

Court will not consider the injury to the defendant, but will protect the plaintiff from the possible consequences of the market being flooded with articles manufactured in infringement of his patent, supposing him to be able to sustain it.<sup>(q)</sup> If it appears that an interim injunction would seriously prejudice the defendant, and not benefit the plaintiff, it will be refused.<sup>(r)</sup>

On application for interlocutory injunction the Court avoids expressing an opinion on the case and endeavours to keep things *in statu quo*.

On an interlocutory application the Court avoids as far as possible expressing an opinion on the merits of the case,<sup>(s)</sup> and does not decide the question of validity unless the patent appears on the face of it so irretrievably and hopelessly bad that it could not possibly be supported.<sup>(t)</sup> The Court endeavours to keep things *in statu quo*.<sup>(u)</sup>

Where a defendant contended that he was working under a patent of his own, which he maintained was valid, Cottenham, L.C., in refusing an interim injunction said: "It would be rash in me if I were to give an opinion, coming to a conclusion contrary to what is sworn by the most eminent scientific persons in this country. If in a question so open to doubt as this I should interfere with the defendant I should be setting up my own judgment in opposition to those who, being practically acquainted with matters of this description, have deposed that, according to all rules and principles, the subject-matter of the defendant's patent may be perfectly new and unconnected with anything claimed by the plaintiff. I may not be satisfied that these gentlemen are right, or that the plaintiffs are wrong, but I am satisfied that the case is not one so free from doubt as to justify me in interfering."<sup>(v)</sup>

Evidence sufficient to obtain an interlocutory injunction.

Where the Court is satisfied that what the defendant has done is a mere invasion of the plaintiff's patent it will grant an interim injunction.<sup>(x)</sup>

<sup>(q)</sup> Davenport *v.* Jepson, 4 De G. F. & J. 448; Hamar *v.* Plane, 14 Ves. 130; Stevens *v.* Keating, 2 W. P. C. 177.

<sup>(r)</sup> Neilson *v.* Thompson, 1 W. P. C. 275, 286; Morgan *v.* Seaward, 1 W. P. C. 167; Thomson *v.* Hughes, 7 P. O. R. 71.

<sup>(s)</sup> Plimpton *v.* Malcolmson, L. R. 20 Eq. 38.

<sup>(t)</sup> Briggs *v.* Lardeur, 1 P. O. R. 126;

Shillito *v.* Larmuth, 2 P. O. R. 1; Plimpton *v.* Malcolmson L. R. 20 Eq. 38,

<sup>(u)</sup> Plimpton *v.* Spiller, L. R. 4 Ch. D. 288.

<sup>(v)</sup> Electric Telegraph Co. *v.* Nott, 11 Jur. 157; 2 Coop. C. C. 41. See also Morgan *v.* Seaward, 1 W. P. C. 167; Muntz *v.* Vivian, 2 W. P. C. 87.

<sup>(x)</sup> Thorn *v.* Worthing Skating Rink Co., L. R. 6 Ch. D. 415 n.

To obtain an injunction on an interlocutory application it is sufficient to show one clear instance of infringement,<sup>(y)</sup> or to make out a *prima facie* case ;<sup>(z)</sup> and the Court of Appeal is slow to interfere with the discretion of a judge of first instance who is satisfied as to the existence of a *prima facie* case.<sup>(a)</sup>

The question of the validity of the patent, though not decided on an interlocutory application is, and ought to be, an important consideration with the Court when determining whether or not to grant an interim injunction.<sup>(b)</sup> Where the infringement is made out, and there is a presumption in favour of the validity of the patent arising, *e.g.*, from long previous enjoyment, or from the circumstance of the patent having been supported in previous litigation,<sup>(c)</sup> or if the defendant is estopped from denying the validity of the patent <sup>Question of the validity of the patent is important consideration.</sup> <sup>(d)</sup> an interim injunction will be granted.

The rule was laid down and acted upon previously to the Act of 1883 that an interim injunction will be refused where the patent is recent, and there is a serious question as to its validity.<sup>(e)</sup>

It may possibly be held on some future occasion that ss. 10 and 11 of the Act of 1883, in virtue of the investigation and protection which they afford to the public, have altered this rule.<sup>(f)</sup>

An important factor which determines the Court in granting or refusing an interlocutory injunction, is the strength of the presumption in favour of the validity of the patent. A presumption in favour of the validity of the patent may arise from long enjoyment, a prior action resulting in a declaration of validity, or other circumstances. Where there has been long enjoyment under a patent the presumption in favour of its validity is based on the consideration that it was in the power of anybody to have <sup>Presumption in favour of the validity of the patent.</sup>

<sup>(y)</sup> United Telephone Co. v. Sharplez, L. R. 29 Ch. D. 164, 169.

<sup>(z)</sup> Briggs v. Lardeur, 1 P. O. R. 128; Shillito v. Larmuth, 2 P. O. R. 1, 3; Anderson v. Patent Oxonite Co., Limited, 3 P. O. R. 279.

<sup>(a)</sup> Baker v. White, 1 Times R. 64.

<sup>(b)</sup> Jackson v. Needle, 1 P. O. R. 174, 177.

<sup>(c)</sup> Dudgeon v. Thomson, 30 L. T. N. S. 244; Bovill v. Goodier, 35 L. J.

Ch. 174; 35 Beav. 427; Bovill v. Smith, W. N. 1867, 240; Davenport v. Goldberg, 2 H. & M. 282; Davenport v. Jepson, 4 De G. F. & J. 448; Newall v. Wilson, 2 De G. M. & G. 282.

<sup>(d)</sup> See p. 434 *ante*.

<sup>(e)</sup> Jackson v. Needle, 1 P. O. R. 174, 177; Lister v. Norton, 1 P. O. R. 114; Caldwell v. Van Vlissingen, 9 Hare, 424.

<sup>(f)</sup> Jackson v. Needle, 1 P. O. R. 177.



obtained the repeal of the patent, by *scire facias* before 1884 and on petition for revocation since that date, yet no one has done so. *(g)*

Long, active, and uninterrupted enjoyment.

Where it is established to the satisfaction of the Court that the plaintiff has been in long, active, *(h)* and uninterrupted *(i)* enjoyment of the patent, an interim injunction will be granted, notwithstanding that the validity of the patent may be doubtful; for if a party gets his patent and puts his invention in execution, and has proceeded to a sale, that may be called possession under it, however doubtful it may be, whether the patent can be sustained; and possession under colour of title is ground enough to enjoin and to continue the injunction till it is proved that it is only colour and not real title; *(k)* provided that the enjoyment has been sufficiently long, and the patent is not on the face of it so irretrievably and hopelessly bad that it is clear it cannot be supported. *(l)*

Thus, where a patentee had been in possession of his exclusive privilege for several years, and a defect in the specification was suggested, the Court refused to allow the privilege to be disturbed until the question of title had been decided; *(m)* and an injunction has been granted in the face of a prior specification, which seemed to be fatal. *(n)*

Not necessary to state that the patent has never been disputed.

It is not necessary for the plaintiff, on motion for an interim injunction, to state that the patent has never been disputed, nor is the mere assertion that the patent is invalid sufficient to determine the Court to withhold the injunction. *(o)*

The Court will, in the words of Jessel, M.R., "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

*(g)* Davenport *v.* Jepson, 4 De G. F. & J. 440; Caldwell *v.* Van Vlissingen, Hare, 415, 424; Electric Telegraph Co. *v.* Nott, 2 Coop. Ch. Cas. 41; 46 & 47 Vict. c. 57, s. 26.

*(h)* p. 463.

*(i)* *Ibid.*

*(k)* See judgment of Eldon, L.C., Universities of Oxford and Cambridge *v.* Richardson, 6 Ves. 706; Dudgeon

*v.* Thomson, 30 L. T. N. S. 244; Betts *v.* Menzies, 3 Jur. N. S. 357, 358; Gardner *v.* Broadbent, 2 Jur. N. S. 1041.

*(l)* p. 463; Briggs *v.* Lardeur, 1 P. O. R. 126; Shillito *v.* Larmuth, 2 P. O. R. 1.

*(m)* Muntz *v.* Foster, 2 W. P. C. 93, 95.

*(n)* Losh *v.* Hague, 1 W. P. C. 201.

*(o)* Read *v.* Andrew, 2 P. O. R. 119, 122.

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 himself, there is no reason to doubt the validity of the patent.”(p)

If the plaintiff relies on long enjoyment as entitling him to a presumption in favour of the validity of his patent on an application for an interim injunction, it is incumbent on him to show that he has actually used the invention. Thus, an injunction was refused where the plaintiff was only able to produce evidence of actual user at a recent period, notwithstanding that the patent was ten years old.(q)

If plaintiff relies on long enjoyment, he must show that he has actually used the invention,

It is also incumbent on the plaintiff to show that his enjoyment of the monopoly has been an uninterrupted one; (r) and it has been held that where the invention is of such a nature that it cannot be exercised without the licence of a prior patentee, the plaintiff's undisturbed enjoyment only commences from the expiration of the prior patent, and where this amounts to only one year the injunction must be refused.(s)

and his enjoyment has been uninterrupted.

In regard to the length of uninterrupted and active enjoyment of the monopoly claimed under a patent which will establish a monopoly in favour of the validity of the patent, and also entitle a plaintiff to an interim injunction, thirteen,(t) twelve,(u) eleven,(v) ten,(w) nine,(y) eight,(z) seven,(a) and six (b) years have, on different occasions, been held to be sufficient.

Length of uninterrupted active enjoyment which entitles plaintiff to interlocutory injunction.

Three years was held sufficient under circumstances from which it appeared that, previously to the grant of the patent,

(p) *Dudgeon v. Thomson*, 30 L. T. N. S. 244; S. C. 22 W. R. 464; see also *Hill v. Thompson*, 3 Mer. 622; S. C. 1 W. P. C. 229, 231; *Universities of Oxford and Cambridge v. Richardson*, 6 Ves. 689, 707; *Stevens v. Keating*, 2 W. P. C. 177; *Hamar v. Plane*, 14 Ves. 130; *Bickford v. Skewes*, 1 W. P. C. 211, 213; *Electric Telegraph Co. v. Nott*, 2 Coop. Ch. Cas. 41; *Wilson v. Tindal*, 1 W. P. C. 730; *Renard v. Levinstein*, 10 L. T. N. S. 94; *Davenport v. Jepson*, 4 De G. F. & J. 440.

(q) *Plimpton v. Malcolmson*, L. R. 20 Eq. 38.

(r) *Collard v. Allison*, 4 My. & Cr. 487; *Curtis v. Cutts*, 8 L. J. N. S. Ch. 184; 2 Coop. C. C. 60; *Hill v. Thompson*, 3 Mer. 622.

(s) *Hugh v. Magill*, W. N. 1877, 62.

(t) *Hamar v. Plane*, 14 Ves. 130; *Read v. Andrew*, 2 P. O. R. 119; *Stevens v. Keating*, 2 W. P. C. 176.

(u) *Neilson v. Thompson*, 1 W. P. C. 279.

(v) *Wilson v. Tindal*, 1 W. P. C. 730.

(w) *Shillito v. Larmuth*, 2 P. O. R. 1.

(y) *Davenport v. Richard*, 3 L. T. N. S. 503.

(z) *Betts v. Menzies*, 3 Jur. N. S. 357; L. R. 3 Eq. 312.

(a) *Stevens v. Keating*, 2 W. P. C. 176; *Osmond v. Hirst*, 2 P. O. R. 265.

(b) *Rothwell v. King*, 3 P. O. R. 379; *Bickford v. Skewes*, 1 W. P. C. 211, 213; *Renard v. Levinstein*, 10 L. T. N. S. 94.



many inventors had been endeavouring to obtain the result achieved by the patentee, who had since the grant sold, at considerable profits, numerous articles manufactured according to the invention without his monopoly being previously questioned; (c) though where the plaintiff's patent was three years old, but the works enabling him to carry on operations under it were not completed till one year before Bill filed, the injunction was refused.(d)

Where a patent was only two years old at the commencement of an action an interim injunction was obtained, but afterwards it was dissolved by the Lord Justices on appeal, Knight Bruce, L.J., saying, in reference to the recent date of the letters patent: "There cannot have been any considerable length of enjoyment under them, and the defendant, in such a case, at least is entitled, I apprehend, to the benefit of any reasonable doubt and reasonable difficulty which he can show to exist as to the sufficiency and validity of the specification."(e)

Again, where a patent was a recent one and the only question as to its validity was one founded on an objection to the sufficiency of the specification, and it was proved that a competent workman, with no other assistance than the specification, could work the invention, an interlocutory injunction was refused.(f)

Where validity of the patent has been previously established the Court, on application for an interlocutory injunction, regards the patent as valid.

Where the validity of the patent has been established on previous occasions, though it is open to the defendant at the trial to dispute it, the Court will, on an interlocutory application, regard its validity as sufficiently established by the previous proceedings as to warrant the grant of an interim injunction,(g) if the infringement is clear,(h) or there is a *prima facie* case of infringement,(i) and this notwithstanding that the defendant disputes the validity of the patent on a ground not raised in any of the previous proceedings.(j)

(c) *Wheatstone v. Wilde*, Griff. P. C. 247.

(d) *Hill v. Thompson*, 1 W. P. C. 232; 3 Mer. 622; see also *Plimpton v. Malcolmsen*, L. R. 20 Eq. 37.

(e) *Renard v. Levinstein*, 10 L. T. N. S. 177.

(f) *Coles v. Baylis*, 3 P. O. R. 178.

(g) *Dudgeon v. Thomson*, 30 L. T. N. S. 244; *Davenport v. Jepson*, 4 De G. F. & J. 440; *Davenport v. Goldberg*,

2 H. & M. 282; *Newall v. Wilson*, 2 De G. M. & G. 282; *Bovill v. Smith*, W. N. 1867, p. 240; *Bovill v. Goodier*, L. R. 2 Eq. 200.

(h) *Hayward v. The Pavement Light Co.*, 1 P. O. R. 207.

(i) *Thorn v. Worthing Skating Rink Co.*, L. R. 6 Ch. D. 415 n.

(j) *Newall v. Wilson*, 2 De G. M. & G. 282.

The fact that a plaintiff has succeeded in obtaining an interdict of a Scotch Court restraining a prior infringement in Scotland, is sufficient *prima facie* evidence of the validity of the patent to justify the grant of an interim injunction against a subsequent infringement in England.<sup>(k)</sup>

Sufficient  
*prima facie*  
evidence of  
validity.

Where a patent had been the subject of an arbitration at the request of parties to a former action, and the arbitrator had given his award in favour of its validity, the Court, in a subsequent action of infringement against the same defendant, considered the patent sufficiently established by the arbitrator's award, and granted an interlocutory injunction.<sup>(l)</sup>

An interim injunction will be granted in a subsequent action, where it is shown by the plaintiff that he has established his patent on a former occasion, though against a different defendant; but the subsequent defendant will at the trial be in no way bound by the previous decision, and may contest the patent anew on the same or different evidence, and he cannot be compelled to do so by presenting a petition for its revocation.<sup>(m)</sup> It is submitted that in such a case the Court will consider itself bound as to the interpretation of the specification by the construction put upon it by a Court of equal or superior jurisdiction.<sup>(n)</sup>

Although the Court has the power to grant an interlocutory injunction *simpliciter*,<sup>(o)</sup> it is the invariable practice not to do so, but to bind the plaintiff in an undertaking to indemnify the defendant, if it should ultimately turn out that the patent is bad and that the injunction ought, therefore, not to have been granted; <sup>(p)</sup> and the undertaking is equally required where the patent has been established on former occasions, as where there has been no previous contest.<sup>(q)</sup>

Practice on  
granting in-  
terlocutory in-  
junctions.

(k) *Dudgeon v. Thomson*, 30 L. T. N. S. 244; *Stevens v. Keating*, 19 L. J. N. S. Ex. 57; 2 W. P. C. 176, 177.

(l) *Lister v. Eastwood*, 26 L. T. 4.

(m) *Bovill v. Goodier* (2), L. R. 2 Eq. 195; *Russell v. Barnsley*, 1 W. P. C. 472; 2 Coop. Ch. Cas. 58; but see *Davenport v. Goldberg*, 2 H. & M. 286.

(n) *Edison v. Holland*, 6 P. O. R. 243, 249, 276; *Slazenger v. Feltham*, 6 P. O. R. 130.

(o) *Bacon v. Jones*, 4 M. & C. 436;

*Wilson v. Tindal*, 1 W. P. C. 730; *Bickford v. Skewes*, 1 W. P. C. 214; *Tuck v. Silver, John*. 218.

(p) *Chappell v. Davidson*, 8 D. M. & G. 1; *Tuck v. Silver, John*. 218; *Wakefield v. Duke of Buccleuch*, 11 Jur. N. S. 523; *Graham v. Campbell*, L. R. 7 Ch. D. 490; *Muntz v. Grenfell*, 2 W. P. C. 91; 2 Coop. Ch. Cas. 59.

(q) *United Telephone Co. v. Taskar*, 5 P. O. R. 628, 633; *Bovill v. Smith*, W. N. 1867, 240.



Unexplained and unreasonable delay in making an application to enforce the undertaking to be answerable in damages will be sufficient ground for refusing it; (*t*) but the undertaking is not put an end to by the discontinuance, (*u*) or dismissal, (*v*) of the action.

The undertaking can be enforced when the injunction has been wrongly granted owing to a mistake of law by the judge; (*x*) and it may be entered into by, (*y*) and enforced against, a married woman. (*z*)

Practice on refusal of interlocutory injunctions.

When an interim injunction is refused, either on the ground that the infringement is doubtful, or on the ground of delay, (*a*) the usual course is to order the defendant to keep an account. (*b*)

Forms of order for account.

This order for an account may be made in different forms, as the circumstances of the case may require. (*c*)

In *Neilson v. Thompson*, the account was for the future as well as from the commencement of the infringement. (*d*) But in *Vidi v. Smith* (*e*) the Court held that a retrospective account should not be granted till final judgment. This is the most general form in which the order is made; (*f*) though in *Plimpton v. Malcolmson*, (*g*) and *Russell v. Cowly*, (*h*) the account was of "all moneys received or to be received" by the sale of the patented articles, and in *Beardsell v. Schwann*, (*i*) the account was of the articles only. (*k*)

Defendant unable to be answerable in damages.

If it be shown that the defendant is unable to be answerable in damages an injunction will probably be granted on that ground. (*l*)

- (*t*) *Ex parte Hall*, L. R. 23 Ch. D. 644.  
 (*u*) *Newcomen v. Coulson*, L. R. 7 Ch. D. 764.  
 (*v*) *Newby v. Harrison*, 3 De G. F. & J. 287; *Graham v. Campbell*, L. R. 7 Ch. D. 490.  
 (*x*) *Griffith v. Blake*, L. R. 27 Ch. D. 474; *Hunt v. Hunt*, 54 L. J. Ch. 289; *Rothwell v. King*, 4 P. O. R. 76.  
 (*y*) *Re Prynne*, W. N. 1885, p. 144.  
 (*z*) *Hunt v. Hunt*, 54 L. J. Ch. 289.  
 (*a*) *Bovill v. Crate*, L. R. 1 Eq. 388; *Neilson v. Thompson*, 1 W. P. C. 286; *Lister v. Norton*, 1 P. O. R. 114.  
 (*b*) *Ibid.*; *Bacon v. Jones*, 4 My. & Cr. 436; *Jackson v. Needle*, 1 P. O. R. 176; *Hill v. Thompson*, 1 W. P. C. 232; 3 Mer. 662; *Morgan v. Seaward*, 1 W. P. C. 169.  
 (*c*) For common form of order see *Seton*, 4th ed. p. 344.  
 (*d*) 1 W. P. C. 286.  
 (*e*) 3 E. & B. 969.  
 (*f*) See *Plimpton v. Spiller*, L. R. 4 Ch. D. 286.  
 (*g*) *Seton*, 4th ed. p. 344.  
 (*h*) 1 W. P. C. 458.  
 (*i*) *Seton*, 3rd ed. p. 910.  
 (*k*) See also *Hill v. Thompson*, 3 Mer. 626; *Jackson v. Needle*, 1 P. O. R. 176.  
 (*l*) *Newall v. Wilson*, 2 De G. M. & G. 282; *Plimpton v. Spiller*, L. R. 4 Ch. D. 286.

Though laches may disentitle a plaintiff to an interlocutory Laches. injunction,<sup>(m)</sup> yet delay to enforce a legal right does not prevent a person from bringing an action, provided it does not cause a statutory bar,<sup>(n)</sup> and consequently delay or acquiescence which would prevent the plaintiff from succeeding on an interlocutory application may be no bar to his right to a perpetual injunction at the trial,<sup>(o)</sup> and to damages or an account.<sup>(p)</sup>

### *Perpetual Injunctions.*

If at the trial of an action the plaintiff succeeds in con-clusively<sup>(q)</sup> proving that the defendant has infringed, and the validity of the patent is established, one of the remedies to which he is usually entitled is a perpetual injunction restraining the defendant from repeating the acts complained of during the continuance of the monopoly. And where the defendant is desirous and willing to consent to a perpetual injunction without bringing the action to a trial, it may be obtained, by the consent of both parties, on the hearing of the motion,<sup>(r)</sup> or by summons in chambers.<sup>(s)</sup> A defendant is entitled to withdraw his consent to a perpetual injunction, if it was given under mistake or surprise.<sup>(t)</sup>

Perpetual in-junction.

Acquiescence on the part of the plaintiff may induce the Court to refuse an injunction but to grant damages.<sup>(u)</sup>

Generally speaking, the Court will not grant an injunction if the patent has expired before the commencement or during the course of an action;<sup>(v)</sup> but where it appeared that the patent would expire in a few days, and that the defendant had piratically manufactured a large stock of the patented article ready to throw on the market as soon as the monopoly was at an end,

Not generally granted if the patent has expired before the commencement or during the course of the action.

<sup>(m)</sup> p. 456 *ante*.

<sup>(n)</sup> *Three Towers Banking Co. v. Maddever*, L. R. 27 Ch. D. 523; *Wood v. Lambert*, 3 P. O. R. 84.

<sup>(o)</sup> *Fullwood v. Fullwood*, L. R. 9 Ch. D. 176; *Johnson v. Wyatt*, 2 De G. J. & S. 18, 25; *Proctor v. Bennis*, L. R. 36 Ch. D. 740; *Bacon v. Spottiswoode*, 1 Beav. 382.

<sup>(p)</sup> *Bovill v. Crate*, L. R. 1 Eq. 388.

<sup>(q)</sup> *Hill v. Evans*, 4 De G. F. & J. 288.

<sup>(r)</sup> *Morrell v. Pearson*, 12 Beav. 284.

<sup>(s)</sup> 46 & 47 Vict. c. 57, s. 30; *Judic.*

*Act*, 1873, s. 39; *Frearson v. Loe*, 26 W. R. 138.

<sup>(t)</sup> *Elsas v. Williams*, 1 Times Rep. 144.

<sup>(u)</sup> *Sayers v. Collyer*, L. R. 28 Ch. D. 103.

<sup>(v)</sup> *Betts v. Gallais*, L. R. 10 Eq. 392; *Davenport v. Rylands*, L. R. 1 Eq. 302; 35 L. J. Ch. 204; *Price's Patent Candle Co. v. Bauwen's Patent Candle Co.*, 4 K. & J. 727; *Smith v. L. & S. W. R. Co.*, Macr. P. C. 209; 23 L. J. Ch. 562.



Lyndhurst, L.C., granted an injunction to restrain the sale of such articles both before and after the term limited by the grant of the patent.(x)

Injunction granted where there is no actual infringement but an intention to infringe.

Although no actionable infringement has been committed, and consequently there could be no claim to damages, yet if there is an evident intention on the part of the defendant to infringe, the Court will grant an injunction.(y) Thus, where it appeared that the defendants had opposed the plaintiff's application for a patent and had infringed it during the interval between the filing and acceptance of the specification, and also subsequently, the Court, though there was no actionable infringement, granted its injunction, on the ground that there was an evident intention to infringe.(z)

Consequences of breach of an injunction.

As a rule, the breach of an injunction of the Court is a contempt, which renders the party guilty of it liable to committal, and it is no answer for a defendant to say that he did not intend to commit the contempt, for if he has actually infringed after injunction he has committed a contempt.(a)

Breach of an injunction may be a duty.

There may be cases in which a breach of an injunction of the Court is not only justifiable but a positive duty. Thus, James, L.J., in reference to a case in which the majority of the Court of Appeal confirmed an injunction restraining the master of a ship from using certain patented pumps, with which the ship was exclusively fitted, said: "In the absence of the owners it appears to me that the Court could not make a mandatory injunction as to the equipment of the ship. And, that being so, I cannot concur in granting an injunction to restrain the master from doing what it appears to me to be his plain duty to do. Whatever appliances there may happen to be on board, however they came there, pumps, anchors, fire extinguishers, stolen or not stolen, pirated or not pirated, it is his bounden duty to use them according to the exigencies of navigation for the safety of ship, cargo, and life. To the master when out at sea (injunction or no injunction), *salus navis est suprema lex*. And for myself,

(x) *Crossley v. Beverley*, 3 Car. & P. 513; 1 Russ. & M. 166 n.; 1 W. P. C. 106.

(y) *Frearson v. Loe*, L. R. 9 Ch. D. 48; *Dowling v. Billington*, 7 P. O. R. 191.

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

(a) *Plimpton v. Spiller*, L. R. 4 Ch. D. 288; *Thomson v. Moore*, 6 P. O. R. 426, 445.

I believe that a master would be practically as safe in disobeying an injunction under a pressing emergency as he would be in shooting a mutineer. And in my opinion, if a single life was lost through the master's neglect to use such appliances, the injunction would be no defence to an indictment for manslaughter."*(b)*

It is doubtful whether on a motion for sequestration against a company and committal against the directors for breach of a perpetual injunction, the Court has power to order an account of profits or the delivery up of the infringing articles.*(c)*

It is a complete answer to a motion for committal for breach of a perpetual injunction restraining infringements of a patent to show that since the injunction the patent has expired, and that the acts complained of were done subsequently to such expiration.*(d)*

Answer to motions for committal for breach of injunction.

Where on a motion to commit for breach of an injunction restraining infringements it appeared that the article complained of was different from that in respect of which the injunction was originally granted, the Court, being of opinion that the new article was also an infringement, but not deciding the question, did not make an order for committal, but upon the plaintiff giving an undertaking as to damages, granted an injunction restraining the manufacture of the new article until further order, and this course was subsequently approved of by the Court of Appeal.*(e)*

It is not a contempt of Court to publish, after a judgment has been obtained, advertisements asking for evidence of the anticipation and publication of the subject-matter of the patent,*(f)* or for subscriptions towards the expenses of an appeal.*(g)*

Instances of no contempt.

Solicitor and client costs may, on a motion to commit for breach of an injunction, be given to a successful plaintiff,*(h)* but not to a successful respondent.*(i)*

Where it appeared that the acts complained of had not been

*(b)* Adair v. Young, L. R. 12 Ch. D. 21.

*(c)* Spencer v. The Ancoats Vale Rubber Co., 6 P. O. R. 67.

*(d)* Daw v. Ely, L. R. 3 Eq. 497

*(e)* Plimpton v. Spiller, L. R. 4 Ch. D. 286.

*(f)* Plating Co. v. Farquharson, L. R. 17 Ch. D. 49.

*(g)* Ibid. *(h)* Ibid. *(i)* Ibid.



done vexatiously, but in the probable belief—an erroneous one—that the defendants were entitled to do what they did, solicitor and client costs were refused, but costs on the higher scale were given.(*k*)

*Evidence.*

Evidence  
not within  
particulars.

By the Act of 1852,(*l*) the evidence of both the plaintiff and the defendant was strictly confined to the particulars which had been given, and, therefore, if at the trial either party wished to give evidence not within them, the proper course was to apply at once for leave to amend, on the ground that fresh evidence had come to light since they were delivered.(*m*)

The Act of 1883 has somewhat enlarged the opportunities open to litigants of giving evidence at the trial by enacting that at the hearing no evidence shall, *except by the leave of the Court or a judge*, be admitted in proof of any alleged infringement or objection of which particulars have not been delivered ;(*n*) but it is not safe to rely on the Court granting the necessary leave, and consequently, if a party desire to go outside his particulars on the ground that the evidence was discovered since they were delivered, he should still apply for leave to amend, which will, however, not be granted unless he makes out a sufficient case.(*o*)

Evidence  
under par-  
ticulars which  
have not been  
objected to.

When particulars have been delivered, and not objected to, such evidence may be given under them as their words are sufficiently wide to include ;(*p*) and, however general they may be, if the evidence tendered is within their literal meaning, it will be admitted.(*q*)

Thus evidence of user in Cheshire was admitted under an objection which alleged that the invention had been publicly used in “corn mills ;”(*r*) and where the particulars alleged

(*k*) *Spencer v. The Ancoats Vale Rubber Co.*, 6 P. O. R. 46, 68.

(*l*) S. 41.

(*m*) *Daw v. Eley*, L. R. 1 Eq. 38.

(*n*) S. 29 (4).

(*o*) *Moss v. Malings*, L. R. 33 Ch. D. 603 ; *Renard v. Levinstein*, 13 W. R. 229 ; 11 L. T. N. S. 505.

(*p*) *Neilson v. Harford*, 1 W. P. C. 332, 370.

(*q*) *Hull v. Bollard*, 1 H. & N. 134 ; *Curtis v. Platt*, 35 L. J. N. S. Ch. 852, 868 ; *Sugg v. Silber*, L. R. 2 Q. B. D. 495 ; *Sykes v. Howarth*, L. R. 12 Ch. D. 826 ; 48 L. J. N. S. Ch. 769. See also *Adair v. Young*, W. N. 1879, p. 8.

(*r*) *Hull v. Bollard*, 1 H. & N. 134.

infringement by manufacture and sale at divers times between specified dates and two specified instances of sale, evidence of a third sale was allowed, the defendant having, by his interrogatories, admitted such a sale.(s)

When, however, an order for amendment of the particulars of objection had not been complied with, evidence of an anticipating specification not given under the order was not admitted.(t)

Evidence under particulars for the amendment of which an order has been obtained.

A patentee who has assigned the whole of his interest is a competent witness for the assignee in any action he may bring for the infringement of the patent.(u) If the patentee has covenanted with the assignee in respect of the validity of the patent, he may have an interest in the event of a subsequent action in which the question of validity is raised, but his evidence would not be excluded, although his interest would be a matter to be taken into consideration as affecting his credit.(v)

Patentee who has assigned his interest is a competent witness.

A licensee is also a competent witness for the plaintiff in a patent action,(x) though he may be an interested one.(y)

Licensee is a competent witness,

If the licence empowers him to use the invention in consideration of a periodical payment or a payment in proportion to the extent of his user, he cannot have an interest in supporting the patent (unless the payments are merely nominal or not a full consideration for the privilege granted), but he may be interested in its destruction. If the licensee has paid a gross sum for an irrevocable licence, or has obtained it for any other consideration, he may have an interest in supporting the patent, for if the invention be thrown open to the public he cannot obtain any benefit from the licence.

If, however, the action be brought for the benefit of the licensee who has an exclusive licence for some particular district, he would not be a competent witness for the plaintiff, because he would be a person "in whose immediate and individual behalf" the action was brought.(z)

but not when the action is brought for benefit of an exclusive licensee.

(s) *Sykes v. Howarth*, L. R. 12 Ch. D. 826; 4 L. J. N. S. Ch. 769.

(t) *Lister v. Leather*, 3 Jur. N. S. 811.

(u) See p. 130 *ante*; *Bloxam v. Elsee*, 1 C. & P. 563.

(v) 6 & 7 Vict. c. 85, s. 1. (x) *Ibid.* (y) *Ibid.* (z) *Ibid.*



Proof of the  
grant of letters  
patent.

If the grant of the patent be denied, it must be proved by the production of the letters patent themselves or a copy thereof certified by the Comptroller and sealed with the seal of the Patent Office,<sup>(a)</sup> and no further proof is necessary.

The letters patent are only proof of the *purport* of the grant which they contain, the effect or operation of the grant being quite a different question. Although letters patent purport to grant a sole privilege to the patentee, it may be that the patent is for some reason illegal or void, and, if so, the patent is of no force, and the grant it purports to make has no operation, and consequently it is strictly correct to say that the Queen did not make such a grant as the plaintiff alleges, for a void grant is the same as no grant at all.<sup>(b)</sup> The letters patent merely prove the purport of the grant, and upon any dispute respecting the invention the specification must be read and considered as incorporated with the patent.<sup>(c)</sup>

Judgment  
when de-  
fendant does  
not appear.

Where a defendant puts in a defence, but does not appear at the trial, the plaintiff is not entitled to judgment without proof of his case; he must show that the specification is good on the face of it, and prove the infringement.<sup>(d)</sup>

Plaintiff must  
prove the  
subject-matter  
of the patent.

It is incumbent on the plaintiff to prove what the invention really is for which the patent was granted. The proper way to do this is to put in the specification, and neither the patentee nor any other witness can be called to prove what the real invention is, the question being one which can only be answered from a critical examination of the specification,<sup>(e)</sup> and evidence of the patentee cannot be tendered to show what effect was intended by the specification.<sup>(f)</sup>

Proof of in-  
fringement.

In order to substantiate the allegation of infringement, the plaintiff must prove that the defendant has used the art which forms the subject-matter of the patent, or that he has violated the patent privilege in the manner alleged in the statement of claim. And in order to make out his case, it is not

(a) 46 & 47 Vict. c. 57, s. 89.

(b) Hindmarch, p. 440.

(c) Hornblower v. Boulton, 8 T. R. 102; Dav. P. C. 221; Crossley v. Beverley, 9 B. & C. 63.

(d) Perori v. Hudson, 1 P. O. R. 261.

(e) Badische Anilin und Soda Fabrik v. Levinstein, L. R. 12 App. Cas. 717; Hinks v. Patent Safety Lighting Co., L. R. 4 Ch. D. 618.

(f) Kaye v. Chubb, 4 P. O. R. 289, 298.

necessary that the plaintiff should prove that the defendant has used the whole of the art or invention comprised in the patent; it is sufficient to show that he has used any essential part of it.(g)

An injunction may be obtained though there is no actionable infringement, if there is an intention to infringe.(h)

There are many cases in which it is impossible to ascertain what it is the defendant has done. Under such circumstances the proper course is for the plaintiff to make out a *prima facie* case, and if the plaintiff makes out a *prima facie* case which the defendant does not venture to answer, the Court will conclude that the alleged wrongful acts have been done in the manner which the plaintiff or his witnesses believe.(i) The defendant may, however, give evidence to show that what he has done does not amount to a user of the art protected by the patent. Thus he may prove that the articles complained of are substantially different to those described in the specification, or that they were manufactured according to a process different to that claimed by the patentee, and this will be a complete answer to the charge of infringement.(k)

If the patent is for a process only and does not include the manufactured article, the *onus* is on the plaintiff to show that the article alleged to have been manufactured in infringement has, in fact, been so made.(l) And similarly, if the patent is for the manufacture of any particular machine, the sale of an article made by the machine would be no proof of infringement.

If the plaintiff proves that the defendant has without authority (m) sold a patented article he makes out a *prima facie* case of infringement, and throws the *onus* on the defendant of showing either that he was a licensee of the plaintiff, or that he

(g) *Cornish v. Keene*, 1 W. P. C. 501; *Morgan v. Seaward*, 1 W. P. C. 170; *Jones v. Pearce*, 1 W. P. C. 124; *Crane v. Price*, 4 M. & G. 580; *Hill v. Thompson*, 8 Taunt. 375; 3 Mer. 622; 1 W. P. C. 232; p. 403 *ante*.

(h) p. 468 *ante*; *Frearson v. Loe*, L. R. 9 Ch. D. 48; *Dowling v. Billington*, 7 P. O. R. 191.

(i) *Huddart v. Grimeshaw*, Dav. P. C. 265; *Hill v. Jarvis*, 1 W. P. C. 100; *Badische Anilin und Soda Fabrik v.*

*Dawson*, 6 P. O. R. 387, 396; *Edison v. Woodhouse*, judgment of Butt, J., 3 P. O. R. 167.

(k) *Morgan v. Seaward*, 1 W. P. C. 171; *Walton v. Potter*, 1 W. P. C. 585, 589.

(l) *Palmer v. Wagstaffe*, 8 Exch. R. 840; 22 L. J. N. S. Ex. 295; 9 Exch. R. 449; 23 L. J. N. S. Ex. 217; p. 338 *ante*.

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



bought the article from a person who was authorised by the plaintiff to manufacture and sell it.(n)

Under some circumstances, however, the *onus* is on the plaintiff of proving not merely the sale of the patented article, but further that it was not manufactured by himself or under his authority, *e.g.*, where a patentee has manufactories both in England and abroad.(o)

Evidence that a defendant gave an order in England, which order was executed in England, for the manufacture by a patented process of articles which were afterwards received by him, is quite sufficient to satisfy an allegation that he made those articles; for he that causes and procures things to be made may well be said to have made them himself.(p)

And in the absence of evidence to the effect that articles complained of may have been manufactured by a process different to that comprised in the patent,(q) the following facts are *prima facie* evidence of infringement: similarity of structure in the patented article and the things produced by the defendant where a trade secret is alleged, and there has been no inspection by the plaintiff; (r) the offering for sale of an article in the state produced by the application of a patented machine where it is proved that the defendant had one such machine in his possession.(s)

Where the defence was that the alleged infringement was an exercise by the defendant of a secret process he was allowed to refuse to answer questions on cross-examination which might disclose his process, and, at his election, evidence was taken *in camera* of what the alleged secret process really was, and the shorthand notes of such evidence were ordered to be impounded in Court until there should be an appeal, or until further order.(t)

When the defendant raises the plea that the patentee was not

(n) *Badische Anilin und Soda Fabrik v. Dawson*, 6 P. O. R. 387, 396; *Gibson v. Brand*, 1 W. P. C. 630.

(o) *Betts v. Willmott*, L. R. 6 Ch. App. Cas. 239; *Société Anonyme, &c., v. Tilghman's, &c., Co.*, L. R. 25 Ch. D. 1.

(p) *Gibson v. Brand*, 1 W. P. C. 631.

(q) *The Cartsburn Sugar Refining Co. v. Sharp*, 1 P. O. R. 181, 186.

(r) *Huddart v. Grimshaw*, 1 W. P. C. 91; *Davenport v. Richard*, 3 L. T. N. S. 503.

(s) *Hall v. Jarvis*, 1 W. P. C. 100.

(t) *Badische Anilin und Soda Fabrik v. Levinstein*, L. R. 24 Ch. D. 156, 170.

the true and first inventor, the *onus* of proof rests with him, but it is usual for the plaintiff to tender *prima facie* evidence to the effect that the patentee was the first person who actually communicated the invention to the public.<sup>(u)</sup>

Proof of issue that patentee is not the true and first inventor.

The decision of an issue raised by a plea that the alleged invention could not form the subject-matter of a valid patent rests more with a judge than a jury. The plaintiff must give the specification in evidence in order that the judge may see what the alleged invention really was, and if there are terms of art involved, the jury, or judge acting as a jury, must determine the meaning to be applied to them in the construction of the specification, which is the duty of the Court alone.<sup>(v)</sup>

If the novelty of the invention be denied, the plaintiff must give *prima facie* evidence that the invention had not been communicated to the public before the date of the patent.<sup>(w)</sup> The plea of want of novelty does not put in issue the fact of the invention being a manufacture within the meaning of the Statutes of Monopolies for which a patent could be granted.<sup>(y)</sup>

Proof of novelty.

In order to prove the novelty of the invention, the plaintiff must call witnesses whose avocations were likely to have made them acquainted with the subject-matter of the alleged invention if it had been published prior to the date of the patent, and who are able to testify that it was unknown to them. It is clear that only indirect evidence of novelty can be given, since it is impossible to examine every member of the public, but if the plaintiff calls witnesses who for some time before the date of the patent were well acquainted with the particular branch of trade or manufacture to which the invention relates, and who can prove that they were ignorant of it until after the date of the patent, this will be sufficient *prima facie* evidence of novelty, and the *onus* of proving the negative will then be on the defendant.<sup>(z)</sup>

If the invention consist of several parts,<sup>(a)</sup> or if several

(u) p. 7 *ante*.

(v) p. 215 *ante*.

(w) *Turner v. Winter*, Dav. P. C. 153; *Manton v. Manton*, Dav. P. C. 348; *Bovill v. Moore*, Dav. P. C. 399; *Galloway v. Bleaden*, 1 W. P. C. 525; *Cornish v. Keene*, 1 W. P. C. 509.

(y) p. 432 *ante*.

(z) See *Cornish v. Keene*, 1 W. P. C.

509; *Manton v. Manton*, Dav. P. C. 350, 353; *Galloway v. Bleaden*, 1 W. P. C. 526; *Amory v. Brown*, L. R. 1 Eq. 663; *Harris v. Rothwell*, L. R. 35 Ch. D. 416, 427.

(a) *Manton v. Manton*, Dav. P. C. 340, 341; *Gibson v. Brand*, 4 M. & G. 179; *Gillett v. Wilby*, 9 Car. & P. 334; *Losh v. Hague*, 1 W. P. C. 208.



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inventions have been comprised in the same patent,(b) it is incumbent on the plaintiff to give *prima facie* proof of the novelty of all the parts, or all the inventions, as the case may be.(c)

After the plaintiff has made a *prima facie* case in respect of novelty, the *onus* is on the defendant of showing that the invention was public property at the date of the patent, and consequently not new, as to the public knowledge, and use of it,(d) but the evidence of one witness may be quite sufficient to do this.(e)

When a published document is alleged as an anticipation, evidence should be called to explain it, if necessary.(f) But if the anticipation relied on is an English complete specification filed in the Patent Office, no proof is required of further publication or its contents having been seen by the public,(g) for the second of two patents for the same invention must be bad in law.(h)

Where the want of novelty appears distinctly from a written document, it is for the Court, and not the jury, to determine the identity of the two supposed inventions,(i) aided as to the meaning of technical expressions by the finding of the jury, or the judge, acting as a jury.(k)

Upon the issue of novelty the plaintiff is entitled to call evidence in reply for the purpose of rebutting that given by the defendant,(l) on whom lies the *onus* of proving his case.(m) Thus, at the hearing of an action where evidence had been admitted on behalf of the defendants, which was not included under the particulars, the case was ordered to stand over, to allow of the plaintiff having an opportunity of rebutting such

(b) *Brunton v. Hawkes*, 4 B. & Ald. 541; p. 260 *ante*.

(c) Chap. III.

(d) *Penn v. Jack*, L. R. 2 Eq. 314; *Minter v. Wells*, 1 W. P. C. 129; *Peroni v. Hudson*, 1 P. O. R. 261.

(e) *Badham v. Bird*, 5 P. O. R. 238.

(f) *Hocking v. Fraser*, 3 P. O. R. 63; *Bovill v. Smith*, L. O. C. 52; *Betts v. Menzies*, 10 H. L. Cas. 117; see pp. 216, 217 *ante*.

(g) *Plimpton v. Malcolmson*, L. R. 3 Ch. D. 551, 557; *Harris v. Rothwell*, L. R. 35 Ch. D. 416, 428.

(h) Chap II.

(i) *Bush v. Fox*, 5 H. L. Cas. 707; *Booth v. Kennard*, 2 H. & N. 84; *Hills v. London Gas Light Co.*, 5 H. & N. 312; *Betts v. Menzies*, 10 H. L. Cas. 134; *Harwood v. Great Northern Ry. Co.*, 11 H. L. Cas. 654; *Simpson v. Holliday*, L. R. 1 E. & I. App. 315.

(k) *Betts v. Menzies*, 10 H. L. Cas. 134; *Harwood v. Great Northern Ry. Co.*, 11 H. L. Cas. 654; *Simpson v. Holliday*, L. R. 1 E. & I. App. 320.

(l) *Penn v. Jack*, L. R. 2 Eq. 314.

(m) p. 475 *ante*.

evidence, the defendants being allowed to amend their particulars.<sup>(n)</sup>

A plaintiff, however, who has tendered evidence of novelty, and has had his attention called to a particular alleged anticipating document, cannot for the purpose of explaining its contents recall a witness in reply, who when he gave his evidence was acquainted with the document.<sup>(o)</sup> A plaintiff has been allowed after the conclusion of all evidence, but before judgment, which had been reserved, to give fresh evidence on a point relevant to the issue, which had not been "threshed out."<sup>(p)</sup>

A defendant cannot re-call the plaintiff's witnesses, after the conclusion of the cross-examination, in order to put to them fresh instances of publication, unless it can be shown that such instances only came to the defendant's knowledge since the cross-examination, and could not, with due diligence, have been discovered earlier; <sup>(q)</sup> and he will not be allowed to give further evidence in answer to that given by the plaintiff in reply, if his evidence has been summed up.<sup>(r)</sup>

If the defendant relies upon publication in a prior document, he should give the plaintiff notice to admit that the document was published prior to the date of the patent. If the publication of any document is not admitted, it must be proved by calling the librarian of the public library at which the book or document was before the date of the patent.<sup>(s)</sup>

Where an affidavit of documents had been required by the plaintiff, he was not allowed to recall one of the defendant's witnesses for the purpose of cross-examining him as to the contents of a report the defendant had received from a patent agent, which report was not produced, and was only referred to at a late stage of the trial.<sup>(t)</sup>

Models are similar to documentary evidence, and the Court Models will draw its own conclusions from them.<sup>(u)</sup>

If the plea of want of utility be raised as an objection to the

Proof of utility.

<sup>(n)</sup> Blakey v. Latham, 6 P. O. R. 29,

<sup>(o)</sup> Tetley v. Easton, Mac. P. C. 61.

<sup>(p)</sup> Boyd v. Horrocks, 5 P. O. R. 557.

<sup>(q)</sup> Moss v. Malings, 3 P. O. R. 373.

<sup>(r)</sup> Penn v. Jack, L. R. 2 Eq. 24.

<sup>(s)</sup> S. C. R. 1883, Ord. xxxii. r. 4.

<sup>(t)</sup> Sugg v. Bray, 54 L. J. N. S. Ch.

132.

<sup>(u)</sup> Seed v. Higgins, 8 H. L. Cas. 565; Westinghouse v. L. & Y. Ry. Co., 1 P. O. R. 245; Bovill v. Smith, L. O. C. 52.



patent, the plaintiff must give *prima facie* evidence to prove that the invention was useful to the public at the date of the grant.(v)

If the defendant sets up a *prima facie* case that the invention was not useful, the burden is then on the plaintiff to prove that it was useful.(x)

The fact that the defendant has attempted to infringe, is itself evidence of utility.(y)

The degree of utility is quite immaterial under this issue ; it is quite sufficient if the plaintiff can show that the invention was of *any* utility to the public.(z)

The question of utility must be determined with reference to the date of the patent. If it can be shown that it was then of some utility to the public, it is no objection that owing to more recent improvements it has since become useless ;(a) and, if the patentee has obtained a subsequent patent for an improvement on a prior invention, it is not to be inferred that the prior invention was therefore useless.(b)

“Utility” in law does not mean abstract utility, but “an invention better than the preceding knowledge of the trade as to a particular fabric.”(c)

Each essential part of the invention must be shown to be useful ;(d) for, if a material part is useless, the patent is void.(e)

It is not necessary that the utility of every part of an invention should be proved by actual trial ; evidence of skilled persons to the effect that if tried it would answer may be sufficient.(f) Thus, in *Neilson v. Harford* (g) a question arose as to the utility of a certain vessel which according to the specifica-

(v) Chap. IV., *R. v. Arkwright*, Dav. P. C. 135 ; *Manton v. Parker*, Dav. P. C. 327 ; *Manton v. Manton*, Dav. P. C. 333 ; *Bovill v. Moore*, Dav. P. C. 399 ; *Minter v. Wells*, 1 W. P. C. 129 ; *Hill v. Thompson*, 2 W. P. C. 237 ; *Crane v. Price*, 1 W. P. C. 411 ; *Russell v. Cowley*, 1 W. P. C. 467 ; *Brunton v. Hawkes*, 4 B. & Ald. 541 ; *Derosne v. Fairie*, 5 Tyr. 393 ; 2 Cr. M. & R. 476.

(x) *Ehrlich v. Ihlee*, 5 P. O. R. 449.

(y) *Lucas v. Miller*, 2 P. O. R. 160 ; *Reynolds v. Amos*, 3 P. O. R. 215 ; *United Horseshoe and Nail Co. v. Stewart*, L. R. 13 App. Cas. 407 ; *Badische*

*Anilin und Soda Fabrik v. Levinstein*, L. R. 12 App. Cas. 712.

(z) p. 129 ante.

(a) p. 58 ante.

(b) *Otto v. Linford*, 46 L. T. N. S. 39 ; *Edison v. Holland*, 6 P. O. R. 277 ; *Thompson v. Batty*, 6 P. O. R. 100.

(c) *Per Grove, J., Young v. Rosenthal*, 1 P. O. R. 34 ; p. 129 ante.

(d) p. 130.

(e) *Hill v. Thompson*, 8 Taunt. 375 ; *United Horseshoe and Nail Co. v. Stewart*, 2 P. O. R. 122, 132,

(f) p. 129 ante.

(g) 1 W. P. C. 295.

tion, formed a material part of the invention. There was no evidence of any person having actually tried the vessel of the shape in question, but there was the evidence of scientific witnesses to the effect that it would answer, and the judge who tried the case told the jury that if they were satisfied with that evidence it was quite sufficient to establish utility.

If the plaintiff proves that the invention as a whole is useful, he is not bound to prove that each part of it possesses an equal amount of utility.<sup>(h)</sup>

The fact that an invention has not come into general use raises a strong presumption against its utility; <sup>(i)</sup> but it is not to be assumed from such evidence that the invention was not sufficiently useful to support a patent. The reason why an invention has not come into general use may be that immediately after the discovery an improvement upon it may have been produced, which, for commercial reasons, prevented the general adoption of the former invention.<sup>(k)</sup>

It is to be observed that a large sale of a patented article does not necessarily prove that it possesses the kind of utility which the patent law requires to support a patent—*i.e.*, that it is more useful than what has gone before.<sup>(l)</sup> The reason why the article has a large sale may be that it is well advertised, or got up in a manner likely to attract the purchasing public.<sup>(m)</sup> On the other hand, the fact that thousands of a patented article have been sold, and, in consequence of their superiority, others of a similar nature have become a drug in the market, may afford evidence of the utility of the patent.<sup>(n)</sup>

The burden of giving evidence of the sufficiency of the specification is upon the plaintiff, as was held by Bullen, J., in a case in which his lordship is reported to have said: "I do not agree with the counsel who have argued against this rule in saying

Proof of the sufficiency of the specification.

<sup>(h)</sup> p. 133 *ante*; *Ehrlich v. Ihlee*, 5 P. O. R. 203.

<sup>(i)</sup> *Morgan v. Seaward*, 1 W. P. C. 185; *Sinister's Patent*, 1 W. P. C. 723; *Morgan v. Windover*, 5 P. O. R. 303; *Re Bakewell's Patent*, 15 Moo. P. C. C. 386; *Re Allan's Patent*, L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 443.

<sup>(k)</sup> *Badische Anilin und Soda Fabrik v. Levinstein*, L. R. 12 App. Cas. 710,

712; *United Telephone Co. v. Bassano*, 3 P. O. R. 313; *Kurtz v. Spence*, 5 P. O. R. 182; *Ehrlich v. Ihlee*, 5 P. O. R. 450; *Edison v. Holland*, 6 P. O. R. 283.

<sup>(l)</sup> p. 129 *ante*.

<sup>(m)</sup> *Cole v. Saqui*, 5 P. O. R. 489; 6 P. O. R. 41.

<sup>(n)</sup> *Ehrlich v. Ihlee*, 5 P. O. R. 437, 449; *American Braided Wire Co. v. Thompson*, 5 P. O. R. 113.



that it was not necessary for the plaintiff to give any evidence to show what the invention was, and that the proof that the specification was improper lay on the defendant; for I hold that a plaintiff must give some evidence to show what his invention was, unless the other side admits that it has been tried and succeeds. But wherever the patentee brings an action on his patent, if the novelty or effect of the invention be disputed, he must show in what his invention consists, and that he produced the effect proposed by the patent in the manner specified. Slight evidence of this on his part is sufficient, and it is incumbent on the defendant to falsify the specification.”(o)

Proof of  
sufficiency.

A plea of the insufficiency of the specification puts the plaintiff to the necessity of giving evidence to the effect that the specification does particularly describe and ascertain the nature of the invention, and in what manner it is to be performed.

For the purpose of proving the sufficiency of the specification it is enough for the plaintiff to call workmen of ordinary intelligence engaged in the trade to which the invention relates who are able to state that they can, or have actually performed the invention with no other aid than the specification.(p)

Under an issue of insufficiency of the specification the plaintiff must prove that it sufficiently describes and ascertains every part of the invention; that it is intelligible to persons of ordinary skill engaged in the trade to which the invention relates; and that the invention is capable of producing the effects specified.(q) If there are any technical terms or terms of art used in the specification which require explanation to make the description intelligible, evidence must be given of their meaning, but the plaintiff is not allowed to correct or explain any error or misdescription, unless they be such that they could not possibly mislead.(r)

If the defendant can prove that there is anything material stated in the specification which is false(s) or calculated to

(o) *Turner v. Winter*, Dav. P. C. 153;  
1 T. R. 606.

(p) *Cornish v. Keene*, 1 W. P. C. 503;  
*Shaw v. Jones*, 6 P. O. R. 335; *Edison  
v. Holland*, 6 P. O. R. 243.

(q) See p. 161 *ante*.

(r) See p. 228 *ante*.

(s) *Bickford v. Skewes*, 1 Q. B. 938;  
*Lewis v. Marling*, 10 B. & C. 22.

mislead or puzzle a person who might attempt to follow its directions, the patent will be void.(*t*)

The construction of the specification is for the Court, aided by such facts as are admissible, to explain written documents. The evidence of scientific witnesses is only admissible as proof of facts. Their opinion as to whether there has been an infringement or not, though sometimes received in order to save time and trouble, is, strictly speaking, inadmissible, and if objected to ought to be rejected.(*u*)

When expert evidence is called for the purpose of explanation, and the first witness explains all that requires explanation, and is not broken down in cross-examination, there is no need to call further expert witnesses on the same points, and it is not admissible to do so.(*v*)

Expert evidence and experiments made for the express purpose of a cause are viewed with suspicion by the Court.(*w*)

#### *Inspection and Discovery.*

It sometimes happens that the plaintiff could not establish the infringement complained of without an inspection of the process or machinery which the defendant is actually using, or the defendant could not prove his innocence by showing that the patent is invalid, or that he does not infringe, without a like inspection against the plaintiff. In such cases the Court has power to make an order for either party to be at liberty to inspect the other's process or machinery; but neither party can claim inspection as a matter of right;(y) and the Court will not allow it to be oppressive or to be carried beyond what is necessary in the interests of justice,(z) the object of inspection being to enable the Court to have the case properly tried, and to assist the Court in forming a right conclusion.(a)

(*t*) pp. 169-173.

(*u*) *Seed v. Higgins*, 8 H. L. C. 565; *Bovill v. Smith Griff*, L. O. C. 52; *Westinghouse v. Lancashire and Yorkshire Ry. Co.*, 1 P. O. R. 245.

(*v*) *Automatic Weighing Machine Co. v. Knight*, 6 P. O. R. 116.

(*w*) *Betts v. Neilson*, L. R. 3 Ch. 433; *Young v. Fernie*, 4 Giff. 609; *Plimpton v. Malcolmson*, L. R. 3 Ch. D.

576; *Crampton v. Patents Investment Co.*, 5 P. O. R. 382, 404.

(*y*) 46 & 47 Vict. c. 57, s. 30.

(*z*) *Bovill v. Moore*, Dav. P. C. 361; 2 Coop. Ch. Ca. 56; *Russell v. Cowley*, 1 W. P. C. 458; *Piggott v. Anglo-American Telegraph Co.*, 19 L. T. N. S. 46.

(*a*) *The Patent Type Founding Co. v. Walter, Johns*, 727; *Bovill v. Moore*, 2 Coop. Ch. Ca. 56; *Russell v. Cowley*,



Thus, where a defendant was charged with infringing a patent for a sewing machine, and objected to an order for the inspection by the plaintiff of all sewing machines on his premises, on the ground that such order would be oppressive, he was allowed to verify on affidavit, all the different kinds of sewing machines which he had sold or exposed for sale since the date of the plaintiff's patent, and the order for inspection was confined to one of each class.<sup>(b)</sup> The defendant cannot be compelled to make an affidavit verifying the machines or processes he uses, if he has offered inspection.<sup>(c)</sup>

Evidence necessary to obtain an order for inspection.

Before the Court makes an order for inspection it will require to be satisfied that the inspection sought is necessary to the case of the party seeking it.<sup>(d)</sup>

Thus, an application for an order for inspection by the plaintiff was refused where he omitted to make an affidavit that it was necessary to his case, and the defendant swore that he made several kinds of the articles complained of, and that some of them did not resemble those described in the plaintiff's specification, and that in his belief the inspection was not required for the purposes of the action, but to gain information of his improvements.<sup>(e)</sup> Again, when the Court was of opinion that the defendant's acts, as alleged by the plaintiff, could not possibly amount to an infringement, an order for inspection was refused.<sup>(f)</sup>

Inspection for the purpose of preparing defence.

In an action for infringement the plaintiff cannot, as a rule, be compelled to produce, or allow inspection of, the patented machine or process at the instance of the defendant for the purpose of preparing the defence, since the specification should give sufficient information of what the invention is and the mode of performing it.<sup>(g)</sup>

1 W. P. C. 459; *Davenport v. Jepson*, 1 N. R. 308; *Pemberton*, 4th ed. 484; *Russell v. Crichton*, 15 Div. of Court of Session, 1st Series, 1270; *Germ Milling Co. v. Robinson*, 3 P. O. R. 11; *Cheetham v. Oldham*, 5 P. O. R. 622.

<sup>(b)</sup> *Singer Manufacturing Co. v. Wilson*, 5 N. R. 505; 12 L. T. N. S. 140.

<sup>(c)</sup> *Drake v. Muntz's Metal Co.*, 3 P. O. R. 43.

<sup>(d)</sup> *Piggott v. Anglo-American Tele-*

*graph Co.*, 19 L. T. N. S. 46; *Batty v. Kynock*, L. R. 19 Eq. 90; *Cheetham v. Oldham*, 5 P. O. R. 617; *Shaw v. Bank of England*, 22 L. J. N. S. Ex. 26; *Meadows v. Kirkman*, 29 L. J. N. S. Ex. 205.

<sup>(e)</sup> *Batley v. Kynock*, L. R. 19 Eq. 91.

<sup>(f)</sup> *Piggott v. Anglo-American Telegraph Co.*, 19 L. T. N. S. 46.

<sup>(g)</sup> *Crofts v. Peach*, 1 W. P. C. 268.

Where, in an action of infringement, the defendants alleged that the patent was anticipated by the sale of articles made according to the alleged invention by various persons named in the particulars, and the plaintiff applied for an order for the production before trial of the articles to be proved by the specified persons, the Court refused the application, on the ground that there was no precedent for such an order, and that on principle it ought not to be made.<sup>(h)</sup>

An affidavit, made by the plaintiff on an application for an order for inspection, should state that he has reason to believe that the process or machine used by the defendant is an infringement of his patent;<sup>(i)</sup> it should also show the grounds of such belief,<sup>(k)</sup> and in what the invention of the plaintiff consists.<sup>(l)</sup> If the plaintiff makes out a *prima facie* case of infringement, and that inspection is necessary to enable him to prove it at the trial, an order will follow almost as matter of course,<sup>(m)</sup> but inspection will be limited to those machines and processes in respect of which a *prima facie* case of infringement is made out.<sup>(n)</sup>

Affidavit of plaintiff on application for an order for inspection.

The Court is not dependent on its power to compel inspection by treating as a contempt a refusal to comply with an order directing the party against whom it is made to allow it. The order of the Court may authorise any person, for the purpose of inspection, to enter upon or into any land or building that may be necessary.<sup>(o)</sup>

Power of Court to compel inspection.

An order for inspection may be made at any time during the progress of an action, and may be obtained on summons or on motion.<sup>(p)</sup>

Delay in asking for an order for inspection is no bar.<sup>(q)</sup>

Delay.

If the party from whom inspection is sought objects, the Court or a judge may, if satisfied that the right to inspection

Inspection when objected to.

<sup>(h)</sup> Garrard v. Edge, 6 P. O. R. 372.

<sup>(i)</sup> Shaw v. Bank of England, 22 L. J. N. S. Ex. 26.

<sup>(k)</sup> Germ Milling Co. v. Robinson, 1 P. O. R. 217.

<sup>(l)</sup> Meadows v. Kirkman, 29 L. J. N. S. Ex. 205.

<sup>(m)</sup> Singer Manufacturing Co. v. Wilson, 13 W. R. 560; 5 N. R. 505; Batley v. Kynock, L. R. 19 Eq. 90; Piggott v. Anglo-American Tele-

graph Co., 19 L. T. N. S. 46; Cheetham v. Oldham, 5 P. O. R. 617.

<sup>(n)</sup> Cheetham v. Oldham, 5 P. O. R. 617.

<sup>(o)</sup> S. C. R. 1883, Ord. 1. r. 3.

<sup>(p)</sup> Judic. Act, 1873, s. 39; S. C. R. 1883, Ord. 1. r. 12; Ord. 1. v. r. 15; Frearson v. Lee, 26 W. R. 138.

<sup>(q)</sup> The Patent Type Founding Co. v. Walter, Johns, 727.



depends on the determination of any issue or question in dispute in the cause, or that for any other reason it is desirable that any issue or question in dispute in the cause should be determined before deciding upon the right to the inspection, order that such issue or question be determined first and reserve the question as to the inspection.(r)

Conditions of order for inspection.

The order for inspecting generally makes it a condition that reasonable notice be given to the parties against whom it is made,(s) and, if the inspection relates to machinery, that the machines be put to work(t) in the presence of persons named(u) and further specifies the number of inspections that are to be allowed.(v)

Inspection by a licensee not a party to the action.

A licensee not a party to the action cannot be compelled to give inspection in one action against his licensor, though the order be made.(x)

Inspection leading to the disclosure of trade secrets.

It is sometimes objected that an inspection if granted would lead to the disclosure of trade secrets, and damage the trade of the party against whom it is sought, but such an objection will not deter the Court from making an order if it appears to be necessary in the interests of justice,(y) though the Court will endeavour to prevent an undue advantage being taken of secrets disclosed during an inspection.(z)

In *Flower v. Lloyd*,(a) where inspection was resisted on the ground of disclosure of trade secrets, an arrangement was come to in the Court of Appeal whereby the defendant's works should

(r) S. C. R. 1883, Ord. xxxi. r. 20.

(s) *Drake v. Muntz's Metal Co.*, 3 P. O. R. 43; *Germ Milling Co. v. Robinson*, 3 P. O. R. 11; *Flower v. Lloyd*, Seton, 4th ed. p. 351; *Russell v. Cowley*, 1 W. P. C. 458; *Davenport v. Jepson*, 1 N. R. 173; *Pemberton*, 4th ed. 484. p. 236; *Drake v. Muntz's Metal Co.*, 3 P. O. R. 43.

(t) Seton, 4th ed. p. 351; *Beardsell v. Schwann*, Seton, 3rd ed. p. 910; *Davenport v. Jepson*, *Pemberton*, p. 484; *Germ Milling Co. v. Robinson*, 3 P. O. R. 11; *Bovill v. Moore*, 2 Coop. C. C. 56; *Russell v. Cowley*, 1 W. P. C. 458.

(u) *Russell v. Cowley*, 1 W. P. C. 458; *Drake v. Muntz's Metal Co.*, 3 P. O. R. 43.

(v) *Heathfield v. Braby*, Seton, 4th

ed. p. 1661; *Germ Milling Co. v. Robinson*, 3 P. O. R. 11.

(x) *Germ Milling Co. v. Robinson*, 3 P. O. R. 11, 14.

(y) *Renard v. Levinstein*, 10 L. T. N. S. 94; *Piggott v. Anglo-American Telegraph Co.*, 19 L. T. N. S. 46; *Smith v. G. W. Ry. Co.*, Macr. P. C. 223; *Russell v. Crichton*, 15 Dec. of Court of Session, 1st Series, 1270; *Cheetham v. Oldham*, 5 P. O. R. 617; *Rylands v. Ashley's Patent (Machine Made) Bottle Co.*, 7 P. O. R. 175.

(z) *Russell v. Crichton*, 15 Dec. of Court of Session, 1st Series 1270; *Flower v. Lloyd*, s. p. 351; *Plating Co. v. Farquharson*, Lawson, Patents, Designs, and Trade Marks Acts, 2nd ed. 500.

(a) W. N. 1876, 169.

be inspected by scientific men to be agreed upon, but not by the plaintiff.

In *Cheetham v. Oldham*,<sup>(b)</sup> the plaintiff, a rival manufacturer of the defendant, was himself allowed to take part in the inspection.

In *Plating Co. v. Farquharson*,<sup>(c)</sup> the Court made an order authorising inspection by a scientific expert, but bound him not to disclose his report on the facts or opinion obtained or arrived at by him, without the leave of the Court or a judge, and, at the trial, the expert was not allowed to be called as a witness or cross-examined.

Where the defendant desired an inspection of machines not belonging to, but in the power of the plaintiff, and the Court thought that such inspection would be beneficial in the interests of justice, an order was made that the plaintiff should *bonâ fide* endeavour to procure the inspection desired, and report the result to the Court.<sup>(d)</sup>

Where an independent inspector is appointed, he is usually required to "report to the Court upon the facts, and his opinion founded upon them."<sup>(e)</sup> Appointment of independent inspector.

Beside granting inspection, the Court or a judge has the power, which is frequently exercised, to authorise samples to be taken, or any observation to be made, or experiment to be tried, which may be necessary or expedient for the purpose of obtaining full information or evidence.<sup>(f)</sup> Samples.

It was held that the inspection "authorised by the Act of 1852" referred to an inspection of the instrument or machinery manufactured or used by the parties, with a view to evidence of infringement, and not to an inspection of books;<sup>(h)</sup> and probably the same meaning must be attached to the word as used in s. 30 of the Act of 1883, and an inspection of books would not Inspection under Act of 1852. Under Act of 1883.

<sup>(b)</sup> 5 P. O. R. 617.

<sup>(c)</sup> Griff. P. C. 187.

<sup>(d)</sup> *Rylands v. Ashley's Patent (Machine Made) Bottle Co.*, 7 P. O. R. 175.

<sup>(e)</sup> *The Plating Co. v. Farquharson*, Lawson, Patents, Designs, and Trade Marks Acts, 2nd ed. p. 500; see also *Hill v. Touts*, *ibid.* 499.

<sup>(f)</sup> S. C. R. 1883, Ord. l. r. 3; *Russell v. Cowley*, 1 W. P. C. 459; *The Patent Type Founding Co. v. Walter, Johns*, 727; *The Plating Co. v. Farquharson*, Griff. P. C. 187; *The Germ Milling Co. v. Robinson*, 3 P. O. R. 14; *Cheetham v. Oldham*, 5 P. O. R. 621.

<sup>(g)</sup> S. 42.

<sup>(h)</sup> *Vidi v. Smith*, 3 E. & B. 969.



be allowed on affidavit merely showing the possibility of discovering matters advantageous to the case of the party seeking it.<sup>(i)</sup>

Inspection where there is merely a threatened infringement.

An injunction may be obtained restraining a threatened infringement; <sup>(k)</sup> and in a case where it appeared that the defendant had entered into a contract to make certain paddle-wheels, which the plaintiff's alleged were a violation of their patent, an order was obtained from the Court authorising the plaintiff's and their witnesses to be at liberty to inspect at all reasonable times, giving reasonable notice, the paddle-wheels or machinery relating to paddle-wheels made, or to be made, pursuant to the said contract.<sup>(l)</sup>

Interrogatories.

Notwithstanding that in patent actions particulars must be delivered by both the plaintiff and the defendant,<sup>(m)</sup> either party may, by leave of the Court or a judge, deliver interrogatories in writing for the examination of the opposite parties, or any one or more of such parties, provided that interrogatories which do not relate to any matters in question in the action shall be deemed irrelevant, notwithstanding that they might be admissible on the oral cross-examination of a witness.<sup>(n)</sup>

Security for costs of.

In the event of the Court or a judge granting leave to any party to administer interrogatories to any other party or parties the costs must in the first instance be secured by the party seeking such discovery in the manner prescribed by the Supreme Court Rules, 1883.<sup>(o)</sup>

Power of the Court when discovery is objected to.

As in the case of inspection,<sup>(p)</sup> so, when discovery is sought if the party from whom it is sought objects to it or any part thereof, the Court or a judge may, if satisfied that the right to the discovery sought depends on the determination of any issue or dispute in the cause, or that for any other reason it is desirable that any issue or question in dispute in the cause

<sup>(i)</sup> See *Smith v. G. W. Ry. Co.*, Macr. P. C. 223.

<sup>(k)</sup> p. 468 *ante*.

<sup>(l)</sup> *Morgan v. Seaward*, 1 W. P. C. 169.

<sup>(m)</sup> 46 & 47 Vict. c. 57, s. 29.

<sup>(n)</sup> S. C. R. 1883, Ord. xxxi. r. 1; *Birch v. Mather*, L. R. 22, Ch. D. 629;

*Haddan's Patent*, 54 L. J. N. S. Ch. 126; *Finnigan v. James*, L. R. 19 Eq. 72; *Crosby v. Tomey*, L. R. 2 Ch. D. 533; *Saunders v. Jones*, L. R. 7 Ch. D. 449.

<sup>(o)</sup> Ord. xxxi. rr. 25, 26, 27.

<sup>(p)</sup> p. 483 *ante*.

should be determined before deciding upon the right to the discovery, order that such issue or question be determined first, and reserve the question as to discovery.(g)

And when a defendant's answer to an interrogatory cannot help the plaintiff to obtain a decree, but will only be of use to him if he obtains a decree, the Court has a discretion whether to oblige the defendant to answer before trial, and will not do so when compelling such discovery would be oppressive.(r) Thus, if the defendant denies infringement, but admits the possession of the infringing articles, he will not be compelled to answer interrogatories which seek an account of all such articles in his possession, as well as discovery as to the purchase or hire of them, and an account of sales and profits.(s)

Where a party interrogates as to facts tending to enable him to prove a particular issue, the party giving discovery will not be excused from answering fully on the ground that such answers cannot be of use to the party seeking it, if he fails to prove some other issue.(t)

Rule that the party interrogated must answer fully.

The limitation as to answering interrogatories applies only to those relating to matters which depend on the part (or it may be the whole) of the case which will become immaterial if the case be not established, or are of such a nature that the party seeking the discovery is not entitled to it till his case is established by the judgment of the Court(u)—*e.g.*, where infringement is admitted and discovery is sought of the sales and profits made by trafficking in the infringing articles.(v) It does not protect a defendant who denies the plaintiff's title *in toto*, or alleges that the patent is invalid, from answering fully all interrogatories which are material.(w)

Subject to the above limitations, the old fixed and rigid rule that "he who answers at all must answer fully," guides the Court in deciding whether any particular answers given are

(g) S. C. R. 1883, Ord. xxxi. r. 20.

(r) Parker v. Wells, L. R. 18 Ch. D. 477; Swabey v. Sutton, 1 H. & M. 514, 514; Fennessy v. Clark, L. R. 37 Ch. D. 184; Lister v. Norton, 2 P. O. R. 68, Bray on Discovery, p. 553

(s) De la Rue v. Dickinson, 3 K. & J. 388; Rolls v. Isaacs, W. N. 1878, p. 37; Fennessy v. Clark, L. R. 37 Ch. D. 184.

(t) Foxwell v. Webster, 2 Drew & Son, 250.

(u) De la Rue v. Dickinson, 3 K. & J. 391; Parker v. Wells, L. R. 18 Ch. D. 477; Lister v. Norton, 2 P. O. R. 68.

(v) *Ibid.*

(w) Swinborne v. Nelson, 16 Beav. 416; Foxwell v. Webster, 3 N. R. 103; 9 Jur. N. S. 1189.



sufficient, or whether any particular interrogatories are allowable or not.(y)

When a defendant, in answer to an interrogatory asking whether or not he was making articles identical with those manufactured by the plaintiff under the patent, and requiring him to state in what respects his articles differed from the plaintiff's, stated that he had for many years before the date of the patent applied to the articles in question the same treatment as was described in the specification, and that he now made articles which, save so far as his own method or process, adopted before the patent, was similar to that described in the specification of the plaintiff's patent, differed from the articles there described, but that it was impossible, without ocular demonstration, to show in what they differed, he was held to have given a sufficient answer.(z)

Interrogatories  
as to infringement.

Where infringement has been alleged, anything showing, or tending to show, the fact of infringement may be required to be set out in answer to interrogatories.(a) Thus, where a plaintiff had been successful in actions against infringers and brought a subsequent action against another infringer, the defendant was compelled to answer whether the process used was the same as that used by one of the prior infringers;(b) and where the defendants denied infringement they were compelled to state, in answer to interrogatories, where they first manufactured, and to whom by name they first sold any, and what quantity, of the articles alleged by the plaintiff to be infringements, and by what process they were manufactured.(c)

Where in-  
fringement is  
admitted.

Where infringement is admitted, the plaintiff is entitled to an answer to interrogatories asking for the names and addresses of the persons to whom the defendant's machines have been sold;(d) and where the defendant had, in answer to interrogatories, set forth the names and addresses of persons resident in

(y) *Swinborne v. Nelson*, 16 Beav. 416; *Elmer v. Creasy*, L. R. 9 Ch. App. 69; *Saull v. Erowne*, L. R. 9 Ch. App. 364; *Lister v. Norton*, 2 P. O. R. 68.

(z) *Crossley v. Tomey*, L. R. 2 Ch. D. 533; see also *Smith v. G. W. Ry. Co.*, Macr. P. C. 227; 6 E. & B. 405.

(a) *De la Rue v. Dickinson*, 3 K. & J. 391; *Lister v. Norton*, 2 P. O. R. 68, 69; *Remard v. Levinstein*, 10 L. T. N. S. 94.

(b) *Bovill v. Smith*, L. R. 2 Eq. 459, 461.

(c) *Swinborne v. Nelson*, 16 Beav. 416.

(d) *Tetley v. Easton*, 18 C. B. 643.

England from whom he had received royalties for the use of machines which the plaintiff alleged were made in infringement of his patent, such defendant was ordered to give the names and addresses of persons resident abroad from whom royalties had been received by him in respect of machines made in England, on the ground that the answer might lead to the discovery of important facts relative to the infringement.(*e*)

A defendant will not be excused from giving the names and addresses of his customers on the ground that by so doing he may thereby expose them to actions for infringements.(*f*)

Where a defendant company sought to withhold from production certain letters which had passed between the officers of the company, and between them and other persons, together with reports relative to infringement and the validity of the plaintiff's claim, it was held that such documents were not privileged, and their production was ordered.(*g*)

The Court will not compel a party to discover facts beyond what is necessary to enable his opponent to prove his case.(*h*) Thus, where the only plea raised by the defence was that the plaintiff was not the true and first inventor, the defendant was allowed to refuse to answer interrogatories as to the inaccuracy of the specification, the novelty of the process, and the fact of the infringement.(*i*)

Fishing interrogatories, which merely help one party to get at the other's evidence and see what he can make of it, are not allowed: *e.g.*, a plaintiff is not allowed to ask a defendant to state the names of the persons to whom he alleges he sold articles similar to the plaintiff's before the date of the patent,(*k*) though he may be required to state whether the alleged anticipating machines mentioned in his objections are in existence, and the names and addresses of the alleged prior users.(*l*)

It has been stated that interrogatories for the examination of

(*e*) *Crossley v. Stewart*, 1 N.R. 426; see also *Davenport v. Rylands*, L. R. 1 Eq. 302, 308; *Leather Co. v. Hirschfield*, L. R. 1 Eq. 299.

(*f*) *Tetley v. Easton*, 18 C. B. 643; *Howe v. McKernan*, 30, Beav. 547; *Bovill v. Cowan*, W. N. 1867, p. 115.

(*g*) *Westinghouse v. Midland Ry. Co.* 48, L. T. N. S. 98, 462.

(*h*) *Bidder v. Bridges*, L. R. 29 Ch. D. 29, 34.

(*i*) *Young v. White*, 17 Beav. 532.

(*k*) *Daw v. Eley*, 2 H. & M. 725.

(*l*) *Birch v. Mather*, L. R. 22 Ch. D. 629.

Discovery limited to facts necessary to enable parties to prove their case.

Fishing interrogatories.

Respective rights of plaintiff and defendant to discovery.



a plaintiff are on a different footing from those for the examination of a defendant in this respect, that a plaintiff is not entitled to discovery of the defendant's case, but a defendant may ask any questions tending to destroy the plaintiff's claim.<sup>(m)</sup> This statement must, however, be taken as having been made in the first instance in reference to a particular case, and must not be taken as establishing the proposition that a defendant has a larger right of discovery than a plaintiff. No such proposition can be upheld in the face of the authorities which, on the contrary, establish that the rights of both plaintiff and defendant are equal in respect of discovery, *i.e.*, either party is entitled to a discovery of such material facts from the other as will enable him to make out *his case*, and not to a discovery of facts which relate exclusively to the manner in which the case of the other party is to be established, or to the evidence which relates exclusively to that case.<sup>(n)</sup>

Where it appeared that certain plaintiffs, before they became owners of the patent in respect of which they were suing, had, in various proceedings, either disputed, or made preparations for disputing, its validity, and the defendants applied for inspection of the documents relating to such proceedings, it was held that they were entitled to have inspection of all except such as the plaintiff should state on oath to come within such terms as counsel should agree on, *i.e.*, to have come into existence merely to be communicated to the solicitor for the purpose of litigation, actual or intended, and either as materials for briefs, or for his advice or consideration.<sup>(o)</sup>

Practice where discovery is a matter of indifference to the party against whom it is sought.

Where discovery is a matter of indifference to the party against whom it is sought, the Court does not weigh carefully the question of materiality or immateriality, still, where the nature of the discovery required is such that the giving of it may be prejudicial to such party, the Court takes into consideration the special circumstances of the case; on the one hand it takes

<sup>(m)</sup> *Hoffmann v. Postill*, L. R. 4 Ch. App. 673; *Lowndes v. Davies*, 6 Sim. 468; *Commissioners of Sewers v. Glasse*, L.R. 15 Eq. 302.

<sup>(n)</sup> *Bray on Discovery*, pp. 467 and 468; *Bovill v. Smith*, L.R. 2 Eq. 459; *Daw v. Eley*, 2 H. & M. 725;

*Bidder v. Bridges*, L. R. 29 Ch. D. 34, judgment of Kay, J.

<sup>(o)</sup> *Haslam v. Hall*, 5 P. O. R. 1; see also *Southwark v. Quirk*, L. R. 3 Q. B. D. 315, 320; *Anderson v. Bank of British Columbia*, L. R. 2 Ch. D. 644.

care that the party desiring discovery obtains all which can be of use to him, on the other it protects the opposite party against undue inquisition into his affairs.(p)

As in the case of inspection(q) so with regard to discovery, the fact that the particular discovery sought would lead to the disclosure of the trade secrets of the opposite party will not deter the Court from granting it, if it is necessary in the interests of justice to enable the applicant to establish his case. Discovery leading to disclosure of trade secrets.

In such cases the Court endeavours, where possible, to protect the party compelled to disclose trade secrets, and will not order discovery beyond what is necessary to prove the case of the party seeking it.

Thus, where a defendant denied having infringed a patent for "improvements in preparing colouring matters for dyeing and colouring," although he was compelled to answer interrogatories as to whether he used certain ingredients mentioned in the specification, whether he added anything else, and whether the additions made any difference in the process, yet he was not obliged to disclose the nature and quantities of the additions (r)

At the hearing of the case, evidence as to the defendant's secret process was taken *in camera*, and the judge ordered the shorthand notes and all the printed copies thereof to be sealed up and impounded in Court until there should be an appeal, in which case the parties were to be at liberty to apply for the delivery out of Court of so many copies as they should want, or until, either by lapse of time or otherwise, it should be determined that there was to be no appeal, in which case any application might be made to the Court for the disposal of them as the parties should think fit.(s)

Communications between a patentee and his patent-agent relative to the preparation of the specification are not privileged, and he may be required to refer to them in answering interrogatories as to documents in his possession. Thus, where the Communications between patentee and patent-agent.

(p) *Moore v. Craven*, L. R. 7 Ch. App. 94, 96; *Simpson v. Charlesworth*, W. N. 1866, p. 255; *Daw v. Eley*, 2 H. & M. 725; *Rolls v. Isaacs*, W. N. 1878, p. 37; *Crossley v. Stewart*, 1 N. R. 426; S. C. 7 L. T. N. S. 848; *Craven v. Pinto Leite*, L. R. 7 Ch. App.

90, 97; *Orr v. Diaper*, L. R. 4 Ch. D. 92.

(q) p. 484 *ante*.

(r) *Renard v. Levinstein*, 10 L. T. N. S. 94.

(s) *Badische Aniline und Soda Fabrik v. Levinstein*, L. R. 24 Ch. D. 176.



defendant interrogated the plaintiff as to documents in his possession relating to the preparation of the specification and the plaintiff refused to answer, stating as a reason for his refusal that the documents were confidential communications between himself and his solicitor (who was also his patent-agent) and counsel, the Court decided that the answer was insufficient, as not distinguishing communications between the plaintiff and his solicitor, and communications between him and his patent-agent, the former class of communications alone being privileged. (*t*)

And where an action was commenced in respect of the infringement of two patents for similar inventions, but discontinued as to one of such inventions, the plaintiff was nevertheless required to answer interrogatories as to communications relative to that patent between himself and his patent-agent, on the ground that such answer might be material to the validity of the patent for the other cognate invention. (*u*)

Irrelevant  
interrogatories.

An interrogating party is entitled only to such answers as will enable him to establish his case, and he is not entitled to answers to irrelevant questions (*v*)—*e.g.*, as to certain unsuccessful proceedings abroad for the infringement of a foreign patent in possession of the plaintiff; (*w*) but in one case the plaintiff was ordered to answer as to the terms of a compromise in another action as being material. (*x*) Consequently, if the particulars of breaches are sufficient the plaintiff will not be compelled to answer further questions as to the alleged infringements. (*y*)

The owner of letters patent for mechanical musical instruments brought an action for alleged infringement against the defendants, and delivered particulars of breaches, in which he complained generally of the infringement of the first claiming clause of the specification, and “in particular and by way of illustration” of a specific article held by the defendants. The defendants delivered particulars of objections which alleged

(*t*) *Mosley v. Victoria Rubber Co.* 3 P. O. R. 351.

(*u*) *Ibid.*

(*v*) *Ehrlich v. Inlee*, 5 P. O. R. 37; *Hoffmann v. Postill*, L. R. 4 Ch. App. Cas. 673; S. C. R. 1883, Ord. xxxi. r. 6.

(*w*) *Hoffmann v. Postill*, L. R. 4 Ch. App. Cas. 673, 679;

(*x*) *Betts v. Neilson*, W. N. 1866, p. 170.

(*y*) *Hoffmann v. Postill*, L. R. 4 Ch. App. Cas. 673, 679.

(*inter alia*) that the alleged invention was not the subject of a patent, but the new application of old machinery to an analogous purpose; that, as disclosed by the specification, it did not make any useful addition to the existing stock of public knowledge; and that the specification did not sufficiently distinguish the new from the old. The defendants also delivered interrogatories which in effect asked the plaintiff to admit the truth of the above-mentioned objections, or to state how he made them out not to be true. The plaintiff having declined to answer these interrogatories, the defendant took out a summons to compel him to do so. The summons was adjourned into Court, and the plaintiff, then consenting to answer the interrogatories as to subject-matter, and to amend the particulars of breaches by omitting the words "by way of illustration," it was held that no further answer should be ordered.<sup>(z)</sup>

Where it appears probable from a document produced by the plaintiff or defendant that he has in his possession relevant documents besides those which are scheduled to his original affidavit, the proper course is to apply for an order calling on him to make a further and better affidavit, and in particular to state whether he has not in his possession documents, which, from that which has been said by him on affidavit or from the documents he has produced, in all probability are in his possession.<sup>(a)</sup> Thus, a plaintiff who in his affidavit of documents referred to certain affidavits made in a previous action against different defendants, but omitted to schedule them, was ordered to make a further and better affidavit with particular reference to the affidavits filed in the previous action.<sup>(b)</sup>

It is established that where an affidavit of documents has been made the opposite party cannot require a further affidavit to be made, if that affidavit is technically sufficient, unless he shows, either upon affidavit or from documents which are produced, or from the pleadings, or admissions in the pleadings of the party giving discovery, or from the very nature of the case

<sup>(z)</sup> Ehrlich v. Ihlee, 5 P. O. R. 37.

<sup>(a)</sup> Per Cotton, L.J., Brown v. Sansom, 5 P. O. R. 515; Jones v. Monte Video Gas Co., L. R. 5 Q. B. D. 556.

<sup>(b)</sup> Brown v. Sansom, 5 P. O. R. 510.



(and as regards the nature of the case there must be very strong evidence to induce the Court to act) that there are, probably, in the possession of the party giving discovery documents, other than those he has scheduled in his affidavit. There can be no cross-examination on an affidavit of documents which has been filed; but though the party requiring discovery cannot take any of those courses either as to cross-examination or without such evidence above referred to, on further affidavit he may, with the leave of the Court, interrogate the party who has made an affidavit as to documents with reference to certain specific documents which he has reason to suppose are in the possession of the party giving discovery, and which have not been disclosed.(c)

The Court may require an affidavit that the application is not for vexation, or for the purpose of delay, but that it is made honestly for the purpose of obtaining discovery; but it is doubtful whether an affidavit as to the existence and nature of documents supposed to be in the possession of the party giving discovery and not included in the schedule to his original affidavit of documents is admissible.(d)

After one party has made a sufficient affidavit of documents the other party to the action will not be allowed to administer to him a general roving interrogatory as to documents in his possession, the effect of which would be to compel him to make a further affidavit. There are cases in which, after a sufficient affidavit as to documents, the Court will allow a party to deliver an interrogatory as to some specific document or documents, but whether this shall be allowed is a matter within the discretion of the judge in each particular case, and though this decision can be appealed from, the Court of Appeal will not readily reverse it.(e)

If an application is made at Chambers for the usual order for discovery of documents, and a limited order only is asked for and obtained, no further order can subsequently be made if

(c) Judgment of Cotton, L.J., *Edison v. Holland*, 5 P. O. R. 216; see also *Hall v. Truman*, L. R. 29 Ch. D. 307; *Rawes v. Chance*, 7 P. O. R. 275.

(d) *Edison v. Holland*, 5 P. O. R. 216.  
(e) *Hall v. Truman*, L. R. 29 Ch. D.

the judge has certified that he did not require argument in Court.(f)

*Account or Damages.*

A plaintiff who succeeds in showing that his patent rights are valid and subsisting, and that they have been infringed, is entitled, not only to an injunction restraining the defendant from continuing the infringements complained of, but also to an account of profits made by the defendant by means of his wrongful acts, or damages against him in respect of the infringements committed. Successful plaintiff is entitled to an account or damages,

A plaintiff cannot have both an account and damages against the same defendant; he must choose one or the other,(g) and this rule applies to every case of infringement.(h)

An inquiry as to the damages and an account of profits are not reconcilable, for, if an account be taken of profits, the infringement is thereby condoned.(i)

An unexplained delay in bringing action may affect a plaintiff's right to an account of profits, or damages,(k) by barring the right altogether,(l) or limiting it to an account of profits, made since the commencement of the action,(m) for it is a principle of equity that a party who claims a right shall not lie by, and, by his silence or acquiescence, induce another to go on expending his money, and incurring risk, and afterwards, if profit be made, come and claim a share in that profit without having been exposed to the losses which might have been sustained.(n)

An account of profits or an inquiry as to do damages may now be had, notwithstanding the fact that the action is commenced or judgment is delivered after the expiration of the patent, and the plaintiff is, therefore, not entitled to an injunction.(o) Formerly the right to an account or damages was

(f) *Thomson v. Hughes*, 7 P. O. R. 187.

(g) *Neilson v. Betts*, L. R. 5 E. & I. App. Cas. 22; *Watson v. Holliday*, 30 W. R. 747.

(h) *De Vitre v. Betts*, L. R. 6 E. & I. App. Cas. 319; *Vidi v. Smith*, 3 E. & B. 969; *Holland v. Fox*, 3 E & B, 977.

(i) *Neilson v. Betts*, L. R. 5 E. & I. App. Cas. 22, per Lord Westbury.

(k) *Crossley v. Derby Gas Co.*, 1 W. P. C., 120; *Harrison v. Taylor*, 11

*Jur. N. S.* 408; *Sayers v. Collyer*, L. R. 28, Ch. D. 103.

(l) *Crossley v. Derby Gas Co.*, 1 W. P. C. 120; *Harrison v. Taylor*, 11 *Jur. N. S.* 408.

(m) *Sayers v. Collyer*, L. R. 28 Ch. D. 103.

(n) *Crossley v. Derby Gas Co.*, 1 W. P. C. 120.

(o) 21 & 22 Vict. c. 27, s. 2; 36 & 37 Vict. c. 66, s. 16; *Betts v. Gallais*, L. R. 10 Eq. 392; S. C. R. 1883, Ord. xv. r. 1; *York v. Stowers*, W. N. 1883, p. 174.



ancillary to the right to an injunction, and if an injunction could not be granted, the plaintiff could not have an account,<sup>(p)</sup> except in the case of fraud.<sup>(q)</sup>

Jurisdiction of Court of County Palatine of Lancaster.

Before the Chancery of Lancaster Act 1890, it was held that the Court of the County Palatine of Lancaster had no jurisdiction to grant an account, or award damages, if the plaintiff was not entitled to an injunction, *e.g.*, if the patent had expired before,<sup>(r)</sup> or during,<sup>(s)</sup> the litigation, or there was no evidence of any intention on the part of the defendant to repeat the infringement.<sup>(t)</sup> It would, however, appear that the Court of the County Palatine of Lancaster has now jurisdiction to grant an account or award damages independently of any right to injunction.<sup>(u)</sup>

Different defendants to same action.

As regards different defendants to the same action, the plaintiff may have an account of profits against one of such defendants and damages against the other.<sup>(v)</sup> Thus, in a case where the manufacturers and the users of an infringing article were sued together in consolidated actions, Page Wood, V.C., said: "It has never been held that an account directed against a manufacturer of a patented article licenses the use of that article in the hands of all purchasers. The patent is a continuing patent, and I do not see why the article should not be followed in every man's hand, until the infringement is got rid of. So long as the article is used, there is continuing damage."<sup>(w)</sup>

An inquiry as to profits made by an infringer, and consequent damages due to the plaintiff, extends to all profits, including those which accrued since the defendant became aware of the plaintiff's claim to the patent, as well as those which accrued before he became aware of such claim.<sup>(y)</sup>

Scope of order for an account of profits.

The account also extends, not merely to the profits made by the sale of the pirated article, but also to all profits

<sup>(p)</sup> *Smith v. G. W. Ry. Co.*, Macr. P. C., 203; *Price's Patent Candle Co. v. Bauwen's Patent Candle Co.*, 4 K. & J. 727.

<sup>(q)</sup> *Crossley v. Derby Gas Co.*, 1 W. P. C. 119.

<sup>(r)</sup> *Smith v. G. W. Ry. Co.*, Macr. P. C., 209; *S. C. Kay*, 417.

<sup>(s)</sup> *Price's Patent Candle Co. v. Bauwen's Patent Candle Co.*, 4 K. & J. 727; but see *Fox & Dellestable*, 15 W. R. 194.

<sup>(t)</sup> *Proctor v. Bayley*, 6 P. O. R. 538.

<sup>(u)</sup> 53 & 54 Vict. c. 23, s. 3; 21 & 22 Vict. c. 27; 36 & 37 Vict. c. 66, s. 16

<sup>(v)</sup> *Penn v. Bibby*; *Penn v. Fernie*, L. R. 3 Eq. 308; 36 L. J. Ch. 277; *United Telephone Co. v. Walker*, 4 P. O. R. 67.

<sup>(w)</sup> *Penn v. Bibby*, *Penn v. Jack*, *Penn v. Fernie*, L. R. 3 Eq. 308; 36 L. J. Ch. 277.

<sup>(y)</sup> *Davenport v. Rylands*, L. R. 1 Eq. 302, 308; *United Horse-shoe and Nail Co. v. Stewart*, L. R. 13 App. Cas. 401.

incidentally derived from its use. For example, where a defendant was sued for the infringement of a patent for gas meters, and was ordered to account for profits made by him, the account was made to include the benefit derived by way of saving effected by the use of the piratical gas meters.(y)

It would appear that if the plaintiff desires an account of collateral profits, he must prove that such profits have been received ; (z) and an account will not be directed when it is clear that no profits whatever have been made.(a)

When an order for an account of profits is made against a defendant, he may be compelled to produce his books, and interrogatories may be administered, notwithstanding that an appeal is pending.(b)

On the taking of an account of profits the plaintiff is not entitled to an account of the losses which he has sustained in consequence of the infringement ; he is only entitled to an account of the profits made by the defendant.(c)

In the bankruptcy of a defendant, the amount found due on an account of profits made by the infringement of a patent, can be proved in the bankruptcy as it is a liquidated debt.(d)

Proof in bankruptcy.

On the taking of an account of profits, the defendant may be compelled to disclose the profits arising from his business before he commenced to manufacture the articles to which the patent refers by the application of the patented process or machine, as well as since, if such information is necessary to put the Court in a position to estimate what proportion of the total profits made by the defendant since the commencement of the infringement, is due to his wrongful acts.(e)

Profits of defendant's business prior to infringement.

On an inquiry as to damages the defendant must disclose the number of the infringing articles he has made, and the names and addresses of the persons to whom, and the prices at which, he has sold them, in spite of the fact that he thereby exposes

Disclosure of names of customers.

(y) *Crossley v. Derby Gaslight Co.*, 1 W. P. C. 119; see also *Househill Co. v. Neilson*, 1 W. P. C. 697 n.

(z) *Bacon v. Spottiswoode*, 1 Beav. 382.

(a) *Bergmann v. McMillan*, L. R. 17 Ch. D. 423; *Sanitas Co. v. Condy*, 4 P. O. R. 530.

(b) *Saxby v. Easterbrook*, L. R. 7. Ex. 207.

(c) *Ellwood v. Christy*, 18 C. B. N. S. 494.

(d) *Watson v. Holliday*, 30 W. R. 747; 31 W. R. 536; 52 L. J. Ch. 543; Bankruptcy Act, 1883, s. 37.

(e) *Siddell v. Vickers*, 6 P. O. R. 464.



his customers to attack from the plaintiff, and himself to a consequent loss of trade.(g) The very object for which the plaintiff desires the names of the defendant's customers may be to enable him to follow the infringing articles in the hands of such customers.

Measure of damages.

The measure of damages to which a successful plaintiff is entitled, is the actual loss sustained by him by reason of the unlawful acts of the defendant, which loss must be the natural and direct consequence of the defendant's acts.(h) The plaintiff is not entitled to receive anything in respect of the annoyance and vexation he experiences from the necessity of having to establish his right in a Court of law, the award of the costs of the action being the only way the Court will attempt to recompense him in respect of such annoyance and vexation.(i)

Infringement before publication of complete specification.

Infringement after failure to pay fees.

No damages can be obtained in respect of an infringement committed before the publication of the complete specification ;(k) and in any proceedings in respect of an infringement committed after a failure to make any payment, in respect of fees for keeping up the patent, 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.(l)

Account of profits when patent has been assigned.

As a rule, where a plaintiff has become possessed of a patent by assignment, the account of profits is only ordered from the date of the registration of the assignment.(m)

But where it appeared that the plaintiffs had taken over a business and certain patents, and succeeded to the rights of their predecessors, they were held to be entitled, in estimating the damages and loss of sales consequent on the competition of the defendants, to take into account the total quantities sold by the defendants before the plaintiffs acquired the business.(n)

(g) Murray v. Clayton, L. R. 15 Eq. 115; American Braided Wire Co. v. Thompson (2), 5 P. O. R. 375; United Telephone Co. v. Walker, 4 P. O. R. 66; Leather-Cloth Co. v. Hirschfield, 1 H. & M. 295.

(h) United Telephone Co. v. Walker, 4 P. O. R. 67.

(i) United Horseshoe and Nail Co.

v. Stewart, L. R. 13 App. Cas. 401 416.

(k) 46 & 47 Vict. c. 57, s. 13.

(l) 46 & 47 Vict. c. 57, s. 17, ss. 4 (b).

(m) Ellwood v. Christy, 18 C. B. N. S. 494.

(n) United Horseshoe and Nail Co. v. Stewart, L. R. 13 App. Cas. 401, 417.

Before a plaintiff can be entitled to an inquiry as to damages, it is incumbent on him to show that he has in fact sustained some damage which is not merely nominal.<sup>(p)</sup>

Evidence necessary to obtain inquiry as to damages.

In estimating the amount of damages to which a successful plaintiff is entitled, the Court recognises that every sale without licence of a patented article must be a damage to the patentee,<sup>(q)</sup> but the actual profit derived by the defendant is not in all cases necessarily the measure of the plaintiff's loss, for it cannot always be ascertained with arithmetical precision what, in the ordinary course of business, would have been the amount of the plaintiff's sales and profits. When the product of the patented machinery is a new and special article which cannot be successfully imitated without using the invention, the process of estimation is comparatively simple, but on the other hand it is quite the reverse when this is not the case. An allowance will be made in respect of loss of sales caused by the defendant's competition, and at the same time the defendant is entitled to strike off a moderate percentage as representing sales due to increased activity in the trade produced by the rivalry of two competitors, if that is the relationship of the parties.<sup>(r)</sup>

Profit as measure of damage.

If a patentee whose patent is being infringed reduces the price at which he sells the patented articles, in order to be able to undersell the infringer, although in an action for damages he may be entitled to the benefit of all sales made by the infringer as if they were made by himself, so that he will get all the profit so made by the the infringer, yet he is not entitled to recover the difference between the original and reduced price, because the reduction is not a natural and direct consequence of the infringer's acts, and therefore too remote.<sup>(s)</sup>

Reduction of price by patentee.

But when it can be shown that the plaintiff has not reduced his price below that of the infringing defendant, and that the plaintiff's reduction has been consequent upon the defendant's, the Court, in estimating the amount of damages, will consider

<sup>(p)</sup> *Dicks v. Brooks*, L. R. 15 Ch. D. 39; *United Telephone Co. v. Sharples*, 2 P. O. R. 28; *Santas Co. v. Condy*, 4 P. O. R. 530; *Cole v. Saqui*, 5 P. O. R. 489, 496.

<sup>(q)</sup> *Davenport v. Rylands*, L. R. 1 Eq. 308.

<sup>(r)</sup> *United Horseshoe and Nail Co. v. Stewart*, L. R. 13 App. Cas. 401, 413, 417; *Ellwood v. Christy*, 18 C. B. N. S. 494; *Penn v. Jack*, L. R. 5 Eq. 81.

<sup>(s)</sup> *United Horseshoe and Nail Co. v. Stewart*, L. R. 13 App. Cas. 401; 5 P. O. R. 260.



that the plaintiff, but for the defendant's wrongful acts, would have made all the sales effected by the defendant at the original and not at the lowered price.<sup>(t)</sup>

Increase of sales by reason of defendant's reduction in price.

Damages where practice is to grant royalties.

A reduction, however, will be allowed to the defendant in consideration of the increase of sales by reason of the diminution of price and also by reason of his business connection.<sup>(u)</sup>

Where the plaintiff is in the habit of supplying to his customers a complete instrument at a fixed royalty, and that instrument consists of patented and non-patented parts, it is proper, in estimating the damages to which he is entitled, to deduct from the royalty a sum in consideration of the non-patented portion of the infringing instrument.<sup>(v)</sup>

Profits not attributable to use of invention.

And in all cases where the plaintiff elects to claim the profits made by an unauthorised use of his invention it becomes material to ascertain how much of it was actually appropriated, in order to determine what proportion of the net profits realised by the infringer was attributable to the use of the plaintiff's invention.<sup>(e)</sup> But when the patentee of machinery, who does not grant licences, claims damages from an infringing manufacturer who competes with him by selling the same class of goods in the same market, the profit made by the infringer is of no consequence. However large his gains, he is only liable in nominal damages so long as his illegal sales do not injure the trade of the patentee; and however great his loss, he cannot escape from liability to make full compensation for the injury which his competition may have occasioned. Every sale of goods manufactured without licence by patented machinery is, and must be, treated as an illegal transaction in a question with the patentee; and its inherent illegality is not affected by the circumstance that the infringement consisted in using a small and, it may be, the least useful part of the invention.<sup>(y)</sup>

If the defendant has made profit by the illegal use of the patented invention, the fact that he might have made a profit by

<sup>(t)</sup> American Braided Wire Co. v. Thompson, 7 P. O. R. 47, 152; W. N. 1890, 68; L. R. 44 Ch. D. 274.

<sup>(u)</sup> *Ibid.*

<sup>(v)</sup> United Telephone Co. v. Walker, 4 P. O. R. 61, 63.

<sup>(x)</sup> United Horseshoe and Nail Co. v. Stewart, L. R. 13 App. Cas. 412.

<sup>(y)</sup> Per Lord Watson, United Horseshoe and Nail Co. v. Stewart, L. R. 13, App. Cas. 413.

selling articles not manufactured by the machine the subject of the patent, is quite immaterial.<sup>(z)</sup>

Where damages are assessed on the principle that the plaintiff's loss is the loss of rents and royalties, the measure of his damages is the profit rent, and royalties for the entire period during which the infringing article was in the hands of the defendant, whether it was or was not in use during the whole of that time.<sup>(a)</sup> And where the plaintiff is in the habit of granting licences he cannot claim by way of damages a manufacturing profit, or any sum beyond the ordinary royalty; moreover, he will not be entitled to recover anything from the manufacturer if he has received the full royalty from the user.<sup>(b)</sup>

Damages in respect of loss of rents and royalties.

A patentee, who has obtained an injunction, cannot be compelled to accept from an infringer desirous of continuing the use of the invention, the same royalties he accepts from other and licensed users.<sup>(c)</sup>

Royalties

If a patentee obtains an injunction and damages against an infringing manufacturer, and the manufacturer does not pay the damages, it is open to the patentee to claim from a purchaser of the manufacturer what is due to him by way of damages in respect of the purchase of infringing machines.<sup>(d)</sup> The acceptance by the plaintiff of agreed damages from an infringing manufacturer of the patent article in respect of his wrongful acts does not preclude the plaintiff from following the article in the hands of a purchaser from such manufacturer and claiming damages from him, for the payment of agreed damages by the manufacturer does not make the article "free" in the hands of a purchaser.<sup>(e)</sup>

Nonpayment of damages by manufacturer.

Effect of acceptance of agreed damages from manufacturer.

In cases where it appears that the defendant has infringed during the interval between a former decision adverse to the validity of the patent and its reversal on appeal, and further, that the defendant's wrongful acts were committed on the strength of that former decision, it is submitted that the de-

Damages where there is a decision adverse to the patent.

<sup>(z)</sup> *United Horseshoe and Nail Co. v. Stewart*, L. R. 13 App. Cas. 401.

<sup>(a)</sup> *United Telephone Co. v. Walker*, 4 P. O. R. 63.

<sup>(b)</sup> *Penn v. Jack*, L. R. 5 Eq. 81.

<sup>(c)</sup> *Penn v. Bibby*, L. R. 3 Eq. 310, 312; *Penn v. Jack*, L. R. 5 Eq. 81.

<sup>(d)</sup> *Cropper v. Smith*, L. R. 24 Ch. D 305, 312.

<sup>(e)</sup> *United Telephone Co. v. Walker*, 4 P. O. R. 63, 67.



defendant would be allowed to give evidence on this point in reduction of damages.(f)

Reference by judge of Chancery Division to judge and jury.

It is open to question whether a judge of the Chancery Division has jurisdiction to order an inquiry as to damages to be referred to a judge and jury.(g)

Scope of order for assessment of damages.

Where an order is obtained for the assessment of damages they are assessed down to the time of assessment, if the cause of action is a continuing one, as the infringement of a subsisting patent is.(h)

And the order for an account of profits, or for the assessment of damages, as the case may be, usually states the time within which the amount found due must be paid after it has been duly certified;(i) but sometimes the time within which such payment is to be made is reserved for further consideration.(k)

Claim to costs of former action.

Where the plaintiff in an action for the infringement of a patent claimed the costs of a former action against the same defendant, which it was alleged was discontinued owing to false evidence on the part of the defendant, the Court held that the proper course was to strike out those paragraphs of the statement of claim which referred to the costs of the former action, and to leave the plaintiff at liberty to bring a separate action in respect of them, and intimated that such action ought to be brought in the Queen's Bench Division.(l)

Omission to ask for damages at the hearing.

Where damages, though claimed in the pleadings, were by an oversight not asked for at the trial, special leave was given, on subsequent motion by the plaintiff, to vary the minutes of the decree by adding an inquiry as to damages.(m)

#### *Destruction or Delivery to Plaintiff of Infringing Articles.*

Plaintiff's right to order for destruction or

In addition to an injunction restraining the defendant from infringing the patent in future, and an account of profits or

(f) pp. 418, 419 *ante*; *Arkwright v. Nightingale*, 1 W. P. C. 61.

(g) *American Braided Wire Co. v. Thompson*, 5 P. O. R. 696.

(h) S. C. R. 1883, Ord. xxxvi. r. 58; *Fritz v. Hobson*, L. R. 14 Ch. D. 542. As to ascertainment of damages in Queen's Bench Division, see S. C. R. 1885, Ord. xxxvi. r. 57.

(i) *Westinghouse v. Lancashire & Yorkshire Ry. Co.*, 1 P. O. R. 253;

11 W. R. 852; *Young v. Fernie*, *Bovill v. Crate*, *Needham v. Oxley*, *Cunningham v. Colling*, *Seton*, 4th ed. p. 355.

(k) *Hocking v. Fraser*, 3 P. O. R. 7; *Betts v. Noel*, *Seton*, 4th ed. p. 355; *Davenport v. Rylands*, L. R. 1 Eq. 302; *Pemberton*, 4th ed. p. 484.

(l) *United Telephone Co. v. Tasker*, 6 P. O. R. 38.

(m) *Edison v. Holland*, 5 P. O. R. 483.

damages at his option, a successful plaintiff in an action for infringement may obtain an order of the Court, directing an inquiry as to how many of the infringing articles are in the possession of the defendant, and ordering further that all such articles shall be destroyed in the presence of the plaintiff or delivered up to him,<sup>(n)</sup> or that they shall be delivered up or destroyed.<sup>(o)</sup>

In a case where the statement of claim prayed for the delivery up and destruction of all infringing articles in the power or control of the defendants, Bacon, V.C., declined to make the order at the trial, but reserved the question for consideration after an account of profits had been taken.<sup>(p)</sup>

The order for delivery up or destruction usually fixes a time within which the infringing articles are to be delivered up or destroyed.<sup>(q)</sup>

Where a defendant is found to have infringed a patent for an invention consisting of a new combination of old parts, the Court will probably grant an injunction restraining the user of the infringing machines, but refuse to order their destruction, on the ground that the parts may be separated and used for other purposes, and the order will give liberty to the plaintiff to mark the infringing machines so as to be able to follow them at any time.<sup>(r)</sup>

Under the following circumstances, an order for delivery up was refused:—The infringing machines consisted of two distinct parts, one of which was an infringement of the patent, and the other was not; the machines had been manufactured abroad and imported into this country, and the defendants dismantled them and kept the separate parts stored in a warehouse.<sup>(s)</sup>

<sup>(n)</sup> *Betts v. De Vitre*, 34 L. J. Ch. 289, 291; S. C. 11 Jur. N. S. 9, 217; Seton, 4th ed. p. 354; *Washburn & Moen Manufacturing Co. v. Patterson*, 1 P. O. R. 157, 162; *Tangye v. Stott*, 14 W. R. 386; *Frearson v. Loe*, L. R. 9 Ch. D. 48, 67; *Otto v. Steel*, 3 P. O. R. 109, 120; *Emperor of Austria v. Day*, 3 De G. F. & J. 217; *Young v. Fernie*, L. R. 1 H. L. 63; *Pemberton*, 4th ed. p. 484; *Edison v. Holland*, 5 P. O. R. 483.

<sup>(o)</sup> *Badische Anilin und Soda Fabrik*

*v. Levinstein*, L. R. 24 Ch. D. 176; *Plimpton v. Malcolmson*, Seton, 4th ed. p. 354.

<sup>(p)</sup> *Hocking v. Fraser*, 3 P. O. R. 7.

<sup>(q)</sup> *Otto v. Steel*, 3 P. O. R. 120; *Washburn & Moen Manufacturing Co. v. Patterson*, 1 P. O. R. 191.

<sup>(r)</sup> *Needham v. Oxley*, 8 L. T. N. S. 604; 11 W. R. 852; *Pemberton*, 4th ed. p. 485; Seton, 4th ed. pp. 352, 353.

<sup>(s)</sup> *United Telephone Co. v. London and Globe Telephone and Maintenance Co.*, L. R. 26 Ch. D. 766, 776.



The destruction of an infringing article may cause a loss to the plaintiff considerably greater than the cost of such infringing article, as, for example, where the infringing article is used in combination with other things which do not infringe, and the article cannot be detached without destroying the whole machine, *e.g.*, the filament in an Edison incandescent electric lamp which was held to infringe the Cheesborough patent and an order for the destruction of which was obtained.<sup>(t)</sup> This loss is part of the risk an infringer incurs when he invades a patentee's rights.

#### Costs.

Discretion of Court or judge.

Subject to the Judicature Acts and the Supreme Court Rules, 1883, the costs of and incident to all proceedings in the Supreme Court are in the discretion of the Court or judge, provided that where any action, cause, matter, or issue is tried with a jury, the costs shall follow the event, unless the judge by whom such action, cause, matter, or issue is tried, or the Court, shall for good cause otherwise order.<sup>(u)</sup> Consequently the costs of an action for infringement of a patent are in the discretion of the judge of any division of the Supreme Court in which the action is tried.

Necessity of certificate of particulars.

On taxation, however, no costs will be allowed to either party in respect of any particular which the Court or a judge has not certified as being reasonable and proper.<sup>(v)</sup> And in case the plaintiff succeeds in an action in respect of a patent, the validity of which has been certified by the Court or a judge to have been questioned in a former action for infringement, he is entitled to have his full costs, charges, and expenses, as between solicitor and client, unless the Court or a judge trying the case certifies that he ought not to have the same.<sup>(x)</sup>

Costs when validity of patent has been certified in former action.

Per Jessel, M. R.

In the words of Sir George Jessel, M. R. : " Where a plaintiff comes to enforce a legal right, and there has been no misconduct on his part, or omission or neglect which could induce

<sup>(t)</sup> Edison *v.* Holland, 5 P. O. R. 459, 483.

<sup>(u)</sup> S. C. R. 1883, Ord. lxxv. r. 1.

<sup>(v)</sup> 46 & 47 Vict. c. 57, s. 29, ss. 6; Longbottom *v.* Shaw, 6 P. O. R. 513. This provision does not apply to the

Court of the County Palatine of Lancaster as that Court is not a Court within the meaning of 46 & 47 Vict. c. 57, s. 29 (6); see p. 511 *post*.

<sup>(x)</sup> 46 & 47 Vict. c. 57, s. 31; p. 514 *post*.

the Court to deprive him of his costs, the Court has no discretion, and cannot take away the plaintiff's right to costs. There may be misconduct of many sorts: for instance, there may be misconduct in commencing the proceedings, or some miscarriage in the procedure, or any oppressive or vexatious mode of conducting the proceedings, or other misconduct which will induce the Court to refuse costs; but where there is nothing of the kind, the rule is plain and well settled, and is as I have stated it." (*y*)

As we have seen, a plaintiff is not bound to apply to the defendant for the relief he seeks before commencing action,<sup>(z)</sup> and ignorance on the part of the defendant is no defence to an action for infringement.<sup>(a)</sup> Neither of these grounds will determine the Court to refuse the plaintiff his costs, if he succeeds in the action and is not otherwise disqualified.<sup>(b)</sup>

Although a defendant admits infringement and promises to discontinue the acts complained of and not to repeat them, the plaintiff is not bound to rely on such promises, but may obtain the injunction of the Court.<sup>(c)</sup> In such a case, if the defendant would avoid the costs of the action he must, at the time he admits the infringement, offer to pay all the costs incurred up to that period.<sup>(d)</sup>

Where the plaintiff failed to prove infringement, and it appeared that the defendant had infringed before the action, but had discontinued the infringement and offered to pay what was reasonable, the plaintiff was condemned in the costs of the action.<sup>(e)</sup>

A defendant who admits infringement must, in order to escape costs, if the plaintiff proceeds to an injunction, not merely promise not to repeat the infringement, but he must admit and offer to pay the amount of his liability. Thus, where a defen-

(*y*) *Cooper v. Whittingham*, L. R. 15 Ch. D. 504.

(*z*) p. 420 *ante*.

(*a*) p. 402 *ante*.

(*b*) *Wittman v. Oppenheim*, L. R. 27 Ch. D. 260; *Upmann v. Forrester*, L. R. 24 Ch. D. 231; *Burgess v. Hateley*, 26 Beav. 249; *Cooper v. Whittingham*, L. R. 15 Ch. D. 504; *Davenport v. Rylands*,

L. R. 1 Eq. 302; *Collins v. Walker*, 7 W. R. 222.

(*c*) p. 420 *ante*.

(*d*) *Burgess v. Hateley*, 26 Beav. 249; *Geary v. Norton*, 1 De G. & S. 9, 12; *Fradella v. Weller*, 2 Russ. & M. 247; *Nunn v. D'Albuquerque*, 34 Beav. 595; *Colburn v. Simms*, 2 Hare, 543.

(*e*) *Fletcher v. Glasgow Gas Co.*, 4 P. O. R. 386.

Ignorance no immunity from costs.

Costs when defendant admits and offers to discontinue infringement.



dant had merely promised not to repeat the infringement, the plaintiff was held to be entitled not only to an injunction but to his costs of the suit.(*f*)

Again, defendants who merely offered to remove certain infringing portions of a machine, but gave no promise not to use them again, and did not offer to pay the costs of the action already incurred, were ordered to pay the costs the plaintiff was put to in order to obtain an injunction.(*g*) And in an action in the Palatine Court, where infringing machines had been disused for five years previous to the commencement of the action, and had been removed from the defendant's premises, the plaintiffs obtained their costs on proof of the infringement, which was denied, and this although there was no threat on the part of the defendants to renew the infringement.(*h*) The Court of Appeal, however, held that in the absence of any evidence of an intention on the defendants' part to continue the wrongful acts an injunction ought not to have been granted, and dismissed the action, but, owing to the defendants' conduct of their case, without costs in the Court below, although they gave the defendants the costs of their successful appeal.(*i*)

Costs when plaintiff's conduct is oppressive.

Oppressive conduct on the part of the plaintiff will induce the Court to deprive him of his costs, even though he succeed in the action. Thus, where a defendant at the hearing submitted to a perpetual injunction, and it appeared that the defendant had ignorantly infringed the patent, but had previously to the commencement of the action offered to deliver up to the plaintiff all profits he had made by selling the infringing articles, and to sell all such articles remaining in his possession to the plaintiff at a fair valuation, but the plaintiff nevertheless continued the action, the Court gave him no costs.(*k*)

Costs of separate issues.

It is provided by S. C. R., 1883, Ord. LXV. r. 2, that where issues of fact and law are raised upon a claim or counter-claim, the costs of the several issues respectively, both in law and fact, shall, unless otherwise ordered, follow the event.

(*f*) Geary v. Norton, 1 De G. & S. 9.  
 (*g*) United Telephone Co. v. London and Globe Telephone and Maintenance Co., 1 P. O. R. 117.

(*h*) Proctor v. Bayley, 6 P. O. R. 106.  
 (*i*) Proctor v. Bayley, 6 P. O. R. 538.  
 (*k*) Nunn v. D'Albuquerque, 34 Beav. 595.

The costs of issues raised by either party, but abandoned at the trial, must be borne by the party who raised them.<sup>(l)</sup>

In considering the question of the apportionment of costs in patent cases, it will be well to divide the decisions into two classes—I. Those in which the validity of the patent was either not contested, or was established; II. Those in which the patent was declared invalid.

I. Where the plaintiff succeeds in upholding the validity of the patent, but fails to prove the fact of infringement, it appears to be the general rule that the Court will apportion the costs.

Where plaintiff upholds validity of patent, but fails on issue of infringement.

Thus, in a case in which the plaintiff succeeded on the question of validity, and the defendant on that of infringement, Bacon, V.C., apportioned the costs, saying: "The costs of the suit, as far as relates to the futile attempt to dispute the plaintiff's right to a patent invention, must be borne by the defendant. The costs of the plaintiff's futile attempt to restrain the defendant from doing that which I think by law he is entitled to do, his patent not being an imitation or piracy of the plaintiff's, the plaintiff must pay him, and the one set of costs must be set off against the other."<sup>(m)</sup>

In an action brought for the infringement of two separate patents, the jury found some of the issues affecting the validity of the patent for the plaintiff and others for the defendant, and it was finally ordered "that the costs be left to abide the event of the several findings for the plaintiff and the defendant company respectively, in respect of the said two letters patent, and that the said costs be taxed on the higher scale, and that the plaintiff do recover nothing against the defendants, save and except the costs of the issues on which he has obtained judgment, and that, save as aforesaid, the defendant company do recover their costs of suit from the plaintiff."<sup>(n)</sup>

And in another instance the action was dismissed with costs, but the Court directed that the plaintiff should have his costs,

<sup>(l)</sup> *Thompson v. The American Braided Wire Co.*, 6 P. O. R. 518.

<sup>(m)</sup> *Simmonds v. Hitchman*, L. R. 29 Ch. D. 417; see also *Automatic Weigh-*

*ing Machine Co. v. Knight*, 6 P. O. R. 297.

<sup>(n)</sup> *Westinghouse v. Lancashire and Yorkshire Ry. Co.* 1 P. O. R. 229, 254.



which were incurred by reason of the defendant disputing the validity of the patent.(o) In one case the Court of Appeal awarded the general costs to the defendant, but gave the costs of the issue of novelty, which was not decided, to neither side.(p)

In an action in which the defendants appealed from a judgment for the plaintiff with costs, and the taxed costs were by consent paid into Court pending the appeal, the Court of Appeal, without going into any other question, decided the issue of infringement in favour of the defendants, and dismissed the appeal with costs. On a subsequent application by the defendants for the repayment of the costs paid by them into court, the Vice-Chancellor of the Palatine Court held that the plaintiff was not entitled to an apportioned part of these costs, attributable to the points other than infringement, on which he had succeeded at the trial; and that the costs must be paid out of court without waiting for the result of an appeal to the House of Lords.(q)

Where the House of Lords reversed the decision of the Court below on the issue of validity, and held that the patent was good, but upheld the finding that the defendant had not infringed, the appeal was dismissed, but no costs were given.(r)

In an action which was dismissed, on the ground of no infringement, without going into the validity of the patent, and costs were given to the defendant, but no certificate was asked for as to the reasonableness and propriety of the particulars of objections,(s) the plaintiff sought, but without success, by taking out a summons to review the taxation, to set off the costs he had incurred by obtaining evidence to meet the defendant's objections.(t) The plaintiff's contention was that the defendant's particulars were "improper, vexatious, or unnecessary" within the meaning of S.C.R. Ord. LXV. 7, 27, sub-r. 20, and that he was, therefore, entitled to the costs occasioned by them. The Court, however, held that the taxing-master had rightly disallowed the defendant's costs of his particulars of objection, not because they were "improper, vexatious, or unnecessary," but

(o) Nordenfelt v. Gardner, 1 P. O. R. 61, 75.

(p) Needham v. Johnson, 1 P. O. R. 49, 59.

(q) Boyd v. Horrocks, 6 P. O. R. 528.

(r) Moore v. Bennett, 1 P. O. R. 129.

(s) p. 510 *post*.

(t) Garrard v. Edge, W. N. 1890, pp. 43, 68.

simply because there had been no certificate, and it was a condition precedent, before the plaintiff could succeed, that he should show the costs of such particulars were disallowed on the ground that they were "improper, vexatious, or unnecessary."

II. There is no general rule as to the apportionment of costs where the plaintiff fails to uphold his patent, but is successful on the issue of infringement.

Where plaintiff fails to uphold validity of patent, but succeeds on the issue of infringement.

The Court has a discretion in the matter which is exercised according to the circumstances of each case.<sup>(u)</sup> It is proper for the Court, if, after hearing the evidence, it comes to the conclusion that issues were unnecessarily raised, to apportion the costs of those issues; but the Court will not apportion the costs of issues which have never been heard in consequence of a decision having been come to at the outset of the case against the validity of the patent.<sup>(v)</sup>

In some cases where the defendant has impeached the patent on more than one ground, but has not been successful on all, and the plaintiff has succeeded on the issue of infringement, the costs of the issues affecting the validity of the patent on which the defendant has failed have been given to the plaintiff, and the other costs of the action to the defendant.<sup>(w)</sup>

A rule has been stated by Fry, J.,<sup>(y)</sup> to the effect that where the plaintiff fails on the issue of validity, but succeeds on other issues, the Court gives the general costs of the action to the defendant, but as regards certain issues raised by the one side or the other, the Court apportions the costs according to the success of the parties.

This rule was approved and applied by the Court of Appeal in *Badische Anilin und Soda Fabrik v. Lerpstein*.<sup>(z)</sup> In this case Bowen, J., said: "I am of opinion, in this case, that the plaintiffs should have the costs occasioned by the issues raised by the particulars of breaches, and that in respect of all the other costs the costs in the action should follow the usual result, and be awarded to the successful party. It seems to me that

<sup>(u)</sup> *Kaye v. Chubb*, 4 P. O. R. 289, 300, 303.

<sup>(v)</sup> *Blakey v. Latham*, 6 P. O. R. 184, 190.

<sup>(w)</sup> *Pooley v. Pointon*, 2 P. O. R. 167; *Lawrence v. Perry*, 2 P. O. R.

179; *Lawrie v. Baker*, 2 P. O. R. 213; *Lister v. Norton*, 3 P. O. R. 199.

<sup>(y)</sup> *Wegmann v. Corcoran*, 27 W. R. 357.

<sup>(z)</sup> L. R. 29 Ch. D. 366, 418, 420.



without laying down any hard-and-fast line, or trying to fetter our discretion at a future period in any other case, we are acting on a sensible and sound principle, namely, the principle that parties ought not, even if right in the action, to add to the expenses of an action by fighting issues in which they are in the wrong. It may be very reasonable as regards their own interest, and may help them in the conduct of the action, that they should raise issues in which in the end they are defeated; but the defendant who does so does it in his own interest, and I think he ought to do it at his own expense.”(z)

Other judges have, however, held that a plaintiff who has failed to substantiate his patent, but has succeeded on the issue of infringement, may be deprived of his costs of that issue, on the ground that in the opinion of the Court the issue was not sufficiently distinguished from the rest of the case,(a) or that the costs of the issue were trifling,(b) or on the ground that there can be no infringement of an invalid patent, and that it is consequently impossible for the plaintiff to succeed on the issue of infringement if the patent is bad.(c)

Necessity of certificate of particulars.

It is provided by the Act of 1883 (d) that on taxation of costs regard shall be had to the particulars delivered by the plaintiff and the defendant, and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a judge to have been proven or to have been reasonable and proper, without regard to the general costs of the case.

Where the plaintiff's particulars alleged four distinct breaches, but no evidence was given as to one of them, and the plaintiff obtained the costs of the action, the certificate was confined to the particulars which had been proved.(e)

Omission to ask for certificate at trial.

If either party omits to ask at the trial for a certificate as to the reasonableness and propriety of his particulars, it is submitted

(z) L. R. 29 Ch. D. 419; see also *Boyd v. Horrocks*, 6 P. O. R. 152, 162.

(a) *Guilbert-Martin v. Kerr*, 4 P. O. R.

23.

(b) *Kay v. Chubb*, 4 P. O. R. 289.

(c) *Edison v. Holland*, 483; *Blakely*

*v. Latham* 6 P. O. R. 29; *United Telephone Co. v. Harrison*, L. R. 21 Ch. D. 720.

(d) S. 29 (6).

(e) *Cole v. Saqui*, 5 P. O. R. 489, 497.

that he may obtain it afterwards on summons in chambers,<sup>(i)</sup> or on motion in Court.<sup>(k)</sup>

In the event of the Court of Appeal reversing the decision of the Court below, the Court of Appeal has power to, and will grant a certificate as to the reasonableness and propriety of the particulars.<sup>(l)</sup> Where the Court of Appeal reversed the decision of the Court below as to the validity of a patent, and granted a certificate as to some of the particulars of objections, Cotton, L.J., said, in reference to s. 29 of the Act of 1883: "I do not think that the Court of Appeal is the Court pointed at in that section, nor that the judge in the Court of Appeal is the judge pointed at; it must mean the judge of the High Court who hears the matter originally, or a Divisional Court of the High Court. But in the Court of Appeal we ought to make such order as in our opinion the judge who heard the case ought to have made—the judge from whom the appeal is. In this case we thought he ought to have dismissed the action, and then, of course, he ought to have considered what particulars were proven, or reasonable and proper. In our opinion we ought to do that, as he has not done it, and could not do it, having regard to the conclusion at which he arrived. That has really been done in several patent cases which have been before this branch of the Court, and, that being so, we ought in our opinion to grant a certificate stating what particulars were reasonable and proper."<sup>(m)</sup>

The Court of the County Palatine of Lancaster is not a Court, nor is the Vice-Chancellor a judge within the meaning of ss. 6 of s. 29 of the Act of 1883,<sup>(n)</sup> but it must be remembered that his Honour has power over the costs of particulars irrespective of any certificate.<sup>(o)</sup> It is his Honour's practice to certify the particulars in respect of which the parties are to receive costs or otherwise.<sup>(p)</sup>

The above provision as to certificates is only applicable when

Certificate only necessary

(i) Judic. Act, 1873, s. 39; S. C. R. 1883, Ord. XLV. rr. 2, 17, 18; Ord. LV. r. 1.

(k) Rowcliffe v. Morris, 3 P. O. R. 145.

(l) Cole v. Saqui, 6 P. O. R. 41, 45; Humpherson v. Sjer, 4 P. O. R. 416.

(m) Cole v. Saqui, 6 P. O. R. 45.

(n) Proctor v. Sutton Lodge Chemical Co., 5 P. O. R. 184.

(o) Parnell v. Mort, Liddell & Co., L. R. 29; Ch. D. 325; 2 P. O. R. 55; Garnett v. Bradley, L. R. 3 App. Cas. 244.

(p) Cheetham v. Oldham, 7 P. O. R. 124; Horrocks v. Stubbs, 3 P. O. R. 240; Parnell v. Mort, Liddell & Co. L. R. 29 Ch. D. 325; 2 P. O. R. 55; see also 53 & 54 Vict. c. 23, s. 3.

Jurisdiction of Court of Appeal to grant certificate.

Jurisdiction of Vice-Chancellor of County Palatine of Lancaster.



where action  
has proceeded  
to judgment.

there has been an actual trial in Court, but when the action is discontinued, or judgment is allowed to go by default, or the action is dismissed for want of prosecution, no certificates will be given, but the costs of particulars will be dealt with in the ordinary way.(q)

Costs of  
particulars  
not proved.

The question arises whether, when the action is actually brought to a trial, but the case of the plaintiff breaks down on account of the patent being clearly proved to be void, or on an admission of one of the plaintiff's witnesses,(r) or on the evidence offered by the defendant, and the defendant is consequently not afforded an opportunity of proving his particulars, the Court can give a certificate that such particulars were reasonable and proper, and so enable him to obtain the costs of them.(s)

In a case in which the plaintiffs failed in their action on the ground of the invalidity of the patent being established by one of their own witnesses, judgment was given for the defendants without their being called upon to go into their defence, and the judge held that he must decide which of the particulars of objection were reasonable and proper in regard to the case so far as it had gone, and a certificate was granted to the defendant in respect of those particulars only which the judge specifically mentioned. It was also held that the plaintiffs not being entitled to any costs, they were not entitled to any certificate in respect of their particulars of breaches.(t) And where at the trial the plaintiff's case broke down on account of his first witness in cross-examination being unable to distinguish the alleged invention from a previous specification, and the action was accordingly dismissed, the defendant was allowed a certificate which was limited to the particulars involved in the decision of the Court.(u)

Where a case broke down on account of the impossibility of supporting the first claim of the patent, and the action was

(q) *Batty v Kynock*, L. R. 20 Eq. 632; *Rothwell v. King*, 4 P. O. R. 397; *Greaves v. The Eastern Counties Ry. Co.*, 1 E. & E. 961; 2 S. L. T. Q. B. 290; *Stevens v. Keating*, 1 Mac & G. 659.

(r) *The Germ Milling Co. v. Robinson*, 3 P. O. R. 254.

(s) *Longbottom v. Shaw*, 5 P. O. R. 497; 6 P. O. R. 143.

(t) *The Germ Milling Co. v. Robinson*, 3 P. O. R. 254.

(u) *Griffin v. Feaver*, 6 P. O. R. 396; see also *Albo-carbon Light Co. v. Kidd*, 4 P. O. R. 535; *Oddy v. Smith*, 5 P. O. R. 503; *Slazenger v. Feltham*, 6 P. O. R. 130; *Boyd v. Horrocks*, 6 P. O. R. 152, 162.

dismissed without the defendants being called on, Kay, J., refused to give a certificate with regard to the particulars of objections, but gave costs on the higher scale and liberty to apply with regard to the costs of the particulars of objections.<sup>(v)</sup> On the other hand, in another case, where the same learned judge at the end of the plaintiff's case intimated that he would not call on the counsel for the defendant, and gave judgment in his favour, he not only refused a certificate in regard to the particulars of objections, but also refused to give liberty to apply.<sup>(x)</sup>

On taxation of the costs in the latter case the Taxing Master allowed the costs relating to or governed by the defendant's particulars, including the costs of the witnesses, but the judge, on summons, varied the Master's order by disallowing those costs, on the ground that the words of the Act are precise, and that as no certificate had been granted at the trial, they could not be allowed.<sup>(y)</sup> Kay, J., in giving his decision, said: "There might well be a case where the matter was decided against the plaintiff without calling upon the defendant's counsel, and yet the Court, relying upon the evidence obtained by the defendant by cross-examining the witnesses, might think it right to look at the particulars of objections, and allow the costs of such particulars as were in fact made out by the cross-examination. I can quite understand that case occurring, and therefore I do not say that there might not be in such a case as this, or in a similar case, like that which I have just described, propriety in the Court looking into the particulars of objections, and saying whether they were reasonable or not, having regard to the specification."<sup>(z)</sup>

The Court of Appeal, when it can dispose of an action on one point—*e.g.*, the issue of infringement—will not hear the case further for the purpose of deciding whether the particulars were reasonable or not.<sup>(a)</sup>

<sup>(v)</sup> Rowcliffe *v.* The Longford Wire, Iron, and Steel Co., 4 P. O. R. 281, 288. 510; Garrard *v.* Edge, 6 P. O. R. 372, 563; 7 P. O. R. 139.  
<sup>(x)</sup> Longbottom *v.* Shaw, 5 P. O. R. 497, 502. <sup>(z)</sup> 6 P. O. R. 513.  
<sup>(y)</sup> Longbottom *v.* Shaw, 6 P. O. R. <sup>(a)</sup> Boyd *v.* Horrocks, 6 P. O. R. 162; Longbottom *v.* Shaw, 6 P. O. R. 143.



Effect of certificate of Court or a judge that patent is valid.

It is provided by the Act of 1883 that 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.(b)

Jurisdiction of Court or a judge to grant certificate of validity in action to restrain threats,

As we have seen (c), the validity of the patent may be called in question in an action brought to restrain the continuance of threats of proceedings in respect of infringements, but it is doubtful whether a certificate can be given in such an action under the above power. One judge has stated that, though an action to restrain threats, in which the validity of the patent is put in issue, is in substance an action for infringement, yet it is only so in substance and not in form. It is not an action for infringement within the meaning of the Patent Act, 1883, and the Court is, therefore, not in a position to give any certificate.(d) And another judge, in a similar case, whilst expressing great doubt as to whether he had jurisdiction to give a certificate, thought the safer course was to grant it without prejudice to its validity, if it should come into operation.(e)

or on the hearing of petition for revocation.

Under the Act of 1852, which authorised the grant of a certificate that the validity of the patent had been questioned, and provided that in a subsequent (f) suit or action touching such patent a plaintiff might recover treble costs if he was successful, it was enacted that such certificate might be given in evidence in any proceeding by *scire facias* to repeal the patent.(g) It is to be observed, however, that there is no corresponding provision made by the Act of 1883 or any subsequent Act with regard to the certificate in reference to a petition for revocation of the patent, which is the modern substitute for the proceeding by *scire facias*.(h)

(b) 46 & 47 Vict. c. 57, s. 31. For forms of Certificate see Seton, 4th ed. p. 1661; Pemberton, 4th ed. p. 482.

(c) p. 386 ante.

(d) Kurtz v. Spence, 5 P. O. R. 161, 184.

(e) Crampton v. The Patents Investment Co., 5 P. O. R. 382, 404.

(f) Bovill v. Hadley, 17 C. B. N. S. 435.

(g) 15 & 16 Vict. c. 83, s. 43.

(h) p. 341 ante.

Where a defendant by his pleadings denied the validity of the patent, but did not appear at the trial, Kay, J., holding that the 31st s. of the Act of 1883 only applied when the patent is established in a case contested in Court, refused to grant a certificate; but (i) Kekewich, J., under similar circumstances, in the absence of authority to the contrary, granted the certificate, (k) and pointed out that if a defendant, by non-appearance at the trial, could deprive a successful plaintiff of the right to a certificate as to the validity of the patent, the plaintiff might be put to the trouble of proving it all over again. Where a certificate of validity has been granted in a previous action, it will not be granted again at the conclusion of a subsequent action. (l)

Certificate of validity when defendant does not appear.

It is submitted that the Court of Appeal, if it reverses a decision of the Court below against the patent, has power to grant a certificate that the validity has come in question. It is the duty of the Court of Appeal to make such order as the judge who heard the case ought to have made, and, in the event of the Court of Appeal reversing the decision below on the question of validity, it is presumed that a certificate would be granted, on the ground that the finding should have been the other way. (m)

Jurisdiction of Court of Appeal to grant certificate of validity.

Should the Court of Appeal not grant the certificate, application for one may be made to the judge of the Court below who tried the case, (n) and in one instance the Court of Appeal granted no certificate, but gave the appellant leave to apply to the judge below. (o)

The Court of the County Palatine of Lancaster is not a Court within the meaning of the Act of 1883, (p) but it is submitted that the Chancery of Lancaster Act 1890, (q) gives power to the Vice-Chancellor, or the Court of Appeal on appeal from his judgment, to grant a certificate entitling the plaintiff to solicitor and client's costs if successful in a subsequent action.

Jurisdiction of Vice-Chancellor of County Palatine of Lancaster to grant certificate of validity.

If a certificate that the validity of the patent was called in

Omission to ask for certificate of validity at the trial.

(i) *Peroni v. Hudson*, 1 P. O. R. 261, 263; *Stocker v. Rodgers*, 1 Car. & K. 99.

(k) *Haydock v. Bradbury*, 4 P. O. R. 74.

(l) *Edison v. Holland*, 6 P. O. R. 287.

(m) S. C. R. 1883 Ord. LVIII. r. 4;

*Cole v. Saqui*, 6 P. O. R. 45; *Humpherson v. Syer*, 4 P. O. R. 416.

(n) *Cropper v. Smith*, 2 P. O. R. 61.

(o) *Otto v. Linford*, 46 L. T. N. S. 35.

(p) *Proctor v. Sutton Lodge Chemical Co.*, 5 P. O. R. 184.

(q) 53 & 54 Vict. c. 23, 3.



question is not asked for at the trial, it may probably be obtained by subsequent summons in Chambers(*r*), or on motion in Court (Rowcliffe *v.* Morris, P. O. R. 145).

No appeal from decision to grant or refuse certificate of validity.

If a certificate be granted there is no appeal, as it is not a judgment or order against which an appeal lies.(*s*)

It seems that the grant of a certificate is discretionary in the Court or judge.(*t*)

But in a case in which the result of the judgment was that the patent was invalid as regarded one claim, but that if the specification could be amended by omitting that claim, the patent would be valid as to the remainder, Stephen, J., granted certificate that the validity had come in question, but made no reference to the finding on the point, and his lordship stated that he could not refuse to certify the fact of the validity having been questioned.(*u*)

It was held under the Act of 1835 that no certificate ought to be given when no evidence on the question of validity was offered, and the judgment was entered for the plaintiff by consent; (*v*) but where the defendant offered evidence against the novelty of the invention, which failed, and was prevented from offering further evidence affecting the validity of the patent on other grounds, it was held that a certificate ought to be given.(*y*)

Meaning of subsequent action.

An action commenced but not determined at the time a certificate in another action is obtained, is not a subsequent action for infringement within the meaning of s. 31 of the Act of 1883, and the plaintiff cannot claim solicitor and client costs on the production of the certificate and record of the first determined action.(*z*)

Under the Act 1852 the order on a motion for a new trial of an action subsequent to one in which a certificate of validity had been obtained was held not to be a "decree, decretal order, or final judgment," and the plaintiff was not entitled to full

(*r*) Judic. Act, 1873, s. 39; S. C. R. 1883.

(*s*) Haslam *v.* Hall, L. R. 20 Q. B. D. 491; 5 P. O. R. 144; Cropper *v.* Smith, 2 P. O. R. 63.

(*t*) 46 & 47 Vict. c. 57, s. 31.

(*u*) Haslam *v.* Hall, 5 P. O. R. 28; see Automatic Weighing Machine Co. *v.* Knight, 6 P. O. R. 113, 120.

(*v*) Stocker *v.* Rodgers, 1 Car. & K. 99.

(*y*) Gillett *v.* Wilby, 1 W. P. C. 270.

(*z*) Automatic Weighing Machine Co. *v.* Combined Weighing Machine Co., 6 P. O. R. 120; Automatic Weighing Machine Co. *v.* International Hygienic Society, 6 P. O. R. 480; Penn *v.* Bibby, L. R. 3 Eq. 308; Bovill *v.* Hadley, 17 C. B. N. S. 435.

costs.(a) It is submitted that such an order, or an order on motion to commit for breach of an injunction, would not be a "final order or judgment" within s. 31 of the Act of 1883, and, therefore, under the present practice the plaintiff could not claim solicitor and client's costs, if successful in resisting a motion for a new trial, or obtaining an order for committal for breach of an injunction.(b)

It is to be noticed that the Act of 1883 provides that a plaintiff possessed of a certificate that the validity of his patent has been questioned is in a subsequent action, on obtaining a final order or judgment, to have his costs as between solicitor and client, *unless the Court or a judge trying the action certifies that he ought not to have the same.* Therefore it is left to the discretion of the Court to deprive a successful plaintiff in a subsequent action of his full costs, if it is of opinion that he ought not to have them. The object of the enactment was to prevent patentees being put under the necessity of bringing repeated actions to determine their rights after the patent has been once established. There are many circumstances under which it might be improper that a plaintiff succeeding in a subsequent action should have costs, notably if it is proved that the first action was collusive(c) or vexatious.(d)

Where a certificate as to validity had been obtained in a prior action, Pearson, J., refused to give full solicitor and client costs on the ground that the patent was attacked in the subsequent action on grounds which were not raised in the prior proceedings, but he granted the plaintiff a fresh certificate of validity specifying to what extent the patent had been questioned.(e)

In a case under the Act of 1852, Lord Hatherley, then Vice-Chancellor Page Wood, refused to give solicitor and client costs, on the ground that the former action was not conclusive as to the validity of the patent, for after the plaintiff had obtained the judgment of the House of Lords in his favour, the Court of Queen's Bench directed a new trial, which, however, did

(a) *Bovill v. Goodier*, Griff. L. O. C. 49.

(b) *Spencer v. The Ancoats Vale Rubber Co.*, 6 P. O. R. 46, 48.

(c) *Davenport v. Rylands*, L. R. 1 Eq. 309.

(d) *Proctor v. Sutton Lodge Chemical Works*, 5 P. O. R. 184.

(e) *Otto v. Steel*, 3 P. O. R. 109, 120.



not take place, in consequence of a compromise between the parties.<sup>(e)</sup>

It has been held by Chitty, J., that the fact that a defendant does not deny the validity of the patent, but only disputes the question of infringement, will not induce the Court to deprive the plaintiff of full solicitor and client costs if he hold a certificate that the validity of the patent has been questioned in a prior action ; <sup>(f)</sup> but, on the other hand, it has been held by Charles, J., that a plaintiff holding a certificate that the validity of his patent was questioned in a prior action would not be entitled to full solicitor and client costs in a subsequent action where the only question raised was one of infringement.<sup>(g)</sup>

It is submitted that the latter of these two decisions will be followed, for the intention of s. 31 of the Act of 1883 seems to be to protect patentees from being harrassed by having to support their patents again after they have been contested and declared valid, and not to affect the question of the costs of the issue of infringement where the evidence before the Court is totally distinct from that which was presented in the former action.

Party and party costs.

It is of great importance to litigants who are unsuccessful that they should not be oppressed by having to pay an excessive amount of costs ; and it is a rule that the costs chargeable under a taxation, as between party and party, are only those necessary to enable the adverse party to conduct the litigation ; any charges merely for conducting litigation more conveniently may be called luxuries, and must be paid by the party incurring them.<sup>(h)</sup>

Costs of scientific evidence.

When scientific evidence is necessary, proper fees to experts will be allowed ;<sup>(i)</sup> and an allowance may also be made in respect of the preparation of drawings or models when they are required ;<sup>(k)</sup> but the Court will not order such drawings and

<sup>(e)</sup> *Betts v. De Vitre*, 11 Jur. N. S. 11.  
<sup>(f)</sup> *The United Telephone Co. v. Pattinson*, 6 P. O. R. 140 ; see *Davenport v. Rylands*, L. R. 1 Eq. 302, 308.  
<sup>(g)</sup> *Automatic Weighing Machine Co. v. International Hygienic Society*, 6 P. O. R. 480.  
<sup>(h)</sup> *Smith v. Buller*, L. R. 19 Eq. 475.

<sup>(i)</sup> *Smith v. Buller*, L. R. 19 Eq. 473 ; *Batley v. Kynock*, L. R. 20 Eq. 632 ; *Musgrave v. Hicks*, 3 P. O. R. 49.  
<sup>(k)</sup> *Batley v. Kynock*, L. R. 20 Eq. 632 ; *Musgrave v. Hicks*, 3 P. O. R. 49 ; *Horrocks v. Stubbs*, 3 P. O. R. 221.

models to be given up to the party ordered to pay the costs of them.<sup>(l)</sup>

If the drawings and models are not really necessary, no allowance will be made in respect of them on taxation---*c.g.*, where drawings were only used for the purpose of being affixed to the margin of copies of evidence supplied to counsel, the costs of their preparation were disallowed, although the opposite party had asked for and been supplied with copies of them.<sup>(m)</sup>

Where a plaintiff succeeds in obtaining an inquiry as to damages or an account of profits, and also obtains the general costs of the action, the Court, as a rule, will not give the costs of the inquiry as well as general costs of the action, but will reserve them, in order that the judge before whom the inquiry is directed may have full control over the costs, and see that that they are not unreasonably exaggerated.<sup>(n)</sup>

And where an undertaking and inquiry as to damages is directed on a successful application for an interim injunction, the usual order provides for the costs,<sup>(o)</sup> and they are not generally reserved.<sup>(p)</sup>

In some cases the Court will order that the costs of the shorthand writers' notes of the evidence shall be paid by the losing party. The application should be made at the trial or hearing.<sup>(q)</sup> But such an order will be made only in very exceptional cases.<sup>(r)</sup>

The costs of a shorthand note of a judgment appealed from will generally be allowed by the Court of Appeal.<sup>(s)</sup>

If the party who has been unsuccessful in a patent action enters notice of appeal from the adverse decision of the Court which tried the action, he may obtain an order staying the pro-

Costs of drawings and models.

Costs of inquiry as to damages.

Costs of shorthand note of evidence.

Costs of shorthand note of judgment.

Stay of proceedings on judgment pending appeal.

<sup>(l)</sup> *Horrocks v. Stubbs*, 3 P. O. R. 241.

<sup>(m)</sup> *Smith v. Beetle*, L. R. 19 Eq. 473.

<sup>(n)</sup> *Stark v. Midland Ry. Co.*, L. R. 16 Ch. D. 81; *United Telephone Co. v. Fleming* (2), 3 P. O. R. 282; *Moss v. Malings*, 3 P. O. R. 379; *United Telephone Co. v. Faulkner*, 3 P. O. R. 282 n; *Cole v. Saqui*, 5 P. O. R. 497; *Needham v. Oxley*, *Seton*, 4th ed. p. 353.

<sup>(o)</sup> *Burdett v. Hay*, 4 De G. J. & S.; *Seton*, 4th ed. p. 172.

<sup>(p)</sup> *Rothwell v. King* (No. 2), 4 P. O. B. 76.

<sup>(q)</sup> *Earl De la Warr v. Miles*, L. R. 19, Ch. D. 82.

<sup>(r)</sup> *Kelly v. Bayles*, L. R. 13 Ch. D. 693.

<sup>(s)</sup> *Collyer v. Isaacs*, 45 L. T. 567; 30 W. R. 71; *London and South-Western Ry. Co. v. Groom*, L. R. 20 Ch. D. 589; *Woodward v. Sansom*, 4 P. O. R. 178.



ceedings on the judgment till the hearing and determination of the appeal.<sup>(r)</sup>

The application must in the first instance be made to the Court below and not to the Court of Appeal;<sup>(s)</sup> but if the Court of First Instance refuse to make an order staying proceedings, an application may be made to the Court of Appeal, and an application of this nature is not properly an appeal motion, and need not be brought within twenty-one days after the refusal of the Court below.<sup>(t)</sup>

Costs of application for order to stay proceedings.

Usually the costs of an application for an order to stay proceedings have to be borne by the party making it in any event;<sup>(u)</sup> but sometimes they are made costs in the appeal.<sup>(v)</sup> Where the plaintiffs obtained a judgment granting a perpetual injunction restraining infringement and an account of profits, and the defendant entered an appeal, and moved for an order staying proceedings under the order for an account, the Court thought that, under the circumstances, the proper course was to advance the appeal, but as the plaintiff thereby obtained a benefit, the costs of the application should be costs in the appeal.<sup>(w)</sup>

Costs on the higher scale.

It is provided<sup>(y)</sup> that costs on the higher scale may be allowed either generally in any cause or matter, or as to the costs of any particular application made or business done, in any cause or matter, if on special grounds arising out of the nature and importance, or the difficulty or urgency of the case, the Court or a judge shall, at the trial or hearing, or further consideration of the cause or matter, or at the hearing of any application therein, whether the cause or matter shall or shall not be brought to trial or hearing, or to further consideration (as the case may be), so order; or if the taxing officer, under directions given him for that purpose by the Court or a judge shall think that such allowance ought to be so made upon such special grounds as aforesaid.

<sup>(r)</sup> *Adair v. Young*, L. R. 11 Ch. D. 136; *Woodward v. Sansom*, 3 P. O. R. 366; *Humpherson v. Syer*, 4 P. O. R. 189; *Proctor v. Bennis*, 4 P. O. R. 363; *Otto v. Steel*, 3 P. O. R. 121.

<sup>(s)</sup> *Otto v. Lindford*, L. R. 18 Ch. D. 394; *Cropper v. Smith*, L. R. 24 Ch. D. 305.

<sup>(t)</sup> *Cropper v. Smith*, L. R. 24 Ch. D. 305.

<sup>(u)</sup> *Cooper v. Cooper*, L. R. 2 Ch. D. 493; *Merry v. Nickalls*, L. R. 8 Ch. App. Cas. 205.

<sup>(v)</sup> *Adair v. Young*, L. R. 11 Ch. D. 6.

<sup>(w)</sup> *Adair v. Young*, L. R. 11 Ch. D. 136.

<sup>(y)</sup> S. C. R. 1883, Ord. LXV. r. 9.

Costs on the higher scale may be given by the Court of Appeal, although refused by the Court below; but the Court of Appeal does not usually allow them, there being no special reason for doing so.(z)

Where an action was of a complicated nature, the Court, considering that special industry and learning, and much time and expense had been employed in preparing it for trial, directed the taxing master to allow all or any part of the plaintiff's costs on the higher scale if he thought fit;(a) and costs on the higher scale have been allowed in other cases, on the ground that the case of the successful party has involved a protracted examination of witnesses, the calling of expert evidence, or the preparation of drawings and models.(b)

Where costs on the higher scale have been asked for, on the ground that the defendant submitted to an injunction,(c) or that important questions were raised,(d) or that the defendant did not appear at the trial,(e) they have been refused; and it would appear that the fact that the damages claimed amount to a large sum is not sufficient reason for directing the costs to be taxed on the higher scale.(f)

Where an application is made at the trial for costs on the higher scale which is refused, the question may be reserved till after the taxation, and liberty given to apply, so that the successful party may have an opportunity of showing that he has suffered an injustice, if such be the fact, by the taxation having been made on the lower scale.(g)

(z) *Automatic Weighing Machine Co. v. Knight*, 6 P. O. R. 310.

(a) *Fraser v. Province of Brescia Steam Tramways Co.* 56, L. T. N. S. 771; 3 *Times R.* 587.

(b) *Westinghouse v. L. & Y. Ry. Co.* 1 P. O. R. 103; *Easterbrook, F. G. W. Ry. Co.* 2 P. O. R. 212; *Watling v. Stevens*, 3 P. O. R. 43; *Otto v. Steel*, 3 P. O. R. 120; *Wenham v. May*, 4 P. O. R. 310; *Kaye v. Chubb*, 4 P. O. R.

289; *Ellington v. Clark*, 5 P. O. R. 528.

(c) *Hudson v. Osgerby*, 32 W. R. 566.

(d) *Grafton v. Watson*, 51 L. T. N. S. 141; *Cardiff Steamship Co. v. Barwick*, 53 L. T. N. S. 56.

(e) *Peroni v. Hudson*, 1 P. O. R. 261.

(f) *Spettigue's Trusts*, 32 W. R. 385; *The Horace*, L. R. 9 P. D. 86.

(g) *Crampton v. The Patents Investment Co.* 5 P. O. R. 282, 404.



# APPENDIX.

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## APPENDIX.

### STATUTE OF MONOPOLIES (1623).

[21 JAC. I. c. 3.]

*An Act concerning Monopolies and Dispensations of Penal Laws  
and the Forfeitures thereof.*

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 in print to the whole realm, and to all posterity, that all grants of monopolies, and of the benefit of any penal laws, or of power to dispense with the law, or to compound for the forfeiture, are contrary to your Majesty's laws, which your Majesty's declaration is truly consonant and agreeable to the ancient and fundamental laws of this your realm: And whereas your Majesty was further graciously pleased expressly to command that no suitor should presume to move your Majesty for matters of that nature; yet nevertheless upon misinformations and untrue pretences of public good, many such grants have been unduly obtained, and unlawfully put in execution, to the great grievance and inconvenience of your Majesty's subjects, contrary to the laws of this your realm, and contrary to your Majesty's most royal and blessed intention, so published as aforesaid: For avoiding whereof, and preventing of the like in time to come, 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 and enacted: and be it declared and enacted by authority of this present Parliament, that all monopolies, and all commissions, grants, licences, charters, and letters patents heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working, or using of any thing within this realm, or the dominion of Wales, or of any other monopolies, or of power, liberty, or faculty,

All monopolies,  
&c., shall be  
void.



to dispense with any others, or to give licence or toleration to do use, or exercise anything against the tenor or purport of any law or statute; or to give or make any warrant for any such dispensation, licence, or toleration to be had or made; or to agree or compound with any others for any penalty or forfeitures limited by any statute; or of any grant or promise of the benefit, profit, or commodity of any forfeiture, penalty, or sum of money, that is or shall be due by any statute, before judgment thereupon had: and all proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things whatsoever, any way tending to the instituting, erecting, strengthening, furthering, or countenancing of the same or any of them, are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in no wise to be put in use or execution.

Monopolies, &c., shall be tried by the common laws of this realm.

2. And be it further declared and enacted by the authority aforesaid, that all monopolies, and all such commissions, grants, licences, charters, letters patents, proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things tending as aforesaid, and the force and validity of them, and of every of them, ought to be and shall be for ever hereafter examined, heard, tried, and determined, by and according to the common laws of this realm, and not otherwise.

All persons disabled to use monopolies, &c.

3. 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, use, exercise, or put in use any monopoly, or any such commission, grant, licence, charter, letters patents, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, or any liberty, power, or faculty, grounded or pretended to be grounded upon them, or any of them.

The party grieved by pretext of a monopoly, &c., shall recover treble damages and double costs.

4. And be it further enacted by the authority aforesaid, that if any person or persons at any time after the end of forty days next after 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, licence, power, liberty, faculty, letters patents, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, and will sue to be relieved in or for any of the premises, that then and in every such case, the same person and persons shall and may have his and their remedy for the same at

the common law, by any action or actions to be grounded upon this statute; the same action and actions to be heard and determined in the Courts of King's Bench, Common Pleas, and Exchequer, or in any of them, against him or them by whom he or they shall be so hindered, grieved, disturbed or disquieted, or against him or them by whom his or their goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained; wherein all and every such person and persons which shall be so hindered, grieved, disturbed, or disquieted, or whose goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained, shall recover three times so much as the damages which he or they sustained by means or occasion of being so hindered, grieved, disturbed, or disquieted, or by means of having his or their goods or chattels seized, attached, distrained, taken, carried away, or detained, and double costs; and in such suits, or for the staying or delaying thereof, no essoin, protection, wager of law, aidprayer, privilege, injunction, or order of restraint, shall be in any wise prayed, granted, admitted, or allowed, nor any more than one imparlance: And if any person or persons shall, after notice given, that the action depending is grounded upon this statute, cause or procure any action at the common law, grounded upon this statute, to be stayed or delayed before judgment, by colour or means of any order, warrant, power, or authority, save only of the court wherein such action as aforesaid shall be brought and depending, or after judgment had upon such action, shall cause or procure the execution of or upon any such judgment to be stayed or delayed by colour or means of any order, warrant, power, or authority, save only by writ of error or 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 King Richard the Second.

He that delayeth an action grounded upon this statute incurs a *præmunire*.

16 Rich. II.  
c. 5.

5. Provided nevertheless, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patents and grants of privilege for the term of one and twenty years or under heretofore made, of the sole working or making of any manner of new manufacture within this realm, to the first and true inventor or inventors of such manufactures, which others at the time of the making of such letters patents 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

Letters patent to use new manufactures saved.  
*Repealed by Stat. Law Rev. Act, 1863.*



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 patents and grants thereof made, shall be of such force as they were or should have been if the same had been made but for term of one and twenty years only, and as if this Act had never been had or made, and of none other.

Exception of  
future letters  
patent.

6. Provided also, and be it declared and enacted, That any declaration before mentioned shall not extend to any letters patents 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 patents and grants shall not use, so as also they be not contrary to the law, nor mischievous to the State, by raising prices of commodities at home, or hurt of trade, or generally inconvenient: the said fourteen years to be accounted from the date of the first letters patents, or grant of such privilege hereafter to be made, but that the same shall be of such force as they should be if this Act had never been made, and of none other.

Grants con-  
firmed by Act  
of Parliament  
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, or confirmed by any Act of Parliament now in force, so long as the same shall so continue in force.

Warrants  
granted to  
justices saved.

8. Provided also, That this Act shall not extend to any warrant or privy seal, made or directed, or to be made or directed by his Majesty, his heirs, or successors, to the justices of the Courts of the King's Bench or Common pleas, and Barons of the exchequer, justices of assize, justices of oyer and terminer and gaol delivery, justices of the peace, and other justices for the time being, having power to hear and determine offences done against any penal statute, to compound for the forfeitures of any penal statute, depending in suit and question before them or any of them respectively, after plea pleaded by the party defendant.

Charters  
granted to  
corporations  
saved.

9. Provided also, 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 patents, to them or any of them made or granted, or for or concerning any custom or customs used by or within them or any of them: or unto any 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 effects 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.(a)

(a) The remaining sections of this Act have been repealed and are, therefore, not printed here.



PATENTS, DESIGNS, AND TRADE MARKS  
ACT, 1883.

[46 & 47 VICT. c. 57.]

*An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks. [25th August 1883.]*

[N.B.—The portions of this Act which have been amended or repealed by subsequent Acts are printed in italics, and a reference is given to the amending or repealing Act in each case.]

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.
- Division of Act into parts.      2. This Act is divided into four parts, as follows :
- Part I.—PRELIMINARY.  
Part II.—PATENTS.  
Part III.—DESIGNS.  
Part IV.—TRADE MARKS.  
Part V.—GENERAL.
- Commence-ment 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.*

4. (1.) Any person, whether a British subject or not, may make an application for a patent. Persons entitled to apply for patent.

(2.) Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly.<sup>(a)</sup>

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.<sup>(b)</sup>

(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.<sup>(c)</sup>

(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 has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the* *Power for comptroller to refuse application or require amendment.*

(a) See 48 & 49 Vict. c. 63, s. 5, p. 573 *post*.  
 (b) See 48 & 49 Vict. c. 63, s. 2, p. 572 *post*.  
 (c) See 49 & 50 Vict. c. 37, s. 2, p. 574 *post*.



*invention, the comptroller may require that the application, specification, or drawings be amended before he proceeds with the application.*

*(2.) Where the comptroller requires an amendment, the applicant may appeal from his decision to the law officer.*

*(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the application shall be accepted.*

*(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.(d)*

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.(e)

(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.

(d) See 51 & 52 Vict. c. 50, s. 2, p. 576 *post*.

(e) See 48 & 49 Vict. c. 62, s. 3, p. 572 *post*.

(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.(f)

(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*.(g) 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, but on no other ground*.(h) Opposition to grant of patent.

(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,

(f) See 48 & 49 Vict. c. 63, s. 3, p. 572 *post*.

(g) See 48 & 49 Vict. c. 63, s. 3, p. 572 *post*.

(h) See 51 & 52 Vict. c. 50, s. 4, p. 577 *post*.



entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made.

(4.) The law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer, with the consent of the Treasury, shall appoint.

Sealing of  
patent.

12. (1.) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, the comptroller shall cause a patent to be sealed with the seal of the Patent Office.

(2.) A patent so sealed shall have the same effect as if it were sealed with the Great Seal of the United Kingdom.

(3.) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, except in the cases hereinafter mentioned, that is to say—

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

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

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.<sup>(k)</sup>

#### *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

(i) See 48 & 49 Vict. c. 63, s. 3, p. 572 *post*.

(k) See 48 & 49 Vict. c. 63, s. 4, p. 573 *post*.

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.*

16. Every patent when sealed shall have effect throughout the United Kingdom and the Isle of Man. Extent of patent.

17. (1.) The term limited in every patent for the duration thereof shall be fourteen years from its date. Term of patent.

(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 specification.

(2.) The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one



month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

(3.) Where such notice is given the comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer.

(4.) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(5.) Where no notice of opposition is given, or the person so giving notice does not appear, the comptroller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(6.) When leave to amend is refused by the comptroller, the person making the request may appeal from his decision to the law officer.

(7.) The law officer shall, if required, hear the person making the request and the comptroller, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed.

(8.) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before amendment.

(9.) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall in all Courts and for all purposes be deemed to form part of the specification.

(10.) *The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending.*(l)

Power to disclaim part of invention during action, &c.

19. (1.) In an action for infringement of a patent, and in a proceeding for revocation of a patent, the Court or a judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the Court or a judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed.

(l) See 51 & 52 Vict. c. 50, s. 5, p. 577 *post*.

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.

Restriction  
on recovery  
of damages.

21. Every amendment of a specification shall be advertised in the prescribed manner.

Advertis-  
ment of  
amendment.

#### *Compulsory 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—

Power for  
Board to  
order grant  
of licences.

(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 transmission 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 primâ facie evidence of any matters by this Act directed or authorised 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.*

Fee in  
schedule.

24. (1.) There shall be paid in respect of the several instruments described in the second schedule to this Act, the fees in that schedule mentioned, and there shall likewise be paid, in respect of other matters under this part of the Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of her Majesty's Exchequer in such manner as the Treasury may from time to time direct.

(2.) The Board of Trade may from time to time, if they think fit, with the consent of the Treasury, reduce any of those fees.

*Extension of Term of Patent.*

Extension  
of term of  
patent on  
petition to  
Queen in  
Council.

25. (1.) A patentee may, after advertising in manner directed by any rules made under this section his intention to do so, present a petition to her Majesty in Council, praying that his patent may be extended for a further term; but such petition must be presented at least six months before the time limited for the expiration of the patent.

(2.) Any person may enter a caveat, addressed to the Registrar of the Council at the Council Office, against the extension.

(3.) If her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same, and the petitioner and any person who has entered a caveat shall be entitled to be heard by himself or by counsel on the petition.

(4.) The Judicial Committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

(5.) If the Judicial Committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for her Majesty in Council to extend the term of the patent for a further term not exceeding seven, or in exceptional cases fourteen, years; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee may think fit.

(6.) It shall be lawful for her Majesty in Council to make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be

regulated according to the existing procedure and practice in patent matters of the Judicial Committee.

(7.) The costs of all parties of and incident to such proceedings shall be in the discretion of the Judicial Committee; and the orders of the Committee respecting costs shall be enforceable as if they were orders of a division of the High Court of Justice.

*Revocation.*

26. (1.) The proceeding by *scire facias* to repeal a patent is hereby abolished. Revocation of patent.

(2.) Revocation of a patent may be obtained on petition to a 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 authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland :

(c.) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims :

(d.) Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee :

(e.) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

(5.) The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the Court or a judge, be admitted in proof of any objection of which particulars are not so delivered.

(6.) Particulars delivered may be from time to time amended by leave of the Court or a judge.

(7.) The defendant shall be entitled to begin, and give evidence in support of the patent, and if the plaintiff gives evidence im-



peaching the validity of the patent the defendant shall be entitled to reply.

(8.) Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.

#### *Crown.*

Patent to  
bind Crown.

27. (1.) A patent shall have to all intents the like effect as against her Majesty the Queen, her heirs and successors, as it has against a subject.

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

#### *Legal Proceedings.*

Hearing with  
assessor.

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

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

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

Delivery of  
particulars.

29. (1.) In an action for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the Court or the judge, at any subsequent time, particulars of the breaches complained of.

(2.) The defendant must deliver with his statement of defence, or

by order of the Court or a judge, at any subsequent time, particulars of any objections on which he relies in support thereof.

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

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

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

(6.) On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a judge to have been proven or to have been reasonable and proper, without regard to the general costs of the case.

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

*Remedy in case of groundless threats of legal proceedings.*



due diligence commences and prosecutes an action for infringement of his patent.

*Miscellaneous.*

Patent for one invention only.

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

Patent on application of representative of deceased inventor.

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

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

Patent to first inventor not invalidated by application in fraud of him.

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

Assignment for particular places.

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

Loss or destruction of patent.

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

Proceedings and costs before law officer.

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

Exhibition at industrial or international exhibition not 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.<sup>(m)</sup>

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. Publication of illustrated journal, indexes, &c.

(2.) Provision shall be made by the comptroller for keeping on sale copies of such journal, and also of all complete specifications 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 require 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 Foreign vessels in British waters.

(m) See 49 & 50 Vict. c. 37, s. 3, p. 574 *post*.



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 authorise subjects of such foreign State, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign State, or in the waters within the jurisdiction of its Courts, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign State.

Assignment to  
Secretary for  
War of certain  
inventions

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

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

(3.) Where any such assignment has been made to the Secretary of State, he may at any time before the application for a patent for the invention, or before publication of the specification or specifications, certify to the comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

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

(5.) Such packet shall until the expiration of the term or extended

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

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

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

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

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

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

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

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



*Existing Patents.*

Provisions  
respecting  
existing  
patents.

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

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

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

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

*Definitions.*

Definitions  
of patent,  
patentee, and  
invention.

46. In and for the purposes of this Act—

“ Patent ” means letters patent for an invention :

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

“ Invention ” means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, entitled “ 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.



Marking  
registered  
designs.

51. Before delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark, or with the prescribed word or words, or figures, denoting that the design is registered; and if he fails to do so the copyright in the design shall cease, unless the proprietor shows that he took all proper steps to ensure the marking of the article.

Inspection of  
registered  
designs.

52. (1.) During the existence of copyright in a design, the design shall not be open to inspection except by the proprietor, or a person authorised in writing by the proprietor, or a person authorised by the comptroller or by the Court, and furnishing such information as may enable the comptroller to identify the design, nor except in the presence of the comptroller, or of an officer acting under him, nor except on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof.<sup>(n)</sup>

(2.) When the copyright in a design has ceased, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.

Information as  
to existence  
of copyright.

53. On the request of any person producing a particular design, together with its mark of registration, or producing only its mark of registration, or furnishing such information as may enable the comptroller to identify the design, and on payment of the prescribed fee, it shall be the duty of the comptroller to inform such person whether the registration still exists in respect of such design, and if so, in respect of what class or classes of goods, and stating also the date of registration, and the name and address of the registered proprietor.

Cesser of  
copyright in  
certain  
events.

54. If a registered design is used in manufacture in any foreign country and is not used in this country within six months of its registration in this country, the copyright in the design shall cease.

#### *Register of Designs.*

Register of  
designs.

55. (1.) There shall be kept at the Patent Office a book called the Register of Designs, wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may from time to time be prescribed.

(2.) The register of designs shall be *primâ facie* evidence of any matters by this Act directed or authorised to be entered therein.

(n) 51 & 52 Vict. c. 50, s. 6, p. 578 *post*.

*Fees.*

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.

Fees on registration, &c.

*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.<sup>(o)</sup>

*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

(o) 49 & 50 Vict. c. 37, s. 3, p. 574 *post*.



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.<sup>(p)</sup>

Action for damages.

59. Notwithstanding the remedy given by this Act for the recovery of such penalty as aforesaid, the registered proprietor of any design may (if he elects to do so) bring an action for the recovery of any damages arising from the application of any such design, or of any fraudulent or obvious imitation thereof for the purpose of sale, to any article of manufacture or substance, or from the publication, sale, or exposure for sale by any person of any article or substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, such person knowing that the proprietor had not given his consent to such application.

*Definitions.*

Definition of "design," "copyright."

60. In and for the purposes of this Act—

"Design" means any design applicable to any article of manufacture, or to any substance artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for a sculpture, or other thing within the protection of the Sculpture Copyright Act of the year 1814 (fifty-fourth George the Third, chapter fifty-six).

"Copyright" means the exclusive right to apply a design to any article of manufacture or to any such substance as aforesaid in the class or classes in which the design is registered.

Definition of proprietor.

61. The author of any new and original design shall be considered the proprietor thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor, and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person or otherwise, and also every person on whom the property in such design or such right to the application thereof shall devolve, shall

(p) 49 & 50 Vict. c. 37, s. 3, p. 574 *post*.

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.*(*q*)

(3.) The application must be accompanied by the prescribed number of representations of the trade mark, and must state the particular goods or classes of goods in connection with which the applicant desires the trade mark to be registered.

(4.) The comptroller may, if he thinks fit, refuse to register a trade mark, but any such refusal shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(5.) The Board of Trade may, however, if it appears expedient refer the appeal to the Court; and in that event the Court shall have jurisdiction to hear and determine the appeal and may make such order as aforesaid.(*q*)

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.*(*r*) 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:* Conditions of registration of trade mark.

(a.) *A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or*

(b.) *A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or,*

(*q*) See 51 & 52 Vict. c. 50, s. 8, p. 578 *post*.

(*r*) See 51 & 52 Vict. c. 50, s. 9, p. 578 *post*.



(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.(s)*

Connection of trade mark with goods.

65. A trade mark must be registered for particular goods or classes of goods.

Registration of a series of marks.

66. When a person claiming to be the proprietor of several trade marks which, while resembling each other in the material particulars thereof, yet differ in respect of (a) the statement of the goods for which they are respectively used or proposed to be used, or (b) statements of numbers, or (c) statements of price, or (d) statements of quality, or (e) statements of names of places, seeks to register such trade marks, they may be registered as a series in one registration. A series of trade marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade marks composing a series shall be deemed and treated as registered separately.

Trade marks may be registered in any colour.

67. A trade mark may be registered in any colour,(t) 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.(t)

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.(u)

Opposition to registration.

69. (1.) Any person may within *two months (v)* of the *first (v)* 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 (w)* 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

(s) See 51 & 52 Vict. c. 50, s. 10, p. 578 *post*.

(t) See 51 & 52 Vict. c. 50, s. 11, p. 579 *post*.

(u) See 51 & 51 Vict. c. 50, s. 12, p. 579 *post*.

(v) See 51 & 52 Vict. c. 50, s. 13, ss. 1 & 2, p. 579 *post*.

(w) See 51 & 52 Vict. c. 50, s. 13, ss. 3, p. 579 *post*.

on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

(3.) *If the applicant sends such counter statement, the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall require him to give security in such manner and to such amount as the comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made or such further time as the comptroller may allow, the opposition shall be deemed to be withdrawn.*(x)

(4.) *If the person who gave notice of opposition duly gives such security as aforesaid, the comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court.*(x)

70. A trade mark, when registered, shall be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill. Assignment and transmission of trade mark.

71. Where each of several persons claims to be registered as proprietor of the same trade mark, the comptroller may refuse to register any of them until their rights have been determined according to law, and the comptroller may himself submit or require the claimants to submit their rights to the Court. Conflicting claims to registration.

72. (1.) Except where the Court has decided that two or more persons are entitled to be registered as proprietors of the same trade mark, the comptroller shall not register in respect of the same goods or description of goods a trade mark identical with the one already on the register with respect to such goods or description of goods. Restrictions on registration.

(2.)(y) The comptroller shall not register with respect to the same goods or description of goods a trade mark *so nearly resembling* (y) a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive.

73. It shall not be lawful to register as part of or in combination with a trade mark any words the exclusive use of which would by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a Court of justice, or any scandalous design. Further restriction on registration.

74. (1.) Nothing in this Act shall be construed to prevent the Saving for power to

(x) See 51 & 52 Vict. c. 50, s. 13, ss. 4, p. 579 *post*.

(y) See 51 & 52 Vict. c. 50, s. 14, p. 580 *post*.



provide for entry on register of common marks as additional to trade marks.

comptroller entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade mark—

(a.) In the case of an application for registration of a trade mark used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures, though the same is common to the trade in the goods with respect to which the application is made ;

(b.) In the case of an application for registration of a trade mark not used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made ;

(2.) *The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register.*(z)

(3.) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or were, before the thirteenth day of August one thousand eight hundred and seventy-five, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods.

*Effect of Registration.*

Registration equivalent to public use.

75. *Registration of a trade mark shall be deemed to be equivalent to public use of the trade mark.*(a)

Right of first proprietor to exclusive use of trade mark.

76. The registration of a person as proprietor of a trade mark shall be *prima facie* evidence of his right to the exclusive use of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of this Act.

Restrictions on actions for infringement,

77. A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade mark

(z) See 51 & 52 Vict. c. 50, s. 16, p. 580 *post*.  
 (a) See 51 & 52 Vict. c. 50, s. 17, p. 580 *post*.

unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the thirteenth of August one thousand eight hundred and seventy-five, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The comptroller may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused.<sup>(b)</sup>

and on defence  
to action in  
certain cases.

*Register of Trade Marks.*

78. There shall be kept at the Patent Office a book called the Register of Trade Marks, wherein shall be entered the names and addresses of proprietors of registered trade marks, notifications of assignments and of transmissions of trade marks, and such other matters as may be from time to time prescribed.

Register of  
trade marks.

79. (1.) At a time not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade mark, the comptroller shall send notice to the registered proprietor that the trade mark will be removed from the register unless the proprietor pays to the comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee; and if such fee be not previously paid, he shall at the expiration of one month from the date of the giving of the first notice send a second notice to the same effect.

Removal of  
trade mark  
after fourteen  
years unless  
fee paid.

(2.) If such fee be not paid before the expiration of such fourteen years the comptroller may after the end of three months from the expiration of such fourteen years remove the mark from the register, and so from time to time at the expiration of every period of fourteen years.

(3.) If before the expiration of the said three months the registered proprietor pays the said fee together with the additional prescribed fee, the comptroller may, without removing such trade mark from the register, accept the said fee as if it had been paid before the expiration of the said fourteen years.

(4.) Where after the said three months a trade mark has been removed from the register for nonpayment of the prescribed fee, the comptroller may, if satisfied that it is just so to do, restore such trade mark to the register on payment of the prescribed additional fee.

(5.) Where a trade mark has been removed from the register for nonpayment of the fee or otherwise, such trade mark shall never-

(b) See 51 & 52 Vict. c. 50, s. 18, p. 581 *post*.



theless for the purpose of any application for registration during the *five years (c)* next after the date of such removal, be deemed to be a trade mark which is already registered.(c)

*Fees.*

Fees for  
registration,  
&c.

80. There shall be paid in respect of applications and registration and other matters under this part of this Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of her Majesty's Exchequer in such manner as the Treasury may from time to time direct.

*Sheffield Marks.*

Registration  
by Cutlers'  
Company of  
Sheffield  
marks.

81. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company) and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers, and assistants of the company, the following provisions shall have effect:

- (1.) The Cutlers' Company shall establish and keep at Sheffield a new register of trade marks (in this Act called the Sheffield register):
- (2.) *The Cutlers' Company shall enter in the Sheffield register, in respect of cutlery, edge tools, or raw steel and the goods mentioned in the next sub-section all the trade marks entered before the commencement of this Act in respect of cutlery, edge tools, or raw steel, and such goods in the register established under the Trade Marks Registration Act, 1875, belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such register, in respect of the same goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the register established under the Trade Marks Registration Act, 1875.(d)*
- (3.) An application for registration of a trade mark used on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge,(e) shall, if made after the commencement of this Act by a person

(c) See 51 & 52 Vict. c. 50, s. 19, p. 581 *post*.

(d) See 51 & 52 Vict. c. 50, s. 20, ss. 1, p. 581 *post*.

(e) See 51 & 52 Vict. c. 50, s. 20, ss. 2, p. 581 *post*.

carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company :

- (4.) Every application so made to the Cutlers' Company shall be notified to the comptroller in the prescribed manner, and unless the comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner :
- (5.) If the comptroller gives notice of objection as aforesaid the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court :
- (6.) Upon the registration of a trade mark in the Sheffield register the Cutlers' Company shall give notice thereof to the comptroller, who shall thereupon enter the mark in the register of trade marks ; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the comptroller on that day.
- (7.) *The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the register of trade marks, the effect of such registration, and the assignment and transmission of rights in a registered trade mark shall apply in the case of applications and registration in the Sheffield register ; and notice of every entry made in the Sheffield register must be given to the comptroller by the Cutlers' Company, save and except that the provisions of this sub-section shall not prejudice or affect any life, estate, and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register.(f)*
- (8.) Where the comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge,(g)* he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company :
- (9.) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' register

(f) See 51 & 52 Vict. c. 50, s. 20, ss. 3, p. 582 *post*.

(g) See 51 & 52 Vict. c. 50, s. 20, ss. 2, p. 581 *post*.



of corporate trade marks, and thereupon all marks entered therein shall, unless entered in the Sheffield register, be deemed to have been abandoned :

- (10.) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register, as proprietor of two or more trade marks :
- (11.) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of a trade mark or trade marks :
- (12.) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the comptroller, who shall have power to confirm, reverse, or modify the decision, but the decision of the comptroller shall be subject to a further appeal to the Court :
- (13.) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Company Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield register.<sup>(h)</sup>

## PART V.

### GENERAL.

#### *Patent Office and Proceedings thereat.*

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

Patent Office.

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

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

<sup>(h)</sup> See 51 & 52 Vict. c. 50, s. 20, ss. 4, p. 582 *post*.

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

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

Officers and clerks.

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

84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence.

Seal of Patent Office.

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

Trust not to be entered in registers.

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

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

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person be entered as proprietor of the patent, copyright in the design, or trade mark, in the register of patents, designs, or trade marks, as the case may be. The person for the time being entered in the register of patents, designs, or trade marks, as proprietor of a patent, copyright in a design or trade mark as the case may be, shall, subject to (i) any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the same and to give effectual receipts for any consideration for such assignment, licence, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property.

Entry of assignments and transmissions in registers.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to (j) such regu-

Inspection of and extracts from registers.

(i) See 51 & 52 Vict. c. 50, s. 21, p. 582 *post*.

(j) See 51 & 52 Vict. c. 50, s. 22, p. 582 *post*.



lations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

Sealed copies  
to be received  
in evidence.

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

Rectification of  
registers by  
Court.

90. (1.) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person<sup>(k)</sup> from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

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

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

Power for  
comptroller  
to correct  
clerical errors.

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

- (a.) Correct any clerical error in or in connection with an application for a patent, or for registration of a design or trade mark; or
- (b.) Correct any clerical error in the name, style, or address of the registered proprietor of a patent, design, or trade mark.
- (c.) Cancel the entry or part of the entry of a trade mark on the register: Provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark<sup>(l)</sup>.

(k) See 51 & 52 Vict. c. 50, s. 23, p. 582 *post*.

(l) See 51 & 52 Vict. c. 50, s. 24, p. 582 *post*.

92. (1.) The registered proprietor of any registered trade mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

Alteration of registered mark.

(2.) Notice of any intended application to the Court under this section shall be given to the comptroller by the applicant; and the comptroller shall be entitled to be heard on the application.

(3.) If the Court grants leave, the comptroller shall, on proof thereof and on payment of the prescribed fee, cause the register to be altered in conformity with the order of leave.

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

Falsification of entries in registers.

94. Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

Exercise of discretionary power by comptroller.

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.

Power of comptroller to take directions of law officers.

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

Certificate of comptroller to be evidence.

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

Applications and notices by post.

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



Provision  
as to days  
for leaving  
documents at  
office.

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

Declaration  
by infant,  
lunatic, &c.

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

Transmission  
of certified  
printed copies  
of specifica-  
tions, &c.

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

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

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

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

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

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

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

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

102. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him 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 <sup>Annual reports of</sup> ~~of~~ <sup>comptroller.</sup>



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.<sup>(m)</sup>

*International and Colonial Arrangements.*

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

103. (1.) If Her Majesty is pleased to make any arrangement with the Government or Governments of any foreign State or States for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such State, shall be entitled to a patent for his invention or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants; and such patent or registration shall have the same date as the *date of the protection obtained* <sup>(n)</sup> in such foreign State.

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

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

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

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

(4.) The provisions of this section shall apply only in the case of those foreign States with respect to which Her Majesty shall from

<sup>(m)</sup> See 51 & 52 Vict. c. 50, s. 25, p. 583 *post*.

<sup>(n)</sup> See 48 & 49 Vict. c. 63, s. 6, p. 573 *post*.

time to time by Order in Council declare them to be applicable, and so long only in the case of each State as the Order in Council shall continue in force with respect to that State.

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

Provision for colonies and India.

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

#### *Offences.*

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

Penalty on falsely representing articles to be patented.

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

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 unauthorised assumption of Royal arms.

#### *Scotland ; Ireland ; &c.*

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

Saving for Courts in Scotland.



assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those courts.

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

Summary proceedings in Scotland.

108. In Scotland any offence under this Act to be punishable on summary conviction may be prosecuted in the sheriff court.

Proceedings for revocation of patent in Scotland.

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

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

Reservation of remedies in Ireland.

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

General saving for jurisdiction of courts.

111. (1.) The provisions of this Act conferring a special jurisdiction on the court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of the said Court; and with reference to any such proceedings in Ireland, the terms "the Court" and "the Court of Appeal" respectively mean the High Court of Justice in Ireland and Her Majesty's Court of Appeal in Ireland.

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

Isle of Man.

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

(1.) Nothing in this Act shall affect the jurisdiction of the courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those courts;

- (2.) The punishment for a misdemeanor under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court ;
- (3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.(o)

*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.(p)

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

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

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

(o) See 51 & 52 Vict. c. 50, s. 26, p. 583 *post*.  
 (p) See 51 & 52 Vict. c. 50, s. 27, p. 583 *post*.

Repeal and saving for past operation of repealed enactments, &c.

Former registers to be deemed continued.

Saving for existing rules.



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

Saving for prerogative.

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

*General Definitions.*

General definitions.

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

“Person” includes a body corporate:

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

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

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

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

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

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

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

In the application of this Act to Ireland, “summary conviction” means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District the Acts regulating the duties of justices of the peace and of the police

for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.<sup>(q)</sup>

## SCHEDULES.

### THE FIRST SCHEDULE.

#### FORMS OF APPLICATION, &c.

*Form A.(r)*

Form of Application.

*Form B.(r)*

Form of Provisional Specification.

*Form C.(r)*

Form of Complete Specification.

*Form D.*

Form of Patent.

[This form will be found at p. 633 *post.*]

*Form E.*

Form of Application of Registration of Design.

*Form F.*

Form of Application for Registration of Trade Mark.

### THE SECOND SCHEDULE.

#### Fees on instruments for obtaining Patents and Renewal.

These fees are all included in the List of Fees given in the First Schedule to the Patent Rules, 1890; *see* p. 737 *post.*

<sup>(q)</sup> See 51 & 52 Vict. c. 50, s. 1, p. 576 *post.*

<sup>(r)</sup> For forms A, B, and C the Board of Trade have, under the powers conferred by s. 101, sub-s. 2, of the Act, substituted the forms A, A1, A2, B and C, which will be found at pp. 636-643 *post.*



## THE THIRD SCHEDULE.

*Enactments repealed.*

21 James I. c. 3. [1623.]	The Statute of Monopolies. In part; namely,— Sections ten, eleven, and twelve.
5 & 6 Will. IV. c. 62. [1835.] In part.	The Statutory Declarations Act, 1835. In part; namely,— Section eleven.
5 & 6 Will. IV. 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. (a) [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.
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.

(a) *Note.*—Sections six and seven of this Act are repealed by the Statute Law Revision (No. 2) Act, 1874.

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 section 65.”
38 & 39 Vict. c. 91. [1875]	The Trade Marks Registration Act, 1875.
38 & 39 Vict. c. 93. [1875.]	The Copyright of Designs Act, 1875.
39 & 40 Vict. c. 33. [1876.]	The Trade Marks Registration Amendment Act, 1876.
40 & 41 Vict. c. 37. [1877.]	The Trade Marks Registration Extension Act, 1877.
43 & 44 Vict. c. 10. [1880.]	The Great Seal Act, 1880. In part ; namely,— Section five.
45 & 46 Vict. c. 72. [1882.]	The Revenue, Friendly Societies, and National Debt Act, 1882. In part ; namely,— Section sixteen.



PATENTS, DESIGNS, &c., AMENDMENT ACT, 1885.

48 & 49 VICT. c. 63.

*An Act to amend the Patents, Designs, and Trade Marks Act, 1883.*

[14th August 1885.]

BE it enacted by the Queen's Most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :

Construction  
and short  
title.

1. This Act shall be construed as one with the Patents, Designs, and Trade Marks Act, 1883 (in this Act referred to as the principal Act).

This Act may be cited as the Patents, Designs, and Trade Marks (Amendment) Act, 1885, and this Act and the principal Act may be cited together as the Patents, Designs, and Trade Marks Acts, 1883 and 1885.

Amendment  
of s. 5 of  
46 & 47 Vict.  
c. 57.

2. Whereas sub-section two of section five of the principal Act requires a declaration to be made by an applicant for a patent to the effect in that sub-section mentioned, and doubts have arisen as to the nature of that declaration, and it is expedient to remove such doubts; be it therefore enacted that :

5 & 6 W. IV.  
c. 62.

The declaration mentioned in sub-section two of section five of the principal Act may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed.

Amendment  
of ss. 8, 9,  
and 12 of  
46 & 47 Vict.  
c. 57.

3. Whereas under the principal Act, a complete specification is required (by section eight) to be left within nine months, and (by section nine) to be accepted within twelve months, from the date of application, and a patent is required by section twelve to be sealed within fifteen months from the date of application, and it is expedient to empower the comptroller to extend in certain cases the said times; be it therefore enacted as follows :

A complete specification may be left and accepted within such extended times, not exceeding one month and three months respectively after the said nine and twelve months respectively as the

comptroller may on payment of the prescribed fee allow, and where such extension of time has been allowed, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act.

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

Specifications, &c., not to be published unless application accepted.

5. Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor; be it therefore enacted and declared that it has been and is lawful under the principal Act to grant such a patent.

Power to grant patents to several persons jointly.

6. In sub-section one of section one hundred and three of the principal Act, the words "date of the application" shall be substituted for the words "date of the protection obtained."

Amendment of s. 103 of 46 & 47 Vict. c. 57.



PATENTS ACT, 1886.

49 & 50 VICT. c. 37.

*An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions. [25th June 1886.]*

46 & 47 Vict.  
c. 57.

WHEREAS by section five of the Patents, Designs, and Trade Marks Acts, 1883, specifications, whether provisional or complete, must be accompanied by drawings, if required, and doubts have arisen as to whether it is sufficient that a complete specification refers to the drawings by which the provisional specification was accompanied, and it is expedient to remove such doubts :

Be it therefore enacted by the Queen's Most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :

Short title and  
construction.  
46 & 47 Vict.  
c. 57.  
48 & 49 Vict.  
c. 63.

1. This Act may be cited as the Patents Act, 1886, and shall be construed as one with the Patents, Designs, and Trade Marks Acts, 1883 and 1885, and, together with those Acts, may be cited as the Patents, Designs, and Trade Marks Acts, 1883 to 1886.

The same  
drawings may  
accompany  
both speci-  
fications.

2. The requirement of sub-section four of section five of the Patents, Designs, and Trade Marks Act, 1883, as to drawings, shall not be deemed to be insufficiently complied with by reason only that, instead of being accompanied by drawings, the complete specification refers to the drawings which accompanied the provisional specification. And no patent heretofore sealed shall be invalid by reason only that the complete specification was not accompanied by drawings, but referred to those which accompanied the provisional specification.

Protection  
of patents  
and designs  
exhibited at  
international  
exhibitions.

3. Whereas by section thirty-nine of the Patents, Designs, and Trade Marks Act, 1883, as respects patents, and by section fifty-seven of the same Act as respects designs, provision is made that the exhibition of an invention or design at an industrial or international exhibition, certified as such by the Board of Trade, shall not preju-

dice the rights of the inventor or proprietor thereof, subject to the conditions therein mentioned, one of which is that the exhibitor must, before exhibiting the invention, design, or article, or publishing a description of the design, give the comptroller the prescribed notice of his intention to do so :

And whereas it is expedient to provide for the extension of the said sections to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows :

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



PATENTS, DESIGNS, AND TRADE MARKS ACT,  
1888.

51 & 52 VICT. c. 50.

*An Act to amend the Patents, Designs, and Trade Marks Act, 1883.*  
[24th December 1888.]

46 & 47 Vict.  
c. 57.

WHEREAS it is expedient to amend the Patents, Designs, and Trade Marks Act, 1883, hereinafter referred to as the principal Act :

Be it therefore enacted by the Queen's Most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :

Register of  
patent agents.

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

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

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

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

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

s. 7, as to  
applications.

2. For section seven of the principal Act the following section shall be substituted, namely :

“7. (1.) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject matter of the invention, the comptroller may refuse to accept the application, or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with.”

Amendments of 46 & 47 Vict. c. 57. s. 7, as to applications.

“(2.) Where the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision, to the law officer.

“(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions (if any) the application shall be accepted.

“(4.) The comptroller shall, when an application has been accepted, give notice thereof to the applicant.

“(5.) If, after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made, accompanied by a specification bearing the same or a similar title, the comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon.”

3. In sub-section five of section nine of the principal Act the words “other than an appeal to the law officer under this Act” shall be omitted.

s. 9, as to disclosure of reports of examiners.

4. In sub-section one of section eleven of the principal Act the words from “or on the ground of an examiner” to “a previous application,” both inclusive, shall be omitted, and there shall be added in lieu thereof the following words, namely, “or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification.”

s. 11, as to opposition to grant of patent.

5. For sub-section ten of section eighteen of the principal Act the following sub-section shall be substituted, namely:

s. 18, as to amended specifications.

“(10.) The foregoing provisions of this section do not apply when



and so long as any action for infringement or proceeding for revocation of a patent is pending.”

s. 52, as to inspection of designs.

6. After sub-section one of section fifty-two of the principal Act the following words shall be added; namely:

“Provided that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered.

s. 58, as to piracy of registered designs.

7. (1.) In section fifty-eight of the principal Act the words “or cause to be applied” shall be added after the word “apply.”

(2.) To the same section the following words shall be added: “Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds.”

s. 62, as to application for registration.

8. (1.) In sub-section two of section sixty-two of the principal Act for the words “the patent office in the prescribed manner” shall be substituted the words “such place and in such manner as may be prescribed.”

(2.) To the same section of the principal Act the following sub-section shall be added:

“(6.) Where an applicant for the registration of a trade mark otherwise than under an international convention is out of the United Kingdom at the time of making the application he shall give the comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given.

s. 63, as to limit of time for proceeding with application.

9. In section sixty-three of the principal Act for the words “the application shall be deemed to be abandoned” shall be substituted the words “the comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and, if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned.”

s. 64, as to fancy words.

10. (1.) For section sixty-four of the principal Act the following section shall be substituted, namely:

“64. (1.) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:

“(a.) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

“(b.) A written signature or copy of a written signature of the

individual or firm applying for registration thereof as a trade mark; or

“(c.) A distinctive device, mark, brand, heading, label, or ticket; or

“(d.) An invented word or invented words; or

“(e.) A word or words having no reference to the character or quality of the goods, and not being a geographical name.

“(2.) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

“(3) Provided as follows :

“(i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof :

“(ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act.”

11. In section sixty-seven of the principal Act the words “or colours” shall be added after the word “colour” in each place where that word occurs. s. 67, as to colours of trade marks.

12. In section sixty-eight of the principal Act after the word comptroller shall be added the words “unless the comptroller refuse to entertain the application.” s. 68, as to advertisement of applications.

13. (1.) In sub-section one of section sixty-nine of the principal Act for the words “two months” shall be substituted the words “one month or such further time, not exceeding three months, as the comptroller may allow.” s. 69, as to opposition to registration.

(2.) In the same sub-section the word “first” shall be omitted.

(3.) In sub-section two of the same section for the words “two months” shall be substituted the words “one month.”

(4.) For sub-sections three and four of the same section the following sub-sections shall be substituted, namely—



“(3.) If the applicant sends such counter-statement the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the comptroller, and may make an order determining whether, and subject to what conditions (if any) registration is to be permitted.

“(4.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court, and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.

“(5.) If the applicant abandons his application after notice of opposition in pursuance of this section, he shall be liable to pay to the opponent such costs in respect of the opposition as the comptroller may determine to be reasonable.

“(6.) Where the opponent is out of the United Kingdom he shall give the comptroller an address for service in the United Kingdom.”

s. 72, as to  
restrictions on  
registration.

14. In sub-section two of section seventy-two of the principal Act, the following words shall be added at the beginning of the sub-section—namely, “except as aforesaid,” and for the words “so nearly resembling,” shall be substituted the words “having such resemblance to.”

s. 73, as to  
restriction on  
registration.

15. In section seventy-three of the principal Act the word “exclusive” shall be omitted.

s. 74, as to  
additions to  
trade marks.

16. For sub-section two of section seventy-four of the principal Act the following sub-section shall be substituted, namely—

“(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

“Provided that a person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.”

s. 75, as to  
effect of  
registration.

17. For section seventy-five of the principal Act the following section shall be substituted, namely—

“Application for registration of a trade mark shall be deemed to

be equivalent to public use of the trade mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been, the date of the registration."

18. After section seventy-seven of the principal Act the following section shall be added, and numbered 77A, namely—

Certificate as to exclusive use and costs thereon.

"In an action for infringement of a registered trade mark the Court or a judge may certify that the right to the exclusive use of the trade mark came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the subsequent action certifies that he ought not to have the same."

19. (1.) In sub-section five of section seventy-nine of the principal Act, for the words the "five years" shall be substituted the words "one year."

Amendments of 46 & 47 Vict. c. 57, s. 79, as to removal of trade mark from the register.

(2.) To the same sub-section the following words shall be added, namely: "Unless it is shown to the satisfaction of the comptroller that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark."

20. (1.) For sub-section two of section eighty-one of the principal Act the following sub-section shall be substituted:

s. 81, as to Sheffield marks.

"(2.) The Cutlers' Company shall enter in the Sheffield register, in respect of metal goods, as defined in this section, all the trade marks entered before the first day of January one thousand eight hundred and eighty-nine in respect of metal goods either in the register established under the Trade Marks Registration Act, 1875, or in the register of trade marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in either of the said other registers."

38 & 39 Vict. c. 91.

(2.) In sub-sections three and eight of the same section, for the words "on cutlery, edge tools, or on raw steel, or on goods made of



steel, or of steel and iron combined, whether with or without a cutting edge," shall be substituted the words "on metal goods."

(3.) For sub-section seven of the same section the following sub-section shall be substituted :

(7.) The provisions of this Act and of any general rules made under this Act with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade marks on metal goods by the Cutlers' Company, and to all matters relating thereto ; and this Act and any such general rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield register, for the comptroller, the Patent Office, and the Register of Trade Marks, respectively ; and notice of every entry, cancellation, or correction made in the Sheffield register shall be given to the comptroller by the Cutlers' Company : Provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register.

(4.) To the same section the following sub-sections shall be added ; namely—

(14.) For the purposes of this section the expression "metal goods" means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.

(15.) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield register a certificate under the hand of the master of the Cutlers' Company shall have the same effect as the certificate of the comptroller.

s. 87, as to entry of assignments, &c.

21. In section eighty-seven of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to."

s. 88, as to inspection.

22. In section eighty-eight of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to."

s. 90, as to rectification of register.

23. In section ninety of the principal Act, after the words "of the name of any person," shall be added the words "or of any other particulars."

s. 91, as to correction of errors.

24. To section ninety-one of the principal Act the following sub-section shall be added ; namely,

"(d.) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular

goods or classes of goods in connection with which he has desired the design or trade mark to be registered."

25. After section one hundred and two of the principal Act the following section shall be added and numbered 102A; namely, Proceedings of Board of Trade.

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

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

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

26. After section one hundred and twelve of the principal Act the following section shall be added and numbered 112A; namely, Jurisdiction of Lancashire Palatine Court.

"The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks the registration whereof is applied for in the Manchester office, have the like jurisdiction under this Act as her Majesty's High Court of Justice in England, and the expression 'the Court' in this Act shall be construed and have effect accordingly.

"Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases."

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. Construction of principal Act.

28. This Act shall, except so far as is by this Act otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine. Commencement of Act.

29. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1888, and this Act and the Patents, Designs, and Trade Marks Acts, 1883 to 1886, may be cited collectively as the Patents, Designs, and Trade Marks Acts, 1883 to 1888. Short title.



INTERNATIONAL CONVENTION FOR THE PROTECTION  
OF INDUSTRIAL PROPERTY.

SIGNED AT PARIS, MARCH 20, 1883.

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RATIFICATIONS EXCHANGED AT PARIS, JUNE 6, 1884.

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I.

*International Convention.*

SA Majesté le Roi des Belges, Sa Majesté l'Empereur du Brésil, Sa Majesté le Roi d'Espagne, le Président de la République Française, le Président de la République de Guatemala, Sa Majesté le Roi d'Italie, Sa Majesté le Roi des Pays-Bas, Sa Majesté le Roi de Portugal et des Algarves, le Président de la République de Salvador, Sa Majesté le Roi de Serbie, et le Conseil Fédéral de la Confédération Suisse,

Egalement animés du désir d'assurer, d'un common accord, une complète et efficace protection à l'industrie et au commerce des nationaux de leurs Etats respectifs et de contribuer à la garantie des droits des inventeurs et de la loyauté des transactions commerciales, ont résolu de conclure une Convention à cet effet et ont nommé pour leurs Plénipotentiaires, savoir :

Sa Majesté le Roi des Belges : M. le Baron Beyens, Grand Officier de son Ordre Royal de Léopold, Grand Officier de la Légion d'Honneur, &c., son Envoyé Extraordinaire et Ministre Plénipotentiaire à Paris ;

Sa Majesté l'Empereur du Brésil : M. Jules Constant, Comte de Villeneuve, Membre du Conseil de Sa Majesté, son Envoyé Extraordinaire et Ministre Plénipotentiaire près Sa Majesté le Roi des Belges, Commandeur de l'Ordre du Christ, Officier de son Ordre de la Rose, Chevalier de la Légion d'Honneur, &c. ;

Sa Majesté le Roi d'Espagne : Son Excellence M. le Duc de Fernan-Nuñez, de Montellano et del Arco, Comte de Cervellon,

INTERNATIONAL CONVENTION FOR THE PROTECTION  
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I.

*International Convention.*

HIS Majesty the King of the Belgians, His Majesty the Emperor of Brazil, His Majesty the King of Spain, the President of the French Republic, the President of the Republic of Guatemala, His Majesty the King of Italy, His Majesty the King of the Netherlands, His Majesty the King of Portugal and the Algarves, the President of the Republic of Salvador, His Majesty the King of Servia, and the Federal Council of the Swiss Confederation,

Being equally animated with the desire to secure, by mutual agreement, complete and effectual protection for the industry and commerce of their respective subjects and citizens, and to provide a guarantee for the rights of inventors, and for the loyalty of commercial transactions, have resolved to conclude a Convention to that effect, and have named as their Plenipotentiaries, that is to say:—

His Majesty the King of the Belgians: the Baron Beyens, Grand Officer of His Majesty's Royal Order of Leopold, Grand Officer of the Legion of Honour, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ;

His Majesty the Emperor of Brazil: M. Jules Constant, Count de Villeneuve, member of His Majesty's Council, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at the Court of His Majesty the King of the Belgians, Commander of the Order of Christ, Officer of His Majesty's Order of the Rose, Chevalier of the Legion of Honour, &c. ;

His Majesty the King of Spain: His Excellency the Duke de Fernan-Nuñez, de Montellano et del Arco, Count de Cervellon,



Marquis de Almonacid, Grand d'Espagne de Première Classe, Chevalier de l'Ordre Insigne de la Toison d'Or, Grand-Croix de l'Ordre de Charles III., Chevalier de Calatrava, Grand-Croix de la Légion d'Honneur, &c., Sénateur du Royaume, son Ambassadeur Extraordinaire et Plénipotentiaire à Paris ;

Le Président de la République Française : M. Paul Challemel-Lacour, Sénateur, Ministre des Affaires Etrangères ; M. Hérisson, Député, Ministre du Commerce ; M. Charles Jagerschmidt, Ministre Plénipotentiaire de Première Classe, Officier de l'Ordre National de la Légion d'Honneur, &c. ;

Le Président de la République de Guatemala : M. Crisanto Medina, Officier de la Légion d'Honneur, &c., son Envoyé Extraordinaire et Ministre Plénipotentiaire à Paris ;

Sa Majesté le Roi d'Italie, M. Constantin Ressiman, Commandeur de ses Ordres des Saints Maurice et Lazare et de la Couronne d'Italie, Commandeur de la Légion d'Honneur, &c., Conseiller de l'Ambassade d'Italie à Paris ;

Sa Majesté le Roi des Pays-Bas : M. le Baron de Zuylen de Nyevelt, Commandeur de son Ordre du Lion Néerlandais, Grand-Croix de son Ordre Grand Ducal de la Couronne de Chêne et du Lion d'Or de Nassau, Grand Officier de la Légion d'Honneur, &c., son Envoyé Extraordinaire et Ministre Plénipotentiaire à Paris ;

Sa Majesté le Roi de Portugal et des Algarves : M. Jose da Silva Mendes Leal, Conseiller d'Etat, Pair du Royaume, Ministre et Secrétaire d'Etat Honoraire, Grand-Croix de l'Ordre de Saint-Jacques, Chevalier de l'Ordre de la Tour et de l'Epee de Portugal, Grand Officier de la Légion d'Honneur, &c., son Envoyé Extraordinaire et Ministre Plénipotentiaire à Paris ; M. Fernand de Azevedo, Officier de la Légion d'Honneur, &c., Premier Secrétaire de la Légation de Portugal à Paris ;

Le Président de la République de Salvador ; M. Torres-Cañedo, Membre Correspondant de l'Institut de France, Grand Officier de la Légion d'Honneur, &c., son Envoyé Extraordinaire et Ministre Plénipotentiaire à Paris ;

Sa Majesté le Roi de Serbie : M. Sima M. Marinovitch, Chargé d'Affaires par intérim de Serbie, Chevalier de l'Ordre Royal de Takovo, &c. ;

Et le Conseil Fédéral de la Confédération Suisse : M. Charles-Edouard Lardy, son Envoyé Extraordinaire et Ministre Plénipotentiaire à Paris ; M. J. Weibel, Ingénieur à Genève, Président

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 Ressaun, 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-Cañedo, 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 Geneva, President of the



de la Section Suisse de la Commission Permanente pour la Protection de la Propriété Industrielle ;

Lesquels, après s'être communiqué leurs pleins pouvoirs respectifs, trouvés en bonne et due forme, sont convenus des Articles suivants :—

#### ARTICLE I.

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.

#### ARTICLE II.

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.

#### ARTICLE III.

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.

#### ARTICLE IV.

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 le dépôt dans les autres Etats, et sous réserve des droit de 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,

Swiss Section of the Permanent Commission for the Protection of Industrial Property :

Who, having communicated to each other their respective full powers, found in good and due form, have agreed upon the following Articles :—

#### ARTICLE I.

The Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland constitute themselves into a Union for the protection of Industrial Property.

#### ARTICLE II.

The subjects or citizens of each of the Contracting States shall, in all the other States of the Union, as regards patents, industrial designs or models, trade-marks and trade names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each State.

#### ARTICLE III.

Subjects or citizens of States not forming part of the Union, who are domiciled or have industrial or commercial establishments in the territory of any of the States of the Union, shall be assimilated to the subjects or citizens of the Contracting States.

#### ARTICLE IV.

Any person who has duly applied for a patent, industrial design or model, or trade-mark in one of the Contracting States, shall enjoy, as regards registration in the other States, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

Consequently, subsequent registration in any of the other States of the Union before expiry of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance



par un autre dépôt, par la publication de l'invention ou son exploitation par un tiers, par la mise en vente d'exemplaires du dessin ou du modèle, par l'emploi de la marque.

Les délais de priorité mentionnés ci-dessus seront de six mois pour les brevets d'invention, et de trois mois pour les dessins ou modèles industriels, ainsi que pour les marques de fabrique ou de commerce. Ils seront augmentés d'un mois pour les pays d'outre-mer.

#### ARTICLE V.

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.

#### ARTICLE VI.

Toute marque de fabrique ou de commerce régulièrement déposée dans le pays d'origine sera admise au dépôt et protégée telle quelle dans tous les autres pays de l'Union.

Sera considéré comme pays d'origine le pays où le déposant 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.

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.

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.

Tout produit portant illicitement une marque de fabrique ou de commerce, ou un nom commercial, pourra être saisi à l'importation

by another registration, by publication of the invention, or by the working of it by a third party, by the sale of copies of the design or model, or by use of the trade-mark.

The above-mentioned terms of priority shall be six months for patents and three months for industrial designs and models and trade-marks. A month longer is allowed for countries beyond sea.

#### ARTICLE V.

The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the States of the Union shall not entail forfeiture.

Nevertheless, the patentee shall remain bound to work his patent in conformity with the laws of the country into which he introduces the patented objects.

#### ARTICLE VI.

Every trade-mark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the Union.

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the Union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

#### ARTICLE VII.

The nature of the goods on which the trade-mark is to be used can in no case be an obstacle to the registration of the trade-mark.

#### ARTICLE VIII.

A trade-name shall be protected in all the countries of the Union, without necessity of registration, whether it form part or not of a trade-mark.

#### ARTICLE IX.

All goods illegally bearing a trade-mark or trade-name may be



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.

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.

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 que figureront aux Expositions Internationales officielles ou officiellement reconnues.

#### ARTICLE XII.

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.

#### ARTICLE XIII.

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.

seized on importation into those States of the Union where this mark or name has a right to legal protection.

The seizure shall be effected at the request of either the proper Public Department or of the interested party, pursuant to the internal legislation of each country.

#### ARTICLE X.

The provisions of the preceding Article shall apply to all goods falsely bearing the name of any locality as indication of the place of origin, when such indication is associated with a trade-name of a fictitious character or assumed with a fraudulent intention.

Any manufacturer of, or trader in, such goods, established in the locality falsely designated as the place of origin, shall be deemed an interested party.

#### ARTICLE XI.

The High Contracting Parties agree to grant temporary protection to patentable inventions, to industrial designs or models, and trade-marks, for articles exhibited at official or officially recognised International Exhibitions.

#### ARTICLE XII.

Each of the High Contracting Parties agrees to establish a special Government Department for industrial property, and a central office for communication to the public of patents, industrial designs or models, and trade-marks.

#### ARTICLE XIII.

An international office shall be organised under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property).

This office, the expense of which shall be defrayed by the Governments of all the Contracting States, shall be placed under the high authority of the Central Administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the Union.



## ARTICLE XIV.

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.

## ARTICLE XV.

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.

Les États qui n'ont point pris part à la présente Convention seront admis à y adhérer sur leur demande.

Cette adhésion sera notifiée par la voie diplomatique au Gouvernement de la Confédération Suisse, et par celui-ci à tous les autres.

Elle emportera, de plein droit, accession à toutes les clauses et admission à tous les avantages stipulés par la présente Convention.

## ARTICLE XVII.

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.

## ARTICLE XVIII.

La présente Convention sera mise à exécution dans le délai d'un mois à partir de l'échange des ratifications et demeurera en vigueur pendant un temps indéterminé, jusqu'à l'expiration d'une année à partir du jour où la dénonciation en sera faite.

Cette dénonciation sera adressée au Gouvernement chargé de recevoir les adhésions. Elle ne produira son effet qu'à l'égard de l'État qui l'aura faite, la Convention restant exécutoire pour les autres Parties Contractantes.

## ARTICLE XIV.

The present Convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the Union.

To this end, Conferences shall be successively held in one of the Contracting States by Delegates of the said States. The next meeting shall take place in 1885, at Rome.

## ARTICLE XV.

It is agreed that the High Contracting Parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of Industrial Property, in so far as such arrangements do not contravene the provisions of the present Convention.

## ARTICLE XVI.

States which have not taken part in the present Convention shall be permitted to adhere to it at their request.

Such adhesion shall be notified officially through the diplomatic channel to the Government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses, and admission to all the advantages stipulated by the present Convention.

## ARTICLE XVII.

The execution of the reciprocal engagements contained in the present Convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the Constitutional laws of those of the High Contracting Parties who are bound to procure the application of the same, which they engage to do with as little delay as possible.

## ARTICLE XVIII.

The present Convention shall come into operation one month after the exchange of ratifications, and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the Government commissioned to receive adhesions. It shall only affect the denouncing State, the Convention remaining in operation as regards the other Contracting Parties.



## APPENDIX.

## ARTICLE XIX.

La présente Convention sera ratifiée, et les ratifications en seront échangées à Paris, dans le délai d'un an au plus tard.

En foi de quoi les Plénipotentiaires respectifs l'ont signée et y ont apposé leurs cachets.

Fait à Paris, le 20 Mars, 1883.

(Signé)

(L.S.)	BEYENS.
(L.S.)	VILLENEUVE.
(L.S.)	Duc DE FERNAN-NUNEZ.
(L.S.)	P. CHALLEMEL-LACOUR.
(L.S.)	Ch. HERISSON.
(L.S.)	Ch. JAGERSCHMIDT.
(L.S.)	CRISANTO-MEDINA.
(L.S.)	RESSMAN.
(L.S.)	Baron DE ZUYLEN DE NYEVELT.
(L.S.)	JOSE DA SILVA MENDES LEAL.
(L.S.)	F. D'AZEVEDO.
(L.S.)	J.-M. TORRES-CAZEVEDO.
(L.S.)	SIMA M. MARINOVITCH.
(L.S.)	LARDY.
(L.S.)	J. WEIBEL.

## II.

*Final Protocol.*

Au moment de procéder, à la signature de la Convention conclue, à la date de ce jour, entre 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, pour la protection de la Propriété Industrielle, les Plénipotentiaires soussignés sont convenus de ce qui suit :

1. Les mots " Propriété Industrielle " doivent être entendus dans leur acception la plus large, en ce sens qu'ils s'appliquent non seulement aux produits de l'industrie proprement dite, mais également aux produits de l'agriculture (vins, grains, fruits, bestiaux, &c.), et aux produits minéraux livrés au commerce (eaux minérales, &c.).

2. Sous le nom de " Brevets d'Invention " sont comprises les diverses espèces de brevets industriels admises par les législations des États Contractants, telles que brevets d'importation, brevets de perfectionnement, &c.

## ARTICLE XIX.

The present convention shall be ratified, and the ratifications exchanged in Paris, within one year at the latest.

In witness whereof the respective Plenipotentiaries have signed the same, and have affixed thereto their seals.

Done at Paris, the 20th March 1883.

(Signed)

(L.S.)	BEYENS.
(L.S.)	VILLENEUVE.
(L.S.)	DUC DE FERNAN-NUNEZ.
(L.S.)	P. CHALLEMEL-LACOUR.
(L.S.)	CH. HERISSON.
(L.S.)	CH. JAGERSCHMIDT.
(L.S.)	CRISANTO-MEDINA.
(L.S.)	RESSMAN.
(L.S.)	BARON DE ZUYLEN DE NYEVELT.
(L.S.)	JOSE DA SILVA MENDES LEAL.
(L.S.)	F. D'AZEVEDO.
(L.S.)	J.-M. TORRES-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.).

2. Under the word "patents" are comprised the various kinds of industrial patents recognised by the legislation of each of the Contracting States, such as importation patents, improvement patents, &c.



3. Il est entendu que la disposition finale de l'Article II. de la Convention ne porte aucune atteinte à la législation de chacun des Etats Contractants, en ce qui concerne la procédure suivie devant les Tribunaux et la compétence de ces Tribunaux.

4. Le paragraphe 1<sup>er</sup> de l'Article VI. doit être entendu en ce sens qu'aucune marque de fabrique ou de commerce ne pourra être exclue de la protection dans l'un des Etats de l'Union par le fait seul qu'elle ne satisferait pas, au point de vue des signes qui la composent, aux conditions de la législation de cet Etat, pourvu qu'elle satisfasse, sur ce point, à la législation du pays d'origine et qu'elle ait été, dans ce dernier pays, l'objet d'un dépôt régulier. Sauf cette exception, qui ne concerne que la forme de la marque, et sous réserve des dispositions des autres Articles de la Convention, la législation intérieure de chacun des Etats recevra son application.

Pour éviter toute fausse interprétation, il est entendu que l'usage des armoiries publiques et des décorations peut être considéré comme contraire à l'ordre public, dans le sens du paragraphe final de l'Article VI.

5. L'organisation du service spécial de la Propriété Industrielle mentionné à l'Article XII. comprendra, autant que possible, la publication, dans chaque Etat d'une feuille officielle périodique.

6. Les frais communs de Bureau International institué par l'Article XIII. ne pourront, en aucun cas, dépasser, par année, une somme totale représentant une moyenne de 2000 fr. par chaque Etat Contractant.

Pour déterminer la part contributive de chacun des Etats dans cette somme totale des frais, les Etats Contractants et ceux qui adhèreraient ultérieurement à l'Union seront divisés en six classes contribuant chacune dans la proportion d'un certain nombre d'unités, savoir :—

1 <sup>e</sup> classe	. . . . .	25 unités.
2 <sup>e</sup> classe	. . . . .	20 „
3 <sup>e</sup> classe	. . . . .	15 „
4 <sup>e</sup> classe	. . . . .	10 „
5 <sup>e</sup> classe	. . . . .	5 „
6 <sup>e</sup> classe	. . . . .	3 „

Ces coefficients seront multipliés par le nombre des Etats de chaque classe, et la somme des produits ainsi obtenus fournira le nombre d'unités par lequel la dépense totale doit être divisée. Le quotient donnera le montant de l'unité de dépense.

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 organisation of the special Department for Industrial Property mentioned in Article XII., shall comprise, so far as possible, the publication in each State of a periodical official paper.

6. The common expenses of the International Office, instituted by virtue of Article XIII. are in no case to exceed for a single year a total sum representing an average of 2000 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 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.



## APPENDIX.

Les Etat Contractants sont classés ainsi qu'il suit, en vue de la répartition des frais :—

1 <sup>e</sup> classe	. . . . .	France, Italie.
2 <sup>e</sup> classe	. . . . .	Espagne.
3 <sup>e</sup> classe	. . . . .	Belgique, Brésil, Portugal, Suisse.
4 <sup>e</sup> classe	. . . . .	Pays-Bas.
5 <sup>e</sup> classe	. . . . .	Serbie.
6 <sup>e</sup> classe	. . . . .	Guatemala, Salvador.

L'Administration Suisse surveillera les dépenses du Bureau International, fera les avances nécessaires et établira le compte annuel, qui sera communiqué à toutes les autres Administrations.

Le Bureau International centralisera les renseignements de toute nature relatifs à la protection de la Propriété Industrielle et les réunira en une statistique générale qui sera distribuée à toutes les Administrations. Il procédera aux études d'utilité commune intéressant l'Union et rédigera, à l'aide des documents qui seront mis à sa disposition par les diverses Administrations, une feuille périodique, en langue Française, sur les questions concernant l'objet de l'Union.

Les numéros de cette feuille, de même que tous les documents publiés par le Bureau International, seront répartis entre les Administrations des Etats de l'Union, dans la proportion du nombre des unités contributives ci-dessus mentionnées. Les exemplaires et documents supplémentaires qui seraient réclamés, soit par les dites Administrations, soit par des Sociétés ou des particuliers, seront payés à part.

Le Bureau International devra se tenir en tout temps à la disposition des membres de l'Union, pour leur fournir, sur les questions relatives au service international de la Propriété Industrielle, les renseignements spéciaux, dont ils pourraient avoir besoin.

L'Administration du pays où doit siéger la prochaine Conférence préparera avec le concours du Bureau International, les travaux de cette Conférence.

Le Directeur du Bureau International assistera aux séances des Conférences et prendra part aux discussions sans voix délibérative. Il fera, sur sa gestion, un Rapport annuel, qui sera communiqué à tous les membres de l'Union.

La langue officiel du Bureau International sera la langue Française.

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 centralise information of every kind relating to the protection of Industrial Property, and will bring it together in the form of a general statistical statement, which will be distributed to all the Administrations. It will interest itself in all matters of common utility to the Union, and will edit, with the help of the documents supplied to it by the various Administrations, a periodical paper in the French language dealing with questions regarding the object of the Union.

The numbers of this paper, as well as all the documents published by the International Office, will be circulated among the Administrations of the States of the Union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired, either by the said Administrations or by Societies or private persons, will be paid for separately.

The International Office shall at all times hold itself at the service of members of the Union, in order to supply them with any special information they may need on questions relating to the international system of Industrial Property.

The Administration of the country in which the next Conference is to be held will make preparations for the 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.



7. Le présent Protocole de Clôture, qui sera ratifié en même temps que la Convention conclue à la date de ce jour, sera considéré comme faisant partie intégrante de cette Convention, et aura même force, valeur et durée.

En foi de quoi, les Plénipotentiaires soussignés ont dressé le présent Protocole.

(Signé)	BEYENS.
	VILLENEUVE.
	DUC DE FERNAN-NUNEZ.
	P. CHALLEMEL-LACOUR.
	CH. HERISSON.
	CH. JAGERSCHMIDT.
	CRISANTO-MEDINA.
	RESSMAN.
	BARON DE ZUYLEN DE NYEVELT.
	JOSE DA SILVA MENDES LEAL.
	F. D'AZEVEDO.
	J.-M. TORRES-CAICEDO.
	SIMA M. MARINOVITCH.
	LARDY.
	J. WEIBEL.

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### 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

7. The present Final Protocol, which shall be ratified, together with the Convention concluded this day, shall be considered as forming an integral part of, and shall have the same force, validity, and duration as the said Convention.

In witness whereof, the undersigned Plenipotentiaries have drawn up the present Protocol.

(Signed) BEYENS.  
 VILLENEUVE.  
 Duc DE FERNAN-NUNEZ.  
 P. CHALLEMEL-LACOUR.  
 CH. HERISSON.  
 CH. JAGERSCHMIDT.  
 CRISANTO-MEDINA.  
 RESSMAN.  
 Baron DE ZUYLEN DE NYEVELT.  
 JOSE DA SILVA MENDES LEAL.  
 F. D'AZEVEDO.  
 J. M. TORRES-CAICEDO.  
 SIMA M. MARINOVITCH.  
 LARDY.  
 J. WEIBEL.

her part in the execution of the stipulations contained in the Convention and Protocol aforesaid.

The Undersigned makes this Declaration on the part of her Britannic Majesty with the express understanding that power is reserved to her Britannic Majesty to accede to the Convention on behalf of the Isle of Man and the Channel Islands, and any of her Majesty's possessions, on due notice to that effect being given through her Majesty's Government.

In witness whereof the Undersigned, duly 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.*

Sa Majesté la Reine du Royaume Uni de la Grande-Bretagne et d'Irlande ayant accédé à la Convention Internationale, relative à la protection de la Propriété Industrielle, conclue à Paris le 20 Mars 1883, et suivie d'un Protocole en date du même jour, en vertu de l'Acte d'Accession délivré par son Ambassadeur Extraordinaire et Plénipotentiaire près le Gouvernement de la République Française ; acte dont la teneur suit ici, mot pour mot :---

(Here is inserted the text of No. III. in English.)

Le Président de la République Française a autorisé le Soussigné, Président du Conseil, Ministre des Affaires Etrangères, à accepter formellement la dite accession, y compris les réserves qui y sont contenues, concernant l'Ile de Man, les Iles de la Manche et toutes autres possessions de Sa Majesté Britannique, s'engageant, tant en son nom qu'au nom des autres Hautes Parties Contractantes, à concourir à l'accomplissement des obligations stipulées dans la Convention et le Protocole y annexé, qui pourront concerner le Royaume Uni de la Grande-Bretagne et d'Irlande.

En foi de quoi, le Soussigné, dûment autorisé, a dressé le présent Acte d'Acceptation et y a fait apposer son cachet.

Fait à Paris, le 2 Avril 1884.

(L.S.)      (Signé)      JULES FERRY.

## IV.

*Declaration of Acceptance of Accession.*

Her Majesty the Queen of the United Kingdom of Great Britain and Ireland, having acceded to the International Convention relative to the Protection of Industrial Property, concluded at Paris, March 20, 1883, together with a Protocol dated the same day, by the Declaration of Accession delivered by her Ambassador Extraordinary and Plenipotentiary to the Government of the French Republic, the text of which Declaration is word for word as follows:—

(Here is inserted the text of No. III. in English.)

The President of the French Republic has authorised the Undersigned, President of the Council, Minister for Foreign Affairs, to formally accept the said Accession, together with the reserves which are contained in it concerning the Isle of Man, the Channel Islands, and all other possessions of her Britannic Majesty, engaging as well in his own name, as in that of the other High Contracting Parties, to assist in the accomplishment of the obligations stipulated in the Convention and the Protocol thereto annexed, which may concern the United Kingdom of Great Britain and Ireland.

In witness whereof the Undersigned, duly authorised, has drawn up the present Declaration of Acceptance, and has affixed thereto his seal.

Done at Paris, the 2nd April 1884.

(L.S.) (Signed) JULES FERRY.



## PATENTS RULES, 1890.

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

### SHORT TITLE.

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

### 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.

### FEEES.

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.

### FORMS.

Forms. Alterations. 5. The Forms A, B, and C in the First Schedule to the Act of 1883 shall be altered or amended by the substitution therefor of the Forms A, A<sub>1</sub>, A<sub>2</sub>, B, and C in the Second Schedule to these Rules.(a)

Application. 6. (1.) An application for a patent containing the declaration mentioned in sub-section 2 of section 5 of the Act of 1883 and section 2 of the Act of 1885 shall be made either in the Form A or the Form A<sub>1</sub>, or the Form A<sub>2</sub>, set forth in the Second Schedule to these Rules as the case may be.(b)

Specification. (2.) The Form B<sub>1</sub>(c) in such Schedule of provisional specification and the Form C (d) of complete specification shall respectively be used.

(a) pp. 636-643 *post*.  
(c) p. 642 *post*.

(b) pp. 636-640 *post*.  
(d) p. 643 *post*.

(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.<sup>(e)</sup> Other forms.

#### GENERAL.

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

Christmas Day.

Good Friday.

The day observed as her Majesty's birthday.

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

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 made be made by or through an agent duly authorised to the satisfaction of the comptroller, and, if he so require, resident in the United Kingdom. Agency.

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.

10. All documents and copies of documents, except statutory declarations and affidavits, sent to or left at the Patent Office or otherwise furnished to the comptroller or to the Board of Trade shall be written or printed in large and legible characters and, unless otherwise directed, in the English language, upon strong, wide, ruled paper (on one side only), of a size of 13 inches by 8 inches, leaving a margin of two inches on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the comptroller. Size, &c., of documents.

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' Exercise of discretionary power by comptroller.

(e) pp. 644-663 *post*.



Notice of hearing.

notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before the comptroller. Statutory declarations and affidavits shall be in the form for the time being in use in the High Court of Justice.

Notice 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.

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.

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.

Power of amendment, &c.

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

16A. Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office, or to the comptroller, or to any other person under these rules, may be sent

by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given at the time when the letter containing the same would be delivered in the ordinary course of post. In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

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:—

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

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

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

#### APPLICATION WITH PROVISIONAL OR COMPLETE SPECIFICATION.

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.

19. Where a person making application for a patent includes therein by mistake, inadvertence, or otherwise, more than one invention, he may, after the refusal of the comptroller to accept such application, amend the same so as to apply to one invention

Application for separate patents by way of amendment.



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.

Application by representative of deceased inventor.

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

Notice and advertisement of acceptance.

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

Inspection on acceptance of complete specification.

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

#### APPLICATION ON COMMUNICATION FROM ABROAD.

Communi-  
cation 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.

#### INTERNATIONAL AND COLONIAL ARRANGEMENTS.

24. The term "foreign application" shall mean an application by any person for protection of his invention in a foreign State or British Possession to which by any Order of her Majesty in Council for the time being in force the provisions of section 103 of the Patents, Designs, and Trade Marks Act, 1883, have been declared applicable.

25. An application in the United Kingdom for a patent for any invention in respect of which a foreign application has been made shall contain a declaration that such foreign application has been made and shall specify all the foreign States or British Possessions in which foreign applications have been made and the official date or dates thereof respectively. The application must be made within 7 months from the date of the first foreign application, and must be

signed by the person or persons by whom such first foreign application was made. If such person, or any of such persons, be dead, the application must be signed by the legal personal representative of such dead person, as well as by the other applicants, if any.

26. The application in the United Kingdom shall be made in the form A<sup>2</sup> in the Second Schedule to these rules, and in addition to the specification, provisional or complete, left with such application must be accompanied by

(1.) A copy or copies of the specification, and drawings or documents corresponding thereto, filed or deposited by the applicant in the Patent Office of the foreign State or British Possession in respect of the first foreign application duly certified by the official chief or head of the Patent Office of such foreign State or British Possessions as aforesaid, or otherwise verified to the satisfaction of the comptroller;

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

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

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

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



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

Drawings for specifications.

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

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

Requirements as to paper, &c.

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

Size of drawings.

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

Quality of ink.

To ensure their satisfactory reproduction, the drawings must be executed with *absolutely black Indian-ink; the same strength and colour of fine and shade lines to be maintained throughout.* Section lines, and lines for effect, or shading lines, must not be closely drawn. A specimen drawing is inserted in illustration of this requirement.<sup>(e)</sup> Reference figures and letters must be bold, distinct, not less than  $\frac{1}{8}$  of an inch in height; and the same letters should be used in different views of the same parts. In cases of complicated drawings, the reference letters must be shown outside the figure, and connected with the part referred to by a fine line.

Scale of drawings.

The scale adopted should be large enough to show clearly wherein the invention consists, and only so much of the apparatus, machine, &c., need be shown as effects this purpose. When the scale is shown

(e) See Official Rules.

on the drawing it should be denoted, *not* by words, but by a drawn scale, as illustrated in the specimen.

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 photo-lithography. 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.

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." Provisional drawings used for complete specification.

#### OPPOSITION TO GRANTS OF PATENTS.

34. A notice of opposition to the grant of a patent shall be on Form D,(f) 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.

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

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. Particulars of prior patent.

37. Within 14 days after the expiration of two months from the date of the advertisement of the acceptance of a complete specification, the opponent may leave at the Patent Office statutory declara- Opponent's evidence.



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

Applicant's  
evidence.

38. Within 14 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 14 days from such delivery the opponent may leave at the Patent Office his statutory declarations in reply, and on so leaving shall deliver to the applicant a list thereof. Such last-mentioned declarations shall be confined to matters strictly in reply.

Evidence in  
reply.

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

Closing of  
evidence.

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

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

Notice of  
hearing.

41. On completion of the evidence, or at such other time as he may see fit, the comptroller shall appoint a time for the hearing of the case, and shall give the parties 10 days' notice at the least of such appointment. If the applicant or opponent desires to be heard he must forthwith send the comptroller an application on Form E.(g) The comptroller may refuse to hear either party who has not sent such application for hearing. If neither party applies to be heard the comptroller shall decide the case and notify his decision to the parties.

Disallowance  
of opposition  
in certain cases.

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

43. Where the ground of an opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation be left at the Patent Office within the time pre-

scribed by these rules, the opposition shall be deemed to be abandoned, and a patent shall be sealed forthwith.

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

CERTIFICATES OF PAYMENT OR RENEWAL.

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. Payment of fees of 50*l.* and 100*l.* for continuance of patent.

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.

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 (*h*) in the second schedule, duly stamped, should be used for the purpose of this and the payment referred to in rule 45.

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.

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 substantiate by such proof as he may think necessary the allegations contained in the application for enlargement. Enlargement of time for payments.

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. Extension of time for leaving and accepting complete specification.

(*h*) p. 651 *post*.



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 thinks fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

#### AMENDMENT OF SPECIFICATION.

Request for leave to amend. 52. A request for leave to amend a specification must be signed by the applicant or patentee (hereinafter in rules 54, 55, and 58 called the applicant) and accompanied by a duly certified printed copy of the original specification and drawings, showing in red ink the proposed amendment, and shall be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may in each case direct.

Advertisement. 52. A request for leave to amend a specification must be signed by the applicant or patentee (hereinafter in rules 54, 55, and 58 called the applicant) and accompanied by a duly certified printed copy of the original specification and drawings, showing in red ink the proposed amendment, and shall be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may in each case direct.

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

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

Opponent's evidence. 55. Within 14 days after the expiration of one month from the first advertisement of the application for 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.

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.

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.

COMPULSORY 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.

Petition for compulsory grant of licences.

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.

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

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

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

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

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

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

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

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

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

74. Where an Order has been made by her Majesty in Council Entry of Orders of the Privy Council or of the Court. 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.

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

76. If a patentee fails to make any prescribed payment within the prescribed time or any enlargement thereof duly granted, such failure shall be duly entered in the register. Entry of failure to pay fees.

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. Entry of licences.

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 :— Hours of inspection of register.

(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.

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 Certified copies of documents.



there, may be furnished by the comptroller on payment of the prescribed fee.

POWER TO DISPENSE WITH EVIDENCE, &c.

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

REPEAL.

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.

Dated the 31st day of March 1890.

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

## RULES REGULATING THE PRACTICE AND PROCEDURE ON APPEAL TO THE LAW OFFICERS.

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

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.

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.

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.

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.

VI. Seven days' notice, at least, of the time and place appointed for the hearing of any appeal, shall be given by the law officers' clerk, unless special leave be given by the law officer that any shorter notice be given

VII. Such notice shall in all cases be given to the comptroller and the appellant; and, when there has been an opposition before the comptroller, to the opponent or opponents; and, when the comptroller has refused to seal a patent on the ground that an



application for a patent for the same invention is pending, to the prior applicant.

VIII. The evidence used on appeal to the law officer shall be the same as that used at the hearing before the comptroller; and no further evidence shall be given, save as to matters which have occurred or come to the knowledge of either party, after the date of the decision appealed against, except with the leave of the law officer upon application for that purpose.

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.

X. Any person requiring the attendance of a witness for cross-examination shall tender to the witness whose attendance is required a reasonable sum for conduct money.

XI. Where the law officer orders that costs shall be paid by any party to another, he may fix the amount of such costs, and if he shall not think fit to fix the amount thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained.

XII. If any costs so ordered to be paid be not paid within fourteen days after the amount thereof has been so fixed or ascertained or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment under the provisions of section 38 of the Act.

XIII. All documentary evidence required, or allowed by the law officer to be filed, shall be subject to the same regulations, in all respects, as apply to the procedure before the comptroller, and shall be filed in the Patent Office, unless the law officer shall order to the contrary.

XIV. Any notice or other document required to be given to the law officers' clerk, under these rules, may be sent by a prepaid letter through the post.

HENRY JAMES, A.G.

FARRER HERSHELL, S.G.

## 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," cop. 83.*

### RULE I.

A party intending to apply by petition, under section 2 of the said Act, shall give public notice by advertising in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carries on any manufacture of anything made according to his specification, or near to or in which he resides, in case he carries on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to petition his Majesty under the said section, and shall in such advertisements state the object of such petition, and give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition, (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day, notice must be given of any opposition intended to be made to the petition; and any person intending to oppose the said application shall lodge notice to that effect at the Council Office, on or before such day so named in the said advertisements, and having lodged such notice shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

### RULE II.

A party intending to apply by petition, under section 4 of the said Act, shall, in the advertisements directed to be published by the said section, give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*),



and that on or before such day caveats must be entered ; and any person intending to enter a caveat shall enter the same at the Council Office, on or before such day so named in the said advertisements ; and having entered such caveat, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

RULE III.

Petitions under section 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*.

RULE IV.

All petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of section 4 of the said Act, and the 1st and 2nd of these rules and the matters in such affidavits may be disputed by the parties opposing upon the hearing of the petitioner.

RULE V.

All persons entering caveats under section 4 of the said Act, and all parties to any former suit or action touching letters patent in respect of which petitions shall have been presented under section 2 of the said Act, and all persons lodging notices of opposition under the 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.

RULE VI.

All parties served with petitions shall lodge at the Council Office, within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions.

RULE VII.

Parties may have copies of all papers lodged in respect of any application under the said Act, at their own expense.

RULE VIII.

The Registrar of the Privy Council, or other officer to whom it may be referred to tax the costs incurred in the matter of any petition presented under the said Act, shall allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

## RULE IX.

A party applying for an extension of a patent, under section 4 of the said Act, must lodge at the Council Office six printed copies of the specification, and also four copies of the balance sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the Lords of the Committee at the hearing. In the event of the applicant's specification not having been printed, and if the expense of making six copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only of such specification and drawing will be deemed sufficient.

All copies mentioned in this Rule must be lodged not less than one week before the day fixed for hearing the application.

The Judicial Committee will hear the Attorney-General, or other counsel, on behalf of the Crown, against granting any application made under either the 2nd or 4th section of the said Act, in case it shall be thought fit to oppose the same on such behalf.