mark is to be used can in no case be an obstacle to the registration of the trade-mark.

Article VIII.

A trade name shall be protected in all the countries of the union, without necessity of registration, whether it form part or not of a trade-mark.

ARTICLE IX.

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.

ARTICLE X.

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.

ARTICLE XI.

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.

ARTICLE XII.

Each of the high contracting parties agrees 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.

ARTICLE XIII.

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.

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.

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.

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.

ARTICLE XVI.

States which have not taken part in the present Convention shall be permitted to adhere to it at their request.

Such adhesion shall be notified officially through the diplomatic channel to the government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses, and admission to all the advantages stipulated by the present Convention.

ARTICLE XVII.

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.

ARTICLE XVIII.

The present Convention shall come into operation one month after the exchange of ratifications, 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.

ARTICLE XIX.

The present Convention shall be ratified, and the ratifications exchanged in Paris, within one year at the latest.

In witness whereof the respective Plenipotentiaries have signed the same, and have affixed thereto their seals.

Done at Paris the 20th March, 1883.

(Signed)

(L.S.) BEYENS.
(L.S.) VILLENEUVE.
(L.S.) DUC DE FERNAN-NUNEZ.
(L.S.) P. CHALLEMEL-LACOUR.
(L.S.) CH. HERISSON.
(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.).

(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.

(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.

(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.	. . .	Franco, Italy.
2nd class	. . .	Spain.
3rd class	. . .	Belgium, Brazil, Portugal, Switzerland.
4th class	. . .	Holland.
th 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 preparations for the trans-

actions 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.

(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-NUNEZ.
P. CHALLEMEL-LACOUR.
CH. HERISSON.
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.

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.

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 authorized, 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.

(Signed) (L.S.) 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.)

The President of the French Republic has authorised the undersigned, President of the Council, Minister for Foreign Affairs, to formally accept the said accession, together with the reserves which are contained in it concerning the Isle of Man, the Channel Islands, and all other possessions of her Britannic Majesty, engaging as well in his own name as in that of the other high contracting parties to assist in the accomplishment of the obligations stipulated in the Convention and the protocol thereto annexed, which may concern the United Kingdom of Great Britain and Ireland.

In witness whereof the undersigned, duly authorised, has drawn up the present declaration of acceptance, and has affixed thereto his seal.

Done at Paris, the 2nd April, 1884.

(L.S.) (Signed) JULES FERRY.

APPENDIX C.

I.—PATENTS RULES, 1890.

By virtue of the provisions of the Patents, Designs and Trade Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following rules:

Short Title.

1. These rules may be cited as the Patents Rules, 1890. Short title.

Commencement.

2. These rules shall come into operation from and immediately after the 31st day of March, 1890. Commencement.

Interpretation.

3. In the construction of these rules, any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively. Interpretation

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.

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.

6.—(1) An application for a patent containing a declaration mentioned in sub-section 2 of section 5 of the Act of 1883 and section 2 of the Act of 1885 shall be made either in the Form A or the Form A1, or the Form A2, set forth in the second schedule to these rules as the case may be. Application.

(2) The form B in such schedule of provisional specifica- Specification.

tion 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.

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 [p. 131].

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 authorised to the satisfaction of the comptroller, and if he so require, resident in the United Kingdom [p. 126].

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 [p. 127].

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 [p. 127].

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 [pp. 180, 153].

Notice by applicant.

12. Within five days from the date when such notice would do 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 [p. 153].

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 [p. 153].

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 [p. 153].

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.

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 [p. 155].

16A. Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office, or to the comptroller, or to any other person under these rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given at the time when the letter containing the same would be delivered in the ordinary course of post. In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post [p. 127].

Manner in which, and persons before whom, declaration is to be taken.

17. The statutory declarations required by the said Acts and these rules, or used in any proceedings thereunder, shall be made and subscribed as follows:

(*a*) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;

(*b*) In any other part of her Majesty's dominions, before any court, judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and

(*c*) If made out of her Majesty's dominions, before a British minister, or person exercising the functions of a British minister, or a consul, vice-consul, or other person exercising the functions of a British consul, or a notary public, or before a judge or magistrate [p. 127].

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 [p. 127].

Application with Provisional or Complete Specification.

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.

Application for separate patents by way of amendment.

19. Where a person making application for a patent includes therein by mistake, inadvertence, or otherwise, more than one invention, he may, after the refusal of the comptroller to accept such application, amend the same so as to apply to one invention only, and may make application for separate patents for each such invention accordingly [p. 120].

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.

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 [p. 127].

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 [p. 132].

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 [p. 182].

Application on Communication from Abroad.

Communication 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.

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.

25. An application 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 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 from the date of the first foreign application, and must be signed by the person or persons by whom such first foreign application was made. If such person, or any of such persons, be dead, the application must be signed by the legal personal representative of such dead person, as well as by the other applicants, if any.

26. The application in the United Kingdom shall be made in the Form A2 in the second schedule to these rules, and in addition to the specification, provisional or complete, left with such application must be accompanied by

(1) A copy or copies of the specification, and drawings or documents corresponding thereto, filed or deposited by the applicant in the Patent Office of the foreign state or British possession in respect of the first foreign application duly certified by the official, chief, or head of the Patent Office of such foreign state or British possessions as aforesaid, or otherwise verified to the satisfaction of the comptroller;

(2) A statutory declaration 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 thereto be in a foreign language, a translation thereof shall be annexed to and verified by such statutory declaration.

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.

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.

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 requirement. 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 affects 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."

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."

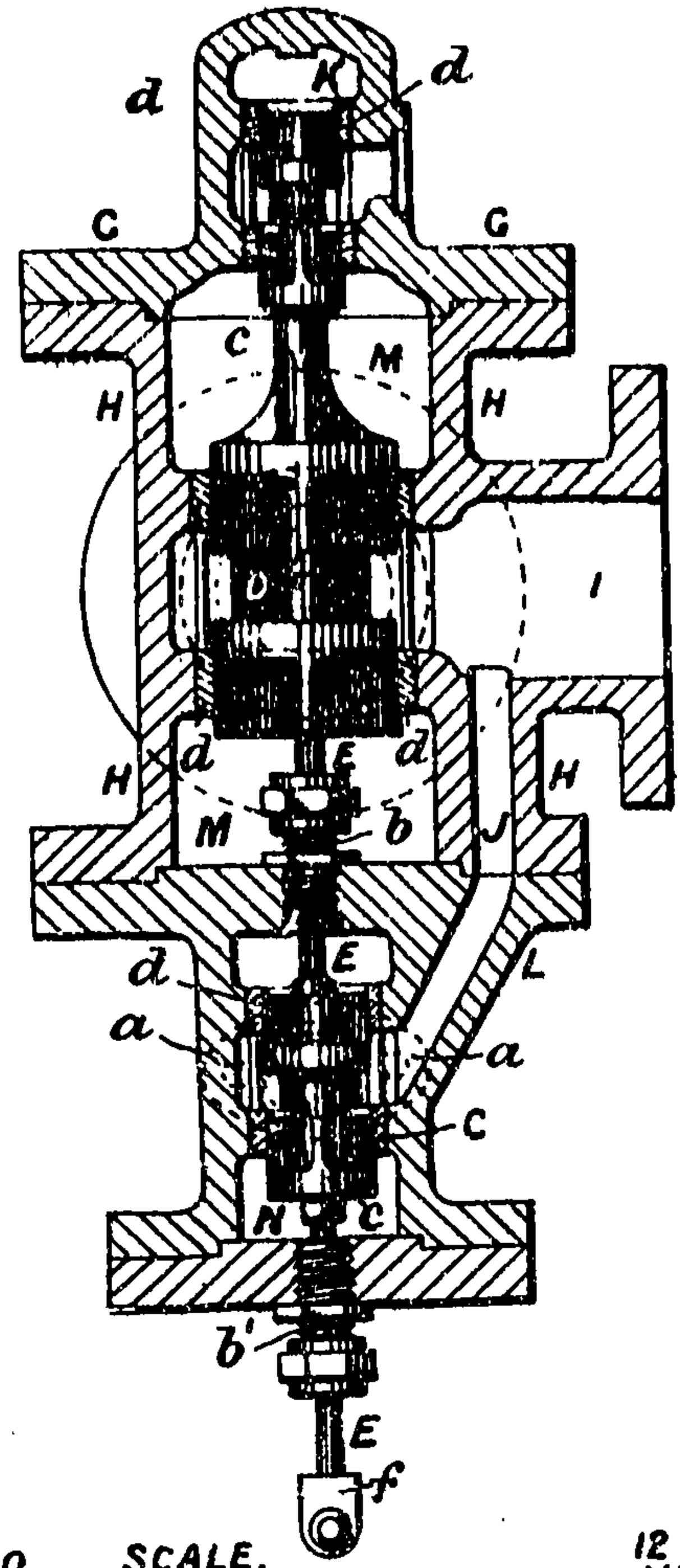
Notice of opposition. 34. A notice of opposition to the grant of a patent shall be

Specimen drawing for Specifications

Border line ¼ an inch from edge of paper

A.(D.N..... No..... (.....Sheets)
Smith's Specification Sheet ....

FIG. 1.



SCALE. 0 INS 12 INS.

Jas Smith (Applicant)
or Jones & Co
Agents for Applicant

Border line ¼ an inch from edge of paper.

Size of paper for Specification drawing. { 13 inches by 8 inches. or 13 ..... 16 inches

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 [p. 136].

Copy for applicant.

35. On receipt of such notice the copy thereof shall be transmitted by the comptroller to the applicant [p. 136].

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 [p. 136].

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 his opposition, and on so leaving shall deliver to the applicant a list thereof [p. 136].

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 [p. 136].

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.

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 [p. 136].

40. Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

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 oppo-

nent 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.

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.

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.

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.

Certificates of Payment or Renewal.

Repealed—P. R. 1892

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.*

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."

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.*

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.

Certificate of payment.

48. On due compliance with these rules, and as soon as may be after such respective periods as aforesaid, or any enlargement thereof respectively duly granted, the comptroller shall issue a certificate that the prescribed payment has been duly made.

Enlargement of Time.

Enlargement of time for payments.

49. An application for an enlargement of the time for making a prescribed payment shall state in detail the circumstances in which the patentee by accident, mistake, or inadvertence has failed to make such payment, and the comptroller may require the patentee to substantiate by such proof as he may think necessary the allegations contained in the application for enlargement.

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 [p. 131].

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 [p. 131].

Amendment of Specification [p. 152, *et seq.*].

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.

Notice of opposition.

53. A notice of opposition to the amendment shall state the ground or grounds on which the person giving such

notice (hereinafter called the opponent) intends to oppose the amendment, and must be signed by him. Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy [p. 158].

Copy for the applicant.

54. On receipt of such notice the copy thereof shall be transmitted by the comptroller to the applicant [p. 158].

Opponent's evidence.

55. Within fourteen 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 [p. 159].

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 [p. 159].

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.

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 [p. 174].

Compulsory Licenses [p. 181].

Petition for compulsory grant of licenses.

60. A petition to the Board of Trade for an order upon a patentee to grant a license 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.

To be left with evidence at Patent Office.

61. The petition and an examined copy thereof shall be left at the Patent Office, accompanied by the affidavits, or statutory declarations, and other documentary evidence (if

any) tendered by the petitioner in proof of the alleged default of the patentee.

Directions as to further proceedings unless petition refused.

62. Upon perusing the petition and evidence, unless the Board of Trade shall be of opinion that the order should be at once refused, they may require the petitioner to attend before the comptroller, or other person or persons appointed by them, to receive his or their directions as to further proceedings upon the petition.

Procedure.

63. If and when a *primâ facie* case for relief has been made out to the satisfaction of the Board of Trade, the petitioner shall upon their requisition, and on or before a day to be named by them, deliver to the patentee copies of the petition and of the affidavits or statutory declarations and other documentary evidence (if any) tendered in support thereof.

Petitioner's evidence.

Patentee's evidence.

64. Within fourteen days after the day of such delivery the patentee shall leave at the Patent Office his affidavits or statutory declarations in opposition to the petition, and deliver copies thereof to the petitioner.

Evidence in reply.

65. The petitioner within fourteen 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.

Further proceedings.

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.

Register of Patents [pp. 185, 186].

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.

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.

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 authorised to the satisfaction of the comptroller, and in the case of a body corporate by their agent, authorised in like manner.

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.

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 [p. 8].

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 recti-

fication 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 [p. 213].

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.

Entry of failure to pay fees.

76. If a patentee fails to make any prescribed payment within the prescribed time or any enlargement thereof duly granted, such failure shall be duly entered in the register.

Entry of licenses.

77. An attested copy of every license 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 license shall at the same time be produced and left at the Patent Office if required for further verification.

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.

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.

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.

Repeal.

81. All general rules heretofore made by the Board of Trade under the Patents, Designs and Trade Marks Act, 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. Repeal.

Dated the 31st day of March, 1890.

M. E. Hicks-Beach,
President of the Board of Trade.

THE SECOND SCHEDULE (a).

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Patents, Designs and Trade Marks Acts, 1883 to 1888.

[PATENT.] FORM A.

[To be accompanied by two copies of Form B. or of Form C.]

APPLICATION FOR PATENT.

[*Here insert name and full address and calling of applicant or applicants*] do hereby declare that in possession of an invention the title of which is [*here insert title of invention*] that [*in the case of more than one applicant, state whether all, or if not, who is or are the inventor or inventors*] the true and first inventor thereof; and that the

(a) First Schedule repealed by P. R. 1892 (Second Set).

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 .

[*To be signed by applicant or applicants.*

In the case of a Firm, each member of the Firm must sign.]

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.

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 to 1888.

[PATENT.] FORM A1.

[*To be accompanied by two copies of Form B. or of Form C.*]

APPLICATION FOR PATENT FOR INVENTIONS COMMUNICATED FROM ABROAD.

I [*here insert name, and full address, and calling of applicant*] of in the county of do hereby declare that I am in possession of an invention the title of which is [*here insert title of invention*] which invention has been communicated to me by [*here insert name, address, and calling of communicant*] 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 .

[*To be signed by applicant or applicants.*]

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.

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 to 1888.

[PATENT.] FORM A2.

APPLICATION FOR PATENT UNDER INTERNATIONAL AND COLONIAL ARRANGEMENTS.

[*Here insert name and full address and calling of applicant, or of each of the applicants*] do hereby declare that I (or we) have made foreign applications for protection of my (or our) invention of [*here insert title of invention*] in the following Foreign States and on the following official dates, viz.: [*here insert the names of each Foreign State followed by the official date of the application in each respectively*] and in the following British Possessions and on the following official dates, viz.: [*here insert the names of each British Possession followed by the official date of the application in each respectively*].

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 [*here insert the official date of the earliest foreign application*] 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 [*here insert the official date of the earliest foreign application*].

[*Signature of applicant or of each of applicants.*]

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

To be issued with Form A, A1, or A2.]

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

FORM B.

PROVISIONAL SPECIFICATION.

(To be furnished in Duplicate.)

[*Here insert title as in declaration*] [*here insert name, and full address and calling of applicant or applicants as in declaration*] do hereby declare the nature of this invention to be as follows :—[*here insert short description of invention*].

NOTE.—No stamp is required on this document, which must form the commencement of the Provisional Specification; the continuation to be upon wide-ruled foolscap paper (but on one side only) with a margin of two inches on left hand of paper. The Provisional Specification and the "Duplicate" thereof must be signed by the applicant or his agent, on the last sheet, the date being first inserted as follows:

"Dated this day of 18 ."

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

Where Provisional Specification has been left, quote No. and date.

No. .
Date .

[PATENT.]

FORM C.

COMPLETE SPECIFICATION.

(To be furnished in Duplicate—one unstamped.)

[*Here insert title as in declaration*] [*here insert name, and full address and calling of applicant or applicants as in declaration*] 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 :—[*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. .]

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.

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

[PATENT.] FORM D.

FORM OF OPPOSITION TO GRANT OF PATENT.

[*To be accompanied by an unstamped copy.*]

I [*here state name and full address*] hereby give notice of my intention to oppose the grant of Letters Patent upon application No. of , applied for by upon the ground [*here state upon which of the grounds of opposition permitted by section* 11 *of the Act the grant is opposed*].

(Signed) [*here insert signature of opponent*].

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

[PATENT.] FORM E.

FORM OF APPLICATION FOR HEARING BY THE COMPTROLLER.

In cases of refusal to accept, opposition, or applications for amendments, &c.

Sir,

of [*here insert address*] hereby apply to be heard in reference to and request that I may receive due notice of the day fixed for the hearing.

Sir,
Your obedient Servant

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

[PATENT.] FORM F.

FORM OF APPLICATION FOR AMENDMENT OF SPECIFICATION OR DRAWINGS.

[*Here state name and full address of applicant or patentee*] seek leave to amend the specification of Letters Patent No. of 188 , as shown in red ink in the copy of the original specification hereunto annexed .

My reasons for making this amendment are as follows [*here state reasons for seeking amendment; and where the applicant is not the patentee, state what interest he possesses in the letters patent*].

(Signed) [*to be signed by applicant*].

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

[PATENT.] FORM G.

FORM OF OPPOSITION TO AMENDMENT OF SPECIFICATION OR DRAWINGS.

[*To be accompanied by an unstamped copy.*]

[*Here state name and full address of opponent*] hereby give notice of objection to the proposed amendment of the specification or drawings of Letters Patent No. of 188 for the following reason: [*here state reason of opposition*].

(Signed)

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

[PATENT.] FORM H.

FORM OF APPLICATION FOR COMPULSORY GRANT OF LICENSE.

[*To be accompanied by an unstamped copy.*]

[*Here state name and full address of applicant*] hereby request you to bring to the notice of the Board of Trade the accompanying petition for the grant of a license to me by [*here state name and address of patentee, and number and date of his patent*].

(Signed)

NOTE.—The petition must clearly set forth the facts of the case and be accompanied by an examined copy thereof. *See* form next page.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

FORM H1.

FORM OF PETITION FOR COMPULSORY GRANT OF LICENSES.

To the LORDS of the COMMITTEE of PRIVY COUNCIL for TRADE.

THE PETITION of [*here insert name, full address, and description*] of in the county of , being a person interested i the matter of this petition as hereinafter described :—

SHEWETH as follows :—

1. A patent dated No. was duly granted to for an invention of [*here insert title of invention*].

2. The nature of my interest in the matter of this petition is as follows :—[*here state fully the nature of petitioner's interest*].

3. [*Here state in detail the circumstances of the case under section 22 of the said Act, and show that it arises by reason of the default of the patentee to grant licenses 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.*]

Having regard to the circumstances above stated, the petitioner alleges that by reason of the aforesaid default of the patentee to grant licenses on reasonable terms [*here state the ground or grounds on which relief is claimed in the language of section* 22, *subsections* (a), (b), *or* (c), *as the case may be.*

Your petitioner therefore prays that an order may be made by the Board of Trade [*here state the purport and effect of the proposed order and the terms as to the amount of royalties, security for payment, or otherwise, upon which the petitioner claims to be entitled to the relief in question*].
or that the petitioner may have such other relief in the premises as the Board of Trade may deem just.

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

[PATENT.] FORM I.

FORM OF OPPOSITION TO COMPULSORY GRANT OF LICENSE.

[*Here state name and full address*] hereby give notice of objection to the application of for the compulsory grant of a license under Patent No. of 188 .

(Signed)

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

FORM J.

APPLICATION FOR CERTIFICATE OF PAYMENT OR RENEWAL.

hereby transmit the fee prescribed for the continuation in force of [*here insert name of patentee*] Patent No. , of 18 for a further period of .

Name [*here insert name and full address*].
Address .

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(This part of the Form to be filled in at the Patent Office.)

[PATENT.] CERTIFICATE OF PAYMENT OR RENEWAL.

Letters Patent No. of 188 .

18 .

This is to certify that did this day of 18 , make the prescribed payment of £ in respect of a period of from and that by virtue of such payment the rights of the patentee remain in force [*see section 17 of the Patents, Designs, and Trade Marks Act*, 1883].

(Seal.)

Patent Office, London.

Patents, Designs, and Trade Marks Acts, 1883 to 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 188 .

The circumstances in which the payment was omitted are as follows :— [*see Rule* 49].

I am, Sir,
Your obedient Servant,

[*Here insert full address to which receipt is to be sent.*]

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

[PATENT.] FORM L.

FORM OF REQUEST TO ENTER NAME UPON THE REGISTER OF PATENTS.

I [or *we*] [*here insert name, full address, and description*] hereby request that you will enter [*my* or *our*] name [or *names*] in the Register of Patents :—

[*I* or *we*] claim to be entitled [*here insert the nature of the claim*] of the Patent No. of 188 , granted to [*here give name and address, &c., of patentee or patentees*] for [*here insert title of the invention*] by virtue of [*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*].

And in proof whereof I transmit the accompanying [*here insert the nature of the document*] with an attested copy thereof [*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*].

I am, Sir,
Your obedient Servant,

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

[PATENT.] FORM M.

FORM OF REQUEST TO ENTER NOTIFICATION OF LICENSE IN THE REGISTER OF PATENTS.

Sir,

I hereby transmit an attested copy of a license granted to me by under Patent No. of 188 , as well as the original license for verification, and I have to request that a notification thereof may be entered in the Register.

I am, Sir,
Your obedient Servant,

[*Here insert full address.*]

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

[PATENT.] FORM N.

APPLICATION FOR DUPLICATE OF PATENT.

Date

Sir,

I regret to have to inform you that the Letters Patent dated [*here insert date, No., name, and full address of patentee*] No. granted to for an invention of [*here insert title of invention*] have been [*here insert the word "destroyed" or "lost," as the case may be*].

I beg therefore to apply for the issue of a duplicate of such Letters Patent [*here state interest possessed by applicant in the Letters Patent*].

[*Signature of Applicant.*]

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

[PATENT.] FORM O.

NOTICE OF INTENDED EXHIBITION OF AN UNPATENTED INVENTION.

[*Here state name and full address of applicant*] hereby give notice of my intention to exhibit a of at the Exhibition, which [*state "opened" or "is to open"*] of 18 , under the provisions of the Patents, Designs, and Trade Marks Act of 1883.

[*Insert brief description of invention, with drawings if necessary*] herewith enclose

(Signed)

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

[PATENT.] FORM P.

FORM OF REQUEST FOR CORRECTION OF CLERICAL ERROR.

Sir,

I hereby request that the following clerical error [*or errors*] in the [*here state whether in application, specification, or register*] No. of 18 , may be corrected in the manner shown in red ink in the certified copy of the original [*here state whether in application, specification, or register*] hereunto annexed.

Signature
Full Address

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

[PATENT.] FORM Q.

CERTIFICATE OF COMPTROLLER-GENERAL.

Patent Office,
London,
18 .

I, , Comptroller-General of Patents, Designs, and Trade Marks, hereby certify .

To [*here insert name and full address of person requiring the information*].

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

[PATENT.] FORM R.

FORM OF NOTICE FOR ALTERATION OF AN ADDRESS IN REGISTER.

Sir,

[*Here state name or names and full address of applicant or applicants*] hereby request that address now upon the Register may be altered as follows :—

[*Here insert full address.*]

Sir,

Your obedient Servant,

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

[PATENT.] FORM S.

FORM OF APPLICATION FOR ENTRY OF ORDER OF PRIVY COUNCIL IN REGISTER.

[*Here state name and full address of applicant*] hereby transmit an office copy of an Order in Council with reference to [*here state the purport of the order*].

Sir,

Your obedient Servant,

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

[PATENT.] FORM T.

FORM OF APPEAL TO LAW OFFICER.

I, [*here insert name and full address of appellant*] of [*here insert name and full address of appellant*] hereby give notice of my intention to appeal to the Law Officer from [*here insert "the decision" or "that part of the decision," as the case may be*] of the Comptroller of the day of , whereby he [*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*] No. [*insert number and year*] of the year 18 [*insert number and year*].

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.

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

[PATENT.] FORM U.

FORM OF APPLICATION FOR EXTENSION OF TIME FOR LEAVING A COMPLETE SPECIFICATION.

Sir,

hereby apply for extension of time for one month in which to leave a Complete Specification upon application dated .

The circumstances in and grounds upon which this extension is applied for are as follows [*see Rule* 50] :—

Sir,
Your obedient Servant,

[*To be signed by applicant or applicants, or his or their agent.*]

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

[PATENT.] 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 [*see Rule* 50] :—

Sir,
Your obedient Servant,

[*To be signed by applicant or applicants, or his or their agent.*]

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

31st March, 1890.

M. E. HICKS-BEACH,
President of the Board of Trade.

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 on 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 connexion with Letters Patent.

Up to Sealing.

	£	s.	d.	£	s.	d.
1. On application for provisional protection . .	1	0	0			
2. On filing complete specification . . .	3	0	0			
				4	0	0
or						
3. On filing complete specification with first application .				4	0	0
4. On appeal from comptroller to law officer. By appellant				3	0	0
5. On notice of opposition to grant of patent. By opponent.				0	10	0
6. On hearing by comptroller. By applicant and by opponent respectively				1	0	0
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
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

		£	s.	d.
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	0	5	0
	after sealing.	1	0	0
35.	For certificate of comptroller under section 98 . . .	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:

SIDNEY HERBERT
HERBERT EUSTACE MAXWELL,
Lords Commissioners of
Her Majesty's Treasury.

II.—RULES REGULATING THE PRACTICE AND PROCEDURE ON APPEALS TO THE LAW OFFICERS.

I. When any person intends to appeal to the law officer from a decision of the comptroller in any case in which such appeal is given by the 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 [pp. 141, 168].

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 [p. 141].

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 [p. 141].

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 [p. 141].

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 [p. 141].

VI. Seven days' notice, at least, of the time and place appointed for the hearing of any appeal, shall be given by the law officers' clerk, unless special leave be given by the law officer that any shorter notice be given.

VII. Such notice shall in all cases be given to the comptroller and the appellant; and, when there has been an opposition before the comptroller, to the opponent or opponents; and, when the comptroller has refused to seal a patent on the ground that an application for a patent for the same invention is pending, to the prior applicant.

VIII. The evidence used on appeal to the law officer shall be the same as that used at the hearing before the comptroller; and no further evidence shall be given, save as to matters which have occurred or come to the knowledge of either party, after the date of the decision appealed against, except with the leave of the law officer upon application for that purpose [p. 141].

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 [p. 141].

X. Any person requiring the attendance of a witness for cross-examination shall tender to the witness whose attendance is required a reasonable sum for conduct money.

XI. Where the law officer orders that costs shall be paid by any party to another, he may fix the amount of such costs, and if he shall not think fit to fix the amount thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained [p. 162].

XII. If any costs so ordered to be paid be not paid within fourteen days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment under the provisions of section 38 of the Act.

XIII. All documentary evidence required, or allowed by the law officer to be filed, shall be subject to the same regulations, in all respects, as apply to the procedure before the comptroller, and shall be filed in the Patent Office, unless the law officer shall order to the contrary.

XIV. Any notice or other document required to be given to the law officers' clerk, under these Rules, may be sent by a prepaid letter through the post.

HENRY JAMES, A.G.
FARRER HERSCHELL, S.G.

III.—RULES TO BE OBSERVED IN PROCEEDINGS BEFORE THE JUDICIAL COMMITTEE OF THE PRIVY COUNCIL

Under the Act of the 5th and 6th Will. IV., intituled "An Act to Amend the Law touching LETTERS PATENT FOR INVENTIONS" (*cap.* 83).

RULE I.—A party intending to apply by petition, under section 2 of the said Act, shall give public notice by advertising in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carries on any manufacture of anything made according to his specification, or near to or in which he resides, in case he carries on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to petition his Majesty under the said section, and shall in such advertisements state the object of such petition, and give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day notice must be given of any opposition intended to be made to the petition; and any person intending to oppose the said application shall lodge notice to that effect at the council office, on or before such day so named in the said advertisements, and having lodged such notice, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

RULE II.—A party intending to apply by petition, under section 4 of the said Act, shall in the advertisements directed to be published by the said section, give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day caveats must be entered; and any

person intending to enter a caveat shall enter the same at the council office, on or before such day so named in the said advertisements; and having entered such caveat, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing [p. 211].

RULE III.—Petitions under sections 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* [p. 211].

RULE IV.—All petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of section 4 of the said Act, and the first and second of these Rules, and the matters in such affidavits may be disputed by the parties opposing upon the hearing of the petitions [p. 211].

RULE V.—All persons entering caveats under section 4 of the said Act, and all parties to any former suit or action touching letters patent, in respect of which petitions shall have been presented under section 2 of the said Act, and all persons lodging notices of opposition under the first 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.

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.

RULE VII.—Parties may have copies of all papers lodged in respect of any application under the said Act, at their own expense.

RULE VIII.—The registrar of the Privy Council, or other officer to whom it may be referred to tax the costs incurred in the matter of any petition presented under the said Act, shall allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

RULE IX.—A party applying for an extension of a patent, under section 4 of the said Act, must lodge at the council office six printed copies of the specification, and also four

copies of the balance-sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the lords of the committee at the hearing. In the event of the applicant's specification not having been printed, and if the expense of making six copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only of such specification and drawing will be deemed sufficient.

All copies mentioned in this rule must be lodged not less than one week before the day fixed for hearing the application.

The judicial committee will hear the attorney-general, or other counsel, on behalf of the Crown, against granting any application made under either the 2nd or 4th section of the said Act, in case it shall be thought fit to oppose the same on such behalf.

IV.—REGISTER OF PATENT AGENTS' RULES, 1889.

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 :—

Register to be kept.

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.

Contents of register.

2. The register shall contain in one list all patent agents who are registered under the Acts 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 copies to be

3. The institute shall cause a correct copy of the register to

published annually, and to be evidence of contents of register.

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.

Registrar.

4. The institute shall appoint a registrar, 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 persons who were patent agents prior to the passing of this Act.

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.

Final qualifying examination for registration.

6. Subject to the provisions of the Act in favour of every person who proves to the satisfaction of the Board of Trade that prior to the passing of the Act he had been *bonâ fide* practising as a patent agent, no person shall be entitled to be registered as a patent agent unless he has passed, and produces or transmits to the registrar a certificate under the seal of the institute that he has passed, such final examination as to his knowledge of patent law and practice and of the duties of a patent agent as the institute shall from time to time prescribe.

Exemption of pupils

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.

and assistants from preliminary examination.

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—

Qualifications of persons generally for registration.

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.

9. The institute shall hold at least once in the year, commencing with the 1st 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,

Final qualifying examinations to be held by the institute.

(*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.

Corrections of names and addresses in register.

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.

Erasure of names of deceased persons.

11. The registrar shall erase from the register the name of any registered person who is dead.

Erasure of names of persons who have ceased to practise.

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.

Erasure of name for non-payment of fees.

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 (*a*).

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. Registrar to act on evidence.

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. Erasure of incorrect or fraudulent entries.

16. If any registered person shall be convicted in her Majesty's dominions or elsewhere of an offence which, if committed in England, would be a felony or misdemeanor, 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. Erasure of names of persons convicted of crimes, and persons found guilty of disgraceful conduct.

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. Restoration of erased name.

(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.

(*a*) *The Chartered Institute of Patent Agents* v. *Lockwood*, 10 P. O. R. 167 ; 11 P. O. R. 374.

Inquiry by Board of Trade before erasure of name from register.

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.

Notice of 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 fourteen 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.

Case on appeal.

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.

Transmission of notice of appeal to Board of Trade.

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.

Directions as to hearing of appeal.

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.

Notice of hearing of 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.

Hearing and decision of appeal.

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.

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. Fees.

27. Any regulation made by the institute under these rules may be altered or revoked by a subsequent regulation. Copies of all regulations made by the institute under these rules shall, within twenty-eight days of the date of their being made, be transmitted to the Board of Trade, and if within twenty-eight days after a copy of any regulation has been so transmitted, the Board of Trade by an order signify their disapproval thereof, such regulation shall be of no force or effect; and if, after any regulation under these rules has come into force, the Board of Trade signify in manner aforesaid their disapproval thereof, such regulation shall immediately cease to be of any force or effect. Alteration of regulations.

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. Report to Board of Trade.

29. In these rules, unless the context otherwise requires— Definitions.

"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.

30. These rules shall commence and come into operation on the 12th day of June, 1889, but at any time after the making Commencement.

thereof any appointment or regulations may be made and things done for the purpose of bringing these rules into operation on the said day.

Title. 31. These rules may be cited as the Register of Patent Agents' Rules, 1889.

By the Board of Trade,
COURTENAY BOYLE,
Assistant Secretary, Railway Department.

11*th June*, 1889.

APPENDIX A.

FORM 1.

FORM OF REGISTER.

Name.	Designation.	Address.	Date of registration.

FORM 2.

FORM OF STATUTORY DECLARATION.

Register of Patent Agents' Rules, 1889.

I, *A. B.* [*insert full name, and in the case of a member of a firm add,* "a member of the firm of "], of , in the county of , Patent Agent, do solemnly and sincerely declare as follows:—

1. That prior to the 24th December, 1888, I had been *bond fide* practising in the United Kingdom as a patent agent.

2. That I acted as patent agent in obtaining the following patents:—

[*Give the official numbers and dates of some patents for the United Kingdom in the obtaining of which the declarant acted as patent agent.*]

3. That I desire to be registered as a patent agent in pursuance of the said Act.

And I make this solemn declaration conscientiously believing the same to be true and by virtue of the provisions of the Statutory Declarations Act, 1835.

Declared at

APPENDIX B.

Particulars of Preliminary Examinations.

1. The Matriculation Examination at any University in England, Scotland, or Ireland.

2. The Oxford or Cambridge Middle Class Senior Local Examinations.

3. The Examinations of the Civil Service Commissioners for admission to the Civil Service.

APPENDIX C.

Fees.

Nature of fee.	When to be paid.	To whom to be paid.	Amount.
			£. s. d.
For registration of name of patent agent who had been bonâ fide in practice prior to the passing of the act.	On application and before registration.	To the Registrar at the Institute	5 5 0
For registration of name of any person other than as above.	Do. do. .	Do. do. .	5 5 0
Annual fee to be paid by every registered patent agent.	On or before November 30 of each year, in respect of the year commencing January 1st following.	Do. do. .	3 3 0
On entry of a candidate for the final qualifying examination.	At time of entering name.	Do. do. .	2 2 0

V.—WAR OFFICE MEMORANDUM TO INVENTORS.

WAR OFFICE,
January 1, 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.

(2) Expenses incurred before the submission of an unpatented invention will not be considered to give a claim for repayment. No liability on behalf of the public will be recognised on account of loss of time or expenses incurred in connection with an invention after such submission, unless authority for such expenses has been previously given by letter, signed by one of the Under-Secretaries of State or the Director of Artillery ; and the liability will be strictly confined to the limits of expenditure authorised 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 payment be recommended by the council and approved by the Secretary of State for War, the sum will, with the concurrence of the Treasury, be included in the Estimates, but it will not be due to the claimant until after the vote is passed by the House of Commons.

(4) No claim for reward for an unpatented invention will be held to be established unless the invention has been adopted into the Service.

(b) With regard to patented inventions—

(5) By section 27 of the Patents, Designs, and Trade Marks Act, 1883, it is enacted as follows :

"A patent shall have to all intents the like effect as against her Majesty the Queen, her heirs and successors, as it has against a subject.

"But the officers or authorities administering any department of the service of the Crown may by themselves, their agents, contractors, or others, at any time after the application, use the invention for the service of the Crown, on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested."

(6) Persons desiring to submit patented inventions should proceed on all points as laid down in paragraph (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.

APPENDIX D.

I.—FORMS IN PROCEEDINGS IN AN ACTION FOR INFRINGEMENT.

1. Indorsement on Writ.

The plaintiff's claim is :—

Injunction. 1. For an injunction to restrain the defendant from infringing the plaintiff's patent, No. , and dated .

Damages. Account. 2. For damages for the infringement of the said patent, or alternatively that an account may be taken of all the machines made in infringement of the said patent which have been manufactured, or sold, or let for hire, or used by or by the order, or for the use and profit, of the defendant, and also of the gains and profits made by the defendant by reason of such manufacture, sale, or letting for hire or use, and that the defendant may by a day to be appointed by the Court be ordered to pay to the plaintiff the amount of such gains and profits.

Order for destruction. 3. That the defendant may be ordered upon oath to deliver up to the plaintiff, or break up, or otherwise render unfit for use, all machines or parts of machines made in infringement of the plaintiff's said patent, which are in the custody or power of the defendant, his servants, or agents.

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2. Notice of Motion for Interlocutory Injunction.

In the High Court of Justice.

Chancery [*or* Queen's Bench] Division.

Between A. B. . . . . Plaintiff,

and

C. D. . . . . Defendant.

Take notice that this Honourable Court will be moved [*if short notice of motion*, by leave granted] on the day of ,

or so soon thereafter as counsel can be heard by Mr. , of counsel for the above-named plaintiff, that an injunction may be awarded against the defendant to restrain the said defendant, his servants or agents, until the trial of this action or further order from either directly or indirectly making, using, or putting in practice the invention described in the specification and drawings filed under the letters patent granted to the plaintiff [*or* assignor, *or* other predecessor in title of plaintiff], and numbered , or that such further order may be made in the premises as to the Court may seem meet.

---

3. Affidavit in Support of Notice of Motion.

[*Title as above.*]

I, of , the above-named plaintiff, make oath and say,

1. Letters patent dated [ ] were granted to me under the seal of the Patent Office for an invention entitled "improvements, &c., &c.," for a period of fourteen years from the day of . Grant.

2. At the time when the said letters patent were granted to me the said invention was new as to the public use and exercise thereof within this realm. Novelty.

3. I am the true and first inventor of the said invention [*or* John Smith or other predecessor in title of the plaintiff, was the true and first inventor of the said invention] . First inventor.

4. The said invention is of great public utility. Utility.

5. [*State any particular facts, such as a previous action or long user, which have a tendency to cause a presumption of the validity of the patent.*]

6. On the day of the defendant infringed the plaintiff's said patent by manufacturing [selling or using], etc. (*a*). Infringement.

(*a*) Evidence should be adduced by supporting affidavits in case it is deemed that the defendant has infringed the patent. In *Moore* v. *Bennett*, 1880, M., No. 94, the evidence adduced was that of several persons who had purchased brushes, which, from their appearance, showed they had been made by the patented machine, from the defendant.

7. [The articles sold by the defendant were not manufactured by me or by my licensees or agents.]

8. I believe that the defendant means to continue the infringement of the said letters patent, whereby my trade is greatly injured; persons refusing to purchase the patented articles from me [*or* I am unable to grant licences, *or state any other grounds of special damage arising by reason of the continued infringement*].

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4. Interlocutory Order to Restrain Infringement of Patent.

Form 1.

Upon motion, &c., by counsel for the plaintiff, and upon hearing counsel for the defendant [*or* reading an affidavit of service of notice of this motion on the defendant; *or*, *if moved ex parte before the defendant has appeared*, the writ of summons issued in this action on the day of] [*enter affidavits in support and in opposition if any*], and the plaintiff, by his counsel, undertaking to abide by any order this Court may make as to damages, in case this Court should hereafter be of opinion that the defendant shall have sustained any, by reason of this order, which the plaintiff ought to pay [*if so*, and also undertaking to accept short notice of motion to dissolve the injunction hereby awarded], let an injunction be awarded to restrain the defendant T. until further order, from manufacturing any tube expanders similar to the tube expander which has been purchased by the defendant B., as in the plaintiff's writ mentioned, or otherwise constructed so as to imitate or resemble the roller expanding tool described in the specification in the plaintiff's letters patent in the said writ mentioned, and to restrain the defendants T. and B., their agents, &c., from selling or offering for sale, or otherwise parting with the custody of any tube expanders, or parts of any tube expanders, which have been so manufactured by the said defendant T. Liberty to either party to apply to expedite the hearing (*b*).

Interlocutory injunction.

(*b*) *Dudgeon* v. *Thompson*, M.R., 24th March, 1874, A. 723.

Form 2.

On usual undertaking as to damages, let an injunction be awarded against the defendants S. and C., to restrain the said defendants, their servants, &c., until the trial of this action or further order, from either directly or indirectly making, using, or putting in practice the invention described in the specification and drawings filed under the letters patent, granted to N., dated the, &c., and numbered 2190, and now vested by assignment in the plaintiff, or any part thereof, except as to any skates made by the plaintiff, or his agents or agent (*c*). The same on terms.

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5. Interlocutory Injunction for Infringement refused on Terms.

Upon motion, &c., for injunction to restrain, &c., and the defendant, by his counsel, undertaking to keep an account of all moneys received or to be received by him, by reason of the sale or use of the parlour or roller skates in the writ mentioned, this Court does not think fit to make any order upon the said motion, but does order that the costs of the said motion be costs in the cause (*d*). Refusal on terms.

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6. Inspection, Notice of Motion for.

[*Title as before.*]

Take notice that this Honourable Court will be moved [*if in the Chancery Division*, before his lordship, Mr. Justice], on the part of the plaintiff, that the plaintiff, his solicitors and agents, $\frac{\text{and}}{\text{or}}$ two scientific witnesses, to be named in the notice hereinafter mentioned, may be at liberty at all seasonable times, and as often as may be requisite, upon giving three days' previous notice in writing to the defendants' solicitors, to enter into and upon the business premises of the defendants, where the process of decorating or printing tin or metal plates is carried on by the defendants as stated in the plaintiff's statement of claim in this action, and to inspect and examine Scientific witnesses.

(*c*) *Plimpton* v. *Spiller*, M.R., 16th March, 1876, B. 424.

(*d*) *Plimpton* v. *Malcolmson*, M.R., 4th March, 1875, B. 421.

there the whole of the process by which such printed and decorated tin and metal plates are manufactured by the defendants; and to take, on paying the reasonable charges of the
Take samples. defendants for the same, samples of such plates, and upon and during such inspection to make such observations as may be necessary and expedient for the purpose of obtaining full information and evidence of the mode by which such plates are manufactured by the defendants; and that the defendants may be ordered to permit the plaintiff, his solicitors and agents, and two persons to be named as aforesaid, to enter into and upon their said premises for the purposes aforesaid, and that
Costs. the costs of this application may be costs in the action (*e*).

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7. Inspection, where for a Process and to take Samples.

[*Title as above.*]

[*Formal parts as above*] to enter in and upon the business premises of the defendants, where the manufacture of is carried on by the defendants, as mentioned in the statement of claim in this action, and to inspect and examine there the machines used by the said defendants in the manufacture of , and the process by which is manufactured by the
Machines to be worked. Samples. said defendants, and that the said machines $\frac{\text{or}}{\text{and}}$ process may be put to work upon such inspection, and that the plaintiff, his servants or agents, may be at liberty to take samples of the made or to be made by the said machines or process, upon paying to the defendants their reasonable charges for the same.

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8. Inspection of Plaintiff's Patented Process by Defendant.

[*Form of Order given in Griffin, P. C., at p.* 106.]

"That A. B. and one other indifferent person appointed by him and C. D., one of the defendant's solicitors, be at liberty

(*e*) *Flower* v. *Lloyd*, 1876, A. 1254; as to inspection, see p. 310, *et seq.*

at all such times and as often as in the opinion of the said A. B. be requisite, on giving 3 days' notice to the plaintiffs to enter into some business premises to be selected by the plaintiffs, where the process or mode of working referred to in the specification mentioned in the Statement of Claim can be seen at work, and to inspect and examine there the whole of the machinery fitted in such mill, and to take such samples of the finished and unfinished products of the working of such machinery as in the opinion of the said A. B. may be necessary for the purposes of this action, And it is ordered that such machinery be put to regular work upon such inspection. The costs of this application are to be costs in the action (*f*).

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9. Inspection, and Order for Delivery by Defendant of Samples for Analysis.

[*Title as above.*]

[*Formal parts as above*] may be at liberty, upon giving three days' previous notice in writing to the defendant's solicitors to enter upon the defendant's premises, and to inspect the type there used by the said defendants in their printing processes, as mentioned in the statement of claim in this action; and that the defendant may be ordered to permit the plaintiff, his solicitors and agents, and one person to be named as aforesaid, to enter upon his premises for the purpose aforesaid, and that said defendant may be further ordered to deliver to the plaintiff a competent part of the said type so used, on payment of a fair price for the same, and that the costs of this application may be costs in the action (*g*).

Samples for analysis.

(*f*) *The Germ Milling Co.* v. *Robinson*, 55 L. J., Ch. 287; 3 P. O. R. at p. 14.

(*g*) This was the notice of motion in *The Patent Type Founding Co.* v. *Walter*, reported at 5 H. & N. 192; 29 L. J., Ex. 207; 6 Jur. N. S. 103; 1 L. T. Rep., N. S. 382. The samples of type in this case were required for the purpose of analysis.

Notice of motion for inspection must be supported by affidavit; a fair *prima facie* case of validity and infringement must be made out. The order for inspection is frequently made upon the application for interlocutory injunction, and is sometimes made to include a cross order that the plaintiff shall permit the defendant to see and inspect the patented machine at work, and also to take samples: *Amies* v. *Kelsey*, 22 L. J., Q. B. 84. The affidavit should show that there is such property or machinery as is required to be inspected, that the

10.—Order for Inspection of Defendant's process by Experts.

Order for experts.

Let I. and C., of, &c., be at liberty at all reasonable times, and as often as requisite, on giving three days' notice to the defendants, to enter into the business premises of the defendants where the process of decorating or printing tin and metal plates is carried on by the defendants, as stated in the plaintiff's statement of claim, and mentioned in the said affidavits, or some of them, and to inspect and examine there the whole of the process by which such printed and decorated tin (*h*) and metal plates are manufactured by the defendants, and to take, on paying the reasonable charges of the defendants for the same, samples of such plates, and upon and during such inspection to make such observations as may be necessary and expedient for the purpose of obtaining full information and evidence of the mode by which such plates are manufactured by the defendants (*i*).

Full information.

11.—Statement of Claim.

Form 1.

In the High Court of Justice.

Chancery [*or* Queen's Bench] Division.

Between A. B. . . . . Plaintiff,

and

C. D. . . . . Defendant.

Statement of Claim.

Infringement.

1. The defendant has infringed the plaintiff's patent, numbered , granted for the term of fourteen years from the

inspection is necessary for the purpose of the action; *Shaw* v. *Bank of England*, 22 L. J., Ex. 26. It should also show what the patent is for, so that the Court or judge may see that there is necessity for the inspection. The order will not be granted on the plaintiff's application, unless the Court is satisfied that it is essential to enable him to prove his case: *Batley* v. *Kynock*, L. R., 19 Eq. 90; *Meadows* v. *Kirkmann*, 29 L. J., Ex. 205. In *The Singer Manufacturing Company* v. *Wilson*, 13 W. R. 560, the Court refused to give the plaintiff inspection of the defendant's stock before judgment, but ordered the defendant to verify by affidavit all the different kinds of sewing machines which he had sold since the last disclaimer entered by the plaintiff, and to produce one of each sort for inspection.

(*h*) No order will be made on this application for the inspection of books, for which a separate order must be obtained: *Vidi* v. *Smith*, 3 E. & B. 969.

(*i*) *Flower* v. *Lloyd*, C.A., 5th July, 1876, A. 1254.

day of , for an invention entitled "Improvements in the manufacture of iron and steel."

2. The plaintiff was the first and true inventor of the said invention. First inventor.

3. The plaintiff claims an injunction to restrain the defendant from further infringement, and that accounts may be taken of the sales and profits made by the defendant by infringing the said letters patent [*or* in the alternative, £100 damages]. Injunction, damages, account.

Particulars of breaches are delivered herewith.

[*Place of trial.*]

Signed.

Delivered the day of , 18 .

Statement of Claim.

Form 2.

In the High Court of Justice.

Chancery [*or* Queen's Bench] Division.

Writ issued .

Between A. B. and C. and C. D . . Plaintiffs,

and

E. F. . . . . Defendant.

Statement of Claim.

1. The plaintiff C. D., by virtue of an assignment dated day of , 18 , and duly registered, is the owner of certain letters patent, No. , of 18 , granted to X. Y. for "Improvements in the extracting mechanism of drop-down small arms," of which the said X. Y. is the first and true inventor. The plaintiffs A. B. and C. are the sole licensees under the said letters patent. Assignment. Licence.

2. The defendant is a gun manufacturer carrying on business at in the county of .

3. The said letters patent are valid and of full force and effect.

4. The defendant has for some time past manufactured and sold both guns and gun actions fitted with ejecting mechanism made in infringement of the plaintiff's letters patent.

The Plaintiffs' Claim.

Injunction.

1. An injunction to restrain the defendant, his servant and agents, from making, using, and vending guns containing ejector mechanism or portions thereof made in infringement of the plaintiffs' letters patent, or made so as to be a mere colourable imitation of the invention therein contained.

Account or damages.

2. An account of profits or, at the option of the plaintiffs, an enquiry as to damages.

Destruction or delivery of infringing articles.

3. Destruction of or delivery up by the defendant to the plaintiffs of all guns or portions of guns made in infringement of the plaintiffs' rights.

4. Costs.

Signed.
Delivered the day of 18 .

Statement of Claim.

Form 3.

[*Formal parts as above.*]

1. By assignment dated day of , X. Y. assigned to the plaintiff certain letters patent granted to him for an invention entitled "Improvement in Ruffling Mechanism for Sewing Machines," dated day of , and numbered 13,503.

2. The said letters patent are valid.

3. The defendant has infringed and threatened to infringe the said letters patent in the manner and at the times mentioned in the particulars of breaches delivered herewith.

12.—Particulars of Breaches (*k*).

Form 1.

In the High Court of Justice.

Chancery [*or* Queen's Bench] Division.

Between A. B. . . . . Plaintiff,

and

C. D. . . . . Defendant.

The following are the particulars of the breaches of the letters patent complained of in the statement of claim herein :—

Using.

1. The defendant on or about the day of at his

(*k*) See p. 286 *et seq.*

factory at , in the county of , manufactured acetate of soda by the process and with the use of the machinery and appliances which form the subject-matter of the plaintiff's patent.

2. On the day of the defendant sold to John Smith of , one parcel containing tons of acetate of soda manufactured by the defendant by the process and with the use of the machinery and appliances which form the subject-matter of the plaintiff's patent. Selling.

3. On the day of the defendant sold, &c.

Yours, &c.,
X. Y.,
Plaintiff's solicitor.

To Mr. E. F.,
Defendant's solicitor.

Particulars of Breaches.

Form 2.

[*Formal parts as above.*]

1. The defendants have since the date of the patent No. of 18 , 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 (*l*).

Particulars of Breaches.

Form 3.

[*Formal parts as above.*]

1. The defendant, on or about the day of , manufactured at his factory at , in the county of , sewing Making.

(*l*) Settled by C.A., in *Casella* v. *Levinstein*, 8 P. O. R. at p. 476.

machines, which sewing machines were infringements of the plaintiff's patent.

Selling. 2. The defendant, on or about the day of at his shop at , in the county of , sold a sewing machine to , which sewing machine was an infringement of the plaintiff's patent.

Using. 3. The defendant, on or about the day of , in his workshop at , in the county of , by himself, his servants or agents, used a sewing machine, which sewing machine was an infringement of the plaintiff's patent (*m*).

(*Further and better particulars of breaches or objections obtained by summons, common form.*)

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13. Order for Delivery of Further Particulars of Breaches.

It is ordered that the plaintiffs within days from the date of this order deliver to Messrs. , solicitors for the defendants, further and better particulars in writing of the breaches alleged to have been committed by the defendant, upon which the defendants intend to rely on the trial of the questions directed to be tried by the said order dated, &c.,

Pages and lines of specification. specifying by reference to the pages and lines the part of the plaintiffs' specification in respect of which such alleged breaches have been committed; and let the time within which the defendants are to deliver to the plaintiffs' solicitors particulars in writing of the objections to the letters patent in the plaintiffs' writ mentioned, be enlarged until the twenty-first day after the delivery of such further and better particulars, costs of application to be costs in the cause (*n*).

(*m*) In the case of a patent for a combination, or where there are several distinct claims, the particulars of breaches should specify what portion of the combination has been infringed, or as to which of the claims infringement is alleged.

(*n*) *Lamb* v. *Nottingham Manufacturers' Co.*, M.R., 14th March, 1874, B. 776.

14. Statement of Defence.

In the High Court of Justice.
Chancery [Queen's Bench] Division.
Between A. B. . . . . Plaintiff,
and
C. D. . . . . Defendant.

Statement of Defence.

1. The defendant did not infringe the patent.
2. The invention was not new.
3. The plaintiff was not the first and true inventor.
4. The invention was not useful.
5. [*The denial of any other matter of fact affecting the validity of the patent.*]
6. The patent was not assigned to the plaintiff.

Particulars of objections are delivered herewith.

Signed.

Delivered the day of , 18 .

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15. Particulars of Objections in Actions for Infringement, and on Petition for Revocation (*o*).

In the High Court of Justice.
Chancery [*Queen's Bench*] Division.
Between A. B. . . . . Plaintiff,
and
C. D. . . . . Defendant.

Take notice, that the defendant [*or petitioner*], will, on the trial of this cause, rely on the following objections to impeach the letters patent in the statement of claim [*or petition*] herein mentioned.

1. That the plaintiff [*or alleged inventor*] was not the first and true inventor of the said invention within this realm. First inventor.

2. That the alleged invention was not subject-matter of a grant of letters patent, within the meaning of the 6th section of the Statute of Monopolies (that is, the act of the 21st year of King James I. ch. 3). Subject-matter.

(*o*) See p. 293 *et seq.*

Utility. 3. That the alleged invention was not useful to the public.

Insufficiency of specification. 4. That the specification of the said invention was not sufficient, and was unintelligible.

Novelty. 5. That the alleged invention was not a new invention as to the public use and exercise thereof within this realm.

Prior publication in specification. 6. That the alleged invention was published at the Patent Office in a specification, dated the day of , and numbered , prior to the date of the said letters patent.

Prior publication in book. 7. That the alleged invention was, prior to the date of the said letters patent, published in a book, which on the day of , was in the British Museum Library and open for public inspection; the title of the said book was , and the pages of the said book particularly referred to are numbered and .

Prior user. 8. That the alleged invention was used prior to the date of the said letters patent, in the following manner, that is to say, by , at , on the day of .

Part old. 9. That a material part of the alleged invention, namely, that part which refers to , was not new at the date of the said letters patent, having been used by , at , on the day of .

Combination not distinguished. 10. That the plaintiff does not sufficiently distinguish and point out in his specification which of the matters and things therein mentioned he claims to have invented, and which he does not claim to have invented, or admits to be old.

11. The defendant will also rely, as examples of prior publication, upon the following specifications, filed with the Commissioners of Patents, and will object that the specification of the plaintiff's patent claims some of the matters thereby patented or specified, that is to say [*enumerate specifications*].

Yours, &c.,

L.

Defendant's Solicitor or Agent.

To Mr. A. B.,
Plaintiff's Solicitor.

16. ORDER FOR DELIVERY OF FURTHER PARTICULARS OF OBJECTIONS.

Let the order dated 6th July, 1876, whereby it was ordered that the defendants should on or before the 20th July, 1876, deliver to the plaintiffs further and better particulars of objections, stating therein the names and addresses of the persons by whom, and the places where, and the dates at, and the manner in which the process of, &c., was known and publicly practised in England before the 8th March, 1864 [*date of letters patent*], and that in default thereof the words from, and after the words "in a dry state," in the 6th paragraph of the statement of defence, which had been delivered in this action, to the end of the said 6th paragraph, should be struck out; and in that case no evidence should be given by the defendants on the trial of this action of such prior publication, and that defendants should pay to the plaintiffs their costs of the application, to be taxed, &c., BE VARIED, and as varied be as follows:—Let the defendants on or before the deliver to the plaintiffs further and better particulars of objections under the paragraph of the statement of defence on which they mean to rely at the trial, stating therein the place or places at or in which, and in what manner, the process of printing upon tin or metal surfaces by direct impression by means of damp stones is alleged to have been used or published prior to the day of , 1864 (*p*).

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17. ORDER FOR LIBERTY TO AMEND PARTICULARS OF OBJECTIONS BY ADDING FRESH OBJECTIONS UPON TERMS.

Let the plaintiff, within six weeks from the date of this order elect whether he will discontinue this suit, and if the plaintiff shall elect to discontinue this suit, and shall give notice thereof to the defendants within six weeks from the date of this order, refer it to the taxing master to tax the defendants their costs up to and including the 23rd February, 1875 (*delivery of the original particulars of objection*), and to tax

(*p*) *Flower* v. *Lloyd*, C.A., 2nd August, 1876, A. 1523; 25 W. R. 17. Varying order of V.-C. B., 6th July, 1876, A. 1252.

the plaintiff's costs of this suit subsequently to the said 23rd February, 1875, to the date of this order, and the taxing master is to set off the costs of the plaintiff and of the defendants to be so respectively taxed, and certify to which of them the balance after such set-off is due, and let such balance be paid by the party from whom, to the party to whom the same shall be certified to be due. And if the plaintiff shall not give notice to the defendants of his discontinuance of this suit within the time aforesaid let the defendants be at liberty to add to the particulars of objections to the validity of the plaintiff's letters patent, &c., which have been already delivered by the defendants, the following further objections to be relied on by the defendants at the hearing of this cause, viz. (*particulars of new objections proposed to be introduced by amendment*). And let defendants, Moules, &c., Co. pay to the plaintiff, A. F. Baird, his costs of this application to be taxed, &c., liberty to apply (*q*).

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18. Interrogatories.

Interrogatories may be delivered in the common form, subject to the Rules of 1883, by either party, notwithstanding the delivery of particulars. Enquiry may be made by the plaintiff as to the names and addresses of the persons by whom prior user is alleged to have been made as well as the places where the prior user has taken place (*r*).

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19. Order for liberty to apply for Leave to amend Specification while Action pending.

That the plaintiff be at liberty to apply to the Patent Office for leave to amend his specification on which his letters patent of the 12th day of February, 1879, No. 558 in the statement of claim mentioned, were granted, and his specification on which his letters patent of the 9th day of June, 1880, No. 2333 in the statement of claim mentioned, were granted by way of

(*q*) See *Baird* v. *Moules, &c., Co.*, L. R. 17 Ch. D. 139 (*n*).

(*r*) *Birch* v. *Mather*, L. R., 22 Ch. D. 629; see p. 303 *et seq.*

disclaimer, provided that the specifications as amended shall not be receivable in evidence in this action. And the costs of and occasioned by any such application of the plaintiff shall be the defendant's costs in any event. And it is ordered that the costs of this motion shall be costs in the action.

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20. Order for Reference under Sect. 57 of the Judicature Act, 1873.

[*Formal parts.*]

Upon hearing counsel for the plaintiff, and for the defendant [*or* This cause coming on for trial], It is ordered that the following questions

1. As to whether the invention, the subject of his letters patent of the day of , was or was not, at the date of the said letters patent, now as to the public use and exercise thereof within this realm ; — Novelty.
2. Whether the plaintiff was the true and first inventor of the said invention ; — First inventor.
3. Whether the specification of the said letters patent in the pleadings mentioned does or does not particularly describe the nature of the said invention, and in what manner the same is to be performed pursuant to the proviso in that behalf contained in the said letters patent ; — Sufficiency of specification.
4. Whether the defendant has, or has not, infringed the said letters patent, in or by any or either, and which of the apparatus manufactured by him, as in his statement of defence delivered in this action mentioned, or in any other manner ; — Infringement.
5. Whether the undisclaimed portions of the said alleged invention were used in the United Kingdom at the date of the said letters patent ; — Disclaimer.

be referred, to be tried before one of the official referees [*or* a special referee], who shall have all the powers as to certifying and amending of a judge at nisi prius, and shall make his report of and concerning the matters ordered to be tried as aforesaid, pursuant to the statute ; and it is further ordered that the said referee shall be at liberty, if he shall think fit, to

examine the said parties to this action, and their respective witnesses upon oath or affirmation, and that the said parties do and shall produce before the said referee all books, deeds, papers, and writings in their or either of their custody or power, relating to the matters ordered to be tried as aforesaid. And it is further ordered, that neither the plaintiff nor the defendant shall bring or prosecute any action against the said referee, or against each other of and concerning the matters ordered to be tried as aforesaid. And that if either party shall by affected delay, or otherwise, wilfully prevent the said referee from making his report, he or they shall pay such costs to the other as the said Court, or any judge thereof, shall think reasonable and just. And it is further ordered, that in the event of the said referee declining to act, or dying before he shall have made his report, the said parties may, or if they cannot agree, one of the judges of the said High Court may, upon application of either side, appoint a new referee.

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21. Order for Trial of a representative Case, for the purpose of determining the Question of Validity.

Undertaking to be bound.

And the plaintiff, F., by his counsel, undertaking to be bound by the result of the trial hereinafter directed, and the said above-mentioned defendants, by their respective counsel, admitting that the letters patent in the pleadings mentioned are duly vested in the plaintiff, and consenting to be bound by the result of the trial hereinafter directed, and that the said trial shall be conducted by B., G., B. and W., four of the above-named defendants, on behalf of, and as representing all the defendants in the said suit; let, by consent of all the said several defendants in the above-mentioned suits, the said defendants, B., G., B. and W., be the defendants in the said trial, and let the said defendants, B., G., B. and W., on or

Delivery of objections.

before the day of , pursuant to the statute, deliver to the plaintiff their objections to the validity of the said patents; and let, by the consent of the plaintiff and the said defendants, the following question be tried before his lordship without a jury, that is to say, whether the patent in the pleadings men-

tioned, dated, &c., is a valid patent; and the plaintiff is to proceed to such trial on such day, &c. Adjourn the consideration of the costs on the several applications to the judge and to his lordship until after the said trial; and let all further proceedings in the above-mentioned causes be stayed until after the said trial, and any of the defendants in any suits commenced by the plaintiff with respect to infringement of the said patent are to be at liberty to apply to be made parties to this order (s). Liberty to apply.

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22. FINAL JUDGMENT—RECITAL OF EVIDENCE—INJUNCTION —INQUIRY AS TO DAMAGES—ORDER FOR DESTRUCTION —COSTS AS BETWEEN SOLICITOR AND CLIENT—LIBERTY TO APPLY.

The following Order was settled by the late Master of the Rolls, Sir George Jessel, personally, in the case of Plimpton v. *Spiller, reported L. R. 6 Ch. D.* 412.

In the High Court of Justice. 1876. P. 69.

Chancery Division.

Thursday the 19th day of April, 1877.

Master of the Rolls.

Mr. Clowes, Reg.

Between J. L. P. . . . . Plaintiff,

and

A. F. S. and T. C. . . Defendants.

This action, coming on for trial the 11th and 12th days of April, 1877, and this day before this Court, in the presence of counsel for the plaintiff and the defendants, upon hearing an order, dated the 4th August, 1876, an affidavit of A. F. S. filed the 15th March, 1876; an affidavit of J. I., filed the 16th February, 1877, the bill, answers, orders, record for trial, and the certificate of the Master of the Rolls, the judge before whom the questions of fact were tried, that the validity of the letters patent of the 25th day of August, 1865, granted to A. V. N., and numbered 2190 hereinafter mentioned, came in Evidence Certificate

(s) *Foxwell* v. *Bradbury, &c.*, 80 other titles, L.C., 7th December, 1863, A. 2391.

question in the cause of P. *v.* M., 1875, P. 39, and upon hearing the said letters patent, and a certified printed copy of the specifications and drawings, filed under the said letters patent, and the indenture of assignment, dated the 10th day of January, 1866, and made between the said A. V. N., therein described, of the one part, and the plaintiff, J. L. P., of the other part, and registered in the Great Seal Patent Office on the day of the date thereof, the printed shorthand note of the evidence taken orally before this Court, on the trial of the said action of P. *v.* M., 1875, P. 39; of A. V. N., F. J. B., J. I., J. L. P., E. A. C., R. C. M., W. W. H. and E. J. C. W. and the exhibits marked 1, 2, and 4, then produced; the examination of H. J. A., W. B. P., W. G. A., A. F. S., J. I., T. M. W., G. B., C. P. B. S., E. E., W. S. M. and H. L., taken orally before this Court, on the 11th, 12th, and 19th days of April, 1877, and the exhibits marked: 1. 2. 4. A. B. C. D. E. F. G. H. I. L. M. N. O. P. E. E. 2. S. 1. S. 2. E. E. 1. E. E. 3. W. S. M. 1. W. 1. and W. 2. and the two catalogues and donation book produced to W. G. A., and the volume of the year 1863, of Jewitt's Book of Illustrations to the Report of the American Commissioners of Patent, and the "Scientific American" for the years 1863 and 1865; the records from the Court of Bankruptcy of an assignment, dated the 11th August, 1865, by W. S. M., for the benefit of his creditors, and of a composition deed by the said W. S. M., in the year 1869, and what was alleged by counsel on both sides, and this Court being of opinion that the plaintiff has proved the breaches complained of, in the particulars of breaches delivered by him in this action, doth order that an injunction be awarded to restrain the defendants, their servants, agents, and workmen during the continuance of the letters patent, granted to A. V. N., dated the 25th day of August, 1865, and numbered 2190, and any extension of the term thereof from using, or exercising, or causing or permitting to be used or exercised, the invention described in the hereinbefore mentioned specification and drawings, filed under the said letters patent, and from selling, letting for hire, or making any profitable use, or permitting the sale, letting for hire, or profitable use of any roller or runner skates not made by the plaintiff, or his licensees, and having applied thereto rollers or runners in manner described

Proof of breaches.

Injunction.

and for the purposes mentioned in the said specification, or fitted with any apparatus for causing the skate to run in a curved line, in the manner described in the said specifications and drawings, or differing therefrom only colourably, and by the substitution of more mechanical equivalents, and it is ordered that it be referred to the official referee in rotation, to inquire what sum of money is fit to be awarded to the plaintiff, to be paid by the defendants in respect of any damage sustained by the plaintiff up to the day of the date of this order, from the manufacture, sale, or letting for hire, of skates, being the same as the "Spiller" Skates, and "Wilson" Skates, in the pleadings in this action, and in the said order dated the 4th August, 1876, mentioned, or of any other skates made in infringement of the said letters patent, or otherwise from the sale, or use by the defendants of the said invention, or any apparatus in imitation of, or being only a colourable deviation from the said invention. And it is ordered, that the defendants, A. F. S. and T. C., do pay to the plaintiff, J. L. P., such sum of money as upon such inquiry shall be found fit, to be awarded to the plaintiff for such compensation as aforesaid, within twenty-one days after service of the official referee's report of the result of the said inquiry. And it is ordered, that the defendants, A. F. S. and T. C., do deliver up on oath to the plaintiff, or break up, or otherwise render unfit for use, all roller skates, or parts of roller skates so manufactured, or let for hire by, or by the order, or for the use of the defendants in infringement of the said letters patent as aforesaid, which are in the possession, custody, or power of the defendants, or either of them, or their, or either of their, servants or agents. And it is ordered, that the said defendants, A. F. S. and T. C., do pay to the plaintiff, J. L. P., his full costs, to be taxed by the taxing master as between solicitor and client, including all costs, charges, and expenses. And any of the parties are to be at liberty to apply, as they may be advised.

Mechanical equivalents.

Enquiry as to damages.

Payment of amount.

Destruction.

Full costs.

Liberty to apply.

W. C.

Entered.
G. L.

Registrar's Office, Entering Lib. B. Seal.

23. Judgment for Perpetual Injunction under the Patent Law Amendment Act, 1852, restraining Infringement of Patented Skates after Trial without Jury, with account of Sales and Profits, Discovery, Delivery up, or Destruction.

Injunction.

Let an injunction be awarded to restrain the defendant, his servants, &c., during the continuance of the said letters patent granted to N., dated, &c., from using or exercising, or causing, or permitting to be used and exercised the invention described in the hereinbefore-mentioned specification and drawings of the said N., and from selling, letting for hire, or making any profitable use, or permitting the sale, letting for hire, or profitable use, of any roller or runner skates not made by the plaintiff or his licensees, and having applied thereto rollers or runners in manner described and for the purposes mentioned in the said specification, or fitted with any apparatus for causing the skate to run in a curved line in the manner described in the said specification and drawings, or differing therefrom only colourably and by the substitution of mere mechanical equivalents; and let an account be taken of all roller skates being the same as the skates sold by the defendant to G., as in the pleadings mentioned, or otherwise made in infringement of the said letters patent, which have been manufactured, or sold, or let for hire, by or by the order, or for the use or profit of the defendant and also of the gains and profits made by the defendant by reason of such manufacture, sale, or letting for hire: and let the defendant within [seven] days after the service upon him of the chief clerk's certificate of the result of such account pay to the plaintiff the amount of such gains and profits, and let the defendant forthwith upon oath deliver to the plaintiff, or break up, or otherwise render unfit for use, all roller skates or parts of the roller skates so manufactured or let for hire, by or by the order or for the use of the defendants in infringement of the said letters patent as aforesaid, which are in the possession, custody, or power of the defendant, or his servants or agents. Defendant to pay to plaintiff costs of suit (*l*).

Account of profits.

Destruction.

Ordinary costs.

(*l*) *Plimpton* v. *Malcolmson*, M.R., 28th Jan., 1876, B. 381.

24. JUDGMENT FOR PERPETUAL INJUNCTION UNDER THE PATENT LAW AMENDMENT ACT, 1852, RESTRAINING INFRINGEMENT AS TO PATENTED ARTICLES (PULLEYS) AFTER REFUSAL OF MOTION FOR NEW TRIAL AND FOR DELIVERY UP OF THE ARTICLES MADE BY DEFENDANT TO BE SPECIFIED BY AFFIDAVIT.

Let an injunction be awarded to restrain the defendant, S., during the continuance of the letters patent, and any extension of the term thereof, from using or exercising, &c., and from in any manner infringing the rights and privileges granted by the said letters patent; defendant within seven days to specify by affidavit what apparatus constructed or arranged according to the said invention and improvements, or only colourably differing from those described in the said specification and drawings, have been manufactured by or by the order or for the use of the said defendant as in the writ mentioned, and are in the possession, custody or power of the said defendant or his servants or agents; defendant within [seven] days after filing such affidavit to deliver up to the plaintiffs all such pulleys or apparatus (*u*). Injunction. Delivery up of articles.

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25. JUDGMENT FOR PERPETUAL INJUNCTION UNDER THE PATENT LAW AMENDMENT ACT, 1852, RESTRAINING INFRINGEMENT OF PATENT FOR MACHINERY AFTER TRIAL OF ISSUES BY A JURY—DISCOVERY—ACCOUNT OF PROFITS—CERTIFICATE FOR FULL COSTS.

And the parties having, on the day of , proceeded to a trial of the questions of fact directed to be tried by the order dated, &c., before this court by a jury, when the jury found that [*finding for the plaintiff upon all the issues*]. And upon reading the letters patent, dated, &c., and the complete specification, dated, &c., in the writ respectively mentioned, an affidavit of the plaintiff's, &c. [*enter evidence*], this court doth order [*and*] decree [*and adjudge*] that an injunction be awarded to restrain the defendant, O., his agents, servants, &c., during the subsistence [*continuance*] of the plaintiff's Findings of jury. Evidence. Injunction.

(*u*) *Tangye v. Stott*, V.-C. W., 12th Feb., 1866, B. 461.

letters patent in the writ mentioned, or any extension thereof, from manufacturing, or selling, or disposing of, or using any machine of the same construction as that supplied to him by the W. B. Co., in the said writ mentioned, or only colourably differing therefrom, or being an infringement of the plaintiff's said patent, and from in any way infringing the plaintiff's said patent; and it is ordered that the defendant, O., do, within [*seven*] days after service of this decree, make and file an affidavit stating what machines of the same construction as that supplied by him to the said W. B. Co., including such machines, are in his possession or power; and the plaintiffs are to be at liberty to inspect and mark the same for the purpose of identification. And it is ordered that an account be taken of the profits made by the defendant by making, using, selling, or disposing of the machines supplied by him to the said W. B. Co., or any other machine of the same construction therewith, or otherwise by an infringement of the plaintiff's patent. And it is ordered that the defendant O., do, within one month after the date of the chief clerk's certificate, pay unto the plaintiffs, N. and C., what shall be certified to be the amount of such profits. Direction for certificate that the validity of the plaintiff's patent came in question. And it is ordered that the defendant, O., pay to the plaintiffs their costs of this cause up to and including this hearing, and their costs of the trial by jury of the questions of fact directed to be tried by the said order, dated, &c., including the costs of a special jury; such costs to be taxed, &c. Liberty to apply in chambers touching subsequent costs, and otherwise to apply as advised (*x*).

Order to inspect and mark.

Account.

Costs.

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26. JUDGMENT FOR THE DEFENDANT.

[*Formal parts as above.*]

The action having on the day of been tried before Mr. Justice [and a common or special jury of the county of , and the jury having found a verdict for the defendant on the issues] and the said Mr. Justice having ordered that judgment be entered for the defendant on the issues [*cer-*

(*x*) *Needham* v. *Oxley*, V.-C. W., 24th June, 1863, 1395.

tificate as to particulars of objections as in form] : therefore it is adjudged that the plaintiff recover nothing against the defendant, and that the defendant recover against the plaintiff £ , for his costs of defence.

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27. CERTIFICATES NECESSARY UNDER SECT. 29, SUBSECT. 6, OF THE PATENTS, &C., ACT, 1883.

[*Form of judgment for perpetual injunction, accounts of profits and damages as above.*]

It is certified that the plaintiff has proved to the satisfaction of the Court the breaches mentioned in the particulars of breaches delivered by him, and numbered respectively, 1, 2, 3, 4, and 5, and that the particulars numbered 6 and 7 were, under the circumstances of the case, reasonable and proper.

[*Form of judgment for defendant as above.*]

It is certified that the defendant has proved to the satisfaction of the Court the objections mentioned in the particulars of objections delivered by him, and numbered respectively 1, 2, 3, 4, and 5, and that the objections numbered 6 and 7 were, under the circumstances, reasonable and proper.

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28. CERTIFICATE OF VALIDITY UNDER SECT. 31 OF THE PATENTS, &C., ACT, 1883.

I hereby certify, pursuant to the 31st section of the Patents, Designs, and Trade Marks Act, 1883 (46 & 47 Vict. c. 57), that upon the trial of this action, the validity of the letters patent, in the pleadings mentioned, dated the 28th November, 1878, and numbered 4,847, granted to F. J. C., amended by disclaimer allowed 12th November, 1884, and now vested in the Edison and Swan United Electric Light Co., Limited, came into question.

Dated this 16th day of July, 1888.

E. E. KAY.

II.—FORMS IN AN ACTION TO RESTRAIN THREATS.

29. Indorsement on Writ.

The plaintiff's claim is:—

Injunction.

1. For an injunction restraining the defendant from, by circulars, advertisements, or otherwise, threatening to take legal or other proceedings against persons manufacturing, using, or selling an alleged invention of the defendants, to wit, . The said threats being to the prejudice of the plaintiff.

2. For damages in respect of the injury sustained by the plaintiff by reason of the circulars, advertisements, or other threats of the defendant to take legal or other proceedings against persons manufacturing, using, or selling the said alleged invention.

30. Interlocutory Injunction to Restrain Threats.

Upon motion &c., let an injunction be granted to restrain the defendant personally, or by his servants, agents, and workmen, by circulars, letters, or otherwise, from threatening any person with legal proceedings or liability in respect of the manufacture, use, sale, or purchase of a certain tap union of which the plaintiff was the patentee, and from interfering by such threats or otherwise with the manufacture, use, sale, or purchase of the plaintiff's invention (*y*).

[*Another Form.*]

A particular circular.

Upon motion, &c., let an injunction be granted to restrain the defendant personally or by his servants, agents, and workmen, until further order, from issuing the circular dated 15th December, 1888, and from, by means of circulars, letters, or otherwise, threatening any person with proceedings or liabiiity in respect of the following papers manufactured by the plaintiff (*z*).

Other forms in an action to restrain threats are similar to those given under the heading of "Forms in an Action for Infringement."

(*y*) *Challender* v. *Royle*, L. R. 36 Ch. D. 425.

(*z*) *Colley* v. *Hart*, 6 P. O. R. 17.

III.—FORMS IN A PETITION FOR REVOCATION.

31. Petition for Revocation.

In the High Court of Justice.

Chancery [*or* Queen's Bench] Division.

In the matter of letters patent granted to of , dated , and numbered , and in the matter of the Patents, Designs, and Trade Marks Act, 1883, sect. 26.

To Her Majesty's High Court of Justice.

The humble petition of Sir , Her Majesty's Attorney-General in England (or Ireland, or Lord Advocate in Scotland) (or other person authorised to petition by sect. 26, sub-sect. 4, of the Patents, &c., Act, 1883) (*a*).

Shewеth as follows :—

1. *Your petitioner is duly authorised by Her Majesty's* Authority. *Attorney-General in England* (*or Ireland, or Lord Advocate in Scotland*) (*b*).

1. Letters patent, dated the , 18 , have been granted Grant. to , for [*title of invention*]. The said letters patent were sealed on the .

2. On the said [*date of letters patent*], the said [*name of grantee*] was not the true and first inventor of the said invention. Not first inventor.

3. The said letters patent were obtained by the said [*name of grantee*], in fraud of the rights of your petitioner, who was the true and first inventor of such invention, [*or*, in fraud of the rights of J. S., who was the true and first inventor of the said invention. The said J. S. died on the day of , intestate, and letters of administration of his estate were granted to your petitioner out of the Probate Division of this Honourable Court, on the day of]. Obtained in fraud of petitioner.

4. The said invention was not at the time of the date of the said letters patent a new invention as to the public use and Invention not new.

(*a*) If the petition be presented by any person under sect. 26, sub-sect. 4 (c), (d), or (e), the name and address, and description of the petitioner, must appear.

(*b*) This clause must be inserted where the petition is presented under sect. 26, sub-sect. 4 (b): *Glazbrook* v. *Gillatt*, 9 Beav. 492.

exercise thereof within this realm, for the reasons set forth in the particulars of objections herewith (*c*).

Had been used by petitioner.

5. Your petitioner [*or person under or through whom he claims an interest in any trade, business, or manufacture*] had prior to the date of the said letters patent publicly manufactured, used, or sold within this realm the alleged invention (or a part of the alleged invention, to wit, such part as relates to, &c., &c.), in respect of which such letters patent were granted as aforesaid.

Not subject matter for patent.

6. The said alleged invention was not any manner of new manufacture, the subject of letters patent and grant of privilege within sect. 6 of the Statute of Monopolies.

Your petitioner humbly prays that the said letters patent may be revoked, 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.

It is intended to serve this petition on (*d*) , .

Other forms relevant to a Petition for Revocation will be found among the Forms in an Action for Infringement.

IV.—FORMS USED IN OBTAINING THE FIAT OF THE ATTORNEY-GENERAL.

32. The Memorial of the Petitioner (*e*).

In the matter of the Patents Acts, 1883—88,
and
In the matter of letters patent granted to A. B., for an invention entitled No. of 18 .

Previous proceedings.

1. By judgment delivered 17th March, 1893, in an action in Her Majesty's High Court of Justice, Queen's Bench (or

(*c*) Any objection which can impeach the validity of a patent is a ground for revocation, and should be set forth in the petition. See p. 267 *et seq.*

(*d*) Here insert the names and addresses of all persons who, either as original grantees or by assignment, are registered under sect. 23 of the Patent, &c., Act, 1883, as interested in the patent.

A copy of the petition must be served personally, unless an order has been obtained for substituted service. The original must be shown if demanded. An order may be obtained for service out of the jurisdiction; see Daniell's Chancery Practice.

(*e*) The memorial must be drawn upon Judicature paper; see practice on obtaining fiat of A.-G., p. 269, *ante*.

Chancery) Division, in which the said A. B. was plaintiff and your memorialist was defendant, the claim in the said action being to restrain infringement of the said letters patent and for damages. The Right Hon. Lord Justice Kay held that the said letters patent were void, for that the specification disclosed no subject matter for letters patent, and for that the invention in the specification relating thereto described and claimed had been anticipated by one Louis Edward Atkins between October 9th and November 25th, 1882. And also by a specification filed by your memorialist in the Patent Office, No. of 18 , and judgment was given in the said action for the defendant with costs. And upon appeal of the plaintiff from the said judgment to the Court of Appeal, the appeal was dismissed with costs without calling upon the counsel appearing for the respondent (your memorialist).

Licensees.

2. A large number of the manufacturers of drop down small arms in the United Kingdom are licensees of the said letters patent, and are therefore estopped from denying the validity of the said letters patent.

Grantee of Letters Patent.

3. Your memorialist is the grantee of letters patent, No. of 18 , for an invention entitled "Improvements in Breech-loading Fire arms," the infringement alleged in the hereinbefore-mentioned action (which was admitted) consisted in manufacturing ejecting mechanism for guns in accordance with the specification to the said letters patent of 18 , and it is impossible to use your memorialist's said invention of 18 without infringing the said letters patent of A. B., assuming the said letters patent to be valid.

Hampered in trade.

4. Your memorialist is seriously hampered in his trade by reason that no persons who are estopped as aforesaid from denying the validity of the said letters patent of A. B. can purchase from your memorialist gun actions and mechanism made in pursuance of his said letters patent of 18 .

Documents.

5. The following documents are sent herewith :—

The specification of A. B. No. of 18 .
C. D. No. of 18 .
No. of 18 .

Copy writ, pleadings, and objections in the action.
Copy judgment of Lord Justice Kay, 17th March, 1893.
„ „ of the Court of Appeal, 1st August, 1893.

Application. 6. Your memorialist humbly requests you will authorise him to petition the Court for revocation of the said letters patent of A. B. No. of 18 .

33.—Declaration of Applicant verifying Statements in his Memorial to Her Majesty's Attorney-General (*f*).

In the matter of the Patents, Designs, and Trade-Marks Acts, 1883—1888,

and

In the matter of letters patent granted to for an invention *entitled* No. , *dated* .

I , of , do solemnly and sincerely declare as follows :—

That the several statements contained in the paper writing now produced and shown to me and marked A, purporting to be a memorial addressed by myself to Her Majesty's Attorney-General of England (*or* Ireland, *or* Lord Advocate of Scotland) are true as therein set forth.

And I make this solemn declaration conscientiously believing the same to be true and by virtue of the provisions of the Statutory Declarations Act, 1885.

Declared at .

34.—Declaration by Applicant that no Proceedings are pending (*g*).

[*Title as before.*]

I, A. B., of , do solemnly and sincerely declare as follows :—

That the questions proposed to be raised by the petition and particulars of objections upon which revocation of the said letters patent is sought, are not and cannot be raised in any legal proceedings now pending in the United Kingdom.

(*f*) On Judicature paper. (*g*) On foolscap.

35.—Certificate of Solicitor (*h*).

In the matter of the Patents, Designs, and Trade-Marks Acts, 1883—1888,

and

In the matter of letters patent granted to for an invention entitled No. , dated .

Between A. B. . . . . Petitioner,

and

C. B. . . . . Respondent.

I, , of , solicitor for the above-named petitioner, do hereby certify that the said petitioner is a fit and proper person to be a petitioner in this matter, and that he is competent to answer the costs of all proceedings in connection with the said petition.

V.—FORMS IN PETITION FOR EXTENSION OF TERM OF PATENT.

36.—Advertisement of Intention to Present Petition.

In the Privy Council.

In the matter of letters patent granted to , of , and bearing date the day of , 18 , and numbered .

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 day 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 .

Solicitor for the petitioner.

(*h*) On foolscap.

37.—Caveat.

In the Privy Council.

In the matter of letters patent granted to , of , and bearing date the day of , and numbered .

Cavent issued on behalf of .

Let nothing be done in reference to the above-mentioned patent without due notice to .

Dated this day of , 18 .

Solicitor for .

38.—Notice of Objections to Extension of Term.

In the Privy Council.

In the matter of letters patent granted to , of , and bearing date the day of , 18 , and numbered .

In the matter of the petition of for an extension of the term of the said letters patent.

Notice is hereby given of the several grounds of the objection of to the granting of the prayer of the said petition, that is to say :

Patent held invalid in a court of law.

1. The said letters patent a.. l and void, and a verdict was given against the validity of the said letters patent in a certain cause in the Court of , wherein the petitioner was plaintiff and defendant.

Patent revoked.

2. The said letters patent were repealed by the judgment of the Court of , in a petition for revocation presented by .

Want of novelty.

3. The alleged invention was not new at the date of the said letters patent.

Want of utility.

4. The alleged invention is of no use to the public, or not of so much public utility as to be a sufficient consideration for any prolongation of the term granted by the said letters patent.

Denial of merit.

5. The said petitioner does not possess sufficient merit to entitle him to a prolongation of the term granted by the said letters patent.

Title of petitioner.

6. The said petitioner is not entitled to (the whole of) the

privilege granted by the said letters patent (by assignment or otherwise).

7. The petitioner has been sufficiently remunerated and rewarded for all his expenses, labour, and ingenuity respecting the said invention. Remuneration.

8. If the petitioner has failed to obtain a sufficient amount of remuneration or reward he has only failed to do so in consequence of his own gross negligence. Negligence of petitioner.

9. The petitioner has permitted infringements of the said letters patent, and has not taken any proceedings to restrain such infringements. Negligence in restraining infringements.

10. The specification of the said letters patent does not sufficiently describe the nature of the invention or the manner in which the same is to be performed. Insufficiency of specification.

11. The allegations contained in the said petition are not true in substance or in fact. Denial of statements in petition.

Dated the day of , 18 .

Solicitor for .

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39. Advertisement of day appointed for hearing Petition.

(*Title as above.*)

Notice is hereby given that their lordships, the Judicial Committee of the Privy Council, have appointed the day of , 18 , at half-past ten o'clock in the forenoon, for hearing the matter of the above petition.

Solicitor for the plaintiff.

40. Form of Petition for Extension.

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 formerly of , now of , for the invention of , dated the day of , 18 , and numbered .

The humble petition of the above-named , formerly of , now of .

Showeth :—

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 , 18 , 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. 3. That your petitioner, in compliance with a proviso in the said letters patent contained, duly made and caused to be filed in the Patent Office within nine 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.

(*Here must be set out in detail all the facts of the case upon the lines indicated in the chapter upon Petition for Extension.*)

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. 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.

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.

APPENDIX E.

EXAMPLES OF SPECIFICATIONS AND CLAIMS.

PROVISIONAL AND COMPLETE SPECIFICATION TO A PATENT FOR A NEW MECHANICAL APPLIANCE AND MODE OF OPERATING—A VERY GENERAL CLAIM. 1885. No. 6205.

NOTE.—*These were the specifications contested in Siddell v. Vickers, L. R. 39 Ch. D. 92, decision of Kekewich, J., affirmed by the Court of Appeal, Cotton, Fry and Lopes, L.JJ., and the House of Lords, L. R. 15 App. Cas. 496, holding that the provisional specification was sufficient and that the claim was sufficient having regard to the body of the complete specification and to the particular subject-matter of the invention.—Two sheets of drawings which accompany the specification are not given here (i).*

Title.

PROVISIONAL SPECIFICATION. AN IMPROVED MECHANICAL APPLIANCE FOR WORKING OR OPERATING ON LARGE FORGINGS IN IRON OR STEEL.—This Invention relates to the construction and application of an improved and more simple and effective mechanical appliance or means, for working or operating on large forgings in iron or steel, being such forgings as are usually made under a hydraulic forging press or machine.

Provisional specification.

My improved appliance consists of a horizontal bar or bars made of suitable metal and fitted with suitable pulleys and hooks, which bar or bars can be placed or fitted on either side of the crosshead of the forging press, or through the "pellet" or key way.

Clips or grips or ratchets are conveniently arranged so as to fix on or hold the ingot or forging and hooked on the ratchet or clip or grip; and in operating, when the press lifts up or

(i) It would not be wise to treat this as a model in preparing specifications, it is given here as showing probably the extreme limits to which the courts will go in supporting a patent.

is raised, the ingot or forging will be turned as much as required at every stroke or operation of the press.

The crank bar of the press in connection with the wheel and endless chain thereof will raise the forging from the anvil at the same time that the clip or grip or the ratchet is turning the forging, the ratchet being suitably fixed for turning the crane wheel over which the endless chain passes.

The ratchet has a chain attached to the crane girder which will travel along a horizontal bar suitably fixed for the purpose, and will turn over the ingot or forging in the furnace.

Dated this 20th day of May, 1885.

Complete specification.

COMPLETE SPECIFICATION.—This invention relates to the construction adaptation and application of an improved more simple and effective mechanical appliance or means for working or operating on large forgings in iron or steel, which forgings are such as are usually made under a hydraulic forging press or machine or a steam hammer; and in order that the carrying out of my invention in practice may be fully understood, I have illustrated it on the accompanying two sheets of explanatory drawings, and have marked the same with letters of reference corresponding with those in the following description thereof, that is to say :—

Description of drawings.

Figure 1, on Sheet 1, is an end elevation or view, and Figure 2, is a front or face view of one arrangement of my mechanical appliance for working large forgings.

A, is the hydraulic forging press or machine. G, is the endless chain which is attached to the crank bar of the press, and which passes over the wheel W, and under the ingot or forging or mandril F, which is being operated upon by the press A.

The wheel W, is held in position by means of the crane block hook *b*, and shackle or bridle *a*; the crane with the horizontal bar and carriage are not shown on the drawings.

On or to the centre pin of the wheel W, is attached a double or single lever L, having pawls or ratchets R (one only being shown on the drawings) working on pins. The ratchets engage in teeth provided for them on the wheel W.—When the endless chain G, is slack the ratchet lever L, falls or is forced in towards the centre so as to crank or bend the chain

to any required extent, and when the weight of the forging comes on the chain it tends to straighten it, and the pressure on the end of the lever L, is transferred to the pawl or ratchet R, and thence to the teeth of the wheel, which will cause it to rotate on its axis to the desired extent. An eye or other convenient appliance E, is attached to the end of the ratchet lever L, in order to work the ratchet and rotate or turn the wheel independently of the endless chain G.

Figure 3, on Sheet 1, shows the appliance arranged and applied in another manner ; the centre pin of the wheel is connected with a cranked bar K, or by other convenient means to the pellet or crosshead of the press, whereby the wheel W, and endless chain G, are simultaneously raised when the pellet is lifted. The chain when slack is cranked or bent as before mentioned, and when the pellet rises the ingot or forging rises with it, and the consequent straightening of the chain forces round the wheel W, by means of the ratchet lever (not shown in this Figure) and so turns over the forging at the same time that it rises from the anvil ; or it can be made to turn the forging by means of the eye provided at the end of the ratchet lever L, and thus this arrangement of the appliance can be made either automatic or self-acting, or it can be worked by steam or other power independently of the appliances shown at Figures 1, 6, and 7 ; for the working of the forging under the steam hammer.

This appliance can likewise be used to turn over the ingot or forging when in the furnace, and it is operated by the crane as an automatic appliance, or when suspended the forging can be turned by working the ratchet lever L, by any convenient means, such as by steam or other power.

In the combination and arrangement of the appliance, as shown at Figures 4 and 5 on Sheet 2, a horizontal bar B, is provided and fixed on or through the crosshead or pellet of the press, this bar carries one or more bridles *c*, and rollers *d*, with one or more hooks or shackles H attached to them. An adjustable clip or ratchet grip X, is put on to the ingot or forging or mandril F, and an eye *e*, on the end of the screw or lever *f*, is attached to the hook or shackle H. When the pellet or crosshead of the press rises, the clips or ratchet grips X, engage with or grip the ingot or forging or mandril, and the leverage so

obtained will turn over the forging, and when the pellet descends the appliance will release itself and will slip round to obtain a fresh hold for the next lift.

The wheels and endless chains shown at Figures 6 and 7, on Sheet 2, which are similar to those described as shown at Figure 3, on Sheet 1, can also be used in combination with the appliances represented at Figures 4 and 5, on Sheet 2, and the forging will be lifted up from the anvil and turned over to the required extent, at the same time that the press rises.

The appliance as shown at Figures 1 and 2, on Sheet 1, can also be used in combination; in fact each arrangement of appliance can be used either separately or combined, for the purposes of lifting, slinging, or turning over the ingot or forging when in the furnace, under the press or hammer, or when being otherwise operated on.

The ratchet appliance has a chain attached to the crane girder, which will travel along a horizontal bar provided and fixed for that purpose, or with the crane carriage, and will turn over the ingot or forging in the furnace.

Having now particularly described and ascertained the nature of my said invention, and in what manner the same is to be and can be performed, I here declare that I do not limit myself to the precise details of my invention as hereinbefore specified and as illustrated on the accompanying drawings, because equivalent modifications or variations can be made in such details, and quite consistent with the principles or characteristic features of my invention; and in conclusion I declare that what I claim is

Claim. The general construction, adaptation or application, and the combination and use of the several parts, in the whole, constituting improved, more simple, and efficient appliances or means for working or operating on iron or steel forgings, substantially as hereinbefore set forth, and as illustrated on the accompanying drawings.

Dated this 19th day of September, 1885.

COMPLETE SPECIFICATION FOR A CHEMICAL INVENTION.—FOUR PROCESSES.—TWO CLAIMS. 1878. No. 786.

NOTE.—*This is the specification to the Patent in The Badische Anilin, &c., Co. v. Levinstein and others, tried before Mr. Justice Pearson, reported L. R. 24 Ch. D.* 156, *and held good subject-matter, sufficient and workable. In the Court of Appeal, by Bowen and Fry, L.JJ., Baggallay dissenting, L. R.* 29 *Ch. D.* 366, *to be bad for ambiguity. In the House of Lords by Lord Halsbury, L.C., Lords Herschell and Macnaghten, L.R.* 12 *App. Cases,* 710, *the judgment of Pearson, J., upheld on all grounds. The particulars of objections in this action, after dealing with alleged instances of anticipation, were in these terms:*—5. "*That the specification purporting to be filed* "*in pursuance of the condition in that behalf in the said letters* "*patent does not sufficiently describe and ascertain the nature* "*of the said alleged invention, or in what manner the same is* "*to be performed, and does not sufficiently distinguish which* "*of the matters and things therein described the said John* "*Henry Johnson claims to be new or as being comprised in* "*the said letters patent, and which of the same he does not so* "*claim and admits to be old, the said specification is in other* "*respects vague and insufficient, and framed so as to mislead.* "6. *That the alleged invention claimed in the said specifica-* "*tion is not the alleged invention for which the said letters* "*patent were granted.* 7. *That the said alleged invention is* "*not useful.* 8 (*added at trial*). *The said invention is not* "*proper subject-matter for which letters patent can be validly* "*granted.*"

Communication from abroad and title.

JOHN HENRY JOHNSON, of 47, Lincoln's Inn Fields, in the county of Middlesex, Gentleman. "IMPROVEMENTS IN THE PRODUCTION OF COLOURING MATTERS SUITABLE FOR DYEING AND PRINTING." A communication to me from abroad by Heinrich Caro, chemist to the Badische Aniline and Soda Works of Mannheim in the Empire of Germany

This invention consists in the production of red and brown colouring matters which in chemical language may be termed

the "Sulphoacids of Oxyazonapthaline" and the following processes may be employed for their preparation.

First Process.—Napthylamine is converted into its diazo compound by the action of nitrous acid and in a manner well known to chemists and equal molecules of the diazo compound thus obtained and of napthol or napthylic alcohol are allowed to react upon one another by preference in an alkaline solution. First process.

According to the employment of either of the two isomeric modifications of napthylic alcohol known as alpha-napthol and beta-napthol the result of this operation is a precipitate containing either of the two corresponding and isomeric modifications of oxyazonapthaline and which may be termed "Alpha and Beta-Oxyazonapthaline" respectively.—These azo compounds are further converted into their sulpho-acids by any method now in use for the preparation of organic sulpho-acids such as for instance by heating them with fuming sulphuric acid. The excess of sulphuric acid may then be removed by any of the known means for effecting this purpose and the colouring matter may be obtained in a solid state by precipitation or evaporation.

In this manner brown colouring matters are obtained from alpha-oxyazonapthaline and red colouring matters from beta-oxyazonapthaline.

As an example of the manner in which this first process may be carried out I proceed as follows:—About ten pounds of napthylamine are mixed with or dissolved in about two gallons of concentrated or strong muriatic acid and about 100 gallons of cold water and thereto an aqueous solution of nitrite of sodium is added containing about 4·3 (four and eight-tenths) pounds of pure nitrite of sodium or as much as will be found necessary to convert the napthylamine into its diazo compound or into hydro-chlorate of diazonapthaline. The solution thus obtained is added to an aqueous and strongly alkaline solution of about ten pounds of either of the two isomeric napthols or of mixtures of the same when a dark red or brown precipitate will be produced consisting of oxyazonapthaline, which is to be filtered, washed, and dried. In order to obtain the sulpho-acids of oxyazonapthaline I dissolve about ten pounds of the oxyazo-napthaline in about 20 lb. of fuming sulphuric acid containing about 80 per cent. of anhydrous sulphuric acid and the mixture is Example.

heated at a temperature of about 100° Centigrade for about two hours or until a sample of the mixture will be found to produce a solution with water.—The further treatment consists in removing the free sulphuric acid contained in the mixture by any of the known means for effecting this purpose such as for instance by neutralization with caustic lime and the colouring matter may be obtained in a solid state by preference in the state of a sodium salt in a manner well understood by chemists.

Second process.

SECOND PROCESS.—Napthylamine is converted into its diazo compound as before stated and equal molecules of the diazo compound thus obtained and of the sulpho-acids of either alpha-napthol or beta-napthol are allowed to react upon each other by preference in an alkaline solution. In this instance red colouring matters are the result of the operation and may be obtained in a solid state by precipitation or evaporation.

The above said sulpho-acids of either alpha-napthol or beta-napthol are produced as is well known by heating napthol with excess of sulphuric acid at a temperature of about 100° Centigrade.—The resulting product is a mixture of several napthol sulpho-acids and as my process may be applied not only to the mono-sulpho-acids of napthol contained in that mixture but also to the other sulpho-acids which result from the treatment of napthol with sulphuric acid I wish it to be understood that what I consider as my invention under this second process for preparing the sulpho-acids of oxy-azo-napthaline is the action of diazonapthaline upon all sulpho-acids of either alpha or beta-napthol and substantially in the manner aforesaid. And as an

Example.

example of the manner in which I prefer to carry out this second process I take a solution of hydrochlorate of diazonapthaline prepared from about t a pounds of napthylamine substantially in the manner described in the first process and the solution of the diazo compound is added to a cold and strongly alkaline solution of the sodium salts of the napthol sulpho-acids such as result from the treatment of about ten pounds of napthol with about twenty or thirty pounds of sulphuric acid. —This mixture which throughout this operation is to be kept alkaline is precipitated with chloride of sodium and the precipitate of the colouring matter thus obtained is filtered washed pressed and dried.

Third process. THIRD PROCESS.—The sulpho acids of napthylamine are converted into their respective diazo compounds and equal molecules of the diazo compounds thus obtained and of either alpha-napthol or beta-napthol are allowed to react upon each other by preference in an alkaline solution and substantially in the manner above described in the first and second processes. In this instance alpha-napthol produces brown colouring matters while red colouring matters result from the employment of beta-napthol.

As is well known the said sulpho acids of napthylamine may be produced in various ways such as for instance by the direct action of sulphuric acid upon napthylamine or in a less direct manner by treating nitro-napthaline with sulphite of ammonium or by submitting the sulpho acids of nitro napthaline to the action of reducing agents. By the said methods as is well known several modifications of the sulpho acids of napthylamine are obtained chiefly differing from each other by their various degrees of solubility in water some of them being nearly insoluble such as the so-called napthionic acid.

Example. As an example of the manner in which the sulpho acids of napthylamine may be prepared from the sulpho acids of nitro-napthaline I proceed as follows :—One part by weight of nitro-napthaline is mixed with about two parts by weight of rectified sulphuric acid and with about one part by weight of fuming sulphuric acid containing about 80 per cent. of anhydrous sulphuric acid and the mixture is treated at a temperature of about 100° Centigrade until the conversion into the sulpho-acids of nitronapthaline is perfect or until a sample of the mixture produces a clear solution with an excess of caustic alkali. The result of this operation is then mixed with about ten parts of water and treated with reducing agents such as metallic iron and in a manner well known in order to obtain the sulpho acids of napthylamine which may be further purified in the following manner :—

The reduction of the nitronapthaline compounds being complete the mixture is treated with an excess of milk of lime filtered and the filtered solution of the lime salts is strongly concentrated and decomposed by an excess of muriatic acid when the difficultly soluble sulpho acids will become precipi-

tated and may be separated from the more soluble modifications by filtration or otherwise.

Example of subordinate process.

As an example of the manner in which the sulpho acids of napthylamine may be prepared by the direct action of sulphuric acid upon napthylamine I proceed as follows :—

One part by weight of napthylamine is mixed with about three parts by weight of fuming sulphuric acid containing about 80 per cent. of anhydrous sulphuric acid and the mixture is heated at a temperature of about 70° to 80° Centigrade until a sample of the mixture produces a clear solution with an excess of caustic alkali. The result of this operation is then mixed with about twenty parts of water when the difficultly soluble sulpho acids will become precipitated and may be separated from the easily soluble modifications by filtration or otherwise. All these modifications of the sulpho acids of napthylamine may be converted into the corresponding sulpho acids of oxyazonapthaline in the manner above described and thus colours obtained differing in a similar ratio in their various degrees of solubility.

Fourth process.

Fourth Process.—The sulpho acids of napthylamine are converted into their respective diazo compounds and equal molecules of the diazo compounds thus obtained and of any of the various sulpho acids of either alpha-napthol or of beta-napthol are allowed to react upon each other by preference in an alkaline solution and substantially in the manner described in the foregoing processes. In this instance the sulpho acids of oxyazonapthaline thus produced are red colouring matters.

Alternative process.

This invention further consists in the production of similar colouring matters and which may be termed "The Sulpho acids of Dioxyazonapthaline" by substituting dioxynapthaline or the diatomic napthylic alcohol for either of the two isomeric napthols in any of the before-mentioned processes.

Having now described and particularly ascertained the nature of the said invention and the manner in which the same is or may be used or carried into effect I would observe in conclusion that what I consider to be novel and original and therefore claim as the invention secured to me by the herein-before in part recited letters patent is :—

Claims.

First. The production of red and brown colouring matters which in chemical language may be termed the sulpho acids of

oxyazonapthaline by the action of the diazo compounds which may be prepared from napthylamine or from the sulpho acids of napthylamine upon any of the isomeric napthols or of mixtures of the same or upon any of the sulpho acids which may be prepared from either alpha-napthol or from beta-napthol or from mixtures of the same substantially by the processes above described.

Secondly. The production of similar colouring matters and which in chemical language may be termed the sulpho acids of dioxyazonapthaline by substituting dioxynapthaline for either of the two isomeric napthols in any of the processes above described for the preparation of the sulpho acids of oxyazonapthaline substantially as hereinbefore described.

In witness whereof I the said John Henry Johnson have to this my specification set my hand and seal this ninth day of August one thousand eight hundred and seventy-eight.

J. HENRY JOHNSON (L.S.).

COMPLETE SPECIFICATION. — A NEW PRINCIPLE COUPLED WITH THE METHOD OF CARRYING THE PRINCIPLE INTO EFFECT—SUPPORTED BY A COMBINATION CLAIM. 1882, No. 3660.

NOTE.—*This Specification was attacked as disclosing no subject-matter and want of utility. Held by the Court of Appeal, Cotton, Bowen, and Fry, L.JJ., affirming Kekewich, J., to be good subject-matter: that the claims were sufficient and the patent valid.* 5 P. O. R. 437.

PAUL EHRLICH, resident at Gohlis, near Leipsic, Saxony, German Empire, "IMPROVEMENTS IN MECHANICAL MUSICAL INSTRUMENTS." Title.

This invention relates to that class of mechanical musical instruments in which the notes or sounds are produced by the passage of a perforated sheet or surface across the levers operating the valves of reeds or pipes, and it consists substantially in the employment of a perforated disk of circular Complete specification.

form or of a number of like semi-circular disks, instead of the ordinary strip or band hitherto used in such instruments.

Description and reference to drawings.

The invention is represented on the annexed sheet of drawings. Fig. 1 is a sectional elevation, and Fig. 2 a sectional plan of the instrument. Fig. 3, *x*, *y* *z* are three diagrams showing the relative position and arrangement of the air-holes in the reeds or pipes. Fig. 4 is a plan of a perforated circular disk; Fig. 5 a top view of a part of the instrument; Fig. 6 a top view of the instrument with semi-circular disks, one of which only is shown, and Fig. 7 a like view with both semi-circular disks in their place.

The disk *a* is made of thin sheet metal, card-board, paper or other suitable material, and perforated in the manner required for producing a given melody. The same is carried by a plate *b* forming the head of the vertical shaft *c*, and provided with a driving-pin or pins engaging with holes in the disk. The shaft *c* is slowly rotated from the main shaft c^1 by worm-wheel gearing or otherwise. The main-shaft also operates the bellows *k* and k^1 by means of a crank and connecting rods. *h* are the pipes or reeds.

The valve-leaders *d*, which have their fulcrum at *s*, are provided each with a projecting stud or finger, which bears by virtue of a spring *n* against the under side of the disk *a*, so that when, during the rotation of the disk, a perforation thereof comes opposite to one of the said fingers, this finger enters into the perforation, thus permitting the valve to which it belongs, to open, and the note to sound.

Description and reference to drawings.

In order to prevent the fingers of the valve levers from lifting the disk and from coming out of line with the perforations with which they are to register, the grates or combs *e* and e^1 are arranged, the former being fixed to a bar *f* Figs. 1 and 5, the latter to the top of the chest *p*. The disk *a* rotates between these grates, while the fingers of the valve levers are guided in the slits between the bars thereof, the said slits registering with the perforations of the disk when these are in a line with the fingers. The latter are thus always guided accurately into the corresponding perforations. The bar *f* is hinged at one end to the chest *p*, while at the other end it is secured in such a manner that it may with facility be released and lifted, in order to allow the disk *a* to be exchanged. It may, when

hinged at one end, also be kept in its place by a spring in the manner of a clasp knife.

The valves *r* and their levers are arranged in a compartment *q* hermetically separated from the rest of the inside space of the instrument, and communicating with the outer air by the holes g, g^1, g^2, g^3, &c.

In case a piece of music be too long for one disk, a number of semi-circular disks A, B, C, &c., Figs. 6 and 7, may be used, each of which contains a part of the notes, and which may be inserted into the instrument one after the other without interrupting the playing. The bar *f* with the grate *e* is in this case by preference made of a length as not to reach to the centre of the plate *b*, as otherwise it would prevent, or at least render difficult the exchange of the disk-parts.

In perforated music sheets of all kinds it is desirable that the perforations for the lower notes have a comparatively greater length than those for the higher ones. Considering that in the circular disk the length of the perforations for notes of the same duration must be in proportion to the distance of these perforations from their centre of rotation, the disk presents the advantage that the aforesaid condition will be naturally fulfilled simply by the arrangement of the reeds and the valves in such a manner that the outer perforations will correspond to the lower notes, the inner ones to those of higher pitch.

In order to reduce as much as possible the diameter of the disk, the valve-levers *d* must be brought together as close as possible. To this effect the reeds or pipes *h* are placed in vertical ranges, but each reed or pipe is shifted laterally by so much in respect to the one which is below or above it, as is required for allowing the valve-levers to pass freely by the side of each other.

For the purpose of reducing the requisite lift of the valves, I prefer to provide each pipe or reed with two air-holes as shown in section by Fig. 1, and in front view by Fig. 3 *x*, or with three holes as in Fig. 3 *y*, and to form the valve of as many separate bars, each of which is adapted to cover one of the said holes. The valves may also be arranged in the manner of slide-valves, and in some cases two valves may be connected together in order to produce double notes; see Fig. 3 *z*. In Figs. 3 *x* and 3 *y* is also shown the relative posi-

tion of the air-holes of the different reeds, I, II, III being the first range, IV, V, VI the second, &c.

The reeds *h* communicate with the main chamber T of the instrument. This chamber is hermetically closed and contains the bellows *k*, k^1 and the driving mechanism. The air sucked in by the said bellows is delivered into the chamber T, with which is combined the regulating bellows *l*. The bellows *k*, k^1 may, however, also operate in the contrary manner by sucking the air from the chamber T; the pipes or reeds and the regulating bellows *l* having, in this case, of course to be arranged accordingly.

Having thus described the nature and object of my invention and the manner in which it is to be carried out in practice, I hereby claim as new and important features of the same:

Claims perforated disk.

1. In a mechanical musical instrument, the rotative music sheet *a*, consisting of a disk perforated in accordance with the notes to be produced, and co-operating with the valve-levers *d*, substantially as and for the purpose described.

Combination.

2. The combination with the valve-levers *d* of a perforated disk consisting of two parts A and B, either of which may be exchanged, as and for the purpose specified.

IN WITNESS whereof, I, &c.

APPENDIX F.

A FEW PRECEDENTS FOR THE TRANSFER OF INTERESTS IN LETTERS PATENT.

Sale of Patent Rights to a Proposed Company.

1. *Preliminary Agreement with Promoter.*

An Agreement made this day of 188 , Between A. B. of , C. D. of , and E. F. of , hereinafter called the vendors of the first part, and X. Y. of hereinafter called the promoter of the other part.

Agreement to assign to company.

Whereas the vendors are the owners of certain letters patent dated and numbered , for an invention entitled . **And whereas** it is intended that the promoter shall procure forthwith the incorporation by registration under the Companies Acts, 1862 to 1883, of a company to be called Limited, and that the vendors shall for the considerations hereinafter mentioned sell and assign the said letters patent to the said Limited. **And whereas** a print of the memorandum and articles of association of the Limited has been approved by the parties hereto and is annexed to this agreement. Now it is agreed as follows:

Promoter to procure incorporation.

1. The promoter shall and will forthwith procure the incorporation under the above-mentioned acts of the said Limited, and shall and will duly register as the memorandum and articles of association of the said company the memorandum and articles of association hereinbefore referred to and which are set forth in the *schedule* hereto.

Assignment to be executed by company.

2. With as little delay as possible after incorporation the vendors shall execute and the said promoter shall procure the execution by the said Limited of a contract similar to that set forth in the schedule hereto or such other contract as the parties hereto and the Limited shall agree upon.

Notice of determination.

3. If the promoter shall not before the day of 188 , perform his part of this agreement, then it shall be lawful for the vendors or either of them to determine the same

by giving notice in writing of such determination to the promoter, and if the said Limited shall at that time have been incorporated also to the said Limited.

SCHEDULE.

---

2. *Agreement to Assign to the Company.*

An Agreement made this day of 1888, Between A. B. of , C. D. of , and E. F. of , hereinafter called the vendors of the one part, and the Limited hereinafter called the purchasers of the other part. **Whereas** the vendors are the owners of certain letters patent dated and numbered and entitled . **And whereas** by agreement dated and made between the vendors of the one part and therein called the promoter of the other, it was agreed that for certain considerations therein and herein mentioned the vendors should sell the said letters patent to the purchasers. Now it is agreed as follows :

Recital of above agreement.

1. The vendors shall upon the completion of the purchase as hereinafter provided for, assign unto the purchasers the said letters patent and all the right, title and interest of the vendors therein, free from all incumbrances save as regards assignments for districts and licences already granted as hereinafter mentioned, and the vendors shall do all things necessary and execute all documents necessary for rendering the said assignment valid and effectual.

to assign.

Payment of cash and allotment of shares.

2. The purchasers shall pay to the vendors on or before the day of the sum of £ in cash, and shall allot to the vendors or to such other person or persons as the vendors shall nominate fully paid up shares in the vendors' company, and immediately upon such payment being made and the said shares being allotted the vendors shall assign the said letters patent as in the first clause hereof provided.

Assignment subject to licences, &c.

3. The said assignment shall be subject to assignments for districts and licences in the schedule hereof mentioned, but such assignment shall include all the rights and benefits from time to time hereafter accruing to the vendors under or by virtue of such assignments for districts or licences.

4. The vendors do not warrant or represent the validity of the said letters patent. No warranty of validity.

5. Should the said purchase price not be paid or the shares not be allotted on or before the said day of the vendors shall be entitled to interest upon the said purchase price and upon the nominal value of the said shares after the rate of 5 per cent. per annum until payment and allotment, or at their option to determine this contract by notice under their hands delivered at the registered office of the company. **Provided always** that the vendors shall not be entitled to sue for or recover damages against the purchasers in respect of the breach of the said agreement. Determination upon default.

6. The said A. B. shall be deemed the agent of the said C. D. and E. F. for the purpose of receiving the said purchase money and shares and giving an effectual discharge for the same.

SCHEDULE.

AGREEMENT TO OBTAIN AND ASSIGN LETTERS PATENT FOR AN INVENTION IN CONSIDERATION OF A SUM OF MONEY AND DELIVERY OF CERTAIN NUMBER OF THE PATENT ARTICLES (*k*).

An Agreement made the day of , Between (*inventor*) of, &c., of the one part and (*purchaser*) of, &c., of the other part. **Whereas** the said (*inventor*) claims to have invented a new and improved kind of , a plan or drawing of which is hereunto annexed. **And whereas** the said (*purchaser*) has arranged with the said (*inventor*) for the sale to him of the benefit of the said invention in the manner and upon the terms hereinafter expressed. **Now Witness** that in consideration of the sum of £ to the said (*inventor*) now paid by the said (*purchaser*) the receipt whereof is hereby acknowledged and also in consideration of the agreements hereinafter contained on the part of the said (*purchaser*) he

Parties.

Agreement to obtain and assign patent.

Recital of invention.

Testatum.

In consideration of a sum and of the purchaser's covenants, inventor

(*k*) Extracted by permission of the publishers from Bythewood and Jarman's Conveyancing.

covenants with purchaser, to solicit grant of letters patent:

the said (*inventor*) hereby agrees with the said (*purchaser*) in manner following (that is to say) that he the said (*inventor*) will at any time or times hereafter within the term of fourteen years to be computed from the day of the date of these presents upon the request and at the cost of the said (*purchaser*), his executors, administrators, or assigns, take and use all such steps, means, and proceedings as shall be requisite or proper for obtaining, and use his the said (*inventor*)'s utmost endeavours to obtain, in the name of him the said (*inventor*), a patent for the sole and exclusive making, using, exercising, and vending of the said invention within the United Kingdom of Great Britain and Ireland, and the Isle of Man, as the said (*purchaser*), his executors, administrators, and assigns, may desire, during the term or terms for which patents for inventions are usully granted.

and to assign letters patent;

And further, that the said (*inventor*), his executors, or administrators, will at any time or times after obtaining any such patent upon the request and at the cost of the said (*purchaser*), his executors, administrators, or assigns, make, do, and execute all such assignments, deeds, matters, and things, as the said (*purchaser*), his executors, administrators, and assigns, shall reasonably require for assigning, and transferring unto the said (*purchaser*), his executors, administrators, and assigns, for his or their absolute benefit, the said patent, and the full benefit and advantage thereof;

to instruct purchaser in the invention.

And further, that he the said (*inventor*) will, at any time or times hereafter, upon every reasonable request of the said (*purchaser*), his executors, administrators, or assigns, more particularly and sufficiently describe to him or them, or his or their agents or workmen, either in writing or by personal explanation and instruction, or otherwise, the nature of the said invention, and in what manner the same, and every part thereof, and every process relating thereto, are to be performed or carried into effect and used;

Not to use invention without purchaser's licence;

And further, that he the said (*inventor*), his executors or administrators, will not, nor shall any person or persons claiming by, from, through, or under him or them, at any time or times hereafter, during the term of fourteen years to be computed from the day of the date of these presents, without the consent or licence of the said (*purchaser*), his executors, administrators, and assigns, either alone or in co-partnership, or in any other manner, howsoever, directly or

indirectly, make or assist in the making of any of the new and improved kind hereinbefore mentioned, or in the construction of which the aforesaid invention shall be used; or (except by any specification or specifications which may have to be executed and enrolled for the purposes of the application for the said patent) described, either in writing or otherwise, to any person or persons other than the said (*purchaser*), his executors, administrators, or assigns, the nature of the said invention, or in what manner the same is to be performed or carried into effect, or give any information, or do or permit or be party or privy to, any act, matter, or thing whereby or by means whereof the same respectively may be known by any person or persons other than as aforesaid, or whereby or by means whereof the said (*inventor*) may be prevented or hindered, from obtaining the said patent for the purposes hereinbefore mentioned. **And further,** that he the said (*inventor*) has not at any time or times heretofore described, either in writing, or otherwise, to any person or persons other than the said (*purchaser*), the nature of the said invention, or in what manner the same is to be performed or carried into effect, or given any information, or done or permitted, or been party or privy to, any act, matter, or thing, whereby or by means whereof the same respectively may have been or may be known by any person or persons other than as aforesaid, or whereby or by means whereof he may be prevented or hindered from obtaining the said patent for the purposes hereinbefore mentioned; **And further,** that he the said (*inventor*) will, at any time or times hereinafter, upon every request and at the cost of the said (*purchaser*), his executors, administrators, or assigns, make, do, execute, and perfect all such lawful acts, deeds, disclaimers, amendments, and other matters and things, for the better or more satisfactorily or effectually sustaining or maintaining such patent as aforesaid, and assuring the same, and the full benefit thereof, and of the said invention unto the said (*purchaser*), his executors, administrators, and assigns, as by him or them shall be reasonably required. **And** in consideration of the agreements hereinbefore contained on the part of the said (*inventor*), he the said (*purchaser*) hereby agrees with the said (*inventor*), his executors and administrators, that he the said (*purchaser*), his executors or administrators, will, within

nor, except by specification, to disclose invention;

that inventor hath not disclosed invention, and is not prevented from obtaining patent;

for further assurance,

purchaser agrees to make a certain number of articles, and deliver them to the inventor;

the space of one year, to be computed from the day of the date of the patent to be so obtained as aforesaid, at his or their cost, make and deliver, for and to the said (*inventor*), his executors and administrators,—complete, perfect, and well made and finished,—of the new and improved kind hereinbefore mentioned. **And will**, from time to time and at all times hereafter, save, defend, and keep harmless and indemnified the said (*inventor*), his heirs, executors, and administrators, and his and their estates and effects whatsoever and wheresoever, of, from, and against all costs and charges to be incurred or sustained in, about, or in anywise relating to the obtaining of the said patent, and the preparing any specifications which may be necessary for the purposes of the application for the same, and of, from, and against all claims and demands on account thereof. **Provided always**, and it is hereby agreed and declared, that the solicitor or agent to be employed in obtaining the said patent, and in preparing any such specification or specifications as aforesaid, shall be appointed by the said (*purchaser*), his executors, administrators, or assigns; **And that** the said (*inventor*), his heirs, executors, or administrators, shall not be answerable or accountable for any neglect or default of such solicitor or agent anything hereinbefore contained to the contrary thereof in anywise notwithstanding.

to indemnify inventor from costs of obtaining letters patent.

Proviso that purchaser is to appoint solicitor, or agent, and that inventor shall not be responsible for his default.

As witness, &c.

Agreement between Joint Owners of a Patent for Partition.

An Agreement made the day of 188 , Between A. B. of of the one part, and C. D. of of the other part. **Whereas** the said A. B. and C. D. are joint owners of certain letters patent dated and numbered and entitled . **And whereas** they have agreed to divide the special licence, full power, sole privilege, and authority by the said letters patent granted in the manner and upon the terms hereinafter appearing. Now it is agreed as follows:

Agreement to divide.

1. The said A. B. shall be solely entitled henceforth to use, work and vend the invention forming the subject matter of the said letters patent in the following counties and shall

Assignment of district to A. B.

be solely entitled within the said counties to grant assignments for districts or special or general licences upon any terms which the said A. B. shall see fit, and the said C. D. shall whenever required to do so by the said A. B., execute a valid assignment of all his interest in the said letters patent within the said counties to the said A. B.

Assignment of district to C. D.

2. The said C. D. shall be solely entitled henceforth to use, work, and vend the said invention in the following counties , and shall be solely entitled within the said counties to grant assignments for districts or special or general licences upon any terms which the said C. D. shall see fit, and the said A. B. shall, whenever required to do so by the said C. D., execute a valid assignment of all his interest in the said letters patent within the said counties to the said C. D.

Neither party to account.

3. Neither party shall be bound to account to the other for any profits, royalties, or payments received by him with respect to the using, vending, or working the said invention within the counties or districts assigned to him hereby.

Payment of fees, &c.

4. The said C. D. shall from time to time and as they become due pay the fees for the continuance and renewal of the said letters patent, and shall be entitled to recover one moiety of the sums of money so paid from the said A. B.

Future patents elective.

5. This agreement and all the provisions thereof shall apply to any letters patent obtained or acquired by either party hereto for any improvements upon the said patented invention, and neither party shall be bound to make any payments in respect of any such improvements to the other. **Provided always**, that immediately after applying for any such letters patent the party seeking to obtain the same shall give notice in writing to the other of the said improvement and full particulars respecting the same, together with a copy of the specification filed, and thereupon the other party shall elect whether he shall take the benefit of the said invention or not, and if he elects to take the benefit thereof shall from time to time pay to the party applying for such letters patent one moiety of all the costs, fees, and charges incurred in obtaining or seeking to obtain such letters patent, and then the said letters patent and the said invention shall be deemed to be within this agreement, but should he elect not to pay the said moiety of costs, fees, and charges, then he shall be deemed to have abandoned all claim

to the said letters patent and invention, and the party applying for such letters patent shall thenceforth be the sole owner thereof.

No amendment without consent.

6. Neither party shall apply for leave to amend the specifications to any letters patent within this agreement without the consent of the other first had and obtained.

7. So far as practicable this agreement shall apply to and be binding on the executors, administrators, or assigns of the parties hereto.

AGREEMENT FOR WORKING AND SELLING AN INVENTION, IN RESPECT OF WHICH AN APPLICATION FOR A PATENT HAS BEEN MADE, FOR THE JOINT BENEFIT OF THE INVENTOR AND ANOTHER PERSON (*l*).

Parties.

Recitals of application for patent;

of acceptance of specification;

of agreement for arrangement as to working, &c., the invention.

Testatum.

Agreement.

An Agreement made the day of , 18 , Between (*inventor*), of, &c., of the one part; and (*capitalist*), of, &c., of the other part. **Whereas** the said (*inventor*) has, under the Patents, Designs, and Trade Marks Act, 1883, made an application, dated the day of 18 , number , for a patent for an invention of (*title of invention*), which application was accompanied by a complete specification: **And whereas** the said complete specification has been accepted: **And whereas** the parties thereto have agreed to enter into the arrangements hereinafter mentioned in respect of the said invention and application, and the patent to be obtained thereupon. **Now these Presents witness** that it is hereby agreed as follows, that is to say:—

Capitalist to contribute sum for expenses.

1. The said (*capitalist*) shall immediately upon the execution of these presents, pay to the said (*inventor*) a sum of £ , to be applied by him towards the expenses of working and developing the said invention.

Inventor to endeavour to obtain patent, and assign the same when required.

2. In consideration of the payment so agreed to be made as aforesaid, and of the agreements on the part of the said (*capitalist*) hereinafter contained, the said (*inventor*) shall use his best endeavours to perfect the said invention, and to obtain the

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grant of the said patent in his own name, and shall, whenever required by the said (*capitalist*) after the granting of such patent, assign the same, so that the same premises may be legally and beneficially vested in the said parties hereto as tenants in common in equal shares, and the said parties hereto shall as well before as after such assignment, be entitled to the said patent in the shares aforesaid.

Inventor to communicate improvements.

3. The said (*inventor*) without any further remuneration than the monies hereinafter agreed to be paid by the said (*capitalist*), will communicate to the said (*capitalist*) all improvements which the said (*inventor*) has already invented, discovered, or made, or may during the continuance of the said patent, or of any other patent which may become subject to the provisions of these presents, invent, discover, or make in, or in connection with the said invention; and also all improvements whether patented or not in or in connection with the said invention, of which the said (*inventor*) shall become the owner, or have the control.

Inventor to apply for foreign and colonial patents.

4. The said (*inventor*) will also, at the expense in the first instance of the said (*capitalist*), such expense to be considered as an advance, and to be reimbursed as hereinafter mentioned, apply for and endeavour to obtain in such foreign countries, or British Colonies, or dependencies, as the said (*capitalist*) shall think proper, and shall require, the like privilege for the invention comprised in the application, and for any such improvements as aforesaid; and will, as far as practicable, at the request and expense, in the first instance, of the said (*capitalist*), such expense to be considered as an advance, and to be reimbursed as hereinafter mentioned, render all such foreign and colonial patents, and the said improvements available for the exclusive use of the said parties hereto in equal shares; and execute and do every act, deed, and thing which may be necessary or expedient for effectually vesting the same in the said parties hereto in the shares aforesaid.

Capitalist to make advances for working and developing invention.

5. The said (*capitalist*) shall advance from time to time such monies as he shall think fit for working and developing the patent to be obtained on the aforesaid application numbered , or the said foreign and colonial patents or like privileges, or any such patents for improvements as aforesaid (all which patents and privileges are collectively referred to as the "said

patents"), and for defraying the costs and expenses of obtaining and completing the said patents respectively, and keeping the same on foot, and for protecting or defending the same from, or obtaining damages or other compensation for infringements or otherwise defending the said patents, or of obtaining renewals and extension of the term of the said patents, or amending the specification thereof, or working or developing the working comprised in the said patents (hereinafter referred to as the said patented inventions), or introducing the same to the public, or exercising or using the said patented inventions, or any of them, or any parts thereof respectively, or for any purpose whatever in connection with the said patents, or any of them; and the said advances, and also the aforesaid sum of £ shall be repaid to the said (*capitalist*) as hereinafter mentioned; and if there shall at any one time during the continuance of this agreement be owing to the said (*capitalist*) in respect of such advances in the aggregate, the sum of £ , or upwards, then any excess of such advances over the sum of £ , shall carry interest at the rate of £5 per cent. per annum from the date when such excess shall have become due to the said (*capitalist*) until the same shall be paid.

Charge of advances on patents.

6. All advances made by the said (*capitalist*) as aforesaid, and all interest shall be, and the same are hereby charged upon the said patents as a first charge upon the same.

Application of royalties, proceeds of sale of patent rights, &c.

7. All monies which shall be received by way of royalties, or otherwise, as the consideration for any licence granted for the use of the said patented inventions, or any of them, or any part thereof respectively, or which shall be received as the proceeds of the sale, or other disposition of the said patents, or any share or interest therein, or which shall be received in respect of any working, using, or exercising by or on behalf of the said parties hereto, or either of them, of the said patented inventions, or any of them, or any part thereof respectively, or which shall in any manner whatever arise, or be received out of, or in respect of the said patents, or any of them, all which monies are hereinafter referred to as "the proceeds of all the said patents," shall be applied as follows:—that is to say, in the first place, in payment of the costs and charges incurred with the consent of the said (*capitalist*) attending the licence, sale, disposition, or working in respect of which the same

respectively shall be received; and in the next place, and as a charge upon the said proceeds of the said patents, and in priority to any other payments hereinafter mentioned, in payment to the said (*capitalist*) of all advances made by the said (*capitalist*) as aforesaid with the interest thereon, in the events, and at the rate, and in manner aforesaid; and in the next place, in payment of all expenses of working the said patents (hereinafter referred to as the patent expenses, and defined as hereinafter mentioned); and the balances which shall remain of the proceeds of the said patents, after making the same payments aforesaid, shall be divided between the parties hereto in equal shares.

Definition of "patent expenses."

8. For the purposes of this agreement the expression "patent expenses" shall mean and include all monies which, with the consent of the said (*capitalist*), shall be expended for any of the purposes mentioned in the 5th clause of these presents, which shall not have been defrayed by monies advanced by the said (*capitalist*).

Reserve fund.

9. There shall be set aside yearly out of the aforesaid proceeds of the said patents and premises, after payment of the said costs, charges, and interest (if any), and of the said patent expenses, such a sum not exceeding £ in any one year, as the said (*capitalist*) shall think proper, as a reserve fund for meeting contingencies, and providing monies for working and developing the patents, or for any of the purposes mentioned in the 5th clause of these presents, and such reserve fund may from time to time be drawn upon and applied for any of the purposes aforesaid, as and whenever the said (*capitalist*) shall think fit.

Inventor to devote attention to working patent.

10. The said (*inventor*) shall give as much time and attention as may be necessary for working and developing the said patented inventions, and shall use his best endeavours to promote the success thereof, but the said (*capitalist*) shall not be bound to give more time or attention thereto than he shall think proper.

Neither party to grant licences, &c., without consent of the other.

11. During the continuance of the arrangement hereby made neither of the said parties hereto shall, without the consent of the other of them, grant or agree to grant any licence for working the patented inventions, or any of them, or any part thereof, or sell or dispose of his share or interest in

the said patents or any of them, or any part thereof, or use or exercise the said invention, or make any payment, or incur any expenses, debts, or liabilities in respect of the said patents or patented inventions, and in case any payment, debt, or liability shall be so made or incurred without such consent, the same shall be made or incurred on the separate and individual account of the party making or incurring the same, and shall be borne by him exclusively, without any right to resort to the proceeds aforesaid of the said patents, and the other of the said parties hereto shall be indemnified by him in respect of the same.

Inventor alone to work the patent; rendering accounts to capitalist.

12. The said patents, patented inventions, and premises shall be worked, and the business thereof shall be carried on in the name of the said (*inventor*) alone as patentee; and proper accounts shall be kept by him of all payments made, and monies received, and liabilities incurred in respect thereof, and of all transactions relating thereto, and all monies received in respect of licences, sales, and dispositions or otherwise in respect of the said patents, shall be paid into a bank to an account to be kept in the joint names of the said parties hereto, and shall not be paid out except upon the joint cheque of both parties. The books of account and other documents shall be kept in the custody of the said (*inventor*) at his office or such other place in London as the said parties hereto may agree upon, but so as that the said (*capitalist*) may at any time have access thereto. The accounts relating to the said patents, patented inventions, and premises shall be made up and balanced half-yearly on the day of , and the day of , or oftener if the said parties hereto shall so agree.

Inventor to take all proceedings necessary for protecting patents.

13. The said (*inventor*) shall, during the continuance of the arrangements hereby made, take all such proceedings as the said (*capitalist*) shall require for keeping up the said patents and protecting and defending the same from and obtaining damages or other compensation for infringement or otherwise defending the said patents or any of them, obtaining renewals or extensions of the term of the said patents or any of them, or amending the specifications thereof, and the costs and expenses of all such proceedings as last aforesaid shall be defrayed in the first instance by the said (*capitalist*), and shall be considered as advances by him within the meaning of the

5th clause of these presents, and so far as not defrayed by the said (*capitalist*) shall be considered as part of the patent expenses as hereinbefore defined.

14. Nothing herein contained shall be construed as constituting a partnership between the said parties hereto. Clause negativing partnership.

15. The arrangement hereby entered into shall remain in force until the expiration of the term of the patent to be granted in respect of the said application numbered aforesaid, and of any renewal or extension thereof, and during any further patents, whether British, colonial, or foreign, to be obtained for the said invention, or any such improvements as aforesaid in case both the said parties hereto shall so long live. **Provided always** that it shall be lawful for the said (*capitalist*) at any time hereafter to determine the said arrangement upon giving to the said (*inventor*), or leaving for him at his last known place of business or abode in England, calendar months' previous notice in writing of an intention so to do; And in the event of the said arrangement being determined by the death of either party, or by notice as aforesaid, the said patents and any extension or renewal thereof, and the proceeds of the said patents to be received in respect of any licences, sales, working, or using of the patented inventions which have been granted, effected, or taken place previously to such determination as aforesaid shall, subject to the payment thereout of the costs, charges, advances, interest, and patent expenses as aforesaid (subject to any charge thereon under the provisions hereinbefore contained in favour of the said (*capitalist*) for unpaid advances and interest) belong to the said parties hereto in equal shares, and each of the parties hereto, or their respective executors, administrators, or assigns, shall thenceforward be at liberty and entitled to work, use, and exercise the said patented inventions, and to grant licences (not being exclusive licences) for working and using the same, or to sell, assign, or otherwise dispose of his share and interest in the said patents without being liable to account to the other of such parties, his executors, administrators, or assigns, for the profits, royalties, or moneys to be derived from the same. Duration of arrangement. Proviso for determining arrangement by notice.

As witness, &c.

Assignment of a Patent.

This Indenture made the day of 18 , Between A. B. of of the one part, and C. D. of of the other part.

Whereas by letters patent under the seal of the Patent Office, numbered and dated day of , 18 , and entitled "Improvements, &c. ," Her Majesty the Queen gave and granted unto the said A. B., his executors, administrators, and assigns, Her Majesty's especial licence, full power, sole privilege and authority, that he the said A. B., his executors, administrators, and assigns, and every of them during the term therein expressed should and lawfully might make, use, exercise, and vend his said invention within the United Kingdom of Great Britain and Ireland and the Isle of Man, and the whole profit and advantage from time to time accruing by reason of the said invention during the term of years therein mentioned to have, hold, exercise and enjoy the said licence, power, privileges, and advantages thereinbefore granted unto the said A. B., his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years from the date of the now reciting letters patent next ensuing subject to the conditions and provisoes therein contained. **And whereas** the said A. B. has agreed for the sum of £ to assign unto the said C. D. the said invention and the said letters patent and all the licence, power, privilege and advantage thereby granted, and any extension of the same, together with all improvements and additions useful to the manufacture, the subject-matter of the said letters patent now already in the knowledge or possession of or which may hereafter be made by the said A. B.

General recitals.

Testatum.

Now this Indenture witnesseth that in pursuance of the said agreement and in consideration of the sum of £ , this day paid by the said C. D. to the said A. B. (the receipt whereof is hereby acknowledged) he the said A. B. *as beneficial owner* (*m*), doth hereby assign unto the said C. D., his executors,

(*m*) By the Conveyancing Act, 1881, s. 7 (*a*), it is provided "In a conveyance for valuable consideration, other than a mortgage, the following covenant by a person who conveys and is expressed to convey as beneficial owner (namely):—'That, notwithstanding anything by the person who so conveys, or any one through whom he derives

administrators and assigns, all that the said special licence, full power, sole privilege and authority, and the said invention and all and every of the rights, privileges, profits, benefits, commodities and advantages in and by the said hereinbefore recited letters patent granted, together with the said hereinbefore recited letters patent, and also all the right, title, interest, claim and demand whatsoever of him the said A. B., his executors, administrators and assigns, or any of them, to

title, otherwise than by purchase for value, made, done, executed, or omitted, or knowingly suffered, the person who so conveys, has, with the concurrence of every other person, if any, conveying by his direction, full power to convey the subject-matter expressed to be conveyed, subject as, if so expressed, and in the manner in which it is expressed to be conveyed, and that notwithstanding anything as aforesaid that subject matter shall remain to and be quietly entered upon, received and held, occupied, engaged and taken by the person to whom the conveyance is expressed to be made and any person deriving title under him, and the benefit thereof shall be received and taken accordingly without any lawful interruption or disturbance by the person who so conveys or any person conveying by his direction or rightfully claiming, or to claim by, through, under, or in trust for the person who so conveys or any person conveying by his direction or by, through, or under anyone, not being a person claiming in respect of an estate or interest subject whereto the conveyance is expressly made through whom the person who so conveys derives title otherwise than by purchase for value; and that freed and discharged from or otherwise by the person who so conveys sufficiently indemnified against all such estates, incumbrances, claims and demands other than those subject to which the conveyance is expressly made as either before or after the date of the conveyance, have been or shall be made, occasioned or suffered by that person or by any person conveying by his direction or by any person rightfully claiming by, through, under, or in trust for the person who so conveys or by, through, or under any person conveying by his direction or by, through, or under any one through whom the person who so conveys derives title otherwise than by purchase for value, and further that the person who so conveys and any person conveying by his direction and every other person having or rightfully claiming any estate or interest in the subject matter of conveyance other than an estate or interest subject whereto the conveyance is expressly made by, through, under, or in trust for the person who so conveys or by, through, or under, any person conveying by his direction or by, through, or under any one through whom the person who so conveys derives title otherwise than by purchase for value will from time to time, and at all times after the date of the conveyance on the request and at the cost of any person to whom the conveyance is expressed to be made or of any person deriving title under him execute and do all such lawful assurances and things for further or more perfectly assuring the subject matter of the conveyance to the person to whom the conveyance is made and to those deriving title under him subject as if so expressed and in the manner in which the conveyance is expressed to be made as by him or them or any of them shall be reasonably required: (in which covenant a purchase for value shall not be deemed to include a conveyance in consideration of marriage).'"

apply and petition for, obtain and procure a prolongation, or extension of the said licence, privilege and authority, and of the said term of fourteen years granted by the said hereinbefore recited letters patent, and to apply and petition for, obtain and procure any new or other letters patent to be granted for any new or additional term or terms of years.

Habendum. **To have, hold, and receive**, take, exercise and enjoy the said especial licence, sole privilege and authority, invention, letters patent, rights, privileges, and all and singular the premises hereby assigned or intended so to be unto and by the said C. D., his executors, administrators and assigns for and during all the rest, residue and remainder which is now to come and unexpired of the said term of fourteen years granted and created by the said hereinbefore recited letters patent and for and during all other the term right and interest of him the said A. B. under or by virtue of the said hereinbefore recited letters patent or otherwise howsoever to and for the sole use, benefit and advantage of the said C. D., his executors, administrators and assigns.

And the said A. B. for himself, his heirs, executors and administrators doth covenant with the said C. D., his executors, administrators and assigns, by these presents in manner following, (that is to say) that notwithstanding any act, deed, matter

Covenant as to validity

or thing by the said A. B. done, executed or permitted, the said hereinbefore recited letters patent are at the time of the sealing and delivery of these presents, good, valid and sufficient in the law for all and every of the purposes therein mentioned and expressed, and that the same letters patent or the grant therein expressed or contained have not been and are not surrendered, forfeited or become void or voidable in anywise whatsoever (*n*).

and as to specification being sufficient, &c.

And that the specification filed by the said A. B. at the Patent Office pursuant to the conditions upon which the hereinbefore recited letters patent were granted, well and sufficiently describes and ascertains the nature of the invention mentioned in the said letters patent, and in what manner the same is to be performed, and that the same specification was

(*n*) It is obvious that this is a stringent covenant on the part of the patentee, inasmuch as it renders him responsible should it hereafter appear that for any reason such as anticipation, &c., the letters patent were invalid, this covenant and the next should be carefully considered before they or either of them are inserted.

truly and duly made and filed according to and well, truly, fully and sufficiently performed and complied with the conditions in that behalf in the same hereinbefore recited letters patent expressed and contained.

In witness.

Additional Recitals.

Substituted recital of agreement for a sum down and future payments. See Covenant and Conditions in such a case.

And whereas the said A. B. has agreed for the sum of £ , and for other sums by way of percentage as hereinafter mentioned, and subject to the contracts on the part of the said C. D., hereinafter contained to assign (&c., as before).

Foreign and colonial patents recital.

And whereas the said A. B. has applied for and obtained letters patent or a Brevet d'Invention, for the said invention in the following foreign states and countries . . . . . and in the following British Colonies . . . . . whereby the said A. B., his executors, administrators and assigns, have acquired the sole right privilege and authority to work, use, or vend the said invention in the said Foreign States and British Colonies for the terms of years limited respectively by the said letters patent and Brevet d'Invention, and whereas in consideration of the sum of money hereinbefore expressed, the said A. B. has agreed to assign the said letters patent and Brevet d'Invention to the said C. D.

True and first inventor.

And whereas the said A. B. has represented himself to the said C. D. to be to the best of his knowledge, information and belief, the true and first inventor of the said invention within this realm.

Previous assignments for districts (o),

And whereas the said A. B. has assigned the said letters patent and all the rights, powers, privileges and advantages of he the said A. B. in the said letters patent, and the said inven-

(o) See special covenant necessary in such cases as to applications to amend, &c., &c.

tion for the counties of to G. H. his executors, administrators or assigns, and for the counties of to J. K. his executors, administrators or assigns, &c., &c.

and of intention to assign for other district.

And whereas the said A. B. contemplates and intends to assign the said letters patent and all the rights, powers, privileges and advantages of he the said A. B. in the said letters patent and the said invention for other districts so soon as a purchaser shall be found therefor.

Recital of licence granted.

And whereas the said A. B., by indenture dated , has granted a licence unto E. F. of , his executors, administrators and assigns, to manufacture, use and vend the said invention during the continuance of the said letters patent or any extension or renewal thereof, upon certain terms and conditions as to the payment of royalties and otherwise in the said indenture made and provided (*p*).

Substituted recital of agreement to assign for a district.

And whereas the said A. B. has agreed in consideration of the sum of £ to assign unto the said C. D., benefit of the said letters patent so far as the same relates to the counties of , but not elsewhere, and so far as the same relates to the said counties, all the licence, power, privilege and advantage thereby granted, and any extension of the said letters patent together with all improvements and additions useful to the manufacture the subject matter of the said letters patent now already in the knowledge or possession of or which may hereafter be made by the said A. B.

Assignment for a county (*q*).

Now this Indenture witnesseth that in pursuance of the said agreement, and in consideration of the sum of £ this day paid by the said C. D. to the said A. B. (the receipt

(*p*) This may be varied by reciting "an exclusive licence" or "an exclusive licence for the county of ——."

(*q*) See proviso restricting actions for infringement.

whereof is hereby acknowledged) the said A. B., as *beneficial owner*, doth hereby assign unto the said C. D., his executors, administrators and assigns, all that the said special licence, full power, sole privilege and authority, and the said invention, and all and every the rights, privileges, profits, benefits, commodities and advantages in and by the said hereinbefore recited letters patent granted so far as the same relate to the counties of , and not elsewhere.

Foreign and colonial patents (*r*).

Together with all licence, powers, privileges, and advantages granted to the said A. B., his executors, administrators, and assigns: by virtue of the said recited Letters Patent and Brevets d'Invention for Foreign States and British Colonies.

Assignment of benefit of licences.

Together with all the rights, royalties, benefits and advantages of the said A. B., under and by virtue of the said recited licence granted by the said A. B. unto E. F., his executors, administrators, and assigns.

Additional Covenants. (*See* Recitals.)

Covenant as to percentage when such is stipulated for by vendor.

And the said C. D. hereby covenants with the said A. B. that if and so soon as the said C. D., his executors, administrators, or assigns, shall have received out of the net profits (to be calculated as hereinafter mentioned) arising from or by means of the said invention, or such improvements as aforesaid (patents for which improvements shall have been assigned to or become vested in the said C. D., his executors, administrators, or assigns, or from or by means of any sales, or licences, or dispositions of, or dealings with the same invention, or patented improvements, or otherwise, from, or by means of the using, exercising, vending, or making the said invention, or any such patented improvement as aforesaid, or the said patent, the sum of £ , he, the said C. D., his executors, administrators, or assigns, shall pay to the said A. B., his executors, administrators, or assigns, at the times and in the manner

(*r*) See covenants as to maintaining such foreign patents.

hereinafter mentioned, such a sum or sums of money as shall be equal to a percentage of £ per cent. upon the net profits (to be calculated as hereinafter mentioned), arising as aforesaid, from the time when the said C. D., his executors, administrators, or assigns, shall have received the aforesaid sum of £ , and thenceforth during the remainder of the period in which the said patent hereby assigned, or any such patent for improvements as aforesaid as shall be assigned to or become vested in the said C. D., his executors, administrators, or assigns, shall continue in force. **And further**, that the said C. D., his executors, administrators, or assigns, will, so soon as he or they shall have received from the net profits arising as aforesaid the sum of £ thenceforth twice in every year on the day of , and the day of , or within 14 days thereafter respectively, furnish to the said A. B. an account showing the amount for the half year in respect of which the account is furnished, of the net profits arising as aforesaid; and shall within one calendar month after the date up to which such half-yearly account is furnished, pay to the said A. B., his executors, administrators, or assigns, the percentage by the said account appearing to be due.

Covenant not to apply for leave to amend applicable to assignments for a district (*t*).

And the said C. D. covenants with the said A. B. that he the said C. D., his executors, administrators and assigns, will not apply for leave to amend, or amend, or cause to be amended, the said specification or the drawings thereof, in any way whatsoever without the consent of the said A. B., his executors, administrators, or assigns, in writing, first had and obtained—such consent not to be unreasonably withheld (*s*).

(*s*) In some cases where the district assigned is large a converse covenant on the part of the assignor should be inserted.

(*t*) A great difficulty is introduced by section 36 of the Act of 1883: "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." It will be observed that under this section a patentee can create innumerable patentees all with coequal rights, not only amongst themselves but with the original patentee, but still all possessing only one *original* patent and one specification. It was clearly not the intention of the legislature that the specification might be split up and amended in one county and not in another and so on; but on the other hand the whole validity and value of a patent may very often depend upon the question of amendment or non-amendment—if one assignee amends he might by doing so ruin all the others, on the other hand by refus-

And that in case he, the said A. B., shall obtain letters patent in respect of any improvements, additions to, or discovery useful to the manufacture the subject-matter of the said recited letters patent, he shall, at the expense of the said C. D., his executors, administrators, or assigns (if and when requiring him to do so), execute and do all such assurances and things as shall be necessary or convenient for vesting the same letters patent, and the exclusive benefit thereof, *for the said counties* in the said C. D., his executors, administrators, or assigns.

Covenants by assignor as to taking future patents in assignment for a district only.

And also that he the said A. B., his executors, administrators, or assigns, will pay all fees necessary for the renewal of the said letters patent respectively during the respective terms comprised therein one calendar month at least before the times provided by the Patents, &c., Act, 1883, or the rules made in pursuance thereof in that behalf, but in case of non-payment thereof as aforesaid, will, if required by the said C. D., his executors, administrators, or assigns, permit him or them to pay the same, and any sum if so paid by him or them shall be repayable on demand, together with interest thereon at the rate of 5 per cent. per annum from the time of payment thereof and until repayment, and shall together with the interest aforesaid, be a charge upon the interest of the said A. B. and his executors, administrators, or assigns, in the said letters patent respectively.

Covenant to pay fees on renewal when patent assigned for a district only.

And the said A. B. hereby covenants with the said C. D. that the said A. B. will without any further remuneration or royalties communicate to the said C. D. all improvements which the said A. B. may during the continuance of the said patent invent, discover, or make for or in connection with the said invention, and also all improvements, whether patented or not, of which the said A. B. shall become the owner or of which the said A. B. shall have the control, and will, so far as practicable, at the request and expense of the said C. D., render the same available for the exclusive use of the said C. D., and do

Covenant to communicate and assign future improvements.

ing to consent to an amendment he might do the same thing. The author has drafted a precedent clause which might do for some instances, but it is chiefly introduced to call the attention of conveyancers to the difficulty of the position.

every act, deed, and thing which may be necessary or expedient for obtaining and perfecting patents for all or any such improvements, and for assigning or vesting the same to or in the said C. D.

Conditions to be inserted when a percentage is to be paid as well as a sum down.

And it is hereby further agreed and declared between and by the said parties hereto as follows:

1. For the purpose of calculating the moneys to be derived as aforesaid, there shall be deducted from the gross moneys received from or by means of the said inventions, or such patented improvements as aforesaid, or any sales, or licences, or other dispositions and dealings with the same, or otherwise, from, or by means of the using, exercising, vending, or working the invention, or patented improvements, or patent, which moneys are hereinafter called the gross receipts, all costs, charges, losses, damages, and expenses whatsoever, which the said C. D., his executors, administrators, or assigns, may have already paid or incurred, or may hereafter pay or incur, in or about the obtaining, or endeavouring to obtain, or the keeping in force any such patent for improvements as aforesaid, or the assigning the same to the said C. D., his executors, administrators, or assigns, or in or about the introducing to the public the said patents, inventions, and patented improvements, or any of them, or in or about any such sales, licences, or other dispositions, or dealings as aforesaid, or in or about any legal, or other proceedings, which may be taken for the purpose of restraining infringement of the said patents, or any of them, or for recovering damages for infringements, or which may be taken in respect of any sale, or proposed sale of the said patents, or any interest therein, or any licence or proposed licence for working the said invention and patented improvements, or any of them, or any part thereof; or generally in any manner in or about the said patents, or any of them, or the using, exercising, vending, or working the said invention, or patented improvements, or any of them, or patents, all which costs, charges, losses, damages, and expenses are hereinafter referred to as patent expenses, together with interest at the rate of £ per cent. per annum, upon such patent expenses respectively from the time of the payment thereof, and the difference between the gross receipts for any half year and the

patent expenses for the same half year, shall be the net profits arising as aforesaid, upon which the percentage aforesaid is to be paid.

3. Proper books of account shall be kept by the said C. D., his executors, administrators, and assigns, in which true, plain and perfect entries shall be made of all the payments, expenses, and gross receipts aforesaid, and such books of account shall at all reasonable times be open to the inspection of the said A. B., his executors, administrators, or assigns, or any agent duly appointed by him or them in writing. Keeping accounts.

3. Nothing herein contained shall be construed as obliging the said C. D., his executors, administrators, or assigns to obtain, or endeavour to obtain, any patent for any such improvements as aforesaid, or to accept any assignment of any patent for such improvements, or to pay the stamp duty upon, or to defend, or maintain the said patent hereby assigned, or any such patent for improvements as aforesaid, which may be assigned to, or become vested in him or them, in performance of the covenants in that behalf hereinbefore contained, or to take any steps for restraining infringements of the same patents, or any of them, or recovering damages for any infringement, or to make any sale or sales of the said patents, or any interest therein, or to grant any licence, or licences for the use of the said invention, or any such patented improvements as aforesaid, or any part thereof respectively, or in any manner to use, exercise, vend, or work the said invention, improvements or patents, or any of them; it being hereby expressly agreed and declared that the said C. D., his executors, administrators or assigns, is and are and shall be the absolute owners of the said patent hereby assigned and of any patent or patents for improvements which may be assigned to or vested in him or them as aforesaid, or which he or they may under the covenants aforesaid, require to be assigned to him or them; and that the said C. D., his executors, administrators, or assigns, shall not in regard to the said patents, or any of them, be subject to any control or interference whatsoever of the said A. B., his executors, administrators or assigns. Assignee not to be bound to apply for patent for improvements.

4. During the continuance of the said patent hereby assigned, and during the continuance of any patent or patents for improvements which may be assigned to or become vested Assignor not to assign interest without consent.

in the said C. D., his executors, administrators, or assigns as aforesaid, the said A. B., his executors, administrators, or assigns, shall not sell or dispose of the percentage payable to him or them as aforesaid without the consent in writing of the said C. D., his executors, administrators, or assigns; nor shall the said C. D., his executors, administrators, or assigns, sell, or dispose of the said patents, or any of them, without the consent in writing of the said A. B., his executors, administrators, or assigns.

Assignee not to reassign without consent.

No partnership.

5. Nothing herein contained shall be considered as constituting a partnership between the said parties hereto.

No warranty of validity.

6. Nothing herein contained shall be construed as a warranty by the said A. B., of the novelty or utility of the said invention, or of the validity of the said patent hereby assigned.

Proviso to be inserted in assignment for a district of certain inventions (*u*).

Provided always, and it is hereby further agreed and declared, that no action at law or equity shall be brought by the said C. D. against any person or persons to restrain infringements or to recover damages in respect of the more user of (*collar studs made in pursuance of the said patented invention*) within the said county of provided that such user be not for profit or for sale, or in the way of trade.

Non-exclusive Licence to use Patented Invention in consideration of an Annual Payment and the Purchase of the Patented Articles from the Inventor.

Parties.

This Indenture made the day of 18 , between A. B., of , hereinafter called the patentee of the one part, and C. D. of , hereinafter called the licensee of the other part.

Recitals.

Whereas the patentee is in possession of and entitled to the

(*u*) It is evident that some such proviso as this is of the utmost importance, when the patent is for an article of common use. The words of section 36 are:—"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." It would create great confusion and injury to all parties if a man travelling from London to York were liable to actions by different assignees of the districts through which he travelled on account of wearing a particular collar stud.

full benefit of certain letters patent dated and numbered for an invention entitled , **And whereas** the patentee has agreed to grant to the licensee a licence to use the said invention at , in the course of his trade and business as a upon the terms and conditions hereinafter set forth. **Now this Indenture witnesseth** that in pursuance of the said agreement and in consideration of the payments and covenants hereinafter reserved, contained, and on the part of the licensee to be paid and performed, he the patentee grants to the licensee full and free licence and authority during all the residue now to come and unexpired of the term of fourteen years by the said patent to use the said invention in the course of his trade and business as a , upon the terms and conditions following, that is to say:

1. The licensee shall pay to the patentee upon the execution of this indenture the sum of £ , and further shall once in every year during the continuance of the said letters patent, including any extended term thereof, pay the sum of £ , the first of such payments to be made on or before the day of , 18 . Payments by licensee.

2. The licensee shall purchase of the patentee and the patentee shall sell and deliver to the licensee all the (*here insert name and description of patented articles*) which the licensee shall from time to time require, paying for the same after the rate of per (*dozen or gross*) with net cash within one month after delivery. Covenant to purchase patented articles.

3. The licensee shall not manufacture or vend any of the said , but shall only be entitled to use the same in the course of his trade or business, and the licensee shall not purchase or otherwise acquire any of the said other than of the patentee. Covenant not to manufacture or sell.

4. The licensee shall be at liberty upon giving months' notice in writing to the patentee to determine the licence and all the terms and conditions thereof, provided always that upon any such determination the licensee shall deliver to the patentee free of charge all the which at that time shall be in his possession, or in the possession of any of his servants, agents, or customers. Power to licensee to determine licence.

5. In the event of the infringement of the said patent by any person or persons the licensee shall at the cost of the Covenant by licensee to render

Assistance to patentee in actions.

Proviso patentee not to be bound to take action.

patentee render to him all the information and assistance in his power to enable the patentee to restrain further infringements of the said patent, and to recover damages for any past infringements thereof: Provided always that nothing herein contained shall be construed as placing the patentee under any obligation to take proceedings for the purpose of restraining or recovering damages for infringements, or as in any manner exonerating the licensee from payment of the amounts and observance of the covenants herein reserved and contained by reason that the profits of the licensee from the use of the said invention may be diminished on account of such infringements being permitted.

Determination of licence on default by licensee.

6. Should the licensee make default in the payment of the annual sum hereinbefore provided for, within twenty-one days after the same shall have become due, or commit any breach of the covenants herein contained as on his part to be observed, it shall be lawful for the patentee by writing under his hand to give to the licensee, or leave at his usual or last known place of business in England notice of the patentee to determine this present licence, and thereupon this licence shall be deemed to be determined, and the licensee shall deliver to the patentee as soon as practicable, free of charge, all the which at that time shall be in his possession or in the possession of any of his servants, agents, or customers.

Determination on patent being declared invalid.

7. If during the continuance of the licence hereby granted the said patent shall be pronounced to be invalid by a decision of the House of Lords, these presents shall be void as to the future operation thereof, but without prejudice to any rights or liabilities which shall be then subsisting on either side with respect to any prior breach of any of the covenants and agreements herein contained.

Reduction of payments to level of other licences.

8. If whilst this licence is in force the patentee shall at any time grant any licence or premium to any other person or persons for the use of the said invention in the United Kingdom, and shall reserve any annual payment or charge any price for the said lower than the annual payments and price reserved under and by virtue of this indenture, then that the annual payments and price thenceforward payable to the patentee shall be reduced to an amount equal to the lowest

price reserved and payable for the use of the said invention by such other person.

Power of patentee to amend specification.

9. The patentee shall be at liberty from time to time, and at all times hereafter, without the consent or concurrence of the licensee to apply for and procure the amendment of the specification or specifications of the said invention, whether by way of disclaimer, amendment or alteration.

Transmission clause and cost as "beneficial owner."

10. The word patentee herein shall include the patentee, his executors, administrators, or assigns, and he shall be deemed to covenant as beneficial owner with like effect as if this indenture were a conveyance within the meaning of the Conveyancing and Law of Property Act, 1881. The word licensee shall include the licensee, his executors, administrators, and assigns.

Licensee not to be estopped after determination of licence.

11. Nothing in this indenture contained shall preclude or estop the licensee from disputing the validity of the said patent after the determination of the licence by notice or otherwise.

Arbitration clause.

12. If any dispute, question, or difference shall arise between the parties to these presents, touching these presents or any clause or thing herein contained, or the construction hereof, or any matter in any way connected with these presents, or the operation hereof, or the rights, duties, or liabilities of either of the said parties hereto in connection with the premises then and in every or any such case the matters in difference shall be referred to two arbitrators or the umpire, pursuant to and so as with regard to the mode and consequences of the reference, and in other respects to conform to the provisions in that behalf contained in the Common Law Procedure Act, 1854, or any other subsisting statutory modification thereof, and upon every or any such reference the arbitrators and umpire shall respectively have power to examine the parties and witnesses upon oath or affirmation, and either to fix, settle, and determine the amount of cost of the reference and award respectively or incidental thereto to be paid by both parties or either party, or to direct the same to be taxed either as between solicitor and client, or otherwise to direct and award when, by and to whom such costs shall be paid.

As witness, &c.

Exclusive Licence for a District.

This Indenture made the day of 188 , Between A. B. of , hereinafter called the grantor of the one part and C. D. of hereinafter called the grantee of the other part. **Whereas the** grantor is the registered legal owner of certain letters patent dated and numbered granted for an invention entitled . **And whereas** the grantor has agreed to grant to the grantee the sole and exclusive licence to make, use, exercise, or vend the said invention within the counties of upon the terms and conditions hereinafter appearing. **Now this Indenture witnesseth** and it is agreed as follows :—

Recitals.

Grant.

1. The grantor *as beneficial owner* and with like effect as if these presents were a conveyance, doth hereby grant unto the grantee, his executors, administrators and assigns, the sole and exclusive licence to make, use, exercise or vend the said invention within the counties of and during the continuance of the said letters patent or any extended time thereof, together with all improvements and additions useful to the manufacture the subject-matter of the said letters patent now already in the knowledge or possession of or which may hereafter be made by the grantor.

Consideration and royalty reserved.

2. The grantee shall upon the execution of these presents pay to the grantor the sum of £ , and shall further pay to the grantor during the continuance of the licence once in every year on the day of or within twenty-one days thereafter the sum of £ by way of annual royalty. **Provided always** that in the event of the said letters patent being adjudged invalid by any court of competent jurisdiction and within months of the said judgment the grantor, his executors, administrators, or assigns, shall not have done all things necessary for the purpose of appealing from the said judgment, or in the event of the said letters patent having been adjudged invalid by the House of Lords, then that these presents shall be deemed to be cancelled, and all payments accruing thereafter from the grantee to the grantor shall cease, but without prejudice to the recovery by the grantor of any moneys then already due.

3. The grantor shall not without the consent of the grantee, his executors, administrators or assigns, in writing first had and obtained apply for leave to amend the specification to the said letters patent in any way whatsoever (*x*). Grantor not to amend.

4. The grantee shall be at liberty upon giving months' notice in writing to the grantor to determine this licence and all the terms and conditions thereof, and thereupon the said letters patent for the district hereinbefore defined, and all the rights and privileges thereby granted, shall revert in the grantor absolutely, and the annual payments hereinbefore provided for shall cease. Grantee to be at liberty to determine.

5. The grantee shall be at liberty either in his own name or in the name of the grantor, or both, as he may be advised, to bring any action or proceeding for the purpose of restraining the infringement of the said letters patent within the district hereinbefore defined. **Provided always** that before in any way making use of the name of the grantor in any such action or proceeding the grantee shall give security to the satisfaction of the grantor to indemnify him in respect of any costs or damages which he may become liable for by reason of any such action or proceeding. As to actions

6. The grantor shall pay all fees necessary for the renewal and maintenance of the said letters patent during the term comprised therein one calendar month at least before the times provided by the Patents, &c. Act, 1883, or the rules made in pursuance in that behalf thereof, and in case of non-payment thereof as aforesaid, the grantee shall be at liberty to pay the same and to deduct any monies so paid by him from the annual payments hereinbefore provided for, or to recover the same from the grantor at the grantee's option. Payment of fees, &c.

7. Should the grantor during the continuance of this licence obtain letters patent in respect of any improvements, additions to, or discovery useful to the manufacture of the subject-matter of the said letters patent, he shall at the expense of the grantee grant to him an exclusive licence to make exercise use or vend the invention the subject-matter of the said further letters patent within the said district without any extra or additional

(*x*) See last preceding precedent for the converse — in a general licence the patentee should reserve power to amend, but in an exclusive licence it is obviously otherwise.

payment on the part of the grantee. **Provided always** that the grantor shall not be bound to maintain or keep in force the said further letters patent by payment of the prescribed fees or otherwise.

Default in payment of royalty.

8. Should the grantee make default in the payment of the annual royalty reserved by the second clause hereof as therein provided, it shall be lawful for the grantor to serve upon the grantee by leaving the same at his last known place of business or abode notice in writing determining these presents, and thereupon the licence hereby granted shall cease but without prejudice to the right of the grantor to sue for and recover any arrears of the said annual royalty which may then be due.

No warranty of validity.

9. The licensor notwithstanding anything herein to the contrary shall not be deemed in any way to warrant or represent the validity of the said letters patent.

In witness, &c.

MORTGAGE OF A PATENT.

Parties.

This Indenture made the day of 188 , Between A. B. of , hereinafter called the mortgagor of the one part, and C. D. of , hereinafter called the mortgagee of the other part.

Recitals.

Whereas the mortgagor is the registered owner of certain letters patent dated 188 and numbered for an invention entitled "Improvements, &c. ." **And whereas** the mortgagee has agreed to lend to the mortgagor the sum of £ to be secured together with interest thereon by mortgage of the said letters patent as hereinafter expressed.

Testatum.

Now this Indenture witnesseth that in consideration of the sum of £ this day paid by the mortgagee to the mortgagor (the receipt whereof is hereby acknowledged) the mortgagor doth covenant with the mortgagee that he the mortgagor will pay to the mortgagee on the day of 188 , the sum of £ together with interest thereon at the rate of £ per cent. per annum.

Assignment

And this Indenture also witnesseth that for the consideration aforesaid the mortgagor *as beneficial owner* doth hereby assign to the mortgagee the said letters patent and the sole and exclusive benefit thereof and all extensions thereof and all the rights, privileges, profits, benefits, commo-

ditics and advantages by the said letters patent granted to have and to hold the same to the mortgagee subject to the proviso for redemption hereinafter contained. **Provided always** that if the mortgagor shall pay to the mortgagee the sum of £ with interest for the same at the rate aforesaid then that the mortgagee will at any time thereafter at the request and cost of the mortgagor re-assign to him the said letters patent and the sole and exclusive benefit thereof. And the mortgagor doth hereby covenant with the mortgagee that if the said sum of £ or any part thereof shall remain unpaid after the said day of 18 , he the mortgagor will pay to the mortgagee so long as the said sum of £ or any part thereof shall remain unpaid interest upon such sum as shall from time to time remain unpaid after the rate of £ per cent. per annum by equal half-yearly payments on the day of and the day of in every year. **Provided also** that if the mortgagor shall on every day of and day of until the day of 18 , or within days after the said days respectively pay to the mortgagee all interest then due and shall perform and observe all the covenants on his part to be performed or observed then the mortgagee will not before the day of 18 call in the principal sum aforesaid or any part thereof. **Provided also** that the mortgagor shall not before the day of 18 compel the mortgagee to receive the said principal sum or any part thereof. And that the mortgagor during the continuance of the security will take all steps necessary for the protection of the said letters patent and maintaining the same in full force and effect and for the prevention of any infringement thereof and will pay all fees necessary for the continuance of the said letters patent one calendar month at least before the same shall become due and payable and will whenever required to do so produce to the mortgagee or his agent the receipts for the said fees and in default of the mortgagor taking any such steps as aforesaid or protecting the said letters patent from infringement or making payment of the said fees it shall be lawful for the mortgagee to do or pay the same either in his own name or in the name of the mortgagor as he the mortgagee shall elect and to sue for and recover from the mortgagor any costs, charges or expenses which he may incur in so doing or at his

Proviso for redemption.

Mortgagor to be at liberty to use and work invention,

option to allow the same to remain on the security hereof as monies advanced as aforesaid. **Provided always** that until the mortgagee shall become entitled to exercise the power of sale to be implied herein the mortgagor shall be at liberty to use and work the said invention without interruption from the mortgagee and also may (but so that he shall in each case give to the mortgagee days at least notice in writing of his intention so to do and of the particulars thereof) with the consent of the mortgagee in writing but not otherwise grant licences to use and work the said invention as from the dates thereof respectively for the whole or any part of the term comprised in the said letters patent. **And further** the mortgagor shall within fourteen days after the execution of every such licence furnish the mortgagee with a copy of the same. **Provided also** that *from and after* the time when the mortgagee shall first become entitled to exercise the statutory power of sale to be implied herein but subject to any licences which may have been granted as hereinbefore authorised it shall be lawful for him alone to work the said invention and to grant licences in respect thereof or to assign the said letters patent and invention for districts or otherwise to deal with the same in any manner that he shall think fit. And the mortgagor **doth hereby further covenant** with the mortgagee that he will communicate to the mortgagee during the continuance of this security all improvements which he may discover or make in connection with the said invention and also all improvements which during the said time he shall have control of or acquire by purchase or otherwise and whether patented or not and such improvements and letters patent if any shall be deemed to be comprised within this security and the mortgagor will execute all documents and do all things necessary to extend the operation of this security to all such improvements or letters patent. **And that** during the continuance of this security the mortgagor will not without the consent of the mortgagee first had and obtained amend or apply for leave to amend the specifications to the said letters patent or either of them in any way whatsoever. **And lastly** that it shall be lawful for the mortgagee if the monies secured hereby shall not have been repaid within one year from the expiration of the term of fourteen years for which the said letters patent

and grant licences.

Mortgagor to supply copy to mortgagee.

Proviso for foreclosure.

Communication of improvements.

As to amendments.

As to application for extension.

were originally granted to apply for an extension of such term in his own name or in the name of the mortgagor or of both of them as he shall think fit and the mortgagee shall do all acts and things and execute all documents and prepare all accounts necessary for such application. And it is hereby declared that except where the context requires a different interpretation, each of the expressions "the mortgagor" and "the mortgagee" shall whenever used herein be also applicable as far as possible to the executors administrators and assigns of the person designated thereby. Transmission clause.

In witness, &c.

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