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THE LAW AND PRACTICE

RELATING TO

LETTERS PATENT FOR INVENTIONS

BY

THOMAS TERRELL, K.C.

SIXTH EDITION

48520

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An Associate Member of the Institutions of Civil and Electrical Engineers

LONDON:

SWEET AND MAXWELL, LIMITED

8, CHANCERY LANE, W.C. 2

Law Publishers

1921

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PREFACE TO THE SIXTH EDITION.

NEARLY twelve years have elapsed since the fifth edition of this work appeared. During that period the Statute Law has been amended by the Act of 1919, and by Acts and Rules which have resulted from the Great War and Treaties of Peace. General principles have been re-stated by experienced Judges, by Lord Moulton and Lord Parker in particular, to suit modern requirements.

It has been necessary, therefore, to rearrange and rewrite a greater part of the book. A new chapter has been added on War and Peace Legislation; much of the Law on this subject must be a matter of speculation, but we have endeavoured to deal, in anticipation of authoritative decisions, with some of the many difficulties caused by the necessity of expressing in a single document the least common measure of many and different requirements arising from the diverse legal systems and policies of the numerous parties to the Treaty. The "Vesting Order" of October 30, 1918, makes its first public appearance at the end of this chapter.

Patent Law is peculiarly rich in cases, because all Patent Cases are officially reported, and for the same reason text-books tend to become overloaded with references. From the last edition many obsolete cases have been removed; we have retained only those which are still useful, and have substituted for those removed many newer decisions in which fundamental principles have received modern expression. All case references have been carefully checked and the Index has been amplified.

Stamp Duties, Income Tax, and Excess Profits Duty, as

affecting Patent rights and property, are now dealt with for the first time.

The Appendix has been revised, and the Act of 1907, as printed, incorporates the amendments effected by the Act of 1919.

We desire to express our thanks to Mr. A. J. Martin and other Officials of the Patent Office for valuable suggestions and help, but we are entirely responsible for the opinions and anticipations of Official decisions expressed herein.

C. T.
A. J.

NEW COURT, TEMPLE,
LONDON.

January, 1921.

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THE LAW AND PRACTICE

RELATING TO

LETTERS PATENT FOR INVENTIONS.

CHAPTER I.

LETTERS PATENT.

"LETTERS PATENT" is the name given to the document in which the sovereign signifies his will to confer special rights or privileges upon a subject. The privileges granted to any one when created a peer of the realm or the monopoly of a trade or manufacture are alike conferred by the grant to him of letters patent.

History of the law.

An exhaustive account of the early history of the law would be out of place in a text-book intended for the use of practitioners. The following summary may however serve as an introduction to an account of modern legislation.

It appears to have been recognised as part of the Common Law Prerogative from the earliest times, that the Crown might grant to any one, be he a subject or an alien, a monopoly of a new trade or manufacture provided that the grantee of the monopoly had done something (such as inventing the manufacture or bringing it from abroad or spending much time and money on its development) to merit such a reward. In the days of the Tudor Sovereigns this prerogative was abused, and monopolies were granted to Court favourites without any pretence of merit. The famous "*Case of Monopolies*," otherwise *Darcy* v. *Allein* (*a*), argued in the last year of Elizabeth's reign

(*a*) Mr. Gordon's book, "Monopolies by Patents," Stevens & Sons, 1897, contains a most carefully edited report of this great case, collated

and decided in the first year of the reign of James I., marks the first serious sign of re-action against the growing abuse. The queen had granted to the plaintiff a monopoly of the right of making and trading in playing cards, and he sued the defendant for infringement. The Court of King's Bench, relying upon the courtly doctrine that the Crown could never have intended to make a grant, the effect of which would be injurious to the Realm, decided that the grant sued on was restrictive of trade and industry, and was therefore void.

In the year 1610 King James I. issued his Declaration or "Book of Bounty," which set forth "monopolies" as the first of those "special things for which we expressly command that no suitor presume to move us" and as "Things contrary to Our Laws," but reserved in "a memorial of those suits wherein we are contented to be moved by our servants and subjects, and to reward them according to the particular merit of the suitor," *inter alia* "Projects of new invention so they be not contrary to the Law, nor mischievous to the State, by raising prices of commodities at home, or hurt of trade, or otherwise inconvenient." The language of the king was followed in the Statute of Monopolies, 21 Ja. I. c. 3, enacted in 1623, which recited the royal declaration, declared all monopolies and dispensations void, enacted that the validity of all monopolies and grants should be tried according to the Common Law, and after excepting any letters patent and grants of privilege "heretofore made of the sole working and making of any manner of new manufacture within this Realm to the true inventor or inventor of such manufactures which others at the time of making of such letters patent and grants did not use" (*b*) by the famous 6th section laid down the foundation of modern patent law as follows :—

"Provided also (and be it declared and enacted) (*c*) that any declaration before-mentioned shall not extend to any letters patents and grants of privilege for the term of fourteen years

from all available contemporary sources, and is the best authority upon the history of the early law.

(*b*) Sect. 5.

(*c*) Words in brackets repealed by the S. L. R. Act, 1888, 51 Vict. c. 3, s. 1, Sched., Part I.

or under, hereafter to be made of the sole working or making of any manner of new manufactures (*d*) within this Realm, to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patents and grants shall not use, so as also they be not contrary to the law nor mischievous to the State (*e*), by raising prices or commodities at home, or hurt of trade, or generally inconvenient" (*f*).

It will be seen that the Statute of Monopolies creates no statutory rights, but merely saves the common law rights of the Crown; and by sect. 97 of the Patents and Designs Act, 1907, 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 sect. 93 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 six of the Statute of Monopolies . . . and includes an alleged invention.*"

Definition of "invention" still retained.

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 his 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.

Firstly, he must be the true and first inventor of—

Secondly, a new manufacture;

Thirdly, the new manufacture must not be contrary to law, nor must it be mischievous to the State, by raising the prices

(*d*) See chapters entitled "Novelty" and "Subject-Matter."

(*e*) See Chapters III. and VIII.

(*f*) See Chapter XIII.

of commodities at home; it must not be hurtful to trade, nor generally inconvenient.

The Acts of 1883 and 1907 successively 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.

In the case of *The Badische Anilin und Soda Fabrik* v. *Thompson* (21 R. P. C. 473) it was argued that the patent should be declared void, because it had never been the intention of the patentee to manufacture in this country, and by means of his patent he maintained a very high price in this country for the article which he manufactured in Belgium. It was urged that this was contrary to sect. 6 of the Statute of Monopolies and to the condition recited in the letters patent. It was held that no condition was imposed by law that the manufacture should be carried on in this country, and that in the particular circumstances the evidence had not established that the price maintained was excessive. No opinion was expressed on the question of law as to the effect on the validity of the patent if the evidence had satisfied the Court that excessive prices had in fact been maintained.

The Act of 1907, as amended by the Act of 1919, however, imposed obligations of this kind, which will be considered in Chap. XIII.

The definition of "new manufacture," and the construction which is to be placed upon the word "*invention*," will have to be dealt with hereafter, in the Chapters entitled "Novelty" and "Subject-matter."

Thus we see that the same essentials must be proved to-day by an applicant for the grant of letters patent 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 and Designs Act, 1907, as amended by the Act of 1919, consolidates all the previous enactments and will be dealt with in detail in the course of the consideration of the various branches of the subject as they arise.

The Patents Act of 1907 consolidates the law.

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 attended by all the formalities and expense which surround 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" (*g*). Sect. 14 (1) of the Act of 1907 enacts: "*A patent sealed with the seal of the Patent Office shall have the same effect as if it were sealed with the great seal of the United Kingdom, and shall have effect throughout the United Kingdom and the Isle of Man.*" And sect. 64, "*Impressions of the seal of the Patent Office shall be judicially noticed and admitted in evidence.*"

The seal of the Patent Office.

THE LETTERS PATENT.

Form D in the first schedule to the Act of 1883 gave the form in which letters patent were to be issued, which has since been modified (*h*). By sect. 14, sub-sect. 2, it is enacted, "*Every patent may be in the prescribed form . . .*"

The form of a patent.

Letters patent, as issued at the present time, consist of six material parts:—

1st. The address.
2nd. The recitals.
3rd. The grant.
4th. The prohibition.
5th. The provisoes.
6th. The construction of the grant.

(*g*) *East India Co.* v. *Sandys*, Skin. 225.

(*h*) See Appendix.

THE ADDRESS.

The address is a public address from the sovereign to "all to whom these presents shall come." Hindmarch gives the reason for this as being, that it contains bargains made between the public and patentee.

THE RECITALS.

Recitals contain suggestions which must be true.

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.

These are the so-called "suggestions" which are supposed to have been made to the sovereign prior to the patent being granted and are the representations upon which it has been granted. If either of these suggestions be untrue the patent is void.

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 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. 75 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.

The requirements as to novelty, utility, subject-matter, and

disclosure of the invention in the specifications will be considered in detail in subsequent chapters, but they are all based on the "suggestions" contained in these recitals.

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 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 sixteen years from the date hereunder written of these presents."

The monopoly grant.

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. 97 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. 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, and does not confer upon the patentee a right to manufacture according to his invention. That is a right which he would equally effectively have 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

Nature of patent right.

differs from trade mark.

Is a chose in action.

particular way, and using a particular invention. Accordingly a patentee's right is a chose in action and entirely distinct from the right of property in a chattel, and so comes within sect. 35 of the Trustee Act, 1893, and is incapable of seizure so that it cannot be taken under a writ of *fi. fa.* (*i*).

It was held in *Edwards* v. *Picard* (1909, 2 K. B. 903), by the Court of Appeal, that a receiver could not be appointed to receive royalties under patents towards satisfaction of a judgment.

No property in mere secret.

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 of manufacture cannot, apart from contract express or implied (*j*), 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 (*k*).

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 subsequently to invalidate the plaintiff's patent, or to take out a patent for the invention himself (*l*), and if he does so, he will be liable in damages to the plaintiff (*m*).

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 93rd section, as amended by the Act of 1919, construed as being "*the person for the time being entered on the*

(*i*) *British Mutoscope Co.* v. *Homer*, 18 R. P. C. 177; *Heath's Patent*, 29 R. P. C. 389; *Steers* v. *Rogers*, 10 R. P. C. 245.

(*j*) As in *The Amber Size and Chemical Co., Ltd.* v. *Menzel*, 1913, 2 Ch. 239, and *Alperton Rubber Co.* v. *Manning*, 33 T. L. R. 205; 116 L. T. 499.

(*k*) *Canham* v. *Jones*, 2 Ves. & B. 218; *James* v. *James*, L. R. 13 Eq. 421; *Massam* v. *Thorley's Cattle Food Co.*, 6 C. D. 574.

(*l*) See sect. 15 of the Act of 1907.

(*m*) *Smith* v. *Dickenson*, 3 B. & P. 630.

register as the grantee or proprietor of the 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 sixteen (*n*) 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." **The prohibition.**

The period includes the day of issue and dates from it (*o*).

It is very difficult to understand the form of letters patent which was appended to the Act of 1883, and since substantially followed. 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 PROVISOES.

"Provided always that these letters patent shall be revocable on any of the grounds from time to time by law prescribed as **Proviso for revocation.**

(*n*) *Sixteen* substituted by the amending Act of 1919 for the former term of *fourteen years* and this amendment applies to all patents which were in force on 23rd Dec., 1919, or which might thereafter come into force.

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

grounds for revoking letters patent granted by us and the same may be revoked and made void accordingly" (see Chapters XIII. and XIV.).

The next proviso is one for the determination of the patent in the event of the prescribed fees not being paid (*p*), and the last provides for the supply of the patented article for the use of the public service on reasonable terms.

The rights of the Crown and of contractors under Government Departments are dealt with in Chapter XV.

THE CONSTRUCTION.

Construction of patent.

"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." The meaning of these words is obscure, but they are not inserted in the patent for the purpose of ousting the common rule of construction of grants of the Crown that they shall be read most strongly against the grantee. It would appear that they are a survival of the form which was in use when a patent was granted on an application accompanied by the "title" of the invention only, and have no significance to-day (*q*). In any case this "favourable construction" applies only to the letters patent and not to the specification.

Form of patent of addition.

The form of a "Patent of Addition," created by the Act of 1907, resembles that of an ordinary patent in all particulars material to the questions hitherto discussed (*r*).

Modern Patent Law is regulated by the Act of 1907, as amended by the Acts of 1914 and 1919, the Partial Suspension Act of 1915, the Patents Rules, the Law Officers Rules, the Rules of the Supreme Court Order LIIIA, and the Acts and Orders giving effect to the Treaties of Peace.

(*p*) See the Act of 1907, s. 20, as to restoration of patents which have lapsed for this reason.

(*q*) See *Feather* v. *R.*, 6 B. & S. at p. 287.

(*r*) See Appendix.

CHAPTER II.

THE GRANTEE.

Who may apply.

By sect. 1, sub-sect. 1, of the Act of 1907, "*An application for a patent may be made by any person who claims to be the true and first inventor of an invention, whether he is a British subject or not, and whether alone or jointly with another person.*"

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.

Persons under disability.

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 words "any person" and the Married Women's Property Act, 1882, however, swept away any doubt that might have been entertained on the subject. By sect. 83, which deals with persons under disability of lunacy or infancy, it is enacted that the necessary declarations and other acts may be made and performed by the committee or by a guardian appointed by the Court.

It was always competent for an alien to obtain a patent (*a*).

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

The practice of the Patent Office during the war, and as affected by the Treaties of Peace, will be dealt with in Chapters VIII. and XVIII.

In *Patterson* v. *Gas Light and Coke Co.* (L. R. 2 Ch. D. 832), 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

(*a*) *Wirth's Patent*, L. R. 12 Ch. D. 303; 28 W. R. 329 (but see p. 17 in connection with this particular case); *Chappell* v. *Purday*, 14 M. & W. at p. 318, and *Carez's Application*, 6 R. P. C. 552.

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

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. . . . The consideration for every patent is the communication of useful information to the public. What consideration is there when the information was already the property of the State?" These remarks would seem to have a bearing upon the validity of patents granted to Government officials employed to discover or produce munitions of war, without regard to any reward which may have been recommended to such officials by the Royal Commission appointed for that purpose (*c*).

Under sect. 1 of the Act of 1907, quoted above, it is clear that a patent may be granted to a corporation, together with the true and first inventor; and a grant to a corporation alone can be made in the case of a new manufacture communicated to it from abroad, or under the provisions of the International Convention (*d*). But a corporation cannot apply in the ordinary way open to an individual and describe itself as "the true and first inventor," since a corporation could not be said to invent in the modern sense of the word (*e*).

The enactment that the true and first inventor may receive a grant of letters patent jointly with another person is for the purpose of enabling an impecunious inventor to associate himself with a financier and so to give the latter an interest in the invention from the beginning.

As to the rights of co-grantees and co-owners *inter se*, see Chap. XI.

The declaration.

The law requires that each application shall be accompanied by a declaration to the effect that the applicant, or in the case of joint applicants, one at least is "the true and first inventor;" and in the case of an application by the representative of a deceased inventor a declaration is required that

(*c*) See Chap. XVII.

(*d*) *Carez's Application*, 6 R. P. C. 552; see *In re The Société Annoyme du Générateur du Temple*, 13 R. P. C. 54. See Chap. VIII. for formalities when a corporation is applicant.

(*e*) Hindmarch on Patents, p. 34, and the cases cited in note (*d*), *supra*.

the applicant believes the deceased to have been the "true and first inventor."

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

TRUE AND FIRST INVENTOR.

True and first inventor.

By the common law the Crown had power to grant letters patent, giving monopolies for manufactures newly introduced into the realm, whether newly invented or newly imported. There is no doubt, therefore, that the words "true and first inventor" in the Statute of Monopolies included both—

(1) True and first inventor (in the modern popular sense), and

(2) True and first importer.

Patents granted to importers.

The right of the Crown to grant letters patent to true and first importers of inventions appears to have been a common law right. 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. We find that so far back as 1567 a patent had been granted to one *Hastings* (*f*) 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 Cloth-workers of Ipswich* (1615, 1 W. P. C. 6; 1 Godb. 252) we have this 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. 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

Inventions new to the realm.

(*f*) See "Monopolies by Patents," by Mr. Gordon, at p. 220.

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."

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 manufacture 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 decision of *Edgebury* v. *Stevens* (1691, 1 W. P. C. 35; 2 Salk. 447), where it is said, "for the statute speaks of new manufactures within this realm, so that if it be now 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* (1795, 2 H. Bl. at p. 491; Dav. P. C. 162).

Jessel, M.R., on importers.

The effect of numerous earlier decisions was summed up by Jessel, M.R., in the important case of *Plimpton* v. *Malcolmson* (1876, L. R. 3 Ch. D. at p. 555): "The Act of Parliament (21 Jac. I. c. 3) on which all these patents are founded, tells us this: that to come within the exception of the Statute of Monopolies a man who has the patent must be the first and true inventor, and he must describe something in his specification which is not already known and used. What is the meaning of a first and true inventor? To ascertain its meaning you must have recourse, no doubt, to various decisions given on the statute, which is very nearly three hundred years old. . . . In order that those who may have to consider my judgment hereafter may know the view that I take of the statute, combined with decisions, I will state the result at which I have arrived. As I understand, shortly after the passing of the statute, the question arose whether a man could be called a first and true inventor who, in the popular

sense, had never invented anything, but who having learned abroad (that is out of the realm, in a foreign country, because it has been decided that Scotland is within the realm for this purpose) that somebody else had invented something, quietly copied the invention, and brought it over to this country, and then took out a patent. As I said before, in the popular sense he had invented nothing. But it was decided, and now, therefore, is the legal sense and meaning of the statute, that he was a first and true inventor within the statute, if the invention being in other respects novel and useful, was not previously known in this country—'known' being used in that particular sense as being part of what had been called the common or public knowledge of the country" (*g*).

Declarations distinguish inventors into classes.

Long before the Act of 1852 (*h*), however, there had been a custom or practice for the applicant to state distinctly in his declaration, by virtue of which qualification he prayed for a patent. By sect. 5, sub-sect. 2, of the Act of 1883, it was enacted for the first time that "*every application must contain a declaration that the applicant . . . claims to be the true and first inventor.*" The Rules, however, continued the old practice of using distinct forms for original inventions and those communicated from abroad, but required the applicant on a communicated invention to state that he claimed to be the true and first inventor.

Legal effect of this.

In *Avery's Patent* (L. R. 36 Ch. D. at p. 316), Stirling, J., 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 his 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

(*g*) And see Jessel, M.R., in *Marsden* v. *Saville Street Co.*, L. R. 3 Ex. D. 203.

(*h*) See Hindmarch, pp. 509, 510.

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* (2 Jur. N. S. 1083) what appears to be a dictum of Vice-Chancellor Sir 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* (10 L. T. N. S. 177), 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."

And Lindley, L.J., in the case of *Moser* v. *Marsden* (10 R. P. C. at p. 359), said: "Then it was suggested that as the English patentee had himself improved *Grosselin's* invention, 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."

It follows from the above decisions that a person who has derived an invention from abroad has a choice: he may either say nothing of the source of his knowledge and apply on Form 1 (*i*) stating that he is the true and first inventor, or he may apply on Form 1A (*i*) stating that the invention has been

(*i*) Appendix—Patent Office Rules and Forms.

communicated to him from abroad, stating the name of the person who has made the communication, and stating further, that he (the applicant) is the true and first inventor, as in law we see him to be. In the first case he is under the burden of using the utmost good faith in disclosing the invention (see Chap. VI.). In the second he need only use the utmost good faith in disclosing what has been disclosed to him by his correspondent (*j*). It follows also that in either case the importer of an invention from abroad need not be a meritorious importer; he may be merely the clerk or agent to whom the communication is made by the foreign inventor and as trustee for him, so that he may hold as trustee for the foreigner, but in law the applicant is nevertheless the true and first inventor whether his allegation of communication be true or not (*k*), and save in so far as his relations with his employers are concerned he is in the legal position of a patentee as against others. A communication made in this country 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 meaning of the Statute of Monopolies (*l*). But circumstances might render it necessary to send over from abroad some person who understood the invention, in order that the intended grantee might be able to understand and properly describe it in the specification. It is submitted that this would not prevent the communication from being a genuine "communication from abroad" (*m*).

It was decided in *Wirth's Patent* (12 C. D. 303; 23 W. R. 329) 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, as a matter of practice, is no longer possible, a direction having been given

(*j*) See Chap. VI.

(*k*) *Beard* v. *Egerton*, 3 C. B. at p. 129; *Nickels* v. *Ross*, 8 C. B. at p. 723; *Steedman* v. *Marsh*, 2 Jur. N. S. 391; *Avery's Patent*, 36 C. D. 307.

(*l*) *Marsden* v. *Savile Street Foundry Co.*, L. R. 3 Ex. D., per Jessel, M.R., at p. 206.

(*m*) Discussed but not decided in *Pilkington* v. *Yeakley Vacuum Hammer Co.*, 18 R. P. C. 459, and see (on same patent) *Jameson's Patent*, 19 R. P. C. 246.

that only persons resident in the U.K. may apply on Form 1A for a grant, this direction being expressly designed to prevent foreign agents from making the declaration (*n*).

If the invention has been communicated from abroad the Comptroller will not enter into any inquiry as to whether it was obtained honestly or otherwise (*o*).

The special provisions with respect to applications under the International Convention will be discussed later in this chapter.

The actual inventor.

An actual inventor is a person who, either by accident or design, produces or discovers an art or manufacture. The operation of the mind in which the invention originates must 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 any one else whom he may employ for the purpose. What amount, if any, of labour of the mind is required is another question, and will be dealt with more fully under the head of "Subject-matter." But it may be broadly stated here, that provided the invention has originated in the mind of the patentee, the Court will not inquire further, but will judge in the main from the results produced as shown in the invention itself.

It must be remembered that the question "Is the patentee true and first inventor?" is entirely separate and distinct from one which we shall have to consider later, in the Chapter on Novelty, viz., "Is the invention itself new?" In the former case we are dealing with the history of an idea in the mind of a particular man; in the latter with the history of a manufacture.

True inventor and novelty distinguished.

This difference was pointed out by Tindal, C.J., in *Gibson and Campbell* v. *Brand* (1 W. P. C. at p. 628): "The defendant next says that these letters patent have not been granted to the true and first inventors, which you are aware is a condition required by the statute. Now 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

(*n*) *Official Journal*, 9th May, 1884.

(*o*) See Chap. IX.

first and true inventor; he may have borrowed it from some other person, he may have taken it from a book, he may have learnt it from a specification; and then the legislature never intended that a person who had taken all his knowledge from the act of another, from the labours and assiduity or ingenuity of another, should be the man who was to receive the benefit of another's skill. There is some distinction, although perhaps not a very broad one, between the plea which alleges the plaintiffs were not the first and true inventors and that on which I conceive the principal question between the parties will turn . . . whether the subject-matter of this patent was known in England at the time the letters patent were granted?" (*p*).

In *Tennant's Case* (1 W. P. C. 125) a material portion of the invention claimed was found to have been suggested to the patentee 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 some one else and communicated to the plaintiff, he was held not to be an inventor.

In *Cornish* v. *Keene* (1 W. P. C. 507), 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 to 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 (*q*) was new—that the party who got the patent 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

(*p*) And see *Household Co.* v. *Neilson*, 1 W. P. C. at p. 689.

(*q*) *I.e.*, the publication to the world.

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 have followed *Cornish* v. *Keene*. The principle laid down in those cases we have cited has invariably been followed.

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 with the full intention of abandoning them, B. will not be the first inventor. Take, for instance, the case of *Dollond's Patent* (unreported but mentioned with many other cases in 1 W. P. C. 43): this was an improvement in the manufacture of object-glasses for telescopes. 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.

Dollond's Case.

In *Lewis* v. *Marling* (10 B. & C. at p. 27; 1 W. P. C. at p. 496; 4 C. & P. at p. 58) Bayley, J., 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.

Master and servant.

The extent to which science has developed in modern times, and the immense labour and time required to work out the details of construction of a complicated machine, frequently make it impossible for one man to perfect his invention by himself. And it is the practice of inventors to suggest the

main idea to subordinates, together with rough plans and sketches, and to leave the practical working out of the details to the latter, a task often requiring great skill, and occasionally even inventive ability. But this skill, while exercised in the employment of the master, and under his general directions, does not entitle the servant or workman to claim an interest in the invention, although the claim by the master to the ingenuity of the servant does not extend beyond mere improvements in mechanical details. 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 involved in the question, "Is it the idea itself, or is it merely the method of carrying the idea into effect, that constitutes the pith of the invention?"

The rights of the master.

The cases illustrating the question of "true and first" inventor as affected by the relation of master and servant must be distinguished from those in which a servant is bound under an express or implied contract to give to the master the benefit of any inventions which he (the servant) may make while in the master's employ. In these latter there is usually no doubt that the servant is the inventor, and the only question for decision is as to the right of the master to have the patent when granted assigned to or held in trust for him by the servant. Such cases will be referred to in the discussion now following.

Cases to illustrate.

The summing up of Baron Alderson, in the case of *Minter* v. *Wells* (1 W. P. C. at p. 129), 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 some one else had invented it, the Crown is deceived in that suggestion, which was the foundation on which it granted the patent; and then the 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 (r) 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."

In *Allen* v. *Rawson* (1 C. B. at p. 567), Erle, J., directed the jury thus: "I take the law to be that, if a person has discovered an improved principle, and employs engineers, agents, or other persons to assist him in carrying out that principle, and they in the course of experiments arising from that employment make valuable discoveries accessory to the main principle, and tending to carry that out in a better manner, such improvements are the property of the inventor of the original improved principle, and may be embodied in his patent; and if so embodied the patent is not avoided by evidence that the servant or agent made the suggestion of the subordinate improvement of the primary and improved principle." This was confirmed by Tindal, C.J., who said (p. 574): "It would be difficult to define how far the suggestions of a workman employed in the construction of a machine are to be considered as distinct inventions by him, so as to avoid a patent incorporating them taken out by his employer. Each case must depend on its own merits. But when we see that the principle and object of the invention are complete without it, I think it is too much that a suggestion of a workman, employed in the course of the experiments, of something calculated more easily to carry into effect the conceptions of the inventor, should render the whole patent void." This case was followed by Buckley, J., in *In re Smith's Patent* (22 R. P. C. 57).

But where the idea of the invention has not been suggested by the employer, there is nothing to prevent the servant having a patent. The Solicitor-General, in *In re Heald's Patent* (8 R. P. C. 429), said: "I am not aware of any authority which lays it down that the invention of a servant, even made in the employer's time, and with the use of the employer's materials, and at the expense of the employer, thereby becomes

(r) A workman in the plaintiff's employ.

the property of the employer, so as to prevent the person employed from taking out a patent for it," particularly where the servant has been requested to invent, as in *Marshall and Naylor's Patents* (17 R. P. C. 553).

Where servant requested to invent.

The cases all seem to show that the man who conceives the idea has no right to the inventions of the man 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.

Where relations confidential.

It may be, however, that the relations between master and servant may be of such a close and confidential character that it may be inequitable to allow the servant to retain the benefit of a patent. In *The Worthington Pumping Engine Co.* v. *Moore* (20 R. P. C. 41), the plaintiffs employed the defendant as their agent and manager in England, and communications constantly passed between them as to improvements and alterations in the machines sold to suit the English market. The defendant was employed at a high rate of remuneration and a commission. There was no express stipulation as to inventions or original suggestions which might be made by the defendant. The defendant took out three patents for inventions which he employed in the business of the plaintiffs. He was subsequently dismissed, and sought to restrain the plaintiffs from using the patented inventions. This action was to obtain a declaration that the defendant should be declared a trustee for the said patents on behalf of the plaintiffs. Byrne, J., said (p. 46): "I think he (the defendant) would not have been acting in accordance with the good faith implied in his contract had he kept back new ideas or details of construction suggested or carried out in the ordinary course of business between the parties (even though such ideas or details might have been in the hands of a third person properly subject-matter for a patent) with a view to his personal profit at the expense of the plaintiff corporation. It appears to me that the degree of good faith due from the defendant to the plaintiff company was little, if at all, less than that required from a partner towards the

Cases.

firm of which he was a member . . . (p. 48). I propose now to deal with the principles of law applicable to the case; and first I desire to say that I recognise and quite appreciate the principle of those cases which have established that the mere existence of a contract of service does not *per se* disqualify a servant from taking out a patent for an invention made by him during his term of service, even though the invention may relate to subject-matter germane to and useful to his employers in their business, and that, even though the servant may have made use of his employers' time and servants and materials in bringing his invention to completion, and may have allowed his employers to use the invention while in their employment; but, on the other hand, without repeating what has been so fully and admirably expressed by the Court of Appeal in the two cases of *Lamb* v. *Evans* and *Robb* v. *Green* (*s*), it is clear that all the circumstances must be considered in each case. I consider that, bearing in mind the principles laid down in the authorities to which I have referred, it is impossible to say in the present case that the defendant has established the right he claims, having regard to the obligations to be implied arising from his contract of service, and I am of opinion that his case is inconsistent with an observance of that good faith which ought properly to be inferred or implied as an obligation arising from his contract" (*t*).

Similarly on the basis of express or implied contract a servant may be sued for damages and an injunction to restrain him from making any use of secrets learned while in the service of the employer (*u*).

Applications in fraud of inventor.

By sect. 15 of the Act of 1907, as amended by the Act of 1919, "(1) *A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the*

(*s*) See *Lamb* v. *Evans*, 1893, 1 Ch. 218; *Robb* v. *Green*, 1895, L. R. 2 Q. B. 315.

(*t*) And see *Richmond & Co.* v. *Wrightson*, 22 R. P. C. 25; and *Edisonia, Ltd.* v. *Forse*, 25 R. P. C. 546; *British Reinforced Concrete Co.* v. *Lind*, 34 R. P. C. 101.

(*u*) *The Amber, Size and Chemical Co., Ltd.* v. *Menzel*, 1913, 2 Ch. 239; *Alperton Rubber Co.* v. *Manning*, 33 T. L. R. 205; 116 L. T. 499.

invention subsequent to that fraudulent application during the period of provisional protection.

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

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

In *Richmond & Co., Ltd.* v. *Wrightson* (22 R. P. C. 25), the defendant Wrightson had applied for certain patents (including foreign patents), having obtained the invention either from A. or from B. (but from which of them was not decided). Buckley, J., made a declaration that the defendant was trustee of all the patents for A. and B. jointly. Subsequently (*unreported*), when the time came for sealing the patents, it was found by Sir E. Carson, S.-G., that as Wrightson was expressly declared by the judgment not to be the true and first inventor, no patent could be sealed. But A. and B. were able to apply for a patent under sect. 35 of the Act of 1883.

Provisional protection.

By sect. 4 of the Act of 1907, "*Where an application for a patent in respect of an invention has been accepted, the invention may, during the period between the date of the application and the date of sealing such patent, be used and published without prejudice to the patent to be granted for the invention. And such protection from the consequences of use and publication is in this Act referred to as provisional protection.*"

Under the Act of 1852, s. 23, the Lord Chancellor had a discretion as to the date of the patent. This discretion no longer exists. The Act of 1883, s. 13, first fixed the date of application as the date of the patent.

The general question of concurrent applications, where there is no fraud, that is, where each applicant is in a position to offer the consideration of invention, 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.

Applications under International Convention.

It was provided by sect. 103 of the Act of 1883, as amended by sect. 6 of the Act of 1885, and re-enacted by sect. 91 of the Act of 1907, amended by the Act of 1914, 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 twelve months from his applying for protection in the foreign State with which the arrangement is in force. The section also applies to such British Colonies as have made arrangements for the protection of inventions patented in this country.

The object of the section 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 were, under the Convention of 1883, purely personal to the applicant in the foreign country himself, and could not be enjoyed by the agent of such applicant or by any person to whom he had communicated his invention (*v*), but under the 1911 Convention and the Patents and Designs Act, 1914, the right is extended to the legal representative or assignee of the applicant in the foreign country.

In *Eisler's Application* (*w*) the applicant had made an application in the United States, but he prayed that a patent should be granted, not to him, but to a company. He now applied for a patent to be granted to him in this country claiming the

(*v*) *Shallenberger's Application*, 6 R. P. C. 550; *Carez's Application*, 6 R. P. C. 552; *Lentz and Berner's Application*, 31 R. P. C. 71.

(*w*) 34 R. P. C. 69.

date of his application in the United States. The Comptroller having his suspicions aroused by the circumstances of the application in the United States required the applicant to declare whether or not he had assigned his right in this country, and on the applicant's refusal to answer, the Comptroller who was supported in his attitude by the Law Officer declined to proceed with the application.

Foreigner has alternative rights.

A foreign patentee thus has alternative rights: he may either take advantage of the Act and apply for a patent, antedated to the date of his first foreign application, and thereby shorten the period of protection to that extent, or he may obtain a patent for the full period from the actual date of application, in the ordinary way, the date of the patent being conclusive to show which course he has pursued; he may also obtain a patent for the full period by instructing his British agent to apply on a communication from abroad, the patent when obtained to be conveyed to the foreigner; but after having obtained a patent for the full period in the ordinary way, he may not avail himself of the provisions of sect. 91 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 (*x*).

Rule 15 provides that the application in this country must be made within twelve months of the earliest foreign application, and the dates of all foreign applications must be set forth. If therefore, the applicant conceals the fact of a foreign application having been made prior to that specific one, in respect of which he requests his British application to be dated, it is submitted that he has committed a fraud on the Crown, and that his declaration is false in a material particular. This point was taken in the pleadings attacking the validity of a patent in a case in our experience but it was not brought to trial (*y*).

The time limited by the Convention for the filing of applications has been extended by the Treaties of Peace subject to

(*x*) *The British Tanning Co.* v. *Groth*, 8 R. P. C. 113; *Acetylene Illuminating Co.* v. *United Alkali Co.*, 19 R. P. C. 222.

(*y*) See *Van der Poele's Patent*, 7 R. P. C. 69, as supporting this view of the law.

provisions for safeguarding the rights of persons *bonâ fide* in possession of conflicting rights prior to the coming into force of the Treaties (see Chap. XVIII.).

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 Law Officer that the period (seven months at that time) 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 (*z*).

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 person for letters patent in respect of a similar invention, it was held by the Law Officer 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" (*a*).

(*z*) *Van de Poele's Patent*, 7 R. P. C. 69.

(*a*) *Main's Patent*, 7 R. P. C. 13.

CHAPTER III.

SUBJECT-MATTER.

Statute of Monopolies.

THE Statute of Monopolies declared all grants of monopoly rights to be void at common law, but sect. 6 provided "*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 shall not use. . . .*" This definition of the subject-matter of a valid grant has been followed in all subsequent enactments; by sect. 93 of the Act of 1907, "'*Invention*' *means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies.*"

In actions for infringement and petitions for revocation the validity of the patent is frequently called in question under the plea that "the alleged invention is not proper subject-matter for Letters Patent" and the object of this chapter is to discuss the significance of this plea and the legal requirements of an invention to secure immunity from its attack. The plea is used in two senses, which are nevertheless related.

Firstly, it is clear that in order to be classed as a "manufacture" an invention must have a very close relation to something tangible. It is easy to assent to the proposition that the production of a new class of article, or a method of producing a new artificial substance is a "manufacture," and that on the other hand a plan of campaign in warfare or business, or the discovery of a hitherto unknown natural law is not a "manufacture."

The importance of progress was gradually realised during the

great industrial revolution of the late eighteenth and early nineteenth centuries, and we find that the Courts gradually extended the meaning of the word manufacture to include improvements in manufacture and to changes in method which though small in themselves are shown to have had great economic importance. In 1819 Abbott, C.J., said (*a*): "Now the words 'manufacture' has been generally understood to denote either a thing made, which is useful for its own sake, and vendible as such, as a medicine, a stove, a telescope, and many others, or to mean an engine or instrument to be employed either in the making of some previously known article, or in some other useful purpose, as a stocking-frame, or a steam engine for raising water from mines. Or it may perhaps extend also to a new process to be carried on by known implements, or elements, acting upon known substances, but producing it in a cheaper or more expeditious manner, or of a better or more useful kind. But no merely philosophical or abstract principle can answer to the word manufactures. Something of a corporeal and substantial nature, something that can be made by man from the matters subjected to his art and skill, or at the least some new mode of employing practically his art and skill, is requisite to satisfy this word." The doubt felt by the Chief Justice as to patents for processes has long since been resolved in their favour.

Meaning of "Manufacture."

The judges at first 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 of processes for 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. The judgment in *Boulton* v. *Bull* (1795, Dav. P. C. 191) confirmed the change of opinion, and

(*a*) *R.* v. *Wheeler*, 2 B. & Ald., at p. 349.

in 1841, in the case of *Gibson* v. *Brand* (1 W. P. C. at p. 633), Tindal, C.J., said: "The patent is taken out 'for a new or improved process for the manufacture of 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. *Watt* (1795, 2 H. Bl. 468; Dav. P. C. 207), and such also appears to have been the opinion (carefully guarding against any abuse of that doctrine) of Lord Tenterden in the case of *R.* v. *Wheeler* (cited above)."

It is still a common thing for the Patent Office to receive requests for Patents for ingenious notions which cannot be classed as manufactures under any interpretation of the word, such, for example, as schemes for arranging correspondence, new systems of musical notations, a method for extracting metal from the human body, the use of a well-known substance as a manure for increasing the fertility of the soil, and many others (*b*). Inasmuch as these applications rarely result in the grant of a patent validity is seldom attacked in the Courts on the ground that the alleged invention lacks subject-matter in the sense of having no relation to a manufacture whatever.

A bare principle not a manufacture.

There are nevertheless some cases which illustrate this aspect of the question of subject-matter. For example, no man can claim the monopoly of a principle, for that would be to claim the laws of nature, which have always existed. Man merely discovers the principle; but if, when he discovers a principle, he can discover a method of utilising 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.

(*b*) See, *e.g.*, *Johnson's Application*, 19 R. P. C. 56; *A. F.'s Application*, 31 R. P. C. 58; *C. and W.'s Application*, 31 R. P. C. 235; *B. A.'s Application*, 32 R. P. C. 348; *T.'s Application*, 37 R. P. C. 109; *F.'s Application*, 37 R. P. C. 112, and the doubtful case of *Cooper's Application*, 19 R. P. C. 53.

Cases on alleged claims to principle.

Lord Justice Clark Hope, in directing the jury in the case of *The Household Co.* v. *Neilson* (1843, 1 W. P. C. at p. 685), 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. If that were necessary you see what would be the result? Why, that a patent could hardly ever be obtained for any mode of carrying a newly discovered principle into practical results though the most valuable of all discoveries. For the best form and shape or modification of apparatus cannot, in matters of such vast range, and requiring observation on such a great scale, be attained at once; and so the thing would become known, and so the right lost, long before all the various kinds of apparatus could be tried. Hence 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" (*c*).

In the above case, as in the case of *Neilson* v. *Harford* (1841, 1 W. P. C. 295), the patent was for producing heat in furnaces, by blowing the air for the furnace through a vessel which was heated. It was stated in the specification that the size of the vessel was to depend on the circumstances, and there was no claim. The Court held that the method suggested for carrying the principle into effect was sufficient to support a patent.

In *Otto* v. *Linford* (46 L. T. N. S. 36), 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

(*c*) See also Moulton, L.J., quoted on p. 48, *post*.

produced by the combustion *are rendered gradual* substantially as and for the purposes set forth."

Jessel, M.R., in the Court of Appeal, said (p. 39): "It is said that what is claimed is a principle . . . or, as 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." The Master of the Rolls then instanced the case of *Neilson* v. *Harford* (supra).

In *British United Shoe Machinery Co.* v. *Simon Collier, Ltd.* (*d*), the patent was for a machine for performing some of the operations involved in boot-making, more particularly trimming the edge of the sole. The position of the trimming knife at any moment was automatically governed by the position of a guide which bore upon another portion of the boot so that the width of the sole was varied in relation to that other portion. One of the patentee's claims was as follows: "In a sole trimming machine, a trimming knife, a guide, support therefor, and automatic means for automatically varying the relative positions of the knife and guide during the trimming operation for the purpose described." One method of effecting such automatic variation (by means of a cam) was described and made the subject of other claims. Mr. Justice Parker said: "If on the true construction of the specification, the claim is as wide as the defendants contend, the validity of the patent depends upon whether an inventor, who discloses one way of doing automatically for a particular purpose what, in existing machines, could be done for the same purpose, not indeed, automatically, but by the service of skill on the part of the workman, can obtain the grant of letters patent for all means of doing the same thing automatically for the same purpose. It appears

(*d*) Reported on this point in 21 R. P. C. 21.

from the judgment of Baron Alderson in *Jupe* v. *Pratt* (*e*), approved by the House of Lords in *Chamberlain* v. *Mayor of Bradford* (*f*), that though you cannot take out a patent for a principle, yet if the principle is new, and you show one mode of carrying it into effect, you may protect yourself against all other modes of carrying the principle into effect. If, however, the principle is not new, you can only protect yourself against those modes of carrying it into effect which are substantially the same as the mode you have yourself invented, the question being in each case what is the pith and marrow of the invention sought to be protected, and it being impossible to treat any principle already known as part of such pith and marrow. Thus, where the principle is old, a claim to all modes of carrying it into effect will avoid the patent as in *Patterson* v. *Gas Light and Coke Co.* (*g*). . . . In the present case, considering that in existing machines the relative position of knife and guide could be varied (though not automatically) . . . the problem was simply how to do automatically what could already be done by the skill of the workman. On the other hand, the principle which the inventor applies for the solution of the problem is the capacity of a cam to vary the relative position of two parts of a machine while the machine is running. Assuming this principle to be new, it might be possible for the inventor, having shown one method of applying it to the solution of the problem, to protect himself during the life of his patent from any other method of applying it for the same purpose, but I do not think that the novelty of the principle applied would enable him to make a valid claim for all means of solving the problem whether the same or a different principle were applied to its solution. If he could do so, it would seem to follow that the invention of one means to secure a particular end would entitle an inventor to protection against all means of attaining the same end. If therefore the claim be construed as including all automatic means of solving the problem (the learned judge

(*e*) 1 W. P. C. 146.

(*f*) 20 R. P. C. 684, and see *British United Shoe Machinery Co.* v. *Standard Rotary Machine Co.*, 35 R. P. C., per Lord Haldane, at pp. 46 and 47.

(*g*) L. R. 2 C. D. 812.

held that it had this meaning), I am of opinion it is too wide, and is not proper subject-matter for letters patent" (*h*).

Doubts have been expressed as to whether a patent can be granted for a new product irrespective of the manner in which it had been brought into existence. It is submitted that such a grant would be wholly invalid, since it would not be for a manufacture at all. For example, a new metal might be smelted from some well-known mineral, which metal might possess extraordinary qualities, and become indispensable. A valid patent could be obtained for the process of smelting, if novel in itself, which would probably receive a wide construction so as to cover any substantially similar process. But if some one discovered a vein of the metal in a pure state requiring no smelting, the person who had actually first discovered the metal, and patented the process of smelting, could not have a patent to prevent the owner of the vein from selling the produce of his mine. The same remarks apply to a chemical product. Of course, the use of the product in manufactures could be patented if the patentee described some particular method of using it. In other words, a discovery of properties is not a manufacture. **Patentability of new substance discussed.**

By sect. 11 of the Patents and Designs Act, 1919, the following section was inserted in the principal Act :—

"38A (1) *In the case of inventions relating to substances prepared or produced by chemical processes or intended for food or medicine, the specification shall not include claims for the substance itself, except when prepared or produced by the special methods or processes of manufacture described and claimed, or by their obvious chemical equivalents. Provided that, in an action for infringement of a patent where the invention relates to the production of a new substance, any substance of the same chemical composition and constitution shall in the absence of proof to the contrary be deemed to have been produced by the patented process.*" And later on: "*This section shall apply only to patents applied for after the passing of this Act*" (23 December, 1919).

Therefore patents in respect of chemical substances applied

(*h*) And see *Automatic Weighing Machine Co.* v. *Knight*, 6 R. P. C. at p. 308.

for before 23 December, 1919, depend for their validity if any upon the law as it was before that date, and for the reasons stated above it is suggested that substances are not subject-matter for grants inasmuch as they do not necessarily involve a manufacture.

The judgment of Lord Davey in *The Acetylene Illuminating Co.* v. *United Alkali Co.* (22 R. P. C. at p. 153) contains some observations which would seem to indicate a contrary view, but it is respectfully submitted that the remarks are *obiter dicta* and were clearly not necessary to a decision on the facts of that particular case; moreover, the point was not argued. His lordship said: "The title of the patent, which is still retained, is 'Improved metallic carbides applicable for use in the production of acetylene, and means for producing the same.' I need scarcely say that if the patentee had discovered a new matërial of the character which he mentions, a material having the very valuable commercial properties which he ascribes to it, that would have been a good subject-matter for a patent, and there would have been no question, supposing that he had done so, that his patent was a good one. He would be bound, of course, to state the means by which he produced that material; but the novelty of the means or the process by which the material was produced would have been immaterial, because the merit and the novelty of the invention would consist in the substance produced itself." This case was decided upon the ground that neither the substance nor the method of manufacture were novel. The remarks of Cotton, L.J., in *Vorwerk* v. *Evans* (7 R. P. C. at p. 271) are open to the same comment (*i*).

Equally *obiter* were the observations of Buckley, J., in *Kopp* v. *Rosenwald* (19 R. P. C. at p. 211), expressing the contrary view. The "invention" there consisted in an entirely new article (strips of whalebone braided together with a selvedge for sewing) by the use of a machine which was old. The claim was for "The manufacture of the new material, strips of natural whalebone covered or braided with threads of fibrous material applied substantially in the manner and by the means

(*i*) See also the remarks of Eyre, C.J., in *Boulton* v. *Bull*, 1795, Dav. P. C. at p. 208.

hereinbefore described with reference to and shown in the drawings." It was not denied during the case that the article produced was quite new and useful. Buckley, J., said: "The subject-matter of this invention, Mr. Terrell tells me, is that the patentee says there is a well-known thing known as a braiding machine, and that he tells you, 'Select a particular type of that well-known machine, namely, one with four heads and thirteen spindles. Use it in the way indicated in my specification, and the result is you will produce an article which is new,' and that is patentable. Now I doubt myself whether, in the strict sense of the word, an article can ever be treated as being in itself the subject of a patent. In saying that, I am not for a moment forgetting *Thompson* v. *American Braided Wire Co.* in the House of Lords. What I mean is that, assuming that an article is produced by a particular process, and that that article is new, you may say that you take out a patent for the article in the sense that it is a new thing, and it is got out in a way which was not known before, but I do not think it has ever been laid down that it would be an infringement of a patent for that article if some one ascertained a totally different path by which you would arrive at the same completed thing." The patent was held invalid by the learned judge on the ground that the claim was for a process, and that the process itself was old—its new application requiring no invention. It is submitted that the reasoning of Buckley, J., was correct. The invention must be of "a new manufacture," and protection will be granted against any method of manufacture of the new product which is substantially similar to that of the patentee. In other words, the construction will be wide, as is usual where a new process is applied to effect a new result.

Claims to applications of new principles have wide scope.

Where a new principle has been shown newly applied to some new object, the method of application shown will be given a very wide construction by the Courts, and as Wright, J., said: "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" (*j*).

In the Court of Appeal, Cotton, L.J., speaking on this

(*j*) *Edison Bell Phonograph Co.* v. *Smith*, 11 R. P. C. at p. 148.

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" (*k*).

The construction of the claim in relation to its ambit will be more fully discussed in Chap. VII. on Infringement.

Subject-matter in the sense of "Invention."

We now turn to the more numerous decisions in which the term subject-matter is used in a somewhat different sense. In this class there is no question that the invention must be classed as a manufacture; frequently also it is admitted or proved that the invention is novel and useful, but it is contended that the step forward taken by the patentee in view of the state of the common knowledge in the art "did not call for any exercise of the inventive faculty," or, more shortly, "did not require invention," and the debate and the decision really turn upon the question whether or not it was *obvious* in view of the common knowledge at the date of the patent. The decisions are therefore really decisions of feeling (*l*)—each judge viewing the invention against the background of his own experience of life. It has often been said that "subject-matter is a question of law, whereas novelty is a question of fact," and it is possible to cull from the reported cases general principles which judges are used to take into consideration when arriving at a decision; nevertheless subject-matter is always the most uncertain issue in patent cases, depending as it does upon the temperament and experience of the judge.

The difference between novelty and subject-matter was stated by Lindley, L.J., as follows (*m*): ". . . In considering subject-matter, novelty is assumed; the question is whether, assuming

(*k*) *The Automatic Weighing Machine Co.* v. *Knight*, 6 R. P. C. at p. 304; and see *Ashworth* v. *English Card Clothing Co.*, 20 R. P. C. 790.

(*l*) See p. 52, post.

(*m*) *Gadd and Mason* v. *Mayor, etc. of Manchester*, 9 R. P. C. at p. 515.

the invention to be new, it is one for which a patent can be granted. In considering novelty, the invention is assumed to be one for which a patent can be granted if new, and the question is whether on that assumption it is new. Has it been disclosed before? If there is an earlier specification for the very same thing, the second invention is not new; but if the two things are different, the nature and extent of the difference have to be considered."

The cases discussed hereafter are cited to define and illustrate the principles which commonly guide the tribunal in deciding whether or not the invention was or should have been obvious to the person skilled in the art at the date of the letters patent in question.

Summary of law of invention.

Put quite shortly the law on subject-matter may be stated thus. If the invention is a manufacture, if it is new, if it is useful, and if the judge holds on the evidence that it is one which would not have been obvious to a person skilled in the art and acquainted with the common knowledge in that art at the date of the patent, then it is subject-matter for a grant. For purposes of convenience the questions of utility and novelty will be separately treated.

Mind of inventor immaterial.

It will be observed that in the decisions, much use is made of the word "invention." It must not be imagined that the State attaches the slightest importance to what has actually occurred in the mind of an inventor (*n*). Patents have been held valid for inventions that have been the result of the merest accident (*o*), and for inventions imported from abroad. But in considering whether any given invention can be considered obvious or not in the light of prior common knowledge it is necessary to inquire whether in fact the new application would be indicated by an examination of the old application. In considering this question regard must be had to the class of persons to whom the specification is addressed, and who are concerned in the act with which the invention deals. If it can be shown that the new result was long sought for:—if it be shown that persons of this kind had been working

Evidence required.

(*n*) See Tindal, C.J., in *Crane* v. *Price*, 1842, 1 W. P. C. at p. 411.

(*o*) See *Liardet* v. *Johnson*, 1 W. P. C. at p. 54.

without success to attain it, and had long regarded it in the light of a problem, and that the invention of the patentee successfully solved the problem,—then such a state of affairs constitutes evidence of the strongest kind that the prior applications did not in fact give a clear clue to the solution and ought not to be considered as destroying subject-matter. What really occurred in the mind of the inventor would be utterly immaterial even if it were discoverable. In *Lyon* v. *Goddard* (10 R. P. C. at p. 336) Bowen, L.J., said: "When you see 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."

Commercial success.

In *Gosnell* v. *Bishop* (5 R. P. C. at p. 158) 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. But it may be that the demand itself is quite new, and that the novelty of the demand has produced immediately and without any operation of ingenuity, an obvious article to satisfy it."

And in *Hinks* v. *Safety Lighting Co.* (L. R. 4 Ch. D. at p. 615) 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" (*p*).

But commercial success alone, without the solution of a difficulty, will not establish subject-matter. For commercial success is often due merely to commercial enterprise, or the awakening of a new demand. The case of *The Haskell Golf Ball Co.* v. *Hutchinson* (cited below) is an instance in point.

In the case of *Longbottom* v. *Shaw* (8 R. P. C. at p. 336) 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 a larger 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."

A useful illustration is to be found in *The Haskell Golf Ball Co.* v. *Hutchinson*, which turned upon the validity of the patent for the Haskell golf-ball. This patent was held invalid by Mr. Justice Buckley and by the Court of Appeal and the House of Lords. The patented invention consisted of a ball of which the cover was made of gutta-percha, and the core of rubber thread wound under tension into a ball. It had been well known to use gutta-percha as a cover for golf-balls, and it was well known that this material was the only suitable one for such covers. Balls had also been used for other purposes than golf composed of rubber thread wound under tension, and such balls were usually covered with leather. The purpose of the rubber thread core was to impart elasticity; the purpose of the gutta-percha cover was to protect the core and to muffle that elasticity when the ball was given a slight

(*p*) See also Lord Herschell in *American Braided Wire Co.* v. *Thomson* (The "Bustle Case"), 6 R. P. C. at p. 527; *Bonnard* v. *London General Omnibus Co.*, 36 R. P. C. 307; *Osram Lamp Works, Ltd.* v. *Pope's Electric Lamp Co.*, cited at p. 49, post.

blow, as when on the putting-green, where elasticity is a disadvantage. Balls having elasticity were at first regarded with great disfavour by golfers, but ultimately—some four years or so after the grant of the patent—the majority of players came to the conclusion that their use was advantageous. As soon as this change of opinion took place the Haskell ball became a great commercial success, *i.e.*, the success of a particular point of view rather than that of a manufacture.

The judgment of Collins, M.R., demonstrates this aspect of the matter. He said (23 R. P. C. at p. 313): "Now there being that right in every person to play the game with any ball that he found if he chose to do so, what was there open to this gentleman to patent in this case? . . . All that he has done is really, when you come to sift it, that he has substituted for the leather cover, which was the common cover of the balls composed of rubber wound in tension then in use, for the purpose of golf, a cover of gutta-percha. That is the invention. What room was there for invention in taking that step into the unknown?—a step from a cover of leather to a cover of gutta-percha for the purpose of making a ball, fit for other purposes, fit for golf. What did he find to his hand? He found that every ball in the market was a ball made either in whole or in part of gutta-percha. Certainly the external part of it was gutta-percha. It was well known that if you wanted to strike a ball with an iron club probably gutta-percha was one of the best substances you could choose to admit of that impact. It was well known that gutta-percha was a common, or at least a well-known, cover for balls which required a considerable impact from the conditions in which they were used. Under those circumstances, it seems to me that that step, when you have once made up your mind that there was a certain degree of originality in playing golf with an elastic ball, was not the subject of a patent. The idea of putting a cover on strong enough to stand the impact of an iron club, and substituting, therefore, gutta-percha for leather, seems to me not to be one which can be the subject-matter of a patent." A further illustration is to be found in the case of *Thermos* v. *Isola* (27 R. P. C. 388).

The cases which involve the application of an old device to a new purpose are many; the following are frequently cited, and usefully illustrate the method of the Courts in approaching the issue of subject-matter. But it must be remembered that the facts in one case are no guide to the treatment of the facts in another save in so far as a statement of them is necessary to illustrate a principle.

In *Thierry* v. *Rickman* (14 R. P. C. at p. 115) Halsbury, L.C., said: "Whether there is or is not invention such as will support a patent is a question of fact and degree, and the state of facts and degree in one case can never be any guide in another. It is certainly quite true that mere simplicity will not prevent there being invention." He then referred to *Hinks* v. *Safety Lighting Co.* (L. R. 4 Ch. D. 607) and *Brook* v. *Aston* (8 E. & B. 478), and continued: "I refer to these two cases only as illustrative of the proposition that no smallness or simplicity will prevent a patent being good, while mere novelty of manufacture or usefulness in the application of known materials to analogous uses will not necessarily establish invention within the meaning of the patent laws."

In *Penn* v. *Bibby* (L. R. 2 Ch. 127) the invention related to bearings for screw propeller shafts of vessels. The specification described the inner surfaces of the bearings as having grooves to receive fillets of wood which projected to some extent beyond the inner surfaces of the metal bearings, so as to prevent the shaft coming into contact with the metal of the bearings, the spaces permitting water to flow freely between the shaft and the inner surfaces of the metal bearings. Great utility was proved. The nature of the alleged anticipations is shown in the judgment of Lord Chelmsford, L.C., who said: "In every case of this description one main consideration seems to be whether the new application lies so much out of the track of the former use as not naturally to suggest itself to a person turning his mind to the subject, but to require some application of thought and study. Now, strictly applying this test, which cannot be considered an unfair one, to the present case, it appears to me impossible to say that the patented invention is merely an application of an old thing to a new purpose. The

only examples of old use alleged by the defendant were in grindstones and water-wheels. No doubt these have what may be called bearings, but they are of a totally different character and for a totally different object, from the bearings patented. In neither water-wheel nor grindstone is there a wooden bearing in which the wheel revolves, but the wheel is merely supported on wood, not encased or submerged, nor constructed for the purpose of admitting the water to flow freely within the bearing, and the revolutions of each of them are at a very slow pace. It is difficult to believe that bearings of this description could ever have suggested the application of wood to the bearings of screw propellers in the way described in the patent."

In *Gadd* v. *The Mayor, &c. of Manchester* (9 R. P. C. 516) 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. Lord Justice Lindley (at p. 524), after an elaborate review of the authorities, expressed the law 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. If, practically speaking, there are no difficulties to be overcome in adapting an old contrivance to a new purpose, there can be no ingenuity in overcoming them, there will be no invention, and the first rule will apply. The same rule will, I apprehend, also apply to cases in which the mode of overcoming the so-called difficulties is so obvious to every one of ordinary intelligence and acquaintance with the subject-matter of the patent, as to present no difficulty to any such person. Such cases present no real difficulty to people conversant with the matter in hand, and admit of no sufficient ingenuity to support a patent. If, in these two classes of cases, patents could be supported, they would be intolerable nuisances, and would seriously impede all improvements in the practical application of common knowledge. . . . But unless an invention can be brought within one or other of the above classes, a patent for it cannot be held bad on the ground of want of subject-matter" (*q*). An instance of a patent being held to be invalid as being for the analogous use of an old device, involving no difficulties in its application and consequently requiring no ingenuity, and expressly held to be within Lord Justice Lindley's definition above quoted, is to be found in *Merton's Patent*, 31 R. P. C. 373.

In *Bush* v. *Fox* (Macr. P. C. at p. 164) 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 any one 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.

In *Harwood* v. *G. N. R.* (35 L. J. Q. B. 27) (a case very frequently cited), the patentee used a "fish plate" for joining together the ends of rails. The evidence showed that

(*q*) See also *Hayward* v. *Hamilton*, Griff. P. C. 115; *Brooks* v. *Lamplugh*, 15 R. P. C. 33; and *British Vacuum Cleaner Co.* v. *L. and S. W. Ry. Co.*, 29 R. P. C. 309.

this particular form of joint had been applied in various mechanical contrivances, and notably in the joining together of pieces of timber used in bridge building, with pieces of channelled iron. It was more or less agreed, however, that exactly the same kind of strains were not involved, where the earlier applications were made. But Lord Chelmsford, L.C., said (at p. 38): "Then the question is whether there can be any invention of the plaintiff in having taken that thing, which was a fish for a bridge, and having applied it as a fish for a railway. Upon that I think that the law is well and rightly settled, for there would be no end to the interferences with trades, and with the liberty of any mechanical contrivance being adopted, if every slight difference in the application of a well-known thing were held to constitute a patent. . . . No sounder or more wholesome doctrine, I think, was ever established by the decisions which are referred to in the opinions of the four learned judges, who concur in the second opinion delivered to your lordships, namely, that you cannot have a patent for a well-known mechanical contrivance, merely because it is applied in a manner, or to a purpose which is analogous to the manner, or to the purpose in or to which it has been hitherto notoriously used. The channelled iron was applied in a manner which was notorious, and the application of it to a vertical fish would be no more than the application of a well-known contrivance, to a purpose exactly analogous, or corresponding to the purpose, to which it had been previously applied."

In *Morgan* v. *Windover* (7 R. P. C. 131) 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 (at

p. 137): "Now, my lords, if it had required mechanical ingenuity and skill to adapt the composite springs which had hitherto 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 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" (*r*).

Obviousness of application of conception.

The last words quoted from Lord Herschell's judgment must be read with caution and with due regard to the facts of the particular case; it has sometimes been said that in the application of an old device to a new purpose there must be ingenuity, not only in conceiving the idea of the application but in the method of application itself must require ingenuity, and must not be obvious. The wording of Lord Herschell's judgment certainly gives colour to this view. It is more correct, however, to say that there must be ingenuity shown *either* in the conception of the idea *or* in the application of it; in the first case, the broad idea may be claimed; in the second, a narrow claim only may be made in respect of the particular method of application. In *Hickton's Patent Syndicate* v. *Patents, &c. Ltd.* (26 R. P. C. at p. 347), Moulton, L.J. (supported by Cozens-Hardy, M.R., and Buckley, L.J.), dealt with this point. The invention in question involved a conception by no means obvious, but once it had been conceived it could not be denied that the application was obvious, and Swinfen Eady, J., had held the patent invalid on this ground. The Lord Justice said: "The learned Judge says, 'an idea may be new and original and very meritorious, but

(*r*) And see the judgment of Lord Davey in *The Acetylene Illuminating Co., Ltd.* v. *United Alkali Co.*, 22 R. P. C. at p. 155; *Blakey* v. *Latham*, 6 R. P. C. 184; and *Dredge* v. *Parnell*, 16 R. P. C. 625.

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unless there is some invention necessary for putting the idea into practice it is not patentable.' With the greatest respect for the learned judge, that, in my opinion, is quite contrary to the principles of patent law, and would deprive of their reward a very large number of meritorious inventions that have been made. I may say that this dictum is to the best of my knowledge supported by no case, and no case has been quoted to us which would justify it. But let me give an example. Probably the most celebrated patent in the history of our law is that of Boulton and Watt, which had the unique distinction of being renewed for the whole fourteen years. The particular invention there was the condensation of the steam, not in the cylinder itself, but in a separate vessel. That conception occurred to Watt, and it was for that his patent was granted, and out of that grew the steam engine. Now, can it be suggested that it required any invention whatever to carry out that idea when once you had got it? It could be done in a thousand ways, and by any competent engineer, but the invention was in the idea, and when he had once got that idea the carrying out of it was perfectly easy. To say that the conception may be meritorious and may involve invention, and may be new and original, and simply because when you have once got the idea it is easy to carry it out, and that that deprives it of the title of being a new invention according to our patent law, is, I think, an extremely dangerous principle, and justified neither by reason, nor authority. . . . In my opinion, invention may lie in the idea, and it may lie in the way in which it is carried out, and it may be in the combination of the two; but if there is invention in the idea plus *the* way of carrying it out, then *it* is good subject-matter for Letters Patent." It is respectfully suggested with regard to the last sentence quoted, that if the antecedent of the "*it*" is "the idea" then the law would be more correctly defined by reading the "the" as "a." As printed in the report, the words of the learned lord justice would seem to suggest that although there might be invention in the idea, invention was also needed in the way of carrying it out—an interpretation quite at variance with the earlier sentences quoted.

Selection.

It is sometimes said that a selection from possible alternatives for the solution of a problem may afford subject-mattor for a patent, but "a mere selection among possible alternativos is not subject-matter. A selection to be patentable must be a selection in order to secure some advantage or avoid some disadvantage. It must be an adaptation of means to ends impossible without exercise of the inventive faculty. It follows that in describing and ascertaining the nature of an invention consisting in the selection between possible alternatives, the advantages to be gained, or the disadvantages to be avoided ought to be referred to" (*s*).

Chemical cases.

In the case of patents for chemical and metallurgical processes the principles of law applicable are precisely similar, and in the application of an old and well-known process to a new material the same question arises, that is to say, "was the new application obvious in view of the common knowledge." Some few years ago a distinguished chemist stated when giving evidence in such a case that "there is no prevision in chemistry," and this phrase being since often repeated has given rise in the minds of some to the belief that the law applicable to chemical cases is peculiar. This is not so. True it is that the unexpected nature of chemical reactions often makes a chemist who is aware that things may and do occur contrary to expectation, distrustful of his own belief in what to anticipate, and realise that analogies are dangerous, but the question of obviousness still remains to be decided on the evidence in the particular case (*t*). The following quotation from the judgment of Lord Parker in *Osram Lamp Works, Ltd.* v. *Pope's Electric Lamp Co.*, 34 R. P. C. at p. 396, clearly illustrates the modern method of approaching the facts: "I now pass to the objection to the Patent based on want of subject-matter. I agree that the invention consists merely in the application to tungsten and its compounds of a process (previously) invented and disclosed by Dr. Welsbach for making filaments of osmium or other metals of the platinum

(*s*) Lord Parker in *Clyde Nail Co.* v. *Russell*, 33 R. P. C. at p. 306; and see Chap. VI., post.

(*t*) See, *e.g.*, *Osram Lamp Works, Ltd.* v. *Pope's Electric Lamp Co.*, 34 R. P. C. at p. 396.

group. This is good subject-matter, unless, having regard to what was generally known at the date of the patent sued upon, it was obvious without experiment or research, that the process invented by Welsbach could be applied to tungsten and its compounds as well as to osmium or other metals of the platinum group. I am not prepared to hold that this was obvious. Indeed, all the facts appear to point to the contrary conclusion. Long before the date of Welsbach's specification it was well recognised that if a filament could be made of some cheap hard metal with a high melting temperature, such filament would be free from many of the defects in, and would be likely to supersede, the carbon filaments then in use. The difficulty had been to manufacture such filaments, for hard metals with high melting temperatures are intractable, and cannot, or at any rate could not then, be made by any process of drawing. If a method of manufacturing such filaments could be invented, tungsten, which is plentiful and cheap, would obviously be suitable for the purpose. In 1889 one, *Bottome*, had patented in the U.S. a process for making a filament of mixed tungsten and carbon. In 1897 one, *Lodyquine*, had also patented in America a process in which he proposed to make filaments of platinum and tungsten, the tungsten being deposited round a platinum wire as a base. *Welsbach* was the first to invent a process by which a filament of hard metal could be made, but the fact that his specification mentions only scarcer and dearer metals might well suggest to his readers that his process was inapplicable to tungsten, which was more suitable for the purpose he had in view. I cannot find that in the interval of six years or thereabouts, which elapsed between the date of *Welsbach's* patent and the date of the plaintiff's patent, any one ever suggested this application of *Welsbach's* process to tungsten, although, during that period, one, *Gülcher*, patented in Germany a process for building up an iridium filament, in the same way as Welsbach had built up an osmium filament, and although in 1903 *Just* and *Hanaman* obtained in Germany a patent for a process in which a tungsten filament was to be obtained in an entirely different manner. The inference I draw from the facts above

stated is that it was by no means obvious that *Welsbach's* process could be successfully applied to tungsten. The objection based on want of subject-matter must therefore fail." On the other hand, in *British Thomson-Houston Co.* v. *Duram, Ltd.* (35 R. P. C. 161), the patentees stated that they had discovered that tungsten became ductile if the coherent metal (rendered coherent by any suitable method) were heated, and claimed broadly, "The method of working tungsten which consists in subjecting the metal in a coherent form to the action of heat while it is being operated on or manipulated." It was proved to be the common practice of metallurgists to work metals hot either to test their properties or in the course of industries, and that to apply such a process to tungsten was obvious.

Old material applied to new purpose.

The application of an old material for a new purpose, or the discovery of a use for an old material formerly thought useless, may be the subject of a patent; for instance, *Muntz* v. *Foster* (2 W. P. C. 96) 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.

But it is necessary to establish invention in the patented use of the old material. In *The Albo-Carbon Light Co.* v. *Kidd* (4 R. P. C. 535) the disputed claim was "The use of solid naphthaline prepared in the form of sticks, rods, or pellets for the enrichment of combustible gas, substantially as herein described." It was shown that the use of naphthaline (though not in solid form) was known for enriching gas, and the existence of solid naphthaline was also old. The method of application described was obvious, and the patent was declared invalid.

The reasoning of the judgment in this case is defective, although on the facts summarised above the decision was justified.

In *McLay* v. *Lawes & Co.* (22 R. P. C. 199) the invention consisted in utilising the calcium sulphate obtained as a waste product in the manufacture of tartaric acid, in conjunction with agglutinating materials to form a non-conducting "lagging" for boilers. It was proved that the use of calcium sulphate, as obtained from other sources, was well known for this purpose and the patent was held invalid.

Combinations

We have now to deal with the very important part of patent jurisprudence which concerns the validity of patents for new combinations. New combinations of new with old contrivances, or of old contrivances with other old contrivances, are principally to be met with in the field of labour-saving machinery. New principles are rarely met with. Fundamental departures from old methods of manufacture are not so common nowadays as are new arrangements in old machines of their various parts (which in themselves as mechanical appliances are seldom novel) to produce old effects in a better, cheaper, or more expeditious manner. Lord (then Mr. Fletcher) Moulton, in his presidential address (1904) to the Junior Institution of Civil Engineers, in dealing with this fact, said: "It is here that the lawyers' difficulties are greatest. The benefits of the patent laws are confined to inventions, and it therefore becomes necessary, in deciding whether a new machine or a modification of an old machine is good subject-matter for letters patent, to put to oneself the question, 'Does it involve invention?' The decision is not difficult when it involves a new cycle, or a wholly new mechanism for accomplishing an old cycle. But when it consists of an improvement on old mechanism by the substitution of different but equivalent devices, the task is one of great nicety. It would seem to be necessary to fix upon some definition of invention, but this has never been done, and in my opinion no definition of invention can be found which is of the slightest assistance to anyone in a case of difficulty. . . . When you

approach the dividing line it is so impossible to get a test that it becomes, more or less, a matter of personal opinion. Some of the elements of a combination are altered so as to improve, but not essentially change its working. Is that a new invention? If it is only the substitution of mechanical elements which are notoriously the equivalents of the old elements the law is clear, but in any other case it is treated as being a question of fact for the judgment of whatever tribunal has the duty of deciding. Our Courts in this, as in many other questions, lean to the practical rather than the dogmatic. They impose no rigid test such as that to which the German Patent Office inclines, viz., that the new combination must produce a different technical result. To do the same thing better, or in a way so different that it gives to the public a useful choice of means, may with us be sufficient to support the claim to invention. And I have little doubt that if a case should arise in which a judicious selection out of the list of known and notorious mechanical equivalents gave an unforeseen and markedly superior result, the Courts would consider themselves free to hold it to be an invention, and in treating the decision as thus dependent on the resulting utility they would only be following the dictum of Lord Watson: 'There are many things which you cannot say are or are not inventions until you have tried them.'"

It is unnecessary to quote the cases which in the early history of patent law went to establish that patents for new combinations were valid. New combinations are such a feature of modern machinery and of modern patent practice that the principle hardly needs argument. But it is important to remember that the combination must in *fact* be a combination and not a mere juxtaposition—the parts must combine for some common result. As Buckley, L.J., said in *The British United Shoe Machinery Co.* v. *Fussell* (25 R. P. C. at p. 657), "For this purpose a combination, I think, means not every collocation of parts, but a collocation of inter-communicating parts so as to arrive at a desired result, and to this, I think, must be added that the result must be what, for the moment, I will call a simple and not a complex result. . . .

Meaning of "combination."

It is not every combination of parts which is for this purpose a combination" (*u*).

The "Sausage-machine Case."

The principle enunciated by Buckley, L.J., is illustrated by the well-known "*Sausage-machine Case*": *Williams* v. *Nye* (7 R. P. C. 62). The patent in that case was for a machine for mincing meat and filling the minced meat into skins so as to make sausages. In fact it consisted of a well-known form of mincing machine which fed the meat to a well-known filling machine so as to combine in one apparatus two machines which had formerly been used separately. The mincing part performed no more than its already well-known functions, and the same remark is true of the filling part. The ultimate result was novel and useful, but there was no difficulty to be overcome and no invention.

The "Eye-glass Case."

The case of *Wood* v. *Raphael* (13 R. P. C. 730) (*The "Eye-glass Case"*) is another well-known illustration. There the patent was for a new combination of parts in a pince-nez. It was shown that pince-nez with a rigid bridge piece and a spring to cause the glasses to grip the nose were well known. It was also shown that in other forms of glasses the "plaquet" or pieces that come into contact with the side of the nose had been hinged to secure greater adjustability. The plaintiff's improvement consisted in combining the well-known feature of the adjustable plaquet with the well-known glasses with a rigid bridge. Romer, J., said:

"It now appears that pivoted plaquets as applied to pince-nez with spring bridges were perfectly well known, their qualities were well known, their advantages and disadvantages; and all that the plaintiff's so-called invention comes to is this: that to a well-known article he has given an additional well-known feature; not to do anything new to the glass as a whole, in my opinion, but merely to give to the original well-known article the well-known qualities of the addition. In my opinion there was nothing novel in the application of that extra feature, or in the purpose for which it was applied; there was no difficulty in adding that additional feature if so desired.

(*u*) And see Lord Davey in *Klaber's Patent*, 23 R. P. C. at p. 460, and Sargant, J., in *Read* v. *Stella Conduit Co.*, 33 R. P. C. at p. 199.

Certainly no invention was required to add it." This judgment was confirmed by the Court of Appeal (*v*).

There is one field of invention in which the Courts are loth to decide that a new arrangement of parts is not subject-matter, *i.e.*, in automatic labour-saving machinery, where a very small alteration may produce a profound result so far as ultimate success is concerned. In *The British United Shoe Machinery Co.* v. *Fussell* (25 R. P. C. 631) the patent was for a high speed machine for screwing the soles of boots to the welts. Dealing with this class of machine, Fletcher Moulton, L.J., said (at p. 646): "Its merit is that it does this operation at a high speed, and with unvarying accuracy, so that you can work these machines so as to yield a huge output without making wasters. That is the commercial definition of a high speed machine. . . . When you come to a machine of this type, you have to alter very seriously the canons which influence you in deciding such questions as novelty. In the case of operations which have to be done under normal circumstances, in the absence of any special difficulties arising from speed, small and trivial alterations in the apparatus are viewed with suspicion, as possibly being idle variants; but when you come to machines which with this demand upon them still give uniform success, I think any tribunal will be very careful before it applies its ordinary ideas of what are mere idle and trivial changes to those alterations which have resulted in a success so triumphant. So that I approach the consideration of novelty in this case, *i.e.*, of the importance of apparently slight variations in the combination, in a very humble spirit, willing to be taught by those who know the practical performance of the machine, and are able to judge of the means which render that practical performance so successful."

Labour-saving machinery

It is essential to remember that the new combination is what constitutes the subject-matter of the patent, whether the invention in *fact* be the addition of a new element or the subtraction of an old element theretofore considered necessary,

(*v*) 14 R. P. C. 496. See also *Layland* v. *Boldy*, 30 R. P. C. 547.

and it is the new combination which should be claimed as the subject of monopoly (see Chap. IV.).

Patent of addition.

Sect. 19 of the Act of 1907 is as follows: (1) "*Where a patent for an invention has been applied for or granted, and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement in or modification of the invention, he may, if he thinks fit, in his application for the further patent, request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired.*"

And by sub-sect. 4: "*The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject of a patent of addition, and the validity of the patent shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.*"

Subject-matter limited.

The wording of sub-sect. 4 is important; it does *not* mean that the grant of a patent of addition is conclusive as to the existence of subject-matter or novelty (*w*), but only that the form of the patent cannot be attacked. The subject-matter of a patent of addition, therefore, like that of other patents, must be a new manufacture as defined by the Statute of Monopolies, but it is limited to improvements and modifications of the original invention—*i.e.*, to inventions which would be infringements of the first patent; and in effect the new legislation is merely a relief to inventors against the burden of taxation in respect of every new improvement they may make in their inventions. Hitherto an inventor has been forced either to take out fresh patents for each improvement or to run the risk that others who, having learnt the groundwork and principle from him, may blacknail him by patenting some small but useful improvement.

(*w*) See, *e.g.*, *Rochford* v. *Dublin Theatre Co., Ltd.*, 29 R. P. C. 185.

CHAPTER IV.

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" or "prior publication" will invalidate 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, 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. 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 infringer when he sets up a defence 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 or publication.

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 considered 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. Consequently the defendant to an action for infringement has always been entitled to allege the invalidity of the plaintiff's patent on the ground of want of novelty.

At common law.

In the case of *Hasting's Patent* (1567, 1 W. P. C. 6) 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 patentee's 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" (*a*).

Novelty means so far as public is concerned.

When we speak of an invention being new, we mean that it must be new so far as the public is concerned, that is, so far as the means of information of the public goes, and the means by which the public become possessed is immaterial (*b*). The law on this point was laid down by Lord Blackburn, in *Patterson* v. *Gas Light and Coke Co.* (L. R. 3 A. C. 244), in the words of Mr. Hindmarch (p. 33): "'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 and first inventor himself, or to any other person, for the public cannot be

(*a*) And see the account of the "*Case of Monopolies*," in Mr. Gordon's well-known work "Monopolies by Patent."

(*b*) Subject to the qualification introduced by sects. 41 and 45 of the Act of 1907; see pp. 72 and 76.

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.' It is not necessary that the invention should be used by the public as well as known to the public. If the invention and the mode in which it can be used has been made known to the public by a description in a work which has been publicly circulated (*Stead* v. *Williams*, 7 M. & G. 818, 842); or in a specification duly enrolled (*Bush* v. *Fox*, 5 H. L. C. 707; *Betts* v. *Menzies*, 10 H. L. C. 117); it avoids the patent, though it is not shown that it ever was actually put in use. It is true that the latter case establishes that 'an antecedent specification ought not to be held to be an anticipation of a subsequent discovery, unless you have ascertained that the antecedent specification discloses a practicable mode of producing the result which is the effect of the subsequent discovery'" (*c*).

Is question of fact.

Therefore, the question of whether the invention is new or not is one of fact, and depends on the circumstances in every case (*d*).

Prior user.

Having stated the general principles upon which a patent may be attacked for want of novelty, we may now proceed to deal particularly with cases of "Prior User," in which it is alleged that the invention has been previously put into practice within the realm. (That the invention has been put into practice in a foreign country or in a colony will not invalidate the patent—for a patent may be obtained for importing an invention from abroad.) The prior user must have been public, and the question of the extent of publicity required gives rise to considerable difficulties.

The making of a machine by a person who kept it secret would not amount to such a publication 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 application, there would be a prior user to void the subsequent patent.

(*c*) See also *Lister* v. *Norton*, 3 R. P. C. at p. 211; *Westley, Richards & Co.* v. *Perkes*, 10 R. P. C. at p. 193; *Robertson* v. *Purdey*, 24 R. P. C. 299.

(*d*) *Pickard* v. *Prescott*, 9 R. P. C. at p. 200.

In *Carpenter* v. *Smith* (1 W. P. C. 530; 9 M. & W. 300), the patent sued on was for a lock. The defendant called a witness who proved that a similar lock had been used on a gate adjoining a public road for sixteen years prior to the patent. It was held that this invalidated the patent. Lord Abinger, C.B., analysed 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." In *Taylor's Patent* (1896, 13 R. P. C. 482) the patent was for a fire-grate. It was revoked on the ground that a similar grate had been used in a private house in the ordinary way and under no conditions of secrecy.

In *Stead* v. *Anderson* (1846, 2 W. P. C. 147) the alleged prior user consisted in the use on a private carriage drive, the principal approach to a private house, of the kind of paving for which the patent was granted, and 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" (*c*).

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.

Prior manufacture and sale of chemical substance.

Miller's Patent (15 R. P. C. 205) was granted for the manufacture of an alloy containing bismuth. The petitioners proved that there had been public sales of a similar alloy, called "Magnolia Metal," before the date of the patent, and that a skilful chemist could by analysis have detected its composition. Romer, J., revoking the patent, said (p. 211): "The bismuth could have been detected, and I am satisfied that, if reasonable care and reasonable skill were used by analysts before the date of this patent, when this magnolia metal was sold, its constituents and the proper proportions of those constituents could have been ascertained, so that, the metal being sold, its constituents and their proportions could have been known, and it

(*c*) And see *Humpherson* v. *Syer*, 4 R. P. C. 407.

could have been made, there was no difficulty, I wish to point out, and no secret or invention in making the alloy, when once you knew the constituents and the proportions of those constituents. . . . So that you have a public sale of a metal, as I am pointing out, not of a metal made by any secret process at all, but a public sale of a metal, which if any one wanted to find out what it was made of, and how it was made, he could have done so without difficulty by analysis." This judgment was approved and followed by the House of Lords in the case of *Stahlwerk Becker's Patent* (36 R. P. C. 13), where the patent was granted for the manufacture of a high-speed tool steel having a certain chemical composition. It was proved by the petitioners for revocation that they had made small quantities of steel of the patented composition before the date of the patent, and had put it on the market under one of their ordinary trade marks without calling attention to its properties or composition. It was admitted by the patentees that the composition could have been detected by analysis, but they contended that in order to invalidate the patent the petitioners must show either that the steel had in fact been analysed by some member of the public, or at least that the circumstances were such that there was a high degree of probability that such analysis would have been made in the course of business. Lord Finlay, L.C., said: "I think it would be very dangerous to introduce the doctrine which your lordships are now invited to introduce, either that it must be actually shown that the knowledge had been acquired by some individual, or that there is a high probability that it had in fact been acquired. The law as to prior user seems to be this, that if the article has been manufactured and sold, that gives the means of knowledge to the purchaser, and that that is enough to establish prior user."

Prior secret user no anticipation.

The remarks of Lord Bramwell, in *Hills* v. *London Gaslight Co.* (5 H. & N. at p. 336), 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 any one else discovers that invention it is new, that is to say,

new in the sense that the first invention has not been published."

Dollond's Case.

In *Dollond's Case* (*f*) the objection to Dollond's patent was that he was not the inventor of the method of making 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.

Experiments.

An abandoned experiment is not a prior publication by user (*g*). In every case the question to be decided is one of fact, and the fact of abandonment gives rise to the inference that the user was experimental only—an inference which may of course in some cases be rebutted.

Experiments with assistants.

There are many inventions which cannot be perfected unless the inventor employs assistance, and experiments of this nature in the course of which the spectators and assistants are under an obligation of secrecy do not amount to a prior publication of the invention even though the experiments prove successful.

In *Morgan* v. *Seaward* (see 2 M. & W. at p. 557) the patent granted to *Galloway* and assigned to *Morgan*, the plaintiff, was for paddlewheels of a peculiar construction. Before the date of the patent, *Curtis*, an engineer, made for *Morgan* two pairs of wheels upon the principle mentioned in the patent, at his own factory; *Galloway*, the patentee, gave the instructions to *Curtis* under an injunction of secrecy, because he was about to take out a patent. The wheels were completed and put together at *Curtis's* factory, but not shown or exposed to the view of those who might happen to come there; after remaining a short time, the wheels were taken to pieces, packed up in cases and sent to Venice, to be used by a company, of which Morgan was a director. *Morgan* paid *Curtis* for the wheels with the knowledge of *Galloway*. Dealing with these facts, Parke, B., said (p. 558): "The wheels were constructed under the direction of the inventor, by an engineer and his servants, with an injunction

(*f*) 1766, unreported, but mentioned with many others in 1 W. P. C. at p. 43.

(*g*) *Cornish* v. *Keene*, 1 W. P. C. at p. 508; *Galloway* v. *Bleaden*, 1 W. P. C. at p. 525; *Walton* v. *Bateman*, 1 W. P. C. at p. 619.

of secrecy, on the express ground that the inventor was about to take out a patent, and that injunction was observed. And this makes the case, so far, the same as if they had been constructed by the inventor's own hands, in his own private workshop, and no third person had seen them whilst in progress. The operation was disclosed, indeed, to *Morgan*, the plaintiff, but there is sufficient evidence that *Morgan* at that time was connected with the inventor, and designing to take a share of the patent. A disclosure of the nature of the invention to such a person, under such circumstances, must surely be deemed private and confidential. The only remaining circumstance is, that *Morgan* paid for the machines with the privity of Galloway on behalf of the Venice Company, of which he was director, but there is no proof that he paid more than the price of the machines, as for ordinary work of that description, and the jury would also be well warranted in finding that he did so with the intention that the machine should be used abroad *only* by this company; and the question is, whether this solitary transaction, without any gain being proved to be derived thereby to the patentee or to the plaintiff, be a use or exercise in England, of the mode of construction, in any sense which can be deemed a use by others, or a public use, within the meaning of the statute and the patent. We think not" (*h*).

In *Newall* v. *Elliott* (see 4 C. B. N. S. at p. 295) the Court had to deal with a plea of prior user in which the invention (relating to cable laying) was of such magnitude that only experiment upon a scale which was commercial and remunerative would have been and was in fact of use. Byles, J., said: "The experimenter is obliged either to experiment in a way that may turn out to be useful in the particular instance, or else not to make any efficient and decisive experiment at all. The coincidence of an experiment with actual immediate profit or advantage from it, if successful, is unavoidable."

On the other hand, if the use of the invention is conducted in such a way that persons under no obligation of secrecy have access to it, the inference is that such a use is not an experiment

(*h*) See also *Bentley* v. *Fleming*, 1 C. & K. 587.

and will amount to a prior user (*i*). In this connection it is important to observe the effect of the proviso introduced by the Act of 1919 into sect. 41, sub-sect. (2), which will be dealt with at p. 74, post.

Secret profitable user by patentee.

It is probable that an inventor who manufactured an article by a secret process and sold it would be unable subsequently to obtain a patent for the process, since by that means he would be enabled to derive a larger advantage than the law allows him in a monopoly for sixteen years from the date of application. The point is not without difficulty and has never been definitely decided. It has, however, received the attention of judges. Baron Parke, in *Morgan* v. *Seward* (2 M. & W. at p. 559; 1 W. P. C. at p. 194), 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." Romer, J., in *Miller's Patent* (15 R. P. C. at p. 213), said: "I think it might be said to be still open in some respects for further consideration by the Court whether a person who discovers a secret process and uses the benefit of that secret process to manufacture an article which he sells publicly and commercially, and obtains considerable benefit from it, and then seeks to obtain a patent for that very same process, is entitled to hold that patent under those circumstances." 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.

Secret process and sale of product by others.

A greater difficulty arises in the case of secret use by some one other than the patentee. In *Robertson* v. *Purdey* (24 R. P. C. at p. 290) Mr. Justice Parker, dealing with an alleged prior user, found in fact that the article had been

(*i*) *Elias* v. *Grovesend Tinplate Co.*, 7 R. P. C. 455, at p. 466; *Hoe* v. *Foster*, 16 R. P. C. 33; *Poulton's Patent*, 23 R. P. C. 184.

manufactured prior to the date of the plaintiff's patent, but had only been used privately, and that such prior private use was not such as to invalidate the plaintiff's patent, but went on to say: "It was, however, argued that on the words of the 6th section of the Statute of Monopolies, 'which others at the time of making such letters patent shall not use,' there may be a contemporaneous user not amounting to publication which will avoid letters patent. In my opinion this argument is well founded. Suppose A. invents a process for the manufacture of dyes, keeps the process secret, and continues to manufacture and publicly sells dyes manufactured according to the process, the sale of the dyes, which might be made by any process, may not amount to a publication of the invention, but I think that A. is using the invention in such a way as to preclude B., who subsequently makes the same invention, from obtaining valid letters patent in respect thereof. This, at any rate, would appear to be the effect of the judgments of Mr. Justice Erle and Lord Justice Campbell in *Heath* v. *Unwin* (2 W. P. C. at pp. 227, 228; 3 E. & B. at pp. 272, 273), and *Tennant's Case* (1 W. P. C. 195)." The above quoted observations are of course *obiter dicta*, and against the view expressed by Mr. Justice Parker the argument may be urged that patents are granted as a reward for the instruction of the public in a new and useful art, and that until the public are in possession of the knowledge secretly made use of, it is open to any one to reap the reward for communicating it to them. It may be fairly replied to this answer that more than one person may be carrying on the process secretly, and consequently, unless the word "others" is to be construed strictly to mean "any other person," a great difficulty in administering the law is involved, since it will be impossible to find any fixed line beyond which the *public* may be said to be in possession of an invention.

The question is really one of policy, but the opinion of Mr. Justice Parker certainly seems correct upon a strict construction of the words "which others at the time of making such letters patent shall not use."

The prior sale of an article, even though to one individual only, will nearly always be sufficient to invalidate the patent,

since such sale is strong evidence that the user was commercial and not experimental (*j*). In order for the sale to constitute sufficient evidence, it should be open and in the ordinary way of business (*k*). The fact that there was no demand for the article will not affect the sale either in law or fact (*l*). It will be sufficient if only one article be sold (*m*), and, apparently, if merely for export (*n*). An offer to sell, even though no sale was effected, will also be evidence of prior publication (*o*).

Sending out of samples.

The manufacture and sending out of samples for the purpose of experimenting as to the satisfactory character of the invention has been held to amount to a publication (*p*).

By sect. 41, sub-sect. 2, of the Act of 1907, the inventor has been protected against fraudulent disclosure of his inventions by persons with whom he might have confidential relations :—

Disclosure without consent of patentee.

(2) "*A patent shall not be held to be invalid by reason only of the invention in respect of which the patent was granted, or any part thereof, having been published prior to the date of the patent, if the patentee proves to the satisfaction of the Court that the publication was made without his knowledge and consent, and that the matter published was derived or obtained from him, and, if he learnt of the publication before the date of his application for the patent, that he applied for and obtained protection for his invention with all reasonable diligence after learning of the publication. Provided that the protection afforded by this sub-section shall not extend to a patentee who has commercially worked his invention in the United Kingdom otherwise than for the purpose of reasonable trial of the invention prior to the application for the patent.*"

(*j*) *Wood* v. *Zimmer*, Holt, N. P. 58; 1 W. P. C. 44.

(*k*) *Honiball* v. *Bloomer*, 2 W. P. C. 199; *Lister* v. *Norton*, 3 R. P. C. at p. 208, and see *Morgan* v. *Seaward*, *supra*.

(*l*) *Losh* v. *Hague*, 1 W. P. C. 205; and see *Lister* v. *Norton*, 3 R. P. C. at p. 208.

(*m*) *Honiball* v. *Bloomer*, 2 W. P. C. 200; *Stahlwerk Becker's Patent*, 36 R. P. C. 13.

(*n*) *Carpenter* v. *Smith*, 1 W. P. C. at p. 536. (But *cf.* *Morgan* v. *Seaward*, quoted on p. 62, ante.)

(*o*) *Oxley* v. *Holden*, 8 C. B. N. S. at p. 704; *Mullins* v. *Hart*, 3 C. & K. 297.

(*p*) *Hudson, Scott and Sons, Ltd.* v. *Barringer and others*, 23 R. P. C. at p. 87.

The proviso was added by sect. 13, sub-sect. (1), of the Act of 1919, and by sub-sect. (2) of that section the proviso is *not* to apply to patents granted before 23rd of December, 1919. The words "*otherwise than for the purpose of reasonable trial*" have been expressly inserted in order to deal with cases where the magnitude of the industry with which the invention deals (as for example newspaper printing machinery) is such that a trial to be reasonable must be on a commercial scale (and see p. 62, ante). Sect. 15, sub-sect. (1), enacts "*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.*"

Formerly the law was such that although a confidential communication did not invalidate a subsequent patent, yet if the person to whom the confidential communication was made published his information the patent was anticipated. It is to be observed that the onus of proving the relieving circumstances is cast entirely on the shoulders of the patentee.

Anticipation in writing.

Another description of anticipation which is capable of invalidating a patent is prior publication in a document, i.e., the printing, writing, or publishing of some document to which the public have access, containing such a description of the invention as will enable the invention to be carried into effect from the description given. Vague hints or descriptions of experiments, incomplete or imperfect, are not sufficient to invalidate a subsequent patent. 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. The question will always be one of fact, depending on the circumstances of each particular case.

In *Von Heyden* v. *Neustadt* (50 L. J. Ch. at p. 128) 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: "We are of opinion that if it requires this 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."

Lord Westbury's dictum.

In *Hills* v. *Evans* (4 De G. F. & J. at p. 289; 31 L. J. Ch. 463) 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."

Effect modified by later judgment.

The effect of this statement has, however, been slightly modified by subsequent judgments.

In *Philpott* v. *Hanbury* (2 R. P. C. at p. 43) 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 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), w(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."

And the same thing was better said by Lord Watson, in *King, Brown & Co.* v. *The Anglo-American Brush Light Co.* (9 R. P. C. at p. 320): "Every patentee, as a condition of his exclusive privilege, is bound to describe his invention in such detail as to enable a workman of ordinary skill to practise it, and the penalty of non-compliance with that condition is forfeiture of his privilege. His patent right may be invalid by reason of non-compliance; but it certainly does not follow that his invention has not been published. His specification may, notwithstanding that defect, be sufficient to convey to men of science and employers of labour information which will enable them, without any exercise of inventive ingenuity, to understand his invention, and to give a workman the specific directions which he failed to communicate. In that case, I cannot doubt that his invention is published as completely as if his description had been intelligible to a workman of ordinary skill." This statement was accepted by Lindley, L.J., in *Savage* v. *Harris*, 13 R. P. C. at pp. 368, 369, as modifying and correcting the view of Lord Westbury in *Hills* v. *Evans*. The view of the Court seems to be that the knowledge of "the ordinary workman" to whom a specification is addressed is not necessarily the measure of public knowledge.

On the other hand, great caution must be exercised in coming to the conclusion that a given publication or prior user is an anticipation, and it must not be assumed that there is invalidity owing to prior publication merely because a person of great skill might turn the prior publication to practical account. Regard should be had to the observations of Lord Justice Moulton (cited at pp. 52 and 55, ante) concerning labour-saving machinery. Moreover, the distinction drawn by Grove, J., and Lord Watson has not invariably been made; for instance, in *Kaye* v. *Chubb* (4 R. P. C. at p. 298) Lord Esher, M.R., said: "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, and he cannot be defeated, because that which is really his invention can be got within general words which describe nothing."

The reader is referred to the chapter on Subject-matter for consideration of the leading cases in greater detail; it is undesirable to repeat the arguments there set forth. It must be remembered that novelty is a question of *fact*, and a decision as to what may be a sufficient anticipation in any particular case cannot be any guide in deciding upon a different set of circumstances.

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.

Publication of the document.

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 (*q*). "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" (*r*).

It is the practice for the Patent Office library to receive copies of foreign specifications from abroad and to bind them in volumes which are open to public inspection. An English patent may be invalidated by the fact that such a specification, or in fact any other publication containing the description, was

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

(*r*) Per Sir John Romilly, M.R., in *Lang* v. *Gisborne*, 31 Beav. at p. 136.

on view prior to the date of the English application (*s*). 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.

In *Otto* v. *Steel* (L. R. 31 Ch. D. 241), 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 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 (*t*). **Otto *v.* Steel.**

In *Harris* v. *Rothwell* (4 R. P. C. at p. 232) Lord Justice Lindley, reading the judgment of Lord Justice Cotton and himself, after an elaborate review of the authorities, said:

(*s*) *Harris* v. *Rothwell*, L. R. 35 Ch. D. 416; 56 L. J. Ch. 459; 56 L. T. 552; 3 R. P. C. 383; 4 R. P. C. 225; *Pickard* v. *Prescott*, 9 R. P. C. 195.

(*t*) See also *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.

"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 and in *Otto* v. *Steel*, 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."

Publication by drawing.

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 machinist would understand it, and could make the machine from the drawing without any further information, and without the exercise of ingenuity (*u*).

The publication in a prior specification is conclusive against a subsequent patent, since the object of a specification is to publish to the world.

By sect. 7 of the Act of 1907 the Patent Office is directed to make a search as to the novelty of all applications. The search is only to extend to specifications published within fifty years next before the date of the application.

Rule as to fifty-year-old specifications.

By sect. 41, sub-sect. 1, it is enacted: "*An invention covered by any patent applied for on or after the first day of January one thousand nine hundred and five* (*v*) *shall not be deemed to have been anticipated by reason only of its publication in a specification left pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for the*

(*u*) *Herrburger* v. *Squire*, 6 R. P. C. at p. 198; *Electric Construction Co.* v. *Imperial Tramways Co.*, 17 R. P. C. at p. 550.

(*v*) On account of the similar section (2) of the Act of 1902, which came into force on January 1st, 1905.

patent, or of its publication in a provisional specification of any date not followed by a complete specification."

Therefore, as to inventions patented after the 1st of January, 1905, any anticipation may be alleged that would formerly have been available, save a provisional specification not followed by a complete specification (such have not been published since 1884), and a person who alleges invalidity may not rely solely upon a specification published fifty years before the application. But it is submitted that he could use the fifty-year-old specification as evidence to support an allegation of prior user (*w*). The effect merely seems to be to take away the conclusive nature of such a specification as prior publication. The Patent Office search does not preclude any one from attacking the validity of the patent by means of a specification which the Office may have overlooked (sect. 1, sub-sect. 9). With regard to applications filed before the commencement of the Act, the old law applies.

Abandoned prior application.

At one time it was questioned whether the abandonment of a provisional specification would invalidate a subsequent application. It must be remembered that the Court has power to order the production of a provisional specification, filed on an abandoned application not as an anticipation, but as evidence to establish a prior user, and in the interests of justice. This was done by Mr. Justice Wills in *Pneumatic Tyre Co.* v. *The English Cycle and Tyre Co.* (14 R. P. C. at p. 852). In *Oxley* v. *Holden* (8 C. B. N. S. 666) 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 specification filed in support of it was not published, and the second was carried to completion—*there was no evidence that between the date of the first application and the second the invention had in any way*

(*w*) See, on a somewhat similar principle, *The Pneumatic Tyre Co.* v. *The English Cycle and Tyre Co.*, 14 R. P. C. at p. 852.

been put in practice or published: held, that the first application did not invalidate the patent.

Sect. 4. of the Act of 1907 is as follows: *Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the invention; and such protection from the consequences of use and publication is in this Act referred to as provisional protection.*" Here "such patent," which is not to be invalidated, is the patent for which the particular application is made. Hence the abandonment of an application for provisional protection will not invalidate a subsequent application for the same invention (*Oxley* v. *Holden* (supra)); but if the invention is put into practice between the filing of the two provisional specifications, the second patent will be void on the ground of prior user merely.

Abandoned specifications not published.

By sect. 69, sub-sect. 1, it is enacted that specifications filed in pursuance of applications which are subsequently abandoned are not to be published save in the case of applications under the Convention.

Effect of want of novelty in part.

Hitherto the consideration for a grant of letters patent has been considered as entire and indivisible; consequently, where two or more mechanisms or processes were claimed in one specification, the want of novelty of one would avoid the whole (*x*). Sect. 9 of the Act of 1919, however, has effected a very important change in the law. A new section, 32A, was, by it, inserted in the principal Act to the following effect:—

"*Notwithstanding anything to the contrary appearing in section twenty-three of this Act, if the Court in any action for infringement of a patent finds that any one or more of the claims in the specification, in respect of which infringement is alleged, are valid, it shall, subject to its discretion as to costs and as to the date from which damages should be reckoned, and to such terms as to amendment as it may deem desirable, grant relief in respect of*

(*x*) *Brunton* v. *Hawkes*, 4 B. & Ald. 541; *Morgan* v. *Seaward*, 1837, 2 M. & W. 544; 1 W. P. C. 196; *Patterson* v. *Gas Light and Coke Co.*, L. R. 2 Ch. D. 812, 833.

any of such claims which are infringed without regard to the invalidity of any other claim in the specification. In exercising such discretion, the Court may take into consideration the conduct of the parties in inserting such invalid claims in the specification or permitting them to remain there."

The effect of this section is not that it makes valid claims formerly invalid, but that relief is granted against some of the consequences of such invalidity, and it may therefore still be important to an infringer to show that a claim of a patent is invalid in order to avoid the full consequences of damages and cost which might otherwise follow.

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. As an illustration of this proposition we may instance the case of *True and the Variable Electric Lamp Syndicate* v. *Bryant Trading Syndicate* (25 R. P. C. 461). The patentee described and claimed a new form of incandescent electric lamp. It was essential to the particular nature of his invention that the lamp should be held firmly in the socket, and to ensure this he provided the wire projecting from the lamp to form a bayonet joint with the socket, with a small nut by means of which it was firmly clamped to the socket. There were only three claims, and the second was as follows: "A screwed nut *n* upon the end of the wire *f*, by which the said wire is held firm and prevented from coming out of the bayonet joint, substantially as described and illustrated." Mr. Justice Swinfen Eady said: "It was contended that the plaintiff's patent was invalid as claim 2 was an independent claim to the user of a screwed nut upon the end of a wire to fix the wire to the holder and to prevent it changing its position, and that the use of such a nut for such a purpose was one of the oldest devices in mechanics. In my opinion, the patentee . . . is merely describing a method of affixing his invention to the holder, as an advantageous method of using his invention, where special circumstances render it expedient, as, for instance, in any position where unusual vibration existed, so as to prevent the

transverse wire from accidentally coming out of the notches of the bayonet joint, and claim 2 is not an independent claim or a claim in gross, but merely a subsidiary claim within the meaning of the phrase as used by Lord Cairns in *The British Dynamite Co.* v. *Krebs* (13 R. P. C. 193), applied by Farwell, J., in *Parker* v. *Satchwell* (18 R. P. C. 307). Claim 2 is only claimed in connection with and as appendant to the improved device shown in claim 1."

Prior grant.

A patent will be invalidated if it can be shown that the invention has been the subject of a prior grant, although there may have been no prior publication. But only a valid prior grant would be sufficient for this purpose (*y*).

Industrial exhibitions and learned societies.

By sect. 45 of the Act of 1907 (as amended by the Act of 1919) it is enacted: "*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 and consent of the inventor, or the reading of a paper by an inventor before a learned society, or the publication of the paper in the society's transactions, shall not prejudice the right of the inventor to apply for and obtain a patent in respect of the invention or the validity of any patent granted on the application, provided that—*

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

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

(2) "*His Majesty may by Order in Council apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the*

(*y*) *The Mica Insulator Co.* v. *The Electrical Co.*, 15 R. P. C. 495; *Robertson* v. *Purdey*, 24 R. P. C. 273.

Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the Order."

Procedure for notifying the Comptroller is provided for by Rules 102 and 103 of the Patents Rules, 1920.

CHAPTER V.

UTILITY.

At common law.

WE now come to the consideration of the question of utility, for not only must the invention be new, but it must be now 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 repect of inventions, it refers us back to what had previously been held to be the necessary elements of an invention. In *Darcy* v. *Allein* (1602, Noy 182; see report in Gordon's "Monopolies by Patent") it was held that 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 (*a*).

In the case of *R.* v. *Arkwright* (1785, 1 W. P. C. 72) Buller, C.J., in leaving the matters to the jury, said: "There is another question, whether the stripe in it makes a material alteration, for 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 of fact, whether the invention is useful; that is, whether that which is new is a sufficient

(*a*) *Manton* v. *Parker*, Dav. P. C. 327; 1 W. P. C. 192, n.; *The Badische Anilin und Soda Fabrik* v. *Levinstein*, 4 R. P. C. at p. 462; *Elias* v. *Grovesend Tinplate Co.*, 7 R. P. C. at p. 467; *Ward* v. *Hill*, 20 R. P. C. at p. 199.

meritorious advance or improvement upon what was already known by the public (*b*).

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 an improvement in the results attained, and not necessarily an extensive alteration; for instance, 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.

The test of utility.

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, and be practically useful at the time when the patent is granted for the purposes indicated by the patentee.

In *Lane-Fox* v. *The Kensington and Knightsbridge Electric Lighting Co.* (9 R. P. C. at p. 417) Lindley, L.J., said: "The utility of the alleged invention depends not on whether by following the directions in the complete specification all the results now necessary for commercial success can be obtained, but on whether by such directions the effects which the patentee professed to produce could be produced, and on the practical utility of those effects. . . . To judge of utility the directions in the specification must be followed, and if the result is that the object sought to be obtained can be attained, and is practically useful at the time when the patent is granted, the test of utility is satisfied. . . . An invention may be useful as indicating the direction in which further progress is to be expected, and yet that same invention may be useless for any other purpose; useless, that is, as an invention without further developments and improvements which have not occurred to the patentee. That is, in my opinion, the real truth with respect to the plaintiff's invention as now claimed by him. He made a distinct and important step in advance. The plaintiff

(*b*) *Hill* v. *Thompson*, 1 W. P. C. at p. 237; *Cornish* v. *Keene*, 1 W. P. C. at p. 506.

was the pioneer: he showed others the road to be followed, but he did not give the traveller the information necessary to enable him to travel on it. There were difficulties to be overcome which the patentee did not foresee, and against which he naturally made no provision. There is an enormous mass of conflicting evidence upon the possibility of obtaining practically useful results by following the directions contained in his specification. Much of the evidence adduced against the patentee merely goes to show that by following the directions in the specification you cannot produce such good results as are produced by the defendants. This obviously is wholly immaterial. But there is, besides, a great deal of evidence to show that an electrician of ordinary skill could not have produced any useful result in 1878 if he simply followed the directions contained in the specification with such variations only as an electrician of ordinary skill would have known how to make in 1878. So much more can be done now by a *Planté* battery than was suspected in 1878, that I have found the greatest difficulty in coming to a conclusion on this all important question. . . . I have studied the whole evidence with all the care I can bestow upon it, and have come to the conclusion that the plaintiff had not, in 1878, invented what he now says he had, namely, a practical method of keeping the electro-motive force in the mains constant at about 100 volts, by means of secondary batteries and dynamos used simultaneously as described."

Failure of consideration.

In *Alsop's Patent* (24 R. P. C. at p. 752) Parker, J., said: "In considering the validity of a patent for a process it is therefore material to ascertain precisely what the patentee claims to be the result of the process for which the patent has been granted; the real consideration which he gives for the grant is the disclosure of a process which produces a result, and not the disclosure of a process which may or may not produce any result at all. If the patentee claims protection for a process for producing a result; and that result cannot be produced by the process in my opinion the consideration fails"; and in *Hatmaker* v. *Joseph Nathan & Co.* (36 R. P. C. at p. 237) Lord Birkenhead, L.C., after stating that the issue of utility was one of fact, quotes with approval the passage from Mr.

Justice Parker's judgment above set forth and added: "In other words protection is purchased by the promise of results. It does not, and ought not to, survive the proved failure of the promise to produce the results" (*c*).

Subsequent improvement immaterial.

On the other hand, in *Edison* v. *Holland* (6 R. P. C. at p. 283) Lindley, L.J., said: "Edison's patent is said to be of no use, and the proof of this statement is said to be furnished by the fact that lamps are not made according to the patent, even by Edison himself. 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" (*d*).

Commercial success not necessary.

In *The Badische Anilin und Soda Fabrik* v. *Levinstein* (4 R. P. C. at p. 462), in 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."

Slight amount suffices.

A very slight amount of utility will be sufficient to support a patent. Alderson, B., in *Morgan* v. *Seaward* (1 W. P. C. at p. 186), said: "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, Jessel, M.R., in *Otto* v. *Linford* (46 L. T. N. S. at p. 41), said: "And, as to this question of utility, very little will do" (*e*).

(*c*) And see *Atkins and Applegarth* v. *The Castner Kellner Alkali Co., Ltd.*, 18 R. P. C. at p. 295, and *Natural Colour Kinematograph Co., Ltd.* v. *Bioschemes, Ltd.* (*Smith's Patent*), 32 R. P. C. 256.

(*d*) And see *Otto* v. *Linford*, 46 L. T. N. S. at p. 41; and *Sunlight Incandescent Co.* v. *Incandescent Gas Light Co.*, 14 R. P. C. at p. 775; *Welsbach Incandescent Gas Light Co.* v. *New Incandescent Co.*, 17 R. P. C. at p. 252.

(*e*) See also Halsbury, L.C., in *The Badische Anilin und Soda Fabrik* v. *Levinstein*, 4 R. P. C. at p. 462; *Philpott* v. *Hanbury*, 2 R. P. C. at p. 37; *Ehrlich* v. *Ihlee*,

New choice must be useful.

If the patent is for an invention which purports to offer the public a new choice of means to accomplish what has previously been known, that choice must be a useful choice. In *Ward* v. *Hill* (20 R. P. C. at p. 199) Vaughan Williams, L.J., said: "I do not agree, that in every claim, if you secure the end which you profess by the letters patent to have in view, that is sufficient to constitute utility. He (counsel) says that if you present to the public a new choice, or present to the public an alternative mode of procuring a result in a manufacture which is already well known, that in itself is sufficient to constitute utility. I do not think so. I do not conceive that I am saying anything new, or anything different from the decided cases, when I say that in my judgment the alternative, or the choice which is presented to the public, must be a useful alternative or a useful choice" (*f*).

Dangerous result.

In *Easterbrook* v. *The Great Western Ry. Co.* (2 R. P. C. 201) the patent was granted for machinery for actuating railway points. It was proved at the trial that the patented apparatus could be worked so as to give conflicting signals which might give rise to great danger. The patent was held invalid on this ground.

Utility alone is not sufficient.

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 (*g*).

Want of utility in part.

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 (*h*). The effect of sect. 9 of the Act of 1919 must not be forgotten in this connection (*i*).

5 R. P. C. at p. 450; *Pirrie* v. *York Street Flax Spinning Co.*, 10 R. P. C. at p. 39.

(*f*) And see *Welsbach Incandescent Co.* v. *New Incandescent*, 17 R. P. C. at p. 252; 1900, 1 Ch. 850.

(*g*) Per Lord Watson in *Morgan* v. *Windover*, 7 R. P. C. at p. 136; and see Chap. III., on "Subject-matter."

(*h*) *Simpson* v. *Holliday*, L. R. 1 H. L. 315, 322; *Turner* v. *Winter*, 1 W. P. C. at p. 82; *Morgan* v. *Seaward*, 2 M. & W. at p. 561; *The United Horsenail Co.* v. *Stewart*, 2 R. P. C. at p. 132; *United Horseshoe and Nail Co.* v. *Swedish Horsenail Co.*, 6 R. P. C. at p. 8.

(*i*) See p. 74, ante.

Two classes of cases.

A distinction must be drawn between cases in which the patentee claims to produce certain results, and can be said to base his application for a patent upon the representation that such results are obtained and cases in which he merely states certain advantageous applications of his new result. In the former class failure to produce the result is a failure of consideration, and of this class *Hatmaker* v. *Nathan & Co.* (cited above) is an example. As to the latter class in *Alsop's Patent* (24 R. P. C. at p. 753) Parker, J., said: "There may be cases in which the result which the patentee claims to have produced can in fact be produced, but the patentee has gone on to detail the useful purposes to which such result can be applied, and that in fact the result produced cannot be applied to one or more of such purposes. In such a case I do not think the patent is necessarily void, provided there are purposes for which the result is useful. If it be avoided it can only be because it contains a misrepresentation so material that it can be said the Crown has been deceived."

Tindal, C.J., in *Haworth* v. *Hardcastle* (1 Bing. N. C. at p. 190), 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."

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 (*j*).

Where an invention is as a whole useful, a very small amount of utility will be sufficient to support a second and subsidiary claim (*k*), and it does not show that the patent is bad because one of the methods claimed is preferred to the others (*l*).

Commercial success is strong evidence of utility (*m*), though,

(*j*) And see *Lewis* v. *Marling*, 10 B. & C. at p. 25.

(*k*) *Ehrlich* v. *Ihlee*, 5 R. P. C. at p. 455.

(*l*) *Miller* v. *Scarle*, 10 R. P. C. 106.

(*m*) *Automatic Airtight Cover, Ltd.* v. *Stockford*, 19 R. P. C. at p. 460.

as has been pointed out above, its absence is no proof of want of utility (*n*).

Fact of infringement is evidence.

Kay, J., in *Lucas* v. *Miller* (2 R. P. C. at p. 160), said: "Better evidence of the utility of an invention cannot possibly be had than the fact that the defendant has attempted to infringe it" (*o*).

(*n*) See ante, p. 81.

(*o*) See also Bowen, L.J., in *Miller* v. *Scarle*, 10 R. P. C. at p. 111.

CHAPTER VI.

THE SPECIFICATION.

To publish the invention.

ONE of the conditions which support the consideration for a valid patent is that the patentee must publish his invention, that is to say, he must file a "specification" containing a description of the subject-matter of his patent. He must give such an account 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 sect. 1, sub-sect. 3, of the Act of 1907, "*the application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application one at least of the applicants, claims to be the true and first inventor, and for which he desires to obtain a patent, and must be accompanied by either a provisional or complete specification.*"

The functions of a provisional and those of a complete specification are defined by sect. 2, which has made no alteration in the law upon this point.

(1) "*A provisional specification must describe the nature of the invention.*

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

If the applicant elects to file a provisional specification he must within nine months file a complete specification, and a patent is not granted until the condition of filing a complete specification has been fulfilled.

History of specification.

In the early days of patent law the king granted a patent for an invention, naming it in the patent, and defining it merely by that name, and it was open to the patentee to allege that anything which fell within the name was covered by the

patent. As manufactures sprang up this method was found to lack preciseness of limitation, and accordingly in the reign of Anne a condition was inserted in all grants of letters patent, and that condition is the foundation of modern patent law. It was a proviso obliging the inventor "by an instrument under his hand and seal particularly to describe and ascertain the nature of the said invention, and in what manner the same is to be performed and to cause the same to be enrolled within six calendar months." The Crown continued, however, to grant patents on a mere title, the obligation to file a description being a mere subsequent condition. The reason for granting the patent on the title and giving the inventor a further nine months was to ensure that he should not be forestalled before he could complete the invention and bring it to a practical form. It was, however, necessary that the specification should not be inconsistent with or wider than the title which still continued to form the basis of the grant, and numerous cases are recorded in which the patent was held to be invalid on the ground of variance between the title and 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 (*a*).

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* (4 B. & Ald. 558) 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."

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. Whereas prior to the passing of that Act, an applicant

(*a*) *Cochrane* v. *Smethurst*, Dav. P. C. 354; 2 Coop. Ch. Cas. 57; 1 Stark. R. 205; and see *R.* v. *Else*, 1785, 1 W. P. C. 76; *Bloxam* v. *Elsee*, 1827, 6 B. & C. 169; *Croll* v. *Edge*, 9 C. B. 479.

for letters patent, when he made his application, had merely deposited the title of his invention, by sect. 6 a provisional specification was required, which was intended to give more definite information as to the nature of the invention for which protection was sought than could possibly be given in a mere title. The provisional specification was thereafter to perform the function that was formerly that of the title, and since the Act of 1852 there is no reported case of a patent held to be invalid on the ground of variance between the title and the specification. It is true that the specification must commence with a title (*b*), but the function of the modern title is altogether different from that which it formerly fulfilled. It is more for the purpose of identifying the invention for reference and indexing, and its accuracy is in these times a matter for the examiners at the Patent Office.

Function of modern title quite different.

The filing of a provisional specification confers upon the applicant "Provisional Protection" for his invention against the consequences of publication (*c*). The patent when granted dates back to the time when the application was lodged (*d*), but no rights against the public are conferred until the complete specification is accepted and published (*e*), after which a right of action accrues against infringers. No proceedings may be taken, however, until the patent is sealed (*f*). In these respects the law is the same as under the Act of 1883.

Provisional protection.

It is somewhat difficult to define clearly the distinction between that which is absolutely necessary in the provisional specification and that which is absolutely necessary in a complete specification. In *Newall* v. *Elliott* (4 C. B. N. S. at p. 293) 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." In *Stoner* v. *Todd* (L. R. 4 Ch. D. 58) 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

(*b*) Act of 1907, sect. 2, sub-sect. 4.
(*c*) Sect. 4.
(*d*) Sect. 13.
(*e*) Sect. 13.
(*f*) Sect. 10.

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." In *Woodward* v. *Sansum* (4 R. P. C. at p. 174; 56 L. T. 347) 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 (*g*).

Purpose of provisional specification.

Disconformity.

It is evident, therefore, 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 ascertain clearly 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 would be defeated.

Lord Chelmsford, in *Penn* v. *Bibby* (L. R. 2 Ch. at p. 133), 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 perfect correspondence, but merely that there shall be nothing in the complete specification at variance with the provisional. . . . Nor is it at all

(*g*) And see *Moseley* v. *Victoria Rubber Co.*, 4 R. P. C. 241.

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."

A. L. Smith, L.J., in *The Cassel Gold Extracting Co., Ltd.* v. *The Cyanide Gold Recovery Syndicate* (12 R. P. C. at p. 257), said: "In a provisional specification no claim is ever made by the patentee, he has not to state therein what he claims, or how he carries out his invention; but he must state its nature in such a way that the law officers may see what it is, and so that the identity of its subject-matter, with that of the complete specification which is to come thereafter, may be ascertained. In the complete specification the patentee has to do much more. Not only has he to state therein what his invention is, but he must particularly describe how his invention is to be carried out and performed, and what he claims" (*h*).

It does not follow if the provisional specification describes some method of carrying the invention into effect, and the complete specification does not describe this method, but sets forth a better method, the nature of the invention remaining

(*h*) And see *Bailey* v. *Roberton*, L. R. 3 A. C. at p. 1075; *Woodward* v. *Sansum*, 4 R. P. C. at p. 178, and *The Pneumatic Tyre Co.* v. *The East London Rubber Co.*, 14 R. P. C. at p. 98.

the same, that the method described in the provisional specification is thereby disclaimed (*i*).

The plea of disconformity when successful often worked great hardship, for the excess of invention in the complete specification over that in the provisional was sometimes the most meritorious part and quite novel in itself. Of course, if the excess matter had not been novel at the date when the application was made and the provisional specification filed, the patent failed for want of novelty, and the patentee was not entitled to any special sympathy. In order, however, to relieve the patentee under the circumstances of the first-mentioned kind, the law was considerably modified by sect. 42 of the Act of 1907. The section is as follows:—

Statutory relief by sect. 42.

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

The excess matter must not only have been invented by the inventor, but it must have been novel at the date when the complete specification was put in, a considerably later date than that of the application. If the excess matter was not novel at the date of the provisional specification (*i.e.*, the application), then of course the patent will be invalid for want of novelty. If it be established that the excess matter was novel at the date of the application and provisional specification, but had been published before the complete specification had been filed, even by the patentee himself, the patent will be invalid, not on the ground of want of novelty, for in discussing novelty it is the date of the application that has to be considered, but on the old ground of disconformity.

The Welch Case.

The Welch Patent is an instructive example by which to illustrate the law on disconformity and also the effect of sect. 42. The patent was attacked on the ground of disconformity, and was held valid. If the arguments of the defendants had been successful the patent would have been

(*i*) *Sandow* v. *Szalay*, 23 R. P. C. 6.

held invalid under the old law, but had the section been law at that time the validity would have been saved, on the ground that the excess matter was novel at the date when the complete specification was put in. The judgment of Romer, J., in *The Pneumatic Tyre Co.* v. *The East London Rubber Co.* (14 R. P. C. at p. 98) covers all the arguments. In his provisional specification the inventor described an improved method of holding solid rubber tyres on to concave wheel rims by means of circular hoops of wire passed through circumferential holes in the edges of the tyre. Towards the end of the specification he said: "The above described improvements are also applicable to cycle and other wheels in present use, or made in the ordinary way, in which case they may be fitted over the existing rubbers without necessarily making any alteration. Or I may substitute in place of the ordinary rubber a lighter or cheaper material such as cork"; he also indicated that his invention might be applied to "cushion tyres." No mention of pneumatic tyres was made, although they were known at that date. In the complete specification he showed the invention as applied to pneumatic tyres, and this turned out to be by far the most valuable part of the invention, the effects produced being quite new, and making the pneumatic tyre, for the first time, a merchantable article. In the provisional specification the chief objects of the invention were stated to be "easy running, reduction of vibration, and the security of the rubbers to the metal rims or felloes." The learned judge said (p. 99): "The patentee was not bound, in his provisional specification, to detail the advantages of his invention. . . . No doubt, in the first part of his invention, when he is dealing with his tyres when used as the only tyres on a cycle, and not as covers to existing rubbers, he does effect all the three chief objects mentioned above. . . . He certainly obtains one of those objects when his tyre, with its fastening, is applied as a cover to pneumatic rubbers, namely, the securing of the tyre over the existing pneumatic rubber; and if he obtains that and other advantages by the extension, I fail to see why the extension, being useful, is not within the specification. He was not bound, when he

came, in his provisional specification, to the extension, to point out its particular advantages; and, indeed, it would have been imprudent, if not impossible, satisfactorily for him to do so, seeing that different advantages might probably be obtained from covering different kinds of existing rubbers."

Drawings may be required with provisional specification.

Sub-sects. 3, 4 and 5 of sect. 2 are as follows:—

(3) "*In the case of any provisional or complete specification where the comptroller deems it desirable he may require that suitable drawings shall be supplied with the specification, or at any time before the acceptance of the same, and such drawings shall be deemed to form part of the said specification* (*j*).

(4) "*A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed* (*k*).

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

THE COMPLETE SPECIFICATION.

The complete specification.

One of the essential considerations for the grant is that the patentee shall completely disclose the nature of his invention and the manner of carrying it into effect. This he does by filing a "complete specification" either at the time of the application or within nine (*l*) months thereof.

The information which must be conveyed by the complete specification is therefore considerably more than that required in a provisional, which need only describe the nature of the invention.

A complete and full disclosure is necessary, as the patent is in the nature of a bargain with the public, and the same

(*j*) The relation between the drawings and the letterpress will be discussed later.

(*k*) As to title, see p. 86 *et seq.*, supra. As to claims, see below.

(*l*) Under the Act of 1883 the period was nine months; this was shortened to six months by the Act of 1907; and extended again to nine months by the A t of 1919.

principle of good faith must be applied as that which regulates other contracts.

The following are the requirements which a complete specification must fulfil, and which we shall proceed to treat in detail:—

1. It must be set forth in clear language, free from ambiguity, (*a*) the nature of the invention and (*b*) the way it is to be carried into effect, so that persons to whom it is addressed would have no difficulty in carrying out the invention from the description.
2. It must be framed in good faith and show clearly the best way of carrying out the invention known to the patentee at the time—including any information he may have acquired since filing the provisional specification.

1.—(*a*) INTELLIGIBILITY AND DEFINITION OF AMBIT.

Intelligibility and sufficiency distinguished.

The inventor must point out clearly (*a*) the nature of his invention and (*b*) the manner of carrying it into effect.

In *Phillpott* v. *Hanbury* (2 R. P. C. at p. 38) Grove, J., said: "By the letters patent, a patentee is required as a condition of his patent, to particularly ascertain and describe the nature of his invention and the means of performing the same. Now those are two quite different things. The object of requiring the patentee to state what his invention is, as has been said (for I am by no means the first who has said it), to let the public know what is the prohibited ground, and what they are not to do—what the patentee has got his grant for, which gives him a monopoly for fourteen years . . . a patentee for the purpose of telling the public what his patent prevents their using without his licence for fourteen years, must give the nature of his invention in reasonably accurate language. . . . Then the second proviso is that he shall also particularly ascertain the means—I repeat the words, though the words are not repeated but implied—of performing the same, that is, of carrying the invention into practical effect. That is a totally different object. The object of that is to prevent what was at one time done and practised, I believe to a large extent, namely patentees getting

patents for an invention and keeping to themselves the 'trick of the trade,' if I may use the expression, that is to say, the means of performing it. . . . Letters patent therefore say 'you shall not have this monopoly unless you do two things—first of all, disclose the nature of the invention and tell the public the prohibited ground; and secondly, give them the means of carrying it into effect, so that at the expiration of your patent anybody (at all events, anybody with the ordinary knowledge of the particular trade to which it relates) may put your invention into practice.'"

Defining ambit of monopoly.

Now as to definition of the nature of the invention in the sense of the ambit of the monopoly, it is the duty of the patentee to mark out his territory clearly and without any ambiguity, and of late years the Court have enforced this obligation very strictly. In *Natural Colour Kinematograph Co., Ltd.* v. *Bioschemes, Ltd.* (*Smith's Patent*) (32 R. P. C. at p. 266), Lord Loreburn, L.C., said: "This patent is bad for ambiguity in the specification. There seems to be some danger of the well-known rule of law against ambiguity being in practice invaded. Some of those who draft specifications and claims are apt to treat this industry as a trial of skill, in which the object is to make the claim very wide upon one interpretation of it, in order to prevent as many people as possible from competing with the patentee's business, and then to rely upon carefully prepared sentences in the specification which, it is hoped, will be just enough to limit the claim within safe dimensions if it is attacked in Court. This leads to litigation as to the construction of specifications, which could generally be avoided, if at the outset a sincere attempt were made to state exactly what was meant in plain language. The fear of a costly lawsuit is apt to deter any but wealthy competitors from contesting a patent. This is all wrong. It is an abuse which a Court can prevent, whether a charge of ambiguity is or is not raised on the pleadings, because it affects the public by practically enlarging the monopoly, and does so by a kind of pressure which is very objectionable. It is the duty of a patentee to state clearly and distinctly, either in direct words or by clear and distinct reference, the nature and limits of

what he claims. If he uses language which, when fairly read, is avoidably obscure or ambiguous, the patent is invalid, whether the defect be due to design, or to carelessness, or to want of skill. Where the invention is difficult to explain, due allowance will of course be made for any resulting difficulty in the language. But nothing can excuse the use of ambiguous language when simple language can easily be employed, and the only safe way is for the patentee to do his best to be clear and intelligible. It is necessary to emphasize this warning." Lords Parker and Parmoor used words to the same effect. In *The British Ore Concentration Syndicate, Ltd.* v. *Minerals Separation, Ltd.* (27 R. P. C. at p. 47), Lord Halsbury said: "The statute requires it (the specification) to be a distinct statement of what is the invention. In construing a specification one has to remember that it is a document not only assuring a monopoly to the patentee, which but for the statute would be contrary to the common law, but so prohibiting any one, other than the patentee, doing what he would be free to do, but for the right which is granted, subject to the condition, among other things, that the patentee states distinctly what his invention is. If he designedly makes it ambiguous, in my judgment the patent would undoubtedly be bad on that ground; but even if negligently and unskilfully he fails to make distinct what his invention is, I am of opinion that the condition is not fulfilled, and the consequence would be that the patent would be bad" (*m*).

By sect. 2, sub-sect. 4, of the Act of 1907, re-enacting 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, emphasising, in a more distinct manner than had been provided before the passing of the Act of 1883, that the inventor must make a distinct and unambiguous claim.

It was decided in the House of Lords that the enactment in sect. 5 of the Act of 1883, that a complete specification must

(*m*) See also Loreburn, L.C., in *Linotype and Machinery, Ltd.* v. *Hopkins*, 27 R. P. C. at p. 112.

end with a distinct statement of the invention claimed, was directory only, and when letters patent have been granted, they will not be invalid merely because it has not been complied with (*n*).

History of the claim.

In the case of *The British United Shoe Machinery Co.* v. *Fussell* (25 R. P. C. at p. 650) Fletcher Moulton, L.J., dealt with the history of distinct claims as part of specifications. After mentioning the Act of Anne (see p. 86, ante), which required the patentee to state in a specification: (1) The nature of the invention, and (2) the method of performing the same, the learned Lord Justice proceeded: "The first was necessary to define the monopoly and the second was necessary to secure that the public was not defrauded by the patentee. . . . These two things—the delimitation of the invention and full practical directions how to use it—are in their nature almost antagonistic. As it is the duty of the inventor to give the fullest practical information to the public, he is bound to put in, if for instance the invention is a process, quantities and times which are the best he knows. But it would be very cruel to hold him to the invention when carried out only with those best quantities and times, because a person could then take his invention in substance if he did not take it in quite the best way, and the value of the grant would be practically nothing. Hence inventors, in their own protection, took to introducing into their specifications language intended to distinguish between that which was there for the practical information of the public, and that which was there for delimitation of the invention. Correct delimitation was of the greatest possible importance to the inventor, because if his patent covered something which was old the patent was wholly bad. At the same time there was the danger of confining himself to a mere outline which gave delimitation, but did not tell the public the best way within those limits of performing his invention. The one duty required him to state his invention in its most general form, and the other duty required him to state it in its best, and therefore in a very special form.

(*n*) *Vickers* v. *Siddell*, 7 R. P. C. at p. 303; L. R. 15 App. Cas. 496, 500, 505.

Out of that has arisen the practice, which originally was perfectly optional, of having a separate part of the specification primarily designed for delimitation. That is what we call the claim."

The Court, therefore, 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, provided that it is made clear 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. Provided moreover that the ambit of the monopoly be distinctly defined there is no need to discriminate between the prior state of the art and the new features in fact introduced by the patentee.

No need to "distinguish new from old."

Fletcher Moulton, L.J., pointed this out also in his judgment: "In the Act of 1883, for the first time, it was made a statutable duty to insert claims to define the invention, and that has been continued up to the present time; but the language of the statute follows that of the old proviso and leaves no doubt that the duty is only to define the invention for which the monopoly is claimed. The justice and sufficiency of that requirement are obvious. Specifications are not for the purpose of providing material for subsequent historians as to the genesis of ideas; they are for the purpose of informing the public as to what is the monopoly . . . A patentee often works solitarily. He has very little idea of what others are doing, and I think I may say that in the enormous majority of instances, if not universally, he has no complete knowledge of what has been done by others in connection with the matter on which he is working. The inventive acts by which he arrives at the invention for which he finally obtains protection may be inventive acts which have started far behind the level of public knowledge at the time, and much of his work truly inventive so far as he is concerned has been to re-invent that which others, without his knowledge, have invented. The consequence is that the inventive act of the inventor can have no relevance or effect; it is a thing which depends on his knowledge of what others had done. Then are we to say that he is to state what

would have been the inventive act, supposing him to know the whole knowledge of the world. . . . Of course, if his ignorance has led him to claim something which is not novel he has to take the penalty. He has chosen at his own risk to ask for and take a monopoly as against the public, and the consequence is, that if, with the best of faith, he has asked for too much, he must suffer for it. But to say that he must also ascertain, under the penalty of his patent being bad, everything that preceded his invention, every approach from every side that persons have made to it, and must correctly indicate the little step which he has made in addition to these, most of which he never knew, would be to require something of him, which would be perfectly idle so far as regards utility to the public, and grossly unjust so far as the patentee is concerned. . . . For these reasons I am satisfied that there is no duty to distinguish old from new in the invention actually claimed. If the invention actually claimed is novel that is sufficient."

Combination claims.

So where a patent is for a combination of old or new parts, or for an improved arrangement of old mechanism, provided it be clear that a monopoly is claimed for the new combination only, the specification need not discriminate between the new and old parts of such combination or improved apparatus unless it be desired to claim any of those subordinate parts *per se*, since it is the new combination alone that constitutes the novelty and merit of the invention; but it is necessary for the patentee to ascertain and define particularly what his monopoly covers, 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 know that the invention claimed consists in the combination specified.

As Lord Justice Fletcher Moulton observed (p. 651): "If I were to sum up my criticism of the point I should say that a man must distinguish what is old from what is new *by* his claim; but he has not got to distinguish what is old from what is new *in* his claim. If the combination which he has claimed, and for which he asks a monopoly, is novel, that is sufficient. There is no obligation to go further and to state why it is novel, or what in it is novel."

Where the meaning of a phrase is dubious, or there is a doubtful use of a commonly used word, the construction, as is the case with all documents, is for the Court alone (*o*). In the construction of technical words, however, there are involved the questions of intelligibility and sufficiency, and such construction is one of fact to be decided by the judge (or by the jury if there be one) after hearing the evidence of expert in the trade, but 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, and for this reason the ambit of the monopoly claim, *i.e.*, the "nature of the invention," is a matter not of evidence but of construction. The distinction was clearly pointed out by Lord Cairns in *The British Dynamite Co.* v. *Krebs* (13 R. P. C. at p. 192): "In determining whether the complete specification is sufficient, the first thing is to ascertain what the invention is. This is a question of construction, and the construction of the specification is for the Court, to be determined like the construction of any other written instrument, the Court placing itself in the position of some person acquainted with the surrounding circumstances as to the state of art and manufacture at the time, and making itself acquainted with the technical meaning in art or manufactures which any particular word or words may have. When the nature of the invention is thus ascertained by the Court, as a matter of construction, the Court has then to inquire whether the manner in which the same is to be performed is sufficiently described in the specification to the comprehension of any workman of ordinary skill in the particular art or manufacture; and this the Court can best do by the evidence of workmen of that description, and by the evidence of what workmen of that description have actually

Construction is for the Court.

Ambit of claim is for Court alone.

(*o*) *Neilson* v. *Harford*, 1 W. P. C. at p. 370; *Seed* v. *Higgins*, 30 L. J. Q. B. at p. 317; 8 H. L. C. 565; *Hills* v. *Evans*, 31 L. J. Ch. at p. 460; *Brooks* v. *Steele and Currie*, 14 R. P. C. at p. 73; and see Index, cap. "Evidence."

done under the patent." And Lindley, L.J., in *Brooks* v. *Steele and Curric* (14 R. P. C. at p. 73), said: "The judge may, and indeed generally must, be assisted by expert evidence to explain technical terms, to show the practical working of machinery described or drawn, and to point out what is old and what is new in the specification. Expert evidence is also admissible, and is often required to show the particulars in which an alleged invention has been used by an alleged infringer, and the real importance of whatever differences there may be between the plaintiff's invention and whatever is done by the defendant. But, after all, the nature of the invention for which a patent is granted must be ascertained from the specification, and has to be determined by the judge and not by a jury, nor by any expert or other witness. This is familiar law, although apparently often disregarded when witnesses are being examined" (*p*).

In the case of *Hills* v. *London Gaslight Co.* (27 L. J. Ex. 60) 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 was raised by evidence *dehors* the document, which was plain upon the face of it, the ambiguity being as to a term which imported one thing in a scientific sense, and another in a commercial sense, Baron Bramwell was of opinion that the meaning became a matter of fact.

Benevolent construction.

The leaning of the Courts is generally 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.* (L. R. 4 Ch. D. at p. 612), said: "I am anxious, as I believe every judge is who knows anything of patent law, to support honest bonâ fide inventors who have actually invented something novel and useful, and to prevent their patents being overturned on mere technical objections or on mere cavillings with the language of their specifications, so as to deprive the inventor of the benefit

(*p*) And see *Gadd and another* v. *The Mayor of Manchester*, 9 R. P. C. at p. 530.

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."

The word "benevolent" has been commented on in several cases:—

In *Needham* v. *Johnson* (1 R. P. C. at p. 58) 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."

Lord Esher, M.R., in *Nobel's Explosives Co.* v. *Anderson* (11 R. P. C. at p. 530), said: "It is quite true that the Court has in this specification, 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 (at 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

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that the canons of construction of the patent are the same canons of construction that are to be applied to every written instrument which has to be construed by the Court" (*q*).

The patentee is to be presumed not to claim things which he must have known perfectly well were not new (*r*), 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 (*s*).

Construction as of date of publication.

A specification is to be construed with reference to the state of knowledge at the time it is published (*t*). Lord Esher, in *Nobel's Explosives Co.* v. *Anderson* (11 R. P. C. at p. 523), said: "Now what is the very first canon of construction of all written business documents? Why, that the Court ought to construe them as if it had to construe them the day after they were published."

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, including the drawings, and will give an effective meaning to every part of it, if it can. Lord Esher, M.R., in *Parkinson* v. *Simon* (11 R. P. C. at p. 502), 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

(*q*) See also *Plimpton* v. *Spiller*, L. R. 6 C. D. at p. 422; *Otto* v. *Linford*, 46 L. T. N. S. at p. 39; *Cropper* v. *Smith*, 1 R. P. C. at p. 88; *Automatic Weighing Machine Co.* v. *Knight*, 6 R. P. C. at p. 307; *Edison Bell Phonograph Co.* v. *Smith*, 11 R. P. C. at p. 400; *Benno Jaffé Fabrik* v. *Richardson*, 11 R. P. C. at p. 271; *Parkinson* v. *Simon*, 12 R. P. C. at p. 411; *Tolson* v. *Speight*, 13 R. P. C. at p. 721.

(*r*) *Haworth* v. *Hardcastle*, 1 W. P. C. at p. 484; *Cropper* v. *Smith*, 1 R. P. C. at p. 85; *Lyon* v. *Goddard*, 10 R. P. C. at p. 133; *Tubes, Ltd.* v. *Perfecta Seamless Tube Co.*, 20 R. P. C. at p. 97.

(*s*) This statement of the law was approved by Swinfen Eady, J., in *The Cooper Patent Anchor Rail Joint Co.* v. *The London County Council*, 23 R. P. C. at p. 295. See also *Adie* v. *Clark*, L. R. 2 A. C. at p. 437.

(*t*) And see *The Badische Anilin und Soda Fabrik* v. *Levinstein*, L. R. 12 App. Cas. 710; 4 R. P. C. at p. 463; *Lane-Fox* v. *Kensington and Knightsbridge Electric Lighting Co.*, 9 R. P. C. at p. 417; *The Presto Gear Case Co.* v. *Orme, Evans & Co.*, 18 R. P. C. at p. 23.

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" (*u*). 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" (*v*). But if the provisional specification contains a description of the manner in which the invention may be carried into effect, it does not follow that if the complete specification describes a better method, the earlier method is thereby disclaimed (*w*).

Provisional may be looked at.

A question has been raised as to whether portions of a specification deleted by amendment might be referred to for construing the remainder (*x*). This question is now set at rest by sect. 21, sub-sect. 7, of the Act of 1907, as amended by the Act of 1919, which enacts that ". . . *the amendment . . . shall in all Courts and for all purposes be deemed to form part of the specification. Provided that the Court shall be entitled in construing a specification as amended to refer to the specification as accepted or published.*"

Construction of amended specification.

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 (*y*).

Construction of the claims.

(*u*) And see *Edison* v. *Woodhouse*, 4 R. P. C. at p. 107; *Tubes, Ltd.* v. *Perfecta Seamless Tube Co., Ltd.*, 20 R. P. C. at p. 96; *Hattersley* v. *Hodgson*, 23 R. P. C. at p. 203.

(*v*) Per Lord Esher, M.R., in *Parkinson* v. *Simon*, 1894, 11 R. P. C. at p. 503.

(*w*) *Sandow* v. *Szalay*, 1906, 23 R. P. C. at p. 14.

(*x*) See *Lake and Elliott* v. *Rotor Motor Accessories, Ltd.*, 28 R. P. C. 532.

(*y*) *Arnold* v. *Bradbury*, L. R. 6 Ch. at p. 712; *Plimpton* v. *Spiller*, L. R. 6 Ch. D. at p. 427; *Edison* v. *Woodhouse*, 4 R. P. C. at p. 107; *Leadbeater* v. *Kitchin*, 7 R. P. C. at p. 244; *Edison* v. *Smith*, 1894, 11 R. P. C. at p. 395; *Electric Construction Co.* v. *Imperial Tramways Co.*, 16 R. P. C. at p. 638; *British*

Order of consideration.

In the case of *Arnold* v. *Bradbury* (L. R. 6 Ch. at p. 712) Lord Hatherley, in the course of his judgment, says: "I do not think that the proper way of dealing with this question is to look first at the claims, and then see what the full description of the invention is; but rather first to read the description of the invention, in order that your mind may be prepared for what it is the inventor is about to claim."

Each subordinate part of an invention must be claimed specifically in order to be independently protected, 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 (*z*).

"Substantially as described."

The claims at the end of a specification frequently end with the words "as herein described," or "substantially as herein described." The effect of these words on the ambit of the claim both for novelty and infringement depends entirely on the nature of the object to be attained by the device described, which is to be ascertained by reading the specification as a whole. If the merit of the invention be the attainment of a new result the Court does not attach much importance to the words "as affecting any narrow limitation" (*a*). If, on the other hand, the invention have the smaller merit of being the discovery of a new road to an old result, the words "as herein described" are a useful abbreviation for emphasising this fact in the claim (*b*). But beyond having this cautioning effect, they are mere verbiage, as the same result may be obtained by carefully construing the specification.

United Shoe Machinery Co. v. *Hugh Claughton, Ltd.*, 23 R. P. C. at p. 334.

(*z*) *Hinks* v. *Safety Lighting Co.*, L. R. 4 Ch. D. at p. 612.

(*a*) See, *e.g.*, *United Telephone Co.* v. *Bassano*, 3 R. P. C. at p. 315; *Proctor* v. *Bennis*, 4 R. P. C. 333; *Cassel Gold Extracting Co.* v. *Cyanide Gold Recovery Syndicate*, 12 R. P. C. at p. 257; *Parkinson* v. *Simon*, 12 R. P. C. at p. 408; *Welsbach Incandescent Gas Light Co.* v. *New Incandescent Co.*, 17 R. P. C. at p. 250, and see Chap. VII.

(*b*) See, *e.g.*, *Curtis* v. *Platt*, L. R. 3 C. D. 136 n.; *Easterbrook* v. *Great Western Rail. Co.*, 2 R. P. C. at p. 208; *Brooks* v. *Lamplugh*, 15 R. P. C. at p. 49; *Ackroyd and Best, Ltd.* v. *Thomas*, 21 R. P. C. at pp. 749 and 750.

In *Westinghouse* v. *Lancashire and Yorkshire Ry. Co.* (1 R. P. C. at p. 241) Grove, J., said: "I have said before, practically 'substantially as herein described' comes to nothing. It is supposed, and probably it does have some effect when counsel are addressing the jury to say, 'we claim it substantially as herein described'; but they are idle words, because, if the infringer does what is 'substantially herein described and claimed' he just as much infringes the patent whether the word 'substantially' is used or not. So that they are mere catch expressions and no real use at all, but some patent agents are very fond of putting them in, . . . but they do not alter the law or carry it a step further because the patentee, when he claims his invention, claims it in connection with the drawings, and when he describes the nature of his invention, any person who substantially adopts that invention as claimed by him, infringes his patent, and not a bit the more or less, because the patentee puts in the word 'substantially.' It is simple verbiage" (*c*).

Repetition of claims no objection.

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.* (9 R. P. C. at p. 55) Lindley, L.J., said: "I think the true construction of the fourth claim is pointing out the importance 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." But an effective meaning must if possible be given to each claim. In *Parkinson* v. *Simon* (11 R. P. C. at p. 502) Lord Esher, M.R., said: "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 which are identical with each other, then some of them have no effect at all. It follows from the ordinary rules of construction that you must construe the

(*c*) See the same judge's remarks in *Young* v. *Rosenthal*, 1 R. P. C. at p. 33, and *Goddard* v. *Lyon*, 11 R. P. C. at p. 362.

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."

Appendant claims.

Where one of the claims in a specification, although strictly, if taken by itself, would be for something old, is purely appendant and subordinate to the main invention, it has been held that a patent is not void on that account (*d*).

Previous constructions binding.

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 (*c*), 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 (*f*).

(*b*) SUFFICIENCY.

The Addressee.

We may now proceed to deal with the requirement that a specification must be sufficient to enable a person skilled in the art to carry the invention into effect. The patentee is entitled to assume that the person to whom the specification is addressed will possess that degree of skill and knowledge which would ordinarily be expected of his class.

In *Heath* v. *Unwin* (1 W. P. C. at p. 245) 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 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

(*d*) *E.g.*, *True and The Variable Electric Lamp Syndicate* v. *Bryant Trading Syndicate*, 25 R. P. C. 461.

(*c*) *Edison* v. *Holland*, 6 R. P. C. at p. 276; *The Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*, 6 R. P. C. at p. 370, and the various actions on the Welch patent.

(*f*) *Shaw* v. *Day*, 11 R. P. C. at p. 189; see also *Edison* v. *Holland*, 6 R. P. C. at p. 277; *Flour Oxidizing Co.* v. *Carr*, 25 R. P. C. at p. 448.

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."

Therefore the language to be used and the completeness of the description will depend entirely on the person to whom it is addressed. It is not sufficient to say that it must appeal to the ordinary workman practising that particular trade; since, for instance, a workman, or even a foreman, in a chemical works might not possess the technical skill and knowledge to understand a new chemical process which the manager would have no difficulty in directing them to put in practice. This must be understood when those judgments in which the words "competent workmen" are used come to be considered.

As an instance, the case of *The Incandescent Light Co.* v. *The De Mare Incandescent Gas Light Co.* (13 R. P. C. at p. 327) may be mentioned, where Mr. Justice Wills said: "The subject-matter of the specification is such that no one but a person possessing a very considerable amount of chemical knowledge could, at the date of the specification, be considered a competent workman."

The complexity of modern industries involving chemical and engineering questions in the solution of a single problem may necessitate more than one "addressee" for a single specification. In *Osram Lamp Works, Ltd.* v. *Pope's Electric Lamp Co.* (34 R. P. C. at p. 391) Lord Parker said: "A specification may be considered as addressed, at any rate primarily, to the persons who would in normal course, have to act on the directions given for the performance. These persons may be assumed to possess not only a reasonable amount of common sense, but also a competent knowledge of the art or arts which have to be called into play in carrying the patentee's directions into effect. I say 'art or arts' because in carrying out the directions given by the patentee it may well be necessary to call in aid more than one art. Some of the directions contained in a specification may have to be carried out by skilled mechanics, others by competent chemists. In such a case, the mechanic and chemist

must be assumed to co-operate for the purpose in view, each making good any deficiency in the other's technical equipment. The specification cannot be considered insufficient merely because the mechanic without the aid of the chemist, or the chemist without the aid of the mechanic, would be unable to comprehend the meaning of, or to carry into effect the directions given by the patentee. For example, in the present case a skilled mechanic might be uncertain as to the temperature of carbonisation; but this would be unimportant if the industrial chemist would, having regard to the object to be attained, have no doubt on the point. Again, the chemist might be ignorant of some necessary detail in the mechanical means usually employed in the formation of filaments; but this would be unimportant if the mechanic, acquainted with the way in which filaments were usually formed, had the necessary knowledge."

An interesting illustration of the principle that the addressee is the person engaged in the particular industry to which the invention relates is to be found in *The "Z" Electric Lamp Co.* v. *Marples Leach & Co.* (*g*). The specification prescribed the use of a substance known as "phospham" in the manufacture of incandescent electric lamps for a particular purpose. The defendants showed that "phospham" in the strictest chemical sense would not operate in the manner desired. The plaintiffs on the other hand showed that the substance as obtained from chemical manufacturers was not quite pure and that it would work satisfactorily. It was held that the addressee was the lamp manufacturer, and that he would in the ordinary course of business procure his "phospham" from the chemical manufacturer. The patent was held valid.

Intelligibility and sufficiency questions of fact.

Whether it be sufficient is a question of fact in each particular case to be decided on evidence (*h*).

Degree of sufficiency required.

Generally speaking, then, an inventor is entitled to assume that the persons to whom the specification is addressed possess the ordinary skill of their trade, and he is not required to give directions of a more minute nature than such a person

(*g*) 27 R. P. C. 305, 737.

(*h*) *R.* v. *Arkwright*, 1 W. P. C. 64; *Hill* v. *Thompson*, 1 W. P. C. at p. 237; *British Dynamite Co.* v. *Krebs*, 13 R. P. C. at p. 192.

might fairly be expected to need (*i*). If, for example, 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. But should the success of the invention depend particularly on the manner in which an old instrument though well known is directed to be used, the directions must lay stress on this point, if it would not be obvious to the skilled tradesman.

In *The Badische Anilin* v. *La Société Chimique* (15 R. P. C. 359), the specification directed that two substances were to be heated together "in an iron autoclave." Now it was proved that in similar operations the trade frequently made use of autoclaves which were not made of iron, and in many such operations enamelled autoclaves had advantages. The success of the plaintiff's process entirely depended upon the use of an *iron* vessel, without which the reaction would not take place. The specification was declared insufficient.

The specification must be sufficient to enable the invention to be carried into effect without a series of experiments.

Jessel, M.R., in *Plimpton* v. *Malcolmson* (L. R. 3 Ch. D. at p. 576), said: "You must not give people mechanical problems and call them specifications."

Degree of experiment necessitated.

But this broad statement requires some modification. The inventor cannot be expected to relieve the "competent workman" from all obligation to take trouble in carrying into effect the description in the specification. Moreover, it may safely be said that in modern engineering practice no one would think of treating the drawings of a machine in a specification as working drawings. Even with the best of such drawings a certain amount of designing and calculation has to be carried out before a machine can be built, and the degree of knowledge

(*i*) *Boulton* v. *Bull*, 2 H. Bl. at p. 478; *Morgan* v. *Seaward*, 1 W. P. C. at p. 174; *In re Gaulard and Gibbs' Patent*, 6 R. P. C. 224; *Edison* v. *Holland*, 6 R. P. C. at pp. 280, 282; *Miller* v. *Clyde Bridge Steel Co.*, 8 R. P. C. at p. 201; *Hopkinson* v. *St. James's and Pall Mall Lighting Co.*, 10 R. P. C. at p. 61; *Kane* v. *Boyle*, 18 R. P. C. at p. 336.

requisite to perform such operations must be presumed in the person to whom the specification is addressed. In *Edison and Swan Electric Light Co.* v. *Holland* (6 R. P. C. at p. 277) Cotton, L.J., said: "The objection taken as a whole, was that the specification did not sufficiently show how the invention is to be carried into effect. It is necessary that this should be done so as to be intelligible, and to enable the thing to be made without further invention by . . . a person conversant in the subject. But in my opinion it is not necessary that such a person should be able to do the work without any trial or experiment, which, when it is now or especially delicate, may frequently be necessary, however clear the description may be" (*j*).

Effect of errors.

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 or drawing, 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 (*k*).

And it frequently occurs that the inventor states an erroneous theory as to the operation of the machine or process, the subject of the invention. This will not invalidate the patent unless it amounts to a misleading statement (*l*).

In *Wegmann* v. *Corcoran* (L. R. 13 Ch. D. 65) it was held that the specification of a patent was bad if one of the materials to be used was described by a generic term comprising a variety of species, the majority of which would be

(*j*) And see *Morgan* v. *Seaward*, 1 W. P. C. at p. 176; *Otto* v. *Linford*, 46 L. T. N. S. at p. 40; *Osram Lamp Works, Ltd.* v. *Pope's Electric Lamp Co.*, quoted at p. 107, supra; *Watson, Laidlaw & Co.* v. *Pott & Ors.*, 27 R. P. C. at p. 558 and 28 R. P. C. at p. 580.

(*k*) *Simpson* v. *Holliday*, 13 W. R. 578; L. R. 1 H. L. 321; *Otto* v. *Linford*, 46 L. T. N. S. at p. 40; *Miller* v. *Scarle*, 10 R. P. C. at p. 111; *British United Shoe Machinery Co.* v. *A. Fussell and Sons, Ltd.*, 25 R. P. C. at p. 385.

(*l*) As in *Monnet* v. *Beck*, 14 R. P. C. at p. 847, and see "*Z*" *Electric Lamp Co.* v. *Marples, Leach & Co.*, 27 R. P. C. 305, 737; *Knight* v. *Argylls, Ltd.*, 29 R. P. C. 593; 30 R. P. C. 321.

unsuitable, thus rendering experiment necessary to ascertain which were suitable.

And in *Simpson* v. *Holliday* (L. R. 1 H. L. 315) the patentee described specifically two alternative methods of producing his result. And his claim included both methods. One of them would not work and the patent was held invalid. It is important, therefore, before holding that a patent is invalid for this or for any other reason that the Court should first construe the specification correctly. If that description of the process which is claimed as the subject of the monopoly is insufficient then the patent is invalid. In *Vidal Dyes Syndicate* v. *Levinstein* (29 R. P. C. at p. 269) Moulton, L.J., said: "It is this coexistence of the duty to tell the public the best way of carrying out the invention, which is at the time known to the inventor, and the duty of marking out clearly the limits of the monopoly which the inventor claims, that leads so frequently to the presence of permissible alternatives in the specification, and the Courts rightly consider that an inventor is not to be limited by description of steps which he recommends, provided, on the fair construction of the specification, he has not represented them as necessary, and that his claim fairly construed, includes cases where these useful alternatives are not used, as well as those where they are. . . . (p. 270). In the case of dinitrophenols the specification clearly says that you must reduce by sulphuret of sodium before you expose the body to the reaction of sulphur which causes the formation of the dye. But in the case of dinitronaphthols, the specification only says that you may advantageously do so, and it clearly reserves to the patentee, as one method of carrying out his invention, that you should perform the dye-forming reaction without previously treating the dinitronaphthols with sulphuret of sodium. Both these processes, therefore, are included within the claim, and it is admitted that the latter will not work. It follows, therefore, that on this ground the patent must be held to be invalid" (*m*).

But if the inventor describes, under a generic term, an ingredient to be used, and illustrates the term by examples, the mere fact that some things which might be included

(*m*) And see *Lewis* v. *Marling*, 1 W. P. C. at p. 495.

under the generic term, and are not described, would not be suitable, will not invalidate the patent. In *Leonhardt* v. *Kallé* (12 R. P. C. at p. 116) Romer; J., said: "Now, with reference to that, what has the patentee done, and what really could he do more? He has pointed out numerous oxidisable substances, and admittedly those oxidisable substances he mentioned are as good, if not better, and are more easily dealt with than the other oxidisable substances which are not specifically mentioned. Was it reasonable to suppose that the patentee ought to set himself down as a sort of dictionary to specify every known oxidisable substance, and to point out which of those could not give very useful results, or which might be disregarded?" (*n*).

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.

SECOND REQUIREMENT, GOOD FAITH AND DISCLOSURE OF BEST METHOD.

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

In *Crompton* v. *Ibbotson* (1 W. P. C. 83) 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.

In *Wegmann* v. *Corcoran* (L. R. 13 Ch. D. 65) the invention patented, on a communication from abroad, consisted

(*n*) And see *Watson, Laidlaw & Co.* v. *Potts and Ors.*, 27 R. P. C. at p. 558, and 28 R. P. C. at p. 580.

of a special construction of rollers for milling corn. The specification prescribed the use of iron rollers covered with very hard china, turned smooth by the aid of diamond tools. It was proved that china of the requisite hardness had not been made in England for half a century, and that such china could not be made unless the manufacturer tried elaborate experiments. The plaintiff himself obtained his rollers from Italy, where the process of their manufacture was kept secret, but the specification did not mention this fact, and without it the description in the specification was useless. The specification was held to be insufficient and misleading. Fry, J., 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." *Sturtz* v. *De la Rue* (1 W. P. C. 83) was a very similar case.

In case of communicated invention.

It will be seen that *Wegmann* v. *Corcoran* is distinguishable from the case of *Plimpton* v. *Malcolmson* (L. R. 3 Ch. D. 582). There the question was whether the patentee, having disclosed a useful invention, was bound to disclose something more, some fact more useful still than the description actually given, 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 itself useful, and that he was bound to tell all that he himself knew, and to give a sufficient description to work the invention.

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.

But Bayley, J., in *Lewis* v. *Marling* (1 W. P. C. at p. 496)

said: "His patent is for an instrument where something of that kind was always thought material, and I am of opinion that the subsequent discovery that the plush was unnecessary is no objection to the patent. If the party knew that it was unnecessary the patent would be bad, on the ground that this was a deception, but if he thought it was proper, and only by a subsequent discovery finds out that it is not necessary, I think that forms no ground of objection."

Therefore the requirement is not as much for perfection of detail as for good faith on the part of the patentee. This is illustrated by the case of *The British Dynamite Co.* v. *Krebs* (13 R. P. C. at p. 195). The inventor, Nobel, described a new explosive (dynamite) which he said, in his specification, was to be made by causing nitro-glycerine, *per se* a very dangerous and erratic liquid, to be absorbed by a porous unexplosive substance. He gave a list of such substances which were shown to be more or less useful. The resulting mass was safe and could be stored. He found subsequently that there was a certain, well-known silicious earth called "kieselguhr" which possessed the requisites of porosity and power of absorption to a very high degree, and the dynamite actually manufactured was, in consequence, always produced by the aid of this material. Lord Hatherley, restoring the judgment of Fry, J., said: "If it had been proved that the inventor, Nobel, knew the best material, which turned out to be a material called 'kieselguhr,' a silicious earth; if he had known of the existence of 'kieselguhr' at the time, and that it would take up 75 per cent. of the nitro-glycerine, whereas some other materials specified by the patentee took up only 25 or 50 per cent., it would have been an objection to his patent to say that he, being in possession of the best mode of producing the most valuable dynamite, had not informed the public of that method."

In *Tetley* v. *Easton* (Mac. P. C. at p. 76) 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* (2 W. P. C. at p. 243) Coleridge, 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, which would be directly contrary to the good faith required from every patentee in his communication with the public" (*o*).

In *The Badische Anilin und Soda Fabrik* v. *Levinstein* (4 R. P. C. at p. 464; L. R. 12 A. C. 716) 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 the shades was proved to have any practical value, and it was argued that the patent was bad on the ground that no description was given of the relative advantages of each 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."

No need to state advantages.

But where the attainment of a particular advantage constitutes the whole essence of the invention it is necessary to state this advantage in order to properly delimit the invention. In *Clay* v. *Allcock* (23 R. P. C. 745) the invention consisted of a paternoster sea-fishing line, in which booms carrying hooks were pivoted at right angles to the trace, and were capable of swinging downwards so as to give a "straight pull" when a bite occurred; so far the invention was not novel. The specification stated, however, that the inward end of the boom should be constructed "preferably" of a diamond shape, and the drawings illustrated a construction of this form. The

save where such are whole essence of invention.

(*o*) And see *Wood* v. *Zimmer*, 1 W. P. C. 82, n.; *Crossley* v. *Beverley*, 1 W. P. C. at p. 117; *Morgan* v. *Seaward*, 1 W. P. C. at p. 174.

claim was for booms constructed "as described." It appeared, although it was not so stated in the specification, that a particular advantage attended the use of the diamond shape which rendered it very useful and constituted the whole novelty of the invention. The Court of Appeal held that the invention, as broadly claimed, was invalid for want of novelty. Fletcher Moulton, L.J. (at p. 750), said: "I quite agree that in the preferable form of his invention, which the patentee has shown in his drawings, he would have that effect or advantage, but I can find nothing which indicates that he intended that to mark out the limits of his territory. . . . Counsel for the plaintiff urged the well-known principle in patent law that a man need not state the effect or the advantage of his invention, if he describes his invention so as to produce it. But that is not true where he has to rely on the presence or absence of such effect or advantage as a part of the necessary delimitation. The fact that it is a mere consequence cannot be pleaded by him as an excuse for not putting it in, if the leaving it out leaves his invention inadequately defined" (*p*).

Drawings. By sect. 2, sub-sect. 3, of the Act of 1907, it is enacted: "*In the case of any provisional or complete specification where the comptroller deems it desirable, he may require that suitable drawings shall be supplied with the specification, or at any time before the acceptance of the same, and such drawings shall be deemed to form part of the said specification.*"

Before the Act of 1883 drawings were quite optional on the part of the patentee; but then, as now, if drawings had not been filed, and the invention had been too complicated to be understood without them, the patent would be invalid on account of insufficiency, and not because drawings were not filed. Drawings have always been held to be merely part of the specification and to be read with the letterpress, and whether the invention will be limited by the drawings will depend on the nature of the invention.

Discrepancies in drawings. It is sometimes asked, "What is to be done if there is a discrepancy between the printed matter and the drawings?"

(*p*) And see as an illustration *Contraflo Condenser Co.* v. *Hick*, *Hargreaves & Co.*, 37 R. P. C. at p. 103.

And this may be answered by the question, "Does the discrepancy produce ambiguity sufficient to mislead?" If it be clear to persons skilled in the trade what is meant, then the patent is not ambiguous, and it is immaterial from which part of the specification they have drawn their information. If there is ambiguity, the patent is invalid. It is submitted that this proposition covers the whole point.

CHAPTER VII.

INFRINGEMENT OF LETTERS PATENT.

Royal Command in Letters Patent.

THE infringement of a patent is the doing that which the patent prohibits from being done. 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 sixteen 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 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."

No duty to warn infringers.

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 (*a*). If, however, the patentee were falsely to represent to a manufacturer that the wares manufactured by him were not an infringement of the patent, and thereby induce him to spend money on further manufactures or otherwise to place himself at a disadvantage, the conduct of the patentee would amount to acquiescence, and he could not succeed in an action for infringement (*b*).

(*a*) *Proctor* v. *Bennis*, L. R. 36 Ch. D. 740. (*b*) Ibid. at p. 760.

Infringement a mixed question of law and fact.

Infringement is a mixed question of law and fact; firstly, the specification must be construed and its ambit determined as a matter of law, and then it is a matter of fact whether (*a*) the defendant has committed the acts complained of and (*b*) whether such acts do or do not fall within the construction already put on the specification and its claims.

If, however, the defendant can prove that the act complained of is merely what was done before the date of the patent without substantial or patentable variation he has a good defence and need not trouble himself with any argument as to the construction of the plaintiff's specification. In *Gillette Safety Razor Co.* v. *Anglo-American Trading Co.* (30 R. P. C. at p. 480), Lord Moulton said: "I am of opinion that in this case the defendant's right to succeed can be established without an examination of the terms of the specification of the plaintiff's letters patent. I am aware that such a mode of deciding a patent case is unusual, but from the point of view of the public, it is important that this method of viewing their rights should not be overlooked. In practical life it is often the only safeguard to the manufacturer. It is impossible for an ordinary member of the public to keep watch on all the numerous patents which are taken out and to ascertain the validity and scope of their claims. But he is entitled to feel secure if he knows that that which he is doing differs from that which has been done of old only in non-patentable variations, such as the substitution of mechanical equivalents or changes of material, shape, or size. The defence that 'the alleged infringement was not novel at the date of the plaintiff's letters patent,' is a good defence in law, and it would sometimes obviate the great length and expense of patent cases if the defendant could and would put forth his case in this form, and thus spare himself the trouble of demonstrating on which horn of the well-known dilemma the plaintiff had impaled himself, invalidity or non-infringement." No case has yet arisen, however, in which the defendant has been bold enough to avail himself on the pleadings of Lord Moulton's suggestion (*c*).

(*c*) See also *Proctor* v. *Bennis*, 4 R. P. C. at p. 351; chapter on Practice in Infringement Action; heading, "Particulars of Objections."

No infringement of invalid patent.

If the patent be invalid there can be no infringement in the sense that a patent which has no legal existence cannot be infringed.

Ignorance no excuse.

It is equally an infringement whether the defendant acted in ignorance of the plaintiff's patent or not (*d*). In *Heath* v. *Unwin* (14 L. J. Ex. at p. 156; 2 W. P. C. at p. 227), 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." Thus judgment certainly give an erroneous impression of the law, and subsequently, when *Heath* v. *Unwin* (25 L. J. C. P. at p. 19; 5 H. L. at p. 537) came before the House of Lords, the opinion of the judges being taken, Parke, B., acknowledged the error into which the Court had fallen.

Nor intention.

In *Stead* v. *Anderson* (2 W. P. C. at p. 156), Wilde, C.J., tersely puts it: "We think it clear that the action is maintainable in respect of what the defendant does, not what he intends."

So it is immaterial whether the defendant was aware that the thing was patented or not, since in law every person in the realm is taken to have notice of a patent in the same way that he is taken to be aware of the law (*e*).

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 (*f*).

Save as to question of remedy.

The bona fides of the infringer does, however, affect the rights of the patentee with respect to the remedy which he may obtain (*g*).

Proof of an intention to infringe, apart from actual infringement, may, however, justify an injunction to restrain such infringement (*h*).

The question as to what will or what will not amount to infringement, like many other points which arise in the law of

(*d*) *Proctor* v. *Bennis*, 36 C. D. at p. 760.

(*e*) And see *Wright* v. *Hitchcock*, L. R. 5 Ex. 37; *Young* v. *Rosenthal*, 1 R. P. C. at p. 39.

(*f*) *Newall* v. *Elliott*, 10 Jur. N. S. at p. 958; 13 W. R. at p. 18.

(*g*) See sect. 33 of the Act of 1907.

(*h*) See Index, Cap. "Injunction."

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* (11 R. P. C. at p. 127), Romer, J., said: "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."

One principle governs all cases.

But the consideration of the question of infringement is much simplified if one remembers that inventions may be divided roughly into two classes in respect to subject-matter (see p. 37, supra). Firstly there is that kind of invention which consists in the discovery of a method of application of a new principle—here what has been invented is in effect the new principle, and, generally speaking, the Court will regard jealously any other method embodying that principle, for the patentee was not bound to describe every method by which his invention could be carried into effect. Secondly there is that kind of invention which consists in some particular new method of applying a well-known principle, and in this case the use of other methods is not contemplated by the patentee, and such will not fall within the ambit of his claim. It is important to remember that, as was pointed out by Romer, J., in the passage quoted above, the claim made by the patentee is the point to be considered, not the actual merit of the invention.

But two classes of inventions.

A patentee is at liberty to make a wide or a narrow claim as he chooses. If his claim be too wide he runs the risk of invalidity, if too narrow he allows persons to escape who have taken advantage of his real invention but avoided the net of his monopoly, for if it be clear on construing his claim that he has limited his monopoly to the precise method shown of carrying out his invention no amount of merit and originality in the fundamental principle involved will extend his claim to other methods. As Lord Shaw said in *Ridd Milking Machine Co.* v. *Simplex Milking Machine Co.* (33 R. P. C. at p. 317): "It might be possible in very many cases of a claim for apparatus—if the argument presented were sound—to evolve a claim for a principle from a description given of the results achieved, and to maintain accordingly that it was the principle of the invention in that sense, which was the real subject of the claim. This is in their Lordships' opinion, a method of construction of patent claims which is accompanied with serious danger . . . if any claim for a principle is made it must undoubtedly appear in the claim as that claim is stated, and must not be left to an inference resting on a general review of the specification, or a general secret among the language employed therein for the meritorious element of principle or idea" (*i*).

Bowen, L.J., in *Jackson* v. *Wolstenhulmes* (1 R. P. C. at p. 108), said: "It must be remembered that claims are for the security of patentees, to prevent it being said that the patentee has claimed more than can be really supported as his invention."

An interesting case of an inventor limiting himself by his claim to something narrower than he had actually invented, and thereby failing to catch an infringer, is to be found in *The Incandescent Gas Light Co.* v. *The Sunlight Incandescent Gas Light Co.* (13 R. P. C. 333). The real nature of the discovery was that a skeleton of earthy oxides could be produced, which, when suspended in a Bunsen flame, formed an illuminant. The claim, however, was limited to the manufacture of such a skeleton of certain specified materials, and in a certain specified

(*i*) And see *Ackroyd and Best, Ltd.* v. *Thomas*, 21 R. P. C. at p. 750; *Dudgeon* v. *Thompson*, L. R. 3 A. C. at p. 44; and *Presto Gear Case Co.* v. *Orme Evans & Co.*, 18 R. P. C. at p. 23.

manner. The defendant skilfully avoided the use of the patented invention by making use of the principle, but producing the skeleton of other substances and manufacturing in another manner.

Baron Alderson's dictum.

In *Jupe* v. *Pratt* (1 W. P. C. at p. 146), in the course of the argument Alderson, B., said: "You cannot take out a patent for a principle. You may take out a patent for a principle coupled with the mode of carrying the principle into effect, provided you have not only discovered the principle but invented some mode of carrying it into effect. But then you must start with having invented some mode of carrying the principle into effect. If you have done that, then you are entitled to protect yourself from all the other modes of carrying the principle into effect, that being treated by the jury as a piracy of your original invention." This statement of the law was approved by the House of Lords in *Chamberlain and Hookham, Ltd.* v. *Bradford Corporation* (20 R. P. C. at p. 684), and by Parker, J., in *The British United Shoe Machinery Co., Ltd.* v. *Simon Collier, Ltd.* (26 R. P. C. at p. 49), but when the words ". . . patent for a principle *coupled with* the mode . . ." are closely examined it is easy to see that they are liable to misinterpretation. Alderson, B., did *not* say that in such a case the specification could end with two distinct claims, one for the principle irrespective of its application, and the other for the method of application—his meaning is made clear by his observations in *Neilson* v. *Harford* (1 W. P. C. at p. 355). The dictum in *Jupe* v. *Pratt* and the subsequent observations in *Neilson* v. *Harford* were dealt with by the Court of Appeal in *The Automatic Weighing Machine Co.* v. *Knight* (6 R. P. C. 297), in which Cotton, L.J., said (at p. 204), referring to the dictum in *Jupe* v. *Pratt*: "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* (4 R. P. C. 333). 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, 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" (*j*).

It may be stated generally that the Court will in every case inquire in what the essence of the invention as claimed consists, and will hold the defendant to have infringed if he has taken the pith and marrow of the invention as claimed, and when the claim is merely for an improved mode of attaining an old object the monopoly is for that particular improved method, and only by making use of that particular method will a man be held to have infringed; but when the claim is for a 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; 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. In other words, there are two classes of invention, but only one principle governing the law of infringement.

Curtis v. Platt.

In *Curtis* v. *Platt* (L. R. 3 C. D. 136, n.), 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

(*j*) And see the observations of Lord Esher, M.R., and Kay, L.J., in *Nobel's Explosives Co.* v. *Anderson*, 11 R. P. C. at pp. 525 and 527; Halsbury, L.C., in *Ashworth* v. *English Card Clothing Co.*, 20 R. P. C. at p. 797; and Lord Haldane, L.C., in *British Vacuum Cleaner Co.* v. *Robertshaw*, 32 R. P. C. 435

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" (*k*).

Proctor v. Bennis.

In *Proctor* v. *Bennis* (4 R. P. C. 333) the patentee claimed the combination in the mechanism of four integers designated by the letters used to indicate them in the drawings when applied "as and for the purpose herein fully described and illustrated." The purpose was shown to be a novel purpose, and the defendant had used mechanical equivalents for each of the integers and had combined them for the same purpose. In the course of his decision Cotton, L.J. (at p. 355), comparing this patent with that sued on in *Curtis* v. *Platt*, said of the latter: "It was specially to introduce improvements into the mechanical, means and arrangements which a previous patentee had used to obtain a well-known object in a well-known machine. Therefore in that case, in applying those words used by the judges, we must deal with the case before them and come to the conclusion, as I do, that what they meant was this, that where there is no novelty in the result, where neither the machine nor the result is new, there you must tie down the patentee, who claims an improvement in the machinery for producing in a known machine that result, strictly to the invention which he claims, and the mode of effecting the

(*k*) See also Lord Watson in *Tweedale* v. *Ashworth*, 9 R. P. C. at p. 128; and in *Miller* v. *Clyde Bridge Steel Co.*, 9 R. P. C. at p. 478; Lord Davey in *Consolidated Car Heating Co.* v. *Came*, 20 R. P. C. at p. 766; Lord Shaw in *Ridd Milking Machine Co.* v. *Simplex Milking Machine Co.*, 33 R. P. C. at p. 317.

improvement which he says is his invention. But here the throwing coal on to the furnace by the intermittent radial action of a flap or door was new, and nothing of the kind had been done before. It is true there had been previous though imperfect machines for feeding furnaces automatically, but that had not been done previous to this machine by any intermittent radial action of a flap or door, as was done by the plaintiff, and apparently successfully done by him. In my opinion, therefore, these opinions expressed by the judges with reference to mere improvements in an old machine for an old purpose cannot lay down any law for a case like this, where the result of throwing coal on to the furnace by the intermittent radial action of the flap is first applied in a machine invented by the plaintiff. There was not only novelty in the machine, but there was novelty in the effect, and in the result to be produced by that machine" (*l*).

To sum up the effect of these two famous leading cases and the numerous judgments in which the principles therein laid down have been applied we venture upon the following statement of the law:—

The specification and claims must be construed in the light of the common knowledge in the art at the date of the letters patent. It must be determined by the Court whether the monopoly claimed is for the precise mechanism described or for the attainment of a result by any means substantially equivalent to the precise mechanism described. If the claim be construed to bear the latter meaning, and if in fact the attainment of the result be a novel achievement the claim will then cover mechanical equivalents for the mechanism described. But whether the attainment of the result be novel or old in fact, if the claim be construed as limited to the precise mechanism shown, the patentee must abide by the result of his limitation.

Improvement does not

If a man has taken the pith of an invention, the fact that he

(*l*) See also Cotton, L.J., in *Ehrlich* v. *Ihlee*, 5 R. P. C. at p. 453; Lindley, L.J., in *Automatic Weighing Machine Co.* v. *National Exhibitions Association*, 9 R. P. C. at p. 44; Parker, J., in *Marconi* v. *British Radio Telegraph Co.*, 28 R. P. C. at p. 217; and see *Moore* v. *Thomson*, 7 R. P. C. 325.

has improved upon it is immaterial; he has nevertheless infringed (*m*). It is a very common delusion of infringers that because the infringing article presents advantages over the patented article and is perhaps itself the subject of a patent taken out by the infringer that this fact negatives infringement. The fact that the infringer has a patent is entirely immaterial to the question as to whether the article made or the process used embodies the invention claimed by the plaintiff. **negative infringement.**

The principles that underlie the question of infringement, by taking a part only of the invention, were very fully and clearly considered by Mr. Justice Wills in *The Incandescent Gas Light Co.* v. *The De Mare Incandescent Gas Light System* (13 R. P. C. at p. 330). In his judgment the learned judge deals with the means by which the relative importance of different parts of the invention is to be ascertained, and consequently in what part the substance lies, as follows:—"In dealing with the question of construction, I have carefully avoided any reference to the relative importance of different parts of the invention. In dealing with the question of infringement, it is impossible not to consider them. Infringement is a question of fact for the jury, if there be one; and the question is not whether the substantial part of the process, said to be an infringement, has been taken from the specification; but the very different one, whether what is done, or proposed to be done, takes from the patentee the substance of his invention. What the thing invented is must be gathered from the specification alone, and the patentee cannot escape from the thing he has claimed as the standard, and the only standard with which to compare the alleged infringement, so as to see if it constitutes substantially the appropriation of the thing claimed. When, however, you come to make that comparison, how can you escape from considering the relative magnitude and value of the things taken and of those left or varied? It is seldom that the infringer does the thing, the whole thing, and nothing **Infringement by taking part only.** **Relative importance of parts.**

(*m*) *Neilson* v. *Harford*, 1 W. P. C. at p. 310; *United Telephone Co.* v. *Harrison*, 21 C. D. at p. 740; *Ehrlich* v. *Ihlee*, 5 R. P. C. at p. 454; *Wenham Gas Co.* v. *Champion Gas Co.*, 9 R. P. C. at p. 55; *Pilkington* v. *Massey*, 21 R. P. C. at p. 437.

but the thing claimed by the specification. He always varies, adds, omits; and the only protection the patentee has in such a case lies, as has often been pointed out by every Court, from the House of Lords downwards, in the good sense of the tribunal which has to decide whether the substance of the invention has been pirated. It is contended by the defendants that what is important, and what is of subsidiary consequence, can only be gathered from the specification itself. I am satisfied that that neither is nor can be the law. . . . There are no means of ascertaining whether, notwithstanding additions or subtractions, the invention has been taken, except by seeing what they are worth as compared with the things which have been taken bodily from the invention." The earlier authorities of *Clark* v. *Adie* and *Proctor* v. *Bennis* were then analysed in detail (*n*).

The question of relative importance, therefore, remains one of fact to be decided on evidence. But in saying that the relative importance of parts of the invention is to be ascertained as a question of fact and by means outside a direct reference to the specification, the learned judge was clearly referring to cases in which the patentee has not given any indication of what he considers essential. Where, however, the patentee has expressly claimed some specific means of accomplishing an object, he will be tied down to that means, for it must be remembered that what is protected is what is claimed, and not all that is described.

Infringement is of specified claim only.

Lord Justice Romer said, in *Nobel's Explosives Co.* v. *Anderson* (11 R. P. C. at p. 128): "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 thespecification." In *Bunge* v. *Higginbotham*, Kekewich, J., said (18 R. P. C. at

(*n*) See also Lord Davey in *Consolidated Car Heating Co.* v. *Came*, 20 R. P. C. at p. 765; and Parker, J., in *Osram Lamp Works, Ltd.* v. "*Z*" *Electric Lamp Co.*, 29 R. P. C. at p. 424.

p. 206; and see 19 R. P. C. at p. 199), on this point of the substance of the combination: "But in order to ascertain whether any part of the combination, which is absent in the alleged infringement, can be dispensed with so as still to hold the latter to be an infringement, one must go back to the specification, and one must hear what the patentee himself has said about it. . . . You must find whether he considers the one part which has not been taken, to be an integral part of his invention, or perhaps it would be better to say an essential part of his invention."

Lord Alverstone, L.C.J., in *The Presto Gear Case and Components Co.* v. *Orme, Evans & Co.* (18 R. P. C. at p. 23), said: "In patent cases I have always felt that there is a line of thought which is most likely to lead you to the right result in the speediest way. The first thing, assuming you understand the alphabet of the science or art, is to clearly understand what was the previous state of knowledge. Having got, either by agreement or deduction from the evidence, a clear view as to what was the previous state of knowledge, you must then construe the specification with reference to that, disregarding issues of novelty or subject-matter which may arise in the particular case, and you then have to consider whether or not the infringement comes within the fair meaning of the claims—not anything else, but the claims read in the light of the previous state of knowledge, and without altering the words unduly in favour of the patentee or infringer."

How to approach infringement.

The cases in which a claim for a combination is alleged to be infringed do not differ in general principles from any other kind of infringement. But they are liable to give rise to difficulty under either of the following circumstances:—(a) A part only of the combination may be taken; or (b) A mechanical or chemical equivalent may be substituted for a portion of the combination.

Combinations how infringed.

In *Clark* v. *Adie* (10 Ch. at p. 675) Lord Justice James said: "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." And when the same case reached the House of Lords (2 A. C. 320), Lord Cairns, L.C., said: "One mode of infringement would be a very simple and clear one; the infringer would take the whole instrument from beginning to end. . . . About an infringement of that kind no question could arise. The second mode would be one which might occasion more difficulty. The infringer might not take the whole of the instrument here described, but he might take a certain number of parts of the instrument described; he might make an instrument which in many respects would resemble the patent instrument, but would not resemble it in all its parts. And there the question would be, either for a jury or for any tribunal which was judging of the facts of the case, whether that which was done by the alleged infringer amounted to a colourable departure from the instrument patented, and whether in what he had done he had not really taken and adopted the substance of the instrument patented. And it might well be, that if the instrument patented consisted of twelve different steps, producing in the result the improved clipper, an infringer who took eight or nine or ten of those steps might be held by the tribunal, judging of the patent to have taken in substance the pith and marrow of the invention, although there were one, two, three, four, or five steps which he might not actually have taken and represented upon his machine."

Lord Blackburn said (at p. 335): "I incline to agree with what was said in the Exchequer Chamber in the case of *Lister* v. *Leather* (8 E. & B. 1004; 27 L. J. Q. B. 296), 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*, 12 W. R. 723), 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 which A, B, and C are, and what is their relation to each other."

Combination does not protect integers.

A patent for a combination is not infringed by taking separately the integers which are comprised in that combination. For some considerable time it was thought that the judgment in *Lister* v. *Leather* (8 E. & B. 1004) established the contrary proposition, but, as was pointed out by Fletcher Moulton, L.J., in his elaborate review of the authorities in *The British United Shoe Machinery Co., Ltd.* v. *A. Fussell & Sons, Ltd.* (25 R. P. C. at p. 653), the law on this point was not correctly stated in that case. It was made clear by Lord Cairns in *Clark* v. *Adie* (L. R. 2 A. C. at p. 321): "Suppose, my lords, that in a patent you have a patentee claiming protection for an invention consisting of parts which I will designate as A, B, C, and D; he may at the same time claim that as to one of those parts, D, it is itself a new thing, and that as to another of those parts, C, it is itself a combination of things which possibly were old in themselves, but which, put together and used as he puts them together and uses them, produce a result so new that he is entitled to protection for it as a new invention. In a patent of that kind the monopoly would or might be held to be granted, not only to the whole and complete thing described, but to those subordinate integers entering into the whole which I have described. But then, my lords, the invention must be described in that way; it must be made plain to ordinary apprehension, upon the ordinary rules of construction, that the patentee has had in his mind, and has intended to claim, protection for those subordinate integers; and moreover he is, as was said by the Lords Justices, at the peril of justifying those

subordinate integers as themselves matters which ought properly to form the subject of a patent of invention."

Substitution of equivalents.

There is a description of imitation which is produced by the substitution of chemical or mechanical equivalents for the specific integers which the patentee has claimed in combination. 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. A great deal of confusion has been caused by misunderstanding the term "mechanical equivalent." The use of a mechanical equivalent for that which the plaintiff has invented, which at the time of the act complained of is known as an equivalent, is always an infringement. It is not true to say that "the doctrine of mechanical equivalents does not apply in the *Curtis* v. *Platt* type of cases." A patent which did not cover all known mechanical equivalents would be void for want of invention. The narrowest claim for a particular means of attaining an old ultimate result may be infringed by the use of a mechanical or chemical equivalent, *i.e.*, an obvious method of carrying out the same invention, a method which a skilled mechanic or chemist, having once seen the original invention, could at once suggest and apply without the necessity for any inventive power whatever. The confusion has arisen partly because the expression "new result" has been loosely applied, sometimes to mean the ultimate result, and sometimes to mean the new effect immediately produced by the invention. In this latter sense all inventions must produce a new result, or they would fail for want of utility. Things may be mechanical equivalents for many purposes, and yet not for the purpose immediately at hand. A fire-tongs is in many aspects the mechanical equivalent of a dental forceps, but not for the purpose of extracting teeth. Sulphuric acid is a chemical equivalent for nitric acid as far as the reddening of litmus is concerned, but is far from an equivalent in the manufacture of explosives. Equivalents may be substituted for parts as well as for the whole invention, so that it may happen that a patent may be taken out for a combination of three parts, and 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.

Some difference is to be observed between the treatment accorded by the Courts to chemical cases and mechanical cases respectively. In the case of an invention which consists of a chemical process the state of human knowledge makes it exceedingly difficult to predict what will happen if an ingredient or a step in the process is changed, and accordingly patentees are constrained in the majority of cases to claiming the precise combination of steps described. Occasionally, however, it may happen that the patentee may grasp the broad principle involved and make a broad claim in which the steps are described in generic terms, and in such a case the substitution of equivalent steps for the specific ones detailed in the example given may nevertheless fall within the terms of the claim and constitute an infringement. In such a case, of course, the patentee runs the risk that his generic terms may include an unworkable example, in which case his patent will be invalid (*o*).

Take, for instance, the case of *Stevens* v. *Keating* (2 W. P. C. 181). 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 effect was this: A salt, 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 specification terminated thus: "And whereas other alkalis and acids, besides those hereinbefore mentioned, will answer the purposes of my said invention, though none that I have tried have answered so well as the alkali and acid hereinbefore set forth, and whereas I claim as my invention the processes of mixing the powdered materials, alkalis, and acids, as hereinbefore described, and subsequently burning, heating or calcining the same, for the purposes hereinbefore set forth." The principle of this discovery

(*o*) See p. 96, ante.

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 pearl-ash and sulphuric acid a salt which is 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, but inasmuch as considerable experiment was necessary in order to find out what examples of acids and alkalis could usefully be employed, the patent was held to be invalid.

On the other hand, if the claim be restricted to the specific example shown, then on account of the difficulty with which the result of the substitution of another ingredient can be foreseen, or in other words, the fact that in most cases it was not known at the date of the patent whether the defendant's substituted ingredient or step was in fact an equivalent for what the patentees claimed, has in many cases been held to prevent the substitution from being considered an infringement.

In *Unwin* v. *Heath* (2 W. P. C. 228-295; 5 H. L. C. 505) the patentee said in his specification: "I propose to make an improved quality of cast steel, by introducing into a crucible bars of common blistered steel, broken, as usual, into fragments, or mixtures of cast or malleable iron, or malleable iron and carbonaceous matters, *along with from one to three per cent. of their weight of carburet of manganese*, and exposing the crucible to the proper heat for melting the materials, which are, when fluid, to be poured into an ingot mould in the usual manner; but I do not claim the use of any such mixture of cast and malleable iron, or malleable iron and carbonaceous matter, as any part of my invention, *but only the use of carburet of manganese in any process for the conversion of iron into cast steel.*" In another part of the specification he said: "I claim the employment of *carburet of manganese* in preparing an improved cast steel." At the date of the patent carburet of manganese was well known and very expensive. The defendant heated broken iron with coal tar and oxide of manganese—an inexpensive process. The evidence of the plaintiff was to the effect that carburet of manganese was actually formed in the

defendant's melting pot at the moment of fusion. The House of Lords after taking the opinions of the judges, decided that there had been no infringement. Lord Cranworth, L.C., said (2 W. P. C. at p. 319): "There is no evidence whatever tending to prove that, at the date of the patent, it was known to persons acquainted with the subject of manufacturing cast steel, that coal tar and oxide of manganese would be chemical equivalents for the carburet of manganese claimed by the plaintiff. Indeed, it is obvious that the discovery of such equivalents was made after the use of the carburet, as a distinct metallic substance had been some short time in operation. It was itself a most valuable discovery, and would legitimately have formed the subject of a new patent. . . . On the short ground, therefore, that the invention claimed is for the use of a particular metallic substance, namely, carburet of manganese, in certain definite proportions according to the weight of the steel under fusion, and that no such substance, nor any equivalent for it, known to be such at the date of the specification, was used by the defendant, I think that there was no evidence of infringement." . . . This method of reasoning was followed by Moulton, L.J., in *Vidal Dyes Syndicate* v. *Levinstein, Ltd.* (29 R. P. C. at pp. 275–277). Parker, J., however, in *Marconi* v. *British Radio Telegraph Co.* (28 R. P. C. at p. 217), a case concerning electrical inventions which may be considered in much the same light as chemical inventions, preferred to base his decision, in which he held infringement, upon the proposition of law that infringement is a matter depending on the construction of the claim alone, and that the question of whether equivalents were known to be such or not, at the date of the patent was immaterial, or at any rate inconclusive. The reasoning of Lord Parker was followed in the House of Lords by Lord Wrenbury in *Fellows* v. *Lench* (34 R. P. C. at p. 61), and it is submitted, is supported by the reasoning of Lord Brougham in *Unwin* v. *Heath* (5 H. L. C. at p. 550). "I come at once to the case which is chiefly relied upon, namely, *Stevens* v. *Keating*, which came before Lord Cottenham, and in which, the patent being for making cement by uniting gypsum with an acid and an alkali, the defendant made cement (which was the

alleged infringement) by uniting gypsum with borax, and it being discovered that borax was composed of an acid and an alkali, Lord Cottenham held that uniting gypsum with borax was uniting gypsum with an acid and an alkali; and that consequently there was an infringement of the patent, which was granted for gypsum united with an acid and an alkali. . . . But I very much question whether the judgment would have been in the affirmative upon the question of infringement or no infringement, if, instead of the patent having been for uniting gypsum with an acid and an alkali, the patent had been for making cement by uniting gypsum with borax; and it being found that borax was compounded of an acid and an alkali, it then had been contended that any compounding of an acid and an alkali was an infringement of the patent, inasmuch as the materials of borax being an acid and an alkali, and the patent being for continuing an acid and an alkali with gypsum to make cement, therefore there was an infringement. In my opinion, the proposition affirmed by Lord Cottenham in this decision would not at all lead by any necessity whatever to giving a similar decision upon the converse, where the case was such as I have just supposed."

In *Nobel's Explosives Co.* v. *Anderson* (11 R. P. C. 115, 519; 12 R. P. C. 164), the object of the invention was the production of an explosive suitable for propelling projectiles, in the use of which explosive perfect combustion might be obtained. The patentee in his specification confined his claim to 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, any one 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 and the House of Lords, 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 mechanical cases the state of human knowledge permits of the behaviour of a substituted element being foretold with considerable accuracy, and it is harder to escape infringement. The difference between the two classes of cases was pointed out by Sir F. Pollock, C.B., in the case (cited above) of *Stevens* v. *Keating* (2 W. P. C. at pp. 188, 189): "I may say that I do not quite go along with the doctrine of equivalents in chemistry, applied in the same way as in mechanics and those matters to which you can apply the principles of the exact sciences. . . . In the mechanical sciences, or wherever you can apply the exact sciences, you can frequently predict the results without the slightest difficulty, and with the same certainty as that with which a skilful arithmetician can tell you what will be the amount of certain numbers added together, and that a certain other set of numbers apparently differing from them altogether will, when added together, produce the same result. With precisely the same certainty a skilful mechanic will tell you that such and such a combination will produce a result, and that such and such another combination, to the ordinary eye apparently totally different, will produce precisely the same result . . . so that however different they may appear to the eye, they are to the mind precisely the same. I do not think that doctrine applies altogether to the case of chemistry, for although you can predict with confidence in mechanics in some instances, and in some cases where mathematics can be applied, in chemistry you almost entirely fail. You cannot—because sulphuric acid will succeed—tell at all that nitric acid will succeed, or that any other acid will succeed until you have tried. They do not exist in any relation to each other as numbers do, or as mechanical science presents to you the different mechanical powers. You cannot anticipate the result; it is a mere question of result upon experiment" (*p*).

Nevertheless, it may sometimes occur even in a mechanical case that the operation involved is of such an obscure character that the behaviour of substituted elements could not be

(*p*) See also Moulton, L.J., in *Vidal Dyes Syndicate* v. *Levinstein, Ltd.*, 29 R. P. C. at pp. 275–277. The reasoning can also in some degree be applied to the question of Subject-matter (see p. 49, ante).

foretold with any degree of certainty, and they cannot in such circumstances be regarded as equivalents (*q*).

As an instance of an infringement involving the use of a mechanical equivalent we may cite *Russell* v. *Cowley* (1 W. P. C., see p. 462), in which the invention claimed was the bringing to a welding heat of 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 as a fact, that the two rollers with grooves were a mere mechanical equivalent for the hole through which the iron was passed according to the plaintiff's invention, and that the patent had been infringed (*r*).

Patenting or granting of licence is not infringing.

Taking out a patent for a process or machine that infringes a prior patent does not amount to infringement (*s*), nor does the granting of a licence to manufacture under a subsequent patent amount to infringement (*t*); 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.

Infringement by agents and servants.

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. In *Sykes* v. *Howarth* (L. R. 12 Ch. D. 826) the invention consisted in 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

(*q*) See, *e.g.*, *Fellows* v. *Lench*, 34 R. P. C., per Lord Wrenbury, at p. 60.

(*r*) See also *Benno Jaffé Fabrik* v. *Richardson*, 11 R. P. C. at p. 270.

(*s*) *Tweedale* v. *Ashworth*, 7 R. P. C. at p. 431.

(*t*) *Montgomerie* v. *Paterson*, 11 R. P. C. 221.

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."

But actions against mere workmen who innocently help in an infringement, and are not the really guilty persons, will not be encouraged (*u*).

Express instructions as of patentee.

Express instructions given by the patentee or on his behalf will negative infringement, if the instructions are specific directions to do that which is claimed in the specification, such directions amounting in effect to a licence.

In *Kelly* v. *Batchelar* (10 R. P. C. 289) 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 (*v*).

In *The Dunlop Pneumatic Tyre Co.* v. *Neal* (16 R. P. C. 247), the agent of the plaintiffs was sent to the defendant to

(*u*) See *Savage* v. *Brindle*, 13 R. P. C. at p. 267.

(*v*) See also *Henser* v. *Hardie*, 11 R. P. C. 421.

ask him to repair an old tyre, the subject of the plaintiffs' patent, with a view to ascertaining whether the defendant was infringing the patent by purporting merely to repair tyres. The agent gave no express instructions as to what was to be done to the worn tyres beyond saying that they were to be repaired. It was held that what was done by the defendant amounted to infringement, and that in such a case he could not shelter himself behind the instructions of the plaintiffs' agent.

Making and selling elements of combination.

Where the patent is for a combination there is no infringement in making or selling the separate elements of the combination, even though the manufacturer or vendor knows perfectly well that the separate elements are destined eventually to be combined so as to constitute an infringement.

In *The Dunlop Pneumatic Tyre Co.* v. *Moseley* (1 Ch. 177; 21 R. P. C. 274) the patent was for a pneumatic tyre cover, held on to the rim of the wheel by wires passed through circumferential pockets in the edges of the cover. The defendants made and sold covers only, fitted with pockets, but without wires, and advertised them as "ready for wires." There was no other evidence to connect the defendants with the persons who purchased the covers and fitted the wires. It was held, following *Townsend* v. *Haworth* (L. R. 12 Ch. D. 831, n.), and after an elaborate review of the authorities, that this did not constitute infringement.

But where the circumstances were such as to indicate very clearly that the person selling an element which did not infringe was practically in partnership with another person who completed the infringement, and the real object of his business was to aid in the infringement, an injunction was granted (*w*). And making and selling all the constituent parts of a machine so that they could easily be put together would probably amount to evidence of infringement (*x*).

Aiding and abetting infringement.

In *Innes* v. *Short* (15 R. P. C. 450) the plaintiff's patent was

(*w*) *The Incandescent Gas Light Co.* v. *New Incandescent Mantle Co.*, 15 R. P. C. 81.

(*x*) *United Telephone Co.* v. *Dale*, L. R. 25 Ch. D. at p. 782; *Dunlop Pneumatic Tyre Co.* v. *Mosely*, 21 R. P. C. at p. 280.

for the use of powdered zinc in boilers to prevent incrustation. The defendant sold bags of powdered zinc with directions for the use of the powder in boilers. Bigham, J., granted an injunction to restrain the sale *in this manner*, and said: "There is no reason whatever why Mr. Short should not sell powdered zinc, and he will not be in the wrong, though he may know or expect that the people who buy it from him are going to use it in such a way as will amount to an infringement of Mr. Innes' patent rights. But he must not ask the people to use it in that way in order to induce them to buy his powdered zinc from him." It is submitted that this decision was erroneous. There cannot be a claim for "an old substance for a new purpose," for a purpose is not a manufacture—properly drafted the claim should be for the "new use of an old substance"—and this is not infringed unless the old substance is actually put to that new use (*y*). Moreover, there is no such tort as "aiding and abetting" infringement (*z*).

Infringement by repairing.

The points above considered are of material importance when it is alleged that the patent has been infringed by what amounts to the manufacture of a new article under the guise of repairing an old article which has been made under the patent. The tests by which such cases may be decided were enunciated by Kekewich, J., in *The Dunlop Pneumatic Tyre Co.* v. *The Holborn Tyre Co.* (13 R. P. C. 226): "There are two tests which might equally well be applied to this question on the evidence. The first test would be this: In the alleged repair, has the workman so employed the patent as that in doing it he has taken an essential part of the patent and infringed it? . . . But there is another test which, but for the existence of the patent, one would employ, and which I think is the real and most satisfactory test to employ now, and that is this: Is it substantially, in common parlance, honestly, a new article, or is it an old article repaired?" (*a*).

(*y*) See Parker, J., in *Adhesive Dry Mounting Co.* v. *Trapp*, 27 R. P. C. at p. 353, disapproving *Innes* v. *Short*.

(*z*) See Lindley, L.J., in *Badische Anilin und Soda Fabrik* v. *Johnson & Co.*, 14 R. P. C. at p. 413; and Fry, J., in *Sykes* v. *Howarth*, L. R. 12 Ch. D. at p. 833.

(*a*) See also *Dunlop Pneumatic*

In *The United Telephone Co.* v. *Nelson* (1887, W. N. 192) it was held that the restoration of a broken instrument which had originally been licensed under the patent was an infringement. But the case is not fully reported. It appears to be a question of fact whether an instrument is broken to such an extent as to destroy its identity so as to enable the patentee to say that the repair by its owner amounts in fact to the manufacture of a new article. In *The Sirdar Rubber Co., Ltd.* v. *Wallington, Weston & Co.* (24 R. P. C. at p. 543) Lord Halsbury said: "The principle is quite clear, although its application is sometimes difficult; you may prolong the life of a licensed article but you must not make a new one under cover of repair."

Experiments. 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* (1 W. P. C. at p. 125) Patteson, J., 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* (9 C. D. at p. 66) 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 a 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

Tyre Co., Ltd. v. *Neal*, 16 R. P. C. 247; *Dunlop Pneumatic Tyre Co., Ltd.* v. *Excelsior Tyre Co.*, 18 R. P. C. 209.

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" (*b*).

Use to instruct pupils.

To purchase and use 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 (*c*).

The grant confers the sole right to "make, use, exercise, and vend" the invention, and by the words of the prohibition the subject is commanded to refrain from "making use of or putting into practice" the said invention. There are a number of cases which have been decided upon the meaning of these words, and they are principally concerned with instances where the defendant has certainly derived advantage from the invention, and yet it would be difficult to say that he had been guilty of making or vending.

Sale of article made by patented process.

In the case of a patent for a process the sale, in this country, of goods manufactured by that process is an infringement of the process, even though the manufacture took place abroad. In *Wright* v. *Hitchcock* (L. R. 5 Ex. at p. 47) Kelly, C.B., said: "If the law were otherwise, then when a man has patented an invention, another might, by merely crossing the Channel, and manufacturing abroad and selling in London for far less than the original price, but also at a trifle less than the price charged by the patentee, articles made by the patented process, wholly deprive the patentee of the benefit of his invention. It is therefore impossible to suppose that an exclusive right to vend is not given, and the defendants have therefore infringed the plaintiff's right, and it is immaterial whether it was or was not known to them that Orr's machine was identical with the plaintiff's" (*d*).

(*b*) See also *Muntz* v. *Foster*, 2 W. P. C. at p. 101; *Proctor* v. *Bayley*, 6 R. P. C. 106; *Pessers and Others, Ltd.* v. *Newell*, 31 R. P. C. 510.

(*c*) *United Telephone Co.* v. *Sharples*, L. R. 29 Ch. D. 164; 2 R. P. C. 28.

(*d*) See also *Elmslie* v. *Boursier*,

Onus of proof in such cases.

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 (*c*).

In the various *Saccharin Cases* (*c*), the plaintiffs were the owners of patents which covered all known processes of making saccharin. They were able to produce evidence to the effect that although it was conceivable that saccharin might be made in some other way, no other processes were then known to the scientific world. The defendants, who imported saccharin, could never give any satisfactory account of the way in which the imported substance was actually made. It was held that infringement had been made out.

The onus of proof in cases of this character is now shifted on to the shoulders of the defendant by sect. 11 of the Act of 1919, which at the end of the new sect. 38A introduced into the principal Act provides as follows: "*Provided that, in an action for infringement of a patent where the invention relates to the production of a new substance, any substance of the same chemical composition and constitution shall in the absence of proof to the contrary be deemed to have been produced by the patented process.*" The process for the production of the new substance may be chemical or mechanical, and the test of the applicability of the section is whether the substance produced has or has not new characteristics. A new substance may be identical in chemical composition with an old substance but may differ from it in physical constitution.

In *The Cartsburn Sugar Refining Co.* v. *Sharp* (1 R. P. C. 181) the alleged infringement consisted in the sale in England

L. R. 9 Eq. 217; *Von Heyden* v. *Neustadt*, 14 C. D. 230; *Neilson* v. *Betts*, L. R. 5 H. L. at p. 11.

(*c*) *Saccharin Corporation* v. *Dawson*, 19 R. P. C. 169; *Saccharin Corporation* v. *Jackson*, 20 R. P. C. 611; *Saccharin Corporation* v. *Mack*, 23 R. P. C. 611; *Saccharin Corporation* v. *National Saccharin Co.*, 26 R. P. C. 654.

of cube sugar manufactured in America by a machine made in accordance with the specification of the plaintiff's patent. Lord Kinnear, in his judgment, said (at p. 186): "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."

In *Gibson and Campbell* v. *Brand* (4 M. & G. 196; 1 W. P. C. 631) 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. Sir N. C. Tindal, C.J., said: "This is quite sufficient to satisfy an allegation that he made those articles, for he that causes or procures to be made, may well be said to have made them himself."

Contracts for delivery in United Kingdom and abroad.

The delivery, however, must take place in this country to constitute an infringement. In *The Badische Anilin und Soda Fabrik* v. *The Basle Chemical Works* (1898, A. C. 200; 14 R. P. C. 919), a trader in England ordered goods from the defendant in Switzerland to be sent by post to England. The

defendant addressed the goods to the trader in England, and delivered them to the Swiss Post Office, by whom they were forwarded to England. The goods were manufactured according to an invention protected by the plaintiffs' patent. It was held by the House of Lords that, since the contract of sale was completed by the delivery to the Post Office in Switzerland, and since the Post Office was the agent of the buyer and not of the vendor, the vendor had not made, used, exercised, or vended the invention within the ambit of the patent, and that the patentee had no right of action against the vendor for an infringement of the patent.

In *The Saccharin Corporation* v. *Reitmeyer & Co.* (1900, 2 Ch. 659; 17 R. P. C. 606) the facts were as follows: The defendant, while in England, contracted with persons in England for the delivery to them at a *foreign* port of goods manufactured on the Continent by a process similar to that protected by the plaintiff's English patent. Cozens-Hardy, J., said: "Now it is plain that a patent is of local force . . . it is admitted that the defendant has not 'made' or 'used,' and I think it is clear that he has not 'vended' within the jurisdiction (see *Badische Anilin Co.* v. *Basle Chemical Works*, supra). It is said, however, that he has 'exercised' the invention within the jurisdiction. It is remarkable that this word, which has been found in letters patent at least since 1621, so far as I am aware, has never been construed. I think, however, that it can only mean 'put in practice.' I do not think it can be taken to cover a transaction such as I have to deal with. The defendant, as a commission agent, contracted for delivery to the purchasers at a German port. He had no interest whatever in the case when delivered at the foreign port to the purchasers. He had no right to control its destination. I assume that he knew or suspected that the greater part of the stuff would find its way into this country, but I cannot regard that as material."

The House of Lords in *The Badische Anilin und Soda Fabrik* v. *Hickson* (1906, A. C. 419; 23 R. P. C. 433) approved of this decision. Counsel for the plaintiff in this case relied on the argument that inasmuch as the vendor had not set aside the

goods in the foreign country, the property in them had passed, and there was a completed sale. Lord Loreburn said that although there was appropriation to the purchaser and a completed sale, the operation of completing the sale had not taken place in this country, and consequently there had been no infringement; he stated further that he agreed with Lord Davey, who said "the exclusive right of 'vending the invention' must be construed consistently with the language of the Statute of Monopolies, and with regard to the general purpose of the patent to give the inventor the full benefit of his invention in this country. . . . A contract to deliver the goods abroad does not in any way interfere with the patentee's rights to work and utilise his invention in this country. . . . Nor is it material to consider whether or when the property in the goods passed to the purchaser. It is lawful to be the owner of the goods if made and situate abroad, and neither the vendor nor the purchaser in my opinion thereby infringes the patent. The goods may or may not be afterwards brought into this country, and a different question will then arise, but that is no concern of the vendor after he has parted with them. I am of opinion that 'vending the invention' in the common form of patent is confined to selling goods made or brought into this country, and that the respondent in this case has not, directly or indirectly, made, used, or put in practice the appellant's invention within the meaning of the prohibition contained in the patent." Lord Atkinson's judgment is to the same effect. To export under a contract of sale, whether such contract was made here or abroad, is an infringement. In *The British Motor Syndicate* v. *Taylor* (17 R. P. C. 189, 723) the defendants bought in England twenty-seven infringing articles; they sold seven of them and used another in England. As regards the remaining nineteen, they sent them abroad to their French house in Paris, where they sold them to various foreign firms. The question was whether there had been an infringement in respect of these nineteen. Stirling, J., decided that this was "making use of" the invention, and *that the words "make use of" have a wider significance than the words "put in practice."* The learned judge said: "In the present

Sending abroad.

case the patented articles, when being transported from place to place in this country, were not serving the purpose for which they were patented, and in my opinion the defendants did not, during that transporting, exercise or put in practice the patented invention. What the defendants did was to carry these articles out of the kingdom with a view to selling them; that is, with the object of turning them to profitable account" (*f*).

Purchase, transport, and possession.

Mere purchase, possession, or transport does not amount to infringement, unless it involves a user of the invention, although it may justify an injunction on the ground that it is strong evidence of a threat to use (*g*).

In the case of *Neilson* v. *Betts* (L. R. 5 H. L. 1), 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. Neilson 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 (L. R. 3 Ch. at

(*f*) See also *United Telephone Co.* v. *Sharples*, L. R. 29 C. D. 164; 2 R. P. C. 28.

(*g*) *Adair* v. *Young*, 12 C. D. 13; *Pessers and Others* v. *Newell & Co.*, 31 R. P. C. 510 (disapproving *United Telephone Co.* v. *London and Globe Telephone Co.*, L. R. 26 C. D. 766; *British Motor Syndicate* v. *John Taylor and Sons*, 1 Ch. 122; 17 R. P. C. 723; *British United Shoe Machinery Co.* v. *Simon Collier, Ltd.*, 26 R. P. C. at pp. 41, 538, and 27 R. P. C. 567.

p. 439): "It is the employment of the machine or article for the purpose for which it was 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" (*h*).

Possession accompanied by exposure for sale is an infringement, as it is a user for one of the purposes for which it was intended that the patentee alone should use it during the fourteen years (*i*). **Exposure for sale.**

In the case of *Adair* v. *Young* (12 C. D. 13), 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.

By sect. 48 of the Act of 1907, corresponding to sect. 43 of the Act of 1883,

(1) "*A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of His Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.*

(*h*) See also *Nobel's Explosives Co.* v. *Jones, Scott & Co.*, 17 C. D. 721; *The Universities of Oxford and Cambridge* v. *Richardson*, 6 Ves. 689; *The Dunlop Pneumatic Tyre Co.* v. *British and Colonial Motor Car Co.*, 18 R. P. C. 313.

(*i*) Alverstone, L.C.J., in *British Motor Syndicate, Ltd.* v. *John Taylor and Sons, Ltd.*, 17 R. P. C. at p. 729.

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

A patent is not infringed by the use of the invention on board an English vessel abroad (*j*).

Custom House agents.

In the case of *Nobel's Explosives Co.* v. *Jones and Scott* (L. R. 17 C. D. 721) the Court of Appeal reversed the decision of Vice-Chancellor Bacon, on the grounds that the defendants had not infringed the plaintiffs' 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.

Carriers.

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 (*k*).

Lending.

Lending is not selling and is not an infringement (*l*).

Effect of sale by patentee.

A patentee by himself or by his agent selling the patented article without limitation sells with it the right of free disposition as to that article, and if he sells the article abroad, the purchaser may import and sell it in England. Lord Hatherley, in *Betts* v. *Willmott* (L. R. 6 Ch. at p. 245), said: "Unless it can be shown, not that there is some clear injunction to his agents, but that there is some clear communication to the party to whom the article is sold, I apprehend that 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

(*j*) *Newall* v. *Elliot*, 10 Jur. N.S. 954.

(*k*) *Washburn and Moen Manufacturing Co.* v. *Cunard Steamship Co.*, 6 R. P. C. at p. 403; see also *Upmann* v. *Elkan*, L. R. 7 Ch. 130.

(*l*) *United Telephone Co.* v. *Henry*, 2 R. P. C. 11; Griff. P. C. 228.

licenso to soll tho articlo, or to use it wherever ho pleasos *as against himsclf*."

Where tho defendants, being owners of patents in Belgium and England for an invention for making glass lamp globes, by a deed oxocutod in Belgium, grantod a licence to tho plaintiffs to manufacturo undor their invention in Belgium but not elsowhoro, and tho plaintiffs under this liconco manufacturod articlos in Belgium and sold them in England, it was held by tho Court of Appeal, affirming Pearson, J., that tho grant of tho licouco to uso tho patent in Belgium did not imply permission to sell the manufactured article in England in violation of tho defendants' English patent (*m*).

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 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 (*n*).

Limited licence.

The question of infringement by the breach of a limited licence will be dealt with in Chap. XI.

No warranty under sale of Goods Act.

In *Monforts* v. *Marsden* (12 R. P. C. 266) it was decided that the sale of an article does not imply any warranty within sect. 12 of the Sale of Goods Act, 1893, that the article sold is not an infringement of an existing patent, and in that case it was not contended that there was any implied warranty apart from the section.

It will be remembered that prior to the Act of 1883 letters patent did not operate as against the Crown; questions

(*m*) *Société Anonyme des Manufactures de Glaces* v. *Tilghman's Patent Sand Blast Co.*, L. R. 25 Ch. D. 1.

(*n*) *Betts* v. *Willmott*, L. R. 6 Ch. 239.

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 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 (*o*).

Sect. 27 of the Act of 1883 (re-enacted as sect. 29 of the Act of 1907 and amended by the Act of 1919) provided that a patent should bind the Crown, but that the Crown might use the invention "by agents or *contractors*" on terms to be before or after the use agreed upon (see Chap. XVII.).

(*o*) *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.

CHAPTER VIII.

APPLICATION FOR LETTERS PATENT AND RESTORATION.

By sect. 1, sub-sect. 2, of the Act of 1907 "*The application must be made in the prescribed form, and must be left at, or sent by post to the Patent Office in the prescribed manner.*"

The practice is regulated by the Patents Rules, 1919, which came into force on April 1st, 1920. The Patent Office publishes a very complete and practical set of "Instructions to Applicants for Patents."

The rules provide forms applicable to all circumstances. Form 1 is for the use of an "inventor" in the ordinary sense of the word or for joint applicants, one of whom must be the inventor. It would also appear (see p. 16, ante) that when an invention is partly original and partly communicated from abroad Form 1 may be used, and in any case the patent will not be invalid if this course is taken, as the applicant in such circumstances is the "true and first inventor" in law. In the case of a corporation alone, however, Form 1 will not be acceptable for the reason that a corporation cannot be said to invent in the ordinary sense (*a*).

In the case of an application in respect of a "communication from abroad," the applicant must be resident in the United Kingdom (*b*), and a corporation may apply in this way.

Under sect. 91, which gives effect to the International and Colonial arrangements, a person, or the legal representative or assignee of a person who has made application for protection in a country or British possession which is a party to the International Convention may apply for a patent in this country and have his patent dated as of the date of his first foreign or Colonial application provided that (A) the application is made

(*a*) *Carez's Application*, 6 R. P. C. 552; *Société Anonyme du Générateur du Temple*, 13 R. P. C. 54.

(*b*) See p. 17, ante.

within twelve months of the application for protection in the foreign state, and (B) that the applicant shall not be entitled to recover damages in respect of infringements committed prior to the date when his specification filed on his application in this country is accepted by the Comptroller. Form 1B is used by such an applicant, but if the applicant is the legal representative or assignee of the person who first made application in the foreign state (*c*) he will use Form 1B[x]. The Comptroller has the right to inquire of an applicant under this section who applies on Form 1B whether he has assigned his rights so that the rights of assignees may be protected (*d*). Corporations may also apply under this section.

The election to take the benefit of this procedure must be taken before the expiry of the twelve months from the date of the first foreign application (*e*), and the Comptroller may not give any other date than that of the first foreign application (*f*). Where the application was based on a foreign application which had succeeded after several abortive applications in the foreign country, the British application was given the date of the successful foreign application (*g*). The practice is regulated by rules 15–18, which prescribe the documents to be left with such applications. If the specification filed on an application under sect. 91 is not accepted within twelve months from the date of the foreign application it becomes open for public inspection (*h*). The subject-matter of the application must be limited to what is protected by the foreign application, and in cases of doubt as to the effect of the foreign patent law the applicant must supply some *primâ facie* evidence as to the extent of the protection acquired in the foreign state (27 R. P. C., Ruling B).

Applications for patents of addition are made according to circumstances on Forms 1C, 1C[x], 1C[xx], or 1C[xxx].

(*c*) See amendment in sect. 91, effected by the Act of 1914.

(*d*) *Eisler's Application*, 34 R.P.C. 69.

(*e*) *Acetylene Illuminating Co.* v. *United Alkali Co.*, 20 R. P. C. 161.

(*f*) *Scott's Application*, 27 R. P. C. 298.

(*g*) *Van der Poele's Patent*, 7 R. P. C. 69.

(*h*) Sect. 91, sub-sect. 3 (a).

Applications for secret patents under sect. 30 (*i*) are made on Form 1D.

The applicant must himself sign the application, and certain other specified formal documents, but for many matters he may employ an agent. Such agent need not be a "patent agent," but he must be an agent duly authorised to the satisfaction of the Comptroller (*j*), and must be resident or have a place of business in the United Kingdom (*k*).

The Comptroller refuses to be satisfied with the authorisation of irresponsible foreigners, who, although resident in this country, are the nominees of foreign patent agents.

In the case of an application by two or more persons, the application must be signed by all those persons.

The case of a dispute between joint applicants in the course of proceedings is provided for by the proviso to sect. 12 (1) of the Act of 1907 which was added by the Act of 1919. It runs as follows:—

"*. . . where—*

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

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

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

The words "*writing to assign a patent when granted*" means only an agreement having reference to a specific application already made at the date of the agreement and signed by the applicant as true and first inventor. This provision remedies a

(*i*) See p. 169, post.
(*j*) See *Graham* v. *Fanta*, 9 R. P. C. 164.
(*k*) See Rule 9.

difficulty which had existed under the old law, and renders proceedings in the Courts unnecessary (*l*).

Deceased inventor.

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, and such an application must contain a declaration by the legal representative that he believes the deceased to have been the true and first inventor (*m*).

Posting documents.

A document may be sent to the Patent Office by post (*n*), and by sect. 26 of the Interpretation Act, 1889, 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. Nevertheless, Sir S. Evans, S.-G., in *Mathews and Strange's Application* (27 R. P. C. 288), decided that if an application were delivered by post at the Patent Office after office hours the patent must be dated as of the following day. (Under rule 12 applications are opened and *numbered* in the order in which the letters containing the same are delivered in the ordinary course of post.) The Solicitors-General's attention does not seem (from the report) to have been directed to the effect of the Interpretation Act.

The declaration.

Sect. 1, sub-sect. 3, enacts: "*The application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application, one at least of the applicants, claims to be the true and first inventor, and for which he desires to obtain a patent, and must be accompanied by either a provisional or complete specification.*

(4) "*The declaration may be either a statutory declaration or not, as may be prescribed.*"

The prescribed form of declaration is incorporated in the form of application in each case, and is not a statutory declaration. 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

When inventor incapable.

(*l*) See, *e.g.*, *A. and B.'s Application*, 28 R. P. C. 454.

(*m*) Sect. 43.

(*n*) Sect. 81.

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 (*o*).

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 Revenue Act, 1884 (*p*).

Reference to examiner.

By sect. 3, sub-sect. 1, "*The Comptroller-General of Patents, Designs and Trade Marks* (*hereinafter referred to as the Comptroller*) *shall refer every application to an examiner.*"

The duty of the examiner is to ascertain that the application and specification have been prepared in accordance with the rules, and whether the invention is contrary to law or morality, and whether it is a "manufacture" within the meaning of the Statute of Monopolies (*q*). In the case of an application under sect. 91 the greatest care will be exercised to see that in preparing his specification, the applicant has not gone farther than the subject-matter on which his foreign application was founded in view of the fact that his patent when granted will be dated as of the date of such foreign application (*r*).

The following points upon the preparation of the specification require special notice:—

One invention only to be described.

One invention only must be described.

Rule 13 commences thus: "(1) When a specification comprises several distinct matters, they shall not be deemed to constitute one invention by reason only that they are all applicable to or may form parts of an existing machine, apparatus or process."

No general rule can be laid down as to what constitutes "one invention," and the Comptroller's discretion will not be interfered with unless he is clearly wrong (*s*). But it may be stated generally that where the attainment of a new object is described several methods of attaining that object may be

(*o*) Sect. 83.
(*p*) 47 & 48 Vict. c. 62, s. 9.
(*q*) See ante, p. 31.
(*r*) See *Austin Motor Co.'s Application*, 30 R. P. C. 319.
(*s*) "*Z.'s*" *Application*, 27 R. P. C. 285.

included in one specification. Sect. 38A (*t*) prohibits bare claims for chemical substances and food products, but claims will be admitted in a single specification for a method or process and also for a machine for carrying out the process, and for the product produced by the claimed method or process.

Rule 13 continues thus: "Where a person making application for a patent has included in his specification more than one invention, the Comptroller may require or allow him to amend such application and specification and drawings, or any of them so as to apply to one invention only, and the applicant may make application for a separate patent for any invention excluded by such amendment.

"Every such last-mentioned application may, if the Comptroller at any time so direct, bear the date of the original application, or such date between the date of the original application and the date of the application in question, as the Comptroller may direct, and shall otherwise be proceeded with as a substantive application in the manner prescribed by the Act, and by these rules.

"Where the Comptroller has required or allowed any application, specifications or drawings to be amended as aforesaid, such application shall, if the Comptroller at any time so direct, bear such date subsequent to the original date of the application and not later than the date when the amendment was made, as the Comptroller shall consider reasonably necessary to give sufficient time for the subsequent procedure relating to such application" (*u*).

By sect. 16 of the Act of 1907, as amended by the Act of 1919, the following provision was introduced into the practice of the Office:—

Provision for cognate inventions.

"*Where the same applicant has put in two or more provisional specifications for inventions which are cognate or modifications one of the other, and has obtained thereby concurrent provisional protection for the same, and the Comptroller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may*

(*t*) Introduced by sect. 11 of the Act of 1919. See p. 35, ante.

(*u*) Paragraph 2 of rule 13 will be dealt with on p. 159.

accept one complete specification in respect of the whole of such applications and grant a single patent thereon.

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

It must not be forgotten that, if the applicant avails himself of this arrangement, he runs the risk (subject to the effect of sect. 32A) of the whole patent being declared invalid on account of the want of novelty in a part of the complete specification which is founded on one only of the provisional specifications.

Paragraph 2 of rule 13, dealing with this practice, is as follows: "Where the same applicant has put in two or more provisional specifications for inventions which he believes to be cognate or modifications one of the other, and the Comptroller is of opinion that such inventions are not cognate or modifications one of the other, the applicant may divide the complete specification left in connection with his application into such number of complete specifications as may be necessary to enable the application to be proceeded with as two or more separate applications for patents for different inventions."

The rule that a patent may only be granted for one invention is merely one of practice, and if a patent be actually granted it cannot afterwards be impugned on the ground that it was granted for more than one invention (sect. 14, sub-sect. 2).

The title of the invention must sufficiently indicate the subject-matter of the invention (see p. 86, ante).

The Complete Specification.

By sect. 5 it is prescribed that a complete specification must be filed within nine months of the date of the application, the Comptroller on payment of the prescribed fee must grant an extension of this time not exceeding one month, and if the complete specification be not so filed the application is to be deemed abandoned. **Time for lodging.**

Time for acceptance.

By sect. 6, unless the complete specification is accepted within fifteen months from the date of application, the application shall (except where an appeal has been lodged) become void. The Comptroller must on payment of the prescribed fee grant an extension of this period not exceeding three months.

The months allowed by these sections are calendar months (*v*), and are reckoned exclusive of the day of the application (*w*), and in the event of the last day falling on a Saturday or on a day when the office is not open, the specification may be filed on the day succeeding such excluded day or days (*x*).

Chemical samples.

By sect. 2, sub-sect. 5, in the case of a chemical invention, the Comptroller, before accepting the complete specification, has power to demand typical samples and specimens. The procedure for lodging such samples is prescribed by rule 38. The object of this enactment is to prevent the lodging of applications for the mere purpose of blocking future industrial development and to ensure that a person who professes to have solved a chemical problem has really done so. In *T. Y. J.'s Application* (28 R. P. C. 625) Sir J. Simon, S.-G., dealt with the principle of this requirement, and said (at p. 627): "An inventor may have discovered a reaction which depends on the existence of a certain feature in the structure of one of the reacting bodies, that body may belong to a very large class of bodies, all of which are characterised by possessing this feature though in other respects their constitution may be different. In a true case of class reaction a chemist may, I presume, be warranted in believing that all the members of the class will alike give the same reaction, and if he is the first to have discovered it, he is certainly entitled to claim its application not only to one member of that class but to the whole. But although this may be conceded as a principle, it is clear that care must be exercised in permitting so wide a monopoly. . . . Possibly the inventor has erroneously supposed his discovery to be a class reaction, whereas it is an individual peculiarity of

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

(*w*) *Russell* v. *Ledsom*, 14 M. & W. 574, 582; *Williams* v. *Nash*, 28 Beav. 93; 5 Jur. N. S. 696.

(*x*) Sect. 82 and rule 113.

the particular substance with which he has experimented. . . . No doubt the Comptroller cannot in all cases secure the due limitation of claims, but the legislature has conferred upon him a discretion in proper cases to challenge the reality of a chemical invention by requiring typical samples and specimens as a condition of the acceptance of the complete specification. By choosing a few typical samples or specimens judiciously, an expert may be able practically to ascertain whether the width of the claim is justified. I should be very slow to interfere with the responsible action of the office in a technical matter of this kind unless the requisitions made were plainly unreasonable in extent, or were wrong in principle. . . . The object of the provision in the Act is to protect the public from the mischief of unwarrantably wide claims based on theoretic reasoning when the actual reaction has not been sufficiently tested . . . the Comptroller's powers must be exercised with caution in order not unduly to thwart the claims representing the application of a scientific deduction to a wide field, and his demands must be for samples that are typical, not for samples that are exhaustive." It is suggested that in an action for infringement or a petition for revocation the Court might order the production and analysis of samples so deposited if the utility or sufficiency of the specification were in issue. The samples have to be supplied in sealed bottles, and it is difficult to see under what rule the Patent Office officials can examine or analyse the samples to see if they are genuine.

The complete specification and the provisional must describe substantially the same invention, and the titles must correspond.

Power of Comptroller to refuse at this stage.

By sect. 3, sub-sects. 2, 3 and 4: (2) "*If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the Comptroller may refuse to accept the application or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the Comptroller so directs, bear date as from the time when the requirement is complied with.*"

Claims must be succinct.

The claims must be succinct as well as separate and distinct from the body of the specification. It must be remembered that the object of the claim is to give a perfectly clear statement of the invention claimed. Of late years a superstition has arisen that a patent is more valid and has a greater hold over infringements if every possible permutation and combination of the elements entering into the invention is separately claimed, and it has become a practice to file claims which are copies of those used in American specifications. American claims may be very useful in dealing with American law, but in English law such prolixity does not help a Court which, whether in considering subject-matter novelty or infringement, invariably seeks to obtain an answer to the broad question, "What has this man invented?"

The matter came before both law officers of the Crown on the interpretation of rule 4 of the Patents Rules, 1905 (rule 14, 1920), in the case of *Bancroft's Application* (23 R. P. C. 89). The Attorney-General pointed out that certain kinds of inventions might be such as to justify a large number of claims. "So long as the statement of each claim is in itself clear and succinct, and so long as there is an absence of repetition in the separate claims, we do not think that there is necessarily any infringement of this rule. . . . But in the present case we think that the decision of the Chief Examiner was right. . . . An attempt is made to deal with every possible contingency. . . . I must say that I deprecate very much the multiplication of claims by the system, which seems to have prevailed in America, of attempting to deal with every possible contingency. I do not think it results in clearness. I think that the system of claims with which we are more familiar in this country is really clearer in the result, and that those who have American patents and who desire protection in this country, in bringing forward their claims, must endeavour to conform to the practice which has prevailed in this country."

Examiner's report not binding on Comptroller.

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 (*y*). 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. It is clear, however, that the invention must be sufficiently described to enable the inquiry as to novelty to proceed. As a matter of practice, the examiners always require ambiguous descriptions to be made clear, and this is distinctly advantageous to applicants.

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

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

The procedure on appeals to the law officer will be dealt in the consideration of "Oppositions."

By sect. 6, sub-sects. 1, 2 and 3: (1) "*Where a complete specification is left after a provisional specification, the Comptroller shall refer both specifications to an examiner.*

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

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

As to disconformity.

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

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

(*y*) C.'s *Application*, 7 R. P. C. 250.

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

If the original application covers the main principle of the invention, and the subsequent additional matter is in the nature of improvement, it is better to take out a further patent or patent of addition, and so secure the earlier date for the main invention, than to use the procedure created by clause (b).

The Examination for Novelty.

Examination for novelty.

The complete specification is next examined with reference to the novelty of the invention so far as British specifications published within fifty years from the date of application are concerned. This is provided for by sect. 7 (see Appendix). If anticipations are found the Comptroller may require the specification to be amended to his satisfaction, "*and* (by sub-sect. 4) *unless the objection is removed by amending the specification to the satisfaction of the Comptroller, determine whether a reference to any, and if so what, prior specifications ought to be made in the specification by way of notice to the public.*

Power to refuse patent.

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

It is to be noted that the investigation under this section extends to prior claims and descriptions, but the proviso limits the power of the Comptroller in refusing a grant to a case in which prior *claim* is established.

The search extends to specifications open for public inspection under sect. 91, sub-sect. 3 (a) which are held to be published within the meaning of sect. 7 (*z*).

(*z*) *Parsons and Stoney's Application*, 27 R. P. C. 491.

An appeal to the law officer from any decision by the Comptroller under this section is given by sub-sect. 5.

Rule 32 is as follows: "When under sub-sect. 4 the Comptroller determines that a reference to a prior specification ought to be made by way of notice to the public, the form of reference shall be as follows, and shall be inserted after the claims:—'*Reference has been directed in pursuance of sect. 7, sub-sect. 4, of the Patents and Designs Acts*, 1907 *and* 1919, *to specification No. of* .' Where the reference is inserted as the result of a provisional report under rule 29, a statement to that effect shall be added to the reference." It will be noticed that the prescribed form of reference is very clear and explicit, and is intended to warn the public that the invention has been actually claimed in a prior specification. **The specific reference.**

The applicant, if he has any invention at all, should usually succeed in removing the objection by amendment of the specification without the prescribed form of reference. Sometimes a general reference to the state of the art will suffice; sometimes a specific reference to a prior patent is acceptable in another form. The nature of and circumstances in which specific references are directed will be discussed at length under the law relating to Oppositions.

Before the Act of 1907 the search on novelty only extended to complete specifications filed pursuant to prior applications and published before the date of the application. By sect. 8 it was extended further to the claims of specifications filed in pursuance of prior applications and published after the application under investigation. Now specifications until accepted and thrown open to public inspection are secret documents, and the Patent Office may not disclose their contents, so that such specifications as are filed in pursuance of prior applications may only be shown to the applicant as they are accepted. The officials, however, who are acquainted with the prior applications already, know where to find the specification when filed, and after its acceptance they may bring it to the attention of the applicant. Sect. 8 as, amended by the Act of 1919, is as follows: (1) "*In addition to the investigation under the last* **The additional search under sect. 8.**

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

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

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

Reference may therefore be directed to specifications actually filed after that of the applicant but given a prior date under the International Convention (see 30 R. P. C., Ruling A). The procedure is regulated by rules 33—36, and in cases where a specific reference is directed the form of such reference is prescribed and is similar to that used under sect. 7. But the reference is made conditional upon a patent being granted on the earlier application (27 R. P. C., Ruling G). The Comptroller has power under the rules to extend times. By sect. 68, as amended by the Act of 1919, "*Reports of examiners made under this Act shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, unless the court or officer having power to order discovery in such legal proceeding certifies that such production or inspection is desirable in the interests of justice, and ought to be allowed. Provided that, on an application being made by any person in the prescribed form, the comptroller may disclose the result of a search made under section seven or eight of*

...ct on any particular application for the grant of a patent."

Under the proviso application is made under rule 37 on Form

No. 9, and a list of the specifications, if any, found in the search will be supplied.

Acceptance to be advertised.

Sect. 9 enacts: "*On the acceptance of the complete specification the Comptroller shall advertise the acceptance; and the application and specifications with the drawings (if any) shall be open to public inspection.*"

The advertisements are published in the *Illustrated Official Journal.*

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 (*b*), except in the case of an abandoned application under sect. 91 (*c*).

Patents of addition.

A new kind of patent was introduced by the Act of 1907. By sect. 19, sub-sect. 1: "*Where a patent for an invention has been applied for or granted, and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement in or modification of the invention, he may, if he thinks fit, in his application for the further patent, request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired.*

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

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

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

The proviso was introduced by the Act of 1919, and it would appear that if the Court or the Comptroller orders the revocation

(*b*) Sect. 69. (*c*) Sect. 91, sub-sect. 3 (a).

of a patent upon which depends a patent of addition the application for the establishment of the patent of addition as an independent patent should be made before the order for revocation becomes effective, otherwise the patent of addition would cease to exist from the moment of revocation of the principal patent, and there are no provisions for calling it into existence again. The Court and the Comptroller would appear to have a discretion in the matter, and the circumstances which they should take into consideration are not defined. The fees payable are to be determined by the date of the patent for addition. The meaning of this may be illustrated by the following hypothetical case. A. obtains the grant of a patent dated Jan. 1st, 1919, and he obtains a patent of addition thereon dated Jan. 1st, 1921. On Jan. 1st, 1930, the principal patent is revoked, and an order is made establishing the patent of addition as an independent patent. It is suggested that the independent patent will have no *arrears* of fees to pay, but will be treated as a patent whose ninth year renewal fee has then become due. The analogy of a secret patent which has ceased to be such is important on this point (see below).

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

For remarks on the subject-matter of a valid Patent of Addition, see Chap. III., p. 56.

The subject-matter of a patent of addition is limited to improvements on the subject-matter of the principal patent. Therefore where the specification filed on application for a patent of addition referred to two earlier patents in addition to the principal patent, a patent of addition was refused (*d*). But when a patent of addition has been granted, a second patent of addition may be granted in respect of an improvement upon the original invention as improved by the subject-matter of the first patent of addition, and application Form 1C[xxx] was designed for this purpose, and to give effect to the decision of

Second patent of addition.

(*d*) *H. S. J.'s Application*, 31 R. P. C. 47.

Sir J. Simon, S.G., in *McFeelcy's Application* (29 R. P. C. 386).

Secret patents.

Sect. 30 provides for the assignment by an inventor of all the benefit of an invention to the Secretary of State for War or to the Admiralty. And in such a case the Secretary of State or the Admiralty may certify that the application for a patent and the specifications be kept secret. The Secretary of State may waive his rights and re-assign at any time, and thereafter the documents are kept in the ordinary way, and the patentee must if the patent is to be kept in force pay the fees that would have thereafter been payable if it had not been a secret patent. A secret patent cannot be revoked. The procedure is regulated by rules 98—100.

Provisional protection.

By sect. 4: "*Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the invention; and such protection from the consequences of use and publication is in this Act referred to as provisional protection.*"

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; it does not afford him the perfect rights which he obtains when his patent is sealed, since he cannot institute an action in respect of any infringement until his patent is sealed (*e*), nor may he claim in respect of infringements committed before the acceptance of his complete specification (*f*), and further, he may not style the invention which is provisionally protected as "patent," (*g*) but he may make use of such words as "patent applied for."

Use of word "patent."

Sect. 10 enacts:—

Rights given by acceptance of complete specification.

"*After the acceptance of a complete specification, and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges*

(e) Sect. 10.
(f) Sect. 13.
(g) Sect. 89; see *R.* v. *Wallis*, 3 R. P. C. 1; *R.* v. *Crampton*, 3 R. P. C. 367.

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."

It is no offence, therefore, to describe an article as "patented" after the complete specification has been accepted but before the patent is sealed (*h*).

The mere fact that the article has at one time been the subject of a patent now expired will not entitle the patentee to mark it as "patented," as the word implies that there is an existing patent (*i*).

The effect of sects. 4 and 10 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.

RESTORATION.

Restoration of lapsed patents.

By sect. 20 of the Act of 1907 a remedy is provided for the relief of inventors whose patents have lapsed from non-payment of fees where such non-payment has been due to circumstances concerning which no blame is attributable to the patentee. Formerly, if the agent of the patentee fraudulently misappropriated the moneys entrusted to him for payment of renewal fees, or if the renewal fees were left unpaid through accident or inadvertence, the unfortunate patentee had no remedy but to apply for a private Act of Parliament.

The section is as follows:—

(1) "*Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may apply to the Comptroller in the prescribed manner for an order for the restoration of the patent.*

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

(*h*) *R.* v. *Townsend*, 13 R. P. C. 265.

(*i*) See *Cheavin* v. *Walker*, L. R. 5 Ch. D. 850.

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

(4) "*Where such notice is given the Comptroller shall notify the applicant thereof.*

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

(6) "*An appeal shall lie from the decision of the Comptroller under this section to the Court.*"

The practice is regulated by rules 58—63.

A patentee is obliged to show a clear case of hardship, and mere inadvertence will not be sufficient to justify restoration.

Nor will a mistaken view of the law avail the patentee. In one case a patentee decided not to pay the fee or keep the patent alive because he was applying for a further patent for improvements on his invention, and was under the impression that a patent for such improvements would cover and protect the original invention. He only discovered his mistake when the office cited his earlier patent as an anticipation of the invention the subject of his new application. Restoration was refused (*j*).

Delay in taking proceedings for restoration after knowledge of the lapse of the patent has come to the patentee will in general be fatal to an application for restoration (*k*).

The application is advertised, and opposition may be entered to the proposed restoration.

Advertisements.

The requirement for advertisement of the application is for the purpose of enabling persons whose interests may be injured

(*j*) 27 R. P. C., Ruling I.

(*k*) 30 R. P. C., Ruling D.

by the restoration to enter an opposition, when terms may be imposed for their protection.

Conditions. The nature of the conditions which are imposed are set forth in rule 62.

The procedure on appeal is regulated by rules 4, 5 and 6 of Order LIIIA. For a discussion on the effects of the war on Applications and the Restoration of Patents which lapsed during the war, see Chap. XVIII. under "Extension of Time."

CHAPTER IX.

OPPOSITION TO THE GRANT, AND REVOCATION UNDER SECTION 26.

By sect. 11 of the Act of 1907, as amended by the Act of 1919, it is enacted 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 at the Patent Office of opposition to the grant of the patent on any of the following grounds:—*

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

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

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

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

(d) "*that the complete specification describes or claims an invention other than that described in the provisional* **Fifth ground.**

specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification; or

Sixth ground.

(e) "*that in the case of an application under section ninety-one of this Act a specification describes or claims an invention other than that for which protection has been applied for in a foreign state or British possession, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the application in the foreign state or British possession and the leaving of the application in the United Kingdom,*

but on no other ground.

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

(3) "*The decision of the Comptroller shall be subject to appeal to the law officer, who shall, if required, hear the applicant and the opponent, if the opponent is, in his opinion, a person entitled to be heard in opposition to the grant of the patent, and shall decide the case; and the law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer with the consent of the Treasury may determine.*"

The second and sixth grounds have been added by the Act of 1919. The second ground is a very great extension of the right of opposition. The practice is regulated by rules 42—49.

Sect. 26 gives what is in effect an extended right of opposition after the patent has been granted on the same grounds as it might have been opposed, and limited to the same class of "opponent," or rather "applicant," as the attacking party is called in these circumstances. Its provisions will be dealt with at p. 190.

The Opponent.

The Opponent.—The wording of sub-sect. 3 limits the interpretation which might otherwise be placed upon the words "*any person.*" Under the Act of 1907 before amendment, the Comptroller required the opponent to show either an interest in the prior patent under which he alleged that the applicant's

invention had been claimed, *or* if he had no interest in such prior patent he had at least to show a manufacturing interest to give him a right to oppose. Now that the second ground of opposition—prior publication—has been added it would appear that the opponent need only establish a manufacturing or trading interest, and the cases which were decided on the interest in prior patents are no longer strictly applicable. It can hardly be reasoned that an opponent who relies on prior publication in a specification must show an interest in the patent, in respect of which it was filed, whereas he may rely on a prior publication in a technical journal in which, of course, he could not have an interest. We propose, therefore, to deal with those cases which define interests of the other character. In *Meyer's Application* (16 R. P. C. at p. 527) Sir R. Webster, A.-G., said: "I lay down the rule that if there has been a bonâ fide attempt to carry out the invention sought to be protected by the person who desires to be heard in opposition, and proof that he may be damnified or affected by the application which he desires to oppose he is entitled to be heard. I do not pretend to say that those particulars or limitations are exhaustive, though they will indicate the class of case in which I think the Comptroller ought to hear an opponent." In *Application by New Things, Ltd.* (31 R. C. P. 45) the opponent possessed a kinematograph screen, covered by the patent applied for, which he was exhibiting to persons whom he desired to assist him in the formation of a company to manufacture it, otherwise he had not used it for any mercantile purpose. Sir S. O. Buckmaster, S.-G., refused to admit his opposition and said: "Having considered all the cases to which my attention has been called, I am not prepared to limit the interest which an opponent must show in order to bring himself within the class of persons qualified to give notice of opposition under sect. 11, to what is called a manufacturing interest. I think that is a mistake. A trading interest would also be sufficient, but the interest must be a real, definite, and substantial interest, and must not arise from something that the opponent proposes to do. So far as the present interest of the present opponent is concerned it is nothing but the possession and use in the manner which I have mentioned

of this particular screen. The rest of his interest arises from something which he intends to do in the future, and which he may or may not accomplish ; it appears to me that that intention gives him no more right to oppose than a man saying that he intended in the future to make a patented article would give him the right to be heard. I have therefore to consider whether the use of the screen, as he at present possesses and uses it, is a definite and substantial interest entitling him to oppose. I am unable to find that it is. It appears to me that it is no more than the ordinary possession and use of a particular article said to be covered by the patent applied for, and I do not think that the mere fact that a man is in possession of such an article gives him the right to appear and oppose under sect. 11. For example, if a man were using a golf ball which it is said would infringe a patent for which an application was made in respect of golf balls, I do not think that would entitle him to come in and oppose, because it is obvious that when once the area of the class within which opposition is permitted is extended so as to include all people who use—as opposed to those who make or trade in—a particular article, there would be no check on oppositions which might be of a fictitious or unreal character." This decision overruled the decision of the Comptroller in the same case (*a*).

It is submitted that the possession of an article and the use of it in the course of the opponent's trade or occupation would give him a right to oppose.

The Comptroller has decided (*b*) that the fact that the opponent has himself applied for patents in respect of similar subject-matter is enough to give him a locus even when the opponent's application was filed subsequently to the notice of opposition (*c*).

A disparaging reference to the opponent's apparatus or invention in the body of the applicant's specification would appear to be a grievance entitling him to oppose (*d*).

(*a*) Reported as Comptroller's Ruling, 30 R. P. C., B.

(*b*) 29 R. P. C., Ruling B; 29 R. P. C., Ruling C.

(*c*) 29 R. P. C., Ruling C.

(*d*) *Wadham's Application*, 27 R. P. C. 172.

Possibly, also, the use of the opponent's trade mark as a descriptive term for a substance would give the opponent a locus, apart from its being a specific objection based on the fourth ground (*e*).

It was decided before the Act of 1907 that an opponent who had established a locus on one ground of opposition could also rely on others upon which had he relied upon them alone he would not have been able to establish his right to be heard (*f*), and it is submitted that the same reasoning applies to the present law.

Result of collusive opposition.

In a case where an opposition had been entered, and it was shown that the opposition was collusive and had been entered for the purpose of obtaining an extension of time for sealing, the law officer refused to allow a patent to be sealed (*g*). In *Kempton and Mollan's Application* (22 R. P. C. 573) the opposition was successful before the Comptroller, and a patent was refused. The applicant appealed, and prior to the hearing before the law officer, came to an arrangement with the opponent to the effect that the opposition should be withdrawn. Sir E. Carson decided that the appeal could not be allowed by consent, since the Comptroller in refusing the seal was acting in a public capacity, and that the case must be decided on its merits alone, and he refused to allow the patent to be sealed.

Public nature of Comptroller's functions.

The Grounds of Opposition.—Prior to the passing of the Act of 1883 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*, Hindmarch, p. 534), so also was an alleged dedication to the public by the inventor himself (*In re Adamson's Patent*, 1856, 6 De G. M. & G. 420; 25 L. J. Ch. 456; 4 W. R. 473); but it was always considered necessary that the ground of the opposition should be proved beyond the shadow of a doubt (*In re Tolhausen's Patent*, 14 W. R. 551, and also *In re Vincent's Patent*, 1867, L. R. 2 Ch. 341). If there was any doubt it was considered that the patent ought

The grounds of opposition before 1883.

(*e*) See 31 R. P. C., Ruling (A).
(*f*) *Stewart's Application*, 13 R. P. C. 627.
(*g*) *A. B.'s Application*, 19 R. P. C. 403, 556.

to be sealed, so as to give the inventor the benefit of an exhaustive trial.

Under the Act of 1883.

The Act of 1883, however, reduced the grounds of opposition to three in number, corresponding to the first, the third (with a slight difference), and the fifth grounds provided by the Act of 1907 as amended by the Act of 1919.

Under the Act of 1907.

By the Act of 1907 the present fourth ground was introduced, and a modification of the third ground was effected.

By the Act of 1919 the present second and sixth grounds were introduced, and the third ground was modified to its present form.

The grounds of opposition will now be considered *seriatim*.

The first ground (*a*).

The first ground of opposition as defined by the Act is that the applicant has obtained the invention from the opposing party, or from one of whom he is the legal representative. This question involves the credibility of witnesses. Before the Act of 1907 the Comptroller had no power to examine witnesses, although he might request the voluntary attendance for explanation of any one who had made a declaration; and if a conflict was shown in the declarations, the usual practice was that the Comptroller formally decided that the patent should be sealed, and the opponent appealed to the law officer, who was able to take evidence on oath. By sect. 77 the Comptroller was empowered to take evidence upon oath, in addition to receiving statutory declarations in any case in which he thinks it right to do so. The practice will be further dealt with at p. 192.

Patent stopped in clear cases only.

But the law officer would not and will not decide a case of this kind against the applicant unless there is very little doubt on the facts, since the opponent always has an opportunity of having the question tried in open court on a petition to revoke the patent under sect. 25, sub-sect. 3.

In *Edmund's Patent* (Griff. P. C. 283), 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 *Stuart's Application* (9 R. P. C. 452), 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."

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 (*h*).

The words "obtained the invention" do not necessarily imply that the person from whom the invention had been obtained had 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 (*i*). On the other hand, if the invention said to have been "obtained" be a matter of mere common knowledge or has been published in such a way as to deprive the opponent of any rights in it, then although the information may have come to the knowledge of the applicant through the medium of the opponent, the latter cannot oppose on the ground that the inventor has obtained the invention from him within the meaning of the section, and he has no personal rights under this section (*j*) or sect. 15 (set forth at p. 181).

If, however, the opponent can show that he made a confidential communication of a design, drawing, plan or the like to the applicant it does not lie in the mouth of applicant to prove by reference to prior publications that the subject-matter of the

(*h*) *Russell's Patent*, 2 De G. M. & J. 130; Good. P. C. 589; *Luke's Patent*, Griff. P. C. 294; *Eadie's Patent*, Griff. P. C. 279; *Evans and Otway's Patent*, Griff. P. C. 279; *Garthwaite's Patent*, Griff. P. C. 284.

(*i*) *Thwaite's Application*, 9 R. P. C. 515.

(*j*) *Ashton and Knowles' Application*, 27 R. P. C. 181.

communication was not patentable, and that therefore he had a right to appropriate it for the purposes of his application. In such circumstances he would be held to have "obtained" the invention from the opponent (*k*).

It is not necessary for an opponent under this section to prove that the applicant has acted fraudulently, although in circumstances it is part of his case, but the opponent must clearly show that the invention in question was obtained from him, either directly or through his agent; or he must bring the applicant by evidence of notice or otherwise into some known legal relationship with himself. It will not be sufficient to show that the invention has been handed on from A. to B. through numerous intermediate parties, and that B. has received it in entire innocence of the fact that it owed its origin to A. There must be some connection, known and recognised by the law, between A. and B., and not merely a casual connection in which no proof of knowledge or notice is brought against B. and no agency is proved (*l*).

Inasmuch as the appeal to the law officer is in the nature of a re-hearing fresh evidence will be heard by him if he thinks it desirable (*m*).

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 (*n*).

Legal representative.

In *Edmunds' Patent* (Griff. P. C. 281) the Comptroller was of opinion that the words "legal representative" meant the executor or administrator of a deceased person and would not include a person holding a power of attorney (*o*).

No inquiry into fraud abroad.

In the case of inventions communicated from abroad neither the Comptroller nor the law officer will inquire 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

(*k*) *Ashton and Knowles' Application*, 27 R. P. C. 181.

(*l*) Per C. G. Ruling (A), 27 R. P. C.

(*m*) *Chambers' Application*, 32 R. P. C. 416.

(*n*) *Thwaite's Application*, 9 R. P. C. 515.

(*o*) See also *Adolph Spiel's Patent*, 5 R. P. C. 281.

considered, since the merit of the invention consists in its importation into this country (*p*). This is the case even when the opponent has made an application under sect. 91 in respect of the same invention subsequent to the applicant's application, but which by reason of the International Convention will have a date prior to the applicant's application (*q*). It also holds good in a case where the applicant has applied under sect. 91 and has claimed the date of a foreign application, it being alleged that the foreign application was made in fraud of the rights of the opponent (*r*). In such a case opposition proceedings in the foreign country might result in the foreign application being cancelled, but the rights of the applicant in this country would probably not be affected, and he could still claim the foreign date.

Where fraud has been committed in this country. true and first inventors who have been the victims of fraudulent applications are specially protected by sect. 15 of the Act of 1907 as amended by the Act of 1919, which runs as follows :—

(1) "*A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection* (s).

(2) "*Where a patent has been revoked by the Court on the ground that it has been obtained in fraud of the true and first inventor or where the grant has been refused by the Comptroller under the provisions of paragraph* (a) *of sub-section* (1) *of section eleven of this Act or revoked on the same ground under the provisions of section twenty-six of this Act, the Comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent for the whole or any part of the invention in lieu of and bearing the same date as the patent*

(*p*) *Application by McNeil and the Pearson Fire Alarm Co.*, 24 R. P. C. 680; *Edmund's Patent*, Griff. P. C. 281.

(*q*) *Meurs-Gerkin's Application*, 27 R. P. C. 565.

(*r*) *Curwen's Application*, 30 R. P. C. 128. See also *Halsey's Application*, 31 R. P. C. 101.

(*s*) See also sect. 41, sub-sect. (2), and p. 66, ante.

so revoked or as would have been borne by the patent if the grant thereof had not been refused: Provided that no action shall be brought for any infringement of the patent so granted committed before the actual date when such patent was granted."

Second ground (*b*).

The second ground of opposition was added to the Act of 1907 by the amendments made by the Act of 1919. Before these amendments an opponent who relied on prior specifications had to show that the invention had been *claimed* therein. He may now rely upon prior publication in a specification or any other document whatever, and the ordinary law of prior publication would seem to apply (*t*). The words "made available to the public" were expressly inserted, however, at the instance of Lord Moulton, so as to exclude semi-private communications which, although not publications in the popular sense, might have been held to invalidate the patent for want of novelty (*u*).

Consideration of subject-matter.

It is suggested that the Comptroller will refuse the grant only in very clear cases, and that if no clear anticipation is brought to his notice he will not readily refuse the application on the ground of want of subject-matter but will leave this question to be decided by the Courts. The effect of an opposition on this ground will in most cases be to effect a revision of the applicant's specification and claims and their limitation to the precise invention shown to be novel. The Comptroller has power to refuse an application in respect of an "invention" which cannot be considered as a "manufacture" within the meaning of the Statute of Monopolies (*v*). And in some cases patents have been refused when no invention whatever was disclosed, and the idea which it was sought to protect was obvious.

In *Smith's Application* (13 R. P. C. 200) Sir R. Webster said in refusing a patent: "It is only in cases in which the law officer is satisfied that there is no difference which can be regarded as amounting to invention that the later patent can be stopped. . . . I desire to say that it is quite incorrect to suppose that, in giving judgment in *Stubbs' Case*, I ever intended to suggest that the law officer ought not to consider mechanical equivalents as bearing upon the question of identity

(*t*) See Chap. IV., "Novelty." 104, p. 656.
(*u*) See Hansard, vol. 37, No. (*v*) See p. 31, ante.

of invention. I entirely agree with the judgment of my then colleague, Sir E. Clarke, in *Haythornthwaite's Case*; and on many occasions when I had to deal with the matter previously, I did consider the question of mechanical equivalents as bearing upon the question of identity."

And where it appeared that all the elements of the combination claimed by the applicant had been previously patented, and there was no invention in combining them, a patent was refused. (*Bridge's Application*, 18 R. P. C. 257) (*w*).

In *Hodgkins' Application* (23 R. P. C. 527), the alleged invention was a new process for making golf balls. The opponent proved that the greater part of the process had been the subject of a prior grant. The applicant offered to limit his claim to the additional part only, but having been allowed to file evidence relating to the additional part, he failed to convince the law officer that such additional part produced any material advantage in fact, and a patent was refused. The Comptroller will not ordinarily enter into a discussion or evidence as to the practical utility of the applicant's alleged invention. In 27 R. P. C., Ruling D, he said that any experiments directed to this issue should be carried out in the presence of both parties, and added: "It is, however, in any case, a highly inconvenient procedure, and I do not think that the Comptroller should, except in very exceptional instances, ask for experimental proof of the utility of any claimed invention or combination, and then only when no proper protection can be given by means of disclaimer or reference or by other amendment of the specification. Where it is shown on the face of the specification, or where in the light of ordinary knowledge, it is doubtful whether a claimed invention is capable of utility or of practical use, I think experiments may possibly be required, but I think this course should be confined to clear cases, and where the documents themselves disclose some ground for such suspicion."

Consideration of utility.

(*w*) See also *Haythornthwaite's Application*, 7 R. P. C. 70; *Wylie and Morton's Application*, 13 R. P. C. 97; *Deutsche Gasgulicht Aktiengesellschaft's Application*, 26 R. P. C. 101; *Van Wye's Application*, 26 R. P. C. 490; *Bosch's Application*, 26 R. P. C. 710.

Amendment of notice of opposition.

The Comptroller will (subject to an order as to costs) allow an amendment of the notice of opposition to include a specification or other document which has been omitted provided that the notice of opposition relies on the general ground, even though such application to amend is made after the lapse of two months from the acceptance of the complete specification opposed (*x*).

The Comptroller may refuse an application on the ground that the invention has been disclosed in a prior specification which has not been referred to in the notice of opposition, inasmuch as he must protect the public (*y*). And in one cas (29 R. P. C., Ruling E) the Comptroller ruled that where the applicant had admitted that he had published the invention in circumstances that would render any patent therefor invalid, he had, under his general jurisdiction, power to refuse a grant. This view was approved by the law officer in *Barraclough's Application* (37 R. P. C. 105).

References enforced.

Where it appears to the Comptroller-General 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 insertion of a "reference"; such reference may be general or special, that is, either a general reference to common knowledge or a specific reference to the opponent's specification.

General disclaimer and special reference.

The effect of a general reference or disclaimer is somewhat different from that of a special reference. The former is inserted for the purpose of preventing the later patentee from alleging that his invention is wider than that which he is entitled to claim, both in his own interests, in order that his specification may not be considered too wide, and in the interests of the public, 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.

The specific reference, however, is intended as a warning to the public and to indicate the relationship between patents, and will only be directed with reluctance.

(*x*) 27 R. P. C., Ruling C.

(*y*) *Hughes and Kennaugh's Application*, 27 R. P. C. 281.

Before the system of searching to test the novelty of the invention was instituted at the Patent Office the Comptroller could do little to cut down the applicant's claims to what he had really invented, nor could he effectually alter the description, and a special reference was often a necessity in the interests of the public and of the patentee. Under existing circumstances the aim of the office is to secure as far as possible that specifications shall be framed properly and thus obviate the necessity for inserting references and disclaimers, which in many instances were only used as a rough and unscientific method of defining the real scope of the invention, and its relation to former invention and discovery (*z*). The general principle is that a reference is not for the purpose of advertising a prior patentee, but to guide the public, to define the true scope of an invention, and to bring into clear light the relationship and importance of one patent to another. "I think that the real underlying principle which should govern the insertion of specific references is this, 'Is the governing idea, or basic principle of an invention sought to be protected, claimed or protected by a specific earlier patent?'" There are two classes of cases: (1) Where a "master patent" is involved; and in this case a specific reference is rightly inserted if the new invention is merely an improvement or amendment on the "master patent." But in such a case the opponent must give notice of the contention and file evidence that the specification relied on is of this kind. Such a patent is one which has broad claims, which in view of the importance of the principle involved stand alone (*a*). (2) "In the cases where there is no proper "master patent" involved, I think the same general principle in regard to specific references applies; but the conditions are stricter and more severe. I think that in such cases a specific reference should only be allowed where the following conditions are present, viz.:—(a) The patent to which reference is asked should be clear and distinct in its own field,

Master patent.

(*z*) See the Comptroller in *Hopkin's Patent*, 27 R. P. C. 72, for a discussion of the principle on which references are enforced. The passages quoted or condensed are from his decision.

(*a*) See *Southwell and Head's Application*, 16 R. P. C. 361.

and as far as can be gathered, free from anticipation. (b) The invention claimed therein must be clearly and unequivocally claimed or included in the later specification. (c) It must be claimed or included substantially as a whole and not merely in part. (d) The improvement or addition claimed by the applicant must be small, and the governing principle, so to speak, must come from the prior patent" (*b*). In *Walker and Peck's Application* (32 R. P. C. 199) Sir S. O. Buckmaster, S.-G., said: "A specific reference is not intended for the protection of an opponent who desires to have his patent referred to in an applicant's specification; it is intended for a perfectly different purpose; it is introduced in order that the specification may be made clear and definite, and that a member of the public who desires to use the invention for which the applicant is seeking letters patent may not be misled into thinking that an invention is involved or included in the specification, which is in fact the subject of protection by prior letters patent, of which no warning has been given" (*c*).

It is a matter of doubt whether the applicant may refer to a specification prior in date to the opponent's specification but published after it with a view to showing that the latter is not entitled to the description of Master Patent (*d*).

It was decided by the law officer in *Barraclough's Application* (37 R. P. C. 105) that the opponent's right to a specific reference is not defeated by evidence of a prior user before the date of the opponent's patent, inasmuch as the question of prior user is not suitable for trial before the Comptroller or the law officer.

Amendment of applicant's specification.

It frequently happens that the applicant's invention is shown to be anticipated to a great extent, and the question then arises as to the extent to which he may be allowed to amend his specification and claims so as to cut away the invalid part. This depends on the circumstances of the case (*e*), and is by no

(*b*) See also *Sachse's Application*, 18 R. P. C. 221.

(*c*) See also *Welch's Patent*, 8 R. P. C. 443; *Brockie's Application*, 25 R. P. C. 813; *Woolldridge and Fox's Patent*, 37 R. P. C. 114.

(*d*) See *Lanchester's Application*, 30 R. P. C. 130.

(*e*) *Harrild and Parkins' Application*, 17 R. P. C. 617.

means permitted as a matter of course (*f*). Having regard to the modern procedure for searching it may be taken that proposals for amendment are more readily acceded to than was formerly the case (*g*). But the applicant should not wait to affect these amendments until his case arrives before the law officer on appeal. The true principle to be applied is to be found in the question, "Does the amended specification indicate an invention substantially different from that at first described?" Where this is so, even though the specification before amendment contained the elements of what is now set forward as the invention to be protected, the patent will be refused (*h*), and the invention ultimately claimed must in any case have been within the provisional specification (*i*).

Third ground (*bb*).

The third ground of opposition is for the purpose of dealing with possible prior grants for the same invention, and the same considerations apply as in the case of the extended search under sect. 8. The same considerations also affect the enforcement of specific references and refusal of the grant, save that in the case of a specific reference the order will be conditional upon a patent being granted upon the earlier application (*j*). And as to refusal, in 29 R. P. C., Ruling D, the Comptroller said: "I have come to the conclusion that the concurrency of two applications cannot be urged in any case as necessarily forming a bar to the refusal of the grant of patent rights on the later application. I think the only way in which the fact of concurrency can legitimately be used is in urging on the tribunal greater care and greater accuracy in determining the existence of identity between the two inventions. If there is any reasonable doubt as to the differences between the two inventions, or as to the clearness of the language in which the prior invention is described, the grant, in my opinion, ought not to be refused."

(*f*) *Thomas and Prevost's Application*, 16 R. C. P. 69; *Crist's Application*, 20 R. P. C. 475.

(*g*) See the remarks of the Comptroller in *Hopkins' Patent*, 27 R. P. C. 72, referred to above.

(*h*) *Mills' Application*, 18 R. P. C. 322.

(*i*) *Lancaster's Application*, 20 R. P. C. 366.

(*j*) 27 R. P. C., Ruling G.

It would appear that an opponent who bases his opposition on this ground may rely upon a specification filed pursuant to an application under the Convention which though lodged at the office after the date of the applicant's application is given a prior date by reason of the Convention. This was decided by the Comptroller in Ruling C, 30 R. P. C., and by the law officer in *Hulsey's Application* (31 R. P. C. 101) construing the wording of sect. 11 (1) (b) of the Act of 1907 before amendment ("which is or will be of prior date"), which in all material particulars is the same as the present third ground defined in sub-sect. (1) (bb). On the other hand, as will be seen later, in objecting on the fifth ground (d) an ante-dated specification may not be relied on (*k*). The decisions under the Act of 1883 on this point are no longer applicable, as the wording of the sub-sections has been materially changed (*l*).

Fourth ground (*c*).

This ground was introduced by the Act of 1907. It is commonly relied on in the sense that the ambit of the monopoly is not clearly defined, in order to effect a cutting down of the applicant's claims (*m*), and in conjunction with opposition on the second and third grounds. Used in the sense that the directions in the specification are not sufficient to ensure practical success it is seldom used, although it was probably designed to ensure sufficiency in this respect, and for the same reason that samples are required on application for a patent in respect of a chemical invention.

In a case where the applicant stated that his invention related to the treatment of a substance named "Permutit," and this word was the opponent's registered trade mark the Comptroller held that this fact entitled them to oppose on this ground, because it might cause a secondary meaning to become attached to the word, whereas the opponents had the right to retain the word while varying the composition of the substance sold under it (*n*).

An opponent was held entitled to rely on this ground when

(*k*) 30 R. P. C., Ruling A.

(*l*) See, *e.g.*, *Johnson's Application*, 24 R. P. C. 694; *Everitt's Patent*, Griff. L. O. C. 28.

(*m*) See *Wadham's Application*, 27 R. P. C. 172.

(*n*) 31 R. P. C., Ruling A.

his invention was described in the body of the applicant's specification though not included in the claims, and the description of it was irrelevant to the invention which the applicant had really made (*o*).

It was decided by the Comptroller in *Screx's Application* (29 R. P. C. 284) that an opponent relying on this ground and opposing an application under the International Convention, could not allege that the invention claimed was not the same as that in the specification originally filed abroad. Nor could he allege that the specification as originally filed had been improperly amended into the form in which it was ultimately accepted in an ordinary case not under the Convention (*p*).

Fifth ground (*d*).

The fifth 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 invention; but an applicant is not thereby deprived of his old right to include fair developments of his patent in his complete specification (*q*).

An opponent will not be allowed to rely on an application filed after the date of the applicant's complete specification but dated by reason of the International Convention between the applicant's provisional and complete specifications (*r*).

Sixth ground (*c*).

The sixth ground was introduced by the Amending Act of 1919. It partly remedies the decision in *Screx's Application* (29 R. P. C. 284) on the fourth ground, but the opponent must show not only that the specification accepted describes or claims an invention other than that for which he has applied for protection abroad, but that he has himself made the excess matter the subject of an application in the interval between the applicant's foreign and British applications.

(*o*) *Francis' Application*, 27 R. P. C. 86.

(*p*) See effect of sixth ground, however.

(*q*) *Edwards' Application*, 11 R. P. C. 461; *Millar's Application*, 15 R. P. C. 718; *Ross' Application*, 30 R. P. C. 722.

(*r*) 30 R. P. C., Ruling A.

Practice. The Practice in oppositions is regulated by rules 42—49 and appeals to the law officer by the Law Officers' Rules. (See sect. 40 of the Act of 1907.) In these will be found all the rules relating to evidence and notices.

REVOCATION BY THE COMPTROLLER UNDER SECT. 26.

Sub-sect. 1 of sect. 26 is as follows :—

"*Any person who would have been entitled to oppose the grant of a patent, or is the successor in interest of a person who was so entitled, may, within two years from the date of the patent, in the prescribed manner apply to the Comptroller for an order revoking the patent on any one or more of the grounds on which the grant of the patent might have been opposed.*

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

The result of this enactment is merely to extend the time within which an opposition may be lodged subject to the effect of the latter part of sub-sect. (2): "*The Comptroller shall give notice of the application to the patentee, and after hearing the parties, if desirous of being heard, may make an order revoking the patent or requiring the specification relating thereto to be amended by disclaimer, correction, or explanation, or dismissing the application; but the Comptroller shall not make an order revoking the patent unless the circumstances are such as would have justified him in refusing to grant the patent had the proceedings been proceedings in an opposition to the grant of a patent.*"

Sub-sect. (3) provides for the surrender of a patent at the instance of the patentee. This has been dealt with in the preceding chapter; and by sub-sect. (4), "*Any decision of the Comptroller under this section shall be subject to appeal to the Court.*"

The words "*successor in interest*" in sub-sect. (1) mean as regards a person who would have been entitled to oppose on the first ground, his legal representatives only, and as regards other grounds, interests based on the possession of patent rights, and

includes assignees of such patent rights, and it also includes as regards the *locus standi* of the opponent, the assignee of the "manufacturing interest," the possession of which would have given the assignor a right to be heard (*s*).

The procedure is regulated by the same rules as oppositions, together with rules 76 and 77.

The notice of opposition (or application for revocation, the practice is the same) must state the grounds upon which the opponent intends to oppose the grant, and must be signed by him. A copy of such notice is delivered by the Comptroller to the applicant. If the opponent does not desire that the patent should be refused, but merely that the specification should be amended by disclaimer or limitation, the notice should state the relief to which the opponent considers himself entitled. Either party must give notice to the other of any specification or other publications to which he intends to refer at the hearing.

If the applicant desires to contest the opposition he must within fourteen days of the notice of opposition file a counter-statement setting out fully the grounds upon which the opposition is contested and deliver a copy to the opponent, and within fourteen days of receipt of such copy the opponent may file statutory declarations in support of his opposition, and must deliver to the applicant copies thereof. If he intends to rely on the first ground, he must file declarations. If he intends to rely on the fourth ground, he must state in writing the deficiencies of the specification. Within fourteen days from the delivery of such copies the applicant may leave statutory declarations in reply, copies of which must be sent to the opponent. The opponent may leave further declarations at the Patent Office, copies of which must be delivered to the applicant; such last-mentioned declarations must be confined to matters strictly in reply. No further evidence may be left on either side except by leave of the Comptroller. Foreign documents must be accompanied by attested translations.

The parties, if they so wish, are entitled to a hearing. In oppositions or applications for revocation, unless they be based

(*s*) *Gascoine's Patent*, 27 R. P. C. 78.

on the first ground, the applicant for a patent or the patentee as the case may be has the right to begin (*t*).

The Comptroller or the officer sitting on his behalf usually reserves his decision and sends it to the parties in writing. If 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 (*u*).

By sect. 77 of the Act of 1907 the Comptroller is empowered to receive vivâ voce evidence. The section is as follows:—

Oral evidence. (1) "*Subject to rules under this Act in any proceeding under this Act before the Comptroller the evidence shall be given by statutory declaration in the absence of directions to the contrary; but in any case in which the Comptroller thinks it right so to do, he may take evidence vivâ voce in lieu of or in addition to evidence by declaration or allow any declarant to be cross-examined on his declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.*

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

The usual practice is for the parties to request the Comptroller to give notice to the witnesses on the other side to attend for cross-examination. They are asked at the hearing by way of examination-in-chief whether their statutory declarations are true, and are then cross-examined by the other side, and finally re-examined. There is nothing, however, to prevent witnesses being called who have not made declarations.

The attendance of witnesses may be enforced by *subpœna* under Order XXXVI., rules 49 and 50 of the Rules of the Supreme Court.

By sect. 40—

Appeals to law officer. "*The law officer may examine witnesses on oath and administer*

(*t*) 27 R. P. C., Ruling (F). L. O. C. 35.
(*u*) *Lake's Application*, Griff

oaths for that purpose, and may make rules regulating references and appeals to the law officer and the practice and procedure before him under this Part of this Act; and in any proceeding before the law officer under this Part of this Act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the Court."

An appeal from the Comptroller to the law officer is not an appeal in the sense that the law officer must assume that the Comptroller's decision is right until the appellant shows that it should be upset. He must form his own judgment upon the matter, and has almost original jurisdiction, and the appeal is in the nature of a re-hearing (*v*), and the law officer will hear fresh evidence if he so chooses (*w*).

By sect. 73A the Comptroller has also power to award costs :—

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

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

It has been said that the opponent should state in his notice of opposition the relief to which he considers himself entitled, but if he does not succeed in obtaining the full amount of relief asked for he will not necessarily be deprived of costs (*x*), although if after having been offered by the applicant substantially all that he is ultimately held entitled to he persists in forcing the matter to a hearing he will get no costs (*y*). The

(*v*) *Ross' Application*, 30 R. P. C. 722.

(*w*) *Chambers' Application*, 32 R. P. C. 416.

(*x*) 27 R. P. C., Ruling (H).

(*y*) Ibid.

amount awarded by the Comptroller or the law officer is not sufficient to indemnify the successful party, and a specific sum ranging from three to fifty guineas is usually named in the decision. It has been customary for the Comptroller to add to his award of costs a further award of three guineas if an application is made to the Court to make the order a rule of Court, and to direct further that no application is to be made for a rule until the lapse of fourteen days from his own decision. It is doubtful if the Comptroller has any power whatever to deal with costs in the High Court or to direct people not to apply to it. In some cases recently this course has not been followed (probably for the reason stated), and applications have been made to the Court to have the order for costs made a Rule of Court, and for the costs of such application, which applications (to Mr. Justice Sargant) have been successful.

The appeal from a decision of the Comptroller under sect. 26 is to the Court, and by sect. 92, sub-sect. (2), as amended by the Act of 1919: "*Where by virtue of this Act a decision of the Comptroller is subject to an appeal to the Court, or a petition may be referred or presented to the Court, the appeal shall, except in the case of a petition for the revocation of a patent under section twenty-five of this Act and, subject to and in accordance with rules of the Supreme Court, be made and the petition referred or presented to such judge of the High Court as the Lord Chancellor may select for the purpose. An appeal shall not lie from any decision of such judge except in the case of an order revoking or confirming the revocation of a patent.*"

The practice on appeal to the Court is governed by rules 4, 5 and 6 of Order LIIIA. The petition is set down in the witness list, and the evidence used is that given before the Comptroller unless leave be given to call further evidence.

SURRENDER OF PATENT.

Under sub-sect. 3 of sect. 26, "*A Patentee may at any time by giving notice in the prescribed manner to the comptroller offer to surrender his patent, and the comptroller may, if after giving notice of the offer and hearing all parties who desire to be heard he thinks fit, accept the offer, and thereupon make an order for the*

revocation of the patent." Under sub-sect. 4 an appeal lies to the Court from the Comptroller's decision. The Practice is governed by rule 78. The object of the section is to relieve a patentee from the onus of having to submit to an order revoking the patent under sect. 25, in which case even when he consents he usually had to pay the costs. A licensee might object to the invention being thrown open to the trade and would probably appear and oppose the surrender.

CHAPTER X.

AMENDMENT OF SPECIFICATIONS.

IN previous chapters we have seen that the specification may be amended before publication as a result of the procedure on application and acceptance or on account of opposition to the grant. We now have to deal with cases in which the applicant or patentee desires to amend the specification after publication. The extent to which this may be done and the procedure are regulated by sects. 21 and 22 of the Acts of 1907—1919, and rules 64—68.

History of law.

The history of the law on this matter is, however, instructive. 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 or the Lord Chancellor upon petition, but these amendments were strictly limited to verbal or clerical errors arising from mistake or inadvertence (*a*). In *Gare's Patent* (L. R. 26 C. D. 105), Brett, M.R., allowed amendments of clerical errors in a specification filed under sects. 27 and 28 of the Patents, &c. Act, 1852 (*b*).

Sect. 70 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.

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

(*a*) *Sharp's Patent*, 1 W. P. C. 649; *Johnson's Patent*, L. R. 5 C. D. 503.

(*b*) See also *Berdan's Patent*, L. R. 20 Eq. 346.

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, to disclaim any part of the "title of the invention or of the specification, stating the reason for such disclaimer;" or, with such leave as aforesaid, to "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* (1842, 2 Q. B. 466) 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 Act of 1907.

The provisions of sect. 21 of the Act of 1907 (following sect. 18 of the Act of 1883 as amended by sect. 5 of the Act of 1886) are as follows:—

Sub-sect. 1 provides—

(1) "*An applicant or a patentee may at any time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of, and the reasons for, the proposed amendment.*"

When the Comptroller-General has not required an amendment, all amendments by the applicant or patentee from the date of lodging the complete specification (save those made under sect. 22 to be considered hereafter) must be made under sect. 21.

"The patentee," as has been pointed out in a previous chapter, means the person for the time being entered on the

register as the grantee or proprietor of the patent, while "the applicant" means the person whose patent has not yet been sealed, but whose complete specification has been lodged, and includes the legal representative of such a person.

Amendments after publication under sect. 21.

Directly the specification is accepted it becomes open to public inspection (see sect. 9), and therefore the application to amend will have to be made under sect. 21. The practice of the Patent Office is to allow amendments under sects. 6, 7 and 8 before acceptance.

Permissible amendments.

We will deal firstly with the nature of permissible amendments and refer later to the practice.

Nature of permissible amendments.

(6) "*No amendment shall be allowed that would make the specification as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.*"

It will be observed that the amendments 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.

Under the Acts of 1883 and 1907 it is not the exclusive right which must not be extended, but the invention must not be substantially larger or different.

Cases to illustrate.

The case of *Dellwik's Patent* (15 R. P. C. 682) is instructive on this point. The inventor had originally described improvements in incandescent mantles for gas lighting, in which he enumerated a long list of metallic oxides which might be used to coat the mantles, and he described an elaborate theory of the behaviour of the mantles so treated, attributing it partly to the relative conducting powers of the mantle and the coating. His claim was: "The herein-described process of treating incandescents which are non-conductors of heat, such as the oxides of calcium, magnesium, aluminium, zirconium, and similar metals of this group, or compounds of these oxides, by covering or saturating them with a coating of refractory oxide of a heavy metal or metals."

The proposed amendments were to cut out all the description of the theory, the words "non-conductor of heat" and "similar metals of this group" in the claim, and to substitute for the words "with a coating of refractory oxide of a heavy metal or metals" the words "with a coating of chromium oxide," chromium oxide being one of the coatings in the list set out in the body of the specification.

Sir Robert Finlay, S.-G., held that the amendments were permissible, since an inventor is not bound to set forth an accurate theory, nor, indeed, any theory of the behaviour of his invention, and said: "It is perfectly true in this case that the patentee desires to throw a very large part of his cargo overboard, but I confess that I think for all that it is a case of disclaimer. It may be a case of disclaiming six-sevenths, or nine-tenths, or ninety-nine hundredths of what was contained in the original patent, but for all that he is not introducing anything new; he is merely retaining one of the elements which formed the subject of the alleged invention contained in the original patent."

Nature of combination unalterable.

But where a claim is for a combination, an alteration of that combination will mean that the claim will be for a different invention.

The case of *Parkinson's Patent* (13 R. P. C. 509) is an instructive example of a disclaimer which would have made the claim not wider, but different from what it originally was. The claim originally was for the combination of A. and B. to operate on a new principle. It was found that the principle and the combination of A. and B. for effecting it were well known. The proposed amendment was to disclaim the mere combination of A. and B., and to claim A. and B. in combination with the other portions of the apparatus. Sir R. Finlay, S.-G., said: "To my mind the specification as amended, if this application were allowed, would be for something substantially different from what the patent originally claimed . . . the patentee claims the combination of the sieve with the side deposit surfaces, tapering or not tapering. . . . What would be the effect of the patent as amended? It would be really for a new combination: for the combination of the sieve and side

deposit surfaces with the other parts of the apparatus indicated by the words in the proposed amendment: 'Other portions of the apparatus substantially in the manner hereinbefore described, so as practically to free the escaping air from particles of dust.' That may or may not be a good claim, but to my mind it is perfectly impossible to say that it is not substantially different from the naked claim . . . for the combination of the sieve with side deposit surfaces."

Where there are in the original specification two claims for A. and for B. respectively, it is not permissible to amend by substituting for these claims one for A. and B. in combination, since the combination is a different invention. The case of *Kelly* v. *Heathman* (45 C. D. 256; 7 R. P. C. 343), which seems to have been at one time considered an authority to the contrary, was explained by Sir E. Carson, S.-G., in his decision in *Hattersley and Jackson's Patent* (21 R. P. C. 233). Mr. Justice North had held in the former case that there was no objection in that particular case to the amendment, but he so decided upon the ground that even before amendment there was a claim to a combination, though not happily expressed, and that the amendment amounted to nothing more than a correction or explanation, which is, of course, admissible (c).

The same point is illustrated by the decisions in the case of *The British Thomson-Houston Co.'s Patent* (36 R. P. C. 251) where the claim was "The method of working tungsten, which consists in subjecting the metal in a coherent form to the action of heat while it is being operated on or manipulated." There had been claims for particular methods of obtaining the metal "in a coherent form," which claims had been struck out by a former amendment although the methods were still described in the body of the specification. It had been held by the House of Lords that the claim was meant to cover the treatment under heat of tungsten brought into a coherent form by any method whatsoever, and that it disclosed no invention and was invalid. The patentees sought to amend by inserting before the claims the following passage which they said was a

(c) See also *Goltstein's Application*, 27 R. P. C. 289.

disclaimer: "We desire it to be understood that by the expression 'coherent form' and 'coherent metal' in the claims we exclude any forms of tungsten other than those agglomerated from tungsten powder and rendered very dense and strong by a heat treatment very near the melting point." Mr. Justice Sargant (afterwards supported by the Court of Appeal) said: "As the specification is proposed to be amended, it will be for working under heat coherent tungsten which has previously gone through a process of agglomeration and fierce heat treatment. There is here an obvious addition to that which is claimed as defining or constituting the invention. The invention has an extra element added to it and is correspondingly more specific and more capable of reaching that degree of inventiveness which results in subject-matter. . . . It appears to me that this is not more disclaimer, and further that, after the alteration, the invention claimed will be substantially different from that claimed by the specification" (*d*).

In *Johnson's Patent* (13 R. P. C. 659) Sir R. Webster said: "Disclaimer is not to be used solely for the mere purpose of turning an insufficient description into a sufficient description. Of course, it is to be used for the purpose of turning an ambiguous specification into a clear specification, but not for the purpose of turning an insufficient description into a sufficient, especially if the amendment introduces subsequent knowledge."

Not insertion of subsequent discovery.

In the case of *Beck and Justice's Patent* (Griff. L. O. C. 10), the specification described "improvements in nozzles for the escape of steam or gases under pressure." The proposed amendment included directions for modifying the invention for use in gas engines. Gas engines were not mentioned in the original specification, and it was admitted that the amendment was rendered necessary by the development of them, which had since taken place. The amendment was not allowed.

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

(*d*) And see *Rhenische Gummi und Celluloid Fabrik* v. *British Xylonite Co.*, 29 R. P. C. 672, also *Hennebique's Patent*, 28 R. P. C. 41.

time he patented the invention. I do not think it is intended that he should put in subsequently ascertained knowledge."

Sufficient reason must be given.

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 (*e*).

In *Hampton and Facer's Patent* (Griff. L. O. C. 13), 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.

Re-writing of specification not allowable.

An amendment which in effect amounts practically to the re-writing of the whole specification will not be allowed (*f*). In *Nairn's Patent* (8 R. P. C. 444) the original specification contained a general description with diagrammatic drawings. It was proposed to add a full description and drawings. This was disallowed. An amendment which abandons the original substantive claim and limits the invention to a subordinate and unimportant alternative will not be allowed (*g*).

No power to amend title or provisional.

Under this section there is no power either to amend the title or the provisional specification. When a complete specification is filed with a narrower title than the provisional, the proper course for the Comptroller-General to adopt is to amend the title of the provisional (such amendment, however, must be in the nature of excision only) 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 (*h*).

Reasons for amendment.

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

(*e*) *Nordenfelt's Patent*, Griff. L. O. C. 18.

(*f*) *Nairn's Patent*, 8 R. P. C. 444; *Garnett's Application*, 16 R. P. C. 154; *Crist's Application*, 20 R. P. C. 475 (see p. 186, ante).

(*g*) *Heath and Frost's Patent*, Griff. P. C. 310; *Crist's Application*, 20 R. P. C. 475.

(*h*) *Dart's Patent*, Griff. P. C. 307.

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—*e.g.*, that the patentee has discovered that parts of the invention claimed are not new, or are useless, or that certain phrases and terms as originally used need explanation, or that parts of the machine or process as described will not work.

The reasons for an amendment form no part of the amendment itself (*i*). And the proceedings on amendment cannot be used subsequently to effect construction of the amended specification (*j*)

If the reasons do not disclose any ground on which the amendment ought to be allowed, the application will be dismissed (*k*); but the amendment will not be refused merely on the ground that the reasons given for it are not conclusively sufficient (*l*).

Removal of specific reference.

In *Morley's Patent* (32 R. P. C. 473) the Comptroller had inserted a specific reference owing to the result of the search as to novelty. The applicant amended his specification under sect. 21, and the law officer allowed the reference to be removed as being no longer necessary.

Method of printing amendments.

Amended specifications are printed with the amendments shown in crased type, and this is the case even when a reference to a prior specification has been removed as the result of the amendment (*m*).

No prohibition to law officer.

Prohibition will not lie to the law officer in the exercise of his discretion under this section (*Van Gelder's Patent*, 6 R. P. C. 22).

By sub-sect. 2 of sect. 21 "*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.*"

(*i*) *Cannington* v. *Nuttall*, 1871, L. R. 5 H. L. 205, 227, 228.

(*j*) *Bowden Brake Co.* v. *Bowden Wire, Ltd.*, 30 R. P. C. at p. 571.

(*k*) *Nordenfelt's Patent*, Griff. L. O. C. 18.

(*l*) *Ashworth's Patent*, Griff. L. O. C. 6.

(*m*) *Morley's Patent*, 32 R. P. C. 473.

In *Ashworth's Patent* (Griff. L. O. C. 7), Sir H. Davey, S.-G., said: "The section (18 (2) of the Act of 1883) does not in terms say the reasons are to be advertised, but probably the reasons are a part of the request." It is not the practice, however, to advertise the reasons.

The opponent. The section says that "any person" may oppose. This is, of course, limited in exactly the same manner as an opposition entered to a grant (see p. 174, ante).

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

Power of Comptroller to impose conditions. The Comptroller exercises the power to impose conditions given in express terms to the law officer under sub-sect. 5 (*n*).

But in the case of applications for leave to amend patents granted since the Act of 1883 conditions will not be imposed except under special circumstances.

In *Allen's Patent* (Griff. L. O. C. 3), 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 articles 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,

(*n*) *Pietschmann's Patent*, Griff. P. C. 314; *Andrew* v. *Crossley*, 9 R. P. C. at p. 168.

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. 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 (sect. 23 of the Act of 1907) have been established to its satisfaction. I do not think that I am entitled to substitute my own 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 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" (*o*).

In *Ashworth's Patent* (Griff. L. O. C. 6), 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" (*p*).

The nature of the conditions imposed by the Court will be discussed at p. 210.

The specification is considered to be amended from the moment that leave to amend is given, and the conditions imposed,

(*o*) Followed in *Pitt's Patent*, 18 R. P. C. 478.

(*p*) And see *Davies' and Davies' Patent*, 28 R. P. C. 50.

if any, agreed to (*q*); 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 (*r*), since the written assent precludes the patentee from alleging that he did not accept the condition (*s*).

Evidence and costs.

The Comptroller may take evidence vivâ voce in the same manner as on an opposition.

The power of the Comptroller to grant costs is expressly conferred by sect. 73A, that of the law officer by sect. 40.

In *Ashworth's Patent* (Griff. L. O. C. 6), 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 *Lake's Patent* (Griff. L. O. C. 16), which was an unopposed application for leave to amend, the applicants appealed to the law officer against the decision of the Comptroller-General. Sir R. Webster, A.-G., allowed the appeal on the ground that a doubtful amendment ought to be allowed, but refused to give costs against the Comptroller. "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 Comptroller-General should neither give nor receive costs."

In *Morgan's Patent* (Griff. L. O. C. 17), which was a successful appeal to the law officer from the decision of the Comptroller-General, 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 Comptroller-General was quite right in declining to allow the amendment in the first instance and to leave it to the law officer.

Leave to amend conclusive.

By sub-sect. 7, "*leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall be advertised in the prescribed manner, and shall in all Courts and for all purposes be*

(*q*) *Andrew* v. *Crossley*, 9 R. P. C. 165.

(*r*) Ibid.

(*s*) Ibid.; see also *Re Berdan*, L. R. 20 Eq. 346.

deemed to form part of the specification: Provided that the Court shall be entitled in construing a specification as amended to refer to the specification as accepted and published."

The result of this enactment is that the amended specification stands in the place of the old specification, and its validity must be determined in the same way and on the same footing as though it were the original specification.

Until the decision of the House of Lords in *Moser* v. *Marsden* (13 R. P. C. 24) there had been considerable doubt as to the effect of this enactment, and numerous cases had been decided upon the question of whether, when a specification had been amended so as to include in the amended portion something that was itself invalid, the amendment only or the whole patent would be invalid (*t*). These cases are no longer of importance, and until further enactment the law on the point is definitely settled.

Lord Watson said (at p. 31): "In my opinion, the very object of the Act of 1883 was to make an amended claim, when admitted by the proper authorities, a complete substitute, to all effects and purposes, for the claim originally lodged by the patentee. The validity of the amended claim must therefore be determined in the same way, and on the same footing, as if it had formed part of the original specification; and the claim as it stood before amendment cannot be competently referred to, except as an aid in the construction of its language after amendment."

Deleted parts referred to for construction.

The proviso was added by the Amending Act of 1919, and puts an end to a difficulty which was experienced in such cases as *Hattersley* v. *Hodgson* (21 R. P. C. at p. 524).

When legal proceedings are pending.

(8) "*This section shall not apply when and so long as any action for infringement or proceeding before the Court for the revocation of a patent is pending*" (corresponding to sub-sect. 10 of sect. 18 of the Act of 1883).

In *Cropper* v. *Smith* (1 R. P. C. 254; L. R. 28 C. D. 148) the Comptroller having declined leave to amend a specification by reason of the 10th sub-section of sect. 18 on the ground that

(*t*) See *Foxwell* v. *Bostock*, 4 De G. J. & S. 298; *Van Gelder's Patent*, 6 R. P. C. 22; *Gaulard and Gibbs*, 7 R. P. C. 367.

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 of the Act of 1883 (corresponding to sect. 22 of the present Act). 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 *Brooks* v. *Lycett's Saddle and Motor Co.* (21 R. P. C. 651), notice of trial in an action for infringement had been given. An order was obtained for the action to stand over generally, with liberty to either party to restore, in order for a settlement to be arrived at. The negotiations proved abortive, but nothing more was done for two years, when the plaintiffs applied to the Comptroller for leave to amend their specification under sect. 18, which leave was granted. The defendants afterwards applied to restore the infringement action to the list. On the trial of the action it was contended that this amendment was invalid, as the action had been "pending" at the time. Mr. Justice Farwell decided that this was so, and allowed the action to stand over with leave to the defendants to apply, under sect. 19.

In *Codd* v. *Bratby* (1 R. P. C. 209), liberty to amend under sect. 19 was given upon terms by the Court after a previous refusal by the Comptroller under sect. 18, on the ground that an action was pending, but the applicant was ordered to pay the costs of the application to the Comptroller.

Where the application for leave to amend had been made under sect. 18, it was decided that the subsequent institution of legal proceedings did not suspend the application pending before the Comptroller (*u*), and the amended specification is to be used in the trial of the action even when the action is brought in consequence of an action to restrain threats made on the strength of the unamended specification (*v*).

(*u*) *Woolfe* v. *The Automatic Picture Gallery Co.*, 20 R. P. C. 177.

(*v*) *Stepney Spare Motor Wheel, Ltd.* v. *Hall*, 28 R. P. C. 381.

Sect. 22, as amended by the Act of 1919, provides for the case of amendments, pending actions for infringement and petitions for revocation.

Power of Court to amend.

"*In any action for infringement of a patent or proceedings before a Court for the revocation of a patent the Court may by order allow the patentee to amend his specification by way of disclaimer, correction or explanation* (*w*) *in such manner, and subject to such terms as to costs, advertisement or otherwise, as the Court may think fit:*

"*Provided that no amendment shall be so allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before the amendment, and where an application for such an order is made to the Court notice of the application shall be given to the Comptroller, and the Comptroller shall have the right to appear and be heard, and shall appear if so directed by the Court.*"

Different from power under Act of 1883.

This section introduced a new procedure. Under sect. 19 of the Act of 1883 the patentee could apply to the Court *for leave to apply at the Patent Office for leave to amend by way of disclaimer*. The Court now has power to amend, and the procedure at the Patent Office was abolished.

The practice under this section is regulated by Order LIIIA, rule 23. The application must be advertised, and persons desiring to oppose are entitled to be heard. The Comptroller must be served with notice, and may be heard.

Before the alteration effected by the Act of 1919 an amendment under this section was limited to disclaimer only, and no correction or explanation was allowed (*x*); the two sections are now made alike in the nature of amendment permissible.

The power to give leave to amend is discretionary. Where the patentees had issued threats broadcast and only took action with reluctance and after delay and the patent was held invalid, it was held that these were circumstances justifying the Court in withholding leave to amend (*y*). And the Court of

(*w*) "Correction or explanation," added by the Act of 1919.

(*x*) See, *e.g.*, *Alsop's Patent*, 24 R. P. C. 684; *Owen's Patent*, 15 R. P. C. 755.

(*y*) *Klaber's Patent*, 22 R. P. C.

Appeal will refuse to interfere with the exercise of such discretion (*z*).

Power to impose conditions.

The section also gives discretion to the Court or judge in imposing conditions upon which leave 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" (*a*).

In *Bray* v. *Gardner* (4 R. P. C. at p. 44), Lord Justice Lindley said: "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."

The order made in *The Gillette Safety Razor Co.* v. *Luna Safety Razor Co.* (27 R. P. C. at p. 539) is, however, now usually followed (*b*) where an injunction had been granted in an action for infringement, and the defendants subsequently petitioned for revocation and the patentees applied in the revocation proceedings for leave to amend, the injunction was dissolved as one of the terms of leave being given (*c*), inasmuch as it would be highly inconvenient to try what might be a new issue on a motion to commit for breach of an injunction obtained before amendment (*d*).

By sect. 23, as amended by the Act of 1919 :—

at p. 415; *British Thomson-Houston Co.'s Patent*, 36 R. P. C. 251.

(*z*) *British Thomson-Houston Co.'s Patent*, 36 R. P. C. 251.

(*a*) Per Lord Esher, M.R., in *Allen* v. *Doulton*, 4 R. P. C. at p. 383; see also *Lang* v. *Whitecross Wire and Iron Co.*, 6 R. P. C. at p. 574; 7 R. P. C. 389; *Ludington Cigarette Machine Co.* v. *Baron Cigarette Machine Co.*, 17 R. P. C. at p. 747.

(*b*) Appendix; see also *Corrigal* v. *Armstrong, Whitworth & Co.*, 20 R. P. C. at p. 524; *Geipel's Patent*, 20 R. P. C. at p. 556.

(*c*) *Kenrick and Jefferson's Patent*, 29 R. P. C. 25.

(*d*) See *Dudgeon* v. *Thomson*, L. R. 3 A. C. 34.

"Where an amendment of a specification by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the date of the decision allowing the amendment, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge."

This section should be read with sect. 32A which, in the case of a patent having invalid claims, allows the Court to give relief in respect of such as are valid, "subject to its discretion as to costs and as to the date from which damages should be reckoned, and to such terms as to amendments as it may deem desirable."

In *Armstrong's Patent* (13 R. P. C. 501), leave to apply to amend was refused on the ground that there would be nothing left to support a patent after the proposed amendment should have been made. The Court of Appeal (14 R. P. C. 747) refused to interfere with the judge's discretion, and, moreover, agreed with his view of the matter.

Liberty to amend under sect. 22 will not be given after judgment (*e*), since the patentee is then free to act under sect. 21.

In *Hopkinson* v. *St. James and Pall Mall Electric Light Co.* (10 R. P. C. at p. 62), judgment was given for plaintiff with the usual relief. The defendants referred to sect. 20 of the Act of 1883, and asked that the account of profits should be kept only from the date of the amended specifications. 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. But the relief afforded by the Act is seldom granted, and the onus of proof of the circumstances under which the original specification was framed is entirely on the shoulders of the patentee (*f*).

In *Kane and Pattison* v. *Boyle* (18 R. P. C. at p. 338),

(*e*) *Lawrence* v. *Perry*, 2 R. P. C. at p. 187; Griff. P. C. at p. 148.

(*f*) See *The British United Shoe Machinery Co.* v. *A. Fussel & Co.*, 25 R. P. C. 368.

Byrne, J., said: "I think that what the patentee has to establish is that in his original specification he meant and intended to claim that which he had invented, and no more. . . . If the inventor has knowingly sought to include a field of subject-matter beyond that which he knows he has invented, I think he cannot be regarded as having framed his claim in good faith within the meaning of this particular section, and I am of opinion, in the present case, that he meant and intended that which his original specification says, namely, to make a larger claim than that which he knew he was entitled to; and, secondly, I think he has failed to establish, to my satisfaction, that his original claim was framed in good faith and with reasonable skill and knowledge within the meaning of that expression in the section. I believe that the power given by this section of the Act to award further damages has been exercised in one case only in the immense number of cases in which, since the passing of this section, amendments must have been allowed and actions have been brought upon the amended patents."

CHAPTER XI.

DEVOLUTION, ASSIGNMENT AND LICENSES.

THE "patentee" is by the Act of 1919 defined as "the person for the time being entered on the register as the grantee or proprietor of the patent." This includes the first inventor or any person or persons in whom the patent may have become vested by operation of law or by assignment, and by sect. 71 of the Act of 1907, as amended, such person *shall* make application to the Comptroller to register his title, and any person who, prior to the Act of 1 919, was entitled to be registered as the proprietor of a patent but has omitted to make a request to the Comptroller should now do so without delay.

DEVOLUTION BY OPERATION OF LAW.

Devolution.—The property in 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. 43 of the Act provides that—"(1) *if the person claiming to be inventor 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, means his legal personal representative and not the holder of a power of attorney (*a*).

Devolution on death.

Prior to the Act of 1907, if one of two co-grantees died his interest passed to the survivor, unless their relations had been modified by contract, according to the ordinary rules

Death of co-grantee.

(*a*) See *Edmund's Patent*, Griff. P. C. 281.

governing joint-tenancies (*b*), but it was not clear whether the surviving joint-tenant held as trustee for the representatives of the deceased joint-tenant. By sect. 37, however, it is provided as regards patents granted to two or more persons jointly after January 1, 1908, that if any such person dies his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate (*c*). As regards patents granted before the Act the law remains unchanged.

As to grants after January, 1908.

Bankruptcy.

If the patentee becomes bankrupt the property in the patent will pass to his receiver, trustee, or assignee in bankruptcy, and a patent granted to a bankrupt prior to his discharge will vest in the trustee in bankruptcy (*d*). But patents though in the possession, order or disposition of the bankrupt in his trade and business by the consent of the true owner under such circumstances that he is the reputed owner do not pass (*e*). The persons in whom the patent vests by reason of bankruptcy, are, when registered, placed in all respects in the position of the original patentee, and may sue in respect of infringements (*f*).

Dissolution of limited company.

Where a patentee dies intestate and leaving no heirs, his patent, together with the rest of his property, will vest in the Crown. And the same result may occur if a limited liability company be dissolved without having assigned the patent (*g*).

Merger.

An interesting question arises as to whether in these circumstances merger takes place, the patent franchise being reabsorbed by the Crown (*h*). If this were so the Crown would have no power to enforce a patent, which no longer existed as against third parties, and the monopoly would have come to an end, as is the case where a patent is surrendered under sect. 26, sub-sect. 3 (*i*). In any case, it is most advisable for a

(*b*) *National Society for the Distribution of Electricity* v. *Gibbs*, 1899, 2 Ch. 299; 16 R. P. C. 339.

(*c*) As to the right of each joint grantee to sue for infringement, see p. 220.

(*d*) Bankruptcy Act, 1914, sect. 48 (5); *Hesse* v. *Stevenson*, 1803, 3 B. & P. 577.

(*e*) Bankruptcy Act, 1914, sect. 38.

(*f*) *Bloxam* v. *Elsee*, 9 D. & R. 215.

(*g*) *In re Taylor's Agreement Trusts*, 1904, 2 Ch. 737; 21 R. P. C. 713. See also *In re Higginson and Dean*, 1899, 1 Q. B. 325; *In re Mills & Co.*, 1905, W. N. 36.

(*h*) See *In re Taylor's Agreement Trusts*, supra.

(*i*) See p. 194.

purchaser of a patent from a company in liquidation to obtain an assignment from the liquidator before the company is dissolved; unless the Comptroller takes notice of his equitable ownership he will not be able to get on the register. But a patent being a "chose in action" a vesting order will be made under sect. 35 of the Trustee Act, 1893, when the vendor of a patent disappears after the purchase money has been paid but before the patent is assigned (*j*).

Not seizable by sheriff under fi. fa.

The rights conferred by letters patent being of an incorporeal nature, it would appear that the right to use a patented article seized by the sheriff under a writ of *fi. fa.* does not pass with the ownership in the article (*k*), and a receiver will not be appointed where it is not shown that the patentee is in receipt of profits, by way of royalties or otherwise (*l*).

DEVOLUTION BY ASSIGNMENT.

Assignment.

Assignment.—Patent rights may be transferred 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.

The right of the patentee to assign the exclusive right which has been granted to him is recognised in the patent itself in the recital "... the said inventor (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee)..."

Agreement to assign.

An assignment must be by deed to convey the legal estate (*m*), but a parol agreement to assign will be specifically enforceable in equity. An agreement to assign will depend upon the ordinary rules relating to contract as to specific performance, and consideration, etc. It does not alter the proprietorship of a patent, but it gives the right in equity to have the proprietorship altered in law (*n*); and this is so even when the

(*j*) *In re Heath's Patent*, 29 R. P. C. 289.

(*k*) See judgment of Farwell, J., in *British Mutoscope and Biograph Co.* v. *Horner*, 1901, 18 R. P. C. at p. 179.

(*l*) *Edwards* v. *Picard*, 1909, 2 K. B. 903. (Moulton, L.J., dissenting).

(*m*) Co. Lit. 9 b, 172 a; *Stewart* v. *Casey*, 1892, L. R. 1 Ch. 113; 9 R. P. C. 9.

(*n*) Bowen, L.J., in *Stewart* v. *Casey*, 1892, L. R. 1 Ch. at p. 116.

patent was not at the date of the contract actually taken out by the vendor, provided, at least, that he was then entitled to make an application for the same (*o*). The usual conditions of an equitable assignment will apply, and a legal assignee without notice may claim priority (*p*).

Equities.

The assignment of patent rights to a company is usually preceded by an agreement between the patentee and the promoters, by which the latter agree to procure incorporation of the future company and the execution by the company of a scheduled form of contract with the patentee, by which the patentee shall agree to assign the letters patent to the company. The assignment of the patent to the company usually takes place after the payment of the purchase price.

Where the patent has not been granted at the date of the agreement to assign, a clause is inserted by which the vendor agrees to take all necessary steps to obtain it.

After an assignment by deed has been executed and registered the assignee becomes "the patentee" within the definition of the Act, and his rights against the public, including the assignor unless specially limited by the terms of the assignment, are the same as those which the assignor had, and the latter may be restrained from infringing.

(a) previous licenses;

An assignee with notice of previous licenses takes subject to those licenses, otherwise he is not bound by them, and may restrain the persons purporting to manufacture under them. Consequently it is of great importance that licenses should be immediately registered, but a licensee who has an express notice of a prior equitable assignment of the patent may be restrained from using the invention by the assignee even though the registration of the assignment is subsequent to the registration of the license (*q*).

(b) previous covenant.

Where an assignee of a patent covenants with the assignor for himself and his assigns that he will work the patent and

(*o*) *Cogent* v. *Gibson*, 33 Beav. 557.

(*p*) *E.g.*, as in *Wapshare Tube Co., Ltd.* v. *Hyde Imperial Rubber Co.*, 1901, 18 R. P. C. 374.

(*q*) *Hassall* v. *Wright*, 1870, L. R. 10 Eq. 509; *The New Ixion Tyre and Cycle Co.* v. *Spilsbury*, 1898, 2 Ch. 484; 15 R. P. C. 380 and 567.

pay certain royalties thereon to the assignor, a subsequent assignee with notice takes the patent subject to those covenants, as was said by Jessel, M.R., in *Werderman* v. *Société Générale d'Electricité* (1881, 19 C. D. at p. 252): "It is a part of the bargain that the patent shall be worked in a particular way and the profits be disposed of in a particular way, and no one taking with notice of that bargain can avoid the liability." It must be remembered that in such a case there is no privity of contract between the assignor and the second assignee, but the rights of the assignor are analogous to a vendor's lien, and the second assignee cannot hold the rights which he has acquired without also fulfilling the obligations which may be said to attach to those rights, and consequently the terms of the original assignment become a matter of great importance. In *Dansk Rekylriffel Syndikat Aktieselskab* v. *Snell* (1908, 2 Ch. at p. 136), Neville, J., said: "The obligation to fulfil the terms of the agreement, being with regard to the assignees not personal, but attached to the property which they acquired with notice of the terms upon which it was held by their assignor, disables them from holding the property without fulfilling the terms. It appears to me that such an interest of the vendor, if not properly described as a vendor's lien, is closely analogous to it (*r*). The question involved is whether, upon the true construction of the original assignment, it was intended that the vendor should retain a charge upon the property, or that he should part with the property completely, looking solely to the personal liability of the purchaser to pay the consideration" (*s*).

Covenants not implied to pay renewal fees.

Unless it be specially so provided the assignment does not *per se* cast on either party the obligation of maintaining the patent by paying the fees (*t*).

Nor to work invention.

And by analogy there is no implied obligation to work the

(*r*) But see remarks of Cozens-Hardy, M.R., in *British Association of Glass Bottle Manufacturers* v. *Foster*, 34 R. P. C. at p. 224.

(*s*) See also *Bagot Pneumatic Tyre Co.* v. *Clipper Pneumatic Tyre Co.*, 1902, 1 Ch. at p. 157; 19 R. P. C. 69; *Barker* v. *Stickney*, 1919, 1 K. B. 121.

(*t*) *Re Railway and Electrical Appliance Co.*, 1888, L. R. 38 C. D. 597.

patented invention in this country to an extent necessary to avoid the consequences of an abuse of monopoly rights under sect. 27 of the Act of 1907 as amended. Express covenants should be entered into for this purpose (*u*).

Assignment of part of patent.

There may be an assignment of a distinct part of a patent right, but now that patents are not issued for more than one invention this form is seldom required. An assignee of a part is entitled to sue for an infringement without joining the persons who are interested in the remaining part or parts (*v*).

Mortgagee cannot sue.

A mortgagee by assignment, registered as mortgagee, is not entitled to sue infringers. This right remains vested in the mortgagor as the "patentee" who need not join the mortgagee as co-plaintiff (*x*).

Rights of co-patentees inter se.

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 use the invention for his own profit without incurring the liability to account to his co-owners for the profits which he may make. In *Steers* v. *Rogers* (1893, A. C. at p. 235; 10 R. P. C. at p. 251), Lord Herschell, in delivering the judgment of the House of Lords, said: "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."

(*u*) See Appendix.

(*v*) *Dunnicliffe* v. *Mallett*, 1859, 7 C. B. N. S. 209; 29 L. J. C. P. 70.

(*x*) *Van Gelder, Apsimon & Co.* v. *Sowerby Bridge Co.*, 7 R. P. C. 208; 44 Ch. D. 374.

The rights of co-owners *inter se* are summed up by Lindley, L.J., in his book on Partnership (*a*): "In the case of a patent belonging to several persons in common, each co-owner can assign his share, and sue for an infringement (*b*); and can also work the patent himself; and it is now settled that even if he be a mortgagee of the other share (*c*) he is entitled to retain for his own benefit whatever profit he may derive from the working. As regards licenses, except where sect. 37 of the Patents and Designs Act, 1907, applies, a co-owner may give licenses to work the patent and sue for royalties payable to him for its use (*d*), although it is perhaps still open to question whether he is not liable to account for what he receives in respect of the licenses" (*e*). The mutual obligations of co-grantees as to the grant of licenses have been placed beyond doubt by sect. 37 of the Act of 1907: "*Where, after the commencement of this Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interest therein as joint tenants, but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a license without their consent, and if any such person dies, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate.*"

It is to be noted that sect. 37 only applies to patents granted to co-patentees after January 1st, 1908, and apparently not at all where the patent has become vested in co-owners by assignment.

As regards consent, the same principles which underlie the raising of an equity against a plaintiff or litigant by means of acquiescence are involved when an attempt is made to raise a consent under this section by implication (*f*).

(*a*) 8th ed. p. 39.

(*b*) *Dunnicliffe* v. *Mallett*, 1859, 7 C. B. N. S. 209, and *Walter* v. *Lavater*, 8 ib. 162; *Dent* v. *Turpin*, 1861, 2 J. & H. 139; 30 L. J. Ch. 495; *Sheehan* v. *Great Eastern Railway*, 1881, L. R. 16 Ch. D. 59, 63.

(*c*) *Steers* v. *Rogers*, 1892, 2 Ch. 13; 1893, A. C. 232.

(*d*) *Sheehan* v. *Great Eastern Railway*, 1881, L. R. 16 Ch. D. 59.

(*e*) *Mathers* v. *Green*, 1865, L. R. 1 Ch. 29; *Russell's Patent*, 1857, 2 De G. & J. 130; *Horsley* v. *Knighton's Patent*, 8 Eq. 475.

(*f*) *Whitehead and Poole, Ltd.* v.

Co-owner may sue.

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* (1861, 30 L. J. Ch. 496). The law as therein expressed is that although the co-owner of a trade mark 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 the co-owner of a patent is only entitled to such portion of the damages as bears a relation to his interest in the patent. And it would appear that the other co-owners should be joined if possible in order that an account may be taken of the amount due to all the co-owners, without having recourse to a series of actions (*g*).

In *Smith* v. *L. & N. W. Ry. Co.* (1853, 2 El. & B. 74), it was decided that the right of co-owners, who were tenants in common by assignment and not joint tenants, to damages for infringement was a joint right, and on the death of one the survivor was entitled to recover the whole.

Partnership.

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 (*h*), but this would not be the case if it were a term of the partnership that the patent rights in the invention should belong exclusively to one of them (*i*).

Where a grant is made to more than one person it is usual to divide the interests, as the power which each grantee has to work the invention himself without accounting is highly

Sir James Farmer and Sons, Ltd., 35 R. P. C. p. 241.

(*g*) See *Bergmann* v. *Macmillan*, 1881, 17 Ch. D. 423.

(*h*) *Kenny's Patent Button-Holeing Co.* v. *Somervell*, 1878, 38 L. T. 878; 26 W. R. 786.

(*i*) See *Axmann* v. *Lund*, 1874, L. R. 18 Eq. at p. 336.

inconvenient. Provision may thus be made for accounts, granting licenses, survivorship, and many other matters.

A patent may be vested in trustees, who may sue for infringement in their own names, subject to the power of the Court to order the cestuis que trust to be joined (*j*).

Covenants for improvements and in restraint of trade.

Covenants for improvements and in restraint of trade.—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. And a covenant by the vendor not to make or sell the invention at all, nor the product obtained by the invented process, even though obtained in a different manner, is good. As Jessel, M.R., said in *Printing and Numerical Registering Co.* v. *Sampson* (1875, L. R. 19 Eq. at p. 464), the purchasers are entitled to say: "We cannot buy on any other terms because otherwise we are exposed to the instantaneous, or almost instantaneous, competition with the inventor with the benefit of his previous experience." As in all contracts which involve the restraint of trade, their validity depends upon whether they extend further than is necessary to protect the reasonable rights of the other party under the particular circumstances in question (*k*).

Should be carefully drawn.

Covenants for the assignment of or payment of royalties on future improvements require to be very carefully drawn. The ambit of the assignee's rights depends entirely upon the construction of the contract (*l*). In some cases it may be that only such improvements as would involve an infringement of the original patent may be intended; in others it may be desired to secure for the assignee any further inventions of the assignor relating to the particular art. In *Linotype and Machinery Co.* v. *Hopkins* (25 R. P. C. 665), where the licensor covenanted to communicate "every improvement in or addition to the Hopkins machine or mode of applying the same or any discovery useful to the manufacture thereof," the Court of

(*j*) R. S. C. Order XVI., rule 8.

(*k*) See *Nordenfelt* v. *The Maxim Nordenfelt, &c., Co.*, 1894, A. C. 535; *Mouchel* v. *Cubitt & Co.*, 24 R. P. C. 194.

(*l*) *Valveless Gas Engine Co.* v. *Day*, 16 R. P. C. 97.

Appeal, having regard to these words, would not agree that the improvement of which the company was to have the benefit should necessarily be limited to infringements of the original patent assigned, and in the same case Lord Loreburn (27 R. P. C. at p. 113) said: "I think that any part does constitute an improvement, if it can be adapted to this machine, and it would make it cheaper and more effective or in any way easier or more useful or valuable, or in any other way make it a preferable article in commerce." On the other hand, a separate and distinct invention, although relating to the same general subject-matter, cannot usually be described as an improvement (*m*).

Estoppel.

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 (*n*), 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* (1884, L. R. 26 Ch. D. 700; 2 R. P. C. 17), letters patent for improvements in lace machines were granted to H. in 1873, 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, 1914, s. 48, sub-s. 5.) It is probable that there is estoppel by record between the Crown and the grantee of letters patent (*o*), but this would only be against the subject, since no estoppel operates against the Crown.

(*m*) *Davies* v. *Davies Patent Boiler, Ltd.*, 25 R. P. C. 823.

(*n*) *Bowman* v. *Taylor*, 1834, 2 A. & E. 278; *Hocking* v. *Hocking*, 1889, 6 R. P. C. 69; and see 1 W. P. C. 290—295.

(*o*) Per Fry, L.J., L. R. 26 Ch. D. at p. 712.

Upon assignment of a patent without a warranty the assignee may not, in an action upon the contract for the purchase price, set up the invalidity of the patent as a defence, since there is no implied warranty of validity (*p*); so that the question to be decided in each case is: "Did the defendants buy a good and indefeasible patent right, or was the contract merely to place the defendants in the same situation as the plaintiff was in with reference to the alleged patent?" (*q*). An express covenant for the validity of the patent will, of course, remove the estoppel, and the assignee may rely on this in answer to an action for the purchase-money (*r*).

Warranty of validity.

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 (*s*).

It may be here noted that upon the sale of an article there is no implied warranty that it is not an infringement of any existing patent (*t*), and it may from this be inferred that, in an assignment of a patent or a license under a patent, there is no implied warranty that the manufacture or sale of articles made under the patent will not infringe any other patent. On the other hand, if the assignor or licensor concealed the fact, it being within his knowledge, it is possible that the contract might be rescinded on the ground of fraud.

No implied warranty against infringement.

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 (*u*). But where the

(*p*) *Hall* v. *Conder*, 1857, 26 L. J. C. P. 138; 2 C. B. N. S. 22; *Smith* v. *Buckingham*, 1870, 21 L. T. N. S. 819; *Liardet* v. *Hammond Electric Light Co.*, 1883, 31 W. R. 710.

(*q*) Per Cresswell, J., in *Hall* v. *Conder*, 1857, 26 L. J. C. P. at p. 143 a.

(*r*) *E.g.*, as in *Nadel* v. *Martin*, 20 R. P. C. 721; 23 R. P. C. 41; *Henderson* v. *Shiels*, 24 R. P. C. 108.

(*s*) *Chanter* v. *Leese*, 1838, 5 M. & W. 698; *Hall* v. *Conder*, 1857, 26 L. J. C. P. at p. 143 b.

(*t*) *Montforts* v. *Marsden*, 1895, 12 R. P. C. 266.

(*u*) *Chambers* v. *Critchley*, 1864, 33 Beav. 374; *Gonville* v. *Hay*, 21 R. P. C. 49.

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, it was held that plaintiff was not estopped from denying the validity of the patent (*v*). 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 (*x*).

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 (*y*). And he is at liberty to show that the ambit of the claims of the patent assigned is not as wide as the assignee alleges (*z*).

LICENSES.

Licenses.

Licenses differ from assignments, in that the patentee granting a license does not part with his whole interest, nor in fact with any interest or property in the patent, but grants merely a right to use the invention for the whole term or any portion of the whole term, that is merely a right to do that which without a license could not be done except by violating the monopoly granted to and still vested in the licensor (*a*). This principle has been applied to copyright by the Court of Appeal (*b*), but has not been followed in two recent cases in the Scottish Courts (*c*).

Licensee cannot sue.

A licensee, whether under a general or an exclusive license, cannot sue infringers (*d*); the person in whom the legal interest in the patent is vested must be joined, and it is usual to insert

(*v*) *Axmann* v. *Lund*, L. R. 18 Eq. 330; 22 W. R. 789.

(*x*) *Heugh* v. *Chamberlain*, 1877, 25 W. R. 742.

(*y*) *London and Leicester Hosiery Co.* v. *Griswold*, 3 R. P. C. 251.

(*z*) *Hocking* v. *Hocking*, 6 R. P. C. 69.

(*a*) *Heap* v. *Hartley*, 6 R. P. C. at p. 499.

(*b*) *Nielson* v. *Horniman*, 26 T. L. R. 188.

(*c*) *Cochrane & Co.* v. *Martin's (Birmingham), Ltd.*, 28 R. P. C. 284; *Scottish Vacuum Cleaner Co., Ltd.* v. *Provincial Cinematograph Theatres, Ltd., Drs.*, 32 R. P. C. 353.

(*d*) *Heap* v. *Hartley*, 6 R. P. C. 495.

covenants by which the licensor agrees to proceed against infringers or to allow his name to be joined. Sub-sect. 1 (d) of sect. 24, and sub-sect. 3 (b) of sect. 27 of the Act of 1907, as amended (see ante), make special provision for enabling a licensee under a license granted by the Comptroller to sue in his own name, as though he were the patentee, by making the patentee a defendant.

Licenses may be voluntarily granted by the patentee, or they may be compulsory under an order of the Comptroller subject to appeal to the Court (*e*). In this chapter we shall deal with voluntary licenses and licenses of right only.

An exclusive license grants the sole right to put the invention into practice, and the licensor covenants not to grant licenses to any other person during the continuation of the license; and unless he reserves to himself a right to manufacture he may be restrained from so doing by his licensee.

A general license leaves to the licensor the power to grant other licenses in respect of the same invention.

A limited license may contain restrictions as to time, place, or manner of use of the invention.

Form of license.

It would appear from the words of the prohibition contained in the grant—"without the consent, license or agreement of the said patentee in writing under his hand and seal"—that licenses should be under seal; but at the end of the patent occur the words, "but nothing herein contained shall prevent the granting of licenses in such manner and for such consideration as they may by law be granted." Therefore, provided it can be proved that there is an agreement to grant a license, no matter how made, it will be acted upon, and neither party can be excused on the ground that it is not under seal (*f*).

An agreement to grant a license for a fixed term may be specifically enforced (*g*). But an agreement to grant a license at will could not be enforced.

(e) See Chap. XIII.

(*f*) *Chanter* v. *Dewhurst*, 12 M. & W. 823; 13 L. J. Ex. 198; *Crossley* v. *Dixon*, 10 H. L. C. 293; *Tweedale* v. *Howard*, 13 R. P. C. 522.

(*g*) *E.g.*, as in *Brake* v. *Radermacher*, 20 R. P. C. 631.

Stamps. The question of stamps has assumed an added importance owing to the provisions (post) of the Act of 1919, by which persons becoming entitled by assignment to a patent or entitled to an interest in a patent as mortgagee, licensee or otherwise, are required to register the document of title, and is dealt with in Chap. XVIII.

Ambit of license: exercising, using, making, vending. By the prohibition the public are to refrain from making, using, exercising or vending. These terms require examination, as they have not the same meaning. A license to "use and exercise" conveys the fullest rights, including that of importation (*h*). A license to make does not imply a license to use or vend (*i*). But a license to make and vend will imply a license to the purchaser to use and vend (*j*).

An inventor, by himself or his agent, unreservedly selling the patented article abroad cannot restrain the importation and sale of articles so sold in this country (*k*). But the assignee of the English patent could restrain the importation of articles sold abroad, prior to the assignment, by a person who had been the owner of the English patent (*l*); and a license under a foreign patent to manufacture abroad and sell abroad does not imply a license under the corresponding British patent to import articles so manufactured or sold into this country (*m*). And if the patentee assigned his English patent at a date later than that of the importation of articles sold abroad under the patentee's foreign patent, the assignee could not restrain their continued use, since the sale by the patentee would have implied a license to use and sell as wide as his own right at the date of the sale (*n*).

Sub-licensing. Whether a licensee may sub-license or assign depends upon

(*h*) *Dunlop Pneumatic Tyre Co.* v. *North British Rubber Co.*, 21 R. P. C. 161.

(*i*) *Basset* v. *Craydon*, 14 R. P. C. 701.

(*j*) *Thomas* v. *Hunt*, 1864, 17 C. B. N. S. 183; *Badische Anilin und Soda Fabrik* v. *Isler*, 1906, 1 Ch. 605; 1906, 2 Ch. 443; 23 R. P. C. 173, 633.

(*k*) *Betts* v. *Wilmott*, 1871, L. R. 6 Ch. 245.

(*l*) Ibid. at p. 244.

(*m*) *Société Anonyme des Manufactures de Glaces* v. *Tilghmann's Patent Sand Blast Co.*, 25 Ch. D. at p. 9.

(*n*) *Gillette Safety Razor Co., Ltd.* v. *A. W. Gamage, Ltd.*, 25 R. P. C. 492.

the terms of the contract, but in the absence of such terms the license would appear to be personal only (*o*). Should the patentee accept royalties from the person acting with the authority of the licensee, he will be estopped from denying that the license was assignable (*p*).

No implied covenant to pay fees.

It is not an implied term of a license that the patentee will maintain the patent in force by paying the fees; express covenants should be entered into on this point (*q*), and a covenant to pay renewal fees cannot be implied from a covenant for quiet enjoyment (*r*), but can be implied from a covenant to sue infringers (*s*).

Nor to work invention.

Similarly no covenant can be implied binding the licensee to manufacture in this country to an extent necessary to avoid revocation or the other remedies for the abuse of monopoly rights under sect. 27 of the Act of 1907 (*q.v.*), and express covenants to this effect should be inserted in an exclusive license (*t*).

Power to revoke license.

Licenses usually contain clauses which empower either party to revoke the arrangement after due notice; but, apart from such a clause, the question of the power of revocation by the licensor gives rise to some difficulty. It is quite clear that a mere license without a contract may be revoked at will. It is clear also that revocation of a license granted as the consideration in a contract will give a right to an action for damages for breach of that contract. But will the licensee be restrained from manufacturing after the revocation? It would appear from the judgment of Lindley, L.J., in *Guyot* v. *Thompson* (L. R., 1894, 3 Ch. at p. 397; 11 R. P. C. at p. 552), that the general intention of the parties must be looked to, and that where there are mutual obligations to be fulfilled, or, in other words, where the granting of the license is part of a contract, the licensor may not revoke. Moreover, it has been noticed

(*o*) *Lawson* v. *Donald Macpherson & Co.*, 14 R. P. C. 696.

(*p*) Ibid.

(*q*) *Mills* v. *Carson*, 10 R. P. C. 9; see also *Ward* v. *Livesey*, 5 R. P. C. 102, and Appendix.

(*r*) *In re Railway and Electric Appliances Co.*, 1888, 38 Ch. D. 597.

(*s*) *Lines* v. *Usher*, 14 R. P. C. 206; *Cummings* v. *Stewart*, 30 R. P. C. at p. 212.

(*t*) See Appendix.

above (*u*) that an agreement to grant a license for a fixed term may be specifically enforced, but an agreement to grant a license at will could not be enforced. Where a license has been granted for the term of a patent whose life is extended automatically from fourteen to sixteen years by sect. 6 of the Act of 1919 the section further provides that the license shall be treated as having been granted for the term as so extended if the licensee so desires, and it would therefore appear that if the license has been granted for the term of the patent and any extension thereof the licensee could not so determine.

Estoppel.

Unless the licensor has covenanted for the validity of the patent in express terms, the licensee will be estopped from alleging its invalidity in answer to an action for royalties. An express warranty of validity will, of course, negative estoppel (*v*).

Express warranty of validity.

In *Bowman v. Taylor and Others* (1834, 2 A. & E. 278; 1 W. P. C. 292), the plaintiff sued the defendants for the non-payment of certain royalties due from the defendants to the plaintiff under a license 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 (2 A. & E. at p. 291): "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 that the supposed invention in the declaration and letters patent mentioned was not nor is a new

(*u*) P. 225.

(*v*) *Mills* v. *Carson*, 10 R. P. C. at p. 17; *Henderson* v. *Shiels*, 24 R. P. C. 108.

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* (3 T. R. 438), 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.

In the case of *Lawes* v. *Purser* (6 E. & B. 930), the license was not under seal, and the licensee was held to be estopped from alleging the invalidity of the patent, and in *Crossley* v. *Dixon* (10 H. L. C. 293) the same principle was held to apply in the case of a mere verbal license.

In *Adie* v. *Clark* (L. R. 3 Ch. D. at p. 144), 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 (L. R. 2 A. C. 423). But it appears that if the license 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 license; for example, in the case of an agreement between a patentee and a manufacturer to the effect that the manufacturer shall pay to the patentee a fixed royalty on each patented article made, there being no stipulation as to the length of time during which the arrangement shall last, and no annual minimum, it is within the power of the licensee to determine the license, and in answer to an action for damages on any articles made by him after such determination, but not before, he may plead the invalidity of the patent (*w*).

(*w*) *Crossley* v. *Dixon*, 1863, 10 H. L. C. 293; *Redges* v. *Mulliner*, 10 R. P. C. at p. 27.

Where, however, the license was for a specified term of four years, and the patent was revoked within that period, the licensees were nevertheless held liable for royalties on the patented process during the remainder of the term of the license (*x*).

In *Cheetham* v. *Nuthall* (10 R. P. C. 321), it was provided that the license should determine if the patent should be 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 license, and it was held that he was still liable to pay royalties for the use of the invention.

Mills v. *Carson* (10 R. P. C. 9) 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 license 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 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.

But where the defendant took a license from the plaintiff to work his invention "subject to the result of an inquiry into the

(*x*) *African Gold Recovery Co., Ltd.*, 14 R. P. C. 660. *Ltd.* v. *Sheba Gold Mining Co.*,

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 (*y*).

Licensee may contend for limited construction.

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 claim (*z*), and he may, following the analogy of lessor and lessee, show that the patent in question has in fact expired (*a*).

Fraud negatives estoppel.

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 (*b*); beyond that the only reply that is left to the licensee is that he has not worked the patent in question (*c*).

When the plaintiff, fraudulently asserting that he had a right to a patent, induced the defendant to come to terms with him for a license 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 (*d*). But it would be 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 (*e*).

An assignee of a share of the profits is entitled to an account of the profits 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; the licensee is not bound to account to the assignor and to each assignee of a share separately (*f*).

(*y*) *Wilson* v. *Union Oil Mills Co.*, 9 R. P. C. 57.

(*z*) *Adie* v. *Clark*, 1876, L. R. 2 A. C. 423; *Young and Beilby* v. *Hermand Oil Co., Ltd.*, 9 R. P. C. 373; see also *Neil and Others* v. *Neil*, 20 R. P. C. at p. 223.

(*a*) *Muirhead* v. *Commercial Cable Co.*, 11 R. P. C. 317; 12 R. P. C. 39.

(*b*) *McDougall* v. *Partington*, 7 R. P. C. at p. 223; *Ashworth* v. *Law*, 7 R. P. C. at p. 234.

(*c*) *Clark* v. *Adie*, L. R. 2 App. Cas. 423, 435.

(*d*) *Hayne* v. *Mallby*, 1789, 3 T. R. 438.

(*e*) *Taylor* v. *Hare*, 1 W. P. C. 292.

(*f*) *Bergmann* v. *Macmillan*, 1881, L. R. 17 Ch. D. 423.

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LIMITED LICENSES.

Limited licenses.

Some observations are necessary upon what are known as "limited licenses," and the effect of the Act of 1907 in restricting the power of the patentee to impose terms of limitation. It had been decided that a "patentee had a right, not merely by sale without reserve, to give an unlimited right to the purchaser to use, and thereby to make in effect a grant from which he could not derogate, but might attach to it conditions, and if those conditions were broken, then there was no license, because the license was bound up with the observance of the conditions" (*g*). Consequently the patentee might license the user of his patented article, but might attach the condition that it was to be used only in connection with some other article sold by him. In the cases of *The Incandescent Gas Light Co., Ltd.* v. *Cantelo* (12 R. P. C. 262), and *The Incandescent Gas Light Co., Ltd.* v. *Brogden* (16 R. P. C. 179), the article the subject of the patent was an incandescent mantle; and the condition imposed was that the mantle was to be used only upon gas burners supplied by the patentees, and upon no other burners. It was held that such conditions might lawfully be imposed, and that the license to use was to that extent a limited one. It has been pointed out that the sale of an article by the patentee or by his agent without limitation implies a full license to use and to resell. Consequently it was necessary for the patentee in an action against a purchaser for infringement by breach of such conditions to prove that the license was limited, and that the terms thereof were clearly communicated to or were within the knowledge of the purchaser at the time of the purchase, otherwise he would not be bound by them. In the first of the cases above cited the agent did not bring the limitation to the notice of the purchaser; in the second case the agent did communicate the limitation to the purchaser. The distinction drawn by Buckley, J., in *The Badische Anilin und Soda Fabrik* v. *Isler* (1906, 1 Ch. at p. 610) between the case of purchaser from a patentee or his

Knowledge of conditions when necessary.

(*g*) Kennedy, J., in *The Incandescent Gas Light Co., Ltd.* v. *Brogden*, 16 R. P. C. at p. 183.

agent and that of a purchaser from a licensee with a limited license in accordance with which it was immaterial whether or no the purchaser knew of the limitation in the latter case must be deemed inferentially to have been overruled by the decision of the Privy Council in *National Phonograph Co. of Australia, Ltd.* v. *Menck* (1911, A. C. 336; 28 R. P. C. 229) (*h*).

Abuse of limited licenses.

The device of the "limited license" was gradually developed into a machine by means of which Letters Patent for certain kinds of inventions were made to produce commercial profits independently of any royalty that might adequately have rewarded the ingenuity of the inventor or the enterprise of the capitalist. It became customary (particularly in the world of labour-saving machinery) for the patentee to lease such machinery on hire to the manufacturer, and to stipulate that, in addition to paying a royalty, the manufacturer should use in his factory no machinery of any kind other than that supplied by the patentee, and further, that the manufacturer should purchase from the patentee the raw material used in connection with his factory. Another stipulation was to the effect that the leasing contract should endure between the parties for a term of years longer than that of the Letters Patent.

By sub-sect. 1 of sect. 38 of the Act of 1907 it was enacted :—

Statutory change of law.

"It shall not be lawful in any contract made after the passing of this Act in relation to the sale or lease of, or license to use or work, any article or process protected by a patent to insert a condition the effect of which will be—

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

(b) *"to require the purchaser, lessee, or licensee to acquire from the seller, lessor, or licensor, or his nominees,*

(*h*) *Columbia Phonograph Co.* v. *Regent Fittings Co.*, 30 R. P. C. 484; *Columbia Graphophone Co.* v. *Vanner*, 33 R. P. C. 104.

any article or class of articles not protected by the patent;

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

The definitions in clauses (a) and (b) of the kinds of conditions which are to be void are modified by sub-sect. 5, which is as follows:—

(5.) "*Nothing in this section shall—*

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

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

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

(d) "*affect any condition in a contract for the lease of or license to use a patented article, whereby the lessor or licensor reserves to himself or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair.*"

Respects in which law remains unchanged.

The consequence of sub-sect. 1 and of par. (a) of sub-sect. 5 is that a patentee may supply patented goods on sale or hire on condition that the purchaser or hirer does not *sell* any other goods than those supplied by the patentee whether patented or not, but the purchaser or hirer may not be restricted in any way from *using* goods other than those supplied by the patentee.

The consequence of par. (b) of sub-sect. (1) and of par. (d) of sub-sect. 5 is to leave the right of deriving profits from the repair of the patented article in the hands of the patentee but not profits from the supply of a substance used in carrying out a patented process where the substance is not protected by the patent (*i*).

By par. (b) the common law rule as to contracts in restraint of trade is left untouched, and licenses limiting the price at which the patented article may be sold (*j*), or the quantities which may be sold at one time (*k*), are still valid.

(*i*) *Sarason* v. *Frenay*, 1914, 2 Ch. D. 474; 31 R. P. C. 330.

(*j*) See Chap. XIII.

(*k*) See *The Badische Anilin und*

But it is most important to notice that contracts of the kind mentioned are not invariably to be deemed invalid. The evil that was aimed at by the statute only existed in the case of a purchaser or licensee who was practically compelled to enter into such a contract, and it was not the purpose of the section to interfere with contracts which had been voluntarily entered into by parties who had the opportunity clearly laid before them of purchasing or hiring upon different terms. Accordingly sub-sect. 1 concludes with this proviso:— **Condition not necessarily invalid.**

"*Provided that this sub-section shall not apply if*—

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

(ii) "*the contract entitles the purchaser, lessee, or licensee to relieve himself of his liability to observe any such condition on giving the other party three months' notice in writing and on payment in compensation for such relief in the case of a purchase of such sum, or in the case of a lease or license of such rent or royalty for the residue of the term of the contract, as may be fixed by an arbitrator appointed by the Board of Trade.*"

It is suggested that one way of reducing the risk of such a condition being set aside would be to recite in the agreement an alternative offer to the purchaser or hirer and to recite that the purchaser, although deeming such terms to be reasonable, nevertheless preferred to enter into the agreement as herein provided. This would at all events cast the onus of proof on to the licensee. However, as the Act of 1919 adds the following paragraph to sub-sect. 1:—

"*In any action application or proceedings under this Act no person shall be estopped from applying for or obtaining relief by reason of any admission made by him as to the reasonableness of the terms offered to him under sub-section* (1) (i)," an admission by the licensee is not conclusive as against him.

Soda Fabrik v. *Isler*, 1906, 1 Ch. 605; 2 Ch. 443; 23 R. P. C. 173 and 633.

In the event of the contract providing for compensation, such compensation cannot be fixed in the agreement as liquidated damages, but will be such as the arbitrator appointed by the Board of Trade may fix.

Contracts made before Act.

Contracts made before the passing of the Act are to be deemed valid save in so far as they were invalid at Common Law, but may be terminated, and the party terminating becomes liable to pay compensation :—

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

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

Whole contract may be terminated.

It is to be noticed that the whole contract may be terminated, and not the condition only.

Basis of compensation.

No directions are given as to the proper basis upon which such compensation shall be fixed, and it is to be remembered that cases in which decisions have been given upon the assessment of statutory compensation have invariably been based

upon the wording of the particular statute and its general intention. There is no definition of "compensation" universally applicable. And until a case is stated for the Court to definite rule can be laid down.

Sub-sect. 4 of sect. 38 is of a penal nature:— **Defence in infringement action.**

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

It effectually prevents a patentee from prosecuting an action for infringement where an existing contract containing conditions offending against the provisions of the section and made by the patentee after the 28th August, 1907, has come to the knowledge of the defendant. It would appear that the plaintiff must be a party to the contract, but the defendant need not be (*l*). But a plaintiff who has had to discontinue an action owing to the existence of a contract containing such an unlawful condition being pleaded may commence a fresh action against the same defendant for infringement of the same patent after the offending contract has been terminated (*m*), and may recover damages, if successful, for infringements committed while the offending contract was in force.

In addition to the remedies provided by sect. 38 for the abuse of limited licenses sect. 27, sub-sect. 2 (e) of the Act of 1907, as amended, now provides for numerous alternative remedies (see Chap. XIII.) in case any trade or industry in the United Kingdom, or any person or class of person engaged therein, is unfairly prejudiced by the conditions attached by the patentee to the purchase, hire, license or use of the patented article or to the using or working of the patented process.

"LICENSES OF RIGHT."

Sect. 24, which has been introduced into the Act of 1907 by sect. 2 of the Act of 1919, creates a new feature of law and

(*l*) *Sarason* v. *Frenay*, 1914, 2 Ch. 474; 31 R. P. C. 330.

(*m*) *Aktiengesellschaft für Autogene Aluminium Schweissung* v. *London Aluminium Co.*, 36 R. P. C. 29.

policy. A patentee may voluntarily throw his invention open to any one who cares to ask for a license on terms to be agreed with him, or in default of agreement on terms to be settled by the Comptroller. Or if a case of abuse of his monopoly is made out against him under sect. 27 (see Chap. XIII.) the Comptroller may, as one of the remedies applicable, make an order throwing the invention open in the same way. The patentee gains some advantages: he reduces the risk that he may be held at any time to have abused his monopoly; to some small extent he advertises his invention and gives manufacturers or financiers a hope that reasonable terms are obtainable for the use of the invention, and by sub-sect. 1 (f), his renewal fees are reduced to a half of what they would otherwise have been.

Sub-sect. (1) begins as follows:—"*At any time after the sealing of a patent the Comptroller shall, if the patentee so requests, cause the patent to be indorsed with the words 'licenses of right,' and a corresponding entry to be made in the register, and thereupon:—*

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

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

The paragraphs referred to in the proviso provide:

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

Paragraph (d) confers upon such a licensee power to call

upon the patentee to sue infringers or to sue them himself in the name of the patentee (see Chap. XVI. "Parties").

Before acceding to a request by a patentee to indorse his patent, the Comptroller must under sub-sect. 2 advertise the request and must satisfy himself that the patentee is not precluded by contract from making such a request: "*Provided that a patentee shall not be deemed to be so precluded by reason only of his having granted a license under the patent where the license does not limit his right to grant other licenses.*"

If the patentee is not precluded from making the request, and if any or all existing licensees consent, the Comptroller has power to put existing licensees and future licensees on an equality in the matter of royalties or other payments. Paragraph (b) of sub-sect. (1) is as follows:—

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

"(i) *he shall, on the one hand, endeavour to secure the widest possible user of the invention in the United Kingdom consistent with the patentee deriving a reasonable advantage from his patent rights;*

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

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

It is doubtful whether the Comptroller may make any other alteration in an existing license *without* the consent of the licensee save as the result of a license under (1) (c).

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

An existing licensee, with the benefit of a contract that the

patentee shall not make such request, can prevent the indorsement from being made; by sub-sect. (3):

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

"*An order under this sub-section shall be subject to appeal to the Court.*"

The contract may be in express terms, or the licensee may allege that the request is contrary to its spirit and that there is an implied term. On the other hand, a licensee who has not the benefit of such a contract, express or implied, could, it is surmised, appear before the Comptroller in answer to the advertisement in the *Official Journal* and show cause against the indorsement, and as noted under sub-sect. (1) (b) (iii) above, the Comptroller probably could not interfere with the terms of his license save to reduce the royalties or other payments, and must then be guided by the considerations set forth in the proviso. The only other modification of the terms of an existing license which could be effected is the introduction of a covenant against importation as the result under sub-sect. (1) (c) of the settlement by the Comptroller of a license to some one else containing such a restrictive covenant.

Sub-sect. (1) (c) deals with the case of infringement of a patent which has been indorsed: "*If in any action for infringement of a patent so indorsed the infringing defendant is ready and willing to take a license upon terms to be settled by the comptroller, no injunction against him shall be awarded, and the amount recoverable against him by way of damages (if any) shall not exceed double the amount which would have been recoverable against him as licensee if the license had been dated prior to the earliest infringement:*

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

By sect. 27A: "*Any order for the grant of a license under*

this Act shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a license executed by the patentee and all other necessary parties."

It would appear that a decision of the Comptroller under this section, save in the case of a decision under sub-sect. (3), cannot be appealed from. Certainly no provision is made for an appeal, and the policy of the Act seems to be that a patentee who has voluntarily surrendered his control over his monopoly must submit to the Comptroller's decision as to the terms of licenses, as final. On the other hand, if the patent has been indorsed by the Comptroller in exercise of his powers under sect. 27, sub-sect. 3 (a), existing licensees in spite of any restrictive covenant may apply to surrender their licenses in exchange for licenses settled by the Comptroller, and any such order by the Comptroller is subject to appeal to the Court.

No appeal from Comptroller.

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

THE REGISTER.

Sect. 28 of the Act of 1907 provides :—

The register.

(1) "*There shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licenses under patents, and of amendments, extensions and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed; (2) the register of patents existing at the commencement of this Act shall be incorporated with and form part of the register of patents under this Act; (3) the register of patents shall be primâ facie evidence of any matters by this Act directed or authorised to be inserted therein; (4) copies of deeds, licenses and any other documents affecting the proprietorship in any letters patent or in any license*

thereunder, must be supplied to the Comptroller in the prescribed manner for filing in the Patent Office."

The practice of the Patent Office with regard to registration is regulated by rules 86—95 of 1920.

Notice of trust not registrable.

By sect. 66, "*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. 71, sub-sects. (1) and (2), as amended by the Act of 1919, provides that where a person becomes entitled by assignment, transmission or other operation of law to a patent, or becomes entitled as mortgagee, licensee, or otherwise to any interest in a patent he *shall* make application to the comptroller to register his title and that "*Except in applications made under section seventy-two of this Act, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of sub-sections* (1) *and* (2) *aforesaid, shall not be admitted in evidence in any court in proof of the title to a patent . . . or any interest therein unless the court otherwise directs,*" thereby imposing a penalty for non-registration which did not previously exist. It should also be noted that applications for the registration of documents if made after the expiration of six months from the date of acquisition of interest are subject to a fee of ten pounds in place of one pound. The discretion given to the Court may prove useful where the instrument affecting the title to the patent has to be produced in Court in matters entirely unconnected with the patent. This new sub-section also disposes of doubts which existed as to whether under the Act of 1907 an assignee had to be registered before he could sue infringers; it had been held that under the Act of 1852 that an assignee could not sue until his assignment had been registered (*n*), except where the assignor and his licensees had notice of the assignment (*o*). The person registered as the proprietor of a patent shall, subject to any rights appearing from the register to be vested in any other person, have power to deal with the patent absolutely: "*Provided that any equities in respect of such patent or design may be*

Equities may be enforced.

(*n*) *Chollet* v. *Hoffman*, 1857, 7 E. & B. 686.

(*o*) *Hassall* v. *Wright*, L. R. 10 Eq. 509.

enforced in like manner, as in respect of any other personal property."

Caveat against registration.

It is a well-established practice that any person interested in a particular patent may leave a request at the Patent Office to be informed of any attempt to register an assignment or other document in connection with the patent in question. Notice will then be given to the person who has left the request and registration will be suspended for a few days so as to enable the person interested to apply to the Courts for leave to serve notice of motion to prevent registration if he so desires (*p*).

Doctrine of notice.

Lindley, M.R., in *New Ixion Tyre Co.* v. *Spilsbury* (1898, 2 Ch. at p. 488; 15 R. P. C. at p. 571), said, referring to this proviso: "That lets in the whole doctrine of notice and the equitable consequences of it. That proviso cannot be cut down. When it says, 'any equities in respect of such patent,' it cannot mean registered equities. You do not want a proviso for that, because you have got that before. It means that any equitable rights in any person in respect of such patent may be enforced in like manner as in respect of any other personal property. What are they? Those rights are that they can be enforced in equity against all persons who have taken with notice."

In *In re Morsey's Patent* (1858, 25 Beav. 581), 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 license 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 license referred to in B.'s assignment was the deed of assignment to A. subsequently entered.

Registration does not amount to notice to the whole world, so where the grant of an exclusive license for a district had been entered on the register, it was held that this did not by itself 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 (*q*).

(*p*) *Viola* v. *Sharpe*, 22 R. P. C. 23. (*q*) *Heap* v. *Hartley*, 5 R. P. C.

Sect. 67 deals with the inspection of registers, and the obtaining of certified copies. By sect. 79 sealed copies are to be received in evidence.

Registrable documents.

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. In *Stewart* v. *Casey* (9 R. P. C. 9) the owners of two patents employed C. about their patents and wrote to him that, in consideration of his services, they agreed to give him one-third share of the patents, to take effect from the date of the letter. The original letters patent were subsequently put into C.'s hands for the purpose of a sale which fell through. C. retained the letters patent, and caused an entry to be made on the register of patents of the above-mentioned letter. An entry was also made in the register of proprietors that C. claimed an interest in the patents under this document. It was held that the letter was properly registered, it being a document affecting the proprietorship of the patents, and although an assignment of a patent should be by deed, yet an agreement to assign is an equitable assignment, and consequently may be entered on the register under the section, but the documents containing the agreement and entered on the register must be complete, and, of a nature that specific performance of the agreement could be enforced, since otherwise no legal or equitable interest in the patent or proprietorship thereof would pass (*r*). For example, in *Fletcher's Patent* (10 R. P. C. 252) X., the owner of a patent, wrote a letter to Y. agreeing to give him an exclusive license for the duration of the patent, "provided always that you pay me a royalty, of the amount to be mutually agreed upon between us." X. and Y. subsequently disagreed. Y. contended that the royalties had been verbally agreed upon; this was disputed by X. Y. applied to register the letter. It was held that the letter was not registrable.

Agreement must be complete.

Power to amend entries.

Sect. 72 empowers the Court (High Court of Justice) to

603; 6 R. P. C. 495; *Scottish Vacuum Cleaner Co.* v. *Provincial Cinematograph Theatres, Ltd.*, 32 R. P. C. 353.

(*r*) *Haslett* v. *Hutchinson*, 8 R. P. C. 457.

order the alteration of the registers, upon the application of persons aggrieved, and upon sufficient cause shown. The application is made by motion, and notice must be given to the Comptroller, who is entitled to appear and to be heard. The Comptroller may himself under sect. 70 correct errors in the registers which are merely of a clerical nature.

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, but it would appear that if that objection does not apply, the fact that the document is dated prior to the date of the patent is not in itself a bar to registration (*s*). Needless to say, until the patent is granted the registration of the legal interest cannot be effected (*t*). The Comptroller will not enter into the question of the legality of the document to be registered provided that it is correct in form (*u*).

(*s*) *Parnell's Patent*, 1888, 5 R. P. C. 126.

(*t*) *E. M. Bowden's Patents Syndicate, Ltd.* v. *Smith*, 21 R. P. C. 439.

(*u*) 27 R. P. C. Appendix, Ruling E.

CHAPTER XII.

EXTENSION OF THE TERM OF A PATENT.

History of practice.

PRIOR to the year 1835 a patentee who desired an extension of the term of his patent had to apply for a private Act of Parliament, the grant by the Crown being limited to the period of fourteen years fixed by the Statute of Monopolies. By the Act 5 & 6 Will. IV. c. 83, amended by 2 & 3 Vict. c. 67 and by sects. 2 and 3 of 7 & 8 Vict. c. 69, and re-enacted by sect. 25 of the Act of 1883, the Crown was enabled to prolong the term for seven, or in exceptional cases for fourteen, years upon the advice of the Judicial Committee of the Privy Council, which was given jurisdiction to hear petitions. By sect. 18 of the Act of 1907 the power to hear petitions and to grant prolongation is transferred to the High Court, but the considerations which are to guide the tribunal in arriving at a decision remain the same. The judgments of the Privy Council here cited are therefore applicable to petitions to the Court.

Sect. 18, as amended by sect. 7 of the Act of 1919, is as follows:—

The Act of 1907.

(1) "*A patentee may, after advertising in manner provided by rules of the Supreme Court his intention to do so, present a petition to the Court 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: Provided that the court may in its discretion extend such period within which such a petition may be presented.*

(2) "*Any person may give notice to the Court of objection to the extension.*

(3) "*On the hearing of any petition under this section the patentee and any person who has given such notice of objection shall be made parties to the proceeding, and the Comptroller shall*

be entitled to appear and be heard, and shall appear if so directed by the Court.

(4) "*The Court, in considering its decision, shall have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.*

(5) "*If it appears to the Court that the patentee has been inadequately remunerated by his patent, the Court may by order extend the term of his patent for a further term not exceeding five, or in exceptional cases ten, years, or may order the grant of a new patent for such term as may be specified in the order and containing any restriction, conditions, and provisions the Court may think fit.*"

Sub-sect. 6 (introduced by the Act of 1919) provides special machinery for extending patents in cases in which a patentee has suffered loss owing to the war, and will be dealt with hereafter (see p. 269).

Judge's decision final.

By sect. 92, sub-sect. 2, all petitions which "*by virtue of this Act*" are to be presented to the Court are to be presented to a judge to be selected by the Lord Chancellor, and his decision is to be final. By sect. 94 of the Act of 1907 as amended by the Act of 1919 the decision of any Lord Ordinary on a petition presented in Scotland is also final. A petition for prolongation is "by virtue of this Act" to be presented to the Court.

Grounds for extension.

The transference to a judicial authority of powers which had formerly been exercised by Parliament gave rise in the beginning to some doubts as to the spirit in which petitions should be approached. In *Soame's Patent* (1 W. P. C. 733), Lord Brougham 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;

but their lordships have always considered that it was with the view of affording a better remedy, not only cheaper and easier, but better in this respect: that there might be cases which never would have prevailed on the legislature to make a new personal law prolonging a monopoly, which nevertheless might seem meritorious enough in respect of the individual, beneficial enough in respect of the public, and deficient enough in remuneration to justify interference, which nevertheless, had they been presented in the form of a petition to Parliament, would have failed to procure an Act. Proceeding therefore upon this ground, that it is not necessary to show there is case enough for an Act of Parliament, their lordships are of opinion that in this case there may be sufficient ground for granting a very moderate extension of the term" (*a*). The considerations laid down by the Act of 1883, and again by the Act of 1907, are almost identical with those given by Lord Brougham in *Derosne's Patent* (2 W. P. C. 4): "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."

Must be strictly proved.

It is immaterial whether or not the application is opposed. The Privy Council required every necessary ground for extension to be strictly proved before they advised an extension, and this even though the Crown through the Attorney-General consented (*b*).

Uberrima fides required.

The utmost good faith is required to be observed in framing the petition for prolongation. In addition to setting forth the accounts, the nature of which we shall consider later, the petition should state the whole history of the case and everything bearing on the matter. In *Ferranti's Patent* (18 R. P. C. 518), for example, it transpired at the hearing that the petitioner had long ago parted with a substantial interest in his invention, and this fact was not disclosed in the petition. Prolongation was refused without any further investigation (*c*). And the

(*a*) And see *Morgan's Patent*, 1 W. P. C. 739.

(*b*) *Cardwell's Patent*, 10 Moo. P. C. C. 488; *Darby's Patent*, 8 R. P. C. p. 383.

(*c*) See also *Horsey's Patent*, 1 R. P. C. 226; *Standfield's Patent*, 15 R. P. C. 17; *Poulsen's Patent*, 30 R. P. C. 597.

circumstances relating to any foreign patents which may have been obtained or refused must be set forth with great strictness (*d*).

Conduct of petitioner considered.

The conduct of the petitioner in placing the invention before the public is one of the circumstances which will be considered; and so where false statements are made as to profits in the prospectus of a company floated for the purpose of manufacturing under the patent, this was a ground for refusing prolongation (*e*).

Merit of the invention.

The merit of the invention does not mean the merit of the inventor, which must be considered separately (*f*), but the merit of the consideration which he has given to the public. An inventor may have worked diligently for years in a most deserving manner, and yet have produced an improvement of the most trifling nature—the merit of the inventor in such a case will not be considered.

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 (*g*).

In *Fleming and Gale's Patents* (36 R. P. C. 266), the Court granted an extension for three years in view of the great practical utility of the invention notwithstanding the comparatively small amount of inventive ability shown in it.

Degree of merit required.

In *Trantom's Patent* (34 R. P. C. at p. 37), Sargant, J., said: "There is no doubt whatever that before the Court can exercise its jurisdiction in favour of a petitioner it must be satisfied that there has been some merit considerably greater than is sufficient to support the grant of the patent itself (*h*), and having regard to the nature and merits of the invention in relation to the public, I think the Court has to find, as a condition precedent

(*d*) *Pitman's Patent*, L. R. 4 P. C. 84; 8 Moo. P. C. N. S. 293; *Johnson's Patent*, 25 R. P. C. 728.

(*e*) *Lawrence's Patent*, 9 R. P. C. 89.

(*f*) See *Hill's Patent*, 1 Moo. P. C. N. S. 264.

(*g*) *Muntz's Patent*, 2 W. P. C. at p. 119.

(*h*) *Stoney's Patent*, 5 R. P. C. 520; *Saxby's Patent*, L. R. 3 P. C. 292, 294.

to exercising its jurisdiction in favour of the patentee, that there has been some considerable benefit given to the public by the inventor in respect of that invention. The patent must be one of more than ordinary merit or utility, and of the two it appears to me having regard to the words 'in relation to the public,' that the utility is an even more important factor than the inventiveness or skill shown in making the invention."

Novelty of invention immaterial.

The Court will not inquire into the novelty or utility of an invention, except in so far as such novelty or utility may form elements in the consideration of the merit of the invention, save in the case of obvious invalidity.

In *Saxby's Patent* (L. R. 3 P. C. 294), Lord Cairns said: "In point of fact, it is not the practice of this tribunal to decide upon the novelty or utility of a patent; and although they would, of course, abstain in any case from prolonging a patent which was manifestly bad, yet, in one point of view, they are in the habit, in taking into account that which may be termed the question of utility, to consider not that amount of utility which would be necessary to support a patent, but that kind of utility which might more properly be described as merit. Upon that question it is the habit of this tribunal to consider whether the invention brought before them is one of that high degree of merit which, if everything else were satisfactory, would entitle the patentee to a prolongation."

Save as affecting merit.

In *Stewart's Patent* (3 R. P. C. at p. 10), Lord Monkswell said: "Their lordships do not propose to determine the validity or invalidity of the patent on this occasion; but they are satisfied that the invention, whether or not it may have sufficient novelty to sustain the patent, upon which they give no opinion, has been so far anticipated by previous patents and by actual user of machines in this country as to deprive the invention of that degree of novelty which would be necessary in order to justify their lordships in advising her Majesty to prolong its term."

In *Johnson's Patent* (25 R. P. C. at p. 723, Parker, J., said: "The consideration which supports the grant of the monopoly granted by Letters Patent being in fact the disclosure of something of value to the public, it is only where

this value largely exceeds the benefit derived by the patentee from his invention that the patentee can be said to have been inadequately remunerated; but, even where this inadequacy exists, there may be other circumstances sufficient to induce the Court to refrain from exercising its power. The first question, therefore, which arises on a petition for extension is the nature of the disclosure contained in the specification. For, without deciding first on the nature of the disclosure made, it would be impossible to form an opinion on its value to the public. For the purpose of determining the nature of the disclosure made and its value to the public, questions of novelty and subject-matter, though not directly in issue, are necessarily of considerable materiality, for without considering what was already known at the date of the Letters Patent, it is impossible to arrive at any adequate conception of the nature of the disclosure made by the patentee, and, in the same way, the value of this disclosure to the public cannot be altogether independent of the extent of inventive ingenuity required to arrive at the thing disclosed. While, therefore, it would be wrong to allow detailed scientific evidence such as is usual in actions for infringement or petitions for revocation, evidence as to novelty or subject-matter cannot be altogether excluded. It is the duty of the petitioner at the outset to bring to the notice of the Court all that may in any way affect the judgment of the Court in these matters. The length to which the petitioner's witnesses should be cross-examined, and the extent to which an objector should be allowed to bring evidence impeaching the validity of a patent on the ground of want of novelty or subject-matter, must be left to the determination of the judge who hears the petition having regard to the nature of the individual case. As a general rule, if, after hearing the evidence of the petitioner's witnesses, there be in the opinion of the Court a primâ facie case for upholding the validity of the patent in respect of novelty and subject-matter, the Court need not, in my opinion, investigate the matter further. It is always open to an objector to challenge the validity of a patent in proceedings more appropriate for that purpose. The Court on a petition for prolongation ought,

in my opinion, to pay especial attention to the fact that the thing disclosed may be minute compared with the sum total of what was known before, and yet may be the *sine quâ non* of the successful application of existing knowledge, and thus fall within the category of great inventions."

In *Dewar's Patent* (35 R. P. C. 229), the Court, however, considered the objection of want of novelty raised by the Crown.

Nor in validity.

In *Lane-Fox's Patent* (9 R. P. C. 412), 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 (*i*).

In *Worrall's Patent* (35 R. P. C. 226), the Court held that where one of the claims of a specification was obviously bad the original grant was a nullity, and no extension could be granted (*j*). But having regard to the effect of sect. 32A of the Act of 1907, introduced by sect. 9 of the Act of 1919, which enables the Court in an infringement action to give relief in respect of valid claims in spite of the invalidity of others, it is doubtful if the reasoning upon which this judgment is based would be followed to-day.

And the Committee will not hear an objection to the validity of the patent on the ground of non-payment of fees (*k*).

Effect of non-user.

Non-user of the invention for the whole or a great part of the period of the grant creates a strong presumption against the merit of an invention, which presumption can only be rebutted by the strongest evidence; and, in general, such an explanation to be satisfactory must rest on some broad ground such as a State monopoly, a very limited class of users, great expense in introduction, special experimental difficulties, and the like (*l*).

(*i*) And see *Heath's Patent*, 2 W. P. C. 257; *In re Stoney's Patent*, 5 R. P. C. 522.

(*j*) And see *Burlingham's Patent*, 15 R. P. C. 195.

(*k*) *Dolbear's Patent*, 13 R. P. C. 507; 4 Moo. P. C. N. S. 443; *Henderson's Patent*, 18 R. P. C. 449; *Runcorn White Lead Co.'s Patent*, 33 R. P. C. at p. 214.

(*l*) *Allan's Patent*, L. R. 1 P. C.

But the same objection being raised in *Hughes' Patent* (4 A. C. 174), the application was granted after strong and unanswered evidence of merit, though the patent had not been used in England during the whole term (*m*).

In *Semet and Solvay's Patent* (12 R. P. C. 10), the invention consisted in an improved apparatus for coking and distilling coal. For some time it was found impossible to obtain any practical introduction of the invention into the country, partly by reason of expense and partly owing to the prejudices of the manufacturers. Lord Watson said: "The invention appears to their lordships to be one which from its very nature cannot reasonably be expected to come at once, or within a short period, into general use. Its adoption necessitates the destruction of existing and the erection of new apparatus, and will therefore, in all probability, be gradual, as the old-fashioned apparatus wears out." The prolongation was granted (*n*).

In *Pieper's Patent* (12 R. P. C. 292), the invention consisted in an improved expansion gear for steam engines. Prolongation was refused on several grounds, one being that no steps were taken to push the invention for two and a half years after the date of the patent. Lord Watson, dealing with this as a reason for the refusal, said: "Looking at the progressive amounts obtained from year to year under the English patent, it is by no means clear that if due activity had been shown in making the invention known to persons who were likely to use it in this country, there might not have been, during the last year or two's currency, a sum which, added to those which have actually been obtained, might have amounted to adequate remuneration."

Conduct of inventor in pushing invention.

The principle upon which these cases were decided was approved in *Henderson's Patent* (18 R. P. C. 449), and in *Johnson's Patent* (25 R. P. C. at p. 727) Parker, J., said:—

"As this is the first petition under sect. 18 of the Act of 1907,

(*m*) See also *Wright's Patent*, 1 W. P. C. 575; *Herbert's Patent*, L. R. 1 P. C. 399; 4 Moo. P. C. N. S. 300; *Southby's Patent*, 8 R. P. C. 433.

(*n*) And see *Thompson's Patent*, 19 R. P. C. 565.

I think it may be useful to add a few further observations. In the first place, I do not consider that the reasons given by the petitioner for not bringing his invention prominently before British manufacturers are at all satisfactory. His attitude of mind appears to have been that, if he could not persuade his own firm to give his invention a trial, he certainly would be unable to persuade any one else, either in America or in England. This may have been quite true with regard to the invention in question, but it is, in my opinion, incumbent on a patentee who invokes the discretionary power conferred by sect. 18 to prove that he has done all a patentee could do to launch his invention on the British market. If an invention be of that large value to the public which alone will justify the term of the patent being extended—and there is certainly a chance, and I should say a reasonable chance, of some one being found in this country enterprising enough to give it a trial—the least that can be required of the patentee is to show that he has made an effort to find such a person. The petitioner had been able to convince himself of the value of his process, and I cannot ignore the possibility that with reasonable effort he might have convinced others" (*o*).

In *Roper's Patent* (4 R. P. C. 291), an extension was granted although the invention had not been pushed during a period of eight years, the reason for the delay being the serious ill-health of the patentee produced by a railway accident.

Extension of meritorious part.

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 (*p*), and verbal alterations, not in the nature of amendments, of the extended claims, so as to make them read correctly having regard to the omission of other claims, will be allowed.

Subsequent improvement no bar to prolongation.

The mere fact that the invention has been considerably improved upon since it was patented is not a reason for refusing prolongation (*q*).

(*o*) See also *Poulsen's Patent*, 30 R. P. C. 597.

(*p*) *Bodmer's Patent*, 8 Moo. P. C. C. 282; *Lodge's Patent*, 28 R. P. C. 365; *Ferranti's Patent*, 35 R. P. C. 149.

(*q*) *Galloway's Patent*, 1 W. P. C. 727; *Southby's Patent*, 8 R. P. C. 433.

But where a patent had been taken out for the subsequent improvements, and remuneration had been derived therefrom, this was held to be a reason amongst others for refusing a prolongation (*r*), and if the invention in its original form was useless, it would be a ground for refusal.

Save as affecting remuneration.

The degree of merit together with the circumstances which in the future are likely to tend to the proper remuneration of the patentee are taken into consideration in determining for what period the patent shall be prolonged. Sub-sect. 5 of sect. 18, following the Act of 1883, allowed an extension not exceeding seven, or, in exceptional cases, fourteen years, and by the Act of 1919 the term is limited to "*a further term not exceeding five years, or, in exceptional cases, ten years.*"

Period of prolongation.

In *Stoney's Patent* (5 R. P. C. 518), the patent was for improvements in sluice or flood-gates, and enabled a very small amount of power to move gates which had theretofore required the expenditure of great force. Sir William Grove said: "There is one other matter which has always been considered by this Court, and that is that the invention is not one which would promote itself. This is not a case like that of some of those little improvements in forks or knives, in fireplaces, or things of that sort, which, if once known, the public will necessarily have for their own convenience. On the contrary, this is an invention which only appeals to a small number of minds, is only used in a small number of cases, and *requires a considerable outlay, and consequently is not an* invention of daily use, nor one of that class which rapidly gets into general use; it is exceptional therefore in that respect. . . . Now, in the case of a common application such as I have spoken of, . . . if by some means it has been ignored by the public and the patentees come before the Court for a prolongation of their patent, the mere advertisement of the petition would materially assist and start the invention, . . . and would probably lead to its getting into rapid application, and to its becoming rapidly remunerative to the patentees. But this is not an invention of that description. It is from its nature an invention which cannot be very largely used, and which only

Exceptional merit.

(*r*) *Nussey and Leachman's Patent*, 7 R. P. C. 22.

applies to peculiar cases, namely, where sluices are wanted for large bodies of water to regulate the flow of that water, and to do it without friction and without substantial leakage. It can therefore only be profitably applied, at all events, in certain large undertakings, which must be few and far between. . . . Under those circumstances my lords think that this is an exceptional case within the meaning of the statute, and that there should be a prolongation for the term of ten years."

Persons entitled to petition, merits of.

The Act gives a patentee the right to petition, and as amended, the definition of the word patentee is by sect. 93, "*The person for the time being entered on the register as the grantee or proprietor of the patent.*"

Prior to the Act of 1883, which like the Act of 1907 defined a patentee as "*the person for the time being entitled to the benefit of a patent,*" it had been held, in a series of cases, that executors and administrators of a grantee of letters patent might petition for an extension (*s*). So might the assignee of a patent (*t*), even though a public company. So might the executor of an assignee (*u*); so also any person having merely an equitable interest in the patent (*v*); an unpaid mortgagee should be joined as a party (*x*).

But the Court, in addition to considering the merit of the invention, consider that of the petitioner.

In *Soames' Patent* (1843, 1 W. P. C. p. 733), Lord Brougham said: "The merit of an importer is less than of an inventor," but in *Berry's Patent* (7 Moo. P. C. 187), he qualified this by stating that "importers are also public benefactors and render themselves entitled to be put on somewhat, if not entirely, the same footing as inventors," and an extension of six years was granted in view of the loss of nearly 10,000*l.* proved to have been sustained by the petitioners.

Merit of assignee.

Extension of the term may be granted to assignees, as they may, so to speak, have purchased the merit of the original

(*s*) *Heath's Patent*, 8 Moo. P. C. C. 217; 2 W. P. C. 247.

(*t*) *Norton's Patent*, 1 Moo. P. C. N. S. 339.

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

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

(*x*) *Church's Patent*, 3 R. P. C. 95.

inventor, but the argument against importers will apply with equal force against assignees (*y*).

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

And in *Pitman's Patent* (8 Moo. P. C. N. S. 293; L. R. 4 P. C. 84), 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 patronising the patentee, and in pushing the patent into notice; but the general rule which their lordships entertain on applications on the part of assignees is, as was stated by Lord Brougham in *Morgan's Patent* (1 W. P. C. 737), that by so doing 'they are, though not directly, yet immediately 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."

(*y*) See *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.

(*z*) And see *Finch's Patent*, 15 R. P. C. 674.

In *Hopkinson's Patent* (14 R. P. C. 5), the petitioners were the inventor and a company who had purchased the patents from an assignee of the inventor. It appeared that the inventor himself had been well remunerated in the course of the transactions. Lord Hobhouse dealt with the questions of principle involved and the authorities which illustrate them, and said: "Their lordships consider that they would be departing both from authority and from sound principle if they were to hold that this company occupies the position of an inventor who has been inadequately remunerated. The company entered upon a purely commercial speculation, which, unluckily for them, has, up to the present time, proved unremunerative. They did not assist to perfect or bring out the invention. They purchased it out and out from a prior assignee of the inventor, who has, in one way or another, been well paid, and has now no claim or interest to ask for an extension" (*a*).

In *McCulloch's Patent* (25 R. P. C. at p. 692), Lord Salvesen said: "I can draw no distinction between a patentee who is an inventor and an assignee to whom he has conveyed his rights on equitable terms, and who has incurred the greater part of the expense in maturing the method of manufacture and introducing it to the notice of possible users, more especially when the executors of the deceased patentee . . . will share in the benefits of any extension," and in *Ritchie's Patent* (31 R. P. C. p. 6), where the petitioning company were the purchasers twice removed from the inventor, and it was proved that the remuneration of the successive owners had been inadequate, and that there had been nothing in the nature of speculation, an extension of five years was granted (*b*).

Where the petitioner is an assignee conditions may be imposed in favour of the original inventor. In *Herbert's Patent* (L. R. 1 P. C. 399), 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

Interests of applicant considered.

(*a*) And see *Barff and Bower's Patent*, 12 R. P. C. 383; *Henderson's Patent*, 18 R. P. C. 453.

(*b*) And see *Houghton's Patent*, L. R. 3 P. C. 461.

permitted the hearing to proceed, and granted an extension, subject to a condition that the assignee should hold a moiety on behalf of the widow of the patentee.

In *Whitehouse's Patent* (1 W. P. C. 473), 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*l.* during the term of the patent (*c*).

Interests of public considered.

The interests of the public will also be considered, and in the event of the petition being granted terms may be imposed. In *Hardy's Patent* (6 Moo. P. C. C. 441), the patentee was obliged to sell the patented articles at a certain fixed price, and no more. In *Lyon's Patent* (11 R. P. C. 537), an extension was granted upon the condition that the petitioner should grant licenses on the same terms to all persons, and the royalty receivable was limited. In *Lodge's Patent* (28 R. P. C. 365), and in *Dewar's Patent* (35 R. P. C. 229), licenses were to be granted on terms to be decided by an arbitrator nominated by the Board of Trade, and in *Taylor's Patent* (35 R. P. C. 247), extension was made conditional on the supply of range-finders to Government departments on terms to be fixed by arbitration.

Effect of exclusive license.

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, was held to be a good ground of objection to the prolongation (*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 interests 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* (9 R. P. C. 438), an extension was granted subject to the condition that the exclusive licensee abandoned all right and benefit under the license.

(*c*) See also *Ritchie's Patent*, 31 R. P. C. at p. 8.

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

(*e*) *Darby's Patent*, 8 R. P. C. 380.

Inventions worked abroad.

The Act of 1907, as amended, provides for relief, by revocation or otherwise, in the case of abuse of monopoly rights, such as when a patented invention, capable of being worked in the United Kingdom, is not so worked on a commercial scale within four years, and such circumstances will, *a fortiori*, militate against the grant of any extension of a patent (*f*). To a certain extent this aspect of the matter was not ignored before the Act. In *Johnson's Patent* (L. R. 4 P. C. at p. 80), James, L.J., said: "The merits of the case, so far as regards the English patent, appear to their lordships to be nil. The patentee, by taking out a patent in England, has in effect secured to himself a monopoly during a period of fourteen years of the sale of articles manufactured in America, and exported from America here, which would have been manufactured there and exported to this country quite in the same way if no English patent had been taken out, but with this difference, that the patentee would not have had the monopoly of his patent, and would not, therefore, have had any opportunity of securing the monopoly of prices. The merits, therefore, so far as regards the introduction of the invention into this country, seem to their lordships to be nothing."

"Merit" is a vague term. Different persons have different ideas as to wherein it consists. Each case that comes before the Court 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 remuneration 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.

Sufficiency of 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.

In *Michell's Patent* (36 R. P. C. 230), an invention of great

(*f*) *Poulsen's Patent*, 30 R. P. C. 597.

value and importance, a remuneration of 15,000*l.* by the patentee apart from what was considered fair payment for time and labour in pushing the patent was held to be obviously inadequate (*g*).

The account of profit and loss must be clear and precise.

Accounts must be clear.

In *Wütcrick's Patent* (20 R. P. C. 286), Lord Macnaghten said: "That the accounts presented to them have been honestly kept, and have been honestly made out by the accountant, their lordships do not doubt, nor do they doubt that the accountant has done his best to present the accounts to them in an intelligible form; but still the fact remains that their lordships are unable to discover from the accounts put before the Committee what is the remuneration that the patentee has actually received. What a patentee intending to come for prolongation of his patent ought to do is stated very plainly in a judgment of Lord Chelmsford in *Betts' Patent* (1 Moo. P. C. N. S. 49). It was repeated by Lord Cairns in perhaps stronger language in *Saxby's Patent* (L. R. 3 P. C. 294; 7 Moo. P. C. N. S. 82), and it has been recently repeated in a judgment delivered by Lord Davey in the matter of *Henderson's Patent* (18 R. P. C. 449)."

In *Hughes' Patent* (15 R. P. C. 371), the petitioner had kept no books, but shortly before the presentation of the petition he had marked upon certain cheques drawn upon his private account approximately the amounts expended by him in working the patent. Upon these materials the accounts accompanying the petition were made up by the accountant. There were no vouchers or other corroboration. Prolongation was refused (*h*).

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 (*i*). And where the accounts were primâ facie satisfactory, the petitioners were allowed to prove the merits of the invention before going into the accounts (*j*). The books of the petitioner in respect to

(*g*) And see *Derosne's Patent*, 2 W. P. C. 1.

(*h*) And see *Lawrence and Kennedy's Patent*, 27 R. P. C. 252.

(*i*) *Wield's Patent*, L. R. 4 P. C. 89.

(*j*) *Houghton's Patent*, L. R. 3 P. C. 461; 7 Moo. P. C. N. S. 309.

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 absence of the books, without reasonable excuse, everything will be taken most strongly against the petitioner (*l*).

Perfect accounts sometimes excused.

But in exceptional cases, where a strong primâ facie case has been made out, the filing of perfect accounts may be excused (*m*). 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 (*n*).

And where the invention was of exceptional merit, and it was clear that a loss of about 8,000*l.* had been incurred, it was held that extreme accuracy in the accounts was unnecessary (*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*).

Patentee's distinguished from manufacturer's profits.

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, and while interest charges on new works during the constructional period will not be allowed as a legitimate charge against the profits a proper sum for depreciation on existing buildings (3 per cent.) and existing plant (6 per cent.) was allowed in *Trantom's Patent* (34 R. P. C. p. 40); and the profits that he would in any case have made in his capacity of a manufacturer will not be taken as patentee's

(*k*) *Hutchinson's Patent*, 14 Moo. P. C. C. 364.

(*l*) *Lawrence's Patent*, 9 R. P. C. 85; see also *Yates and Kellett's Patent*, 12 A. C. 147; 4 R. P. C. 150.

(*m*) *Lowe's Patent*, 10 Jur. 363.

(*n*) *Heath's Patent*, 8 Moo. P. C. C. 217; 2 W. P. C. 247.

(*o*) *Darby's Patent*, 8 R. P. C. 380, 384.

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

(*q*) *Newton's Patent*, 9 A. C. 592; 1 R. P. C. 177; *Yates and Kellett's Patent*, 12 A. C. 147; 4 R. P. C. 150.

profits (*r*). But in some cases the very fact of the ownership of the patent will be sufficient to increase greatly the number of orders he will receive as a manufacturer, and such matters will be taken into account in considering the remuneration. In *Saxby's Patent* (L. R. 3 P. C. 295), Lord Cairns said: "It has been decided more than once by this Committee (*s*) that where the patentee is also the manufacturer, the profits which he makes as manufacturer, although they may not be in a strict point of view profits of the patent, must undoubtedly be taken into consideration upon a question of this kind. It is obvious that in different manufactures there will be different degrees of connection between the business of the applicant as a manufacturer and his business or his position as the owner of a patent. There may be patents of some kind which have little or no connection with the business of a manufacturer, and there may be patents of a different kind, where there is an intimate connection with the business of the manufacturer; that the possession of the patent virtually secures to the patentee his power of commanding orders as a manufacturer."

Also losses.

The same remarks apply to the reckoning of losses. In *Thorneycroft's Patent* (16 R. P. C. 202), the owners of the patent, which was granted for a new form of marine boiler, had constructed boilers for ships built by other firms, and on these there had been a profit. They also built a vessel (the "Speedy") themselves, and equipped her with boilers. On this vessel the firm made a great loss, and in estimating the loss they divided the total loss between the boilers and the vessel without the boilers in proportion to their relative cost; thus obtained, the loss attributable to the boilers was about 5,000*l*. Lord Davey said: "It appears, however, on cross-examination, that the tenders for the 'Speedy' . . . contained separate prices for the boilers and for the boat, and the difference between the contract price and the actual cost of the boilers of the 'Speedy' was 688*l*. only. Their lordships think that the

(*r*) See Lord Brougham's remarks in *Galloway's Patent*, 1 W. P. C. at p. 729.

(*s*) See *In re Betts' Patent*, 1 Moo. P. C. N. S. 49, also *Willans and Robinson's Patent*, 13 R. P. C. 550.

proportion of loss attributed to the boilers is ascertained on a fallacious principle. . . . No explanation whatever has been offered why this large loss was incurred in building boats fitted with the patent boilers for themselves, while a handsome profit was made on supplying the boilers for boats built by other builders. In the absence of any explanation, the facts proved are consistent with the existence of some error of judgment, miscalculation, or other defect in the petitioners' mode of carrying on their business of boat-building."

Deduction allowed.

In estimating profits, a deduction will be allowed for the expenses of experiments in bringing the invention to perfection (*t*).

The expenses of taking out the patent will be allowed as deduction (*u*). So also will the expenses incurred in bringing the invention into general public use (*x*). 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 (*y*). The amount allowed will depend on the circumstances of the case (*z*), but it must be quite clear to what extent the patentee has given his time (*a*). 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 (*b*), but where the relations between the inventor and the agent were those of partners, the share of the agent had to be brought into account as profits (*c*). And deductions will also be allowed in respect of the costs of litigation necessary to maintain the validity of the patent, and to restrain infringers (*d*). But not where actions

(*t*) *Bate's Patent*, 1 W. P. C. 739, n.; *Kay's Patent*, 1 W. P. C. 572; *Davies's Patent*, 11 R. P. C. 28.

(*u*) *Roberts' Patent*, 1 W. P. C. 575.

(*x*) *Galloway's Patent*, supra.

(*y*) *Carr's Patent*, L. R. 4 P. C. 539; *Michell's Patent*, 36 R. P. C. 230.

(*z*) *Bailey's Patent*, 1 R. P. C. 2.

(*a*) *Turner's Patent*, 2 R. P. C. 177.

(*b*) *Poole's Patent*, 4 Moo. P. C. N. S. 452; L. R. 1 P. C. 514.

(*c*) *Pieper's Patent*, 12 R. P. C. 292.

(*d*) *Kay's Patent*, 1 W. P. C. 572: *Galloway's Patent*, 1 W. P. C. 729; *Betts' Patent*, 1 Moo. N. S. 62.

have been compromised improvidently, and costs abandoned without sufficient reason (*e*).

Profits of interested parties.

The profits of persons interested in the patent, such as part assignees or free licensees (*f*), must be shown, but not necessarily those made by licensees who pay a royalty (*g*).

And in *Johnson's Patent* (L. R. 4 P. C. 75), Lord Justice James said: "Their lordships are of opinion that, where the question to be considered is, whether an invention has been sufficiently remunerative 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*" (*h*).

Future profits and foreign patents.

Probable future profits must also be taken into account. In *Johnson's Patent* (25 R. P. C. at p. 727), Mr. Justice Parker said: "For the purpose of considering whether a patentee has been inadequately remunerated I am of opinion (1) that profits on his corresponding foreign patents as well as on his English patents must be taken into account, and (2) that some allowance ought properly to be made for profits *which, though not yet received, will in all probability be received* in respect of both the English and the foreign patents before their expiration. The petitioner in the present case admits a realised profit in respect of the American patent of some 7,500*l*., and in respect of the English patent of over 1,000*l*. Unless something very unforeseen happens, he will receive further profits in respect of both the English and American patents, and he anticipates that under the American patent his receipts will be very considerable—more, in fact, than he has yet realised in America. Under these circumstances I am not satisfied that he can be said to have been inadequately remunerated, having regard to the nature and character of his invention."

(*e*) *Hill's Patent*, 1 Moo. N. S. 1 P. C. 118; 3 Moo. P. C. N. S. 488; 258.

(*f*) *Thomas' Patents*, 9 R. P. C. 367, 373.

(*g*) *Thomas' Patents*, 9 R. P. C. 367; cf. *Trotman's Patent*, L. R. *Cross and Bevan and Beadle's Patent*, 23 R. P. C. at p. 491.

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

Where the patent has been granted on a communication from abroad it must be established that the foreign inventor has been insufficiently remunerated, or at least sufficient information must be given to enable the Court to form an opinion as to his position in the matter (*i*).

Sect. 25 of the Patent Law Amendment Act, 1852, provided that letters patent obtained in the United Kingdom for inventions first patented abroad 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 (*k*). 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 (*l*).

This Act, however, was specifically repealed, by sect. 113 of the Act of 1883, and dealing with this repeal and its effect, Lord Watson, in *Semet and Solvay's Patent* (12 R. P. C. 17), said: "But the lapse or expiry of foreign patents remains, as it always has been, one of the circumstances which must necessarily be considered. . . . In cases where the prolongation of a patent would place the inhabitants of Great Britain and Ireland at a disadvantage in competition with the subject of a foreign State, that circumstance must militate strongly against its extension. Whether the disadvantage, either certain or probable, ought to outweigh the right of the patentee to obtain a renewal upon other grounds, must always be a question of degree, to be decided according to the special circumstances of each case (*m*). But the profits derived from foreign patents must be set out clearly, as they are considered with 'all the circumstances of the case'" (*n*).

(*i*) *Peach's Patent*, 19 R. P. C. 65.

(*k*) *Newton's Patent*, 15 Moo. P. C. C. 176.

(*l*) *Betts' Patent*, 1 Moo. P. C. N. S. 49; but see *Blake's Patent*, L. R. 4 P. C. 535; 9 Moo. P. C. N. S. 373.

(*m*) And see *Pieper's Patent*, 12 R. P. C. 292.

(*n*) *Newton's Patent*, 1 R. P. C. 177; *Barff and Bower's Patent*, 12 R. P. C. 385.

In *Schwerin's Patent* (31 R. P. C. 299), the petitioners were allowed to give primâ facie proof of devolution of interest of foreign persons and of their accounts by sworn declarations. Practice.

The practice is regulated by rule 3 of Order LIIIA (see Appendix), which, "taken in connection with the rules of the Supreme Court which (by rule 2) are made applicable, forms in itself a code by which all questions relating to petitions for the extension of patents ought to be governed as to matters of practice" (*o*).

A petition for extension presented prior to the automatic extension of two years provided by the Act of 1919 will apart from special circumstances be adjourned for two years to enable the Court to ascertain whether the patentee has been adequately remunerated.

The practice is substantially similar to that under the Privy Council Rules, and cases decided by the Privy Council will guide the Court.

Two or more patents might be made the subject of one petition (*p*). The Attorney-General appears on behalf of the Comptroller and the Board of Trade. His duty is as much to assist and instruct the Court as to oppose, and indeed only to oppose when in his judgment prolongation should not be granted (*q*).

Any person may give notice of opposition, which must be lodged and served before the day named in the petitioner's advertisements as that on which he intends to apply for a day to be fixed for hearing the petition, and no extension of the time will be granted unless good reason is shown (*r*). The petitioner must then serve a copy of the petition upon the objector, who within three weeks of such service must serve upon the petitioner "particulars of objections" (rule 3 (1)). Time for delivery of particulars may be extended (*s*).

(*o*) Parker, J., in *Johnson's Patent*, 25 R. P. C. at p. 544.

(*p*) *In re Clark's Patent*, L. R. 3 P. C. 421; *Johnson's and Atkinson's Patent*, L. R. 5 P. C. 87; *Church's Patent*, 3 R. P. C. 95.

(*q*) *Stoney's Patent*, 5 R. P. C. 522.

(*r*) *Hopkinson's Patent*, 13 R. P. C. 114.

(*s*) *Barton's Patents*, 29 R. P. C. 207.

In *Johnson's Patent* (25 R. P. C. 542), among other matters, the objector stated that the alleged invention "was not novel." A summons was taken out for further and better particulars, and Parker, J., said: "It . . . appears to me that rule 3 (l) is drawn in such a way as to give the Court considerable latitude as to what particulars it may in any particular case be necessary and proper for the objector to give. On the one hand, I do not think it would be at all desirable that a bonâ fide objector should be bound down by objections given at an early stage of the proceedings, or rather particulars of the objections given at an early stage of the proceedings, because he might acquire some valuable evidence on, say, the question of novelty which it would be his duty at a subsequent stage to communicate to the Court on behalf of the public (*t*). On the other hand, it would be only fair, having regard to the nature of the proceedings, that he should be tied down, and accordingly that provision is made in the rule. In considering what particulars of the objections, on which he is entitled to rely and of which he gives notice, he ought to give in the document which states the grounds of his objection, I think that really the considerations which apply are those considerations which apply to pleadings generally. It is, in my opinion, only fair that a petitioner should at the earliest possible stage get to know what it is alleged prevents his patent from being considered novel or from having subject-matter. . . . If any prior user is intended to be relied on, some particulars of that prior user ought to be given, and it ought not to be sprung upon the petitioner at the trial. . . . Similarly, if there has been anticipation by a document, he ought to be informed what that anticipation is, because the existence of that anticipation may lead him to withdraw his petition."

The Crown may rely on prior publications without giving any notice (rule 3 (t)).

The Court may give costs to or against opponents (rule 3 (u)). Where the petition had been very honestly prepared

(*t*) See *Ball's Patent*, 4 A. C. 171; *Livet's Patent*, 9 R. P. C. 327. *Stewart's Patent*, 3 R. P. C. 9;

and the invention was of merit, but the petition was dismissed on the ground that the petitioner had been sufficiently remunerated, and the effect of the opposition had been merely to prolong the inquiry, costs were refused the opponent (*u*).

Under rule 3 (v), following the Privy Council practice as laid down in *Wield's Patent* (L. R. 4 P. C. 92; 8 Moo. P. C. N. S. 300), the Court will not, save under special circumstances, grant more than one set of costs amongst all the opponents. **Opponent's costs.**

Rule 3 (s), corresponding to rule 7 of the old Privy Council rules, enables the Court to excuse petitioners and opponents from compliance with the rules and to give such directions in matters of procedure and practice as it shall consider just and expedient (*v*). This does not, however, enable the Court to excuse non-compliance with statutory requirements (*w*).

The Privy Council in *Goucher's Patent* (2 Moo. P. C. N. S. 532) decided that, having once granted an extension, they had no power to entertain a petition for a further extension under the laws then in force. The reasoning is applicable to the present law in applications by petition, and was followed by Parker, J., in *Thompson's Patent* (No. 2) (26 R. P. C. 673).

It is the practice for the Court to make an order for a new grant for the further term specified and containing such terms and conditions as may be imposed.

By sect. 7 of the Act of 1919 an additional ground for granting an extension of the term of a patent is added in the form of sub-sect. 6 of sect. 18 of the Act:—

(6) "*Where, by reason of hostilities between His Majesty and any foreign state, the patentee as such has suffered loss or damage (including loss of opportunity of dealing in or developing his invention owing to his having been engaged*

(*u*) *Muntz's Patent*, 2 W. P. C. 122.

(*v*) See, *e.g.*, *Lindon's Patent*, 14 R. P. C. 643 (extension of time for advertising); *Barton's Patents*, 29 R. P. C. 207 (extension of time for delivery of objections); *Stearn's Patents*, 28 R. P. C. 663, and *Steffen's Patent*, 33 R. P. C. 324 (effect of vacation).

(*w*) *Adam's Patent*, 16 R. P. C. 1.

in work of national importance connected with such hostilities) an application under this section may be made by originating summons instead of by petition, and the Court in considering its decision may have regard solely to the loss or damage so suffered by the patentee:

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

It would appear that in seeking an extension under this sub-section while a patentee is not bound to furnish accounts for the whole life of the patent, but only sufficient to show the loss or damage during the war, yet, as the greater the difference between pre-war profits and the diminished profits or losses during the war the greater his claim may be for an extension (*x*), he may be well advised to follow the ordinary practice as regards accounts. Loss or damage by reason of hostilities may clearly continue after hostilities have ceased.

The discretion given to the Court by the Act of 1919 to enlarge the time within which a petition may be presented applies equally to applications made by originating summons, and in both cases the discretion may be exercised in favour of a patentee whose patent has expired (*y*). The ordinary practice of originating summonses will be followed, and the summons will usually be adjourned into Court and tried on affidavit evidence subject to the right of the law officer or any opponent to make an application to cross-examine (*z*).

Rule 3A has been added to Order LIIIA to regulate the practice under sub-sect. (6), and it should be observed that sub-sect. (u) of this rule provides that a patentee applying for an extension by petition may rely in his petition on the special grounds added by the Act of 1919.

It is submitted that procedure by originating summons will be before the special judge appointed by the Lord Chancellor

(*x*) In *Brown's Patents*, 37 R. P. C. at p. 55, and at p. 142.

(*y*) Ibid. at p. 54.

(*z*) Ibid. at p. 56.

under sect. 92 (2) of the Act of 1907, and that his decision will be final as in the case of petitions for extension (*a*).

The proviso disentitling ex-enemy patentees from taking advantage of this procedure may cause hardship to British exclusive licensees who may have been unable to work the invention during the war. In such a case the exclusive licensee might, however, arrange for a voluntary or compulsory assignment under the provisions of the "Divesting Order" of the Board of Trade (see Chap. XVIII.) and so become the "patentee."

It has been decided by Sargant, J., in *Davidson's Patents* (37 R. P. C. p. 145), that applications by originating summons are, like those by petition, to be made very shortly before the six months prior to the expiration of the patent. The judge also held that, although the sub-section provides that the Court may have regard solely to the loss or damage suffered by the patentee by reason of hostilities, it may also have regard to the remuneration received by the patentee over the whole period of the life of the patent where this has been excessive, or to his failure to push the invention subsequently to hostilities or to the injurious effect an extension might have on the industry of the country. And although he did not state that absence of that quantum of merit, which a patentee seeking extension by petition must prove, might be a reason for withholding the extension, there does not seem to be any reason why the Court should not also take the question of merit into consideration. This decision would also appear to necessitate a separate summons in respect of each one of a number of patents if they expire at different dates, although they may all deal with the same manufacture which was interfered with by reason of the hostilities.

(*a*) *Davidson's Patent*, 37 R. P. C. p. 145 (in the Court of Appeal).

CHAPTER XIII.

ABUSE OF MONOPOLY, SECTION 27.

THE amending Act of 1919 has defined the policy of the Patent Law in terms which mark a reversion to the view, long in abeyance, that the establishment of a manufacture is as important as the reward of invention. "*It shall be taken that patents for new inventions are granted not only to encourage invention but to secure that new inventions shall so far as possible be worked on a commercial scale in the United Kingdom without undue delay*" (*a*).

History of Law.

For many years there had existed provisions whereby a patentee who unreasonably used his patent to prevent the working of the invention might be compelled to grant compulsory licenses, and the law has been gradually strengthened until at the present day a patentee is held to abuse his monopoly if he fails to establish the working of his invention by himself or others.

Under the Act of 1883, where the patentee abused his monopoly in such a manner that (1) the patent was not being worked in the United Kingdom; or (2) the reasonable requirements of the public with respect to the invention were not satisfied; or (3) any person was prevented from working or using an invention of which he was possessed, the Board of Trade might be petitioned to order the patentee to grant a compulsory license upon such terms as the Board might deem reasonable. The Board appointed a referee, who heard the parties and reported to the Board, but every case so dealt with resulted in a compromise, the order made was by consent, and the terms thereof were never published. There were only a few cases reported of the enactment having been put in force.

(*a*) See proviso to sect. 27, sub-sect. (2) of the Act of 1907 as amended.

By sect. 3 of the Act of 1902 the provisions of the Act of 1883 with respect to compulsory licenses were repealed. The petition was thereafter to be referred to the Judicial Committee of the Privy Council, who might order a compulsory license, or in cases where the Committee were of opinion that the granting of licenses would be an inadequate remedy they might revoke the patent.

The provision in this enactment for revocation of the patent marked a change in the attitude of the law towards the privileges conferred by letters patent, and probably a reversion to the earlier policy of the Crown. In Mr. J. W. Gordon's learned work on "Compulsory Licenses," published in 1899, the history of the law is discussed in a most interesting manner. The author points out that it is only in comparatively recent times that the Courts have adopted the view that the abuse of his privileges by the patentee has been deemed no ground for invalidating the patent (*b*).

No cases are reported of the Act of 1902 having been put into force.

By sect. 24 of the Act of 1907 the Court was substituted for the Judicial Committee of the Privy Council as the tribunal for granting compulsory licenses or for revoking the patent on the petition of a person who alleged that the reasonable requirements of the public with respect to a patented invention had not been satisfied, and sect. 37 of that Act enabled the Comptroller to revoke a patent on the application of a person who could prove that the invention was carried on wholly or mainly abroad, and the decision of the Comptroller was made subject to an appeal to the Court.

The Act of 1919.

By the Act of 1919 sects. 24 and 37 of the Act of 1907 are repealed, and the matter of abuse of monopoly rights is dealt with by the new sect. 27. Sub-sect. 1 enacts that "*any person may at any time apply to the Comptroller alleging in case of any patent that there has been abuse of the monopoly rights thereunder and asking for relief under this section.*"

(*b*) See *Badische Anilin und Soda Fabrik* v. *W. G. Thompson & Co.*, 21 R. P. C. 473; and *Hatschek's Patent*, 26 R. P. C. at p. 244.

Applicant must show interest.

It must be remembered that the words "*any person*" are also used in sect. 11, and have been construed in that section to mean a person with some sort of grievance. By sub-sect. 8 of sect. 27 the applicant is obliged to show a "bonâ fide interest."

Abuse of monopoly.

Sub-sect. 2 defines certain circumstances which are to be deemed abuses of monopoly rights, and it is in this respect that wide changes have been made in the law. "*The monopoly rights under a patent shall be deemed to have been abused in any of the following circumstances:—*

First kind of abuse.

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

By sect. 93, "'*working on a commercial scale*' *means the manufacture of the article or the carrying on of the process described and claimed in a specification for a patent in or by means of a definite and substantial establishment or organisation, and on a scale which is adequate and reasonable under all the circumstances.*"

The period of four years from the date of the patent has been fixed to correspond with Article 5 of the International Convention, which prescribes a minimum term of three years from the date of application, which may be a year later than the date of the grant.

N.B.—As to the effect of Articles 307 and 308 of the Treaty of Peace and the Patents and Designs (Partial Suspension) Act, 1915, on the period to be taken into account as affected by the War, see Chap. XVIII.

"Patented invention."

The meaning of the words "patented invention" require some discussion in considering the obligation on the patentee to establish a manufacture on a commercial scale. In the case of an invention involving a small improvement in a complicated machine a question has arisen as to the obligation on the patentee to manufacture. The patent may be for the combination of old parts, and it has been asked whether the mere assembling in this country of parts made abroad is a compliance

with the section. The Comptroller, in the case of *Lake's Patent* (26 R. P. C. at p. 447), said: "As a general rule a patentee ought not to be called upon to manufacture any mechanism or machine which he has not specifically described and claimed in his specification. . . . There may be, of course, cases in which it is impossible to sever the various elements claimed in combination, and in such cases different considerations may arise. If, however, the general principle stated is correct, the following general results would seem to follow, viz: If the patentee has claimed a wholly new machine or mechanism, he must manufacture that in this country or run the risk of coming within the provisions of sect. 27. If he claims a new improvement in a well-known machine, he must manufacture the improvement, and not necessarily the whole machine; but if he claims the improvement in combination with a machine consisting of well-known parts it may be that he must besides manufacturing the improvement put together the whole machine in this country, or at any rate the combination he claims. If his invention merely consists in a new combination of old and well-known elements, it would seem sufficient for him primâ facie to put together the whole machine in this country, and it is not necessary for him to manufacture the old and well-known parts which are also possibly the subject-matter of prior patents; but different considerations may again arise where important alterations in the known parts are necessary for the new combination. Each case must of course be decided on its merits; and in each case it will have to be determined on a proper construction of the patentee's specification, what the patentee's invention really is, and what are its essential features."

In the case of *Hill's Patent* (32 R. P. C. p. 475), the invention related to a knitting machine, and the first claim was for, "in a circular warp knitting machine, the employment of sinker blades" of a specified type. The applicant proved that such machines were mainly used in Germany. The applicant did not prove, however, that the machines were mainly manufactured abroad, and the Comptroller held that inasmuch as the patented invention was a machine and not a process, the applicant had

not discharged the burden of proof that the "patented article" was wholly or mainly manufactured abroad.

Adjournment for disclaimer.

Where the Comptroller is prepared to find that a patentee, though manufacturing in this country, is not manufacturing sufficiently having regard to his existing claims, he might reasonably be asked by the patentee for an adjournment to enable the specification to be amended by disclaimer of the parts not manufactured here.

Manufacture by infringers.

The words "*patented invention*," like the words "*patented article or process*" in the repealed sect. 27, do not imply that a patentee to escape the penalties imposed for non-working must prove that any working on which he relies as a defence must have taken place with an acknowledgment of his patent rights; they are descriptive of the manufacture itself, and consequently he may rely upon manufacture by infringers (*c*).

"Satisfactory reason."

The important question under the section is as to what will be held to be a "*satisfactory reason*" to account for such non-working.

Under the repealed section an applicant had to show that the patented invention was worked exclusively or mainly abroad, and the patentee had to furnish "*satisfactory reasons*" why manufacture "*to an adequate extent*" in the United Kingdom was not carried on to escape the penalties imposed. The cases decided under that section are of some assistance in construing the words "satisfactory reason" under the present section. It must be remembered that under the former section, if the invention was not being worked *anywhere*, the attack on the patentee failed (*d*), the essential comparison having been made between the extent of foreign as compared with home manufacture. This is no longer the case: the patentee has to account for the fact that working in this country has not been established "on a commercial scale" (which in this case would seem to mean much the same as the words "adequate extent" in the former Act), and not for the fact that the manufacture is carried on exclusively or mainly abroad. Nevertheless, in many respects the reasoning applied to

(*c*) *Mercedes Daimler Co.'s Patents*, 27 R. P. C. 762.

(*d*) *Jonkergouw and Destrez's Patent*, 28 R. P. C. 423

the old section is in many cases applicable to the present one.

In *Hatschek's Patent* (26 R. P. C. at p. 241), Parker, J., said: "I do not think that any reasons can be satisfactory which do not account for the inadequacy of the extent to which the patented article is manufactured or the patented process is carried on in this country by causes operating irrespective of any abuse of the monopoly granted by the patent. The first thing, therefore, for the patentee to do is, by full disclosure of the manner in which he has exercised his patent rights, to free himself from all suspicion of having done anything to hamper the industry of the United Kingdom." The learned judge then went on to deal with the case of a patentee who had favoured foreign manufacturers to the disadvantage of Britishers. Under the new section, although the British and foreign manufacturers may have been treated on an equality by the patentee, he is under the further obligation to furnish an explanation of the circumstances which have prevented the establishment of commercial manufacture at home. On this point the observations of Parker, J., at p. 243, are applicable: "It was suggested that if a patentee could prove that an industry in a patented article or founded on a patented process could not be carried on in this country or as profitably as it could be carried on abroad owing to difference in the cost of material or labour, or other local conditions, he would have given a satisfactory reason within the meaning of the section. I do not think this suggestion is entirely correct. Certainly the fact that persons who were carrying on the industry in this country would make smaller profits than persons carrying it on abroad would, in my opinion, be no satisfactory reason at all . . . it can never, in my opinion, be sufficient for a patentee, defending himself under the section, to prove that he cannot now start an industry with any chance of profit." The last quoted sentence of the learned judge needs explanation; he goes on to say that proof that the proposed industry would have no chance of profit would not avail the patentee in cases where he had favoured the foreign at the expense of the British manufacturer, and the foreign manufacture had in consequence become firmly

Manufacture here unprofitable.

established and defied competition. It is suggested that in the absence of such abuse of the monopoly proof that there was no hope of profit or a reasonable anticipation of loss by any one working the invention in the circumstances of the times would under the new section constitute a "satisfactory reason" (*e*).

Absence of demand.

The proof of absence of any special demand for the invention in this country is not a satisfactory reason unless the patentee has taken all those steps to create a demand which a reasonable business man in this country would take, more especially if there is a demand abroad. "The consideration of the adequacy of manufacture in this country does no doubt depend to some extent upon the demand existing for the article here or in neutral markets, but it does not follow that, if there is no demand existing, there is no obligation on a patentee to start an industry here. If he does in fact manufacture in foreign countries, and if there is in fact a demand for the article or process abroad, the absence of any demand here does not seem to be a valid excuse. The patentee must in such cases, make an effort to create a demand here, and the establishment of an industry will in itself help to create in many cases a demand for the article or process in question" (*f*).

Export trade.

The reference by the Comptroller to the "demand in neutral markets" shows that in considering the question of demand regard must be had to the possible export trade with countries, in which the importer would not be liable to actions for infringement, as well as to the demand for internal consumption in the United Kingdom. On the other hand, where the type of engine to which the invention was applicable had been almost superseded, and it would not have been commercially advisable to establish a manufacture in this country of the patented mechanism, and the patentee had done no more than to charge royalties on imported French machines of a special kind, containing the patented mechanism, it was held that he had furnished a satisfactory reason (*g*).

(*e*) See, *e.g.*, the observations of the Comptroller in *Boult's Patent*, 26 R. P. C. at p. 387; also *Kent's Patent*, 26 R. P. C. 666.

(*f*) *Boult's Patent*, 26 R. P. C. at p. 387.

(*g*) *Osborn's Patent*, 26 R. P. C. 819.

Price as affecting demand.

The matter of the price charged for articles made at home as compared with that asked for the imported article may be a cause of a small demand, and it then becomes necessary to inquire whether the price charged is a bonâ fide one, and not merely adopted for the very purpose of checking and diminishing the demand for the home manufactured article (*h*).

Lack of capital.

Lack of capital would furnish a satisfactory reason provided that the patentee could show that he had done everything that would be expected of a reasonably capable business man to obtain financial assistance or to obtain licensees.

Fear of infringement action.

Where the patentee showed that he dared not establish manufacture in this country for fear of infringement proceedings under a master patent which was in fact owned by the applicants for revocation of his patent, Parker, J., held that the patentee was not bound, as the applicants contended, to apply for a voluntary or a compulsory license under the applicants' patent (*i*), although had the applicants been able to show that they had been ready and willing to grant the patentee a license under reasonable terms the decision might have been otherwise.

Preclusion by contract.

Patentees who obtained their patents before the Act came into force are in nearly all respects in the same position as those who obtained them after the Act, and a patentee is not entitled to rely upon a contract made before the Act precluding him from manufacturing in this country. Parker, J., in *Hatschek's Patent* (26 R. P. C. at p. 244), said: "I totally dissent from the contention that, if a patentee has before the Act precluded himself by contract from working his patent in this country, the existence of such a contract is a satisfactory reason within the meaning of the section for not working here. As I have said before, no such reason can be satisfactory which does not operate independently of any misuse which the patentee has made of his property."

Requisite skill exclusively foreign.

It will not avail the patentee to allege that the special skill and experience necessary to enable the invention to be carried

(*h*) *Kent's Patent*, 26 R. P. C. at p. 670.

(*i*) *Taylor's Patent*, 29 R. P. C. 296.

into effect can only be found abroad (*j*), although it may well be that an invention requiring special skill and the establishment of a factory with special tools may require a longer time to develop than one in which these features are not present. It is incumbent on the patentee to take steps to import the necessary tools and skilled labour, and to effect manufacture in this country at the earliest possible moment. In *Kent's Patent* (26 R. P. C. at p. 670), the Comptroller said: "I shall always decline to accept, as a rule, any argument based on the impossibility of securing an efficient manufacture of special machinery in this country, but I think it is natural for a patentee who desires to put the best possible machine upon the market to be somewhat over-scrupulous at first in obtaining his materials, and supervising the construction of his machine."

Generally speaking, if the patentee can be shown to have done his best to establish a manufacture in the United Kingdom, and has failed for reasons beyond his control, he will not be held to have abused his monopoly. In *Bremer's Patent* (26 R. P. C. at p. 465), Parker, J., said: "In my opinion, the company have throughout used, and still are using, their best endeavours to fulfil the obligation arising under the Act of 1907 by establishing in this country an industry in the article, the subject of their patent, and they have further proved, to my satisfaction, that their want of success up to the present time has been due to circumstances beyond their own control, and not to the manner in which they have exercised the rights conferred upon them by the patent in question. The Act of 1907 was never meant to penalise want of success when the patentee has done his best, and I cannot, therefore, come to the conclusion that the patent ought to be revoked."

Power to adjourn.

When, in spite of the lapse of four years from the date of the patent, the circumstances are such as to justify the Comptroller in affording the patentee more time to comply with the section he may do so; sub-sect. 2 (a) concludes thus: "*Provided that if an application is presented to the comptroller on this ground, and the comptroller is of opinion that the time*

(*j*) *Johnson's Patent*, 26 R. P. C. 52.

which has elapsed since the date of the patent has by reason of the nature of the invention or for any other cause been insufficient to enable the invention to be worked within the United Kingdom on a commercial scale, the comptroller may adjourn the application for such period as will in his opinion be sufficient for that purpose." This power to adjourn should be compared with the power to make a deferred order *nisi* conferred by sub-sect. 3 (d), and will be dealt with in connection with that sub-section.

Second kind of abuse.

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

By sub-sect. 13: "*For the purposes of this section the expression "patented article" includes articles made by a patented process.*"

Importation.

The paragraph would appear to cover any such underselling of workers of the invention by means of importations by the patentee or his licensees or infringing importers as would make the working by licensees in the United Kingdom an unprofitable venture. It would, moreover, appear open to any one who proposed to start a manufacture of the article, even if he had not yet a license, to set the machinery of the Act in motion.

It will be noticed that competition by importing infringers only is a grievance under this paragraph. Infringement by persons manufacturing in this country is, as has been seen under paragraph (a) above, wholly in favour of the patentee.

Application may be made to the Comptroller on the grounds defined by this and subsequent paragraphs of the sub-section at any time after the grant of the patent.

The patentee's defence would appear to be confined to a denial of the facts alleged as to importation, or to the assertion that such importation as had taken place had not the effect of preventing or hindering manufacture in the United Kingdom.

In some cases, especially in the case of an invention communicated from abroad, such importation might be necessary and desirable for the purpose of stimulating a demand for the patented article. The facts having been proved, it is not open to the patentee, as under the preceding paragraph, to offer anything in the nature of "satisfactory reasons." He might obtain an adjournment in order to sue the infringing importers.

Third kind of abuse.

(c) "*If the demand for the patented article in the United Kingdom is not being met to an adequate extent and on reasonable terms.*" The whole point of this paragraph lies in the words "on reasonable terms." The words used are much the same as in sub-sect. 5 (a) of the repealed sect. 24 (*q.v.*), which were interpreted by Warrington, J., in the *Robin Electric Lamp Co.'s Petition* (32 R. P. C. at 202).

In the first place the learned judge held that it was not enough to show that the interests of a particular individual were adversely affected, but that the section aimed only at behaviour on the part of the patentee prejudicial to a particular trade as a whole or to the general public. This part of the decision is not now of great importance, because paragraphs (d) and (e) of the new section provide for cases in which individuals have a grievance.

The remainder of the judgment is, however, of importance, inasmuch as it will probably affect the construction which will be placed on paragraph—

Fourth kind of abuse: refusal of licenses.

(d) "*If, by reason of the refusal of the patentee to grant a license or licenses upon reasonable terms, the trade or industry of the United Kingdom or the trade of any person or class of persons trading in the United Kingdom or the establishment of any new trade or industry in the United Kingdom is prejudiced, and it is in the public interest that a license or licenses shall be granted.*" The two paragraphs may together be compared with the former sect. 24, sub-sect. 5. Opinions based on considerations of public policy may well vary as to what constitutes a proper protection of the "public interests," and as usual in modern legislation Parliament has shifted the burden of a question properly within its own province on to the

shoulders of an administrative officer with an appeal to a judge of the High Court.

In the case referred to above the learned judge said: "A patentee may use the advantage given by his patent, either by putting it into operation himself and supplying the public with the article, or by licensing others to do so. If he himself maintains an adequate supply there is no necessity from the public point of view, for the granting of licenses, and, in my opinion, sub-sect. (5) contemplates these alternatives as legitimate modes of working a patent. It is not enough, in my judgment, for a petitioner to prove that the patentee makes default in one of these two alternative modes; he must prove that he has made default in the other also." It would seem that this reasoning, and especially from the learned judge's words "from the public point of view," that an applicant who desires to manufacture something in which the patented article is an essential ingredient, and who is refused a license, may be met with the allegation that the patentee is ready and willing to supply him with the patented article ready made, and this will be sufficient to show that "in the public interest" a license should not be granted.

Price is clearly an element to be considered in applying the words "reasonable terms" in paragraphs (c) and (d), and here the question arises as to what is a reasonable remuneration to a patentee as such. There have been numerous decisions in cases of applications for suspension of enemy-owned patents during the war, in which a royalty of 5 per cent. on the selling price of the patented article has been deemed adequate, but it is highly unlikely that such low terms would be a criterion of price under the new sections. And in the *Robin* petition above referred to, the fact that the patentees asserted a right to remuneration, which made the articles in which the patented invention was used, sell at a very much higher price than could be obtained on the continent, was held not to be an excessive claim in the circumstances. No doubt the speculative nature of an industry founded on patent rights, the difficulty of establishing the particular industry, and the need for a large capital expenditure are all matters which should be taken into consideration in fixing price as an element of "reasonable terms."

Fifth kind of abuse: unfair conditions of sale.

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

This paragraph covers more than the objectionable conditions which are rendered unlawful by sect. 38. The word "unfairly" is the keynote of its interpretation and application, and the meaning given to it depends again on political and economic views. The exhortation contained in the final proviso is not helpful in construing the section generally, and its effect remains to be seen.

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

THE REMEDY.

Sub-sect. 3 deals with the remedies to be administered by the Comptroller and the Court: "*On being satisfied that a case of abuse of the monopoly rights under a patent has been established, the comptroller may exercise any of the following powers as he may deem expedient in the circumstances:—*

First remedy: "licenses of right."

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

precluded the indorsement of the patent at the request of the patentee."

The circumstances of a patent indorsed "licenses of right" are dealt with in Chap. XI. After such an indorsement the patentee is, by virtue of sect. 24 (1) (f), only bound to pay half the renewal fees which would otherwise have been payable. The Comptroller has the widest powers in dealing with new licenses to be granted, in exchange for old licenses, to existing licensees subject to the conditions laid down by sect. 24 (b) for the guidance of the Comptroller. If an existing licensee is in the enjoyment of exceptionally favourable terms he naturally will not seek to effect the exchange; but, on the other hand, the new licensees will probably seek similar terms. A difficulty will arise in equalising the terms enjoyed by competing licensees when one of them has made a cash payment in lieu of royalties or in lieu of heavy royalties, or is under some collateral advantage or disadvantage such as the obligation to pay a salary to the patentee or enjoys the advantage of his assistance and experience as a term of the license.

It is clearly of the utmost importance that a licensee, in agreeing the terms of his license, should insist on a covenant by the licensor and on behalf of any other licensees that he and they shall do nothing which would constitute an abuse of monopoly rights. Such a covenant, while ineffective to prevent the exercise of his powers by the Comptroller, would give the licensee a right to damages.

This remedy will be used in cases in which the applicant, while able to prove an abuse of monopoly, cannot show that he in particular should be placed in any specially favoured position as regards other members of the public, otherwise the remedy in the next paragraph is applicable:—

Second remedy: license to applicant.

(b) "*He may order the grant to the applicant of a license on such terms as the comptroller may think expedient, including a term precluding the licensee from importing into the United Kingdom any goods the importation of which, if made by persons other than the patentee or persons claiming under him, would be an infringement of the patent, and in such case the patentee and all licensees for the time being*

shall be deemed to have mutually covenanted against such importation." Pausing at this point it is not clear whether this means that if the Comptroller exercises his power to grant a license to the applicant, rather than indorse the patent "licenses of right," that he is bound to impose the term on the licensee precluding importation, or whether the imposition of this term is permissive only among other terms which the Comptroller may deem expedient. It is probable that the later construction is correct. It is clear that the insertion of such a term automatically affects all existing licenses. To take a hypothetical case, let us suppose that A., a patentee, grants to B., C., and D. licenses to manufacture and sell, and to E., who does not wish to manufacture, he grants a license to sell the patented articles imported by E. from abroad with a restrictive covenant as to selling price and subject to a royalty. F. applies to the Comptroller alleging abuse of the monopoly under sect. 2 (c) alleging the excessive price of the article as supplied to the public by A. and his licensees, and showing that he (F.) has a claim to a license to himself. If the term is imposed the effect will be to destroy E.'s license altogether, inasmuch as the Comptroller has no power under this paragraph to modify the terms of licenses already in existence save in so far as this automatic modification is concerned. And if E. continued to import he could be sued by A. for damages for breach of covenant, and by F. for infringement (see below). By the concluding portion of the paragraph a licensee under a license so granted (but not other licensees?) may take action against infringers; this will be dealt with in the consideration of "Action for Infringement," Chap. XVI.

Third remedy: exclusive license to applicant.

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

comptroller may think just, but subject as hereinafter provided."

Under this paragraph, unless it be very carefully administered, the great manufacturing Trusts will be able to secure to themselves the benefit of any invention relating to their industry, and it would appear that their position is much strengthened. They will be able to show that no competitor is likely to enter the field of industry against them on the strength of a single patent, and that they and the companies under their control are alone in a position to finance the invention and establish its manufacture. On the other hand, the inventor will have the benefit of the protection of the Comptroller in fixing terms. A curious feature of this remedy is that the circumstances which are to give a claim to a compulsory license may in many cases have been actually brought about by the applicants. Before this section, an inventor if courageous enough to face the fact that he would never be able to get his invention adopted could nevertheless defy a wealthy corporation which controlled the industry. Under this section the corporation might force him (at a price to be fixed by the Comptroller who must deal with trade finances as put before him by the corporation) to hand over the invention to them. For these reasons it is essential that the Comptroller should require persons asking for an exclusive license to prove with great strictness that the patentee has abused his monopoly and should protect a solitary inventor from being overborne by a powerful trade combination.

Terms of compulsory exclusive licenses.

The conditions of a compulsory exclusive license under this section are generally prescribed by sects. 4, 5 and 6, which afford the Comptroller some vague guiding hints.

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

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

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

and in addition to any other powers expressed in the license or order, the license and the order granting the license shall be made revocable at the discretion of the comptroller if the licensee fails to expend the amount specified in the license as being the amount which he is able and willing to provide for the purpose of working the invention on a commercial scale within the United Kingdom, or if he fails so to work the invention within the time specified in the order."

It is difficult to see that this sub-section is anything more than a direction to the Comptroller to do justice to the best of his ability. None of the terms suggested is made compulsory, and the Comptroller may even dispense with the provision of a minimum royalty. An action for damages should lie against either party for failing to carry out the covenants imposed by the license apart from the revocability of the license by the Comptroller for breaches by the licensee, inasmuch as there are no stipulations against recourse to the law courts.

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

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

A question arises as to whether the exclusive licensee should not indemnify the patentee against an action for damages by a

licensee whose license is terminated against his will. It does not seem that such right of action would be affected by the fact that the order of the Comptroller renders the forfeiture compulsory. The existence of licenses which have been granted before the proceedings under the section will make the settlement of the terms of an exclusive license a very difficult matter.

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

In the case of an application alleging an abuse of monopoly rights under sub-sect. 2 (a) the proviso to that section allows of an adjournment: "*Provided that if an application is presented to the comptroller on this ground, and the comptroller is of opinion that the time which has elapsed since the date of the patent has by reason of the nature of the invention or for any other cause been insufficient to enable the invention to be worked within the United Kingdom on a commercial scale, the comptroller may adjourn the application for such period as will in his opinion be sufficient for that purpose.*"

Fourth remedy, revocation.

And by sub-sect. 2 (d): "*If the comptroller is satisfied that the objects of this section cannot be attained by the exercise of any of the foregoing powers, he may order the patent to be revoked, either forthwith or after such reasonable interval as may be specified in the order, unless in the meantime such conditions as may be prescribed in the order with a view to attaining the objects of this section are fulfilled, and the comptroller may, on reasonable cause shown in any case, by subsequent order, extend the interval so specified:*

"*Provided that the comptroller shall make no order for revocation which is at variance with any treaty, convention, arrangement of engagement with any foreign country or British possession*" (*k*).

Order *nisi* for revocation.

The power of the Comptroller to make an order *nisi* in cases where non-working had been proved, existed under the repealed

(*k*) As to the effect of this proviso, see Chap. XVIII.

section. In a case where the patentee had made no efforts until after the commencement of proceedings and said that he had misunderstood the meaning of the section, the Comptroller refused to allow further time and made an order revoking the patent forthwith (*l*). Where, however, the patentee had made some efforts which the Comptroller thought entitled him to consideration, a period of nine months was granted, and later on production of satisfactory evidence that the invention was being worked the order *nisi* for revocation was finally discharged (*m*).

Where there was no substantial working at the date of the application, but by the time the case came to a hearing such working had been established, the Comptroller refused the application for revocation (*n*).

Power to adjourn.

The power of adjournment to enable the patentee to have further time is only specified for the case of an application alleging abuse of monopoly under sub-sect. 2 (a), and then only when the nature of the invention or other circumstances show that the period of four years from the date of the patent has been insufficient. This is, of course, apart from the inherent power of any judicial tribunal to adjourn a case before it for good reason shown. In other cases it would appear that the proper course is either to make an order for one of the remedies referred to in sub-sect. 3 (a), (b) or (c), or to make an order *nisi* unless he decides to revoke the patent, or under (e). "*If*

Power to refuse order.

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

Practice.

Sub-sects. 7—12 deal with procedure which is further provided for in rules 79—84. The application is made in writing setting forth the facts and the relief asked for, and must be verified by declarations which must also support an allegation of interest. The Comptroller examines these, and if satisfied that a bonâ fide interest is disclosed and a primâ facie

(*l*) *Worring and Kortenbach's Patent*, 26 R. P. C. 163.

(*m*) *Weber's Patent*, 26 R. P. C. 300; 27 R. P. C. 30.

(*n*) *Boult's Patent*, 26 R. P. C. 383.

case for relief is made out directs the applicant to serve copies on the patentee and on all persons appearing, from the entries in the Register to be interested, and advertises the application in the *Official Journal*. The patentee or other person desiring to oppose the application delivers a counter-statement verified by declaration. The Comptroller may either dismiss the application at this stage unless any party demands a hearing, or he may appoint a hearing, and may require the production of books and documents relating to the issues (*o*).

Power to refer to arbitrator.

Sub-sect. 12 provides that if the parties consent, or "*if the proceedings require any prolonged examination of documents or any scientific or local investigation which cannot in the opinion of the comptroller conveniently be made before him the comptroller may at any time order the whole proceedings or any question or issue of fact arising thereunder to be referred to an arbitrator agreed on by the parties, or in default of agreement appointed by the comptroller, and in such a case if the parties consent the decision of the arbitrator shall be final.*"

Arbitrator's fees.

There is no provision under this section for the payment of the arbitrator's fees, and it is to be supposed that he will be paid by the Treasury. In arbitrations under claims for licenses under a patent which has been extended, the applicants have been compelled to pay the arbitrator's fees in order to obtain the award, but it is hoped that this practice will not be applied, having regard to the fact that under the concluding words of the sub-section, "*Where a question or issue of fact is so referred, the arbitrator shall report his findings to the comptroller,*" and the Comptroller could hardly withhold his decision in order to force the parties to pay the arbitrator's fees.

Appeal to Court.

By sub-sect. 11, "*All orders of the comptroller under this section shall be subject to appeal to the Court, and on any such appeal the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.*"

The procedure in appeals to the Court (the selected judge whose decision is final under sect. 92 (2)) is regulated by

(*o*) As to the power of the Comptroller in this matter, see ante, p. 192.

Order LIIIA, rules 4, 5 and 6. They must be presented by way of petition within one month (which may be extended) of the Comptroller's decision. The time for appealing runs during the long vacation (*p*). The petition is set down to be heard as a witness action, and by rule 6 "the evidence used shall be the same as that used at the hearing before the Comptroller, and no further evidence shall be given except by the leave of the Court on application to be made to the Court at or before the hearing." This means that the evidence must be confined to the same issues as those before the Comptroller, and that a party will not be allowed to set up a fresh case or to call further witnesses. It does not mean that the witnesses must repeat in the same words what they said before the Comptroller.

(*p*) *Beldam's Patent*, 27 R. P. C. 758.

CHAPTER XIV.

REVOCATION UNDER SECTION 25.

Revocation under sect. 25.

UNDER sect. 25, as amended by the Act of 1919 :—

"(1) *Revocation of a patent may be obtained on petition to the Court.*

"(2) *Every ground on which a patent might, immediately before the first day of January, one thousand eight hundred and eighty-four, have been repealed by* scire facias *shall be available by way of defence to an action of infringement and shall also be a ground of revocation under this section.*"

The Act of 1883 abolished the proceeding of *scire facias*, which had already fallen into desuetude, and had substituted the petition for revocation.

No declaration of invalidity.

An action cannot be brought claiming a declaration that a patent is invalid (*a*), the proper course being to petition for revocation, and it is probable that a petition would lie for the revocation of a patent which had expired (*b*).

Expired patent.

By sect. 30, sub-sect. 9, no petition for revocation will lie in respect of a patent granted for an invention which the Secretary of State or the Admiralty has certified should be kept secret in the interest of public service.

Grounds of revocation.

The grounds upon which a patent may be revoked are those upon which it might have been cancelled by *scire facias*. These are in the Fourth Institute (p. 88) said to be : "*Firstly*, when the king by his letters patent doth grant by several letters patent one and the self-same thing to several persons, the former patentee shall have a *scire facias* to repeal the second patent;

(*a*) *North-Eastern Marine Engineering Co.* v. *Leeds Forge Co.*, 23 R. P. C. 529; *Traction Corporation* v. *Bennett*, 25 R. P. C. 819.

(*b*) *North-Eastern Marine Engineering Co.* v. *Leeds Forge Co.*, supra.

sccondly," 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* (about 1680, 2 Vent. 344) that "where a 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 of the Act of 1883 (re-enacted as sub-sect. 3 of sect. 24 of the Act of 1907) very considerably narrowed and limited this general right.

Every ground of invalidity of the patent sued on 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 Act makes a distinction between persons who are entitled to petition as of right and persons who must first obtain the fiat of the Attorney-General; by sub-sect. 3—

"*A petition for revocation of a patent may be presented—*

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

"*(b) by any person alleging—*

Persons entitled of right.

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

"(ii.) *that he, or any person under or through whom*

he claims, was the true inventor of any invention included in the claim of the patentee; or

"(iii.) *that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.*"

As to Scotland, by sect. 94 (3), "*Proceedings for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only, and service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.*"

It is doubtful whether the Attorney-General for Ireland can grant the fiat.

It will be seen that it is necessary that one of the three grounds specified under clause (b) must be established in order to give the petitioner a locus standi unless he has previously obtained the fiat of the Attorney-General. But 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 (*c*).

The fiat of the Attorney-General.

If, however, the petitioner should fail to establish the ground which would have given him his locus standi, it is submitted that he cannot proceed upon the other grounds alleged by him, but must retire to obtain the fiat of the Attorney-General to enable him to allege such other grounds of objection. In *Max Müller's Patent* (24 R. P. C. 465) the petitioners proceeded without the fiat, alleging that certain persons through whom they claimed were the true and first inventors of the invention patented by the respondent, and relied also on other grounds affecting the validity of the patent. During the course of the trial it became doubtful whether the first ground

(*c*) *Morgan's Patent*, 5 R. P. C. 186.

of objection could be sustained. Parker, J., gave leave to the petitioners to apply for the fiat, which, if granted, was to be treated as having been granted *nunc pro tunc*, and directed that the petition should be treated as having been technically amended by inserting an allegation that the fiat had been obtained, and expressed a doubt as to whether the petitioners had any locus standi if the fiat were not granted. It is to be noticed, however, that if it were merely necessary to allege one of the grounds set forth in the sub-section in order to dispense with the fiat, without any obligation to prove it, no one would ever incur the expense and trouble of laying the case before the Attorney-General. In any case it is a useful measure of precaution to obtain the fiat. The hearing of the petition may be adjourned to enable the petitioner to apply for the fiat (*d*). The clauses defining the grounds which entitle a petitioner to proceed without the fiat are strictly construed, and care must be taken that the petition is framed under the proper clause.

In re Avery's Patent (L. R. 36 C. D. 307; 4 R. P. C. 322) was a petition for revocation presented under clause (c) (clause (i.) under the Act of 1907); 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 at p. 326: "If it is made out that the 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 . . . 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) (clause (ii.) under the Act of 1907).

(*d*) *Dege's Patent*, 12 R. P. C. at p. 452; *Jameson's Patent*, 19 R. P. C. at p. 250.

The opinion of the Court of Appeal on the words "in fraud of his rights" was followed in *Ralston's Patent* (26 R. P. C. 313), and Warrington, J., said (at p. 331): "It appears to be settled law that the expression 'in fraud of the rights of the true and first inventor' involves the idea of moral turpitude on the part of the patentee, but the existence of this element may be inferred not merely from his conduct prior to and at the time of the application or grant, but also from the use he makes of the grant when obtained, as, for example, by insisting, as against the true inventor, on treating the invention as his own."

There is no decision interpreting the words "under or through whom he claims" in paragraph (b) (i.), (ii.), and (iii.), but it probably means legal representatives (*e*). The Court, like the Comptroller, will not inquire into fraud which is alleged to have taken place abroad (*f*).

If the patent be revoked on the ground of fraud, the first and true inventor may apply to the Comptroller under sub-sect. 2 of sect. 15 for a patent to be granted to him in lieu thereof, but the Comptroller is not bound to accede to the application, and retains his discretion as in any ordinary application (*g*). This right will not apply where the petition is under clause (ii.) only.

To obtain the fiat.

In order to obtain the Attorney-General's 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 must be accompanied by all specifications and documents referred to.

2. A statutory declaration by the petitioner verifying the statements in the memorial; this also should be upon judicature paper.

(*e*) See discussion on a similar point under sect. 11 in Chap. IX. at p. 180.

(*f*) See Chap. IX., p. 180.

(*g*) *Norwood's Patents*, 12 R. P. C., per Stirling, J., at p. 219.

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.

The costs of obtaining the fiat are recoverable if the petition proves successful (*h*).

The seventh of the above-mentioned documents will not be required when it is proposed to counterclaim under sect. 32 for revocation in an action for infringement. Sect. 32 is as follows:—

Counterclaim for revocation.

"*A defendant in an action for infringement of a patent, if entitled to present a petition to the Court for the revocation of the patent, may, without presenting such a petition, apply in accordance with the rules of the Supreme Court by way of counterclaim in the action for the revocation of the patent.*" But it is to be noted that unless properly qualified a defendant must obtain the fiat of the Attorney-General for his counterclaim for revocation.

Formerly, if the defendant in an action for infringement desired the revocation of the patent sued on, he had to present a petition independently, and then apply for the two cases to be tried together.

Estoppel.

If the defendant does not counterclaim and obtain the revocation of the patent, a judgment in an action for infringement either for or against the validity of a patent does not create an estoppel in a petition for revocation. In *The Shoe Machinery Co., Ltd.* v. *Cutlan* (12 R. P. C. at p. 533), Smith, L.J., said: "We held in *Deeley's Patent* (12 R. P. C. 192) that in a petition for revocation of a patent there was no estoppel,

(*h*) *Poulton's Patent*, 23 R. P. C. 571.

because the person petitioning . . . stands as one of the public, and not as an individual; and although the person petitioning for revocation may be the same person against whom judgment has been given in a patent suit, there is no estoppel against him when he petitions, because he appears as one of the public" (*i*).

But as Farwell, J., said in *Jameson's Patent* (19 R. P. C. at p. 522), dealing with a prior decision on a point of fact in the infringement action: "At the same time, it is impossible for the judge who tries the second action, not to bear in mind the fact that, unless the witnesses are so obviously unimpeachable that there is no suspicion of an attempt to mislead the Court, it is a most dangerous precedent to allow witnesses to appear and attempt to supplement evidence which has proved deficient on the former occasion."

In *Poulton* v. *Adjustable Cover and Boiler Block Co.* (25 R. P. C. 559, 561) judgment had been obtained by the patentee against the defendant, and an inquiry into damages had been ordered. Before the inquiry was held the patent was revoked on the petition of the defendant who adduced further reasons for attacking its validity. It was held that this fact did not preclude the inquiry from being prosecuted and the damages recovered. Parker, J., decided the case on the basis of an estoppel operating against the defendant. The Court of Appeal confirming the judgment decided on the basis of *res judicata*.

The Attorney-General has absolute discretion in granting or refusing his fiat; but cases are unlikely to arise in which the fiat will be refused (*k*). If the applicant shows sufficient interest, and makes out a good case, the Attorney-General will grant his fiat without hearing the patentee, but in some cases (*e.g.*, as in *Martin's Patent* (Griff. P. C. 320), where the applicant was a licensee under the patent) he has directed notice to be given to the persons interested in the patent, and heard both parties and given his decision in the ordinary way. Sir H. James,

(*i*) And see *Re Lewis' Patent*, 14 R. P. C. 24; *Jameson's Patent*, 19 R. P. C. 252.

(*k*) Per A. L. Smith, L.J., in *The Shoe Machinery Co.* v. *Cutlan*, 12 R. P. C. at p. 533.

A.-G., decided that he had no power under sect. 38 of the Act of 1883 to give costs in these cases (*l*).

The forms for obtaining the fiat of the Attorney-General will be found in the Appendix.

Practice. The practice before the Court is partly regulated by Order LIIIA. By rule 11 the petitioner is bound to deliver particulars of the objections on which he intends to rely, and the degree of particularity required, and the consequences, so far as costsare concerned, are precisely the same as in the case of the particulars delivered in an action for infringement (see Chap. XVI.).

By rule 12 the respondent is entitled to begin and give evidence in support of the patent, and if the petitioner gives evidence impeaching the validity of the patent the respondent is entitled to reply.

The evidence which will be required of the respondent 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 of reply that the respondent is made practically plaintiff at the trial.

The usual practice is to allow the petition to appear in the petition list, nominally for hearing; a patent may be revoked at this stage when a clear case is made out if the patentee does not appear (*m*). The order for revocation will, however, only be made in open Court and not in chambers, even though the respondent consent (*n*); 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, &c., and the manner of trial, after which the petition stands adjourned.

A day should be fixed before which the petition is not to come on for trial, and the day should not be fixed earlier than that on which the parties will be ready (*o*).

(*l*) See notes in Griff. P. C. at pp. 319, 320.

(*m*) *Vaisey's Patent*, 11 R. P. C. 591.

(*n*) *Clifton's Patent*, 21 R. P. C. 515.

(*o*) *Borrowman's Patent*, 19 R. P. C. 159; *Scott's Patent*, 19 R. P. C. 273.

It is advisable to ask for directions as to the persons to be served with the petition if there are any parties interested in the patent other than its actual owners, since it is possible that by serving licensees extra costs may be incurred, although such persons may have taken no active part in the trial at all (*p*). But all persons whose names appear upon the register as beneficially interested should be served.

Where an assignment had been executed after the petition had been presented, the name of the assignee was ordered to be substituted for that of the original respondent to the petition (*q*).

Where the patentee or other person interested in the patent is out of the jurisdiction, notice should be given to such person by registered letter that the petition has been presented, 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 (*r*).

The usual order is that notice of the proceedings be sent to the patentee or other proposed respondent, and that unless he appear by counsel the petition is not to appear in the list for hearing except by leave of the judge (*s*).

A respondent residing out of the jurisdiction will not be ordered to give security for costs (*t*).

Order XXXI., rule 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, and leave will be given to the respondent (called defendant in the Patent Act, 1883) to deliver interrogatories to the petitioner. Circumstances may arise when it would be just to permit the petitioner to examine the respondent. The

(*p*) See, *e.g.*, *Brown's Patent*, 24 R. P. C. 313, at p. 346.

(*q*) *Haddan's Patent*, 2 R. P. C. 218.

(*r*) *Drummond's Patent*, 6 R. P. C. 576; L. R. 43 Ch. D. 80; *Kay's Patent*, 11 R. P. C. 279; *Goerz and Hoegh's Patent*, 12 R. P. C. 370; *Cerckel's Patent*, 15 R. P. C. 500.

(*s*) *King's Trade Marks*, 9 R. P. C. 350; L. R. 1892, 2 Ch. 462; *Kay's Patent*, 11 R. P. C. 279.

(*t*) *La Société Anonyme Trade Mark*, 10 R. P. C. 290; *Miller's Patent*, 11 R. P. C. 55.

rules as to interrogatories are similar to those in an action for infringement.

The petition may be tried at the assizes if convenient (*u*); but by sect. 31, sub-sect. 1, the trial is to be without a jury unless otherwise ordered. In modern practice patent actions are almost invariably tried in the Chancery Division.

The parties are entitled to have the petition heard with vivâ voce evidence (*v*).

Assessor.

Under sect. 31 (1) the Court may if it think fit, and shall if all the parties request, call in the aid of a qualified assessor.

Amendment of specification.

In cases before the Act of 1907, where the patent was invalid on the ground of want of novelty in part, which defect might be cured by amendment, the Court usually followed the order made in *Deeley* v. *Perkes* (13 R. P. C. 581; L. R. A. C. 496), by which the patent was ordered to be revoked unless within a given time the patentee applied at the Patent Office to amend by a specified disclaimer and unless such disclaimer was allowed.

This course was followed because if the order to revoke had not been made conditional, the Comptroller would have been unable to amend the specification of a patent which did not exist. This difficulty arose in *Deeley* v. *Perkes* (supra), and was thus surmounted.

Under sect. 22 the Court was given power in an action for infringement or petition for revocation to make an order amending the specification by way of disclaimer. By rule 23 of Order LIIIA the application to amend must be made by way of motion, and directions may be given by the judge as to advertisements, &c., and the Comptroller is to be notified. The order will be made subject to suitable terms. (See Chap. X. on "Amendment.")

When the patent has been revoked on the ground of fraud the Court will not entertain an application to amend the specification so as to disclaim those parts which have been fraudulently claimed but will revoke the patent as a whole (*w*).

(*u*) *Edmond's Patent*, 6 R. P. C. 355.

(*v*) *Gaulard and Gibbs' Patent*, L. R. 34 C. D. 396; 56 L. J. Ch. 606; 56 L. T. 284

(*w*) *Ralston's Patent*, 26 R. P. C. 313.

An order for revocation even when made by consent will usually include an order to pay the petitioner's costs (*x*).

It is usual to stay the order for revocation pending an appeal.

The power of the Court to make an order for revocation on the ground that some of the claims of the specification are invalid is not affected by the new sect. 32A, which gives power to the Court in an infringement action to give relief in respect of valid claims notwithstanding the existence of invalid claims. The proper course is for the respondent if he finds that some of his claims are invalid is to apply in the petition under the rule for leave to amend, and, as was seen in Chap. X., such leave is in the discretion of the Court and subject to the payment of costs.

Surrender of patent.

By sub-sect. 3 of sect. 26, "*A patentee may at any time by giving notice in the prescribed manner to the Comptroller offer to surrender his patent, and the Comptroller may, if after giving notice of the offer and hearing all parties who desire to be heard he thinks fit, accept the offer, and thereupon make an order for the revocation of the patent.*"

The practice on such an application is dealt with in Chap. IX.

(*x*) *Aylott's Patent*, 20 R. P. C. 227; *Merryweather's Patent*, 29 R. P. C. 64.

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CHAPTER XV.

ACTION TO RESTRAIN THREATS.

SECT. 36 of the Patents Act, 1907 (corresponding to Sect. 32 of the Act of 1883), as amended by the Act of 1919, provides, "*Where any person claiming to have an interest in a patent, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings, or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as he has sustained thereby, if the alleged infringement, to which the threats related, was not in fact an infringement of the patent:*

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

Common law before 1883.

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; 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 by the defendant amounted

(*a*) The alterations made by the amendment may be seen by reference to the text of the Act in the Appendix.

(*b*) *Halsey* v. *Brotherhood*, 1880, L. R. 15 C. D. 514.

to a "malicious attempt to injure the plaintiffs by asserting a claim of right against his own knowledge that it was without any foundation" (*c*).

Object of statutory change.

The object of sect. 32 of the Act of 1883 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*).

The old common law remedy still lies when the case is taken out of the statute by the proviso, and in such a case the plaintiff in the threats action must show that notwithstanding that the defendant has duly prosecuted an action for infringement such action was not brought bonâ fide (*e*).

In the Acts of 1883 and that of 1907 (before amendment) the words at the beginning of the section read "*where any person claiming to be the patentee of an invention. . . .*" Accordingly threats by a person who stated that he was "the sole licensee" under the patent were held not to be actionable under the section (*f*). Probably on account of this decision the amendment was made to cover such a case.

Nature of threats.

The words "by circulars, advertisements, or otherwise" have given rise to a number of cases in which an interpretation has been put upon them, and in which the principle of the enactment is clearly illustrated. The cause of action is not similar to libel, and there is no question of publication; therefore the manner in which the threat is made is immaterial. In *Skinner* v. *Perry* (1893, 1 Ch. 413; 10 R. P. C. 1), the plaintiffs complained of two threats—one in the form of a letter to a third party, who had inquired of the defendants whether they thought

(*c*) Per Blackburn, J., in *Wren* v. *Wield*, 1869, L. R. 4 Q. B. at p. 737.

(*d*) Per North, J., in *Day* v. *Foster*, 1890, 7 R. P. C. at p. 60; see also Lindley, L.J., in *Skinner* v. *Perry*, 1893, 1 Ch. at p. 420; 10 R. P. C. at p. 5.

(*e*) *Challender* v. *Royle*, 35 C. D. at p. 434; *Colley* v. *Hart*, 7 R. P. C. at p. 112.

(*f*) *Diamond Coal Cutter Co.* v. *Mining Appliances Co.*, 32 R. P. C. 569.

that the plaintiffs' article of manufacture infringed the defendants' patent; the other contained in a letter from the defendants to the plaintiffs themselves in reply to similar inquiries. In giving judgment for the plaintiffs, Bowen, L.J., said: "Using language in its ordinary sense, it is difficult to see that an intimation ceases to be a threat because it is addressed to a third person in answer to an inquiry, or because it is addressed to the person himself. We are not dealing with libel or questions of publication—we are dealing with threats. If I threaten a man that I will bring an action against him, I threaten him none the less because I address that intimation to himself, and I threaten him none the less because I address the intimation to a third person." The usual letter by a solicitor before issuing a writ or in proposing a compromise if conveying the intimation that the alleged infringer is incurring liability or that proceedings will be taken against him is a threat within the meaning of the section (*g*). And verbal statements will therefore probably be threats (*h*), and the use of the words "without prejudice" will not affect the matter (*i*).

Bona fides of patentee immaterial.

It is immaterial that the threat was made bonâ fide or in answer to inquiries (*j*); 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.

General warning is not threat.

The publication of a general warning to the whole world—such as, "I have a patent for such and such a machine, proceedings will be taken against any person who infringes it"—will not be actionable, since this is no more than the patent itself says; 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

(*g*) *Driffield Cake Co.* v. *Waterloo Mills Cake Co.*, 3 R. P. C. 46; L. R. 31 C. D. 638; *The Combined Weighing Machine Co.* v. *The Automatic Weighing Machine Co.*, 6 R. P. C. 502; 42 C. D. 66; *Day* v. *Foster*, 7 R. P. C. at p. 58.

(*h*) See *Kurtz* v. *Spence*, 5 R. P. C. at p. 172.

(*i*) Ibid.

(*j*) *Skinner* v. *Perry*, 10 R. P. C. at p. 8.

detriment of such manufacturer, an action will lie under the section. In *Challender* v. *Royle* (L. R. 36 C. D. at p. 441; 4 R. P. C. at p. 375), 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" (*k*).

Save when aimed at special manufacture.

In the same case the same Lord Justice, in his judgment suggested that the language of the section would not apply to threats relating to future infringements. Commenting upon that portion of the Lord Justice's judgment in *Johnson* v. *Edge* (9 R. P. C. at p. 148), 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." 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?" (*l*).

"*Any person aggrieved.*"—The right of action under the section is not limited merely to the person threatened, but any person, such as a rival patentee, 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 person aggrieved.

(*k*) And see *Boneham* v. *Hirst, Ltd.*, 34 R. P. C. 209.

(*l*) See also *Kurtz* v. *Spence*, 5 R. P. C. at p. 171.

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 (*m*).

Validity of patent may be in issue.

"*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 persons 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 (*n*).

Defendant need not now be legal owner to succeed.

The words of the section immediately preceding the proviso were amended by the Act of 1919. Formerly they read, "*if the alleged infringement to which the threats related, was not in fact an infringement of any legal rights of the person making such threats*," consequently, to constitute a defence to an action under this section, not only had it to 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 had to be the legal owner of the patent and not merely possessed of a beneficial interest (*o*).

By reason of the amendment this is no longer the case, and the defendant may allege infringement although, in spite of his claim, he has no interest in the patent.

The burden of proof.

Primâ facie the burden of proof is on the plaintiff that what he has done is not an infringement of the patent but the onus may easily be shifted on to the defendant, and the

(*m*) *Kensington, &c. Electric Lighting Co.* v. *Lane-Fox Co.*, 1891, 2 Ch. 573; 8 R. P. C. 277; see also *Burt* v. *Morgan*, 4 R. P. C. 278; *Johnson* v. *Edge*, 9 R. P. C. 142; L. R. 1892, 2 Ch. 1.

(*n*) 4 R. P. C. at p. 371; L. R. 36 Ch. D. at p. 435; see also *Kurtz* v. *Spence*, 4 R. P. C. 427; *Herrburger* v. *Squire*, 5 R. P. C. 581.

(*o*) *Kensington, &c. Electric Light Co.* v. *Lane-Fox Co.*, 8 R. P. C. 277.

issues, including validity, will be tried as in an action for infringement (*p*).

"*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 owning the patent should commence and prosecute an action for infringement of his patent. Before the amendment effected by the Act of 1919, the action had to be taken by the person uttering the threats but inasmuch as threats by persons other than the person claiming to be patentee are made actionable, the proviso has been amended so as to be effective if the person entitled to sue takes action although he may not be the person who has uttered the threats.

The proviso.

The infringement action.

The action need not necessarily be against the person aggrieved by the threats (*q*), since in many cases an action could not be brought against him—where, for instance, the person aggrieved is a rival patentee who does not manufacture at all.

It is immaterial whether the issue of validity is raised in the infringement action. In *Day* v. *Foster* (7 R. P. C. 54) the plaintiff, after threatening the defendant, who was a licensee under the plaintiff's patent, and also Messrs. Barrett and Elers, brought an action against the defendant for infringement and royalties; he being a licensee, was unable to dispute the validity of the patent, and consequently Messrs. Barrett and Elers were anxious to be joined as co-defendants to the action. This being refused by the plaintiff, they instituted proceedings under the section. 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

Validity need not be disputed.

(*p*) *Challender* v. *Royle*, 4 R. P. C. at p. 371; L. R. 36 C. D. at p. 435.

(*q*) *Challender* v. *Royle*, 4 R. P. C. 363; 36 Ch. D. 425.

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 for threats was vexatious, and directed that all further proceedings in it should be stayed.

Must be on same patent as threats.

The action for infringement must be brought in respect of the patent on which the threats are based. In *Dowson, Taylor & Co., Ltd.* v. *The Drosophore Co., Ltd.* (12 R. P. C. 95), where the threats action was in respect of four patents on which the defendant threatened, and the infringement action was in respect of one only of these four, the motion to stay the threats action was dismissed. In *Temler* v. *Stevenson & Sons* (15 R. P. C. 24) the defendants issued general threats in respect of three patents. In the action for infringement they sued on all three patents, but abandoned one of them in the statement of claim, and abandoned another after the particulars of objections had been amended, and as to the third they discontinued the action altogether after the particulars had been re-amended. Romer, J., said (at p. 31): "Of course considerations applicable to a case like this would not concern a case where there were special threats under separate patents. I am only dealing with a case like that before me, where the particular acts were done, not under a particular patent, but where there were only general threats that what the plaintiff was doing would be stopped because of the defendants' rights as patentees generally of the three patents. In this case, it seems to me that even if the action had been originally brought on the two patents alone, it would have brought them within the benefit of the proviso."

The fact that the specification of the patent has been amended after the threats and before the hearing of the action for infringement is immaterial to the protective effect of the proviso over the threats, notwithstanding that the effect of the amendment has been to make valid a patent which was invalid at the time when the threats were uttered (*r*).

The fact that an action for infringement by the patentee has

(*r*) See *Hall* v. *Stepney Spare Motor Wheel, Ltd.*, 27 R. P. C. 233, and *Stepney Spare Motor Wheel, Ltd.* v. *Hall*, 28 R. P. C. 381.

already been decided in favour of the defendant will not disentitle the patentee from issuing further threats if he can shelter himself under the proviso by beginning a fresh action for infringement and prosecuting it with due diligence (*s*).

And for same infringement.

The action for infringement must be brought in respect of the same or similar articles as those to which the threats relate (*t*). The case of *The Lycett Saddle Co., Ltd.* v. *Brooks, Ltd.* (21 R. P. C. 656), which deals with this point, requires some comment. The defendants in that case had issued threats with respect to three specific types of saddle called "L 16," "L 5," and "L 14." The plaintiffs issued their writ on November 19th, 1903. On May 9th, 1903, the defendants had issued a writ claiming damages for infringement by the manufacture of certain saddles, not specifically mentioning "L 5," "L 14," and "L 16." "L 5" and "L 14" were not manufactured at all when the action for infringement was commenced, and so could not have been included in the particulars of breaches. It would seem from the report that the learned judge considered that the saddles complained of in the infringement action and those the subject of the threats were of the same type, and he held that the case came within the proviso. The case was therefore decided upon a question of fact only, and is no authority for the proposition that the infringement sued for need not be the same as the act in respect of which the threats are made.

Bona fides essential.

As is pointed out, the action must be brought bonâ fide (*u*), and the onus of proof rests on the other party to show that the action was not in fact an honest one (*v*), and so to bring the action for threats under the old common law rule requiring malice.

Due diligence.

"*Is commenced and prosecuted with due diligence.*"—In considering whether such an action is brought with due diligence, the time of issuing the threats, and not the time when the

(*s*) *Waite and Saville, Ltd.* v. *Johnson Die Press Co.*, 18 R. P. C. 1.

(*t*) *Combined Weighing Machine Co.* v. *The Automatic Weighing Machine Co.*, 6 R. P. C. 502; 42 Ch. D. 665.

(*u*) *Challender* v. *Royle*, L. R. 36 Ch. D. at p. 439; 4 R. P. C. 363; *Colley* v. *Hart*, 7 R. P. C. at p. 112; 44 Ch. D. 179.

(*v*) *Colley* v. *Hart*, 7 R. P. C. at p. 112.

party bringing the action first knew of the acts which he alleges to be infringements, is the period to be looked at (*w*), and it is immaterial whether the action is brought before or after the commencement of the threats action (*x*).

The Courts have refused to consider threats made after an action has been commenced for infringement, as contempt of court (*y*).

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 (*z*).

Infringement action need not be successful.

The section does not require that the action should be prosecuted to a successful termination, and the extent to which the action must be prosecuted will depend largely on the circumstances of the case.

In *Colley* v. *Hart* (7 R. P. C. 101; 44 Ch. D. 179), the facts were as follows:—On September 15th, 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 December 6th the defendant commenced an action for infringement against the plaintiff, and delivered particulars of infringement in February in the following year, and on May 13th delivered his statement of claim. On November 7th, 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 the section. In his judgment, North, J., said (7 R. P. C. at p. 111):

May be discontinued.

"Under those circumstances, of course, he is exactly in the

(*w*) *Challender* v. *Royle*, L. R. 36 Ch. D. at p. 437.

(*x*) *Combined Weighing Machine Co.* v. *Automatic, &c. Co.*, 6 R. P. C. 502; *Berliner* v. *The Edison-Bell Phonograph Co.*, 16 R. P. C. 336; *Haskell Golf Ball Co.* v. *Hutchison*, 21 R. P. C. 497.

(*y*) *Dunlop Pneumatic Tyre Co.* v. *Clifton Rubber Co.*, 19 R. P. C. 527; *Haskell Golf Ball Co.* v. *Hutchison*, 21 R. P. C. 497.

(*z*) *Edlin* v. *Pneumatic Tyre, &c. Agency*, 10 R. P. C. 311.

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."

In *The English and American Machinery Co.* v. *The Gare Machine Co.* (11 R. P. C. 627), 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.

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 (*a*).

On the other hand the mere fact that the patentee has been advised, even by a competent person, that his action must fail does not make the action the less bonâ fide (*b*).

The question of "due diligence" is therefore one of fact.

Infringement raised by counterclaim.

The action for infringement may be raised by way of counterclaim, and if the proviso be relied on, it will be a question of fact whether such a claim is brought with sufficient diligence (*c*).

Stay of threats action.

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, the stay upon the first action will be removed, and an injunction will be granted.

In *The Fusee Vesta Co.* v. *Bryant and May* (4 R. P. C. 191), the action, which was one for infringement of the plaintiffs'

(a) See, *e.g.*, *Herrburger* v. *Squire*, 5 R. P. C. at p. 594.

(b) *Craig v. Dowding*, 25 R. P. C. 259; and see *Colley* v. *Hart*, supra.

(c) *Appleby Twin Roller Chain Co.* v. *Albert Eadie Chain Co.*, 16 R. P. C. 318.

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. 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 whether the threats were bonâ fide or not (*d*), 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 opened 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 (*e*), the abandonment of the proceedings for infringement would imply, of necessity, that those threats would not be continued, and 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 the section would be revived.

Proper course to pursue.

Where an action for infringement has been commenced after

(*d*) *Challender* v. *Royle*, L. R. 36 Ch. D. at p. 439.

(*e*) See *Dredge* v. *Parnell*, 13 R. P. C. at p. 393; *Incandescent Gas Light Co.* v. *Sunlight Incandescent Gas Lamp Co.*, 14 R. P. C. at p. 198.

the institution of proceedings under the section the proper course for the parties to pursue in the threats action was indicated by Kekewich, J. (*f*). 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."

But on a motion to stay an action for threats, on the ground that an action for infringement is being prosecuted, it must be shown that the letters patent, which are the subject-matter of the two actions, are the same. So where the threats action was in respect of four patents on which the defendant threatened, and the infringement action was in respect of one only of these four, the motion to stay the threats action was dismissed (*g*). But where the defendant has threatened, on the strength of several patents, he is not compelled to use all of them in the infringement action (*h*) (see p. 310, supra).

General effect of section.

The effect of the section, taken as a whole, is not to deprive a patentee of the power, or it may be termed the duty (*i*), 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 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

(*f*) *Combined Weighing, &c. Co.* v. *Automatic, &c. Co.*, L. R. 42 Ch. D. 665.

(*g*) *Dowson-Taylor Co., Ltd.* v. *The Prosophore Co., Ltd.*, 12 R. P. C. 95.

(*h*) *Temler* v. *Stevenson & Sons*, 15 R. P. C. 34; *Lycett Saddle Co.* v. *Brooks*, 1904, 21 R. P. C. 656.

(*i*) Per Jessel, M.R., in *Halsey* v. *Brotherhood*, L. R. 15 Ch. D. at p. 517.

into execution, by which means alone can he escape liability under the provisions of this section.

Interlocutory injunction.

In *Challender* v. *Royle* (L. R. 36 Ch. D. at p. 435), 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 plaintiff's 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 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 injunction merely on the ground that it cannot do the defendant any harm."

In *Colley* v. *Hart* (6 R. P. C. 17), 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."

Usual interlocutory order.

The usual order is that the action be stayed until after the trial of the infringement action which the defendant undertakes to begin, commence and prosecute with due diligence, the threats to be discontinued, costs in the threats action to abide the result of the infringement action, with liberty to apply to remove the stay if the action for infringement be not commenced and prosecuted with due diligence (*j*).

Form of injunction.

The injunction being by far the more important remedy, it seldom occurs that a substantial sum in damages is asked for or granted. The form of injunction granted in *Mountain* v. *Parker and Smith* (20 R. P. C. at p. 774) is given in the Appendix.

Damages.

The best course is for the judge to assess the damages at the trial. They are usually problematical, and depend upon a general impression of the case rather than upon a close examination of figures, and the cost of a reference for inquiry would be as a rule quite out of proportion to the amount that could be awarded. See, for example, *Ungar* v. *Sugg* (9 R. P. C. 113) (*k*).

Particulars.

The defendant in an action under this section is entitled to particulars of the threats upon which the plaintiff relies (*l*), and if the validity of the patent is put in question the general rules relating to particulars of objections will apply (*m*). 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 (*n*).

(*j*) *Mackie* v. *Solvo Laundry Co., Ltd.*, 9 R. P. C. 465; *Wrightson* v. *Taylor*, 24 R. P. C. 347, and see as to the costs of the threats action thus stayed *Metropolitan Gas Meters, Ltd.* v. *British Automatic Controlling Co.*, 29 R. P. C. 680.

(*k*) But see *Skinner* v. *Perry*, 11 R. P. C. 406; *Hoffnung* v. *Salsbury*, 16 R. P. C. 375.

(*l*) *Law* v. *Ashworth*, 7 R. P. C. 86.

(*m*) Ibid., and *Union Electrical Power Co.* v. *Electrical Power Storage Co.*, 5 R. P. C. 329.

(*n*) *Union Electrical Power Co.* v. *Electrical Storage Co.*, 5 R. P. C. 329; 38 Ch. D. 325.

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 (*o*).

(*o*) *Dowson-Taylor* v. *The Drosophore Co.*, 11 R. P. C. 536.

CHAPTER XVI.

ACTION FOR INFRINGEMENT.

I. Parties.

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.

Plaintiff. *The Plaintiff.*—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, even though he have acquired the right by assignment of two separate moieties, and the party sued be the original grantee (*a*).

Assignees.

Joint owners. 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 (*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* (7 C. B. N. S. at p. 209), 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 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."

(*a*) *Walton* v. *Lavater*, 8 C. B. N. S. 162; 29 L. J. C. P. 275; see p. 222, supra.

(*b*) *Sheehan* v. *Great Eastern Railway Co.*, 16 Ch. D. 59, and see p. 220, supra.

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. 14, sub-sect. 2, however, of the Act of 1907 (corresponding to sect. 33 of the Act of 1883) provides, "*Every patent . . . shall be granted for one invention only, but the specification may contain more than one claim; and it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.*"

Assignee for a district.

By sect. 14, sub-sect. 1, "*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.

The requirement that titles shall be registered has been made stringent under the new sections introduced by the Act of 1919. The patentee is now defined as "*the person for the time being entered on the register as the grantee or proprietor of the patent.*" By the new sect. 71 assignments and transmissions of interest have to be registered, and by sub-sect. (3): "*The person registered as the proprietor of a patent or design shall subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have power absolutely to assign, grant licenses as to or otherwise deal with the patent or design, and to give effectual receipts for any consideration for any such assignment, license or dealing: Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other personal property.*

(4) "*Except in applications made under section seventy-two (c) of this Act, a document or instrument in respect of*

(c) For rectification of the Register.

which no entry has been made in the register in accordance with the provisions of sub-sections (1) *and* (2) *aforesaid, shall not be admitted in evidence in any court in proof of the title to a patent or copyright in a design or to any interest therein unless the court otherwise directs.*"

In *Duncan* v. *Lockerbie and Wilkinson, Ltd.* (29 R. P. C. 454), the plaintiff had before the date of the writ assigned his patent to a trustee for the benefit of creditors, and after the writ had been issued the trustee re-assigned the patent to the plaintiff. The assignment to the trustee did not appear on the register, and Neville, J., held that at the date of the writ, the plaintiff, being the registered proprietor, had the right to sue.

Legal owner must be party

An equitable assignee cannot sue without joining the legal owner. In *Bowden's Patent Syndicate, Ltd.* v. *H. Smith & Co.* (1904, 2 Ch. 86; 21 R. P. C. 438), the facts were as follows: In 1897 B. applied for a patent. By a deed in the same year B. assigned to the plaintiffs the benefit of this application. The patent was subsequently granted to B., and of course was dated as of the day of application. In June, 1903, the plaintiffs issued the writ in this action, and in October, 1903, B., in pursuance of the deed of 1897, assigned the letters patent to the plaintiffs. B. had since died. It was held that as the patent was not granted at the time of the assignment of 1897 that assignment was equitable only, and consequently the plaintiffs at the date of the issue of the writ were not the legal owners of the patent and could not sue. They were allowed to amend the writ and statement of claim by adding the executors of B.

It will be noticed that sub-sect. (4) of sect. 71 prevents evidence being given of any unregistered documents which should have been registered under sub-sects. (1) and (2), and under these sub-sections the duty of registering is thrown on the shoulders of the assignee or grantee. But an assignor suing for the purchase price or on a covenant in the assignment, or a licensor suing for royalties, would not be bound to prove registration as the document is not used in proof of title to or any interest in a patent.

Licensees cannot sue.

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 without prejudicing the rights of the licensee; and although 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, yet he cannot sue infringers (*d*).

This principle, however, has not been followed in Scotland, where it has been held that an exclusive licensee may sue (*e*).

Licensees under sects. 24 and 27.

Sub-sect. (1) (d) of sect. 24 and sub-sect. (3) (b) of sect. 27 enable licensees under licenses granted by the Comptroller to sue infringers if the patentee neglects to sue, making the patentee a defendant, and if the patentee does not appear he is not under any liability as to costs.

Trustees in bankruptcy and executors.

The assignees or trustees in bankruptcy of a patentee may maintain action for infringement in their own name (*f*), and so may the executors or administrators of a patentee.

Mortgagee cannot sue.

A mortgagee of a patent is not a necessary party in an action for infringement of that patent (*g*), and he cannot sue infringers, inasmuch as although an assignee he is registered as mortgagee and not as proprietor (*h*).

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 (*i*).

Defendants.

As defendants, any person infringing is liable (*j*).

A company, to whom the business of the defendants was assigned while an action for infringement of a patent was pending against them, could not be joined as co-defendants in that action (*k*).

Effect of contract of indemnity.

But where an indemnity was given to the defendants, after the commencement of the action, by a third party who had manufactured the infringing articles, it was held that the

(*d*) See p. 224, supra.

(*e*) *Cochrane & Co.* v. *Martin's (Birmingham), Ltd.*, 28 R. P. C. 284; *Scottish Vacuum Cleaners Co.* v. *Provincial Cinematograph Theatres, Ltd.*, 32 R. P. C. 353.

(*f*) See p. 214, supra.

(*g*) *Van Gelder* v. *Sowerby Bridge Flour Co.*, 44 C. D. 374; 7 R. P. C. 208.

(*h*) Ibid.

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

(*j*) See Chap. VII.

(*k*) *Briggs* v. *Lardeur*, 2 R. P. C. 13.

person giving such an indemnity should be joined as a party under R. S. C. Order XVI., r. 48 (*l*), 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, and if the plaintiffs neglect to amend by joining him as a defendant they will not be able to obtain an injunction against him as well as against the actual defendant (*m*).

Manufacturers need not be joined.

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 (*n*).

Directors of company.

Where a company is defendant, and its financial position is unsound, it may be advisable to join the directors as defendants, inasmuch as they are equally liable with the company as joint tort feasors (*o*).

Carriers.

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 (*p*).

II. Pleadings.

The writ.

Writ.—An action for infringement is commenced by writ issued out of the High Court of Justice.

The writ may be issued either in the King's Bench or in the Chancery Division, but the machinery of the latter tribunal is the more suitable, and is the more generally used.

County Court.

Where the validity of the patent is put in issue the County Court has no jurisdiction to entertain an action for infringement inasmuch as a patent confers a "franchise" within the meaning

(*l*) *Edison* v. *Holland*, 3 R. P. C. 395.

(*m*) *Edison* v. *Holland*, 6 R. P. C. 243, 286.

(*n*) *Moser* v. *Marsden*, 9 R. P. C. 214.

(*o*) See, *e.g.*, *Welsbach Incandescent Gas Light Co.* v. *New Incandescent Gas Lighting Co. and Ors.*, 17 R. P. C. at p. 247.

(*p*) *Washburn and Moen Manufacturing Co.* v. *Cunard Steamship Co.*, 6 R. P. C. 398.

of the sect. 56 of the County Courts Act, 1888 (*a*). If infringement were the only issue, and the amount claimed as damages were within £100, there would seem to be no reason apart from practice and convenience why the action should not be so tried, but the authors do not know of any case where the attempt has been made. Actions for royalties have been tried in the County Court (*b*).

The Court of the County Palatine of Lancaster has jurisdiction to hear actions for infringement and to decide the issue of validity.

In nearly all actions for infringement, the writ is indorsed with a claim for (1) an injunction; (2) damages; and (3) delivery up to the plaintiffs or destruction of all infringing articles in the possession of the defendants. If the patent has expired there cannot, of course, be a claim for an injunction.

Service of a writ in Scotland for an infringement in England will be allowed (*c*).

The practice is regulated by Order LIIIA. of the Supreme Court Rules. In addition to the special rules of this order, the ordinary rules apply where applicable (*d*).

By sect. 94, sub-sect. 1, nothing is to affect the forms of process in Scotland, and, apart from rules which may be made by the Scottish Courts, the practice seems to remain what it was under the Act of 1883, so far as particulars and costs are concerned, for the English Supreme Court Rules do not apply to Scotland (*e*).

Statement of claim.

Statement of claim.—Order 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

(*a*) *Reg.* v. *County Court Judge of Halifax*, 1891, 1 Q. B. 793; 8 R. P. C. 344.

(*b*) See *Cutlan* v. *Dawson*, 14 R. P. C. 249.

(*c*) *Speckhart* v. *Campbell, Achnach & Co.*, Solr. Journ. Feb. 2nd, 1884; Vol. 28, p. 254; W. N. (84) 24.

(*d*) See *Haddan's Patent*, 54 L. J. Ch. 126; Griff. P. C. 108 (decided before O. LIIIA.).

(*e*) And see *Mica Insulators Co., Ltd.* v. *Bruce, Peebles & Co., Ltd.*, 22 R. P. C. 527.

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 form 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.

The statement of claim should allege that the plaintiff is the grantee or registered legal owner of the letters patent, and if his title is derived by assignment he should set forth the devolution; this, however, is not strictly necessary.

It is unnecessary to allege either that the plaintiff or the original patentee was the first and true inventor (*f*), or that the invention is new (*g*). If the specification has been amended, it is better to plead the fact, and that the original specification was framed in good faith and with reasonable skill and knowledge (*h*), since, by sect. 23 of the Act of 1907 (see p. 211, ante), no damages are recoverable in respect of infringements committed prior to the decision allowing the amendment unless the patentee can satisfy the Court that it was so framed.

If a certificate of validity has been granted in a previous action so as to entitle the plaintiff to solicitor and client costs under sect. 35 of the Act of 1907 (sect. 31 of the Act of 1883), the certificate and the claim to such costs should be pleaded (*i*).

Two or more patents may be sued on at one and the same time if the different issues can be conveniently tried together.

Particulars of breaches.

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 by sect. 29, sub-sect. 1, of the Act of 1883. Rules 13, 16, 19, 20 and 21 of Order LIIIA., have replaced these statutory

(*f*) See *Ward* v. *Hill*, 18 R. P. C. 491.

(*g*) *Amory* v. *Brown*, L. R. 8 Eq. 663.

(*h*) *Kane and Pattison* v. *Boyle*, 18 R. P. C. at p. 337.

(*i*) *The Pneumatic Tyre Co.* v. *Chisholm*, 13 R. P. C. 488.

The new rules.

requirements and are as follows: "(13) *In action for infringement of a patent, the plaintiff must deliver with his statement of claim particulars of the breaches relied upon.*

"(16) *Particulars of breaches shall specify which of the claims in the specification of the patent sued upon are alleged to be infringed, and shall give at least one instance of each type of infringement of which complaint is made.*

"(19) *Particulars of breaches and particulars of objections (j) may from time to time be amended by leave of the Court, upon such terms as may be just.*

"(20) *Further and better particulars of breaches or particulars of objections may at any time be ordered by the Court.*

"(21) *At the hearing of any action, petition, or counter-claim relating to a patent, no evidence shall, except by leave of the Court (to be given upon such terms as to the Court may seem just), be admitted in proof of any alleged infringement or objection not raised in the particulars of breaches or objections respectively.*"

The practice as formulated by these rules is substantially the same as that under sect. 29, sub-sect. 1, of the Act of 1883.

Purpose of particulars of breaches.

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 (*k*). In *Batley* v. *Kynoch* (L. R. 19 Eq. at p. 231), 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, 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

(*j*) See p. 334, infra.

(*k*) *Needham* v. *Oxley*, 1863, 1 H. & M. 248; *Mandleberg* v. *Morley*, 10 R. P. C. 256.

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 (*l*).

Differ from particulars of objections.

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. (*m*): "You must always bear this in mind, that the plaintiff, 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 by what act he considers the defendant to have infringed, and if these two points be made clear without adducing specific instances, that will be sufficient (*n*).

Rule 16, in so far as it refers to the necessity of specifying, in all cases, the claiming clauses which are alleged to be infringed, follows what was substantially the practice before the rule in cases where the specification included a number of claims.

There is no objection, however, to a plaintiff stating that he relies on *all* the claims of his specification, and it is a matter of costs at the trial if this course has been taken unreasonably (*o*).

(*l*) *Wenham Co.* v. *Champion Gas Co.*, 8 R. P. C. 22.

(*m*) *Cheetham* v. *Oldham*, 5 R. P. C. at p. 626 (and see cases therein cited).

(*n*) *Aktiengesellschaft für Anilin* v. *Levinstein*, 29 R. P. C. 677.

(*o*) *Haslam & Co.* v. *Hall*, 4 R. P. C. at p. 206.

Type of infringement should be specified.

It has been customary to state that the patent has been infringed and "in particular by the sale, on the 3rd day of May, 1909, to one A. B., of an article constructed according to the invention described and claimed in claim No. —." This has been for the purpose of identifying the type of act complained of, and technically proving it if denied. The giving of the instance is merely for identification purposes, and a defendant does not limit his rights to damages to the example only. "It lies on the party who alleges that for the honest purpose of his litigation he wants further information or limitation, to satisfy the Court that he is really placed in a difficulty by the particulars as they stand" (*p*).

Infringements after action brought.

When an action is brought in respect of a particular type of infringement, and to restrain the threatened infringement by continued manufacture of that type (the usual way in which an action is framed), the plaintiffs will not be allowed to give evidence of infringements of a different type committed after action brought to justify the allegation of intention to infringe; the proper course is to apply to amend the particulars of breaches (*q*).

Further particulars of breaches have sometimes been postponed to discovery on the ground that the defendant knew the breaches which he had committed better than the plaintiff (*r*).

Degrees of particularity required against vendor.

Where an action is brought against the vendor of articles alleged to have been made by a process which infringed the plaintiff's patent, a greater degree of precision is required in the particulars of breaches than if the defendant had been the manufacturer himself.

In *Mandleberg* v. *Morley* (10 R. P. C. at p. 260), Stirling, J., said: "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

(*p*) Per Wills, J., in *Huslam & Co.* v. *Hall*, 4 R. P. C. at p. 207.

(*q*) *The Shoe Machinery Co., Ltd.* v. *Cutlan*, 12 R. P. C. 342; *The Welsbach Incandescent Light Co., Ltd.* v. *Dowle*, 16 R. P. C. 391.

(*r*) *Russell* v. *Hatfield*, Griff. P. C. 204; 2 R. P. C. 144.

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.

Evidence admitted if within 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 (*s*).

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.

(*s*) *Hull* v. *Bollard*, 25 L. J. Ex. at p. 306.

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 that there is no such witness" (*t*).

Conversely, where the particulars of breaches complained of infringement by user only, the Court refused to enter into the question as to whether there had been infringement by manufacturing the articles complained of (*u*).

Particulars of breaches may also be ordered in actions which are not strictly actions for infringement or petitions for revocation; this is done under the ordinary jurisdiction of the Court. In an action charging that the defendant falsely and maliciously wrote and told persons who had bought certain machines of the plaintiff's 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 plaintiff's 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 of the inventions therein described he alleged to have been infringed (*v*).

Where infringement alleged to be contemplated in future.

Where the plaintiff claiming an injunction relies on certain acts of the defendant as evidence of an intention to infringe in the future, the defendant is entitled to full notice of the nature of the infringements he is alleged to be contemplating, especially where such acts have been committed since action brought (*w*), and the plaintiff will not be permitted to adduce evidence thereof unless such notice has been given.

(*t*) *Sykes* v. *Howarth*, L. R. 12 Ch. D. 826.

(*u*) *Henser* v. *Hardie*, 11 R. P. C. 421, 427.

(*v*) *Wren* v. *Weild*, L. R. 4 Q. B. 213.

(*w*) See *The Shoe Machinery Co.* v. *Cutlan*, 12 R. P. C. 357; *Welsbach Incandescent Light Co.* v. *Dowle*, 16 R. P. C. 391.

DEFENCE.

The following defences are available to a defendant to an action for infringement. **Defences available.**

1. He may deny the plaintiff's title to the letters patent sued on.
2. He may plead the leave and license of the patentee, specifying the circumstances.
3. He may deny that he has committed the acts complained of in the particulars of breaches.
4. He may deny that the acts complained of are infringements of the letters patent.

   [Nos. 3 and 4 are included under a mere denial of infringement.]
5. He may allege that at the date of the letters patent sued on the alleged infringing manufacture made, used, or sold by him was not new (see p. 119, ante).
6. He may allege that the letters patent are invalid, in which case he must deliver particulars of objections to the validity.
7. He may allege that in a contract made after the passing of the Act of 1907, if such contract is in force at the time, relating to the sale or lease of, or licence to use or work any article or process protected by the patent, there exist certain conditions which are made void by sect. 38 (constituted a defence by sect. 38, sub-sect. 4).
8. As a defence to a claim for damages (but not to a claim for an injunction) on a patent granted after the commencement of the Act of 1907, he may allege that at the date of the infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent (constituted a defence to a claim for damages by sect. 33 of the Act of 1907).

Estoppel. An assignor who has covenanted for the validity of the patent is estopped from alleging invalidity in an action for infringement brought against him by the assignee (see p. 222 *et seq.*).

A licensee is always estopped from denying the validity of the patent or the title of his licensor (see p. 228 *et seq.*).

Where there are several defendants, an estoppel may operate against one and not against the others, and in an action against partners, one of the partners by putting in a separate defence may be able to free himself from the effect of the estoppel which prevents his partner from raising the issue of validity (*a*).

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 (*b*), and the defendant will not even be allowed to raise the question of validity on new grounds (*c*).

But where the defendants in the second action are not the same as those in the first, there will be no estoppel (*d*), 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, and the Court will usually hold itself bound by previous decisions in the question of the construction of the patent (*e*).

Similarly, if the patent has been held invalid in a previous action it will be a bar to a subsequent action for infringement between the same parties (*f*). But if the ground of invalidity has been removed by amendment of the specification there will be no estoppel (*g*).

"An estoppel must be certain to every intent and not be taken by argument or inference" (*h*), so where a question of infringe-

(*a*) *Heugh and Chamberlain*, 25 W. R. 742; *Goucher* v. *Clayton*, 1865, 11 Jur. N. S. 107.

(*b*) *Thomson* v. *Moore*, 6 R. P. C. 426; 7 R. P. C. 325; *Brown* v. *Hastie & Co., Ltd.*, 23 R. P. C. 361.

(*c*) *The Shoe Machinery Co.* v. *Cutlan* (No. 2), 13 R. P. C. 141.

(*d*) *Goucher* v. *Clayton*, 1865, 11 Jur. N. S. 107; 34 L. J. Ch. 239; *Otto* v. *Steel*, 3 R. P. C. 109, 114.

(*e*) *Otto* v. *Steel*, 3 R. P. C. at p. 114; *Automatic Weighing Machine Co.* v. *Combined Co.*, 6 R. P. C. 367; *Edison* v. *Holland*, 1889, 6 R. P. C. 243; *The Flour Oxidising Co., Ltd.* v. *Carr & Co., Ltd.*, 25 R. P. C. at p. 448.

(*f*) *Horrocks* v. *Stubbs*, 12 R. P. C. at p. 540.

(*g*) See *Deeley's Patent*, 11 R. P. C 72.

(*h*) Com. Dig. tit. Estoppel (E 4).

ment 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 (*i*).

And in an action against manufacturers who have at an earlier date, under a contract of indemnity, financed the defence of users in actions by the same plaintiffs, the manufacturers will not be precluded from raising the issue of validity (*j*).

Conditional defence.

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 the paragraph under Order XIX., rule 27; the Court of Appeal dismissed the appeal with costs (*k*). This is somewhat similar to the defence numbered 5 on p. 331 and dealt with at p. 119, ante.

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 inquiry 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*).

Special defence created by Act of 1907.

The defences which are made available by the Act of 1907, as amended by the Act of 1919, and numbered 7 and 8 on p. 331, must be specially pleaded in the defence and are not matters to be dealt with in the particulars of objections to validity.

It is no longer permissible to raise the question of non-working as a defence to an action for infringement (*m*).

By sect. 38, sub-sect. 4, of the Act of 1907 it is provided:—

(*i*) *Newall* v. *Elliott*, 32 L. J. Ex. 120.

(*j*) *Gammons* v. *Singer Manufacturing Co.*, 22 R. P. C. at p. 459.

(*k*) *Hocking* v. *Hocking*, Griff. P. C. 129; 3 R. P. C. 291.

(*l*) *United Telephone Co.* v. *Donohoe*, L. R. 31 C. D. 399; 3 R. P. C. 45.

(*m*) See amendment of sect. 25 effected by the Act of 1919.

Defence of existence of contract with void conditions.

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

The nature of the conditions made void by sect. 38 has been discussed at p. 233, and the use of such conditions as a defence at p. 237.

By rule 10 of Order LIIIA. it is provided that a defendant relying on this defence must deliver with his defence full particulars of the contract and condition on which he relies.

Defence as to damages; ignorance of patent.

By sect. 33 it is provided that a patentee shall not be entitled to recover damages from a defendant who proves that he was not aware of the patent, and had no reasonable means of making himself aware of it.

This section is discussed farther on in this chapter. From the point of view of the pleader it is submitted that he should merely state that "at the date of the infringement alleged, he was not aware, nor had reasonable means of making himself aware, of the patent." The onus of proof is expressly laid upon the shoulders of the defendant.

Particulars of objections.

Particulars of Objections.—If the defendant in an action for infringement, or the petitioner in a petition for revocation pleads the invalidity of the patent he must deliver with his defence particulars of the objections upon which he intends to rely. The requirements as to the specific nature of such particulars have grown more and more stringent since the Act 5 & 6 Will. IV. c. 83, s. 3, which required that "in any action brought against any person for infringing any letters patent, the defendant, on pleading thereto, shall give to the plaintiff a notice of any objections on which he means to rely at the trial of such action." The Act of 1883 required particulars of the objections, which implies considerably more than a mere notice.

Sect. 29, sub-sect. (2), of that Act provided:—"The defendant must deliver with his statement of defence, or by order of the Court, or a judge at any subsequent time, particulars of any objections on which he relies in support thereof; (3) if

the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it; and if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him; (4) At the hearing, no evidence shall, except by leave of the Court, or a judge, be admitted in proof of any alleged infringement or objection, of which particulars are not so delivered; (5) Particulars delivered may be from time to time amended, by leave of the Court, or a judge."

The statutory requirement is now replaced by rules 14, 15, 17, 18, 19, 20 and 21 of Order LIIIA. Rule 17 is as follows:—"*Particulars of objections (whether delivered with the defence in an action for infringement of patent or with a petition for revocation under sect. 25 of the Act or with a counterclaim for revocation under sect. 32 of the Act) must state every ground upon which the validity of the patent is disputed and must give such particulars as will clearly define every issue which it is intended to raise.*" **The new rules.**

By rule 21, "*At the hearing of any action, petition, or counterclaim relating to a patent, no evidence shall, except by leave of the Court (to be given upon such terms as to the Court may seem just), be admitted in proof of any alleged infringement or objection not raised in the particulars of breaches or objections respectively.*"

Every objection must be pleaded.

Apart from granting leave to amend the particulars, the Court will not readily allow an objection to be taken to the validity of the patent unless that objection has been pleaded (*n*).

In other than infringement actions or petitions.

Particulars of objections have always been ordered, when the validity of a patent has been put in issue. When 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

(*n*) See judgment of Fletcher Moulton, L.J., in *British United Shoe Machinery Co., Ltd.* v. *A. Fussell & Sons*, 25 R. P. C. at pp. 659, 660, and of Lord Loreburn in *Alsop Flour Process, Ltd.* v. *Flour Oxidizing Co.*, 25 R. P. C. at p. 490.

validity of the patent was at issue and that the plaintiff was entitled to particulars of objections (*o*).

It is not necessary for every one of two or more defendants defending in the same interest to deliver separate particulars of objections (*p*).

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.

In *Avery, Ltd.* v. *Ashworth, Ltd.* (32 R. P. C. 463), the defendants in their particulars of objections stated that they would rely "either by way of anticipation or as showing the scope of the claims . . . upon matters known to the plaintiffs, in consequence of which the plaintiffs" at an earlier date had applied to amend their specification by disclaimer. The defendants were directed to deliver full particulars of the "matters" alleged. The further particulars delivered under this objection consisted of a statement that the defendants would rely upon all the matters contained in the particulars of objections which had been delivered in an action by the plaintiffs against other defendants upon another patent several years before. This and the original paragraph were ordered to be struck out (33 R. P. C. 235).

True and first inventor.

If it be pleaded that the patentee was not the true and first inventor particulars must be delivered stating the name of the person whom the defendant alleges to have been the true and first inventor (*q*). The case of *Russell* v. *Ledsam* (11 M. & W. 647), which has been referred to in various text-books as an authority to the contrary, was decided upon the construction of the Act 5 & 6 Will. IV. c. 83, s. 3, and is now obsolete. Moreover, it is to be remembered that the issue raised by this plea is not one of novelty, but a specific ground of attack in itself.

Want of novelty. Rule 18.

The most common ground of objection to the validity of a

(*o*) *Hazlehurst* v. *Rylands*, 9 R. P. C. 1.

(*p*) *Smith* v. *Cropper*, L. R. 10 A. C. 249.

(*q*) *Smith's Patent*, 29 R. P. C. 339.

patent is want of novelty either on account of prior publication in some document or prior public user of the invention. By rule 18 of Order LIIIA., "*If one of the objections taken in the particulars of objections be want of novelty, the particulars must state the time and place of the previous publication or user alleged, and if it be alleged that the invention has been used prior to the date of the patent, must also specify the names of the persons or person who are alleged to have made such prior user and whether such prior user is alleged to have continued down to the date of the patent, and if not, the earliest and latest dates on which such prior user is alleged to have taken place, and shall also contain a description (accompanied by drawings if necessary) sufficient to identify such alleged prior user, and if such user relates to any machinery or apparatus shall specify whether the same is in existence and where the same can be inspected.*

"*No evidence at variance with any statement contained in the particulars shall be given in support of any objection, and no evidence as to any machinery or apparatus which is alleged to have been used prior to the date of the patent and which is in existence at the date of the delivery of the particulars shall be receivable unless it be proved that the party relying on such prior user has, if such machinery or apparatus be in his own possession, offered inspection of the same, or if not in his own possession, has used his best endeavours to obtain inspection of the same for the other parties to the proceedings.*"

If this rule be compared with paragraph 2 of sect. 29, sub-sect. 2, of the Act of 1883, it will be seen that the requirement for particulars has become far more strict than was formerly the case. It was decided by Parker, J. (*r*), that in the case of a prior user alleged to be in existence at the date of the particulars the defendants were not bound to deliver a description and drawings provided they obtained inspection of the articles for the plaintiffs, for in that case the plaintiffs might themselves make the required drawings.

Where the patent was for a process and anticipation by a prior user of the process. **Prior user of process.**

(*r*) *The Crossthwaite Fire Bar Syndicate* v. *Senior*, 26 R. P. C. 260.

process was relied on, the Court of Appeal would not order particulars of the apparatus employed nor would it order production of samples, holding themselves bound by the rule, and the Master of the Rolls said: "It seems to me that we cannot impose upon the defendant in a patent action any greater liability than is justified by that rule (18), and it does not seem to me to be relevant to urge that something beyond and outside that rule will enable the plaintiffs better to prepare for trial and will minimise expense. . . . If the patent is one for machinery or apparatus great detail is required by the rule . . . drawings have to be furnished and experiments have to be permitted, always qualifying that statement by the fact that it must be within the power of defendants to furnish the drawings and allow the experiments. But when the patent is for a process, and merely for a process, no such detailed particulars are required. All that the rule exacts is a description sufficient to identify such alleged prior user. . . . The patent relates to a process, and there is nothing either in the body of the specification or in the claim at the end which justifies us in exacting from the defendants any further particulars as to the nature of the apparatus used in working the particular process; nor do I think it is within our jurisdiction to require the defendants to say whether they have any samples of the ores so treated, or to require them to say whether they will allow the plaintiffs to have inspection of such samples and to make tests therefrom. Whether it might or might not be convenient that the rule should be so altered as to extend to a case like that I express no opinion. . . ." (*s*).

The same reasoning applies where the patent is for a particular prescription of ingredients; in such circumstances particulars will only be ordered of the ingredients used in the alleged prior user (*t*).

We submit, however, that the defendant should in justice be forced to disclose in his particulars all the information in his possession concerning the prior user which he proposes to prove

(*s*) See *Minerals Separation, Ltd.* v. *Ore Concentration Co., Ltd.*, 26 R. P. C. 413, 421.

(*t*) *Stahlwerk Becker Aktiengesellschaft's Patent*, 34 R. P. C. 332.

in Court, and that no useful purpose is served by allowing him to conceal the true nature thereof until the trial. Unfortunately the words "sufficient to identify" are precisely the words used in the judgment of Fletcher Moulton, L.J., in *Brown's Patent* (23 R. P. C. 792) before Order LIIIA. came into force. The learned Lord Justice held that the purpose of particulars under the old practice was not to describe the prior user to the plaintiff or to inform him of its nature, but merely to identify the article in question. We are not concerned with the question of whether this judgment was taken into account in framing the rules, but if the words of the rules bear the same meaning as those in the judgment there is some danger that a manifest and ridiculous injustice will be perpetuated.

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.

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 or to point out specifically what part or parts of the plaintiff's specification he alleges to be affected thereby will depend upon the circumstances of the case and the nature of those specifications (*u*); where it appeared that the defendant had, figuratively speaking, "thrown at the head" of the plaintiff a large number of complicated specifications without any attempt at discrimination, further particulars were required (*v*), but if the defendant bonâ fide relies upon the whole of a specification, or any number of specifications in reason, and the subject-matter is simple, his particulars of objections will not be interfered with (*w*).

(*u*) *Heathfield* v. *Greenway*, 11 R. P. C. 17.

(*v*) *Holliday* v. *Heppenstall*, 6 R. P. C. 320; *Sidebottom* v. *Fielden*, 8 R. P. C. at p. 270; *Heathfield* v. *Greenway*, 11 R. P. C. 17.

(*w*) *Siemens* v. *Karo*, 8 R. P. C. 376; *Nettlefolds* v. *Reynolds*, 8 R. P. C. 410; *Edison-Bell Phonograph Co.* v. *Columbia Phonograph Co.*, 18 R. P. C. 4.

Want of subject-matter.

The objection that the invention is not proper subject-matter in view of the common knowledge of the time when it was patented is a distinct allegation, and should be specifically pleaded (*x*).

Common knowledge.

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 particularised, 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 references to well-known standard works upon the subject (*y*).

"Common knowledge" must be distinguished from "public knowledge." If the prior document is relied on in the latter sense it must be pleaded specifically (*z*), and in such a case it should not strictly be weighed as anything but an anticipation, and, strictly speaking, the contents of specifications, although part of public knowledge, are not necessarily common knowledge (*a*), but may be shown by evidence to be part of the common knowledge (*b*). Nevertheless, if a specification has been referred to in the particulars of objections it is common practice for the Courts to take it into consideration in dealing with the question of common knowledge without formal proof that its contents are sufficiently widely known to be considered properly as such (*c*).

The usual practice is to state in the particulars whether the specifications cited are referred to as anticipations or as part of the common knowledge.

(*x*) *Holliday* v. *Heppenstall*, 6 R. P. C. at p. 326; *Phillips* v. *The Ivel Cycle Co.*, 7 R. P. C. at p. 82.

(*y*) *Holliday* v. *Heppenstall*, supra; *English and American Machinery Co.* v. *Union Boot Co.*, 11 R. P. C. at p. 374.

(*z*) See *British Thomson-Houston Co.* v. *Stonebridge Electrical Co.*, 33 R. P. C. 166.

(*a*) *The Salvo Laundry Co.* v. *Mackie*, 10 R. P. C. 68; *English and American Machinery Co.* v. *Union Boot Co.*, 11 R. P. C. 367.

(*b*) *Salvo Laundry Supply Co.* v. *Mackie*, 10 R. P. C. 68; *Holliday* v. *Heppenstall*, 6 R. P. C. 320.

(*c*) See, *e.g.*, *Sutcliffe* v. *Abbott*, 20 R. P. C. at p. 55.

Particulars are not required of the allegation that "the patented invention is not useful." **Want of utility.**

The allegation that the specification is insufficient or ambiguous and misleading must be supported by particulars which indicate the alleged defect, and where a workman would meet with difficulty in carrying out the directions given (*d*). But if the objection amounts to saying that if the directions in the specification are followed the result described is not attained no further particulars will be ordered (*c*). Every case, however, will depend on its own merits (*f*). **Insufficiency of specification.**

The objection that the specification does not define the limits of the invention claimed is sufficient and does not require to be further particularised (*g*). **Specification does not define invention.**

When the objection is (under sect. 42) on the ground of disconformity between the provisional and complete specification, coupled with want of novelty in the excess matter at the date of the complete specification, the defendant ought to give such particulars as will inform the plaintiffs of the nature and scope of the alleged differences, and particulars of the want of novelty. 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. **Disconformity.**

Order XIX., rule 6, of the Rules of the Supreme Court 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 **Fraud.**

(*d*) *Crompton* v. *Anglo-American Brush Corpn.*, 4 R. P. C. 197; *Heathfield* v. *Greenway*, 11 R. P. C. 17.

(*e*) See, *e.g.*, "*Z*" *Electric Lamp Co.* v. *Marples, Leach & Co.*, 26 R. P. C. 762.

(*f*) Ibid.

(*g*) *British Ore Concentration, Ltd.* v. *Minerals Separation, Ltd.*, 24 R. P. C. 790.

folios, the fact must be so stated, and a reference to full particulars already delivered or to be delivered with the pleading."

Such an allegation of fraud would be raised where the plaintiff is alleged to have stolen the invention from some one else, or that he had obtained the patent by bribery.

Particulars limit evidence.

By rule 21 of Order LIIIA., "*At the hearing of any action, petition, or counterclaim relating to a patent, no evidence shall, except by leave of the Court (to be given upon such terms as to the Court may seem just), be admitted in proof of any alleged infringement or objection not raised in the particulars of breaches or objections respectively.*"

Apart from rule 19, which will be considered presently, the Court has always possessed the power to allow the evidence to go beyond the matters set forth in the particulars of objections (*h*).

Evidence will be admitted at the trial, provided the language of the particulars of objections is large enough to admit it; since 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.

In *Sugg* v. *Silber* (L. R. 2 Q. B. D. at p. 495), Mellish, L.J., said: "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."

Amendment of particulars.

By rule 19, "*Particulars of breaches, and particulars of objections may from time to time be amended by leave of the Court upon such terms as may be just.*"

(*h*) *Britain* v. *Hirsch*, 5 R. P. C. at p. 231.

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 for leave to amend, when an order will be made upon terms.

Whether the application to amend be made before or at the trial the terms should be such that the plaintiff is 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; and 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; and he should be able to 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.

The form of order for leave to amend before trial which has been consistently followed is that which was made in *Baird* v. *Moule's Patent Earth Closet Co.* set out in the report of *Edison Telephone Co.* v. *India Rubber Co.* (17 C. D. 137) (*i*).

Where the application to amend is made at the trial such leave will only be granted if the new evidence has only been recently discovered, and could not with reasonable diligence have been discovered before (*j*).

In *British United Shoe Machinery Co.* v. *Fussel* (25 R. P. C. 631), the specification had been amended, and the judge at the trial held that the original claims were not framed with reasonable skill and knowledge. The defendant, in the Court of Appeal, attempted to rely on this finding of fact as an additional ground of invalidity, but the Court would not allow this course as the objection had not been pleaded, and they saw no grounds for going beyond the particulars of objections.

(*i*) See also *Ehrlich* v. *Ihlee*, 4 R. P. C. 115; *Wilson* v. *Wilson*, 16 R. P. C. 315.

(*j*) Per North, J., in *Moss* v. *Malings*, 3 R. P. C. at p. 375.

In *Badische Anilin und Soda Fabrik* v. *La Société Chimique* (14 R. P. C. at p. 881), it became clear during the course of the trial that the specification of the patent sued upon was insufficient, and the defendants applied to Romer, J., who was trying the case, for leave to amend the particulars by inserting an objection on this ground. Leave was granted to amend, the plaintiffs having a fortnight to elect whether they would continue the action, the terms upon which such leave should be granted being left for argument until the plaintiffs had elected. On the hearing the plaintiffs elected to continue, and the patent was declared invalid as a result of the new objection, but all costs of and occasioned by the application to amend, and all costs thrown away by reason of the amendment being made so late, were given to the plaintiff (*k*).

In *Allen* v. *Horton* (10 R. P. C. 412), the defendant obtained leave to put a prior specification which had not been pleaded to the plaintiff's witnesses and the patent was held invalid on account of prior publication by that specification. The action was dismissed but without costs.

In *Westley, Richards & Co.* v. *Perkes* (10 R. P. C. at p. 186), the Court allowed the defendants to amend at the trial by adding an allegation that the patented invention lacked subject-matter.

In *Pirrie* v. *York Street Spinning Co.* (11 R. P. C. at p. 431), leave to amend the particulars of objections was granted by the Court of Appeal in Ireland pending appeal.

The terms on which amendment will be allowed are a matter for the discretion of the Court, and it is of little use to appeal (*l*).

In *The Shoe Machinery Co.* v. *Cutlan* (1896, 1 Ch. 108), the Court of Appeal decided that they had jurisdiction to amend the particulars of objections although in that particular case they declined to do so, and the same rule has been held to apply to the Scottish Inner House (*m*).

(*k*) See also *Parker* v. *Maignen's Filtre Rapide Co.*, 5 R. P. C. 207; *Allen* v. *Horton*, 10 R. P. C. 412.

(*l*) *Wilson* v. *Wilson*, 16 R. P. C. 315.

(*m*) *Watson, Laidlaw & Co.* v. *Pott and Ors.*, 26 R. P. C. at p. 360.

III. Interlocutory Injunction.

Interlocutory injunction, when granted.

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, where there is a presumption that the patent is valid, when he can clearly establish his title and the commission of the act which he declares to be an infringement, and where there is a strong primâ facie case that that act is an infringement of the patent (*a*); and the Court will usually require the plaintiff to give a satisfactory undertaking that he will pay any damage that the defendant may suffer in the event of the latter being successful at the trial (*b*).

Notice of motion.

Notice of motion having been given, an interlocutory injunction will be granted after appearance, or leave may be given to serve notice of motion with the writ.

Must be "primâ facie" evidence of validity.

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 primâ facie reasons for acting on the supposition that the patent is valid.

Established in former trial.

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; and where the patentee has worked and enjoyed the patent for many years without dispute, an interlocutory injunction will be granted (*c*); so also where the defendant has admitted the validity of the patent (*d*), or is so placed in his relationship to the patentee as to be estopped from denying its validity (*e*).

Long possession.

In *Dudgeon* v. *Thompson* (30 L. T. N. S. 244), Jessel, M.R.,

(*a*) See *Gardner* v. *Broadbent*, 1856, 2 Jur. N. S. 1041.

(*b*) See p. 348, infra.

(*c*) *Dudgeon* v. *Thompson*, 30 L. T. N. S. 244; *Muntz* v. *Foster*, 2 W. P. C. at p. 95; *Rothwell* v. *King*, 3 R. P. C. 379; *Hayward* v. *Pavement Light Co.*, Griff. P. C. 124.

(*d*) *Dircks* v. *Mellor*, 26 Lon. Journ. 268.

(*e*) *Dudgeon* v. *Thompson*, 30 L. T. N. S. 244; *Clarke* v. *Fergusson* 1 Griff. 184.

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* (3 Jur. N. S. 358), 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 (*f*); 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 (*g*).

Mere possession insufficient.

Seldom granted for new patent.

An interlocutory injunction is seldom granted in the case of a new patent even though the defendant refuses to undertake to keep an account (*h*), unless very strong evidence in support of the motion be adduced. The proper course is for the motion to stand to the trial.

In *Clarke* v. *Nichols* (12 R. P. C. 310) the patent was less than a year old. Notice of motion was served with the writ, but the defendant did not appear. The affidavit by the plaintiff stated that prior to the purchase of the patent he had caused a full investigation to be made into its validity by his patent agents, and that he was advised that it was valid, and to the best of his knowledge, information and belief, it was valid now. The injunction was granted.

In *Holophane, Ltd.* v. *Berend & Co.* (15 R. P. C. at p. 19),

(*f*) *Bickford* v. *Skewes*, 1 Web. P. C. 211; *Rothwell* v. *King*, 3 R. P. C. 379.

(*g*) *Plimpton* v. *Malcolmson*, 44 L. J. Ch. 257; L. R. 20 Eq. 37.

(*h*) *Lister* v. *Norton*, 1 R. P. C. 114; *Jackson* v. *Needle*, 1 R. P. C. 174; *British Tanning Co.* v. *Groth*, 7 R. P. C. 1.

Kekewich, J., said: "During the forty years over which my experience extends, and I think for a considerably longer period, the Court has acted on one uniform rule, subject, of course, to exceptions, in dealing with applications of this character. The rule, as I understand, is this: that where the proprietor of recently granted letters patent, the validity of which has not been established by legal process, seeks an injunction against an alleged infringer, the Court declines to interfere by interlocutory injunction and leaves the patentee to establish the validity by formal proceedings. Of course, forty years ago, the motion for injunction had to stand over while the validity of the patent was established at law. Fortunately we have got rid of that, and the injunction and the validity can all be determined and disposed of in one and the same action in one and the same Court; but the rule holds still. Of course, there are exceptions; it will not do for a defendant coming here as against the proprietors of letters patent simply to say, 'I challenge the validity.' There must be something more than that. The Court must be satisfied that there is an honest intention of trying the question; and not only an honest intention of trying the question, but that there is something to be tried."

If a certificate of validity has been granted in a previous action, it will not avail the defendant on an application for an interlocutory injunction to allege fresh grounds for invalidity (*i*).

Delay will bar right.

An interlocutory injunction will not be granted in cases where the plaintiff is guilty of delay.

In *The North British Rubber Co.* v. *The Gormully and Jeffery Co.* (12 R. P. C. at p. 20), Chitty, J., said: "Now I am not aware, having regard to patents, that there is any substantial ground of distinction between an interlocutory injunction upon a patent right and upon any other. The principles appear to me to be substantially the same; and the general rule of the Court is that a person who comes to ask for that remedy, which is granted with despatch and for the purpose of protecting rights until the trial, should come promptly" (*j*).

(*i*) *Heine, Solly & Co.* v. *Norden*, 21 R. P. C. 513.

(*j*) See also *Bovill* v. *Crate*, L. R. 1 Eq. 388; *The Aluminium Co.* v.

The amount of delay which will prevent the granting of an interlocutory injunction will, of course, vary with the nature of the patent and the circumstances of the trade.

Unless explained.

The delay may, in some cases, be satisfactorily explained, and will not therefore be fatal, as in a case where the plaintiffs' solicitors advised them not to commence an action until the defendants appeared to be in a condition of sufficient financial soundness to undertake manufacture of the infringing articles (*k*).

Delay in proceeding against persons who are not parties to the application in question is no ground for refusing an injunction, if there has been no delay in proceeding against the defendant (*l*).

Usual course on application.

A common course is for the Court to order the motion to stand until the trial of the action on the condition that the defendant undertakes to keep an account of all articles made and sold by him, but in some cases the plaintiff may be justified in persisting in his application, and the Court may make the injunction notwithstanding that the defendant offers to keep such an 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, and the plaintiff will usually be required to give an undertaking to pay any damages occasioned by the injunction if it should appear subsequently that the defendant was in the right (*n*). And the discontinuance of the action will not prevent the undertaking being enforced (*o*). An undertaking in damages will not be required from the Crown or any one suing on the Crown's behalf (*p*).

Undertaking to keep account.

Plaintiff to undertake in damages.

Although the Court is naturally disposed to avoid granting an injunction and to induce the defendant to keep an account,

Domeicre, 15 R. P. C. 32; *Gillette Safety Razor Co.* v. *A. W. Gamage, Ltd.*, 24 R. P. C. 1.

(*k*) *United Telephone Co.* v. *Equitable Telephone Co.*, 5 R. P. C. 233.

(*l*) *The Pneumatic Tyre Co.* v. *Warrilow*, 13 R. P. C. 284.

(*m*) *Plimpton* v. *Spiller*, L. R. 4 C. D. 286.

(*n*) See *Graham* v. *Campbell*, L. R. 7 C. D. 490 (undertaking enforced).

(*o*) *Newcomen* v. *Coulson*, L. R. 7 C. D. 764.

(*p*) *Secretary of State for War* v. *Cope*, 36 R. P. C. 273.

yet if he should refuse to keep an account the Court will not be the more disposed to grant the injunction, the application for which must be heard on its merits (*q*).

The evidence to be used upon an application for an interlocutory injunction is upon affidavit.

Nature of affidavit required.

The affidavit should clearly point out in what the alleged infringement consists, and depose to the novelty and utility of the invention. Affidavits on "information and belief" must state the sources of the information (*r*). 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 (*s*).

In the Chancery Division it is the practice to hear applications for interlocutory injunctions as motions in Court. In the King's Bench Division the application is heard by the judge in chambers upon a summons.

Forms of injunction upon undertaking as to damages, and of order refusing injunction upon terms, will be found in the Appendix.

IV. Discovery.

Order XXXI. rule 1, of the Rules of the Supreme Court provides that either party to an action, with leave of the Court, or a judge, may interrogate the other party.

The general rules as to interrogatories in ordinary actions apply equally to actions for infringement.

Interrogatories.

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.

Directed to infringement issue.

The plaintiff may interrogate the defendant as to the act of infringement complained of; but where the defendant is asked

(*q*) See, *e.g.*, *The British Tanning Co., Ltd.* v. *Groth*, 7 R. P. C. 1.

(*r*) *The Saccharin Corporation* v. *Chemicals Co.*, 15 R. P. C. 55; *Badische Anilin und Soda Fabrik* v. *W. G. Thompson*, 19 R. P. C. 502.

(*s*) *Stocking* v. *Llewellyn*, 3 L. T. 33.

concerning the customers whom he has supplied, it becomes material to ascertain from the pleadings whether the acts complained of are admitted. If the act complained of be not admitted, the defendant may be asked whether he has not supplied a certain definite article to anybody, and to whom—since by this means an admission, not necessarily of infringement but of the act complained of, may be obtained. But if the act complained of be admitted, an inquiry as to the persons supplied only becomes relevant on the issue of damages and should be postponed until the inquiry (*a*).

The rule as to particulars of breaches requires that the plaintiff shall give at least one instance of the type of infringement complained of. Where the plaintiff in his particulars made firstly a general allegation of infringement of the only claim of his specification and then in compliance with the rule instanced a specific act as illustrating the type of infringement complained of, he was not allowed to interrogate the defendant broadly as to whether or not he had carried out the process claimed but was limited to an examination of the defendant as to the specific act alleged (*b*).

Crossley v. *Tomey* (L. R. 2 Ch. D. 533) 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.

As to persons who supplied defendant.

An inquiry as to the names of persons who supplied a defendant who is merely a vendor will usually be inadmissible,

(*a*) *Lister* v. *Norton*, 2 R. P. C. 68, and see *Tetley* v. *Easton*, 18 C. B. 643; *De la Rue* v. *Dickinson*, 3 K. & J. 388; *Lea* v. *Saxby*, 32 L. T. N. S. 731; *Fennessy* v. *Clark*, 37 C. D. 184; *Rawes* v. *Chance*, 7 R. P. C. 275.

(*b*) *Aktiengesellschaft für Aluminium Schweissung* v. *London Aluminium Co.*, 36 R. P. C. 199.

since it is not relevant to any issue between the parties. But where the vendors sold a chemical product, which the plaintiffs had good reason to believe was manufactured in infringement of one of their patents for processes, the Court of Appeal allowed the interrogatory on the ground that the answers would probably enable the plaintiffs to ascertain whether the article were an infringement or not (*c*).

Framed on plaintiff's specification.

In *Benno Jaffé* v. *Richardson* (10 R. P. C. 136), the plaintiff administered interrogatories to the defendant, framing them upon the statements in his specification, which he alleged that the defendant had infringed, and 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.

On the other hand, the plaintiff although entitled to ask "Do you not use the process claimed by me?" is not entitled to go further and ask "If not, tell me then what you do use" (*d*).

Where defendant's process is secret.

Therefore, 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 (*e*).

The use of discovery after judgment on an inquiry as the damages (*f*) will be dealt with later.

Particulars will not excuse interrogatories.

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 (*g*).

(*c*) *Saccharin Corpn.* v. *Haines*, 15 R. P. C. 344; and see *Osram Lamp Works, Ltd.* v. *Gabriel Lamp Co.*, 31 R. P. C. 231.

(*d*) *Aktiengesellschaft für Anilin Fabrikation* v. *Mersey Chemical Works*, 30 R. P. C. 401; *Osram Lamp Works, Ltd.* v. *Pope's Electric Lamp Co.*, 31 R. P. C. 31.

(*e*) *Renard* v. *Levinstein*, 3 N. R. 665; 10 L. T., N. S. 94.

(*f*) See p. 373.

(*g*) *Birch* v. *Mather*, 22 C. D. 629; *Alliance Pure White Lead Syndicate* v. *MacIvor's Patents*, 8 R. P. C. 321; *General Electric Co.* v. *Safety Light and Elevator Co.*, 21 R. P. C. 109.

As to prior user.

In *Delta Metal Co., Ltd.* v. *Maxim Nordenfelt, Ltd.* (8 R. P. C. 169), the defendants had pleaded prior user; the plaintiffs proposed to interrogate by asking whether the alleged prior user was in respect of a particular process, specifying it. The defendants answered that the prior user was substantially the process as described in the plaintiffs' specification. It was held that this was a sufficient answer.

Documents relating to prior user.

In *Carnegie Steel Co.* v. *Bell Bros., Ltd.* (24 R. P. C. 82), the defendants objected to allow inspection of certain documents referred to in their affidavit of documents, which documents, they said, referred solely to certain prior users alleged in their particulars of objections. It was held that the documents were privileged, and Buckley, L.J., said (at p. 92), "Particulars of prior user must be given; evidence of prior user need not be given; and it does not follow that every document relating to prior user is a particular of prior user; it may be something which may assist the defendant to prove the prior user, but that he is not bound to produce. I am not aware of any principle which in a patent action any more than any other action compels the defendant to produce documents of that description" (*h*). Needless to say, however, all documents that are relevant must be included in the affidavit of documents whether privileged or not (*i*). The same rules apply to a petition for revocation under sect. 25 (*j*).

For examination of plaintiff.

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 case (*k*).

Communications with patent agent not privileged.

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

(*h*) See also *Stahlwerk Becker's Patent*, 34 R. P. C. 332.

(*i*) *Carnegie Steel Co., Ltd.* v. *Bell Bros., Ltd.*, 24 R. P. C. at p. 93.

(*j*) *Haddan's Patent*, 54 L. J. Ch. 126.

(*k*) *Hoffman* v. *Posthill*, L. R. 4 Ch. 673.

having taken place in the relationship of patent agent, and not of solicitor, and client (*l*).

In a case where the plaintiff had amended his specification by disclaimer, the defendant in a subsequent action was held not to be entitled to discovery of the documents including correspondence with the patent agent showing the prior knowledge which had induced him so to disclaim, in order to support a general plea of the existence of such prior knowledge as rendering the patent invalid (*m*).

A defendant in a suit for infringement of a patent in order to prove that there was no novelty in the plaintiff's patent interrogated 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 (*n*). But in a more modern case where the defendant having given particulars of alleged prior users sought to interrogate the plaintiff by asking him whether the prior users so alleged did not embody all the features claimed by the plaintiff's specification, it was held by the Court of Appeal that this amounted to asking him to state on oath whether or not the defendant was right in his defence and was disallowed (*o*).

In *Rylands* v. *Ashley's Patent Bottle Co.* (7 R. P. C. 175) the defendant pleaded that the invention patented was not useful, and administered an interrogatory asking whether it had not been found necessary to use some and what modifications in the process described in the specification. The Court of Appeal allowed this interrogatory.

As in other cases discovery of documents will not be ordered until after the delivery of the defence (*p*).

(*l*) *Moseley* v. *Victoria Rubber Co.*, 3 R. P. C. 351.

(*m*) *Avery* v. *Ashworth*, 32 R. P. C. 560.

(*n*) *Hoffman* v. *Posthill*, L. R. 4 Ch. 673.

(*o*) *Bibby and Baron* v. *Duerden*, 27 R. P. C. 283.

(*p*) See *Woolfe* v. *Automatic Picture Gallery Co.*, 19 R. P. C. 161.

The rules generally applicable with reference to discovery of documents apply to patent cases.

V. Inspection.

Inspection.

Sect. 34 of the Act of 1907 (as amended by the Act of 1919) provides *inter alia*: "*In an action for infringement of a patent . . . the Court may, on the application of either party, make such order for an injunction or inspection, and impose such terms and give such directions respecting the same and the proceedings thereon, as the Court may see fit.*"

The power to order an inspection was always assumed by the Courts; in *Bovill* v. *Moore* (1815, 2 Coop. Ch. Ca. Temp. Cottenham 56, n.) 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 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 with due regard to the interests of the parties concerned in the litigation" (*a*).

(*a*) Per Bristowe, V.-C., in *McDougall* v. *Partington*, 7 R. P. C. at p. 357.

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.

Primâ facie case of infringement necessary. May be limited to scientific witnesses.

The Court requires, before granting an order for inspection, that a primâ facie case of infringement shall be made out, and that inspection is essential to enable the plaintiff to prove his case (*b*).

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 do not affect the question of infringement. In *Flower* v. *Lloyd* (1876, W. N. 169, 230) and *Swan* v. *Edlin-Sinclair Tyre Co.* (20 R. P. C. 435) the Court strictly limited the inspection to scientific men, and excluded the plaintiff from being present.

In *Pigott* v. *The Anglo-American Telegraph Co.* (19 L. T. N. S. 46) 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 *British Thomson-Houston Co.* v. *Duram, Ltd.* (37 R. P. C. 121), the plaintiffs filed an affidavit of an expert who deposed that he had examined the defendants' products and believed that they could only have been produced by the aid of the plaintiff's patented process. Inspection of defendants' process was asked for and the defendants swore that their process was a valuable

(*b*) *Batley* v. *Kynoch*, L. R. 19 Eq. 90; *Germ Milling Co.* v. *Robinson*, 1 R. P. C. 217; *Cheetham* v. *Oldham*, 5 R. P. C. 617.

secret. Astbury, J., gave leave to the plantiffs to administer interrogatories, and to ask for samples (*c*), and refused to entertain the application for inspection until it should be shown that the answers by the defendants would be insufficient to enable the plaintiffs to present their case.

In *Batley* v. *Kynoch* (L. R. 19 Eq. at p. 92) Bacon, V.-C., said: "Upon the single point which is raised before me, there can 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 patents, 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."

Laches sufficient to defeat the plaintiff's right to an interlocutory injunction is no bar to an order on the same motion for inspection.

In *Webb* v. *Kynoch & Co., Ltd.* (15 R. P. C. at p. 273), inspection was ordered of the defendants' works as one of the conditions for the refusal to grant an interlocutory injunction.

Mutual inspection.

In some cases, where it is necessary, the Court will order the

(*c*) See also *Patent Type Founding Co.* v. *Walter*, 8 W. R. 353.

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 (*d*).

Patent Office samples.

It is submitted that the Court could order the production of the samples which a patentee of a chemical invention is obliged to deposit at the Patent Office under sect. 2, sub-sect. 5, of the Act of 1907 (see p. 160, ante).

In a case where the defendant delivered to the plaintiff specimens of the alleged infringing articles, the latter was not allowed to see those articles in actual use on the defendant's premises (*e*).

In *McDougall* v. *Partington* (7 R. P. C. 351, 472) the plaintiff's right to inspection depended upon a contract, the construction of which was disputed, and since he was unable to show that inspection was necessary to prepare his case, it was held that no inspection should be granted, on the ground that the right depended upon the question to be determined at the trial.

Application how made.

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, and an order has been made before delivery of the statement of claim (*f*). The evidence in support must be on affidavit, and a primâ facie case of infringement must be made out, and it must be shown that the inspection is essential to the plaintiff's case.

Costs of inspection.

The costs of an inspection depend on the circumstances, and are in the discretion of the Court (*g*). In *Ashworth* v. *English Card Clothing Co.* (21 R. P. C. 353) Joyce, J., allowed the costs of an inspection to the successful party, although it had taken place voluntarily and without an order of the Court, on the ground that circumstances showed that it had been necessary and proper.

(*d*) *Davenport* v. *Jepson*, 1 N. R. 307; see also *The Germ Milling Co.* v. *Robinson*, 3 R. P. C. 11.

(*e*) *Sidebottom* v. *Fielden*, 8 R. P. C. 266.

(*f*) *Edler* v. *Victoria Press Manufacturing Co.*, 27 R. P. C. 114.

(*g*) *Mitchell* v. *The Darley Colliery Co.*, L. R. 10 Q. B. D. 457.

New rule as to inspection of prior users.

Rule 18 of Order LIIIA., dealing with particulars of objections concludes thus: ". . . *No evidence as to any machinery or apparatus which is alleged to have been used prior to the date of the patent and which is in existence at the date of the delivery of the particulars shall be receivable unless it be proved that the party relying on such prior user has, if such machinery or apparatus be in his own possession, offered inspection of the same, or if not in his own possession, has used his best endeavours to obtain inspection of the same for the other parties to the proceedings.*"

The Court has always exercised power to order inspection of articles in the possession of the parties, but it generally happened that when an application was made to inspect an important "prior user" the defendant was in a position to say that the article was in the possession of a third party who, though willing to produce it at the trial, positively refused to allow inspection beforehand. This device is now, it is to be hoped, effectually rendered useless, for it is to be remembered (*h*) that if the third party refuses inspection the defendant is nevertheless bound to deliver a description and drawings.

VI. The Remedy.

The remedy sought or granted in an action for infringement may consist of an injunction, damages, and delivery up or destruction of all infringing articles in the possession or power of the defendant.

Before the amending Act of 1919 there existed a right to claim an account of profits as an alternative to a claim for damages, but sect. 34 of the Act of 1907, as amended, has taken away this right which was in fact seldom claimed.

Injunction based on threat to continue.

Injunction.—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 right; 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

(*h*) See p. 337, ante.

patent rights will, in most 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* (L. R. 9 C. D. at p. 65) 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* (7 R. P. C. 191) 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 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).

Evidence of acts after action brought.

Unless to support a claim for an injunction and for the purpose of showing that the defendant has an intention of infringing in the future, evidence of acts after action brought is inadmissible. In *The Welsbach Incandescent Gas Light Co.* v. *Dowle* (16 R. P. C. 391) the plaintiffs attempted to supplement their evidence of an actual infringement having taken place by means of evidence of such acts since the issue of the writ. Bruce, J., refused to admit the supplementary evidence.

Where what has been done since action brought is different in any away from what was done before, and is relied on as evidence of the intention to infringe, the defendant must have clear notice of the nature of the infringement which he is alleged to be contemplating. In *Shoe Machinery Co.* v. *Cutlan* (12 R. P. C. at p. 357) Romer, J., said: "Two kinds of action may be brought by a plaintiff patentee. The one is based on this—that the defendant has infringed before action brought, and in respect of this the plaintiff is entitled to claim damages, or an account, and an injunction to prevent similar infringements in the future. The other action is based on the fact, not that the defendant has infringed, but that he threatens and intends to infringe; and in this case the plaintiff may claim an injunction to restrain the threatened infringement. Of course you may find both kinds of action combined in one, but they are distinct in themselves in several respects. In the first, the plaintiff has to give particulars of breaches, that is to say, of the infringement relied on; and by statute, except by leave of the Court or a judge, no evidence can be given at the hearing, of an breaches other than those stated in the particulars. In the other, of necessity, there can be no particulars of breaches; but to avoid unfairness to the defendant, care is always taken that he shall have fair notice as to the nature and particulars of the special infringement he is alleged to be contemplating; and then no doubt, if after action he commits that special

Two kinds of action.

infringement, or substantially that infringement, evidence of it can be given, as it is evidence to show that the plaintiff was right in his allegation that, at the date of action brought, the defendant was threatening and intending to infringe. I may add that if an action, as originally brought by a plaintiff patentee, is of the first class only, but he finds that the defendant has, since action brought, infringed in a way substantially different from his former infringements, leave would be given by the Court to the plaintiff in a proper case, and on proper terms, to amend his action, and to bring these subsequent infringements before the Court to be dealt with once and for all with the prior infringements."

Actual infringement evidence of intention.

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, unless it be proved beyond doubt that there can be no intention to continue infringing (see p. 363 *et seq.*, post), and an injunction will be granted. Vice-Chancellor Shadwell, in *Losh* v. *Hague* (1 W. P. C. at p. 200), 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" (*a*).

Mere possession is not threat.

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 *British United Shoe Machinery Co.* v. *Simon Collier, Ltd.* (27 R. P. C. 567), the defendants had purchased a machine provided with an extra appliance which was an infringement of the plaintiff's patent; they had no use for the appliance and never connected it to the machine. After action brought they returned the appliance to the manufacturers. It was clear that there was no intention to infringe at the date of the action, and counsel for the plaintiffs relied on the purchase of the machine and appliance for the purposes of trade as an infringement. The House of Lords upheld the decision of the Court of Appeal, reversing the decision of Parker, J., on this point, holding that there

(*a*) See also *Geary* v. *Norton*, 1 De G. & S. 9.

had been no actual infringement and that no injunction could be granted.

In the case of *Adair* v. *Young* (L. R. 12 C. D. 13), 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, 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.

Sale. 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 (*b*).

The principle upon which the Court grants an injunction was clearly demonstrated in *Proctor* v. *Bayley* (6 R. P. C. 538). 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 was 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 (at p. 541): "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 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?" (*c*).

(*b*) *Betts* v. *Willmott*, L. R. 6 Ch. 239.

(*c*) Note also *Hudson* v. *Chatteris Engineering Co.*, 15 R. P. C. 438.

Innocent carriers.

An action for an injunction may be brought against innocent carriers of infringing articles. In *Upmann* v. *Elkan* (L. R. 7 Ch. 130) (*d*), 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 an 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 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."

Consignees should be joined.

The above reasoning would apply equally well to infringements of letters patent. The consignees of the goods should also be added, even if out of the jurisdiction. In *The Washburn and Moen Manufacturing Co.* v. *The Cunard Steamship Co. and J. C. Parkes and Sons* (6 R. P. C. at p. 403) Stirling, J., said: "I conceive the action was properly brought in the first instance against the Cunard Steamship Company, who are within the jurisdiction, and the question which remains is, were Messrs. Parkes, who are out of the jurisdiction, the consignees, and, as it now turns out, the owners of the goods, proper parties to the action? If they were resident within the jurisdiction, I conceive there would be no question that they were. Where goods were alleged to constitute an infringement of a patent or were marked in such a way that a trade mark was infringed, it was the settled practice in the Court of Chancery to bring actions against carriers and others who had

(*d*) And see *Washburn and Moen Manufacturing Co.* v. *Cunard Steamship Co.*, 6 R. P. C. 398.

control of the goods, to restrain them from being dealt with, and upon the consignees of those goods being found out, to add them as parties, in order that the questions which arose might be decided once for all in the presence of the persons who were the real owners of the goods alleged to infringe." 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.

Proper course where several infringers.

In cases where there are several infringers the plaintiff is not justified in commencing a vast multitude of actions and applying for injunctions in each.

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" (*e*).

Where one defendant only appears.

A question has arisen as to what should be done if on an action against two defendants for the same infringement one of them fails to appear. The defendant who appeared might succeed in establishing the invalidity of the patent, and the difficulty arises as to the position of the other defendant, since judgment for the defendant on the ground of invalidity is *inter partes* only, and does not affect the status of the patent.

On the whole, however, it may be said that injunction is an equitable remedy, and that it would be contrary to principle for the same tribunal which had pronounced a patent to be invalid to restrain a member of the public from doing what could not be an infringement.

(*e*) Per Sir W. Page-Wood, V.-C., *Bovill* v. *Crate*, L. R. 1 Eq. at p. 391. See also *Foxwell* v. *Webster*, 3 N. R. 103.

In *Actien Gesellschaft für Cartonnagen Industrie* v. *Remus and Burgon* (12 R. P. C. 94) Chitty, J., refused to set down on motion for judgment against the defendant who had not delivered a defence, asking what would happen if the other defendant succeeded in upsetting the patent.

In *Savage* v. *Brindle and Another* (17 R. P. C. at p. 233) a motion for judgment against one defendant stood over until the trial; after the hearing he consented to an injunction, but the other defendant succeeded in upsetting the patent. Farwell, J., granted the injunction asked for, but it is not likely that this practice would be followed to-day.

General convenience looked to.

The general balance of convenience will be looked to in granting an injunction.

In *Hopkinson* v. *St. James and Pall Mall Electric Light Co.* (10 R. P. C. at p. 62) 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.

In *The Leeds Forge Co.* v. *Deighton's Patent Flue Co.* (18 R. P. C. at p. 240) the injunction was suspended pending an appeal on the ground that to put it into force at once would throw a large number of workmen out of employment.

The injunction falls with the expiration of the patent (*f*), 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 (*g*).

Injunction and subsequent amendment of specification.

In *Dudgeon* v. *Thomson* (3 A. C. 34) the plaintiff had obtained an injunction. Subsequently he amended his specification, and after this had been done took proceedings to enforce the injunction. The House of Lords held that he should have brought a new action, since the new specification might be open to objection, and was not the same as the old specification. It is submitted that this is no longer good law,

(*f*) *Daw* v. *Eley*, L. R. 3 Eq. 496.

(*g*) *Crossley* v. *Beverley and Crossley* v. *The Derby Gas Light Co.*, 1 W. P. C. 119.

on account of sect. 18, sub-sect. 9, of the Act of 1883, re-enacted as sect. 21, sub-sect. 7, of the Act of 1907 (see p. 206, ante).

In *Saccharin Corporation* v. *Dawson* (19 R. P. C. 169) and *The Same* v. *Jackson* (20 R. P. C. 611) the actions were brought upon several patents. It was impossible to say which patent had been infringed, but it was clear that one of them must have been. The injunction was granted for the life of the patent which would earliest expire.

A person against whom an injunction has been granted or who has given an undertaking in Court is liable to be committed should he be guilty of a breach of such injunction or undertaking, and a person aiding and abetting such a person and with knowledge of the injunction is also guilty of contempt (*h*), but an application for committal, involving as it does the liberty of the subject, will require the strictest proof in its support (*i*).

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 any one might put together (*j*).

Acquiescence and delay.

Positive acquiescence will bar the right of the patentee to apply for an injunction (*k*). But such acquiescence must amount to a representation to the defendant. Otherwise it is the general impression that laches do not bar the right to a perpetual injunction, although they certainly will prevent a plaintiff from obtaining an interlocutory order.

Damages or account.

Damages.—In addition to an injunction, the plaintiff is entitled to damages, when there has been actual infringement as distinguished from an intention to infringe.

Measure of damage.

The measure of damage is not the profit made by the infringer, but is the loss which the plaintiff has actually sustained (*l*),

(*h*) *Incandescent Gas Light Co.* v. *Sluce*, 17 R. P. C. 173.

(*i*) *Dick* v. *Haslam*, 8 R. P. C. 196.

(*j*) *United Telephone Co.* v. *Dale*, 25 Ch. D. 778.

(*k*) *Proctor* v. *Bennis*, 36 Ch. D. at p. 759.

(*l*) *United Horsenail Co.* v. *Stewart*, 3 R. P. C. at p. 143; 5 R. P. C. at p. 267.

"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" (*m*); 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.

The principle to be applied is the restoration of the plaintiff to the *status quo ante* the infringement, and the plaintiff may properly say that owing to the infringement he has lost profit which he would otherwise have made in his trade, he has lost business connection, and the development of his business on its natural lines has been interrupted by his having been driven by the acts of piracy out of sections of his own trade (*n*). And it is no answer for the defendant to say that even had he not manufactured and sold the infringing articles, that in the circumstances of the trade the orders for such articles would never in fact have gone to the plaintiff. In such circumstances the measure of damages will be the amount which on a reasonable estimate the defendants would have had to pay to the plaintiff for the privilege of fulfilling such orders. As Lord Shaw said (*o*): "If with regard to the general trade which was done, or would have been done by the plaintiffs within their ordinary range of trade, damages be assessed, these ought of course to enter the account and to stand. But in addition there remains that class of business which the plaintiffs would not have done; and in such cases it appears to me that the correct and full measure is only reached by adding that a patentee is also entitled, on the principle of price or hire, to a royalty for the unauthorised sale or use of every one of the infringing machines in a market which the infringer, if left to himself, might not have reached. Otherwise, that property which consists in the monopoly of the patented articles granted to the patentee has been invaded, and indeed abstracted, and the

(*m*) Per Lord Macnaghten, *United Horsenail Co.* v. *Stewart*, 5 R. P. C. at p. 268.

(*n*) See Lord Shaw's judgment in *Watson, Laidlaw & Co.* v. *Pott and Ors.*, 31 R. P. C. 104.

(*o*) Ibid. at p. 120.

law when appealed to would be standing by and allowing the invader or abstractor to go free. In such cases a royalty is an excellent key to unlock the difficulty, and I am in entire accord with the principle laid down by Lord Moulton in *Meters, Ltd.* v. *Metropolitan Gas Meters, Ltd.* (28 R. P. C. 163). Each of the infringements was an actionable wrong, and although it may have been committed in a range of business or of territory which the patentee may not have reached, he is entitled to hire or royalty in respect of each unauthorised use of his property. Otherwise the remedy might fall unjustly short of the wrong" (*p*).

Commercial competition.

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.

There may be cases in which the whole profit of the plaintiff is derived from the granting of licenses, and in such a case the damages might very properly be fixed at the amount which the defendants would have had to pay in royalties, as in such a case there could be no loss by reason of competition (*q*).

In the case of a patentee who is also a manufacturer the question of damages is more difficult, the use of royalties as a measure not being available and the profits of the defendant being immaterial. As Lord Watson said in *The United Horse-nail Co.* v. *Stewart* (5 R. P. C. at p. 267): "In that case the profit made by the infringer is a matter of no consequence. However large his gains, he is only liable in nominal damages so long as his illegal sales do not injure the trade of the patentee; and however great his loss, he cannot escape from liability to make full compensation for the injury which his competition may have occasioned." In that case loss of profit

(*p*) And see *British United Shoe Co.*, 13 R. P. C. 64; *The Pneumatic Machinery Co.* v. *Fussell*, 27 R. P. C. 205.

(*q*) *Penn* v. *Pack*, L. R. 5 Eq. 81; *English and American Machinery Co.* v. *Union Boot and Shoe Machine Tyre Co., Ltd.* v. *Puncture Proof Pneumatic Tyre Co., Ltd.*, 16 R. P. C. 209; *The British Motor Syndicate* v. *John Taylor and Sons, Ltd.*, 17 R. P. C. 723.

arising from such competition was not allowed. The patent in question was one for a machine to produce horseshoe nails more cheaply than had been done before. Consequently any one else could make nails in competition with the plaintiffs; they were only restrained from making them by means of that particular description of machine, and further, the plaintiffs had always gone a little before the defendants in reducing their price, and so continually kept the price lower than that quoted by the defendants.

When it is sought to recover damages on account of the reduction in prices, it must be clear that the reduction in the plaintiff's prices has been the result of the defendant's competition, and not of the ordinary exigencies of trade (*r*).

In *The American Braided Wire Co.* v. *Thomson* (7 R. P. C. 152) 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 (*s*).

Regard had to plaintiff's establishment charges.

In *The Leeds Forge Co., Ltd.* v. *Deighton's Patent Flue Co.* (25 R. P. C. 209), it was held that in arriving at the damages due to competition, regard should be had to the fact that had the plaintiffs received the orders which in fact went to the defendants, they would have been able to make a profit larger than the profit actually made by themselves on similar articles, or by the defendants on the articles actually

(*r*) *Alexander* v. *Henry*, 12 R. P. C. at p. 367.

(*s*) And see *Wellman and Others* v. *Burstinghaus*, 28 R. P. C. 326.

made in infringement, since the proportion borne on account of establishment charges by each article made would have been materially reduced.

In estimating the amount of damage by competition, or by injuring the reputation of the plaintiff's goods, it is of course impossible to name any precise sum, and it will always be a matter largely for individual judgment and discretion.

In *Ungar* v. *Sugg* (8 R. P. C. at p. 388), 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 sufficient reason for giving only a nominal sum"; and Lord Esher, M.R., in the Court of Appeal, said (9 R. P. C. at p. 117): "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."

In the case where the infringement is a part only of the article manufactured and sold by the defendant, the plaintiff is entitled to recover damages in respect of that part only provided that the infringing part is clearly separable and does not co-operate with the rest to produce the new effect which is the feature of the patented invention in question (*t*). But where it is an integral part of a machine as a whole, damages must be based on the fact that the plaintiff has lost an order for the whole machine, and the profits on the whole machine must be taken into account (*u*).

Users liable for damages as well as manufacturers.

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 (*v*). But the

(*t*) *Clement Talbot, Ltd.* v. *Wilson and Another*, 26 R. P. C. 467; 28 R. P. C. 157; and see *The United Horsenail Co.* v. *Stewart*, 3 R. P. C. at p. 143.

semble also *United Telephone Co.* v. *Walker*, 4 R. P. C. 63.

(*u*) *Meters, Ltd.* v. *Metropolitan Gas Meters, Ltd.*, 27 R. P. C. 721;

(*v*) *United Telephone Co.* v. *Walker*, 4 R. P. C. 63.

damages recoverable in respect of each infringement must be confined to that infringement only.

Innocent infringers.

By sect. 33 of the Act of 1907, provision is made for the better protection of innocent infringers.

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

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

The section applies only to patents granted after January 1, 1908.

Prior to this Act it had been the law that ignorance of the existence of a patent was no excuse for infringement, and the infringer was liable to an injunction and to pay damages for such infringement.

The effect of the section is merely to affect the right of the patentee in so far as his remedy is concerned.

It is to be noticed that the part of the section referring to the marking of the patented article with the number and year of the patent does not necessarily make the fact of such marking notice to the whole world that there is a patent for the article—the circumstances of the infringer are the true criterion. A manufacturer of an infringement of a patent for a costly machine might induce an innocent purchaser to use that machine; the purchaser might never before have seen such a machine, although those sold by the patentee were properly marked. But the whole burden of proof is on the infringer, who is primâ facie liable to damages, and we submit that in the

Burden of proof on infringer.

case of infringement by the use of tools in well-defined trades, the burden will not easily be discharged.

Patents indorsed "Licenses of Right".

By sect. 24, sub-sect. 1 (e), dealing with patents indorsed "Licenses of Right": "*if in any action for infringement of a patent so indorsed the infringing defendant is ready and willing to take a license upon terms to be settled by the comptroller, no injunction against him shall be awarded, and the amount recoverable against him by way of damages (if any) shall not exceed double the amount which would have been recoverable against him as licensee if the license had been dated prior to the earliest infringement: Provided that this paragraph shall not apply where the infringement consists of the importation of infringing goods.*"

Damages are recoverable (subject to the effect of the Statute of Limitations—six years) from the date of acceptance of the complete specification by the Patent Office (*w*).

Discovery on inquiry as to damages.

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, have been sold (*x*); but not the names of the agents concerned in the transaction (*y*).

In *Hamilton & Co.* v. *Nielson* (26 R. P. C. 671), a Scottish case, the pursuers alleged damage under the head of falling off of their profits; and they were ordered to give discovery of their business books. The costs of an inquiry into damages are usually reserved in the order granting the inquiry, and if the defendant, before the inquiry, should offer a sum in satisfaction, that fact should be recited in the order so that it may be considered in the question of costs when that question comes to be decided (*z*).

Costs of inquiry.

Order for delivery up.

Order for delivery up or destruction.—After trial and judgment,

(*w*) Sect. 10.

(*x*) *Murray* v. *Clayton*, L. R. 15 Eq. 115; *American Braided Wire Co.* v. *Thomson*, 5 R. P. C. 375; *Saccharin Corporation* v. *Chemicals Co.*, 17 R. P. C. 612.

(*y*) *Murray* v. *Clayton*, L. R. 15 Eq. 115.

(*z*) *British Vacuum Co.* v. *Exton Hotels Co.*, 25 R. P. C. 617; *Fettes* v. *Williams*, 25 R. P. C. 511, and see *British Ore Concentration Syndicate* v. *Minerals Separation, Ltd.*, 26 R. P. C. at p. 148.

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 (*a*). This was done in *Plimpton* v. *Malcolmson* (ref. M.R., January 28, 1876, B. 381). But where by reason of the nature of the invention such an order would be unreasonable, it will not be granted (*b*). The order for delivery up or destruction is usually made in the alternative, but where the defendant omitted to say which he preferred to do, and the order was made and drawn up for delivery up only, the Court would not vary the order to allow the defendant to make his choice (*c*). An inquiry will, when necessary, be directed as to the articles manufactured which are in the defendant's possession, and an order will be made that they be destroyed (*Betts* v. *De Vitre* (ref. V.-C. W., 1865, A. 119)). The 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 (*d*). 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 (*e*). But a defendant is not entitled to set off against the claim for damages the value of the goods delivered up under the order (*f*).

No set off of value.

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.

VII. The Trial.

By sect. 31 of the Act of 1907 (as amended by the Act of 1919):

(*a*) *Frearson* v. *Loe*, 9 C. D. at p. 67.

(*b*) *United Telephone Co.* v. *London and Globe Co.*, 26 C. D. 776; *Siddell* v. *Vickers*, 5 R. P. C. 101. See also *Aktiengesellschaft für Autogene Schweissung* v. *London Aluminium Co.*, 37 R. P. C. at p. 170.

(*c*) *British Westinghouse Co.* v. *Electrical Co.*, 28 R. P. C. at p. 530.

(*d*) *Westinghouse* v. *Lancashire and Yorkshire Rail. Co.*, 1 R. P. C. at p. 253; *Edison-Bell Phonograph Co.* v. *Smith*, 11 R. P. C. at p. 406.

(*e*) *Vavasseur* v. *Krupp*, 9 C. D. 351.

(*f*) *United Telephone Co.* v. *Waller*, 4 R. P. C 63.

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

"(2) *The Court of Appeal may, if they think fit, in any proceeding before them call in the aid of an assessor as aforesaid.*

"(3) *The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Court of Appeal, as the case may be, and be paid as part of the expenses of the execution of this Act.*"

Prior to the Act of 1883 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*).

In the case of *Saxby* v. *The Gloucester Wagon Co.* (1880, W. N. 28) Hawkins, J., ordered a patent case to be tried before an official referee, it being a case involving a "prolonged scientific examination," and in his opinion within sect. 57 of the Judicature Act, 1873. This practice has never been followed.

Actions for infringement and petitions for revocation are now almost invariably tried in the Chancery Division, although there is no rule of practice to prevent them from being tried in the King's Bench Division. It is to be noticed that it is only certain special matters that are to be tried before the selected judge. Actions for infringement are tried before any judge before whom the action comes in the ordinary way.

In *Hattersley* v. *Hodgson* (22 R. P. C. 229), an action in the King's Bench Division, an assessor was employed to assist the judge. When the case went to the Court of Appeal (at p. 240) the written statement of the assessor was read to the Court. **Assessor.**

Before the amendment affected by the Act of 1919 either of the parties could insist on trial with an assessor (*b*). Such procedure now requires the consent of all parties.

(*a*) *Sugg* v. *Silber*, L. R. 1 Q. B. D. 362.

(*b*) *Marconi* v. *Helsby Wireless Telegraph Co.*, 31 R. P. C. 121, 399.

An independent expert has also been employed to make experiments and report to the Court in matters in which there was a conflict of testimony (*c*). "His duty is, instead of determining issues of fact, or of law, to find the materials upon which the Court is to act" (*d*).

Where the defendant alleged a secret process in an action for infringement, the hearing was conducted *in camerâ* and the shorthand notes of the trial impounded by order of the Court (*e*).

Jury. Cases have occasionally been tried before a jury at assizes, but the practice is not successful, and it is hardly likely to be followed in the future.

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" (*f*).

Right to begin. 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

(*c*) *Badische Anilin und Soda Fabrik* v. *Levinstein*, 24 C. D. 156; *Moore* v. *Bennett*, 1 R. P. C. 129; *North British Rubber Co.* v. *Macintosh*, 11 R. P. C. 477.

(*d*) Bramwell, L.J., in *Mellin* v. *Monico*, L. R. 3 C. P. D. at p. 149.

(*e*) *Badische Anilin und Soda Fabrik* v. *Levinstein*, 24 C. D. 156.

(*f*) See also Selborne, L.C., in *Patent Marine Inventions Co.* v. *Chadburn*, L. R. 16 Eq. at p. 448.

place himself in the position of plaintiff. But, by sect. 26, sub-sect. 7, of the Act of 1883, it was 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.*" This rule of practice is continued by rule 12 of Order LIIIA.

Counterclaim for revocation.

The defendant has a right to counterclaim for revocation. By sect. 32, "*A defendant in an action for infringement of a patent, if entitled to present a petition to the Court for the revocation of the patent, may, without presenting such a petition, apply in accordance with the Rules of the Supreme Court by way of counterclaim in the action for the revocation of the patent.*"

In such a case the plaintiff naturally begins and has a right to reply. It must be remembered that a defendant is not obliged to counterclaim; he may if he so desires present an independent petition to revoke, but it has always been held that 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* (2 W. P. C. 93, n.) 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* (Hindmarch, 293), 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 the rule for the new trial in *scire facias* had been disposed of (*g*).

Burden of proof.

In *Westley Richards* v. *Perkes* (10 R. P. C. 181) 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. He must prove his patent if the grant be denied. (In practice it is always admitted.) This is done by producing the patent itself, with the seal of the Patent Office attached to it. He must also prove the specifications (these are also always admitted in practice). Sect. 14, sub-sect. 1 provides that, "*A patent sealed with the seal of the Patent Office shall have the same effect as if it were sealed with the Great Seal of the United Kingdom*"; or under sect. 79, if it be not convenient or possible to produce the original, "*Printed or written copies or extracts, purporting to be certified by the Comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, and other documents in the*

(*g*) *Smith* v. *Upton*, 6 M. & G. 251.

Patent Office, and of or from registers and other books kept there shall be admitted in evidence in all Courts in His Majesty's dominions, and in all proceedings, without further proof or production of the originals."

And in Ireland or Scotland where it may be inconvenient to obtain certified copies from the Patent Office recourse may be had to the provisions of sect. 80, "(1) *Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after they have been accepted or allowed at the Patent Office.*

"(2) *Certified copies of or extracts from any such documents and of any documents so transmitted in pursuance of any enactment repealed by this Act shall be given to any person on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.*"

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 78th 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 78th section.

Registration of title necessary.

By sub-sect. (4) of sect. 71 of the Act of 1907, enacted by the amending Act of 1919, "*except in applications made under section seventy-two of this Act* (for rectification of the Register), *a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of*

sub-sections (1) *and* (2) *aforesaid, shall not be admitted in evidence in any court in proof of the title to a patent or copyright in a design or to any interest therein unless the Court otherwise directs.*"

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.

The burden of proving infringement is strictly on the plaintiff, and if he does not satisfactorily prove it there is no necessity for 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 (*h*).

True and first inventor, and novelty.

As to the burden of proof of the validity of the patent, when the defendant pleads that the grantee of the letters patent was not the true and first inventor, or that the invention is not novel, the onus of proof is entirely on him, and no evidence need be given by the plaintiff to establish a primâ facie case (*i*). 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 (*j*).

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 (*k*).

Defect in specification.

When the defendant alleges that there is a defect or insufficiency in the specification, the burden of proving that there is

(*h*) *Betts* v. *Willmott*, L. R. 6 Ch. 239.

(*i*) *Ward* v. *Hill*, 18 R. P. C. at p. 490.

(*j*) *Penn* v. *Jack and Others*, L. R. 2 Eq. at p. 377.

(*k*) *Penn* v. *Jack*, L. R. 2 Eq. at p. 318.

such a defect is on the defendant, after the plaintiff has given primâ facie evidence that the specification is sufficient.

We have seen that it is a question of fact 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.

Functions of expert witness.

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. But the expert may explain the nature of what the defendants have done, and he may be asked whether the elements claimed in the patentee's specification (as construed by the Court) are to be found in the defendants' apparatus (*l*).

An expert cannot be asked whether any given invention is "subject-matter," for this is a question of law (*m*), but he may be asked whether the problem solved by the patentee involved any and what difficulties, and whether the solution offered is satisfactory. An expert may not be asked the "nature of the invention," *i.e.*, the ambit of the claim, for this is a question of construction for the Court alone (*n*).

The function of an expert was very clearly explained by Lindley, L.J., in *Brookes* v. *Steele and Currie* (14 R. P. C. at p. 73). "It is necessary to examine the patent, and to ascertain first what the patented invention really is; and secondly whether the defendants have used that invention. In this, as in all cases, the nature of the invention must be ascertained from the specification, the interpretation of which is for the judge, and not for any expert. The judge may, and indeed generally must, be assisted by expert evidence to explain technical terms, to show the practical working of machinery described or drawn, and to point out what is old and what is new in the specification. Expert evidence is also admissible and is often required to show the particulars in which an alleged invention has been used by an alleged infringer, and the real importance of whatever differences there may be between the plaintiff's invention and whatever is done by the

(*l*) See judgment of Lord Wensleydale, in *Seed* v. *Higgins*, 8 H. L. Cas. at p. 550.

(*m*) See Ch. III. ante.

(*n*) See pp. 99, 119, ante.

defendant. But, after all, the nature of the invention for which a patent is granted must be ascertained from the specification, and has to be determined by the judge and not by a jury, nor by any expert or other witness. This is familiar law, although apparently often disregarded when witnesses are being examined" (*o*).

Questions of Law and Questions of Fact.

(*A summary.*) (*p*)

Questions of law and fact.

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 be useful to consider again what are the questions which the Court should leave to the jury as matters of fact, and what are left to the decision of the Court as matters of law.

As to the specification. The construction is for the Court. The ambit of the claim is for the Court, and the rules of construction are similar to those which govern the construction of other documents.

It is for the jury to say whether the specification is intelligible or not, and it is for the Court to direct the jury as to the class of persons to whom it must be intelligible.

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.

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 new, and to say whether or not they are identical. And so any document

(*o*) See also the remarks of Neville, J., in *Graphic Arts Co.* v. *Hunters, Ltd.*, 27 R. P. C. at p. 687; and in *Joseph Crosfield, Ltd.* v. *Techno-Chemical Laboratories, Ltd.* 30 R. P. C. at p. 309.

(*p*) See Index for separate headings.

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.

Subject-matter is a question of law for the Court.

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.

The question of infringement is a mixed question of law and fact. In *Seed* v. *Higgins* (8 H. L. C. at p. 565) Lord Wensleydale said: "The question of infringement is one of mixed law and fact. The construction of the specification is for the Court, with the aid of such facts as are admissible to explain written documents. In deciding whether there has been an infringement, there is a question of fact wholly for the jury, viz., what the defendants have done; and if scientific evidence is necessary fully to elucidate the case on either side, it is no doubt admissible, and in determinating the question of infringement the judge must apply what the jurymen find to be true. . . . The opinion of scientific witnesses is only admissible as proof of fact." In *De la Rue* v. *Dickenson* (7 E. & B. 755) 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."

VIII. Certificate of Validity.

Sect. 35 of the Act of 1907, as amended by the Act of 1919, is as follows:—

Certificate of validity.

"In an action for infringement of a patent, the Court may certify that the validity of any claim in the specification of the patent came in question; and if the Court 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, unless the Court trying the action otherwise directs, have his full costs, charges, and expenses as between solicitor and client so far as that claim is concerned."

Similar provisions were contained in 5 & 6 Will. IV. c. 83, in sect. 43 of the Patent Law Amendment Act, 1852, and in sect. 31 of the Act of 1883.

The object of these sections is to prevent patentees of important inventions from being ruined by successive actions which they might be obliged to bring to restrain infringements, manufacturers banding themselves together to defeat a patentee's rights in this manner.

Before the amending Act of 1919 a certificate of validity could only be given for the whole patent. The Court may now certify as to any claim. This amendment has been effected in order to correspond with the new sect. 32A.

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.

As to whether the Vice-Chancellor of the Palatine Court can grant a certificate or even the Court of Appeal on hearing appeals from him, see *Proctor* v. *Sutton Lodge Chemical Co.* (5 R. P. C. 184).

To acquire the protection of the 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 has tried the cause.

The Court has no power under the section 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" (*a*).

(*a*) *Penn* v. *Fernie*, L. R. 3 Eq. 308.

For the same reason the costs of a subsequent counter-claim for revocation can only be on the "party and party" scale (*b*).

When a certificate of validity has once been granted there is no need for another in a subsequent action upon the same patent (*c*), save where the validity is attacked on new grounds (*d*).

If the specification is amended after the granting of the certificate, so as to affect the claim or claims certified, the certificate will no longer hold good, and a new one must be applied for in any subsequent action (*e*).

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.* (5 R. P. C. 382), which was an action under sect. 32. 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 sect. 31. Field, J. (p. 404), 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."

Court will protect the public.

In granting this certificate the judge is bound to protect the interests of the public 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 brought merely 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.

When granted.

The practice seems to be to grant the certificate where the plaintiff is quite ready to fight the validity of the patent, even though the fight should not actually take place through the non-appearance or the submission of the defendant; but the

(*b*) *British Vacuum Cleaner Co.* v. *L. and S.W. Ry. Co.*, 27 R. P. C. at p. 670.

(*c*) *Edison* v. *Holland*, 6 R. P. C. 243.

(*d*) See *Flour Oxidising Co.* v. *Hutchinson*, 26 R. P. C. at p. 638.

(*e*) *Brooks & Co., Ltd.* v. *Rendall, Underwood & Co., Ltd.*, 24 R. P. C. 17.

Court ought to be satisfied that the withdrawal of the defendant from the contest is not the result of collusion, and primâ facie evidence should be given in such cases.

In *Haydock* v. *Bradbury* (4 R. P. C. 74) 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. Primâ facie evidence of validity was given, and judgment was given for the plaintiff and a certificate of validity granted (*f*).

In *Chadburn's Telegraph Co.* v. *Robinson* (22 R. P. C. 486) the action was brought upon two patents. As to one of them, the defendants submitted to an injunction before any evidence was given. Evidence was then given in support of the validity of both patents, and the witnesses were not cross-examined. The defendants then submitted, as the result of a compromise, to pay a fixed sum as damages and to become the licensees of the plaintiffs. Farwell, J., granted a certificate in respect of each patent (*g*).

In *Claughton* v. *Foster* (21 R. P. C. 17) the defendant agreed to take a license from the plaintiff, and the certificate was refused.

In *Morris and Bastert* v. *Young* (12 R. P. C. 455) the defendants attacked the validity of the patent only on the assumption that it was wide enough to cover what they were doing. The House of Lords held that there was no infringement, and that the patent was valid on a narrow construction, and therefore refused a certificate of validity (*h*).

No appeal will lie from a granting or refusing to grant a certificate that the validity of a claim of the patent came in question; such appeal not being from a judgment or order within sect. 19 of the Judicature Act (*i*).

(*f*) Also *United Phonograph Co.* v. *Young*, 11 R. P. C. 489; *Acetylene Illuminating Co.* v. *Midland Acetylene Syndicate*, 17 R. P. C. 534; *Brooks* v. *Lycett*, 20 R. P. C. 390; *Consolidated Pneumatic Tool Co.* v. *Churchill*, 22 R. P. C. 367; *British Thomson-Houston Co.* v. *A. and A. Electrical Co.*, 34 R. P. C. 42.

(*g*) And see *Ferguson Superheaters, Ltd.* v. *Askern Coal and Iron Co.*, 29 R. P. C. 431.

(*h*) And see *New Inverted Gas Lamp Co.* v. *Cope and Timmins, Ltd.*, 23 R. P. C. at p. 116.

(*i*) *Haslam* v. *Hall*, L. R. 20 Q. B. D. 491; 5 R. P. C. 144.

"*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 (*j*). The subsequent action.

"*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 (*k*), or where litigation was the natural consequence of the vague and lax manner in which the specification had been drawn up (*l*), costs as between solicitor and client were refused.

In *Otto* v. *Steel* (3 R. P. C. at p. 120) solicitor and client costs were refused on the ground that the validity of the patent was attacked on new grounds entirely; but it is unlikely that that case will be followed at the present day (*m*).

The burden is on the defendant to show cause why he should not pay solicitor and client costs under this section (*n*).

The fact that the validity of the patent was not brought into question in the second action is merely one of the circumstances to be considered by the judge in exercising his discretion, and will not preclude the granting of solicitor and client costs (*o*). This is now decided, although in some older cases it had been doubted.

In two cases, however, where the issue in the second action

(*j*) *The Automatic Weighing Machine Co.* v. *The International Hygienic Soc.*, 6 R. P. C. at p. 480; *Saccharin Corpn.* v. *Anglo-Continental Co.*, 17 R. P. C. at p. 350.

(*k*) *Proctor* v. *Sutton Lodge Chemical Co.*, 5 R. P. C. 184.

(*l*) *Automatic Weighing Machine Co.* v. *National Exhibitions Association*, 8 R. P. C. at p. 352, but query this decision. See also *Boyd* v. *The Tootal Broadhurst Lee Co.*, 11 R. P. C. at p. 185.

(*m*) See *Fabrique de Produits Chimiques* v. *Lafitte*, 16 R. P. C. 68. See also *Flour Oxidising Co.* v. *Hutchinson*, 26 R. P. C. 638.

(*n*) *United Telephone Co.* v. *Patterson*, 6 R. P. C. 142; see also *United Telephone Co.* v. *St. George*, 3 R. P. C. at p. 339; *The Welsbach Incandescent Gas Light Co.* v. *The Daylight Incandescent Mantle Co.*, 16 R. P. C. at p. 354.

(*o*) *Welsbach Incandescent Gas Light Co.* v. *Daylight Incandescent Mantle Co.*, 16 R. P. C. at p. 353; *British Vacuum Cleaner Co.* v. *Exton Hotels, Ltd.*, 25 R. P. C. at p. 629.

was merely one of infringement, solicitor and client costs were refused by Farwell, J. (*p*).

IX. Certificates as to Particulars.

Rule 22 of Order LIIIA. re-enacts, with certain modifications, sub-sect. 6 of sect. 29 of the Act of 1883. The rule is as follows:—"*On taxation of costs in any action or counterclaim for infringement of patent, or in any petition for revocation of a patent under sect. 25 of the Act, or in any counterclaim for revocation of a patent under sect. 32 of the Act, the following provision shall apply, that is to say:—*

"*If the action, petition, or counterclaim proceeds to trial on any patent, no costs shall be allowed in respect of any issues raised in the particulars of breaches or particulars of objections, and relating to that patent to the parties delivering the same respectively, except in so far as such particulars are certified by the Court to have been proven or to have been reasonable and proper, without regard to the general costs of the case; but, subject as aforesaid, the costs of the issues raised by the particulars of breaches and the particulars of objections shall be in the discretion of the taxing master.*" This may be compared with sub-sect. 6 of sect. 29 of the Act of 1883, now repealed, which was as follows:—"*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.*"

Changes effected thereby.

Two principal changes were effected by the rule, viz., (1) Certificates are required in petitions for revocation as well as in actions for infringement, and (2) It is no longer necessary for the action to proceed to trial for the successful party to obtain the costs of his particulars.

It is important, therefore, to ask for a certificate that the particulars of breaches or of objections, as the case may be, were

(*p*) *Saccharin Corporation* v. *Dawson*, 19 R. P. C. at p. 173; *Edison-Bell Phonograph Co.* v. *Waterfield*, 19 R. P. C. at p. 330.

reasonable and proper. The application should be made at the conclusion of the trial, although the omission to do so does not preclude the successful party from obtaining it, provided he applies within a reasonable time, and he is subject to the costs incurred by the delay (*a*).

As to the paticulars of objections, the practice is now well settled that when the action goes to trial, the Court will not certify unless the defendants can actually show that they are reasonable and proper; and so, where the action came on for hearing, and the plaintiff's case broke down by reason of certain of the particulars, the Court would not go through all the particulars with a view to ascertaining whether they were reasonable and proper, and a certificate was granted only as to those upon which the action was decided (*b*). And when the defendant succeeds on the issue of infringement and the issue of validity is not considered, the particulars of objections will not be certified.

If when a case is called on for hearing the plaintiff abandons it, the case is deemed not to have proceeded to trial, and the cost of the particulars are in the discretion of the taxing master (*c*). Where the defendant does not appear at the trial the Court will usually certify for the particulars of breaches on the ground that the defendant's non-appearance is evidence that they are reasonable (*d*).

In some cases it may be reasonable to put a number of specifications to a witness *en bloc*, and if thereupon he concedes the point the certificate may allow each specification (*e*).

Where one of the items in the particulars of objections is relied on as an anticipation, but fails in this capacity, the Court

(*a*) *Rowcliffe* v. *Morris*, 3 R. P. C. 145; *Duckett* v. *Sankey*, 16 R. P. C. 357.

(*b*) *Boyd* v. *Horrocks*, 6 R. P. C. p. 162; *Longbottom* v. *Shaw*, 6 R. P. C. 143, 510; *Peter Pilkington, Ltd.* v. *Massey*, 21 R. P. C. 712.

(*c*) *British Foreign and Colonial, &c., Co.* v. *Metropolitan Gas Meters, Ltd.*, 29 R. P. C. 303; *Babcock and Wilcox, Ltd.* v. *Water Tube Boiler and Engineering Co.*, 27 R. P. C. 626.

(*d*) *Brooks* v. *Hall*, 21 R. P. C. 29; *Saccharin Corporation* v. *Skidmore*, 21 R. P. C. 31.

(*e*) Per Swinfen-Eady, J., in *The Cooper Patent Anchor Rail Joint Co., Ltd.* v. *London County Council*, 23 R. P. C. at p. 297.

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may nevertheless certify for it, if it has been useful in illustrating the state of the art or otherwise (*f*).

And it may occur that costs incurred by a defendant in respect of an investigation into prior knowledge may be allowed as part of the costs of his defence in limiting the plaintiff's claim, although no certificate as to the particulars of the objections may have been granted (*g*).

Particulars of breaches.

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 cost of witnesses, or of and incidental to such breach of objection as is not specially certified for, will be allowed (*h*).

The certificates granted under this rule must not be confused with the certificate under sect. 35. The object of the rule is to provide what costs shall be payable in the action itself, and the object of sect. 35 is to provide for the costs of future actions.

Apportionment of costs.

Where the plaintiff is successful on some issues and the defendant on some, the costs should be apportioned, the plaintiff receiving a certificate as to the particulars of breaches and the defendant as to the particulars of objections. In *Badische Anilin Fabrik* v. *Levinstein* (L. R. 29 C. D. at p. 418; 2 R. P. C. at p. 118), 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

(*f*) *The Castner-Kellner Alkali Co.* v. *Commercial Development Co.*, 16 R. P. C. at p. 276.

(*g*) *Piggott & Co., Ltd.* v. *Corporation of Hanley*, 23 R. P. C. 639.

(*h*) *Honiball* v. *Bloomer*, 10 Exch. 538; see also *Losh* v. *Hague*, 5 M. & W. 387; *Longbottom* v. *Shaw*, 6 R. P. C. 510.

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 (*i*), and where the plaintiff fails on the issue of infringement and succeeds in upholding his patent (*j*), but in each of these cases the issues must be perfectly distinct (*k*), because in theory there is only one issue, viz., the infringement of the plaintiff's legal right (*l*).

In cases of great difficulty the apportionment has been much simplified by the judge at the trial making an order that the entire taxed costs are to be divided between the parties in definite proportions (*m*).

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 (*n*).

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 (*o*). And a similar apportionment may be made where the plaintiff succeeds on one patent and fails on

(*i*) *Brooks* v. *Hall*, 21 R. P. C. 29; *Saccharin Corporation* v. *Skidmore*, 21 R. P. C. 31. See also *Young* v. *Rosenthall*, 1 R. P. C. at p. 41; *Binnington* v. *Hill*, 8 R. P. C. at p. 332; *Cassel Gold Extracting Co.* v. *Cyanide Gold Recovery Syn.*, 11 R. P. C. at p. 653.

(*j*) *Tweedale* v. *Ashworth*, 7 R. P. C. at p. 435; *The Sunlight Incandescent Gas Light Co.* v. *The Incandescent Gas Light Co.*, 14 R. P. C. at p. 755; *Dunlop Pneumatic Tyre Co.* v. *Wapshare Tube Co.*, 17 R. P. C. at p. 458; *Pilkington* v. *Massey*, 21 R. P. C. at p. 712.

(*k*) *Kaye* v. *Chubb*, 4 R. P. C. at p. 300; *Robertson* v. *Purdey*, 24 R. P. C. at p. 302.

(*l*) *Haskell Golf Ball Co.* v. *Hutchinson*, 23 R. P. C. 125.

(*m*) *Incandescent Gas Light Co.* v. *Sunlight Incandescent Co.*, 13 R. P. C. at p. 345; *Monnet* v. *Beck*, 14 R. P. C. at p. 850.

(*n*) *Westley Richards* v. *Perkes*, 10 R. P. C. at p. 194.

(*o*) *Hocking* v. *Fraser*, 3 R. P. C. 3.

another (*p*), or even where the plaintiff succeeds on one claim of a single patent and fails on the others (*q*).

Costs on higher scale.

Costs on the higher scale are only allowed in cases of exceptional difficulty (*r*).

In *Gadd* v. *The Mayor, &c. of Manchester* (9 R. P. C. at p. 535), Lindley, L.J., said: "I think costs on the higher scale ought not 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."

In *The Wenham Gas Co.* v. *The Champion Gas Co.* (8 R. P. C. at p. 320) 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. Costs on the higher scale have been refused although the costs of three counsel have been allowed (*s*).

Three counsel.

The principle upon which costs on the higher scale should be allowed and the costs of briefing three counsel were discussed, and the authorities considered, by Buckley, J., in *The Dunlop Pneumatic Tyre Co.* v. *The Wapshare Tube Co.* (17 R. P. C. at p. 459), where both were allowed. But in the majority of cases in recent times they have been refused (*t*).

The practice has now arisen of leaving the question of allowing three counsel to the taxing master (*u*).

Costs of shorthand notes.

The costs of the shorthand notes are usually agreed between the parties before the trial commences, but in default of such an arrangement they will not be allowed unless they have been of material assistance to the Court in shortening the amount of time the case has taken, or otherwise (*v*).

(*p*) *Brooks* v. *Lamplugh*, 15 R. P. C. at p. 52.

(*q*) *Mouchel* v. *Coignet*, 23 R. P. C. 649.

(*r*) *Farbenfabriken vorm. F. Bayer & Co.* v. *Bowker*, 8 R. P. C. 389, 397; *Hopkinson* v. *St. James' Electric Light Co.*, 10 R. P. C. 46, 62; *Muirhead* v. *Commercial Cable Co.*, 12 R. P. C. at p. 64; *British Liquid Air Co.* v. *British Oxygen Co.*, 25 R. P. C. 218, 577; *Andrews' Patent*, 24 R. P. C. at p. 378.

(*s*) *Marconi* v. *British Radio Co.*, 28 R. P. C. 181.

(*t*) On this point, see the list of authorities cited in *Bradford Dyers' Association* v. *Bury*, 19 R. P. C. 125.

(*u*) *Andrews' Patent*, 24 R. P. C. at p. 378.

(*v*) See, *e.g.*, *Castner-Kellner Alkali Co.* v. *Commercial Development Co.*,

Public Authorities Protection Act.

Under the Public Authorities Protection Act, 56 & 57 Vict. c. 61, a public authority is entitled to costs as between solicitor and client, and this applies to actions for infringement (*w*).

No appeal as to costs.

Sect. 49 of the Judicature Act, 1873, provides that there shall be no appeal as to costs save where the costs were a matter of right, and not discretionary (*x*).

Directors of companies.

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.* (6 R. P. C. 46) a motion for sequestration and attachment for breach of an injunction, 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 (*y*).

Where an action is brought against two defendants and the case against one of them is settled, and the action proceeds against the other and judgment is recovered, then unless a special order as to costs is made no deduction on taxation will be made from the general costs of the action to represent the amount incurred as against the defendant whose case was settled (*z*).

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, when an inquiry is directed, 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.

16 R. P. C. at p. 275; *The Palmer Tyre Co., Ltd.* v. *Pneumatic Tyre Co., Ltd.*, 16 R. P. C. at p. 496.

(*w*) *Chamberlain and Hookham* v. *Bradford*, 17 R. P. C. 762; *British Thomson-Houston Co.* v. *Manchester*, 20 R. P. C. at p. 471; cf. *New Conveyor Co.* v. *Edinburgh Commissioners*, 21 R. P. C. 147.

(*x*) *Turner* v. *Hancock*, 20 C. D. 303, C. A.

(*y*) See also *Betts* v. *De Vitre*, L. R. 3 Ch. 429.

(*z*) *Kelly's Directories, Ltd.* v. *Gavin and Lloyds*, 1901, 2 Ch. 763; *Badische Anilin und Soda Fabrik* v. *Hickson*, 23 R. P. C. 149.

A common course with regard to costs is for the solicitor to the successful party to give an undertaking to return the costs in the event of a successful appeal (*a*). In *Ackroyd and Best* v. *Thomas* (21 R. P. C. at p. 412), where the solicitors refused the undertaking, Joyce, J., stayed the payment of the costs, but refused to stay the taxation.

PRACTICE ON APPEAL.

Under Order LVIII. r. 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* (2 R. P. C. at p. 47), 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 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*) *The Ticket Punch Register Co.* v. *Colley's Patents, Ltd.*, 12 R. P. C. at p. 10.

a mere flood of affidavits made up to meet the blots and defects which have been disclosed upon the first trial" (*b*).

As to amendment of pleadings and particulars, in *Cropper* v. *Smith* (L. R. 26 C. D. at p. 710), Bowen, L.J., said: "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."

In *The Shoe Machinery Co.* v. *Cutlan* (12 R. P. C. 530) the Court of Appeal refused to allow amendment of the particulars of objections by adding seven new anticipating specifications. They based their decision on the fact that no satisfactory explanation was forthcoming as to why these specifications had not been found before. But in *Pirrie* v. *York St. Spinning Co.* (11 R. P. C. at p. 431) the Court allowed a similar application, which was supported, however, by affidavits by the applicant's patent agents, that a diligent and careful search had been made, and that the new specifications could not have been discovered in spite of proper care.

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 its own costs of the appeal (*c*).

(*b*) And see *Nadel* v. *Martin*, 20 R. P. C. 721. Instances where fresh evidence was allowed on appeal were *Britain* v. *Hirsch*, 5 R. P. C. 226; *Spencer* v. *Ancoat's Rubber Co.*, 6 R. P. C. 46; *Blakey* v. *Latham* 6 R. P. C. at p. 186.

(*c*) *Moore* v. *Bennett*, 1 R. P. C.

The costs of employing an expert to assist counsel in the Court of Appeal will not be allowed save under the most special circumstances (*d*).

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 R. P. C. 260, 269.

(*d*) *Consolidated Pneumatic Tool Co.* v. *Ingersoll Sergeant Drill Co.* 25 R. P. C. 574.

CHAPTER XVII.

RIGHTS OF THE CROWN AND TAXATION.

ALTHOUGH it had been the practice for the Crown to remunerate inventors when their inventions were used in the service of the Crown it was decided in *Feather* v. *The Queen* (6 B. & S. 257), notwithstanding that the patent included a condition that the patentee should supply the patented articles for the use of the Crown at or upon such reasonable prices and terms as should be settled by the officers of the Crown requiring them, and that the letters patent should be "taken, construed and adjudged in the most favourable and beneficial sense for the best advantage of" the patentee, that the Crown might use the inventions protected by the patent without the assent of or compensation made to the patentee.

In *Dixon* v. *London Small Arms Co.* (L. R. 10 Q. B. 130) it was, however, held that the decision in *Feather* v. *R.* was not to be extended so as to protect a contractor, as distinguished from a servant or agent of the Crown, who supplied to the Crown patented articles manufactured without license from the patentee, and this unanimous decision of the Court of Queen's Bench, reversed by the unanimous decision of the Court of Appeal (*a*), was restored by the House of Lords (*b*).

The right of the Crown to use a patented invention for the public service without being under any obligation to remunerate the inventor was expressly abolished by sect. 27 of the Act of 1883, re-enacted by sect. 29 of the Act of 1907, and this section, now amended by the Act of 1919, is as follows:—

"29.—(1) *A patent shall have to all intents the like effect as against His Majesty the King as it has against the subject:*

"*Provided that any Government department may, by*

(*a*) 1 Q. B. D. 384. (*b*) 1 A. C. 632.

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

It will be observed that this sub-section places contractors who are authorised on the same footing as servants and agents of the Crown as regards immunity. It is submitted that the authorisation in *writing*, required for the first time by the Act of 1919, need not refer explicitly to the patent in question, but may be inferred from the terms of the written contract as was done in *Pyrene Co., Ltd.* v. *Webb Lamp Co.* (37 R. P. C. 57), the judgment in which was delivered a few days before the amended section came into operation. Provided, therefore, the contract leaves no doubt as to the article which is to be made or the process which is to be used in making it, no specific reference to the patent need appear in it and, indeed, the officers of the department and the contractors may be in ignorance of the existence of the patent. It should also be noted that while under the unamended section the right given was "to use the invention" in the section as amended the right is "to make use or exercise the invention," but it is not clear that this change in any way alters the rights of the Crown (*c*).

Following the practice initiated during the war, when a Royal Commission presided over by a judge of the High Court was appointed on March 19, 1919, with powers *inter alia* to settle in lieu of the Treasury the sum to be paid by the Crown for the use of patented inventions, the provisions of the amended section substitute for the Treasury a new tribunal for this and other purposes. It has been decided that the new procedure

(*c*) *In re Hale's Patents*, 37 R. P. C. at p. 174.

(laid down in sub-sect. 2) of settling claims is not retrospective, *i.e.* if the user was prior to April 23, 1920, on which date the sub-sects. 1, 2 and 4 came into operation (*d*), the method laid down by the Act of 1907, unamended, as modified by the appointment of the Royal Commission, applied (*e*).

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

The question arises as to whether the words "*recorded in a document by . . . any Government department*" apply to a provisional specification, or to a complete specification before publication, which has been lodged at the Patent Office. If they do so apply then a Government department, *e.g.* the Admiralty, which has a claim made against it under this section may refer to such an unpublished specification to defeat the inventor's claim. On the other hand, it must be observed that under sect. 69 of the Act of 1907 the Comptroller is not allowed to communicate or publish such specifications, and this prohibition extend as much to communication to other Government departments as to a private individual. It is true that during the war he was allowed, under Regulation 18B of the Defence of the Realm Regulations, to communicate to the Admiralty, the Army

(*d*) S. R. & O., 1920, No. 658. R. P. C. 371.
(*e*) *In re Hale's Patents*, 37

Council and Air Council such inventions as he considered of military interest, but this regulation is no longer in force, and it is submitted that sect. 69 now prevents him doing so. It is clear that if the Government department have recorded a private letter in which the invention is disclosed, this, although not a publication which could invalidate the patent, will be enough to defeat the claimant's application for reward. A Government department, therefore, is in this respect in a position stronger than that of a defendant in an ordinary infringement action.

"(2) *In case of any dispute as to the making, use or exercise of an invention under this section, or the terms therefor, or as to the existence or scope of any record or trial as aforesaid, the matter shall be referred to the court for decision, who shall have power to refer the whole matter or any question or issue of fact arising thereon to be tried before a special or official referee or an arbitrator upon such terms as it may direct. The court, referee, or arbitrator, as the case may be, may, with the consent of the parties, take into consideration the validity of the patent for the purposes only of the reference and for the determination of the issues between the applicant and such Government department.*"

Pausing here for a moment it is not clear what effect, if any, is to be attributed to the last sentence. It does not give the patentee the right to insist on the question of validity being determined by the Court, referee, or arbitrator, if the Crown does not admit validity, and the Crown may still maintain the attitude adopted by the Treasury in the past that nothing is payable by the Crown for the user of an invention, the validity or infringement of which is not admitted.

It has been suggested by Sargant, J., who was also the Chairman of the Royal Commission already referred to, that in these circumstances a patentee could proceed by petition of right for a declaration by the Courts as to validity.

In two cases (*f*) under the former provisions the Crown agreed

(*f*) *Nobel Explosives Co., Ltd.* v. *Anderson*, 11 R. P. C. 115, 519; 12 R. P. C. 164; *Maxims Nordenfeldt Guns and Ammunition Co., Ltd.* v. *Anderson*, 14 R. P. C. 371.

to allow a nominal defendant to be sued for infringement in the ordinary way before the Courts, and the question of validity and infringement was tried, but this is a voluntary proceeding on their part, and the infringement of a patent, being a tort, does not enable the patentee to proceed by petition of right against the Crown (*g*).

Apart from the provision, the determination of validity has no effect (except on the question of costs in subsequent actions, if a certificate is obtained that the validity of the patent came into question) except *inter partes*.

Sub-sect. (2) continues: "*The court, referee, or arbitrator, further in settling the terms as aforesaid, shall be entitled to take into consideration any benefit or compensation which the patentee, or any other person interested in the patent, may have received directly or indirectly from the Crown or from any Government department in respect of such patent.*"

It has been decided by Sargant, J., that the "Court" for the purposes of this sub-section, is the High Court, as defined by sect. 92 (1), and not the judge selected by the Lord Chancellor under sect. 92 (2) of the Act (*h*).

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

The Crown's right to sell implies the purchaser's right to use the articles in this country, but not in the colonies or foreign countries if they are infringements of local patents. A purchaser of unassembled parts, which are in themselves unprotected, of a patented article, will also not be protected from an action for infringement of a patent for the combination if he assembles them.

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

(*g*) *Feather* v. *R.*, 6 B. & S. 257.

(*h*) *In re Hale's Patent*, 37 R. P. C. p. 174.

Goods forfeited under the provisions of the Merchandise Marks Acts, 1887, on importation (see sect. 16) but not otherwise (see sect. 2) are "*articles forfeited under the laws relating to the customs or excise.*" It is, however, submitted that these Acts only empower the Crown to forfeit and sell such articles, and that they do not permit the Crown or purchasers from them to use the articles if they are infringements of a patent any more than the right to use a patented article can be taken in execution under a writ of *fi. fa.* (*i*).

DEFENCE OF THE REALM ACTS.

The Regulations made during the war under the Defence of the Realm Acts in so far as they dealt with patents or inventions may be summarised as follows:—

8cc. Enabled certain Government departments, including the Food Controller, with a view to the more efficient or increased production of war material, to require the communication to their nominee of all particulars of any invention or process or method of manufacture, and provided that the communication of the invention should not prejudice the right of the inventor or owner subsequently to apply for or obtain a patent.

18B. Enabled the Comptroller, after consultation with and at the request of the Admiralty, Army Council or Air Council might delay the acceptance of the complete specification for a patent, the publication of which might be detrimental to the public safety, and might in such case prohibit:

(*a*) the publication or communication in any way of the invention;

(*b*) application being made for the protection of the invention in an enemy or neutral country; and

(*c*) application being made for the protection of the invention in any allied country or in any of the Dominions without permission.

The Regulation further prohibited the application for any patent abroad without the permission of the Comptroller.

These regulations have both been repealed, but they are of

(*i*) *British Mutoscope Co.* v. *Homer*, 18 R. P. C. 177.

interest as showing the additional powers deemed necessary by the Crown during a national emergency.

30A. Prohibited the entering into negotiations for the sale or purchase or other dealing in any right in any invention or process of manufacture relating to certain classes of war material without the permission of the competent naval or military authority.

Finally, 40BB enabled the Local Government Board to authorise any local authority or person to purchase, distribute and use medicinal preparations for the treatment of venereal diseases without being liable to any action for infringement of patent rights.

This power is an extension of the rights of the Crown conferred by sect. 29 of the Act of 1907 in that the user authorised is not confined to contractors or agents of the Crown, and the assessment of compensation (if any) is transferred from the Treasury to the Defence of the Realm Losses Commission. This regulation expires with the termination of the War.

Indemnity Act.

The Indemnity Act (*j*) has, we suggest, no effect on the rights of patentees as regards the use of inventions by the Crown or Government departments. The proviso to clause 1, sub-sect. (1) enacts: "*Provided that, except in cases where a claim for payment or compensation can be brought under section 2 of this Act, this section shall not prevent . . . (c) the institution or prosecution of proceedings respecting the validity or infringement of a patent.*" And the cases excepted by sect. 2 only apply to persons who have incurred or sustained any direct loss or damage "*by reason of interference with*" their property or business. We contend that infringement of a patent is not an interference with property or business within the meaning of this definition, and where the right of dealing with a patent has been interfered with under Regulation 30A the right of claiming compensation would not be in respect of infringement.

(*j*) 10-11 Geo. 5, c. 48.

STAMP DUTY.

In view of the amended provisions of sect. 71 of the Act of 1907 by which patentees, licensees, and others who fail to register the documents under which they acquire their title are placed under disabilities, the question of stamping has assumed an added importance. The Comptroller is liable to a penalty of 10*l.* if he register a document which is not duly stamped (*k*), and he may therefore refuse to register a document where he is not satisfied that the true consideration is not stated on the face of the document (*l*). The proper mode of questioning the legality of his refusal is to obtain the opinion of the Commissioners of Inland Revenue. An appeal from their decision lies to the High Court (*m*).

An assignment of a patent requires to be stamped as a conveyance or transfer on sale on the *ad valorem* scale imposed by the Finance (1909–1910) Act, 1910, which is at the rate of approximately 1 per cent. on the consideration money. The scale is arranged in stepped stages, and must be consulted. It should be noted that where the consideration for sale does not exceed 500*l.*, and the instrument contains a statement certifying that the transaction thereby effected does not form part of a larger transaction in respect of which the amount or value, or the aggregate amount or value, of the consideration exceeds 500*l.*, the sale is at one-half of the above rate.

An irrevocable license to use and vend is also liable to conveyance duty on sums reserved by way of fixed royalties during the life of the patent, but if the license contains a power of revocation no conveyance duty is payable in practice though covenant duty may be payable (see post).

For the purposes of conveyance duty it is immaterial whether a conveyance is under hand or under seal, but a deed must always bear a 10*s.* stamp unless the *ad valorem* duty exceeds this amount. Licenses which are not liable to conveyance duty because they are revocable will however be liable to

(*k*) Stamp Act, 1891, sect. 17.

(*l*) *Maynard* v. *Consolidated Kent Collieries*, 29 T. L. R. 448.

(*m*) *R.* v. *Registrar of Joint Stock Companies*, 21 Q. B. D. 131.

covenant duty, which is an *ad valorem* duty of $\frac{1}{8}$ per cent., in so far as they contain a covenant to pay fixed royalties, and the duty will be calculated on the amount to be received for the whole life of patent or period of the license. No duty is, however, payable on the royalty per article, apart from any minimum, as it is indeterminate, and no *ad valorem* duty is payable in respect of a lump sum of money paid down in consideration of the grant of a revocable license.

By sect. 59 (4) of the Stamp Act, 1891, the *ad valorem* stamp is not required for the mere purpose of enforcing specific performance or recovering damages for the breach of a contract or agreement for a license.

Though foreign patents rights are not within the scope of this book, and documents transferring rights in them are not registrable at the Patents Office, certain decisions in connection with the stamping of agreements made in this country for transferring foreign patent rights may not be out of place.

For the purposes of the Stamp Acts it has been held that a share in a patent and a sole license to use the invention patented are property (*n*). It was further held that such an interest in a colonial patent was not "property locally situate out of the United Kingdom," and that therefore an agreement to sell such rights made in this country was liable to pay "conveyance duty" on the lump sum which was agreed as the purchase price for both the share of the patent and the license as though it were an actual conveyance on sale (*o*).

The correctness of this decision of the Court of Appeal as regards the "local situation" of interests in foreign patents has been gravely doubted by Lord Lindley in a case dealing with the local situation of goodwill (*p*) on the ground that the patent was not assignable without registration in Australia and was therefore locally situated there, like shares, the transfer of which had to be registered in Australia. It has, however, been decided by the Court of Appeal that the decision in the

(*n*) *Smelting Company of Australia* v. *Commissioners of I.R.*, 1897, 1 Q. B. at p. 181,

(*o*) Ibid.

(*p*) *Müller & Co.'s Margerine* v. *Commissioners*, 1901, A. C. 237.

Smelting Co. of Australia Case was not overruled by *Müller's Case*, and it is therefore still law (*q*).

The question of the "local situation" of interests in foreign patents is also of importance in connection with Estate Duty (*r*).

INCOME TAX AND EXCESS PROFITS DUTY.

The high rates of income tax have also rendered an understanding of their rights and duties in this respect of increased importance to patentees and licensees, and an attempt is here made to state the law on the subject.

Sale of patent.

The proceeds of sale of a patent for a lump sum is not treated as annual income of a patentee and is exempt from income tax, for invention can hardly be treated as a profession (*s*). But if a man habitually invented and sold his patents it might be said he was carrying on a business (*t*), though not even then if he retained his patents and only granted licenses in return for royalties (*u*). For a royalty income, like a shareholder's income, cannot be regarded as income derived from a business, and cannot therefore be assessed for excess profits duty.

Royalties.

But though not liable to excess profits duty royalties received by a patentee are subject to income tax, the tax being deducted at its source.

The manufacturer is not allowed to make any deduction from his profits for purposes of income tax in respect of the royalty paid (*v*), though he may do so for the purpose of computing profits for excess profits duty (*w*). If the royalty is paid out of profits or gains on which income tax has been paid he is entitled on making the royalty payment to deduct and

(*q*) *Urban and Another* v. *Commissioners*, 1913, 29 T. L. R. 476.

(*r*) Finance Act, 1894, sect. 2, II. (2).

(*s*) Report of Departmental Committee on Income Tax, 1905, cmd. 2575, para. 51–52.

(*t*) *Commissioners of I.R.* v. *Sangster*, 1920, 1 K. B. 587.

(*u*) *Commissioners* v. *Marine Steam Turbine Co.*, 89 L. J. K. B. 49.

(*v*) Income Tax Act, 1918. Rules applicable to Cases I., II., Schedule D, rule 3, but see *Lanston Monotype Corporation* v. *Anderson*, 1911, 2 K. B. 15 and 1019, and *Boyd* v. *Havelock*, 1918, S. C. 727, as to the effect of royalties having ceased to be payable.

(*w*) Finance (No. 2) Act, 1915, Fourth Schedule, Part I. (2).

retain a sum representing the tax at the appropriate rate (*x*), for the period during which the royalty was accruing due (*y*), and if the royalty is paid out of profits which in whole or in part have not paid income tax he *must* deduct income tax from the sum paid as royalty, and account for the sum deducted to the Commissioners of Inland Revenue.

Deduction of income tax on royalties at the source secures the collection of the tax on the profits derived from the working of patents in the United Kingdom payable to patentees who reside abroad and have no agent resident in this country.

Deductions for expenses.

A patentee who has income tax deducted from his royalties is however entitled to claim an allowance for his expenses, including litigation expenses for the purpose of protecting and enforcing his patent rights (*z*).

Wasting assets.

Patents are material assets for the purpose of ascertaining the amount of capital employed in a business for Excess Profits Duty, and their value must be estimated at the time of introduction into the business (*a*).

In dealing with the question of the allowance for wasting assets the Royal Commission on the income tax has recommended as follows: Cmd. 615/1920 at para 197.

"Our general recommendation is that where copyrights, patent rights, goodwill and trade marks are in the hands of the original owner, no allowance for depreciation should be made, nor should any allowance be given to the purchaser of any assets of this nature if the vendor is within the scope of the United Kingdom Income Tax. We do, however, recommend that an allowance calculated in accordance with paragraphs 186–188 should be made to the patentee in respect of the proved cost of experimenting and patenting, whether (a) he works the patent himself, or (b) lets it on a royalty. If the patent is sold outright the allowance should be granted to the purchaser."

(*x*) Income Tax Act, 1918, General Rules, Schedules A, B, C, D, and E, 19 (2).

(*y*) Income Tax Act, 1918, General Rules, Schedules A, B, C, D, and E, 21 (1) and (2).

(*z*) Royal Commission on Income Tax, 1920: Cmd. 615, questions 2693/6.

(*a*) *Hamer* v. *I.R. Commissioners*, 37 T. L. R. 15.

CHAPTER XVIII.

WAR AND PEACE LEGISLATION.

Special legislation.

SPECIAL legislation dealing with Patents and arising out of the war is contained in the following Acts and in the orders, rules, and regulations made thereunder:—

1. Patents, Designs, and Trade Marks (Temporary Rules) Act, 1914 (*a*), amended by the Patents, Designs, and Trade Marks Temporary Rules (Amendment) Act, 1914 (*b*), together hereinafter referred to as the "Rules Acts."

2. Patents and Designs Act (Partial Suspension) Act, 1915 (*c*).

3. Defence of the Realm Act, 1914 (*d*).

4. Trading with the Enemy Acts, 1914 to 1918.

5. Treaty of Peace Acts.

6. Indemnity Act, 1920.

7. International Arrangement, signed at Berne, 30th June, 1920.

In addition a number of cases dealing with the rights and disabilities of enemy patentees during the war were decided by the Courts.

ENEMY WAR-TIME APPLICATIONS.

Common law.

In *Bloxam* v. *Elsee* (1825, 1 C. & P. at p. 564) the question whether a patent, granted to a British subject acting as trustee for a French subject at a time when this country was at war with France, was void, was raised but not decided. Be that as it may, patents were not granted directly to enemies during the Great War, but various steps were taken to give this country the benefit of enemy inventions without assisting the enemy.

(*a*) 4–5 Geo. 5, c. 27.
(*b*) 4–5 Geo. 5, c. 73.
(*c*) 5–6 Geo. 5, c. 85.
(*d*) 4–5 Geo. 5, c. 29.

At first applications from enemy nationals were received, and patent agents and others were licensed to pay the necessary fees, but formal acceptance of the specifications was not issued. As such documents might be of importance to British manufacturers, and as they might be anticipations of later applications, it was subsequently decided to accept and publish them in the ordinary way, but to withhold the grant. Following the policy, adopted in the early days of the war, of granting licenses under existing enemy patents under the "Rules Acts" (see post), patents were granted to the Custodian, under sect. 6 of the Trading with the Enemy (Amendment) Act, 1916 (*e*), on applications by or on behalf of or for the benefit of an enemy, and licenses to use such patents were thereupon granted by the Custodian to manufacturers in this country. Later a reversal of policy took place and enemy applications were no longer received, and finally, pursuant to the provisions of the Trading with the Enemy (Amendment) Acts, 1916 and 1918, a general Vesting Order, dated the 30th October, 1918, vested the benefit of all outstanding enemy owned patents and of applications made on their behalf in the Custodian.

Early policy.

Reversal of policy.

General vesting of all enemy interests.

This Order is set out in full at p. 438. It will be observed that while it operated to vest the patent interests of certain definite companies, namely, those in respect of which Orders under the Trading with the Enemy Acts had been made, in general the patents which it vested were unascertained and were not recorded on the Register. The Order also did not specify whether it operated on future-acquired interests as well as on existing interests, and this question may prove to be of importance in view of the restrictions subsequently imposed on all interests vested by the Order.

The Treaty of Versailles with Germany was signed on 28th June, 1919, and was ratified and came into force on 10th January, 1920. The Treaty of Peace Act, 1919 (*f*), enables His Majesty to make Orders in Council, and to do such things as appear necessary for carrying out the Treaty with Germany. The Treaty of Peace Order, 1919 (*g*), made pursuant to this

Statutory sanction of Treaties.

(*e*) 5-6 Geo. 5, c. 105. Amended by S. R. & O., 1920, No. 1410.
(*f*) 9-10 Geo. 5, c. 33.
(*g*) S. R. & O., 1919, No. 1517.

Act provides that certain sections of the Treaty, *inter alia* Articles 306 to 310 dealing with Industrial Property, shall have full force and effect as law as from 10th January, 1920, and it is only in so far as the Treaty alters the law relating to patents in the United Kingdom that its provisions will be considered in this chapter. In so far as Industrial Property in the United Kingdom is concerned, the Treaties with Austria, Bulgaria, Hungary and Turkey are substantially in similar terms to the Treaty with Germany, and reference will therefore only be made to the Articles of the German Treaty.

It should however be noted that the Treaties with Austria and Bulgaria have been ratified and made part of the law of the United Kingdom, and the nationals of the signatory powers, including those of the United Kingdom, consequently have under the provisions for the extension of time a similar period as under the German Treaty, but running from a later date (*h*). As this appears to be considered an inconvenient and unnecessary privilege, suitable measures may still be adopted in agreement with the other allied signatory powers to limit such extended times, as far as the rights of British and Allied nationals in the United Kingdom are concerned, to the period granted by the Treaty with Germany and the "Rules Acts."

In this connection it should be noted that in adhering to the International Arrangement concerning the preservation and re-establishment of rights of Industrial Property affected by the war, signed by certain belligerents and neutrals at Berne on 30th June, 1920 (*i*), hereinafter referred to as the "Berne Arrangement," which provides, *inter alia*, for longer extensions of time than are respectively provided for by Articles 307 (para. 1) and 308 of the Treaty with Germany (see post), these extensions, so far as the United Kingdom is concerned, have been limited so as to expire on 10th January, 1921.

In considering the construction to be placed on the terms of the Treaty the following points should be borne in mind:—

1. The Treaty was imposed on Germany and therefore,

(*h*) July 16th, 1920, in the case of the Austrian Treaty, and August 9th, 1920, in the case of the Bulgarian Treaty, S. R. & O., 1920, Nos. 1613, 1614.

(*i*) Treaty Series, 1920, No. 18.

according to the rules of International law, if there is a doubt as to whether it imposes a disability on German interests the doubt will probably be resolved in favour of Germany.

2. The French and English texts are both authentic, so that where they differ Germany will probably be able to choose the meaning which suits her best.

3. Prior to the signature of Treaty the Allied and Associated Powers explained and limited the scope of certain provisions of the Treaty in their "Reply to the Observations of the German Delegation on the Conditions of Peace," hereinafter referred to as the "Allied Reply" (*j*).

RESTORATION OF, AND RESTRICTIONS ON GERMAN-OWNED PATENTS.

Article 306 of the Treaty provides for the re-establishment, subject to exceptions and conditions, of German-owned patents, and for the establishment of patent rights which would have been acquired in this country but for the war by virtue of applications in this or other countries during the war, in the following terms:—

Article 306, para. 1.

"*Subject to the stipulations of the present Treaty, rights of industrial, literary, and artistic property, as such property is defined by the International Conventions of Paris and of Berne, mentioned in Article* 286, *shall be re-established or restored, as from the coming into force of the present Treaty, in the territories of the High Contracting Parties, in favour of the persons entitled to the benefit of them at the moment when the state of war commenced or their legal representatives. Equally, rights which, except for the war, would have been acquired during the war in consequence of an application made for the protection of industrial property, or the publication of a literary or artistic work, shall be recognised and established in favour of those persons who would have been entitled thereto, from the coming into force of the present Treaty.*

"*Nevertheless, all acts done by virtue of the special measures taken during the war under legislative, executive or administrative authority of any Allied or Associated Power in regard to the*

(*j*) 1919, Misc. No. 4, Cmd. 258.

rights of German nationals in industrial, literary or artistic property shall remain in force and shall continue to maintain their full effect."

In addition to the provisions of Articles 306 to 310 which are dealt with seriatim hereafter the principal "stipulations of the present Treaty," to which restoration and establishment are subject, are contained in Article 297 and in the Annex to sect. IV. of the Treaty. Paragraph 15 of the latter is as follows:—

Sect. IV., annex.

"15. *The provisions of Article* 297 *and this Annex apply to industrial, literary and artistic property which has been or will be dealt with in the liquidation of property, rights, interests, companies or businesses under war legislation by the Allied or Associated Powers, or in accordance with the stipulations of Article* 297, *paragraph* (*b*)."

Article 297, paragraph (*b*), is as follows:—

Article 297 (b).

"*Subject to any contrary stipulations which may be provided for in the present Treaty, the Allied and Associated Powers reserve the right to retain and liquidate all property, rights, and interests belonging at the date of the coming into force of the present Treaty to German nationals, or companies controlled by them, within their territories, colonies, possessions and protectorates, including territories ceded to them by the present Treaty.*

"*The liquidation shall be carried out in accordance with the laws of the Allied or Associated State concerned, and the German owner shall not be able to dispose of such property, rights, or interests nor to subject them to any charge without the consent of that State.*

"*German nationals who acquire* ipso facto *the nationality of an Allied or Associated Power in accordance with the provisions of the present Treaty will not be considered as German nationals within the meaning of this paragraph.*"

The Treaty, therefore, empowers the Allies to liquidate all patent rights and interests belonging on 10th January, 1920, to German nationals and German-controlled corporations. Where advantage has been or is in future taken of this provision Article 306 has no application, for its final paragraph provides:—

Article 306, para 7.

"*The provisions of this article shall not apply to rights in*

industrial, literary, or artistic property which have been dealt with in the liquidation of businesses or companies under war legislation by the Allied or Associated Powers, or which may be so dealt with by virtue of Article 297, *paragraph* (*b*)."

And the "Allied Reply" explains that :—

Allied reply

"2. *The last paragraph of Article* 306 *relates only to cases where German-owned companies and businesses have been, or will be hereafter liquidated under Article* 297. . . . *The provision . . . is therefore limited to the businesses or companies which are, or will be, in existence at the coming into force of the Treaty.*"

Divesting Order.

Instead of carrying out a general liquidation of all such German-owned patent rights and interests as had not already been dealt with, these were, subject to the restrictions contained in an Order made by the Board of Trade on 19th July, 1920 (*k*), restored by the Custodian to the persons entitled to them. This Order, hereinafter referred to as the "Divesting Order," is set out in full at p. 440, and as it imposes drastic restrictions and limitations on "restored patents" and "restored applications" it will in due course be necessary to examine carefully what these expressions cover.

Article 306 continues :—

Article 306, para. 2.

"*No claim shall be made or action brought by Germany or German nationals in respect of the use during the war by the Government of any Allied or Associated Power, or by any persons acting on behalf or with the assent of such Government, of any rights in industrial, literary or artistic property, nor in respect of the sale, offering for sale, or use of any products, articles or apparatus whatsoever to which such rights applied.*"

This provision prevents German nationals making any claim against the Crown under sect. 29 of the Act of 1907 for user during the war, and protects subsequent purchasers of articles so used on the lines of the protection afforded by sub-sect. (3) of sect. 29 of the Act of 1907, as amended.

Article 306 continues :—

Article 306, para. 3.

"*Unless the legislation of any one of the Allied or Associated Powers in force at the moment of the signature of the present*

(*k*) S. R. & O., 1920, No. 1336.

Treaty otherwise directs, sums due or paid in virtue of any act or operation resulting from the execution of the special measures mentioned in paragraph 1 *of this Article shall be dealt with in the same way as other sums due to German nationals are directed to be dealt with by the present Treaty; and sums produced by any special measures taken by the German Government in respect of rights in industrial, literary or artistic property belonging to the nationals of the Allied or Associated Powers shall be considered and treated in the same way as other debts due from German nationals."*

When licenses were granted under the "Rules Acts" the royalties reserved were payable to the Public Trustee, and were recoverable by the Board of Trade as debts due to the Crown. The above provision gives the benefit of such royalties to the German nationals, and provides for their being dealt with through the Clearing Office in the same way as other credits. The proviso to clause 8 of the "Divesting Order" directs that the payment of such royalties to the Custodian shall be continued.

In addition to their powers under the "Rules Acts," which will expire six months after the termination of the war, the Board of Trade are given power by the Treaty of Peace Order 1919, sect. 1, sub-sect. xx., to prescribe the limitations, conditions and restrictions to be imposed on patent rights acquired before or during the war or which may be acquired hereafter by German nationals, as provided in the following paragraph of Article 306:—

Article 306, para. 4.

"Each of the Allied and Associated Powers reserves to itself the right to impose such limitations, conditions, or restrictions on rights of industrial, literary, or artistic property (with the exception of trade marks) acquired before or during the war, or which may be subsequently acquired in accordance with its legislation, by German nationals, whether by granting licences, or by the working, or by preserving control over their exploitation, or in any other way, as may be considered necessary for national defence, or in the public interest, or for assuring the fair treatment by Germany of the rights of industrial, literary, and artistic property held in German territory by its nationals, or for securing the due

fulfilment of all the obligations undertaken by Germany in the present Treaty. As regards rights of industrial, literary, and artistic property acquired after the coming into force of the present Treaty, the right so reserved by the Allied and Associated Powers shall only be exercised in cases where these limitations, conditions, or restrictions may be considered necessary for national defence or in the public interest."

Allied reply.

According to the "Allied Reply" this paragraph has by no means for its object the outlawing of such property or the confiscation of these rights.

"(*a*) *It is intended, on the one hand, to reserve to the Allied and Associated Powers the right to impose restrictions on industrial . . . property when considered necessary for national defence or public interest. This right, which Germany has reserved to herself by her domestic legislation is a general and continuing right, to be exercised as occasion arises in respect of industrial . . . property acquired before or after the coming into force of the Treaty of Peace.*

"(*b*) *It is intended, on the other hand, to retain the power to use industrial property as a pledge for the accomplishment of the obligations of Germany and for the reparation of damages in the same manner as it is proposed to retain power to deal with other German property. But it is not the intention . . . to utilise for this purpose the industrial . . . property which may arise after the coming into force of the present Treaty. Only the industrial property arising before or during the war will be subjected . . . to limitations, conditions or restrictions . . . for securing the due fulfilment of all the obligations undertaken by Germany in the present Treaty.*"

It is submitted that the powers of the Comptroller under sect. 27 of the Act of 1907 and the rights of the Crown under sect. 29 of that Act, in both cases amended after the signature of the Treaty, provide all the limitations which are considered necessary by Parliament for safeguarding the public interest or national defence of the United Kingdom.

Acquirement of patent rights.

As the right of imposing limitations for the other objects, mentioned in paragraph (*b*), is restricted to rights of industrial property "acquired before or during the war," it is important

to ascertain the exact step in consequence of which such rights are acquired. It is submitted that as far as the United Kingdom is concerned no rights are acquired until a complete specification is accepted (see sects. 10 and 91 (1) (b) of the Act of 1907), and that full rights are not acquired until the patent is granted. Until the grant there is no registrable title or interest and no legal estate, and no right of action can be enforced. That the lodging of an application is not considered as the acquirement of rights of industrial property is also made clear in the Treaty itself, for the first paragraph of Article 307 speaks of "rights which, except for the war, might have been acquired during the war as a result of an application made before the war or during its continuance." Similar phraseology is used in the first paragraph of Article 306. The considerations which apply to determining the time when "rights of industrial property" are acquired differ, it is submitted, from those considered in *Osram-Robertson Lamp Works, Ltd.* v. *Public Trustee* (37 R. P. C. p. 189). In that case by a pre-war agreement a German company undertook to communicate to an English company all their inventions in connection with the manufacture of certain types of lamps, and to transfer to them the patents obtained. Russell, J., held that the English company were the beneficial owners of a patent granted during the war to the Custodian on an application by the German company made after the outbreak of war in respect of an invention which they had communicated to the English company before the war, on the ground that the rights in the invention had been acquired before the war, and that the subsequent acquirement and assignment of patent rights was merely machinery for giving the English company the full benefit of the invention.

Divesting Order. Objects.

It will now be convenient to examine the "Divesting Order" more closely. The objects of the Order are twofold: firstly, forthwith to divest the Custodian of all interests in patents, subject to certain exceptions, which were vested in him in consequence of the war with Germany by the special and general Vesting Orders referred to in the recitals; and, secondly, to impose such of the limitations and restrictions authorised by the Treaty in the case of German nationals, or

otherwise authorised in the case of other nationals, as are considered necessary in this country.

Uncertainty as to interests affected.

The difficulty in appreciating the effect of the restrictions, which are imposed on every such interest of which the Custodian divests himself of (except where the persons entitled have ceased to be German nationals by virtue of the Treaty), is due, firstly, to the fact that the ownership of the interests vested by the General Vesting Order was defined as that of "hostile persons" who, in the main, consisted of persons who were never individually determined to be "hostile persons" much less to be "hostile persons by reason of the war with Germany" to whom alone the "Divesting Order" applies (*l*), and secondly, to the fact that the classes of interest vested, being stated in the most general and all-embracing terms possible, can in consequence not be enumerated with certainty. This uncertainty may have been admirable for the purposes of a Vesting Order which was framed to satisfy popular clamour rather than to serve any useful purpose; it is most objectionable in an Order imposing restrictions on an undefined portion of a class of property which is the subject of constant dealing between British nationals.

Hostile person. Definition.

The ownership of the rights affected by the "Divesting Order" depends on the meaning of a "hostile person," and this term includes:—

(*a*) A subject of a State for the time being at war with His Majesty, and includes a body corporate constituted according to the laws of such a State.

(*b*) A company with respect to which the Board of Trade has made an order, (A) under sect. 1 of the Trading with the Enemy Amendment Act, 1916,

(1) prohibiting the . . . company from carrying on business, except for the purposes and subject to the conditions, if any, specified in the order; or

(2) requiring the business to be wound up;

or (B) under sect. 3 of the Trading with the Enemy Amendment Act, 1918,

(*l*) A similar Order, dated 9th November, 1920 (S. R. & O., 1920, No. 2118), has now been made to deal with patents of Austrian and Bulgarian nationals vested in the Custodian.

for the realisation and distribution of the assets of the business where the company has ceased to carry on business.

(*c*) An "enemy-controlled corporation," which expression means any corporation,

(1) where the majority of the directors or the persons occupying the position of directors, by whatever name called, are subjects of an enemy State; or

(2) where it appears to the Board of Trade that the majority of the voting power or shares is in the hands of persons who are subjects of an enemy State, or who exercise their voting powers or hold the shares directly or indirectly on behalf of persons who are subjects of an enemy State; or

(3) where the control is by any means whatever in the hands of persons who are subjects of an enemy State; or

(4) where the executive is an enemy-controlled corporation or where the majority of the executive are appointed by an enemy-controlled corporation.

The fact that a patent was vested in the Custodian by the General Vesting Order is not shown on the Register, and prior to the outbreak of the war no statement of the nationality of the parties was recorded by the Patent Office. It is therefore evident that it will often be a matter of great difficulty to recognise the enemy nationality of the patentee or to decide whether a company might be deemed to have been an "enemy-controlled corporation" within the meaning of the Trading with the Enemy Amendment Act, 1918.

Suggested Covenant.

In view of the serious restrictions and limitations imposed by the "Divesting Order" and the uncertainty as to the patents which fall within its scope, any person henceforth taking any interest in any British patent the date of the grant of which is prior to the 10th January, 1920, or, assuming similar restrictions to be imposed in the case of patents restored to nationals of other enemy States (*m*), the latest date when peace with any enemy State was ratified, probably the date of the "Termination of the

(*m*) See note, p. 417.

War," will be well advised in requiring the patentee to enter into an express covenant that no "hostile person" had at any time since the 1st August, 1914, any interest, share or right whatsoever in the patent. He should also register his interest without delay, for the fact that the Comptroller had registered the transfer or other interest would be primâ facie evidence that the devolution had taken place with the consent of the Board of Trade and that an assignee, for instance, could sue for infringements.

Powers of Board of Trade.

In considering the ownership of the interests affected by the Order it must also be borne in mind that the restrictions are expressed to be imposed by the Board in exercise of the powers conferred by sect. 5 (1) of the Trading with the Enemy Amendment Act, 1914, and by the Treaty of Peace Order, 1919. This Order only empowers the imposition of restrictions on the property of German nationals, but British companies in which Germans are interested, whether enemy-controlled or not, are not included in the definition of "German nationals" in the Order. Authority for the imposition of restrictions on the property of such British companies must therefore be sought in the Trading with the Enemy Acts, the relevant provision of which, having regard to subsequent amendments, is as follows:—

"5. (1) *The Custodian shall, except so far as the Board of Trade . . . may otherwise direct . . . hold any property vested in him . . . until the termination of the present war, and shall thereafter deal with the same in such manner as His Majesty may by Order in Council direct.*"

It is submitted that these words enable the Board to order the transfer or liquidation of such vested interests but do not enable them to vary the law in respect to patents laid down by Parliament, *e.g.* clause 5 of the Order under which the Board have substituted for the Comptroller, subject to an appeal to the Court, themselves, without such appeal, as the tribunal for deciding whether a patentee has refused to grant a licence on reasonable terms or whether it is in the public interest that a compulsory licence should be granted is in our view *ultra vires* the above provision of the Trading with the Enemy Acts. If the views of the authors on the true construction of the Treaty and the "Divesting Order" are correct, the conditions

under which German nationals enjoy their restored patent rights are briefly as follows:—

Restored Patents.

Subject to any other legislation not dealing specifically with industrial property, German nationals may by themselves or their agents exercise their monopoly rights, including the right to sue for infringements which are not excepted by the provisions of Art. 306, para. 2, or Art. 309, but any sale or other transfer of a restored patent, or any licence is invalid until the consent of the Board of Trade has been obtained. This will only be given on condition that 75 per cent. of the royalties or other cash consideration is paid to the Clearing Office. As the Board evidently wish to encourage such voluntary dealings by allowing the German national to retain 25 per cent. in such cases, as against nothing when a compulsory order is made, it is presumed that voluntary dealings with Allied nationals who may be established in this country are permitted under the same conditions as dealings with British nationals, although the Order does not expressly say so. The payments to the Clearing Office can only be authorised under the provisions of the Treaty which enable the Allies to use industrial property "as a pledge for the accomplishment of the obligations of Germany and for reparation of damages," and for this purpose, as the "Allied Reply" explains, only property in existence on the 10th January, 1920, can be used.

In the opinion of the authors this means, as regards patent rights, patents which had been sealed before that date, whether in force on that date or subsequently revived, but does not include patents granted subsequent to the coming in force of the Treaty on applications in this country made before or during the war or on convention applications in this country made after the termination of the war based on applications made before or during the war in another union country. All such patents are industrial property acquired after the coming in force of the Treaty, although the patent, when sealed, is dated prior to that event, and they are therefore only subject to restrictions considered necessary for national defence or in the public interest.

It is however understood that the authorities in this country maintain that all such patents and applications are industrial

property acquired before or during the war, as the case may be, and that the "Divesting Order" was intended to, and does in fact, impose on them the restrictions authorised by the Treaty in such case.

It is also not clear that a transfer out of German ownership with the assent of the Board frees the patent henceforth from the restrictions imposed by the Order, and it is therefore not safe to assume that this is the effect of such a transfer. In any case, licences granted thereunder during the war or prior to transfer into non-German ownership would remain subject to revision by the Board under clause 6 of the Order.

Apart from the difficulties in determining the scope and application of the Order the restrictions imposed are clear and require no comment; the same applies to the Patents (Treaty of Peace) Rules, 1920, made under clause 11 of the Order, which are also set out at the end of the chapter.

Article 306 continues:— **Article 306, para. 5.**

"*In the event of the application of the provisions of the preceding paragraph by any Allied or Associated Power, there shall be paid reasonable indemnities or royalties which shall be dealt with in the same way as other sums due to German nationals are directed to be dealt with by the present Treaty.*"

Effect is given to the above in the "Divesting Order" by clause 5, which continues the power of the Board of Trade to grant licences "on such terms as to Royalty or otherwise as may be thought fit"; by clause 6, which allows the Board to alter the royalties; by clause 7, which enables the Board to expropriate, take over or sell patents on terms to be settled by a special Tribunal; and by clause 8, which provides that the royalties or other monies payable to the German national shall be paid to the Clearing Office.

Article 306 further continues:— **Article 306, para. 6.**

"*Each of the Allied or Associated Powers reserves the right to treat as void and of no effect any transfer in whole or in part of or other dealing with rights of or in respect of industrial, literary, or artistic property effected after August* 1, 1914, *or in the future, which would have the result of defeating the objects of the provisions of this article.*"

Effect is given to this provision by sect. 1 (xx.) of the Treaty of Peace Order, and by clause 3 of the "Divesting Order," which requires all dealings in regard to restored patents or restored applications, and all devolutions to be assented to by the Board of Trade.

Article 306, para. 7. The final provision of Article 306 has already been set out (*n*). Such interests as have been effectually dealt with in the liquidation of businesses or companies under the Trading with the Enemy Acts are not restored or subjected to restrictions by the Divesting Order (see clause 12).

EXTENSION OF TIME.

"Rules Acts." In view of the difficulty, and in many cases the impossibility, of inventors and patentees obtaining, maintaining, and exercising their rights, or otherwise complying with the provisions of the Act of 1907 as regards time, the "Rules Acts" empowered the Board of Trade :—

"*. . . to make rules and to do such things as they think expedient . . . for extending the time within which any act or thing may or is required to be done. . . .*"

Rules (*o*) were made under the "Rules Acts," *inter alia* Rule 3, enabling the Comptroller to extend the time subject to such conditions as he may think fit, namely:—

"(*a*) *Where it is shown to his satisfaction that the applicant, patentee or proprietor, as the case may be, was prevented from doing the said act, or filing the said document, by reason of active service or enforced absence from this country, or any other circumstances arising from the present state of war which in the opinion of the Comptroller would justify such extension;*

"(*b*) *Where the doing of any act would by reason of the circumstances arising from the present state of war be prejudicial or injurious to the rights or interests of any applicant, patentee or proprietor as aforesaid.*"

It was held in *Woodall and Duckham's Patent* (34 R. P. C. 228) that these provisions enabled the Comptroller not only to grant extensions of time in matters which ordinarily fell

(*n*) See p. 412.

(*o*) S. R. & O., 1914, No. 1255.

within his jurisdiction, but also for the presentation to the Court of a petition for extension.

The Acts and the Rules made thereunder were originally to continue in force during the continuance of the state of war in Europe, and for a period of six months thereafter, but, by the War Emergency Laws (Continuance) Act, 1920 (*p*), in so far as they relate to the extension of time within which acts or things may or are required to be done under the Act of 1907, they are continued only until the 10th January, 1921, the date on which the extension of time granted under Article 307, para. 1, to nationals of powers which ratified the Treaty with Germany also expires. This Treaty provision is as follows:—

Article 307, para. 1.

"*A minimum of one year after the coming into force of the present Treaty shall be accorded to the nationals of the High Contracting Parties, without extension fees or other penalty, in order to enable such persons to accomplish any act, fulfil any formality, pay any fees, and generally satisfy any obligation prescribed by the laws or regulations of the respective States relating to the obtaining, preserving, or opposing rights to, or in respect of, industrial property either acquired before August* 1, 1914, *or which, except for the war, might have been acquired since that date as a result of an application made before the war or during its continuance, but nothing in this article shall give any right to reopen interference proceedings in the United States of America, where a final hearing has taken place.*"

It should be noted that the benefits granted by this provision accrue to British nationals *inter alios* but not to nationals of the United States of America, until they ratify, or to neutrals. However, by adhering to the "Berne Arrangement," all Union States could give their nationals the benefit of a similar extension of time in matters relating to the obtaining and preserving (but not to the opposing) of patent rights. Further, the Treaty does not grant any extension of time for the accomplishment of acts, the time for doing which expired subsequent to the coming into force of the Treaty. Nationals of the United States and neutrals for all extensions of time, and nationals of the High Contracting parties for extensions in

(*p*) 10 Geo. 5, c. 5.

respect of acts due subsequent to 10th January, 1920, cannot make application as of right under the Treaty, but only for good cause under the "Rules Acts."

Although the only exception to this Treaty right specifically mentioned is that of reopening interference proceedings in the United States after a final hearing has taken place, it seems unlikely that an applicant who desired to oppose the grant or extension of a patent after it had been granted or extended would be heard in the United Kingdom.

Article 307, para. 2.

Article 307 continues :—

"*All rights in, or in respect of, such property, which may have lapsed by reason of any failure to accomplish any act, fulfil any formality, or make any payment, shall revive, but subject in the case of patents and designs to the imposition of such conditions as each Allied or Associated Power may deem reasonably necessary for the protection of persons who have manufactured or made use of the subject matter of such property while the rights had lapsed. Further, where rights to patents or designs belonging to German nationals are revived under this article, they shall be subject in respect of the grant of licences to the same provisions as would have been applicable to them during the war, as well as to all the provisions of the present Treaty.*"

Lapsed patents or applications, needless to say, only revive on payment of the fees, the omission to pay which have occasioned the lapse, but, in contradistinction to the provisions of sect. 20 of the Act of 1907, it is immaterial that the rights were deliberately allowed to lapse as long as the lapse occurred during the war. The terms for the protection of persons who have started to manufacture since a patent lapsed are the usual ones contained in Rule 62 of the Patents and Designs Rules, 1920, but no provision for compensation corresponding to Rule 63 is being imposed.

It should be noted that the French text speaks of "patents" and not of "rights to patents" being revived, as does also the Allied Reply on Article 307, which is as follows:—

Allied reply on Art. 307.

"8. *The German objection to the reservation by the Allied and Associated Powers of freedom to apply their war legislation to patents which may be revived under Articles* 307 *and* 308 *is based*

on an exaggerated view of the effect of this provision, which would probably affect only a small number of patents revived. All such patents would, if they had been kept up, have been subject to similar provisions during the war. The Allied and Associated Powers are prepared to limit their rights in this matter to the grant of licences, and for this purpose to insert the words 'as to the grant of licences' after the word 'provisions' in the penultimate line of the second paragraph of Article 307."

It would, therefore, appear that patents granted in respect of applications which are revived under Article 307, in contradistinction to patents which are revived, are not subject to the grant of licences by reason only that the owners are German nationals and that the provisions of clause 7 of the Divesting Order are to this extent *ultra vires* the Treaty, a conclusion already arrived at on the ground that such patents were only acquired after the coming in force of the Treaty.

The limitation, in the case of revived patents, to the grant of licences would, however, appear to be meaningless, because such revived patents are still subject "to all the provisions of the Treaty," which include the Allies right to liquidate.

SUSPENSION OF PROVISIONS FOR WORKING.

Finally, Article 307 provides that:— **Article 307. para. 8.**

"*The period from August* 1, 1914, *until the coming into force of the present Treaty shall be excluded in considering the time within which a patent should be worked or a trade mark or design used, and it is further agreed that no patent, registered trade mark, or design in force on August* 1, 1914, *shall be subject to revocation or cancellation by reason only of the failure to work such patent or use such trade mark or design for two years after the coming into force of the present Treaty.*"

In this country the Patents and Designs Act (Partial Suspension) Act, 1915 (*q*), hereinafter called the "Suspension Act," had already made provision for the suspension of the penalty which might be imposed by sect. 27 of the Act of 1907 for non-working as follows:—

(*q*) 5-6 Geo. 5, c. 85.

Partial Suspension Act, 1915.

"*The operation of section twenty-seven of the Patents and Designs Act*, 1907, *shall be suspended during the continuance of the present war, and for a period of six months thereafter, and in reckoning the period of four years mentioned in the said section the period during which that section is suspended by virtue of this Act shall not be taken into account.*"

It is therefore submitted that from 10th January, 1920, when Article 307 became law, nationals of powers which had ratified the Treaty became entitled to the benefit of both these suspensory provisions, while neutrals and nationals of the United States retained the benefit of the "Suspension Act."

On 1st April, 1920, the Board of Trade made an order (*r*) bringing into operation the amendments to sect. 27 of the Act of 1907 made by sect. 1 of the Act of 1919, that is to say, on that date the new provisions were substituted for the old.

Operation on sect. 1 of Act of 1919.

The "Suspension Act" has not been repealed, and therefore continues to operate until six months after the termination of the present war, and the question arises as to whether and to what extent the new sect. 27 is affected by its operation. One view is that the new section is not suspended at all, and in support it is said that the old section was, in effect, not amended but repealed, and that it is a matter of accident that the new section bears the same number as the old one.

Against this opinion it may be urged that the "Suspension Act" gave effect to the intention of the legislature to suspend the obligation on a patentee to work his invention and establish an industry in this country until the conditions brought about by the war had had time to alter, and that the Act of 1919 was intended to enable the Board of Trade to impose further obligations and further penalties at, or within a limited period subsequent to, such time as the requirements to establish industries would be automatically reimposed in consequence of the lapse of six months after the termination of the war.

A third view is that in passing the 1919 Act the intention of the legislature was to continue the suspension of the requirement as to working but to enable the Board of Trade to bring into operation the remedies provided for other newly defined

(*r*) S. R. & O., 1920, No. 413.

abuses of monopoly right at an earlier date, and that this limited purpose has been effected by the Order of the 1st April, 1920. This view may be supported by the fact that the abuse of monopoly right defined in sub-sect. 2 (*c*) of the new sect. 27 corresponds closely with the abuse which the old sect. 24 was intended to meet, and that this section was never suspended.

It is, however, submitted that of these three alternatives the second is the correct one, viz., that the operation of the whole new section remains suspended. The Act of 1919 is intituled "An Act to amend the Patents and Designs Acts," and sect. 21 (3) is as follows :— **Act of 1919, sect. 21.**

"*A reference in any Act of Parliament or other instrument to the principal Act shall, unless the context otherwise requires, be construed to refer to the principal Act as amended by this Act.*"

The new sect. 27 is simply an extension of the principle underlying the old sect. 27 requiring the establishment of an industry in this country, and there is nothing in the context which makes suspension inapplicable.

The combined effect of the "Suspension Act" and the Treaty with Germany on sect. 27 of the Act of 1907, as amended, would therefore appear to be the following :— **Conclusions.**

(1) A patent cannot be revoked by reason only of failure to work before the expiry of four years from the date of the grant, exclusive of the period between August 4, 1914, and six months after the termination of the present war, but in no case before 10th January, 1922 (*s*).

(2) On proof of an abuse of monopoly rights by reason only of non-working the Comptroller may order the patent to be indorsed "licences of right," or he may grant a compulsory licence, general or exclusive, six months after the termination of the present war.

(3) If the Comptroller is satisfied that the monopoly rights have been abused in the circumstances set out in sect. 27 (2) *b*, *c*, *d* or *e*, he may, six months after the

(*s*) Under the "Berne Arrangement," nationals of adhering powers, including British nationals, are protected until 30th September, 1922.

termination of the present war, exercise any of the powers given to him by sub-sect. (3) of sect. 27, including that of revocation.

The above applies to nationals of all Treaty-ratifying Powers, including German nationals, although the latter, in respect of "restored patents," are also subject to the jurisdiction of the Board of Trade, who may grant compulsory licences at any time, as provided by clause 5 of the "Divesting Order."

INTERNATIONAL CONVENTION.

Revival as between U.K. and Germany.

Article 286 of the Treaty provides that the International Convention for the Protection of Industrial Property shall again come into effect between this country and Germany as from 10th January, 1920, in so far as it is not affected or modified by the exceptions and restrictions resulting from the Treaty.

Article 308, para. 1.

Article 308 of the Treaty provides:—

"*The rights of priority, provided by Article IV. of the International Convention for the Protection of Industrial Property of Paris, of March* 20, 1883, *revised at Washington in* 1911 *or by any other Convention or Statute, for the filing or registration of applications for patents or models of utility, and for the registration of trade marks, designs, and models which had not expired on August* 1, 1914, *and those which have arisen during the war, or would have arisen but for the war, shall be extended by each of the High Contracting Parties in favour of all nationals of the other High Contracting Parties for a period of six months after the coming into force of the present Treaty.*"

Under the "Berne Arrangement" this period has been extended until 10th January, 1921, and an extension up to this date can be granted equally to nationals of non-adhering powers under the "Rules Act."

Article 308, para. 2.

Article 308 continues:—

"*Nevertheless, such extension shall in no way affect the right of any of the High Contracting Parties or of any person who before the coming into force of the present Treaty was bonâ fide in possession of any rights of industrial property conflicting with rights applied for by another who claims rights of priority in respect of them, to exercise such rights by itself or himself personally,*

or by such agents or licensees as derived their rights from it or him before the coming into force of the present Treaty; and such persons shall not be amenable to any action or other process of law in respect of infringement."

Protection of prior rights:—(a) Under Treaty.

This proviso is far from clear, but it is submitted that the persons protected include not only a patentee, the subject-matter of whose patent is identical with the invention claimed by the Convention patentee, or is an improvement which is an infringement thereof, but that they also include persons who made or used prior to 10th January, 1920 (*t*), an unpatented article or process which is within the monopoly claimed. It might also well be held that the protection extends to an invention which was in the possession of a person though not actually used; as far as Government departments in this country are concerned such protection is already afforded by the second proviso to sect. 29 of the Act of 1907, as amended.

(b) Under Rules Acts.

It may be here mentioned that when the Comptroller allows a Convention applicant, who is not a national of a Treaty-ratifying Power, an extension of time under the "Rules Acts," beyond that provided in the Convention, a proviso is inserted in the patent exempting from actions of infringement "*such persons who may have been bonâ fide in possession of the invention before the date of application in this country.*"

The limitation that the possession is to be bonâ fide would appear to require the Courts, on occasion, to go into the question of fraud committed abroad, a matter which up to the present they have refused to do in connection with the obtaining and revocation of patents.

RIGHTS OF ACTION FOR INFRINGEMENT.

Common Law.

During the war alien enemies could not sue for infringements, whether committed before or during the war (*u*).

Article 309. para. 1.

Article 309 provides that:—

"*No action shall be brought and no claim made by persons residing or carrying on business within the territories of Germany on the one part and of the Allied or Associated Powers on the other, or persons who are nationals of such Powers respectively, or*

(*t*) 30th September, 1920, under the "Berne Arrangement."

(*u*) *Porter* v. *Freudenberg*, 1915, 1 K. B. 857.

by any one deriving title during the war from such persons, by reason of any action which has taken place within the territory of the other party between the date of the declaration of war and that of the coming into force of the present Treaty, which might constitute an infringement of the rights of industrial property or rights of literary and artistic property, either existing at any time during the war or revived under the provisions of Articles 307 *and* 308."

It therefore continues to deprive all Germans or persons carrying on business in Germany at the date the Treaty came into force of the right to sue for infringements committed in the United Kingdom during the war, but this disability does not apply to Alsace-Lorrainers who ceased to be Germans pursuant to the Treaty, or to non-Germans who carried on business in Alsace-Lorraine during the war.

Suspension of periods of limitation.

As regards infringements committed before the outbreak of war the rights of action of German nationals are no longer suspended by common law, and Article 300 of the Treaty provides that:—

"(*a*) *All periods of prescription, or limitation of right of action, whether they began to run before or after the outbreak of war, shall be treated in the territories of the High Contracting Parties, so far as regards relations between enemies, as having been suspended for the duration of the war. . . .*"

And the Treaty of Peace Order, 1919, provides by sect. 1 (xviii.) that:—

"*The time at which the period of prescription or limitation of right of action referred to in Article* 300 *shall begin again to run shall be at the expiration of six months after the coming into force of the Treaty. . . .*"

The General Vesting Order of 30th October, 1918, stated specifically that the rights of action accrued since the outbreak of war were included in the rights vested in the Custodian, and, although such rights of action are not mentioned in the relevant recital of the "Divesting Order," it is submitted that they are included in what was restored, and that the German patentee can sue for infringements committed since 10th January, 1920, not excepted by Article 306, para. 2, and Article 309. By a

writ issued, for example, on 10th July, 1921, a German national could recover damages for infringements by manufacture in this country committed since 4th August, 1909, excepting those between 4th August, 1914, and 10th January, 1920, *i.e.* a period of six and a half years prior to the issue of the writ. If, however, the correct view is that the Custodian retains rights of action which arose prior to the date when patents were restored, he should be joined as plaintiff or defendant in order to recover damages arising since 10th January, 1920. An interesting problem may arise in the case where a German transfers all his rights to a British national with the consent of the Board of Trade; *e.g.* will the British national obtain the benefit of the suspension of the period of limitation and/or be able to sue for infringements committed during the war, for which the German national could not sue?

Damages.

Damages assessed after the war under a pre-war judgment in favour of a German national are covered by the words "property rights and interests belonging at the date of the coming into force of the Treaty to German nationals." They may therefore be retained by the British Government under Article 297 (*b*), and are charged by sect. 1 (xvi.) of the Treaty of Peace Order in favour of the claims of British nationals, the German nationals being left with the right of compensation from the German Government given by Article 297 (*i*) of the Treaty (*The Marie Gartz*, L. R., 1920, P. 172). It is submitted that damages awarded to a German national in an action commenced after the termination of the war in respect of pre-war infringements would be treated in a similar manner, but that damages for post-war infringements of "restored patents" are payable in full to German patentees, although under the "Divesting Order" all royalties under a licence granted by the Custodian or the Board of Trade would be payable to the Custodian or the Clearing Office.

Article 309, para. 2.

Article 309 continues:—

"*Equally, no action for infringement of industrial, literary, or artistic property rights by such persons shall at any time be permissible in respect of the sale or offering for sale for a period of one year after the signature of the present Treaty in the*

territories of the Allied or Associated Powers on the one hand, or Germany on the other, of products or articles manufactured, or of literary or artistic works published during the period between the declaration of war and the signature of the present Treaty, or against those who have acquired and continue to use them. It is understood, nevertheless, that this provision shall not apply when the possessor of the rights was domiciled or had an industrial or commercial establishment in the districts occupied by Germany during the war."

The object of this provision is to allow manufacturers and dealers a reasonable period for the disposal of infringing articles made prior to the publication of the Treaty and to protect purchasers using such articles, acquired prior to 28th June, 1920, for ever. The question arises whether a resale after that date, say, by a retailer or by a user disposing of his business, and the subsequent user by the purchaser are infringements. A hardship may arise if such resale or user is an infringement, yet the wording of the Treaty as to the limiting period is precise and the case has apparently not been provided for.

On the other hand, if the user during the war was by the British Government, their agents, or persons authorised by them, the articles may be sold and used at any time under the provisions of Article 306, para. 2.

Article 306, para. 2.

"*No claim shall be made or action brought by Germany or German nationals in respect of the use during the war by the Government of any Allied or Associated Power, or by any persons acting on behalf or with the assent of such Government, of any rights in industrial, literary or artistic property, nor in respect of the sale, offering for sale, or use of any products, articles or apparatus whatsoever to which such rights applied.*"

Article 309 para. 2.

It is understood that the proviso at the end of paragraph 2 of Article 309 was introduced to enable a manufacturer established, for instance, in the occupied district of Northern France to sue for infringements committed by the sale or user in Germany after the coming in force of the Treaty of articles made with his own stolen machinery. The exception is, however, not happily worded, and may be held to deprive persons in the United Kingdom of the rights given to them by the second

paragraph in cases where the German owner of the British patent was domiciled or had a commercial establishment in, say, Belgium unless the Court holds that the exception, which is not reciprocal, and which is obviously intended to place persons who have suffered directly at Germany's hands in a more favourable position than other persons of the same or an allied nationality, should not be construed to deprive other allied nationals of freedom from actions of infringement by German nationals which they otherwise would have enjoyed.

LICENCES.

In addition to providing for extension of time (see ante) the "Rules Acts." "Rules Acts" enable the Board of Trade :—

"... *to make rules and to do such things as they think expedient for avoiding or suspending in whole or in part any patent or licence, the person entitled to the benefit of which is the subject of any State at war with His Majesty; ... for avoiding or suspending any application made by any such person ...; for enabling the Board to grant, in favour of persons other than such persons as aforesaid, on such terms and conditions, and either for the whole term of the patent ... or for such less period, as the Board may think fit, licences to make, use, exercise, or vend, patented inventions ... so liable to avoidance or suspension as aforesaid.*"

The "Rules Acts," and the Rules (*v*) made thereunder, continue in force for the above purpose during the continuance of the present state of war in Europe (the termination of which has not yet been declared by Order in Council at the time of writing) and for a period of six months thereafter.

The Treaty of Peace Order, 1919, sect. 1, sub-sect. (xxi.), provides that the term "*subject of any State at war with His Majesty*" shall, since 10th January, 1920, be deemed to include German nationals whose patents have been revived under Article 307 of the Treaty.

Under the provisions of the "Rules Acts" a few enemy-owned patents were avoided, *i.e.* revoked, and a large number were suspended in favour of one or more persons carrying on

War licences granted : (*a*) By Board of Trade.

(*v*) S. R. & O., 1914, Nos. 1255 and 1328.

business in the United Kingdom to whom licences, which provided for the payment of royalties to the Public Trustee, were granted. The existence of British non-exclusive licensees did not prevent the Board of Trade granting other licences (*w*), and the mere assertion by statutory declaration by a British subject that he was beneficially entitled to a share in an enemy-owned patent by reason of a partnership agreement, the terms of which were not put in evidence, was held insufficient to oust the jurisdiction of the Board (*x*).

(*b*) By the Custodian.

The "Rules Acts" only applied to patents which had been sealed; but by vesting the benefit of enemy applications in the Custodian, and granting patents to him under sect. 6 of the Trading with the Enemy Amendment Act, 1916, the Custodian was able to grant licences under such patents by virtue of sect. 5 (1) of the Trading with the Enemy Amendment Act, 1914.

All licences so granted by the Board or the Custodian remain of full force and effect under the provisions of Article 310 of the Treaty, but by clauses 6 and 9 of the Divesting Order the Board has power to alter the terms of such licences.

"Allied reply."

The "Allied Reply" on Article 310 explains that since contracts for licences in respect of rights in industrial property should receive the same treatment as other pre-war contracts the same procedure should be applied to them as is applied to contracts generally in Articles 299 to 305 of the Treaty.

Article 310, para. 1.

Article 310 commences as follows:—

"*Licences in respect of industrial, literary, or artistic property concluded before the war between nationals of the Allied or Associated Powers or persons residing in their territory or carrying on business therein, on the one part, and German nationals, on the other part, shall be considered as cancelled as from the date of the declaration of war between Germany and the Allied or Associated Power.*"

During the war the continued operation of contracts involving trading with the enemy was illegal by common law, and British nationals could sue under the Legal Proceedings against Enemies

(*w*) *British Association of Glass Bottle Manufactures* v. *Foster*, 34 R. P. C. 217.

(*x*) *R.* v. *Board of Trade, ex parte Derry*, 34 R. P. C. 241.

Act, 1915 (*y*), for a declaration by the Court, or could obtain an order from the Board of Trade under sect. 2 of the Trading with the Enemy Amendment Act, 1916, putting an end to such contracts. This provision of the Treaty deals with all such licences, and it is submitted, having regard to the reference in the "Allied Reply" to the general provisions of the Treaty for the cancellation of contracts, the parties to which became enemies, that "concluded before the war" means "operative at the declaration of war," *e.g.* if the German had prior to the war bonâ fide assigned his interest to an Allied national the licence is not cancelled. Also if the German national acquired under the Treaty the nationality of an Allied or Associated Power the licence is exempted from cancellation as provided in Article 299 (*d*). On the other hand, it is submitted the licence is cancelled if one of the parties, though not a German, is acting as the agent of or for the benefit of a German national. The paragraph continues :—

Article 310, para. 1 continued.

"*But, in any case, the former beneficiary of a contract of this kind shall have the right, within a period of six months after the coming into force of the present Treaty, to demand from the proprietor of the rights the grant of a new licence, the conditions of which, in default of agreement between the parties, shall be fixed by the duly qualified tribunal in the country under whose legislation the rights have been acquired, except in the case of licences held in respect of rights acquired under German law. In such cases the conditions shall be fixed by the Mixed Arbitral Tribunal referred to in Section VI. of this Part. The tribunal may, if necessary, fix also the amount which it may deem just should be paid by reason of the use of the rights during the war.*"

The Treaty of Peace Order, sect. 1 (xxii.), appointed the Comptroller as the duly qualified tribunal for granting new licences in this country to former beneficiaries, and if they have not applied within the six months provided they can, in the case of "restored patents," apply to the Board of Trade under clause 5 of the "Divesting Order."

Paragraph 2 is as follows :—

Article 310, para. 2.

"*No licence in respect of industrial, literary, or artistic property,*

(*y*) 5 Geo. 5, c. 36.

granted under the special war legislation of any Allied or Associated Power, shall be affected by the continued existence of any licence entered into before the war, but shall remain valid and of full effect, and a licence so granted to the former beneficiary of a licence entered into before the war shall be considered as substituted for such licence."

The terms of the licences granted by the Board of Trade or the Custodian may, however, by clauses 6 and 9 of the "Divesting Order," be modified by the Board on the application of the licensee or the patentee, and clause 4 of that Order adds a further provision to all such licences, viz. the licensee is to be deemed to have the right of calling upon the patentee to take proceedings for infringement, and, on the latter's refusal or failure for two months so to do, the licensee may institute proceedings in his own name as if he were *the* patentee, as provided in sect. 27 (3) (b) of the Act of 1907, as amended. It may therefore be argued that a licensee in these circumstances will have the benefit of the suspension of the statute of limitations during the period of the war and six months after which the patentee has by virtue of Article 300 (*a*) and the Treaty of Peace Order, and that he can sue persons still infringing for infringements committed in pre-war times.

Article 310, para. 8.

Finally, Article 310 provides :—

"*Where sums have been paid during the war by virtue of a licence or agreement concluded before the war in respect of rights of industrial property or for the reproduction or the representation of literary, dramatic, or artistic works, these sums shall be dealt with in the same manner as other debts or credits of German nationals as provided by the present Treaty.*"

It is understood that this provision was introduced to cover royalties paid to an international agency in respect of dramatic or musical copyright. It would not appear to have any practical application in this country in so far as royalties under patents are concerned.

DEFENCE OF THE REALM ACT, 1914.

INDEMNITY ACT, 1920.

The effect of these Acts in regard to patents and inventions have been dealt with, ante, in the chapter dealing with the "Rights of the Crown."

DECISIONS IN THE COURTS.

During the war an alien enemy could not institute or maintain an action in the Courts as actor (*z*). The same rule applied to an alien enemy company and a British company as joint co-plaintiffs (*a*), unless the alien was merely a formal party (*b*). An alien enemy could, however, defend an action, or appeal against a decision in a case in which he had been attacked (*c*), and as a defence to a petition for revocation he could apply to the Court for leave to amend his specification by disclaimer (*d*).

(*z*) *Porter* v. *Freudenberg*, 1915, 1 K. B. 857.

(*a*) *Actiengesellschaft für Anilin Fabrikation* v. *Levinstein*, 32 R. P. C. 140.

(*b*) *Mercedes Daimler Motor Co.* v. *Maudsley Motor Co.*, 32 R. P. C., p. 149.

(*c*) *Mertens' Patent*, 32 R. P. C. 109.

(*d*) *Patent of Stahlwerk Becker Actiengesellschaft*, 34 R. P. C. 339.

THE "GENERAL VESTING ORDER" OF THE 30TH OCTOBER, 1918.

In the matter of the Trading with the Enemy Amendment Acts, 1916 *and* 1918,

and

In the matter of—

(1) Every person, firm, body and company being an Enemy or Enemy Subject within the meaning of the above-mentioned Acts.

(2) Every Company with respect to which an Order has been made under section one of the Trading with the Enemy Amendment Act, 1916, or section three of the Trading with the Enemy Amendment Act, 1918.

(3) Every Company being an Enemy Controlled Corporation within the meaning of the Trading with the Enemy Amendment Act, 1918,

and

Entitled (a) to any interest, share or right in of or to any Letters Patent which have been granted in and for the United Kingdom of Great Britain and Ireland and the Isle of Man or

(b) to the benefit of an application for any such Letters Patent.

Whereas the expression "hostile person" (*a*) when hereinafter used means and includes—

(a) a person, firm, body or company being an enemy or enemy subject within the meaning of the Trading with the Enemy Amendment Acts, 1916 and 1918:

(b) a company with respect to which an Order has been made under section one of the Trading with the Enemy Amendment Act, 1916, or section three of the Trading with the Enemy Anendment Act, 1918:

(c) a company being an enemy controlled corporation within the meaning of the Trading with the Enemy Amendment Act, 1918:

And whereas the expression "British Patent" when hereinafter used means Letters Patent which have been granted in and for the United Kingdom of Great Britain and Ireland and the Isle of Man:

And whereas divers hostile persons are respectively (1) the owners of or otherwise interested in various British Patents (2) entitled to the benefit of applications for British Patents:

And whereas it appears to the Board of Trade to be expedient that such Vesting Order should be made as hereinafter appears:

(*a*) See also p. 417.

Now therefore the Board of Trade in exercise of the powers conferred on them by the Trading with the Enemy Amendment Acts, 1916 and 1918, and of all other powers enabling them in this behalf do hereby Order that—

(1) All and every the interest, share and right of every hostile person in, of or to any British Patent including all rights of action which since the 4th day of August, 1914, have or would but for the present War have accrued to any hostile person in respect or by reason of any British Patent, and

(2) The benefit of every application which has been made by or on behalf or for the benefit of any hostile person for any British Patent Do except in so far as the same shall already have been vested by any Order made under the Trading with the Enemy Amendment Acts or any of them Vest in the Public Trustee of Kingsway in the County of London the Custodian for England and Wales under the Trading with the Enemy Amendment Act, 1914.

Provided always that notwithstanding this order or anything herein contained any Order or Licence which the Board of Trade shall in pursuance or by virture of the powers or provisions conferred by or contained in the Patents Designs and Trade Marks (Temporary Rules) Acts, 1914, have made or granted in respect of any British Patent, and all rights, powers, conditions and stipulations by or in such Order or Licence granted, reserved or contained shall operate and take effect and shall be exercisable, enforceable, performed and observed as fully and freely and to the same extent as if this present Order had not been made.

Dated this 30th day of October, 1918.

By The Board of Trade

(Sd.) *H. Fountain,*

Assistant Secretary to the Board of Trade.

THE "DIVESTING ORDER."

STATUTORY RULES AND ORDERS, 1920, No. 1336.

TRADING WITH THE ENEMY.

PATENTS OF GERMAN NATIONALS VESTED IN CUSTODIAN (*a*).

ORDER OF THE BOARD OF TRADE, DATED JULY 19, 1920, UNDER SECTION 5 (1) OF THE TRADING WITH THE ENEMY AMENDMENT ACT, 1914 (5 GEO. 5, c. 12), AS TO "VESTED PATENTS," "VESTED APPLICATIONS" AND "RESTORED PATENTS."

In the matter of divers patents and applications for patents vested in the Custodian; and
In the matter of the Trading with the Enemy Acts, 1914 to 1918; and
In the matter of the Treaty of Peace (with Germany) Act, 1919; and
In the matter of the Treaty of Peace (with Germany) Order, 1919 (*b*).

Whereas the expression "British Patent" when hereinafter used means Letters Patent which have been granted in and for the United Kingdom of Great Britain and Ireland and the Isle of Man:

And whereas prior to the Order of the Board of Trade of the 30th October, 1918, hereinafter recited, divers British Patents which had been granted to or for the benefit of German Nationals (as defined by the Treaty of Peace (with Germany) Order, 1919), the shares and interests of German Nationals in divers other British Patents and also the benefit so far as the same belonged to German Nationals of or in divers applications which had been made by or on behalf or for the benefit of German Nationals, either alone or jointly with other parties, for grants of such patents were by or by virtue of Orders which were made by the High Court of Justice or the Board of Trade under the Trading with the Enemy Acts, 1914–1918, or some or one of such Acts duly vested in the Public Trustee, the Custodian for England and Wales under the Trading with the Enemy Amendment Act, 1914 (hereinafter called "the Custodian"):

And whereas by an Order dated the 30th October, 1918, and so made by the Board of Trade as aforesaid, after reciting that the expression "hostile person" when thereinafter used meant and included (a) a person, firm, body or company being an enemy or enemy subject within the meaning of the Trading with the

(*a*) The corresponding Divesting Order, dated November 9th, 1920, for Patents of Austrian and Bulgarian Nationals is S. R. & O., 1920, No. 2118.

(*b*) S. R. & O., 1919, No, 1517.

Enemy Amendment Acts, 1916 and 1918 (*c*), (b) a Company with respect to which an Order had been made under section 1 of the Trading with the Enemy Amendment Act, 1916, or section 3 of the Trading with the Enemy Amendment Act, 1918, and (c) a Company being an enemy controlled corporation within the meaning of the Trading with the Enemy Amendment Act, 1918, it was amongst other things ordered that (1) all and every the interest, share and right of every hostile person in, of or to any British patent, and (2) the benefit of every application which had been made by or on behalf or for the benefit of any hostile person for any British patent should, except in so far as the same should already have been vested by any Order made under the Trading with the Enemy Amendment Acts, or any of them, vest in the Custodian :

And whereas as regards certain of the said applications patents have in pursuance of the Trading with the Enemy Amendment Act, 1916, been duly granted to the Custodian :

And whereas the expression "vested patent" as hereinafter used means such interest, share, rights or title in, of or to a British patent as may by reason or on account of the late war between the United Kingdom and Germany have been so vested in or granted to the Custodian as aforesaid, and the expression "vested application" as hereinafter used means such benefit and rights of or in respect of any application for the grant of a British patent as may by reason or on account of the said late war have been so vested in the Custodian as aforesaid :

And whereas it is expedient that such Order or Orders and directions as are hereinafter contained shall be made and given in regard to vested patents and vested applications :

Now, therefore, the Board of Trade in exercise of the powers conferred upon them by section 5 (1) of the Trading with the Enemy Amendment Act, 1914, and/or the Treaty of Peace (with Germany) Order, 1919, and of all other powers (if any) them hereunto enabling do hereby order and direct as follows :—

1. (i) Subject to the provisions hereinafter contained the Custodian shall forthwith divest himself of the vested patents and of the vested applications in favour as the case may be of the respective persons who were at the commencement of the late war between the United Kingdom and Germany or would but for such war and the relative Vesting Orders now be entitled thereto.

Provided always that if by any Order made under the Trading with the Enemy Amendment Acts, or any of them which may affect any vested patent or vested application any condition was imposed upon the Custodian which might operate so as to prohibit him from dealing with such patent or application, the prohibiting condition shall be and stand discharged upon the Board of Trade certifying to that effect, but so nevertheless that such divesting as aforesaid shall not take effect as regards such patent or application unless and until the Board of Trade shall so certify :

(ii) In the subsequent provisions of this Order the following expressions shall mean and be construed as follows, that is to say :

(*c*) 5–6 Geo. 5, c. 105, and 8–9 Geo. 5, c. 31.

"restored patent" shall mean and include any vested patent of which the Custodian shall have divested himself under the directions in the preceding sub-clause contained and also such interest, share, rights or title in, of or to any British patent as may be or may have been granted upon or in pursuance or by virtue of a restored application: "restored application" shall mean and include any vested application of which the Custodian shall have divested himself as aforesaid and also to the extent to which the same may be or may have been revived as next hereinafter mentioned any application for the grant of a British patent which may be or may have been revived under the provisions of the Treaty of Peace between the United Kingdom and Germany (hereinafter referred to as the "Treaty of Peace"): "patentee" shall mean and include the person for the time being entitled to the benefit of a restored patent: "licensee" shall in relation to a licence mean and include any person for the time being entitled to the benefit of the licence.

2. Subject to the provisions of this Order dealings in regard to a restored patent are permitted between British Nationals and German Nationals (as respectively defined by the said Treaty of Peace Order).

3. An assignment or assurance *inter vivos* of a restored patent or a restored application shall not be made nor shall any licence be granted under a restored patent except after notice to and with the consent of the Board of Trade, and any such purporting (*d*) licence which may be made or granted except after such notice and with such consent shall be void and of no effect. And any devolution of a restored patent or of a restored application otherwise than by an assignment or assurance *inter vivos* shall not be operative unless and until assented to by the Board of Trade.

4. A restored patent shall remain and be subject to any licence under or in respect thereof which may have been granted by the Board of Trade under the Patents, Designs and Trade Marks (Temporary Rules) Acts, 1914 (*e*), or by the Custodian under section 5 (1) of the Trading with the Enemy Amendment Act, 1914, and any such licence shall with the additional rights, powers and privileges next hereafter conferred upon the Licensee, be and remain as valid and effectual as if this Order had not been made:

Provided always that in addition to any other rights, privileges or powers to which he may be entitled the Licensee, exclusive or otherwise as the case may be, shall be deemed to have and shall have all the rights, privileges and powers of such a Licensee under the provisions of section 1 of the Patents and Designs Act, 1919 (*f*):

Provided further that all powers which by or under any such licence as aforesaid may have been given to or vested in the Board of Trade or the Custodian shall as regards any powers given to or

(*d*) S. R. & O., 1920, No. 2118 (Austrian and Bulgarian Order), inserts the following words here:—"Assignment or assurance *inter vivos* or any such purporting," and it is assumed they were intended to be included in the German Order.

(*e*) 4–5 Geo. 5, cc. 27 and 73.

(*f*) 9–10 Geo. 5, c. 80.

vested in the Custodian be and be deemed to have been transferred to the Board of Trade and as to all such powers whether given to or vested in the Board of Trade or given to or vested in the Custodian shall be and remain exercisable by the Board of Trade.

5. The Board of Trade have and shall continue to have power upon the application of any person to grant to or in favour of the applicant a compulsory licence under any restored patent upon such terms as to Royalty or otherwise as may be thought fit (*a*) if in the opinion of the Board of Trade it is in the public interest that such licence shall be granted, or (*b*) if the Patentee shall refuse to grant to the applicant a licence upon reasonable terms. And for the purpose of and in connection with the exercise of such power the Board of Trade shall have all the powers of the Comptroller of Patents, Trade Marks and Designs (hereinafter called the Comptroller) under the Patents and Designs Act, 1919, in a case in which abuse of the monopoly rights has been established.

6. The Board of Trade shall as regards any licence which has been or may be granted under any restored patent, whether the licence is granted as mentioned in Clause 4 hereof or as mentioned in Clause 5 hereof, have power upon the application of the Licensee or of the Patentee to make such revisions or amendments in the licence as may be thought fit whether as regards the Royalty payable thereunder or otherwise, and any such revision or amendment may consist of or include a provision which will preclude the Patentee (*a*) from importing into the United Kingdom any goods the importation of which would if effected by a person other than the Patentee be an infringement of the patent, and/or (*b*) from working or using the patented invention in the United Kingdom.

7. Notwithstanding anything herein contained the Board of Trade shall as regards any restored patent or restored application have power either without or upon the application of any person interested to expropriate, take over or sell any such patents or the patent rights under any such application on such terms as to indemnity, purchase, consideration or otherwise as may be determined by a special Tribunal to be nominated by the Lord Chancellor for the time being but so that the President or Chairman of such Tribunal shall be a high judicial officer or a barrister of not less than ten years' standing, and in such case the Board of Trade shall be deemed to have all the powers of the patentee or proprietor and may make a good title to any transfer, licence or other assurance provided always that the power hereby conferred shall not be exercised unless in the opinion of the Board of Trade the exercise thereof is necessary for the National Defence or in the public interest or for securing the due fulfilment of all the obligations undertaken by Germany in the Treaty of Peace.

8. All Royalties and/or other monies which but for this provision would by virtue of anything done under or in pursuance of any provision contained in this Order be payable to a German National shall be divided and paid as follows, namely :—

(*a*) in the case of voluntary dealings—75 per cent. of such Royalties and/or other monies shall be paid to the

Controller of the Clearing Office for the purposes of such Office and the remaining 25 per cent. thereof shall be paid to the other party or parties who may be concerned :

(*b*) in every other case the whole of such Royalties and/or other monies shall be paid to the Controller of the Clearing Office for the purposes of such Office.

Provided always that any Royalties under any such licence as is mentioned in Clause 4 hereof which have accrued prior to the date upon which the patent shall have become a restored patent or which may thereafter accrue shall be retained by or paid to the Custodian as the case may be.

9. The conditions imposed by and other provisions contained in Clauses 3 to 8 of this Order upon or in regard to restored patents and restored applications shall not, except as hereafter mentioned, apply as regards vested patents or vested applications of which the Custodian shall have divested himself under the directions contained in Clause 1 (1) herein in favour of persons who, by or by virtue or in pursuance of the Treaty of Peace, have ceased to be German Nationals : Provided nevertheless that as regards such patents as last mentioned—

(i) The patents shall remain and be subject to any licence under or in respect thereof which may have been granted by the Board of Trade under the Patents, Designs and Trade Marks (Temporary Rules) Acts, 1914, or by the Custodian under section 5 (1) of the Trading with the Enemy Amendment Act, 1914, and any such licence shall be and remain as valid and effectual as if this Order had not been made.

(ii) The Board of Trade shall as regards any licence which has been granted as aforesaid under the patent have power upon the application of the licensee or of the patentee to make such revisions or amendments in the licence as may be thought fit whether as regards the royalty payable thereunder or otherwise.

10. Any application to be made under any provision herein contained shall be made to the Comptroller.

11. The Board of Trade may from time to time make such rules as may be necessary or expedient for the purpose of carrying out the provisions of this Order and by any such rules may regulate the procedure to be followed and may prescribe the payment of fees and fix the amount thereof and any such rules whilst in force shall be of the same effect as if the same were contained in this Order.

12. This Order shall not nor shall anything herein contained apply to any patent or application for the grant of a patent which has been effectually dealt with in or for the purpose of the liquidation of any business or company as regards which a Winding-up Order has been made under or in pursuance of the Trading with the Enemy Acts, 1914 to 1918, or any of them.

13. The Board of Trade may at any time revoke or vary this

Order and any provisions herein contained as well as any rules made under Clause 11 hereof.

Dated this 19th day of July, 1920.

R. S. Horne,
President of the Board of Trade.

THE PATENTS (TREATY OF PEACE) RULES, 1920 (*g*).

DATED 24TH JULY, 1920.

By virtue of the provisions of the Trading with the Enemy Acts, 1914 to 1918, the Treaty of Peace Act, 1919, the Treaty of Peace Order, 1919, and the Order of the Board of Trade, dated 19th July, 1920, the Board of Trade do hereby make the following Rules:—

Preliminary.

1. These Rules may be cited as the Patents (Treaty of Peace) Rules, 1920, and shall come into operation from and immediately after the 19th day of July, 1920.

Interpretation.

2. In the construction of these Rules any words herein used, the meanings of which are defined by the Order of the Board of Trade, dated the 19th day of July, 1920, shall have the meanings thereby assigned to them respectively.

Fees.

3. The fees to be paid under these Rules shall be those specified in the first Schedule to these Rules.

Forms.

4. The forms herein referred to are the forms contained in the second Schedule to these Rules. Such forms shall be used in all cases to which they are applicable and may be modified as directed by the Comptroller to meet other cases.

Voluntary Dealings in or under Restored Patents, &c.

5. Where any assignment or assurance of a restored patent or of the benefit of a restored application or any licence under a restored patent has been agreed between parties, application for the consent of the Board of Trade to any such assignment, assurance, or licence shall be made on Patents Form No. 40 before the execution of the document effecting such assignment, assurance or licence. Such application shall be accompanied by a copy of the draft document proposed to be executed.

(*g*) These Rules apply to Austrian and Bulgarian restored patents as from November 29th, 1920.

Devolution of Title by Operation of Law.

6. Where any person claims to be entitled to the benefit of or any interest in a restored patent or restored application by virtue of operation of law, arising after the outbreak of war, he shall make application for the consent of the Board of Trade to his title as claimed being recognised upon Patents Form No. 41. Such application shall be accompanied by a copy of the instrument or other document under which the applicant claims title.

Application for Licence under Restored Patent other than under Rule 5.

7. An application for the grant of a licence under a restored patent or a patent granted upon a restored application shall be made upon Patents Form No. 42. Such application shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the reason for making the application, the facts upon which the applicant bases his case, and the terms of the licence which he is prepared to accept. A copy of the application and of the statement will be transmitted by the Comptroller to the patentee at his address for service on the Register of Patents.

Upon such application being made and copy thereof transmitted to the patentee, the latter, if desirous of contesting the application, shall within one month of the receipt of such copy at his address for service, or such further time as the Comptroller may allow, leave at the Patent Office a counter-statement fully setting out the grounds upon which the application is contested and, on so leaving, shall deliver to the applicant a copy thereof.

Upon receipt of such counter-statement, and/or any further evidence the Comptroller may require, the Comptroller shall proceed to determine the application.

Application for Revision of Licence.

8. An application for the revision of a licence, whether granted by the Board of Trade, the Custodian, or under these Rules under a restored patent, shall be made upon Patents Form No. 43. Such application shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the facts upon which the applicant bases his case and the terms of such licence as he is prepared to accept or grant. A copy of the application and of the statement will be transmitted by the Comptroller to the patentee, at his address for service on the Register of Patents or the Licensee concerned, as the case may be.

Upon such application being made and copy thereof transmitted, the patentee or licensee, as the case may be, if desirous of contesting the application, shall within one month of the receipt of such copy at his address for service, or such further time as the Comptroller may allow, leave at the Patent Office a counter-statement fully setting out the grounds upon which the application is contested and, on so leaving, shall deliver to the applicant a copy thereof.

Upon receipt of such counter-statement and/or any further

evidence the Comptroller may require, the Comptroller shall proceed to determine the application.

Application for the Expropriation Taking Over or Selling Any Restored Patent.

9. An application for the expropriation, taking over or sale of any restored patent or a patent granted upon a restored application shall be made upon Patents Form No. 44. Such application shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the reason for making the application and the facts upon which the Applicant bases his case. A copy of the application and of the statement will be transmitted by the Comptroller to the patentee at his address for service on the Register of Patents.

Upon such application being made and copy thereof transmitted to the patentee, the latter, if desirous of contesting the application, shall, within one month of the receipt of such copy at his address for service, or such further time as the Comptroller may allow, leave at the Patent Office a counter-statement fully setting out the grounds upon which application is contested and on so leaving, shall deliver to the applicant a copy thereof.

Upon receipt of such counter-statement and/or any further evidence the Comptroller may require the Comptroller shall proceed to determine whether the application should be granted and be referred to a special tribunal for the settlement of terms.

Where it is decided to grant the application and refer it to a special tribunal for the settlement of terms application to be heard by the special tribunal shall be made upon Patents Form No. 45.

Hearings.

10. Before deciding any issue raised under Rules 7, 8 and 9 of these Rules, or before exercising any discretionary power given to the Comptroller under the Order of the Board of Trade, dated 19th July, 1920, or these Rules, adversely to any party, the Comptroller shall give ten days' notice, or such longer notice as he may think fit, to the party or parties as the case may be, of the time when he is prepared to hear such party or parties or their representatives.

Evidence.

11. In lieu of or in addition to any oral evidence that may be given at a hearing the Comptroller may require any party to file evidence by way of statutory declaration, and allow any declarant to be cross-examined on his declaration.

Costs.

12. The Comptroller may award costs in any proceedings under these Rules, and direct how and by what parties they are to be paid. Further, in any case in which he thinks fit, the Comptroller may

require any person initiating proceedings to give security for costs, and in the event of such security not being forthcoming, may dismiss the application in question.

Dated this 24th day of July, 1920.

R. S. Horne.
President of the Board of Trade.

FIRST SCHEDULE.

Fees.

Subject or Proceeding.	Amount.	Corresponding Form.
	£ s. d.	
On application under Rule 5 for consent of Board of Trade to assignment, assurance or licence of patent rights .	2 0 0	Patents Form No. 40.
On application under Rule 6 for consent of Board of Trade to devolution of title to Patent rights by operation of Law .	2 0 0	Patents Form No. 41.
On application for licence under restored Patent	2 0 0	Patents Form No. 42.
On application for revision of Licence .	5 0 0	Patents Form No. 43.
On application for expropriation, taking over, or selling any restored patent rights	5 0 0	Patents Form No. 44.
On application for hearing by Tribunal in respect of the expropriation, taking over, or selling of restored patent rights	5 0 0	Patents Form No. 45.

Dated this 24th day of July, 1920.

R. S. Horne.
President of the Board of Trade.

SECOND SCHEDULE.

Here follows a Schedule of forms mentioned in the Order.

APPENDIX.

STATUTES.

SECTIONS 6 AND 7 OF THE STATUTE OF MONOPOLIES (1623).

[21 JAC. I. c. 3.]

An Act concerning Monopolies and Dispensations of Penal Laws and the Forfeitures thereof.

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 patent or grants or 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. **What new patents to be good.**

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. **Proviso.**

PATENTS AND DESIGNS ACT, 1907.

[7 EDW. VII. c. 29.]

AS AMENDED BY

THE PATENTS AND DESIGNS ACT, 1919.

[9 & 10 GEO. 5, CH. 80.]

ARRANGEMENT OF SECTIONS.

PART. I.—PATENTS.

Application for and Grant of Patent.

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2. Specifications.
3. Proceedings upon application.
4. Provisional protection.
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7. Investigation of previous specifications in United Kingdom on applications for patents.
8. Investigation of specifications published subsequently to application.
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12. Grant and sealing of patent.
13. Date of patent.
14. Effect, extent, and form of patent.
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Term of Patent.

17. Term of patent.
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21. Amendment of specification by Comptroller.
22. Amendment of specification by the Court.

SECT.

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Compulsory Licences and Revocation.

24. Provisions as to patents indorsed "licenses of right."
25. Revocation of patent.
26. Power of Comptroller to revoke patents on certain grounds.
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27A. Enforcement of order for grant of licence.

Register of Patents.

28. Register of patents.

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65. Fees.

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67. Inspection of and extracts from registers.
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98. Repeal and savings.
99. Short title and commencement.
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An Act to consolidate the enactments relating to Patents for Inventions and the registration of Designs and certain enactments relating to Trade Marks.

[28th August, 1907.]

[*Amending Act*, 23*rd December*, 1919.]

BE it enacted by the King's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :—

[N.B.—Parts repealed by the Act of 1919 are printed in italic type. Amendments are printed (or indicated by notes) in black type.]

PART I.—PATENTS.

Application for and Grant of Patent.

Application.

1.—(1) An application for a patent may be made by any person who claims to be the true and first inventor of an invention, whether he is a British subject or not, and whether alone or jointly with any other person. (*See p. 11.*)

(2) The application must be made in the prescribed form, and must be left at, or sent by post to, the Patent Office in the prescribed manner. (*See p. 153.*)

(3) The application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application one at least of the applicants, claims to be the true and first inventor, and for which he desires to obtain a patent, and must be accompanied by either a provisional or complete specification. (*See pp. 85, 156.*)

(4) The declaration required by this section may be either a statutory declaration or not, as may be prescribed. (*See p. 156.*)

Specifications.

2.—(1) A provisional specification must describe the nature of the invention. (*See p. 85.*)

(2) A complete specification must particularly describe and ascertain the nature of the invention and the manner in which the same is to be performed. (*See p. 85.*)

(3) In the case of any provisional or complete specification, where the Comptroller deems it desirable he may require that suitable drawings shall be supplied with the specification, or at any time before the acceptance of the same, and such drawings shall be deemed to form part of the said specification. (*See pp. 92, 116.*)

(4) A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed. *(See pp. 92, 95.)*

(5) Where the invention in respect of which an application is made is a chemical invention, such typical samples and specimens as may be prescribed shall, if in any particular case the Comptroller considers it desirable so to require, be furnished before the acceptance of the complete specification. *(See pp. 92, 160.)*

Proceedings upon application.

3.—(1) The Comptroller-General of Patents, Designs, and Trade Marks (hereinafter referred to as the Comptroller) shall refer every application to an examiner. *(See p. 157.)*

(2) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the Comptroller may refuse to accept the application or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the Comptroller so directs, bear date as from the time when the requirement is complied with. *(See p. 161.)*

(3) Where the Comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer, who shall, if required, hear the applicant and the Comptroller, and may make an order determining whether and subject to what conditions (if any) the application shall be accepted. *(See p. 163.)*

(4) The Comptroller shall, when an application has been accepted, give notice thereof to the applicant. *(See p. 163.)*

Provisional protection.

4. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the invention; and such protection from the consequences of use and publication is in this Act referred to as provisional protection. *(See pp. 25, 74, 169.)*

Time for leaving complete specification.

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

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

of time to the extent applied for, but not exceeding one month.

(2) Unless a complete specification is so left the application shall be deemed to be abandoned. (*See p. 159.*)

Comparison of provisional and complete specification.

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

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

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

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

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

Provided that where the complete specification includes an invention not included in the provisional specification, the Comptroller may allow the original application to proceed so far as the invention included both in the provisional and in the complete specification is concerned, and (*treat the claim*) allow an **application** for the additional invention included in the complete specification **to be made and treated** as an application for that invention made on the date at which the complete specification was left. (*See p. 163.*)

(4) (*A refusal of the Comptroller to accept a complete specification shall be subject to appeal*) **An appeal shall lie from the decision of the Comptroller under this section** to the law officer, who shall, if required, hear the applicant and the Comptroller, and may make an order determining whether and subject to what conditions (if any) the complete specification shall be accepted.

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

Provided that where an application is made for an extension of time for the acceptance of a complete specification, the Comptroller shall, on payment of the prescribed fee, grant an extension of

time to the extent applied for, but not exceeding three months.
(Amended by Act of 1919.) (*See p. 160.*)

Investigation of previous specifications in United Kingdom on applications for patents.

7.—(1) Where an application for a patent has been made and a complete specification has been left, the examiner shall, in addition to the other inquiries which he is directed to make by this Act, make a further investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed or described in any specification (other than a provisional specification not followed by a complete specification) published before the date of the application, and left pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application. (*See p. 72.*)

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

(3) If the Comptroller is satisfied that no objection exists to the specification on the ground that the invention claimed thereby has been wholly or in part claimed or described in a previous specification as before mentioned, he shall, in the absence of any other lawful ground of objection, accept the specification.

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

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

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

((6) *The investigations and reports required by this section shall not be held in any way to guarantee the validity of any patent, and no liability shall be incurred by the Board of Trade or any officer thereof by reason of, or in connection with, any such investigation or report, or any proceeding consequent thereon.*) (*See p. 164.*)

Investigation of specifications published subse-

8.—((1) *An investigation under the last preceding section shall extend to specifications published after the date of the application in respect of which the investigation is made, and being specifications which have been*

quently to application. *deposited pursuant to prior applications; and that section shall, subject to rules under this Act, have effect accordingly.*)

(1) In addition to the investigation under the last preceding section, the examiner shall make an investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed in any specification published on or after the date of the application and deposited pursuant to a prior application. **(Substituted by Act of 1919.)**

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

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

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

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

(5) The investigations and reports required by this and the last preceding section shall not be held in any way to guarantee the validity of any patent, and no liability shall be incurred by the Board of Trade or any officer thereof by reason of or in connection with any such investigation or report or any proceedings consequent thereon. **(Sub-sects. 4 and 5 introduced by Act of 1919.)** (*See p. 165.*)

Advertisement on acceptance of complete specification.

9. On the acceptance of the complete specification the Comptroller shall advertise the acceptance; and the application and specifications, with the drawings (if any), shall be open to public inspection. (*See p. 167.*)

Effect of

10. After the acceptance of a complete specification and until

the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification. Provided that an applicant shall not be entitled to institute any proceeding for infringement until a patent for the invention has been granted to him. (*See p. 169.*)

acceptance of complete specification.

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 any of the following grounds:—

Opposition to grant of patent.

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

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

(By sect. 4 of the Act of 1919 the following paragraphs (b) and (bb) were substituted.)

Amendment of sect. 11 of principal Act as to opposition to grant of patent.

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

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

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

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

interval between the leaving of the provisional specification and the leaving of the complete specification,

or (*e*) that in the case of an application under section ninety-one of this Act the specification describes or claims an invention other than that for which protection has been applied for in a foreign state or British possession and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the application in the foreign state or British possession and the leaving of the application in the United Kingdom. (**Paragraph (e) added by sect. 4 of the Act of 1919.**)

but on no other ground.

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

(3) The decision of the Comptroller shall be subject to appeal to the law officer, who shall, if required, hear the applicant and the opponent, if the opponent is, in his opinion, a person entitled to be heard in opposition to the grant of the patent, and shall decide the case; and the law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer with the consent of the Treasury may determine. (*See p. 173.*)

Grant and sealing of patent.

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

Amendment of sect. 12 of principal Act as to grant and sealing of patents.

Provided that where—

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

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

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

decision of the Comptroller under this proviso to the law officer. **(Proviso added by sect. 5 of the Act of 1919.)** (*See p. 155.*)

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

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

(*b*) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer **or the Comptroller as the case may be** may direct:

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

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

Date of patent.

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

Effect, extent, and form of patent.

14.—(1) A patent sealed with the seal of the Patent Office shall have the same effect as if it were sealed with the Great Seal of the United Kingdom, and shall have effect throughout the United Kingdom and the Isle of Man. (*See pp. 5, 378.*)

Provided that a patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only. (*See p. 320.*)

(2) Every patent may be in the prescribed form and shall be

granted for one invention only, but the specification may contain more than one claim; and it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention. (*See pp. 5, 320.*)

Fraudulent applications for patents.

15.—(1) A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection. (*See p. 67.*)

(2) Where a patent has been revoked (*on the ground of fraud*) **by the Court on the ground that it has been obtained in fraud of the true and first inventor or where the grant has been refused by the Comptroller under the provisions of paragraph (*a*) of sub-sect. (1) of sect. 11 of this Act or revoked on the same ground under the provisions of sect. 26 of this Act,** the Comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent **for the whole or any part of the invention** in lieu of and bearing the same date as the patent so revoked **or as would have been borne by the patent if the grant thereof had not been refused.**

Provided that no action shall be brought for any infringement of the patent so granted committed before the actual date when such patent was granted. (*See pp. 24, 181.*)

Single patent for cognate inventions.

16.—(1) Where the same applicant has put in two or more provisional specifications for inventions which are cognate or modifications one of the other, and has obtained thereby concurrent provisional protection for the same, and the Comptroller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may accept one complete specification in respect of the whole of such applications and grant a single patent thereon. (*See p. 158.*)

(2) Such patent shall bear the date of the earliest of such applications, but in considering the validity of the same **and in determining other questions under this Act** (*and for the purpose of the provisions of this Act with respect to oppositions to the grant of patents*), the Court or the Comptroller, as the case may be, shall have regard to the respective dates of the provisional specifications relating to the several matters claimed therein. (*See p. 158.*)

Term of Patent.

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

By sect. 6 of the Act of 1919 it was enacted—

"(1) The term limiting the duration of patents shall be increased from fourteen to sixteen years, and accordingly in sub-sect. (1) of sect. 17 of the principal Act, for the word 'fourteen' there shall be substituted the word 'sixteen.'

"(2) Any patent the original term of which had not expired at the date of the commencement of this Act shall have effect as if the term mentioned therein was sixteen years instead of fourteen years, subject to the following conditions:—

(*a*) any licence existing at that date which has been granted for the term of the patent shall be treated as having been granted for the term as so extended if the licensee so desires;

(*b*) if the patent would, apart from this section, have expired on or before the first day of January nineteen hundred and twenty, the patent shall, during the period of extention, be subject to all the provisions by this Act substituted for sect. 24 of the principal Act (except sub-sect. (5) thereof) as if the patent had been endorsed 'licences of right.'

"(3) Where any party to a contract with the patentee or any other person, entered into before the nineteenth day of November nineteen hundred and seventeen, is subjected to loss or liability by reason of the extention of the term of any patent under the provisions of this section, the Court shall have power to determine in what manner and by which parties such loss or liability shall be borne."

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

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

thinks fit, refuse to award any damages in respect of such infringement.

Extension of term of patent.

18.—(1) A patentee may, after advertising in manner provided by Rules of the Supreme Court his intention to do so, present a petition to the Court 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.

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

(2) Any person may give notice to the Court of objection to the extension.

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

(4) The Court, in considering its decision, shall have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

(5) If it appears to the Court that the patentee has been inadequately remunerated by his patent, the Court may by order extend the term of the patent for a further term not exceeding (*seven*) **five** or, in exceptional cases, (*fourteen*) **ten** years, or may order the grant of a new patent for such terms as may be specified in the order and containing any restriction, conditions, and provisions the Court may think fit.

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

Provided that this sub-section shall not apply if the patentee is a subject of such foreign state as aforesaid, or is a company the business whereof is managed or controlled by such subjects or is carried on wholly or mainly for the benefit or on behalf of such subjects, notwithstanding that the company may be registered within His Majesty's Dominions. **(Sub-sect. 6 was added by sect. 7 of the Act of 1919.)** (*See pp. 246, 269.*)

Patents of addition.

19.—(1) Where a patent for an invention has been applied for or

granted, and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement in or modification of the invention, he may, if he thinks fit, in his application for the further patent, request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired.

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

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

Provided that, if the patent for the original invention is revoked, then the patent of addition shall, if the Court or Comptroller so orders, become an independent patent, and the fees payable, and the dates when they become payable shall be determined by its date, but its duration shall not exceed the unexpired term of the patent for the original invention. **(Proviso added by the Act of 1919.)** (*See pp. 56, 167.*)

(4) The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject for a patent of addition, and the validity of the patent shall not be questioned on the ground that the invention ought to have been the subject of an independent patent. (*See p. 168.*)

Restoration of lapsed Patents.

Restoration of lapsed patents.

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

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

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

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

(5) After the expiration of the prescribed period the Comptroller

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

(6) An appeal shall lie from the decision of the Comptroller under this section to the Court. **(Sub-section added by the Act of 1919.)** (*See p. 170.*)

Amendment of Specification.

Amendment of specification by Comptroller.

21.—(1) An applicant or a patentee may at any time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of, and the reasons for, the proposed amendment. (*See p. 196.*)

(2) The request and the nature of the proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment. (*See p. 203.*)

(3) Where such a notice is given the Comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case. (*See p. 204.*)

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

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

(6) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment. (*See p. 198.*)

(7) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall be advertised in the prescribed manner,

and shall in all Courts and for all purposes be deemed to form part of the specification: (*See p. 206.*)

Provided that the Court shall be entitled in construing a specification as amended to refer to the specification as accepted and published. **(Proviso inserted by the Act of 1919.)** (*See p. 103.*)

(8) This section shall not apply when and so long as any action for infringement or proceeding before the Court for the revocation of a patent is pending. (*See p. 207.*)

Amendment of specification by the Court.

22. In any action for infringement of a patent or proceedings before a Court for the revocation of a patent the Court may by order allow the patentee to amend his specification by way of disclaimer **correction or explanation** in such manner, and subject to such terms as to costs, advertisement or otherwise, as the Court may think fit:

Provided that no amendment shall be so allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before the amendment, and where an application for such an order is made to the Court, notice of the application shall be given to the Comptroller, and the Comptroller shall have the right to appear and be heard, and shall appear if so directed by the Court. (*See p. 209.*)

Restriction on recovery of damages.

23. Where an amendment of a specification by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before (*the disclaimer, correction, or explanation*) **the date of the decision allowing the amendment,** unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge. (*See p. 211.*)

Compulsory licences and revocation.

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

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

(3) *Where any such petition is referred by the Board of Trade to the Court, and it is proved to the satisfaction of the Court that the*

reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by the Court to grant licences on such terms as the Court may think just, or, if the Court is of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, the patent may be revoked by order of the Court:

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

(4) *On the hearing of any petition under this section the patentee, and any person claiming an interest in the patent as exclusive licensee or otherwise, shall be made parties to the proceeding, and the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.*

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

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

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

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

Sect. 2 of the Act of 1919 enacted as follows:—

Provision as to patents indorsed "licences of right."

For section twenty-four of the principal Act, the following section shall be substituted:—

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

(*a*) any person shall at any time thereafter be entitled as of right to a licence under the patent upon such terms as, in

default of agreement, may be settled by the comptroller on the application of either the patentee or the applicant:

Provided that any licence the terms of which are settled by agreement shall be deemed, unless otherwise expressly provided, to include the terms and conditions specified in paragraphs (*c*) and (*d*) of this sub-section as if they had been imposed by the comptroller thereunder in like manner as if the terms had been settled by the comptroller: (*See p. 238.*)

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

(i) he shall, on the one hand, endeavour to secure the widest possible user of the invention in the United Kingdom consistent with the patentee deriving a reasonable advantage from his patent rights;

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

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

Provided, that, in considering the question of equality of advantage, the comptroller shall take into account any work done or outlay incurred by any previous licensee with a view to testing the commercial value of the invention or to securing the working thereof on a commercial scale in the United Kingdom: (*See p. 239.*)

(*c*) any such licence the terms of which are settled by the comptroller may be so framed as to preclude the licensee from importing into the United Kingdom any goods the importation of which, if made by persons other than the patentee or those claiming under him, would be an infringement of the patent, and in such a case the patentee and all licensees under the patent shall be deemed to have mutually covenanted against such importation: (*See p. 238.*)

(*d*) every such licensee shall be entitled to call upon a patentee to take proceedings to prevent the infringement of the patent, and if the patentee refuses, or neglects to do so within two months after being so called upon, the licensee

may institute proceedings for the infringement in his own name as though he were patentee, making the patentee a defendant. A patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings. Service on him may be effected by leaving the writ at his address for service given on the register : (*See pp. 225, 238.*)

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

Provided that this paragraph shall not apply where the infringement consists of the importation of infringing goods : (*See p. 373.*)

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

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

Provided that a patentee shall not be deemed to be so precluded by reason only of his having granted a licence under the patent where the licence does not limit his right to grant other licences. (*See p. 239.*)

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

Any order under this sub-section shall be subject to appeal to the court. (*See p. 240.*)

(4) All indorsements of patents under this section shall be

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

(5) If at any time it appears that in the case of a patent so indorsed there is no existing licence the comptroller may, if he thinks fit, on the application of the patentee and on payment by him of the unpaid moiety of all renewal fees which have become due since the indorsement, after due notice cancel the indorsement, and in that case the patentee's rights and liabilities shall be the same as if no such indorsement had been made. (*See pp. 238, 241.*)

Revocation of patent.

25.—(1) Revocation of a patent may be obtained on petition to the Court. (*See p. 293.*)

(2) Every ground on which—

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

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

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

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

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

(*b*) by any person alleging—

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

(ii) that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee; or

(iii) that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention. (*See p. 294.*)

Power of Comptroller to revoke patents on certain grounds.

26.—(1) Any person who would have been entitled to oppose the grant of a patent, or is the successor in interest of a person who was so entitled, may, within two years from the date of the patent, *in the prescribed manner* apply to the Comptroller for an order revoking the patent on any one or more of the grounds on which the grant of the patent might have been opposed.

Provided that when an action for infringement or proceedings

for the revocation of the patent are pending in any Court, an application under this section shall not be made except with the leave of the Court.

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

(3) A patentee may at any time, by giving notice in the prescribed manner to the Comptroller, offer to surrender his patent, and the Comptroller may, if after giving notice of the offer and hearing all parties who desire to be heard he thinks fit, accept the offer, and thereupon make an order for the revocation of the patent. (*See pp. 194, 303.*)

(4) Any decision of the Comptroller under this section shall be subject to appeal to the Court. (*See p. 190.*)

Revocation of patents worked outside the United Kingdom.

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

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

(a) forthwith; or

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

Provided that no such order shall be made which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or British possession.

(3) *If within the time limited in the order the patented article or process is not manufactured or carried on within the United Kingdom*

to an adequate extent, but the patentee gives satisfactory reasons why it is not so manufactured or carried on, the Comptroller may extend the period mentioned in the previous order for such period not exceeding twelve months as may be specified in the subsequent order.

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

Sect. 1 of the Act of 1919 repealed the above section and substituted the following:—(*See pp. 274, 426.*)

Provisions for the prevention of abuse of monopoly rights.

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

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

(*a*) If at any time after the expiration of four years from the date of the patent, the patented invention (being one *capable of being* worked in the United Kingdom), is not being worked within the United Kingdom on a commercial scale, and no satisfactory reason can be given for such non-working: (*See p. 274.*)

Provided that, if an application is presented to the comptroller on this ground, and the comptroller is of opinion that the time which has elapsed since the date of the patent has by reason of the nature of the invention or for any other cause been insufficient to enable the invention to be worked within the United Kingdom on a commercial scale, the comptroller may adjourn the application for such period as will in his opinion be sufficient for that purpose: (*See p. 289.*)

(*b*) If the working of the invention within the United Kingdom on a commercial scale is being prevented or hindered by the importation from abroad of the patented article by the patentee or persons claiming under him, or by persons directly or indirectly purchasing from him, or by other persons against whom the patentee is not taking or has not taken any proceedings for infringement: (*See p. 281.*)

(*c*) If the demand for the patented article in the United Kingdom is not being met to an adequate extent and on reasonable terms: (*See p. 282*).

(*d*) If, by reason of the refusal of the patentee to grant a licence or licences upon reasonable terms, the trade or

industry of the United Kingdom or the trade of any person or class of persons trading in the United Kingdom, or the establishment of any new trade or industry in the United Kingdom, is prejudiced, and it is in the public interest that a licence or licences should be granted: (*See p. 282.*)

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

Provided that, for the purpose of determining whether there has been any abuse of the monopoly rights under a patent, it shall be taken that patents for new inventions are granted not only to encourage invention but to secure that new inventions shall so far as possible be worked on a commercial scale in the United Kingdom without undue delay. (*See p. 284.*)

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

(*a*) He may order the patent to be indorsed with the words "licences of right" and thereupon the same rules shall apply as are provided in this Act in respect of patents so indorsed, and an exercise by the comptroller of this power shall entitle every existing licensee to apply to the comptroller for an order entitling him to surrender his licence in exchange for a licence to be settled by the comptroller in like manner as if the patent had been so indorsed at the request of the patentee, and the comptroller may make such order; and an order that a patent be so indorsed may be made notwithstanding that there may be an agreement subsisting which would have precluded the indorsement of the patent at the request of the patentee: (*See pp. 241, 284.*)

(*b*) He may order the grant to the applicant of a licence on such terms as the comptroller may think expedient, including a term precluding the licensee from importing into the United Kingdom any goods the importance of which, if made by persons other than the patentee or persons claiming under him, would be an infringement of the patent, and in such case the patentee and all licensees

for the time being shall be deemed to have mutually covenanted against such importation. A licensee under this paragraph shall be entitled to call upon the patentee to take proceedings to prevent infringement of the patent and if the patentee refuses, or neglects to do so within two months after being so called upon, the licensee may institute proceedings for infringement in his own name as though he were the patentee, making the patentee a defendant. A patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings. Service on him may be effected by leaving the writ at his address for service given on the register: (*See pp. 225, 285.*)

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

(*c*) If the comptroller is satisfied that the invention is not being worked on a commercial scale within the United Kingdom, and is such that it cannot be so worked without the expenditure of capital for the raising of which it will be necessary to rely on the patent monopoly, he may, unless the patentee or those claiming under him will undertake to find such capital, order the grant to the applicant, or any other person, or to the applicant and any other person or persons jointly, if able and willing to provide such capital, of an exclusive licence on such terms as the comptroller may think just, but subject as hereinafter provided: (*See p. 286.*)

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

Provided that the comptroller shall make no order for revocation which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or British possession: (*See p. 289.*)

(*e*) If the comptroller is of opinion that the objects of this section will be best attained by making no order under the above provisions of this section, he may make an order refusing the application and dispose of any question as to costs thereon as he thinks just. (*See p. 290.*)

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

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

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

and, in addition to any other powers expressed in the licence or order, the licence and the order granting the licence shall be made revocable at the discretion of the comptroller if the licensee fails to expend the amount specified in the licence as being the amount which he is able and willing to provide for the purpose of working the invention on a commercial scale within the United Kingdom, or if he fails so to work the invention within the time specified in the order. (*See p. 287.*)

(5) In deciding to whom such an exclusive licence is to be granted the comptroller shall, unless good reason is shown to the contrary, prefer an existing licensee to a person having no registered interest in the patent. (*See p. 287.*)

(6) The order granting an exclusive licence under this section shall operate to take away from the patentee any right which he may have as patentee to work or use the invention and to revoke all existing licences, unless otherwise provided in the order, but on granting an exclusive licence the comptroller may, if he thinks it fair and equitable, make it a condition that the licensee shall give proper compensation to be fixed by the comptroller for any money or labour expended by the patentee or any existing licensee in developing or exploiting the invention. (*See p. 287.*)

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

statutory declarations verifying the applicant's interest and the facts set out in the application.

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

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

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

(11) All orders of the comptroller under this section shall be subject to appeal to the Court, and on any such appeal the law officer or such other counsel as he may appoint shall be entitled to appear and be heard. (*See p. 291.*)

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

(*a*) if the parties interested consent, or

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

the comptroller may at any time order the whole proceedings or any question or issue of fact arising thereunder to be referred to an arbitrator agreed on by the parties, or in default of agreement

appointed by the comptroller, and, where the whole proceedings are so referred, the award of such arbitrator shall, if all the parties consent, be final, but otherwise shall be subject to the same appeal as the decision of the comptroller under this section, and, where a question or issue of fact is so referred, the arbitrator shall report his findings to the comptroller. (*See p. 291.*)

(13) For the purposes of this section, the expression "patented article" includes articles made by a patented process. (*See p. 272.*)

And sect. 3 of the Act of 1919 added the following new section :—

Enforcement of order for grant of licence.

27A. Any order for the grant of a licence under this Act shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence executed by the patentee and all other necessary parties. (*See pp. 240, 289.*)

Register of Patents.

Register of patents.

28.—(1) There shall be kept at the Patent Office a book called the register of patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may be prescribed.

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

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

(4) Copies of deeds, licences, and any other documents affecting the proprietorship in any letters patent or in any licence thereunder, must be supplied to the Comptroller in the prescribed manner for filing in the Patent Office. (*See p. 241.*)

Crown.

Patent to bind Crown.

(29. *A patent shall have to all intents the like effect as against His Majesty the King as it has against a subject :*

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

agreement, as may be settled by the Treasury after hearing all parties interested.)

The above section was repealed by sect. 8 of the Act of 1919, which substituted the following:—

Right of Crown to use patented inventions.

"29.—(1) A patent shall have to all intents the like effect as against His Majesty the King as it has against a subject:

"Provided that any Government department may, by themselves or by such of their agents, contractors, or others as may be authorised in writing by them at any time after the application, make, use or exercise the invention for the services of the Crown on such terms as may, either before or after the use thereof, be agreed on, with the approval of the Treasury, between the department and the patentee, or, in default of agreement, as may be settled in the manner hereinafter provided. And the terms of any agreement or licence concluded between the inventor or patentee and any person other than a Government department, shall be inoperative so far as concerns the making, use or exercise of the invention for the service of the Crown: (*See p. 397.*)

"Provided further that, where an invention which is the subject of any patent has, before the date of the patent, been duly recorded in a document by, or tried by or on behalf of, any Government department (such invention not having been communicated directly or indirectly by the applicant for the patent or the patentee), any Government department, or such of their agents, contractors, or others, as may be authorised in writing by them, may make, use and exercise the invention so recorded or tried for the service of the Crown, free of any royalty or other payment to the patentee, notwithstanding the existence of the patent. If in the opinion of the department the disclosure to the applicant or the patentee, as the case may be, of the document recording the invention, or the evidence of the trial thereof, if required, would be detrimental to the public interest, it may be made confidentially to counsel on behalf of the applicant or patentee, or to any independent expert mutually agreed upon. (*See p. 399.*)

"(2) In case of any dispute as to the making, use or exercise of an invention under this section, or the terms therefor, or as to the existence or scope of any record or trial as aforesaid, the matter shall be referred to the court for decision, who shall have power to refer the whole matter or any question or issue of fact arising thereon to be tried before a special or official referee or an arbitrator upon such terms as it may direct. The court, referee, or arbitrator, as the case may be, may, with the consent of the parties, take into consideration the validity of the patent for the purposes

only of the reference and for the determination of the issues between the applicant and such Government department. The court, referee, or arbitrator, further in settling the terms as aforesaid, shall be entitled to take into consideration any benefit or compensation which the patentee, or any other person interested in the patent, may have received directly or indirectly from the Crown or from any Government department in respect of such patent. (*See p. 400.*)

"(3) The right to use an invention for the services of the Crown under the provisions of this section or any provisions for which this section is substituted shall include, and shall be deemed always to have included, the power to sell any articles made in pursuance of such right which are no longer required for the services of the Crown. (*See p. 401.*)

"(4) Nothing in this section shall affect the right of the Crown or of any person deriving title directly or indirectly from the Crown to sell or use any articles forfeited under the laws relating to the customs or excise." (*See p. 401.*)

Assignment to Secretary for War or the Admiralty of certain inventions.

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

(2) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State or the Admiralty on behalf of His Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Secretary of State or the Admiralty.

(3) Where any such assignment has been made, the Secretary of State or the Admiralty may at any time before the publication of the complete specification certify to the Comptroller that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4) If the Secretary of State or the Admiralty so certify the application and specifications, with the drawings (if any), and any amendment of the complete specification, and any copies of such documents and drawings shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the Comp-

troller in a packet sealed by authority of the Secretary of State or the Admiralty.

(5) The packet shall, until the expiration of the term during which a patent for the invention may be in force, be kept sealed by the Comptroller, and shall not be opened save under the authority of an order of the Secretary of State or the Admiralty or of the law officer.

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

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

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

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

(10) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but, save as in this section otherwise directed, the provisions of this Act shall apply in respect of any such invention and patent as aforesaid.

(11) The Secretary of State or the Admiralty may at any time waive the benefit of this section with respect to any particular invention, and the specifications, documents, and drawings shall be henceforth kept and dealt with in the ordinary way.

(12) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State or the Admiralty, or to any person or persons authorised by the Secretary of State or the Admiralty to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

(13) Rules may be made under this Act, after consultation with

the Secretary of State and the Admiralty, for the purpose of ensuring secrecy with respect to patents to which this section applies, and those rules may modify any of the provisions of this Act in their application to such patents as aforesaid so far as may appear necessary for the purpose aforesaid. (*See p. 155.*)

Legal Proceedings.

Hearing with assessor.

31.—(1) In an action or proceeding for infringement or revocation of a patent, the Court may, if it think fit, and shall on the request of (*either*) **all** of the parties to the proceeding, call in the aid of an assessor specially qualified, and try the case wholly or partially with his assistance; the action shall be tried without a jury, unless the Court otherwise directs. **(Amended by Act of 1919.)**

(2) The Court of Appeal may, if they think fit, in any proceeding before them, call in the aid of an assessor as aforesaid.

(3) The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Court of Appeal, as the case may be, and be paid as part of the expenses of the execution of this Act. (*See p. 375.*)

Power to counterclaim for revocation in an action for infringement.

32. A defendant in an action for infringement of a patent, if entitled to present a petition to the Court for the revocation of the patent, may, without presenting such a petition, apply in accordance with the Rules of the Supreme Court by way of counterclaim in the action for the revocation of the patent. (*See pp. 298, 377.*)

Power of court to grant relief in respect of particular claims.

32A. Notwithstanding anything to the contrary appearing in section twenty-three of this Act, if the court in any action for infringement of a patent finds that any one or more of the claims in the specification, in respect of which infringement is alleged, are valid, it shall, subject to its discretion as to costs and as to the date from which damages should be reckoned, and to such terms as to amendment as it may deem desirable, grant relief in respect of any of such claims which are infringed without regard to the invalidity of any other claim in the specification. In exercising such discretion, the court may take into consideration the conduct of the parties in inserting such invalid claims in the specification or permitting them to remain there. **(Added by sect. 9 of the Act of 1919.)** (*See pp. 74, 82, 211.*)

Exemption of innocent infringer from liability for damages.

33. A patentee shall not be entitled to recover any damages in respect of any infringement of a patent granted after the commencement of this Act from any defendant who proves that at the date of the infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent, and the marking of an article with the word "patent," "patented," or any

word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed on, or otherwise applied to the article, shall not be deemed to constitute notice of the existence of the patent unless the word or words are accompanied by the year and number of the patent.

Provided that nothing in this section shall affect any proceedings for an injunction. (*See pp. 331, 333, 372.*)

Order for inspection, &c., in action.

34. In an action for infringement of a patent, **the plaintiff shall be entitled to relief by way of injunction and damages but not to an account of profits, but subject as aforesaid (Act of 1919, sect. 10)**, the Court may on the application of either party make such order for an injunction (*inspection or account*) **or inspection**, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court may see fit. **(Amended by the Act of 1919.)** (*See p. 354.*)

Certificate of validity questioned and costs thereon.

35. In an action for infringement of a patent, the Court may certify that the validity of **any claim in the specification of the patent** (*the patent*) came in question; and, if the Court so certifies, then in any subsequent action for infringement **of such claim** the plaintiff in that action on obtaining a final order or judgment in his favour shall, unless the Court trying the action otherwise directs, have his full costs, charges, and expenses as between solicitor and client **so far as that claim is concerned. (Amended by the Act of 1919.)** (*See pp. 325, 383, 387.*)

Remedy in case of groundless threats of legal proceedings.

36. Where any person claiming (*to be the patentee of an invention*) to have **an interest in a patent**, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as he has sustained thereby, if the alleged infringement to which the threats related was not in fact an infringement of (*any legal rights of the person making such threats*) **the patent:**

(*Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.*)

Provided that this section shall not apply if an action for infringement of the patent is commenced and prosecuted with due diligence. **(This proviso substituted for the above by the Act of 1919.)** (*See pp. 304, 309.*)

Miscellaneous.

Grant of patents to two or more persons.

37. Where, after the commencement of this Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interest therein as joint tenants, but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a licence without their consent, and, if any such person dies, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate. (*See p. 219.*)

Avoidance of certain conditions attached to the sale, &c., of patented articles.

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

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

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

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

Provided that this sub-section shall not apply if—

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

(ii) the contract entitles the purchaser, lessee, or licensee to relieve himself of his liability to observe any such condition on giving the other party three months' notice in writing and on payment in compensation for such relief in the case of a purchase of such sum, or in the case of a lease or licence of such rent or royalty for the residue of the term of the contract, as may be fixed by an arbitrator appointed by the Board of Trade.

In any action, application, or proceedings under this Act no person shall be estopped from applying for or obtaining relief by reason of any admission made by him as to the reasonableness of

the terms offered to him under sub-sect. (1)(i). **(This paragraph was inserted by the Act of 1919.)** *(See pp. 233, 235.)*

(2) Any contract relating to the lease of or licence to use or work any patented article or patented process, whether made before or after the passing of this Act, may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything in the same or in any other contract to the contrary, be determined by either party on giving three months' notice in writing to the other party; but where any such notice is given determining any contract made before the passing of this Act, the party giving the notice shall be liable to pay such compensation as failing agreement may be awarded by an arbitrator appointed by the Board of Trade. *(See p. 236.)*

(3) Any contract made before the passing of this Act relating to the lease of or licence to use or work any patented article or process and containing any condition which, had the contract been made after the passing of this Act, would by virtue of this section have been null and void may, at any time before the contract is determinable under the last preceding sub-section, and notwithstanding anything in the same or any other contract to the contrary, be determined by either party on giving three months' notice in writing to the other party, but where any such notice is given the party giving the notice shall be liable to pay such compensation as, failing agreement, may be awarded by an arbitrator appointed by the Board of Trade. *(See p. 236.)*

(4) The insertion by the patentee in a contract made after the passing of this Act of any condition which by virtue of this section is null and void shall be available as a defence to an action for infringement of the patent to which the contract relates brought while that contract is in force. *(See pp. 237, 331, 333.)*

(5) Nothing in this section shall—

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

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

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

(*d*) affect any condition in a contract for the lease of or licence to use a patented article, whereby the lessor or licensor reserves to himself or his nominees the right to supply

such new parts of the patented article as may be required to put or keep it in repair. (*See pp. 233, 284.*)

Chemical products and substances intended for food or medicine.

38A.—(1) In the case of inventions relating to substances prepared or produced by chemical processes or intended for food or medicine, the specification shall not include claims for the substance itself, except when prepared or produced by the special methods or processes of manufacture described and claimed or by their obvious chemical equivalents: Provided that, in an action for infringement of a patent where the invention relates to the production of a new substance, any substance of the same chemical composition and constitution shall in the absence of proof to the contrary be deemed to have been produced by the patented process. (*See pp. 144, 158.*)

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

Any decision of the comptroller under this sub-section shall be subject to appeal to the court.

(2) This section shall apply only to patents applied for after the passing of this Act. **(This section was added by sect. 11 of the Act of 1919.)** (*See p. 35.*)

Costs and security for costs.

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

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

(Repealed by sect. 12 of the Act of 1919. See sect. 73A substituted therefor.)

Procedure on appeal to law officer.

40. The law officer may examine witnesses on oath and administer oaths for that purpose, and may make rules regulating references and appeals to the law officer and the practice and procedure before him under this Part of this Act; and in any proceeding before the law officer under this Part of this Act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the Court. (*See p. 192.*)

Provisions as to anticipation.

41.—(1) An invention covered by any patent applied for on or after the first day of January One thousand nine hundred and five shall not be deemed to have been anticipated by reason only of its publication in a specification left pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for the patent, or of its publication in a provisional specification of any date not followed by a complete specification. (*See p. 72.*)

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

By sect. 13 of the Act of 1919 it was enacted that at the end of sub-sect. (2) of sect. 41 of the principal Act, the following proviso should be added:—

> Provided that the protection afforded by this sub-section shall not extend to a patentee who has commercially worked his invention in the United Kingdom otherwise than for the purpose of reasonable trial of the invention prior to the application for the patent.
>
> (2) This section (*i.e.* the proviso above) shall not apply in the case of patents granted before the passing of this Act. (*See p. 66.*)

Disconformity.

42. A patent shall not be held to be invalid on the ground that the complete specification claims a further or different invention to that contained in the provisional, if the invention therein claimed, so far as it is not contained in the provisional, was novel at the date when the complete specification was put in, and the applicant was the first and true inventor thereof. (*See p. 90.*)

Patent on application of representative of deceased inventor.

43.—(1) If any person claiming to be inventor of an invention die without making an application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative. (*See p. 213.*)

(2) Every such application must contain a declaration by the legal representative that he believes him to be the true and first inventor of the invention.

Loss or destruction of patent.

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

Provisions as to exhibitions.

45.—(1) The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, **or the reading of a paper by an inventor before a learned society, or the publication of the paper in the society's transactions,** shall not prejudice the right of the inventor to apply for and obtain a patent in respect of the invention or the validity of any patent granted on the application, provided that—

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

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

(2) His Majesty may by Order in Council apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition of giving notice to the Comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the Order. (*See p. 76.*)

Publication of illustrated journal, indexes, &c.

46.—(1) The Comptroller shall issue periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that he may deem generally useful or important.

(2) Provision shall be made by the Comptroller for keeping on

sale copies of such journal, and also of all complete specifications of patents in force, with any accompanying drawings.

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

Patent Museum.

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

(2) The Board of Education may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model, the amount to be settled, in case of dispute, by the Board of Trade.

Foreign vessels in British waters.

48.—(1) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of His Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.

(2) This section shall not extend to vessels of any foreign State of which the laws do not confer corresponding rights with respect to the use of inventions in British vessels while in the ports of that State, or in the waters within the jurisdiction of its Courts.
(*See p. 149.*)

PART II.—DESIGNS.

(This Part of the Act is not relevant to this Work.)

PART III.—GENERAL.

Patent Office and Proceedings thereat.

Patent Office. 5 Edw. 7, c. 15.

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

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

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

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

Officers and clerks.

63.—(1) There shall continue to be a Comptroller-General of patents, designs, and trade marks, and the Board of Trade may, subject to the approval of the Treasury, appoint the Comptroller, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may remove any of those officers and clerks.

(2) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and those salaries and the other expenses of the execution of this Act and the Trade Marks Act, 1905, shall continue to be paid out of money provided by Parliament.

Seal of Patent Office.

64. Impressions of the seal of the Patent Office shall be judicially noticed and admitted in evidence. (*See p. 5.*)

Fees.

Fees.

65. There shall be paid in respect of the grant of patents and the registration of designs, and applications therefor, and in respect of other matters with relation to patents and designs under this Act, such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade; so, however, that the fees prescribed in respect of the instruments and matters mentioned in the First Schedule to this Act shall not exceed those specified in that Schedule.

Provisions as to Registers and other Documents in Patent Office.

Trust not to be entered in registers.

66. 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. (*See p. 242.*)

Inspection of and extracts from registers.

67. 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. (*See p. 244.*)

Privilege of reports of examiners.

68. Reports of examiners made under this Act shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, unless the Court or officer having power to order discovery in such legal proceeding certifies that such production or inspection is desirable in the interests of justice, and ought to be allowed.

Provided that on application being made by any person in the prescribed form the Comptroller may disclose the result of a search made under section seven or eight of this Act on any particular application for the grant of a patent. **(Proviso inserted by Act of 1919.)** *(See p. 166.)*

Prohibition of publication of specification, drawings, &c., where application abandoned, &c.

69.—(1) Where an application for a patent has been abandoned, or become void, the specifications and drawings (if any) accompanying or left in connection with such application, shall not, save as otherwise expressly provided by this Act, at any time be open to public inspection or be published by the Comptroller. *(See p. 74.)*

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

Power for Comptroller to correct clerical errors.

70. The Comptroller may, on request in writing accompanied by the prescribed fee,—

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

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

(*c*) correct any clerical error in the representation of a design or in the name or address of the proprietor of any patent or design, or in any other matter which is entered upon the register of patents or the register of designs. *(See p. 245.)*

Entry of assignments and transmissions in registers.

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

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

(3) *The person registered as the proprietor of a patent or design shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person have power absolutely to assign, grant licences as to, or otherwise deal with, the patent or design and to give effectual receipts for any consideration for any such assignment, licence, or dealing: Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other personal property.* **(Repealed by sect. 16 of the Act of 1919, which re-enacted the following section in its place.)**

71.—(1) Where a person becomes entitled by assignment, transmission, or other operation of law to a patent or to the copyright in a registered design, he shall make application to the Comptroller to register his title, and the Comptroller shall, on receipt of such application and on proof of title to his satisfaction, register him as the proprietor of such patent or design and shall cause an entry to be made in the prescribed manner on the register of the assignment, transmission, or other instrument affecting the title. (*See p. 213.*)

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

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

Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other personal property. (*See pp. 242, 320.*)

(4) Except in applications made under section twenty-two of this Act, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of sub-sections (1) and (2) aforesaid, shall not be admitted in evidence in any Court in proof of the title to a patent or copyright in a design or to any interest therein unless the Court otherwise directs. (*See pp. 242, 320, 379, 404.*)

Rectification of registers by Court.

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

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

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

(4) Any order of the Court rectifying a register shall direct that notice of the rectification be served on the Comptroller in the prescribed manner, who shall upon the receipt of such notice rectify the register accordingly. (*See p. 245.*)

Powers and Duties of Comptroller.

Exercise of discretionary power by Comptroller.

73. Where any discretionary power is by or under this Act given to the Comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard.

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

(2) If any party giving notice of any opposition under this Act, or applying to the Comptroller for the revocation of a patent, or giving notice of appeal from any decision of the Comptroller under this Act, neither resides nor carries on business in the United Kingdom or the Isle of Man, the Comptroller, or in case of appeal to the law officer or the Court, the law officer or the Court may require such party to give security for the costs of the proceedings or appeal, and in default of such security being given may proceed to treat the proceedings or appeal as abandoned. **(Added by sect 12 of the Act of 1919 to replace sect. 39.)** (*See p. 193.*)

Power of Comptroller to take directions of law officers.

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

Refusal to grant patent, &c., in certain cases.

75. The Comptroller may refuse to grant a patent for an invention, or to register a design, of which the use would, in his opinion, be contrary to law or morality.

An appeal shall lie from the decision of the Comptroller under this section to the law officer. (Act of 1919, sect. 17.)

Annual reports of Comptroller.

76. The Comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which the report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

Evidence, &c.

Evidence before Comptroller.

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

(2) In case any part of the evidence is taken viva voce, the Comptroller shall, in respect of requiring the attendance of witnesses and taking evidence on oath, **and discovery and production of documents (Act of 1919)**, be in the same position in all respects as an official referee of the Supreme Court. (*See p. 192.*)

Certificate of Comptroller to be evidence.

78. 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. (*See p. 379.*)

Evidence of documents in Patent Office.

79. Printed or written copies or extracts, purporting to be certified by the Comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, and other documents in the Patent Office, and of or from registers and other books kept

there, shall be admitted in evidence in all Courts in His Majesty's dominions, and in all proceedings, without further proof or production of the originals. (*See pp. 244, 378.*)

Transmission of certified printed copies of specifications, &c.

80.—(1) Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after they have been accepted or allowed at the Patent Office.

(2) Certified copies of or extracts from any such documents and of any documents so transmitted in pursuance of any enactment repealed by this Act shall be given to any person on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals. (*See p. 379.*)

Applications and notices by post.

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

Excluded days.

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

Declaration by infant, lunatic, &c.

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

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

Register of Patent Agents.

Register of patent agents.

84.—(1) *A person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business,*

by any document issued by him or otherwise, unless he is registered as a patent agent in pursuance of this Act or an Act repealed by this Act.

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

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

(4) *In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.* **(Repealed by sect. 18 of the Act of 1919, which enacted the following section in its place):—**

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

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

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

(*c*) in the case of a company which commenced to carry on business as a patent agent after the seventeenth day of November nineteen hundred and seventeen, every director and the manager (if any) of the company is so registered;

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

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

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

misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom.

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

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

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

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

Agents for patents.

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

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

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

Powers, &c., of Board of Trade.

Power for Board of Trade to make general rules.

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

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

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

(*c*) For making or requiring duplicates of specifications, drawings, and other documents:

(*d*) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, and other documents:

(*e*) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications, and other documents in the Patent Office; and providing for the inspection of indexes and 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*) For regulating the keeping of the register of patent agents under this Act:

(*h*) generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the Comptroller, or of the Board of Trade.

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

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

Proceedings of the Board of Trade.

87.—(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.

Provision as to Order in Council.

88. An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if it had been contained in this Act; but may be revoked or varied by a subsequent Order.

Offences.

Offences.

89.—(1) If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

(2) If any person falsely represents that any article sold by him is a patented article, or falsely describes any design applied to any article sold by him as registered, he shall be liable for every offence, on conviction under the Summary Jurisdiction Acts, to a fine not exceeding five pounds.

(3) If any person sells an article having stamped, engraved, or impressed thereon or otherwise applied thereto the word "patent," "patented," "registered," or any other word expressing or implying that the article is patented or that the design applied thereto is registered, he shall be deemed for the purposes of this section to represent that the article is a patented article or that the design applied thereto is a registered design.

(4) Any person who, after the copyright in a design has expired, puts or causes to be put on any article to which the design has been applied the word "registered," or any word or words implying that there is a subsisting copyright in the design, shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding five pounds.

(5) If any person uses on his place of business, or on any document issued by him, or otherwise, the words "Patent Office," or any other words suggesting that his place of business is officially connected with, or is, the Patent Office, he shall be liable on conviction

under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

Unauthorised assumption of Royal Arms.

90.—(1) The grant of a patent under this Act shall not be deemed to authorise the patentee to use the Royal Arms or to place the Royal Arms on any patented article.

(2) If any person, without the authority of His Majesty, uses in connection with any business, trade, calling or profession the Royal Arms (or arms so nearly resembling them as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised to use the Royal Arms, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing such Arms to continue to use such trade mark.

International and Colonial Arrangements.

International and Colonial arrangements.

91.—(1) If His Majesty is pleased to make any arrangement with the Government of any foreign State for mutual protection of inventions, or designs, or trade marks, then any person who has applied for protection for any invention, design, or trade mark in that State or his legal representative or assignee (*a*), shall be entitled to a patent for his invention or to registration of his design or trade mark under this Act or the Trade Marks Act, 1905, in priority to other applicants; and the patent or registration shall have the same date as the date of the application in the foreign State.

Provided that—

(*a*) The application is made, in the case of a patent within twelve months, and in the case of a design or trade mark within four months, from the application for protection in the foreign State; and

(*b*) Nothing in this section shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the actual date on which his complete specification is accepted, or his design or trade mark is registered, in this country.

(2) The patent granted for the invention or the registration of a design or trade mark shall not be invalidated—

(*a*) in the case of a patent, by reason only of the publication of a description of, or use of, the invention; or

(*b*) in the case of a design, by reason only of the exhibition or use

(*a*) Extended to representative or assignee by the 4 & 5 Geo. 5, c. 18, and the 1911 Convention.

of, or the publication of a description or representation of, the design; or

(c) in the case of a trade mark, by reason only of the use of the trade mark,

in the United Kingdom or the Isle of Man during the period specified in this section as that within which the application may be made.

(3) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act or the Trade Marks Act, 1905: Provided that—

(a) In the case of patents the application shall be accompanied by a complete specification, which, if it is not accepted within the twelve months from the application for protection in the foreign State, shall with the drawings (if any) be open to public inspection at the expiration of that period: and

(b) In the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under the Trade Marks Act, 1905.

(4) The provisions of this section shall apply only in the case of those foreign States with respect to which His Majesty by Order in Council declares them to be applicable, and so long only in the case of each State as the Order in Council continues in force with respect to that State.

(5) Where it is made to appear to His Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, (*and*) or trade marks, patented or registered in this country, it shall be lawful for His Majesty, by Order in Council, to apply the provisions of this section to that possession, with such variations or additions, if any, as may be stated in the order. (*See pp. 26, 153.*)

Definitions.

Provisions as to "the Court."

92.—(1) In this Act, unless the context otherwise requires, "the Court" means, subject to the provisions as to Scotland, Ireland, and the Isle of Man, the High Court in England.

(2) Where by virtue of this Act a decision of the Comptroller is subject to an appeal to the Court, or a petition may be referred or presented to the Court, the appeal shall, **except in the case of a petition for the revocation of a patent under section twenty-five of this Act, and,** subject to and in accordance with Rules of the Supreme Court, be made and the petition referred or

presented to such judge of the High Court as the Lord Chancellor may select for the purpose. (*and the decision of that judge shall be final, except in the case of an appeal from a decision of the Comptroller revoking a patent on any ground on which the grant of such patent might have been opposed.*) (*See p. 247.*)

An appeal shall not lie from any decision of such judge except in the case of an order revoking or confirming the revocation of a patent. (*See p. 194.*)

Definitions.

93. In this Act, unless the context otherwise requires,—

"Law Officer" means the Attorney-General or Solicitor-General for England:

"Prescribed" means prescribed by general rules under this Act:

"British possession" does not include the Isle of Man or the Channel Islands:

"Patent" means letters patent for an invention:

("*Patentee*" *means the person for the time being entitled to the benefit of a patent*:)

"Patentee" means the person for the time being entered on the register as the grantee or proprietor of the patent: **(Definition substituted by sect. 19 of the Act of 1919).** (*See pp. 8, 256.*)

"Invention" means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled "An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof"), and includes an alleged invention: (*See pp. 3, 29.*)

"Inventor" and "applicant" shall, subject to the provisions of this Act, include the legal representative of a deceased inventor or applicant:

("*Design*" *means any design* (*not being a design for a sculpture or other thing within the protection of the Sculpture Copyright Act*, 1814) *applicable to any article, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined.*)

54 Geo. 3, c. 56.

"Design" means only the features of shape, configuration, pattern, or ornament applied to any article by any industrial

process or means, whether manual, mechanical, or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction, or anything which is in substance a mere mechanical device. **(Definition substituted by the Act of 1919.)**

"Article" means (as respects designs) any article of manufacture and any substance artificial or natural, or partly artificial and partly natural:

"Copyright" means the exclusive right to apply a design to any article in any class in which the design is registered.

"Proprietor" of a new (*and*) **or** original design,—

(*a*) Where the author of the design, for good consideration executes the work for some other person, means the person for whom the design is so executed; and

(*b*) Where any person acquires the design or the right to apply the design to any article, either exclusively of any person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired; and

(*c*) In any other case, means the author of the design;

and where the property in, or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person.

"Working on a commercial scale" means the manufacture of the article or the carrying on of the process described and claimed in a specification for a patent in or by means of a definite and substantial establishment or organisation, and on a scale which is adequate and reasonable under all the circumstances. **(This definition was added by sect. 19 of the Act of 1919.)** (*See p. 274.*)

Application to Scotland, Ireland, and the Isle of Man.

Application to Scotland.

94. In the application of this Act to Scotland—

(1) In any action for infringement of a patent in Scotland the provisions of this Act with respect to calling in the aid of an assessor shall apply, and the action shall be tried without a jury, unless the Court otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts; and for the purposes of the provisions so

applied "Court of Appeal" shall mean any Court to which such action is appealed. (*See p. 324.*)

(2) Any offence under this Act declared to be punishable on conviction under the Summary Jurisdiction Acts may be prosecuted in the sheriff Court.

(3) Proceedings for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only, and service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act: (*See p. 294.*)

(4) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland in any proceedings relating to patents or to designs; and with reference to any such proceedings, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of that Court:

((5) *Notwithstanding anything in this Act, the expression "the Court" shall, as respects petitions for compulsory licences or revocation which are referred by the Board of Trade to the Court in Scotland, mean any Lord Ordinary of the Court of Session, and shall in reference to proceedings in Scotland for the extension of the term of a patent mean such Lord Ordinary:*)

(5) Notwithstanding anything in this Act the expression "the Court" shall in reference to proceedings in Scotland for the extension of the term of a patent mean any Lord Ordinary of the Court of Session. **(This sub-section substituted by Act of 1919.)**

(6) The expression "Rules of the Supreme Court" shall, except in section ninety-two of this Act, mean Act of sederunt:

(7) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court, a copy of the order, decree, or other authority for the rectification, shall be served on the Comptroller, and he shall rectify the register accordingly:

(8) The expression "injunction" means "interdict."

Application to Ireland.

95. In the application of this Act to Ireland—

(1) All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent

as if the same had been granted to extend to Ireland only:

(2) The provisions of this Act conferring a special jurisdiction on the Court, as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Ireland in any proceedings relating to patents or to designs; and with reference to any such proceedings the term "the Court" means the High Court in Ireland:

(3) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court, a copy of the order, decree, or other authority for the rectification shall be served on the Comptroller, and he shall rectify the register accordingly:

Isle of Man.

96. This Act shall extend to the Isle of Man, subject to the following modifications:—

(1) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man in proceedings for infringement, or in any action or proceeding respecting a patent or design competent to those Courts:

(2) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court:

(3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered, at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Repeal, Savings, and Short Title.

Saving for prerogative.

97. 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. (*See p. 3.*)

Repeal and savings.

98.—(1) The enactments mentioned in the Second Schedule to this Act are hereby repealed to the extent specified in the third column of that schedule—

(*a*) As respect the enactments mentioned in Part I. of that Schedule, as from the commencement of this Act;

(*b*) As respects the enactments mentioned in Part II. of that Schedule, as from the date when Rules of the Supreme

Court regulating the matters dealt with in those enactments come into operation;

(*c*) As respects the enactments mentioned in Part III. of that Schedule, as from the date when rules under this Act regulating the matters dealt with in those enactments come into operation;

and the enactments mentioned in Part II. and Part III. of that Schedule shall, until so repealed, have effect as if they formed part of this Act:

Provided that this repeal shall not affect any convention, Order in Council, rule, or table of fees having effect under any enactment so repealed, but any such convention, Order in Council, rule, or table of fees in force at the commencement of this Act shall continue in force, and may be repealed, altered or amended, as if it had been made under this Act.

(2) Except where otherwise expressly provided, this Act shall extend to patents granted and all designs registered before the commencement of this Act, and to applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

Short title and commencement.

99. This Act may be cited as the Patents and Designs Act, 1907, and shall, save as otherwise expressly provided, come into operation on the first day of January one thousand nine hundred and eight.

Sects. 21 and 22 of the Act of 1919—

Construction, printing, and repeal.

21.—(1) This Act shall, except where otherwise expressly provided, apply to patents granted and applications for and specifications relating to patents made and deposited, and designs registered, before as well as after the passing of this Act.

(2) Where by this Act any enactments or words are directed to be added to or omitted from the principal Act, or to be substituted for any other enactments or words in the principal Act, copies of the principal Act printed under the authority of His Majesty's Stationery Office after such direction takes effect may be printed with the enactments or words added or omitted, or substituted for other enactments or words as such direction requires, and with the sections, sub-sections, and paragraphs thereof numbered in accordance with such directions; and the principal Act shall be construed as if it had at the time at which such direction takes effect been made with such addition, omission, or substitution.

(3) A reference in any Act of Parliament or other instrument to the principal Act shall, unless the context otherwise requires, be construed to refer to the principal Act as amended by this Act.

(4) The Patents and Designs Act, 1908, is hereby repealed.

22.—(1) This Act may be cited as the Patents and Designs Act, 1919, and the principal Act and this Act may be cited together as the Patents and Designs Acts, 1907 and 1919. **Short title and commencement.**

(2) The provisions by sections one and two of this Act substituted for sections twenty-seven and twenty-four of the principal Act shall not come into operation until such time, not being later than one year after the passing of this Act, as may be fixed by order of the Board of Trade (*b*), except so far as the provisions so substituted for the said section twenty-four are by sub-section (2) of section six of this Act applied to the patents therein mentioned; and the provisions of this Act relating to the terms on which an invention or registered design can be made, used or exercised by or on behalf of a Government department shall not come into operation until such time as may be fixed by order of the Board of Trade (*c*); save as aforesaid this Act shall come into operation on the passing thereof.

STATUTORY RULES AND ORDERS, 1920, No. 338.

PATENTS FOR INVENTIONS.

THE PATENTS RULES, 1920, DATED FEBRUARY 25TH, 1920.

By virtue of the provisions of the Patents and Designs Acts, 1907 and 1919 (7 Edw. 7, c. 29, and 9 & 10 Geo. 5, c. 80), hereinafter referred to as the "Acts," the Board of Trade, hereinafter referred to as the "Board," do hereby make the following Rules :—

SHORT TITLE.

1. These Rules may be cited as the Patents Rules, 1920. **Short title.**

COMMENCEMENT.

2. These Rules shall come into operation from and immediately after the 31st March, 1920, with the exception of such of them as relate to procedure under sects. 24 and 27 of the Acts, which shall come into operation at such date as the Board may by Order direct. Provided that those relating to the procedure under sect. **Commencement.**

(*b*) S. R. & O., No. 413 of 1920, brought these sections into operation on 1st April, 1920.

(*c*) S. R. & O., No. 59 of 1920, brought sub-sect. (3) into operation on 21st January, 1920; and S. R. & O., No. 658 of 1920, brought sub-sects. (1), (2) and (4) into operation on 23rd April, 1920.

24 shall come into operation immediately as regards patents which but for the passing of the Patents and Designs Act, 1919, would have expired between the date of the passing of that Act and the 1st January, 1920; and those relating to the payment of renewal fees before the expiration of the fourteenth year from the date of a patent and in respect of the fifteenth year, and those relating to the disclosure of result of search under sects. 7 or 8 of the Acts, shall have effect as from the passing of the Patents and Designs Act, 1919, but the fees which have become due in respect thereof may be paid at any time before the 1st May, 1920.

Interpretation.

Interpretation.

3. In the construction of these Rules—

"United Kingdom" includes the Isle of Man;

"Foreign Application" means an application by any person for protection of his invention in a Foreign State or British Possession to which by any Order in Council for the time being in force the provisions of sect. 91 of the Acts are applicable;

"Convention Application" means an application in the United Kingdom under sect. 91 of the Acts;

"Office" means the Patent Office;

"Journal" means the Illustrated Official Journal (Patents).

Fees.

First Schedule.

4. The fees to be paid under the Acts, so far as the Acts relate to Patents, shall be those specified in the First Schedule to these Rules.

Second and Third Schedules.

5. The forms herein referred to are those contained in the Second and Third Schedules to these Rules and such forms shall be used in all cases to which they are applicable, and may be modified as directed by the Comptroller to meet other cases.

Documents.

Size, &c., of documents.

6. All documents and copies of documents, except drawings, sent to or left at the Office or otherwise furnished to the Comptroller or to the Board shall be written, type-written, lithographed or printed in the English language (unless otherwise directed) in large and legible characters with deep permanent ink upon strong wide-ruled white paper, and, except in the case of statutory declarations and affidavits, on one side only, of a size of approximately 13 inches by 8 inches, leaving a margin of at least one inch and a half on the left-hand part thereof, and the signatures thereto must be written

in a large and legible hand. Duplicate documents shall at any time be left, if required by the Comptroller.

At the top of the first page of a specification a space of about two inches should be left blank.

Leaving and serving documents.

7. Any application, notice, or other document authorised or required to be left, made, or given at the Office, or to the Comptroller, or to any other person under the Acts or these Rules, may be sent by a prepaid or official paid 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 sending, it shall be sufficient to prove that the letter was properly addressed and put in the post.

A letter addressed to a patentee at his address as it appears on the register of patents or at his address for service or to any applicant or opponent in any proceedings under the Acts or these Rules, at the address appearing on the application or notice of opposition or given for service as hereinafter provided shall be deemed to be sufficiently addressed.

Address for service.

8. Every applicant or opponent in any proceedings under the Acts or these Rules, and every person who shall hereafter become a patentee, shall give an address for service in the United Kingdom, and such address may be treated, for all purposes connected with the patent, as the actual address of such applicant, opponent or patentee.

If any patentee desires to have two addresses for service entered in the register a request therefor shall be made on Patents Form No. 31 in respect of each patent.

The Comptroller may require any patentee, who does not reside in the United Kingdom, to give an address for service within the United Kingdom, and such address may be treated as the actual address of the patentee for all purposes connected with such patent.

AGENCY.

Agency

9. With the exception of the signing of the following documents, namely, applications for patents, for the revocation of patents, for the grant of a licence under a patent, for the indorsement of a patent "licences of right," for the refusal of a request for the indorsement of a patent "licences of right," for the cancellation of such indorsement, for the restoration of lapsed patents, requests for leave to amend applications or specifications, authorisations of agents, notices of oppositions, requests for issue of duplicate letters patent, and surrenders of letters patent, all

communications to the Comptroller under the Acts and these Rules relating to patents may be signed by and all attendances upon the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller, and resident or having a place of business in the United Kingdom. In any particular case, the Comptroller may, if he think fit, require the personal signature or presence of an applicant, opponent, or other person.

The Comptroller shall not be bound to recognise as such agent, or to receive further communications in respect of any business under the Acts from, any person whose name, by reason of his having been adjudged guilty of conduct discreditable to a patent agent, has been erased from the register of patent agents kept under the provisions of the Acts and not since restored.

Applications for the Grant of Patents.

Form of application.

10. An application for a patent, other than a Patent of Addition or a Secret Patent, shall be made on one of the Patents Forms, Nos. 1, 1A, 1B or 1B* as the case may be. An application for a Patent of Addition shall be made on Patents Form No. 1C. 1C*, 1C**, 1C*† or 1C***, and an application for a Secret Patent on Patents Form No. 1D.

Application by representative of deceased inventor.

11. In the case of an application for a patent by the legal representative of a person who has died possessed of an invention, the probate of the will, or the letters of administration granted of the estate and effects, or an official copy of such probate or letters, shall be produced at the Office in proof of the applicant's title to be regarded as legal representative and be supported by such further evidence as the Comptroller may require.

Order of recording applications.

12. 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 are delivered in the ordinary course of post.

Applications left at the Office otherwise than through the post shall be in like manner numbered in the order of their receipt at the Office.

One invention.

13.—(1) When a specification comprises several distinct matters, they shall not be deemed to constitute one invention by reason only that they are all applicable to or may form parts of an existing machine, apparatus, or process.

Applications for separate

Where a person making application for a patent has included in his specification more than one invention, the Comptroller may

require or allow him to amend such application and specification and drawings or any of them so as to apply to one invention only, and the applicant may make application for a separate patent for any invention excluded by such amendment. **patents by way of amendment.**

Every such last-mentioned application may, if the Comptroller at any time so direct, bear the date of the original application, or such date between the date of the original application and the date of the application in question, as the Comptroller may direct, and shall otherwise be proceeded with as a substantive application in the manner prescribed by the Acts and by these Rules.

Where the Comptroller has required or allowed any application or specification or drawings or any of them to be amended as aforesaid, such application shall, if the Comptroller at any time so direct, bear such date, subsequent to the original date of the application and not later than the date when the amendment was made, as the Comptroller shall consider reasonably necessary to give sufficient time for the subsequent procedure relating to such application.

(2) Where the same applicant has put in two or more provisional specifications for inventions which he believes to be cognate or modifications one of the other and the Comptroller is of opinion that such inventions are not cognate or modifications one of the other, the applicant may divide the complete specification left in connection with his application into such number of complete specifications as may be necessary to enable the application to be proceeded with as two or more separate applications for patents for different inventions.

14. The statement of the invention claimed, with which a complete specification must end, shall be clear and succinct as well as separate and distinct from the body of the specification. **Claims.**

Applications under the International Convention.

15. Every Convention application shall contain a declaration that a foreign application has been made for protection of the invention to which such Convention application relates, and shall specify all the Foreign States or British Possessions in which such foreign applications have been made, and the official date or dates thereof respectively. The application must be made within twelve months from the date of the first foreign application, and must be accompanied by a complete specification, and signed by the person by whom such first foreign application was made or by his legal representative or assignee. **Convention applications.**

Foreign specification, &c., to accompany application.

16. In addition to the specification left with every Convention application a copy or copies of the specification or specifications and drawings or documents filed or deposited by the applicant in the Patent Office of the Foreign State or British Possession in respect of the first foreign application, duly certified by the official chief or head of the Patent Office of such Foreign State or British Possession as aforesaid, or otherwise verified to the satisfaction of the Comptroller, must be left at the Office at the same time as the application or within such further time thereafter not exceeding three months as the Comptroller may allow. If any specification or other document relating to the application is in a foreign language, a translation thereof shall be annexed thereto and verified by statutory declaration or otherwise to the satisfaction of the Comptroller.

An application for extension of time for leaving the copy or copies of the foreign specification or specifications, translations, drawings or documents shall be made on Patents Form No. 5.

Public inspection.

17. If the complete specification left with the application be not accepted within twelve months from the date of the first foreign application, it shall nevertheless be open to public inspection at the expiration of that period.

Proceedings.

18. Save as aforesaid and as provided by Rule 87 all proceedings in connection with a Convention application shall be taken within the times and in the manner prescribed by the Acts or those Rules for ordinary applications.

Drawings (*a*).

General.

19. Drawings, when furnished, should accompany the provisional or complete specification to which they refer, except in the case provided for by Rule 26. No drawing or sketch such as would require the preparation for the printer of a special illustration for use in the letterpress of the specification when printed may appear in the specification itself.

Requirements as to paper, &c.

20. Drawings must be made on pure white, hot-pressed, rolled, or calendered strong paper of smooth surface, good quality, and medium thickness, without washes or colours, in such a way as to admit of being clearly reproduced on a reduced scale by photography. Mounted drawings may not be used.

Size of drawings and arrangement of figures.

21. Drawings must be on sheets which measure 13 inches from top to bottom and are either from 8 inches to 8¼ inches or

(*a*) NOTE.—Copies of Instructions as to the Preparation of Drawings may be had on application to the Patent Office.

from 16 inches to 16½ inches wide, the narrower sheets being preferable. A clear margin must be left half an inch from the edges of the sheet.

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 figure is required, it should be continued on subsequent sheets. There is no limit to the number of sheets that may be sent in, but no more sheets should be employed than are necessary. The figures should be numbered consecutively throughout and without regard to the number of sheets. They should be separated by a sufficient space to keep them distinct.

Drawings to be suitable for reproduction.

22. Drawings must be prepared in accordance with the following requirements :—

(*a*) They must be executed with absolutely black ink.

(*b*) Each line must be firmly and evenly drawn, sharply defined, and of the same strength throughout.

(*c*) Section lines, lines for effect, and shading lines should be as few as possible, and must not be closely drawn.

(*d*) Shading lines must not contrast too much in thickness with the general lines of the drawing.

(*e*) Sections and shading should not be represented by solid black or washes.

(*f*) They should be on a scale sufficiently large to show the invention clearly, and only so much of the apparatus, machine, &c., should appear as effects this purpose. If the scale is given, it should be drawn, and not denoted by words. No dimensions should be marked on the drawings.

(*g*) The figures should be drawn in an upright position in regard to the top and bottom of the sheet.

(*h*) Reference letters and numerals, and index letters and numerals used in conjunction therewith, must be bold, distinct and not less than one-eighth of an inch in height. The same letters or numerals should be used in different views of the same parts. Where the reference letters or numerals are shown outside the figure, they must be connected with the parts referred to by fine lines.

Drawings to bear name of applicant, &c., but no descriptive matter.

23. Drawings must bear the name of the applicant (and, in the case of drawings left with a complete specification after one or more provisional specifications, the numbers and years of the applications) in the left-hand top corner; the number of sheets

of drawings sent, and the consecutive 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. Neither the title of the invention nor any descriptive matter shall appear on the drawings.

Copies of drawings.

24. A facsimile or "true copy" of the original drawings shall be filed at the same time as the original drawings, prepared strictly in accordance with the above Rules, except that the reference letters or numerals and leading lines thereto should be in black-lead pencil. In the case of a hand-made drawing this copy may be on tracing cloth. Where drawings are filed in connection with a Convention application a second "true copy" of the original drawings must be filed.

Marking of originals and true copies.

The words "original" or "true copy" must in each case be marked at the right-hand top corner, under the numbering of the sheet.

Condition of drawings on delivery.

25. Drawings must be delivered at the Office free from folds, breaks, or creases which would render them unsuitable for reproduction by photography.

Provisional drawings used for complete specification.

26. If an applicant desires to adopt the drawings lodged with his provisional specification as the drawings or part of the drawings for his complete specification, he shall refer to them in the complete specification as those left with the provisional specification.

Extension of time for leaving complete Specification.

Extension of time for leaving complete specification.

27. An application for one month's extension of time for leaving a complete specification shall be made on Patents Form No. 6.

Procedure under Section 7 of the Acts.

Power of Comptroller to post-date.

28. If after the leaving of any complete specification the Examiner reports that the nature of the invention is not sufficiently disclosed and defined to enable him to make the investigation prescribed by sub-sect. 1, and the Comptroller requires amendment of the specification and drawings, or any of them, the application shall, if the Comptroller at any time so direct, bear such date, subsequent to its original date and not later than the date when the requirement is complied with, as the Comptroller may consider reasonably necessary to give sufficient time for the subsequent procedure relating to such application.

Provisional report in

29. When the Examiner in prosecution of the investigation prescribed in sub-sect. 1, finds that the invention claimed in the

specification under examination has been wholly claimed or described in one or more specifications within the meaning of the sub-section, he shall, without any further prosecution of the investigation, make a provisional report to that effect. **Case of complete anticipation.**

If the provisional report of the Examiner made under this Rule be not reversed or altered, it may be deemed a final report, and the application shall be dealt with as provided by sub-sect. 4. If, however, such provisional report be reversed or altered, the investigation shall be continued, and a further report shall be made, and the specification shall be dealt with as provided in sub-sect. 3 or sub-sect. 4, as the case may require.

30. The time within which an applicant may leave his amended specification under sub-sect. 2 shall be two months from the date of the letter informing him that the invention claimed has been wholly or in part claimed or described in any specification or specifications within the meaning of sub-sect. 1. **Time for leaving amended specification.**

Application for an extension of time for leaving the amended specification shall be made on Patents Form No. 7, but no such extension of time shall be granted which would extend beyond the date prescribed by the Acts and Rules for the acceptance of the specification, and any fees payable under these Rules for the extension of time for acceptance of a specification shall be paid in addition to the fees for an extension of time under this Rule.

31. When the applicant for a patent has been informed of the result of the investigation of the Examiner, made under the provisions of sub-sect. 1, and the time allowed for amendment of his specification has expired, the Comptroller, if he is not satisfied that no objection exists to the specification on the ground that the invention claimed therein has been wholly or in part claimed or described in a previous specification within the meaning of that sub-section, shall inform the applicant accordingly and appoint a time for hearing him, and shall give him ten days' notice at the least of such appointment. The applicant shall as soon as possible notify the Comptroller whether or not he desires to be heard. The Comptroller shall, after hearing the applicant, or without a hearing, if the applicant has not attended a hearing appointed or has notified that he does not desire to be heard, determine whether reference ought to be made in the applicant's specification to any, and, if so, what prior specification or specifications by way of notice to the public, and in the event of the invention claimed being wholly and specifically claimed in any specification to which the investigation has extended, whether he should refuse to grant a patent, and shall inform the applicant accordingly. As an **Hearing by the Comptroller under sub-sect. 4.**

alternative to the insertion of a reference to a prior specification, the Comptroller may prescribe or permit such amendments of the specification as will be to his satisfaction and, in such case, the applicant must elect, within such time as may be fixed by the Comptroller, whether he agrees to the amendments or to the insertion of a reference. If no communication is received within the prescribed time or such further time as may be allowed, the references will be inserted. Application for an extension of the time fixed by the Comptroller under this Rule shall be made in the manner prescribed in Rule 30.

Reference to prior specification.

32. When under sub-sect. 4 the Comptroller determines that a reference to a prior specification ought to be made by way of notice to the public, the form of reference shall be as follows, and shall be inserted after the claims :—

"Reference has been directed in pursuance of sect. 7, sub-sect. 4, of the Patents and Designs Acts, 1907 and 1919, to specification No. of 1 ."

Where the reference is inserted as the result of a provisional report under Rule 29, a statement to that effect shall be added to the reference.

PROCEDURE UNDER SECTION 8 OF THE ACTS.

Procedure under sect. 8.

33. Where on the extended investigation provided for by sect. 8 of the Acts it appears that the invention claimed in any specification deposited pursuant to an application is wholly or in part claimed in any published specification deposited pursuant to a prior application, the applicant shall be informed of the result of such extended investigation, and shall, within two months from the date of the letter so informing him, apply for leave to amend his specification by way of disclaimer, stating specifically what amendments he is prepared to make in it to remove the objection of anticipation, or if he considers that no amendments are necessary, inform the Comptroller accordingly.

Application for an extension of time for leaving the amended specification shall be made on Patents Form No. 7, but no such extension of time shall be granted which would extend beyond the date prescribed by the Acts and Rules for the acceptance of the specification, and any fees payable under these Rules for the extension of time for acceptance of a specification shall be paid in addition to the fees for an extension of time under this Rule.

The Comptroller shall consider any amendments submitted by the applicant for this purpose, and may allow the necessary amendments to be made.

34. If, at the expiration of the said two months, or such further time as the Comptroller may allow, the Comptroller is not satisfied that the invention claimed by the applicant is not wholly or in part claimed in the specification or specifications cited, he shall inform the applicant accordingly and appoint a time for hearing him, and shall give him ten days' notice at the least of such appointment. The applicant shall as soon as possible notify the Comptroller whether or not he desires to be heard. The Comptroller shall, after hearing the applicant or without a hearing, if the applicant has not attended a hearing appointed, or has notified that he does not desire to be heard, determine whether reference ought to be made in the applicant's specification to any, and if so, what prior specification or specifications by way of notice to the public and shall inform the applicant accordingly. As an alternative to the insertion of a reference to a prior specification, the Comptroller may prescribe or permit such amendments of the specification as will be to his satisfaction and, in such case, the applicant must elect, within such time as may be fixed by the Comptroller, whether he agrees to the amendments or to the insertion of a reference. If no communication is received within the prescribed time or such further time as may be allowed, the references will be inserted. Application for an extension of the time fixed by the Comptroller under this Rule shall be made in the manner prescribed in Rule 30. **Hearing by Comptroller.**

35. When, under sub-sect. 2, the Comptroller determines that reference to a prior specification ought to be made, by way of notice to the public, the form of reference shall be as follows, and shall be inserted after the claims:— **Reference to prior specification.**

"Reference has been directed, in pursuance of sect. 8, sub-sect. 2, of the Patents and Designs Act, 1907 and 1919, to specification No. of 1 ."

36. When, after any accepted specification has been published, any amendment has been made, or any reference inserted therein, under either of the last two preceding Rules, notice thereof shall be advertised in the Journal. **Advertisement of amendments.**

Disclosure of Result of Search.

37. Application for disclosure of the result of a search made under sects. 7 or 8 of the Acts may be made, on Patents Form No. 9, at any time after the acceptance of the specification. **Disclosure of result of search.**

Chemical Inventions.—Typical Samples and Specimens.

38. Where under sect. 2, sub-sect. (5), of the Acts, before the **Chemical**

inventions—Typical samples and specimens.

acceptance of the complete specification left on any application for a patent for a chemical invention, the Comptroller in any particular case considers it desirable to require typical samples or specimens to be furnished, such samples or specimens must, if so required by the Comptroller, be supplied in duplicate.

The fact that such samples or specimens have been furnished shall be notified to the public by a statement to that effect on the complete specification and in connection with the advertisement of acceptance of same in the Journal.

The samples or specimens must, unless other directions are specially given, be supplied in glass bottles of a total height not exceeding 3 inches, and of an external diameter of 1½ inches, and the bottles must be securely closed by well-fitting stoppers, and sealed. Each bottle must have an adhesive or otherwise securely attached label bearing a description which clearly identifies the sample with the substance described in the specification. Labels which are not secured to the bottle by an adhesive should be 3 inches wide and not more than 4 inches long.

Where samples or specimens of colouring matters are required to be supplied, they must be accompanied by samples or specimens of materials printed or dyed with such colouring matters; such last-mentioned samples or specimens must be as flat as possible, and firmly attached to cards 13 inches long by 8 inches broad. The cards must bear a full description of the processes by which the respective dyed or printed effects were produced, including the compositions and strengths of the various baths, the temperatures, duration of treatment, degree of exhaustion of the dye baths, in the case of dyed fabrics the percentage of colouring matter fixed on, in the case of prints the composition of the printing paste, and other necessary information. This description must also clearly identify the substance used with that described in the specification.

Samples of poisonous, corrosive, explosive, or easily inflammable substances must be clearly marked as such.

Acceptance of Specifications.

Extension of time for accepting complete specification.

39. An application for extension of time for accepting a complete specification shall be made on Patents Form No. 8.

Notice and advertisement of acceptance.

40. On the acceptance of a provisional or complete specification the Comptroller shall give notice thereof to the applicant, and shall advertise the acceptance of every complete specification in the Journal.

41. After such acceptance in the case of a complete specification the application and specification or specifications with the drawings (if any) may be inspected at the Office upon payment of the prescribed fee. **Inspection of specification.**

Opposition to Grant of Patent.

42. A notice of opposition to the grant of a patent shall be given on Patents Form No. 10, and shall state the ground or grounds on which the person giving such notice (herein called the opponent) intends to oppose the grant, and must be signed by him. Such notice shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the opponent's interest, the facts upon which he bases his case and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the applicant. **Notice of opposition.** **Copy for applicant.**

43. If the applicant is desirous of contesting the opposition, he shall within 14 days of the receipt of such copies, or such further time as the Comptroller may allow, leave at the Office a counter-statement fully setting out the grounds upon which the opposition is contested and on so leaving shall deliver to the opponent a copy thereof. **Counter-statement.**

44. The opponent may within 14 days from the delivery of such copy, or within such further time as the Comptroller may allow, leave at the Office evidence by way of statutory declarations in support of his case and, on so leaving, shall deliver to the applicant a copy thereof. **Opponent's evidence.**

45. Within 14 days from the delivery of such copy, or if the opponent does not leave any evidence, within 14 days from the expiration of the time within which the opponent's evidence might have been filed, or within such further time as the Comptroller may in either case allow, the applicant may leave at the Office statutory declarations in answer and, on so leaving, shall deliver to the opponent a copy thereof; and within 14 days from such delivery or within such further time as the Comptroller may allow, the opponent may leave at the Office statutory declarations in reply and, on so leaving, shall deliver to the applicant a copy thereof. Such last-mentioned declarations shall be confined to matters strictly in reply. **Applicant's evidence.** **Evidence in reply.**

46. No further evidence shall be left on either side except by leave, or on requisition, of the Comptroller. **Closing of evidence.**

47. Where a document in a foreign language is referred to in any statement or declaration filed in connection with an opposition, an attested translation in duplicate shall be furnished. **Translations of documents in foreign languages.**

Hearing.

48. On completion of the evidence (if any), 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 either party does not desire to be heard he shall forthwith notify the Comptroller to that effect. If either party desires to be heard he must leave Patents Form No. 11 at the Office. The Comptroller may refuse to hear either party who has not left Patents Form No. 11 prior to the date of hearing. If either party intends to refer at the hearing to any publication other than a specification or publication already mentioned in the proceedings, he should give to the other party and to the Comptroller five days' notice at the least of his intention, together with details of each publication to which he intends to refer. After hearing the party or parties desirous of being heard or if neither party desires to be heard, then without a hearing, the Comptroller shall decide the case and notify his decision to the parties.

Costs in uncontested cases.

49. In the event of an opposition being uncontested by the applicant, the Comptroller in deciding whether costs should be awarded to the opponent shall consider whether proceedings might have been avoided if reasonable notice had been given by the opponent to the applicant before the opposition was filed.

Sealing of Patent and Payment of Fee.

Sealing of patent and payment of fee.

50. If the applicant for a patent desires to have a patent sealed on his application, he shall within the period allowed by sect. 12 of the Acts pay the sealing fee by leaving at the Office Patents Form No. 12.

Extension of time for sealing.

51. Where for any reason a patent cannot be sealed within the period allowed by sect. 12, the applicant may apply to the Comptroller on Patents Form No. 13 for an extension of such period not exceeding three months.

Form of Patent.

Form of patent.

52. A patent, except in the cases provided for in Rules 53 and 54, may be in the Form A, in the Third Schedule to these Rules.

Form of patent of addition.

53. A patent of addition may be in the Form B, in the Third Schedule to these Rules.

Form of patent to legal representatives of deceased inventor and others

54. Where a patent is granted to the legal representatives of a deceased inventor, or in any case in which the applicants have asked to be treated for the purpose of the devolution not only of the legal but also of the beneficial interest in such patent as joint tenants, the form of the patent shall be modified so as to

show clearly that the persons to whom the grant is made are to be treated for the purpose of the devolution not only of the legal but also of the beneficial interest in the patent as joint tenants.

Renewal Fees.

Renewal fees.

55. If a patentee intends, at the expiration of the fourth year from the date of his patent or of any succeeding year during the term of the patent, to keep the same in force, he shall before the expiration of such year pay the prescribed annual renewal fee by leaving at the Office Patents Form No. 14. The patentee may pay all or any of such prescribed annual renewal fees in advance. An application for an enlargement of time for payment of any fee under this Rule shall be made on Patents Form No. 15.

Certificate of payment of fee.

56. On due compliance with the terms of Rule 55, the Comptroller shall issue a Certificate that the prescribed payment has been duly made.

Notice as to renewal fees.

57. At any time not less than one month before the date when any renewal fee will become due in respect of any patent, the Comptroller shall send to the patentee or patentees, whose names appear in the Register of Patents, at his or their address or addresses for service, or to the address of the person or persons who paid the last renewal fee, a notice reminding him or them of the date when such fee will become due, and of the consequences of the non-payment thereof.

Restoration of Lapsed Patents.

Restoration of lapsed patents.

58. Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time the patentee may apply to the Comptroller on Patents Form No. 16 for an order for the restoration of the patent. Every such application shall be accompanied by one or more statutory declarations verifying the statements contained in such application. If the Comptroller entertains the application, he shall advertise it in the Journal, and in such other manner as in his opinion is desirable.

Opposition.

59. At any time within two months from the first of such advertisements in the Journal any person may give notice of opposition at the Office on Patents Form No. 17. Such notice shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the opponent's interest, the facts upon which he bases his case and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the applicant.

Further procedure.

60. Upon such notice of opposition being given and copy thereof transmitted to the applicant the provisions of Rules 43 to 49 shall apply to the case, and the further proceedings thereon shall be regulated in accordance with such provisions as if they were herein repeated.

Hearing.

61. If no opposition to the application is entered the Comptroller shall at the expiration of the opposition period appoint a time for hearing the applicant and, if satisfied with the evidence adduced, issue an Order restoring the patent.

Order.

62. In every Order of the Comptroller restoring a patent, provisions shall be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent has been announced as void in the Journal. Such provisions shall restrain the patentee from commencing or prosecuting any action or other proceeding, and from recovering any damage :—

(1) In respect of any infringement of the patent which shall have taken place after the date on which the patent was announced in the Journal to be void and before the date of the order.

(2) In respect of the use or employment at any time thereafter of any mechanism, machine, machinery, process or operation actually made or carried on within the United Kingdom or of the use, purchase, or sale of any article manufactured or made in infringement of the patent after the date of the said announcement and before the date of the order. Provided that such use, purchase, sale, or employment is by the person or corporation by or for whom such machine or machinery or article was bonâ fide manufactured or made, or such mechanism, machine, machinery, process or operation was bonâ fide made or carried on, his or their executors, administrators, successors, or vendees or his or their assigns respectively.

(3) In respect of the use, employment, or sale at any time thereafter by any person or corporation entitled for the time being under the preceding paragraph to use or employ any machine, machinery, mechanism, process, or operation of any improved or additional machine, machinery, mechanism, process, or operation or of the use or sale of any article manufactured or made by any of the means aforesaid in infringement of the patent; provided that the use or employment of any such improved or additional machine, machinery, mechanism, process, or operation shall be limited to the buildings, works or premises existing at the time being or afterwards erected of the person or corporation by or for whom such machine, machinery,

mechanism, process or operation was made or carried on within the meaning of the preceding paragraph, his or their executors, administrators, successors or assigns.

Compensation.

63. The Order shall further provide that if any person within one year after the date thereof make an application to the Board for compensation in respect of money, time, or labour expended by the applicant upon the subject-matter of the patent in the bonâ fide belief that such patent had become and continued to be void, it shall be lawful for the Board, after hearing the parties concerned or their agents, to assess the amount of such compensation if in their opinion the application ought to be granted, and to specify the party by whom and the day on which such compensation shall be paid, and if default shall be made in payment of the sum awarded, then the said patent shall become void, but the sum awarded shall not in that case be recoverable as a debt or damages.

AMENDMENT OF SPECIFICATIONS UNDER SECTION 21 OF THE ACTS.

Request for leave to amend.

64. A request to the Comptroller for leave to amend a specification, except when such request is made under Rules 33 or 34, shall be made on Patents Form No. 18. The request must be accompanied by a duly certified printed copy of the original specification and drawings, showing in red ink the proposed amendment in such manner as to indicate clearly the alteration desired, and shall be advertised by publication of the request and the nature of the proposed amendment in the Journal, and in such other manner (if any) as the Comptroller may in each case direct.

Notice of opposition. Copy for the applicant.

65. A notice of opposition to the amendment shall be on Patents Form No. 19. Such notice shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the opponent's interest, the facts upon which he bases his case and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the applicant.

Further proceedings.

66. Upon such notice of opposition being given and copy thereof transmitted to the applicant the provisions of Rules 43 to 49 shall apply to the case, and the further proceedings thereon shall be regulated in accordance with such provisions as if they were herein repealed.

Requirements on amendment.

67. 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 Office a new specification and drawings as amended, to be prepared in accordance with Rules 6 and 19 to 25.

Advertisement for amendment.

68. Particulars of all amendments of specifications allowed and made under sect. 21 shall be advertised forthwith by the Comptroller in the Journal, and in such other manner (if any) as the Comptroller may direct.

Licences of Right.

Request for indorsement "licences of right."

69. A request to the Comptroller to indorse a patent with the words "licences of right" shall be made upon Patents Form No. 20. Such request shall be accompanied by a statutory declaration and such other evidence as the Comptroller may deem necessary to show that the patentee is not precluded by contract from making such request.

Application for refusal of request.

70. Upon receipt of such request it shall be advertised in the Journal and any person alleging that such request has been made contrary to some contract, in which he is interested, may apply to the Comptroller upon Patents Form No. 21, within one month from the date of the advertisement, for the refusal of the request. Such application shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the applicant's interest, the facts upon which he bases his case, and the relief which he seeks. A copy of the application and of the statement will be transmitted by the Comptroller to the patentee.

Further procedure.

71. Upon such application being made and a copy thereof transmitted to the patentee, the provisions of Rules 43 to 49 shall apply *mutatis mutandis* to the further proceedings thereon.

Application to settle terms of licence.

72. An application to the Comptroller for settlement of the terms of a licence under a patent which has been indorsed "licences of right" shall be made upon Patents Form No. 22. Such application shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the applicant's interest, the facts upon which he bases his case and the terms of the licence which he is prepared to grant or accept. A copy of the application and of the statement will be transmitted by the Comptroller to the patentee or the applicant for the licence, as the case may be. Upon such application being made and copy thereof transmitted to the patentee or applicant for the licence, as the case may be, the provisions of Rules 43 to 49 shall apply *mutatis mutandis* to the further proceedings thereon.

Application for cancella-

73. An application by a patentee for the cancellation of an indorsement under sect. 24 of the Acts shall be made upon

Patents Form No. 23 and shall be advertised by the Comptroller in the Journal and in such other manner, if any, as he deems desirable. Such application should be accompanied by Patents Form No. 14 in respect of the unpaid moiety of all renewal fees which have become due since the indorsement. **tion of indorsement.**

74. At any time within one month from the first of such advertisements in the Journal any person may give notice of opposition at the Office on Patents Form No. 24. Such notice shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the opponent's interest, the facts upon which he bases his case and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the patentee. **Opposition.**

75. Upon such notice of opposition being given and a copy thereof transmitted to the patentee, the provisions of Rules 43 to 49 shall apply *mutatis mutandis* to the further proceedings thereto. **Further procedure.**

Procedure under Section 26 of the Acts.

76. An application for the revocation of a patent under sect. 26 of the Acts shall be made on Patents Form No. 25. Such application shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the applicant's interest, the facts upon which he bases his case and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the patentee. **Application under sect. 26 of the Acts.** **Copy for patentee.**

77. Upon such application being made and copy thereof transmitted to the patentee the provisions of Rules 43 to 49 shall apply *mutatis mutandis* to the further proceedings thereon. **Procedure.**

78. A notice of an offer by a patentee to surrender his patent under sect. 26 of the Acts shall be given on Patents Form No. 26, and shall be advertised by the Comptroller in the Journal and in such other manner, if any, as he deems desirable. **Surrender of patent.**

Procedure under Section 27 of the Acts.

79. An application to the Comptroller for an Order under sect. 27 of the Acts shall be made on Patents Form No. 27 and shall show clearly the nature of the applicant's interest, the facts upon which he bases his case and the relief which he seeks. The application shall be accompanied by statutory declarations verifying the applicant's interest and the facts set out in the application. **Application for compulsory licence or revocation of a patent.**

Advertisement of application.

80. If the Comptroller upon consideration of the application decides that it may proceed, it shall be advertised in the Journal and the applicant shall upon receipt of directions from the Comptroller serve a copy of the application and of the declarations upon the patentee and upon any other persons appearing from the Register to be interested in the patent.

Service of documents.

Counter-statement.

81. The patentee or any person desirous of opposing the application shall within 14 days from the advertisement of the application in the Journal, or such further time as the Comptroller may allow, deliver to the Comptroller a counter-statement verified by a statutory declaration fully setting out the grounds on which the application is opposed. A copy of the counter-statement and of the declaration shall at the same time be delivered to the applicant by the opponent.

Application for hearing.

82. A demand for hearing by any of the parties shall be made upon Patents Form No. 28 which must be left at the Office within 14 days from the date of the delivery of the counter-statement and declaration.

Hearing.

83. Upon receipt of such demand, the Comptroller shall appoint a time for hearing the case and shall give all the parties ten days' notice at the least of such appointment. Any party who does not desire to be heard shall forthwith notify the Comptroller to that effect. Every person who desires to be heard, except the person applying for the hearing, must leave Patents Form No. 11 at the Office, and the Comptroller may refuse to hear any person who has not left Patents Form No. 11 prior to the date of the hearing. If no application for a hearing has been received from any party and the Comptroller is of opinion that a hearing is necessary, he shall appoint a time for hearing the case and the procedure shall be the same as that set out above. After hearing the party or parties, or without a hearing if no hearing is necessary, the Comptroller shall decide the case and notify his decision to the parties.

Application by licensee to surrender a licence under sect. 27 (3) (a).

84. An application by an existing licensee, under a patent which has been indorsed "licences of right" under the provisions of sect. 27, sub-sect. 3 (*a*) of the Acts, or an Order of the Comptroller entitling the licensee to surrender his licence in exchange for a licence to be settled by the Comptroller, shall be made upon Patents Form No. 22 as provided in Rule 72, and the further proceedings thereon shall be regulated in accordance with the provisions contained in Rule 72 as if it were herein repealed.

PATENTS FOR FOOD OR MEDICINE.

Patents for food or medicine.

85. An application to the Comptroller under sect. 38A (2) of the Acts for a licence to use an invention for the purposes of the preparation or production of food or medicine shall be made on Patents Form No. 29. The procedure to be followed shall be the same as that prescribed in Rules 79 to 83 for an application under sect. 27 of the Acts.

REGISTER OF PATENTS.

Entry of grant.

86. Upon the sealing of a patent the Comptroller shall cause to be entered in the Register of Patents the name, address, and nationality of the patentee as the grantee thereof, the title of the invention, the date of the patent, and the date of the grant thereof, together with the address for service.

Entry in respect of Convention application.

87. The patent granted on any Convention application shall be entered in the register 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. The date of the application in this country shall also be entered in the register.

Alteration of address.

88. If a patentee send to the Comptroller on Patents Form No. 30 notice in respect of a patent of an alteration in his name or address or address for service, the Comptroller shall cause the register to be altered accordingly, and may require the altered address to be in the United Kingdom.

Application for entry of subsequent proprietorship.

89. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to any interest therein, as mortgagee or licensee, application for the entry in the register of his name as proprietor or part proprietor of the patent, or of a notice of such interest, as the case may be, shall be made on Patents Form No. 32 or Patents Form No. 33, as the case may be, and shall in the case of individuals be made and signed by the person requiring to be registered as proprietor or part proprietor, or by his agent, and in the case of a body corporate by its agent.

Form and signature of request.

Production of documents of title and other proof.

90. 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 application, except such documents as are matters of record in the United Kingdom, shall, unless the Comptroller in his discretion otherwise directs, be produced to him together with the application, and he may call for such other proof of title or written consent as he may require for his satisfaction.

As to a document which is a matter of record in the United Kingdom, an official or certified copy thereof shall in like manner be produced to the Comptroller.

Copies for office.

91. The application shall be accompanied by an attested copy of the assignment or other document or copy above required to be produced.

Entry of notice of interest.

92. The notice of interest in the patent of any person other than the proprietor or part proprietor entered in the register in pursuance of the application shall be such as may appear applicable to the circumstances of the particular case.

Entry of notification of document.

93. Application for entry in the Register of notification of any document (not already provided for) purporting to affect the proprietorship of a patent shall be made on Patents Form No. 34. Such application shall be accompanied by an attested copy of the document, the accuracy of such copy being certified as the Comptroller may direct, and the original document shall at the same time be produced and left at the Office if required for further verification.

Entry of date of payment of fees on issue of certificate.

94. Upon the issue of a certificate of payment under Rule 56, the Comptroller shall cause to be entered in the register a record of the date of payment of the fee on such certificate.

Hours of inspection of register.

95. The register of patents shall be open to the inspection of the public on every day on which the Office is open to the public during the time it is so open except at such times when the register is required for any purpose of official use.

Correction of Clerical Errors.

Correction of clerical errors.

96. A request for the correction of a clerical error in or in connection with an application for a patent, or in any patent or specification, or in any matter which is entered upon the register of patents, shall be made on Patents Form No. 35.

Certificates.

Certificates and certified copies of documents.

97. A request for a certificate of the Comptroller as to any entry, matter or thing which he is authorised by the Acts or any of these Rules to make or do, shall be made on Patents Form No. 36.

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 Office, or of or from registers and other books kept there, may be furnished by the Comptroller on payment of the prescribed fee.

Secret Patents.

Secret patents.

98. When it has been decided by the Admiralty, Secretary of State for War or the President of the Air Council that it is advisable to take out a secret patent for any invention assigned under sect. 30 of the Acts, and an application for such patent has been made on Patents Form No. 1D, accompanied by a certificate of the Admiralty, Secretary of State or the President of the Air Council under sect. 30 (3) of the Acts, the Comptroller shall not communicate the application or any documents relating thereto to any member of his staff other than a deputy or special examiner or examiners, who shall make the required investigations and reports required by the Acts to be made in the case of other applications for patents.

Unless and until such invention is re-assigned to the inventor by the Admiralty, Secretary of State or the President of the Air Council—

(1) No copy of any specification or any other document or drawing relating thereto shall in any manner whatever be published or open to the inspection of the public.

(2) The application for the patent, and the acceptance of any specification relating to the invention shall not be advertised, nor shall the grant of the patent for such invention be open to opposition under sect. 11 of the Acts; but the Comptroller shall cause a patent to be sealed in respect of every such invention as soon as may be after the acceptance of the complete specification relating thereto.

(3) Every such secret patent shall be registered in a confidential register at the Office, and no details or particulars relating thereto shall at any time be published as required by the Acts for ordinary patents. Nor shall any entry be made in the ordinary Register of Patents in respect of any such patent or any assignment thereof.

(4) No fees shall be payable in respect of any secret patent, and every such patent, notwithstanding the non-payment of such fees, shall remain in force for the full period of 16 years from its date.

Certificate of secrecy after application.

99. When an application has been made otherwise than as provided by the last preceding rule for a patent for an invention, and such application is still pending, and a certificate under sect. 30 (3) of the Acts is furnished to the Comptroller by the Admiralty, Secretary of State or the President of the Air Council,

the provisions of such rule shall, so far as is practicable, having regard to the date of such certificate, apply to such application and to all documents relating thereto.

Re-assignment.

100. In the event of any secret patent being re-assigned to the inventor by the Admiralty, Secretary of State or the President of the Air Council, it shall be removed from the Confidential Register of secret patents; all fees that would have been thereafter payable if the same had not been a secret patent shall be paid in respect thereof; and the patent shall remain in force only for the same term, and subject to the same conditions as to payments o fees and otherwise as if it had not been a secret patent.

Lost Patent.

Lost patent.

101. An application for a duplicate of a patent which has been lost or destroyed shall be made on Patents Form No. 37, and in accordance with the directions thereon.

Industrial or International Exhibitions.

Industrial or international exhibitions.

102. 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, may, after the Board have issued a certificate that the exhibition is an industrial or international one, give to the Comptroller notice on Patents Form No. 38 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 inventor 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.

Publication of Inventions before Learned Societies.

Publication of inventions before learned societies.

103. Any person desirous of publishing an invention by reading a paper before a learned Society or of permitting publication of the paper in such Society's transactions may give the Comptroller notice on Patents Form No. 38 of his intention to publish the invention as provided in Rule 102.

Exercise or Discretionary Powers by the Comptroller.

Exercise of discretionary

104. Before exercising any discretionary power given to the Comptroller by the Acts or these Rules 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. **powers by Comptroller. Notice of hearing.**

105. Within five days from the date on which such notice would be delivered in the ordinary course of post, or such longer time as the Comptroller may appoint in such notice, the applicant shall notify in writing to the Comptroller whether or not he intends to be heard upon the matter. **Notice by applicant.**

106. Whether the applicant desires to be heard or not, the Comptroller may at any time require him to submit a statement in writing within a time to be notified by the Comptroller, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require. **Comptroller may require statement, &c.**

107. 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 to any other person who appears to him to be affected thereby. **Decision to be notified to parties.**

Statutory Declarations and Affidavits.

108. The statutory declarations and affidavits required by these Rules, or used in any proceedings thereunder, shall be headed in the matter or matters to which they relate and shall be drawn up in the first person, and shall be divided into paragraphs consecutively numbered, and each paragraph shall so far as possible be confined to one subject. Every statutory declaration or affidavit shall state the description and true place of abode of the person making the same, and shall be written, typed, lithographed or printed bookwise and shall bear the name and address of the person leaving it and shall state on whose behalf it is left. **Form, &c., of statutory declaration and affidavit.**

109. The statutory declarations and affidavits required by the Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows:— **Manner in which, and persons before whom, declaration or affidavit is to be taken.**

(*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 His 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 His 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 before a notary public, or before a judge or magistrate.

GENERAL.

Power of amendment, &c.

110. Any document for the amending of which no special provision is made by the Acts may be amended, and any irregularity in procedure, which in the opinion of the Comptroller may be obviated without detriment to the interests of any person, may be corrected, if and on such terms and in such manner as the Comptroller may think fit.

General power to enlarge time.

111. The times prescribed by these Rules for doing any act, or taking any proceeding thereunder, other than the times prescribed by Rules 16 and 55, may be enlarged by the Comptroller if he thinks fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

Days and hours of business.

112. The Office shall be open to the public every weekday except Saturday between the hours of ten and four, and on Saturday between the hours of ten and one, except on the days following:—

Christmas Day, Good Friday, the day observed as His Majesty's birthday, the days observed as days of public fast or thanksgiving, or as holidays at the Bank of England, and days which may from time to time be notified by a placard posted in a conspicuous place at the Office.

Excluded days.

113. Whenever the last day fixed by the Acts, or by these Rules, for doing any thing shall fall on a day when the Office is not open or on a Saturday, which days shall be excluded days for the purposes of the Acts and these Rules, it shall be lawful to do any such thing on the day next following such excluded day, or days if two or more of them occur consecutively.

Powers to dispense with evidence, signature, &c.

114. 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 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 to make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, and upon the production of such other evidence, and

subject to such terms as he may think fit, to dispense with any such act or thing, document, declaration, or evidence.

Applications to and Orders of Court.

115. *Four clear days' notice of every application to the Court* under sect. 72 of the Acts for rectification of the register of patents shall be given to the Comptroller. **Applications to Court.**

Where any Order has been made by the Court under the Acts revoking a patent or extending the term of a patent, or allowing a patentee to amend his specification or affecting the validity or proprietorship of a patent or any rights thereunder, the person in whose favour such order has been made shall forthwith leave at the Office an office copy of such order together with Patents Form No. 39. The specification shall thereupon be amended or the register rectified or the purport of such Order shall otherwise be duly entered in the register as the case may be. **Orders of Court.**

Repeal.

116. All general rules relative to Patents heretofore made by the Board of Trade under the Patents and Designs Act, 1907, and in force on the 31st day of March, 1920, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to anything done under such rules, or to any application or other matter then pending. **Repeal.**

Dated the 25th day of February, 1920.

A. C. Geddes,
President of the Board of Trade.

SCHEDULES. Sect. 65.

FIRST SCHEDULE.

FEES ON INSTRUMENTS FOR OBTAINING PATENTS AND RENEWAL.

(a) Up to sealing.

	£	s.	d.	£	s.	d.
On application for provisional protection	1	0	0			
On filing complete specification	3	0	0			
				4	0	0
or						
On filing complete specification with first application				4	0	0
On the sealing of the patent in respect of investigations as to anticipation				1	0	0

(b) *Further before end of four years from date of patent.*

	£	s.	d.
On certificate of renewal	50	0	0

(c) *Further before end of eight years from date of patent.*

On certificate of renewal	100	0	0

Or in lieu of the fees of £50 and £100 the following annual fees :—

Before the expiration of the	4th	year	from	the	date	of	the	patent...	10 0 0
" "	5th	"	"	"	"	...			10 0 0
" "	6th	"	"	"	"	...			10 0 0
" "	7th	"	"	"	"	...			10 0 0
" "	8th	"	"	"	"	...			15 0 0
" "	9th	"	"	"	"	...			15 0 0
" "	10th	"	"	"	"	...			20 0 0
" "	11th	"	"	"	"	...			20 0 0
" "	12th	"	"	"	"	...			20 0 0
" "	13th	"	"	"	"	...			20 0 0

FORMS IN PROCEEDINGS IN AN ACTION FOR INFRINGEMENT.

Indorsement on Writ.

The plaintiff claims :—

(1) An injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's letters patent No. of .

(2) Damages for such infringement.

(3) That the defendant be ordered to deliver up to the plaintiff or to destroy all articles made in infringement of the said letters patent, and in the defendant's possession or power.

(4) Costs.

Notice of Motion for Interlocutory Injunction.

In the High Court of Justice.
Chancery 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 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.

Interlocutory Order to Restrain Infringement of Patent.

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. under 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 explanding 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.

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.

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, and/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 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 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 the costs of this application may be costs in the action (*a*).

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 said defendants, and that the said machines or/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.

(*a*) *Flower* v. *Lloyd*, 1876, A. 1254; as to inspection, see p. 354 *et seq.*

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 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" (*b*).

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 defendant in his 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 (*c*).

(*b*) *The Germ Milling Co.* v. *Robinson*, 55 L. J. Ch. 287; 3 R. P. C. at p. 14.

(*c*) 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 primâ 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

Order for Inspection of Defendants' Process by Experts.

Let I. and C., of, &c., be at liberty at all seasonable 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 (*d*) 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 (*e*).

Statement of Claim.

1. The plaintiff is the registered legal owner of letters patent No. , granted to him in respect of an invention entitled " ."

2. The defendant has infringed and threatens to infringe the said letters patent in the manner appearing in the particulars of breaches delivered herewith.

3. The plaintiff claims:—

(1) An injunction to restrain the defendant, his servants and agents, from infringing the said letters patent.

(2) An inquiry as to the damages sustained by the plaintiff by reason of such infringement.

(3) That the defendant may be ordered to deliver up forthwith to the plaintiff all articles in his possession or power made

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. *Kynoch*, 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.

(*d*) 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.

(*e*) *Flower* v. *Lloyd*, C. A., 5th July, 1876, A. 1254.

in infringement of the said letters patent, or that the said articles may be ordered to be destroyed.

(4) Costs.

Signed
Delivered.

[*Plea to be used where specification has been amended*].

On the day of the plaintiff applied at the Patent Office for leave to amend the specification describing the said invention, and such leave was duly granted on the day of (*or* on the day of in an action entitled the Hon. Mr. Justice granted to the patentee leave to amend his complete specification). The specification as originally filed was framed in good faith and with reasonable skill and knowledge.

[*To be used where a certificate of validity has been granted in a previous action.*]

The plaintiff claims full costs, charges and expenses as between solicitor and client. In an action brought by the plaintiff against X. for infringement, Mr. Justice certified that the validity of the patent came into question.

Particulars of Breaches.

FORM 1.

In the High Court of Justice,
Chancery Division.

Between A. B. . . . . Plaintiff,
and
C. D. . . . . Defendant.

The following are the particulars of the breaches complained of in the statement of claim herein :—

1. The defendant on or about the day of at his 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 all of the claiming clauses in the specification 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 plaintiffs' patent, and in infringement of all the claiming clauses

thereof. The plaintiff will rely upon this sample as an instance of the type of the infringement committed by the defendants.

Signed.

Delivered the day of .

To

Defendant's solicitor.

Particulars of Breaches.—Where two or more types of Infringement complained of.

FORM 2.

[*Formal parts as above.*]

1. The defendant, between the days of and or thereabouts, manufactured at his factory at , in the county of , sewing machines, which sewing machines contained shuttles which are infringements of the third claiming clause of the complete specification of the plaintiff's patent.

The defendant, on or about the day of , at his shop at , in the county of , sold a sewing machine which contained such a shuttle to .

The plaintiff will rely upon this machine as an instance of this type of infringement committed by the defendant.

2. The defendant, on or about the day of , in his workshop at , in the county of , by himself, his servants or agents, manufactured sewing machines, which sewing machines contain parts for bobbin-winding which are an infringement of the fifth claiming clause of the complete specification of the plaintiff's patent.

The defendant, on or about the day of , at his shop at , sold a sewing machine, which contained a bobbin-winding apparatus, to .

The plaintiff will rely upon this machine as an instance of this type of infringement committed by the defendant.

Defence and Counterclaim.

[N.B.—*One set of Particulars of Objections will serve Defence and Counterclaim.*]

In the High Court of Justice,

Chancery Division.

Mr. Justice .

Between A. B. . . . . Plaintiff,

and

C. D. . . . . Defendant.

1. The defendant denies that the plaintiff is the legal owner of the letters patent sued on.

2. If the defendant has manufactured (sold *or* used) the articles (*or* process) as alleged in the particulars of breaches, the same were manufactured (sold *or* used) by leave and licence of the patentee under the following circumstances :—(*set forth particulars*).

3. The defendant has not infringed the said letters patent as alleged, or at all.

4. The said letters patent are invalid for the reasons appearing in the particulars of objections delivered herewith.

5. At the date of the said letters patent the apparatus made by the defendant and complained of in this action was not novel (*f*).

6. The defendant will rely as a defence upon the fact that in a contract dated the day of and made between the patentee of the one part and of the other part, which contract was in force when this action was commenced, there existed the following conditions, which have been rendered void by the Statute 7 Ed. VII. c. 29, p. 38 (*g*):—

(*Set forth the objectionable clauses.*)

7. As an answer to the plaintiff's claim for damages, the defendant will rely upon the fact that at the date of the alleged infringement, he was not aware nor had he reasonable means of making himself aware of the existence of the plaintiff's letters patent.

Counterclaim.

The defendant repeats paragraph 4 of his defence and counterclaims for revocation of the plaintiff's letters patent.

The defendant is entitled to counterclaim for revocation by reason that :—

(a) The defendant is duly authorised by His Majesty's Attorney-General for England.

(b) The letters patent sued on were obtained in fraud of the defendant's rights (*or* in fraud of the rights of X. through whom the defendant claims). Particulars of the said fraud are as follows :—(*set them forth*).

(c) The defendant (or X., through whom the defendant claims an interest in the business of carried on at) had prior to the date of the said letters patent publicly manufactured (sold *or* used) the articles as claimed in the

(*f*) See p. 119. (*g*) See p. 331.

claiming clauses (No.) of the specification of the said letters patent, as set forth in paragraph of the particulars of objections delivered herewith.

Particulars of Objections in an Action for Infringement or Petition for Revocation.

In the High Court of Justice,
Chancery Division.
Mr. Justice .
Between A. B. . . . . Plaintiff,
and
C. D. . . . . Defendant.
(*Or Title of Petition.*)

Take notice, that the defendant (*or* petitioner) will, on the trial of this cause, rely on the following objections to the validity of the letters patent sued upon :—

1. The said (*name the original patentee*) was not the true and first inventor of the alleged invention. The true and first inventor thereof was J. S. of .

2. The said alleged invention was not new at the date of the said letters patent. It had been published:—

(a) By the public manufacture (sale *or* use) of (*articles*) constructed in accordance with the said invention from the year to the present day at by the defendant (*or some other, naming him*) of . Articles so manufactured are now in existence and may be inspected by the plaintiff at .

(b) By the public manufacture (sale *or* use) of (*articles*) constructed in accordance with the said invention from the year to the at by J. S. of . The said articles are no longer in existence. A description and drawings of the said articles are delivered with these particulars.

(c) By the public manufacture (sale *or* use) of (*product*) by means of the patented process at by of from the year until the year . A description of the said process and drawings of the apparatus used accompanies these particulars. The process is no longer in use, but the apparatus is in the possession of . The defendant will endeavour to obtain inspection of the apparatus by the plaintiff.

(d) By the deposit in the Patent Office Library of the follow-

ing specification of letters patent granted in foreign countries:—

Name.	Date and Number.	Country.	Claims of plaintiffs' specification against which relied on.

(e) By the publication of the following specifications of British letters patent.

Name.	Date and Number.	Parts relied on.	Claims of plaintiffs' specification against which relied on.

(f) By the deposit in the Library of the British Museum in the year of a work bearing the title " " by and in particular by the passage commencing at p. l. and ending at p. l. .

3. The said alleged invention was not proper subject-matter for letters patent having regard to the common general knowledge at the date thereof. The defendant will rely upon the specifications set forth under paragraph 2 hereof as part of the common general knowledge of the art.

4. The said alleged invention was not useful.

5. The specification is insufficient to enable the invention properly to be carried into effect. The plaintiffs will rely upon the passage p. l. to p. l. , wherein no sufficient directions are given for (*state particulars of insufficiency*).

6. The specification gives directions which are misleading and dangerous. If the directions on p. , l. to p. , l. are carried out an explosion is liable to occur (*or other reasons*).

7. The claims of the said specification (and claim—in particular) do not sufficiently define the monopoly which the patentee intends to claim.

8. The subject-matter of the said letters patent was the subject-matter of a prior grant of letters patent to J. S., dated and numbered which letters patent were and are good and valid

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Order for Further and Better Particulars of Objections.

Let the defendants on or before the day of deliver to the plaintiffs further and better particulars of the matters alleged in paragraph of the particulars of objections giving:—

(a) A description, accompanied by drawings, of the prior user alleged.

(b) The names and addresses of the persons by whom the articles mentioned are alleged to have been manufactured.

(c) The claims against which each of the prior publications alleged.

(d) The pages of the prior publications relied on.

And in default of the delivery of such particulars let the said paragraph be struck out.

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 the plaintiff's cost 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 (*h*).

Notice of Motion for Leave to amend Specification where Action for Infringement, or Petition for Revocation Pending.

In the High Court of Justice,
Chancery Division.
Mr. Justice

(*Title of action or petition.*)

Take notice that this Honourable Court will be moved on at o'clock or soon thereafter as counsel can be heard, by

(*h*) See *Baird* v. *Moules, &c., Co.*, L. R. 17 Ch. D. 139, n.

counsel on behalf of the plaintiff (*or* respondent) that the plaintiff (*or* respondent) be granted leave to amend the complete specification upon which his letters patent No. of were granted, by (*state nature of amendment*) as indicated in red ink in the King's Printer's copy of the specification delivered herewith.

Order allowing Application to amend to Proceed.

This motion coming before the Court on the day of and upon hearing counsel for the plaintiff (*or* respondent) and counsel for the defendant (*or* petitioner), and upon reading the copy of the specification with the proposed amendments indicated thereon the Court doth order that the application of the plaintiff (*or* respondent) be allowed to proceed and that this motion shall stand for hearing in the non-witness (witness) list on the day of (*fix date late enough to allow of applicant fulfilling requirements of Ord. LIII*A., r. 23), and the plaintiff (*or* respondent) shall within . days deliver to the defendant (*or* petitioner) copies of the affidavits in support of his application; and the defendant (*or* petitioner) shall within days of such delivery deliver to the plaintiff (*or* respondent) copies of his affidavits in answer; and in the event of any third party giving notice of opposition to the amendment in accordance with the Statute and Rules in that behalf made and provided the plaintiff (*or* respondent) shall within days of receipt of such notice deliver to such person copies of the affidavits in support of his application, and such person shall within days of such delivery deliver to the plaintiff (*or* respondent) and to the defendants (*or petitioners*) copies of his affidavits in opposition, and within days of such delivery the plaintiff (*or* respondent) shall deliver to such person copies of his affidavits in reply to the opposition.

And the costs of this motion up to and including this order shall be the defendant's (*or* respondent's) costs in the cause (*or as directed*).

Final Order allowing Amendment of the Specification on Terms.

This motion coming on for final hearing in the non-witness list on the day of and upon hearing counsel on behalf of the plaintiff (*or* respondent), counsel on behalf of the defendant (*or* petitioner), and counsel on behalf of A. B. an opponent to the opposition, and counsel on behalf of C. D. an opponent and counsel on behalf of the Comptroller-General of Patents and upon reading

the specification and proposed amendments and the pleadings and particulars in the action (*or* petition) of and the affidavits of P., Q., S., T., and R., and upon the plaintiffs (*or* respondents) undertaking to seek no relief from the defendants (*or* petitioners) or from purchasers from them in respect of anything done prior to the date of the notice of motion on this application the Court doth Order that the said specification be amended by (*state amendment*); and it is Ordered that the plaintiffs (*or* respondents) pay to the defendants (*or* petitioners) and the Comptroller-General their costs of this application, and that the opponents A. B. and C. D. (*costs as directed*). And it is Ordered that the defendant may within days amend his defence and particulars of objections (and the petitioner shall within days hereof elect whether he shall withdraw his petition and in the event of such withdrawal the respondent shall pay to the petitioner his costs of the petition up to the date of such withdrawal *or as directed*).

Minutes of Judgment for Plaintiff in Default of Defence, Order for Inquiry as to Damages, Injunction and Costs.

Let the defendants, Robert F. Chisholm and Joseph Lawrence, trading as R. F. Chisholm and Co., their servants and agents, be restrained during the continuance of the letters patent, No. 14,563 of 1890, and any extension thereof, from infringing the said letters patent, of which the plaintiff company are owners. Let an inquiry be made as to the damages sustained by the plaintiff company by reason of the infringement of the said letters patent by the defendants. Order payment by the defendants of the amount awarded within fourteen days after such amount has been ascertained. Let the defendants deliver up to the plaintiffs all tyres and parts of tyres in their possession or power made in infringement of the said letters patent. Let it be referred to the taxing master to tax the plaintiffs' costs of this action up to and including this judgment as between solicitor and client. Let the costs of the inquiry as to damages be reserved. Liberty to apply (*i*).

(*i*) *Pneumatic Tyre Co.* v. *Chisholm*, 13 R. P. C. at p. 489.

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 of 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, records 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 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

Evidence.

Certificate.

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 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 mere 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

Payment of amount.

Destruction.

of the defendants, do 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. **Full costs.** **Liberty to apply.**

W. C.

Entered.
G. L.

Registrar's Office, Entering Lib. B. Seal.

Certificates necessary under Order LIIIa., Rule 22.

[*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, in 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, in the circumstances, reasonable and proper.

Certificate of Validity under Sect. 35 of the Patents and Designs Act, 1907.

I hereby certify, pursuant to the 35th section of the Patents and Designs Act, 1907, that upon the trial of this action, the validity of the letters patent (*or* that the validity of Claim 3 of the specification of the letters patent) in the pleadings mentioned, dated the day of , and numbered , granted to , (amended by disclaimer allowed the day of ,) and now vested in , came into question.

Dated this day of .

Signature of Judge .

FORMS IN AN ACTION TO RESTRAIN THREATS.

Indorsement on Writ.

The plaintiff's claim is:—

Injunction. 1. For an injunction restraining the defendant from, by circulars, advertisements, or otherwise, threatening with legal proceedings or liability persons manufacturing, using, or selling stoves invented by the plaintiff, alleging the same to be infringements of letters patent in which the defendant claims an interest. The said threats being to the prejudice of the plaintiff.

Damages. 2. For damages in respect of the injury sustained by the plaintiff by reason of the circulars, advertisements, or other threats of the defendant.

Interlocutory Injunction to restrain Threats.

A particular circular. 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 (*j*).

[*Another Form.*]

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 liability in respect of the following papers manufactured by the plaintiff (*k*).

Form of Injunction.

This Court does order and adjudge that the defendants *Parker and Smith*, their agents, travellers, and servants, be perpetually restrained from threatening the plaintiff or his customers with legal proceedings for the alleged infringement by him or them of the defendants' letters patent No. , of , by reason of the manufacture, sale, or use, of the plaintiff's hair-binder, known as

(*j*) *Challender* v. *Royle*, L. R. 36 Ch. D. 425.

(*k*) *Colley* v. *Hart*, 6 R. P. C. 17.

the "Peigne Attache" or "Simple Attache" hair-binder (being the exhibit V. M. 1 produced to the plaintiff at the trial), and from circulating, by letters, advertisements, or other means any statements to the effect that the plaintiff's said hair-binder is made in infringement of the defendants' said letters patent (*l*).

FORMS IN A PETITION TO THE HIGH COURT FOR REVOCATION.

Petition of Revocation.

In the High Court of Justice,
Chancery Division,
In the matter of letters patent granted to of , dated , and numbered , and in the matter of the Patents and Designs Act, 1907, sect. 25.

To his Majesty's High Court of Justice.

The humble petition of
SHEWETH as follows:—

1. Your petitioner is duly authorised by his Majesty's Attorney-General in England to present this petition (*if so, if not,* your petitioner claims to be entitled to present this petition by reason of the matters appearing hereafter in paragraphs 7 *or* 8, *which set forth the circumstances*).

2. Your petitioner is a manufacturer of cigar cases, and has gained a high reputation in the trade and with the public for his goods. Your petitioner has recently commenced to manufacture and has entered into contracts with retailers to supply to them quantities of cigar cases made with spring clips to hold each cigar in place.

3. The respondent is a manufacturer of cigar cases who carries on his manufacture at , in Belgium, and thence imports large numbers of cigar cases to his place of business at , Fleet Street, London.

4. The respondent claims to have a monopoly in the right to manufacture and sell cigar cases with spring clips of whatever construction, and bases his claim upon letters patent granted to him on the day of , and numbered , of .

5. The said letters patent are wholly invalid by reason of the matters set forth in the particulars of objections accompanying this petition.

6. By reason of the wide and comprehensive claims made in the

(*l*) *Mountain* v. *Parker and Smith*, 20 R. P. C. at p. 774.

specification, the retailers are afraid to purchase the goods manufactured by your petitioner and some have asked to be released from their contracts.

7. The said letters patent were obtained in fraud of the rights of your petitioner:—On the day of your petitioner purchased from J. S. his goodwill and business of manufacturing cigar cases, together with the right to join with him in applying for letters patent for an invention which was the same as the invention subsequently patented by the respondent. The respondent was at the time an employee of the said J. S. and applied for and obtained the said grant of letters patent without the consent of the said J. S. or of your petitioner (*or other allegations of fraud*).

8. Prior to the date of the said letters patent your petitioner had publicly manufactured and sold articles constructed according to the alleged invention subsequently patented by the respondent (as set forth in the particulars of objections accompanying this petition).

The form of Particulars of Objections is similar to that used in an action for infringement.

FORMS USED IN OBTAINING THE FIAT OF THE ATTORNEY-GENERAL.

The Memorial of the Petitioner (*m*).

In the matter of the Patents and Designs Act, 1907,

and

In the matter of letters patent granted to A. B. for an invention entitled No. of .

(*Set forth in numbered paragraphs all the matters alleged in the petition, amplifying them in detail. It is desirable that a bonâ fide statement should be made as to the state of affairs, and the memorial is not to be treated as in the nature of a mere pleading. Set forth also matters of this kind.*)

1. On the day of , the said (*naming the respondent*) commenced an action for infringement of the said letters patent against your memorialist, and on the day of , Mr. Justice gave judgment pronouncing the said letters patent invalid, but holding that had they been valid the articles manufactured by your memorialist would have infringed them.

(*m*) On Judicature paper.

2. Your memorialist is the grantee of letters patent No. of , for an invention entitled , the infringement alleged in the hereinbefore-mentioned action (which was admitted) consisted in manufacturing cigar cases in accordance with the specification of the said letters patent of , and it is impossible to use your memorialist's said invention of without infringing the said letters patent of (*naming the respondent*), assuming the said letters patent to be valid. **Grantee of letters patent.**

3. 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, by reason of licences granted to them by the said (*respondent*), can purchase from your memorialist cigar cases made in pursuance of his said letters patent of . **Hampered in trade.**

4. The following documents are sent herewith :— **Documents.**

The specification of A. B. No. of 19 .
C. D. No. of 19 .
E. F. No. of 19 .
Copy writ, pleadings, and objections in the action.
Copy judgment of Mr. Justice , dated .

5. Your memorialist humbly requests you will authorise him to petition the Court for revocation of the said letters patent of (*the respondent*) of . **Application.**

Declaration of Applicant verifying Statements in his Memorial to his Majesty's Attorney-General (*n*).

In the matter of the Patents and Designs Act, 1907,
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 his Majesty's Attorney-General of England (*or* Ireland, *or* Lord Advocate of Scotland), are true as therein set forth.

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.

And I make this solemn declaration conscientiously believing

(*n*) On Judicature paper.

the same to be true and by virtue of the provisions of the Statutory Declarations Act, 1835.

Declared at .

Certificate of Solicitor (*o*).

In the matter of the Patents and Designs Act, 1907,

and

In the matter of letters patent granted to for an invention entitled No. , dated .

Between A. B. . . . Petitioner,

and

C. D. . . . 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.

FORMS IN PETITION FOR EXTENSION OF TERM OF PATENT

(See Ord. LIIIa., R. 3).

Advertisement of Intention to present Petition.

In the High Court of Justice,
Chancery Division.
Mr. Justice Sargant.
In the matter of the Patents and Designs Act, 1907,

and

In the matter of letters patent granted to , of , and bearing date the of , and numbered .

Notice is hereby given that it is the intention of to present a petition to the High Court of Justice praying that the term of the said letters patent may be extended. And notice is further given that on the day of at , or so soon thereafter as counsel may be heard, the said intends to apply to the Court for a day to be fixed before which the petition shall not be in the paper for hearing. Notices of objection must be lodged before the date above mentioned at the chambers of Mr. Justice Sargant, Room No. . Documents requiring service upon the said

(*o*) On foolscap.

pursuant to the Rules of the Supreme Court, Order LIIIA., rule 3, may be served at the office of the solicitor to the said .

Dated this day of .

Solicitor to the said .

Address for service .

Petition.

In the High Court of Justice,

Chancery Division.

Mr. Justice Sargant.

In the matter of the Patents and Designs Act, 1907,

and

In the matter of letters patent dated the day of , numbered and granted to A. B., of , for the invention of "."

To his Majesty's High Court of Justice.

The humble petition of A. B., of , and of C. D. of , SHEWETH as follows:—

1. On the day of letters patent numbered , were granted to your petitioner A. B., for an invention entitled

2. Your petitioner C. D. has become entitled to a half share in the said letters patent under the circumstances hereinafter appearing.

SET FORTH (a) *The history of the Art with special reference to the invention.*

(b) *The special utility and advantages of the invention.*

(c) *The circumstances under which the patent was obtained and the rights of C. D. created.*

(d) *All information relating to foreign patents.*

(e) *The rights of third parties, such as licensees, etc.*

(f) *The difficulties with which the patentee has had to contend in getting his invention taken up.*

(g) *The fact of insufficient remuneration, generally stated without special reference to accounts.*

Your petitioners have given public notice by advertisement caused to be inserted in the "London Gazette" and in metropolitan and provincial newspapers pursuant to the rules in such cases made and provided, that it is their intention to apply to this Honourable Court for an extension of the term of the said letters patent.

Your petitioners therefore humbly pray that the said letters patent may be extended for a further term of fourteen years, or for such other term as to this Honourable Court shall seem fit.

And your petitioners will ever pray, &c.

Affidavit as to Advertisements.

[*Heading as above.*]

I, of , solicitor, make oath and say as follows :—

1. I am acting as solicitor for the petitioners A. B. and C. D. in the petition for extension of the above-mentioned letters patent.

2. Pursuant to the directions given by the Honourable Mr. Justice Sargant, I caused the advertisement of which a copy is contained in the Schedule hereto to be inserted in the issues of the "London Gazette" of [*date*] and in the issues of [*name papers and give dates*]. Copies of the issues of the said newspapers containing the said advertisements are now produced to me and marked respectively.

The Schedule above referred to
(*Set forth copy of advertisement.*)

Notice of Opposition to Petition.

[*Heading as above.*]

Notice is hereby given that J. K. and Co., Ltd., of , intend to oppose the petition for extension of the term of the above-mentioned letters patent presented on the day of and returnable on the day of , and require due notice of all proceedings in reference to the above-mentioned letters patent.

Dated this day of .

(Signed.)

Solicitors for and on behalf of J. K. and Co., Ltd., aforesaid.

Notice of Grounds of Objection.

[*Heading as above.*]

Notice is hereby given of the several grounds of the objection of J. K. and Co., Ltd., 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 are null and void, and a judgment 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 revoked 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. The opponent will refer to the following publications in support of this contention [*set them forth*].

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. **Want of utility.**

5. The said petitioner does not possess sufficient merit to entitle him to a prolongation of the term granted by the said letters patent. **Denial of merit.**

6. The said petitioner is not entitled to (the whole of) the privilege granted by the said letters patent (by assignment or otherwise). **Title of petitioner.**

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 allegations contained in the said petition are not true in substance or in fact. **Denial of statements in petition.**

Dated the day of

(Signed.)

Solicitors for said J. K. and Co., Ltd.

SOME HINTS FOR DRAFTING ASSIGNMENTS AND LICENCES.

(1) Assignment.

Recitals.

1. Act of Assignment.
2. Consideration :—
   (a) Cash payment or cash and shares.
   (b) Annual fixed royalty, so long as patent is not revoked or declared invalid) (*coupled with covenant numbered* 16).
   (c) Royalty upon each article made (and sold) by the assignee or his licensees so long as patent is not revoked or declared invalid (*coupled with covenant numbered* 16).
   (d) Provision for minimum royalty per annum, to cease if patent revoked or declared invalid.
   (e) Any other consideration agreed upon between the parties.

Covenants.

3. Covenant by assignor as to validity (*very onerous and seldom inserted*).

4. Covenant that assignor has done no act or thing or omitted to do any act or thing which might be held to be an abuse of monopoly rights under sect. 27 of the Acts of 1907 and 1919, nor done any act prior to the date of the patent which might render the patent liable to revocation under sect. 25.

5. Covenant by assignor that no "hostile person" as defined in the Order made by the Board of Trade dated 30th October, 1918, had at any time since the 4th August, 1914, any interest, share or right whatsoever in the letters patent.

6. Covenant by assignor to assign future improvements. ("*Improvements*" *should be defined,—the following alternative definitions are suggested:* "Improvements shall mean any manufacture, the use of which if by persons other than the owner of the letters patent hereby assigned, or their licensees, would involve an infringement of the said letters patent," *or* "Improvements shall mean any invention which if used with the patented invention assigned would make it cheaper or more effective or in any way preferable," *or* "Improvements shall mean any invention which relates to the art to which the assigned invention relates.")

7. Covenant by assignor to instruct assignee or his servants in the

manufacture, with such provisions for remuneration, &c., as may be agreed.

8. Covenant by assignee to keep accounts and permit inspection of books (*not necessary when the consideration is a fixed sum*).

9. Covenant by assignee to pay the consideration punctually (*onerous*).

10. Covenant by assignee to pay renewal fees and not to do or omit to do any act or thing which might be held to be an abuse of monopoly rights under sect. 27 of the Acts of 1907 and 1919. (*This is necessary only when the assignor retains an interest by way of royalties or otherwise.*)

11. Covenant by assignee not to amend the specification without the consent of the assignor, such consent not to be withheld unreasonably. (*This may be necessary where the assignor retains an interest by way of royalties, or otherwise, which ceases on the patent being declared void. The assignee might amend the specification and thereby render the patent void, and on the other hand it may be necessary to amend to preserve the validity.*)

12. Covenant by assignee not to re-assign without the consent of the assignor.

13. Covenant by assignee to do his best to push the invention and to supply the public to the extent of the demand. (*This is often necessary when the assignor is paid by royalties, and the assignee carries on a rival process or manufacture and acquires the patent merely to maintain a monopoly and prevent competition.*)

14. Covenant by assignee that he will not by exporting to foreign countries, where foreign patents exist for the same invention, infringe such foreign patents or imperil their validity.

15. Covenant by assignor that in dealing with foreign patents he will make provision for the prevention of importation into this country, and for the protection of the assignee.

16. Covenant by assignee that he will sue infringers and that he will defend the validity and existence of the patent, and that he will use his best endeavours in all courts and at all times to maintain its validity and existence for the full term for which it was granted. (*Necessary when the consideration is a reserved royalty with or without a provision for a minimum.*)

Agreement for a General Licence (*not usually under seal*).

(1) Grant of licence for term of patent or less.

(2) Alternative considerations :—

(a) A cash payment—cash or shares.

(b) An annual fixed royalty, so long as patent is not revoked or declared invalid.
(c) Royalty upon each article made and sold so long as patent is not revoked or declared invalid.
(d) Provision for minimum royalty.
(e) Any other consideration agreed upon between the parties.

(3) Warranty of validity by grantor (*should not be inserted save in extraordinary circumstances*). Alternatively recite that grantor has done nothing and knows of nothing which would render the patent invalid.

(4) Warranty by the licensor that no "hostile person" as defined in the Order made by the Board of Trade dated 30th October, 1918, had at any time since the 4th August, 1914, any interest, share or right whatsoever in the letters patent.

(5) Agreement by grantor to communicate all "improvements" (*see clause* 6 *of* "*assignment*" (*ante*)), whether patented or not, which he may make or which shall come into his possession, and that the licensee shall have the full use of such improvement during the term of the licence, with or without further payment, as may be agreed, *or* the obligation to communicate improvements may be mutual and may extend to all other licensees under the letters patent.

(6) Agreement by grantor to instruct licensee and his servants in the manufacture with such provision for remuneration as may be agreed.

(7) Provision for keeping accounts, inspection of books and payment of royalties.

(8) Agreement by grantor to pay renewal fees.

(9) Agreement by licensee not to export, and in so far as he is able, to prevent exportation of the patented article to foreign countries where patents exist for the same article.

(10) Agreement by the licensee to mark all articles sold with the number of the patent.

(11) Conditions as to selling prices, &c., with a declaration that any breach of these conditions will constitute infringement. (*But beware of making terms which might bring into operation section* 38.)

Agreement by grantor that in granting future licences he will bind the future licensees by a similar clause.

(12) Agreement by the licensor to lend his name for the purpose of proceeding against infringers, on being properly secured by the licensees against liability for costs.

Exclusive Licence (*may be under seal or not*).

(1) Grant of exclusive licence for term of patent or less (with or without power to sub-licence).

(2) Alternative considerations :—

(a) A cash payment, cash or shares.

(b) An annual fixed royalty so long as patent is not revoked or declared invalid.

(c) Royalty upon each article made (and sold) so long as patent is not revoked or declared invalid.

(d) Minimum annual royalty, to cease if patent revoked or declared invalid, or if minimum not paid, licence to become general only.

(e) Any other consideration agreed upon.

(3), (4), (5), (6), (7), (8), (9), (10), and (11) *As in general licence.*

(12) Agreement by licensee not to do or omit to do any act or thing which might be held to be an abuse of monopoly rights under sect. 27 of the Acts of 1907 and 1919.

(13) Agreement by licensor, that in dealing with foreign patents he will make provision for the prevention of importation into this country, and for the protection of the licensee.

(14) Agreement by licensee not to export or permit exportation of the patented article to countries or colonies where patents exist for the same invention.

(15) Agreement by the licensor not to amend the specification of the invention without the consent of the licensee, such consent not to be unreasonably withheld.

(16) Agreement by the licensor to lend his name for the purpose of proceeding against infringers, on being properly secured by the licensees against liability for costs.

(17) Agreement by the licensees to finance and carry on proceedings against infringers and to defend proceedings directed against the validity or existence of the patent.

INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

Signed at Washington, June 2, 1911.

[*British Ratification deposited at Washington, April* 1, 1913.]

(Translation.)

Union Convention of Paris of March 20, 1883, for the Protection of Industrial Property, revised at Brussels on December 14, 1900, and at Washington on June 2, 1911.

(Between the United Kingdom, Germany, Austria, Hungary, Belgium, Brazil, Cuba, Denmark, Dominica, Spain, the United States, France, Italy, Japan, Mexico, Norway, the Netherlands, Portugal, Sweden, Switzerland, and Tunis (see Treaty Series, 1913, No. 8), and New Zealand and Czecho-Slovakia have since adhered to the Convention.)

ARTICLE 1.

The contracting countries constitute themselves into a Union for the protection of industrial property.

By a final Protocol it was agreed that—

The words "industrial property" are to be taken in their broadest sense; they extend to all productions of the agricultural industries (wines, corn, fruits, cattle, &c.) and of the mining industries (minerals, mineral waters, &c.).

ARTICLE 2.

The subjects or citizens of each of the contracting countries shall in all the other countries of the Union, as regards patents, utility models, industrial designs or models, trade-marks and trade names, indications of origin, and the suppression of unfair competition, enjoy the advantages that their respective laws now grant, or may 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 conditions and formalities imposed on native subjects or citizens. No obligation as to the possession of a domicile or establishment in the country where protection is claimed shall be imposed on those who enjoy the benefits of the Union.

By a final Protocol it was agreed that—

(*a*) Under the word "patents" are comprised the various kinds of industrial patents recognised by the legislation of each of the contracting countries, such as importation patents, improvement patents, &c., whether for processes or for products.

(*b*) It is understood that the provision of article 2, which exempts the subjects or citizens of the Union countries from the obligation as to the possession of a domicile and establishment, is of the nature of an interpretation, and is consequently to apply to all rights resulting from the Convention of the 20th March, 1883, before the present Act comes into operation.

(*c*) It is understood that the provisions of article 2 do not affect the legislation of each of the contracting countries as regards the procedure to be followed before the tribunals and the competence of those tribunals, nor as regards the election of domicile or appointment of an authorised agent which may be laid down in laws as to patents, utility models, trade-marks, &c.

Article 3.

Subjects or citizens of countries not forming part of the Union, who are domiciled or who have real and effective industrial or commercial establishments in the territory of any of the countries of the Union, shall be assimilated to the subjects or citizens of the contracting countries.

Article 4.

(*a*) Any person who has duly applied for a patent, the registration of a utility model, industrial design or model, or trade-mark, in one of the contracting countries, or his legal representatative or assignee, shall enjoy, for the purposes of registration in other countries, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

(*b*) Consequently, subsequent registration in any of the other countries of the Union before the expiration 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.

(*c*) The above-mentioned periods of priority shall be twelve months for patents and utility models, and four months for industrial designs and models and trade-marks.

(*d*) Any person desiring to take advantage of the priority of a previous application must make a declaration giving particulars as to the date of such application and the country in which it was made. Each country will determine for itself the latest date at which such declaration must be made. The particulars referred to shall be stated in the publications issued by the competent authority, and in particular in the patents issued and the specifications relating thereto. The contracting countries may require any person making a declaration of priority to produce a copy of the application (with the specification, drawings, &c.) previously made, certified as correct by the authority by whom it was received. Such copies shall not require any legal authentication. They may also require that the declaration shall be accompanied by a certificate from the proper authority showing the date of the application, and also by a translation. No other formalities may be required for the declaration of priority at the time of application. Each of the contracting countries shall decide for itself what consequences shall follow the omission of the formalities prescribed by the present article, but such consequences shall in no case be more serious than the loss of the right of priority.

(*e*) At later stages, further proof in support of the application may be required.

By a final Protocol was added—

It is understood that when an industrial design or model is registered in a country in virtue of a right of priority based on the registration of a utility model, the period of priority shall not exceed that fixed by article 4 for industrial designs and models.

ARTICLE 4 *bis*.

Patents applied for in the various contracting countries by persons admitted to the benefits of the Convention in the terms of articles 2 and 3 shall be independent of the patents obtained for the same invention in the other countries, whether such countries be or be not parties to the Union.

This stipulation must receive a strict interpretation; in particular, it shall be understood to mean that patents applied for during the period of priority are independent, both as regards the grounds for refusal and for revocation, and also as regards their normal duration.

The stipulation shall apply to all patents already existing at the time when it shall come into effect.

The same stipulation shall apply in the case of the accession of new countries, to patents in existence, either on one side or the other, at the time of accession.

ARTICLE 5.

The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the countries 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, but with this reservation: that the patent shall not be liable to revocation on account of failure to work it in any country of the Union until after the expiration of three years from the date of application in that country, and then only in cases where the patentee cannot show reasonable cause for his inaction.

Articles 6–10 *are omitted as having no reference to Patents.*

ARTICLE 11.

The contracting countries shall, in conformity with the legislation of each country, accord temporary protection to patentable inventions, to utility models, and to industrial designs or models, as well as to trade-marks, in respect of products which shall be exhibited at official, or officially recognised, international exhibitions held in the territory of one of them.

ARTICLE 12.

Each of the contracting countries agrees to establish a special Government department for industrial property and a central office for communication to the public of patents, utility models, industrial designs or models, and trade-marks.

This department shall, as far as possible, publish an official periodical paper.

Articles 13–19 *are omitted, having reference to the establishment of the International Office at Berne.*

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