

(2.) But the officers or authorities administering any department of the service of the Crown, may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury,² between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested. Sect. 27.

¹ These sub-sections do not apply to patents granted before the commencement of this Act, or upon applications then pending: sect. 45, sub-sect. 2. Such patents, are, therefore subject to the former law, which it may be interesting to trace.

By the theory of the law, the Crown was not bound to grant a patent to any person for a new invention, however valuable, and it was a consequence of the power to withhold a patent altogether that the Crown might make a grant subject to such qualifications as it deemed right; and those qualifications were introduced into each patent according to the discretion of the Attorney-General for the time being. The form generally used was the following proviso: "If the patentee, his executors, &c., shall not supply or cause to be supplied for our service all such articles of the said invention as he or they shall be required to supply by the officers or commissioners administering the department of our service for the use of which the same shall be required, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said officers or commissioners requiring the same, that then the patent shall be void." Former law.

Now the proviso had one grave defect: It dealt merely with the use of patented articles, and was assumed not to give the Crown the power of using, upon terms, patented processes. The result was that patents for processes were taken out in the most vague and general terms, not with any view to use by private individuals, but simply in the hope that some improvement, proposed by a public department, would be found to constitute an infringement of the patented process, and that then the patentee might obtain substantial damages or compensation.

It was suggested that a clause should be inserted in the customary proviso, empowering the officers of any public department to require a patentee to grant a licence for the use of his patent; but the

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decision in *Feather v. Reg.* ((1865), 35 L. J. Q. B. 200; 6 B. & S. 257), that the Crown has, independent of any proviso, the right to use a patented invention, seems to have met the difficulty.

Contractors.

In the form of letters patent now in use, the old proviso is retained. In *Dixon v. London Small Arms Co.* ((1876), 1 App. Ca. 632), it was held that the doctrine of *Feather v. Reg.* did not extend to *contractors* for the public service, a decision which still holds good in the case of those patents to which sub-sect. 2 of sect. 27 does not apply.

2 *With the approval of the Treasury.*—This clause is in accordance with a recommendation made by the Commission of 1865.

LEGAL PROCEEDINGS.

Hearing with
assessor.

28. (1.) In an action or proceeding for infringement¹ or revocation² of a patent, the Court may, if it thinks fit, and shall, on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified,³ and try and hear the case⁴ wholly or partially with his assistance; the action shall be tried without a jury⁵ unless the Court shall otherwise direct.

(2.) The Court of Appeal or the Judicial Committee of the Privy Council, may if they see fit, in any proceeding before them respectively, call in the aid of an assessor as aforesaid.

(3.) The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Court of Appeal or Judicial Committee, as the case may be, and be paid in the same manner as the other expenses of the execution of this Act.⁶

1 It is to be observed that the majority of the powers given to the Court already exist under the R. S. C. 1883. See action of infringement, at p. 353.

2 See revocation of patents, p. 484.

3 *An assessor specially qualified, &c. :*

Scientific
assessors.

This power of calling in an assessor has been very rarely exercised. This provision is new, is a development of a similar power conferred by 15 & 16 Vict. c. 83, s. 8, upon the law officer dealing with the sufficiency of a provisional specification, and was enacted in

accordance with the recommendations of successive Parliamentary Commissions. Sect. 28.

The power to summon an expert assessor, conferred by this section, has been exercised in Scotland, but not in England.

As to power of law officer to summon scientific assessors, see sect. 11, sub-sect. 4.

4 *Shall try and hear the case.*—It may be that this clause deprives the Court of the right to remit an action of infringement, although involving a prolonged scientific examination, to an official referee.

5 *And the action shall be tried without a jury.*—The reasons why patent cases should be tried without a jury were well summarized by Lord Selborne, L. C., in *Patent Marine Inventions Co. v. Chadburn* (1873), L. R. 16 Eq. 447. See p. 423.

Trial without a jury, why advisable.

6 *Expenses incurred in execution of Act.* See sect. 83, sub-sect. 2.

29. (1.) In an action for infringement of a patent¹ the plaintiff² must deliver with his statement of claim,³ or by order of the Court or the Judge, at any subsequent time, particulars of the breaches complained of.⁴

Delivery of particulars.

(2.) The defendant⁵ must deliver with his statement of defence,⁶ or, by order of the Court or a Judge, at any subsequent time, particulars of any objections⁷ on which he relies in support thereof.

(3.) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him.

(4.) At the hearing no evidence shall, except by leave of the Court or a Judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered.⁸

(5.) Particulars delivered may be from time to time amended,⁹ by leave of the Court or a Judge.

(6.) On taxation of costs, regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs¹⁰ in respect of any particular delivered by them

Sect. 29. unless the same is certified by the Court or a Judge¹¹ to have been proven or to have been reasonable and proper,¹² without regard to the general costs of the case.¹³

1 *Action for infringement.*—See Chap. XIII. p. 353.

2 *The plaintiff.*—As to who may or should be plaintiffs, see *supra*, p. 359.

Statement of claim.

3 *Statement of claim.*—The subject is treated of under “Action of Infringement,” at p. 385.

For forms of statement of claim, see Appendix, pp. 828, 829.

The form of statement of claim for the infringement of a patent, prescribed by the R. S. C. 1883, App. C. Sect. VI. No. 6, contains the following material allegations: the number, date, and term of the patent, the subject-matter, the fact that the plaintiff is the true and first inventor, and the fact of infringement by the defendant. The claim concludes for an injunction and damages, and refers to the particulars of breaches delivered along with it.

In *Sarazin v. Hamel* (1863), 32 Beav. 145, it was doubted whether, under a bill to restrain the infringement of a patent, it was necessary to allege that the patentee had duly paid the instalments of stamp duties necessary to keep the patent alive under 16 & 17 Vict. c. 5, s. 2, and no such allegation is now required.

It may be said, generally, that a statement of claim must contain all the material allegations (with the exception of the particulars) on which the plaintiff relies: R. S. C. 1883, Order XIX. rule 4.

Particulars of breaches.

4 *Particulars of breaches.*—See *supra*, p. 392.

Form of particulars, *infra*, p. 829. There is no prescribed form.

The object of requiring particulars is to prevent surprise and avoid expense; if this be attained, the particulars will generally suffice: *Church Engineering Co. v. Wilson* (1886), 3 R. P. C. 127.

As regards particulars of breaches, a vendor infringer requires more particulars than a manufacturer: *Mandelberg v. Morley* (1893), 10 R. P. C. 256. Usually particulars “by way of example” are not allowed, but there are exceptions: See *Patent Type-Founding Co. v. Richards* (1860), 1 Johns. 381; *Church, &c., Co. v. Wilson, supra*; *Haslam v. Hall* (1887), 4 R. P. C. 203.

Generally plaintiff should state lines and pages of his specification which he says is infringed; but where the thing said to be infringed is actually exhibited in the cause, or where the case is a simple one, this may not be required: *Cheetham v. Oldham* (1888), 5 R. P. C. 634; *Church, &c., Co. v. Wilson, supra*; *Lamb v. Nottingham Manufacturers' Co., Seton*, 557.

These matters are fully dealt with, *ante*, p. 393, &c.; for forms, see Sect. 29.
post, pp. 830, 833.

5 *The defendant*.—As to who may and ought to be defendants, see *supra*, p. 364.

6 *Statement of defence*.—See p. 387.

For forms of defence, see pp. 832, 833.

As to object, see above, note 4. But relatively better particulars of objections are required than of breaches, for the breaches are probably within the defendant's knowledge: *Ledgard v. Bull* (1887), 11 App. Ca. 648; 3 R. P. C. 390.

7 *Particulars of objections*.—For a form of particulars, see p. 833; there is no prescribed form. Particulars of objections.

For particulars of objections generally, see p. 400. The following points are noteworthy:—

They do not take the place of pleadings, and may not go beyond the defence: *Macnamara v. Hulse* (1842), 2 W. P. C. 128, n.; *Jones v. Berger* (1843), 1 W. P. C. 544. Particulars should be drafted with care, so as not to put in mere formal defences: *Morgan v. Windover* (1890), 7 R. P. C. 446; *Thomson v. Batty* (1889), 6 R. P. C. 84; but if pleading honestly, the defendant must not be hampered in setting up what he thinks right: *Nettlefolds v. Reynolds* (1891), 8 R. P. C. 410.

(a) *First and true inventor*: To be used when alleged plaintiff obtained the invention from somebody: *Morgan v. Windover* (*supra*). *Quære*, whether name of alleged true inventor can be demanded by plaintiff: *Russell v. Ledsam* (1843), 11 M. & W. 647.

(b) *Novelty*.—(i) Prior user; names and addresses of users and places of users are generally ordered: *Flower v. Lloyd* (1876), 45 L. J. Ch. 746; *Birch v. Mather* (1883), 22 Ch. Div. 629; 52 L. J. Ch. 392. But when general user is alleged, the particulars need not be so full: *Palmer v. Wagstaffe* (1853), 22 L. J. Ex. 295; *Jones v. Berger* (1843), 5 M. & G. 208. Date of user must be mentioned with sufficient definiteness: *Smith v. Lang* (1890), 7 R. P. C. 148. Also the objections should state whether the invention has been anticipated wholly or in part and which part: *Boyd v. Horrocks* (1886), 3 R. P. C. 285. See also *Boyd v. Farrar* (1888), 5 R. P. C. 33.

(ii) *Public knowledge*.—This should be alleged separately from anticipation: *Phillips v. Ivel Cycle Co.* (1890), 7 R. P. C. 77; books and specifications used to prove general knowledge should not be particularized: *Holliday v. Heppenstall* (1889), 41 Ch. Div. 109; 6 R. P. C. 320. A specification will not ordinarily be allowed as evidence of common knowledge: *Solvo Laundry v. Mackie* (1893), 10 R. P. C. 68.

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(iii) *Books and persons*.—References to volume, page, name of individual, &c., generally required; but see *ante*, p. 406.

(c) *Insufficiency of specification*.—(a) Disconformity; particulars required: *Boyd v. Horrocks* (1886), 3 R. P. C. 285; *Anglo-American Brush Co. v. Crompton* (1887), 4 R. P. C. 27. (b) If it is alleged that the specification does not describe the invention or method of working it, particulars will be required if they can be given: *Crompton v. Anglo-American Brush Co.* (1887), 35 Ch. Div. 283; 4 R. P. C. 197. (c) Ambiguity, if alleged, must be accompanied by particulars: *Heathfield v. Greenaway* (1894), 11 R. P. C. 17.

If there are several defendants the particulars given by one may be used by the other (*Smith v. Cropper* (1885), 10 App. Ca. 249; 2 R. P. C. 1), but not always: *Ibid.*, pp. 253, 254.

Restriction of evidence at hearing.

8 *No evidence shall, except by leave, &c.*—The words “except by leave of the Court or Judge” are new. The rest of the sub-section re-enacts substantially 5 & 6 Will. IV. c. 83, s. 5, and 15 & 16 Vict. c. 83, s. 41. As to meaning of “the Court or a Judge,” see *Cole v. Saqui* (1888), 40 Ch. Div. 132; 5 R. P. C. 489; *Shoe Manufacturers’ Co. v. Cutlan* (1896), 1 Ch. 108; 12 R. P. C. 530.

Where additional evidence comes to the knowledge of a defendant after the delivery of his particulars, the proper course is to apply at once for leave to amend the particulars: *Daw v. Eley* (1865), 1 Eq. 33. Though where the particulars are sufficiently wide to include the new evidence tendered, it will be admitted: *Sugg v. Silber*, 2 Q. B. D. 493, 495; 45 L. J. Q. B. 460; *Hull v. Bollard* (1856), 1 H. & N. 134, 137; *Curtis v. Platt* (1866), 35 L. J. Ch. 852.

Amendment of particulars.

9 *Amendment of particulars*.—See p. 410, and note the following:—The Court of Appeal has power to allow amendment of particulars: *Shoe Machinery Co. v. Cutlan* (1896), 1 Ch. 108; 12 R. P. C. 530. Any amendment may be allowed, if the other side can be compensated by costs: *Cropper v. Smith* (1884), 26 Ch. Div. 700; 1 R. P. C. 96. The application may be made at any time, even at the trial: *e.g.*, *Allen v. Horton* (1893), 10 R. P. C. 412. The Court may, and generally will, refuse leave to a defendant unless he agrees to allow plaintiff to elect to discontinue, and to pay plaintiff’s costs incurred since the delivery of the unamended particulars if the action is discontinued: *Edison Telephone Co. v. India Rubber Co.* (1881), 17 Ch. Div. 137; *Ehrlich v. Ihlee* (1887), 4 R. P. C. 115. But the rule is not invariable: *Wooley v. Broad* (1892), 2 Q. B. 317; 9 R. P. C. 429.

10 *Shall not be allowed any costs, &c.*—With the exception of the words “to have been reasonable and proper,” this sub-section substantially re-enacts 15 & 16 Vict. c. 83, s. 43.

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11 If the Court of Appeal reverses the Judge below it may grant the certificate: *Cole v. Saqui* (1888), 40 Ch. Div. 132; 5 R. P. C. 41. In the House of Lords, see *Morris v. Young* (1894), 12 R. P. C. 455. See also R. S. C. 1883, Order LVIII. rule 4. If the Court dismisses the appeal, there seems a question whether it has power to make the order; *semble*, there is no jurisdiction to interfere with the order of the Judge below as to particulars allowed by him: *Cassel Gold Co. v. Cyanide Recovery Co.* (1895), 12 R. P. C. 303. The Palatine Court of Lancaster may give the certificate: 53 & 54 Vict. c. 23, s. 3.

12 It is not necessary that the particulars should have been actually proved; the certificate may be given if they are reasonable and proper: *Phillips v. Ivel Cycle Co.* (1890), 7 R. P. C. 77; *Cassel Gold Co. v. Cyanide Recovery Co.*, *supra*. The Court cannot grant the certificate unless it has materials on which it may form an opinion that the particulars are reasonable and proper: *Longbottom v. Shaw* (1889), 43 Ch. Div. 46; 6 R. P. C. 510 (plaintiff's case broke down before particulars of objection could be brought before the Court; certificate refused); *Mandelberg v. Morley* (1895), 64 L. J. Ch. 245; 12 R. P. C. 35 (plaintiffs at trial elected to have action dismissed; particulars of objection not certified); *Middleton v. Bradley* (1895), 2 Ch. 716; 12 R. P. C. 390 (plaintiff discontinued; particulars of objections not certified). But if the cross-examination shows the particulars to be reasonable (*Longbottom v. Shaw, supra*), or interlocutory proceedings have enabled the Court to form an opinion (*Middleton v. Bradley, supra*), the particulars may be allowed. The Court will not undertake inquiry unnecessary to the decision, merely to see whether the particulars are reasonable: *Boyd v. Horrocks* (1889), 6 R. P. C. 162; *Longbottom v. Shaw* (1889), 6 R. P. C. 143. See also *Germ Milling Co. v. Robinson* (1886), 3 R. P. C. 254; *Albo-Carbon Light Co. v. Kidd* (1887), 4 R. P. C. 539. See also *Boake v. Sterenson* (1895), 12 R. P. C. 228, in which discontinuance was allowed on terms that plaintiff should pay the costs of particulars of objections.

13 Without regard to the general costs of the case.—According to Stephen, J., in *Haslam Co. v. Hall* ((1888), 5 R. P. C. 26), this does not mean that the certificate of the Judge is to be "without regard," &c., and the sub-section should read, "and with regard to the general costs of the case, they respectively shall not be allowed any costs," &c.

30. In an action for infringement of a patent, the Court or a Judge may on the application of either party make such order for an injunction, inspection, or account,

Sect. 30. and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a Judge may see fit.

Interlocutory injunction.

As to granting an *interlocutory* injunction, the rule upon which the Courts still act is that stated by Sir George Jessel, M. R., in *Dudgeon v. Thomson* (1874). 30 L. T. N. S. 244.

“The Court can grant an injunction before the hearing where the patent is an old one, and the patentee has been in long and undisturbed enjoyment of it, or where its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result, or where the conduct of the defendant is such as to enable the Court to say that as against the defendant himself there is no reason to doubt the validity of the patent.”

But an interlocutory injunction will be refused (1) if there be substantial doubt as to infringement; or (2) if there be unnecessary delay in the application for an injunction; or (3) if the plaintiff has acquiesced in the infringement; or (4) if the balance of convenience is against it, especially if defendant offers to keep an account. These propositions are dealt with *ante*, p. 370.

A plaintiff must apply promptly after discovery of an alleged infringement, in order to obtain an interlocutory injunction to restrain it: *Thomson v. Batty* (1889), 6 R. P. C. 84.

Perpetual injunction.

A perpetual injunction may be granted by the Court (but not against a third party: *Edison v. Holland* (1889), 41 Ch. Div. 23; 6 R. P. C. 233), where the plaintiff has established the validity of his patent and the fact of infringement (*Hill v. Evans* (1862), 31 L. J. Ch. 457; 4 De G. F. & J. 289), and may be obtained by motion in Court (*Morrell v. Pearson* (1849), 12 Beav. 284), or by order in Chambers (Judicature Act, 1873, sect. 39; see *Frearson v. Loe* (1878), L. R. 9 Ch. D. 48; 26 W. R. 138; cp. also R. S. C. 1883, Order LIV. rule 12; and Order LV. rule 15) where the defendant is willing to submit to the plaintiff's demands without bringing the action to trial.

If, however, there be no threatened danger to plaintiff's rights the injunction is often refused. If the patentee amends his specification, he cannot enforce an injunction already obtained: *Dudgeon v. Thompson* (1879), 3 App. Ca. 34; nor will he usually be allowed to continue a pending action to get an injunction: see *Mayer v. Sherwood* (1890), 7 R. P. C. 283; and cf. R. S. C. 1883, Order L. rules 3 to 6.

If the plaintiff is unable to prove an infringement, but proves a *clear* intention on the part of the defendants to infringe, he is entitled to an injunction: *Frearson v. Loe* (1878), 9 Ch. Div. 65; *Douling v.*

Billington (1870), 7 R. P. C. 191. But see *Shoe Machinery v. Cutlan* (1896), 12 R. P. C. at p. 358; whence it appears that to enable the plaintiff to succeed on this ground the claim must clearly be for an injunction for threatened future breaches, and not merely for past breaches.

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§ *Inspection*.—See *supra*, p. 413.

Form of order for inspection, p. 838.

Inspection,
when ordered
by.

Before ordering inspection the Court must be satisfied (1) that there is a *prima facie* case to be tried (*Piggott v. Anglo-American Telegraph Co.* (1868), 19 L. T. N. S. 46); and (2) that the inspection demanded will probably, and not merely possibly (*Smith v. London and Great Western Railway Co.* (1854), Macr. P. C. 223; *Germ Milling Co. v. Robinson* (1886), 3 R. P. C. 13) yield something material to the case of the party demanding it (*Piggott v. Anglo-American Telegraph Co.*, *ubi supra*), and (3) will not be oppressive to the other party: *Singer Manufacturing Co. v. Wilson* (1865), 5 N. R. 505.

That an inspection will lead to the disclosure of trade secrets is not a sufficient ground for refusing it (*Renard v. Levinstein* (1884), 10 L. T. N. S. 94); but the Court will take steps to prevent the inspection being used to the prejudice of the defendant (*Russell v. Crichton* (1837), Ct. Sess. 1270), and it has been customary in such cases to order an inspection and report by some scientific man under an "obligation of confidence," and not by the plaintiff (*Howe v. Lloyd* (1876), W. N. 230. Sometimes the Court causes a secret process to be disclosed *in camera*: *Badische, &c. v. Levinstein* (1884), 24 Ch. Div. 156.

Inspection of
trade secrets.

In ordering inspection of an examiner's report under this section, it seems that the Court must certify such inspection to be desirable, and in the interests of justice: Cp. sect. 9, sub-sect. 5.

Inspection of
examiner's
report.

The Court has no power under this section to require the defendants to an action for infringement to make an affidavit verifying the machines and processes used by them in the manufacture which is in issue: *Drake v. Muntz's Metal Co.* (1886), 3 R. P. C. 43; Griff. 79.

Inspection can only be ordered when the property is under the control of the party, or can be produced for inspection by him: *Garrard v. Edge*, 50 L. J. Ch. 397; 6 R. P. C. 372; *Ryland v. Ashley's Bottle Co.* (1890), 7 R. P. C. 175. The order is discretionary: *Rare v. Chance* (1890), 7 R. P. C. 275. It is often mutual: *Germ Milling Co. v. Robinson* (1885), 55 L. J. Ch. 287; 3 R. P. C. 11.

The application should not be *ex parte*, and should, in the Queen's Bench Division at any rate, be made in the general summons for directions; see Order XXX. rule 2. But the application may be

Sect. 30. made at any time after the issue of the writ, or by a defendant after appearance: R. S. C. 1883, Order L. rule 6.

The Court may order an expert to make a report to the Court itself: *e.g.*, *Badische, &c. v. Levinstein* (1884), 24 Ch. Div. 156; 2 R. P. C. 73; *British Rubber Co. v. Mackintosh and Co.* (1894), 11 R. P. C. 447.

Account of profits.

3 Account.—See above, p. 442.

Any Division of the High Court of Justice may order an account of profits against a person infringing patent rights: R. S. C. 1883, Order XVI. rule 1; but the plaintiff must elect between such an account and damages: *Neilson v. Betts* (1871), 2 L. R. 5 H. L. 1. The basis of the claim for profits is that the patentee condones the infringement, and does not complain of it, but seeks to recover the whole profit made by the infringer as if it had been made as trustee for him.

For the form of an order for an account of profits where an article is only partially made by the use of a patented invention, see *Siddell v. Vickers*, 5 R. P. C., at p. 436.

4 Terms.—Inspection was allowed in one case on payment of the costs in any event: *Michell v. Darley Colliery Co.* (1883), 10 Q. B. D. 457; 52 L. J. Q. B. 394.

Certificate of validity questioned and costs thereon.

31. In an action for infringement of a patent, the Court or a Judge may certify that the validity of the patent came in question;¹ and if the Court or a Judge so certifies, then in any subsequent action for infringement,² the plaintiff in that action on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses, as between solicitor and client, unless the Court or Judge trying the action certifies that he ought not to have the same.

¹ *Quære* in a threats action: *Kurtz v. Spence* (1888), 5 R. P. C. 184; *Crampton v. The Patents Investment Co.* (1888), 5 R. P. C. 404.

² The application may be made in Chambers, or more properly at the trial. The Court of Appeal may grant the certificate: see *Cole v. Saqui* (1889), 40 Ch. Div. 132; 6 R. P. C. 41. Also see *Incandescent Light Co. v. De Mare, &c., Syndicate* (1896), 13 R. P. C., at p. 579.

³ The certificate is discretionary; there is no appeal from a refusal: *Haslam v. Hall* (1888), 20 Q. B. D. 491; 5 R. P. C. 144.

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⁴ If there is no defence it is an open question whether the Court should grant a certificate: see *Peroni v. Hudson* (1884), 1 R. P. C. 263 (refused); *Haydock v. Bradbury* (1887), 4 R. P. C. 75 (granted). And see other cases quoted *ante*, p. 449.

⁵ A second action was held not to be a subsequent action within this section, so as to entitle the plaintiff to solicitor and client costs, where it was commenced before the certificate was given in a former action: *Automatic Weighing Co. v. International Hygienic Society* (1889), 6 R. P. C. 480.

See form of certificate of validity, p. 841.

⁶ If the only question in the second action is infringement, the certificate will not always entitle to solicitor and client costs: *Automatic, &c. v. International, &c.*, *supra*. And see cases *ante*, p. 450, n. If validity is impeached on different grounds to those set up in the first action, solicitor and client costs are often not allowed: *Otto v. Steel* (1886), 3 R. P. C. at p. 120. As to granting certificate where validity is upheld, but plaintiff fails on the question of infringement, see *Automatic Weighing Co. v. Knight* (1889), 6 R. P. C. 120; *Morris v. Young* (1895), 12 R. P. C. at p. 465.

A certificate is not given to a successful defendant: *Badische, &c. v. Levinstein* (1885), 29 Ch. Div. 366, 419.

32. Where any person¹ claiming to be the patentee² of an invention, by circulars, and advertisements, or otherwise³ threatens any other person⁴ with any legal proceedings or liability in respect of any alleged manufacture, use, sale or purchase⁵ of the invention, any person or persons aggrieved⁶ thereby may bring an action against him, and may obtain an injunction⁷ against the continuance of such threats, and may recover such damage⁸ (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement⁹ of any legal rights¹⁰ of the person making such threats:¹¹ Provided¹² that this section shall not apply¹³ if the person making such threats¹⁴ with due diligence¹⁵ commences and prosecutes¹⁶ an action for¹⁷ infringement of his patent.

Remedy in case of groundless threats of legal proceedings.

See *ante*, Chap. XIV., p. 470, and for forms see *post*, Appendix, pp. 847 *et seq.*

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This section is not retrospective: *Sugg v. Bray* (1885), 2 R. P. C. 223.

The law as it existed independently of this section was thus stated in *Halsey v. Brotherhood* ((1881) 15 Ch. Div. 514, affirmed 19 Ch. Div. 386; 49 L. J. Ch. 514):—"To support the action (for an injunction to restrain threats) the allegations must not only assert the statement to be untrue, but that it was made without reasonable and probable cause A man merely giving notice that his rights are being infringed, believing that they are infringed, is not to be subject to an action for giving that notice, even although he does not follow up that notice by bringing an action at law for the infringement." The defendant, however, while not bound to be correct in his statement of the law, was bound to be correct in his statement of facts, and if the threats were not mere allegations of piracy, which is matter of law, but went on to allege untrue matters of fact, an action would generally lie: *Dicks v. Brooks* (1880), 15 Ch. Div. p. 39. See also *Wren v. Wiold* (1869) L. R. 4 Q. B. 730; 38 L. J. Q. B. 327.

Construction
of present
section.

This section contemplates final judgment. This appears from the circumstance that it speaks of damages which could not be obtained on an interlocutory application: *Challender v. Royle* (1887), 36 Ch. Div., at p. 434; 4 R. P. C. at p. 371.

1 "Person" includes a body corporate. See sect. 117.

2 "Patentee" means the person for the time being entitled to the benefit of a patent: sect. 46.

3 The word "otherwise" is not to be cut down in accordance with the *ejusdem generis* rule of construction: *Driffield and East Riding Pure Linseed Cake Co. v. Waterloo Mills Cake Co.* (1886), 31 Ch. Div. 636; 3 R. P. C. 46; *Crampton v. Patents Investment Co.* (1888), 5 R. P. C. 393; *Skinner v. Shew* (1892), 1 Ch. 413; 10 R. P. C. 1. Thus a private interview or a letter from the alleged patentee may be a threat: *Willoughby v. Taylor* (1894), 11 R. P. C. 45; though it be marked "without prejudice:" *Kurtz v. Spence* (1888), 5 R. P. C. 161, 173; so may a solicitor's letter: *Combined Weighing and Advertising Machine Co. v. Automatic Weighing Machine Co.* (1889), 42 Ch. Div. 665; 6 R. P. C. 502; and a letter in reply to an inquiry may be enough to found a threats action under this section: *Skinner v. Shew* (1892), 1 Ch. 413; 9 R. P. C. 406; 10 R. P. C. 1. The threat has the same legal effect whether it be addressed to the party alleged to be infringing or to third parties: *Skinner v. Shew, supra*; see also the threats in *Taylor v. Willoughby, supra*.

But a patentee is entitled to issue a warning not to infringe,

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provided there be no threat which can be pointed to as affecting any particular person or transaction. The threats alleged in the following actions should be read and compared and from the decisions the limits which cannot safely be passed can be deduced: *Challender v. Royle* (1887), 36 Ch. Div. 425, 434, 441; 4 R. P. C. 363; *Johnson v. Edge* (1892), 2 Ch. 1; 9 R. P. C. 142. In the former case, as reported in 4 R. P. C., Bowen, L. J., said: "Supposing that a manufacturer is making and issuing machines which the patentee considers to be an infringement of his patent: if, with reference to that act done, or to those machines made, the patentee endeavours to guard himself against this section by merely issuing a threat in the air, it seems to me he would not escape if the whole gist of what he has done is to apply that threat to a particular person and a particular act." And see below, note 5 to this section.

4 See note 1, *supra*. A solicitor's letter to one person has been treated as a threat by another person: *Barrett v. Day* (1889), 43 Ch. Div. 435; and threats addressed to a plaintiff or to a third party may both be within the section: *Skinner v. Shew* (1892), 1 Ch. 413; 10 R. P. C. 1.

5 These words have caused difficulty, and have given rise to the idea that the threats cannot be within the section if they are not such as refer to infringements which have actually taken place; the section does not here refer to intended acts. The law may be stated thus: a threat comes within this section if the threat refers to an alleged actual infringement, or to an intention which, if carried out, would be an actual infringement, assuming for this purpose the validity of the patent. Whether a threat is a threat within the meaning of this section, or a mere warning, is a difficult question of fact. In *Challender v. Royle* (1887), 36 Ch. Div. 425; 4 R. P. C. 371, Bowen, L. J., used words which might bear the interpretation that threats against future acts cannot be within this section; but these remarks have been explained in subsequent cases: see *Kurtz v. Spence* (1888), 5 R. P. C. at p. 171, and *Johnson v. Edge* (1892), 2 Ch. 1; 9 R. P. C. 142, 149.

But even if the words literally construed refer only to future or contingent events, in reality they are "threats" within the meaning of this section if they refer to acts already done or immediately intended to be done: *Challender v. Royle, supra*; *Willoughby v. Taylor* (1894), 11 R. P. C. 45.

6 A person other than the person threatened may be a person aggrieved; e.g., A. threatens B. that if B. uses C.'s goods he will proceed for infringement; C. can bring the action against A. under this section: *Johnson v. Edge* (1892), 1 Ch. 1; 9 R. P. C. 142;

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Willoughby v. Taylor (1894), 11 R. P. C. 45; *Kensington, &c., Electric Lighting Co. v. Lane-Fox Electric Light Co.* (1891), 2 Ch. 573; 8 R. P. C. 277. If the threat is general in its nature, it would seem that any person who can show that the trade would take it that the threat was aimed at such person would be a person aggrieved. The limit case in this respect so far is *Johnson v. Edge, supra.* Cf. *Apollinaris Co.'s Trade Marks* (1891), 2 Ch. 186; 8 R. P. C. 137; and see *Re Powell's Trade Mark* (1894), A. C. 8; 11 R. P. C. 4.

7 In applications for interlocutory injunctions the Court ought to consider, not merely the balance of convenience, but whether the plaintiff has a *prima facie* case: *Challender v. Royle* (1886), 36 Ch. Div. 425, 436; 4 R. P. C. 371. (*Walker v. Clarke* (1887), 4 R. P. C. 11, *contra*, is no longer law.)

If an interim injunction be granted, it will not necessarily be on the condition of an undertaking as to damages: see *Fenner v. Wilson* (1893), 2 Ch. 656; 62 L. J. Ch. 984. Where there was no intention of repeating the threats, an interlocutory injunction was refused: *Mackie v. Solvo Laundry Co.* (1892), 9 R. P. C. 465.

A perpetual injunction will usually be granted at the trial if the plaintiff proves his case, but it is not a matter of absolute right; the ordinary considerations as to the granting of injunctions will be regarded: *Edlin v. Pneumatic Tyre, &c., Co.* (1893), 10 R. P. C. 311, 316.

If the threats are long continued, and the threatened party stands by and does nothing, the right to an interlocutory injunction is difficult of attainment: *Ibid.*

8 Damages are allowed only when actual damage has been sustained: *Driffield Linseed Cake Co. v. Waterloo Mills Cake Co.* (1886), 31 Ch. Div. 638, 644; 3 R. P. C. 46. The amount will be a rough estimate: *Ungar v. Sugg* (1892), 9 R. P. C. 113. In *Kurtz v. Spence* (1888), 5 R. P. C. 173, 40s. was awarded. In *Skinner v. Shew* (1894), 2 Ch. 581; 11 R. P. C. 406, the loss of a contract lost owing to the threats was taken into account.

If possible, the damages should be estimated by the Judge who tries the action: *Ungar v. Sugg, supra.* But in *Johnson v. Edge* (1892), 2 Ch. 1; 9 R. P. C. 142, Matthew, J., referred the calculation to an official referee; usually this is the more convenient course.

9 In order to grant relief at the trial, the Court must be satisfied that, in fact, what is complained of and in respect of which the threats were made is not an infringement of any legal rights of the person making the threats: *Challender v. Royle* (1887), 36 Ch. Div. 425, 435; 4 R. P. C. 363; the burden of proof will *prima facie* be on

the plaintiff, though it may easily be thrown on to the defendant in most cases: *Ibid.*; and see *Barney v. United Telephone Co.* (1885), 28 Ch. Div. 394; 2 R. P. C. 173.

10 If the threatener has no valid patent he has no legal right that can have been infringed. On this it has been said—though not absolutely decided—that if the patent is invalid the plaintiff in the threats action will succeed, unless the threatener brings himself within the proviso. Chitty, J., in *Kurtz v. Spence* (1886), 33 Ch. Div. 579, decided that “validity” could not be raised in a threats action; this has never been actually overruled, but the opinions expressed by Cotton, Bowen and Fry, L. JJ., in subsequent cases have virtually made an end of Mr. Justice Chitty’s decision. See *Challender v. Royle* (1887), 36 Ch. Div. 425, 435, 443; 4 R. P. C. 371; *Kurtz v. Spence* (1887), 36 Ch. Div. 770; 4 R. P. C. 427; also see *Herrburger v. Squire* (1888), 5 R. P. C. 581.

11 If one man is the legal owner of the patent, but has assigned it by equitable assignment to another, *quere* the latter cannot safely threaten: *Kensington and Knightsbridge Electric Light Co. v. Lanc-For Electric Light Co.* (1891), 2 Ch. 573; 8 R. P. C. 277, does not altogether settle the point. See sect. 87 as to equitable rights, and note the definition of a patentee in sect. 46.

12 This proviso has been described as a legislative puzzle: per Kekewich, J., in *Combined, &c., Co. v. Automatic, &c., Co.* (1889), 42 Ch. Div. 665; 6 R. P. C. 502. The effect of it is peculiar; see next note.

13 A person aggrieved commences his action, and at the date of writ may have a very good cause of action under the section; but if subsequently with due diligence the defendant commences and prosecutes his action for infringement, the plaintiff’s right of action disappears, and *semble* he will have to pay the costs of an action properly started, even though in substance he may succeed, *e.g.*, if the defendant abandons his infringement action as hopeless: *Colley v. Hart* (1890), 44 Ch. Div. 179; *Combined Weighing and Advertising Co. v. Automatic Weighing Co.* (1889), 42 Ch. Div. 665; *English and American Machinery Co. v. Gare Machinery Co.* (1894), 11 R. P. C. 627. And see the difficulty as expressed by Pearson, J., in *Barnett v. Barrett’s Screw Stopper Co.* (1884), 1 R. P. C. 10.

14 Action brought by an assignor in whom the legal title to the patent still resides, is no answer if the threats are issued by the assignee: *Kensington and Knightsbridge Electric Light Co. v. Lanc-For Electric Light Co.* (1891), 2 Ch. 573; 8 R. P. C. 277.

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15 "Due diligence is a question of fact, and no case is a reliable guide to the decision of another on this point: *Combined Weighing, &c., Co. v. Automatic, &c., Co.* (1889), 42 Ch. Div. 665; 6 R. P. C. 502; *Colley v. Hart* (1890), 44 Ch. Div. 179; 7 R. P. C. 101. In *Herrburger v. Squire* (1888), 5 R. P. C. 581, the threats were issued in October, 1886; the threats action commenced November 12th, 1887; the infringement action commenced November 14th, 1887; held: not due diligence. In *Combined Weighing, &c., Co. v. Automatic Weighing Co.* (1889), 42 Ch. Div. 665; 6 R. P. C. 502, we find: threats, September 21st; threats action, September 27th; infringement action, September 30th; held: due diligence. See also *Challender v. Royle* (1887), 36 Ch. Div. 425; 4 R. P. C. 363; *Colley v. Hart* (1890), 44 Ch. Div. 179; 7 R. P. C. 101. In *Edlin v. Pneumatic Tyre Co.* (1893), 10 R. P. C. 311, three years elapsed between threat and infringement action, but the circumstances were exceptional. Where proceedings for infringement are started after the commencement of a threats action, manifestly for the purpose of getting within the proviso, the Court will not be inclined to regard the action as brought with due diligence: *Johnson v. Edge* (1892), 2 Ch. 1; 9 R. P. C. 142.

The infringement action may bring the case within the proviso, whether the infringement action be brought before or after the threats; the only point to be determined is, was it started and prosecuted with due diligence: *Barrett v. Day* (1889), 43 Ch. Div. 435; 7 R. P. C. 54.

A person against whom an action for threats is brought may sometimes wait to see if he can counter-claim for infringement, and will not run any great risk of losing the benefit of the proviso, if in fact he does counter-claim for infringement: *Colley v. Hart* (1890), 44 Ch. Div. 179; 7 R. P. C. 101.

Bonâ fides will not of itself bring the threatener within the proviso: *Herrburger v. Squire* (1888), 5 R. P. C. 581. Nor can "privilege" be set up: *Skinner v. Shew* (1892), 1 Ch. 413; 9 R. P. C. 406; 10 R. P. C. 1.

16 It is not requisite that the action should be carried to a successful result. In *Colley v. Hart*, 44 Ch. Div. 179; 7 R. P. C. 101, the threatener abandoned his infringement action, nevertheless he was held to be within the proviso. In that case, moreover, the pleadings were not hurried on by either side. In *Combined Weighing, &c., Co. v. Automatic, &c., Co.* (1892), 42 Ch. Div. 665; 6 R. P. C. 502, the threatener lost his infringement action, but was held to be within the proviso. But threats made after a discontinuance may be restrained: *Fusee Vesta Co. v. Bryant and May* (1887), 56 L. T. N. S. 136.

An action may be prosecuted with due diligence, though the length of time between each pleading appears long at first glance; *e.g.*, whether the matters in issue are complicated and the particulars numerous: *English and American Machinery Co. v. Gare Machinery Co.* (1894), 11 R. P. C. 627. But see *Household v. Fairburn* (1884), 1 R. P. C. 109; 2 R. P. C. 140.

But the action must be an honest one, really brought to test the question, and not brought collusively: *Challender v. Royle* (1887), 36 Ch. Div. 425, 442; 4 R. P. C. 363; *Barrett v. Day* (1889), 42 Ch. Div. 435; 7 R. P. C. 54. Discontinuance does not prove *mala fides*: *English and American Machinery Co. v. Gare Machinery Co.* (*supra*).

17 An infringement action against a party other than the plaintiff in the threats action may bring the threatener within the proviso; but *quære*, when none of the persons against whom the infringement action is brought were amongst the persons threatened: *Combined Weighing, &c., Co. v. Automatic, &c., Co.* (1889), 42 Ch. Div. 665; 6 R. P. C. 502; *Challender v. Royle* (1887), 36 Ch. Div. 425, 439, 442; 4 R. P. C. 367.

Practice.—Particulars of objection must be given when the validity of the patent is attacked: *Law v. Ashworth* (1890), 7 R. P. C. 86. The threatener must state on which patents he relied when making his threats, unless the point be clear: *Union Electric Power Co. v. Electrical Power Storage Co.* (1888), 38 Ch. Div. 325; 5 R. P. C. 329.

Particulars of the names of plaintiff's agents who are alleged to have been threatened may be demanded: *Dowson, Taylor v. Drosophore Co., Ltd.* (1894), 11 R. P. C. 536; 12 R. P. C. 95.

When an infringement and a threats action is in existence between the same parties, unless the points are raised by way of claim and counter-claim, the proper course is to stay one action by consent: *Combined Weighing, &c., Co. v. Automatic Weighing, &c., Co.* (1889), 42 Ch. Div. 665; 6 R. P. C. 502.

If the threatener succeeds in upholding his patent, *quære*, can he be given a certificate of validity? It should seem not, but Field, J., gave such a certificate (subject to all objections) in *Crampton v. Patents Investment Co.* (1889), 5 R. P. C. 382. The point was not dealt with when the case came before the Court of Appeal.

In *Willoughby v. Taylor* (1894), 11 R. P. C. 45, Day, J., gave a certificate that the plaintiff's particulars of objection were reasonable. *Quære*, whether this is not a matter of taxation. If the practice in actions for infringement is to be followed, it is submitted in that case the plaintiffs ought not to have had the costs of the particulars; they were not proved.

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For form of statement of claim, see *post*, p. 847.

For form of defence, see *post*, p. 848.

For form of order for injunction, &c., see *post*, p. 849.

MISCELLANEOUS.

Patent for
one invention
only.

33. Every patent may be¹ in the form in the First Schedule to this Act, and shall be granted for one invention only,² but may contain more than one claim;³ but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention.⁴

Form of
patent.

¹ *Every patent may be, &c.*—The word *may* is permissive. As a matter of fact the form of the grant in the schedule is adhered to, except in so far as necessary variations are requisite in cases where there are several applicants, or an applicant dies, &c. See *post*, p. 667.

Rule as to
one invention.

² *One invention only.*—Cp. Patents Rules, 1890, rule 19, p. 639. Where, by mistake, inadvertence, or otherwise, more than one invention is included, the application may be amended and separate patents may be applied for. Every such application may bear the date of the original application.

Unless by implication in this section, the Act neither enables the comptroller to refuse an application on the ground that it claims more than one invention (sect. 7, sub-sect. 1), nor allows an appeal to the law officer from such a refusal (sect. 7, sub-sect. 1). In fact, however, the comptroller-general does exercise this power, and appeals to the law officers have been taken from his decision. There should be no technical difficulty in this, as the comptroller can at any time take the opinion of the law officers; see sect. 95 of the Act of 1883.

The *test* by which the question of one invention is decided is "the general object of the invention:" *Jones's Patent*, 3 Griff. P. C. 265; *Hearson's Patent* (1885), *ibid.* 266; *Robinson's Patent*, *ibid.* 267.

"If you have a particular general object of an invention," said Herschell, S.-G., in *Jones's Patent*, "to make rails rest more securely, and you describe one, two, or three cognate devices for carrying it into effect, I should say they were all one invention; but if there is no common purpose, so that you could say, 'I use this as a substitute for that,' both serving the same purpose, although there is some difference between them, but they are to serve some different purpose, there is no connection between them, except that both are used in connection with rails, and it strikes me that would be two

inventions. I should always allow alternative devices for producing a particular object as one invention." **Sect. 33.**

3 *One claim.*—The claim appears in the specification, not in the patent. One claim.

4 No objection can be taken to a patented invention on the ground that it comprises more than one invention after the specifications have been accepted by the comptroller.

34. (1.) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.¹ Patent on application of representative of deceased inventor.

(2.) Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

¹ *Deceased inventors :*

This section alters the law laid down in *Marsden v. Saville Street Foundry and Engineering Company* (1878), 3 Ex. D. 203.

The application must be accompanied by an official copy of, or extract from the will of the deceased inventor, or the letters of administration granted of his estate and effects, in proof of the applicant's title : Patents Rules, 1890, rule 20, p. 690. Application by representative of deceased inventor.

If the applicant dies before sealing, a patent may be sealed to his executor or administrator ; sect. 12, sub-sect. 3 b.

Where an applicant dies after the acceptance of the provisional, but before the acceptance of the complete, specification, the practice is for the executor or administrator to produce for the inspection of the comptroller-general probate of the will, or letters of administration of the deceased inventor, and then to carry out the subsequent stages in his own name.

35. A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection. Patent to first inventor not invalidated by application in fraud of him.

Sect. 35.

This is substantially a re-enactment of 15 & 16 Vict. c. 83, s. 10. In the case of *Re Vincent's Patent* ((1867), L. R. 2 Ch. 341), the sealing of a patent was opposed on the ground of previous public user of the invention; in reply to which the applicant made the case that such user was obtained by fraud on him, so as to bring the case within 15 & 16 Vict. c. 83, s. 10. It was held that the question ought to go before a jury, and that the patent ought to be sealed in order that such a trial might not be precluded.

Assignment for particular places.

36. A patentee may assign¹ his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.

¹ *Assignment of patents.*—See Chap. X. p. 281.

Loss or destruction of patent.

37. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may at any time cause a duplicate thereof to be sealed.

This section in substance re-enacts 15 & 16 Vict. c. 83, s. 22. The fee is 2*l.*, Form N., *infra*, p. 815.

Proceedings and costs before law officer.

38. The law officers¹ may examine witnesses on oath² and administer oaths for that purpose under this part of this Act, and may from time to time make, alter, and rescind rules³ regulating references and appeals to the law officers and the practice and procedure before them under this part of this Act; and in any proceeding before either of the law officers under this part of this Act, the law officer may order costs⁴ to be paid by either party; and any such order may be made a rule of the Court.⁵

Law officer. ¹ *The law officer* means her Majesty's Attorney-General or Solicitor-General for England; sect. 117, *infra*.

Examination of witnesses. ² *May examine witnesses on oath.*—This provision is new. The Lord Chancellor had, under the old practice, power to examine witnesses *vivâ voce* at the hearing of a petition for the Great Seal to be affixed to letters patent: *Re Gething* (1874), 9 Ch. 633. The oath is administered by the law officer himself.

Law Officers' Rules. ³ *And may from time to time make . . . rules.*—See the Law Officers' Rules, *infra*, p. 713.

4 *Power of law officer over costs.*—The Comptroller-General has no power over costs; the law officers have. See *Opposition to Grant*, p. 250. See also *Law Officers' Rules*, p. 713. The law officers award in general a lump sum for costs, and there is no taxation.

Sect. 38.
Costs.

When there is no opposition and the question is only between the Comptroller-General and the applicant, the law officer will not award costs against the Comptroller-General, nor ordinarily to him: *Re Lake*, Griff. A. P. C. 17. Under exceptional circumstances the law officer has recommended the fees payable on appeal to be returned: Griff. P. C. 16, n. In one case (*Newman's Patent* (1888), 5 R. P. C. 279), where an applicant for a patent obtained from the law officer a protecting clause, to which he was not absolutely entitled, no costs were allowed to him though successful.

In another case (*Aire and Calder Works and Walker's Application* (1888), 5 R. P. C. 347) the opponent, successful on appeal to the law officer, was allowed costs to cover the stamp on the notice of appeal.

The unsuccessful party is usually made to pay the costs: *Re Haddan*, Griff. A. P. C. 13. The costs allowed are usually a lump sum. The largest sum ever yet allowed on proceedings before the law officer is twenty guineas. It is not intended that they should be a complete indemnity to the successful party: *Stuart's Application* (1892), 9 R. P. C. 452. Where an application made to the Attorney-General to authorize revocation proceedings is abandoned, the law officer cannot give costs: *Martin's Patent*, Griff. 320.

5 The object of making the order a rule of Court is to enable the party obtaining an order for costs to enforce payment by any of the usual processes of execution available on orders of the High Court of Justice.

39. The exhibition of an invention at an industrial or international exhibition, certified¹ as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any

Exhibition at industrial or international exhibition not to prejudice patent rights.

Sect. 39. patent granted on the application, provided that both the following conditions are complied with, namely,—

- (a) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice² of his intention to do so; and
- (b) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

Whereas it is expedient to provide for the extension of this section to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows:

Protection of patents and designs exhibited at international exhibitions.
Act 1886, sect. 3.

It shall be lawful for her Majesty, by Order in Council,³ from time to time to declare that sections thirty-nine and fifty-seven of the Patents, Designs, and Trade Marks Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to her Majesty in Council may seem fit.

1 Exhibition certified as industrial or international.—In order to have an exhibition certified under this section, application must be made by the authorities controlling the exhibition or by some person interested, to the Board of Trade, and evidence produced to satisfy the Board that the exhibition is of sufficient importance, and, generally, a proper subject for the certificate. Upon being so satisfied a certificate is issued: see Form, in Appendix, p. 872. The Board of Trade communicates the issue of the certificate to the Patent Office, where a list of such certified exhibitions is kept. The notice of intention to exhibit (Patents Rules, 1890, rule 15, p. 686, and Form O., p. 815), and the description of the invention, are left at the Patent Office, and, if satisfactory, the inventor's name will be registered, and he will then be able to apply for a patent within six months of the opening of the exhibition.

The form of certificate by Board of Trade is given in Appendix, p. 872.

2 Prescribed Notice.—An intending exhibitor of an unpatented invention must (1) give the comptroller seven days' notice (Form O., *infra*, p. 815) of his intention to exhibit, publish, or use his invention, and (2) furnish the comptroller with a brief description of the invention, accompanied with drawings, if necessary, and with

such other information as the comptroller may in each case require : **Sect. 39.**
 Patents Rules, 1890, rule 15.

This section re-enacts, with modifications, 28 Vict. c. 3, and 33 & 34 Vict. c. 27.

³ The form of Order in Council granting temporary protection to inventions exhibited at the Paris Universal Exhibition, 1889, is given in Appendix, p. 872.

40. (1.) The comptroller shall cause to be issued periodically an illustrated journal of patented inventions,¹ as well as reports of patent cases decided by Courts of law,² and any other information that the comptroller may deem generally useful or important.³

Publication
of illustrated
journal,
indexes, &c.

(2.) Provision shall be made by the comptroller for keeping on sale copies of such journal, and also of all complete specifications⁴ of patents for the time being in force,⁵ with their accompanying drawings, if any.

(3.) The comptroller shall continue, in such form as he may deem expedient, the indexes and abridgments of specifications hitherto published, and shall from time to time prepare and publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he may see fit.⁶

¹ *An illustrated journal of inventions.*—The journal forms part of *The Illustrated Official Journal (Patents)*, which appears every week.

² *Reports of Patent Cases.*—These are appended to the official journal. Formerly they were published separately. There were no official reports of patent cases until 1884. These reports commence with commencement of the principal Act, Jan. 1st, 1884.

³ *Any other information.*—*E.g.*, Patent Office circular.

⁴ *Complete specifications.*—Where an application for a patent has been abandoned or become void, the specification or specifications and drawings, if any, accompanying or left in connection with such application, shall not at any time be open to public inspection, or be published by the comptroller.

Abandoned
application.

⁵ *Specifications of patents in force.*—Printed copies of specifications of patents in force are kept on sale at the Patent Office (Sale Branch), and if the original edition has been exhausted, a further edition will

Sect. 40. be printed by the comptroller, if the specifications are required, at the public expense. Where the patent has expired, whether by non-payment of renewal fees or otherwise, the comptroller is not bound to keep printed copies on sale, and if the stock has run out any person wanting printed copies must pay the cost of reprinting and lithographing the drawings, if any.

6 Patent Office publications.—See list of such publications, *supra*, p. 114.

Patent
Museum.

41. The control and management of the existing Patent Museum and its contents shall, from and after the commencement of this Act, be transferred to and vested in the Department of Science and Art, subject to such directions as her Majesty in Council may see fit to give.¹

1 Patent Museum.—See *supra*, Chap. IV.

Power to
require
models on
payment.

42. The Department of Science and Art may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model; the amount to be settled, in case of dispute, by the Board of Trade.

No demand for models seems now ever to be made by the Patent Office. The few additions made to the Patent Museum at South Kensington, appear to be voluntary gifts.

Foreign
vessels in
British
waters.

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

(2.) But this section shall not extend to vessels of any foreign state of which the laws authorize subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such

inventions in British vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its Courts, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign state.¹ Sect. 43.

¹ *User by foreign vessels in British waters.*

Prior to 15 & 16 Vict. c. 83, s. 26—of which the present section is substantially a re-enactment—the exclusive rights under an English patent were enforced against foreigners while in England, in the same way and to the same extent as against British subjects.

Therefore, in a case in which the foreign owners of a ship caused to be made in their own country, and attached to their vessel, a steam screw propeller, the manufacture and user of which was unrestrained by law there, but restricted in England by a patent, and afterwards sent the vessel with a cargo for the purpose of trade to England, the use of the steam propeller was restrained by injunction while the vessel should be within the waters covered by the English patent: *Caldwell v. Vanlissengen* (1851), 21 L. J. Ch. 97; 9 Hare 415.

44. (1.) The inventor of any improvement in instruments or munitions of war, his executors, administrators, or assigns (who are in this section comprised in the expression the inventor) may (either for or without valuable consideration) assign to her Majesty's Principal Secretary of State for the War Department (hereinafter referred to as the Secretary of State), on behalf of her Majesty,¹ all the benefit of the invention and of any patent obtained or to be obtained for the same; and the Secretary of State may be a party to the assignment.

Assignment to Secretary for War of certain inventions.

(2.) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State for the time being on behalf of her Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Secretary of State for the time being.

(3.) Where any such assignment has been made to the

Sect. 44. Secretary of State, he may at any time before² the application for a patent for the invention, or before publication of the specification or specifications,³ certify to the comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4.) If the Secretary of State so certifies, the application and specification or specifications with the drawings (if any), and any amendment of the specification or specifications, and any copies of such documents and drawings, shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the comptroller⁴ in a packet sealed by authority of the Secretary of State.

(5.) Such packet shall until the expiration of the term or extended term during which a patent for the invention may be in force, be kept sealed by the comptroller, and shall not be opened save under the authority of an order of the Secretary of State, or of the law officers.

(6.) Such sealed packet shall be delivered at any time during the continuance of the patent to any person authorized by writing under the hand of the Secretary of State to receive the same, and shall if returned to the comptroller be again kept sealed by him.

(7.) On the expiration of the term or extended term of the patent, such sealed packet shall be delivered to any person authorized by writing under the hand of the Secretary of State to receive it.

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

Sect. 44.

(9.) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which the Secretary of State has certified as aforesaid.

(10.) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but save as in this section otherwise directed, the provisions of this part of this Act shall apply in respect of any such invention and patent as aforesaid.

(11.) The Secretary of State may, at any time by writing under his hand, waive the benefit of this section with respect to any particular invention, and the specifications, documents and drawings shall be thenceforth kept and dealt with in the ordinary way.

(12.) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State, or to any person or persons authorized by him to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

This section is substantially a re-enactment of 22 Vict. c. 13.

For "Memorandum for Inventors," issued by the War Office with regard to applications under this section, and as to other inventions or patents, see p. 873.

There have been very few assignments to the Secretary of State for War under the provisions of this section. The following are instances:—12,883 of 1884, 6,168 of 1886, 3,503 of 1888, 5,614 of 1889, all of which were kept secret. But assignments where the specifications are not kept secret are more common. An example is 15,792 of 1887. Applications to the War Office as to inventions, whether patented or not, are made by letter addressed to the Under Secretary of State for War, stating the nature of the invention and the reward asked for, if any, by the inventor.

¹ Apart from this section, it is perhaps doubtful if the Sovereign

Sect. 44. could take an assignment of his own grant, as it would be equivalent to a grant to himself. Hence the necessity of this provision.

2 In which case the specifications are not examined by an examiner, and the patent appears to be granted without any inquiry by the Patent Office.

3 Where the provisional specification only has been left, or before acceptance of the complete specification, the Secretary of State for War can step in when the benefit of the invention has been assigned to him.

4 Such secret specifications are kept by the comptroller personally, and not placed in the usual way on the file.

EXISTING PATENTS.¹

Provisions
respecting
existing
patents.

45. (1.) The provisions of this Act relating to applications for patents and proceedings thereon shall have effect in respect only of applications made after the commencement of this Act.²

(2.) Every patent granted before the commencement of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act, relating to patents binding the Crown, and to compulsory licences.³

(3.) In all other respects (including the amount and time of payment of fees)⁴ this Act shall extend to all patents granted before the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.⁵

(4.) All instruments relating to patents granted before the commencement of this Act required to be left or filed in the Great Seal Patent Office shall be deemed to be so left or filed if left or filed before or after the commencement of this Act in the Patent Office.

¹ Sub-sect. 1. *Existing patents.*—This section—especially sub-sect. 3 thereof—must be read to a certain extent with sect. 113, *infra*. In *Brandon's Patent* (1884), 1 R. P. C. 154; see also *Singer v. Stassen*, (1884) 1 R. P. C. 121) 9 A. C. 589, where this matter was discussed.

2 *Applications*.—The applications under the Act of 1852, pending at the time of the commencement of the Act of 1883, were completed under the procedure laid down in the earlier Act. **Sect. 45.**

3 The provisions as to patents binding the Crown are new in the Act of 1883. See sect. 27. The provisions of sect. 22, as to compulsory licences, are likewise new. The effect of this sub-section is to restrict the operation of these new provisions to applications made after January 1st, 1884. **Sub-sect. 2.**

4 The payment of annual fees on patents applied for under Act of 1852, where the third year's renewal fee of 50*l.* had been paid in lieu of the payment of 100*l.* before the end of the seventh year, was regulated by an order of the Board of Trade, made under their general powers under this Act, in August, 1884. See now schedule to rules of 1892, *post*, p. 710.

5 *General effect of Act of 1883*.—This sub-section must be read with sect. 113, and, apparently, in subordination thereto. **Sub-sect. 3.**

In *Singer v. Stassen* (1884), R. P. C. 121, Bowen, L. J., said, that old patent rights and old patent liabilities are affected by the substantial legislation which the statute contains, but the express repeal of the old law contained in sect. 113 is not to affect them. It appears, therefore, that sect. 18 as to amendment, and sect. 19 as to disclaimer pending action, apply to all existing patents applied for under the Act of 1852: *Singer v. Stassen, supra*.

As to the effect of sect. 25 of the Act of 1852, providing for the falling of a British patent with any prior foreign patent, see *Blake's Patent* (1873), L. R. 4 P. C. 535; and *Winan's Patent* (1872), L. R. 4 P. C. 93.

DEFINITIONS.¹

46. In and for the purposes of this Act—

“Patent”^{1a} means letters patent for an invention:

“Patentee”² means the person for the time being entitled to the benefit of a patent:

“Invention”³ means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled “An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof”), and includes an alleged invention.

Definitions
of patent,
patentee, and
invention.

Sect. 46. In Scotland “injunction” means “interdict.”

1 For other definitions, see sect. 117, at p. 663.

1a *Patent*.—As to other grants by letters patent, see p. 1.

2 *Patentee*.—This definition includes an executor, administrator, or assignee; and “person” includes persons. See 13 & 14 Vict. c. 21, s. 4, and also *Powell v. Head*, 1879, L. R. 12 C. D. at p. 686.

3 *Invention*.—As to subject-matter of patents, see Chap. III.

By the definition of “invention” here given, the law as to what inventions are valid subject-matter for a patent is retained intact as it existed prior to the Act of 1883. See *ante*, Chap. III.

PART III.

DESIGNS.

PART IV.

TRADE MARKS.

PART V.

GENERAL.

PATENT OFFICE AND PROCEEDINGS THEREAT.

Patent Office. **82.** (1). The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.¹

(2.) Until a new Patent Office is provided,² the offices of the Commissioners of Patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the Patent Office within the meaning of this Act.

(3.) The Patent Office shall be under the immediate control of an officer called the comptroller-general of patents, designs, and trade marks,³ who shall act under the superintendence and direction⁴ of the Board of Trade.

(4.) Any act or thing directed to be done by or to the comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorized by the Board of Trade. Sect. 82.

¹ *The Patent Office.*—For a full account of the history and present constitution of the Patent Office, and of the business transacted therein, see *ante*, Chap. IV.

² *New Patent Office.*—No new Patent Office has been provided. The former "Great Seal Patent Office" is still under the name of the "Patent Office," the building in which the official patent business is carried on.

³ *The Comptroller-General.*—The comptroller has the general superintendence of the Patent Office under the Board of Trade.

⁴ *Who shall act under, &c.*—The comptroller is further enabled by sect. 95, *infra*, to apply to either of the law officers for directions in any case of doubt or difficulty.

83. (1.) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller-general of patents, designs, and trade marks,¹ and so many examiners² and other officers and clerks with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks. Officers and clerks.

(2.) The salaries³ of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

¹ *Appointment of comptroller.*—Sir H. Leader Lack was appointed comptroller-general on the new Act coming into force.

² *Examiners.*—See *ante*, Chap. IV.

³ As to salaries of such officers and clerks, see Comptroller-General's Reports.

84. There shall be a seal for the Patent Office, and Seal of Patent Office.

Sect. 84. impressions thereof shall be judicially noticed and admitted in evidence.

Trust not to be entered in registers.

85. There shall not be entered in any register kept under this Act,¹ or be receivable by the comptroller, any notice of any trust expressed, implied or constructive.

¹ *Any register kept under this Act.*—As to the register, see Chap. XI., *ante*.

As a matter of fact, many deeds which are now filed in the Patent Office contain declarations of trust in favour of other parties. But in the notification of the deed in the register itself, no notice is taken of the trust. As regards patents, it has been decided that an equitable assignment of a patent, or share in it, may be put upon the register: *Stewart v. Casey* (1892), 1 Ch. 104; 61 L. J. Ch. 61; 9 R. P. C. 9. And see *Haslett v. Hutchinson* (1891), 8 R. P. C. 457. If the assignment is not to be found in documents complete in themselves it will not be registered: *Re Fletcher's Patent* (1893), 10 R. P. C. 252.

Refusal to grant patent, &c., in certain cases.

86. The comptroller may refuse¹ to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality.

¹ *Refusal of comptroller.*—As to exercise of discretionary power by comptroller, see rules 11—14, *post*, p. 686. See also sect. 94, *post*.

It is stated that under this section a patent has been refused for an apparatus for a lottery: Griff. P. C. p. 30.

Entry of assignments and transmissions in registers.

87. Where a person becomes entitled by assignment,¹ transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor^{1a} of the patent, copyright in the design, or trade mark, in the register of patents, designs, or trade marks, as the case may be. The person for the time being entered in the register² of patents, designs, or trade marks, as proprietor of a patent, copyright in a design, or trade mark as the case may be, shall, subject to the provisions of this Act and to any rights appearing from such register to be vested in

Act 1888,
sect. 21.

any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the same and to give effectual receipts for any consideration for such assignment, licence, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property.³ Sect. 87.

¹ *Assignment, &c.*—As to assignments and licences, see *ante*, Chap. X., and sect. 36. As to assignments to the Secretary of State for War, see *ante*, p. 635.

As to the Register, see sect. 23, and *ante*, p. 309.

See also Rules, 1890, rules 67 *et seq.*, &c., *infra*, p. 704, and Forms, p. 822.

The stamp is the same as for an original registration: see Schedule of Fees, *post*, p. 710.

Assignments should be under seal: *Re Casey's Patents* (1892), 1 Ch. 104. As to equitable assignments, see *ante*, p. 286.

^{1a} There is jurisdiction under this section to change the name on the register when the registered owner changes his name: *Ex parte New Ormonde Cycle Co., Ltd.* (1896), 2 Ch. 520; 13 R. P. C. 475.

² *The Register of Patents.*—See *ante*, pp. 309 *et seq.*, and note to sect. 23.

³ Trusts are not entered on the register, see *ante*, sect. 85, and note thereto. Mortgagees may be entered on the register as such; as to the effect of this, see *Van Gelder v. Sowerby Bridge Flour Mills* (1890), 44 Ch. Div. 374; 7 R. P. C. 208.

Under the Act a right of assignment for particular districts is given (sect. 36); but the right to assign at all depends entirely on the words of the patent. An assignee, whether of a share or of the entirety, takes the legal interest, and is not to be considered merely as a licensee: *Walton v. Lavater* (1860), 29 L. J. C. P. 275; 8 C. B. N. S. 162.

“In the case of a patent belonging to several persons in common,” says Lindley, L. J., in his work on Partnership, “each co-owner can assign his share, and sue for an infringement, and can also work the patent himself, and gives licences to work it; and it is now settled that he is entitled to retain for his own benefit whatever profit he may derive from the working, although it is perhaps still open to question whether he is not liable to account for what he receives in respect of the licences.”

Sect. 87.

It appears to be the law that while an assignee cannot sue until his assignment has been registered, registration relates back to the date of the assignment: *Chollett v. Hoffman* (1857), 26 L. J. Q. B. 249.

Under a covenant in a deed of assignment to communicate improvements to the assignees, a patentee cannot be restrained from giving evidence against the assignees as a scientific witness, under a subpoena; nor can he be prevented from disclosing any information in his possession which may tend to show that the patents assigned were invalid: *London and Leicester Hosiery Co. v. Griswold* (1886), 3 R. P. C. 251. During an action for infringement, the defendants assigned their business, and then obtained an order in Chambers to add the assignees as third parties. On appeal to the Judge in Court the order was discharged: *Briggs v. Lardour* (1885), 2 R. P. C. 13.

Inspection
of and ex-
tracts from
registers.

Act 1888,
sect. 22.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and to such regulations as may be prescribed;¹ and certified copies,² sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.³

¹ See sect. 23 and rule 78, *post*, p. 706.

² *And certified copies.*—See sect. 96 and rule 79.

³ *Prescribed fee.*—The fee for a copy is 4*d.* per folio, but not less than 1*s.* in all. A certified copy is necessary when it is proposed to put a copy in evidence: Kekewich, J., in *Haslett v. Hutchinson* (1891), 8 R. P. C. 457.

If the copy is to be certified, the fee is 1*s.* for certifying, plus the cost of copying. See *post*, p. 711.

Sealed copies
to be received
in evidence.

89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

The register is *prima facie* evidence of any matters by this Act directed or authorized to be inserted therein: sect. 23, sub-sect. 2.

90. (1.) The Court¹ may, on the application of any person aggrieved² by the omission without sufficient cause of the name of any person³ or of any other particulars from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry,⁴ as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs⁵ of the proceedings as the Court thinks fit.

Sect. 90.

Rectification
of registers
by Court.

**Act 1888,
sect. 23.**

(2.) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages⁶ to the party aggrieved.

(3.) Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the comptroller.

This section applies to all the subjects comprised in the present Act, and much information may be obtained from the cases on Designs and Trade Marks. As to costs, see *La Compagnie Générale, &c.* (1891), 3 Ch. 458.

¹ The High Court of Justice in England has jurisdiction (sect. 117. *post*), even though the registered proprietor be domiciled in Scotland or Ireland: *Re King & Co.'s Trade Mark* (1892), 2 Ch. 462; 62 L. J. Ch. 153; 9 R. P. C. 356. Whether the Scotch or Irish Courts have a concurrent jurisdiction, *quære*: *Ibid.*

Orders made under this section can be appealed against like any other orders of Court. The order is for the purpose of notice of appeal a final one.

Service of the notice or summons on a person domiciled abroad will not be allowed; but, notice of the proceedings having been given to such persons, the Court may make the order. See *Drummond's Patent* (1889), 43 Ch. Div. 80; 6 R. P. C. 576; *Kay's Patent* (1894), 11 R. P. C. 279; *King & Co.'s Trade Mark, supra*; *La Compagnie Générale D'Eaux, &c.* (1891), 3 Ch. 451; 8 R. P. C. 446; and *Re Cliff* (1895), 2 Ch. 21; 64 L. J. Ch. 423. See remarks of North, J., in *Goerz's case* (1895), 12 R. P. C. 370.

Sect. 90.

2 For those falling under the class of "persons aggrieved," see *Re Rivière's Trade Mark* (1884), 26 Ch. Div. 48; 53 L. J. Ch. 455, 578; *Re Apollinaris Co.'s Trade Marks* (1891), L. R. 2 Ch. 186; 8 R. P. C. 137; *Re Talbot's Trade Marks* (1894), 63 L. J. Ch. 264; 11 R. P. C. 77; and *Re Powell's Trade Mark* (1893), 2 Ch. 388, and (1894), A. C. 8; 10 R. P. C. 195; 11 R. P. C. 4. The whole subject is dealt with *ante*, p. 318.

The following cases under the Patent Law Amendment Act, 1852, sect. 38, will illustrate the practice:—

A patentee having assigned his patent to persons who omitted to register the assignment, afterwards *fraudulently* assigned the patent to another person, who registered it on the same day. The first assignees registered their assignment a week afterwards. The Court, on the motion of the first assignees, ordered the register of the second assignment to be expunged, and with costs: *Re Green's Patent* (1857), 24 Beav. 145.

A patentee assigned half his patent to A., and afterwards he assigned the whole to B. by deed, reciting that he had already granted a licence to work and use to A. B.'s assignment was first registered. It was held that B. had constructive notice of A.'s rights, and an entry was ordered to be made in the register that the licence referred to in B.'s assignment was the deed of assignment to A. subsequently entered: *Re Morey's Patent* (1858), 25 Beav. 581; 6 W. R. 612. It was also held in this case that the Court could, in a motion under 15 & 16 Vict. c. 83, s. 38, direct any *facts* relating to the proprietorship to be inserted on the register, but not the legal inference to be drawn from them.

One of two joint patentees by deed assigned his interest in the patent to a third person, and released to him all the rights of action, &c., against him, of both the patentees, and the deed was set out completely in the register of proprietors. It was held that the other patentee was entitled under 15 & 16 Vict. c. 83, s. 38, to have the entry struck out: *In re Horsley and Knighton's Patent* (1869), L. R. 8 Eq. 475; 39 L. J. Ch. 157.

3 This will not of itself enable a person to appeal to the Court from the refusal of the comptroller or of the Board of Trade to make an entry: *Re the Trade Mark "Normal"* (1886), 35 Ch. Div. 231; 4 R. P. C. 123.

4 Apparently this does not empower the Court to substitute the name of the true proprietor for the name of the person improperly on the register: *Re Guiterman's Design*, *infra*; and see *ante*, p. 643. North, J., said that where a registered owner of a trade mark changed

his name and desired to have the register altered so that the trade mark should stand in the new name, application might be made under sect. 87: *Ex parte the New Ormonde Cycle Co., Ltd.* (1890), 2 Ch. 520; 13 R. P. C. 475.

Sect. 90.

The costs would ordinarily have to be paid by the unsuccessful party (e.g., *Guiterman's Design* (1886), 55 L. J. Ch. 309), unless that party is the comptroller, but the matter is discretionary.

6 *Ante*, p. 317.

91. The comptroller may, on request in writing¹ accompanied by the prescribed fee,²—

Power for comptroller to correct clerical errors.

(a) Correct any clerical error in or in connexion with an application for a patent, or for registration of a design or trade mark; or

(b) Correct any clerical error in the name, style, or address of the registered proprietor of a patent, design, or trade mark.

(c) [This sub-section relates only to trade marks.]

(d) [This relates only to designs or trade marks.]

Act 1888, sect. 24.

¹ *Request in writing*.—See Form P *infra*, p. 815.

² *Prescribed fee*.—Fee No. 34, *post*, p. 711.

92. [This section relates only to trade marks.]

93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour.

Falsification of entries in registers.

As to punishment of misdemeanours in Isle of Man, see sect. 112, *post*.

94. Where any discretionary power¹ is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or

Exercise of discretionary power by comptroller.

Sect. 94. design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

1 Cp. rules 11—14, *infra*, p. 686.

Power of
comptroller
to take direc-
tions of law
officers.

95. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for directions in the matter.

By sect. 82, sub-sect. 3, the comptroller acts under the superintendence of Board of Trade.

Applications to the law officers are not infrequently made under this section, especially in cases of legal questions arising as to the construction of provisions of the Act in the practice of the Patent Office.

Certificate of
comptroller
to be
evidence.

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

See Rules, 1890, rule 79 ; *infra*, Form Q, p. S16.

Applications
and notices by
post.

97. (1.) Any application, notice, or other document authorized or required to be left, made or given at the Patent Office or to the comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2.) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

In *Trotter v. Maclean* ((1879), L. R. 13 Ch. D. 574; 49 L. J. Ch. 256), a witness produced a copy of a letter which he said he had made, and swore that he should in the ordinary course of business have posted the original, and it was held that this was evidence of the posting, and that the original not being produced the copy was good secondary evidence.

Sect. 97.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the Patent Office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day or days, if two or more of them occur consecutively.

Provision as to days for leaving documents at office.

As to enlargement of time : Patent Rules, 1890, rule 51.

As to hours of inspection : Patent Rules, 1890, rule 78.

99. If any person is, by reason of infancy, lunacy or other inability, incapable of making any declaration or doing anything required or permitted by this Act, or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any Court or Judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

Declaration by infant, lunatic, &c.

So long as the necessary documents are prepared in the prescribed

Sect. 99. manner there is nothing to prevent the grant to an infant, and the age, sanity, or coverture of an applicant is in no way inquired into by the office or referred to in any of the proceedings to obtain registration. In the case of an inventor becoming insane before applying for his patent, it is presumed the application might be made for him under this section, also that other steps might, under this section, be taken for him in the event of insanity after application.

See Rules, 1890, rule 80, *post*, p. 707, as to the power of the controller to dispense with evidence.

Transmission of certified printed copies of specifications, &c.

100. Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

See sect. 40.

This section re-enacts, with modifications, 16 & 17 Vict. c. 115, sect. 5.

Power for Board of Trade to make general rules for classifying goods and regulating business of Patent Office.

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

- (a) For regulating the practice of registration under this Act;
- (b) For classifying goods for the purposes of designs and trade marks;
- (c) For making or requiring duplicates of specifications, amendments, drawings, and other documents;

- (d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, amendments, and other documents ;
- (e) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office, and providing for the inspection of indexes and abridgments and other documents ;
- (f) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications, to patentees and to public authorities, bodies, and institutions at home and abroad ;
- (g) Generally for regulating the business of the Patent Office and all things by this Act placed under the direction or control of the comptroller or of the Board of Trade.

Sect. 101.

(2.) Any of the forms in the first schedule to this Act may be altered or amended by rules made by the Board as aforesaid.

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5.) If either House of Parliament, within the next

Sect. 101. forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

And see the Rules Publication Act (56 & 57 Vict. c. 66). For a discussion of the question whether the Court has power to declare the rules *ultra vires*, see *Institute of Patent Agents v. Lockwood* (1894), L. R. App. Ca. 347; 11 R. P. C. 374.

Annual
reports of
comptroller.

102. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

1 This Report is made annually, and is the continuation of the Commissioners of Patents Annual Reports made under the Act of 1852. The report is usually issued in June. The first report was made on the working of the Act of 1883 for the first three months of 1884. Afterwards a report was made for the whole year, and there is now one report a year under this section.

The report of the comptroller gives information, amongst other things, upon the following matters (so far as patents are concerned) :—

The number of applications and patents sealed.

A table of the sources whence the applications come, giving the number of applications from persons in the United Kingdom and in various countries and colonies.

The number of applications by way of communication.

The number of applications under the International Convention.

The number of patents remaining in force.

The publications of the Patent Office and of the grants made to various libraries, &c.

Particulars of amendments, oppositions, applications for prolongation to Privy Council, applications to Board of Trade for compulsory licences, &c.

Sect.102.

An account of the receipts and expenditure of the office.

102a. (1.) All things required or authorized under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

Proceedings
of Board of
Trade.

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

Act 1888,
sect. 25.

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

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

103. (1.) If Her Majesty is pleased to make any arrangements with the government or governments of any foreign state or states¹ for mutual protection of inventions, designs, and trade marks, or any of them,² then any person³ who has applied for protection for any invention, design, or trade mark in any such state, shall be entitled to a patent for his invention or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants;⁴ and such patent or registration shall have the same date as the [date of the protection obtained] date of the application⁵ in such foreign state.

International
arrangements
for protection
of inventions,
designs, and
trade marks.

Act 1885,
sect. 6.

Provided that his application is made, in the case of a patent within seven months,⁶ and in the case of a design or trade mark within four months, from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete

Sect.103. specification, or the actual registration of his design or trade mark in this country, as the case may be.

(2.) The publication,⁷ in the United Kingdom, or the Isle of Man, during the respective periods aforesaid, of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark:

(3.) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner, as an ordinary application,⁸ under this Act: provided that, in the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act:

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which her Majesty shall from time to time by Order in Council⁹ declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

¹ *Arrangements with foreign States.*—For a complete list of the States with which such arrangements have been made, see *ante*, p. 536.

² *Mutual protection of inventions, designs, and trade marks.*—The International Convention seems to contemplate a wider scope, but its operation in Great Britain appears to be limited to the subjects above mentioned, except in so far as the ordinary legal remedies are equally available to foreigners and British subjects.

³ *Any person.*—*Seem* a corporation is a "person," and can claim rights under this section: *Re Carez* (1889), 6 R. P. C. 552, and see sect. 117, *infra*.

Sect. 103.

A patent under the International Convention and sect. 103 can be granted only to the person who has made the foreign application: *Re Carez (supra)*. A communicatee of an invention from abroad cannot claim any rights under this section: *Re Shallenberger (1889)*, per Webster, A.-G., 6 R. P. C. at p. 551.

"Person" includes citizen and foreigner alike: *Re Shallenberger (supra)*.

In *Main's Patent (1890)*, 7 R. P. C. 13, Webster, A.-G., held that an applicant was entitled to have his English application antedated, although his foreign application was made before the country in which it was made had come under sect. 103.

4 In priority to other applicants.—See *L'Oiseau and Pierrard*, Griff. A. P. C. 36.

This section does not give a foreign applicant any right of opposing, under sect. 11, the grant of a subsequent patent: *Re Everitt (1888)*, Griff. A. P. C. 28.

5 Date of the application.—These words were, at the instigation of Lord Herschell (*L'Oiseau and Pierrard, ubi supra*), substituted for the words in italics by sect. 6 of the Act of 1885. In one case where the foreign application was a renewed application, the seven months were allowed to date from this renewed and not from the original application: *Van Poole's Application (1890)*, 7 R. P. C. 69.

6 See the International Convention, Art. 4, *post*, p. 727.

But the statute is not to be interpreted by the Convention: *Re Californian Fig Syrup Co. (1889)*, 40 Ch. Div. 620; 6 R. P. C. 126.

7 See the Convention, Art. 4. The section protects against prior publication, but not against any other objection to the sealing of a patent: *Carter's Trade Mark (1892)*, 9 R. P. C. 401.

Protection to this extent is granted only if the application is made under this section, in which case the patent dates back to the foreign application. If application in ordinary form is made, the patent dates from the English application, but then the protection of this section is lost; the dates will be an index to the course intended to have been pursued: *British Tanning Co. v. Groth (1891)*, 8 R. P. C. 113.

8 See the procedure to be followed under this section in the Patents Rules, 1890, rules 24—29, pp. 691 *et seq.*

9 See table of these Orders in Council, *supra*, p. 536.

The general effect of this section and its relation to the International Convention are discussed in Chap. XVIII.

Sect. 104.

Provision for
Colonies and
India.

104. (1.) Where it is made to appear to her Majesty that the legislature of any British possession¹ has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for her Majesty from time to time by Order in Council² to apply the provisions of the last preceding section, with such variations or additions, if any, as to her Majesty in Council may seem fit, to such British possession.

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for her Majesty in Council to revoke any Order in Council made under this Act.

¹ *British possession*.—See sect. 117, sub-sect. 1.

² *Order in Council*.—See list of such Orders in Council, *supra*, p. 536.

OFFENCES.

Penalty on
falsely repre-
senting
articles to be
patented.

105. (1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

(2.) A person shall be deemed, for the purpose of this enactment, to represent that an article is patented or a design or a trade mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

A person cannot mark his invention "patented," although he has (a) applied for a patent (*Reg. v. Crampton* (1886), 3 R. P. C. 367), or (b) obtained provisional protection (*Reg. v. Wallis* (1886),

3 R. P. C. 1), unless or until a complete specification has been accepted, in which case it may be that under sect. 15 the applicant is entitled to do so.

Sect.105.

This section does not apply to a case of false representation of an expired patent as still subsisting: *Gridley v. Swinborne* (Law Journal, 1894, p. 683). Cp. *Cheavin v. Walker* (1877), 5 Ch. Div. 850; 46 L. J. Ch. 686; *Marshall v. Ross* (1869), 8 Eq. 651.

106. Any person who, without the authority of her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connection with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

Penalty on unauthorized assumption of Royal arms.

SCOTLAND, IRELAND, ETC.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor,¹ shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts.

Saving for Courts in Scotland.

For the purposes of this section "Court of Appeal" shall mean any Court to which such action is appealed.

¹ An assessor.—Sect. 28, p. 612.

United Horse Shoe and Nail Company v. Stewart (1885), 2 R. P. C. 127, and *Mackie v. Berry* (1885), 2 R. P. C. 146, were tried before a Lord Ordinary of the Court of Session (Lord Kinneir) and an assessor—the late Mr. Fleming Jenkin, Professor of Engineering in Edinburgh University

Sect. 108.

Summary
proceedings
in Scotland.

108. In Scotland any offence¹ under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

¹ *Offence.*—As to what are offences under the Act, see Chap. XIX.

Proceedings
for revocation
of patent in
Scotland.

109. (1.) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

Reservation
of remedies in
Ireland.

110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland¹ only.

¹ *Ireland.*—Prior to the Act of 1852, an English patent did not extend to Ireland or Scotland.

Under the Act of 1852, Ireland, as well as Scotland, was embraced in the grant, but sect. 29 of that statute contained a saving clause similar in terms to the present section. In *Bovill v. Finch* (1870), L. R. 5 C. P. 523, a case decided under the old law, three separate original letters patent had been granted in 1849 to an inventor for England, Scotland, and Ireland respectively. The Scotch patent was void for want of novelty, and afterwards a prolongation of the terms of the three original patents was granted by one and the same letters patent under the Great Seal of the United Kingdom, pursuant to 15 & 16 Vict. c. 83. It was held that the grant of prolongation was divisible, and operated as if there had been separate grants by separate instruments for the three countries, so that the prolongation of the English patent was not rendered void by the invalidity of the Scotch patent. In delivering judgment, however, Montague Smith, J., said, "We do not, however, deem it necessary to decide what would be the effect of the want of novelty in one kingdom in the case of an original grant for the three kingdoms under one seal."

General
saving for
jurisdiction
of Courts.

111. (1.) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect

the jurisdiction of any Court in Scotland or Ireland in Sect. 111.
 any proceedings relating to patents, or to designs, or to
 trade marks; and with reference to any such proceedings
 in Scotland, the term "the Court" shall mean any Lord
 Ordinary of the Court of Session, and the term "Court
 of Appeal" shall mean either division of the said Court;
 and with reference to any such proceedings in Ireland,
 the terms "the Court" and the "Court of Appeal"
 respectively mean the High Court of Justice in Ireland
 and Her Majesty's Court of Appeal in Ireland.

(2.) If any rectification of a register¹ under this Act is
 required in pursuance of any proceeding in a Court in
 Scotland or Ireland, a copy of the order, decree, or other
 authority for the rectification, shall be served on the
 comptroller, and he shall rectify the register accord-
 ingly.

¹ *Rectification of register.*—See notes to sect. 90, p. 465, and
 pp. 316 *et seq.* This section does not confer an exclusive jurisdiction
 on the Scotch or Irish Courts, though the registered owner be
 resident in Scotland or Ireland: *Re King and Co.'s Trade Mark*
 (1892), 2 Ch. 462; 10 R. P. C. 350.

112. This Act shall extend to the Isle of Man,¹ and— Isle of Man.

(1.) Nothing in this Act shall affect the jurisdiction of
 the Courts in the Isle of Man, in proceedings
 for infringement or in any action or proceeding
 respecting a patent, design, or trade mark com-
 petent 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 dis-
 cretion 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,

Sect. 112.

and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

1 A patent granted under the International Convention does not extend to the Isle of Man.

Jurisdiction
of Lancashire
Palatine
Court.

Act 1888,
sect. 26.

Repeal and
saving for
past opera-
tion of re-
pealed enact-
ments, &c.

112a. [This section relates only to trade marks.]

REPEAL, TRANSITIONAL PROVISIONS, SAVINGS.

113. The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

- (a) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or
- (b) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or
- (c) Take away or abridge any protection or benefit in relation to any such action or proceeding.

Construction
of principal
Act.

Act 1888,
sect. 27.

The principal Act shall, as from the commencement of this Act, take effect subject to the additions, omissions, and substitutions required by this Act, but nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act.

See also sect. 45, *supra*, and the notes thereto.

The provisions of sub-section (a) must be read distributively, and if so read they declare that the enactments of the Act of 1883 shall not affect any patent granted before the commencement of the Act; and they also declare that those enactments shall not affect any *right or privilege* which had accrued to the grantee before or at the commencement of this Act: *Brandon's Patent* (1884), 1 R. P. C. 154; 9 A. C. 589. But the patentee must take his rights subject to such limitations as prior Acts have put on them; he cannot claim the rights under a repealed Act and claim to have the advantage of the repeal of a statute which would, before 1883, have limited his right: *Re Jablockhoff's Patent* (1891), App. Ca. 293; 8 R. P. C. 281; and contrast *Smet and Solway's Patent* (1895), App. Ca. 78; 12 R. P. C. 10.

In *Singer v. Stassen* ((1884) 1 R. P. C. 121 (cp. also *Hearson's Patent* (1884), Griff. P. C. 310)), the effect of this section upon the general body of the Act, as it affects patents applied for under the Act of 1852, was very fully considered in the Court of Appeal. In this case an action of infringement was commenced in 1883, and in 1884 an application was made by the plaintiff for liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer. The defendants objected that sect. 19 of the Act of 1883 did not apply to actions pending at the date of its coming into operation, and that the right of the defendants not to have a disclaimer put in evidence in such an action, by virtue of the proviso of 5 & 6 Will. IV. c. 83, s. 1, was saved by sect. 113 of the Act of 1883. Bowen, L. J., summarized the effect of sect. 113 on the effect of the Act of 1883 on patents applied for under the Act of 1852, as follows:—"Old patent rights and old patent liabilities are affected by the substantial legislation which the statute contains, but the express repeal of the old law contained in sect. 113 is not to affect them. They will be still protected by the keeping in force for their benefit of any of the old enactments which are required to safeguard vested rights or interests to the extent to which sect. 113 means it to apply. There is nothing, therefore, which prevents sect. 19 applying to old patents and old patent rights."

See also the trade marks cases:—*Hayward's Trade Marks*, 54 L. J. Ch. 1003, and *Jackson v. Napper*, 35 Ch. Div. 162. See also *Wittman v. Oppenheim*, 27 Ch. Div. 260.

114. (1.) The registers of patents and of proprietors¹ kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act.

Former registers to be deemed continued.

Sect. 114.

(2.) The registers of designs and of trade marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of designs and the register of trade marks kept under this Act.

1 Old Registers.—See *ante*, p. 310, where the relation of the Register of Patents and the Register of Proprietors under the Act of 1852, to the Register of Patents and the accompanying *file* under the Act of 1883, is referred to.

Saving for
existing rules.

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed, altered, or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal, alteration, or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

See Patents Rules 1890, rule 81. New rules for Patents, Designs, and Trade Marks were issued early in 1890, consolidating and amending previous rules made under this Act, which were repealed.

Saving for
prerogative.

116. Nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

As to effect of patent against Crown, see sect. 27, *supra*, p. 610. This section is very important. Apparently, under it, there is nothing to prevent the Crown granting a patent for an invention altogether outside the procedure laid down in the Patents Acts, 1883—88, provided only the grant be within the common law prerogative, as modified by the Statute of Monopolies. It would also seem to imply that a patent granted under this Act is merely

a matter of grace and not of right, even if all the provisions of the Act are complied with. **Sect. 116.**

GENERAL DEFINITIONS.

117. (1.) In and for the purposes of this Act, unless the context otherwise requires,— General definitions.

“Person”¹ includes a body corporate :

“The Court”² means (subject to the provisions for Scotland, Ireland, and the Isle of Man) her Majesty’s High Court of Justice in England :

“Law officer” means her Majesty’s Attorney-General or Solicitor-General for England :

“The Treasury” means the Commissioners of Her Majesty’s Treasury :

“Comptroller” means the Comptroller-General of Patents, Designs, and Trade Marks :

“Prescribed” means prescribed by any of the Schedules to this Act, or by general rules under or within the meaning of this Act :

“British possession” means any territory or place situate within her Majesty’s dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man, and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act :

“Legislature” includes any person or persons who exercise legislative authority in the British possession ; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland, “summary conviction” means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

Sect. 117.Register of
patent agents.Act 1888,
sect. 1.

(1.) After the first day of July, one thousand eight hundred and eighty-nine, a person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act.³

(2.) The Board of Trade shall, as soon as may be after the passing of this Act, and may from time to time, make such general rules⁴ as are in the opinion of the Board required for giving effect to this section, and the provisions of section one hundred and one of the principal Act shall apply to all rules so made as if they were made in pursuance of that section.

(3.) Provided that every person who proves to the satisfaction of the Board of Trade that prior to the passing of this Act he had been bona fide practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.⁵

(4.) If any person knowingly describes himself⁶ as a patent agent in contravention of this section he shall be liable on summary conviction to a fine not exceeding twenty pounds.

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

¹ *Person* includes a company registered under the Act of 1862. A body corporate may be registered as proprietors by its corporate name. (Patents Rules, 1890, rule 73.)

² The Court of Chancery of the County Palatine of Lancaster has jurisdiction: 53 & 54 Vict. c. 23.

³ *Patent agents*.—Prior to this Act, there were no means of excluding unqualified persons from acting as patent agents; and the Parliamentary Reports of 1851 and 1865 contain abundant evidence of the inconvenience and expense to which the absence of any such provision might give rise.

The profession of a patent agent has not been carried on in this country as a separate branch of business more than seventy years. (See an interesting paper by Mr. A. V. Newton, Fellow C. I. P. A., in Transactions C. I. P. A., vol. 1892.)

A communication with a patent agent is not privileged, though he is a solicitor: *Moseley v. Victoria Rubber Co.* (1886), 3 R. P. C. 355.

It is hardly necessary to add that a patent agent is liable to his principal for fraud or negligence: *Lee v. Walker* (1872), L. R. 7 C. P. 121.

As to lien of patent agents see Coote on Mortgage, p. 656.

⁴ *Register of Patent Agents Rules*.—These rules were issued by the Board of Trade on the 11th June, 1889. The Institute of Patent Agents was thereby entrusted, under the Board of Trade, with the care

of the Register of Patent Agents and the control of the qualifying examinations for admission to the register, &c. For the rules at length, see Appendix, pp. 881 *et seq.* The rule requiring the payment of certain fees is not *ultra vires*: *Institute of Patent Agents v. Lockwood* (1894), App. Ca. 347; 11 R. P. C. 374. **Sect. 117.**

The Institute of Patent Agents was incorporated as the "Institute of Patent Agents," as an association limited by guarantee, on the 12th August, 1882, under the Companies Acts, 1862 to 1880; and the use of the word "limited" was dispensed with by licence of the Board of Trade under the Companies Act, 1867, sect. 23.

A royal charter of incorporation has recently been applied for, in which it is proposed that Fellows of the Institute should be entitled to describe themselves as "chartered patent agents."

5 This sub-section preserves the rights of existing practitioners, and entitles them to be placed upon the register without examination.

6 Signing a complete specification "agent for —," is not necessarily an offence under this section: *Graham v. Fanta* (1892), 9 R. P. C. 164.

SCHEDULES.

THE FIRST SCHEDULE.

FORMS OF APPLICATION, &c.

FORM A.

Sect. 5.

£1 Stamp. FORM OF APPLICATION FOR PATENT.

This Form is replaced by Forms A, A1, Patents Rules, 1890. See pp. 805, 806.)

I, John Smith, of 29, Perry Street, Birmingham, in the county of Warwick, Engineer, do solemnly and sincerely declare that I am in possession of an invention for "Improvements in Sewing Machines," that I am the true and first inventor thereof, and that the same is not in use by any other person or persons to the best of my knowledge and belief; and I humbly pray that a patent may be granted to me for the said invention.

And I make the above solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

‡ John Smith.

Declared at Birmingham, in the county of Warwick, this day of
, 18 .

Before me,

§ James Adams,

Justice of the Peace.

NOTE.—Where the above declaration is made out of the United Kingdom, the words “and by virtue of the Statutory Declarations Act, 1835,” must be omitted; and the declaration must be made before a British consular officer, or where it is not reasonably practicable to make it before such officer, then before a public officer duly authorized in that behalf.

* Here insert name, address, and calling of inventor.

† Here insert title of invention.

‡ Signature of inventor.

§ Signature and title of the officer before whom the declaration is made.

FORM B.

FORM OF PROVISIONAL SPECIFICATION.

*(This Form is replaced by Form B, Patents Rules, 1890.
See p. 808.)*

*Improvements in Sewing Machines.**

I, † John Smith, of 29, Perry Street, Birmingham, in the county of Warwick, Engineer, do hereby declare the nature of my invention for “Improvements in Sewing Machines” to be as follows :‡—

* * * * *

§ John Smith.

Dated this day of , 18 .

NOTE.—No stamp is required on this document.

* Here insert title as in declaration.

† Here insert name, address, and calling of inventor as in declaration.

‡ Here insert short description of invention.

§ Signature of inventor.

FORM C.

£ Stamp. | **FORM OF COMPLETE SPECIFICATION.**

*(This Form is replaced by Form C, Patents Rules, 1890.
See p. 808.)*

*Improvements in Sewing Machines.**

I, John Smith, of 29, Perry Street, Birmingham, in the county of Warwick, Engineer, do hereby declare the nature of my invention for "Improvements in Sewing Machines," and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement : † —

* * * * *

Having now particularly described and ascertained the nature of my said invention and in what manner the same is to be performed, I declare that what I claim is ‡

- 1.
- 2.
- 3. &c.

John Smith.

Dated this day of , 18 .

* Here insert title as in declaration.
 * Here insert name, address, and calling of inventor as in declaration.
 ‡ Here insert full description of invention.
 † Here state distinctly the features of novelty claimed.
 Signature of inventor.

FORM D.

Sect. 33.

FORM OF PATENT. ¹

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith: To all to whom these presents shall come greeting: ²

Style and address (a).

Whereas *John Smith, of 29, Perry Street, Birmingham, in the county of Warwick, Engineer, hath by his solemn*

Recital of declaration and invention.

(a) These side-notes do not appear in the Queen's Printers' copy.

declaration (b) represented unto us that he is in possession of an invention for "*Improvements in Sewing Machines,*" that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief :

Petition of inventor.

And whereas the said inventor hath humbly prayed that we would be graciously pleased to grant unto him (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our Royal Letters Patent for the sole use and advantage of his said invention :

Recital of specification of invention.

And whereas the said inventor hath by and in his complete specification particularly described the nature of his invention :

Recital of motive.

And whereas we, being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request :³

The grant

to patentee, &c.

Know ye, therefore, that We, of our especial grace, certain knowledge, and mere motion,⁴ do by these presents, for us, our heirs and successors,⁵ give and grant⁶ unto the said patentee⁷ our especial licence, full power, sole privilege, and authority,⁸ that the said patentee by himself, his agents or licensees,⁹ and no others, may at all times hereafter during the term of years herein mentioned make,¹⁰ use, exercise, and vend¹¹ the said invention within our United Kingdom of Great Britain and Ireland and Isle of Man,¹² in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention¹³ during the term of fourteen years¹⁴ from the date¹⁵ hereunder written of these presents: And to the end that the said patentee may have and enjoy the

Extent of grant.

Term of grant.

(b) *By his solemn declaration.*—These words are now omitted, since an applicant makes no solemn declaration, but merely an ordinary declaration without any formalities, as under the Statutory Declarations Act, 1835, which was con-

templated by the original forms of this schedule. By the new forms of the Patents Rules and the Act of 1855, sect. 2 (see *post*, p. 793), there is now no solemn declaration, if *solemn* means something beyond a simple declaration.

sole use and exercise and the full benefit of the said invention, We do by these presents for us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland and the Isle of Man that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, licence, or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command and of being answerable to the patentee according to law for his damages thereby occasioned :¹⁶ Provided that these our letters patent are on this condition, that if at any time during the said term it be made to appear to us, our heirs or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything hereinbefore contained :¹⁷ Provided also that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided ; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or

Prohibition
against
infringement.

Proviso for
revocation by
Crown or
Privy
Council.

Proviso
avoiding
patent if
renewal fees
not paid.

Proviso in
connection
with Act of
1883, s. 27,
sub-sect. 2.

commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything hereinbefore contained:¹⁷ Provided also that nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted:¹⁷ And lastly, we do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee.¹⁸ In witness whereof we have caused these our letters to be made patent this¹⁹ one thousand eight hundred and and to be sealed as of the one thousand eight hundred and²⁰

Proviso as to licences.

Favourable construction.

Date.

Seal.

Seal
of Patent
Office.²¹

Variations in the form of patent

1 *Form of patent.*—The form here given is only applicable to the case of a single inventor. It will be observed, that by the Act of 1883, sect. 33, a patent *may* be in this form. To meet rarer cases, one of the printed forms is altered in ink. The printed forms in use have been much more fully punctuated than this form in the schedule; and in all of them the words “*by solemn declaration*” are now omitted, as the declaration is not now made under the Statutory Declarations Act, 1835. See examples of older forms of patents, *post*, p. 883.

There are kept in the Patent Office, in stock, eight forms, marked A, B, C, D, E, EE, F and G.

Form A.
Grant to single inventor.

A is the form of grant to a single inventor, and follows the form in the schedule, except that, as with all the printed forms, the words “*by his solemn declaration*” are omitted, and the punctuation is fuller.

B is the form of grant to several joint applicants, all of whom are actual inventors. Where necessary the plural is used instead of the singular. Form B. Joint applicants.

C is the form of grant of a patent of communication, and the recitals are different. The patent runs— Form C. Importers.

VICTORIA, &c., greeting :
 Whereas hath represented unto us that he is in possession of an invention for , that the said invention has been communicated to him from abroad, by , and that the same is not in use by any other person, to the best of his knowledge and belief :
 And whereas the said declarant hath humbly prayed that we would be graciously pleased to grant unto him (hereinafter, together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our royal letters patent for the sole use and advantage of the said invention :
 And whereas the said declarant hath by and in his complete specification particularly described the nature of the said invention :
 &c., &c., &c.,
 and then continues as in schedule.

D is the form of grant to several applicants. It is in the plural throughout, and the recitals are slightly different. It runs— Form D. Several applicants some inventors.

VICTORIA, &c., greeting :
 Whereas have represented unto us that they are in possession of an invention for , that the true and first inventor thereof, and that the same is not in use by any other person, to the best of their knowledge and belief :
 And whereas the said applicants have humbly prayed that we would be graciously pleased to grant unto them (hereinafter, together with their executors, administrators, and assigns, or any of them, referred to as the said patentees) our royal letters patent for the sole use and advantage of the said invention :
 And whereas the said applicants have by and in their complete specification particularly described the nature of the said invention :
 &c., &c., &c.

E applies to cases where the inventor dies after the application for the patent and before the complete specification is left. It runs— Form E. Deceased inventor.

VICTORIA, &c., greeting :
 Whereas represented unto us that he was in possession of an invention for , that and that the same was not in use by any other person, to the best of his knowledge and belief :
 And whereas the said declarant humbly prayed that we would be graciously pleased to grant unto him our royal letters patent for the sole use and advantage of his said invention :
 And whereas the said declarant departed this life on the :

And whereas the said hath by and in his complete specification particularly described the nature of the invention :

And whereas we, being willing to encourage all inventions which may be for the public good, are graciously pleased to grant to the said (hereinafter, together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our royal letters patent :

&c., &c., &c.

the grant being to an executor or administrator.

Form EE.
Grant to
executors.

EE is the same except that two or more executors are supposed to have the grant conferred on them jointly after the recital. And whereas the said declarant departed this life, &c.; the rest of the patent is in the plural of Form E.

Form F.
Feminine.

F.—This applies to the case of a female applicant, and is the same as Form A, except that *he* is changed to *she*, &c., as required.

Form G.
An applicant
deceased.

G.—This applies to the case of several joint applicants where one of the applicants dies. It runs—

VICTORIA, &c., greeting :

Whereas represented unto us that they were in possession of an invention for that and that the same was not in use by any other person, to the best of their knowledge and belief :

And whereas the said declarants humbly prayed that we would be graciously pleased to grant unto them our royal letters patent for the sole use and advantage of their said invention :

And whereas the said declarant departed this life on the :

And whereas the said have by and in their complete specification particularly described the nature of the invention :

And whereas we, being willing to encourage all inventions which may be for the public good, are graciously pleased to grant to the said (hereinafter, together with their executors, administrators and assigns, or any of them, referred to as the said patentees) our royal letters patent :

It will be observed that this form is framed so as to be easily altered to suit varying circumstances.

The style and
address.

2 *Victoria . . . greeting.*—These words constitute what are called in the old treatises the *style* of the Sovereign and the *address* or *direction* to her subjects in general. For the *styles* formerly used by the kings of England in letters patent, see Co. Litt. 7 a, 7 b; 2 Inst. 1.

Letters patent are directed to all persons to whom they shall come because they are public records, and all persons are bound to take notice of the grants which they contain.

Prior to the time of Richard II., the direction of letters patent was

as follows:—“ *Omnibus archiepiscopis ducibus marchionibus countibus episcopis, &c.* ” : 2 Inst. 1.

Letters patent are under seal, formerly the Great Seal, now (sect. 12, sub-sect. 1, p. 448) the seal of the Patent Office.

3 *Whereas . . . request.*—These clauses form the *recitals*, which contain a short statement of the substance of the inventor's declaration and petition for the grant, of the filing of the specification, and the motive of the Sovereign in making the grant. The recitals.

The words “by his solemn declaration” are now (1885, sect. 2) omitted in the form of grant, as the declaration is not now made under the Statutory Declarations Act, 1835.

An inventor is not entitled to a patent as of right, but only by the grace and favour of the Crown. See sect. 116 of the Act of 1883. It is necessary that he should inform the Sovereign of his invention, and also that the information should in *every material particular* be correct. The representations made by the inventor are made at his own peril; they form the *consideration* for the grant; this consideration is *entire*, and if any part of it fail, the patent as a whole will be void, and may be set aside by a petition for revocation. Cp. *Hill v. Thompson* (1818), 2 B. Moo. 424, per Dallas, J.; *Brunton v. Hawkes* (1821), 4 B. & Ald. at p. 549, per Abbott, C. J.; *Kay v. Marshall* (1839), 5 Bing. N. C. 501, per Tindal, C. J.; *Morgan v. Seaward* (1837), 2 M. & W. 544. An immaterial mistake does not, however, vitiate a patent, *e.g.*, a grant to a person as a knight, who in truth was no knight, where the identity of the grantee sufficiently appeared: *R. v. The Bishop of Chester*, 2 Salk. 560; 5 Mod. 297; Show. P. C. 212. Consideration for grant.

An invention being “any manner of new manufacture the subject of letters patent and grant of privilege” within the meaning of the Statute of Monopolies, sect. 6, it is not necessary to insert in the recital a clause to the effect that the petitioner believes that his invention would be of great public utility. Utility.

In letters patent granted before the time when a specification began to be required, the nature of the invention was more or less fully set forth in the recital. Cp. *Smalt Patents*, 3 Jac. 1; 1 Web. P. C. p. 9; *Baker's Smalt Patent*, 6 Jac. 1; *Ibid.* p. 11; *Mansell's Glass Patent*, 21 Jac. 1; *Ibid.* p. 17. And a patent without such a recital would most probably have been held void (unless it contained a proviso dispensing with it) by reason of the grant being too general and not sufficiently certain. As to the proviso by which an insufficient description of the nature of an invention was prevented from invalidating the grant of letters patent, see notes to the words “of our especial grace, knowledge, and mere motion” and to the proviso for favourable construction. Nature of invention.

- Prerogative of Crown in trade matters. The words "our royal letters patent for the sole use and advantage of his said invention" point to the control which the Crown has always exercised over the trade of the country and to its common law prerogative (which the Statute of Monopolies merely regulated) of granting the exclusive right to trade with a new invention for a limited period.
- Recital.
Motive of Sovereign. The words "and whereas we, being willing to encourage all inventions which may be for the public good," were introduced in substance in the earliest forms of letters patent, novelty and utility are thus by implication made essential conditions, and the encouragement of the arts is suggested as the motive of the grant. Consequently if these conditions and objects do not exist, or cannot be fulfilled, the Crown will have been deceived by false suggestions, and the letters patent will be void.
- 4 *Know ye, therefore, that we, of our especial grace, certain knowledge, and mere motion.* . These words are considered *ante*, p. 273.
- For us, our heirs, &c. 5 *For us, our heirs and successors.*—The object of inserting the words "for us, our heirs and successors," is to show that the grant is to continue in force during the whole of the term granted, notwithstanding the demise of the Crown: Hindmarch, 52. It seems, however, that these words are not necessary in order to make the grant binding upon the Queen's successors: Com. Dig. Grant G 3.
- Give and grant. 6 *Give and grant.*—The words "give and grant" are the proper operative words in a patent for an invention with regard not only to the Queen, who is grantor, but also to the nature of the grant: Shep. Touch. 228.
- Definition of patentee. 7 *Patentee.*—The definition of patentee, given by sect. 46 of the present Act, as the person for the time being entitled to the benefit of a patent, renders the insertion of the words "executors, administrators, or assigns," as in the earlier forms of letters patent, unnecessary.
- Especial licence. 8 The words "especial licence, full power, sole privilege, and authority," give the patentee a right to exclude all others from the use or exercise of his invention during the patent term.
- Agents or licensees. 9 *By himself, his agents or licensees.*—These words are important. For the variation in them where there are several patentees, see *supra*, pp. 671 *et seq.* As to the position of co-owners of a patent, see pp. 277 *et seq.*
- Make. 10 The word make, which is within the exception of the Statute of Monopolies, is intended to signify the sole privilege of exercising the invention in the making of articles by manufacture.

11 The word *vend* has given rise to some difficulty. By sect. 1 Vend. of the Statute of Monopolies, patents granting "the sole buying, selling, making, working, or using of anything" are declared to be void, and the proviso in favour of inventions contained in sect. 6 extends only to "grants of privilege of the sole working or making of any manner of new manufactures," leaving the sole buying or selling of anything within the prohibition of sect. 1 of the statute. It seemed, therefore, that a grant of the sole right to *vend* an invention was contrary to sect. 1 of the statute, and not within the meaning of the proviso.

The following considerations, however, dispose of this difficulty:—

The things produced by the exercise of a patent invention must be manufactures, or *vendible* articles, capable of being made the subject of transaction in trade and commerce. But the object of the law in permitting the grant of letters patent is to reward such inventors as shall give to the public the benefit of useful inventions; and that reward is the profit to arise from the exercise or sale of the invention during the patent term: see Hindmarch, p. 55, and *cp. Minter v. Wells* (1835), 4 A. & E. 251.

12 *United Kingdom of Great Britain and Ireland, and Isle of Man.* Extent of grant.
—Prior to the Patent Law Amendment Act, 1852, sect. 18, letters patent obtained in England conferred an exclusive privilege only within England, Wales, Berwick-upon-Tweed, the Channel Islands, the Isle of Man, and the Colonies and plantations abroad, if so expressed in the grant. Patents for Scotland and Ireland were required to be taken out under the Great Seals of these countries respectively.

The Channel Islands, which were introduced, on the solicitation of Mr. W. Carpmael, by Sir John Campbell (Attorney-General) and Sir R. M. Rolfe (Solicitor-General), into letters patent, granted November, 1838, are omitted from sect. 16 of the present Act. Channel Islands.

13 In the form of letters patent which was in use before, and under the Patent Law Amendment Act, 1852, the manner in which the patent privilege was to be exercised was left, as it substantially is in the present form, to the discretion of the patentee. Exercise of the invention.

Mr. Hindmarch (p. 56) expresses a doubt whether a patentee was bound under that clause to exercise his patent at all during the continuance of his right. The declaration in an action for infringement always, indeed, alleged that the "plaintiff had made, used, exercised, and vended the invention to his great advantage and profit;" but the object of this allegation was to show that the plaintiff had been injured by the invasion of his privilege, and that the patent did not confer upon him a bare right of no utility or benefit: and it was

Saving of
rights of
Crown.

never decided that a patentee must have exercised his invention in order to enable him to prevent others from infringing his patent right.

There was, however, usually inserted in the form of letters patent a proviso requiring the patentee to supply articles of his invention for the service of the Crown, in such manner, at such times, and upon such terms as might be settled by the officers or commissioners requiring the same; and, independently of the new provisions as to compulsory licences (sect. 22, *supra*, p. 593), a grant of letters patent might probably be avoided as "prejudicial and inconvenient" to the Sovereign's "subjects in general," if it were made to appear to the Privy Council that the patentee was not exercising his privilege.

14 *Fourteen years.*—Patents are now always granted for fourteen years, as provided by Act of 1883, sect. 17, sub-sect. 1. But it seems the Sovereign might grant a patent for a less time. The term of a patent includes the day of its date: *Russell v. Ledlam* (1843-S), 14 M. & W. at pp. 574, 582.

15 *Date.*—A patent is sealed as of the day of application (1883, sect. 13). This ante-dating is a curious contrivance, under which the advantages of provisional protection are obtained without further special provisions being required as to anticipation, priority, &c. It is also adopted in applications under the International and Colonial Arrangements.

Habendum.

After the clause defining the extent of letters patent, there was formerly inserted in the grant what was technically called the *Habendum* declaring that the inventor, his executors, administrators, and assigns, should have and enjoy the privilege according to the statute in such case made and provided. From this clause it was clear that the grant was intended to be made subject to the conditions required by the Statute of Monopolies.

Prohibitory
part of grant.

16 *And to the end thereby occasioned.* This is the prohibitory part of the grant. It has been referred to already, under the head of infringement, *ante*, Chap. XII.

All persons are bound to take notice of the grant of the Crown, and the object of the prohibition is to warn them of its effect and what the law requires them to abstain from doing. The prohibition extends to all subjects of the Crown living within those parts of the realm to which the privilege extends, and it operates during the whole term of the patent. The granting and the prohibitory parts differ in the terms employed, those of the former being, "make, use, exercise, and vend;" those of the latter, "make use of, or put in practice." The prohibitory words, however, are in aid of the grant and not in derogation from it (*Caldwell v. Vanrlissingen* (1851), 21 L. J.

(Ch. 97), and will receive from the Court the construction which will effectuate the purpose of the patent and prevent acts injurious to the patentee with as little restraint on the public as possible: *Minter v. Williams* (1835), 4 A. & E. 251. The omission of the word "vend" from the prohibition will not, therefore, diminish the effect of the preceding grant. The words "put in practice" appear from the declaration of intention at the commencement of the clause to be synonymous with exercise.

Prior to the Statute of Monopolies, questions on patent rights were determined in the Star Chamber, and infringements were punishable as contempt of royal authority. In addition to his equitable and common law remedies of injunctions and damages, a patentee was enabled by 5 and 6 Will. IV. c. 83, s. 7, to recover a penalty of 50*l.* against any person who had made an unauthorized use of his name. This statute was, however, repealed by the present Act.

See sect. 105 and notes thereon.

The prohibition formerly contained a command by the Sovereign to all justices, officers, and ministers, not to molest the patentee in the lawful use and exercise of his invention at any time during the patent term. The reason for this clause being inserted is thus explained by Hindmarch. "All monopolies, except those preserved by the provisions in the Statute of Monopolies, are contrary to law, and persons who put them in force may be punished by fine and imprisonment. The grant to a patentee of the sole use of his invention being a lawful grant, this clause seems to have been introduced into the patent as a protection to the patentee, so that if he were to be charged before any justices or officers of the Crown with putting an illegal monopoly in force, he might produce his patent to them in proof of his right, and to show by the command contained in it that they had no power to proceed against him."

17 *The three provisoes.*—These provisoes constitute the *conditions* Provisocs. of the grant of letters patent. The first makes a grant revocable by the Sovereign, or any six members of the Privy Council, for certain causes mentioned in the proviso. A similar power of summary revocation has been inserted in all letters patent granted since the Statute of Monopolies, but no authentic instance of its exercise is on record, and it is difficult to see how it could be exercised. In *Reg. v. Eastern Archipelago Co.* (1853), 12 L. T. 35, the Court of Queen's Bench was equally divided as to the effect of a similar condition upon proceedings by *scire facias* to repeal a charter granted to an incorporated company. In the opinion of Campbell, C. J., the proviso gave only an additional and cumulative remedy, by enabling the Crown in a summary manner to revoke the charter or modify it.

The object of this proviso is thus explained by Hindmarch (p. 431): "The grant of a patent is a matter of grace and favour, and therefore . . . the Crown may annex any condition it pleases to the grant; and this condition seems to have been inserted with the view of enabling the Crown to determine any illegal grant which may be unadvisedly made, without allowing the public to be put to the trouble or cost of resisting the unlawful patent."

The revocation, if by the Sovereign, must be under the signet or the Privy Seal; if exercised by the Privy Council, it must be under the hands of six or more members thereof.

The grounds of revocation under this proviso are—(1) that the grant is contrary to law, or prejudicial or inconvenient to the people of the kingdom in general, (2) that the invention is not new as to public use, or (3) that the patentee is not the first and true inventor thereof within the realm. Of these grounds, the first is merely an affirmation of the common law (Shep. Abr. Prerog. sects. 6, 7), corroborated by the Statute of Monopolies that letters patent which are contrary to law or common justice, or prejudicial or inconvenient to Her Majesty's subjects, are null and void; the second expresses the conditions of novelty and non-user, the third also is declaratory of the common law, and in accordance with the Statute of Monopolies.

Up to the date of the present Act, the form of letters patent contained a proviso that the patent should not affect any former grant. In some cases letters patent under the Great Seal—containing, for example, a new commission of the peace—operate so as to determine the powers or privileges conferred by previous letters patent. The proviso, under consideration, seems to have been inserted in order to except letters patent for inventions from this general rule, and to prevent the rights of different patentees from clashing with each other. This express stipulation was, however, unnecessary, for it was clearly the law, that if the Sovereign by his letters patent granted the same thing to several persons, a *scire facias* would lie for the repeal of the last patent: Hindmarch, 65. As to the effect of this rule on patents for improvements see *R. v. Lister* (1826), Web. Lett. Pat. 80; *R. v. Fussell*, *ibid.*

Proviso
against as-
signment to
more than
twelve.

Prior to the Patent Law Amendment Act, 1852, a proviso was inserted in letters patent against the assignment of the patent privilege to more than *twelve*—before 1832, to more than *five*—persons at any one time, *entitled to divide the profits as partners*. This proviso applied only to assignments by act of party, and not to assignments by operation of law (*Bloxam v. Elsee* (1825), 6 B. & C. 169), and any number of licences, exclusive or common, might be

granted, in spite of it (*Protheroe v. May* (1839), 1 Web. P. C. 414). Whenever it was desired to transfer a patent to a company of more than twelve persons, an Act of Parliament was necessary. Many such special Acts were passed before the Act of 1852.

As to the fees payable by a patentee, see *infra*, p. 710.

Proviso as to fees.

“In manner for the time being by law provided.”—These words are new. In previous forms of letters patent, the settlement of the terms of the supply of patented articles for the public service was left to the department requiring it; and considerable hardship was sometimes caused to the patentees thereby.

It appears that the proper remedy of a patentee against a public department refusing to settle terms according to the patent was by petition of right, and not by mandamus (*Ex parte Pering* (1836), 4 A. & E. 949; Cp. *Walker v. Congreve* (1816), 1 Coop. P. C. 356); and this is still the law in the case of patents existing before the commencement of the present Act, to which the provisions of sect. 27, as to patents binding the Crown, do not apply.

18 As to the effect of the proviso for favourable construction, see *supra*, pp. 202 *et seq.*

Favourable construction.

19 *In witness whereof*.—The name “letters patent” is derived from this clause, which occurs in the old forms also, by which it is in effect declared that the Queen makes her grant “patent,” or known to all persons, by passing it under the Great Seal, or now the seal of the Patent Office: 2 Inst. 78.

Name “letter patent.”

Patents for inventions were always tested in the name of the Sovereign.

20 *Date*.—In *Lord Zouch and More's Case* (Godbolt, 416) it was laid down that “the King's patent may be without date; for he may resort to the enrolment and the Privy Seal to help it.” But the statute 18 Hen. VI. c. 1, s. 1, provided that letters patent should bear date the day of the delivery of the Privy Seal bill to the Chancellor, and that letters patent made to the contrary should be void. Under sect. 13 of the present Act, every patent is dated as of the day of application, and the term runs from that date inclusive.

Date.

Letters patent had formerly subscribed to them the words “By warrant” or “By writ of privy seal,” to show that the patent had been made in pursuance of a command contained in the Queen's writ or warrant under her privy seal: 2 Inst. 555, 556; 8 Co. Rep. 186.

At the bottom was written the name of the Clerk of Patents, and a heavy wax impression of the Great Seal was affixed to the document, as is still done in those letters patent for other royal grants to which the wafer Great Seal is not affixed. The Great Seal gave authority

to the document; all persons were bound to take notice of it, and it was admissible in evidence without further proof.

21 *The Seal of the Patent Office* has now (sect. 12, sub-sect. 2) the same effect as the Great Seal of the United Kingdom. From the 1st October, 1852, when the Patent Law Amendment Act came into force, to the 1st March, 1878, the impression of the Great Seal was always appended to the parchment. At the latter date, under the Crown Office Act, 1877, sect. 5, and the rules made by the Privy Council (see *London Gazette*, 5th March, 1878) thereunder, letters patent for inventions were sealed with the wafer Great Seal. Since 1st January, 1884, the seal of the Patent Office is impressed on the letters patent.

Sect. 47.

[FORM E AND FORM F APPLY TO DESIGNS AND TRADE MARKS.]

Sect. 24.

THE SECOND SCHEDULE

Deals with Fees on Instruments for obtaining Patents and Renewal. These are now regulated by the scale published in 1892. See post, p. 709.

Sect. 113.

THE THIRD SCHEDULE.

Enactments repealed.

21 James 1, c. 3 ... [1623.]	The Statute of Monopolies. In part; namely,— Sections ten, eleven, and twelve.
5 & 6 Will. 4, c. 62... [1835.] In part.	The Statutory Declarations Act, 1835. In part; namely,— Section eleven.
5 & 6 Will. 4, c. 83... [1835.]	An Act to amend the law touching letters patent for inventions.
2 & 3 Vict. c. 67 ... [1839.]	An Act to amend an Act of the fifth and sixth years of the reign of King William the Fourth, intituled "An Act to amend the law touching letters patent for inventions."
5 & 6 Vict. c. 100... [1842.]	An Act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
6 & 7 Vict. c. 65 ... [1843.]	An Act to amend the laws relating to the copyright of designs.
7 & 8 Vict. c. 69 ... [1844.] In part.	An Act for amending an Act passed in the fourth year of the reign of his late Majesty, intituled "An Act for the better administration of justice in his Majesty's Privy Council and to extend its jurisdiction and powers." In part; namely,— Sections two to five, both included.

Enactments repealed—continued.

13 & 14 Vict. c. 104 [1850.]	An Act to extend and amend the Acts relating to the copyright of designs.
15 & 16 Vict. c. 83... [1852.]	The Patent Law Amendment Act, 1852.
16 & 17 Vict. c. 5... [1853.]	An Act to substitute stamp duties for fees on passing letters patent for inventions and to provide for the purchase for the public use of certain indexes of specifications.
16 & 17 Vict. c. 115 [1853.]	An Act to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act.
21 & 22 Vict. c. 70... [1858.]	An Act to amend the Act of the fifth and sixth years of her present Majesty, to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
22 Vict. c. 13 [1859.]	An Act to amend the law concerning patents for inventions with respect to inventions for improvements in instruments and munitions of war.
24 & 25 Vict. c. 73... [1861.]	An Act to amend the law relating to the copyright of designs.
28 & 29 Vict. c. 3... [1865.]	The Industrial Exhibitions Act, 1865.
33 & 34 Vict. c. 27... [1870.]	The Protection of Inventions Act, 1870.
33 & 34 Vict. c. 97... [1870.]	The Stamp Act, 1870. In part; namely,— Section sixty-five, and in the schedule the words and figures— “Certificate of the registration of a design £5 0 0 And see sect. 65.”
33 & 39 Vict. c. 91... [1875.]	The Trade Marks Registration Act, 1875.
33 & 39 Vict. c. 93... [1875.]	The Copyright of Designs Act, 1875.
39 & 40 Vict. c. 33... [1876.]	The Trade Marks Registration Amendment Act, 1876.
40 & 41 Vict. c. 37... [1877.]	The Trade Marks Registration Extension Act, 1877.
43 & 44 Vict. c. 10... [1880.]	The Great Seal Act, 1880. In part; namely,— Section five.
45 & 46 Vict. c. 72... [1882.]	The Revenue, Friendly Societies, and National Debt Act, 1882. In part; namely,— Section sixteen.

PATENTS RULES, 1890 (a).

By virtue of the provisions of the Patents, Designs, and Trade Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following rules:—

SHORT TITLE.

Short title.

1. These rules may be cited as the Patents Rules, 1890.

For the rules repealed by these rules, see notes to rule 81.

COMMENCEMENT.

Commencement.

2. These rules shall come into operation from and immediately after the 31st day of March, 1890.

INTERPRETATION.

Interpretation.

3. In the construction of these rules, any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively.

For definitions of terms used in the Patent Acts, see Act of 1883, sects. 46 and 117. For definition of Board of Trade, see note (a) below.

(a) These rules consolidate the Patents Rules, 1883, 1885, 1886, and the International and Colonial Arrangements Rules of 1888. They are made by the Board of Trade, under sect. 101 of the Patents Act, 1883, and are signed by the President of the Board. There is no authoritative definition of the term "Board of Trade," except that in 24 & 25 Vict. c. 47, s. 65,

viz., "The Lords of the Committee of the Privy Council appointed for the consideration of matters relating to trade and foreign plantations." Cp. also 22 Geo. III. c. 82, ss. 1. 15. It will be observed that in most instances these rules merely re-enact the provisions of the Patents Acts, 1883-88.

FEES.

4. The fees to be paid under the above-mentioned Acts shall be those specified in the list of fees in the first schedule to these rules. Fees.

Fees.—For schedule of fees, see p. 710. They are prescribed by the schedule to the Patents Rules, 1892, which replace those prescribed by this rule. See 1892, rules 4 and 5.

The fees are prescribed by the Board of Trade, with the consent of the Treasury (*b*).

As regards the amount and time of payment of fees, the Act of 1883 is retrospective (*c*).

The fees are paid by stamps impressed on the forms in the schedule to these rules. These forms cannot be obtained at the Patent Office in Southampton Buildings or at the Patent Office (Sale Branch) in Cursitor Street, but may be obtained at Room 6, Royal Courts of Justice, and there impressed with the necessary stamps in payment of the prescribed fees. Stamped forms may also be obtained, if ordered, by post from the Controller of Stamps, Room 7, Inland Revenue Office, Somerset House, London, W.C. Certain of the forms are also usually kept on sale at certain other places.

FORMS.

5. The Forms A, B, and C in the first schedule to the Act of 1883 shall be altered or amended by the substitution therefor of the Forms A, A1, A2, B, and C in the second schedule to these rules. Forms.
Alterations.

The forms should be used, but they are not intended to be absolutely the only forms in use: *Re Grenfell and MacEvoy* (1890), 7 R. P. C. 151. Therefore the fact that only one of two applicants signs the specification is no bar to its acceptance: *Ibid*.

Forms in Schedule to Act of 1883.—These forms are given at pp. 665 *et seq*.

Patents Rules, 1890.—These forms are given at pp. 805 *et seq*.

6. (1.) An application for a patent containing the declaration mentioned in sub-sect. 2 of sect. 5 of the Act of 1883 and sect. 2 of the Act of 1885 shall be made either in the Form A, or the Form A1, or the Form A2, set forth in the second schedule to these rules, as the case may be. Application.

(*b*) See sect. 24 of the Act of 1883; Patents Rules, 1890, rules 45—48. (*c*) Cp. sect. 45, p. 638.

Specification. (2.) The Form B in such schedule of provisional specification and the Form C of complete specification shall respectively be used.

Other forms. (3.) The remaining forms other than A, A1, A2, B, and C, set forth in the second schedule to these rules, may, as far as they are applicable, be used in any proceedings under these rules.

Under the Patents Rules, 1883, rule 6 (1), application for a patent was made by a statutory declaration. The Patents Act, 1885, sect. 2, allowed the declaration to be either statutory or not, as might be prescribed; and the present form contains merely a statement in writing, which, if false, will avoid the patent, but on which a prosecution for making a false declaration, as provided by the Statutory Declarations Act, 1835, will not lie, as the declaration is not to be made under that Act.

GENERAL.

Hours of
business.

7. The Patent Office shall be open to the public every week-day, between the hours of ten and four, except on the days and times following:—

Christmas Day ;

Good Friday ;

The day observed as her Majesty's birthday ;

The days observed as days of public fast or thanksgiving, or as holidays at the Bank of England.

See provision as to days for leaving documents at the Patent Office, Act of 1883, sect. 98.

As to days when the Register of Patents is open to public inspection, see rule 79.

The library is open from 10 a.m. to 10 p.m. daily.

Agency.

8. An application for a patent must be signed by the applicant, but all other communications between the applicant and the comptroller, and all attendances by the applicant upon the comptroller, may be made by or through an agent duly authorized to the satisfaction of the comptroller, and, if he so require, resident in the United Kingdom.

As to patent agents, see p. 664.
 For practice on applications, see also notes to sects. 4, 5, *supra*,
 pp. 549 *et seq.*, and chapter on Applications, p. 118.
 As to applications under the International and Colonial Arrangements, see rules 24—29.
 When an applicant desires to change his agent, the words, "And I hereby cancel all previous authorizations," should be inserted in the authorization of the new agent (Griff. P. C. p. 322).
 For a form of authorization of agent, see p. 806.
 An authorization to an agent can be given at any time during the progress of an application for a patent. The agent need not be a patent agent: *Graham v. Fanta* (1892), 9 R. P. C. 164.

9. The application shall be accompanied by a statement of an address to which all notices, requisitions, and communications of every kind may be made by the comptroller or by the Board of Trade, and such statement shall thereafter be binding upon the applicant unless and until a substituted statement of address shall be furnished by him to the comptroller. He may in any particular case require that the address mentioned in this rule be in the United Kingdom.

Statement of address.

The statement of address should be on a separate sheet, but may be written on the back of the application, and generally is so written

10. All documents and copies of documents, except statutory declarations and affidavits, sent to or left at the Patent Office, or otherwise furnished to the comptroller or to the Board of Trade, shall be written or printed in large and legible characters, and unless otherwise directed in the English language, upon strong wide ruled paper (on one side only), of a size of thirteen inches by eight inches, leaving a margin of two inches on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the comptroller.

Size, &c., of documents.

As to the sizes and methods of preparing drawings accompanying provisional or complete specifications, see rules 30—33.

Duplicates of specifications and drawings are required by the comptroller.

Exercise of
discretionary
power by
comptroller.

Notice of
hearing.

11. Before exercising any discretionary power given to the comptroller by the said Acts adversely to the applicant for a patent or for amendment of a specification, the comptroller shall give ten days' notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before the comptroller. Statutory declarations and affidavits shall be in the form for the time being in use in the High Court of Justice.

This is practically a repetition of Act of 1883, sect. 94. See also rules 17 and 17a, *infra*.

Notice by
applicant.

12. Within five days from the date when such notice would be delivered in the ordinary course of post, or such longer time as the comptroller may appoint in such notice, the applicant shall notify in writing to the comptroller whether or not he intends to be heard upon the matter.

See form of notice by applicant, Form E, *infra*, p. 809. No fee is payable.

Comptroller
may require
statement,
&c.

13. Whether the applicant desires to be heard or not, the comptroller may at any time require him to submit a statement in writing within a time to be notified by the comptroller, or to attend before him and make oral explanations with respect to such matters as the comptroller may require.

The comptroller-general does not usually require the applicant to be present, but will decide in his absence if he gives notice that he does not desire to be heard.

Decision to be
notified to
parties.

14. The decision or determination of the comptroller in the exercise of any such discretionary power as aforesaid shall be notified by him to the applicant, and any other person affected thereby.

Industrial or
international
exhibitions.

15. Any person desirous of exhibiting an invention at an industrial or international exhibition, or of publishing any description of the invention during the period of the

holding of the exhibition, or of using the invention for the purpose of the exhibition in the place where the exhibition is held, shall, after the Board of Trade have issued a certificate that the exhibition is an industrial or international one, give to the comptroller notice in writing of his intention to exhibit, publish, or use the invention, as the case may be.

For the purpose of identifying the invention in the event of an application for a patent being subsequently made, the applicant shall furnish to the comptroller a brief description of his invention, accompanied, if necessary, by drawings and such other information as the comptroller may in each case require.

As to industrial or international exhibitions, see Act of 1883, sect. 23; and as to foreign exhibitions, see Act of 1885, sect. 3.

Form of notice, *infra*, p. 815. The fee is 10s..

Form of certificate by Board of Trade, *infra*, p. 872.

16. Any document for the amending of which no special provision is made by the said Acts may be amended, and any irregularity in procedure which, in the opinion of the comptroller, may be obviated without detriment to the interests of any person, may be corrected, if and on such terms as the comptroller may think fit. Power of amendment, &c.

This is a very important rule.

For the amending of which no special provision is made.—The following documents are therefore excepted from the operation of this rule:—

A complete specification after acceptance (Act of 1883, sects. 13–21);

An application for a patent so far as clerical errors are concerned (*Ibid.* sect. 91 (a));

Drawings (*Ibid.* sects. 7 and 9);

The register (*Ibid.* sect. 91 (b));

is to all of which the comptroller-general has a special jurisdiction.

The Act gives no power for the amendment of *letters patent*, unless possibly in Act of 1883, sect. 23 (1).

In *Re Airey* ((1888) 5 P. O. R. 348), where a notice of opposition

omitted to give the date and title of a prior patent, in accordance with rule 36, *infra*, the comptroller gave leave to amend under this rule, as it appeared that the applicant had before him the means of referring to the specification; and in *Re Lake* ((1887) Griff. A. P. C. 35), where the notice of opposition had been signed by the opponent's agent, who died before the hearing, the name of the real opponent was allowed to be substituted.

16A. Any application, notice, or other document authorized or required to be left, made, or given at the Patent Office, or to the comptroller, or to any other person under these rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given at the time when the letter containing the same would be delivered in the ordinary course of post. In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Manner in which and persons before whom declaration is to be taken.

17. The statutory declarations required by the said Acts and these rules, or used in any proceedings thereunder, shall be made and subscribed as follows:—

- (a) In the United Kingdom, before any justice of the peace or any commissioner or other officer authorized by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;
- (b) In any other part of her Majesty's dominions, before any Court, Judge, justice of the peace, or any officer authorized by law to administer an oath there for the purpose of a legal proceeding; and
- (c) If made out of her Majesty's dominions, before a British Minister or person exercising the functions of a British Minister, or a consul, vice-consul, or other person exercising the functions of a British consul, or a notary public, or before a Judge or magistrate.

See the Commissioners for Oaths Act, 1889, 52 Vict. c. 10.

17A. Statutory declarations and affidavits shall be headed in the matter or matters to which they relate. They shall be divided into paragraphs consecutively numbered, and each paragraph shall so far as possible be confined to one subject.

Exhibits to declarations may be retained by the declarant's agent or solicitor, but should be open to inspection of opposing party. Country agents often deposit the exhibits at the Patent Office.

APPLICATION¹ WITH PROVISIONAL OR COMPLETE SPECIFICATION.²

18. Applications for patents sent through the post shall, as far as may be practicable, be opened and numbered in the order in which the letters containing the same have been respectively delivered in the ordinary course of post. Order of recording applications.

Applications left at the Patent Office otherwise than through the post shall be in like manner numbered in the order of their receipt at the Patent Office.

¹ For application generally, see Chap. V.

As to joint applications, see sect. 4, p. 550.

As to applications under sect. 103, see p. 653, and Rules 24—29, *infra*.

The form must be signed by the applicant, and not by an agent (Rule 8).

In the case of an application by a company, the form should be signed by the secretary and two directors, and must have the common seal affixed to it. But unless under the International and Colonial Arrangements a company cannot be a sole applicant, because it cannot be an inventor.

As to sending applications through the post, see Act of 1883, sect. 97.

Although not required by the Acts or Rules, a list of applications is advertised weekly in the Official Journal.

² For the relative advantage of filing a provisional or complete specification in the first instance, see pp. 119, 120.

19. Where a person making application for a patent includes therein by mistake, inadvertence, or otherwise, Application for separate patents by

E.

way of
amendment.

more than one invention, he may, after the refusal of the comptroller to accept such application, amend the same so as to apply to one invention only, and may make application for separate patents for each such invention accordingly.

Every such application shall, if the applicant notify his desire to that effect to the comptroller, bear the date of the first application, and shall, together therewith, be proceeded with in the manner prescribed by the said Acts and by these Rules, as if every such application had been originally made on that date.

As to the provision against a patent comprising more than one invention, see note to sect. 33, *supra*, p. 628.

Application
by repre-
sentative of
deceased
inventor.

20. An application for a patent by the legal representative of a person who has died possessed of an invention shall be accompanied by an official copy of or extract from his will, or the letters of administration granted of his estate and effects in proof of the applicant's title as such legal representative, and must be supported by such further evidence as the comptroller may require.

There is no special form of application by legal representative of deceased person.

As to the right of such representative to be an applicant, see Act of 1883, sects. 34 and 12, sub-sect. 3 b.

As to form of grant in such cases, see p. 672.

Notice and
advertise-
ment of
acceptance.

21. On the acceptance of a provisional or complete specification the comptroller shall give notice thereof to the applicant, and shall advertise such acceptance in the official journal of the Patent Office.

The advertisement is in the Illustrated Official Journal, published every Wednesday. The advertisement of the acceptance of the complete specification only is required by the Act.

As to acceptance of specifications, see Act of 1888, sect. 2, and Act of 1883, sect. 10.

22. Upon the publication of such advertisement of acceptance in the case of a complete specification, the application and specification or specifications with the drawings (if any) may be inspected at the Patent Office upon payment of the prescribed fee.

Inspection on acceptance of complete specification.

See Act of 1883, sect. 10. The Act of 1885, sect. 4, provides that publication shall only take place in the event of acceptance; see *ante*, p. 580. The fee for inspection is 1s.

The printed specifications are issued about three weeks after the acceptance of the complete specification. So that there is five weeks after the issue of the printed specification during which the advisability of entering an opposition may be considered, besides the three weeks during which only the written copies can be inspected.

APPLICATION ON COMMUNICATION FROM ABROAD.

23. An application for a patent for an invention communicated from abroad shall be made in the Form A1 set forth in the Second Schedule to these Rules.

Communication from abroad.

The person to whom a communication from abroad is made must be resident in the United Kingdom or the Isle of Man.

The Patent Office does not recognise agents not resident in this country.

A communicator cannot apply under sect. 103: *Re Shullenberger* (1889), 6 R. P. C. 551.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

24. The term "foreign application" shall mean an application by any person for protection of his invention in a Foreign State or British Possession to which by any Order of Her Majesty's Council for the time being in force the provisions of section 103 of the Patents, Designs, and Trade Marks Act, 1853, have been declared applicable.

This and the five succeeding Rules were the Patents (International and Colonial Arrangements) Rules, 1888.

British possession.—See definition of this term in sect. 117, *supra*, p. 663.

Order in Council.—See list of such Orders and the States to which they are applicable, *supra*, at p. 536.

On International and Colonial Arrangements generally, see sects. 103 and 104, *supra*, at pp. 653 *et seq.*, and also at Chap. XVIII.

Foreign application.—See *Re Van de Poele* ((1890) 7 R. P. C. 69).

25. An application¹ in the United Kingdom for a patent for any invention in respect of which a foreign application has been made shall contain a declaration that such foreign application has been made and shall specify² all the Foreign States or British Possessions in which foreign applications have been made and the official date or dates thereof respectively. The application must be made within seven months³ from the date of the first foreign application, and must be signed by the person or persons by whom such first foreign application was made. If such person, or any of such persons, be dead, the application must be signed by the legal personal representatives of such dead person, as well as by the other applicants, if any.

¹ *Application.*—See Form A2, *infra*, p. 807.

As to who may apply, see Rule 23.

² *Shall specify.*—See the case of *Re L'Oiseau and Pierrard* (Griff. A. P. C. 36), and *supra*, at p. 540.

³ *Seven months.*—See International Convention, 1883, Art. 4, and Chap. XVIII.; also Act of 1883, sect. 103, p. 653.

26. The application in the United Kingdom shall be made in the Form A2 in the Second Schedule to these Rules, and in addition to the specification, provisional or complete, left with such application must be accompanied by—

(1.) A copy or copies of the specification, and drawings or documents corresponding thereto, filed or deposited by the applicant in the Patent Office of the Foreign State or British Possession in respect of the first foreign application duly certified by the official chief or head of the Patent Office of such Foreign State or

British Possession as aforesaid, or otherwise verified to the satisfaction of the comptroller ;

- (2.) A statutory declaration¹ as to the identity of the invention in respect of which the application is made with the invention in respect of which the said foreign application was made, and if the specification² or document corresponding thereto be in a foreign language, a translation thereof shall be annexed to and verified by such statutory declaration.

¹ *Statutory declaration.*—As to manner in which, and persons before whom, such declarations may be taken, see Rule 17, *supra*, p. 688.

² *Specification.*—The foreign and British specification need not be in the same terms if they are in substance identical (*Re L'Oiseau and Pierrard* (1887), Griff. A. P. C. 37).

27. On receipt of such application, together with the prescribed specification and the other document or documents accompanying the same, required by the last preceding rule, and with such other proof (if any) as the comptroller may require of or relating to such foreign application or of the official date thereof, the comptroller shall make an entry of the applications in both countries and of the official dates of such applications respectively.

28. All further proceedings in connection with such application shall be taken within the times and in the manner prescribed by the Acts or Rules for ordinary applications.

A "foreign applicant" cannot, however, oppose the grant of a subsequent British patent for the same invention as his own, under the Act of 1883, sect. 11, sub-sect. 1 (*Re Everitt* (1888), Griff. A. P. C. 28).

29. The patent shall be entered in the Register of Patents as dated of the date on which the first foreign application was made, and the payment of renewal fees, and the expiration of the patent, shall be reckoned as from the date of the first foreign application.

SIZES AND METHODS OF PREPARING DRAWINGS ACCOMPANYING
PROVISIONAL OR COMPLETE SPECIFICATIONS.

Drawings for
specifications.

30. The provisional or complete specification need not be accompanied by drawings if the specification sufficiently describes the invention without them, but if drawings are furnished, they should accompany the provisional or complete specification to which they refer, except in the case provided for by Rule 33. No drawing or sketch such as requires a special engraving for letter-press should appear in the specification itself.

Drawings are required in duplicate, see Rule 32.

31. Drawings (if any) must be delivered at the Patent Office either in a flat state or on rollers, so as to be free from folds, breaks, or creases.

Require-
ments as to
paper, &c.

They must be made on pure white, hot-pressed, rolled, or calendered drawing-paper of smooth surface and good quality, and where possible without colour or Indian-ink washes.

Size of draw-
ings.

They must be on sheets of one of the two following sizes (the smaller being preferable): 13 inches at the sides by 8 inches at the top and bottom, or 13 inches at the sides by 16 inches at the top and bottom, including margin, which must be half an inch wide. If there are more figures than can be shown on one of the smaller-sized sheets, two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large drawing is required, it should be *continued* on subsequent sheets. There is no limit to the number of sheets that may be sent in.

Quality of
ink.

To ensure their satisfactory reproduction, the drawings must be executed with *absolutely black Indian ink*; the *same strength and colour of fine and shade lines to be maintained throughout*. Section lines, and lines for effect, or shading lines, must not be closely drawn. A specimen drawing is inserted in illustration of this require-

ment (b). Reference figures and letters must be bold, distinct, not less than one-eighth of an inch in height; and the same letters should be used in different views of the same parts. In cases of complicated drawings, the reference letters must be shown outside the figure, and connected with the part referred to by a fine line.

The scale adopted should be large enough to show clearly wherein the invention consists, and only so much of the apparatus, machine, &c., need be shown as effects this purpose. When the scale is shown on the drawing, it should be denoted, *not* by words, but by a drawn scale, as illustrated in the specimen.

Scale of drawings.

Drawings must bear the name of the applicant (and in the case of drawings left with a complete specification after a provisional specification, the number and year of the application) in the *left-hand top corner*; the number of sheets of drawings sent, and the number of each sheet in the *right-hand top corner*; and the signature of the applicant or his agent in the *right-hand bottom corner*.

Drawings to bear name of applicant, &c.

No written description of the invention should appear on the drawings.

Wood engravings, or representations of the invention, other than the drawings prepared as above described, will not be received unless of such a character as to be suitable for reproduction by the process of photolithography.

Restrictions as to wood engravings.

32. A *facsimile* of the original drawings, but *without* colour or Indian-ink washes, and prepared strictly in accordance with the regulations prescribed in Rule 31, must accompany the originals, and be marked "true copy."

Copies of drawings.

The Office prefers that the lettering on the duplicate copy should be in pencil, preferably blue pencil.

(b) This drawing is not given here, which may be purchased at the Patent Office Sale Branch. Price 6d.

Provisional drawings used for complete specification.

33. If an applicant desires to adopt the drawings lodged with his provisional specification as the drawings for his complete specification, he should refer to them as those "left with the provisional specification."

As to the law in regard to drawings, see *supra*, p. 199.

OPPOSITION TO GRANTS OF PATENTS (c).

Notice of opposition.

34. A notice of opposition to the grant of a patent shall be on Form D, and shall state the ground or grounds on which the person giving such notice (hereinafter in Rules 37, 38, 41, and 43, called the opponent) intends to oppose the grant, and must be signed by him. Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy.

Notice of opposition must be *signed* by the opponent, subject to Act of 1883, sect. 99, but may, with the permission of the comptroller-general, under Rule 16, be signed after delivery. Although Rule 8 does not expressly apply to an opponent, the comptroller-general permits agents to act for opponents as well as for applicants.

Copy for applicant.

35. On receipt of such notice, the copy thereof shall be transmitted by the comptroller to the applicant.

Particulars of prior patent.

36. Where the ground or one of the grounds of opposition is that the invention has been patented in this country on an application of prior date, the number and date of such prior application shall be specified in the notice.

An omission *per incuriam* is curable by the comptroller-general under Rule 16, subject to costs of the day if the correction renders an adjournment of the hearing necessary.

As to disallowance of opposition, see Rule 42.

Opponent's evidence.

37. Within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of a complete specification, the opponent may leave at the Patent Office statutory declarations in support of

(c) For this subject generally, see Chap. VIII.

his opposition, and on so leaving shall deliver to the applicant a list thereof.

The comptroller may extend the time under Rule 51.

Statutory declarations.—See Rule 17, *supra*, p. 688. Unnecessary declarations will have to be paid for by those who file them: *Brand's Application*, 12 R. P. C. 102.

38. Within fourteen days from the delivery of such list the applicant may leave at the Patent Office statutory declarations in answer, and on so leaving shall deliver to the opponent a list thereof, and within fourteen days from such delivery the opponent may leave at the Patent Office his statutory declarations in reply, and on so leaving shall deliver to the applicant a list thereof. Such last-mentioned declarations shall be confined to matters strictly in reply.

Applicant's evidence.

Evidence in reply.

Copies of the declarations mentioned in this and the last preceding Rule may be obtained either from the Patent Office or from the opposite party.

The declarations in reply should be confined strictly to matters in reply, otherwise they may be ordered to be removed from the file.

39. No further evidence shall be left on either side except by leave of the comptroller upon the written consent of the parties duly notified to him, or by special leave of the comptroller on application in writing made to him for that purpose.

Closing of evidence.

40. Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

Such leave will not be granted unless the comptroller-general is satisfied that the further evidence which it is desired to give was not within the knowledge of, or reasonably obtainable by, the party applying for leave, within the times allowed by Rules 35 and 36.

41. On completion of the evidence, or at such other time as he may see fit, the comptroller shall appoint a time for the hearing of the case, and shall give the parties

Notice of hearing.

ten days' notice at the least of such appointment. If the applicant or opponent desires to be heard, he must forthwith send the comptroller an application on Form E. The comptroller may refuse to hear either party who has not sent such application for hearing. If neither party applies to be heard, the comptroller shall decide the case and notify his decision to the parties.

Cases are heard in vacation as well as in term time.

The attendance of both or either of the parties is not required.

Disallowance
of opposition
in certain
cases.

42. On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition, and where the ground or one of the grounds is that the invention has been patented in this country on an application of prior date, the opposition shall not be allowed upon such ground unless the number and date of such prior application shall have been duly specified in the notice of opposition.

See also Rule 36, *supra*.

43. Where the ground of an opposition is that the applicant has obtained the invention from the opponent or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation be left at the Patent Office within the time prescribed by these Rules, the opposition shall be deemed to be abandoned, and a patent shall be sealed therewith.

This Rule is new.

Decision to be
notified to
parties.

44. The decision of the comptroller, after hearing any party who applies under Rule 41, shall be notified by him to the parties.

The decision of the comptroller is usually given to the parties with the reasons therefor in writing.

CERTIFICATES OF PAYMENT OR RENEWAL.

Payment of
fees of 50l.
and 100l. for

45. If a patentee intends at the expiration of the fourth or eighth year from the date of his patent to keep the same in force,

he shall, before the expiration of such fourth or eighth year, as the case may be, subject as hereinafter provided, pay the prescribed fee of 50*l.* or 100*l.* as the case may be. continuance of patent.

Repealed by the Patents Rules, 1892.

46. In the case of patents granted before the commencement of the said Acts, the above Rule shall be read as if the words "seventh year" were therein written instead of the words "eighth year." As to patents granted before commencement of Act.

Repealed by the Patents Rules, 1892.

47. If the patentee intends to pay annual fees in lieu of the above-mentioned fees of 50*l.* and 100*l.*, he shall, before the expiration of the fourth and each succeeding year during the term of the patent, until and inclusive of the 13th year thereof, pay the prescribed fee. Payment of annual fees in lieu of 50*l.* and 100*l.*

The Form J in the Second Schedule, duly stamped, should be used for the purpose of this and the payment referred to in Rule 45.

Repealed by the Patents Rules, 1892.

48. On due compliance with these Rules, and as soon as may be after such respective periods as aforesaid, or any enlargement thereof respectively duly granted, the comptroller shall issue a certificate that the prescribed payment has been duly made. Certificate of payment.

See form of certificate, *infra*, p. 813.
On issue of certificate, the amount and date of payment is entered on the Register of Patents: see Rule 76. The patentee's failure to make any prescribed payment is also recorded on the register: see Rule 77.

ENLARGEMENT OF TIME.

49. An application for an enlargement of the time for making a prescribed payment shall state in detail the circumstances in which the patentee by accident, mistake, or inadvertence has failed to make such payment, and the comptroller may require the patentee to sub- Enlargement of time for payments.

stantiate by such proof as he may think necessary the allegations contained in the application for enlargement.

Cp. Patents Rules, 1883, Rule 46.

See form of such application, *infra*, p. 813.

An enlargement of time for payment may be made, subject to the following penalties:—

Not exceeding one month, 1*l.*

Not exceeding two months, 3*l.*

Not exceeding three months, 5*l.*

No enlargement is granted after three months: Act of 1883, sect. 17, sub-sect. 4 (a).

See prescribed payments, Schedule of Fees, *infra*, p. 710.

Extension of time for leaving and accepting complete specification.

50. An application for enlargement of time for leaving or accepting a complete specification shall state in detail in what circumstances and upon what grounds such extension is applied for, and the comptroller may require the applicant to substantiate such allegations by such proof as the comptroller may think necessary.

This Rule was new in 1890.

In other cases.

51. The time prescribed by these Rules for doing any act; or taking any proceeding thereunder, may be enlarged by the comptroller if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms as he may direct.

See Rule 35.

This application is not granted as a matter of course. The written consent of the other side, if there be one, should, if possible, be obtained, and good cause must be shown for the extension.

This Rule applies only to the times prescribed by *the Rules*. See sect. 98, *supra*, p. 649, as to the days for leaving documents, &c., at the Patent Office in the case of Sunday, holidays, &c.

AMENDMENT OF SPECIFICATION.

Request for leave to amend.

52. A request for leave to amend a specification must be signed by the applicant or patentee (hereinafter, in Rules 54, 55, and 58, called the applicant), and accompanied by a duly certified printed copy of the original

specification and drawings, showing in red ink the proposed amendment, and shall be advertised by publication in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may in each case direct.

Advertisement.

As to amendment of specifications generally, see Act of 1883, sects. 18-21; and Act of 1885, sect. 5; also Chap. VII.

For form of request, see p. 810.

Signed.—The application for leave to amend must be signed by the applicant or patentee. Subsequent proceedings may be conducted by an agent.

Advertised.—The advertisement is in the Illustrated Official Journal.

53. A notice of opposition to the amendment shall state the ground or grounds on which the person giving such notice (hereinafter called the opponent) intends to oppose the amendment, and must be signed by him. Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy.

Notice of opposition.

See Act of 1883, sect. 18, sub-sect. 2, p. 585. The notice must be given within one month of the first advertisement; and this time cannot, it seems, be extended, as Rule 31 applies only to the times prescribed under the Rules. The notice of opposition should be on Form G, with a fee of 10s. It must be signed by the opponent, who must be "a person entitled to be heard" under Act of 1883, sect. 18, sub-sect. 4. But if the signature is not attached when the notice is sent to the comptroller, the comptroller may allow it to be added afterwards: *Re Codd*, Griff. 306.

54. On receipt of such notice the copy thereof shall be transmitted by the comptroller to the applicant.

Copy for the applicant.

55. Within 14 days after the expiration of one month from the first advertisement of the application for leave to amend, the opponent may leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant a list thereof.

Opponent's evidence.

To the applicant, i.e., to the applicant or his authorized agent (Rule 8).

See Rule 37, *supra*, p. 696.

A party filing unnecessary declarations will be made to pay the cost in any event: *per* Lockwood, S.-G. (1895), 12 R. P. C. 102.

Further proceedings.

56. Upon such declarations being left, and such list being delivered, the provisions of Rules 38, 39, 40, 41, and 44, shall apply to the case, and the further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated.

Requirements thereon.

57. Where leave to amend is given the applicant shall, if the comptroller so require, and within a time to be limited by him, leave at the Patent Office a new specification and drawings as amended, to be prepared in accordance with Rules 10, 30, and 31.

Leave by order of Court.

58. Where a request for leave to amend is made by or in pursuance of an order of the Court or a Judge, an official or verified copy of the order shall be left with the request at the Patent Office.

An Order of the Court.—See Act of 1883, sect. 19, *supra*, p. 591.

Advertisement of amendment.

59. Every amendment of a specification shall be forthwith advertised by the comptroller in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may direct.

See Act of 1883, sect. 21, *supra*, p. 592.

The advertisement is in the Illustrated Official Journal.

COMPULSORY LICENCES (*d*).

Petition for compulsory grant of licences.

60. A petition to the Board of Trade for an order upon a patentee to grant a licence shall show clearly the nature of the petitioner's interest, and the ground or grounds upon which he claims to be entitled to relief, and shall state in detail the circumstances of the case, the terms upon which he asks that an order may be made, and the purport of such order.

For form of petition, see p. 811. For fees, see schedule, p. 710.

(*d*) See Act of 1883, sect. 22.

61. The petition and an examined copy thereof shall be left at the Patent Office, accompanied by the affidavits, or statutory declarations, and other documentary evidence (if any) tendered by the petitioner in proof of the alleged default of the patentee.

To be left with evidence at Patent Office.

62. Upon perusing the petition and evidence, unless the Board of Trade shall be of opinion that the order should be at once refused, they may require the petitioner to attend before the comptroller, or other person or persons appointed by them, to receive his or their directions as to further proceedings upon the petition.

Directions as to further proceedings unless petition refused.

63. If and when a *prima facie* case for relief has been made out to the satisfaction of the Board of Trade, the petitioner shall upon their requisition, and on or before a day to be named by them, deliver to the patentee copies of the petition and of the affidavits or statutory declarations and other documentary evidence (if any) tendered in support thereof.

Procedure.

Petitioner's evidence.

64. Within 14 days after the day of such delivery the patentee shall leave at the Patent Office his affidavits or statutory declarations in opposition to the petition, and deliver copies thereof to the petitioner.

Patentee's evidence.

65. The petitioner within 14 days from such delivery shall leave at the Patent Office his affidavits, or statutory declarations in reply, and deliver copies thereof to the patentee; such last-mentioned affidavits or declarations shall be confined to matters strictly in reply.

Evidence in reply.

66. Subject to any further directions which the Board of Trade may give the parties shall then be heard at such time, before such person or persons, in such manner, and in accordance with such procedure as the Board of Trade may, in the circumstances of the case, direct, but so that full opportunity shall be given to the patentee to show cause against the petition.

Further proceedings.

REGISTER OF PATENTS (c).

Entry of
grant.

67. Upon the sealing of a patent the comptroller shall cause to be entered in the Register of Patents the name, address, and description of the patentee as the grantee thereof, and the title of the invention.

There is no entry upon the register until the patent is sealed.

Request for
entry of sub-
sequent pro-
prietorship.

68. Where a person becomes entitled to a patent or to any share or interest therein, by assignment either throughout the United Kingdom and the Isle of Man, or for any place or places therein, or by transmission or other operation of law, a request for the entry of his name in the register as such complete or partial proprietor of the patent, or of such share or interest therein, as the case may be, shall be addressed to the comptroller, and left at the Patent Office.

Forms of request, Appendix, Form L, p. 814.

Signature of
request.

69. Such request shall in the case of individuals be made and signed by the person requiring to be registered as proprietor, or by his agent duly authorized to the satisfaction of the comptroller, and in the case of a body corporate by their agent, authorized in like manner.

A body corporate may be registered as proprietor by its corporate name: Rule 74.

Particulars to
be stated in
request.

70. Every such request shall state the name, address, and description of the person claiming to be entitled to the patent, or to any share or interest therein, as the case may be (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom the patent, or such share or interest therein as aforesaid, has been assigned or transmitted.

See Forms L and M, p. 814.

(c) See Chap. XI., on the Register of Patents.

71. Every assignment and every other document containing, giving effect to, or being evidence of, the transmission of a patent or affecting the proprietorship thereof, as claimed by such request, except such documents as are matters of record, shall be produced to the comptroller, together with the request above prescribed, and such other proof of title as he may require for his satisfaction.

Production of documents of title and other proof.

As to a document which is a matter of record, an official or certified copy thereof shall in like manner be produced to the comptroller.

72. There shall also be left with the request an attested copy of the assignment or other document above required to be produced.

Copies for Patent Office.

As to a document which is a matter of record, an official or certified copy shall be left with the request in lieu of an attested copy.

73. A body corporate may be registered as proprietor by its corporate name.

Body corporate.

74. Where an order has been made by Her Majesty in Council for the extension of a patent for a further term or for the grant of a new patent, or where an order has been made by the Court for the revocation of a patent, or the rectification of the register under section 90 of the Act of 1883, or otherwise affecting the validity or proprietorship of the patent, the person in whose favour such order has been made shall forthwith leave at the Patent Office an office copy of such order. The register shall thereupon be rectified or the purport of such order shall otherwise be duly entered in the register, as the case may be.

Entry of orders of the Privy Council or of the Court.

As to extension of letters patent, see Act of 1883, sect. 25, *supra*, p. 598; and chapter on Extension, pp. 496 *et seq.*

As to revocation of patents, see Act of 1883, sect. 26, *supra*, p. 606; and chapter on Revocation, at p. 484.

As to rectification of register, see Act of 1883, sect. 90, *supra*, pp. 645 *et seq.*

Order in Council for extension, see form of, at p. 865.

Order of Court for revocation, see form of, at p. 852.

Entry of payment of fees on issue of certificate.

75. Upon the issue of a certificate of payment under Rule 48, the comptroller shall cause to be entered in the Register of Patents a record of the amount and date of payment of the fee on such certificate.

See form of certificate of payment, *infra*, p. 813.

As to fees, see Act of 1883, second schedule, p. 710.

Entry of failure to pay fees.

76. If a patentee fails to make any prescribed payment¹ within the prescribed time² or any enlargement³ thereof duly granted, such failure shall be duly entered in the register.

¹ *Prescribed payment.*—See Schedule of Fees, 14—25, *infra*, p. 710.

² *Prescribed times.*—See Act of 1883, sect. 17, sub-sects. 2, 3, 4, *supra*, p. 583.

³ *Enlargement.*—See Rules 49—51.

Entry of licences.

77. An attested copy of every licence granted under a patent shall be left at the Patent Office by the licensee, with a request that a notification thereof may be entered in the register. The licensee shall cause the accuracy of such copy to be certified as the comptroller may direct, and the original licence shall at the same time be produced and left at the Patent Office if required for further verification.

As to licences generally, see p. 300.

See form of request, Form M, p. 814.

For fee, see p. 711.

Hours of inspection of register.

78. The Register of Patents shall be open to the inspection of the public on every week-day between the hours of ten and four, except on the days and the times following:—

(a) Christmas Day, Good Friday, the day observed as Her Majesty's birthday, days observed as

- days of public fast or thanksgiving, and days observed as holidays at the Bank of England; or
- (b) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office;
- (c) Times when the register is required for any purpose of official use.

As to hours of business at Patent Office, see Rule 7, *supra*.

79. Certified copies of any entry in the register, or certified copies of, or extracts from, patents, specifications, disclaimers, affidavits, statutory declarations, and other public documents in the Patent Office, or of or from registers and other books kept there, may be furnished by the comptroller on payment of the prescribed fee. Certified copies of documents.

The fee is 1s., *infra*, p. 711, besides the cost of copying, at 4d. a folio.

POWER TO DISPENSE WITH EVIDENCE, &c.

80. Where, under these Rules, any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the comptroller, or at the Patent Office, and it is shown to the satisfaction of the comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence.

See Act of 1883, sect. 99, *supra*, p. 649, as to declarations by infants, lunatics, &c.

REPEAL (*f*).

Repeal.

81. All general Rules heretofore made by the Board of Trade under the Patents Designs and Trade Marks Acts, 1883 to 1888, and in force on the 31st day of March, 1890, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to anything done under such Rules, or to any application then pending.

The Patents Rules made previously under the Act of 1883 were:—
The Patents Rules, 1883, which came into operation the 1st January, 1883.

The Patents Rules, 1885, which came into operation on the 15th August, 1885.

The Patents Rules, 1886, which came into operation on the 16th September, 1886.

The Patents (International and Colonial Arrangements) Rules, which came into operation on the 1st June, 1888.

Dated the 31st day of March, 1890.

M. E. HICKS-BEACH,

President of the Board of Trade.

(*f*) The Patents Rules, 1890, consolidated in one set the Patents Rules of 1883, 1885, 1886, and 1888, and made some amendments and additions. Among other alterations it is provided as regards hearings before the comptroller or the law officers, that (by Rule 17a) statutory declarations and affidavits shall be headed in the matter or matters to which they relate. They shall be divided into paragraphs consecutively numbered, and each paragraph shall so far as possible be confined to one subject; by Rule 41, on completion of the evidence, or at such other time as he may see fit, the comptroller shall appoint a time for the hearing of the case, and shall give the parties ten days' notice at the least of such appointment. If the applicant or opponent desires to be heard, he *must forthwith send the comptroller an application on Form E*. The comptroller may refuse to hear either party who has not sent such application for hearing. If neither party applies to be heard, the comptroller shall decide the case and notify his decision to the

parties; that (by Rule 43) where the ground of an opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation be left at the Patent Office within the time prescribed by these Rules, the opposition shall be deemed to be abandoned, and a patent shall be sealed forthwith.

Rule 47 abolished the necessity of notice by a patentee who intends to pay annual fees in lieu of the fees of 50*l.* and 100*l.* The Rule of 1892 replaced this rule, and also revised the list of fees.

As regards the recording subsequent proprietorship of patents, it is provided (by Rule 72):—

There shall also be left with the request an attested copy of the assignment or other document above required to be produced.

As to a document which is a matter of record, an official or certified copy shall be left with the request in lieu of an attested copy.

PATENTS RULES, 1892.
(SECOND SET.)

By virtue of the provisions of the Patents, Designs and Trade Marks Acts, 1883-88, the Board of Trade do hereby make the following Rules:—

SHORT TITLE.

1. These Rules may be cited as the Patents Rules, 1892 (Second Set).

COMMENCEMENT.

2. These Rules shall come into operation from and immediately after the 30th day of September, 1892.

CERTIFICATES OF PAYMENT OR RENEWAL.

3. Rules 45, 46, and 47 of the Patents Rules, 1890, are hereby repealed.

PAYMENT OF ANNUAL FEES FOR CONTINUANCE OF PATENT.

4. If a patentee intends at the expiration of the fourth year from the date of his patent to keep the same in force, he shall, before the expiration of the fourth and each succeeding year during the term of the patent, pay the prescribed fee. The patentee may pay the whole or any portion of the aggregate of such prescribed annual fees in advance.

The Form J in the Second Schedule, duly stamped, should be used for the purpose of this payment.

FEES.

5. For the fees specified in the First Schedule to the

Patents Rules, 1890, shall be substituted the fees specified in the Schedule hereto.

M. E. HICKS-BEACH,
President of the Board of Trade.

4th July, 1892.

SCHEDULE.

LIST OF FEES PAYABLE ON AND IN CONNECTION WITH LETTERS PATENT.

Up to Sealing.

	£	s.	d.	£	s.	d.
1. On application for provisional protection	1	0	0			
2. On filing complete specification	3	0	0			
	<hr/>			4	0	0
or						
3. On filing complete specification with first application				4	0	0
4. On appeal from comptroller to law officer. By appellant				3	0	0
<hr/>						
5. On notice of opposition to grant of patent. By opponent				0	10	0
6. On hearing by comptroller. By applicant and by opponent respectively				1	0	0
<hr/>						
On application to amend specification:—						
7. Up to sealing. By applicant.....				1	10	0
8. After sealing. By patentee				3	0	0
9. On notice of opposition to amendment. By opponent				0	10	0
10. On hearing by comptroller. By applicant and by opponent respectively				1	0	0
11. On application to amend specification during action or proceeding. By patentee				3	0	0
<hr/>						
12. On application to the Board of Trade for a compulsory licence. By person applying				5	0	0

	£	s.	d.
13. On opposition to grant of compulsory licence. By patentee	5	0	0
On certificate of renewal:—			
14. Before the expiration of the 4th year from the date of the patent and in respect of the 5th year.....	5	0	0
15. Before the expiration of the 5th year from the date of the patent and in respect of the 6th year.....	6	0	0
16. Before the expiration of the 6th year from the date of the patent and in respect of the 7th year.....	7	0	0
17. Before the expiration of the 7th year from the date of the patent and in respect of the 8th year.....	8	0	0
18. Before the expiration of the 8th year from the date of the patent and in respect of the 9th year.....	9	0	0
19. Before the expiration of the 9th year from the date of the patent and in respect of the 10th year	10	0	0
20. Before the expiration of the 10th year from the date of the patent and in respect of the 11th year	11	0	0
21. Before the expiration of the 11th year from the date of the patent and in respect of the 12th year	12	0	0
22. Before the expiration of the 12th year from the date of the patent and in respect of the 13th year	13	0	0
23. Before the expiration of the 13th year from the date of the patent and in respect of the 14th year	14	0	0
On enlargement of time for payment of renewal fees:—			
24. Not exceeding one month	1	0	0
25. „ two months.....	3	0	0
26. „ three months	5	0	0
—————			
27. For every entry of an assignment, transmission, agreement, licence, or extension of patent.....	0	10	0
28. For duplicate of letters patent	2	0	0
29. On notice to comptroller of intended exhibition of a patent under section 39	0	10	0
30. Search or inspection fee	0	1	0
31. For office copies, every 100 words (but never less than one shilling)	0	0	4
32. For office copies of drawings, cost according to agreement.			
33. For certifying office copies, MSS. or printed, each	0	1	0
34. On request to comptroller to correct a clerical error:—			
Up to sealing.....	5	0	0
After sealing	1	0	0

PATENTS RULES, 1892.

	£	s.	d.
35. For certificate of comptroller under section 96	0	5	0
36. For altering address in register	0	5	0
37. For enlargement of time for filing complete specification, not exceeding one month	2	0	0
38. For enlargement of time for acceptance of complete specification :—			
Not exceeding one month	2	0	0
" two months	4	0	0
" three months	6	0	0

M. E. HICKS-BEACH,
President of the Board of Trade.

4th July, 1892.

Approved :

SYDNEY HERBERT,
HERBERT EUSTACE MAXWELL,

Lords Commissioners of
Her Majesty's Treasury.

LAW OFFICERS' RULES (a).

RULES REGULATING THE PRACTICE AND PROCEDURE ON APPEALS TO THE LAW OFFICERS (a).

I. When any person intends to appeal to the law officer from a decision of the comptroller in any case in which such appeal is given by the Acts, he shall within fourteen days from the date of the decision appealed against file in the Patent Office a notice of such his intention. Notice of appeal.

An appeal lies to the law officer from the decision of the comptroller :

- (a) Requiring the amendment of an application or specification, or of drawings (b) ;
- (b) Refusing an application on the ground that the invention comprised in it is the same as that comprised in a prior application (c) ;
- (c) Requiring the amendment of a complete specification (d) ;
- (d) Upon opposition to the grant of letters patent (e) ;
- (e) Upon opposition to the amendment of a specification (f) ;
- (f) Refusing leave to amend a specification (g).

There is no right of appeal to the law officer from the comptroller-general, refusing—

- (a) To enlarge the time prescribed by the principal Act for the payment of fees (h) ;
- (b) To grant a patent for an invention of which the use would in his opinion be contrary to law or morality (i) ; or
- (c) To extend the time for leaving a complete specification (j).

(a) These Rules are made under sect. 33 of the principal Act, which further empowers the law officer to examine witnesses on oath and to award costs. The comptroller has no power to award costs, and evidence before him must be given by way of statutory declaration. He has no power to administer oaths or to examine witnesses on oath. Appeals are usually held at the Royal Courts of Justice. But the law officer sometimes takes the hearing

at his private room in the House of Commons.

- (b) Act of 1883, sect. 7, sub-sect. 2.
- (c) *Ibid.* sect. 7, sub-sect. 6.
- (d) *Ibid.* sect. 9, sub-sect. 2.
- (e) *Ibid.* sect. 11, sub-sect. 2.
- (f) *Ibid.* sect. 18, sub-sect. 3.
- (g) *Ibid.* sect. 18, sub-sect. 6.
- (h) *Ibid.* sect. 17.
- (i) *Ibid.* sect. 86.
- (j) Act of 1885, sect. 3.

Appeals have been taken to the law officer from the decision of the comptroller-general under sect. 33, that a patent contains more than one invention; but these are rather in the nature of references under Act of 1883, sect. 95, by which the comptroller may apply to either of the law officers in case of doubt and difficulty.

For notice of appeal, see Form T, *infra*, p. 817. The fee is £3, *supra*, p. 710.

In cases where by his decision the comptroller requires an amendment to be made, *and does not in his decision settle the specific words of the amendment*, the time for appealing is regarded as dating from the day of forwarding to the opponent a copy of the amendment approved by him (*k*). Notice of appeal may be signed by an agent authorized by appellant (*l*).

Notice to state what part appealed against.

II. Such notice shall state the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and if so, what part of such decision.

The effect of Rules I. and II. is to limit the hearing before the law officers to points specifically raised by the notice of appeal; and where a notice of appeal is as to part only of the comptroller's decision, the person receiving such notice, and desiring to question other parts of the comptroller's decision, must give a counter-notice. If the original notice of appeal is only given just before the expiration of the fourteen days, the time for giving a counter-notice may be extended under Rule 5 (*m*). A counter-notice is necessary when the appeal is from the whole decision (*n*).

Service of notice of appeal.

III. A copy of such notice of intention to appeal shall be sent by the party so intending to appeal to the law officers' clerk, at Room 549, Royal Courts of Justice, London; and when there has been an opposition before the comptroller, to the opponent or opponents; and when the comptroller has refused to seal a patent on the ground that a previous application for a patent for the same invention is pending, to the prior applicant.

As to how notice may be sent, see Rule XIV., *infra*.

(*k*) *Re Chandler* (1886), Griff. P. C. at p. 273; *Re Cooper and Ford* (1885), *ibid.* 276.

(*l*) *Re Anderson and McKinnell* (1887), Griff. A. P. C. at p. 24.

(*m*) *Re Bairstow* (1888), per Clarke, S.-G., 5 R. P. C. at p. 286.

(*n*) *Re Hall and Hall* (1888), 5 R. P. C. 283.

In *Re Anderson and McKinnell* (o), it was held by Clarke, S.-G., that this rule applied only when the *applicant appealed*. But in *Re Hill* (p), Webster, A.-G., while agreeing with this construction of the terms of the rule, said that due notice should be given of the appeal to the respondent, even if he were applicant before the comptroller, either through the Patent Office or through the official clerk. Cp. *Re Rylands* (1888), 5 R. P. C. 665.

IV. Upon notice of appeal being filed, the comptroller shall forthwith transmit to the law officers' clerk all the papers relating to the matter of the application in respect of which such appeal is made. Transmission of papers to law officer.

V. No appeal shall be entertained of which notice is not given within fourteen days from the date of the decision appealed against, or such further time as the comptroller may allow, except by special leave upon application to the law officer. Extension of time for appealing.

The time for appealing has been extended by the comptroller-general in cases in which the parties were resident abroad. Time for appealing.

VI. Seven days' notice, at least, of the time and place appointed for the hearing of any appeal, shall be given by the law officers' clerk, unless special leave be given by the law officer that any shorter notice be given. Notice of hearing of appeal.

The law officer does not as a rule hear appeals in vacation time.

VII. Such notice shall in all cases be given to the comptroller and the appellant; and when there has been an opposition before the comptroller, to the opponent or opponents; and, when the comptroller has refused to seal a patent on the ground that an application for a patent for the same invention is pending, to the prior applicant. To whom notice of hearing to be given.

VIII. The evidence used on appeal to the law officer shall be the same as that used at the hearing before the comptroller; and no further evidence shall be given, save as to matters which have occurred or come to the Evidence before law officer.

(o) (1887) Griff. A. P. C. 24.

(p) (1888) 5 R. P. C. 601.

knowledge of either party, after the date of the decision appealed against, except with the leave of the law officer upon application for that purpose.

A specification which had come to the knowledge of an appellant since the hearing before the comptroller cannot be put in before the law officer on opposition to the grant of a patent. Such a specification is not evidence, but an additional ground of opposition (*q*). Herschell, S.-G., refused to allow an imputation of fraud in a notice of opposition to be gone into, on the ground that no evidence had been filed in support of it; nor would he allow time for evidence as to fraud to be put in (*r*).

Cross-examination.

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

Powers of law officer.

As to the power of the law officer to examine witnesses on oath, see sect. 38, *supra*.

"When it is desired to obtain an order for the attendance of declarants for cross-examination, a list of such persons must be left with the law officers' clerk, with a request for an order for their attendance. Copies of the request and list should be sent to the other side. The law officer then requests the attendance of both parties before him, with reference to the application, and if satisfied that an order should go directs that summonses should be issued, which the law officers' clerk then issues in due course" (*s*).

Conduct money to witnesses on cross-examination.

X. Any person requiring the attendance of a witness for cross-examination shall tender to the witness, whose attendance is required, a reasonable sum for conduct money.

XI. Where the law officer orders that costs shall be paid by any party to another, he may fix the amount of such costs, and if he shall not think fit to fix the amount

(*q*) *Re Bailey* (1884), Griff. P. C. 269.
 (*r*) *Re Huth* (1884), Griff. P. C. 293;
 cp. *Re L'Oiseau and Pierrard* (1887),

Griff. A. P. C. 36.
 (*s*) Griff. P. C. p. 319.

thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained.

The law officer usually gives his decision by word of mouth at the termination of the hearing.

As to the law officer's power over costs, see Act of 1883, sect. 38, and note thereto, *supra*, p. 630. Costs.

The law officer makes costs follow the event in appeals if he possibly can (t).

The law officer usually orders a lump sum to be paid on account of costs; it is not intended that costs should be a complete indemnity against the expense incurred: *Stuart's Application* (1892), 9 R. P. C. 452.

XII. If any costs so ordered to be paid be not paid within 14 days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment under the provisions of section 38 of the Act. Order for payment of costs.

XIII. All documentary evidence required, or allowed by the law officer to be filed, shall be subject to the same regulations, in all respects, as apply to the procedure before the comptroller, and shall be filed in the Patent Office, unless the law officer shall order to the contrary. Documentary evidence.

XIV. Any notice or other document required to be given to the law officers' clerk, under these rules, may be sent by a prepaid letter through the post. How notices may be sent.

A.-G.

S.-G.

This rule seems to be already covered by Act of 1883, sect. 97, *supra*, p. 648.

(t) *Re Anderton* (1886), Griff. A. P. C. 25; *Re Fletcher* (1887), Griff. A. P. C. 30.

PRIVY COUNCIL RULES IN PATENT CASES BEFORE THE JUDICIAL COMMITTEE.

—

RULES TO BE OBSERVED IN PROCEEDINGS before the
RIGHT HONOURABLE the LORDS of the JUDICIAL
COMMITTEE OF THE PRIVY COUNCIL under the Act
of the 5th and 6th William IV., intituled "An Act
to amend the Law touching LETTERS PATENT FOR
INVENTIONS," cap. 83.

No rules
made under
Act of 1883.

No rules having yet been made under sect. 25, sub.-sect. 6 of the Act of 1883, these Rules, which were made to regulate procedure under the statute 5 & 6 Will. IV. c. 83, are still in force. It is understood that the Judicial Committee have no immediate intention of issuing new rules. Apparently the procedure on prolongation is unaltered. There is no confirmation now by petition to Privy Council, except, perhaps, for patents granted under the Act of 1852.

Petition for
confirmation.

RULE I.—A party intending to apply by petition, under sect. 2 of the said Act, shall give public notice by advertising in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carries on any manufacture of anything made according to his specification, or near to or in which he resides, in case he carries on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to petition His Majesty under the said section, and shall in such advertisements state the object of such petition, and give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which

day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day, notice must be given of any opposition intended to be made to the petition; and any person intending to oppose the said application shall lodge notice to that effect at the Council Office, on or before such day so named in the said advertisements, and having lodged such notice shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

This Rule relates to the provision contained in 5 & 6 Will. IV. c. 83, s. 2, for the confirmation of letters patent, invalid for want of novelty. That provision has not, however, been re-enacted in the present Act.

As to confirmation generally, see Chapter XVII.

In *Re Hopkinson's Patent* (1896), 13 R. P. C. 114, an intending opponent did not give notice of opposition in time, because he had not seen the advertisements, and the Board refused to extend his time.

RULE II.—A party intending to apply by petition, under sect. 4 of the said Act, shall in the advertisements directed to be published by the said section, give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day caveats must be entered; and any person intending to enter a caveat shall enter the same at the Council Office, on or before such day so named in the said advertisements; and having entered such caveat, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

Petition for prolongation.

The sect. 4, here referred to, dealt with the prolongation of letters patent and required the petitioner to advertise in the *London Gazette* three times, and in three London papers, and three times in some

country paper published in the town where, or near to which, he carried on any manufacture of anything made according to his specification, or near to, or in which he resided in case he carried on no such manufacture, or published in the county where he carried on such manufacture, or where he lived, in case there should not be any paper published in such town, that he intended to apply to the Sovereign in Council for extension.

This mode of advertisement must still be followed.

“When the patentee resides abroad, and the invention is carried on under licences, the advertisements should be inserted in papers circulating in places where the manufacture is actually carried on” (a).

To entitle an equitable assignee to appear with the legal assignee of a patent on a petition for extension, the name of the former must appear with that of the latter in the advertisements required by sect. 4 of 5 & 6 Will. IV. c. 83 (b).

The advertisements should be proved before the case is heard (c).

In *Macintosh's Patent* (d), a petition for extension, presented nearly eighteen months before the expiration of the patent, was ordered to stand over, as the profits accruing in the mean time might materially affect the question as to the propriety of an extension being granted. Upon the application to fix a day for the hearing being renewed, it was questioned, but not decided, whether the old notices would be sufficient.

For forms of advertisements, &c., see Appendix, pp. 853 *et seq.*

Petitions.

When petition must be presented.

RULE III.—Petitions under sects. 2 and 4 of the said Act must be presented within one week from the insertion of the last of the advertisements required to be published in the *London Gazette*.

In a case where delay arose from the mistake of the petitioner's agent, this rule was waived by the Judicial Committee (e), and in *Reece's Patent* (f), a supplementary statement to correct errors in a petition was allowed to be delivered before the hearing.

For forms of petition, see Appendix, pp. 856 *et seq.*

(a) *Derosne's Patent* (1844), 2 Web. P. C. 2. “The statute,” said Lord Brougham, in this case, “provides for two cases, the patentee carrying on a manufactory, or residing; but there would be no sense in inserting an advertisement in the ‘Moniteur,’ when the man resides in Paris; that would afford no protection to the Queen's subjects, for whose protection the rule is intended:” *Ibid.*

(b) *In re Noble's Patent* (1850), 1 Moo. P. C. 191.

(c) *In re Perkins' Patent* (1845), 2 Web. P. C. 8; *Bell's Patent* (1844), *ibid.* p. 160.

(d) (1837) Web. P. C. 739, n.
(e) *In re Hutchinson's Patent* (1852), 14 Moo. P. C. 364.

(f) Cited by Lawson, p. 259, from Eng. Rep., Jan. to Mar. 1831, xiv.

RULE IV.—All petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of sect. 4 of the said Act, and the 1st and 2nd of these Rules and the matters in such affidavits may be disputed by the parties opposing upon the hearing of the petitions. Affidavits of advertisements.

RULE V.—All persons entering caveats under sect. 4 of the said Act, and all parties to any former suit or action touching letters patent, in respect of which petitions shall have been presented under sect. 2 of the said Act, and all persons lodging notices of opposition under the 1st of these Rules, shall respectively be entitled to be served with copies of petitions presented under the said sections, and no application to fix a time for hearing shall be made without affidavit of such service. Caveats.

For form of caveat, see Appendix, p. 854.

Where the Judicial Committee made an order to receive a petition which had not been presented in accordance with Rule 3, *supra*, and a caveat had been entered, it was held that as the party filing the caveat was interested in sustaining the objection to the reception of the petition notice of the application must be served upon him (*g*).

RULE VI.—All parties served with petitions shall lodge at the Council Office, within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions. Grounds of objection.

Under this rule, it is sufficient to state the grounds, without the particulars, of the objections (*h*).

RULE VII.—Parties may have copies of all papers lodged in respect of any application under the said Act, at their own expense. Copies.

RULE VIII.—The registrar of the Privy Council, or other officer to whom it may be referred to tax the costs incurred in the matter of any petition presented under the said Act, shall allow or disallow in his discretion all Costs.

(*g*) *In re Hutchinson's Patent* (1861), 24 Moo. P. C. 364.

(*h*) *Ball's Patent* (1879), L. R. 4 App. Cas. 171.

payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

Documents to
be lodged at
Council
Office.

RULE IX.—A party applying for an extension of a patent, under sect. 4 of the said Act, must lodge at the Council Office six printed copies of the specification, and also four copies of the balance-sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the Lords of the Committee at the hearing. In the event of the applicant's specification not having been printed, and if the expense of making six copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only of such specification and drawing will be deemed sufficient.

All copies mentioned in this Rule must be lodged not less than one week before the day fixed for hearing the application.

The Crown.

The Judicial Committee will hear the Attorney-General, or other counsel, on behalf of the Crown, against granting any application made under either the 2nd or 4th section of the said Act, in case it shall be thought fit to oppose the same on such behalf.

Copies of
specification,
&c.

In *Bell's Patent* (i), a petition was allowed to proceed, although copies of the specification had not been lodged as required by this Rule, the omission being unintentional and due to the Rule not being generally known, but the Judicial Committee intimated that their leniency in that case was not to be taken as a precedent.

The rule as to copies of the balance-sheet is imperative (k), and is intended to enable the Attorney-General to inspect the accounts, and to make inquiries before the hearing of the petition.

In considering a petition for the extension of a patent which has not come into use, and is not likely to be used except by the Government, the Judicial Committee rely, to a large extent, upon what is said in favour of the patent by the representatives of the Crown (l).

In *Ball's Patent* (m), it was observed by Sir Barnes Peacock that the Attorney-General might introduce evidence impeaching a patent irrespective of the notice of objections.

(i) (1846) 2 Web. P. C. 159.

(k) *Johnson's and Atkinson's Patents* (1873), L. R. 5 P. C. 87; *Yates and Kellett's Patent* (1887), 4 R. P. C. 151;

12 A. C. 147.

(l) *Hughes' Patent* (1879), 4 A. C. 174.

(m) (1879) 4 A. C. 171.

INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY (a).

Signed at Paris, March 20, 1883.

[Ratifications exchanged at Paris, June 6, 1884.]

I.

INTERNATIONAL CONVENTION (b).

His Majesty the King of the Belgians, His Majesty the Emperor of Brazil, His Majesty the King of Spain, the President of the French Republic, the President of the Republic of Guatemala, His Majesty the King of Italy, His Majesty the King of the Netherlands, His Majesty the King of Portugal and the Algarves, the President of the Republic of Salvador, His Majesty the King of Servia, and the Federal Council of the Swiss Confederation,

Being equally animated with the desire to secure, by mutual agreement, complete and effectual protection for the industry and commerce of their respective subjects and citizens, and to provide a guarantee for the rights of inventors, and for the loyalty of commercial transac-

Recital of
objects of
Convention.

(a) "Industrial property" includes patents, industrial designs and models, trade marks and trade names. See, however, Clause I. of the Protocol.

We are here concerned with the Convention only in so far as it deals with designs, although the text is given in full.

(b) The original Convention was published in French, which, under Art. 6 of the Final Protocol, is the official language of the International

Office. The authorized English translation has been given here; but, except in the formal parts, the French version of each article has been printed immediately below the paragraph to which it refers. The terms of the Convention, both in the original and in the English translation, are often vague. In such cases a reference to the original French text is of assistance.

tions, have resolved to conclude a Convention to that effect, and have named as their Plenipotentiaries, that is to say:—

Plenipoten-
tiaries.

His Majesty the King of the Belgians: the Baron Beyens, Grand Officer of His Majesty's Royal Order of Leopold, Grand Officer of the Legion of Honour, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ;

His Majesty the Emperor of Brazil: M. Jules Constant, Count de Villeneuve, Member of His Majesty's Council, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at the Court of His Majesty the King of the Belgians, Commander of the Order of Christ, Officer of His Majesty's Order of the Rose, Chevalier of the Legion of Honour, &c. ;

His Majesty the King of Spain: His Excellency the Duke de Fernan-Nuñez, de Montellano et del Arco, Count de Cervellon, Marquis de Almonacir, Grandee of Spain First Class, Chevalier of the Distinguished Order of the Golden Fleece, Grand Cross of the Order of Charles III., Chevalier de Calatrava, Grand Cross of the Legion of Honour, Senator of the Kingdom, His Majesty's Ambassador Extraordinary and Plenipotentiary at Paris, &c. ;

The President of the French Republic: M. Paul Challemel-Lacour, Senator, Minister for Foreign Affairs; M. Hérisson, Deputy, Minister of Commerce; M. Charles Jagerschmidt, Minister Plenipotentiary of the First Class, Officer of the National Order of the Legion of Honour, &c. ;

The President of the Republic of Guatemala: M. Crisanto-Medina, Officer of the Legion of Honour, his Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ;

His Majesty the King of Italy: M. Constantin Rössman, Commander of His Majesty's Orders of Saints Maurice and Lazarus, and of the Crown of Italy, Commander of the Legion of Honour, Councillor of the Italian Embassy at Paris, &c. ;

His Majesty the King of the Netherlands: the Baron de Zuylen de Nyevelt, Commander of His Majesty's Order of the Netherlands Lion, Grand Cross of His Majesty's Grand Ducal Order of the Oaken Crown, and of the Golden Lion of Nassau, Grand Officer of the Legion of Honour, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.;

His Majesty the King of Portugal and the Algarves: M. Jose da Silva Mendes Leal, Councillor of State, Peer of the Realm, Minister and Honorary Secretary of State, Grand Cross of the Order of St. James, Chevalier of the Order of the Tower and Sword of Portugal, Grand Officer of the Legion of Honour, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.; M. Fernand de Azevedo, Officer of the Legion of Honour, First Secretary of the Portuguese Legation at Paris, &c.;

The President of the Republic of Salvador: M. Torres-Caicedo, Corresponding Member of the French Institute, Grand Officer of the Legion of Honour, his Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.;

His Majesty the King of Servia: M. Sima M. Marinovitch, Chargé d'Affaires of Servia *ad interim*, Chevalier of the Royal Order of Takovo, &c.;

And the Federal Council of the Swiss Confederation: M. Charles Edouard Lardy, Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.; M. J. Weibel, Engineer at Geneva, President of the Swiss Section of the Permanent Commission for the Protection of Industrial Property;

Who, having communicated to each other their respective full powers, found in good and due form, have agreed upon the following Articles:—

Articles
agreed upon.

ARTICLE I.

The Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia,

Union for
protection

of industrial
property.

and Switzerland constitute themselves into a Union for the Protection of Industrial Property.

Les Gouvernements de la Belgique, du Brésil, de l'Espagne, de la France, du Guatemala, de l'Italie, des Pays-Bas, du Portugal, du Salvador, de la Serbie et de la Suisse sont constitués à l'état d'Union pour la protection de la Propriété Industrielle.

Date of the
Convention.

The necessary ratifications were exchanged by the plenipotentiaries of the High Contracting Parties on June 6, 1884, and as Article XVIII. provides that the Convention should come into operation one month after the exchange of ratifications, the date from which it applies to the countries named in Article I. is July 6, 1884.

"Industrial
property."

The words "industrial property" are to be understood in their broadest sense; they are not to apply simply to "industrial products," properly so called, but also to agricultural products (wines, corn, fruits, cattle, &c.), and to mineral products employed in commerce (mineral waters, &c.). (See Final Protocol.)

ARTICLE II.

The subjects or citizens of each of the Contracting States shall, in all the other States of the Union, as regards patents, industrial designs or models, trade marks and trade names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Legal
remedies.

Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each State.

Les sujets ou citoyens de chacun des Etats Contractants jouiront, dans tous les autres Etats de l'Union, en ce qui concerne les brevets d'invention, les dessins ou modèles industriels, les marques de fabrique ou de commerce et le nom commercial, des avantages que les lois respectives accordent actuellement ou accorderont par la suite aux nationaux.

En conséquence, ils auront la même protection que ceux-ci et le même recours légal contre toute atteinte portée à leurs droits, sous réserve de l'accomplissement des formalités et des

conditions imposées aux nationaux par la législation intérieure de chaque Etat.

Under the word "patents" are comprised the various kinds of industrial patents, recognized by the legislation of each of the Contracting States, such as importation patents, improvements patents. (See Final Protocol, 2.) "Patents."

The last paragraph of this Article does not affect the legislation of each of the Contracting States as regards the procedure to be followed before the tribunals and the competence of those tribunals. (Final Protocol, 3.)

ARTICLE III.

Subjects or citizens of States not forming part of the Union, who are domiciled or have industrial or commercial establishments in the territory of any of the States of the Union, shall be assimilated to the subjects or citizens of the Contracting States. Rights of subjects of States not within Union established in countries within Union.

Sont assimilés aux sujets ou citoyens des Etats Contractants les sujets ou citoyens des Etats ne faisant pas partie de l'Union qui sont domiciliés ou ont des établissements industriels ou commerciaux sur le territoire de l'un des Etats de l'Union.

By this Article subjects or citizens of non-contracting States who are domiciled or have establishments in Contracting States are placed on a better footing than their compatriots at home. It is possible that difficult questions may arise upon the meaning of the words "*domiciled or have industrial or commercial establishments.*"

ARTICLE IV.

Any person who has duly applied for a patent, industrial design or model, or trade mark in one of the Contracting States, shall enjoy, as regards registration in the other States, and reserving the rights of third parties, a right of priority during the periods hereinafter stated. Right of priority.

Consequently, subsequent registration in any of the other States of the Union before expiry of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another registration, by publication of the invention, or by the working

of it by a third party, by the sale of copies of the design or model, or by use of the trade mark.

The above-mentioned terms of priority shall be six months for patents, and three months for industrial designs and models and trade marks. A month longer is allowed for countries beyond sea.

Celui qui aura régulièrement fait le dépôt d'une demande de brevet d'invention, d'un dessin ou modèle industriel, d'une marque de fabrique ou de commerce, dans l'un des Etats Contractants, jouira, pour effectuer de dépôt dans les autres Etats, et sous réserve des droits des tiers, d'un droit de priorité pendant les délais déterminés ci-après.

En conséquence, le dépôt ultérieurement opéré dans l'un des autres Etats de l'Union avant l'expiration de ces délais ne pourra être invalidé par des faits accomplis dans l'intervalle, soit, notamment, par un autre dépôt, par la publication de l'invention ou son exploitation par un tiers, par la mise en vente d'exemplaires du dessin ou du modèle, par l'emploi de la marque.

Les délais de priorité mentionnés ci-dessus seront de six mois pour les brevets d'invention, et de trois mois pour les dessins ou modèles industriels, ainsi que pour les marques de fabrique ou de commerce. Ils seront augmentés d'un mois pour les pays d'outremer.

Construction
of this Article.

When first this Article came into operation, some doubt existed whether the six months were to be computed from the date of the deposit of the application for a patent, or from the date on which the patent was actually sealed in Great Britain, or signed in the other Contracting States. The Act of 1885, sect. 6, substituted "*date of application*" for "*date of the protection obtained*."

See Patents Act, 1885, sect. 103, sub-sect. 1, where seven months is the period within which application must be made.

It appears that *one of the Contracting States* means the first State where application was made, so that six months, or if beyond the sea seven months at most, from the time of first making an application in any of the countries which are parties to the Convention, is the extent of priority given.

Is Great
Britain
beyond sea?

It was also a question whether Great Britain was, as regards France, &c., a country beyond sea. The comptroller-general was instructed that it was not; on the other hand, it is held here that France and other Continental countries are, as regards Great Britain, countries beyond the sea.

ARTICLE V.

The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the States of the Union shall not entail forfeiture. Importation and forfeiture.

Nevertheless, the patentee shall remain bound to work his patent in conformity with the laws of the country into which he introduces the patented objects.

L'introduction par le breveté, dans le pays où le brevet a été délivré, d'objets fabriqués dans l'un ou l'autre des Etats de l'Union, n'entraînera pas la déchéance.

Toutefois le breveté restera soumis à l'obligation d'exploiter son brevet conformément aux lois du pays où il introduit les objets brevetés.

The first conference of delegates of the Contracting States was held at Rome in April and May, 1886; the second at Madrid in 1890. Date of first conference.

On the former of those occasions the following addition to Article V. was recommended:—

Each country shall determine the sense in which the word *exploiter* (work) is to be interpreted by the law of that country. "Exploiter."

The compulsory working of inventions is a source of much useless effort, and gives rise to many technical evasions of the laws. Most foreign countries, however, still exact a "working" of the invention at stated intervals within their own territories. Compulsory working.

This is practically the principal advantage accruing to Great Britain under the Convention, as formerly the introduction of a patented article in France forfeited the French patent rights.

ARTICLE VI.

Every trade mark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the Union. Registration of trade marks.

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the Union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

Toute marque de fabrique ou de commerce régulièrement déposée dans le pays d'origine sera admise au dépôt et protégée telle quelle dans les autres pays de l'Union.

Sera considéré comme pays d'origine le pays où le déposant a son principal établissement.

Si ce principal établissement n'est point situé dans un des pays de l'Union, sera considéré comme pays d'origine celui auquel appartient le déposant.

Le dépôt pourra être refusé, si l'objet pour lequel il est demandé est considéré comme contraire à la morale ou à l'ordre public.

ARTICLE VII.

The nature of the goods on which the trade mark is to be used can, in no case, be an obstacle to the registration of the trade mark.

Nature of goods to be no obstacle to registration of trade mark.

La nature du produit sur lequel la marque de fabrique ou de commerce doit être apposée ne peut, dans aucun cas, faire obstacle au dépôt de la marque.

ARTICLE VIII.

A trade name shall be protected in all the countries of the Union, without necessity of registration, whether it form part or not of a trade mark.

Protection of trade names.

Le nom commercial sera protégé dans tous les pays de l'Union sans obligation de dépôt, qu'il fasse ou non partie d'une marque de fabrique ou de commerce.

ARTICLE IX.

All goods illegally bearing a trade mark or trade name may be seized on importation into those States of the Union where this mark or name has a right to legal protection.

Seizure of goods bearing illegal trade mark or name.

The seizure shall be effected at the request of either the proper Public Department or of the interested party, pursuant to the internal legislation of each country.

Tout produit portant illicitement une marque de fabrique ou de commerce, ou un nom commercial, pourra être saisi à l'importation dans ceux des États de l'Union dans lesquels cette marque ou ce nom commercial ont droit à la protection légale.

La saisie aura lieu à la requête soit du Ministère Public, soit de la partie intéressée, conformément à la législation intérieure de chaque État.

ARTICLE X.

The provisions of the preceding article shall apply to all goods falsely bearing the name of any locality as indication of the place of origin, when such indication is associated with a trade name of a fictitious character or assumed with a fraudulent intention. Goods falsely bearing name of a locality.

Any manufacturer of, or trader in, such goods, established in the locality falsely designated as the place of origin, shall be deemed an interested party.

Les dispositions de l'Article précédent seront applicables à tout produit portant faussement, comme indication de provenance, le nom d'une localité déterminée, lorsque cette indication sera jointe à un nom commercial fictif ou emprunté dans une intention frauduleuse.

Est réputé partie intéressée tout fabricant ou commerçant engagé dans la fabrication ou le commerce de ce produit, et établi dans la localité faussement indiquée comme provenance.

ARTICLE XI.

The High Contracting Parties agree to grant temporary protection to patentable inventions, to industrial designs or models, and trade marks, for articles exhibited at official or officially recognized International Exhibitions. Protection at exhibitions.

Les Hautes Parties Contractantes s'engagent à accorder une protection temporaire aux inventions brevetables, aux dessins ou modèles industriels, ainsi qu'aux marques de fabrique ou de commerce, pour les produits qui figureront aux Expositions Internationales officielles ou officiellement reconnues.

Temporary protection.—See sect. 39 of Act of 1883, as amended by the Act of 1886, sect. 3.

The form of an Order in Council granting temporary protection to designs exhibited at the Paris Universal Exhibition of 1889 is given *ibid.*, p. 872.

ARTICLE XII.

Government
Office.

Each of the High Contracting Parties agree to establish a special Government Department for industrial property, and a central office for communication to the public of patents, industrial designs or models, and trade marks.

Chacune des Hautes Parties Contractantes s'engage à établir un service spécial de la Propriété Industrielle et un dépôt central, pour la communication au public des brevets d'invention, des dessins ou modèles industriels et des marques de fabrique ou de commerce.

In this country the Patent Office fulfils this obligation.

ARTICLE XIII.

International
Bureau.

An international office shall be organized under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property).

This office, the expense of which shall be defrayed by the Governments of all the Contracting States, shall be placed under the high authority of the Central Administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the Union.

Un office international sera organisé sous le titre de "Bureau International de l'Union pour la Protection de la Propriété Industrielle."

Ce bureau, dont les frais seront supportés par les Administrations de tous les États Contractants, sera placé sous la haute autorité de l'Administration Supérieure de la Confédération Suisse, et fonctionnera sous sa surveillance. Les attributions en seront déterminées d'un commun accord entre les États de l'Union.

See the Final Protocol, 5 and 6.

An international office, &c.—This office has been established at Berne. A monthly periodical, entitled *La Propriété Industrielle*, is published under its supervision.

ARTICLE XIV.

The present Convention shall be submitted to periodical Conferences. revisions, with a view to introducing improvements calculated to perfect the system of the Union.

To this end Conferences shall be successively held in one of the Contracting States by delegates of the said States. The next meeting shall take place in 1885 at Rome.

La présente Convention sera soumise à des révisions périodiques en vue d'y introduire les améliorations de nature à perfectionner le système de l'Union.

A cet effet, des Conférences auront lieu successivement, dans l'un des États Contractants, entre les Délégués des dits États.

La prochaine réunion aura lieu en 1885, à Rome.

The first meeting was held at Rome in April and May, 1886.

ARTICLE XV.

It is agreed that the High Contracting Parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of Industrial Property, in so far as such arrangements do not contravene the provisions of the present Convention.

Special arrangements between contracting parties.

Il est entendu que les Hautes Parties Contractantes se réservent respectivement le droit de prendre séparément, entre elles, des arrangements particuliers pour la protection de la Propriété Industrielle, en tant que ces arrangements ne contreviendraient point aux dispositions de la présente Convention.

ARTICLE XVI.

States which have not taken part in the present Convention shall be permitted to adhere to it at their request.

Adherence of other States.

Such adhesion shall be notified officially through the diplomatic channel to the Government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses, and

admission to all the advantages stipulated by the present Convention.

Les États qui n'ont point pris part à la présente Convention seront admis à y adhérer sur leur demande.

Cette adhésion sera notifiée par la voie diplomatique au Gouvernement de la Confédération Suisse, et par celui-ci à tous les autres.

Elle importera, de plein droit, accession à toutes les clauses et admission à tous les avantages stipulés par la présente Convention.

A list of the States belonging to this International Union, with the several dates of the Orders in Council relating thereto, and the dates at which the Convention commenced its effective operation, will be found at p. 536.

The original parties to the Convention are all bound from the same date, July 6th, 1884.

It is obvious that, as regards any two countries subsequently joining the Convention, the date of adhesion of the country which last joined the Convention will regulate the date of commencement of the operation of the Convention between the two countries. The provisions of sect. 103 of Patents Act, 1883, were made applicable to applications under the International Convention, by Order in Council dated 26th June, 1884.

The Order in Council is printed *infra*, at p. 743, and it is to be observed that her Majesty reserved power to hereafter accede to the Convention on behalf of the Isle of Man and the Channel Islands. The ordinary British patent covers the Isle of Man but not the Channel Islands, so that at present a patent obtained under the provisions of the International Convention and Patents Act, 1883, sect. 103, is not co-extensive with the ordinary British patent, as it does not give any rights over the Isle of Man.

ARTICLE XVII.

The execution of the reciprocal engagements contained in the present Convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the Constitutional laws of those of the High Contracting Parties who are bound to procure the application of the same, which they engage to do with as little delay as possible.

Convention subordinate to laws of contracting countries.

L'exécution des engagements réciproques contenus dans la présente Convention est subordonnée, en tant que de besoin, à l'accomplissement des formalités et règles établies par les lois constitutionnelles de celles des Hautes Parties Contractantes qui sont tenues d'en provoquer l'application, ce qu'elles s'obligent à faire dans le plus bref délai possible.

It appears that the International Convention is valid in this country only in so far as its provisions are authorized by the Patents Acts, 1883-88, or any other law, whether statute or common law, affecting the subjects dealt with in the Convention.

ARTICLE XVIII.

The present Convention shall come into operation one month after the exchange of ratifications,¹ and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the Government commissioned to receive adhesions. It shall only affect the denouncing State, the Convention remaining in operation as regards the other Contracting Parties.

Commencement of operation of Convention.

La présente Convention sera mise à exécution dans le délai d'un mois à partir de l'échange des ratifications et demeurera en vigueur pendant un temps indéterminé, jusqu'à l'expiration d'une année à partir du jour où la dénonciation en sera faite.

Cette dénonciation sera adressée au Gouvernement chargé de recevoir les adhésions. Elle ne produira son effet qu'à l'égard de l'Etat qui l'aura faite, la Convention restant exécutoire pour les autres Parties Contractantes.

¹ The ratifications were exchanged on June 6th, 1884, so that the date from which the Convention operates is July 6th, 1884.

Great Britain joined the Convention July 7th, 1884.

ARTICLE XIX.

The present Convention shall be ratified,¹ and the ratifications exchanged in Paris, within one year at the latest.

Ratification.

La présente Convention sera ratifiée, et les ratifications en seront échangées à Paris, dans le délai d'un an au plus tard.

¹ See note to preceding article.

In witness whereof the respective Plenipotentiaries have signed the same, and have affixed thereto their seals.

Done at Paris the 20th March, 1883.

En foi de quoi les Plénipotentiaires respectifs l'ont signée et y ont apposé leurs cachets.

Fait à Paris, le 20 Mars, 1883.

(Signed)

(L.S.)	BEYENS.
(L.S.)	VILLENEUVE.
(L.S.)	DUC DE FERNAN-NUÑEZ.
(L.S.)	P. CHALLEMEL-LACOUR.
(L.S.)	CH. HÉRISSON.
(L.S.)	CH. JAGERSCHMIDT.
(L.S.)	CRISANTO-MEDINA.
(L.S.)	RESSMAN.
(L.S.)	BAYON DE ZUYLEN DE NYEVELT.
(L.S.)	JOSE DA SILVA MENDES LEAL.
(L.S.)	F. D'AZEVEDO.
(L.S.)	J.-M. TORRES-CAICEDO.
(L.S.)	SIMA M. MARINOVITCH.
(L.S.)	LARDY.
(L.S.)	J. WEIBEL.

II.

FINAL PROTOCOL.

On proceeding to the signature of the Convention concluded this day between the Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia, and Switzerland, for the Protection of Industrial Property, the undersigned Plenipotentiaries have agreed as follows :

1. The words "Industrial Property" are to be understood in their broadest sense; they are not to apply simply to industrial products—properly so called, but also to agricultural products (wines, corn, fruits, cattle, &c.), and to mineral products employed in commerce (mineral waters, &c.).

"Industrial property."

2. Under the word "patents" are comprised the various kinds of industrial patents recognized by the legislation of each of the Contracting States, such as importation patents, improvement patents, &c.

"Patents."

3. The last paragraph of Article II. does not affect the legislation of each of the Contracting States as regards the procedure to be followed before the Tribunals, and the competence of those Tribunals.

4. Paragraph 1 of Article VI. is to be understood as meaning that no trade mark shall be excluded from protection in any State of the Union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of that State; provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in said country of origin. With this exception, which relates only to the form of the mark, and under reserve of the provisions of the other Articles of the Convention, the internal legislation of each State remains in force.

To avoid misconception, it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order in the sense of the last paragraph of Article VI.

5. The organization of the special Department for Industrial Property mentioned in Article XII. shall comprise, so far as possible, the publication in each State of a periodical official paper.

Expenses of
International
Office.

6. The common expenses of the International Office, instituted by virtue of Article XIII., are in no case to exceed for a single year a total sum representing an average of 2,000 fr. for each Contracting State.

To determine the part which each State should contribute to this total of expenses, the Contracting States, and those which may afterwards join the Union, shall be divided into six classes, each contributing in the proportion of a certain number of units, namely:—

1st class	25 units.
2nd class	20 "
3rd class	15 "
4th class	10 "
5th class	5 "
6th class	3 "

These co-efficients will be multiplied by the number of States in each class, and the sum of the result thus obtained will supply the number of units by which the total expense has to be divided. The quotient will give the amount of the unit of expense.

The Contracting States are classed as follows, with regard to the division of expense:—

1st class	France, Italy.
2nd class.....	Spain.
3rd class	Belgium, Brazil, Portugal, Switzerland.
4th class	Holland.
5th class	Servia.
6th class	Guatemala, Salvador.

The Swiss Government will superintend the expenses of the International Office, advance the necessary funds, and render an annual account, which will be communicated to all the other Administrations.

The International Office will centralize information of every kind relating to the protection of industrial property, and will bring it together in the form of a general statistical statement which will be distributed to all the Administrations. It will interest itself in all matters of common utility to the Union, and will edit, with the help of the documents supplied to it by the various Administrations, a periodical paper in the French language, dealing with questions regarding the object of the Union.

The numbers of this paper, as well as all the documents published by the International Office, will be circulated among the Administrations of the States of the Union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired either by the said Administrations, or by societies or private persons, will be paid for separately.

The International Office shall at all times hold itself at the service of members of the Union, in order to supply them with any special information they may need on questions relating to the international system of industrial property.

The Administration of the country in which the next Conference is to be held will make preparation for the transactions of that Conference, with the assistance of the International Office.

The Director of the International Office will be present at the meetings of the Conferences, and will take part in the discussions, but without the privilege of voting.

He will furnish an annual Report upon his administration of the office, which shall be communicated to all the members of the Union.

The official language of the International Office will be French.

Final Protocol to be read with Convention.

7. The present Final Protocol, which shall be ratified together with the Convention concluded this day, shall be considered as forming an integral part of, and shall have the same force, validity, and duration as the said Convention.

In witness whereof the undersigned Plenipotentiaries have drawn up the present Protocol.

(Signed)

BEYENS.

VILLENEUVE.

DUC DE FERNAN-NUÑEZ.

P. CHALLEMEL-LACOUR.

CH. HÉRISSON.

CH. JAGERSCHMIDT.

CRISANTO-MEDINA.

RESSMAN.

BARON DE ZUYLEN DE NYEVELT.

JOSE DA SILVA MENDES LEAL.

F. D'AZEVEDO.

J. M. TORRES-CAICEDO.

SIMA M. MARINOVITCH.

LARDY.

J. WEIBEL.

III.

ACCESSION OF HER MAJESTY'S GOVERNMENT TO THE CONVENTION SIGNED AT PARIS, MARCH 20, 1883.

The Undersigned, Ambassador Extraordinary and Plenipotentiary of Her Majesty the Queen of the United Kingdom of Great Britain and Ireland to the French Republic, declares that Her Britannic Majesty, having had the International Convention for the Protection of Industrial Property, concluded at Paris on the 20th March, 1883, and the Protocol relating thereto, signed on the same date, laid before her, and availing herself of the right reserved by Article XVI. of that Convention to States not parties to the original Convention, accedes, on behalf of the United Kingdom of Great Britain and Ireland, to the said International Convention for the Protection of Industrial Property, and to the said Protocol, which are to be considered as inserted word for word in the present Declaration, and formally engages, as far as regards the President of the French Republic and the other High Contracting Parties, to co-operate on her part in the execution of the stipulations contained in the Convention and Protocol aforesaid.

Accession of Her Britannic Majesty to the Convention.

The undersigned makes this Declaration on the part of Her Britannic Majesty with the express understanding that power is reserved to Her Britannic Majesty to accede to the Convention on behalf of the Isle of Man and the Channel Islands, and any of Her Majesty's possessions, on due notice to that effect being given through Her Majesty's Government.

Reservation of right to accede on behalf of the Channel Islands and Isle of Man.

In witness whereof the Undersigned, duly authorised, has signed the present Declaration of Accession, and has affixed thereto the seal of his arms.

Done at Paris on the 17th day of March, 1884.

(L.S.) (Signed) LYONS.

IV.

DECLARATION OF ACCEPTANCE OF ACCESSION.

Her Majesty the Queen of the United Kingdom of Great Britain and Ireland, having acceded to the International Convention relative to the Protection of Industrial Property, concluded at Paris, March 20, 1883, together with a Protocol dated the same day, by the Declaration of Accession delivered by Her Ambassador Extraordinary and Plenipotentiary to the Government of the French Republic; the text of which declaration is word for word as follows:—

(Here is inserted the text of No. III. in English.)

Accession of
Her Britannic
Majesty, with
its reserva-
tions ac-
cepted.

The President of the French Republic has authorized the undersigned, President of the Council, Minister for Foreign Affairs, to formally accept the said Accession, together with the reserves which are contained in it concerning the Isle of Man, the Channel Islands, and all other possessions of Her Britannic Majesty, engaging as well in his own name as in that of the other High Contracting Parties to assist in the accomplishment of the obligations stipulated in the Convention and the Protocol thereto annexed, which may concern the United Kingdom of Great Britain and Ireland.

In witness whereof the Undersigned, duly authorized, has drawn up the present Declaration of Acceptance and has affixed thereto his seal.

Done at Paris, the 2nd April, 1884.

(L.S.)

(Signed)

JULES FERRY.

ORDER IN COUNCIL APPLYING SECTION 103 OF THE ACT OF 1883 TO THE SIGNATORIES TO THE INTERNATIONAL CONVENTION (a).

*At the Court at Windsor, the 26th day of June, 1884:
Present—The Queen's most Excellent Majesty in Council.*

WHEREAS by the provisions of the Patents, Designs and Trade Marks Act, 1883, it is among other things provided:—

That if Her Majesty is pleased to make any arrangement with the Government or Governments of any foreign State or States for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark, in any such State, shall, subject to the conditions further provided and set forth in the said Act, be entitled to a patent for his invention, or to registration of his design or trade mark (as the case may be) under the said Act in priority to other applicants, and such patent or registration shall have the same date as the date of the protection obtained in such foreign State.

Recital of Act of 1883, sect. 103.

And whereas it has pleased Her Majesty to make an arrangement of the nature contemplated by the said Act, by and in virtue of a declaration signed and sealed by Her Majesty's Ambassador at Paris on the 17th March, 1884, duly conveying the accession of Great Britain to the International Convention and Protocol for the Protection of Industrial Property, signed by the representatives of certain Powers on the 20th day of March, 1883, and duly ratified on the 6th day of June, 1884, power being reserved to Her Majesty to hereafter accede to the provisions of the said Convention and Protocol on behalf

Recital of accession of Great Britain to International Convention.

(a) Published in *London Gazette* of July 1, 1884. For the other Orders in Council which have been made, see Table at p. 536.

of the Isle of Man, the Channel Islands, and any of Her Majesty's possessions, which declaration or accession was duly accepted by the French Government on behalf of the Signatory Powers, by and in virtue of a declaration dated the 2nd of April, 1884.

Sect. 103
applied.

Now, therefore, Her Majesty, by and with the advice and consent of her Privy Council, and by virtue of the authority committed to her by the said Act, doth declare, and it is hereby declared, that the provisions of the said Act hereinbefore specified shall apply to the following countries, viz. :—

Belgium.	Salvador.
Brazil.	Servia.
France.	Spain.
Guatemala.	Switzerland.
Italy.	Ecuador, and
Netherlands.	Tunis.
Portugal.	

Order, when
Order takes
effect.

And it is hereby further ordered and declared that this Order shall take effect from the 7th day of July, 1884.

C. L. PEEL.

APPENDIX OF STATUTES.

21 JAC. I. c. 3.

[A.D. 1623 (a).]

An Act concerning Monopolies and Dispensations with Penal Laws, and the Forfeitures thereof. 21 Jac. I. c. 3.

“Forasmuch as your most excellent Majesty, in your royal judgment, and of your blessed disposition to the weal and quiet of your subjects, did, in the year of our Lord God one thousand six hundred and ten, publish (b) in print to the whole realm, and to all posterity, that all grants of monopolies (c), and of the benefit of any penal laws (d), or of power to dispense with the law (e), or to compound for the forfeiture (f), are contrary to your

All monopolies, &c., shall be void.

(a) The Statute of Monopolies was passed on 25th May, 22 Jac. I. 1624. Previous to 33 Geo. III. c. 13, every Act of Parliament was considered as passed upon, and related back to, the first day of the session unless the terms of the Act provided to the contrary (4 Inst. 25). This must be borne in mind, otherwise *Mansell's Patent*, excepted by sect. 13, *infra*, will appear to bear date subsequent to the date of the Act (1 Web. P. C. 29, n. (g)).

(b) This publication was entitled “A Declaration of His Majesty's Pleasure,” &c. It was published, A.D. 1610, out of the King's zeal to law and justice, and states that monopolies are things against the laws of this realm, and therefore expressly commands that no person move the King to grant any of them (Co. 11 R. 88 b). The judgment in *Darcy v. Allin*, the case of monopolies (1 Web. P. C. 1), was the principal motive for publishing this book, and that book was a great motive of obtaining the royal assent to the statute. 3 Inst. 182.

(c) A monopoly is an institution or allowance by the King, by his grant, commission, or otherwise, to any person or persons, or bodies politic or corporate, for the sole buying, selling, making, working, or using of anything whereby

any person or persons, bodies politic or corporate, are sought to be restrained of any freedom or liberty that they had before, or hindered in their lawful trade (Co. 3 Inst. 181, c. 85; and 1 Web. P. C. 5). It is material to attend to the latter part of the definition, since upon it rest the following incidents of a monopoly: 1. That it raises the price of a commodity. 2. That it diminishes its quality. 3. That it impoverishes artificers. 11 R. 26, 86 b.; and Webs. L. P. 40, n. (n).

(d) It had been the practice to grant to particular persons all the penalties which the Crown should become entitled to under penal statutes. Webs. L. P. 41, n. (o).

(e) As to the dispensing power, see 7 Rep. 36 b. By the Bill of Rights it was declared “that from and after this present Parliament, no dispensation by *non obstante* of or to any statute or any part thereof be allowed, but that the same shall be held void and of none effect, except a dispensation be allowed in such a statute.”

(f) The compounding for forfeitures was a relic of the same practice as the exercise of the dispensing power, and was abolished with it. Webs. L. P. 41, n. (e).

Majesty's laws, which your Majesty's declaration is truly consonant and agreeable to the ancient and fundamental laws of this realm (g) : And whereas your Majesty was further graciously pleased expressly to command that no suitor should presume to move your Majesty for matters of that nature ; yet nevertheless upon misinformations and untrue pretences of public good, many such grants have been unduly obtained, and unlawfully put in execution, to the great grievance and inconvenience of your Majesty's subjects, contrary to the laws of this your realm, and contrary to your Majesty's most royal and blessed intention so published as aforesaid." For avoiding whereof, and preventing the like in time to come, may it please your excellent Majesty, at the humble suit of the Lords spiritual and temporal, and the Commons, in this present parliament assembled, that it may be declared (g) and enacted, and be it declared and enacted, by authority of this present parliament, that all monopolies and all commissions, grants, licenses, charters, and letters patent heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole (h) buying, selling, making, working, or using of anything within this realm or the dominion of Wales, or of any other monopolies, or of power, liberty, or faculty to dispense with any others, or to give license or toleration to do, use, or exercise, any thing against the tenor or purport of any law or statute, or to give or make any warrant for any such dispensation, license, or toleration to be had or made ; or to agree or compound with any others for any penalty or forfeitures limited by any statute (i) ; or of any grant or promise (k) of the benefit, profit, or commodity of any forfeiture, penalty, or sum of money, that is or shall be due by any statute, before judgment thereupon had ; and all proclamations, inhibitions, restraints, warrants

(g) The Statute of Monopolies was simply declaratory of the common law.

(h) The word *sole* is here applied to five several things, whereof four are special, and the fifth, *sole using*, is so general that no monopoly can be raised but will be within the reach of this statute ; and yet for more caution the words "or of any other monopolies" are added ; and by reason of these words, *sole using*, divers provisions are made by this Act. The words, also, "of any thing," are of so large an extent as to cause some exceptions in the subsequent clauses. 3 Inst. 187.

(i) The great inconvenience of the practice here abrogated appeared in the proceedings of *Empson* and *Dudley* in the reign of Henry VII., who had the office of Masters of the Forfeiture, and by colour of their commission and office did most intolerably and unlawfully oppress the subjects. 3 Inst. 187.

(k) Not only is the grant declared void as contrary to the common law of the realm, but the promise also ; for such promise maketh the more violent and undue proceedings against the subject, to the scandal of justice and offence of many. 7 Rep. 36 b.

of assistance, and all other matters and things whatsoever any way tending to the instituting, erecting, strengthening, furthering, or countenancing of the same, or any of them, are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in nowise to be put in use or execution.

2. And be it further declared and enacted by the authority aforesaid, that all monopolies, and all such commissions, grants, licenses, charters, letters patent, proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things tending as aforesaid, and the force and validity of them and of every of them, ought to be and shall be for ever hereafter examined, heard, tried, and determined, by and according to the common laws of this realm, and not otherwise (l).

Monopolies, &c., shall be tried by the common laws of this realm.

3. And be it further enacted by the authority aforesaid, that all person and persons, bodies politic and corporate whatsoever, which now are or hereafter shall be, shall stand and be disabled and incapable to have (m), use, exercise, or put in use any monopoly, or any such commission, grant, license, charter, letters patent, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, or any liberty, power or faculty, grounded or pretended to be grounded upon them or any of them.

All persons disabled to use monopolies, &c.

4. And be it further enacted by the authority aforesaid, that if any person or persons, at any time after the end of forty days next after the end of this present session of parliament, shall be hindered, grieved, disturbed, or disquieted, or his or their goods or chattels any way seized, attached, distrained, taken, carried away, or detained, by occasion or pretext of any monopoly, or of any such commission, grant, license, power, liberty, faculty, letters patent, proclamation, inhibition, restraint, warrant of assistance

The party grieved by pretext of a monopoly, &c., shall recover treble damages and double costs.

(l) This Act having in the preceding section declared all monopolies, &c., to be void by the common law, has provided by this that they shall be examined, heard, tried and determined in the Courts of Common Law, according to the common law, and not at the Council Table, Star Chamber, Chancery, Exchequer Chamber, or any other Court of like nature, but only according to the common laws of the realm, and not otherwise. For such boldness the monopolists took, that often at the Council Table, Star Chamber, Chancery and

Exchequer Chambers, petitions, informations and bills were preferred, pretending a contempt for not obeying the commandments and clauses of the said grant of monopolies, and of the proclamations concerning the same. (3 Inst. 182, 183.) The Court of Star Chamber punished all infringements of patents and royal grants, and on that principle supported any patent the Crown thought fit to grant. Webs. L. P. 43, n. (y).

(m) I.e., take. 3 Inst. 183.

or other matter or thing tending as aforesaid, and will sue to be relieved in or for any of the premises; that then, and in every such case, the same person or persons shall and may have his and their remedy for the same at the common law, by any action or actions, to be grounded upon this statute; the same action or actions to be heard and determined in the Courts of King's Bench, Common Pleas and Exchequer, or in any of them, against him or them, by whom he or they shall be so hindered, grieved, disturbed, or disquieted, or against him or them by whom his or their goods or chattels shall be so seized, attached, or distrained, taken, carried away, or detained, wherein all and every such person and persons, which shall be so hindered, grieved, disturbed, or disquieted, or whose goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained, shall recover three times so much as the damages which he or they sustained by means or occasion of being so hindered, grieved, disturbed, or disquieted, or by means of having his or their goods or chattels seized, attached, distrained, taken, carried away, or detained, and double costs; and in such suits, or for the saying or delaying thereof, no essoin, protection, wager of law, aid-prayer, privilege, injunction, or order of restraint, shall be in any wise prayed, granted, admitted, or allowed, nor any more than one imparlance: And if any person or persons shall, after notice given, that the action depending is grounded upon this statute, cause or procure any action at the common law, grounded upon this statute, to be stayed or delayed before judgment, by colour or means of any order, warrant, power or authority, save only of the Court wherein such actions as aforesaid shall be brought and depending, or after judgment had upon such action, shall cause or procure the execution of or upon any such judgment to be stayed or delayed by colour or means of any such order, warrant, power, or authority, save only by writ of error or attain; that then the said person and persons so offending, shall incur and sustain the pains, penalties, and forfeitures ordained and provided by the statute of provision and præmunire made in the sixteenth year of the reign of King Richard the Second (n).

He that delayeth an action grounded upon this statute incurs a præmunire.

(n) The remedy under this section, by action on the statute, to parties grieved by pretext of monopoly, is practically superseded. Many of the terms and proceedings, as aid-prayer, order of restraint, wager of law, are either unknown in modern practice, or abolished

by statute. Webs. L. P. 44, n. (a).
The imparlance, which meant extension of time to plead till next term, was abolished by 2 Will. IV c. 39, sect. 1.
The concluding clause of this section extends to the Judges of the Courts, and is more general than the one immediately

5. Provided nevertheless, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patent and grants of privilege for the term of one and twenty years or under, heretofore made, of the sole working or making of any manner of new manufactures within this realm, to the first and true inventor or inventors of such manufactures, which others at the time of the making of such letters patent and grants did not use, so they be not contrary to the law nor mischievous to the state, by raising of the prices of commodities at home, or hurt of trade, or generally inconvenient, but that the same shall be of such force as they were or should be if this Act had not been made, and of none other: and if the same were made for more than one and twenty years, that then the same, for the term of one and twenty years only, to be accounted from the date of the first letters patent and grants thereof made, shall be of such force as they were or should have been if the same had been made but for the term of one and twenty years only, and as if this Act had never been had or made, and of none other (o).

Letters patent heretofore granted for twenty-one years for new manufactures, saved.

[Repealed by Stat. Law Rev. Act, 1863.]

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

Letters patent hereafter to be granted for fourteen years, for new manufactures, saved.

7. Provided also, and it is hereby further intended, declared, and enacted by authority aforesaid, that this Act, or any thing therein contained, shall not in any wise extend or be prejudicial to any grant, or privilege, power, or authority whatsoever, heretofore made, granted, allowed and confirmed by any Act of Parliament now in force, so long as the same shall continue in force.

This Act not to extend to grants sanctioned by Parliament.

8. Provided also, that this Act shall not extend to any warrant or privy seal, made or directed or to be made or directed by his Majesty, his heirs or successors, to the justices of the Courts of the King's Bench on Common Pleas, and barons of the

Warrants granted to justices, saved.

preceding, which extended to the Courts generally, but, as was resolved by a Committee of the House of Commons, did not extend to the Judge. 3 Inst. 183.

(o) Letters patent for inventions depend on the exceptions in this and the following section. The words of the two sections are the same, except that

one relates to grants in existence at the time of passing the statute, the other to grants to be made afterwards.

See an instructive commentary on these sections, by Sir E. Coke, 3 Inst. 118.

(p) This proviso is very fully dealt with in Chap. III., on the Subject-matter of Patent.

Exchequer, justices of assize, justices of oyer and terminer and gaol-delivery, justices of the peace, and other justices for the time being, having power to hear and determine offences done against any penal statute depending in suit and question before them, or any of them respectively, after plea pleaded by the party defendant.

Charters granted to corporations, saved.

9. Provided also, and it is hereby further intended, declared, and enacted, that this Act, or any thing therein contained, shall not in any wise extend or be prejudicial unto the city of London, or to any city, borough, or town corporate within this realm, for or concerning any grants, charters, or letters patent, to them or any of them; or unto any corporations, companies, or fellowships of any art, trade, occupation, or mystery, or to any companies or societies of merchants within this realm, erected for the maintenance, enlargement, or ordering of any trade of merchandise; but that the same charters, customs, corporations, companies, fellowships, and societies, and their liberties, privileges, powers, and immunities, shall be and continue of such force and effect as they were before the making of this Act, and of none other; any thing before in this Act contained to the contrary in any wise notwithstanding.

Letters patent that concern printing, saltpetre, gunpowder, great ordnance, shot, or offices, saved.

[Repealed by Act of 1883, s. 113.]

10. Provided also, and be it enacted, that this Act, or any declaration, provision, disablement, penalty, forfeiture, or other thing before-mentioned, shall not extend to any letters patent of grants of privilege heretofore made, or hereafter to be made, of, for, or concerning the digging, making, or compounding of saltpetre, or gunpowder, or the casting or making of ordnance, or shot for ordnance, nor to any grant or letters patent heretofore made, or hereafter to be made, of any office or offices heretofore erected, made, or ordained now in being, and put in execution, other than such offices as have been decreed by any his Majesty's proclamation or proclamations: but that all and every the same grants, commissions, and letters patent, and all other matters and things tending to the maintaining, strengthening, and furtherance of the same, or any of them, shall be and remain of the like force and effect, and no other, and as free from the declarations, provisions, penalties, and forfeitures contained in this Act, as if this Act had never been had or made, and not otherwise (g).

(g) These sections excepted from the prohibition contained in sect. 1 of the Statute of Monopolies:—(a) letters patent concerning printing; digging for and making saltpetre or gunpowder; or casting or making of ordnance, or shot for ordnance; or grants of offices (sect. 10); (b) letters patent for digging and making alum, and for alum mines (sect. 11); (c) all privileges enjoyed by the hoast-men of the town of Newcastle-upon-Tyne for selling, carrying, and shipping any pit coals out of the river Tyne, also concerning the licensing of any taverns (sect. 12). The last

two sections of the statute contained similar exceptions for letters patent for glass making, to Sir Robert Mansell, Vice-Admiral of England, for the exportation of calves' skins to James Maxwell (sect. 13), for Baker's small patent, and Lord Dudley's patent for the making of iron ore (sect. 14). These clauses were rendered necessary by the generality of the words "of any thing" in sect. 1 of the Statute of Monopolies. Sect. 10 was annulled, so far as exclusive privileges in the gunpowder and saltpetre trades were concerned, by an Act passed in 1640—16 Chas. I. c. 21.

11. Provided also, and be it enacted, that this Act, or any declaration, provision, disablement, penalty, forfeiture, or other thing before-mentioned, shall not extend to any commission, grant, letters patents, or privilege heretofore made, or hereafter to be made, of, for, or concerning the digging, compounding, or making of alum, or alum-mines: but that all and every the same commissions, grants, letters patents, and privileges, shall be and remain of the like force and effect, and no other, and as free from the declarations, provisions, penalties, and forfeitures contained in this Act, as if the Act had never been had nor made, and not otherwise (r).

This Act shall not extend to commissions for alum-mines.

[Repealed by Act of 1883, s. 113.]

12. Provided also, and be it enacted, that this Act, or any declaration, provision, penalty, forfeiture, or other thing before-mentioned, shall not extend or be prejudicial to any use, custom, prescription, franchise, freedom, jurisdiction, immunity, liberty, or privilege, heretofore claimed, used, or enjoyed by the governors and stewards and brethren of the fellowship of the hoast-men of the town of Newcastle-upon-Tyne, or by the ancient fellowship, guild, or fraternity, commonly called hoast-men, for or concerning the selling, carrying, lading, disposing, shipping, venting, or trading of or for any sea coals, stone coals, or pit coals, forth or out of the haven or river of Tyne, or to any grant made by the said governor and stewards and brethren of the fellowship of the said hoast-men to the late Queen Elizabeth, of any duty or sum of money to be paid for, or in respect of, any such coals as aforesaid: nor to any grants, letters patent, or commission, heretofore granted, or heretofore to be granted, of, for, or concerning the licensing of the keeping of any tavern or taverns; or selling, uttering, or retailing of wines to be drunk or spent in the mansion-house, or houses, or other place in the tenure or occupation of the party or parties so selling or uttering the same; or for or concerning the making of any compositions for such licences, so as the benefit of such compositions be reserved and applied to and for the use of his Majesty, his heirs or successors, and not to the private use of any person or persons (r).

Nor to the liberties of Newcastle-upon-Tyne, nor to licences of keeping taverns.

[Repealed by Act of 1883, s. 113.]

13. Provided also, and be it enacted, that this Act, or any declaration, provision, penalty, forfeiture, or other thing before-mentioned, shall not extend or be prejudicial to a grant or privilege for or concerning the making of glass, by his Majesty's letters patent under the Great Seal of England, bearing date the two-and-twentieth day of May, in the one-and-twentieth year of his Majesty's reign of England, made and granted to Sir Robert Mansell, Knight (s), Vice Admiral of England: nor to a grant or letters patent, bearing date the twelfth of June, in the thirteenth year of his Majesty's reign of England, made to James Maxewell, Esquire, concerning the transportation of calves' skins: but that the said several letters patent, last-mentioned, shall be and remain of the like force and effect, and as free from the declarations, provisions, penalties, and forfeitures before-mentioned, as if this Act had never been had nor made, and not otherwise.

Nor to letters patent for glass making.

[Repealed by Stat. Law Rev. Act, 1863.]

Or exportation of calves' skins.

14. Provided also, and be it declared and enacted, that this Act, or any declaration, provision, penalty, forfeiture, or other thing before-mentioned, shall not extend or be prejudicial to a grant or privilege for or concerning the making of smalt, by his Majesty's letters patent, under the Great Seal of England, bearing date the sixteenth day of February, in the sixteenth year of his Majesty's reign of England, made or granted to Abraham

Nor to grants for making smalt.

[Repealed by Stat. Law Rev. Act, 1863.]

(r) See note (q) on p. 750.

(s) These letters patent were not within the 5th section. The grantee, Mansell, was not the true and first inventor of the manufacture which was the subject of the grant—viz., the making of glass with coal instead of wood, the letters patent themselves showing (1 Web. P. C. 18), that Percival was the true and first inventor:

also that the manufacture was not new at the time of the grant, others having practised the invention before. But for this exception the term of the letters patent would have been reduced to twenty-one years, which, as Mansell had interest at Court, would have endangered the passing of the bill. 1 Web. P. C. 32, n. (q).

Or melting
iron ore.

Baker (*t*); nor to a grant or privilege for or concerning the melting of iron
ewer, and of making the same into cast-works or bars with sea coals or pit
coals, by his Majesty's letters patent, under the Great Seal of England,
bearing date the twentieth day of February, in the nineteenth year of his
Majesty's reign of England, made or granted to Edward Lord Dudley (*u*);
but that the same several letters patent and grants shall be and remain of
the like force and effect, and as free from the declarations, provisions,
penalties, and forfeitures before-mentioned, as if this Act had never been
had nor made, and not otherwise (*v*).

5 & 6 WILL. IV. c. 83.

[This and the two succeeding sections are contained in repealed statutes,
but are set out here on account of their bearing on the prolongation of letters
patent.]

Prolongation
of a patent.

4. And be it further enacted, that if any person who now hath or shall
hereafter obtain any letters patent as aforesaid shall advertise in the *London
Gazette* three times, and in three London papers, and three times in some
country paper published in the town where or near to which he carried on
any manufacture of any thing made according to his specification, or near to
or in which he resides in case he carried on no such manufacture, or pub-
lished in the county where he carries on such manufacture, or where he lives
in case there shall not be any paper published in such town, that he intends
to apply to his Majesty in council for a prolongation of his term of sole
using and vending his invention, and shall petition his Majesty in council
to that effect, it shall be lawful for any person to enter a caveat at the
council office; and if his Majesty shall refer the consideration of such
petition to the Judicial Committee of the Privy Council, and notice shall first be
by him given to any person or persons who shall have entered such caveats,
the petitioner shall be heard by his counsel and witnesses to prove his case.

(*t*) See the smalt patents set forth at
length, 1 Web. P. C. 9-13. Baker's
patent was not within sect. 5. The first
smalt patent shows that other persons
were associated with Baker in the intro-
duction of the invention: nor was the
manufacture new within the realm at
the time of the grant of the excepted
patent. On these grounds, therefore,
the letters patent would have been void
unless specially excepted. 1 Web. P. C.
32, n. (*r*).

(*u*) These letters patent (see 1 Web.
P. C. 14-16, where a sketch is given of
the history of the subject-matter of this
grant—viz., the manufacture of iron
with pit coal), for all that appears on
the face of them, are within sect. 5, and
would consequently have been preserved
to the grantee without this special
exception. But independently of the
importance to the patentee of such an
exception, as a sort of judgment of
Parliament in favour of a grant, at a
time when, from the abuse of the royal
prerogative, all patents were looked
upon with the greatest suspicion and

as grievances, it is very doubtful
whether this patent would have been
saved under that section, since it
appears that Lord Dudley, the son of
the grantee, was the true and first
inventor. 1 Web. P. C. 33, n. (*r*).

(*v*) The conclusion of this and the
preceding section, when taken in con-
nection with the preamble of the Act,
suggests the two following considera-
tions: first, that there were certain
grants which, though partaking in some
measure of the character of monopolies,
were not really grants of monopolies
within the meaning of the use of that
term in the preamble; and, secondly,
that the conditions of validity under the
statute and at common law are different.
At common law the introducer, as well
as the inventor, could be the grantee,
and the term was frequently more than
fourteen years; whereas by the statute
the true and first inventor alone can be
the grantee (1 Web. P. C. 33, n. (*u*)).
The importer of an invention from
abroad is, however, its true and first
inventor.

and the persons entering caveats shall likewise be heard by their counsel and witnesses; whereupon, and upon hearing and inquiring of the whole matter, the Judicial Committee may report to his Majesty that a further extension of the term in the said letters patent should be granted, not exceeding seven years, and his Majesty is hereby authorised and empowered, if he shall think fit, to grant new letters patent for the said invention for a term not exceeding seven years after the expiration of the first term, any law, custom, or usage to the contrary in anywise notwithstanding: *Provided that no such extension shall be granted if the application by petition shall not be made and prosecuted with effect before the expiration of the term originally granted in such letters patent.*

Repealed by
2 & 3 Vict.
c. 67.

7 & 8 VICT. c. 69.

2. "And whereas it is expedient for the further encouragement of inventions in the useful arts to enable the time of monopoly in patents to be extended in cases in which it can be satisfactorily shown that the expense of the invention hath been greater than the time now limited by law will suffice to reimburse:" be it enacted, That if any person having obtained a patent for any invention, shall before the expiration thereof present a petition to her Majesty in Council, setting forth that he has been unable to obtain a due remuneration for his expense and labour in perfecting such invention, and that an exclusive right of using and vending the same for the further period of seven years in addition to the term in such patent mentioned will not suffice for his reimbursement and remuneration, then if the matter of such petition shall be by her Majesty referred to the Judicial Committee of the Privy Council, the said committee shall proceed to consider the same after the manner and in the usual course of its proceedings touching patents, and if the said committee shall be of opinion and shall so report to her Majesty that a further period greater than seven years' extension of the said patent term ought to be granted to the petitioner, it shall be lawful for her Majesty, if she shall so think fit, to grant an extension thereof for any time not exceeding fourteen years, in like manner, and subject to the same rules as the extension, for a term not exceeding seven years is now granted under the powers of the said Act of the sixth year of the reign of his late Majesty.

If extension of a patent term may be granted for fourteen years in certain cases.

[Repealed by
Act of 1883,
s. 113.]

3. Provided always, and be it enacted, That nothing herein contained shall prevent the said Judicial Committee from reporting that an extension for any period not exceeding seven years should be granted, or prevent her Majesty from granting an extension for such lesser term than the petition shall have prayed.

Less term than prayed may be granted.

15 & 16 VICT. c. 83.

25. Where, upon any application made after the passing of this Act, letters patent are granted in the United Kingdom for or in respect of any invention first invented in any foreign country or by the subject of any foreign power or State, and a patent or like privilege for the monopoly or exclusive use or exercise of such invention in any foreign country is there obtained before the grant of such letters patent in the United Kingdom, all rights and privileges under such letters patent shall (notwithstanding any term in such letters patent limited) cease and be void immediately upon the expiration or other determination of the term during which the patent or like privilege obtained in such foreign country shall continue in force, or where more than one such patent or like privilege is obtained abroad, immediately upon the expiration or determination of the term which shall first expire or be determined of such several patents or like privileges: Provided always,

Letters patent obtained in United Kingdom for patented foreign inventions not to continue in force after the expiration of the foreign patent.

that no letters patent for or in respect of any invention for which any such patent or like privilege as aforesaid shall have been obtained in any foreign country, and which shall be granted in the said United Kingdom after the expiration of the term for which such patent or privilege was granted or was in force, shall be of any validity.

THE PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

[N.B.—The words in italics have been repealed by later Acts.]

BE it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

PART I.

PRELIMINARY.

Short title.

1. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1883.

NOTE.—By Act, 1888, s. 29. the principal Act of 1883, and the amending Acts of 1885, 1886, and 1888, may be cited collectively as the Patents, Designs, and Trade Marks Acts, 1883 to 1888.

Division of Act into parts.

2. This Act is divided into parts, as follows:—

Part I.—PRELIMINARY.

II.—PATENTS.

III.—DESIGNS.

IV.—TRADE MARKS.

V.—GENERAL.

Commencement of Act.

3.—This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December one thousand eight hundred and eighty-three.

PART II.

PATENTS.

Application for and Grant of Patent.

Persons entitled to apply for patent.

4. (1.) Any person, whether a British subject or not, may make an application for a patent.

(2.) Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly.

5. (1.) An application for a patent must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed; and must be left at, or sent by post to, the Patent Office in the prescribed manner.

Application and specification.

(2.) An application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or complete specification.

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

(4.) A complete specification, whether left on application or subsequently, must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required.

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

6. The comptroller shall refer every application to an examiner, who shall ascertain and report to the comptroller whether the nature of the invention has been fairly described, and the application, specification, and drawings (if any) have been prepared in the prescribed manner, and the title sufficiently indicates the subject-matter of the invention.

Reference of application to examiner.

7. (1.) *If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings have not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the comptroller may require that the application, specification, or drawings be amended before he proceeds with the application.*

Power for comptroller to refuse application or require amendment.

Repealed.

(2.) *Where the comptroller requires an amendment, the applicant may appeal from his decision to the law officer.*

(3.) *The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the application shall be accepted.*

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

(5.) *If after an application has been made, but before a patent*

has been sealed, an application is made, accompanied by a specification bearing the same or a similar title, it shall be the duty of the examiner to report to the comptroller whether the specification appears to him to comprise the same invention; and, if he reports in the affirmative, the comptroller shall give notice to the applicants that he has so reported.

(6.) Where the examiner reports in the affirmative the comptroller may determine, subject to an appeal to the law officer, whether the invention comprised in both applications is the same, and if so he may refuse to seal a patent on the application of the second applicant.

Time for leaving complete specification.

8. (1.) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within nine months from the date of application.

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

Comparison of provisional and complete specification.

9. (1.) Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification.

(2.) If the examiner reports that the conditions hereinbefore contained have not been complied with, the comptroller may refuse to accept the complete specification unless and until the same shall have been amended to his satisfaction; but any such refusal shall be subject to appeal to the law officer.

(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the complete specification shall be accepted.

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

(5.) Reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding [other than an appeal to the law officer under this Act], unless the Court or officer having power to order discovery in such legal proceeding shall certify

that such production or inspection is desirable in the interests of justice, and ought to be allowed.

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

Advertisement on 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 the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or on the ground that the invention has been patented in this country on an application of prior date or on the ground of an examiner having reported to the comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title, and accompanying a previous application].

Opposition to grant of patent.

Repealed.

(2.) Where such notice is given the comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the person so giving notice, if desirous of being heard, decide on the case, but subject to appeal to the law officer.

(3.) The law officer shall, if required, hear the applicant and any person so giving notice and being, in the opinion of the law officer, entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made.

(4.) The law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer, with the consent of the Treasury, shall appoint.

12. (1.) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, the comptroller shall cause a patent to be sealed with the seal of the Patent Office.

Sealing of patent.

(2.) A patent so sealed shall have the same effect as if it were sealed with the Great Seal of the United Kingdom.

(3.) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, except in the cases hereinafter mentioned, that is to say—

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

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

Date of patent.

13. Every patent shall be dated and sealed as of the day of the application: Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification: Provided also, that in case of more than one application for a patent for the same invention the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application.

Provisional Protection.

Provisional protection.

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

Protection by Complete Specification.

Effect of acceptance of complete specification.

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

Patent.

Extent of patent.

16. Every patent when sealed shall have effect throughout the United Kingdom and the Isle of Man.

Term of patent.

17. (1.) The term limited in every patent for the duration thereof shall be fourteen years from its date.

(2.) But every patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to make the prescribed payments within the prescribed times.

(3.) If, nevertheless, in any case, by accident, mistake, or inadvertence, a patentee fails to make any prescribed payment

within the prescribed time, he may apply to the comptroller for an enlargement of the time for making that payment.

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

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

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

Amendment of Specification.

18. (1.) An applicant or a patentee may from time to time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of such amendment and his reasons for the same. Amendment
of specifica-
tion.

(2.) The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

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

(4.) The law officer shall, if required, hear the person making the request and the person so giving notice and in being the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

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

(6.) When leave to amend is refused by the comptroller, the

person making the request may appeal from his decision to the law officer.

(7.) The law officer shall, if required, hear the person making the request and the comptroller, and may make an order determining whether and subject to what conditions, if any, the amendment ought to be allowed.

(8.) No amendment shall be allowed that would make the specification as amended claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.

(9.) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall in all courts and for all purposes be deemed to form part of the specification.

(10.) [*The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending.*]

Power to disclaim part of invention during action, &c.

19. In an action for infringement of a patent, and in a proceeding for revocation of a patent, the Court or a Judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the Court or a Judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed.

Restriction on recovery of damages.

20. Where an amendment by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge.

Advertisement of amendment.

21. Every amendment of a specification shall be advertised in the prescribed manner.

Compulsory Licences.

Power for Board to order grant of licences

22. If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licences on reasonable terms—

- (a) The patent is not being worked in the United Kingdom; or
- (b) The reasonable requirements of the public with respect to the invention cannot be supplied; or

(c) Any person is prevented from working or using to the best advantage an invention of which he is possessed, the Board may order the patentee to grant licences on such terms as to the amount of royalties, security for payment, or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

Register of Patents.

23. (1.) There shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed. Register of patents.

(2.) The Register of Patents shall be *prima facie* evidence of any matters by this Act directed or authorized to be inserted therein.

(3.) Copies of deeds, licences, and any other documents affecting the proprietorship in any letters patent or in any licence thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office.

Fees.

24. (1.) There shall be paid in respect of the several instruments described in the second schedule to this Act the fees in that schedule mentioned, and there shall likewise be paid, in respect of other matters under this part of the Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of her Majesty's Exchequer in such manner as the Treasury may from time to time direct. Fees in schedule.

(2.) The Board of Trade may from time to time, if they think fit, with the consent of the Treasury, reduce any of those fees.

Extension of Term of Patent.

25. (1.) A patentee may, after advertising in manner directed by any rules made under this section his intention to do so, present a petition to her Majesty in Council praying that his patent may be extended for a further term; but such petition must be presented at least six months before the time limited for the expiration of the patent. Extension of term of patent on petition to Queen in Council.

(2.) Any person may enter a caveat, addressed to the Registrar of the Council at the Council office, against the extension.

(3.) If her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same, and the petitioner and any person who has entered a caveat shall be entitled to be heard by himself or by counsel on the petition.

(4.) The Judicial Committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

(5.) If the Judicial Committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for her Majesty in Council to extend the term of the patent for a further term not exceeding seven, or in exceptional cases fourteen, years, or to order the grant of a new patent for a term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee may think fit.

(6.) It shall be lawful for her Majesty in Council to make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.

(7.) The costs of all parties of and incident to such proceedings shall be in the discretion of the Judicial Committee; and the orders of the Committee respecting costs shall be enforceable as if they were orders of a Division of the High Court of Justice.

Revocation.

Revocation of patent. 26. (1.) The proceeding by *scire facias* to repeal a patent is hereby abolished.

(2.) Revocation of a patent may be obtained on petition to the Court.

(3.) Every ground on which a patent might, at the commencement of this Act, be repealed by *scire facias* shall be available by way of defence to an action of infringement and shall also be a ground of revocation.

(4.) A petition for revocation of a patent may be presented by—

(a) The Attorney-General in England or Ireland, or the Lord Advocate in Scotland.

- (b) Any person authorized by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland.
- (c) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims :
- (d) Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee :
- (e) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

(5.) The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the Court or a Judge, be admitted in proof of any objection of which particulars are not so delivered.

(6.) Particulars delivered may be from time to time amended by leave of the Court or a Judge.

(7.) The defendant shall be entitled to begin, and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent, the defendant shall be entitled to reply.

(8.) Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.

Crown.

27. (1.) A patent shall have to all intents the like effect as against her Majesty the Queen, her heirs and successors, as it has against a subject. Patent to bind Crown.

(2.) But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those officers or authorities and the

patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested.

Legal Proceedings.

Hearing with
assessor.

28. (1.) In an action or proceeding for infringement or revocation of a patent, the Court may, if it thinks fit, and shall, on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance; the action shall be tried without a jury unless the Court shall otherwise direct.

(2.) The Court of Appeal or the Judicial Committee of the Privy Council may, if they see fit, in any proceeding before them respectively, call in the aid of an assessor as aforesaid.

(3.) The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Court of Appeal or Judicial Committee, as the case may be, and be paid in the same manner as the other expenses of the execution of this Act.

Delivery of
particulars.

29. (1.) In an action for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the Court or the Judge, at any subsequent time, particulars of the breaches complained of.

(2.) The defendant must deliver with his statement of defence, or, by order of the Court or a Judge, at any subsequent time, particulars of any objections on which he relies in support thereof.

(3.) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him.

(4.) At the hearing no evidence shall, except by leave of the Court or a Judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered.

(5.) Particulars delivered may be from time to time amended, by leave of the Court or a Judge.

(6.) On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a Judge to have been proven or to have been reasonable and proper, without regard to the general costs of the case.

30. In an action for infringement of a patent, the Court or a Judge may on the application of either party make such order for an injunction, inspection, or account, and impose such terms and give such directions respecting the same and the proceedings thereon, as the Court or a Judge may see fit.

Order for inspection, &c., in action.

31. In an action for infringement of a patent, the Court or a Judge may certify that the validity of the patent came in question; and if the Court or a Judge so certifies, then in any subsequent action for infringement the plaintiff in that action on obtaining a final order or judgment in his favour shall have his full costs, charges, and expenses, as between solicitor and client, unless the Court or Judge trying the action certifies that he ought not to have the same.

Certificate of validity questioned and costs thereon.

32. Where any person claiming to be the patentee of an invention by circulars, advertisements, or otherwise threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale, or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats: Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

Remedy in case of groundless threats of legal proceedings.

Miscellaneous.

33. Every patent may be in the form in the first schedule to this Act, and shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention.

Patent for one invention only.

34. (1.) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

Patent on application of representative of deceased inventor.

(2.) Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

Patent to first inventor not invalidated by application in fraud of him.

35. A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.

Assignment for particular places.

36. A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.

Loss or destruction of patent.

37. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may at any time cause a duplicate thereof to be sealed.

Proceedings and costs before law officer.

38. The law officers may examine witnesses on oath and administer oaths for that purpose under this part of this Act, and may from time to time make, alter, and rescind rules regulating references and appeals to the law officers and the practice and procedure before them under this part of this Act; and in any proceeding before either of the law officers under this part of this Act the law officer may order costs to be paid by either party, and any such order may be made a rule of the Court.

Exhibition at industrial or international exhibition not to prejudice patent rights.

39. The exhibition of an invention at an industrial or international exhibition certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely:—

(a) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice of his intention to do so; and

(b) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

Publication of illustrated journal, indexes, &c.

40. (1.) The comptroller shall cause to be issued periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that the comptroller may deem generally useful or important.

(2.) Provision shall be made by the comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents for the time being in force, with their accompanying drawings, if any.

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

41. The control and management of the existing Patent Museum and its contents shall from and after the commencement of this Act be transferred to and vested in the Department of Science and Art, subject to such directions as her Majesty in Council may see fit to give.

Patent
Museum.

42. The Department of Science and Art may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model, the amount to be settled, in case of dispute, by the Board of Trade.

Power to re-
quire models
on payment.

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

Foreign
vessels in
British
waters.

(2.) But this section shall not extend to vessels of any foreign state of which the laws authorize subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its Courts, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign state.

44. (1.) The inventor of any improvement in instruments or munitions of war, his executors, administrators, or assigns (who are in this section comprised in the expression "the inventor"), may (either for or without valuable consideration) assign to her

Assignment
to Secretary
for War of
certain inven-
tions.

Majesty's Principal Secretary of State for the War Department (hereinafter referred to as the Secretary of State), on behalf of her Majesty, all the benefit of the invention and of any patent obtained or to be obtained for the same; and the Secretary of State may be a party to the assignment.

(2.) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State for the time being on behalf of her Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Secretary of State for the time being.

(3.) Where any such assignment has been made to the Secretary of State, he may at any time before the application for a patent for the invention, or before publication of the specification or specifications, certify to the comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4.) If the Secretary of State so certifies, the application and specification or specifications with the drawings (if any), and any amendment of the specification or specifications, and any copies of such documents and drawings, shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the comptroller in a packet sealed by authority of the Secretary of State.

(5.) Such packet shall, until the expiration of the term or extended term during which a patent for the invention may be in force, be kept sealed by the comptroller, and shall not be opened save under the authority of an order of the Secretary of State, or of the law officers.

(6.) Such sealed packet shall be delivered at any time during the continuance of the patent to any person authorized by writing under the hand of the Secretary of State to receive the same, and shall if returned to the comptroller be again kept sealed by him.

(7.) On the expiration of the term or extended term of the patent, such sealed packet shall be delivered to any person authorized by writing under the hand of the Secretary of State to receive it.

(8.) Where the Secretary of State certifies as aforesaid after

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

(9.) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which the Secretary of State has certified as aforesaid.

(10.) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public; but, save as in this section otherwise directed, the provisions of this part of this Act shall apply in respect of any such invention and patent as aforesaid.

(11.) The Secretary of State may, at any time by writing under his hand, waive the benefit of this section with respect to any particular invention, and the specifications, documents, and drawings shall be henceforth kept and dealt with in the ordinary way.

(12.) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State, or to any person or persons authorized by him to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

Existing Patents.

45. (1.) The provisions of this Act relating to applications for patents and proceedings thereon shall have effect in respect only of application made after the commencement of this Act.

Provisions respecting existing patents.

(2.) Every patent granted before the commencement of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licences.

(3.) In all other respects (including the amount and time of payment of fees) this Act shall extend to all patents granted before the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

E.

(4.) All instruments relating to patents granted before the commencement of this Act required to be left or filed in the Great Seal Patent Office shall be deemed to be so left or filed if left or filed before or after the commencement of this Act in the Patent Office.

Definitions.

Definitions of "patent," "patentee," and "invention."

46. In and for the purposes of this Act—

"Patent" means letters patent for an invention;

"Patentee" means the person for the time being entitled to the benefit of a patent;

"Invention" means any manner of new manufacture the subject of letters patent and grant of privilege within sect. 6 of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter 3, intituled "An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof"), and includes an alleged invention.

In Scotland "injunction" means "interdict."

PART III.

DESIGNS.

Registration of Designs.

Application for registration of designs.

47. (1.) The comptroller may, on application by or on behalf of any person claiming to be the proprietor of any new or original design not previously published in the United Kingdom, register the design under this part of this Act.

(2.) The application must be made in the form set forth in the first schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, the Patent Office in the prescribed manner.

(3.) The application must contain a statement of the nature of the design, and the class or classes of goods in which the applicant desires that the design be registered.

(4.) The same design may be registered in more than one class.

(5.) In case of doubt as to the class in which a design ought to be registered, the comptroller may decide the question.

(6.) The comptroller may, if he thinks fit, refuse to register any design presented to him for registration, but any person

aggrieved by any such refusal may appeal therefrom to the Board of Trade.

(7.) The Board of Trade shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

48. (1.) On application for registration of a design the applicant shall furnish to the comptroller the prescribed number of copies of drawings, photographs, or tracings of the design sufficient, in the opinion of the comptroller, for enabling him to identify the design; or the applicant may, instead of such copies, furnish exact representations or specimens of the design. Drawings, &c., to be furnished on application.

(2.) The comptroller may, if he thinks fit, refuse any drawing, photograph, tracing, representation, or specimen which is not, in his opinion, suitable for the official records.

49. (1.) The comptroller shall grant a certificate of registration to the proprietor of the design when registered. Certificate of registration.

(2.) The comptroller may in case of loss of the original certificate, or in any other case in which he deems it expedient, grant a copy or copies of the certificate.

Copyright in Registered Designs.

50. (1.) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during five years from the date of registration. Copyright on registration.

(2.) Before delivery on sale of any articles to which a registered design has been applied, the proprietor must (if exact representations or specimens were not furnished on the application for registration) furnish to the comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the comptroller may erase his name from the register, and thereupon his copyright in the design shall cease.

51. Before delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark, or with the prescribed word or words or figures, denoting that the design is registered; and if he fails to do so, the copyright in the design shall cease, unless the proprietor shows that he took all proper steps to ensure the marking of the article. Marking registered designs.

52. (1.) During the existence of copyright in a design, the design shall not be open to inspection except by the proprietor, Inspection of registered designs.

or a person authorized in writing by the proprietor, or a person authorized by the comptroller or by the Court, and furnishing such information as may enable the comptroller to identify the design, nor except in the presence of the comptroller or of an officer acting under him, nor except on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof.

(2.) When the copyright in a design has ceased, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.

Information
as to existence
of copyright.

53. On the request of any person producing a particular design, together with its mark of registration, or producing only its mark of registration, or furnishing such information as may enable the comptroller to identify the design, and on payment of the prescribed fee, it shall be the duty of the comptroller to inform such person whether the registration still exists in respect of such design, and if so, in respect of what class or classes of goods, and stating also the date of registration, and the name and address of the registered proprietor.

Cesser of
copyright in
certain
events.

54. If a registered design is used in manufacture in any foreign country and is not used in this country within six months of its registration in this country, the copyright in the design shall cease.

Register of Designs.

Register of
Designs.

55. (1.) There shall be kept at the Patent Office a book called the Register of Designs, wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may from time to time be prescribed.

(2.) The Register of Designs shall be *prima facie* evidence of any matters by this Act directed or authorized to be entered therein.

Fees.

Fees on regis-
tration, &c.

56. There shall be paid in respect of applications and registration and other matters under this part of this Act such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of her Majesty's exchequer in such manner as the Treasury shall from time to time direct.

Industrial and International Exhibitions.

57. The exhibition at an industrial or international exhibition certified as such by the Board of Trade, or the exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof, provided that both the following conditions are complied with ; namely,—

Exhibition at industrial or international exhibition not to prevent or invalidate registration.

- (a) The exhibitor must, before exhibiting the design or article, or publishing a description of the design, give the controller the prescribed notice of his intention to do so; and
- (b) The application for registration must be made before or within six months from the date of the opening of the exhibition.

Legal Proceedings.

58. During the existence of copyright in any design—

- (a) It shall not be lawful for any person without the licence or written consent of the registered proprietor to apply such design or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale to any article of manufacture or to any substance artificial or natural or partly artificial and partly natural ; and
- (b) It shall not be lawful for any person to publish or expose for sale any article of manufacture or any substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor.

Penalty on piracy of registered design.

Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract debt by action in any court of competent jurisdiction.

59. Notwithstanding the remedy given by this Act for the recovery of such penalty as aforesaid, the registered proprietor of any design may (if he elects to do so) bring an action for the

Action for damages.

recovery of any damages arising from the application of any such design, or of any fraudulent or obvious imitation thereof for the purpose of sale, to any article of manufacture or substance, or from the publication, sale, or exposure for sale by any person of any article or substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, such person knowing that the proprietor had not given his consent to such application.

Definitions.

60. In and for the purposes of this Act—

Definition of
“design,”
“copyright.”

“Design” means any design applicable to any article of manufacture, or to any substance artificial or natural or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for a sculpture, or other thing within the protection of the Sculpture Copyright Act of the year 1814 (fifty-fourth George the Third, chapter 56).

“Copyright” means the exclusive right to apply a design to any article of manufacture or to any such substance as aforesaid in the class or classes in which the design is registered.

Definition of
“proprietor.”

61. The author of any new and original design shall be considered the “proprietor” thereof unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor, and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person or otherwise, and also every person on whom the property in such design or such right to the application thereof shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been so acquired, and to that extent, but not otherwise.

PART IV.

TRADE MARKS.

Registration of Trade Marks.

62. (1.) The comptroller may, on application by or on behalf of any person claiming to be the proprietor of a trade mark, register the trade mark. Application for registration.

(2.) The application must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to *the Patent Office in the prescribed manner*].

(3.) The application must be accompanied by the prescribed number of representations of the trade mark, and must state the particular goods or classes of goods in connexion with which the applicant desires the trade mark to be registered.

(4.) The comptroller may, if he thinks fit, refuse to register a trade mark, but any such refusal shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(5.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court; and in that event the Court shall have jurisdiction to hear and determine the appeal and may make such order as aforesaid.

63. Where registration of a trade mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant [*the application shall be deemed to be abandoned*]. Limit of time for proceeding with application.

64. [(1.) *For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars :*

(a) *A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner ; or* Conditions of registration of trade mark.
Repealed.

(b) *A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark ; or*

(c) *A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use.*

(2.) *There may be added to any one or more of these particulars any letters, words or figures, or combination of letters words or figures, or of any of them.*

(3.) *Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five may be registered as a trade mark under this part of this Act.*

Connection of trade mark with goods. Registration of a series of marks.

65. A trade mark must be registered for particular goods or classes of goods.

66. When a person claiming to be the proprietor of several trade marks which, while resembling each other in the material particulars thereof, yet differ in respect of (a) the statement of the goods for which they are respectively used or proposed to be used, or (b) statements of numbers, or (c) statements of price, or (d) statements of quality, or (e) statements of names of places, seeks to register such trade marks, they may be registered as a series in one registration. A series of trade marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade marks composing a series shall be deemed and treated as registered separately.

Trade marks may be registered in any colour.

67. A trade mark may be registered in any colour, and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour.

Advertisement of application.

68. Every application for registration of a trade mark under this part of this Act shall as soon as may be after its receipt be advertised by the comptroller.

Opposition to registration.

69. (1.) Any person may within [two months] of the [first] advertisement of the application, give notice in duplicate at the Patent Office of opposition to registration of the trade mark, and the comptroller shall send one copy of such notice to the applicant.

(2.) Within [two months] after receipt of such notice or such further time as the comptroller may allow, the applicant may send to the comptroller a counter statement in duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

Repealed.

[(3.) *If the applicant sends such counter statement, the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall require him to give security in such manner and to such amount as the comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement*