

Conditions. special circumstances to cause the law officer to insert a later date than January 1, 1884, (f) though the usual practice is not to extend protection to infringers beyond that date. (g)

During the argument in *Ashworth's Application*, (h) the Solicitor-General said that if he saw, or if there was any evidence before him, that the patent had been used for the purpose of endeavouring to obtain a monopoly larger than that which the specification as amended claimed, he should consider that a special circumstance, and impose the condition that no action should be brought for anything done at any time before the amendment; for instance, if the patentees had been threatening persons, and endeavouring to prevent persons from making or selling wire hardened and tempered in a mode different to that described and claimed by the amended specification.

Under the old practice, in order to protect the interests of manufacturers who had embarked large capital in a trade on the strength of a patent having been allowed to remain in its imperfect state for a long time, the law officers frequently imposed conditions for their protection. (i) Such conditions were that the patentee should not sue in respect of infringements committed before amendment, (k) or in respect of certain continued infringements by the use of certain specified machines actually in use before the amendment, (l) or in respect of fresh infringements by certain persons in virtue of the continued use of a process employed by them prior to the amendment, (m) or in respect of infringements by machines made under specified contracts. (n)

A condition that no action be brought in respect of infringements prior to a certain date protects the continued user of infringing articles made before that date, and also the sale of such articles unsold at the fixed date. (o)

But a condition that no action be brought in respect of the infringement of a patent, of which the amendment of the specification is sought, does not prevent the patentee from

(f) Haddan, (1885) Griff. L. O. C. 12.

(g) Ashworth, (1886) Griff. L. O. C. 6.

(h) *Ibid.*

(i) Tranter's Patent, Jones' Patent, (1873) Johns. Pat. Man. 5th ed. pp. 191, 192.

(k) Lucas' Patent, (1854) Macr. P. C. 234, 239; Smith's Patent, (1855) Macr. P. C. 232.

(l) Harrison's Patent, (1853) Macr.

P. C. 31; Westinghouse's Patent, (1885) Griff. P. C. 315; Crabtree's Patent, Eng. Rep. Jan. to Mar. 1881; Fox's Patent, (1878) No. 3988.

(m) *Re* Medlock's Patent, (1865) Newton, Lond. Journ. N. S. vol. xxii. p. 69.

(n) Fox's Patent, (1878) No. 3988.

(o) Cheesebrough's Patent, (1884) Griff. P. C. 303.

bringing an action on another patent belonging to him, if Conditions.
those articles infringe such other patent.(p)

When the condition is imposed that no action be brought in respect of certain specified machines, it is usual to order that such machines be marked with distinguishing marks.(q)

In the case of patents bearing dates subsequent to January 1, 1884, it is not usual for the Comptroller or law officer to impose the condition that no action shall be brought in respect of any infringements committed after that date, as such cases are provided for by s. 20 of the Act of 1883.

Actions commenced after the amendment of the specifications in respect of infringements committed before amendment are, in certain cases, justifiable, on the ground that it is not right that a person should gain his information from a patentee, and, acting on that information, copy and use his invention. He must not presume upon some defect in the specification, and infringe upon the valuable part of the patent.(r)

Under the law prior to the Act of 1883, amendments by disclaimer were retrospective, except when entered pending an action for infringement, in which case it was specially provided that the amended specification should not be given in evidence at the trial.(s) Retrospective effect of amendments.

No action, however, could be brought at all in respect of infringements committed before amendment without the leave of the law officer, certified by his fiat.(t) Cases in which amendments were made retrospective, and power was given to the patentee to proceed against those who had infringed before the disclaimer was filed, were the exception, and not the rule, and it lay on the party applying for a certificate giving a disclaimer a retrospective power to make out a case entitling him to that certificate.(u)

The terms usually imposed by the Court, in granting leave to apply to amend under s. 19 of the Act of 1883, together with the concluding words of the section, "and may direct that, in the meantime, the trial or hearing of the action shall be postponed," are a clear indication that the amendment speaks from the date of the patent, and that there are cases where the Court, in

(p) *United Telephone Co. v. London and Globe Telephone Co.*, (1884) L. R. 26 Ch. D. 766.

(q) *Edison's Patent*, (1877) No. 2909; *Westinghouse's Patent*, (1885) Griff. P. C. 315; *Haddan's Patent*, (1885) Griff. L. O. C. 12, 13; *Crabtree's Patent*, Eng. Rep. Jan. to Mar. 1881.

(r) See *Lucas' Patent*, (1854) Macr. P. C. 234.

(s) 5 & 6 Will. IV. c. 83, s. 1; *Perry v. Skinner*, 2 M. & W. 471; *R. v. Mill*, (1850) 10 C. B. 379.

(t) 15 & 16 Vict. c. 83, s. 39.

(u) *Lucas' Patent*, (1854) Macr. P. C. 234, 239.

Amend-
ment after
Action on,
or Petition
against, the
Patent.

its discretion, ought to, and would, under the present law, allow an amended specification to be given in evidence in a pending action. (x)

If a patentee obtains an injunction against an infringer, before he amends the specification, he cannot enforce his injunction after the amendment, but must proceed *de novo*. (y)

When leave to amend has been given, even though on condition and the patentee's assent to the condition has not been notified, an action on the amended specification can be sustained though the amendment of the specification itself was not actually made by the Patent Office officials till after the commencement of the action. (z)

Amendments
may be made
after adverse
decision in an
action:

Amendment after Action for Infringement.—From a consideration of the principles discussed in the foregoing pages of this chapter, and also from the fact that a judgment adverse to the validity of the patent on the ground of defective specification amounts at most to a declaration of the Court to the effect that the specification as it stands is wholly, or in part, as the case may be, bad, and is not an order for revocation, it will appear that a patentee may be allowed to amend after judgment. If after amendment any portion of the specification which the Court held to be bad is not removed either by excision or alteration in meaning consequent on some amendment made, the judgment would of course act as an estoppel against the patentee as being *res judicata* in any subsequent proceedings against the same defendant. (a)

also after a
conditional
order for revo-
cation.

Amendment after Order for Revocation.—As already demonstrated, so long as certain defects remain in the specification the patent is invalid. (b) In the event of a petition for revocation being presented to the Court, the Court is bound on proof of the existence of any one fatal defect in the specification, however meritorious the real invention may be, to hold that the patent is bad, and to make some order as to its revocation. It is only just that, if the removal by amendment of the defect in the specification on the strength of which the Court comes to a conclusion against the patent, would leave proper subject-matter, the patentee should have an opportunity of amending. Should the Court make an order for revocation without any condition it may be doubtful whether the Comptroller-General has, under any circumstances thereafter, juris-

(x) *Bray v. Gardner*, (1887) 4 R. P. C. 41, 42.

(y) *Dudgeon v. Thompson*, (1877) L. R. 3 App. Cas. 34.

(z) *Andrew v. Crossley*, (1892) 9 R. P. C. 165.

(a) See p. 523 *post*.

(b) Chap. V. *ante*.

·diction to allow any amendment to be made, seeing that it may well be that the order for revocation operates as an immediate revocation, and so there is no patent in existence for the Comptroller to deal with.(c)

Practice when no Action or Petition is pending.

In a case where the Court of first instance had made an order for the unconditional revocation of a patent, and the House of Lords held that the patent was bad on certain grounds, but not on all the grounds alleged by the petitioner, and directed a postponement for the purpose of giving the patentee an opportunity of applying at the Patent Office for leave to amend and so remove the invalid claims, the Comptroller-General, acting on the advice of the law officer, refused leave on the ground that the patent having been revoked by the order of the Judge of first instance, there was no patent existing for him to deal with. The matter being again mentioned to the House of Lords, their Lordships did not decide the point as to the jurisdiction of the Comptroller under the above circumstances, but did justice by, instead of simply affirming the order of the Judge of first instance, making an order (which was of course *nunc pro tunc*) "that the patent be revoked, unless within three months or such further time as the Court may allow the patentee obtain leave to amend his specification," &c.(d)

When the Judge of first instance finds all the claims bad, it is submitted he can only make an unconditional order for revocation; but when he finds that one or more of the claims are good and others bad, the proper order to make is that above referred to and adopted by the House of Lords in *Deeley v. Perks*.(e)

PART II.—PRACTICE.

No Action for Infringement or Petition for Revocation pending.—When there is no pending action for infringement or petition for revocation the procedure for amendment and the kind of amendments allowable are regulated by s. 18 of the Act of 1883,(f) as amended by the Act of 1888,(g) and by the Patents Rules 1890, rr. 52 to 59.(h)

S. 18 of Act of 1883, as amended by Act of 1888, applies when there is no pending action for infringement or petition for revocation.

S. 18 of the Act of 1883, as amended by the Act of 1888, is as follows:—

(c) See *Deeley v. Perks*, (1896) 13 R. P. C. 589-590.

(d) *Deeley v. Perks* (1896) 13 R. P. C. 581.

(e) (1896) 13 R. P. C. 590.

(f) 46 & 47 Vict. c. 57, s. 18.

(g) 51 & 52 Vict. c. 50, s. 5.

(h) p. 721 *post*.

**Practice
when no
Action or
Petition is
pending.**

§. 18 of Act
of 1883 as
amended by
Act of 1888.

“ 1. An applicant or a patentee may from time to time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of such amendment and his reasons for the same. •

“ 2. The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

“ 3. When 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. When no notice of opposition is given, or the person so giving notice does not appear, the Comptroller shall determine whether, and subject to what conditions, if any, the amendment ought to be allowed.

“ 6. When leave to amend is refused by the 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 the infringement or proceeding for the revocation of a patent is pending.”

The Comptroller cannot exercise any discretionary power adversely to an applicant for leave to amend a specification without (if so required within the prescribed time) giving the applicant an opportunity of being heard personally or by his agent.⁽ⁱ⁾

(i) 46 & 47 Vict. c. 57, s. 94 ; P. R. (1890) rr. 11-14.

**Applicant's
right to be
heard.**

Under the old law it was competent for the grantee of a patent to enter a disclaimer, even though he had partially(*k*) or wholly(*l*) parted with his interest ; but this is not so now, as, according to the provisions of the Act of 1883,^(m) only an applicant or a patentee is entitled to apply for leave to amend, and the term "patentee" is expressly defined as meaning the person for the time being entitled to the benefit of the patent.⁽ⁿ⁾ An assignee of a patent is consequently entitled to apply for leave to amend the specification, as he was before the Act of 1883. It would appear that in the case of co-owners, whether as original grantees or as assignees, they should all join as petitioners on an application to amend ; though the petition would not be refused in the absence of co-owners not on the register.

Practice when no Action or Petition is pending.

Who may be an applicant.

It is submitted that a mortgagee need not be made a party to an application by the beneficial owner of a patent for leave to apply to amend the specification, and that he could not make the application himself without the beneficial owner being a party.^(o)

Mortgagee need not be a party.

The request for leave to amend must be signed by the applicant or patentee and must be accompanied by a duly certified printed copy of the original specification and drawings, showing in red ink the proposed amendment.^(p) The request, which states the nature of the desired amendment and the applicant's reasons for making the same,^(q) is then advertised in the official journal of the Patent Office, and in such other manner (if any) as the Comptroller may in each case direct.^(r) Advertisements are necessary, through the specification has not been published, if the procedure of s. 18 applies, and the fact that no advertisements have taken place may be raised as an objection to any amendment being allowed. But when the amendment is once allowed it cannot be objected against it that the advertisements were not duly made, and so it was *ultra vires*.^(s)

Signature and advertisement of request.

It is open to any person at any time within one month from the first advertisement of the request for and the nature of the proposed amendment to give notice at the Patent Office of opposition to the amendment.^(t)

Any one may oppose.

(*k*) *Spilsbury v. Clough*, (1842) 1 W. P. C. 255.

(*l*) *Wallington v. Dale*, (1852) 7 Exch. 888.

(*m*) s. 18, sub-s. 1.

(*n*) s. 46.

(*o*) *Van Gelder Co. v. Sowerby Co.*, (1889) 7 R. P. C. 208.

(*p*) Patents Rules, (1890) r. 52 ; p. 721 *post*.

(*q*) 46 & 47 Vict. c. 57, s. 18, sub-s. 1.

(*r*) Patent Rules, (1890) r. 52 ; p. 721 *post*.

(*s*) *Farbenfabrikens. vorms. F. Bayer*, (1891) 8 R. P. C. 396 ; see p. 257 *ante*.

(*t*) 46 & 47 Vict. c. 57, s. 18, sub-s. 2.

Practice when no Action or Petition is pending.

Notice of opposition.

Evidence.

Hearing by the Comptroller.

Appeal to the law officer.

The notice of opposition must state the ground or grounds on which the opponent intends to oppose the amendment and must be signed by him. Such notice must state the opponent's address for service in the United Kingdom and be accompanied by an unstamped copy.^(u) The notice must be upon Form G ^(x), and the stamp charge is 10s.^(y) The unstamped copy is forthwith forwarded by the Comptroller to the applicant.^(z)

Within fourteen days after the expiration of one month from the first advertisement of the application for leave to amend, the opponent may leave at the Patent Office statutory declarations in support of his opposition; and on so leaving them he must deliver to the applicant a list thereof.^(a) The provisions of Rules 38 to 44 of the Patent Rules 1890 ^(b) then apply to the applicant's evidence, the evidence in reply, the closing of the evidence, the notice of hearing, the disallowance of opposition upon grounds not stated in the notice and the notification of the Comptroller's decision.

The Comptroller, upon the date fixed in the notice of hearing, hears and decides the case, subject to an appeal to the law officer.^(c)

The practice upon appeal to the law officer as regards notices, evidence, cross-examination of witnesses, hearing, &c., is regulated by the Law Officers' Rules.^(d) Though the respondent is entitled to service of the notice of appeal, yet if he appears without having received the notice the law officer will not refuse to hear the case.^(e)

If the Comptroller decides against an applicant or patentee applying for leave to amend his specification, the applicant or patentee must not delay exercising his right of appeal and must file the fourteen days' notice required by the Law Officer's Rules,^(f) or the appeal may not be heard, on the ground that it is too late.

Thus in *Arnold's Application*,^(g) the Comptroller decided against the applicant, who two years afterwards applied again, and then appealed to the law officer. The Attorney-General said that he thought he should have allowed the proposed amendment, but the affidavit of the applicant, to the effect that he was ignorant of the patent law and that he could have

^(u) Patent Rules, (1890) r. 53; p. 721.

^(x) p. 755 *post.* ^(y) p. 839 *post.*

^(z) Patent Rules, (1890) r. 54.

^(a) Patent Rules, (1890) r. 55.

^(b) p. 719 *post.*; see Patent Rules, (1890) r. 56, p. 722 *post.*

^(c) 46 & 47 Vict. c. 57, s. 18, sub-s. 3.

^(d) p. 726 *post.*

^(e) See *Rylands' Patent*, (1888) 5, R. P. C. 668.

^(f) L. O. Rules, r. 1.

^(g) (1882) *Griff. L. O. C.* 5.

appealed against the former decision of the Comptroller, did not satisfy him that any sufficient reason existed why proceedings were not taken to question the previous decision of the Comptroller, and he refused to allow the appeal.

Practice when no Action or Petition is pending.

Sub-s. 3 of s. 18 of the Act of 1883, which regulates the practice before the Comptroller on an application for leave to apply to amend, does not appear to give the applicant any right to object to the opposer as being a person not entitled to be heard in opposition, whereas sub-s. 4, which relates to an appeal to the law officer, provides that he (the law officer) shall hear the applicant and the opposer, who is, "in the opinion of the law officer, entitled to be heard in opposition," thus giving the applicant the right to object to the opposer as a person not entitled to be heard.

Right to question *locus standi* of opponent before the law officer.

In *Bell's Case*,^(h) however, the Comptroller refused to listen to the objection that a proposed amendment would make *Bell's* specification claim the same invention as that described in two prior specifications, on the ground that the opponents were not the owners of the prior patents, and therefore, being mere members of the public, the objection was not one which it was competent for them to set up. On appeal, the Solicitor-General supported the decision of the Comptroller, and held that the opponents were not in the position of persons entitled to be heard with regard to the prior patents; ⁽ⁱ⁾ but this case cannot be regarded as an authority for the statement that the *locus standi* of an opponent may be questioned before the Comptroller.

A prior patentee is a person entitled to oppose an application for leave to apply to amend the specification of a subsequent patent on the ground that the amendment, if allowed, would prejudice the patentee's rights under the prior patent.^(j)

When there is no notice of opposition, or the opponent does not appear, the Comptroller determines whether, and subject to what conditions,^(k) if any, the amendment ought to be allowed. If leave to amend is refused by the Comptroller the applicant may appeal to the law officer, who must, if required, hear the applicant and the Comptroller, and may make an order determining whether, and subject to what conditions, if any, the

Decision of Comptroller when there is no opposition.

^(h) (1887) Griff. L. O. C. 10.
⁽ⁱ⁾ See also Glossop, (1884) Griff. P. C. 285; Heath and Frost, (1886) Griff. P. C. 288; Hookham's Patent, (1886) Griff. L. O. C. 32; Macevoy's

Patent, (1888) 5 R. P. C. 285; Stuart's Patent, (1896) 13 R. P. C. 627,
^(j) Hampton v. Facer, (1885) Griff. L. O. C. 15.
^(k) pp. 271-274 ante.

Practice when no Action or Petition is pending.

amendment ought to be allowed; (l) and the decision of the law officer is final.(m)

When leave to amend is given, the applicant must, if the Comptroller so require, and within a time to be limited by him, leave at the Patent Office a new specification and drawings as amended, and prepared in accordance with the prescribed rules.(n) Every amendment of a specification is forthwith advertised by the Comptroller in the official journal of the Patent Office, and in such manner, if any, as the Comptroller may direct.(o)

Leave to amend is conclusive of right to amend.

Leave to amend is conclusive of the applicant's or patentee's right to make the amendment, except in the case of fraud,(p) e.g., where a disclaimer was filed without the consent of the patentee.(q)

Costs.

The Comptroller has no power over the costs of an application either directly, or indirectly by making the payment of costs a condition of the amendment; (r) but, on appeal, the law officer may order costs to be paid by either party, and any such order may be made a rule of Court.(s) Where the law officer orders that costs shall be paid by any party, he has power to fix the amount of such costs, and, if he does not fix the amount thereof, he must direct by whom and in what manner the amount of such costs shall be ascertained.(t)

As a general rule, costs of an appeal to the law officer are given against the unsuccessful party, but, in the case of a second amendment, costs will most probably not be given against the opponents, on the ground that second amendments are not to be encouraged if they can possibly be avoided.(u)

Where an applicant appeals from the decision of the Comptroller, on an unopposed application, and the Comptroller is represented at the hearing, the Comptroller does not, except in very special circumstances, either give or receive costs.(x)

In cases where leave is given to apply to amend a specification pending an action for infringement, or proceeding for the revocation of a patent, the Court or a Judge does not as a rule order

(l) 46 & 47 Vict. 57, s. 18, sub-s. 5, 6, and 7.

(m) See pp. 259, 260 ante.

(n) P. R. (1890) r. 57; p. 722 post.

(o) *Ibid.*

(p) 46 & 47 Vict. c. 57, s. 18, sub-s. 9.

(q) *Re Berdan's Patent*, (1875) L. R. 20 Eq. 346.

(r) *Pietschmann's Patent*, (1884)

Griff. P. C. 314; *Codd's Patent*, (1884) Griff. P. C. 305.

(s) 46 & 47 Vict. c. 57, s. 38.

(t) L. O. Rules, r. xi.; *Ashworth's*, (1878) Griff. L. O. C. 9; *Bell's*, (1885) Griff. L. O. C. 11.

(u) See *Haddan*, (1885) Griff. L. O. C. 12.

(x) *Lake*, (1887) Griff. L. O. C. 16.

the applicant to pay to the defendant, or petitioner, his costs of appearing to oppose the application on the hearing before the Comptroller. (y)

Practice
pending
Action or
Petition.

When, however, a plaintiff's application was refused by the Comptroller on the ground that an action was pending and the leave of the Court or Judge had not been obtained, on an application to the Court for leave to apply again to the Comptroller, the Judge made it a condition that the plaintiffs should pay the costs of the first application. (z)

Where, in an action for infringement, the plaintiff obtained the leave of the Judge to apply at the Patent Office for leave to amend, and did so, but subsequently abandoned the action, and then applied, under s. 18 of the Act of 1883, to make a different amendment, the Comptroller and the law officer both refused to make it a condition of allowing the amendment that the applicant should pay the costs of the opponents (who were the defendants in the action) incurred in respect of the opposition to the abandoned application. (a)

In *Morgan's Application* (b) the Comptroller refused to allow an amendment, on the ground that he thought it would enlarge the scope of the invention; but the law officer, on appeal, allowed the amendment, being of opinion that the provisional specification was comprehensive enough to cover the claim to the thing shown in a certain drawing and indicated by the corrected description.

In this case an application was made for a return of the stamp on the notice of appeal, but the law officer refused the application, on the ground that there was sufficient difficulty to justify the Comptroller in declining to allow the amendment, and leaving it to the law officer.

When leave to amend had been obtained, but the amended specification was found defective and the patent revoked on petition on subsequent notice, costs of the motion for leave to amend were not given to either side, though on the one hand the application to amend had succeeded in procuring the amendment, and on the other hand the amendment had failed to render the patent valid. (c)

Amendment pending Action for Infringement, or Petition for Revocation.—If a patentee is desirous of amending his specification during an action for infringement

S. 19 of Act of 1883 applies when there is a pending action for infringement or petition for revocation.

(y) See *Fusee Vesta Co. v. Rylands*, (1889) 4 R. P. C. 71.

(z) *Codd v. Bratby*, (1884) 1 R. P. C. 209, 211.

(a) *Bell*, (1887) Griff. L. O. C. 10.

(b) (1886) Griff. L. O. C. 17.

(c) *Perks v. Deeley*, (1896) 14 R. P. C. 3.

Practice
pending
Action or
Petition.

or proceeding for revocation of a patent, he cannot apply at the Patent Office for the necessary leave without first obtaining the permission of the Court or a Judge to do so, and the authority of the Court or Judge in such cases is limited to granting permission to apply at the Patent Office for leave to amend by disclaimer.(d)

Meaning of
"pending
action for in-
fringement or
petition for
revocation."

The terms "action for infringement" and "proceeding for revocation" here mean an action for infringement and proceeding for revocation before judgment.(e)

In *Cropper v. Smith* (f) the plaintiffs obtained, at the trial, judgment against the defendants, which, however, the Court of Appeal reversed as against one of the defendants, *Hancock*. The plaintiffs thereupon applied to the Comptroller, under s. 18 of the Act of 1883, for leave to apply at the Patent Office to amend the specification by disclaimer, and the defendants opposed the application. The defendant *Hancock* subsequently appealed to the House of Lords, and the Comptroller, being doubtful whether the appeal was a pending action within s. 18, sub-s. 10, of the Act of 1883, refused to proceed with the application until the consent of the Court had been obtained. Accordingly the plaintiffs took out a summons under s. 19 of the Act of 1883 that they might be at liberty to apply at the Patent Office to disclaim. *Chitty, J.*, held that an action for infringement pending means an action before judgment, and further that, final judgment having been given, there was in the present case no action for infringement pending; and the summons was consequently dismissed, but, under the circumstances, without costs.

S. 19 of Act of
1883.

S. 19 of the Act of 1883 (g) deals with the amendment of the specification during an action for infringement or proceeding for the revocation of a patent, and enacts as follows:—

"In an action for the infringement of a patent, and in a proceeding for the 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."

(d) 51 & 52 Vict. c. 50, s. 5; 46 & 47 Vict. c. 57, s. 19.

(e) *Cropper v. Smith*, (1884) 1 R. P. C. 254; L. R. 28 Ch. D. 148; *Lawrence v. Perry*, (1885) 2 R. P. C. 179,

188; *Haslam v. Hall*, (1888) 5 R. P. C. 1, 24.

(f) (1884) 1 R. P. C. 254.

(g) 46 & 47 Vict. c. 57, s. 19.

The above section confers power on the Vice-Chancellor of the County Palatine of Lancaster to grant leave to apply to amend a specification by way of disclaimer pending an action in his Honour's Court.^(h) **Practice pending Action or Petition.**

But it would appear that, since "the Court" means "the High Court of Justice,"⁽ⁱ⁾ the House of Lords has therefore no original jurisdiction under the section.^(k)

When an amendment is actually made under the procedure referred to in s. 18 of the Act of 1883,^(l) it cannot be objected to on the ground that before it was completed an action for infringement had been commenced.^(m) But it would appear that, if proceedings for amendment are commenced under s. 18, and then, before the Comptroller's decision is obtained, an action for infringement or petition for revocation is commenced, the effect of sub-s. 10 of s. 18 of the Act of 1883 as amended by the Act of 1888 ⁽ⁿ⁾ is to suspend the proceedings for amendment upon the commencement of the action or presentation of the petition, and to render it necessary for the applicant to obtain the leave of the Court under s. 19 of the Act of 1883 to proceed with the amendment. The Court has a discretion in such a situation which it must exercise, having regard to the circumstances of each particular case.^(o)

Proceedings for amendment begun under s. 18, but not completed before commencement of action for infringement or petition for revocation.

The leave of the Court or a Judge necessary under s. 19 may be obtained by summons in chambers,^(p) or on motion in Court.

Leave may be obtained by summons or motion.

As a rule, patentees who obtain the consent of the Court or a Judge, pending an action for infringement or proceeding for the revocation of a patent, are not allowed to use the amended specification in evidence in the action or petition as the case may be.^(q) Nevertheless, the patentee may in such a case derive a great benefit from being allowed to make an amendment, for there may be other persons, not parties to the action or proceeding for revocation, who, relying on some defect in the specification, are continuing an infringement on the advice that the patent is bad; and it may be of great importance to the patentee to remedy the defect, and place himself in a position to sue other parties besides the defendants in the action or the petitioners in the proceeding for revocation.

Advantages of amendments under s. 19.

To allow a plaintiff in an action for infringement or a re-

^(h) *Winter v. Baybut*, (1884) 1 R. P. C. 76.

⁽ⁱ⁾ s. 117.
^(k) *Cropper v. Smith*, (1884) L. R. 28 Ch. D. 148, 152; 1 R. P. C. 90.

^(l) p. 276 *ante*.
^(m) *Farbenfabriken, vorms. F. Bayer v. Bowker*, (1891) 8 R. P. C. 389.

⁽ⁿ⁾ p. 276 *ante*.

^(o) See *Deeley's Patent*, (1894) 11 R. P. C. 72.

^(p) *Singer v. Stassen*, (1884) 50 L. T. N. S. 326; 1 R. P. C. 121.

^(q) But see *ante*.

**Practice
pending
Action or
Petition.**

respondent in a proceeding for the revocation of a patent to use in evidence a specification amended pending such action or proceeding would be to give him, when he had originally come to the Court with a patent which could not be relied on, power to put himself in a different position as against the defendant or petitioner; and though the consequences of amendment may be that the plaintiff or respondent is entitled to maintain an action in respect of previous acts, which are infringements of the patent as amended, yet an absolute discretion is vested in the Court to impose, as a condition of leave being granted, that the amended specification shall not be given in evidence so as to enable a patentee to sue on a patent which, at the time when he commenced his action, he could not sue on at all.^(r)

Court has an absolute discretion under s. 19.

The Court has a discretion, unfettered by authority, to grant or refuse leave to apply to amend by disclaimer pending an action for infringement or petition for the revocation of a patent, and to impose such terms and conditions as it may think the justice of each particular case requires,^(s) and the Court of Appeal will not lightly interfere with the discretion of a judge of first instance.^(t)

The result of the decisions appears to be that leave will only be given, under s. 19 of the Act of 1883, where the Court sees its way to make full compensation to those against whom the leave is asked, and that where such compensation can be given then the leave will be given.^(u)

When several actions or petitions are pending leave is only necessary in one.

It is submitted that if there be more than one action for infringement or more than one petition for revocation of a patent, or an action for infringement and a petition for revocation pending, leave may be given, under s. 19 of the Act of 1883, in one such proceeding without application being made in any other proceedings; ^(x) though no doubt the parties to the other proceedings would be protected by the terms imposed by the Court, or by the Comptroller, when granting the leave to amend.

The former practice of the Patent Office in cases where there was more than one action for infringement or petition for revocation, or an action for infringement and petition for

^(r) See remarks of Cotton, L.J., *Bray v. Gardner*, (1887) 4 R. P. C. 43.

^(s) *Allen v. Doulton*, (1887) 4 R. P. C. 377; *Lang v. Whitecross Co.*, (1889) 6 R. P. C. 570.

^(t) *Armstrong's Patent*, (1897) 14 R. P. C. 747.

^(u) Per Kekewich, J., *In the Matter*

of *Gaulard and Gibbs' Patent*, (1888) 4 R. P. C. 191; *Bray v. Gardner*, (1888) 5 R. P. C. 40; *Gaulard v. Lindsay*, (1888) 5 R. P. C. 192.

^(x) See *In the Matter of Hall and others*, (1888) 5 R. P. C. 306, 310; L. R. 21 Q. B. D. 137; but see *Gaulard v. Lindsay*, (1888) 5 R. P. C. 192, 196.

revocation, pending, was to refuse to allow an application for leave to amend, unless the leave of the Court or a Judge was obtained in all the different pending proceedings ; (y) but, it is submitted, the Comptroller would not now refuse to entertain an application made in respect of the leave of the Court, or a Judge, obtained in one only of such proceedings.(z)

**Practice
pending
Action or
Petition.**

The Court or a Judge exercising the power of imposing terms (a) when granting leave to apply at the Patent Office for leave to amend, pending an action for infringement or petition for the revocation of a patent, usually imposes the terms laid down in the case of *Bray v. Gardner*.(b) These terms are that the amended specification shall not be given in evidence at the hearing of the action or petition,(c) and that the costs of, and occasioned by, the plaintiff's or respondent's application, as the case may be, shall be the defendant's or petitioner's in any event; though the terms to be imposed are entirely in the discretion of the Court, and no rule can be given applicable to every case.

Terms usually
imposed by
the Court.

In *Winter v. Baybut*, (1884) 1 R. P. C. 76, a case tried in the Court of the County Palatine of Lancaster, the Vice-Chancellor only imposed the terms that the plaintiffs should pay the defendant's taxed costs of the motion and of the action up to, and inclusive of, the hearing of the motion; and that proceedings in the action should be stayed pending the application to the Patent Office.

In *Singer v. Stassen*, (1884) 1 R. P. C. 121, the Court of Appeal held that s. 19 of the Act of 1883 applied in the case of an action commenced before the Act came into operation, and gave liberty to apply to amend the plaintiff's specification upon the terms that the costs of, and occasioned by, the amendment should be the defendant's in any event; and that the specification, as amended, should not be receivable in evidence in the action; and that the costs of the appeal should be costs in the action, as there had been a substantial failure and a substantial success by both parties.

In *Codd v. Bratby*, (1884) 1 R. P. C. 209, *Chitty, J.*, granted leave to apply under s. 19 of the Act of 1883, on the terms that the specification, when amended, should not be given in evidence at the trial of the action, and that no evidence should be

(y) *Codd's Patent*, (1884) Griff. P. C. 385; *Gaulard and Gibbs*, (1888) 5 R. P. C. 192, 196.

(z) In the Matter of *Hall and others*, (1888) 5 R. P. C. 307; L. R. 21 Q. B. D. 137.

(a) 46 & 47 Vict. c. 57, s. 19.

(b) (1887) 4 R. P. C. 40; *Lang v. Whitecross Co.*, (1889) 6 R. P. C. 570.

(c) But see p. 273 ante.

**Practice
pending
Action or
Petition.**

Terms usually
imposed by the
Court.

given of any infringement prior to the date of the filing of the amended specification ; and that the costs of the motion, and of the previous application to the Comptroller, thrown away by reason of the amendment, be paid by the plaintiff.

In *Fusee Vesta Co. v. Bryant & May*, (1887) 4 R. C. P. 71 *Kay*, J., granted the plaintiffs leave to apply to amend before they had delivered their statement of claim, upon the terms that they paid all costs, in any event, of the defendants of the action up to and including the application consequent on the amendment of the specification ; that no further proceedings should be taken till the disclaimer had been properly made ; that the plaintiffs should undertake, forthwith, to take proceedings for disclaimer, and then to amend the action by stating the disclaimer pending the action on the specification as amended ; failing this, the action to be dismissed.

In *Allen v. Douulton*, (1887) 4 R. P. C. 377, *Huddleston*, B., held, on the authority of *Bray v. Gardner*, that leave to apply to amend should be given to the plaintiffs only on condition that the specification, as amended, should not be receivable in evidence in the action. Upon appeal to the Divisional Court the learned Judges were divided in opinion, and upon appeal to the Court of Appeal it was held that ss. 18 and 19 of the Patents, &c., Act of 1883 give a discretion to the Court or a Judge, to be exercised on the circumstances of each particular case, and which is not fettered by authority ; and that, although there had been no exercise of discretion by the Judges below, yet, having regard to the nature of the proposed amendment, the Court, in the exercise of their discretion, would not interfere with the order.

In *the Matter of Gaulard and Gibbs' Patent*, (1888) 5 R. P. C. 189) was a petition for the revocation of *Gaulard and Gibbs'* patent for a system of distribution of electricity. *Kekewich*, J., granted the respondents leave to apply at the Patent Office to amend, on condition that they paid the petitioner's costs up to date ; and that they applied at the Patent Office forthwith, and prosecuted their application with due diligence. His Lordship also gave the petitioner leave, within fourteen days after the amendment, or after it should be ascertained that no amendment would be made, to discontinue by notice, or, if he did not do that, to have fourteen days to amend the petition and the particulars of objection.

In *Haslam Foundry and Engineering Co. v. Goodfellow*, (1888) 5 R. P. C. 28, *Kay*, J., granted leave under s. 19 of the Patents, &c., Act of 1883, on the following terms: The plaintiffs to pay the costs of the application and the costs of, and occasioned by, the disclaimer ; the plaintiffs and defendants to be allowed to make all necessary amendments in their pleadings after dis-

claimer; the plaintiffs to undertake, forthwith, to amend the pleadings, confining their action to the specification as amended by the disclaimer, or to consent to the action being dismissed with costs.

Practice
pending
Action or
Petition.

In *Gaulard v. Lindsay*, (1888) 5 R. P. C. 192, which was an action for infringement of five patents, a petition for the revocation of one of such patents having been previously presented, and leave to apply for liberty to disclaim having been granted in the petition, *Kekewich, J.*, refused to grant similar leave in the action, but subsequently it was granted by consent by the Court of Appeal. The patentees were allowed to give the amended specification in evidence, but the terms imposed were that the plaintiffs should consent to pay all costs of the action up to the application, and waive all claim to relief in respect of any infringement before the date of disclaimer; and that they should pay the costs of the application, but not on the higher scale.

Terms usually
imposed by the
Court.

In *Lang v. Whitecross Co.*, (1889) 6 R. P. C. 570, *Wills, J.*, gave the plaintiffs leave to apply at the Patent Office for liberty to amend their specification by way of disclaimer. The Judge also gave the plaintiffs leave to use the amended specification as evidence, on condition that no damages should be recovered, or claim for an injunction founded, on anything done before disclaimer, and that the costs of the action up to the time (if disclaimer used) be the defendants' costs in the cause. The Judge further ordered that the costs of the application and the costs caused in the action by the disclaimer should be the defendants' in any event, and that proceedings should be stayed pending the disclaimer. The plaintiffs appealed from this order, and contended that the conditions imposed would prevent them from deriving any advantage from continuing the present action, and that the condition as to damages was not within the jurisdiction of the Judge at Chambers, but the Divisional Court and the Court of Appeal held that the Judge had absolute discretion, under s. 19 of the Act of 1883, to impose terms, and that the order ought not to be interfered with.

It would appear that neither of the House of Lords decisions in the recent cases of *Moser v. Marsden*,^(d) and *Deeley v. Perks*,^(e) have in any way limited the discretion of the Court in giving or refusing leave to apply for amendment.^(f) Seeing that the Court has no jurisdiction as to the making of the amendment, when it has no means of saying whether the amendment should be allowed it would not, it is submitted, as a rule be a proper

Recent de-
cisions have
not limited the
discretion of
the Court.

(d) (1895) 13 R. P. C. 24.

(e) (1896) 13 R. P. C. 581.

(f) See *Dellwick's Patent*, (1896)

13 R. P. C. 591.

Practice
pending
Action or
Petition.

exercise of the discretion to refuse the leave and so force the plaintiff or respondent to go to trial on an unamended specification, if he is willing to accept the leave on such terms as may be necessary to protect his opponent's interests.(g)

It is submitted, however, that where there has been an adverse decision against the patent, including (*inter alia*) a claim which the patentee is desirous of leaving untouched, or only slightly modified, the Court will not, upon a subsequent action for infringement or petition for revocation, exercise its discretion in favour of the applicant, unless it is satisfied that the applicant has substantial grounds of objection to the adverse decision worthy of being submitted to a Court with power to review it.(h) In one case where there was a pending petition for revocation leave to apply at the Patent Office for amendment was refused, on the ground that the patent if amended as desired would be still anticipated by a prior specification pleaded in the particulars.(i)

Procedure
after leave of
the Court has
been obtained
under s. 19 is
regulated by
s. 18 of the
Act of 1883.

When, in an action for infringement or petition for revocation of a patent, permission to apply at the Patent Office for leave to amend a specification has been given by the Court or a Judge, the procedure to be observed in order to obtain the leave desired is that under s. 18 of the Act of 1883,(k) and it does not follow, as a matter of course, that, because the Court or a Judge has given permission to apply, therefore, the Comptroller will grant the application.

When the
Court does not
impose terms
relative to the
action or peti-
tion the Comp-
troller or law
officer does
not do so.

Where, however, the Court or a Judge, in an action for infringement or petition for revocation of a patent, has granted leave to apply to the Comptroller for leave to apply at the Patent Office without imposing any terms, no terms will be imposed by the Comptroller or law officer relative to the action or petition, as the case may be.(l)

(g) See Dellwick's Patent, (1896) 13 R. P. C. 591.

(h) See Deeley's Patent, (1894) 11 R. P. C. 72; 12 R. P. C. 65, in which leave to apply was given, and after amendment the patent was declared void.

(i) Armstrong's Patent, (1896) 13 R. P. C. 501; 14 R. P. C. 747.

(k) In the Matter of Hall, (1888) 5 R. P. C. 306.

(l) Hearson's Patent, (1884) 1 R. P. C. 213.

CHAPTER VII.

OBTAINING LETTERS PATENT FOR INVENTIONS.

DISCRETION OF THE CROWN.

No person can demand protection for an invention by letters patent as of right. The power of the Crown to grant letters patent is purely discretionary. It was exercised during, and most probably previous to, the reign of Edward III.,^(a) and preserved by the Statute of Monopolies,^(b) and is not suspended during the minority or other incapacity of the reigning Sovereign.^(c)

Crown exercises its discretion

The Crown exercises its discretion in the matter of granting patents for inventions through the medium of certain officers referred to in the Patents Designs and Trade Marks Act, 1883—viz., the Comptroller-General of the Patent Office, and the Attorney-General, or the Solicitor-General.

through the medium of certain officers.

The Crown can grant letters patent for an invention only to the true and first inventor or inventors, but the grant may be made to such true and first inventor or inventors alone, or jointly with any other person or persons.^(d)

Every grant of letters patent is made at the grantee's peril, and on condition that it is valid only if one or more of the grantees is or are in fact the true and first inventor or inventors, the invention is new and useful, and the specifications are sufficient to fulfil the requirements of the law; moreover, the Crown in no way whatever guarantees the validity of any letters patent if the representations and conditions on the strength of which it is made are not rigidly correct and fulfilled.

Grant is made at the patentee's peril.

The practice, which it is necessary for any person desirous of obtaining a grant of letters patent to observe, is laid down, and regulated by the Act of 1883 together with the Amending

Practice is regulated by Acts and rules made thereunder.

(a) Year Book, part iv., 40 Edw. III. fol. 17, 18; *Darcy v. Allen*, (1602) Moore's Reps. 675.

(b) 21 Jac. I. c. 3.

(c) Co. Lit. 43b; 5 Co. 27a; 7 Co. 12a.

(d) 21 Jac. I. c. 3, s. 6; 46 & 47 Vict. c. 57, s. 4; 48 & 49 Vict. c. 63, s. 5.

Patent Agents.

Acts of 1885, 1886, and 1888, and the rules and regulations from time to time made by the Board of Trade in pursuance of the powers conferred by that statute.(e)

Except as regards patents binding the Crown and compulsory licences, the Act of 1883 in all respects (including the amount and time of payment of fees) extends to all patents granted before the commencement of the Act, or on applications then pending, in substitution for such enactments as would have applied thereto if the Act had not been passed; and all instruments relating to patents granted before the commencement of the Act required to be left or filed in the Great Seal Patent Office are deemed to be so left or filed if left or filed before or after the commencement of the Act in the Patent Office.(f)

PATENT AGENTS.

It is the usual practice for a would-be patentee to engage the services of a patent agent of experience and skill to aid him in filling up the many necessary forms, drafting the specifications and attending the hearing of oppositions, if any, to the grant of the patent.

The form of application must be signed by the applicant himself, but all other communications between the applicant and the Comptroller, and all attendances by the applicant upon the Comptroller, may be made by or through an agent duly authorised to the satisfaction of the Comptroller, and, if he so require, resident in the United Kingdom.(g)

Qualifications of patent agents.

With a view to avoid the abuse of ill-qualified persons practising as patent agents, Parliament, by the Patents Designs and Trade Marks Act, 1888, provided that, if after the passing of that Act any person describe himself as a patent agent, either 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 the Act,(h) he is liable on summary conviction to a fine not exceeding twenty pounds. But any person who proves to the satisfaction of the Board of Trade that he had been practising *bond fide* as a patent agent prior to December 24, 1888, is entitled as of right to be registered.(i)

(e) 46 & 47 Vict. c. 57, s. 101.

(f) 46 & 47 Vict. c. 57, s. 45.

(g) P. R. (1890) r. 8.

(h) 51 & 52 Vict. c. 50, s. 1.

(i) *Ibid.* sub-s. 3.

It is also provided by the Act of 1888 that persons seeking to be registered as patent agents must satisfy various examination tests, both theoretical and practical, before they are entitled to be placed on the register. Application.

Correct copies of the Register of Patent Agents are published annually, and may be obtained at the Patent Office, or any of the depôts where its publications are kept on sale, for the sum of one shilling. In this list will be found the names and business addresses of all the registered members of the Institute of Patent Agents for the time being. Register of Patent Agents.

The Act further provides (*k*) that the Board of Trade shall have power from time to time to make such general rules as are in the opinion of the Board required for giving effect to the provisions of the Act, and that the provisions of s. 101 of the Act of 1883 (*l*) shall apply to all rules so made as if they were made in pursuance of that section. The Register of Patent Agents' Rules for the time being in force will be found in the Appendix. (*m*) The rules so made by the Board of Trade are submitted to Parliament, and, if not annulled by either House within forty days after they are laid on the table, they acquire the force of an Act of Parliament, and the Courts will not entertain the question of any rules made with the prescribed formalities being *ultra vires*. (*n*) In case of the infraction of any rule for which a penalty is imposed—*e.g.*, practising as a patent agent without registration—the proper course is for the Institute of Patent Agents to prosecute for the penalty, and it is incompetent for the Institute or any other person aggrieved to proceed by way of action for injunction in the Supreme Court. (*o*) Register of Patent Agents' Rules.

A person is entitled to act on behalf of another, in the matter of obtaining a patent, as an ordinary agent, and may so describe himself on every document without fear of prosecution. He is not entitled to describe himself as a "patent agent." (*p*) Any one may act as an ordinary agent.

APPLICATION.

Any person, whether a British subject or not, is entitled to make an application for a patent, and two or more persons may Any person may make an application.

(*k*) s. 1, sub-s. 2; p. 684 *post*. Agents *v.* Lockwood, (1893) 10 R. P. C. 167; 11 R. P. C. 374.
 (*l*) 46 & 47 Vict. c. 57, s. 101; p. 671 *post*. (*o*) *Ibid.*
 (*m*) p. 735 *post*. (*p*) Graham *v.* Fanta, (1872) 9 R. P. C. 164.
 (*n*) Chartered Institute of Patent

**Applica-
tion.**

How the appli-
cation must be
made.

make a joint application, and a patent may be granted to them jointly.(*q*)

The application must be made on one of the forms set forth in the first schedule to the Act of 1883, or in such other form as may be from time to time prescribed.(*r*)

If an invention is partly original and partly communicated from abroad, it is doubtful whether it is incumbent on the applicant to distinguish which is which ;(*s*) and it is an undecided point whether or not the omission to do so would render the patent void.(*t*)

Form A is not applicable to the case of a corporation, but is intended for personal applicants who are true and first inventors. Form A I is intended for use where there has been a communication from abroad, whether the communicator is a corporation or a private individual.(*u*)

Application
must be left
at or sent by
post to the
Patent Office,

The applicant having filled up the form of application, which must be signed by himself, must leave it at, or send it by post to, the Patent Office. If sent by post as a prepaid letter it will be deemed to have been left at the Patent Office at the time when the letter containing the same would be delivered in the ordinary course of post, and, in case it becomes necessary to prove such sending, it will be sufficient to prove that the application was properly addressed and posted.(*v*)

and must con-
tain a declara-
tion, and be
accompanied
by a specifi-
cation.

The application must contain a declaration, which may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed,(*y*) to the effect that the applicant is in possession of an invention whereof he claims, 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 a complete specification.(*z*)

Where the provisional specification is accepted it cannot be impeached as being too general.(*a*)

(*q*) 46 & 47 Vict. c. 57, s. 4; 48 & 49 Vict. c. 63, s. 5.

(*r*) 46 & 47 Vict. c. 57, s. 5, sub-s. 1. The forms at present in use for this purpose will be found in the second schedule to the Patent Rules (1890); see Appendix.

(*s*) Renard *v.* Levinstein, (1864) 10 L. T. N. S. 177.

(*t*) *Re* Avery's Patent, (1887) L. R. 36 Ch. D. 307; Moser *v.* Marsden, (1893) 10 R. P. C. 209, 350.

(*u*) Société Anonyme du Générateur du Temple's Patent, (1896) 13 R. P. C. 54.

(*x*) 46 & 47 Vict. c. 57, s. 5, sub-s. 1; s. 97; P. R. (1890) r. 16a.

(*y*) 48 & 49 Vict. c. 63, s. 2.

(*z*) 46 & 47 Vict. c. 57, s. 5, sub-s. 2. As to size of paper drawings, &c., see P. R. (1890) rr. 10, 30-33; see Appendix.

(*a*) Penn *v.* Bibby, (1866) L. R. 2 Ch. App. 127.

The form of declaration at present in use (*b*) is not a declaration, under the Statutory Declarations Act, 1835.

Application.

Statutory declarations required for use in the Patent Office are to be made and subscribed as follows (*c*):—

Statutory declarations for use in the Patent Office are to be made and subscribed in a certain manner,

- (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.

If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration, or doing anything required or permitted by the Act of 1883, or by any rules made thereunder, then the guardian or committee (if any) of such incapable person, or, if there be none, any person appointed by the 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 are, for the purposes of the Act, as effectual as if done by the person for whom he is substituted. (*d*)

A statutory declaration, made under the provisions of the Statutory Declarations Act, 1835, and forming part of an application for a patent, in conformity with the Patents, Designs, and Trade Marks Act, 1883, is exempt from the stamp duty charged on a statutory declaration, under the provisions of the Stamp Act, 1870. (*e*)

and are exempt from duty under Stamp Act, 1870.

An application for a patent should comprise only one invention. It is provided by the Act of 1883 (*f*) that every patent shall be granted for one invention ; though, if a patent should, by

Application should comprise only one invention.

(b) See Appendix.

(c) P. R. (1890) r. 17 ; see Appendix.

(d) 46 & 47 Vict. c. 57, s. 99.

(e) 47 & 48 Vict. c. 62, s. 9.

(f) s. 33.

**Examina-
tion and
Accept-
ance.**

Every appli-
cation is re-
ferred to an
examiner ap-
pointed under
the Act of 1883
to discharge
certain duties.

inadvertence, be made to include several inventions, it is not competent for any person, in an action, or other proceeding, to take any objection on the ground that it comprises more than one invention. *(g)*

Examination and Acceptance.—Every application for a patent is referred by the Comptroller-General to an examiner appointed under the Act of 1883, *(h)* whose duty it is to ascertain whether the nature of the invention has been fairly described, and the application, specification, and drawings (if any) have been prepared in the prescribed manner, and whether the title sufficiently indicates the nature of the invention. *(i)* It is also the examiner's duty to report whether the invention is contrary to law and morality, *(k)* and whether the application comprises more than one invention. *(l)* 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, or that the invention is contrary to law and morality, or that the application comprises more than one invention, the Comptroller may, subject to appeal to the law officer, refuse to accept the application, or require that the specification or drawings be amended before he proceeds further; and in the latter case the application must, if the Comptroller so directs, bear date as from the time when the requirement is complied with. *(m)*

Comptroller
acts on the
report of the
examiner.

It is not the duty of the examiner to make any search with the object of ascertaining whether there are existing complete specifications which would render the patent void for want of novelty. This consideration does not influence the Patent Office officials, and the patent is granted at the applicant's peril. It might be of real benefit to inventors, and the public, if the law were altered so as to allow of an official search being made and to give the Comptroller power, as in the case of trade marks, to refuse—subject, of course, to appeal—a patent on the express ground of lack of novelty and invention, having regard to subsequent specifications. This would in many instances save much expense to persons wrongly supposing themselves to be first and true inventors.

Right of appeal

The Comptroller is not entitled to exercise any discretionary

(g) 46 & 47 Vict. c. 57, s. 33.

(h) 46 & 47 Vict. c. 57, s. 83.

(i) 46 & 47 Vict. c. 57, s. 6. See
chap. v.

(k) 46 & 47 Vict. c. 57, s. 86.

(l) 46 & 47 Vict. c. 57, s. 33.

(m) 51 & 52 Vict. c. 50, s. 2.

power adversely to an applicant without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.⁽ⁿ⁾

**Examina-
tion and
Accept-
ance.**

In any case where a person, having the right, intends to appeal to the law officer from a decision of the Comptroller, he must, within fourteen days from the date of the decision appealed against, file in the Patent Office a notice of such intention, stating the nature of the decision appealed against, and whether the appeal is from the whole or part only, and if so what part, of the decision, and he must otherwise conform to the Law Officer's Rules.^(o) In all cases of appeal to the law officer it is desirable that a statement of fees paid be handed in to the law officer, so that he may have it before him when considering the question of costs.^(p) Where the right of appeal to the law officer lies against a decision of the Comptroller, the effect of Nos. 1 and 2 of the Law Officer's Rules is to limit the hearing before the law officer to points specifically raised by the notice of appeal, and where a notice of appeal is given as to parts only of the Comptroller's decision, the person receiving such notice, if he desires to question other parts of the Comptroller's decision, must give a counter notice. If the original notice of appeal is only given just before the expiration of the fourteen days, the time for giving a counter notice may be extended under Rule 5.^(q)

to the law
officer from
any decision
of the Comp-
troller.

The Act of 1883 gives the law officer control over the costs of the proceedings before him, but there is no such provision in the case of proceedings before the Comptroller.^(r)

Costs.

As a general rule the costs of an appeal to the law officer follow the event,^(s) unless there has been unfair conduct;^(t) and where an appeal is withdrawn the opponent pays the costs.^(u)

In *Brown's Application* ^(x) for a patent under the title "improvements in casks and tubs," accompanied by a complete specification in the first instance, which stated that the invention was applicable to barrels or other casks and also to tubs *and analogous vessels*, in which the staves are formed with a croze

**Example of an
objection to
the title.**

⁽ⁿ⁾ 46 & 47 Vict. c. 57, s. 94; see P. R. (1890), rr. 11-14.

^(o) See Appendix.

^(p) See remarks of Webster, A.G., in the Matter of Sielaff's Application, (1888) 5 R. P. C. 487.

^(q) In the Matter of Bairstow's Patent, (1888) 5 R. P. C. 289.

^(r) 46 & 47 Vict. c. 57, s. 38.

^(s) Anderton, (1885) Griff. L. O. C.

25; *Ex parte Fox*, (1812) 1 V. & B. 67; 1 W. P. C. 431n.

^(t) *Re Lowe's Patent*, (1856) 25 L. J. N. S. Ch. 456.

^(u) *Knight*, (1886) Griff. L. O. C. 35; *Re Copley's Patent*, (1861) 3 Jur. N. S. 106; *Re Ashenurst's Patent*, (1853) 2 W. R. 3.

^(x) (1887) Griff. L. O. C. 1.

Examina-
tion and
Accept-
ance.
—

or groove for receiving the head or bottom, and the object of the invention was to secure the bottom or head against outward displacement, and also to support the staves beyond the croze against any force or blow delivered upon the exterior of the staves such as would tend to break off their ends projecting beyond the croze, the Comptroller refused to accept the specification unless the words "and analogous vessels" were added to the title or omitted from the specification, on the ground that the title did not, in view of the words "and analogous vessels" in the body of the specification, sufficiently indicate the subject-matter of the invention. The law officer on appeal, however, reversed the Comptroller's decision, being of opinion that the title, taken together with the claims, which were specific, was sufficient, and he also pointed out that the patentee is entitled to frame his title in his own way, provided he does not infringe the rules of the statute.

Application
refused as
comprising
more than one
invention may
be amended by
limitation to
one invention.

If the Comptroller refuse to accept an application on the ground that it includes more than one invention, the person making it may amend it so as to apply to one invention only, and may make application for separate patents for each of such inventions accordingly, and every such application must bear the date of the first application and must be proceeded with as if it had been originally made on that date for one invention only. (y)

Test of one
invention.

Lord *Herschell*, when Solicitor-General, (z) gave it as his opinion that the general object of the invention is the test by which the question of one invention must be decided, and in reference to a particular case said:—

"If you have a particular general object of an invention to make rails rest more securely, and you describe one, or two, or three devices of an analogous nature, cognate devices, for carrying it into effect, I should say they were all one invention; but if there is no common purpose, so that you could say, 'I use this as a substitute for that,' both serving the same purpose, although there is some difference between them, but they are to serve some different purpose, there is no connection between them, except that both are used in connection with rails, and it strikes me that would be two inventions. I should always allow alternative devices for producing a particular object as one invention. But if you say, 'I have invented six different kinds of railway sleepers, each of which has its own merits and purposes and objects distinct,' then those are six inventions."

(y) P. R. (1890) r. 19.

(z) Jones's Patent, Griff. P. C. 265.

The following two cases are given as illustrations of the circumstances in which an applicant is required to amend his application so as to limit it to one invention only.

Examina-
tion and
Accept-
ance.

In *Hearson's Patent*, (1885) Griff. P. C. 266, an applicant applied for a patent, under the title "Improvements in apparatus for rapidly heating flowing water, *a part of which improvements is applicable to other purposes*," and after describing in his provisional specification an apparatus consisting of several parts, including improved mechanism, by which the turning of the taps of a geyser, otherwise than in the required order, was prevented, stated: "The arrangements hereinbefore described for locking the water and gas-cocks is applicable to oxyhydrogen light apparatus, and to other apparatus in which two cocks, or a number of cocks, are required to be turned in a certain order," he was ordered to amend his application by striking out from the title the words in italics. Both the Comptroller and the law officer were of opinion that the application, as it stood before amendment, included more than one invention, and the latter pointed out that the applicant was entitled, if he so desired, to make a separate contemporary application for his new and improved cock, or arrangement of cocks by itself, and that he might of course describe the cock, or arrangement of cocks, as part of his combination or apparatus which he claimed to have invented, but that he should in doing so refer to his contemporary application if he desired to make one.

Examples of
cases in which
amendment by
limitation to
one invention
is required.

In *Robinson's Patent*, Griff. P. C. 267, a person applied for a patent for an invention of "improvements in the art of producing and utilising induced electrical currents for telegraphy and other purposes," and it appeared that the invention consisted in the employment in telegraphic transmitting and receiving instruments of a certain appliance. The Comptroller objected to the title, stating that the appliance could be applied to purposes other than telegraphic, and required an amendment so as to limit the invention to such purposes, and held that, if the applicant desired to claim the general use of the appliance for the production of induced currents, it must form the subject of a separate patent.

On appeal, the law officer informed the applicant that if he intended to claim, as a combination, the whole of the apparatus as one telegraphic apparatus, then it might all be included in one specification; but if he was including, for all purposes, the invention of "the appliance," then it was something different, which could not be protected by the same patent. The law officer further stated that he would allow that, if the whole were limited to telegraphy, because that would make an

**Statutory
Offences.**

improved telegraphic arrangement, and although consisting of several parts, he would allow it to be included in one patent; but if there were to be two separate things, which could only be allowed together because they went to make up one better kind of instrument or machine, then he would never allow the use of a part of that for a purpose independent of the main object of the machine.

It was therefore a question for the applicant whether it answered his purpose better to protect "the appliance" for all purposes, or to protect improved telegraphic apparatus, consisting of the employment of "the appliance" therein. The applicant elected to take a patent for the general use of "the appliance," and the law officer allowed the title to be amended to "improvements in the art of producing and utilising induced electrical currents," the description of the telegraphic apparatus being struck out of the provisional specification.

Separate patents granted to joint applicants who are inventors of distinct parts.

If an application be made by two or more joint applicants, and it appears that the invention consists of distinct parts, invented separately by the applicants respectively, it seems that separate patents will be granted to the actual inventors in respect of the separate and distinct parts.(a)

Notice of acceptance of application.

If the application is accepted the applicant will receive due notice to this effect,(b) and the invention may, during the period between the date of the application and the date of sealing the patent, be used and published without prejudice to the patent to be granted for the same;(c) though the applicant is not entitled to sue in respect of infringements of the invention committed before the acceptance and publication of the complete specification.(d)

Representation that an article is patented where no patent has been granted.

Statutory Offences.—S. 105 of the Act of 1883 provides that any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, shall be liable for every offence, on summary conviction, to a fine not exceeding five pounds. The effect of s. 15 of the same Act, however, is to render it no offence to represent an article as "patented" when the complete specification has been accepted, though the patent has not been sealed.(e)

(a) See Craig and Macfarlane's Application, P. M. J. vol. iv. 3rd series, p. 366.

(b) 51 & 52 Vict. c. 50. s. 2 (4).

(c) 46 & 47 Vict. c. 57, s. 14; p. 138 ante.

(d) 46 & 47 Vict. c. 57, s. 13; p. 139 ante; chap. xiii. post.

(e) R. v. Townsend, (1896) 13 R. P. C. 265; In R. v. Wallis, (1886) 3 R. P. C. 1; and R. v. Crampton, (1886) 3 R. P. C. 367, fines were inflicted.

It is not an offence under the Act of 1883 to represent an article as patented when the patent has expired.^(f)

A person is deemed to represent that an article is patented if he sells the article with the word "patent," "patented," or any other word expressing or implying that a patent has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to the article.^(g)

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, is liable, on summary conviction, to a fine not exceeding twenty pounds.^(h)

In Scotland, any offence under the Act of 1883 declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.⁽ⁱ⁾

The punishment for a misdemeanour, under the Act of 1883, in the Isle of Man, is 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.^(k) And any offence committed in the Isle of Man, which would in England be punishable on summary conviction, may be prosecuted, and any fine in respect thereof recovered, at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.^(l)

Filing the Complete Specification.—If an applicant does not leave a complete specification with his application, he may leave it at any subsequent time within nine months, or, on obtaining the leave of the Comptroller on payment of the prescribed fee, within a further extended period of one month^(m) from the date of application, but, unless a complete specification is left within that time, the application will be deemed to be abandoned.⁽ⁿ⁾

Filing
Complete
Specifica-
tion.

Unauthorised
use of the Royal
Arms.

Penalties in
Scotland.

Penalties in
the Isle of
Man.

Complete
specification
must be filed
within nine,
or upon leave
ten, months
from date of
application.

^(f) *Cheavin v. Walker*, (1877) L. R. 5 Ch. D. 850.

^(g) 46 & 47 Vict. c. 57, s. 105, sub-s. 2; but see *Cheavin v. Walker*, (1877) L. R. 5 Ch. D. 863; *Linoleum Co. v. Nairn*, (1877) L. R. 7 Ch. D. 834.

^(h) 46 & 47 Vict. c. 57, s. 106.

⁽ⁱ⁾ 46 & 47 Vict. c. 57, s. 108.

^(k) 46 & 47 Vict. c. 57, s. 112, sub-s. 2.

^(l) 46 & 47 Vict. c. 57, s. 112, sub-s. 3.

^(m) 48 & 49 Vict. c. 63, s. 3; see P. R. 1890, rr. 50, 51.

⁽ⁿ⁾ 46 & 47 Vict. c. 57, s. 8; see also 46 & 47 Vict. c. 57, s. 98.

Filing
Complete
Specifica-
tion.

The nine months is reckoned exclusively of the day of the date of the application.(o)

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 are not at any time open to public inspection, or published by the Comptroller.(p)

If a provisional specification is left with the application a fee of £1 is payable, and a further fee of £3 becomes due on the filing of the complete specification, whereas, if a complete specification is left with the application, a fee of £4 must be paid at the same time.(q)

The complete specification must be signed by the applicant or his authorised agent, but in the case of a joint application the Comptroller will not refuse to accept the complete specification on the ground that it is only signed by, or only on behalf of, one applicant.(r)

Reference of
the complete
specification
to an examiner.

The complete specification is referred to an examiner, whose duty it is to report whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification, and, if the examiner reports that it is not so, the Comptroller is empowered to refuse to accept the complete specification unless and until it shall have been amended to his satisfaction; any such refusal, however, is subject to appeal to the law officer, who must, 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.(s)

Comptroller,
subject to
appeal to law
officer, may
refuse the com-
plete specifica-
tion or require
it to be
amended.

The requisite amendment, if any, is to be determined by the judicial act of the Comptroller, subject to appeal to the law officer. The function of deciding what the amendment is to be is not delegated by the Act to the examiner, though the application proceeds if he reports favourably to the applicant.(t)

The fact that the complete specification narrows the scope of the provisional is not a ground on which the Comptroller or law officer is justified in refusing it.(u) Thus in *Everitt's Application* (x) the Comptroller refused to accept the complete speci-

(o) *Russell v. Ledsam*, (1843) 14 M. & W. 572, 582; 16 M. & W. 633; *Williams v. Nash*, (1859) 28 Beav. 93.

(p) 48 & 49 Vict. c. 63, s. 4.

(q) See Table of fees in the Appendix.

(r) In the Matter of Grenfell and McEvoy's Patent, (1890) 7 R. P. C. 151.

(s) 46 & 47 Vict. c. 57, s. 9 (1), (2), (3); see in the Matter of Anderson's Patent, (1890) 7 R. P. C. 323.

(t) See *C.'s Patent*, (1890) 7 R. P. C. 256.

(u) *Everitt*, (1886) Griff. L. O. C. 27, p. 163 *ante*.

(x) (1888) Griff. L. O. C. 27.

fication on the ground that it claimed only a special means of carrying a principle into effect, whilst the provisional was apparently for the principle, but this decision was reversed on appeal, on the ground that in law the Comptroller was not entitled to refuse to accept the complete specification, which only narrowed down the ambit of the provisional and did not go outside it.

Filing
Complete
Specifica-
tion.
—

Also, if the specification ends with a real statement of the invention claimed, distinct from the description in the body of the document, it is not competent to the Comptroller or law officer to inquire whether the claim is in conformity with the description or not. A claim to an improved machine, "substantially as described," is not a distinct statement within the meaning of sub-s. 5, s. 5, of the Act of 1883, and is not sufficient.^(y)

Reports of examiners are not in any case published or open to public inspection, and are not liable to production or inspection in any legal proceedings under the Act of 1883, unless the Court or officer having power to order discovery in such legal proceedings shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed.^(z) It consequently follows that where there are two applicants for a patent for the same or analogous inventions, each cannot know the nature of the other's specification until the rival complete specifications themselves are accepted and open to public inspection.^(a)

Reports of
examiners are
not published.

Sub-s. 5 and 6 of s. 7 of the Act of 1883 were found in practice to be useless, and to give rise to much hardship and blackmailing, perpetrated by prior against later applicants, and they were abolished by the Act of 1888, which substituted a new section for s. 7 of the original Act of 1883, and *inter alia* provides that ^(b) "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."

Subsequent
application
before seal is
obtained in
respect of a
prior applica-
tion.

^(y) Smith's Patent, Griff. P. C. 268.

^(a) 46 & 47 Vict. c. 57, s. 10.

^(z) 46 & 47 Vict. c. 57, s. 9, sub-s. 5;
51 & 52 Vict. c. 50, s. 3.

^(b) 51 & 52 Vict. c. 50, s. 2.

**Filing
Complete
Specifica-
tion.**

In cases where the Comptroller refuses to accept an application or requires an amendment, the applicant has the right of appeal to the law officer, who must, 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. (c)

The above-mentioned substituted s. 7 and s. 9 of the Act of 1883 (d) do not define any limits within which the Comptroller may require an amendment of the specifications before the final specification is accepted.

**Amendment
of a complete
specification
before and
after accept-
ance.**

It may happen that the applicant himself may desire to amend his specifications before the seal is obtained. It is submitted that if this is so the Comptroller may under the substituted s. 7 and s. 9 of the Act of 1883 allow the amendment before acceptance of the complete specification (e) in the form of a requirement by him. On the other hand, it is also submitted that if the applicant is so minded he may proceed under s. 18 of the Act of 1883 (f) and obtain amendment under that section even though the complete specification has not been accepted. (g) If the complete specification has not become open to public inspection (h) there is no necessity for the advertisement of the request for leave to amend under s. 18. (i)

**Disagreement
by joint appli-
cants as to
form of speci-
fication.**

When joint applicants disagree as to the form of the complete specification and desire to file separate specifications, the Comptroller and law officer have no jurisdiction to decide between them, or to accept two separate specifications, or to accept a specification at all, unless the parties come independently to an agreement and settlement as to its form. (k)

**Acceptance
of complete
specification
is no guaran-
tee in law.**

The acceptance of a specification by the Comptroller is no guarantee that it is good in law. The Comptroller is only required to be satisfied that the specification is prepared in the prescribed manner, and that the invention particularly described in the complete is substantially the same as that described in the provisional specification.

Acceptance of

If a complete specification is not accepted within twelve

(c) 51 & 52 Vict. c. 50, s. 2. The practice on appeal to the law officer is regulated by the Law Officer's Rules: see Appendix.

(d) 46 & 47 Vict. c. 57, s. 9; 50 & 51 Vict. c. 50, s. 2.

(e) Dart's Patent, Griff. P. C. 307.

(f) p. 275 ante.

(g) Jones's Patent, Griff. P. C. 313.

(h) p. 303 post.

(i) Jones's Patent, Griff. P. C. 313. In this case the complete specification was not yet open to public inspection. The term "public property" in the Attorney-General's judgment probably referred to the date of lodging the specification.

(k) Apostoloff's Patent, (1896) 13 R. P. C. 275.

months from the date of application, or within a further extended period of three months, on obtaining the leave of the Comptroller and payment of the prescribed fee,^(l) then (save in the case of an appeal having been lodged against the refusal to accept) the application at the expiration of such period becomes void.^(m)

Foreigner's
Applica-
tion.

complete speci-
fication must
take place
within a defi-
nite period.

When the complete specification is accepted, the Comptroller is required by the Act of 1883 to advertise the acceptance in the official journal of the Patent Office, and the application and specification or specifications, with the drawings (if any), are thereupon open to public inspection and may be inspected at the Patent Office upon payment of the prescribed fee.⁽ⁿ⁾

When a com-
plete specifica-
tion becomes
public.

Foreigner's Application.—In order to enable the British Government to join the "Union for the Protection of Industrial Property," which consists at present of the following States—Great Britain, Belgium, Brazil, Spain, France, Guatemala, Italy, Holland and its East Indian colonies, Portugal, Servia, Switzerland, Norway, Sweden, Tunis, the United States, and Mexico—it is provided by s. 103 of the Act of 1883, as amended by s. 6 of the Act of 1885, as follows:

Foreign appli-
cants.

"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, then any person who has applied for protection for any invention in any such State shall be entitled to a patent for his invention under the Act of 1883, in priority to other applicants; and such patent shall have the same date as the date of application in such foreign State: provided that his application is made within seven months from his applying for protection in the foreign State with which the arrangement is in force: And provided further that the patentee shall not be entitled to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification."

The word "person" includes "corporation," and so the section gives the same rights of priority to foreign corporations as to individuals.^(o)

It is also enacted that the publication in the United Kingdom or the Isle of Man, during the above period of seven months, of any description of the invention, or the use therein during such

(l) 48 & 49 Vict. c. 63, s. 3.

(m) 46 & 47 Vict. c. 57, s. 9 (4).

(n) 46 & 47 Vict. c. 57, s. 10; P. R. (1890) rr. 21, 22.

(o) Carey's Patent, (1889) 6 R. P. C. 552; Société Anonyme du Générateur du Templé's Patent, (1896) 13 R. P. C. 56.

Foreigner's period of the invention, shall not invalidate the patent which
 Application. may be granted for the same.

This latter provision does not apply in all cases where a patent has been previously obtained in a foreign country, but is only applicable, as part of the general provisions of s. 103 of the Act of 1883, to cases where the patentee avails himself of the privilege given by that section. The Act gives a foreign patentee, who has obtained a patent in a State which has joined the convention, a double right—viz., either to apply in this country for a patent ante-dated to the date of his foreign application, or, running the risk of publication, to obtain a patent in the ordinary way for the full period from the date of application. (*p*)

The application for the grant of a patent under the above provisions must be made in the same manner as an ordinary application; and those provisions apply only in the case of those foreign States with respect to which her Majesty shall, from time to time, by Order in Council, declare them to be applicable, and so long only in the case of each State as the Order in Council shall continue in force with respect to that State. (*q*)

Retrospective effect of Order in Council.

An Order in Council, made under the above provisions, has a retrospective effect. Thus, where a person has applied for a patent in a foreign State or British possession to which the provisions of s. 103 of the Act of 1883 have not been extended at the date of the application, he is entitled, during the period of seven months from the date of such application (if it is the first foreign application he has made) to a British patent, bearing the date of such application, if the provisions of s. 103 of the Act of 1883 have been extended to such foreign State or British possession before the expiration of such period of seven months. (*r*)

Provisions of s. 103 of Act of 1883 may by order in Council be applied to British possessions.

The Act of 1883 further empowers her Majesty, where it is made to appear to her that the legislature of any British possession has made satisfactory provision for the protection of inventions patented in this country, by Order in Council (to take effect as if its provisions had been contained in the Act, and from the date fixed by the Order), to apply the above provisions with such variations or additions, if any, as to her Majesty in Council may seem fit; and it is lawful for her Majesty in Council to revoke any such order. (*s*)

(*p*) British Tanning Co. Ltd. v. Groth, (1891) 8 R. P. C. 113.

(*q*) 46 & 47 Vict. c. 57, s. 103, (3) and (4).

(*r*) In the Matter of Main's Patent, (1890) 7 R. P. C. 13.

(*s*) 46 & 47 Vict. c. 57, s. 104; see International Convention in the Appendix

A patent in this country can only be granted under the provisions of s. 103 of the Act of 1883, to the person who has actually made application for protection in the foreign State, and not to another person on his behalf.^(t)

Moreover, s. 103 of the Act of 1883 does not confer any rights on a person making an application for a British patent, in respect of an invention communicated to him from abroad. The rights conferred by the section are personal, and intended to encourage people who have invented abroad to come to this country and to make known their inventions.^(u)

L'Oiseau and Pierrard's Application^(x) is an instance of the advantages conferred on foreign applicants by s. 103 of the Act of 1883. In that case the applicants applied for a patent for "automatic apparatus for subjecting the person to the action of electric currents," which was opposed by one *Everitt*, on the ground that his prior application, in which his complete specification had been accepted, for a patent for "improvement in completing electric currents," contained the subject-matter of the applicant's alleged invention. It appeared, however, that *L'Oiseau and Pierrard* had obtained a patent for their invention in France within seven months of their application in England, and on an application in France of earlier date than *Everitt's* application in England. *L'Oiseau and Pierrard* were therefore held entitled to an English patent, under the Act of 1883 and the Convention of 1884, to the disadvantage of *Everitt*.

When a foreigner makes an abortive application in a foreign country, and then a successful application, before applying in this country, the British patent is antedated to the date of the successful foreign application.

Thus when a person on February 8, 1887, made an application in America for a patent, which became abortive, and on September 7, 1887, renewed his application, and then on April 8, 1888, made an application for a British patent, under s. 103 of the Act of 1883, to bear date September 7, 1887, the Comptroller refused the application. The law officer reversed the Comptroller's decision, and ordered a patent to be granted and dated September 7, 1887, on the ground that the patentee had no subsisting rights

Foreigner's Application.

Only the person who actually made the foreign application is recognised.

The rights conferred by s. 103 are personal.

Effect of an abortive foreign application.

^(t) In the Matter of Shallenberger's Application, (1889) 6 R. P. C. 550; in the Matter of Carey's Application, (1889) 6 R. P. C. 552.

^(u) In the Matter of Shallenberger's Application, (1889) 6 R. P. C. 550.
^(x) (1887) Griff. L. O. C. 36.

Foreigner's under his abortive application in America, of February 8, 1887.(*y*)

**Applica-
tion.**
—
Practice on
applications
under s. 103
of the Act of
1883.

A foreigner applying for a British patent under the provisions of s. 103 of the Act of 1883 must include in his application a declaration that the foreign application as defined by the Patent Rules 1890 has been made,^(z) and must specify the foreign States or British possessions in which foreign applications have been made, and the official date or dates thereof respectively. The application must be made within seven months from the date of the first foreign application, and must be signed by the person or persons by whom such first foreign application was made. If such person, or any of such persons, be dead, the application must be signed by the legal personal representative of such dead person, as well as by the other applicants, if any.^(a)

The application in the United Kingdom must be made in the Form A2,^(b) and must be accompanied by a specification, provisional or complete, together with :—

- (1) A copy or copies of the specification, and drawings or documents corresponding thereto, filed or deposited by the applicant in the Patent Office of the foreign State or British possession, in respect of the first foreign application, duly certified by the official chief or head of the Patent Office of such foreign State or British possession, 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 must be annexed, to and verified by such statutory declaration.^(c)

Minor differences of departure in an applicant's English specification may be allowed, if the Comptroller and law officer are enabled, by the agreed translation of the foreign specification,

(*y*) In the Matter of Van de Poelle's Patent, (1890) 7 R. P. C. 69.

(*z*) "Foreign application" means an application by any person for protection of his invention in a foreign State, or British possession, to which by an order of her Majesty in Council for the time being in force the provisions of s. 103 of the Act of 1883 have

been declared applicable, see Patent Rules (1890), r. 24.

(*a*) See P. R. (1890) r. 25.

(*b*) See Appendix.

(*c*) See P. R. (1890) r. 26; for further details as to practice on applications under s. 183 of Act (1883) see rr. 27, 29.

to conclude that the inventions referred to in the two documents are substantially the same.^(d) Should the British patent, however, be granted for an invention different to that forming the subject of the foreign application, this fact may seriously affect the validity of the patent.^(e)

Opposi-
tion—
General.
—

Though when a foreigner applies for a British patent under the provisions of s. 103 of the Act of 1883 his specification must not claim any invention which is not included in his foreign patent, the British specification may contain a description of an invention not included in the foreign patent, but the claim must be limited to the invention protected in the foreign State.^(f)

OPPOSITION.

By s. 11 of the Patents, Designs and Trade Marks Act, 1883, as amended by the Act of 1888, which (*inter alia*) relieved the Patent Office officials of the necessity of sending notices of interferences to prior applicants or patentees,^(g) it is enacted as follows:—

S. 11 of Act
of 1883 as
amended by
Act of 1888.

“(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 that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification, but on no other ground.

“(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

^(d) L'Oiseau and Pierrard, (1887) Griff. L. O. C. 37; in the Matter of Main's Patent, (1890) 7 R. P. C. 13.

^(e) Averey's Patent, (1887) 4 R. P. C. 152; Renard v. Levinstein, (1864) 10 L. T. 177; Milligan v. Marsh, (1856)

2 Jur. N. S. 1083; Moser v. Marsden, (1893) 10 R. P. C. 209.

^(f) L'Oiseau and Pierrard's Patent, (1887) Griff. L. O. C. 36.

^(g) 51 & 52 Vict. c. 50, s. 4.

Opposi-
tion—
General.

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

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

Opposition is
allowed on
only three
grounds.

Hence the only grounds on which a person entitled so to do may oppose the grant of letters patent are—

- (1) That the applicant has obtained the invention from him, or from a person of whom he is the legal representative.
- (2) That the invention has been patented in this country, on an application of prior date.
- (3) That the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification.

Formerly, want of novelty, non-utility, and lack of subject-matter were all grounds of opposition, but the effect of the Act of 1883 is to abolish the right of the opposer to raise any of these grounds on an application for a patent; though, if the patent is granted, the Crown in no way guarantees that it may not be upset on one or other of these points in subsequent proceedings.^(h)

When the two months time limit for giving notice of opposition has expired, it is submitted, a would-be opponent can only obtain leave to oppose by obtaining a *fiat* from the Privy Council.

Notice of
opposition.

A person entitled so to do, and desirous of opposing a grant of letters patent, must, within the two months allowed from the date of the advertisement of the acceptance of the complete specification, give a notice of his opposition at the Patent Office, on Form D, stating the ground or grounds on which he intends to oppose, and he must himself sign the notice, stating his address, for service in the United Kingdom;⁽ⁱ⁾ and, if he opposes on the ground that the invention has been patented in this country on an application of prior date, the notice must specify the title, number, and date of the patent granted on such prior application.^(k)

The Comptroller has power to allow an amendment of an

^(h) p. 289 *ante*.

⁽ⁱ⁾ P. R. (1890) r. 34.

^(k) P. R. (1890) r. 36. The practice

on oppositions to grants of patents is regulated by the Patent Rules (1890), rr. 34-44, and the Law Officer's Rules.

improperly drawn notice of opposition to be made at the hearing, but he cannot impose terms.^(l)

Opposi-
tion—
General.
—

On giving the notice of opposition the opponent is required to pay a fee of ten shillings, and on the hearing of the opposition both the applicant and the opponents are required to pay a fee of one pound.^(m)

The Comptroller will, on receipt of the notice of opposition, furnish the applicant with a copy of it.⁽ⁿ⁾

Within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the complete specification—*i.e.*, within fourteen days after the expiration of the time fixed by the Act as the limit within which notice of opposition can be taken—the opponent is required to leave at the Patent Office statutory declarations^(o) in support of his opposition, lists of which he must also deliver to the applicant.^(p)

Evidence of
opponent and
applicant.

The applicant on his part must, within fourteen days from the delivery of such list, leave at the Patent Office statutory declarations in answer, delivering a list of them to the opponent, who then is allowed fourteen days from such delivery to leave at the Patent Office statutory declarations in reply, which must be confined strictly to matters in reply, and a list of which he must give to the applicant.^(q)

If either party files a useless and unnecessary multiplicity of declarations, the law officer will, as far as possible, endeavour to fix him with the costs and responsibility of them.^(r)

Either party desiring copies of any of the statutory declarations of the other party may obtain them from the Patent Office or such other party.^(s)

Neither party is allowed to leave any further evidence except with the leave of the Comptroller, and upon the written consent of the opposite party, or by special leave of the Comptroller on application made to him for that purpose,^(t) of which application the party making it must give notice to the other party who is entitled to oppose it.^(u)

When the evidence is finally completed, the Comptroller appoints a time for the hearing of the case, of which he must give at least ten days' notice to the parties.^(x)

Time for
hearing.

(l) In the Matter of Airey's Application, 5 P. O. R. 348; Lake, (1886) No. 8642, Griff. L. O. C. 35; P. R. (1890) r. 16.

(m) See Appendix.

(n) P. R. (1890) r. 35.

(o) See p. 293 *ante*.

(p) P. R. (1890) r. 37.

(q) P. R. (1890) r. 38.

(r) Brand's Patent, (1894) 12 R. P. C. 102.

(s) P. R. (1890) r. 38.

(t) P. R. (1890) r. 39.

(u) P. R. (1890) r. 40.

(x) P. R. (1890) r. 41. The hearing may be during the legal vacations.

**Opposi-
tion—
General.**Application
to be heard.

If the applicant or opponent desires to be heard, he must forthwith send the Comptroller an application on Form E.(y) 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 decides the case and notifies his decision to the parties.(y)

Limit of oppo-
sition.

On the hearing, no opposition can 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 is not allowed upon such ground unless the title, number, and date of the patent granted on such prior application is duly specified on the notice of opposition.(z)

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 is left at the Patent Office within the time prescribed by the Patent Rules, 1890, the opposition is deemed to be abandoned, and the Patent is sealed forthwith.(a)

Hearing.

As a rule, at the hearing of an opposition, the applicant begins; but when the opponent alleges *fraud* as a ground of opposition, the *onus* being on him, his evidence may be ordered to be taken first.(b)

If the opponent does not appear at the hearing, the Comptroller will decide the case in his absence, and will not recall his decision, even though it is subsequently shown that the opponent did not, in fact, receive the notice of hearing, which was duly posted. In such a case, on appeal to the law officer, the matter would most probably be sent back to the Comptroller for re-hearing.(c)

Appeal from
the Comp-
troller's de-
cision.

The Comptroller will notify his decision to the parties,(d) either of whom has the right of appeal to the law officer.(e)

The evidence used on such an appeal will be the same as that used at the hearing before the Comptroller, and no further evidence can 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.(f) Such leave may

(y) P. R. (1890) r. 41.

(z) P. R. (1890) r. 42.

(a) P. R. (1890) r. 43.

(b) Luke's Patent, (1887) Griff. P. C. 294.

(c) Warmann, (1887) Griff. L.O.C. 43.

(d) P. R. (1883) r. 41.

(e) 46 & 47 Vict. c. 57, s. 11 (2).

(f) L. O. Rules, r. viii.; 46 & 47 Vict. c. 57, s. 38; Hampton v. Facer, (1887) Griff. L. O. C. 13; Cheesebrough's Patent, Griff. P. C. 303.

in a proper case be obtained for the examination of witnesses who did not make declarations when the matter was before the Comptroller.(g)

Opposi-
tion—
General.

An appeal to the law officer is a rehearing.(h) The law officer is entitled, if he desires it, to the assistance of an expert;(i) and he is also empowered, at the request of either party, to order the attendance at the hearing, for the purpose of cross-examination, of any person who has made a declaration;(k) and he is entitled to examine witnesses on oath, and to administer oaths for that purpose, and to order costs to be paid by either party.(l)

The law officer does not allow the cross-examination of witnesses or the admission of further evidence, when it appears to him that there has been ample opportunity for the filing of declarations when the case was before the Comptroller, and that he could not deal better with evidence given on cross-examination than with the declarations.(m) The law officer does not take on himself to decide adversely to the applicant fine points of anticipation.(n)

The law officer (and [*sic*] the Comptroller) is entitled to look at models in order to better understand the drawings and specifications, though the models are not exhibits, and consequently not evidence.(o)

Where an opposer appeals to the law officer from a decision of the Comptroller, it is not necessary that he should send a copy of his notice of appeal to the applicant.(p)

Both the Comptroller and the law officer have power to impose conditions on the granting of a patent, which power arises from the discretion of the Crown exercised through the Comptroller-General and the law officer to refuse the grant altogether.(q) Many instances of conditions imposed, and the reasons for the same, will be found in the following pages, where the different grounds of opposition are separately discussed.

A patent is only refused in cases where the opposer proves his ground or grounds of opposition beyond all possibility of doubt, as there is no appeal from the decision of the law officer. It is evident that, should the law officer wrongfully refuse a

Power of
Comptroller
and law officer
to impose con-
ditions.

Patent is only
refused when
the opposition
is proved.

(g) Thwaites' Patent, (1892) 9 R. P. C. 515.

(h) Stubbs' Patent, Griff. P. C. 298.

(i) 46 & 47 Vict. c. 57, s. 11 (4).

(k) L. O. Rules, r. ix.

(l) 46 & 47 Vict. c. 57, s. 38.

(m) In the Matter of Pitt's Patent, (1888) 5 R. P. C. 343, 345.

(n) *Ibid.*

(o) Lancaster's Patent, (1887) Griff. P. C. 294.

(p) Anderson and McKinnell, (1886) Griff. L. O. C. 23.

(q) p. 289 *ante*; L'Oiseau and Pierard's Patent, (1886) Griff. L. O. C. 36.

Opposi-
tion—
General.

patent the applicant would suffer an irremediable injury, whereas if a grant be made in the face of what is really a valid ground of opposition the public injury thereby occasioned may be remedied in a subsequent action for infringement, or petition for the revocation of the patent.(r)

The law officer is only justified in stopping the issue of a patent, having examined all the evidence given on one side or the other, if he is so clearly of opinion that the opponent has made out his case that he would, if a jury were to find in favour of the applicant, refuse to accept the finding and overrule the decision on the ground that it was perverse and contrary to the obvious weight and effect of the evidence.(s)

Costs.

The law officer, unlike the Comptroller, has power to award costs at the hearing before him.(t)

It is not the custom of the law officer to attempt to give costs to such an amount as would indemnify the parties. To do so would be seriously to discourage appeals, and to limit very much the usefulness of the office which the law officers fill in these matters.(u)

Where an applicant, on appeal, consented to make a slight modification in his specification to satisfy the ground of opposition, but asked for costs of appeal, as he had not been previously asked to make the modification, costs were disallowed, as it was not the fault of the other side that the matter had arisen.(x)

In cases of unsuccessful opposition, the insertion of a few explanatory words in the specification may be allowed at the hearing before the law officer, and if the amendment is not a substantial alteration the costs of the appeal may be given as if no such modification had been accepted.(y)

Grounds of Opposition.—It will be convenient to con-

(r) *Re Russell's Patent*, (1857) 2 De G. & J. 130, 132; *Re Simpson and Isaacs' Patent*, 21 L. T. N. S. 81; *Re Spence's Patent*, (1859) 3 De G. & J. 523; *Re Lowe's Patent*, 25 L. J. Ch. 454; *Re Tolson's Patent*, (1856) 6 De G. M. & G. 422; *Chandler's Patent*, (1886) Griff. P. C. 270; *Stubbs' Patent*, (1884) Griff. P. C. 298; *Welch's Patent*, (1884) Griff. P. C. 300; *Edmund's Patent*, (1886) Griff. P. C. 281; *Newman*, (1887) Griff. L. O. C. 40; *Jones*, (1887) Griff. L. O. C. 33; in the Matter of Aire and Calder Glass Bottle Works and Walker's Application, (1888) 5 R. P. C. 345; in the Matter of Daniel's Application, (1888) 5 R. P. C. 413; in

the Matter of Wallis and Ratcliff's Application, (1888) 5 R. P. C. 347; in the Matter of Luke's Patent, (1889) 6 R. P. C. 548; *Stewart's Patent*, (1892) 9 R. P. C. 452; *Codd's Patent*, (1892) 9 R. P. C. 488; *Levinstein's Patent*, (1894) 11 R. P. C. 348.

(s) Per Clarke, S.G., *Stuart's Patent*, (1892) 9 R. P. C. 452.

(t) 46 & 47 Vict. c. 57, s. 38.

(u) Per Clarke, S.G., *Stuart's Patent*, (1892) 9 R. P. C. 453.

(x) *Woodhead*, (1886) Griff. L. O. C. 44.

(y) *Fletcher*, (1886) Griff. L. O. C. 30.

sider separately the three grounds on which the grant of a patent to the applicant may be opposed by persons having a *locus standi* to oppose.

Opposi-
tion—
First
Ground.

I. *The applicant has obtained the invention from the opponent, or from a person of whom he is the legal representative.*

A person who has obtained an assignment of a patent, with the full benefit of all improvements and modifications thereof, from the assignee of the patentee, does not thereby become the legal representative of the patentee, so as to entitle him to oppose the grant of a patent to another inventor on the ground that the applicant obtained the invention from the prior patentee; (z) nor is a person holding a power of attorney from a patentee his legal representative within the meaning of the Act. (a) The term legal representative must be construed in its ordinary meaning of executor or administrator. (b)

Legal repre-
sentative.

It is not the duty of the Comptroller on an application which is opposed, or of the law officer on appeal, to decide whether or not the applicant is the true and first inventor, and he cannot inquire into the circumstances under which the applicant became possessed of the invention, other than those which go to show that it was derived from the opponent, or the person of whom he is the legal representative, if this ground of opposition is properly raised. (c)

Issue of true
and first in-
ventor is not
open.

If this objection be clearly proved no patent will be granted. (d)

The objection may succeed as to part only of the applicant's claim, in which case a patent may be ordered to be sealed for that portion only to which the opposition does not extend. (e)

Objection may
succeed in
part.

The words "obtained the invention" are to be read as meaning "obtained the invention which is purported to be patented," and as referring to the identity of the invention and not to the right of the person from whom it was obtained to be regarded as the first and true inventor. (f)

If at the hearing before the Comptroller the evidence as to the applicant having obtained the invention from the opponent

Patent is
sealed when
evidence is
conflicting.

(z) Spiel's Patent, (1887) 5 R. P. C. 281.

(a) Edmund's Patent, (1888) Griff. P. C. 281.

(b) *Ibid.*

(c) See in the Matter of Adolph Spiel's Application, (1888) 5 R. P. C. 281; in the Matter of Lake's Patent, (1888) 5 R. P. C. 415.

(d) In the Matter of Marshall's Ap-

plication, (1888) 5 R. P. C. 661; in the Matter of Griffin's Application, (1889) 6 R. P. C. 296; Stuart's Patent, (1892) 9 R. P. C. 452; Paterson and Dundon's Patent, (1884) Griff. P. C. 295; Griffin's Patent, (1888) 6 R. P. C. 452.

(e) Thwaite's Patent, (1892) 9 R. P. C. 515.

(f) *Ibid.*

Opposi-
tion—
First
Ground.

Employer and
employed.

or a person of whom he is the personal representative is conflicting, the patent will be ordered to be sealed without prejudice to an appeal to the law officer, (g) and in order that the witnesses may be cross-examined. (h)

With regard to the right of an employer to oppose the grant of a patent for an invention to his servant, it is to be noticed that there is no authority which lays down that, in the absence of special contract, the invention of a servant, even made in the employer's time, and with the use of the employer's materials, and at the expense of the employer, thereby becomes the property of the employer so as to prevent the person employed from taking out and exclusively enjoying a patent for it. (i)

In *David and Woodley's Application*, (k) the facts were that *Jones*, having invented some improvements in sewing machines, was introduced by *David* to *Woodley*, and *Woodley* was employed by *Jones* and *David* conjointly (*David* claiming some interest in *Jones's* invention) to make a model. *Woodley* made some suggestions, which were embodied in the model. *Jones* took out a patent for the machine, whereupon *David* and *Woodley* applied for a patent for the suggestions made by *Woodley*. *David* and *Woodley* had also applied for a patent for alleged improvements on this invention. The Comptroller refused the grant, and the law officer upheld his decision, on the ground that when a workman is employed by an inventor to make a model for the purpose of carrying out his invention, and the workman suggests improvements in detail of the machine which are adopted in the machine or model as completed, those suggestions are the property of his employer, and the workman cannot afterwards take out a patent for them. Further, if *Woodley* was in the employment of *Jones* and *David*, and not of *Jones* alone, the invention was *Jones's*, and he had never parted with his property in it, and *Woodley* stood to *Jones* in the relation of paid servant to employer. *David* was entitled to enforce in a court of law any claims he might have against *Jones*, founded on the alleged partnership or of a pecuniary character.

Experiments
by persons
other than
applicant.

The fact that other persons have made experiments identical with the applicant's will not stop the patent being granted unless the opposer shows that the applicant derived the invention from the person making such experiments, and then

(g) *Luke's Patent*, (1887) Griff. P. C. 294.

(h) *Hatfield's Patent*, (1884) Griff. P. C. 288.

(i) See *Heald's Patent*, (1891) S. R. P. C. 429; p. 14 ante.

(k) (1884) Griff. L. O. C. 26.

only if such person or his legal representative is the opponent.^(l)

In cases of agreements for the assignment of unpatented and unpublished inventions questions may arise as to the right of the alleged assignee to be made the patentee.

Thus, where an opponent in carrying on business had got into difficulties and had made an agreement to sell the business to the applicant, part of the consideration being an understanding that the opponent should give the applicant the benefit of a certain invention for sewing button-holes, and the opponent opposed on the ground that the invention had been obtained from him, the patent was refused in the absence of a written assignment.^(m)

Fraud committed abroad will not prejudice an applicant in respect of an invention stated to have been communicated to him from abroad.

Thus where,⁽ⁿ⁾ on an application for a patent on a communication from abroad, the opposer objected that the applicant had obtained the invention from him through a third party abroad, the patent was granted on the ground that a person availing himself of information from abroad is an inventor within the Statute of Monopolies.^(o) It is to be observed that the Comptroller and law officer have no authority to inquire into the source of the patentee's information in such a case ;^(p) neither will they inquire as to any alleged fraud committed by the applicant (communicator) against the opponent abroad.^(q)

Though a foreign applicant has important rights under s. 103 of the Act of 1883 and the convention of 1884, he is not entitled, on the ground that the applicant obtained part ^(r) or the whole ^(s) of the invention from him, to oppose an application in this country of later date than his own.^(t)

It is a good ground of opposition to the grant of a patent for a communication from abroad that the applicant had no

Opposition—
First
Ground.

Assignment of
unpatented and
unpublished
inventions.

Fraud com-
mitted by
applicant
abroad.

Rights of in-
ventor who is
a foreigner.

^(l) See *Ex parte Henry*, (1872) L. R. 8 Ch. 167 ; in the Matter of Homan's Patent, (1889) 6 R. P. C. 104 ; *Saxb. v. Gloucester Waggon Co.*, (1887) Griff. L. O. C. 57.

^(m) In the Matter of Marshall's Application, (1888) 5 R. P. C. 661.

⁽ⁿ⁾ In the Matter of Lake's Patent, (1888) 5 R. P. C. 415.

^(o) 21 Jac. I. c. 3, s. 6 ; *Nickels v. Ross*, (1849) 8 C. B. 679.

^(p) See *Edmund's Patent*, (1886) Griff. P. C. 281 ; in the Matter of *Adolph Spiel's Patent*, (1888) 5 R. P.

C. 281 ; in the Matter of *Bairstow's Patent*, (1888) 5 R. P. C. 286.

^(q) *Higgin's Patent*, (1891) 9 R. P. C. 74 ; *Edmund's Patent*, (1886) Griff. P. C. 283 ; *Spiel's Patent*, (1887) 5 R. P. C. 281 ; *Bairstow's Patent*, (1887) 5 R. P. C. 286 ; *Lake's Patent*, (1887) 5 R. P. C. 415.

^(r) *Edmund's Patent*, (1886) Griff. P. C. 281.

^(s) In the Matter of *Lake's Patent*, (1888) 5 R. P. C. 415.

^(t) *Everitt*, (1887) Griff. L. O. C. 28.

Opposi-
tion—
First
Ground.

authority from the foreign inventor to make the application, but that the opposer was the person to whom the foreigner entrusted his invention with the view of getting protection in this country.(u)

Joint grantees.

Sometimes the patent is granted to the applicant and opponent conjointly, if it appears that the invention is the joint production of both.(x)

Concurrent applications.

When there were concurrent applications for a patent in respect of the same invention, it was formerly a recognised principle that the patent would be awarded to the inventor who ran quickest through the process and was ready first to obtain the Great Seal.(y) Now, however, since the patent is in all cases dated as on the day of application,(z) in the case of concurrent applications on the same day, one patent would most probably be granted to the two applicants jointly, and if the concurrent applications were not made on the same day the prior applicant would be entitled to the prior patent.

Condition that grantee shall assign a share.

It may be made a condition that the grantee shall assign a certain share to another person if the interests of justice appear to require it, as in the case of joint inventors making separate applications;(a) and each co-owner may be bound to pay a proportionate part of the fees necessary to keep the patent on foot.(b)

Condition that opponent shall be made a joint patentee.

The condition has been imposed, under circumstances that called for it, that the grantee and opponent should enter into an agreement by which the former should undertake to do all such acts as might be necessary to secure to the latter the full rights of a joint patentee in the invention, and the latter should undertake not to commence proceedings for revocation of the patent when granted.(c)

Rival applicants.

In the case of rival applicants, if it appear that distinct parts are the separate inventions of the rival applicants, separate patents will be ordered to be sealed to each applicant in respect of his own invention alone.(d)

Applicant's invention only an improvement on opponent's.

When it is clear that the applicant obtained the idea of his alleged invention from the opponent, and that the alleged

(u) Fiechter, (1882) Griff. P. C. 284.

(x) Eadie's Patent, (1885) Griff. P. C. 279; *Re Russell's Patent*, (1857) 2 De G. & J. 130; Luke's Patent, (1886) Griff. P. C. 294.

(y) *Ex parte Dyer*, Hindmarch on Patents, p. 535; *Re Simpson and Isaacs' Patent*, (1853) 21 L. T. 81.

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

(a) Evans and Otway's Patent, (1884) Griff. P. C. 279; Garthwaite's Patent, (1886) Griff. P. C. 284.

(b) Evans and Otway's Patent, (1884) Griff. P. C. 279.

(c) Luke's Patent, (1885) Griff. P. C. 294.

(d) Craig and Macfarlane's Applications, P. M. J. vol. iv. 3rd series, p. 366.

invention is really nothing more than an improvement upon the opponent's patented invention, the application will be allowed only on the condition that the applicant insert in his specification a statement to the effect that his invention is an improvement upon the opponent's.(e)

Opposi-
tion—
Second
Ground.
—

II. *The invention has been patented in this country on an application of prior date.*

It would appear at first sight that this ground of opposition is open to any person, whether he have a direct interest in opposing the patent or not; but the decisions lead to the conclusion that only persons having a direct interest are allowed to oppose on this ground now, as they were formerly by the special enactment of the repealed Act of 1852.(f) It must also be noticed that sub-s. 3 of s. 11 of the Act of 1883 directs the law officer, on an appeal, to hear the applicant and any person giving notice, and being, "in the opinion of the law officer, entitled to be heard," and thus it is evident that the section contemplates the existence of persons who have no right of opposition. Opponent must have a *locus standi*.

The only persons having a *locus standi* to be heard on this ground of opposition before the Comptroller, or on appeal from him before the law officer, are those who, as original owners or assignees, have a direct interest under prior patents subsisting or expired. The law officer has no wider jurisdiction than the Comptroller. He only hears cases by way of appeal, and the words "being, in the opinion of the law officer, entitled to be heard" refer back to the persons who are allowed to oppose in sub-s. 1.(g)

A person having a *locus standi* is entitled to rely in his opposition upon specifications other than those in which he is, or was, interested and from which he derives his *locus standi*.(h)

A person who is merely an agent—*e.g.*, a patent agent—of a prior patentee has not such an interest in the prior patent as will entitle him to oppose a subsequent application in his own name.(i) The opposition must be in the name of the principal: otherwise this ground of opposition cannot be raised.(k)

(e) Hoskins's Patent, (1884) Griff. P. C. 291; Newman's Patent (2), (1888) 5 R. P. C. 279; for form of statement see Griff. P. C. 292 n.

(f) s. 12.

(g) Stewart's Patent. (1896) 13 R. P. C. 627; Glossop's Patent, (1884) Griff. P. C. 285; Heath and Frost's

Patent, (1886) Griff. P. C. 288; Hookham's Patent, (1886) Griff. L. O. C. 32; Macevoy's Patent, (1888) 5 R. P. C. 285. (h) *Ibid.*

(i) Heath and Frost's Patent, (1886) Griff. P. C. 288; Lake, (1887) Griff. L. O. C. 35; Hookham, (1887) Griff. L. O. C. 32. (k) *Ibid.*

Opposi-
tion—
Second
Ground.

It has been held that where a person is about to commence to work an invention, which he alleges is included under certain expired patents, he has not such an interest in the expired patents as to entitle him to be heard in opposition to the granting of a fresh patent; (*l*) though where the opponent was the patentee by direct grant, (*m*) or by assignment (*n*) under the expired patent, he is entitled to oppose; (*o*) but a person who has no further interest in an expired patent than the fact that he manufactured under it is not entitled to be heard in opposition to the grant of a fresh patent. (*p*)

Webster, A.G., has stated that, in his opinion, the only persons entitled to oppose under the words "patented, &c.," are persons who have made an application in the United Kingdom of prior date to the date of the applicant's patent, (*q*) and that the effect of s. 15 of the Act of 1883 is to place a person who has had a complete specification accepted in the same position, for the purpose of opposition, as a person who has already got a patent upon which he can oppose. (*r*)

Though law
officer over-
rules Comptroller on ques-
tion of *locus
standi*, he will
not lightly
interfere with
result of the
decision.

Patent allowed
in doubtful
cases.

Though the law officer on appeal allows the objection that the opponent is not a person entitled to be heard, he will not interfere with the Comptroller's decision as to the grant or refusal of the patent, unless he is satisfied that, looking at the substance of it, that decision ought to be interfered with. (*s*)

When an application is resisted on this ground of opposition, (*t*) all the Comptroller or law officer can, on the hearing, be called on to decide is, whether or not the invention sought to be patented is the same as that patented on an application of prior date, and in cases of doubt the grant is allowed. (*u*)

(*l*) In the Matter of Bairstow's Patent, (1888) 5 R. P. C. 286.

(*m*) Lancaster's Patent, (1884) Griff. P. C. 293.

(*n*) Glossop's Patent, (1884) Griff. P. C. 285.

(*o*) Lancaster's Patent, (1884) Griff. P. C. 293.

(*p*) Macevoy's Patent, (1888) 5 R. P. C. 285.

(*q*) Everitt, (1887) Griff. L. O. C. 28.

(*r*) L'Oiseau and Pierrard, (1887) Griff. L. O. C. 36; but see *Ex parte* Henry, (1872) L. R. 8 Ch. 167.

(*s*) Heath and Frost's Patent, (1886) Griff. P. C. 290. (*t*) p. 317 *ante*.

(*u*) p. 281 *ante*; Jones, (1886) Griff. L. O. C. 33. In the following cases, decided since the Act of 1883 came into operation, patents were refused on the ground that the respective inventions had been patented on applications of prior date:—

Heath and Frost's Patent, (1886) Griff. P. C. 310.

In the Matter of Daniel's Application, (1888) 5 R. P. C. 413.

In the Matter of Aire and Calder Glass Bottle Works and Walker's Application, (1888) 5 R. P. C. 345.

In the Matter of Wallis and Ratcliff's Application, (1888) 5 R. P. C. 347.

In the Matter of Webster's Patent, (1888) 5 R. P. C. 163.

Green's Patent, (1887) Griff. P. C. 286.

Lancaster's Patent, (1887) Griff. P. C. 293.

Re Bailey, Goodeve, P. P. 57.

It is no part of the duty of the Comptroller or law officer to inquire whether the applicant's patent, if granted, would infringe a prior patent,^(x) or whether the alleged invention is proper subject-matter,^(y) or whether the patent, if granted, would be invalid from any other cause; ^(z) and the applicant in all cases frames his specification at his peril.^(a)

Opposi-
tion—
Second
Ground.

The notice of opposition must distinctly allege this ground of opposition in specific terms; it will be wrong in form if it allege that the prior invention was the same, "or substantially the same," as the applicant's,^(b) or that the applicant's invention is "a direct infringement of the opponent's patent."^(c)

Notice of oppo-
sition must be
distinct.

It is not competent to the applicant to object that the prior patent relied on was void on the ground of disconformity between the specifications or between the title and the specifications, or upon any other ground.^(d)

Question of
validity of
prior patent is
not open.

In *Green's Patent*, decided under the Act of 1883, before amendment of the Act of 1888,^(e) the grant was opposed by *Lowcock* and *Sykes*, on the ground that the invention for which the applicant sought to obtain protection had been, as to certain parts, patented by them. The applicant objected that the opponent's patent was bad, because the complete specification

Green's Patent.

Boult's Application, (1893) 10 R. P. C. 275.

Stewart's Application, (1896) 13 R. P. C. 627.

Whittaker's Application, (1896) 13 R. P. C. 580.

Smith's Application, (1896) 13 R. P. C. 200.

Wylie and Morton's Application, (1896) 13 R. P. C. 97.

In the following cases, decided since the Act of 1883 come into operation, the objection was taken that the respective inventions had been patented on applications of prior date, but unsuccessfully:—

In the Matter of Lorrain's Patents, (1888) 5 R. P. C. 142.

In the Matter of Newman's Patent, (1888) 5 R. P. C. 271.

In the Matter of Pitt's Patent, (1888) 5 R. P. C. 343.

In the Matter of Airey's Application, (1888) 5 R. P. C. 348.

In the Matter of Sielaff's Application, (1888) 5 R. P. C. 484.

In the Matter of Brownhill's Patent, (1889) 5 R. P. C. 135.

Anderton, (1887) Griff. L. O. C. 25.

Fletcher, (1887) Griff. L. O. C. 30.

Von Buch, (1887) Griff. L. O. C. 40.

Huth's Patent, (1884) Griff. P. C. 292.

Cumming's Patent, (1884) Griff. P. C. 277.

Stubbs' Patent, (1884) Griff. P. C. 298.

Ross' Patent, (1891) 8 R. P. C. 477.

Bartlett's Patent, (1892) 9 R. P. C. 511.

Maxim and Silverman's Application, (1894) 11 R. P. C. 314.

Marsden's Patent, (1896) 12 R. P. C. 87.

^(x) Jones, (1887) Griff. L. O. C. 35; In the Matter of Sielaff's Application, (1888) 5 R. P. C. 484.

^(y) Jones, (1887) Griff. L. O. C. 33.

^(z) p. 289 ante.

^(a) In the Matter of Lorrain's Patents, (1888) 5 R. P. C. 142.

^(b) Jones, (1887) Griff. L. O. C. 33.

^(c) In the Matter of Daniel's Application, (1888) 5 R. P. C. 413.

^(d) Green, (1887) Griff. P. C. 286; Newman, (1887) Griff. P. C. 40; In the Matter of Haythornthwaite's Application, (1890) 7 R. P. C. 70.

^(e) (1885) Griff. P. C. 286.

Opposi-
tion—
Second
Ground.
—

went beyond the provisional, which did not include the parts which the applicant wished to cover. The law officer held that, though the opponent's patent might in fact be void, yet he could not entertain the objection; and since the opponent's patent included the parts in dispute he could not allow a patent to be sealed to the applicant. The applicant consequently suffered in that he was prevented from obtaining a patent for the parts which he had invented between the dates of filing the opponent's specifications. The opponent's specifications having been referred to an examiner, and reported favourably upon by him, it was the duty of the Comptroller and law officer, for the purpose of the application, to treat them as good specifications, and consequently the question of disconformity could not be raised.(f)

The third ground of opposition,(g) which was introduced by the Act of 1888,(h) provides for such a case as the above. If the Act of 1888 had then been in force it would have been competent to *Green* to have opposed the grant to *Lowcock* and *Sykes*, and to have himself applied for a patent in respect of his own invention.

Claim by appli-
cant to some-
thing not fore-
shadowed in
the provisional
specification of
patent relied
on by the
opponent.

Where something claimed by the applicant is not to be found foreshadowed in the provisional specification of the patent relied on by the opponent, though it may possibly be found described in the complete specification of such patent, and the said complete specification was in fact filed after the date of the application, these dates become most important. In such a case the patent of the applicant should be sealed on the ground that, by refusing it, great injustice might be done to the applicant. He might succeed, if the patent is allowed, in satisfying a Court that what was described in the opponent's complete specification was in fact novel at the date of his application, since it was not foreshadowed in the opponent's provisional.(i)

Expiration of
prior patent
relied on is
no bar.

Whenever the application is opposed on the ground now under discussion it does not signify that the prior patent has expired; (k) but if an invention has only received provisional protection it cannot be made an objection to a later application.(l)

Invention
described, but
not claimed
in a prior
patent.

If an invention is only described and not claimed in a prior

(f) *Green's Patent*, (1885) Griff. P. C. 286. In the Matter of *Haythornthwaite's Application*, (1890) 7 R. P. C. 70.

(g) p. 308 *ante*. In the Matter of *Anderson and Anderson's Patent*, (1890) 7 R. P. C. 323. (h) s. 4.

(i) *Bartlett's Patent*, (1892) 9 R. P. C. 511.

(k) *Lancaster's Patent*, (1884) Griff. P. C. 293.

(l) *Bailey's Patent*, (1884) Griff. P. C. 269; *Patterson's Patent*, Griff. P. C. 295.

specification, it may be patented on an application of later date, it being a long-established and obvious rule that only that is patented which the inventor claims.^(m) There would, of course, be great doubt as to the validity of a patent granted under such circumstances.⁽ⁿ⁾

Opposi-
tion—
Second
Ground.

The question of the validity of the prior patent, which is said by the opponent to cover the whole or a part of the applicant's claim, is quite immaterial.^(o) An applicant, however, is entitled to contend that the state of common knowledge is such that the opponent's claim ought to be read in a particular way which will exclude the subject-matter of the applicant's claim.^(p)

Ambit of oppo-
nent's claim
may be dis-
puted.

The point always is, Has what the applicant claims been already granted by the Crown, *i.e.*, formed the subject of a prior claim or claims? No doubt it would require a very clear case to stop a patent when it is sought to establish this ground of opposition by putting together claims taken from two separate prior specifications, but still it is submitted this might be done.^(q)

In cases where the law officer is forced to the conclusion that there is no substantial difference between the invention or combination claimed in the applicant's specification and an earlier specification it has not only been the practice but it is the duty of the law officer to refuse the patent.^(r) For example, when the applicant merely claimed to effect a certain result by the use of one of many salts of chromium and one of many salts of iron from out of those covered by the claim on the opponent's specification, and there was no particular advantage shown in doing so, the patent was refused.^(s)

Patent is re-
fused when
there is no
appreciable
difference
between the
applicant's
and opponent's
claims.

When an application is opposed on the ground that an alleged invention is the same as that comprised in the opponent's patent, and it appears that there is a difference, but that such difference is quite immaterial, the patent is refused.^(t)

^(m) Von Buch, (1887) Griff. L. O. C. 40.

⁽ⁿ⁾ See chap. iii.

^(o) Thornborough and Well's Patent, (1896) 13 R. P. C. 115.

^(p) Haythornthwaite's Patent, (1890) 7 R. P. C. 71.

^(q) Ross' Patent, (1891) 8 R. P. C. 477.

^(r) Per Webster, A.-G., Todd's Patent, (1892) 9 R. P. C. 488; see also Thwaites' Patent, (1892) 9 R. P. C. 515; Daniels' Patent, (1888) 5 R. P. C. 413; Aire and Calder's Patent,

(1888) 5 R. P. C. 345; Wallis and Redcliff's Patent, (1888) 5 R. P. C. 347; Webster's Patent, (1888) 6 R. P. C. 163; Bailey's Patent, (1887) Goodeve P. C. 57; Boulton's Patent, (1893) 10 R. P. C. 275.

^(s) Wylie's Patent, (1896) 13 R. P. C. 97; see p. 35 *ante*, as to selection from a class being the subject-matter of invention.

^(t) In the Matter of Aire and Calder's Patent, (1888) 5 R. P. C. 345; Wallis and Ratcliffe's Patent, (1888) 5 R. P. C. 347; in the Master

Opposi-
tion—
Second
Ground.

In *Hedge's Patent*,^(u) it appeared that after eliminating matters of common knowledge nothing in the slightest degree materially different remained to distinguish the applicant's claim from the opponent's that could possibly be valid subject-matter, and the patent was refused accordingly. This case was somewhat unusual. The general course in such a case is to grant the patent subject to a disclaimer,^(x) though, no doubt, the implication in the Act is that in some cases the Comptroller or law officer must take the responsibility of judging whether or not the invention is the same, and he must look to substance and not be influenced by mere verbal changes in the specifications.^(y)

Mechanical
equivalents.

It is competent to the Comptroller or law officer, when an application is opposed on the ground that the invention has been patented on an application of prior date, to consider the question of mechanical equivalents; ^(z) though the application will not be refused unless it is clear that the invention in respect of which it is made is practically identical with that forming the subject-matter of the prior patent^(a)—*e.g.*, where the only difference was the substitution of a coil for an internal cylinder in a heating apparatus,^(b) or an equivalent for a crank bar^(c) when the opponent's claim referred to a "crank bar or its equivalent."

When a would-be patentee has good subject-matter, which is not identically the same as that comprised in a prior patent, he is entitled to have his patent sealed, though an action for infringement may lie against him if he puts his alleged invention into practice.^(d)

Object of the
power to re-
fuse the patent,
or to require an
amendment or
a disclaimer.

It is the duty of the Comptroller and the law officer, on appeal from him, to see that no claim in an applicant's specification is allowed which is wide enough to include something which might unquestionably form part of that which is claimed in a prior specification relied on by the opponent.^(e) This principle is given effect to by disallowing the claim, or by ordering the claim as originally drawn to be modified, or a general or special

of Daniel's Application, (1888) 5 R. P. C. 413; In the Matter of Haythornthwaite's Application, (1890) 7 R. P. C. 70; Heath and Frost's Patent, (1886) Griff. P. C. 310.

^(u) (1895) 12 R. P. C. 136.

^(x) See Marsden's Patent, (1897) 14 R. P. C. 174.

^(y) Boulton's Patent, (1893) 10 R. P. C. 275.

^(z) In the Matter of Haythorn-

thwaite's Application, (1890) 7 R. P. C. 70.

^(a) p. 321 *ante*.

^(b) Smith's Patent, (1896) 13 R. P. C. 200.

^(c) Whittaker's Patent, (1896) 13 R. P. C. 580.

^(d) In the Matter of Newman's Patent, (1888) 5 R. P. C. 271.

^(e) Curtis and André's Patent, (1892) 9 R. P. C. 499.

disclaimer of the principle embodied in the prior patent to be inserted in the applicant's specification. (*f*)

The exercise of the authority of the Comptroller and law officer to impose conditions on the grant of a patent in this way operates for the protection of previous inventors (*g*) and the public generally. (*h*)

If a subsequent patent be granted and a specification accepted which actually or apparently claims something which is included in a prior patent, or something which is not patentable, the prior patentee in the one case, or the public in the other, suffers what may be a disadvantage to them, in so far as the subsequent patentee may endeavour under his grant to lay claim to the exclusive monopoly in the particular thing in question, yet they do not sustain any permanent injury, for the subsequent patent granted under such circumstances would be void. (*i*)

It is not to the interests of subsequent patentees that their patents should be apparently for an original invention, when, as a matter of fact, they can only claim a particular combination which they have described; and it is not to the interest of the public that they should be led into supposing that a description in a specification is entirely general, whereas it can only be supported as a specification of valid letters patent if the description be understood to be a description of an improvement. (*k*)

The Comptroller and law officer, in deciding upon the propriety or impropriety of inserting a disclaimer in the applicant's specification, are in no way whatever concerned with the question whether the applicant's claim amounts to an infringement of the opponent's patent or not. And it is not their duty to stop a patent at the instigation of an opponent because some principle of patent law may be infringed. (*l*) Thus when the opponent desired a special reference in the applicant's specification on the ground that a claim in the prior specification amounted to a legitimate broad claim to a principle as carried out by the means described by the applicant, which were analogous to those claimed in the opponent's specification, the

Opposi-
tion—
Second
Ground.
—

Grounds for
requiring a
disclaimer.

(*f*) Curtis and André's Patent, (1892) 9 R. P. C. 495.

(*g*) In the Matter of Newman's Patent, (1888) 5 R. P. C. 271; Griff. I. O. C. 40.

(*h*) In the Matter of Lorrain's Patent, (1888) 5 R. P. C. 142; In the Matter of Guest and Barrow's Patent, (1888) 5 R. P. C. 312; Teague's Patent, (1884) Griff. P. C. 298.

(*i*) Chap. iii. *ante*. In the Matter of Hill's Application, (1888) 5 R. P. C. 599.

(*k*) Hoskins' Patent, (1884) Griff. P. C. 291; In the Matter of Newman's Patent (2), (1888) 5 R. P. C. 279.

(*l*) Newman's Patent, (1887) 5 R. P. C. 277; McHardy's Patent, (1891) 8 R. P. C. 432; Todd's Patent, (1892) 9 R. P. C. 487.

Opposi-
tion—
Second
Ground.

law officer allowed the patent without disclaiming clause at all.^(m) To obtain a disclaimer the opponent must show that the applicant's claim, without it, will be a repetition of the opponent's.⁽ⁿ⁾

That is to say, it is a principle recognised by the law officers that where there is an existing patent, and there is fair ground for supposing that on the true construction a claim made by a subsequent applicant would interfere with the rights claimed by an existing patentee, he is entitled to be protected; and such protection is usually given by the insertion in the specification of the subsequent applicant of a general disclaiming clause or special reference.^(o)

It would appear that, if there be a distinct reference in the applicant's provisional specification to an invention or device, which was within the specification of the opponent properly construed, the opponent is entitled to have a disclaimer on the face of the complete specification.^(p)

It is to the interests of the public that, where patents overlap, the distinctions between the inventions described in the specifications filed under the earlier and later applications should be made clear;^(q) but it must be remembered that the object of a disclaiming clause is to guard against the inclusion in a new patent of something embraced by the old patent, not of something merely mentioned in the old patent, but of something which has been claimed as part of the previous invention.^(r)

Thus in *Guest and Barrow's Patent* ^(s) *Webster*, A.G., said:—

“I have on many occasions pointed out that the insertion of these disclaimers does not affect the rights of the prior patentee at all. They are inserted for the purpose of preventing the subsequent patentee from alleging that his invention is wider than he is entitled to claim, both in his own interests, in order

^(m) Marsden's Patent, (1896) 13 R. P. C. 87.

⁽ⁿ⁾ Stell's Patent, (1891) 8 R. P. C. 236; Hill's Patent, (1888) 5 R. P. C. 599.

^(o) In the Matter of Newman's Patent, (1888) 3 R. P. C. 271; In the Matter of Hall and Hall's Patent, (1888) R. P. C. 283; In the Matter of Lynde's Patent, (1888) 5 R. P. C. 663; In the Matter of Gozney's Patent, (1888) 5 R. P. C. 597; In the Matter of Guest and Barrow's Patent, (1888) 5 R. P. C. 312; In the Matter

of Wallace's Patent, (1889) 6 R. P. C. 134; Anderson and McKinnell, (1887) Griff. L. O. C. 23; In the Matter of Hoffman's Patent, (1889) 7 R. P. C. 92.

^(p) Hookam, (1887) Griff. L. O. C. 32; see also in the Matter of Hoffman's Patent, (1890) 7 R. P. C. 92.

^(q) In the Matter of Hill's Application, (1888) 5 R. P. C. 599.

^(r) In the Matter of Gozney's Patent, (1888) 5 R. P. C. 597; in the Matter of Hoffman's Patent, (1890) 7 R. P. C. 92. ^(s) (1888) 5 R. P. C. 312.

that his specification may not be considered as being too wide, and in the interests of the public, on the ground that the public are entitled to know what a subsequent patentee may claim, and to have a fair description of the existing state of knowledge. It is not because a particular patentee, or a prior inventor, has made a broad claim that he is entitled to have limiting words inserted, unless he can show, upon a fair view of the evidence before the law officer, or before the Comptroller, that such words are really necessary to protect him."(*t*)

Opposi-
tion—
Second
Ground.

There is no reported case of a special reference having been ordered where the application of the opponent, though prior to, is practically concurrent with that of the applicant, and *Webster*, A.G., has recently pointed out that the considerations above referred to do not apply in the case of concurrent applications, and reserved the decision of the question as to what are the proper disclaimers or references to be inserted in the case of concurrent applications till the matter has to be decided for the purposes of a particular case.(*u*) As a rule concurrent applicants might be expected to agree on the matter to their mutual advantage.(*x*)

Special refer-
ences and
concurrent
applications.

Where a specification only contains a statement of general knowledge, there is nothing in the Patent Law to prevent a patentee on the face of his specification referring to the general defects which he alleges rightly or wrongly exist; but it would appear that, if a prior patentee is referred to specifically in a subsequent specification, no reference to any defect in the prior invention ought to be allowed in the latter specification.(*y*)

References
to defects.

The Comptroller and law officers are always very unwilling to order the insertion of a special reference to the patent of a prior inventor and opponent, unless they can be sure that they have the whole knowledge of the trade before them, and that there are no other specifications which claim part of the ground claimed by the applicant(*z*)—*e.g.*, where it is practically admitted by the applicant that the governing principle was for the first time discovered or disclosed in the opponent's specification.(*a*)

When special
disclaimers
are required.

That is to say, an opponent, who is prior patentee, has no

(*t*) See also Newman's Patent, (1888) 279, 281; In the Matter of Hoffman's Patent, (1890) 7 R. P. C. 92.

(*u*) Gough's Patent and Greenhalgh's Patent, (1897) 14 R. P. C. 388.

(*x*) *Ibid.*

(*y*) Guest and Barrow's Patent, (1888) 5 R. P. C. 316.

(*z*) See Stell's Patent, (1891) 8 R. P. C. 236; Kilner's Patent, (1889) 8 R. P. C. 35.

(*a*) Welch's Patent, (1891) 8 R. P. C. 442.

Opposi-
tion—
Second
Ground.

right to be specially named in a disclaiming clause in the specification of a subsequent patent unless the applicant is willing to name him, or unless it is clear that there is no other prior publication than the specification of the opponent.(b)

General dis-
claimers are
more usually
required than
special dis-
claimers.

The Comptroller and law officer usually prefer to insert a general disclaimer of the principle included in the invention of the prior patentee,(c) bearing in mind that every prior patentee does not possess a right to have a disclaiming clause inserted in a subsequent specification, because, as was pointed out by Lord Cairns, every specification must be read as though the patentee had a knowledge of every previous complete and published specification of earlier letters patent.(d)

The legiti-
mate objects
for which
general and
special dis-
claimers are
ordered.

Disclaimers and especially special disclaimers ought not to be ordered for the mere purpose of making earlier patents known, but only for the purpose of explaining what the claim of the applicant really is. A claim may be so general in its terms as to include something which has been the subject of a prior grant, as well as the improvement which the applicant has, or thinks he has, invented. It is in such a case, where it might be the duty of the Comptroller and law officer to refuse the patent altogether, unless the claim were amended in such a way as to show that it is not directed to the matters which have formed the subject of the prior grant or grants, that a special disclaimer referring *nominatim* to the prior patent or patents should be ordered. The special disclaimer is only a substitute for the more scientific way of altering the language of the claim itself to the form it ought to have assumed if it had been skilfully drawn in the first instance, having regard to the prior patent or patents.(e)

In cases, therefore, where the rights of prior patentees cannot be effectually protected without special mention of the prior patents, the insertion of a special disclaimer is usually made a condition of the granting of a patent to a subsequent applicant, and the form of reference generally ordered is to the effect that the patentee is aware of the existence of the prior patent, and that he does not claim anything claimed and described there-

(b) Teague's Patent, (1884) Griff. P. C. 298; Guest and Barrow's Patent, (1858) 5 R. P. C. 312; Brownhill's Patent, (1889) 6 R. P. C. 135.

(c) Anderson and McKinnell, (1887) Griff. L. O. C. 23; In the Matter of Sielaff's Application, (1888) 5 R. P. C. 484; In the Matter of Wallace's Patent,

(1889) 6 R. P. C. 134; Kilner's Patent, (1889) 8 R. P. C. 35.

(d) See In the Matter of Newman's Patent, (1888) 5 R. P. C. 279.

(e) Marsden's Patent, (1896) 13 R. P. C. 87; Adam's Patent, (1896) 13 R. P. C. 548; Marsden's Patent, (1897) 14 R. P. C. 174.

in.(f) So also in the case of concurrent applications and cross oppositions, if it appear that the specification of one of the applicants includes something which is the sole invention of the other applicant the Comptroller will insist on the first applicant amending his specification so as to confine it to what has actually been invented by him.(g)

On the same principle, if an invention is merely an improvement on and subsidiary to a prior patented machine or process, the Comptroller and law officer will require a disclaimer by reference to the name and number of the prior patent, since it is only just to the opponent and in the interests of the public that this should be so.(h)

The Comptroller and law officer are bound to protect the public from being misled;(i) and the object for which special references to prior patents are ordered to be inserted in the applicant's specification is to guide the public to the proper construction of the claim made by the applicant.(k) So a special disclaimer may be ordered for the purpose of removing an ambiguity.(l) If, on the other hand, a special disclaimer might prejudice the construction a mere reference to the prior patent will be ordered instead (m)—*e.g.*, in a case where neither the Comptroller nor the law officer could come to a clear conclusion that the invention had been patented on the application of prior date relied on, and the Comptroller had ordered a special disclaimer in the words, "We are aware of the specification of patent No. of granted to , and we make no claim to anything described and claimed therein," the law officer, on appeal, to meet the justice of the case and the public interest, ordered the words, "and we make no claim to anything described and claimed therein," to be struck out.(n) A special disclaimer may be ordered on the ground that though

(f) In the Matter of Lorrain's Patent, (1888) 5 R. P. C. 142; In the Matter of Airey's Patent, (1888) 5 R. P. C. 348; In the Matter of Lynde's Patent, (1888) 5 R. P. C. 663; In the Matter of Newman's Patent, (1888) 5 R. P. C. 271; In the Matter of Wallace's Patent, (1889) 6 R. P. C. 134; Hoskins' Patent, (1884) Griff. P. C. 291; Welch's Patent, (1884) Griff. P. C. 300.

(g) Paterson's Patent, (1884) Griff. P. C. 295; Craig and Macfarlane's Application, P. M. J. vol. iv. 3rd series, p. 366.

(h) Hoskins' Patent, (1884) Griff. P. C. 291; Welch's Patent, (1884) Griff. P. C. 300; In the Matter of

Newman's Application, (1888) 5 R. P. C. 271, 279; In the Matter of Lynde's Patent, (1888) 5 R. P. C. 663; Levinstein's Patent, (1894) 11 R. P. C. 349; Tattersall's Patent, (1892) 9 R. P. C. 150.

(i) Lorrain's Patent, (1888) 5 R. P. C. 143.

(k) Van Gelder's Patent, (1892) 9 R. P. C. 326; p. 322 *ante*.

(l) Brand's Patent, (1895) 12 R. P. C. 102.

(m) Van Gelder's Patent, (1892) 9 R. P. C. 325; Maxim and Silverman's Patent, (1894) 11 R. P. C. 314.

(n) Maxim and Silverman's Patent, (1894) 11 R. P. C. 314.

Opposition—
Second
Ground.

in the applicant's specification there are differences from the opponents, yet there is a very strong resemblance between the mechanism as claimed by the opponent's specification and described in the applicant's specification and drawings.(o)

Speaking generally, a special reference, at the request of the opponent, to a prior patent ought to be allowed only, if in the event of the insertion of that reference being refused by the applicant the Comptroller or law officer would be justified in saying that the patent with the proposed claim should not be sealed at all.(p) Sometimes the opponent is allowed to elect whether the objectionable claim of the applicant should be struck out or a disclaiming clause should be inserted in his specification.(q)

A special reference will sometimes tend to stop further litigation where a general disclaimer would not, and will be ordered to be inserted on that account.(r)

Agreement
between
parties as to
the meaning
of a specifica-
tion.

If the meaning of a specification be ambiguous, the Comptroller or law officer may, on the hearing of the application, order it to be placed on record to what the specification is understood to be confined by the statement and agreements of both the opposer and applicant;(s) and, if the provisional specification contain a reasonably clear indication of the improvement it is ultimately desired to protect by the patent, the Comptroller has power to order any amendment which will put the particular description of the invention claimed absolutely beyond doubt.(t)

Striking out
claims.

Sometimes a claim in an applicant's specification is ordered to be struck out altogether, when it includes something claimed by the complete specification under a prior patent;(u) but it must be remembered that the applicant is entitled to frame his specification as he pleases, so long as he does not interfere with existing rights.(x) The Comptroller or law officer has no authority to order a claim to be struck out merely because he may invite the public to infringe a prior patent, if the applicant, in the body of the specification, shows some invention with regard to the thing claimed.(y) Nor can the Comptroller or

(o) Thornborough and Wilks' Patent, (1896) 13 R. P. C. 115.

(p) Per Finlay, S.-G., Marsden's Patent, No. 2, (1897) 14 R. P. C. 174; see also Stell's Patent, (1891) 8 R. P. C. 235; p. 326 *ante*.

(q) Teague's Patent, (1885) Griff. P. C. 298.

(r) In the Matter of Lynde's Patent, (1888) 5 R. P. C. 663.

(s) Anderton, (1887) Griff. L. O. C. 25.

(t) Chandler's Patent, (1884) Griff. P. C. 270, 274.

(u) In the Matter of Hall and Hall's Patent, (1888) 5 R. P. C. 283; In the Matter of Webster's Patent, (1889) 6 R. P. C. 163.

(x) See p. 302 *ante*.

(y) In the Matter of Webster's Patent, (1889) 6 R. P. C. 165.

law officer require the amendment of a claim in order to make it conform to the description in the specification, if the claim is otherwise a real statement of the invention claimed.(z)

Opposi-
tion—
Third
Ground.

The applicant should draft his claim in the first instance so as to embrace only his real invention. If he does not do so, he runs the risk, in the event of opposition, of not being allowed to make such an extensive amendment as might be required to remedy a defective claim, or to remedy the claim by the less scientific method of inserting a special reference to the opponent's patent.(a)

Thus, in a recent case the law officer refused to seal a patent when the applicant's specification contained a claim wide enough to include, without doubt, what had been patented by the opponent; and he further refused to allow a special disclaimer or words limiting the claim, on the express ground that the claim should have been drawn originally for the slight alleged improvement if the intention was to claim it.(b)

An opponent, though not appealing against the grant of a patent, is entitled to appeal against the Comptroller's decision that no reference to his patent be inserted in the specification.(c)

Appeal may
be limited to
the question
of a special
reference.

III. *That the complete specification describes and 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.*

A disconformity between the complete and provisional specifications is fatal to the validity of the grant of letters patent, as has been already demonstrated.(d) Disconformity, however, will not induce the Comptroller and law officer to refuse to seal a patent, unless in accordance with the above-stated ground of objection (which was created by sec. 4 of the Act of 1888) (e) the matter in the applicant's complete specification which is in excess of the provisional has, in the interval between the leaving of the two documents, formed the subject of an application by the opponent.

When discon-
formity is a
ground for
refusing the
patent.

(z) Smith's Patent, (1884) Griff. P. C. 268.

(a) See Whittaker's Patent, (1896) R. P. C. 58.

(b) Lupton and Place's Patent, (1897) R. P. C. 261.

(c) Brownhill's Patent, (1889) 6 R. P. C. 135.

(d) p. 168 ante.

(e) See Appendix.

Sealing the
Patent.

When this objection is raised it is the duty of the Comptroller or law officer to ascertain what is the real and proper construction of the language of the provisional specification, and not to accept any meaning suggested by the applicant which the document itself will not bear out. (*f*) It then becomes important to ascertain whether the alleged excess invention is really only a legitimate development of the invention to be found described in the provisional, (*g*) or whether it is really a different one, and the same as that forming the subject of the opponent's subsequent application. If it is only a legitimate development the opposition will fail. (*h*)

Wilson's Patent (*i*) affords a good illustration of this ground of opposition. In that case the invention related to bicycle tyres, and the applicant's provisional specification described various combinations of parts for the construction of tyres, but did not allude to any method or methods of fastening the tyres to the wheels. The complete specification, on the other hand, described the tyres as fitted to specially constructed wheel rims with special means for fastening the tyres, and the rims, combined with the methods of fastening, were the subjects of claims. The grant was opposed by four different opponents, who had, between the dates of the filing of the applicant's provisional and complete specification, made applications for patents for the various methods of attachment claimed in the applicant's complete specification. The Comptroller ordered the excision of the figures and drawings and of the corresponding description and claims referring to the methods of fastening the tyres to the wheels. The law officer on appeal somewhat varied the Comptroller's decision, but required that the complete specification should be amended so as to prevent the applicant from claiming as a part of his invention the means of fastening the tyres to the wheels as distinct from the construction of the tyres themselves.

SEALING THE PATENT.

Seal of the
Patent Office.

If there be no opposition, or if there be opposition, and the determination is in favour of the applicant, the Comptroller is required, by the Act of 1883, (*k*) as soon as may be, to cause a patent to be sealed with the seal of the Patent Office, which is

(*f*) *Birt's Patent*, (1892) 9 R. P. C. 489.

(*g*) See p. 166 *ante*.

(*h*) *Edward's Patent*, (1894) 11 R. P. C. 461.

(*i*) (1892) 9 R. P. C. 512.

(*k*) s. 12.

equivalent for this purpose to the Great Seal of the United Kingdom.^(l)

A patent cannot be sealed after the expiration of fifteen months from the date of application,^(m) except in the following cases:—

Sealing the Patent.

Time within which the patent must be sealed.

- (1) When the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, in which case the patent may be sealed at such time as the law officer may direct.⁽ⁿ⁾
- (2) If the person making the application dies before the expiration of fifteen months from the date of application, in which case the patent may be granted to his legal representative, and sealed at any time within twelve months after the death of the applicant.^(o)
- (3) Where the Comptroller has granted an extension of time for the leaving and accepting of a complete specification, in which case a patent may be sealed within nineteen months from the date of the application.^(p)

In the case of delay caused by opposition, a patent may be sealed at such time as the law officer appoints, even though the opposition is not adjudicated upon till after the expiration of fifteen months from the date of the application;^(q) the case, however, is different when the delay is caused by the applicant. Thus, where there was an opposition which caused some delay, and the applicant by mere inadvertence neglected to comply with the Comptroller's requisition till long after fifteen months from the application, the law officer refused to seal the patent on the ground that the delay was not caused by the opposition.^(r)

It is expressly enacted that every patent shall be dated and sealed as of the day of the application: Provided that, in the case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application.^(s)

Before the Act of 1883, where there was more than one applicant for a patent for the same invention, the applicant who first obtained the Great Seal was held to be entitled to the benefit of it, and the patent of any other applicant, if

(l) 46 & 47 Vict. c. 57, s. 12, sub-s. 2.

(m) *Ibid.* sub-s. 3.

(n) *Ibid.*

(o) *Ibid.*

(p) 48 & 49 Vict. c. 63, s. 3.

(q) *Re Somerset and Walker's Patent*,

(1879) L. R. 13 Ch. D. 397; *Re Johnson's Patent*, (1879) L. R. 13 Ch. D. 398 n.

(r) *A. & B.'s Patent*, (1896) 13 R. P. C. 63.

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

Extent and Duration of Letters Patent. granted at all, was dated subsequently.^(t) Such is not the case now, for the patent of each applicant (if granted) must bear the date of the application, and consequently the first applicant is the one who gets the real benefit of the invention; for where there is more than one patent for the same invention, anything done under those subsequently dated is an infringement of that which bears the earliest date.^(u) Formerly, however, in cases where there was evidence of *mala fides* the patent of a second applicant was ordered to be dated before that of the prior applicant.^(x) The reason was that the Crown will not grant a second patent in derogation of its own grant, and the system of ante-dating enabled the question of validity to be decided in subsequent proceedings.^(y)

EXTENT AND DURATION OF LETTERS PATENT.

Geographical extent. Every patent when sealed has effect throughout the United Kingdom and the Isle of Man,^(z) and the term for which every patent is granted originally is fourteen years,^(a) which may however, in certain cases, be prolonged on petition to her Majesty in Council.^(b) The time from which a patent runs dates from, and includes, the day on which the patent is dated.^(c)

Conditional on payment of renewal fees. A patent is conditional on the patentee making the prescribed payments within the prescribed times,^(d) and ceases if he fail to do so.^(e)

Enlargement of time for payment of fees. If, nevertheless, in any case, by accident, mistake, or inadvertence, a patentee fails to make any prescribed payment within the prescribed time; he may apply to the Comptroller for an enlargement of the time for making that payment, and the Comptroller is required, if he is satisfied that the failure has arisen from any of the above causes, on receipt of the prescribed fee for enlargement,^(f) not exceeding ten pounds, to enlarge the time accordingly, subject to the following conditions:—

(t) *Ex parte* Bates and Redgate, (1876) L. R. 4 Ch. 577, 580; see p. 8 ante.

(u) *Saxby v. Hennett*, (1873) L. R. 8 Ex. 210.

(x) *Ex parte* Scott and Young, (1871) L. R. 6 Ch. 274; *Saxby v. Hennett*, (1873) L. R. 8 Ex. 210; *Re Vincent's Patent*, (1867) L. R. 2 Ch. D. 341.

(y) *Ex parte* Bailey, (1872) L. R. 8 Ch. 61; *Ex parte* Henry, (1872) L. R.

8 Ch. 167, 169; *Ex parte* Bates and Redgate, (1869) L. R. 4 Ch. 577.

(z) 46 & 47 Vict. c. 57, s. 16.

(a) *Ibid.* s. 17.

(b) *Ibid.* s. 25; chap. xi.

(c) *Russell v. Ledsam*, (1847) 14 M. & W. 574.

(d) 46 & 47 Vict. c. 57, s. 24; P. R. (1890) rr. 45, 46.

(e) 46 & 47 Vic^t. c. 57, s. 17 (2).

(f) See Appendix.

- (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.^(g)

Extent and
Duration
of Letters
Patent.

An application for enlargement of the time for making a prescribed payment must state in detail the circumstances in which the patentee, by accident, mistake, or inadvertence, had 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.^(h)

Whenever the last day for leaving any document, or paying a fee, at the Patent Office falls on Christmas Day, Good Friday, or on a Saturday or Sunday, or on a day observed as a holiday at the Bank of England, or on any day observed as a public fast or thanksgiving, the documents may be left, or the fee may be paid, on the day next following any of these days.⁽ⁱ⁾

If a patentee fails to make a prescribed payment, whether he has obtained an enlargement of time or not, his patent is void and can only be revived by a special Act of Parliament.^(k) A special Act will most probably not be obtained unless it is made clear that the renewal fees were not paid in consequence of the serious illness of the patentee,^(l) and if a special Act is passed it will most probably provide protection for persons who may have used the subject-matter of the invention after the notice of the lapsing of the patent.^(m)

Revival of
patent void
through non-
payment of
fees.

Under the Act of 1853⁽ⁿ⁾ letters patent, obtained in the United Kingdom for inventions already patented abroad, did not continue in force after the expiration of the foreign patent. This provision was repealed by the Act of 1883, but the effect of s. 113, which provides that the past operation of any Act

Effect on
British patent
of lapse of
foreign patent.

^(g) 46 & 47 Vict. c. 57, s. 17 (3) (4).

^(h) P. R. (1890) r. 49.

⁽ⁱ⁾ 46 & 47 Vict. c. 57, s. 98.

^(k) *E.g.*, Wright's Patent Act, (1884) Boulton's Patent Act, (1885); Bradbury and Leman's Patent Act, (1884); Auld's Patent Act, (1885); Potter's Patent Act, (1887). See also Appendix A. to Report of Select Committee on Potter's Patent Bill [H. L.], Skrivanow's Patent

Bill [H. L.] and Gilbert and Sinclair's Patent Bill [H. L.].

^(l) See Report of Select Committee on Potter's Patent Bill [H. L.], Skrivanow's Patent Bill [H. L.], and Gilbert and Sinclair's Patent Bill; Worms and Bale's Patent Act (1891).

^(m) *Ibid.*; Appendix A., Potter's Patent Act, (1887); Worms and Bale's Patent Act, (1891). ⁽ⁿ⁾ s. 25.

Extent and
Duration
of Letters
Patent.

repealed shall not be affected, is to render it still a fatal objection to the validity of any patent in the United Kingdom, dated earlier than January 1, 1884, that there was a prior foreign patent for the same invention which expired before that date.

Confirmation
of letters pa-
tent dated
prior to Jan-
uary 1, 1884.

The Act of 1834 was repealed by the Act of 1883, but all rights and privileges of patentees in respect of patents granted prior to the Act of 1883 were preserved by that Act, and are still subsisting.^(o) One of the rights and privileges of a patentee under letters patent granted prior to January 1, 1884, the date on which the Act of 1883 came into operation, is that provided by the repealed Act of 1834, viz:—

“If in any suit or action it shall be proved, or specially found by the verdict of a jury, that any person who shall have obtained letters patent for any invention or supposed invention was not the first inventor thereof, or of some part thereof, by reason of some other person or persons having invented or used the same, or some part thereof, before the date of such letters patent, or, if such patentee or his assignees shall discover that some other person had, unknown to such patentee, invented or used the same, or some part thereof, before the date of such letters patent, it shall and may be lawful for such patentee or his assigns to petition his Majesty in Council to confirm the said letters patent, or to grant new letters patent, the matter of which petition shall be heard before the Judicial Committee of the Privy Council; and such Committee, upon examining the said matter and being satisfied that such patentee believed himself to be the first and original inventor, and being satisfied that such invention, or part thereof, had not been publicly and generally used before the date of such first letters patent, may report to his Majesty their opinion that the prayer of such petition ought to be complied with, whereupon his Majesty may, if he think fit, grant such prayer; and the said letters patent shall be available in law and equity to give to such petitioner the sole right of using, making, and vending such invention as against all persons whatsoever, any law, usage, or custom to the contrary thereof notwithstanding: Provided that any person opposing such petition shall be entitled to be heard before the said Judicial Committee: Provided also, that any person, party to any former suit or action touching such first letters patent, shall be entitled to have notice of such petition before presenting the same.”^(p)

^(o) In the Matter of Brandon's Patent, (1884) 1 R. P. C. 154

^(p) 5 & 6 Will. IV. c. 83, s. 2. The

following reported cases relate to petitions presented under this section: Heurteloup's Patent, (1836) 1 W. P.

Confirmation may still be applied for in the case of patents granted prior to January 1, 1884, but the privileges conferred by the Act of 1883 cannot be called in aid by the petitioner. The old law is applicable to such cases. Thus, if the British patent was obtained subsequently to a foreign patent, the British patent, since it expired with the foreign patent, cannot be resuscitated by petition for confirmation, the provisions of the Act of 1883 to the effect that British patents do not now expire with prior foreign patents not being applicable to those granted prior to January 1, 1884.^(q)

Journal
and Report
of Cases.

S. 35 of the Act of 1883 enacts that a patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.

Application in
fraud of true
and first
inventor.

In the event of a patent being lost or destroyed, or its non-production being accounted for to the satisfaction of the Comptroller, the Comptroller has authority at any time to cause a duplicate to be sealed.^(r)

Duplicates
of letters
patent.

A decision in an action brought upon a patent to the effect that a claim in the specification cannot be supported does not annul the patent.^(s) Such a decision is not an order for revocation, but merely a decision that the specification is bad as it stands. The defect may well be one capable of being cured by amendment,^(t) in which case fresh actions might be brought upon the patent after amendment.^(u)

Adverse de-
cision in
action of in-
fringement
does not annul
the patent.

ILLUSTRATED JOURNAL AND REPORT OF CASES.

The Comptroller is required to cause to be issued periodically an illustrated journal of patented inventions, as well as reports of cases decided by Courts of law, and any other information that he may deem generally useful or important.^(x) The Comptroller is also required to keep on sale copies of the illustrated journal, and all complete specifications of patents for the time being in force; and to prepare and publish indexes,

Illustrated
journal and
reports of
cases.

C. 553; Westrupp and Gibbin's Patent, (1836) 1 W. P. C. 554; In the Matter of Card's Patent, (1848) 2 W. P. C. 161; In the Matter of Lamenaude's Patent, (1850) 2 W. P. C. 164; Honiball's Patent, (1854) 2 W. P. C. 201.
^(q) Jablochkoff's Patent, (1891) 8 R. P. C. 281.

^(r) 46 & 47 Vict. c. 57, s. 37; P. R. (1890) Form N.

^(s) Deeley's Patent, (1894) 11 R. P. C. 75.

^(t) See chap. vi. *ante*.

^(u) p. 274 *ante*.

^(x) 46 & 47 Vict. c. 57, s. 40.

Patent
Office
Museum.
Register
of Patents.

abridgments of specifications, catalogues, and other works relating to inventions, as he may see fit.(y)

PATENT OFFICE MUSEUM.

Patent Office
Museum.

The control and management of the Patent Museum is vested in the Department of Science and Art, subject to such directions as her Majesty in Council may see fit to give.(z)

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.(a)

REGISTER OF PATENTS.

Register of
Patents under
Act of 1883.

The Act of 1883 (b) provides that there shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments, and of transmissions of patents, of licences under patents, and of amendments, extensions and revocations of patents, and such other matters affecting the validity of proprietorship of patents as may from time to time be prescribed. Such other matters include applications for amendments of specifications and notices of oppositions thereto, as well as the decisions of the Comptroller and law officer; requests for entry of notifications of assignments, licences, Orders in Council affecting the patent; certificates of enlargements of time within which renewal fees may be paid; and notifications of the expiration of patents.

The Register of Patents is *prima facie* evidence of any matters by the Act directed or authorised to be inserted therein. Copies of dates, licences, and any of the 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.(c)

It is provided that former registers of patents and of

(y) 46 & 47 Vict. c. 57, s. 40. The Illustrated Official Journal, comprising reports of the cases decided by the courts of law, the Comptroller, and the law officers, is at present published weekly. Cases decided before the Comptroller or the law officer ought not to be cited before

the High Court of Justice or the Court of Appeal; *Siddell v. Vickers*, (1888) 5 R. P. C. 416, 436.

(z) 46 & 47 Vict. c. 57, s. 41.

(a) *Ibid.* s. 42.

(b) s. 23.

(c) P. R. (1890) rr. 67-69.

proprietors shall be deemed parts of the same book as the Register of Patents, kept under the Act of 1883 (*f*)

Register of Patents.

By s. 85 of the Act of 1883 (*g*) it is provided that no notice of any trust—expressed, implied, or constructive—is to be entered on the Register of Patents, nor is any such notice receivable by the Comptroller. (*h*)

Notices of trusts, as such, cannot be registered,

Where any person becomes entitled by assignment, transmission, or other operation of law, to a patent, it is the duty of the Comptroller on request, and on proof of title to his satisfaction, to cause the name of such person to be entered as proprietor of the patent in the Register of Patents; and the person for the time being entered in the Register of Patents as proprietor of a patent has, subject to the provisions of the Act 1883, and to any rights appearing from such register to be vested in any other person, 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 may be enforced in like manner as in respect of any other personal property. (*i*)

The effect of this s. 85, read, as it must be, together with ss. 23 and 87, and the Patent Rules, 1890, rr. 68-76, is only to exclude from the register simple notices of trusts, but not documents affecting the proprietorship of a patent, whether by creating trusts or otherwise. Consequently equitable assignments of a patent, or of a share in a patent, may be entered on the register as documents affecting the proprietorship. (*j*)

but documents affecting the proprietorship—e.g., equitable assignments—can be registered.

A document which creates neither a legal nor an equitable interest cannot be registered. Thus, a patentee wrote a letter agreeing to give an exclusive licence, and, the patentee and proposed licensee subsequently disagreeing as to whether the amount of royalty had been fixed by subsequent parol agreement, the licensee obtained an entry of the letter on the register. On subsequent motion for rectification of the register, *North, J.*, held that, even assuming the royalty had been subsequently fixed by parol agreement, the letter itself did not give any legal or equitable interest in the patent, and could not be registered. (*k*)

Documents creating neither legal nor equitable interests cannot be registered.

(*f*) 46 & 47 Vict. c. 57, s. 114.

(*g*) p. 668 *post*.

(*h*) 46 & 47 Vict. c. 67, s. 85.

(*i*) 46 & 47 Vict. c. 57, s. 87; 51 & 52 Vict. c. 50, s. 21.

(*j*) *Stewart v. Casey*, (1891) 9 R. P.

C. 9; in view of this case the decision in *Haslett v. Hutchinson*, (1891) 8 R. P. C. 457, would appear to be wrong.

(*k*) In the Matter of Fletcher's Patent, (1893) 10 R. P. C. 252.

Register of Patents. Questions sometimes arise as to the entry on the register of documents dated prior to the patent.

Documents of earlier date than the patent.

For example, where it appeared that, before the date of a patent, the grantee and another person signed a document referring to certain proposed dealings with the ownership of patents to be obtained for a process said to be the invention for which a patent was subsequently granted, the Comptroller refused to enter this document on the Register of Patents, on the ground that it was dated before the grant of the patent; and this decision was upheld on motion to the Court, but upon the ground that the applicant did not appear to be entitled to any share in the patent.^(l)

It would appear from the judgment in *Parnell's Patent*^(m) that there may be documents dated before the grant of a patent which ought to be entered on the register after the patent is obtained, and that an agreement as to the ownership is such a document.

Registration is not notice to all persons.

Registration under the Act of 1883 of an exclusive licence for a limited area is not notice to the world, so as to affect defendants buying certain machines manufactured by the patentee outside the area,⁽ⁿ⁾ and using them inside the area, without notice of the licence.

Registration fee.

A fee of ten shillings is charged in respect of each entry made in the Register of Patents,^(o) and the procedure to be observed on the registration of documents is regulated by the Patent Rules, 1890, rr. 67-69.^(p)

Inspection of Register.

The Register of Patents is at all convenient times open to the inspection of the public, subject to the provisions of the Act of 1883, and to the prescribed regulations,^(q) and any person requiring it may obtain, on payment of the prescribed fee, a certified copy, sealed with the seal of the Patent Office, of any entry made in the register.^(r)

Evidence of entries on the Register.

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, are admitted in evidence in all Courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals.^(s)

^(l) In the Matter of Parnell's Patent, (1888) 5 R. P. C. 126.

^(m) (1888) 5 R. P. C. 128.

⁽ⁿ⁾ *Heap v. Hartley*, (1888) 5 R. P. C. 603; 6 R. P. C. 495.

^(o) See list of fees, Appendix.

^(p) See Appendix.

^(q) Patent Rules, (1890) r. 78.

^(r) 46 & 47 Vict. c. 57, s. 88; 51 & 52 Vict. c. 50, s. 22.

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

A certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorised under the Act of 1883, or any general rules made thereunder, to make or do, is *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.^(t)

Register of Patents.

The Court is empowered by s. 90 of the Act of 1883, as amended by s. 23 of the Act of 1888, on the application of any person aggrieved by the omission, without sufficient cause, of the name of any person, or of any other particulars, from the register, or of any entry made without sufficient cause in the register, to 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. And the Court has power, in any proceedings under this section, to decide any question that it may be necessary or expedient to decide for the rectification of the register, and to direct an issue to be tried for the decision of any question of fact, and to award damages to the party aggrieved.

Rectification of the Register.

Any order of the Court rectifying the register must direct that due notice of the rectification be given to the Comptroller.^(u) Where an order has been made by her Majesty in Council for the extension of a patent for a further time, or for the grant of a new patent,^(x) or where an order has been made by the Court for the revocation of a patent or the rectification of the register under s. 90, or otherwise affecting the validity or proprietorship of the patent, the person in whose favour such order has been made is required forthwith to leave at the Patent Office an office copy of such order. The register will thereupon be rectified, or the purport of such order will otherwise be duly entered in the register, as the case may be.^(y)

It is submitted that the Act of 1883^(z) gives the Court power to expunge any entry fraudulently made on the register, and to enter any facts relative to the ownership of a patent, but not any legal inference to be drawn from these facts. It was held that the corresponding section of the repealed Act of 1852^(a) gave such power to the Master of the Rolls alone.^(b)

An appeal lies from any order made by the Court or a

(t) 46 & 47 Vict. c. 57, s. 96.

(u) 46 & 47 Vict. c. 57, s. 90, sub-s. 3.

(x) Chap. xi.

(y) P. R. (1890) r. 74.

(z) s. 90.

(a) s. 38.

(b) *Re Morey's Patent*, 25 Beav. 581;

Re Green's Patent, (1857) 24 Beav.

145; *Re Horsley and Knighton's Patent*,

(1869) L. R. 8 Eq. 475; *Re Berdan's*

Patent, (1875) L. R. 20 Eq. 346.

Register of Patents. Judge for the rectification of the register, (c) though formerly there was no appeal from the decision of the Master of the Rolls.

If any rectification of the Register of Patents 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 must be served on the Comptroller, who is required to rectify the register accordingly. (d)

Falsification of the Register is a misdemeanour.

It is a misdemeanor for any person to make, or cause to be made, a false entry in the Register of Patents, or a writing falsely purporting to be a copy of an entry in such register, or to produce or tender, or cause to be produced or tendered, in evidence any such writing, knowing the writing or entry to be false. (e)

(c) *Re Morgan's Patent*, (1876) 24 W. R. 245; *Re Myer's Patent*, (1882) W. N. 53, 76.

(d) 46 & 47 Vict. c. 57, s. 111 (2).
(e) 46 & 47 Vict. c. 57, s. 93.

CHAPTER VIII.

ASSIGNMENT OF LETTERS PATENT.

ORIGIN OF POWER TO ASSIGN.

THE author of a literary, or musical, composition actually *creates* the work which is the produce of his mental labour. The law recognises that he has as much natural and moral right to the results created by his mental exertions as he has to the proceeds of his manual industry, and, *independently of any grant from the Crown*, gives him an exclusive copyright in his book or musical composition.^(a)

Rights of an author.

It cannot, however, be contended that an inventor has any natural, or even moral, right in his invention, for he does not create in the same sense as an author does.

Rights of an inventor.

In the case of a book, the result of the author's skill and industry has no existence before the author commits his thoughts to paper; but in the case of an invention, in the patent law sense, all that the inventor does is to make use of natural laws, which must necessarily have been pre-existent, though perhaps undiscovered, and, by a new application of them, produce a manufacture or article of commerce, which has either not been produced before or not been produced in the same way.

The distinction between the production of a great literary composition and the discovery of a great invention is made apparent by a contrast of a play of Shakespere—"Hamlet," for instance—with a world-revolutionising invention, such as the steam engine of Watt. Had Shakespere never written "Hamlet," it is practically certain that the play would never have existed, and the literature of the world would, undoubtedly, have been the loser; but had Watt never lived it can scarcely be doubted that the vast superiority of the plan of condensing the steam in a steam engine in a separate vessel, instead of in the cylinder, would have been perceived and communicated to the world by some other inventor.

Distinction between a literary composition and an invention.

(a) See *Millar v. Taylor*, 4 Burr. 2303.

**Origin of
Power to
Assign.**

The law only gives a right in an invention on condition.

It is thus evident that an inventor merely produces a new art, consisting of a novel application of previously existing, though it may be undiscovered, physical laws to the production of a new article of commerce, or of an old article of commerce in a new manner. The law does not recognise any natural, or moral, right in the inventor to the exclusive use of the invention, and will not, except on certain conditions, attempt to guarantee him a monopoly in the profitable exercise of it.

The conditions upon which the law will secure to an inventor an exclusive property in his invention for a limited period are, as we have seen, (b) that he shall disclose the secret of it, so that the public may enjoy it after the expiration of the patent; and also that he shall describe the best means known to him of performing the invention, in order that the public may enjoy it to the same extent as the patentee himself, when the term for which the patent is granted expires.

The inventor may perhaps be able to keep the invention a profound secret, and make considerable profit by its use; but there are very few inventions, producing valuable results, which could be worked long without the method by which the results are arrived at becoming matter of public knowledge; in which event the law will not prevent any member of the public from exercising the invention for his own gains, provided he has not been guilty of a breach of trust. (c) Undoubtedly the man who makes a useful discovery, or invention, and communicates it to the public is a benefactor; and it is because the law recognises this fact, as well as the desirability of encouraging the production of useful inventions for the public good, that it guarantees to the inventor, his executors, administrators, and assigns the sole privilege of making, using, exercising, and vending the invention within this realm for a definite period, by means of a grant of letters patent from the Crown, upon condition, however, that the inventor discloses the best means known to him of performing the invention.

Effect of keeping an invention secret.

If an inventor endeavours to work the invention in secret the law will not compel him to disclose it, but, if it does leak out, it can never afterwards form the subject of a grant of letters patent, and the inventor cannot claim any monopoly or acquire any right or property in it of any nature whatever, which the law will protect or recognise.

This follows from the fact that one inventor has no natural

(b) Chap. v. *ante*.

(c) *Yovatt v. Winyard*, (1820) 1 J. & W. 394.

right to prevent another from making the same invention, and deriving profit therefrom; the law only allows, as we have seen, (d) the grant of a monopoly in the invention for a limited period to the first and true inventor, *i.e.*, the inventor who actually *first* communicates a knowledge of it to the public.

Origin of
Power to
Assign.
—

Thus in *Canham v. Jones*, 2 Ves. & B. 218, the plaintiff, as the proprietor of a receipt for the preparation of a certain vegetable syrup, which had been bequeathed to him by a person named *Swainson*, who purchased it from the inventor, sought to restrain the defendant from selling an article under the same name as the plaintiff's. Sir *Thomas Plumer*, V.C., gave judgment in favour of the defendant, and used the following words: "This Bill proceeds upon an erroneous notion of exclusive property, now subsisting in this medicine, which *Swainson*, having purchased, had a right to dispose of by his will, and, as it is contended, to give the plaintiff the exclusive right of sale of. If this claim of monopoly can be maintained without any limitation of time, it is a much better right than that of a patentee; but the violation of right, with which the defendant is charged, does not fall within the cases in which the Court has restrained a fraudulent attempt by one man to invade another's property—to appropriate the benefit of a valuable interest in the nature of a goodwill, consisting in the character of his trade or production, established by individual merit; the other representing himself to be the same person, and his trade or production the same as in *Hogg v. Kirby*, 8 Ves. 215, combining imposition on the public with injury to the individual. This is not that sort of case. The observation is correct, that the Bill stating the defendant's medicine to be spurious asserts it not to be the same as the plaintiff's. The defendant does not hold himself out as the representative of *Swainson*, setting up a right in that character to the medicine purchased by him; but merely represents that he sells, not the plaintiff's medicine, but one of as good a quality. He is perfectly at liberty to do so. If any exclusive right in this medicine ever existed, it has long expired. The foundation of this Bill therefore, the exclusive right asserted by the plaintiff, failing, all the consequential relief falls with it; and the demurrer must be allowed."

If a discoverer keeps his invention secret, not only does he run the risk of losing the monopoly of it by an inadvertent disclosure, but he puts himself in a position of evident disadvantage, if he should wish to dispose of it to another person,

(d) Chap. i.

Origin of
Power to
Assign.

The Courts
will neither
decree specific
performance of
a contract for
sale of, nor
restrain the
publication of,
a secret in-
vention.

for the Court could not decree the specific performance of an agreement for the sale of a secret invention, or prevent the disclosure of it. Either it is or it is not a secret. If it is, what means has the Court of interfering, so as to enforce its own orders? If it is not, there can be no ground for interfering.^(e)

Moreover, it would be useless for the Court to grant an injunction to restrain the publication of a secret, for there would be no means of determining whether the injunction had been violated or not.^(f)

In a case ^(g) where the plaintiff sought to restrain the defendant from communicating the secret of preparing a certain medicine, Lord *Eldon*, L.C., dissolved an injunction which had been obtained, and stated the principle on which the Court acts in such cases, thus :—

“ So far as the injunction goes to restrain the defendant from communicating the secret, on general principles, I do not think the Court ought to struggle to protect this sort of secret in medicine. The Court is bound, indeed, to protect them in cases of patents to the full extent of what was intended by the grant of the patent, because the patentee is a purchaser from the public, and bound to communicate his secret to the public at the expiration of the patent. Then, whether this principle can be extended to such a case as this—whether a contracting party is entitled to the protection of the Court, in the exercise of its jurisdiction, to decree the specific performance of agreements by restraining a party to the contract from divulging the secret he has promised to keep—that is a question which would require very great consideration. But the present case is not one which calls for the determination of it. If the defendant has already disclosed the secret the injunction can be of no use. If he only threatens to disclose, it thus becomes necessary to look at his affidavit; and by that he insists that what he has to disclose is no secret at all—then how is the Court to try this question? Or what can the Court do with the case altogether? ”

The mono-
poly in an in-
vention exists
only by virtue
of the grant
of letters
patent.

The monopoly created by the grant of letters patent for a limited period is the only right or property which the law recognises an inventor as possessing in his invention; and the sole or exclusive privilege of using the invention which is vested

^(e) *Newbury v. James*, 2 Mer. 446,
judgment of Lord Eldon, L.C.

^(f) *Ibid.*

^(g) *Williams v. Williams*, 3 Mer.
157.

in the patentee by the patent has existence only by virtue of the grant.

Origin of
Power to
Assign.

The privilege is a mere naked right vested in the patentee, and it would not be assignable unless the letters patent expressly made it so, for it contains no property within itself making it of an assignable nature.^(h)

Notwithstanding the fact that an inventor has no property in his invention unless and until it is made the subject of a grant of letters patent, he has such an interest in an invention for which he intends to take out a patent as to be able to make and enforce an agreement concerning it. Thus, in the case of *Smith v. Dickinson*,⁽ⁱ⁾ it appeared that the defendant had, in fraud of the plaintiff, obtained a patent for an invention which had been communicated to him by the plaintiff under an agreement, whereby the defendant undertook, subject to a penalty, not to avail himself or take any advantage of such communication, and the Court held that the plaintiff was entitled to maintain an action for the breach of this agreement.^(k)

Interest in an
invention
before the
grant of letters
patent.

According to the law as it at present stands, every patent for an invention granted by the Crown is made in the form prescribed in the first schedule to the Patents, &c., Act of 1883. Eight forms, which are modifications of the form in the schedule to the Act of 1883, to meet special circumstances, are at present in use in the Patent Office.^(l) The form in the schedule to the Act of 1883 grants to the patentee the Royal licence, "full power, sole privilege, and authority, that the said patentee, by himself, his agents, or licensees, and no others, may at all times hereafter, during the continuance of the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland and Isle of Man." By a previous recital, the term "patentee," as used in the letters patent, is expressly defined to mean the grantee, his executors, administrators, and assignees.

Form of letters
patent.

Thus, the authority by which a patent right is created invests it with the quality of assignability; and there is now no limit to the number of persons to whom it may be assigned, though formerly it was made a condition that the grant should become void if the patent became vested in more than a specified number of assignees.

Patent is
assignable
only in virtue
of the terms
of the grant.

An assignment may be made to a body corporate, and the

Body cor-
porate.

^(h) *Duvergier v. Fellows*, (1828) 10 B. & C. 829.

⁽ⁱ⁾ (1804) 3 Bos. & Pul. 630.

^(k) See also *McDougall v. Parting-*

ton, (1890) 7 R. P. C. 216; *Punchard v. Dale*, (1894) 11 R. P. C. 257.

^(l) See p. 741 *post*.

**Assign-
ment by
Deed.**Patents dated
prior to 1884.

body corporate is entitled to be entered on the Register of Patents as the proprietor in its corporate name.^(m)

Previous to the Act of 1883, a patent in the United Kingdom, in respect of an invention which had been patented abroad, was only valid for so long as the foreign patent remained in force.⁽ⁿ⁾ Since the Act of 1883 does not affect the past operation of any repealed Act,^(o) it is advisable for an assignee of a British patent of earlier date than January 1, 1884, in respect of an invention previously patented abroad, to ascertain that the foreign patent was in force on the date of the assignment, and to keep it on foot subsequently.

Assignment
for a district.

A patentee may assign his patent for any place in a 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.^(p)

A deed of assignment for a district should contain a covenant on the part of the assignor to pay the renewal fees within the prescribed times, and to give due notice to his co-owner of every such payment when made or permit him to pay the same, and to repay the sums so paid on demand, and until repayment to charge them, together with interest, on his share in the patent.^(q)

Assignment
may be by
deed or by act
and operation
of law.

A patent right may be assigned by deed by the patentee, or by act and operation of law.

ASSIGNMENT BY DEED.Legal assign-
ments must be
by deed failing
act and opera-
tion of law.

Failing an act and operation of law, which will be discussed later,^(r) a legal assignment of letters patent can only be made by deed,^(s) and such an assignment purporting to be made by an agent on behalf the patentee is only valid if the agent is authorised by deed to make it.^(t) Though the letters patent provide that a licence to use the invention must be under the hand and seal of the patentee, they do not specify any particular form or manner in which assignments are to be made. It is, however, necessary that the grant of letters patent shall be under seal,^(u) and it is a rule of law that things which can

(m) P. R. (1890) r. 72; p. 724 *post*.

(n) 15 & 16 Vict. c. 83, s. 25.

(o) 46 & 47 Vict. c. 57, s. 113.

(p) 46 & 47 Vict. c. 57, s. 36.

(q) See Morris' Patents Conveyancing, p. 116.

(r) p. 363 *post*.

(s) Cook's Case, *Power v. Walker*, 3 M. & S. 9; *Stewart v. Casey*, (1892) 9 R. P. C. 9; L. R. (1892) 1 Ch. 104.

(t) *Hazlehurst v. Rylands*, (1891) 9 R. P. C. 7.

(u) Co. Litt. 9b, 172a; *Shep. Touch.* 229-231.

only be granted or created by deed are assignable only by deed.^(x) Assign-
ment by
Deed.

In the words of Lord *Ellenborough*, C.J.^(y): "If the licence, which is the lesser thing, must be in writing, *a fortiori* the assignment, which is the greater thing, must also be."

No particular form of words is necessary to effect an assign-
ment of a patent right, and it has been held that where a patentee has covenanted, under his hand and seal, to assign a patent on the happening of a certain event, the covenant, on the happening of the event, amounts to an actual assignment.^(z) No particular
form of words
is necessary.

An equitable assignment of a patent may, without a deed, arise from the conduct of the parties when there is consideration, and though the consideration be a past service, the equitable agreement may be enforced. Thus, a letter containing an agreement to give a share of a patent in consideration of a past service is an equitable assignment of the share. The principle on which this is so is that a past service raises an implication that it was to be paid for, and a subsequent promise to pay, if not supportable by the consideration of the past service, can be supported as a statement of the remuneration to be accepted in lieu of, or as fixing, the remuneration which the law implies in the first instance on the performance of the service.^(a) Equitable
assignments
may arise from
conduct when
there is con-
sideration.

As the assignment of a grant of letters patent is by deed, no consideration need be stated. Consideration.

Sometimes patents are assigned in consideration of a royalty reserved to the assignor, and where such is the case it is not, in the absence of covenants to that effect, obligatory on the part of the assignee to pay the duties necessary to keep the patent on foot. No obligation
on an assignee
to maintain
the patent.

Thus, in *Re Railway and Electric Appliances Company* ^(b) it appeared that on the sale of a patent by the patentees to the company a deed of assignment was executed by the parties, by which, after a recital that the patentees had agreed to sell the patent to the company for £250, "and for the other considerations herein appearing," the patentees assigned the patent to the company absolutely, and after covenants for title by the patentees, including a covenant for quiet enjoyment of the patent "during the time subsisting therein," the company

(x) 3 Co. R. 63a, Lincoln Coll. Cas.
(y) *Power v. Walker*, (1814) 3 M. & W. 9.
(z) *Cartwright v. Amatt*, (1799) 2 Bos. & Pul. 43.

(a) *Stewart v. Casey*, (1892) 9 R. P. C. 9, 14; L. R. (1892) 1 Ch. 184, judgment of Bowen, L.J.
(b) (1888) L. R. 38 Ch. D. 597.

Assign-
ment by
Deed.

covenanted to pay to the patentees a royalty for every article which should be manufactured or sold by the company under the patent "while subsisting," and also a proportion of the profits arising from the manufacture or sale and from licences granted for the manufacture or sale of articles to be manufactured under the patent "while subsisting." The deed contained no express covenant by the company to keep the patent on foot or to manufacture or sell articles under the patent. On the expiration of the first four years of the patent, the company duly paid the first renewal fee, but on the expiration of the fifth year, by inadvertence, omitted to pay the second renewal fee, and consequently the patent lapsed. After an ineffectual attempt to obtain a private Act of Parliament to revive the patent, the company passed resolutions for a voluntary winding up, and the patentees thereupon sent in a claim for damages for the loss, through the lapse of the patent, of the royalties reserved by the assignment, contending that a covenant to keep the patent on foot should be implied in the assignment. The Court, however, held that no such covenant could be implied; and that, even if it could, the patentees could not obtain more than nominal damages, the company being under no obligation, express or implied, to manufacture the patented articles.

Power of
Secretary of
State for War
to acquire in-
ventions by
assignment.

The Secretary of State for War is empowered, either for or without valuable consideration, to acquire by assignment to himself, on behalf of her Majesty, all the benefit of the invention and of any patent obtained or to be obtained for any improvement in instruments or munitions of war; and where any such assignment has been made to the Secretary of State for War he may at any time before the application for a patent for the invention, or before the publication of the specification or specifications, certify to the Comptroller his opinion that, in the interests of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret; and if the Secretary of State for War so certifies, the specifications of the invention will not be published or open to public inspection at any time without the sanction of the Secretary of State for War.(c)

Equitable and
legal interests
of a licensee.

The equitable interests of a licensee in relation to the district comprised in the licence are co-extensive with those of the grantee or assignee of the letters patent, yet his legal title is very different. Though an exclusive licensee may perhaps sue

(c) See 46 & 47 Vict. c. 57, s. 44.

in his own name for infringements (*d*) he cannot apply to amend the specification or obtain an extension of the patent, and a mere licensee is not able to sue for infringements in his own name.

Assign-
ment by
Deed.
—

Before the passing of the Act of 1883 it was not uncommon to include more than one invention in a grant of letters patent, but the practice is not so frequent now, for it is provided by that Act (*e*) that every patent shall be granted for one invention only, but may contain more than claim.

Different in-
ventions in-
cluded in one
patent.

It is, however, declared (*e*) that 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. It is consequently possible that a patent granted under the present practice may comprise more than one invention.

If the patents comprise two or more inventions separate and distinct in their nature, valid assignments may be made of the different parts of the patent to different persons, and it is competent to the assignee of a separate and distinct portion of a patent to give for an infringement of that part, without joining one who has an interest in another part, the damages recovered in the action accruing to the former alone. (*f*)

Sometimes the assignor covenants with the assignee that he will not trade in competition with him. Such a covenant should be carefully drawn so as not to be contrary to the doctrine of covenants in general restraint of trade. If the restraint is not wider than is necessary for the protection of the covenantee, the covenant can be enforced. (*g*) Thus, a patentee and manufacturer of guns and ammunition for purposes of war covenanted with a company to which his patents and business had been transferred that he would not for twenty-five years engage, except on behalf of the company, either directly or indirectly in the business of a manufacturer of guns or ammunition. The House of Lords held, affirming the Court of Appeal, that this covenant, though unrestricted to space, was not, having regard to the nature of the business and the limited number of customers (namely, the Governments of this and other countries), wider than was necessary for the protection of the company, nor injurious to the public interests of this country; and

Covenants by
an assignor in
restraint of
trade.

(*d*) p. 386 *post*.

(*e*) 46 & 47 Vict. c. 57, s. 33.

(*f*) *Dunncliff v. Mallett*, (1859) 7 C. B. N. S. 209; *Walton v. Lavatu*, (1860) 8 C. B. N. S. 162, 184.

(*g*) *Nordenfelt v. Maxim-Nordenfelt Guns and Ammunition Co.*, (1894) L. R. (1894) A. C. 535; *Dubowski v. Goldstein*, L. R. (1896) 1 Q. B. 478.

Co-Owners. that it was, therefore, valid, and might be enforced by injunction.^(h)

Reservation by an assignor of right to use the invention.

A patentee may assign the patent but reserve to himself the right to use the invention. When this is done questions may sometimes arise as to the power of the assignee to restrain persons claiming to act as the agents of the assignor from manufacturing or selling articles manufactured according to the invention. Thus, in one case,⁽ⁱ⁾ the patentee assigned two patents, reserving to himself the right to work the patents personally, which right was not to be transferable. After the death of the assignee the patents became vested in a company. The assignor entered into partnership with two other persons and by an agreement between him and his firm he agreed to employ the firm, on certain terms, to manufacture articles under the patents on his behalf, and to sell them for him, which they did. In an action by the company against the firm for an infringement of the two patents by working under the agreement, it was held that according to the true construction of the agreement, although the firm were the agents of the assignor as far as selling was concerned, they were manufacturing, not as his agents, but as contractors for him, and had thereby infringed the rights of the plaintiff company, and an injunction was granted in special terms.

CO-OWNERS.

Assignment to several persons.

A patent may be assigned to different persons in different portions as joint tenants, or as tenants in common.^(k)

When a share in a patent is assigned, it is advisable that the deed of assignment should contain covenants binding not only the parties, but all future owners, to account to each other for the profits made by them respectively, and to grant, or concur in granting, licences in a manner prescribed.^(l) A deed of assignment of a share of a patent should also contain a covenant by the assignee to perform and observe the stipulations (if any) which bind the assignor and to indemnify him from future breaches thereof; ^(m) and each owner should covenant to pay his proper proportion of the renewal fees, and should charge

^(h) Nordenfelt *v.* Maxim-Nordenfelt Guns and Ammunition Co., L. R. (1894) A. C. 535.

⁽ⁱ⁾ Howard *v.* Tweedales, (1895) 12 R. P. C. 519.

^(k) Walton *v.* Lavater, (1860) 8 C. B. N. S. 162; Smith *v.* London and

North-Western Ry. Co., (1853) Macr. P. C. 203.

^(l) See Morris' Patents Conveyancing, p. 120; see form of assignment, Appendix.

^(m) See Morris' Patents Conveyancing, p. 121.

his share in the patent with the payment of any moneys which **Co-Owners.** may be paid by any other owner on his behalf in this respect.⁽ⁿ⁾ There should also be a provision to the effect that licences should be granted by the co-owners jointly, and that all benefits arising therefrom should be shared by such co-owners in proportion to their shares.^(o) If a deed of assignment of a share of a patent provides for the sole working of the patent by one of the co-owners alone, it is well to reserve to the other co-owners the right to use the share or shares assigned on agreed conditions; and to enter a notification of such the right can be entered on the Register of Patents.^(p)

It is submitted that when a patent for a single invention is held by different persons, either as joint tenants or as tenants in common, it is competent for one of such co-owners to sue alone in respect of an infringement,^(q) though the Court of Queen's Bench in *Smith v. London and North-Western Railway Co.*,^(r) decided in favour of the right of the survivor of two persons, to whom a patent had been assigned as tenants in common, to sue for the whole damages caused by an infringement, on the ground that, if one of the assignees had not died, the action must have been brought by both.^(s)

In *Smith v. London and North-Western Railway Co.*^(t) it was held that where a patent is assigned to two persons as tenants in common they may maintain a joint action in respect of infringements, and the right of action survives, so that after the death of one tenant in common the survivor may sue for and recover the whole of the damages in respect of infringements committed during the lifetime of the deceased tenant in common. It must be noticed that one ground for the decision in favour of the plaintiff *Smith*, who was a surviving tenant in common, being entitled to sue in respect of the infringements in question, was that, had the action been brought during the lifetime of both tenants in common, it must have been brought by them both jointly, and the case is consequently to that extent an authority for saying that one of two co-assignees cannot sue for infringement without the other being a party to the action.^(u)

There is, however, the authority of *Malins, V.C.*, for saying that one person interested in a patent is entitled to sue without making his co-owners parties to the action, either for an in-

⁽ⁿ⁾ See *Morris' Patent Conveyancing*, p. 123.

^(o) *Ibid.*

^(p) *Ibid.* p. 126.

^(q) *Sheehan v. Great Eastern Ry. Co.*, (1880) L. R. 16 Ch. D. 59.

^(r) (1853) Macr. P. C. 207.

^(s) See p. 352 *post*; *Bergmann v. Macmillan*, (1881) L. R. 17 Ch. D. 423.

^(t) (1853) 2 E. & B. 69; Macr. P. C. 188.

^(u) But see above.

Co-Owners. junction or for an account.(x) It must be concluded, from a consideration of the case (y) on which the learned Vice-Chancellor's opinion was mainly formed, that the damages to which the plaintiff would in such circumstances be held entitled would be, not the whole profits, but only such proportion as should appear to be his, having regard to the proportion of the patent vested in the other co-owners. And on the analogy of *Bergmann v. Macmillan* (z) the account must be taken in the presence of all the parties interested.

Moreover, it has been held that where an assignment is made of a share in profits (arising, e.g., from the working of a patent by licences) the assignee is entitled to an account from the licensee, but that the account must be taken once for all in the presence of all the parties interested. Thus, if there be more than one assignee, all the assignees are necessary parties. And the assignee who asks for an account of the profits must place himself in the position of the assignor, by offering to pay to the accounting party anything which may be due to him from the assignee. Also an account of profits will not be directed if it is clear that no profits have been made.(a)

All parties interested in the patent, if they do not join as co-plaintiffs, may be, and for safety's sake should be, joined as defendants, in order that the infringing defendant may not be called on to account more than once, first to the plaintiff, and then separately to the other persons claiming an interest in the patent.(b)

Each one of a number of joint grantees of a patent is entitled to use the invention himself, without being under any obligation to obtain the consent of the others, or to account to them for any profits made by such use.(c) It is, however, doubtful whether one of such co-grantees could grant a valid licence without the consent of the rest, and without a liability to account to them for royalties received.(d)

But a person who is co-owner in fee of one moiety of a patent and mortgagee of the other moiety is entitled to work the patent himself without liability to account to the mortgagor; and if he grant licences he would no doubt in an action for redemption be bound to account to the mortgagor for

(x) *Sheehan v. Great Eastern Ry. Co.*, (1880) L. R. 16 Ch. D. 62.

(y) *Dent v. Turpin*, (1861) 2 J. & H. 139.

(z) (1881) L. R. 17 Ch. D. 427.

(a) *Bergmann v. Macmillan*, (1881) L. R. 17 Ch. D. 423.

(b) *Westhead v. Keene*, (1838) 1 Beav. 287; *Bergmann v. Macmillan*, (1881) L. R. 17 Ch. D. 423; *Van Gelder Co. v. Sowerby, Limited*, (1890) 7 R. P. C. 41.

(c) *Mathers v. Green*, (1865) L. R. 1 Ch. 29.

(d) p. 368 *post*.

royalties received as being profits received by him when mortgagee in possession.(e)

Assign-
ment of
Improve-
ments.

It is clear that one of two co-patentees cannot dispose of the rights of the other. Thus, if A. and B. are patentees, and B. wants to get rid of A., the only way in which he can do so is by getting A. to assign his rights to him : he cannot assign the whole patent to C., and then say that A. has no right to use it at all.(f)

A patent may be vested in one as trustee for another person or persons, and it is competent for trustees to sue alone in respect of infringements, but the Court or a judge may at any stage of the proceedings order the *cestuis que trustent* to be made parties ;(g) also a person is entitled to bring an action in his own name when the patent is registered in the name of another, if that other is a trustee for the plaintiff.(h)

Trustee and
cestuis que
trustent.

ASSIGNMENT OF FUTURE IMPROVEMENTS.

When inventors have once turned their attention to a particular class of inventions, or to some problem, the successful solution of which is felt to be a desideratum, which must bring benefit to the public and remuneration to the discoverer, it is well known that they are very likely to go on inventing fresh methods and improvements in the same direction. It frequently happens, therefore, that a purchaser of an invention is desirous of acquiring the right to an assignment of all future inventions and improvements of a like nature to the invention sold, which may be the produce of the assignor's inventive talent, for, as far as the purchaser is concerned, the utter destruction of the value, from a commercial point of view, of the original invention may be the result, if the monopoly in a better method, or an improvement in the means of achieving the desired object, is allowed to pass into the possession of anybody but himself. To prevent this, a covenant by the vendor of a patent to assign to the purchaser all future patent-rights which the vendor may thereafter acquire, in whatever way, of a like nature to the patent sold, is frequently inserted in deeds of assignment ; and such an agreement is not contrary to public policy.(i)

Covenants to
assign future
improvements

(e) See *Steers v. Rogers*, (1892) 9 R. P. C. 177 ; 10 R. P. C. 245.

(f) *In re Horsley and Knighton's Patent*, (1869) L. R. 8 Eq. 475.

(g) R. S. C. Order xvi. r. 8.

(h) *Speckhart v. Campbell*, "Times," Mar. 13, 1884.

(i) *Printing and Numerical Registering Co. v. Sampson*, (1875) L. R. 19 Eq. 462.

Estoppel.

are not con-
trary to public
policy.

On the contrary, public policy is directly in favour of such an agreement, by means of which a needy and struggling inventor may obtain a present payment to put his intellectual gifts at the service of a purchaser, and thus become enabled, in comparative ease and affluence, to devote his attention to scientific research, whereas if such a contract were prohibited he would be compelled to apply himself to some menial, or mechanical, or lower calling, in order to gain a livelihood.^(k)

The purchaser of a patent can maintain an action for breach of an agreement to assign further improvements and inventions, but specific performance will not be ordered on an interlocutory application.^(l)

Covenants for the assignment to the purchaser of patents for improvements upon the invention which the assignor shall in future become possessed of should be carefully drafted. Where an assignor covenanted that "any improvements on the said invention that he shall during the continuance of the aforesaid patents become possessed of shall be considered and be held to be part of the property hereby assigned, &c.," the covenant was held to contemplate only improvements discovered or made by the assignor himself, which he would be in a position to patent and assign to the assignee, and not to apply to patents in which he had only a beneficial interest with other persons.^(m)

ESTOPPEL.

Recitals and
covenants by
the assignor
which operate
as an estoppel.

If a deed of assignment recite that the assignor is the inventor, he is estopped from denying the validity of the patent in any subsequent action brought by the assignee, or any person deriving title through him, in respect of any infringement; for the principle of the law of estoppel is, that where a man has entered into a solemn engagement by deed under his hand and seal as to certain facts he shall not be permitted to deny any matter which he has so asserted.⁽ⁿ⁾

When there is fraud, or common mistake between the parties as to what was intended, then there is no estoppel.^(o)

^(k) *Printing and Numerical Registering Co. v. Sampson*, (1875) L. R. 19 Eq. 462; see judgment of Jessel, M.R., p. 465.

^(l) *London and Leicester Hosiery Co., Limited v. Griswold*, (1886) 3 R. P. C. 251.

^(m) *Pneumatic Tyre Co. v. Dunlop*, (1896) 13 R. P. C. 553.

⁽ⁿ⁾ *Bowman v. Taylor*, (1834) 2 A. & E. 278, 291; per Taunton, J., Wal-

ton *v. Lavater*, (1860) 8 C. B. N. S. 162; *Dunncliff v. Mallett*, (1859) 7 C. B. N. S. 209; *Franklin Hocking & Co. v. Franklin Hocking*, (1889) 6 R. P. C. 69, 72; see also rule in *Pickard v. Sears*, (1837) 6 A. & E. 469.

^(o) *Ashworth v. Law*, (1889) 7 R. P. C. 234; *Hayne v. Maltby*, (1789) 3 T. R. 439; *Lovell v. Hicks*, (1836) 2 Y. & C. 46.

It is the usual practice for the assignor to enter into covenants that he is the true and first inventor, and that the patent is valid, so far as his acts and omissions are concerned. A covenant for title is implied if the assignor is expressed to assign as beneficial owner or trustee.^(p)

Estoppel.

There may be an estoppel by matter of recital,^(q) but an estoppel must be certain, and is not to be taken from argument or inference.^(r)

If the recital only amount to an assertion that the assignor is himself an assignee of the actual inventor, it appears that the assignor is not estopped from denying the validity of the patent in an action brought by the assignee on a covenant contained in articles of agreement.^(s)

The grantee and assignor of letters patent is estopped in an action brought by the assignee against him for infringement, from denying that he had any title to convey.^(t)

It is competent, however, for the grantee and assignor to dissent, at the hearing of an action for infringement brought against him by his assignee, from a particular construction of the specification which would have the effect of sustaining the patent as against another construction which would invalidate it.^(u)

Assignor not estopped from denying a particular construction of the specification.

Also in such an action the defendant assignor, though not entitled to dispute the validity of the patent, may contend that the specification bears such a construction as to exclude what he is in fact doing from the ambit of the claim. Thus in *Hocking & Co. v. Hocking* ^(v) the patent was for "an improved apparatus for heating water and other liquids, applicable also as a condenser, cooler, or refrigerator." The specifications had been amended by disclaimer and memorandum of alteration filed by other assignees and predecessors in title of the plaintiff company. The complete specification, as amended, described and claimed the construction of a condenser, cooler, or refrigerator, consisting of an arrangement of annular spaces (*i.e.*, steam-spaces), substantially as described and shown, the principle of annularity and concentricity being disclaimed. Reversibility of the steam and water spaces was also pointed out in the specification as a

(p) Conveyancing Act, 1881, s. 7. 438; 1 W. P. C. 291; *Bowman v. Taylor*, (1834) 2 A. & E. 278.
 (q) *Lainson v. Tremere*, (1834) 1 A. & E. 792; *Bowman v. Taylor*, (1834) 2 A. & E. 278, 293.
 (r) Co. Litt. 352 b; *Bowman v. Taylor*, (1834) 2 A. & E. 278, 294.
 (s) *Hayne v. Maltby*, (1789) 3 T. R. 438; 1 W. P. C. 291.
 (t) *Oldham v. Langmead*, (1789) 1 W. P. C. 291.
 (u) *Hocking & Co. v. Hocking*, (1887) 4 R. P. C. 255, 434; 6 R. P. C. 69.
 (v) (1887) 4 R. P. C. 255, 434; 6 R. P. C. 69.

Estoppel.
 ———

special feature. The plaintiffs alleged against the defendant infringement of the condensing apparatus. It appeared in evidence that the apparatus of the defendant, in its simple form, was composed of a helical steam-space between two water-spaces, all the spaces being concentric and annular, and his multiform arrangement consisted of a cluster of the simple forms inside a large cylindrical vessel, and neither of his forms admitted of reversibility. At the trial, the defendant denied infringement, and alleged that, if the patent was so construed as to cover the alleged infringement, it would be void for want of novelty. *Kekewich, J.*, who was the Judge of first instance, held (1) that the Court would regard with extreme jealousy the defendant's claims, as being in derogation of his own grant, and would assume that the patent must have a reasonable meaning; (2) that the essence of the amended patent was the alternation of steam- and water-spaces of the particular character described and shown in the figures, combined, if convenient, but not of necessity, with concentricity; and (3) that the defendant's apparatus infringed, although it contained certain minor differences and additions, and in one form only a single steam-space, while in the rest the spaces were not concentric. The Court of Appeal (*dissentiente Fry, L.J.*), dismissed the appeal with costs, and the defendant thereupon appealed to the House of Lords. The House of Lords held that, although it approved of the principle that a grantee shall not defeat his own grant, the language of the specification must not be strained against the patentee, and that the effect of the disclaimer was to limit the patent to machines constructed substantially as described, and, therefore, the only question was whether the defendant's apparatus was so constructed. The House found as a matter of fact that the defendant's apparatus was not so constructed, and the decisions of the Court of Appeal and *Kekewich, J.*, were accordingly reversed with costs, in favour of the appellant and defendant in the action.

Assignor not estopped from assisting a defendant with evidence.

Though an assignor, who assigns under terms which amount to an express or implied warranty of the validity of the patent, is estopped from denying the patent in an action brought against him by the assignee, he cannot be restrained from assisting as a scientific witness or otherwise a defendant, other than himself, in an action instituted by the assignee, or from communicating to such defendant evidence tending to show the invalidity of the patent.

Thus, on an interlocutory application in *London and Leicester*

Hosiery Company Limited v. Griswold (y) the plaintiff sought to obtain an injunction of the Court to restrain the defendant in the action, who was the original patentee and assignor of the company's patents, from assisting, as a scientific witness or otherwise, the defendants in two other actions then pending for the infringement of the company's patents. *North, J.*, in refusing the injunction asked for, pointed out that he could not, under any circumstances, grant an injunction to restrain the defendant from obeying the subpoena to attend as a witness in Court and answering questions which might be properly put to him in the course of examination as a witness, the refusal to answer which might lead to his committal to prison for contempt. Warranty.

On the same application it was also sought by the plaintiffs to restrain the defendant in the action from communicating to the defendants in other actions information in his possession which might enable the defendants in the other actions to show that the patents assigned were not valid patents. The Court refused to grant an injunction, and the learned Judge stated that, though it is well settled that a licensee of a patent is, during the continuance of the licence, estopped from disputing the existing patent, yet it is going a great deal further to say that a man, who has assigned a patent, is to be restrained from mentioning to any person, at any time, or under any circumstances, matters which might show that the patent, which was granted by the Crown in the belief that the invention claimed was a new invention, was not, as a matter of fact, a new invention.

A bankrupt patentee, whose patent has been sold by his trustee in bankruptcy, is not estopped, in an action subsequently brought against him (the patentee) for infringement, from denying the validity of the patent, either by matter of record, on the ground that the letters patent were matters of record; or by deed, by reason of the specification being under his seal; or by matters *in pais*, on the ground of the statements in the declaration accompanying his application, there being nothing to show that the purchaser bought on the faith of those statements.(z) Assignment by trustee in bankruptcy does not raise an estoppel against the bankrupt patentee.

WARRANTY.

In cases arising on the breach of contracts by purchasers of letters patent, it is always most important to consider whether Warranty may be express or implied.

(y) (1886) 3 R. P. C. 251.

(z) *Cropper v. Smith*, (1884) L. R.

26 Ch. D. 700; L. R. 10 App. Cas.

249; 1 R. P. C. 81; 2 R. P. C. 17.

Warranty. the contract contains any express or implied warranty on the part of the assignor as to the validity of the patent, for, if there is no such warranty, the purchaser, in the absence of fraud, cannot repudiate the contract on the ground that he has subsequently discovered the patent to be void. A purchaser, without a warranty from the assignor, in the absence of fraud, is bound to take the patent with all its faults, if it have any. (a)

In the absence of warranty the doctrine of *caveat emptor* applies.

In *Hall v. Conder*, (b) the leading case on this point, the facts were as follow:—By an agreement reciting that the plaintiff had invented a method for the prevention of boiler explosions, and had obtained a patent for the use of the same within the United Kingdom, and was desirous of taking out patents in France, Belgium, and such other places as might be found expedient, and that he had disposed of a moiety of the English patent, and had applied to the defendant to purchase the other moiety, and, to assist him in taking out the foreign patents, it was agreed that the defendant should pay to the plaintiff a certain sum in such manner as should be mutually agreed on, and also a proportion of the net profits, and in consideration of such agreement on the part of the defendant, the plaintiff “agreed to make over and transfer, and did thereby accordingly make over and transfer to the defendant one-half of the said foreign patents, when the same should be obtained, and the above-mentioned one-half of the English patent thereinbefore referred to.” The action was brought for the specific performance of this agreement, and the defendant objected that the invention was wholly worthless, and of no public utility, and was not new in England, and that the plaintiff was not the true and first inventor. The Court of Common Pleas, however, held that, in the absence of any allegation of fraud, it must be assumed that the plaintiff was an inventor, and there was no warranty, express or implied, either that he was the true and first inventor, within the meaning of the statute of James I., or that the invention was useful or new; but that the contract was for the sale of the patent such as it was, each party having equal means of ascertaining its value, and each acting on his own judgment.

In *Smith v. Buckingham* (c) it appeared that the defendant had agreed to purchase the patent rights of the plaintiff in an invention for which provisional protection had been obtained. The agreement contained a recital to the effect that the plaintiff

(a) *Hall v. Conder*, (1857) 2 C. B. N. S. 22; *Smith v. Neale*, (1857) 2 C. B. N. S. 67.

(b) (1857) 2 C. B. N. S. 22.

(c) (1870) 21 L. T. N. S. 819.

had lately invented an improved composition or material to be used in waterproofing, or rendering woven fabrics impervious to moisture. The action was on the breach of the agreement, and the defendant pleaded that the plaintiff had not invented an improved, or any, composition or material which could be employed in rendering woven fabrics impervious to moisture, but the Court of Queen's Bench gave judgment for the plaintiff, holding that the plea did not show a total failure of consideration, and that there was no express or implied warranty, and that the defendant had got what he bargained for. Warranty.

When a company is promoted for the purpose of acquiring a patent, which has not been declared void by a Court of law and is described in the prospectus as a "valuable and valid patent" on the strength of a favourable report of an expert, it is not competent to a shareholder in an action for the removal of his name from the register of members, on the ground of misrepresentation in the prospectus, to adduce evidence of the invalidity of the patent. In such a case the question is whether the patent was valuable at the date of the prospectus. *(d)*

Statement that a patent is "valuable and valid."

When, upon an agreement for purchase, the validity of the patent is a subject specially contemplated by the parties, the agreement should make it clear whether the question of validity is to be decided by the opinion of the purchaser, or whether the patentee warrants the validity in fact. Thus, when an agreement for purchase was entered into for a sum down and the remainder "within twenty-eight days, which latter payment the purchaser agrees to make immediately he has satisfied himself that the said patents are valid and of full force and effectual in law," and the vendor warranted the validity, it was held that in an action for specific performance the plaintiff was entitled to particulars of the purchaser's objections to validity; and, as it turned out that one of the patents in question was void for non-payment of fees, the action was dismissed, the real question being as to the validity of the patents in fact and not whether the purchaser was satisfied as to validity. *(e)*

No injunction restraining the patentee from dealing with patents which are the subject of an alleged agreement for sale and distribution of the proceeds of sale between him and the purchaser will be granted unless the purchaser is in a position to obtain specific performance of the agreement. *(f)*

(d) *Stavert v. Passberg Grain Syndicate*, (1891) 8 R. P. C. 400.

(e) *Hazlehurst v. Rylands*, (1892) 9 R. P. C. 1.

(f) *Harlett v. Hutchinson*, (1891) 8 R. P. C. 457.

Rights of Assignees.

No implied warranty that assignee will be able to use the invention without licence.

Assignee with notice takes subject to prior assignee's covenants.

It is submitted that upon the sale of a patent there is no implied warranty that the purchaser will be entitled to put the invention into practice without liability to obtain the licence of a prior patentee.^(g)

When an assignee takes from a prior assignee, with notice, he takes subject to the prior assignee's covenants. Thus,^(h) a patentee assigned letters patent to two persons, A. and B., who covenanted with him that they, their executors, administrators, and assigns, would use their best endeavours to introduce the invention by granting licences, or working the patent, or selling it, and that the patentee should be entitled to receive £5 per cent. of all net profits, whether arising from royalties, sale, or otherwise, which should be received by A. and B., or the survivor of them, the executors or administrators of such survivor, or their or his assigns, and that an account of profits should be rendered yearly to the patentee and his share of profits paid to him by A. and B., and the survivor of them, and the executors or administrators of such survivor, or their or his assigns, with a proviso that, after a sale had been made of the patent, the interests of the patentee in the profits should cease and a final account be come to. A. and B. had taken the assignment with a view to forming a company to work the patent. The company was formed, and the patent made over to it. The patentee sued the company for an account of profits. The company demurred, on the ground that there was no privity between them and the plaintiff, and that the plaintiff's right, if any, was against A. and B. only. It was held, however, both by *Bacon*, V.C., and the Court of Appeal, that the plaintiff could sue the company for an account of profits, since the stipulations of the assignment to A. and B. amounted to a contract that the owners for the time being of the patent should account for and pay to the plaintiff a share of the profits, unless a sale within the meaning of the deed was effected, and no person taking the patent with notice of this contract could refuse to give effect to it.

RIGHTS OF ASSIGNEES.

Action for infringement by assignee.

The assignee of a patent may maintain an action for infringement, though he has acquired the right by two assignments of separate portions and the party sued is the original grantee. Moreover, the action is maintainable, although there has been

^(g) *Monforts v. Marsden*, (1895) 12 R. P. C. 266

^(h) *Werdermann v. Société Générale d'Electricité*, (1881) 1 L. R. 19 Ch. D. 246.

no infringement since the defendant has received notice that the entire interest in the patent has become vested in the plaintiff.⁽ⁱ⁾ Rights of Assignees.

The assignment of a patent restrains the assignor and subsequent licensees from him from working or using the invention without the leave or licence of the assignee ; ^(k) and with respect to prior licensees from the assignor the rule seems (in the absence of any express reservation in the assignment of their rights) to be that, if the assignee took the assignment with notice thereof, he takes it subject to their licences, and, therefore, cannot restrain them, but that, if he had no such notice, he is entitled to restrain them. Action for infringement against assignor.

An assignee is, at any time so long as he remains the person for the time being entitled to the benefit of the patent, entitled to ask for leave to apply at the Patent Office for liberty to amend the specification ; he is in fact included in the meaning of the term "patentee" as used in the Act of 1883.^(l) Amendment of specification by assignee :

It may be questioned whether a person to whom a patent has been assigned by way of mortgage is entitled to apply at the Patent Office for leave to amend the specification, or to present a petition to the Privy Council for the prolongation of the patent, without his mortgagor being a party to the application.^(m) e.g., mortgagee.

It is advisable for the mortgagor of a patent to insist on the mortgagee entering into a covenant not to seek leave to amend the specifications or drawings without the written consent of the mortgagor.

An assignee, as the person for the time being entitled to the benefit of the patent, is included in the meaning of the term "patentee," as defined by the Act of 1883, and competent to petition for the prolongation of the patent ; ⁽ⁿ⁾ and an extension may be granted to the assignee, if the patentee has ceased to have any connection with the working of the patent,^(o) or if the assignee has paid a large sum for the assignment and the development of the invention.^(p) Petition for prolongation of patent by assignee.

But assignees petitioning for the extension of letters patent,

(i) Walton v. Lavater, (1860) 8 C. B. N. S. 162.

(k) Hassall v. Wright, (1870) L. R. 10 Eq. 509.

(l) 46 & 47 Vict. c. 57, s. 46.

(m) See Van Gelder Co. v. Sowerby, Limited, (1890) 7 R. P. C. 41, 208.

(n) 5 & 6 Vict. c. 83 ; 7 & 8 Vict. c. 69 ; Russell v. Ledsam, (1847) 14 M. & W. 574, 588 ; 1 H. L. Cas. 687.

(o) Napier's Patent, (1861) 13 Moo. P. C. 543.

(p) Bodner's Patent, (1849) 6 Moo. P. C. 468.

Assign-
ment and
Partner-
ship.

are not received with so much favour as the original grantee, (q) and the prayer of the petition is not usually granted unless it is evident that the original grantee will derive some benefit by the extension. (r)

Not unfrequently conditions are imposed for the benefit of the patentee when prolongations are granted on the petition of assignees, (s) and in *Bovill's Patent*, (t) where the petition was presented by the patentee and his mortgagee, the extension was granted to the patentee alone.

ASSIGNMENT AND PARTNERSHIP.

Assignment
of a share may
constitute a
partnership.

The assignment of a share in the profits of letters patent may constitute a partnership between the assignor and assignee, and create consequences not perhaps contemplated between them which might have been avoided by the grant of a licence at a royalty instead of an assignment. (u)

Rights of
partners in an
invention.

Where a partnership at will is formed for the purpose of working an invention for which a patent has been taken out by, and registered in the name of, one of the partners alone, the patent becomes an asset of the partnership and each partner acquires a right to practise the invention, which right is not taken away by the registered owner assigning the patent to third parties who have notice of the existence of the partnership; and even after the determination of the partnership each of the partners has an equal right and licence to use the invention, the dealings between them having been such as to create in the one partner an irrevocable licence, as far as the other partner, the patentee, is concerned, to use the invention. (v)

Thus a person named *Kenny*, who had invented an improved kind of button-hole for boots and shoes, and a machine for making it, obtained a loan from a person, *Lutwyche*, to enable him to meet the expense of taking out a patent for the invention; and the patent having been obtained by *Kenny*, in his name alone, he and *Lutwyche* for more than four years worked the invention in partnership, together. After the partnership

(q) Norton's Patent, (1863) 1 Moo. P. C. N. S. 3, 9; Claridge's Patent, (1851) 7 Moo. P. C. 394; Normand's Patent, (1870) L. R. 3 P. C. 193; p. 411 *post*.

(r) Norton's Patent, (1863) 1 Moo. P. C. N. S. 339; Pitman's Patent, L. R. 4 P. C. 87; p. 411 *post*.

(s) Pitman's Patent, (1871) L. R. 4 P. C. 84, 87; Herbert's Patent, (1867)

L. R. 1 P. C. 399; Whitehouse's Patent, (1830) 1 W. P. C. 473; Markwick's Patent, (1860) 13 Moo. P. C. 310; Russell v. Ledsam, (1847) 14 M. & W. 574; p. 438 *post*.

(t) (1863) 1 Moo. P. C. N. S. 348.

(u) 1 W. P. C. 417 n.

(v) *Kenny's Patent Button-holing Co. v. Somervell*, (1878) 26 W. R. 787.

had existed for some years, *Kenny* agreed with the trustee of a projected company to assign the patent to it, and the company having been formed, the assignment was duly made and registered. At the time of the agreement and assignment respectively, the trustee and directors of the company knew that *Lutwyche* and *Kenny* had been working the invention together. Notice of the assignment was given to *Lutwyche*, and he was warned not to infringe the patent, but he continued to work the invention, and the company then sought to restrain him from so doing, but the Court held that by the partnership *Lutwyche* had obtained a licence to work the invention; that at the time of the assignment of the patent the company had notice of the existence of his right; and that they could not revoke the licence.(y)

Assign-
ment
by Act and
Operation
of Law.

ASSIGNMENT BY ACT AND OPERATION OF LAW.

An assignment by act and operation of law takes place when a person becomes entitled to a patent right without any deed of assignment from the person to whom he succeeds or through whom he claims. The patent is granted to the grantee, his executors, administrators, and assigns, and these words of limitation constitute it an assignable chattel interest, assignable by act and operation of law, just as any other chattel is.

Act and opera-
tion of law.

On the death of a grantee or assignee of a patent, the patent vests in his executor if he has made a duly executed will, and in his administrator if he dies intestate; (z) and such executor or administrator may sue for and recover in respect of infringements committed during the lifetime of the testator or intestate, as the case may be, if the probate of the will or grant of letters of administration has been entered on the register of patents.

Death of
grantee or
assignee.

If a person die possessed of an invention without having made an application for a patent, the right to apply vests in his legal representative, who of course would hold the patent, if granted, subject to any trusts contained in the will of the deceased, or for the benefit of the next of kin in cases of intestacy. And the 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.(a)

Death of per-
son possessed
of an inven-
tion.

(y) *Kenny's Patent Button-holing Co. v. Somervell*, (1878) 26 W. R. 787.

(z) *Williams on Executors*, 8th ed. vol. i. p. 824.

(a) 46 & 47 Vict. c. 57. s. 34; p. 5 *ante*.

Registra-
tion of
Assign-
ments.

Trustee in
bankruptcy.

Rights of un-
discharged
bankrupt to
fruits of un-
patented in-
vention.

If a grantee or assignee is declared bankrupt, the patent vests in his trustee in bankruptcy, (b) who thereupon becomes entitled, for the benefit of the creditors, to sue in respect of infringements, whether committed before the bankruptcy or not, but it is submitted that the trustee, before commencing action, must obtain an entry of his title on the register of patents.

If a bankrupt before he obtains his certificate of discharge obtain a patent it will vest in his trustee for the benefit of the creditors. (c) The fruits which result from schemes which a bankrupt has in his head before he obtains his discharge do not pass to the trustee, provided such results are subsequent to the bankrupt's discharge; but if he avail himself of his knowledge and skill, and thereby acquires a beneficial interest, which may be the subject of assignment, that interest will pass to the trustee. (d)

Letters patent are liable to seizure by the sheriff under a writ of *fi. fa.* in satisfaction of a judgment debt. It would appear that the writ authorises the sheriff to sell and assign the chattel interest of the judgment debtor. (e) The assignee, on application at the Patent Office, will be duly entered on the register as patentee.

REGISTRATION OF ASSIGNMENTS.

Statutory
provisions.

By s. 87 of the Act of 1883 (f) it is enacted that when a person becomes entitled by assignment, transmission, or other operation of law, to a patent, the Comptroller shall, on request, and on proof of title to his satisfaction, cause the name of such person to be entered in the register of patents as proprietor of the patent; and it is by the same section further provided that the person for the time being entered on the register of patents as proprietor of a patent shall, subject to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with the same, and to give effectual receipts for any consideration for such assignment, licence, or dealing, provided that any equities in respect of such patents

(b) *Hesse v. Stevenson*, (1808) 3 Bos. & P. 565; *Bloxam v. Elsee*, (1827) 6 B. & C. 169; 9 Dowl. & R. 215; Bankruptcy Act, (1883).

(c) *Hesse v. Stevenson*, (1808) 3 Bos. & P. 565.

(d) *Ibid.* See judgment of the Court

of Common Pleas, delivered by Lord Alvanley, C.J.

(e) *Coleman v. Rawlinson*, 1 F. & F. 330; *Harley v. Harley*, 11 Ir. Ch. Rep. 451.

(f) See also s. 23.

may be enforced in like manner as in respect of any other personal property.

Registra-
tion of
Assign-
ments.
—

It is submitted that a person can only claim registration under this section if he possesses the legal estate, and consequently a mere equitable assignee is not entitled to registration under this section.^(g) Equitable assignments, however, may be entered on the register as documents affecting the proprietorship of the patent.^(h)

It is to the interest of assignees to register their assignments as soon as possible.⁽ⁱ⁾

Assignments
should be
registered
immediately.

Mortgagees of patents are always entered on the register as "mortgagees," and not as "assignees." It is submitted that a mortgagee, together with his mortgagor, form the proprietor.^(k)

Mortgagees
are registered
as such and
not as as-
signees.

As a rule, documents relative to the proprietorship of letters patent of earlier date than the letters patent will not be entered on the register. It cannot, however, be laid down as a hard-and-fast rule that such documents ought not to be entered on the register, for there may be some which, as amounting to assignments, ought to be entered, whilst, on the other hand, to the entry of others very forcible objections might be raised which would prove absolutely insuperable.^(l)

Documents of
earlier date
than the letters
patent.

The practice to be observed where an application is made for an entry of an assignment on the register of patents is regulated by Patent Rules, 1890.^(m)

Practice on
registration..

Since the Act of 1883 came into operation, there has been no decided case in which the question has been determined whether an assignee of a patent is entitled to maintain an action for infringement before the assignment has been entered on the register, but on the authority of the old cases it is submitted that he could not do so, unless the defendant had notice of the assignment.

Is registration
a condition
precedent to
right to sue?

In *Chollet v. Hoffman*,⁽ⁿ⁾ a case decided under the Act of 1852, which provided for the registration of assignments,^(o) it was held that an assignee could not sue until his assignment had been registered, otherwise as the statute provided that before such registry the original patentee should be deemed the sole owner, a defendant would be liable to be sued at one

^(g) *Stewart v. Carey*, (1892) 9 R. P. C. 9, judgment of Bowen, L.J.

^(h) See p. 337 *ante*.

⁽ⁱ⁾ See *post*.

^(k) See *Van Gelder Co. v. Sowerby, Limited*, (1890) 7 R. P. C. 41, 208.

^(l) In the Matter of Parnell's Patent, (1888) 5 R. P. C. 126, 130.

^(m) rr. 67 to 73.

⁽ⁿ⁾ (1857) 7 E. & B. 686.

^(o) 15 & 16 Vict. c. 83, s. 35.

Registra-
tion of
Assign-
ments.

and the same time by the grantee and assignee of the letters patent. It would appear that the reasoning upon which this case was decided applies equally to the law as it now stands.

In *Hassall v. Wright*, (p) which differed from *Chollet v. Hoffman* in that it was an action between assignee and assignor, whereas the latter case was between assignee and third parties, it was decided that the assignee could maintain an action against the assignor and his licensees, who had notice of the assignment, notwithstanding the fact that the assignment had not been registered.

Has registra-
tion a retro-
spective effect?

The question as to whether the registration of an assignment has a retrospective effect, so as to place the assignee in a position to sue for and recover damages in respect of infringement committed after the assignment, but before the registration, has not been judicially determined, but it is submitted that the registration being merely an evidence of title, relates back to the date of the assignment, and that the assignee, on having his title perfected, is entitled to maintain the action.(q)

Where the plaintiff in an infringement action derived his title to the patent under an assignment from the executors of the patentee, and it appeared that the assignment was made after probate was granted, but before it was registered, and that the deed of assignment was not registered until after the registration of the probate, it was held that the plaintiff was entitled to maintain his action.(r)

SURRENDER.

Letters patent
may be sur-
rendered to
the Crown.

A patentee or an assignee may dispose of the patent by surrender to the Crown, the effect being to extinguish the privilege. If there is more than one patentee or assignee, all should join in a surrender of the patent, though probably a joint patentee or assignee might surrender his part of the patent.

The surrender of a patent must be made by deed, which requires enrolment, for nothing can be conveyed to the Crown except by matter of record.(s)

(p) (1870) L. R. 10 Eq. 509; 40 L. J. N. S. Ch. 145.

(q) *Hassall v. Wright*, (1870) L. R. 10 Eq. 509.

(r) *Ellwood v. Christy*, (1864) 17 C. B. N. S. 754; 18 C. B. N. S. 494; 34 L. J. C. P. 130.

(s) *Hindmarch on Patents*, 217.

CHAPTER IX.

LICENCES.

ORIGIN OF POWER TO GRANT LICENCES.

It is open to question whether a patentee could give a valid licence authorising another person to exercise the privilege granted by the Crown, which is of a personal nature, unless the power to grant such licence was expressly given by the letters patent themselves, which, as we have seen, not only grant, but actually create the monopoly.^(a)

Query whether patentee could grant licences without express authority.

The old form in which letters patent were granted gave express power to the grantee to authorise his licensees to perform the invention.

Old form of letters patent.

Express power of granting licences is likewise conferred on the patentee by the form prescribed by the Act of 1883, which, or which slightly modified to meet special circumstances, is now used for the grant of letters patent for inventions.^(b) The grant is made to the "patentee," which by a previous recital means the grantee, his executors, administrators, and assigns; and then follows a prohibition to all the Queen's subjects whomsoever, within the United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the term for which the patent is granted, either directly or indirectly, make use of or put in practice the invention, or any part of the same, nor in anywise imitate the same, nor cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, licence, or agreement of the patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of the royal command, and of being answerable to the patentee, according to law, for his damages thereby occasioned. And the letters patent further contain a proviso that nothing therein contained shall prevent

Present form of letters patent.

^(a) p. 344 *ante*.

^(b) See p. 741 *post*.

How
Licences
may be
Granted.

—
Powers of co-
owners to
grant licences.

the granting of licences in such manner and for such considerations as they may by law be granted.

Each of two or more co-owners of a patent is entitled to work the invention for himself, and to assign his share, but there is some doubt whether he is entitled to grant licences without the consent of his co-owner.(c)

The question whether one of several co-owners is entitled to grant a licence alone depends on the words of the letters patent.(d) If, as in *Mathers v. Green*,(e) the grant is made to the grantees, their executors, administrators, and assigns, that they and every of them, by themselves, their servants and agents, *and such others as they shall agree with*, and no others, may use the invention, then it is submitted that no licence could be granted without the concurrence of all the patentees.(f)

Royalties
received by
co-owners.

Each co-owner is entitled to retain whatever profit he makes by his own working of the invention, though it is open to question whether, if he is entitled to and does grant licences, he is not liable to account to his co-owners for the royalties he receives.(g)

Mortgagee in
possession
may grant
licences.

A mortgagee in possession may grant licences; but he is liable to account to the mortgagor in an action for redemption for royalties received, as being profits made by him whilst mortgagee in possession.(h)

HOW LICENCES MAY BE GRANTED.

Form in which
licences must
be granted.

The effect of the prohibiting clause in the letters patent seems to make it compulsory that the licence must be under the hand and seal of the patentee; that is to say, it must be made by deed, or rather, speaking strictly, by an instrument which is only of the nature of a deed, because it does not require delivery, and will not be refused in evidence, though unstamped.(i)

The prohibiting clause, however, must be read in conjunction with the provision contained in the latter part of the patent, which is in the words "but nothing herein contained

(c) *Mathers v. Green*, (1865) L. R. 1 Ch. 29; see p. 352 *ante*.

(d) See p. 741 *post* as to forms of letters patent at present in use in cases of grants to joint grantees.

(e) L. R. 1 Ch. 29.

(f) See *Jessel, M.R., Powell v. Head*, (1879) L. R. 12 Ch. D. 690.

(g) *Dunnicliff v. Mallett*, (1859) 7

C. B. N. S. 209; *Walter v. Lavater*, (1860) 8 C. B. N. S. 162; *Mathers v. Green*, (1865) L. R. 1 Ch. 29; *Hancock v. Bewley*, (1860) Johns R. 601.

(h) *Steers v. Rogers*, (1892) 9 R. P. C. 177; 10 R. P. C. 245.

(i) *Chanter v. Johnson*, (1845) 14 M. & W. 408.

shall prevent the granting of licences in such manner and for such considerations as they may by law be granted." If there is a writing purporting to be an agreement of licence between the parties which has been acted upon, it is not competent to either party to repudiate responsibility under it on the ground that it is not under seal.^(k)

Also an effective licence may arise from parol agreement,^(l) if acted upon.

In the case of an executory agreement for a licence under seal, it is a question of construction as to whether the grant of a formal deed is a condition precedent; and, if this is not so, the agreement is, in equity, equivalent to a formal deed of licence in questions affecting the rights of the parties.^(m) For example, in *Tweeddale v. Howard and Bullough, Ltd.*,⁽ⁿ⁾ it appeared that negotiations had taken place between the plaintiff and defendants, which in the plaintiff's view resulted in an arrangement for a licence. There never was a complete agreement between the parties as to the terms of the licence by deed which was intended to be entered into; but they had, whilst negotiating as to the terms of the deed, entered into a binding agreement which covered part of the ground contemplated, and which rendered the defendants licensees up to a specific date. The plaintiff accordingly obtained a declaration that the defendants were licensees up to that date, and also an account of royalties due.

An agreement for a licence made before the patent is granted and in contemplation of the grant may be sued upon after the grant. Thus, where an applicant before filing his complete specification granted a licence to use the invention, and the licensees on being sued, after the grant of the patent, for the payment of royalties refused to pay, on the ground that the letters patent were obtained for an invention less than the whole invention described in the provisional specification, *Chitty, J.*, held that, on the construction of the licence, without deciding the point so raised by way of defence, the bargain was that in the circumstances the royalties should be paid.^(o)

A licence to use a patented invention, if made by deed, bears a ten-shilling stamp; and an *ad valorem* stamp is required in cases where a fixed sum is paid as consideration. In cases

How Licences may be Granted.

—
A writing if acted upon is effective though not under seal.

Licence may arise from a parol agreement acted upon.

Necessity for a formal deed is a question of construction in cases of executory agreements.

Agreement for licence prior to the grant of the patent.

Stamps.

(k) *Chanter v. Dewhurst*, (1844) 12 M. & W. 823; 13 L. J. Ex. 198; *Chanter v. Johnson*, (1845) 14 M. & W. 408; *Post Card Automatic Supply Co. v. Samuel*, (1889) 6 R. P. C. 560.

(l) *Crossley v. Dixon*, (1863) 10 H. L. C. 291.

(m) *Post Card Automatic Supply Co. v. Samuel*, (1889) 6 R. P. C. 560; *Tweeddale v. Howard and Bullough, Ltd.*, (1896) 13 R. P. C. 522.

(n) (1896) 13 R. P. C. 522.

(o) *Otto v. Singer*, (1889) 7 R. P. C. 7.

Classifica-
tion of
Licences.

where the licensee covenants to pay a minimum royalty the Stamp Office requires an *ad valorem* duty to be paid on the gross minimum royalty, and this whether or not the licence is determinable.

A mere licence in writing does not require any stamp, but if the writing amounts to an agreement it must be stamped accordingly. (*p*)

CLASSIFICATION OF LICENCES.

Licences to use patented inventions may be—

(1) *Expressed.*

(2) *Implied.*

Sale of pa-
tented article
without re-
strictions gives
purchaser
right to use
where and
how he pleases.

The sale of an article without any restriction, whether manufactured under a British or foreign patent, as against the vendor, gives the purchaser an implied licence to deal with the article in any way he thinks fit, and of course that includes selling in any country where there is a patent in the possession of, and owned by, the vendor. (*q*)

The vendee of a licensee has all the privileges of an ordinary vendee, including that of resale. Thus, where the defendant in an action for the infringement of a patent for improvements in the manufacture of soap pleaded that the alleged infringement was the resale by him of soap purchased by himself from licensees of the plaintiff, the Court of Common Pleas held this to be a good defence, and gave judgment for the defendant accordingly. (*r*)

What the letters patent prohibit the public from doing without the consent, licence, or agreement of the patentee, is the making use of, or putting in practice, the invention comprised in the patent—that is, the art by the exercise of which the patentee produces the finished product.

When use of
a patented
article is an
infringement.

The public are generally entitled to use the invention in the sense of the finished product without the further licence of the patentee, if that finished product was not produced in infringement of the patent—*i.e.*, it was produced by the patentee, or under licence from him.

Use of a manufactured article only constitutes an infringement when the article used was produced without authority; (*s*)

(*p*) *Wilson v. Union Oil Mills*, (1892) 9 R. P. C. 62.

(*q*) *Société Anonyme des Manufactures des Glaces v. Tilghman's Patent Sand Blast Company*, per Cotton, L.J., (1883) L. R. 25 Ch. D. 9; *Betts*

v. Willmott, (1870) L. R. 6 Ch. 239; *Heap v. Hartley*, (1888) 5 R. P. C. 603; 6 R. P. C. 495; but see p. 379 *post*.

(*r*) *Thomas v. Hunt*, (1864) 17 C. B. N. S. 183.

(*s*) p. 497 *post*.

or where it was produced under a licence strictly limited to its manufacture and not applicable to its use, (t) for a licence to manufacture an article does not necessarily imply a licence to use the article when manufactured. (u)

Classi fication of Licences.
—

Licences to use patented inventions may also be—

- (1) *Compulsory.*
- (2) *Voluntary.*

Previous to the Act of 1883 it was optional with the grantee of a patent whether he would grant licences authorising other persons to use the invention, but s. 22 of the Act of 1883 (which only applies in this respect to patents granted on applications since January 1, 1884), (x) enacts (y) as follows:—

Patentee may be compelled to grant licences.

If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licences on reasonable terms—

- (a) The patent is not being worked in the United Kingdom; or,
 - (b) The reasonable requirements of the public with respect to the invention cannot be supplied; or,
 - (c) Any person is prevented from working or using to the best advantage an invention of which he is possessed,
- the Board may order the patentee to grant licences on such terms as to the amount of royalties, security for payment, or otherwise, as the Board, having 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. (z)

It is to be observed that neither the Act nor the Rules give any powers either to the Board of Trade, or the Comptroller, over the costs incurred on presenting a petition for the grant of a compulsory licence.

The Act does not directly provide for any appeal from the decision of the Board of Trade, and in the case of a refusal on the part of the Board to grant an application there is absolutely no appeal; but it would appear that in the event of the Board granting the prayer of the petition the patentee may obtain a revision of the Board's decision by leaving the petitioner to move for a mandamus to enforce the order. A writ of mandamus is a prerogative writ, and not a writ of right, and it is in this sense in the discretion of the Court whether

Appeal from the decision of the Board of Trade.

(t) *Basset v. Graydon*, (1897) 14 R. P. C. 701.

(u) *Ibid.*

(x) 46 & 47 Vict. c. 57, s. 45 (2).

(y) 46 & 47 Vict. c. 57, s. 22.

(z) The practice on an application for the grant of a compulsory licence is governed by rules 60 to 67 inclusive of the Patent Rules, (1890); 51 & 52 Vict. c. 50, s. 25.

Classifica-
tion of
Licences.

it shall be granted or not. The Court may refuse to grant the writ, not only on the merits, but upon some delay, or other matter personal to the party applying for it; in this the Court exercises a discretion which cannot be questioned. So in cases where the right, in respect of which a rule for a mandamus has been granted upon showing cause, appears to be doubtful, the Court frequently grants a mandamus in order that the right may be tried upon the return; this is also a matter of discretion. (a) The writ may be refused on a consideration of the special circumstances of a particular case, (b) and it was refused where it was impossible, owing to want of funds, to perform an order of the Board of Trade. (c)

Licences may also be—

- (1) *Revocable.*
- (2) *Irrevocable.*

Licences con-
taining pro-
visions for
revocation.

Frequently the licence contains a provision under which it may be revoked and terminated by one or both of the parties on the happening of certain events, such as the non-payment of royalties or a decision of a Court of law to the effect that the patent is void. In the latter case, where the patent is in fact declared invalid in an action against third parties, but the decision of the Court is afterwards reversed, even though by consent, the licensee cannot rely upon the decision of invalidity since it was reversed, and under such circumstances he is liable to the licensor in an action to recover unpaid royalties. (d)

When from an examination of the whole instrument it appears clear that the intention of the parties was that the licence was to be irrevocable, neither party can, without the consent of the other, put an end to it. (e)

Licence
coupled with
an interest is
not revocable,
though a mere
licence is
revocable.

If the licence is silent as to the power of the parties to revoke it, it then becomes of the utmost importance to decide whether the licence is one coupled with an interest or not. A mere licence is, in the absence of provisions to the contrary, revocable at the will of either party; (f) but a licence coupled with an interest cannot be so revoked. (g)

(a) Per Lords Chelmsford and Hath-
erley, *R. v. Churchwardens of All
Saints', Wigan*, (1876) L. R. 1 App.
Cas. 620, 622.

(b) *R. v. Garland*, (1870) L. R. 5 Q.
B. 269.

(c) *Re The British and North
Somerset Ry. Co.*, L. R. 3 Q. B. D. 10.

(d) *Cheetham v. Nuttall*, (1893) 10
R. P. C. 321.

(e) *Kenny's Patent Button-holing*

Co. v. Somervell, (1878) 26 W. R.
787; 38 L. T. N. S. 870.

(f) *Wood v. Ledbitter*, 9 Jur. 187;
Redges v. Mulliner, (1893) 10 R. P. C.
21; *Crossley v. Dixon*, (1863) 10 H.
L. C. 291.

(g) *Wood v. Ledbitter*, 9 Jur. 187;
Ward v. Livesay, (1888) 5 R. P. C.
102; *Guyot v. Thomson*, (1894) 11 R.
P. C. 541; *Cutlan v. Dawson*, (1897)
14 R. P. C. 249; 13 R. P. C. 716-717.

“Coupled with an interest” is a somewhat ambiguous term, and it is probably more correct, with reference to licences to use patented inventions, to say “coupled with obligations.”^(h)

Classifica-
tion of
Licences.

Though a licence is one coupled with an interest, or involving obligations on each of the parties, and so not revocable, yet it may, upon the terms of the instrument, be liable to forfeiture in the event of breach of the terms and conditions on which it was made.⁽ⁱ⁾

When from the terms of the licence it appears not to be coupled with obligations on either the licensor or licensee it is, as stated above, generally speaking, revocable at the will of either party.^(k)

When, however, the licence is coupled with obligations on both the parties it is not so revocable—*e.g.*, where the licence is exclusive and the licensor is under the obligation not to use the patented invention himself, and the licensee is under the obligation to use his best endeavours to advertise and push the invention.^(l)

And where the agreement expressly provides that one party may determine the licence, but is silent as to the power of the other party to put an end to it, the Courts will infer an intention to the effect that the licence is not determinable by such other party.^(m)

Licence pro-
viding for
revocation by
one party only.

In the absence of express provision, if the licence is revocable, whether it be made by deed or otherwise, a deed is not necessary to revoke it.⁽ⁿ⁾ It may be revoked by an expression of intention to revoke; but a mere plea in a defence to an action to recover royalties, to the effect that a licence has been abandoned, is not a notice of determination, and consequently in an action to recover royalties, when an account is obtained, the account, notwithstanding such a plea, goes in respect of user after action brought till the proper determination of the licence.^(o)

Revocation
need not neces-
sarily be by
deed.

Though a licence be one which is revocable at the will of one or of either of the parties, yet, upon the true construction of the agreement, the party or parties having the power of revoking the license may have contracted not to exercise it,^(p)

Party to a
licence may
contract not to
exercise his
power of
revocation.

^(h) *Guyot v. Thomson*, (1894) 11 R. P. C. 553.

⁽ⁱ⁾ *Ward v. Livesey*, (1888) 5 R. P. C. 182.

^(k) *Wood v. Ledbitter*, 9 Jur. 187; *Ridges v. Mullinar*, (1893) 10 R. P. C. 21; *Crossley v. Dixon*, (1863) 10 H. L. C. 293.

^(l) *Guyot v. Thomson*, (1894) 11 R. P. C. 541.

^(m) *Cutlan v. Dawson*, (1897) 14 R. P. C. 249; 13 R. P. C. 716-717; *Guyot v. Thomson*, (1894) 11 R. P. C. 541.

⁽ⁿ⁾ *Ward v. Livesey*, (1888) 5 R. P. C. 102.

^(o) *Cheetham v. Nuttall*, (1893) 10 R. P. C. 321.

Classification of Licences. in which case, in the event of a revocation, an action for damages in respect of the breach of contract would be maintainable.^(p)
 Licences may also be—

- (1) *General.*
- (2) *Limited.*
- (3) *Exclusive.*

General licences.

General licences are those which include the right to use every part of the invention, and apply to the whole of the geographical area for which the patent was granted.

Limited licences.

Limited licences may be limited in the sense that they apply only to a part of the invention; or to the construction or use of a patented article, but not to both; ^(q) or to the use of the invention in a particular manner, ^(r) or in a particular district, ^(s) or for a specified portion of the term for which the patent was granted.

Exclusive licences.

Exclusive licences are those under the terms of which the patentee is prevented from making a like grant to any one other than the licensee during the continuance of the licence.

Not unfrequently patentees grant exclusive licences for the whole or some particular part of the invention, applying to the whole or some particular part of the geographical area over which the patent right extends. It is usual to insert in an exclusive licence a covenant on the part of the patentee to the effect that he will not grant any other licence authorising any other person to use the invention within the district to which the licence applies. It may be questioned whether such a covenant divests the patentee of all power of granting any other licence in breach of his covenant, so far as the validity of such other licence is concerned; but he would be clearly liable in damages if he were to do so.

An irrevocable exclusive licence for the whole term of the patent which reserves no interest to the licensor operates as an assignment.

If an exclusive licence be made irrevocable and applicable to the whole geographical area of the patent right, and reserves no interest in the patent to the licensor, it is a grant, or an agreement for a grant, and amounts to an assignment, or an agreement for an assignment, of the patent; ^(t) and it would

^(p) *Kerrison v. Smith*, (1897) 2 Q. B. 445.

^(q) *Basset v. Graydon*, (1897) 14 R. P. C. 701.

^(r) *Société Anonyme pour la Fabrication d'Appareils d'Eclairage v. Midland Lighting Co.*, (1897) 14 R. P. C. 419; *Incandescent Light Co. v. Cantelo*, (1895) 12 R. P. C. 262.

^(s) *Société Anonyme des Manufactures des Glaces v. Tilghmann's Patent Sand Blast Co.*, (1883) L. R. 25 Ch. D. 11.

^(t) *Guyot v. Thomson*, (1894) 11 R. P. C. 554; *Heap v. Hartley*, (1889) 6 R. P. C. 500.

appear that if the licence is made by deed, since no particular form of words is required to effect an assignment, such an exclusive licensee would be entitled to apply to have his name entered on the register of patents as the owner for the time being.^(u)

Classifica-
tion of
Licences.

An exclusive licence operates as an assignment of the patent in the same way as a demise by a lessee of the premises comprised in his lease for the whole of the term granted amounts to an assignment to the under-lessee.^(x) For an assignment is a transfer or making over to another of the whole right of the assignor in the thing transferred,^(y) and any words which show an intention to do this in a deed are sufficient with respect to a patent-right.^(z)

If, however, the exclusive licence reserves to the patentee any direct interest in the patent—*e.g.*, the right to sue for infringements of the patent—it does not amount to an assignment.^(a) A deed conferring an exclusive licence not amounting to an assignment is not a conveyance within the meaning of the Conveyancing Act, 1881; but the introduction of the words “as beneficial owner” into the deed may tend to show an intention that the licence is not to be revocable.^(b)

Exclusive licence which reserves an interest to licensor is not an assignment.

A patentee who grants an exclusive licence may be restrained by the licensee from working or selling under the patent during the continuance of the licence when there is no reservation to the patentee to so work and sell.^(c)

Grantor of exclusive licence may be restrained from infringing.

The exclusive licensee is entitled to make unimportant departures in details from the specification, and may restrain the patentee, by injunction of the Court, from representing that articles so made and sold by him, the licensee, are not made in accordance with the patent.^(d)

Exclusive licensee's rights to make departures in details from the invention.

Licences may also be—

- (1) *Assignable.*
- (2) *Not assignable.*

A licence may be made to an individual only, or to him, his executors, administrators, and assigns, and the question whether or not a licence is assignable depends in each case upon the words by which it was granted.

Whether a licence is assignable or not depends on its terms.

In *Bown v. Humber* (e) it appeared that the plaintiff, the

(u) See p. 337 *ante*; *Heap v. Hartley*, (1889) 6 R. P. C. 495, 500.

(x) *Palmer v. Edwards*, (1779) 1 Doug. 187 n; *Parmenter v. Webber*, (1818) 8 Taunt. 593; 2 B. Mo. 656; *Shep. Touch.* 266.

(y) 2 Bl. Com.

(z) p. 347 *ante*.

(a) *Guyot v. Thomson*, (1894) 11 R. P. C. 554.

(b) *Ibid.*

(c) *Ibid.* p. 541.

(d) *Ibid.*

(e) (1889) 6 R. P. C. 9.

Classifica-
tion of
Licences.

owner of a patent for improvements in the bearings of bicycles in the year 1885, granted to a firm of bicycle manufacturers a licence to use the invention within the United Kingdom, the Channel Islands, and the Isle of Man, for the purpose of applying the invention to the wheels of bicycles, &c., manufactured for sale or use or otherwise by the licensees, or by persons employed by them, but not in any other manner, with a proviso that the licence should not be construed to permit the licensees to make or sell the patent bearings to be applied to the wheels of bicycles, &c., manufactured by any other person or company other than the licensees, or by persons employed by them; and that the licence should not authorise the use of the said invention by the licensees individually or separately, but only by the licensees jointly, or such two or one of them as should continue to carry on the business hitherto carried on by the three licensees at Beeston, or the person or persons or company from time to time carrying on such business. In 1887 the defendants were registered as a limited company to acquire and carry on the business of the licensees and various other businesses at other places. The defendants claimed under the licence the right to manufacture the patent bearings at all places where they carried on business, and also to apply the patent bearings to all bicycles, &c., manufactured by them, whether manufactured by them at Beeston or elsewhere. The plaintiff contended that the licence only authorised the defendants to manufacture the patent bearings at Beeston, in connection with the business of the original licensees; and, secondly, only to apply the patent bearings to all bicycles, &c., manufactured by them at Beeston in connection with the said business; and the plaintiff brought the action and moved for an injunction to restrain the defendants from using the patent otherwise than according to the plaintiff's construction of the licence, but the Court held that the defendants, as carrying on the original business of the licensees at Beeston, were entitled to start other businesses elsewhere, and to apply the patent bearings to any bicycles, &c., manufactured by them in such other businesses, and dismissed the action with costs.

Patentee is
estopped from
disputing
assignability if
he accepts
royalties from
an assignee.

When a patentee has accepted royalties from an assignee of the licensee he is estopped from contending that the licence was not assignable. (*f*)

(*f*) *Lawson v. Donald Macpherson and Co.*, (1897) 14 R. P. C. 696.

RIGHT OF THE CROWN TO USE INVENTIONS.

The Crown has the right to use the inventions comprised in all letters patent granted before the commencement of the Act of 1883, *i.e.*, January 1, 1884, or on any application then pending. And the Crown has the power to use any such invention without the assent of, or compensation to, the patentee.^(g) The Crown enjoys this right, not because it is exempted from the effect of the letters patent, but because the privilege thereby granted is granted against the subjects only, and not against the Crown.^(h)

Right of Crown to free use of inventions patented prior to 1884.

With regard to all patents granted on applications dated after January 1, 1884, it is provided by the Act of 1883⁽ⁱ⁾ that they shall have to all intents the like effect as against her Majesty the Queen, her heirs and successors, as they have against a subject. But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested.

Crown only entitled to use inventions patented after January 1, 1884, on terms.

Contractors who supply the Government with manufactured articles are not servants of the Crown, and if such articles are manufactured according to a patented invention, without the licence of the patentee, the manufacturers are liable to be sued by the patentee for infringement.^(k)

Government contractors.

It is submitted that the patentee's remedy, in case he wishes to question the authority of the Crown to use the patented invention, is by petition of right, and not by action against the officer of the Crown using the invention. With regard to patents granted prior to the Act of 1883, the reverse was the case.^(l) But, since the patent now has the like effect against the Crown as against a subject, and the officers or authorities administering any department of the service of the Crown are

Procedure to question Crown's authority to use a patented invention.

^(g) Feather *v.* The Queen, (1865) 6 B. & S. 257; Dixon *v.* The London Small Arms Co. Ltd., (1875) L. R. 1 App. Cas. 632.

^(h) Per Lord Selborne, Dixon *v.* The London Small Arms Co., Limited. (1875) L. R. 1 App. Cas. 659.

⁽ⁱ⁾ 46 & 47 Vict. c. 57, ss. 27 and 45 (2).

^(k) Dixon *v.* The London Small Arms Co., Ltd., (1875) L. R. 1 App. Cas. 632.

^(l) Feather *v.* The Queen, (1865) 6 B. & S. 257; Walker *v.* Congreve, (1816) 1 Coop. P. C. 356.

Consideration. Covenants. — authorised to use the invention upon terms the settlement of which is not a condition precedent, it would, it is submitted, appear that the proper procedure now is by petition of right.^(m)

CONSIDERATION.

No restriction as to consideration for a licence to use a patented invention.

There is no restriction as to the consideration in respect of which a licence may be granted. When a licence is granted by deed, it is, of course, not necessary that there should be any consideration at all.

The patentee generally grants licences in return for some consideration, which is usually a money payment, either of a fixed amount, or a sum varying according to the extent to which the licensee uses the invention, or of a fixed royalty in respect of every single article manufactured by the licensee according to the invention, or a royalty on profits.

COVENANTS.

Usual covenants.

It is usual to insert in a licence which is granted in consideration of a periodical or other payment, a covenant on the part of the licensor that the patent is valid so far as his acts or omissions are concerned, and that he has power to grant the licence, and on the part of the licensee a covenant for payment of the various sums as they become due. And if the sums reserved vary with the extent of the licensee's user of the invention, it is usual for him to covenant to render accounts to the patentee, and to permit periodical inspections of premises and machinery.⁽ⁿ⁾

It is usual also to insert conditions avoiding the licence altogether if the licensee fail to pay any of the sums and royalties reserved by the licence, or to perform any of his covenants.^(o)

In the interests of a patentee it is absolutely necessary that a licence which is made in consideration of periodical payments should contain covenants on the part of the licensee for payment of the sums reserved, and a proviso terminating the licence if default is made; otherwise a defaulting licensee might assign the licence (if assignable),^(p) and so escape all liability in respect of it.

^(m) Feather v. The Queen, (1865) 6 B. & S. 257; Walker v. Congreve, (1816) 1 Coop. P. C. 356.

⁽ⁿ⁾ p. 777 *post*.
^(o) p. 777 *post*.
^(p) p. 375 *ante*.

It is not unusual for the patentee to covenant that if he grants licences to others upon more favourable terms the licensee shall have the benefit of such terms.^(q) Estoppel.

To meet the requirements of particular cases many other covenants and conditions may be requisite and need careful consideration as occasion arises.

A licensor is not entitled to interfere with the trade of his licensee pending disputes as to collateral matters; ^(r) but the owner of both English and foreign patents, who has granted a licence to work under one or all of the foreign patents, but not under the English patent, will not be restrained from issuing circulars, warning the public that the sale in England of articles made abroad according to the patented invention is an infringement of the English patent.^(s) A licence to use a patented invention under a foreign patent stands in a very different position to the sale of an article manufactured under either a foreign or an English patent.

Difference between licence to work under a foreign patent and the unconditional sale of an article made under a foreign or British patent.

ESTOPPEL.

A licensee, who has covenanted with the patentee to pay a royalty for the right to use a patented invention, is, by recitals or covenants implying the validity of the patent, estopped, during the continuance of the licence, from denying that validity as against the licensor in any legal proceedings to which they are both parties; ^(t) and he is so estopped independent of estoppel by deed,^(u) and even when he has used the invention under a mere verbal agreement.^(x) Estoppel in virtue of recitals or covenants implying validity.

The licensee is entitled to dispute the existence of the licence. Thus where it is made coterminous with the existence of the No estoppel against denial of the existence or ambit of a licence.

^(q) In *Cheetham v. Nuttall*, (1893) 10 R. P. C. 321, the licensee was unsuccessful on the facts in establishing his claim to a revision of terms.

^(r) *Clark v. Adie*, (1873) 21 W. R. 456, 764.

^(s) *Société Anonyme des Manufactures de Glaces v. Tilghman's Patent Sand Blast Co.*, (1883) L. R. 25 Ch. D. 1; *Betts v. Willmott*, (1870) L. R. 6 Ch. 239.

^(t) *Baird v. Neilson*, (1842) 8 Cl. & Fin. 726; *Cutler v. Bower*, (1848) 11 Q. B. 973; 17 L. J. Q. B. 217; *Hills v. Laming*, (1853) 9 Exch. 256; 23 L. J. Ex. 60; *Bowman v. Taylor*, (1834) 2 A. & E. 278; 1 W. P. C. 292; *Lawes v. Purser*, (1856) 6 E. & B. 930; 26 L. J. Q. B. 25; *Norton v. Brooks*, (1861) 7 H. & N. 499; *Smith v. Scott*, (1859)

28 L. J. C. P. 325; 6 C. B. N. S. 771; *Bessmans v. Wright*, (1858) 6 W. R. 719; *Crossley v. Dixon*, (1863) 10 H. L. 293; 32 L. J. Ch. 617; *Hall v. Conder*, (1857) 2 C. B. N. S. 22, 53; 26 L. J. C. P. 138, 288; *Trotman v. Wood*, (1864) 16 C. B. N. S. 479; *Clark v. Adie*, (1877) L. R. 2 App. Cas. 423; *Liardet v. Electric Lighting Co.*, (1883) W. N. 96; *Ashworth v. Law*, (1890) 7 R. P. C. 231; *Wilson v. Union Oil Mills*, (1892) 9 R. P. C. 63; but see p. 381 *post*.

^(u) *Lawes v. Purser*, (1856) 6 E. & B. 930; *Norton v. Brooks*, (1861), 7 H. & N. 499.

^(x) *Crossley v. Dixon*, (1863) 10 H. L. C. 293, 308, 310; *Clark v. Adie*, (1873) L. R. 2 App. Cas. 423.

Estoppel. patent the licensee is not estopped in an action for royalties from contending that the patent has in fact expired, *e.g.*, on the ground that its life depended on that of a foreign patent which has lapsed.^(y)

Estoppel terminates with the licence.

After the termination of the licence, the licensee may dispute the validity of the patent,^(z) but he cannot sell articles as manufactured under licence from the patentee.^(a)

Licence to construct only may operate as an estoppel against a third party, with notice, using a patented article.

When the licence is limited to the construction as opposed to the use of a patented article when constructed, a question may arise as to the right of a third party for whom the article was constructed under the licence to deny the validity of the patent as against the patentee. It may well be that if the third party knew the nature of the licence when he gave the order for the construction an estoppel by conduct arises, and such third party is at the mercy of the patentee as to the terms upon which he may be permitted to use the article. There does not appear to be any authority against the existence of such a state of things.^(b)

Licensee though estopped from denying validity may dispute ambit of patentee's claim.

Though the licensee during the continuance of the licence is estopped from denying the validity of the patent as against the licensor in an action for the recovery of royalties, he is entitled to dispute the ambit of the patentee's claim.^(c) Thus he may dispute the construction put upon the specification by the licensor, and contend that the acts done by him in respect of which it is sought to make him liable in royalties are not covered by the patent upon the true construction of the specification, *i.e.*, they would not be held to be infringements in an action brought for infringement.^(d) And, for the purpose of showing the true ambit of the claim, he may refer to anything which shows the state of public knowledge at the date of the patent.^(e)

A licensee under a patent is in a situation analogous to a tenant who, during the tenancy, cannot dispute the title of the lessee to any of the land held under the lease; but who is nevertheless at liberty to show that part of the land he actually

^(y) *Muirhead v. Commercial Cable Co.*, (1894) 11 R. P. C. 317; 12 R. P. C. 39, 370.

^(z) p. 381 *post*.

^(a) *Postcard Automatic Supply Co. v. Samuel*, (1889) 6 R. P. C. 560.

^(b) *Basset v. Graydon*, (1897) 14 R. P. C. 711.

^(c) *Crossley v. Dixon*, (1863) 10 H. L. C. 293; *Adie v. Clark*, (1876) L. R. 2 App. Cas. 423; *Cropper v.*

Smith, (1884) L. R. 26 Ch. D. 700; *Couchman v. Greener*, (1884) 1 R. P. C. 197; *The Useful Patents Co. v. Rylands*, (1885) 2 R. P. C. 253; *Siemens v. Taylor*, (1892) 393.

^(d) *Young v. Hennand Oil Co.*, (1891) 8 R. P. C. 285; 9 R. P. C. 373; *Ashworth v. Roberts*, (1892) 9 R. P. C. 89, 309.

^(e) *Young v. Hennand Oil Co.* (1892) 9 R. P. C. 373.

occupies is really not comprised within the lease, but belongs to himself under some other right. *(f)* **Estoppel.**

If the licensee, as is commonly done, is sued for infringements as well as royalties, it is open to him to plead the determination of the licence, if, in fact, he has determined it; and then he can also dispute the validity of the patent. *(g)* It is thus open to a licensee, by a revocation of the licence where such is possible, to turn himself from a licensee into a trespasser and wrongdoer if the patent is valid, but a lawful user if the patent is void.

Determination of licence may be pleaded in action to recover royalties.

A licensee (not a party to the action) cannot be compelled to give inspection in an action against the licensor, but if the licensor can arrange for an inspection it is proper he should do so; and if it appear that the licensor is himself or by his licensee working the process in dispute the usual order for inspection will be made. *(h)*

Inspection against licensee not a party to an action against his licensor.

A licensee is a competent witness for the plaintiff in an action for the infringement of a patent under which he has a licence. He has no direct pecuniary interest in supporting the patent, and it may be for his advantage that it should not be supported. *(i)*

Licensee is a competent witness in an action brought by the patentee.

Where a person has agreed, not under seal, with the patentee to pay a certain sum of money, annually or otherwise, for the use of a patented invention, but has not actually used the invention, he is not estopped from denying the validity of the patent in an action brought against him by the patentee for recovery of royalties. *(k)*

No estoppel against a person who has made an agreement, not under seal, for a licence, but has not used the invention.

An equitable assignee of an exclusive licensee also is not estopped, in an action brought against him by the patentee for infringement, from disputing the validity of the patent. *(l)*

No estoppel against an equitable assignee of an exclusive licence.

If it is the intention of the parties that it is to be open to the licensee to dispute the validity of the patent, then the licence ought to be specially framed to allow of this by the insertion of covenants on the part of the licensor for title to grant the licence, and that the patent is valid.

Right to dispute validity may be specially provided for.

If there are no express covenants on the part of the licensor as to his power to grant the licence, and as to the validity of the

(f) Per Lord Blackburn, (1873) Clark v. Adie, L. R. 2 App. Cas. 435.

(g) Redges v. Mullinar, (1892) 10 R. P. C. 21; Crossley v. Dixon, (1863) 10 H. L. C. 293.

(h) Germ Milling Co. v. Robinson, (1886) 3 R. P. C. 11, 14.

(i) Per Lord Abinger, C. B., Derosne

v. Fairie, (1835) 2 Cr. M. & R. 476; 1 W. P. C. 154.

(k) Chanter v. Leese, (1838) 1 W. P. C. 295; 8 L. J. Ex. 58; 9 L. J. Ex. 327; 4 M. & W. 295; 5 M. & W. 698.

(l) Pidding v. Franks, (1849) 1 Mac. & G. 56; 18 L. J. Ch. 295.

Estoppel. patent, the law will not import any, since the privilege created by letters patent is impressed with the nature of personality, and the law will not create a covenant respecting a personal thing.^(m)

In *Hayne v. Maltby* ⁽ⁿ⁾ the action was brought for the breach of an agreement which recited that the plaintiffs were assignees of a patent granted to *T. Taylor*, and that the defendant had applied to the plaintiffs for permission to use the patented invention, to which they assented, on condition of his working it in the manner described in the specification. The agreement contained a covenant by the plaintiffs with the defendant that he should have the free use and quiet enjoyment of the patent machine, in case the same should be worked only in the manner described in the specification, and also a covenant by the defendant that he would not, during the residue of the term, use any of the patent machines except the one by the articles allowed to be used by him. Under these circumstances, the Court of King's Bench held that the defendant was not estopped from denying the validity of the patent, and gave judgment for him on the ground that the patent was void. It is to be noticed that the agreement merely recited that the plaintiffs were assignees of the patent, not that the patent was valid.^(o)

After the termination of the licence, the licensee is in just the same position as the rest of the Queen's subjects, with regard to being able to deny the validity of the patent, if the patentee brings any action against him for infringement.^(p)

In *Goucher v. Clayton* ^(q) it appeared that the plaintiff took proceedings in 1854 against a certain firm of *Clayton & Co.* for infringement of his patent. The firm submitted to a judgment in the action, and took a licence for five years (afterwards extended to seven) to work under the patent. The present suit was instituted in 1864 against the same firm, but two new partners had entered the firm after the judgment at law. The defendants raised the issues of want of novelty and sufficiency of the specification. *Wood*, V.C., overruled the objection that the defendants were estopped from denying the validity of the patent, both as having been licensees and by

^(m) Com. Dig. tit. Covenant A. 4.

⁽ⁿ⁾ (1789) 3 T. R. 438; 1 W. P. C. 291.

^(o) See *Bowman v. Taylor*, (1834) 2 A. & E. 278; 1 W. P. C. 293; and remarks of Lord Cottenham, L.C., in *Neilson v. Fothergill*, (1841) 1 W. P. C. 290.

^(p) *Axmann v. Lund*, (1874) L. R. 18 Eq. 330; 43 L. J. Ch. 655; *Goucher v. Clayton*, (1865) 11 Jur. N. S. 107; 34 L. J. Ch. 239; *Dangerfield v. Jones*, (1865) 13 L. T. N. S. 142; *Neilson v. Fothergill*, (1841) 1 W. P. C. 290.

^(q) (1865) 11 Jur. N. S. 107; 34 L. J. Ch. 239.

reason of the judgment at law, and stated that in any case he could not prevent those defendants who were not parties to the action at law from setting up that defence. Registration.

It is not competent to the defendant to an action for infringement to set up alternative pleas to the effect that the acts complained of as infringements were either done under licence of the patentee, or the patent is itself invalid. He must adopt one line of defence or the other. Thus, where, in an action for infringement, the defendant, who was the mortgagee of certain articles manufactured under a licence which the plaintiff alleged was revoked, disputed the fact of revocation, and contended that the patent was invalid, the Court held that he must elect which line of defence he would adopt.^(r) In action of infringement alternative pleas of no infringement in fact or acts done under licence are not allowable.

REGISTRATION.

A notification of every licence to work under a patent must be entered in the Register of Patents, and an attested copy of every licence granted under a patent must be left at the Patent Office by the licensee, with a request that a notification thereof may be entered in the register. The licensee must cause the accuracy of such copy to be certified as the Comptroller may direct, and the original licence must at the same time be produced and left at the Patent Office, if required, for further verification.^(s) All licences should be registered.

The subject of the registration of licences has already been fully discussed in the chapter dealing with the proceedings at the Patent Office for obtaining a grant of letters patent.^(t)

RECOVERY OF ROYALTIES.

The licensor has a right of action on the contract to sue for the recovery of royalties in arrear, and if successful he may obtain an account of profits against the licensee. Royalties may be recovered by action,

An account of profits, however, will not be granted against a licensee at the instance of the licensor or his assignee if there is proof that no profits have arisen, and not in any case unless all parties interested are before the Court.^(u)

^(r) Postcard Automatic Supply Co. v. Samuel, (1889) 6 R. P. C. 560.

^(t) pp. 336-340 *ante*.

^(s) 46 & 47 Vict. c. 57, s. 23; P. R. (1890) r. 77.

^(u) Bergman v. Macmillan, (1881) L. R. 17 Ch. D. 423.

**Recovery
of
Royalties.**

even though
the patent has
been declared
void.

Though previously to the commencement of an action for the recovery of royalties due under a licence the patent has been declared void in other proceedings, the defendant, if he be the licensee of the plaintiff, under a licence containing no covenant on the part of the licensor as to his title to grant the licence and as to the validity of the patent, cannot plead that the patent is bad.(x)

A licensee also who has covenanted to pay royalties for a term certain is bound to pay such royalties, though the patent is in the meantime declared void and cancelled,(y) and he cannot, in the absence of fraud, recover royalties which he has paid under a licence, though, after the termination of the licence, it should turn out that the patent is bad.(z)

So where a licensee under several patents covenanted to pay royalties in respect of anything manufactured under any of the patents until the effluxion of all the terms of years respectively granted by the said letters patent, he was held liable to pay royalties for the use of any of the inventions so long as any of the patents were subsisting.(a) Thus, in consequence of his covenant, a licensee may be compelled to pay for the use of an invention the subject of a lapsed or cancelled patent, whilst the rest of the public are entitled to use it free.

Fraud is a
defence to an
action to re-
cover royalties.

Fraud is a defence to an action for the recovery of royalties, and it is also a ground on which a licensee, who has paid royalties under a licence tainted therewith, can recover the moneys he has disbursed.(b)

Royalties paid
after breach
of covenant
by licensor.

Royalties paid by the licensee after, and without knowledge of, a breach of covenant by the licensor may be recovered. Thus, when the licensee agreed to pay royalties for a term certain, and the patentee covenanted to protect and defend the patent from infringement, and the patent lapsed through non-payment of renewal fees by the patentee, the licensee was held entitled to recover back the royalties he had paid after, and without knowledge of, the lapse. The reason for the decision was that the neglect of the patentee to pay the renewal fees was a breach of his covenant to protect and defend the patent

(x) *Grover and Baker Sewing Machine Co. v. Millard*, (1862) 8 Jur. N. S. 713.

(y) *African Gold Recovery Co. v. Sheba Gold Mining Co.*, (1897) 14 R. P. C. 660.

(z) *Taylor v. Hase*, (1805) 1 B. & P. N. R. 260; 1 W. P. C. 292; *Collinge v. Bowman*, (1834) 1 W. P. C. 295.

(a) *Siemens v. Taylor*, (1892) 9 R. P. C. 393.

(b) *Cutler v. Bower*, (1848) 11 Q. B. 973; 17 L. J. Q. B. 217; *Hall v. Conder*, (1857) 2 C. B. N. S. 22; 26 L. J. C. P. 138; *Lawes v. Purser*, (1850) 6 E. & B. 930; 26 L. J. Q. B. 25; *Smith v. Scott*, (1859) 28 L. J. C. P. 325; 6 C. B. N. S. 771.

against infringers, which implied a covenant to keep the patent in such a position that he should be able to do so.(c)

Recovery
of
Royalties.

Important questions as to the liabilities of licensees to pay royalties after breach of covenant by the patentee, *e.g.*, involving lapse of the patent, depend sometimes in particular cases upon whether or not the patentee's covenant for quiet enjoyment and the licensee's covenant to pay royalties are conditional and co-extensive or not. In the one case royalties may be claimed by the patentee notwithstanding his breach and the lapse of the patent; in the other case they cannot be so claimed. Moreover it must be remembered that an express condition for cesser of the payments will negative any implied condition for cesser.(d)

The action for recovery of royalties is frequently brought for the recovery of the royalties or, in the alternative, for an injunction and the usual relief to restrain infringement.(e) In such an action where it appeared that the plaintiff was the owner of three patents, under two of which the defendant was a licensee in arrear, and did not appear on the hearing of a motion for an interlocutory injunction, the Court granted an injunction restraining infringement, but specially worded the order so as not to restrain the defendant from working under the licence.(f)

Action may be brought for recovery of royalties or in the alternative for relief in respect of infringement.

On the taking of an account of royalties due for the use of an invention the Court may, under the circumstances of the case, only be able to estimate the real sum due; and, under such circumstances, the Court of Appeal will not lightly put aside the finding of the officer of the Court, who comes to a conclusion upon an estimate.(g)

Court may only be able to estimate royalties due.

Whether or not a patentee can in a particular case recover interest on unpaid royalties depends on the question of fact, whether, upon the true construction of the licence, the overdue royalty is a sum certain payable at a fixed time by virtue of the instrument itself.(h)

Recovery of interest on unpaid royalties.

The taxing master has a discretion as to proceeding with the taxation when an appeal is pending and shortly coming on for

Taxation pending an appeal.

(c) *Lines v. Usher*, (1896) 13 R. P. C. 685; 14 R. P. C. 206.

(d) *Mills v. Carson*, (1892) 10 R. P. C. 9.

(e) *Wilson v. Union Oil Mills Co.*, (1892) 9 R. P. C. 57.

(f) *Pneumatic Tyre Co. v. Ferguson*, (1894) 11 R. P. C. 459.

(g) *Alma Vencer Felt Co. v. Fisher*, (1897) 14 R. P. C. 159.

(h) *Muirhead v. Commercial Cable Co.*, (1894) 11 R. P. C. 346; *Redges v. Mullinar*, (1893) 10 R. P. C. 25; *London, Chatham and Dover Ry. Co. v. South Eastern Ry. Co.*, (1893) L. R. App. Cas. 429; *Merchant Shipping Co. v. Armitage*, (1873) L. R. 9 Q. B. 99.

Licensor
and
Licensee
Plaintiff
in Action
for
Infringe-
ment.

hearing. Thus, when the taxing master on being informed at the taxation that an appeal was pending and might possibly be decided in three days time, in the exercise of his discretion, refused to proceed with the taxation pending the result of the appeal, the defendant took out a summons asking that the taxing master might be ordered to proceed with the taxation. The Court of Appeal decided that an order in the action refusing stay of execution was not so peremptory but that the taxing master had a discretion, which he had wisely exercised, and refused to grant the order asked for.⁽ⁱ⁾

When an action for the recovery of royalties is one of especial difficulty and importance, costs may be given on the higher scale.^(k)

LICENSOR'S AND LICENSEE'S POWERS TO SUE IN RESPECT OF INFRINGEMENT.

Action for in-
fringements
at the instance
of licensors
and licensees
respectively.

It is clear that a mere licensee having a simple licence to work under a patent cannot sue alone in respect of infringements of the patent, but he must join the patentee; since the patentee may grant a licence to any other person, the defendant in the action might possibly be a licensee also, and the infringement is an injury to the patentee and not to the mere licensee.^(l)

It consequently follows that a patentee, who has merely granted simple licences, is entitled to sue alone in respect of any infringements without joining his licensees; for, since he may grant licences to whom he pleases, the injury affects him alone, and it would appear that a patentee, who has granted an exclusive licence, which does not amount to an actual assignment of the patent (*e.g.*, one which contains a power of revocation in the event of breach of covenant), may sue to restrain infringements without bringing the exclusive licensee before the Court; for the injury done to the patentee is distinct from that suffered by the exclusive licensee. The infringement affects the exclusive licensee by injuring his trade; it affects the patentee both by loss of reputation of the patent through infringements being permitted, and by loss of royalties, if royalties are paid for the licence.

An exclusive licensee, whether the licence is for a limited

⁽ⁱ⁾ *Muirhead v. Commercial Cable Co.*, (1895) 12 R. P. C. 258.

^(k) *Ibid.* (1894) 12 R. P. C. 39.

^(l) *Newby v. Harrison*, cited in

Rennard v. Levinstein, 2 H. & M. 628;

Derosne v. Fairie, (1835) 1 W. P. C.

155; *Heap v. Hartley*, (1888) 5 R. P. C.

603; 6 R. P. C. 495.

area or not, is not entitled to sue alone in respect of infringements, if the licence is not coupled with, or equivalent to an assignment, but the patentee must join as plaintiff (*m*) or be added as a defendant.

In the case of exclusive licences it is usual to insert a covenant on the part of the patentee binding him to proceed against all persons who may infringe the patent, or to allow the licensee to do so in his name. (*n*)

The decision of Lord *Hatherley*, then Vice-Chancellor *Wood*, in *Renard v. Levinstein*, (*o*) appears to be an authority for the statement that an exclusive licensee is entitled to sue alone to restrain infringements within the area of the exclusive licence. It must, however, be noticed that in that case the owners of the patent were joined as defendants, and there does not appear to be any decided case in which the licensee has been allowed to sue without the patentee being a party. (*p*)

(*m*) *Heap v. Hartley*, (1888) 5 R. P. C. 603; 6 R. P. C. 495. See R. S. C. or 162.

(*n*) See Form in Appendix.
(*o*) 2 H. & M. 628.

(*p*) *Plimpton v. Malcolmson*, (1875) L. R. 3 Ch. D. 531; *Barnett v. Barrett's Screw Stopper Bottling Co.*, (1884) 1 R. P. C. 9; *Heap v. Hartley*, (1888) 5 R. P. C. 603.

Licensor
and
Licensee
Plaintiff
in Action
for
Infringe-
ment.
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CHAPTER X.

REVOCATION OF LETTERS PATENT.

THE PETITION

Effect of grant
of letters
patent.

LETTERS PATENT for inventions are obtained on the faith of representations made by the patentee, and where there is no opposition (*a*) they are rarely refused.

The Crown makes the grant at the patentee's peril, and does not guarantee its validity, if the representations contained in the applicant's declarations are not true, or if all the requirements of the law are not satisfied. (*b*)

The grant of a patent for an invention operates as a curtailment of the rights of the public, for it prohibits all her Majesty's subjects, other than the patentee and his licensees, from using the invention, even if they should discover it independently for themselves. (*c*) As we have seen, the justification for making the grant is the consideration that the patentee is the first to give the public a knowledge of the invention and the means of making practical use of it. (*d*)

It is evident that, if a grant of letters patent for an invention be made, which is in fact void owing to the grantee not being the true and first inventor, or on account of the alleged invention not being proper subject-matter, or in consequence of some defect as regards novelty, utility, proper specification, or any other ground which vitiates a patent, so long as the grant remains unrevoked the public suffers an injury, and the patentee is in the enjoyment of a monopoly to which he is not entitled.

Validity may
be questioned
by defendant
in an action for
infringement.

We shall see hereafter that in the event of a patentee bringing an action against any member of the public in respect of any act alleged to be an infringement of his rights under the grant, it is competent to the defendant to put in issue the validity of the patent on any one or more of the grounds which

(*a*) pp. 289, 311 *ante*.
(*b*) p. 289 *ante*.

(*c*) p. 92 *ante*.
(*d*) p. 92 *ante*.

in law render it void, so as to obtain the declaration of the Court on the point, which, if found in the defendant's favour, is a complete answer to the action.(e)

The
Petition.

It is sometimes to the interest of a particular member of the public to obtain a revocation of a void patent, quite independently of any proceedings against him in respect of infringement. For instance, where an individual is using an invention, in respect of which another person claims to have a patent, which the unlicensed user believes to be invalid; or where a person is desirous of using an invention included in a patent which he has good reason to believe is defective. The law has long provided a means to enable an aggrieved member of the public to obtain the repeal of a void patent. Formerly the procedure was by *scire facias*; but now it consists in the presentation of a petition to the Court, under s. 26 of the Act of 1883,(f) for the revocation of the patent.

A member of the public may have an interest in obtaining a revocation.

Under the old practice, if two persons had obtained patents for the same invention the Courts would not interfere between them, but left them to determine their rights by *scire facias*,(g) for which proceeding the presentation of a petition for revocation has been substituted by the Act of 1883.(h)

Petition for revocation substituted for the old procedure by *scire facias*.

The presentation of a petition for revocation of a patent, as did the prosecution of a *scire facias*, entails expense on the part of the person presenting it, and in order that the public may not be put to the trouble or cost of resisting an unlawful patent, the Crown imposes a condition on the grantee of every letters patent for an invention. This condition is a proviso in the letters patent to the effect that, if at any time during the term for which the patent is granted it be made to appear to the Queen, her heirs, or successors, or any six or more of her Privy Council, that the grant is contrary to law, or prejudicial, or inconvenient to her Majesty's subjects in general, or that the invention is not a new invention as to the public use and exercise thereof, within the United Kingdom of Great Britain and Ireland, and the Isle of Man, or that the patentee is not the first and true inventor thereof within the realm, the letters patent shall forthwith determine and be void to all intents and purposes.(i)

Conditions of letters patent.

There is no instance in modern times of the determination

(e) p. 517 post. (f) p. 648 post. (h) s. 26.
(g) Copeland v. Webb, (1862) 11 W. R. 134; 1 N. R. 119; Baskett v. Cunningham, (1762) 2 Eden, 137. (i) 46 & 47 Vict. c. 57, 1st Schedule, Form D.

**The
Petition.**

of a patent under this proviso, but it is probable that it was under some such proviso that Queen Elizabeth was enabled to recall patents for monopolies, which were found to be so grievous to the public during her reign.^(k)

A valid patent might probably be cancelled under the above proviso, if the conduct of the patentee rendered the grant prejudicial or inconvenient to the public—*e.g.*, if the patentee refused to sell the patented article or to grant licences upon reasonable terms.^(l)

Revocation in part of the United Kingdom is applicable to the whole.

The Act of 1883 defines the term "patent" as meaning letters patent for an invention ^(m) which have effect throughout the United Kingdom and the Isle of Man,⁽ⁿ⁾ and therefore, if revocation be obtained in any portion of the United Kingdom or the Isle of Man, it is applicable to the whole area for which the patent was originally granted.

Revocation may be obtained in England, Scotland, or Ireland.

The words of s. 26 of the Act of 1883,^(o) which establish the proceeding by petition are: "Revocation of a patent may be obtained on petition to the Court," and it is submitted that in view of the evident contemplation by the Act of proceedings in England, Scotland, and Ireland,^(p) the "Court" must be taken to mean in England her Majesty's High Court of Justice in England; ^(q) in Scotland, any Lord Ordinary of the Court of Session; ^(r) and in Ireland, the High Court of Justice in Ireland.^(s)

Power of the Court of the County Palatine of Lancaster to revoke a patent on petition.

Before the Chancery of Lancaster Act 1890, it was held that the Court of the County Palatine of Lancaster, not being a "Court" within the Act of 1883, was not competent to entertain a petition for revocation, but it would appear that it has jurisdiction to do so now.^(t)

Action of reduction in Scotland.

In Scotland, proceedings for revocation of a patent are in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest, with his concurrence, which concurrence may be given on just cause shown only; and service of all writs and summonses in the action must be made according to the forms and practice existing at the commencement of the Act of 1883.^(u)

(k) See Hindmarch on Patents, p. 432. See also Remb. 98, 223.

(l) *Universities of Oxford and Cambridge v. Richardson d'Ewes*, (1802) 652; 6 Ves. 712; judgment of Lord Eldon, L.C., *Matthey's Patent, Darcy v. Allin*, (1602) Noy. R. 183.

(m) s. 46.

(n) s. 16.

(o) p. 648 *post*.

(p) See s. 26 (4) (a) (b).

(q) 46 & 47 Vict. c. 57, s. 117.

(r) *Ibid.* s. 111.

(s) *Ibid.*

(t) 53 & 54 Vict. c. 23, s. 3; *Proctor v. Sutton Lodge Chemical Co.*, (1888) 5 R. P. C. 184.

(u) 46 & 47 Vict. c. 57, s. 109.

In Ireland, all parties have their remedies under or in respect of a patent as if it had been granted to extend to Ireland only.^(x)

**The
Petitioner.**

Revocation in
Ireland.

Improvements
in munitions
of war.

No proceeding by petition or otherwise lies for revocation of a patent relating to any improvement in instruments, or munitions of war, which has been assigned to her Majesty's Principal Secretary of State for the War Department, and in respect of which such Secretary of State has, before the application for a patent, or before the publication of the specification or specifications, certified to the Comptroller his opinion that, in the interests of the public service the particulars of the invention and of the manner in which it is to be performed should be kept secret.^(y)

THE PETITIONER.

It is to be noticed that s. 26 sub-s. 4 of the Act of 1883 authorises various persons to present a petition for the revocation of a patent; but, whereas by s. 109 the proceeding for revocation in Scotland is further limited, the only persons entitled to initiate proceedings for the revocation of a patent in Scotland are the Lord Advocate and persons having an interest, with his concurrence.

Persons who
are entitled to
take proceed-
ings for revo-
cation.

The Act of 1883^(z) authorises the following persons to present a petition for the revocation of a patent:—

- (1) The Attorney-General in England or Ireland, or the Lord Advocate in Scotland.
- (2) Any person authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland.
- (3) 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.
- (4) 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.
- (5) 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.

^(x) 46 & 47 Vict. c. 57, s. 110.

^(y) *Ibid.* s. 44 (9) (1) (3).

^(z) s. 26, sub-s. 4; p. 648 *post.*

The
Petitioner.

With regard to (3) the power of presenting a petition for the revocation conferred on "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" (a) relates only to cases of fraud, and will not be extended to cases of mistake, notwithstanding that the consequences of the mistake may be to deprive the inventor of his patent-rights. (b) Thus, where a subject of the United States of America, and resident there, gave a power of attorney to an English patent agent, with instructions to obtain a patent in this country, and the agent employed a sub-agent, who took out a patent in his own name for the invention, together with some improvements of his own, without stating in the specification that it, or any part of it, was a communication from abroad, and made a statutory declaration that he was the first and true inventor, the Court of Appeal held that, even if the patent was void by reason of the non-disclosure in the specification of the communication from abroad, as there was no proof of any intention on the part of the patentee to deprive the inventor of his rights, the petition could not be sustained on the ground of fraud, and it was dismissed, without prejudice to any petition which the inventor might be advised to present as a person claiming to be the first and true inventor. (c)

If the petitioner is qualified under (3), (4), or (5), he presents his petition as of right; any other person must obtain the fiat of the Attorney-General in England or Ireland, or the Lord Advocate in Scotland, authorising the presentation.

When once the petitioner has a *locus standi* to present the petition he can impeach the patent on any lawful ground he chooses. Consequently, if he is qualified to present the petition without the fiat on any one ground, he does not need the fiat if he wishes to add other grounds. (d)

Fiat of the
Attorney-
General where
necessary.

If there is any doubt as to whether a would-be petitioner is qualified as of right, he should take the precaution to arm himself with the fiat of the Attorney-General or the Lord Advocate, as the case requires, for the Court will at the hearing refuse to go into the question whether the patent is good or bad, if it appear that the petitioner has no *locus standi*. (e) But any person who presents a petition under any one of the above

(a) p. 391 ante.

(b) *In re Avery's Patent*, (1887) L. R. 36 Ch. D. 307; 4 R. P. C. 152, 322.

(c) *Ibid.*

(d) *Morgan's Patent*, (1887) 5 R. P. C. 186.

(e) *In re Avery's Patent*, (1887) L. R. 36 Ch. D. 307, 322; 4 R. P. C. 152, 322.

clauses is, as above stated, if he proves his right to do so, entitled to impeach the patent on any other lawful ground. ^{The} _{Petitioner.} (f)

In order to obtain the Attorney-General's fiat authorising the presentation of a petition for the revocation of a patent, it is necessary to forward the following papers to the Patent Clerk:— ^{Procedure to obtain the fiat of the Attorney-General.}

1. Memorial to the Attorney-General asking for his authority and stating all the circumstances.
2. Statutory declaration verifying the statements in the memorial.
3. Two copies of the proposed petition, and of the particulars proposed to be delivered with it. (g)
4. Certificate of a barrister that the petition is proper to be authorised by the Attorney-General.
5. Certificate of a solicitor that the proposed petitioner is a proper person to be a petitioner, and that he is competent to answer the costs of all proceedings in connection with the petition if unsuccessful.

Under the old practice in *scire facias* the fiat of the Attorney-General was necessary in all cases, and was not issued as of course; (h) neither does a petitioner under the present practice obtain the fiat as of right, for the Attorney-General grants or refuses it at his discretion; though it is usual for the Attorney-General to exercise his discretion in favour of the petitioner when there is anything like a *prima facie* case. (i)

In some cases the Attorney-General decides *ex parte* whether to grant or refuse his fiat, and in others he directs notice to be given to the patentee, and that the parties be heard before him.

Thus, where no other proceeding was pending, the Attorney-General's fiat was granted without a direction to give notice to the patentees; (k) so likewise where an action for infringement of the patent had been commenced but abandoned. (l) Where an action for infringement against the applicants was pending in Scotland, and the patentees objected that, as they were resident in Scotland, the application should have been made to the Lord Advocate, the Attorney-General's fiat was refused, pending the result of the action in Scotland, but leave was given to renew the application if necessary. (m) Where the

(f) Morgan's Patent, (1888) 5 R. P. C. 186.

(g) For forms, see Appendix.

(h) 1 W. P. C. 671 n; R. v. Prosser, 14 Beav. 306.

(i) Shoe-Machinery Co. v. Cutlan, (1895) 12 R. P. C. 533.

(k) Gaulard and Gibbs' Patent, Griff. P. C. 320.

(l) Bothwell's Patent, Griff. P. C. 320.

(m) Bell and Coleman's Patent, Griff. P. C. 320; see also *In re Young's Patent*, P. M. J. 2nd series, vol. vii. p. 44.

**Grounds
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tion.**

applicant was a licensee under the patent notice was directed to be given to the patentee ;(n) so also where the applicant was a defendant in an action for infringement at the instance of the patentee and the application was made during the interval after judgment in the Court of First Instance and the hearing of an appeal ;(o) and where notice had been given to the patentee, the application was at the hearing ordered to stand over, on the patentee undertaking to commence an action for infringement within a month.(p)

Attorney-
General may
grant his fiat
nunc pro tunc.

The Attorney-General has authority to grant the fiat *nunc pro tunc*. Thus when a petition came on for hearing without the fiat, which was necessary, having been obtained, and the respondent objected, it was ordered to stand over generally with liberty to either side to restore it, so as to afford an opportunity to the petitioner to obtain the fiat.(q)

Costs of pro-
ceedings
necessary to
obtain Attor-
ney-General's
fiat.

The Act of 1883 gives the Attorney-General power to award the costs of proceedings before him,(r) including a petition for his fiat, which is heard out; but it does not give him any authority over the costs of a petition presented to him praying for the grant of his fiat when that petition is subsequently abandoned.(s)

GROUND'S FOR REVOCATION.

Grounds on
which patents
are revoked.

A patent may be revoked on any ground on which previous to the Act of 1883 it could have been repealed by *scire facias*.(t)

A *scire facias* lay to repeal a patent in three cases according to the authority of the fourth Institute.(u)

- (1) When the King by his letters patent doth grant by several letters patent one and the selfsame thing to several persons, the former patentee shall have a *scire facias* to repeal the second patent.
- (2) When the King granteth anything that is grantable upon a false suggestion, the King by his prerogative *jure regio* may have a *scire facias* to repeal his own grant.
- (3) When the King doth grant any thing which by law he cannot grant, he, *jure regio* (for the advancement of justice and right), may have a *scire facias* to repeal his own letters patent.

(n) Martin's Patent, Griff. P. C. 320.

(o) Watling's Patent, Griff. P. C. 320.

(p) Siddell's Patent, Griff. P. C. 320.

(q) Dedge's Patent, (1895) 12 R. P. C. 453.

(r) s. 38.

(s) Martin's Patent, Griff. P. C. 320.

(t) 46 & 47 Vict. c. 57, s. 26 (3).

(u) p. 88.

It was laid down by another well-known authority (x) that the grounds on which a patent could be repealed by *scire facias* were: "fraud, false suggestion, non-compliance on the part of the patentee with the conditions of the letters patent, failure of any of the essential requisites of novelty and utility, or abuse of the privileges granted by the letters patent." (y)

Grounds
for Revo-
cation.

Thus a patent may be revoked on the grounds that the patentee was not the true and first inventor, that the alleged invention is not proper subject-matter, or lacks the essential elements of utility or novelty, or that the specifications are defective, or on any one of those grounds singly. It may also be revoked on the ground that it was obtained in fraud of the rights of the petitioner. (z)

Parke, B., delivering the judgment of the Court of Exchequer in a case where a patent was upset on the ground of false suggestion, said:—

The question is "whether this patent, which suggests that certain inventions are improvements, is avoided, if there be one, which is not so. And upon the authorities we feel obliged to hold that the patent is void, upon the ground of fraud on the Crown, without entering into the question whether the utility of each and every part of the invention is essential to a patent, where such utility is not suggested in the patent itself, as the ground of the grant. That a false suggestion of the grantee avoids an ordinary grant of land or tenements from the Crown is a maxim of the Common Law, and such a grant is void, not against the Crown merely, but in a suit against a third person. (a) It is on the same principle that a patent for two or more inventions, when one is not new, is void altogether, as was held in *Hill v. Thompson* and *Brunton v. Hawkes*; for although the statute invalidates a patent for want of novelty, and consequently by force of the Statute the patent would be void, so far as related to that which was old, yet the principle on which the patent has been held to be void altogether is that the consideration for the grant is the novelty of all, and the consideration failing, or, in other words, the Crown being deceived in its grant, the patent is void, and no action maintainable upon it." (b)

Under the present practice, all letters patent contain a recital Recitals in the
letters patent.

(x) Webster on the Law and Practice of Letters Patent for Inventions, p. 32.

(y) See *R. v. Cutler*, (1847) Macr. P. C. 124; *R. v. Arkwright*, (1785) 1 W. P. C. 66.

(z) p. 391 *ante*; p. 397 *post*.

(a) *Travell v. Carteret*, 3 Lev. 135; *Alcock v. Cooke*, (1829) 5 Bing. 340.

(b) *Morgan v. Seaward*, (1837) 2 M. & W. 544; 1 W. P. C. 196.

**Grounds
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tion.**

to the effect that the patentee has represented to the Crown that he is in possession of an invention of which he is the true and first inventor, and that the same is not in use by any other person to the best of his knowledge and belief;(c) and a further recital to the effect that the patentee has by and in his complete specification particularly described the nature of his invention.(d)

Distinction
between a
false repre-
sentation re-
cited in the
patent and a
false state-
ment in the
specification.

The distinction between a false representation made by the patentee and recited in the letters patent and a false statement, as an error in the specification, is of the greatest importance. A distinction must be drawn between an error in the specification, such as will make a suggestion in the letters patent false, and an error in a matter of direction or otherwise, such as affects the suggestion in some degree short of the preceding, as, for instance, to diminish the extent of utility.(e)

Inventions
with the same
objects.

If a patentee invents an apparatus or process for achieving a given object, he will not necessarily be entitled to obtain (on the ground that he was the first and true inventor) the revocation of a subsequent patent for achieving the same object, when the invention comprised therein is a different method of arriving at the same result and the later patentee shows a different way of dealing with knowledge common at the date of the first patent.(f) If, however, the prior patentee has discovered a new principle and a method of carrying it out, he may be entitled to the revocation of a subsequent patent for another and analogous method of carrying out the same principle.(g)

In a case (h) where revocation of a patent for "improvements in the preparation of foods for infants and invalids" was sought, on the ground that the petitioner had for many years previous to the date of the patent been manufacturing foods by a process substantially similar to that of the patentee, and the evidence established the fact that the two processes were chemically the same, *Kay, J.*, in giving judgment for the petitioner said:—

"This is an application to recall a patent. It is made under the statute of 1883, which provides that a petition for revocation of a patent may be presented by, among other people, 'any person alleging that he or any person under or through whom

(c) Appendix.

(d) *Ibid.*

(g) See pp. 44, 45 *ante*.

(e) See 1 W. P. C. 42 n.

(f) *Walker v. Hydrocarbon Syndi-
cate, Ltd.*, (1885) 2 R. P. C. 3.

(h) In the Matter of Haddan's Pa-
tent, (1885) 2 R. P. C. 219.

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.' Now, the justice and common sense of that is too apparent to need much comment. A man has been carrying on a particular manufacture for some time; and that another person should come and take out a patent for that manufacture as for a new invention by that other person, and stop the manufacture that has been going on for years, would be an intolerable wrong, carried out under the apparent sanction of the Patent Law; and therefore when anything of the kind happens the Legislature provides this simple remedy, that the person who has been carrying on this manufacture may come to the Court and have the patent revoked."

**Grounds
for Revo-
cation.**

Under the following circumstances patents have been revoked on the ground that they were obtained in fraud of the rights of the petitioner. Where it appeared that the petitioner and respondent had jointly put in a provisional specification, which had been allowed to lapse, and the respondent had thereupon, without the knowledge of the petitioner, obtained the patent for the invention of which the petitioner was the first and true inventor.⁽ⁱ⁾ And where the evidence showed that experiments finally resulting in the invention were not made by one of two separate petitioners under the direction of the patentee as the patentee contracted, but by the other separate petitioner assisted by the first petitioner, and the patentee, not being the true and first inventor, had obtained the patent in fraud of the latter petitioner's rights.^(l)

Cases of revocation on the ground that the patent was obtained in fraud of the petitioner's right.

When a petitioner succeeds on the ground that the patent was obtained in fraud of his rights, the patent of the respondent will be revoked, and a fresh patent may be granted to the petitioner,^(l) which will terminate on the expiration of the term for which the revoked patent was granted,^(m) but such a patent will not be granted as matter of course; the Comptroller-General has a discretion in the matter.⁽ⁿ⁾

A fresh patent may be granted to the petitioner when he succeeds on the ground that the original patent was obtained in fraud of his rights, but not when he succeeds on any other ground.

In all other cases when the petitioner succeeds on grounds other than that of fraud of his rights, the invention cannot be good subject-matter of a fresh patent.^(o)

⁽ⁱ⁾ Gale's Patent, (1891) S R. P. C. 438.

^(l) Norwood's Patent, (1895) 12 R. P. C. 214; see also Avery's Patent, (1887) 4 R. P. C. 152; L. R. 36 Ch. D. 307; Norwood's Patent (No. 2), (1898) 15 R. P. C. 99.

^(l) *In re* Avery's Patent, (1887) L. R. 36 Ch. D. 326; 4 R. P. C. 152. 322.

^(m) 45 & 47 Vict. c. 57, s. 26 (8).

⁽ⁿ⁾ Norwood's Patent, (1895) 12 R. P. C. 219; Norwood's Patent (No. 2), (1898) 15 R. P. C. 99.

^(o) *Ibid.*

PRACTICE.

Parties.

Every petition for the revocation of a patent must be presented in the name of the person making the allegations in respect of which the revocation is sought, such person, when necessary, being duly authorised by the fiat of the Attorney-General; (p) and all persons having an interest in the patent must be made respondents. (q)

Under the old practice it was not competent for two persons to have a *scire facias* for the same patent, (r) and if the patent had been originally granted to two persons jointly it was necessary to make them both parties, notwithstanding the fact that one had, before the issue of the suit, assigned his share to the other. (s)

Under the present practice it is only necessary to make the persons respondents who have an interest in the patent at the time the petition for revocation is presented; and when the patent is assigned after the presentation of a petition the name of the assignee may, on payment of a sum into Court, be substituted for that of the patentee as respondent. (t)

Particulars of objections.

The petitioner is required to deliver with his petition particulars of the objections on which he means to rely. (u) These particulars may be, from time to time, amended by leave of the Court or a Judge, (x) and no evidence will, except by leave of the Court or a Judge, be admitted in proof of any objection of which particulars have not been delivered. (y)

In a case of *scire facias*, though particulars of objection were not specially requisite, ambiguous charges were not allowed. Thus it was held that a suggestion in the words "the grant is prejudicial and inconvenient to our subjects in general" was too vague, and the Court refused to hear evidence on this issue. (z) Again after a verdict had been given for the Crown it was held to be no ground for granting a new trial that the patentee could bring further evidence, if there was no allegation of surprise, or the discovery of further evidence. (a)

(p) p. 392 ante.

(q) *Re Avery's Patent*, (1887) L. R. 36 Ch. D. 307; 4 R. P. C. 152, 322.

(r) *R. v. Neilson*, (1842) 1 W. P. C. 673.

(s) *R. v. Betts*, (1850) 15 Q. B. 540; L. J. Q. B. 13, 53.

(t) *Re Haddan's Patent*, (1885) 2 R. P. C. 218.

(u) 46 & 47 Vict. c. 57, s. 26 (5). For a form of particulars of objection to be delivered with a petition

for the revocation of a patent, the reader is referred to *In the Matter of Haddan's Patent*, (1885) 2 R. P. C. 218: and further detailed information, relative to particulars of objections, will be found at pp. 527-540 *post*.

(x) *Ibid.* (6). (y) *Ibid.* (5).

(z) *R. v. Arkwright*, (1785) 1 W. P. C. 64 n.

(a) *R. v. Arkwright*, (1785) 1 W. P. C. 64, 74.

Practice.

In an action for infringement it is necessary for the successful party to obtain the Judge's certificate of the reasonableness and propriety of his particulars, in order that his costs of such particulars may be allowed on taxation,^(b) but this does not seem necessary in the case of a petition for the revocation of a patent, and it would appear that the Court or a Judge has no power to give such a certificate.^(c)

The petitioner is entitled to administer interrogatories to the respondent as in an action for infringement.^(d)

Interrogatories.

All persons interested in the patent ought to be made respondents and served with the petition.^(e)

Service of the petition.

The Act of 1883 does not, however, provide any special procedure for the service of the petition out of the jurisdiction. It is therefore sufficient if such notice is given as is required by natural justice.^(f)

In *Drummond's Patent* ^(g) it appeared that the patentee was resident and domiciled in Scotland. After a copy of the petition, together with the particulars of objection, was delivered to him personally in Scotland, he wrote to the petitioner's solicitors, stating that he did not intend to appear, and objecting to the jurisdiction of the English Court. On the application of the petitioner, the Court ordered that the case should be set down for hearing, unless by a certain day, of which notice was to be given to the respondent, he should appear and show cause to the contrary; it being open to him, if he appeared, to dispute the jurisdiction.

In *Goerz and Hough's Patent* ^(h) the respondents were both domiciled out of the jurisdiction, and on an application for directions as to service, *North, J.*, pointed out that the respondents could not be served at all, but that the proper thing for the petitioner to do was to follow the procedure adopted in *Drummond's Patent* above referred to. The Judge also stated that he could not authorise the petitioner to do anything, but that if he (the Judge) was satisfied that the respondents had had proper notice he might proceed in their absence.

In *Hirschfeld's Patent*,⁽ⁱ⁾ on motion for directions as to

^(b) 46 & 47 Vict. c. 57, s. 29 (6).

^(c) 46 & 47 Vict. c. 57, s. 26; *Gaulard and Gibbs' Patent*, (1888) 5 R. P. C. 525, 537.

^(d) *Haddan's Patent*, (1884) 54 L. J. Ch. N. S. 126; 51 L. T. N. S. 190; W. R. (1884) p. 192.

^(e) *Avery's Patent*, (1887) L. R. 3 Ch. D. 307; 4 R. P. C. 152.

^(f) See *King and Co.'s Trade Mark*, (1892) L. R. 2 Ch. D. 463.

^(g) (1889) 6 R. P. C. 756

^(h) (1895) 12 R. P. C. 370.

⁽ⁱ⁾ (1895) 11 R. P. C. 514.

Practice. service of the petition on a foreigner resident abroad, leave was given to the petitioner to send to the respondent by registered letter a copy of the petition, together with a notice that the petition had been ordered to go into the witness list. The respondent did not appear, and the patent was revoked in his absence.

In *Kay's Patent* (*k*) one of three respondent joint patentees was out of the jurisdiction, and the petition had been duly served on the other two within the jurisdiction. On motion for directions, it was ordered that the petition should go into the witness list; but unless the third patentee appeared by counsel on notice given to him (*l*) it should not come on for hearing without leave; and liberty was given to either party to apply.

Respondent out of the jurisdiction cannot be compelled to give security for costs.

The Court will not compel a respondent out of the jurisdiction to give security for costs, since he does not appear before the Court in consequence of his own application. (*m*)

Respondent has the right to begin at the hearing.

At the hearing of a petition for revocation the *onus* is on the respondent, who therefore has, by statute, the right to begin and give evidence in support of the patent, and he has the right to reply, if the petitioner tenders evidence impeaching the validity of the patent. (*n*)

In an action of *scire facias* the burden of proof was on the plaintiff, and in order to succeed he had to do more than establish a mere *prima facie* case. (*o*)

Petition is an action and tried like other actions.

A petition for revocation is, in every sense of the word, an action, except that it is commenced by a petition instead of a writ, and it will be tried in the way in which actions usually are tried—*i.e.*, by *virâ voce* evidence—if either of the parties desires to have it so determined. (*p*)

Trial with witnesses.

If it is desired to have the petition tried with witnesses the proper course is to make an application, on the day on which the petition is returnable, that the petition should go into the witness list to be tried on oral evidence. (*q*)

Trial on affidavit evidence.

When the petition is to be tried by the Court on affidavit evidence, it is proper for the party who has the right to begin

(*k*) (1894) 11 R. P. C. 279.

(*l*) As in *King and Co.'s Trade Mark*, 9 R. P. C. 350.

(*m*) *Miller's Patent*, (1894) 11 R. P. C. 55; *La Société Anonyme Trade Mark*, (1893) 10 R. P. C. 290.

(*n*) 46 & 47 Vict. c. 57, s. 26 (7).

(*o*) *R. v. Cutler*, *Macr. P. C.* 124, 133, 134.

(*p*) *In re Gaulard and Gibbs' Patent* (1886) L. R. 34 Ch. D. 396; *Walker v. Hydrocarbon Syndicate*, (1884) 2 R. P. C. 3; *In re Haddan's Patent*, (1885) 2 R. P. C. 218.

(*q*) *Miller's Patent*, (1894) 11 R. P. C. 55.

to file his evidence in chief first, and if there is any cross-examination of any of the witnesses of either side such cross-examination ought to be brought before the Court at the trial.^(r) **Practice.**

The Court may, and on the request of either of the parties it must, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance.^(s) Trial with assessor.

Unless the Court otherwise decide, the petition is heard without a jury.^(t) Trial without a jury.

To suit the convenience of the parties to the petition for revocation and their witnesses, an order may be obtained directing the trial of the petition before a Judge without a jury at assizes.^(u) Trial at assizes.

Again, if there is an action for infringement of the patent pending, an order may be obtained for the hearing of the petition at the same time as the trial of the action.^(x) Hearing at same time as an action for infringement.

As a rule joint petitioners must appear by the same counsel, but in *Norwood's Patents* ^(y) two joint petitioners were, under the peculiar circumstances of the case, allowed to appear separately, and one conducted his case in person.^(z) Joint petitioners must appear by same counsel.

Where the respondent consents, an order for revocation with costs will be made when the petition comes on for directions.^(a) Revocation when respondent consents.

When the respondent does not appear the patent may be revoked at once on the petition coming on and the production of affidavits verifying the service and the grounds of revocation stated in the petition.^(b) And since petition is the only way open to a member of the public to obtain the revocation of a void patent, costs will be given against a respondent patentee who does not appear.^(c) Also costs will be given against a respondent who abandons his case.^(d) Revocation when respondent does not appear.

There is no estoppel against a petitioner for revocation who has been an unsuccessful defendant to an action for infringement of the patent brought at the instance of the respondent. No estoppel against an unsuccessful defendant to an action for infringement.

^(r) *Gale's Patent*, (1891) 8 R. P. C. 438. 447; *Rendell's Patent*, (1894) 11 R. P. C. 277; *Wilkinson's Patent*, (1894) 11 R. P. C. 298.
^(s) 46 & 47 Vict. C. 57, s. 28.
^(t) *Ibid.*
^(u) R. S. C. O. 36, r. 8; In the *Matter of Edmond's Patent*, (1889) 6 R. P. C. 355. ^(b) *Hirschfeld's Patent*, (1894) 11 R. P. C. 514; *Vaisey's Patent*, (1894) 11 R. P. C. 593.
^(x) *Edge's Patent*, (1890) W. N. 149. ^(c) *Wallace's Patent*, (1895) 12 R. P. C. 444; *Simmon's Patent*, (1895) 12 R. P. C. 446.
^(y) (1895) 12 R. P. C. 214. ^(d) *Dege's Patent*, (1895) 12 R. P. C. 448.
^(z) *Norwood's Patents*, (1895) 12 R. P. C. 219, 221.
^(a) *Sleight's Patent*, (1893) 10 R. P. C.

Practice. The reason of this is, that the petitioner on the petition appears as a member of the public, and consequently there is no *res judicata* between him and the respondent in that capacity.^(e) And this fact will materially influence the Court of appeal in exercising its discretion to allow fresh evidence of invalidity upon the appeal of an unsuccessful defendant to an action for infringement.^(f)

Old practice as to non-suits and postponements of actions for infringements pending a *scire facias*.

Under the old practice, the fact of a *scire facias* pending was a ground for refusing a nonsuit on an objection to a patent in an action for infringement.^(g) Where a *scire facias* was sued out after a verdict in an infringement action, and a rule obtained to show cause why a nonsuit should not be entered, the Court refused to extend the time for this rule until after the hearing of the *scire facias*. *Tindal*, C.J., pointed out that even if the *scire facias* availed, and the patent was repealed, that would not necessarily prevent the Court from giving judgment on the objections taken at the trial of the cause.^(h) So also the Court refused to deprive the plaintiff in an action for infringement of his Common Law right to try where a *scire facias* had been set down.⁽ⁱ⁾ As a general rule, the plaintiff had a right to have his cause go on to trial, according to the ordinary course of business, but there might be special circumstances upon which the Court might see fit to interpose.^(k)

Where, in a case in the Common Pleas, an action for the infringement of a patent had been tried, and a rule *nisi* for a new trial had been obtained and argued, and it appeared that another action was pending in that Court for another infringement of the same patent, the Court suspended judgment upon the rule for a new trial, and ordered the trial of the other action to be postponed until after the trial of the *scire facias*;^(l) and in another action in the Common Pleas, where it appeared that the defendants had sued out a *scire facias* to repeal the plaintiff's patent, and a verdict had been obtained for the Crown, but a rule *nisi* for a new trial was pending in the Queen's Bench, and the defendant in the Common Pleas gave notice of

^(e) *Deeley's Patent*, (1895) 12 R. P. C. 192, 199; *Shoe Machinery Co. v. Cutlan*, (1895) 12 R. P. C. 533; *Lewis and Stickler's Patent*, (1897) 14 L. R. 24, 35.

^(f) *Shoe Machinery Co. v. Cutlan*, (1895) 12 R. P. C. 530, 533.

^(g) *Haworth v. Hardcastle*, (1834) 1 W. P. C. 485.

^(h) *Haworth v. Hardcastle*, (1834) 1 W. P. C. 486 n.

⁽ⁱ⁾ *Muntz v. Foster*, (1843) 2 W. P. C. 93 n.

^(k) *Ibid.*

^(l) *Patteson v. Holland, Hindmarch Patents*, p. 293.

trial *by proviso*, the Court upon the application of the plaintiff made a rule absolute for postponing the trial. *(m)* Practice.

In *Walker v. The Hydrocarbon Syndicate* *(n)* an application for the postponement of an appeal in a petition for revocation, on the ground that the petitioner could not be found at the hearing, and for leave to adduce further evidence, was refused. Fresh evidence on appeal from order for revocation.

The respondent may, if he thinks fit, on obtaining the leave of the Court or a Judge, during a proceeding for the revocation of his patent, apply at the Patent Office for leave to amend his specification by way of disclaimer, and a postponement of the hearing may be granted to allow of this being done. *(o)* Amendment of specification pending proceedings for revocation.

If a petitioner succeeds in obtaining the order of the Court for the revocation of a patent he must forthwith leave at the Patent Office a copy of such order, and the purport of it will be duly entered in the Register of Patents, *(p)* but the Patents Act, 1883, *(q)* and the Patent Rules, 1890, do not deprive the Court of its power to stay proceedings on an order pending an appeal. *(r)* Stay of proceedings on order for revocation pending an appeal.

Under the old practice, if the trial of a *scire facias* resulted in favour of the Crown the Lord Chancellor had authority to order the patent to be restored into Chancery to be cancelled, *(s)* but recent legislation has not provided for the delivering up of a patent which has been revoked by a decision of the Court.

The judgment of the Court itself is a revocation of the patent, and the practice now is for the Comptroller to register the judgment. If this judgment of revocation is reversed by a Court of Appeal, the judgment of that Court is then entered on the register, and the patent is resuscitated again. *(t)* It is proper for the Court to stay proceedings on the order for revocation pending an appeal. *(u)* Effect of an order for revocation.

It is to be noticed that a decision of the Court in an infringement action against the validity of the patent does not destroy it, since it is not an order for the revocation of the patent; *(x)* and it is open to a patentee by amendment of the

(m) *Smith v. Upton*, (1843) 6 M. & G. 251.

(n) (1886) 3 R. P. C. 253.

(o) 46 & 47 Vict. c. 57, s. 19; p. 234 *ante*.

(p) P. R. (1890) r. 74.

(q) ss. 18 & 19.

(r) *Armstrong's Patent*, (1897) 14 R. P. C. 755.

(s) *R. v. Newton, Hindmarch on Patents*, p. 427; *R. v. Eastern Archi-*

pelago Co., (1853) 4 De G. M. & G. 199.

(t) *Deeley v. Perks*, (1896) 13 R. P. C. 586-587.

(u) *Armstrong's Patent*, (1897) 14 R. P. C. 755; *Deeley v. Perks*, (1896) 13 R. P. C. 586-587.

(x) *Deeley's Patent*, (1894) 11 R. P. C. 75; *Deeley v. Perks*, (1896) 13 R. P. C. 581.

Practice. specification to remove the ground on which the Court has held the patent to be bad ; and, if there is sufficient subject-matter left, he may thus make the patent perfectly valid,^(y) though it may still be liable to attacks by petition for revocation on the ground that what is left is, in fact, not subject-matter.^(z)

Costs. The Act of 1883 does not contain any special provision as to the costs on the hearing of a petition for revocation, but the Court, acting under its general jurisdiction, awards the costs of the petition at its discretion.^(a)

^(y) p. 259 *ante*.

^(z) *Deeley's Patent*, (1895) 12 R. P. C. 192; 13 R. P. C. 581.

^(a) In the *Matter of Haddan's Pa-*

tent, (1885) 2 R. P. C. 218; In the *Matter of Edmond's Patent*, (1889) 6 R. P. C. 358.

CHAPTER XI.

PROLONGATION OR EXTENSION OF LETTERS PATENT.

PROLONGATION PRIOR TO 1884.

THE Common Law sanctions the grant of letters patent for inventions because the pecuniary reward which a monopoly usually brings to the patentee acts as an inducement to others possessing inventive ability to disclose their inventions for the public good. Object of grant of letters patent.

Letters patent are never granted in the first instance for a longer period than fourteen years ; (a) and it sometimes happens that this term is not sufficient to enable the patentee, by means of the profits arising from his monopoly, to recoup himself the outlay to which he has been put, and to reap the remuneration which the law considers he is entitled to in return for communicating a valuable and perfected invention to the public.

Though an invention be beneficial, it may happen that the patentee does not reap any adequate reward during the original term, on account of his outlay in experiments, or on account of the public hesitating to perceive and adopt the discovery. The patentee may also fail to reap a proper reward, because he has been compelled to carry on expensive litigation against persons who have infringed his patent, or to oppose petitions for its revocation. Again, inventors who are not affluent may nearly reach the expiry of their monopoly before they succeed in obtaining the monetary assistance necessary to enable them to develop their discoveries so as to make any adequate profit within the residue of the term.

If from any cause whatever an inventor has not been able to reap the pecuniary benefits to which he was entitled in respect of the disclosure of his secret, there is nothing in the spirit of the patent law which prohibits the Sovereign, acting Power of the Crown to prolong the monopoly.

(a) p. 332 *ante*.

Prolonga-
tion prior
to 1884.

Prolongation
prior to 1835.

Lord
Brougham's
Act of 1835.

for and on behalf of (b) the public, from prolonging the duration of the monopoly, if there is any likelihood of the patentee making profit during the extended period.

Previous to the year 1835 the only way in which a patentee could obtain a prolongation of the period for which the patent was originally granted was by obtaining a special Act of Parliament, and instances of such special Acts are not wanting.(c)

S. 4 of Lord *Brougham's* Act,(d) passed in the year 1835, provided that—

“If any person who now hath or shall hereafter obtain any letters patent as aforesaid—*i.e.*, as grantee, assignee, or otherwise (e)—shall advertise in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carried on any manufacture of 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 apply to his Majesty in Council for a prolongation of his term of sole using and vending his invention, and shall petition his Majesty in Council to that effect, it shall be lawful for any person to enter a caveat at the Council Office; and if his Majesty shall refer the consideration of such petition to the Judicial Committee of the Privy Council, and notice shall first be by him given to any person or persons who shall have entered such caveats, the petitioner shall be heard by his counsel and witnesses to prove his case, and the persons entering the caveats shall likewise be heard by their counsel and witnesses, whereupon, and upon hearing and inquiring of the whole matter, the Judicial Committee may report to his Majesty that a further extension of the term in the said letters patent should be granted, not exceeding seven years; and his Majesty is hereby authorised and empowered, if he shall think fit, to grant new letters patent for the said invention for a term not exceeding seven years after the expiration of the first term, any law, custom, or usage to the contrary in anywise notwithstanding: provided that no such extension shall be granted if the application by petition shall not be made and prosecuted with effect before the expiration of the term originally granted in such letters patent.”

(b) *Harmer v. Playne*, (1809) 14 Ves. 132; Bac. Abr. tit. Prerog.; Year Book, 40 Edw. III. fol. 18.

(c) See 16 Geo. II. c. 25; 23 Geo. II. c. 33; 15 Geo. III. c. 52; 16 Geo. III.

c. 29; 17 Geo. III. c. 6; 25 Geo. III. c. 38; 32 Geo. III. c. 72; 10 Geo. IV. c. 135.

(d) 5 & 6 Will. IV. c. 83, s. 4.

(e) *Ibid.* s. 1.

In consequence of the hardships which patentees suffered who were unable to prosecute their petitions with effect before the expiration of the term of their patents, (f) so much of the above recited Act as provided that no extension of the term of letters patent should be granted, if the application by petition were not prosecuted with effect before the expiration of the term originally granted in such letters patent, was repealed by 2 & 3 Vict. c. 67.

Prolonga-
tion prior
to 1884.

Stat. 2 & 3
Vict. c. 67.

It was provided by this latter statute (g) that the Judicial Committee of the Privy Council should have power wherever it appeared to them that any application for an extension of the term granted by any letters patent, the petition for which extension should have been referred to them for their consideration, had not been prosecuted with effect before the expiration of the said term from any other causes than neglect, or default of the petitioner, to entertain such application, and to report thereon as by Lord *Brougham's* Act (h) provided, notwithstanding the term might have expired before the hearing of such application : and her Majesty was empowered, if she should think fit, on the report of the Judicial Committee recommending an extension of the term of such letters patent, to grant such extension, or to grant new letters patent for the invention or inventions specified in such original letters patent for a term not exceeding seven years after the expiration of the term mentioned in the said original letters patent : Provided that no such extension or new letters patent should be granted if a petition for the same should not have been presented as by Lord *Brougham's* Act directed, before the expiration of the term sought to be extended, nor in case of petitions presented after November 30, 1839, unless such petition should be presented six calendar months at least before the expiration of such term, nor in any case unless sufficient reason should be shown to the satisfaction of the Judicial Committee for the omission to prosecute with effect the said application by petition before the expiration of the said term.

The fact being recognised that, for the encouragement of inventions in the useful arts, it was desirable to give the Crown power to extend the period of a patentee's monopoly beyond seven years from the expiration of the original term in cases where it could be satisfactorily shown that the expense of the invention had been too great for the patentee to recoup

Stat. 7 & 8
Vict. c. 69.

(f) See *Bodmer's Patent*, (1838) (1), 2 Moo. P. C. 471; 13 Newton, L. J. O. S. 175.

(g) s. 2.

(h) p. 406 ante.

Prolonga-
tion prior
to 1884.

himself during the term then limited by law, the Legislature in 1844 by the Act 7 & 8 Vic. c. 69, ss. 2 & 3 enacted as follows:—

“If any person having obtained a patent for any invention shall, before the expiration thereof, present a petition to her Majesty in Council, setting forth that he has been unable to obtain a due remuneration for his expense and labour in perfecting such invention, and that an exclusive right of using and vending the same for the further period of seven years in addition to the term in such patent mentioned will not suffice for his reimbursement and remuneration, then, if the matter of such petition shall be by her Majesty referred to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same after the manner and in the usual course of its proceedings touching patents, and if the said Committee shall be of opinion and shall so report to her Majesty that a further period greater than seven years’ extension of the said patent term ought to be granted to the petitioner, it shall be lawful for her Majesty, if she shall so think fit, to grant an extension thereof for any term not exceeding fourteen years, in like manner, and subject to the same rules as to the extension for a term not exceeding seven years as now granted. Provided always, and be it enacted, that nothing herein contained shall prevent the said Judicial Committee from reporting that an extension for any period not exceeding seven years should be granted, or prevent her Majesty from granting an extension for such lesser term than the petitioner shall have prayed.” (i)

Stat. 15 & 16
Vict. c. 83.

By an Act of 1852 (k) it was provided that any letters patent obtained in the United Kingdom in respect of any invention first invented in any foreign country, or by the subject of any foreign power or State, and in respect of which any foreign letters patent or like privilege should have been obtained, should not continue in force after the expiration of the term which should first expire or be determined of such foreign letters patent or like privileges: Provided that no letters patent granted in the United Kingdom in respect of any invention which formed the subject of any foreign expired letters patent should be valid.

It was, however, provided by the Act of 1852 (k) that the provisions of Lord *Brougham’s* Act, (l) the Act of 1839, (m)

(i) 7 & 8 Vict. c. 69, ss. 2 and 3.
(k) 15 & 16 Vict. c. 83, s. 25.

(l) 5 & 6 Will. IV. c. 83.
(m) 2 & 3 Vict. c. 67.

and the Act of 1844 (*n*) as to prolongation of letters patent should still continue in force.

Extension
under Act
of 1883.

EXTENSION BY PETITION UNDER ACT OF 1883.

The Act of 1883 (*o*) substitutes the term "extension" in place of "prolongation" used in the earlier statutes, and repeals the whole of the statutes hereinbefore referred to, but at the same time provides that the repeal of those enactments shall not affect their past operations, or any patent, 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 done or suffered under or by any of those enactments before or at the commencement of this Act.

Effect of the
Patents, &c.,
Act of 1883.

The Act provides that the repeal of the statutes referred to shall not 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 that Act had not been passed; or take away or abridge any protection or benefit in relation to any such action. (*p*)

The effect of the above reservation was to preserve to patentees whose patents were dated before January 1, 1884, all the rights vested in them by virtue of the repealed statutes. Thus, a patentee whose patent was prior to January 1, 1884, was entitled to present a petition to the Judicial Committee of the Privy Council praying for a prolongation of the term of his monopoly at any time before the expiration of such term, (*q*) though a patentee whose patent is later than that date can only present such a petition at least six months before the time limited for the expiration of his patent. (*r*)

The practice which regulates the presentation and hearing of petitions for the prolongation or extension of patents presented under s. 25 of the Act of 1883 is now governed by the Privy Council Rules, 1898, made under the powers created by that section. (*s*) The former practice was governed by the Privy Council Rules (*t*) made under Lord *Brougham's* Act, (*u*) which are not expressly repealed by the new rules of 1898,

Practice on
petitions under
s. 25 of the Act
of 1883.

(*n*) 7 & 8 Vict. c. 69.

(*o*) 46 & 47 Vict. c. 57, s. 113.

(*p*) *Ibid.*

(*q*) Brandon's Patent, (1884) L. R. 9 App. Cas. 589; 1 R. P. C. 154.

(*r*) 46 & 17 Vict. c. 57, s. 25, sub-s. 1.

(*s*) See Appendix.

(*t*) *Ibid.*

(*u*) See 5 & 6 Will. IV. c. 83; Newton's Patent, (1884) L. R. 9 App. Cas. 592; 1 R. P. C. 177.

Extension
under the
Act of 1883.

S. 25 of the
Act of 1883.

and which it is presumed will still be enforced where not inconsistent with the new rules of 1898.

S. 25 of the Act of 1883 enacts as follows:—

(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. (x)

(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.

(x) By a recent Order in Council, her Majesty, by and with the advice of her Privy Council, approved of the several rules and regulations contained in the schedule thereunto annexed,

and ordered that on and after January, 1898, the same be respectfully observed. The Order in Council and rules referred to will be found at p. 731 *post*.

THE PETITIONER.

The term "patentee," as defined by the Act of 1883, means the person for the time being entitled to the benefit of the patent;(y) and it is, therefore, clear that prolongation or extension of the patent could be granted on the petition of the original patentee, his legal personal representative, or assignee, or, in the case of a partial assignment, the assignee or assignees conjointly with the original patentee or patentees.

Who may
petition.

The term "patentee" includes the executor of a deceased assignee,(z) the trustees of a company,(a) the patentee agent of a foreign inventor,(b) or a mortgagee.(c)

Under Lord *Brougham's* Act (d) it was doubtful whether the Crown had power to grant a prolongation in cases where there had been a complete or partial assignment of the patent right; but it was subsequently enacted that it should be lawful for her Majesty, on the report of the Judicial Committee of the Privy Council, to grant such extension as was authorised by Lord *Brougham's* Act either to an assignee or assignees, or to the original patentee or patentees conjointly;(e) and assignees may obtain an extension under the present Acts.(f)

The Judicial Committee in forming their decision whether or not to recommend an extension of a patent always consider separately whether the extension will benefit the inventor, and also whether it will injure the public.

Committee
consider prob-
able benefit to
the petitioner
as well as
injury to the
public.

Assignees do not stand the same chance of success, on an application for extension of the patent, as original patentees,(g) for the object of the Crown, in granting an extension, being to reward the person who communicated the invention to the public, unless such person—*i.e.*, the original patentee—derives some benefit the extension will not be granted.(h)

Assignees are
not received
so favourably
as original
patentees.

The ground that the merits of the inventor ought to be properly rewarded, in dealing with an invention which has proved useful and beneficial to the public, does not exist in the

(y) s. 46.

(z) *Bodmer's Patent*, (1849) 6 Moo. P. C. 469.

(a) *Petitt Smith's Patent*, (1850) 7 Moo. P. C. 133.

(b) *Newton's Patent* (1), (1861) 14 Moo. P. C. 156.

(c) *Southworth's Patent*, (1837) 1 W. P. C. 486; but see *Church's Patent*, (1886) 3 R. P. C. 95.

(d) 5 & 6 Will. IV. c. 83.

(e) 7 & 8 Vict. c. 69, s. 4.

(f) *Davies Patent*, (1894) 11 R. P. C. 28.

(g) *Norton's Patent*, (1863) 1 Moo. P. C. N. S. 339; *Normand's Patent*, (1870) L. R. 3 P. C. 193; *Claridge's Patent*, (1851) 7 Moo. P. C. 394.

(h) See *Norton's Patent*, (1863) 1 Moo. P. C. N. S. 339; *Normand's Patent*, (1870) L. R. 3 P. C. 193; *Bovill's Patent*, (1863) 1 Moo. P. C. N. S. 348; *Hopkinson's Patent*, (1896) 14 R. P. C. 10.

**The
Petitioner.**

case of an assignee, unless the assignee be a person who has assisted the patentee with funds to enable him to perfect and bring his invention into use.(i)

On an application by assignees, the Judicial Committee always consider that by favourably listening to the application of an assignee they are, though not directly, yet mediately and consequentially, as it were, giving a benefit to the inventor, because, if the assignee is not remunerated at all, it might be said that the patentee's chance of making an advantageous conveyance to an assignee would be materially diminished, and consequently his interest damnified. For this reason, consideration is given to the claims of the assignee who has an interest in a patent (k) and has assisted in the development of the invention.

It thus appears that an assignee who has assisted with capital in developing the invention will be viewed by the Judicial Committee more favourably (l) than one who has rendered no such assistance, but has merely purchased the invention on speculation.(m)

Companies.

Companies formed for the purpose of taking over patents and working them stand in the same position as other assignees with regard to petitions for prolongation or extension; *i.e.*, if it can be shown that the company has expended money in developing the invention for the public benefit, and has not obtained an adequate return, the Judicial Committee will report favourably to the company,(n) but if the company has been formed for purposes of speculation merely no prolongation or extension will be recommended.(o)

**Extension is
not recom-
mended unless
original pa-
tentees would
be directly or
indirectly
benefited.**

There is no reported case in which the Committee have recommended an extension, on the petition of an assignee, when it would not directly or indirectly tend towards the benefit

(i) Per Lord Romilly, Norton's Patent, (1863) 1 Moo. P. C. N. S. 339.

(k) See judgment of Lord Brougham, Morgan's Patent, (1843) 1 W. P. C. 738.

(l) Bodner's Patent, (1849) 6 Moo. P. C. 468; Berry's Patent, (1850) 7 Moo. P. C. 187; Whitehouse's Patent, (1830) 1 W. P. C. 473; 2 Moo. P. C. 496; Carp. P. C. 565; Woodcroft's Patent, (1846) 2 W. P. C. 18; 10 Jur. 363; Normand's Patent, (1870) L. R. 3 P. C. 193; 6 Moo P. C. N. S. 477; Houghton's Patent, (1871) L. R. 3 P. C. 461.

(m) *Ibid.*; Sillar's Patent, (1882) G. P. C. 581; Norton's Patent, (1863)

1 Moo. P. C. N. S. 339; 9 Jur. N. S. 419; G. P. C. 553; Hopkinson's Patent, (1896) 14 R. P. C.

(n) Petitt Smith's Patent, (1850) 7 Moo. P. C. 133; Houghton's Patent, (1871) L. R. 3 P. C. 461; 7 Moo. P. C. N. S. 309; Napier's Patent (1), (1861) 13 Moo. P. C. 543; Church's Patent, (1886) 3 R. P. C. 95.

(o) Sillar's Patent, (1882) 1 G. P. C. 581; Claridge's Patent, (1851) 7 Moo. P. C. 394; Reece's Patent, (1881) 17 Iron. 155; 51 Eng. 207; Duncan and Wilson's Patent, (1884) 1 R. P. C. 257; see also Norton's Patent, (1863) G. P. C. 554, per Romilly, M.R.; Hopkinson's Patent, (1896) 14 R. P. C. 5.

of the original inventor, who would, had there been no assignment, have been in a position to claim an extension himself.^(p)

**The
Petition.**

Thus an assignee who has acquired a patent as a commercial venture cannot hope to obtain an extension when the original inventor could have no legitimate interest in making the application himself, *e.g.*, when the original patentee has been sufficiently rewarded at the expense of the patent, though the assignee has made a loss, or only a small profit, by the adventure, an extension will not be granted.^(q)

The merit of an importer,^(r) *i.e.*, an inventor in the patent law sense, and not a mere assignee, is less than that of an original inventor.^(s) To use the language of Lord *Brougham*, "the patent law is framed in a way to include two species of public benefactors; the one, those who benefit the public by their ingenuity, industry, science, invention, and personal capability; the other, those who benefit the public without any ingenuity or invention of their own, by the importation of the results of foreign inventions. Now, the latter is a benefit to the public incontestably, and, therefore, they render themselves entitled to be put upon somewhat, if not entirely, the same footing as inventors."^(t)

Merit of an importer is less than that of an original inventor.

When the patentee has granted an exclusive licence, the exclusive licensee should be a co-petitioner in order that he may show his accounts, and that the exclusive licence was not in fact prejudicial to the public, and further that he may release any rights he may have in the extension if granted.^(u) If an exclusive licence has proved detrimental to the public interest, this fact may influence the Committee not to recommend an extension.^(x)

Exclusive licensees should be co-petitioners.

THE PETITION.

Two or more patents relating to cognate inventions may be included in one petition.^(y)

Petition may include several patents.

^(p) Bower Barff's Patent, (1895) 12 R. P. C. 386.

^(q) Claridge's Patent, (1851) 7 Moo. P. C. 394; Norton's Patent, (1863) 1 Moo. P. C. N. S. 339; Bower Barff's Patent, (1895) 12 R. P. C. 5; Carmont's Patent, (1897) 14 R. P. C. 239.

^(r) See p. 16 *ante*.

^(s) Soames' Patent, (1843) 1 W. P. C. 729.

^(t) Berry's Patent, (1850) 7 Moo. P. C. 187; see also Bower Barff's Patent, (1895) 12 R. P. C. 385.

^(u) Shone's Patent, (1892) 9 R. P. C. 438, 440.

^(x) Darby's Patent, (1891) 8 R. P. C. 380; Shone's Patent, (1892) 9 R. P. C. 438.

^(y) See Johnson and Atkinson's Patents, (1873) L. R. 5 P. C. 87; Clarke's Patent, (1870) L. R. 3 P. C. 421; 7 Moo. P. C. N. S. 255; Church's Patent, (1886) 3 R. P. C. 95; Erard's Patent, (1835) 1 W. P. C. 557.

**The
Petition.**

**Requisites of
petition.**

A petitioner seeking the grace and favour of the Crown is bound to strict truth in his statements ; (z) and the petitioner should remember that a prolongation or extension is a matter of favour and not of right,(a) and that a petition will be dismissed if it fails to state everything connected with the patent fairly and fully.(b) Thus, the petitioner in his petition and accounts (c) must refer to all foreign patents granted to him in respect of the invention forming the subject-matter of the English patent, and to the remuneration or loss he has derived or sustained through such foreign patents.(d) Prolongation has been refused on the ground that the petition was nominally presented by one, but actually in the interest and for the benefit of another company, to whom the shares in the first company had been transferred and no statement of this fact appeared in the petition, and the Judicial Committee would not have been cognisant of it, had it not been brought forward by the Attorney-General.(e)

Where it appeared from the petition that the petitioners were a company who had purchased the patent, but in fact no company, in a commercial sense, had been formed under the Companies Acts, and the persons really interested were the petitioner and a creditor, the Judicial Committee did not recommend an extension.(f)

And where the petition concealed the fact that the manufacture of the patented article had been, by contract, carried on by one of several joint patentees, who had carried on such manufacture in conjunction with the manufacture of other articles, and the accounts did not disclose any other manufacture than that of the patented article, the petition was dismissed.(g)

The petitioner cannot be too careful in framing his petition properly, as the indulgence of the Judicial Committee in granting amendments and adjournments cannot be relied upon ; but in some cases, where there are special circumstances, an amend-

(z) Clarke's Patent (2), (1870) L. R. 3 P. C. 421, 426 ; 7 Moo. P. C. N. S. 255 ; Johnson's Patent, (1871) L. R. 4 P. C. 75, 83 ; 8 Moo. P. C. N. S. 282 ; Hill's Patent, (1863) 1 Moo. P. C. N. S. 258 ; 9 Jur. N. S. 1209 ; 9 L. T. N. S. 101 ; Horsey's Patent, (1884) 1 R. P. C. 225.

(a) Adair's Patent, (1881) L. R. 6 App. Cas. 176.

(b) Pitman's Patent, (1871) L. R. 4 P. C. 84 ; 8 Moo. P. C. N. S. 293.

(c) p. 429 *post*.

(d) Johnson's Patent, (1871) L. R. 4 P. C. 75 ; 7 Moo. P. C. N. S. 255 ; Pitman's Patent, (1871) L. R. 4 P. C. 84 ; 8 Moo. P. C. N. S. 293 ; Adair's Patent, (1881) L. R. 6 App. Cas. 178 ; 50 L. J. P. C. 68 ; Clarke's Patent, (1870) L. R. 3 P. C. 421.

(e) Reece's Patent, (1881) 17 Iron. 155 ; 51 Eng. 207.

(f) Horsey's Patent, (1884) 1 R. P. C. 225.

(g) Yates and Kellett's Patent, (1887) L. R. 12 App. Cas. 147.

ment, and, if necessary, an adjournment, may be allowed.^(h)
The procedure for such relief is by way of a separate petition to the Committee.⁽ⁱ⁾

The
Petition.

A departure from the statutory provisions on presenting a petition affects the jurisdiction of the Judicial Committee, and is consequently fatal; but an omission to observe properly the rules laid down by the Judicial Committee itself may be remedied.^(k)

Departure from statutory requirements affects the jurisdiction of the Committee, but not so a failure to comply with the rules.

In the case of patents granted prior to January 1, 1884, the petition may be presented at any time before the expiration of the patent, provided that it is prosecuted with effect (*i.e.*, the report of the Judicial Committee is obtained),^(l) before the expiration of the term.^(m)

When petition may be presented.

The Act of 1883 does not require the petition to be prosecuted with effect before the expiration of the original term of the monopoly; and it is submitted that, if it be presented at least six months before the time limited for the expiration,⁽ⁿ⁾ any patent to which the Act applies in this matter may be extended, notwithstanding that the report of the Judicial Committee is obtained, after the expiry of the original term.

There is nothing in the patent law which renders invalid a new grant of letters patent, dated after the expiry of the original term, if such new grant is made on the representations of a report of the Judicial Committee of the Privy Council properly obtained. If, however, the petition is not presented in time, *i.e.*, six months before the natural expiration of the patent, the Judicial Committee has no jurisdiction in the matter, and so cannot entertain the petition.^(o)

It is provided by the Judicial Committee Rules, 1898,^(p) that a party intending to apply by petition under s. 25 of the Act of 1883 shall give public notice by advertisement three times in the *London Gazette*, and once, at least, in each of three London newspapers. If the applicant's principal place of business is situated in the United Kingdom at a distance of fifteen miles or more from Charing Cross, he shall also advertise once, at

Advertisements.

^(h) See *Reece's Patent*, (1881) 17 Iron. 155; 51 Eng. 207; *Adair's Patent*, (1881) L. R. 6 App. Cas. 176, 180; *Hutchinson's Patent*, (1861) 14 Moo. P. C. 364.

⁽ⁱ⁾ *Brandon's Patent*, (1884) 1 R. P. C. 154.

^(k) *Hutchinson's Patent*, (1861) 14 Moo. P. C. 364; *Lindon's Patent*, (1897) 14 R. P. C. 643; *Judicial*

Committee Rules, (1898) r. 7, p. 734 *post*.

^(l) *Ledsam v. Russell*, (1847) 1 H. L. Cas. 687.

^(m) *Brandon's Patent*, (1884) 1 R. P. C. 154.

⁽ⁿ⁾ 46 & 47 Vict. c. 57, s. 25 (1).

^(o) *Jablochkoff's Patent*, (1891) 8 R. P. C. 281; see above.

^(p) Rule 1, p. 731 *post*

**The
Petition.**

least, in some local newspaper published or circulating in the town or district where such place of business is situated. If the applicant has no place of business, then, if he carries on the manufacture of anything made under his specification at a distance of fifteen miles or more from Charing Cross, he shall advertise once, at least, in some local newspaper published or circulating in the town or district where he carries on such manufacture. If he has no place of business, and carries on no such manufacture, then, if he resides at a distance of fifty miles or more from Charing Cross, he shall advertise once, at least, in some newspaper published or circulating in the town or district where he resides.

It is further provided by the same rules (*q*) that the applicant shall in his advertisements state the object of his petition and shall give notice of the day on which he intends to apply for a time to be fixed for hearing the matter thereof, 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*. He shall also give notice that caveats must be entered at the Council Office on or before such day so named in the said advertisements.

Petition must be presented within one week of last advertisement in the *London Gazette*.

Affidavit of advertisements.

Application for time for hearing.

Documents to be lodged by petitioner at the Council office.

A petition for revocation under s. 25 of the Act of 1883 must be presented within one week from the publication of the last of the advertisements required to be published in the *London Gazette*.(*r*)

The petition must be accompanied with an affidavit or affidavits of advertisements having been published according to the requirements of the Judicial Committee Rules, 1898. The statements contained in such affidavit or affidavits may be disputed upon the hearing.(*s*)

It is further the duty of the petitioner to apply to the Lords of the Committee to fix a time for hearing the petition, and when such time is fixed the petitioner is required forthwith to give public notice of the same by advertisement once at least in the *London Gazette* and in two London newspapers.(*t*)

The petitioner must, not less than fourteen days before the day fixed for the hearing, lodge at the Council office eight printed copies of the specification; but if the specification has not been printed, and if the expense of making

(*q*) Rule 1; p. 731 *post*.

(*r*) Judicial Committee Rules, (1898) r. 2, p. 732 *post*.

(*s*) *Ibid*.

(*t*) *Ibid*.

eight copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only is to be deemed sufficient.(u)

**The
Petition.**

The petitioner is also required, not less than fourteen days before the day fixed for the hearing, to lodge at the Council office eight copies of the balance-sheet of expenditure and receipts relating to the patent in question, which amounts are to be proved on oath before the Lords of the Committee at the hearing. He must also furnish three copies of the said balance-sheet for the use of the Solicitor to the Treasury, and must, upon receiving two days' notice, give the Solicitor to the Treasury, or any person deputed by him for the purpose, reasonable facilities for inspecting and taking extracts from the books of account, by reference to which he proposes to verify the said balance-sheet at the hearing, or from which the materials for making up the said balance-sheet have been derived.(x)

If an equitable assignee is desirous of petitioning with the legal owner, his name must appear in the advertisements.(y)

Equitable assignee petitioning with the legal owner.

In cases where the patentee resides abroad, and the invention is carried on under licences, the advertisements should be inserted in papers circulating in places where the manufacture is actually carried on.(z)

Petitioner resident abroad.

The advertisements must be proved before the petition is heard,(a) for if anything required by the statute to be done is not done the Crown has no power to grant a prolongation.(b) The Judicial Committee has, however, power to dispense with exact compliance with the mode of advertisement as required by its own rules, and in a proper case will do so (c)—*e.g.*, where there has by an oversight been an omission to issue the preliminary advertisements, and, if the rules were insisted on, it would be impossible to comply with the statutory requirement that the petition must be presented at least six months before the expiration of the patent, the Committee will allow the petition to be received before the insertion of the advertisements, the parties undertaking to insert before a day named all the advertisements required, and the order being served on the

Proof of advertisements.

(u) Judicial Committee Rules, (1898) r. 3, p. 732 *post*.

(x) *Ibid*.

(y) *In re Noble's Patent*, (1850) 7 Moo. P. C. 191.

(z) *Derosne's Patent*, (1844) 2 W. P. C. 2.

(a) *Perkin's Patent*, (1845) 2 W. P. C. 8; p. 416 *ante*.

(b) *In re Noble's Patent*, (1850) 7 Moo. P. C. 194; p. 415 *ante*.

(c) *Jablochkoff's Patent*, (1891) 8 R. P. C. 281; see p. 415 *ante*; *Lindon's Patent*, (1897) 14 R. P. C. 643.

**Opposi-
tion.**Order fixing
the day for
hearing.

Attorney-General, and to be subject to any objection he may make.(d)

The usual order fixing the day for hearing requires the petitioner to advertise the date fixed in the *London Gazette*, and two other papers named in the order.(e)

If on the application to fix a day for hearing it appear that the petition has been presented some considerable time (e.g., eighteen months) before the expiry of the patent, the hearing will be postponed, on the ground that the profits made during the unexpired period may be sufficient adequately to reward the patentee, or affect the term of extension (if any) granted,(f) but it will not be necessary to serve fresh notices.(g)

OPPOSITION.Any person
may enter a
caveat.

It is to be observed that any person may, on or before the day fixed by the petitioner for his application for a time to be fixed for the hearing of his petition, enter a *caveat* or warning to the Sovereign not to accede to the prayer of the petition.(h) An extension of the time for entering a *caveat* will not be granted as a rule on the ground that the applicant did not see the advertisements of the intended application for a day for hearing till too late.(i) Interest in the patent is not essential, as in the case of opposition to the grant,(j) the amendment of a specification,(k) or the revocation of a patent.(l) A person who has entered a *caveat* is entitled to receive four weeks' notice from the petitioner of the day fixed for the hearing,(m) and to be served with a copy of the petition;(n) but this rule has been relaxed, and an earlier date fixed for the hearing in a case where the patent would have expired before the notice.(o) He is also entitled to notice of any special application by the petitioner,(p) and, at his own expense, copies of all papers lodged in reference to the petition.(q)

Notice to
opponents of
day fixed for
hearing.Notice of
opponents
objections to
be

(d) Lindon's Patent, (1897) 14 R.P. C. 643.

(e) See p. 804 *post*.

(f) See Macintosh's Patent, (1837) 1 W. P. C. 739 n. (g) *Ibid*.

(h) p. 410 *ante*.

(i) Hopkinson's Patent, (1897) 13 R. P. C. 114.

(j) p. 317 *ante*.

(k) p. 278 *ante*.

(l) p. 391 *ante*.

(m) Judicial Committee Rules, (1898) r. 4, see p. 733 *post*.

(n) *Ibid*.

(o) Thomas's Patent, (1892) 9 R. P. C. 378.

(p) Hutchison's Patent, (1861) 14 Moo. P. C. 364.

(q) Judicial Committee Rules, (1898), r. 5, p. 733 *post*.

at the Council office eight printed copies of the grounds of his objections to the granting of the prayer of the petitioner.^(r) It will be sufficient if the grounds of the objections are stated, though particulars are not given.^(s) The rules ^(t) made under Lord *Brougham's* Act contained a similar provision.

**Opposi-
tion.**

lodge at the
Council office.

Opposers are not entitled to production and inspection of the petitioner's accounts until the hearing,^(u) but they are allowed copies of them, at their own expense, when they are filed.^(x)

Copies of peti-
tioner's
accounts.

A party intending to oppose a petition under s. 25 of the Act must enter a *caveat* at the Council Office before the day on which the petitioner applies for a time for hearing the matter thereof, and having entered such *caveat* shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.^(y) The petitioner is required to serve copies of his petition on all parties entering caveats in accordance with the rules, and no application to fix a time for hearing may be made without affidavit of such service.^(z)

Time within
which caveats
may be
entered.

Petition must
be served on
all opponents.

All parties intending to oppose are required, within three weeks after such copies are served on them, respectively to lodge at the Council office eight printed copies of the grounds of their objections to the granting of the prayer of the petition.^(a)

Copies of oppo-
nent's grounds
of opposition
to be lodged at
Council office.

Parties are entitled, at their own expense, to have copies of all papers lodged in respect of the petition.^(b)

Copies of all
papers lodged
may be
obtained.

And all petitions as well as all statements of grounds of objection are to be printed in the form prescribed by the rules which apply to proceedings before the Judicial Committee of the Privy Council. Balance-sheets of expenditure and receipts are to be printed in a form convenient for binding along with such petitions.^(c)

How petitions
and notices of
opposition, &c.,
are to be
printed.

The Lords of the Committee will hear the Attorney-General or other counsel on behalf of the Crown on the question of granting the prayer of the petition. The Attorney-General is not required to give notice of the grounds of any objection he may think fit to take, or of any evidence which he may think fit to place before the Lords of the Committee.^(d)

Attorney-
General may
be heard with-
out notice.

Costs incurred in the matter of the petition are taxed by the

Costs of hear-
ing may be
taxed.

^(r) Rule 4, p. 733 *post*.

^(s) *Ball's Patent*, (1879) L. R. 4 App. Cas. 171; 48 L. J. P. C. 24.

^(t) Rule 6, p. 729 *post*.

^(u) *Bridson's Patent*, (1852) 7 Moo. P. C. 499.

^(x) *Judicial Committee Rules*, (1898)

r. 5; p. 733 *post*.

^(y) *Ibid.* r. 4; p. 733 *post*.

^(z) *Ibid.*

^(a) *Ibid.*

^(b) *Ibid.* r. 5; p. 733 *post*.

^(c) *Ibid.*

^(d) *Ibid.* r. 8; p. 734 *post*.

Hearing of the Petition. Registrar of the Privy Council, or other officer deputed by the Lords of the Judicial Committee of the Privy Council to tax costs in the matter of any petition, and the Registrar or such officer has authority to allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses.*(e)*

Compliance with rules may be dispensed with.

The Lords of the Committee have power expressly given them by the present rules to excuse petitioners and opponents from compliance with any of the requirements of the rules relating to the practice as to petitions under s. 25 of the Act of 1883, and to give such directions in matters of procedure and practice under the section as they shall consider to be just and expedient.*(f)*

HEARING OF THE PETITION.

Parties may appear personally or by counsel.

At the hearing of the petition, the petitioner and opposing parties, if there are any, may appear either in person or by counsel; but where there are several opponents not more than two counsel will be heard on either side, unless the opposing parties have distinct and separate interests.*(g)*

Hearing when there is no opposition.

If there is no opposition, or if any of the grounds on which the patent might be opposed are admitted in the patentee's favour by the opponent, the Committee will require formal evidence in support of the petition as a whole, or in support of the admitted grounds, as the case may be.*(h)*

Petition heard though there are pending proceedings affecting question of validity.

The Judicial Committee will hear and adjudicate on a petition notwithstanding that there are proceedings pending affecting the question of validity of the patent, or judgment has been given or the patent has been declared void by a Court from which an appeal lies, and the decision of which is not binding on the Committee.*(i)*

Practice of the Committee.

It is the usual practice, on the hearing of a petition, for the Judicial Committee to deal first with the question of the utility of the invention to the public,*(k)* and afterwards with that of adequacy of remuneration;*(l)* but sometimes this order is reversed—*e.g.*, where the accounts *(m)* show that the

(e) Judicial Committee Rules, (1898) r. 6; p. 440 *post*.

(f) *Ibid.* r. 7; p. 734 *post*.

(g) Woodcroft's Patent, (1841) 3 Moo. P. C. 172 n.

(h) Toy's Patent, (1893) 10 R. P. C. 89.

(i) Kay's Patent, (1839) 1 W. P. C. 568; 572 note *(f)*; Heath's Patent, (1853) 2 W. P. C. 247; Lane Fox's Patent, (1892) 9 R. P. C. 411.

(k) p. 425 *post*.

(l) p. 423 *post*.

(m) p. 429 *post*.

remuneration has been such that it would be preposterous to grant the petition,⁽ⁿ⁾ or the accounts are unsatisfactory.^(o)

In accordance with the rule laid down in *Erard's Patent*,^(p) the Attorney-General always appears at the hearing of petitions for the extension of letters patent, whether there is opposition or not, to watch the interests of the Crown and the public, and he is entitled to be heard without having previously entered a *caveat*.^(q) Also he is not bound to give any notice of objections at all, and may at the hearing raise objections of which no notice has been given.^(r) The patentee comes to ask a favour, and it is his duty to show the exact state of knowledge at the time of his patent, and the exact pale of his invention, by himself referring to previous publications.^(s)

The Judicial Committee may, if they think fit, appoint one of the clerks of the Privy Council to take any formal proofs required to be taken, in dealing with the matter before them, and may proceed on the clerk's report as if the proofs had been taken by the Committee itself;^(t) and under the Act of 1883 they may call in the aid of an assessor specially qualified and hear the petition, wholly or partially, with his assistance, and determine the remuneration he is to receive.^(u)

Where a petitioner applied to have the hearing of his petition advanced, or his evidence taken on commission on account of his impending absence from England, an order was made to the effect that, if his absence proved to be imperative, his evidence might be taken before the Registrar, subject to any objection which the Attorney-General might raise. In the result the evidence was so taken, and the Registrar directed that it should not be published before the hearing of the petition.^(x)

A patentee is never entitled to demand, *ex debito justitiæ*, a prolongation or extension of the term of his monopoly. In

Hearing of
the
Petition.

Attorney-
General always
appears.

Formal proofs
may be taken
by Clerk of the
Committee.

Committee's
discretion is
absolute.

⁽ⁿ⁾ Crighton's Patent, 39 Eng. 135; Saxby's Patent, (1870) L. R. 3 P. C. 292; 7 Moo. P. C. N. S. 82; 19 W. R. 513; Clark's Patent (2) (1870) L. R. 3 P. C. 421; 7 Moo. P. C. N. S. 255; Trotman's Patent, (1866) L. R. 1 P. C. 118; Houghton's Patent, (1871) 7 Moo. P. C. 309.

^(o) Wield's Patent, (1871) L. R. 4 P. C. 89; 8 Moo. P. C. N. S. 300; Thomas's Patent, (1892) 9 R. P. C. 367.

^(p) (1835) 1 W. P. C. 557 n; Whitehouse's Patent, (1830) 1 W. P. C. 474.

^(q) Petitt Smith's Patent, (1850) 7 Moo. P. C. 133; rule 8, p. 734 *post*.

^(r) Rule 8, p. 734 *post*; Ball's Patent, (1879) L. R. 4 App. Cas. 171; Stewart's Patent, (1885) 3 R. P. C. 7; Church's Patent, (1886) 3 R. P. C. 101; Fountain Livet's Patent, (1892) 9 R. P. C. 327.

^(s) Fountain Livet's Patent, (1892) 9 R. P. C. 331, 332.

^(t) 7 & 8 Vict. c. 69, s. 8.

^(u) 46 & 47 Vict. s. 28, sub-s. 2 and 3.

^(x) Whitworth's Patent, 48 Eng. 15.

Grounds
for
Extension.

all cases, the Judicial Committee have an absolute discretion in recommending the Crown to promote the progress of the petition; (y) and the only limit to this recommendation is that the period of extension shall not be more than fourteen years. (z)

GROUNDS FOR EXTENSION.

Grounds for extension have reference to the patentee and to the public.

It is expressly provided by the Act of 1883 (a) that "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."

All the grounds upon which the Judicial Committee of the Privy Council grant extensions of patents may be said to have reference to the inventor himself. They are, in the first place, to reward the inventor for the peculiar ability and industry he has exercised in making the discovery; in the second place, to reward him because some great benefit of an unusual description has by him been conferred upon the public, through the invention itself; and, lastly, because the inventor has not been sufficiently remunerated by the profits derived from his strenuous exertions to make the invention profitable. All these grounds proceed upon the supposition that the invention is new and useful. (b) But, nevertheless, the grant of an extended term must not be detrimental to the public interest. (c) The fact that the patentee has granted an exclusive licence is a point against the extension of a patent, for it is against public policy that there should be only one licensee. (d) This objection may be got over by making it a condition of extension that the exclusive licensee shall renounce all right and benefit in the licence. (e)

(y) Jones's Patent, (1840) 1 W. P. C. 577; Smith and Robertson's Patent, (1847) 30 Newton L. J. O. S. 451; Porter's Patent, 1 Newton, L. J. N. S. 179; Morgan's Patent, (1843) 1 W. P. C. 739; Soames' Patent, (1843) 1 W. P. C. 733; Perkins' Patent, (1845) 2 W. P. C. 16; Derosne's Patent, (1844) 2 W. P. C. 4; Honiball's Patent, (1855) 9 Moo. P. C. 393; Cardwill's Patent, (1856) 10 Moo. P. C. 499.

(z) 46 & 47 Vict. c. 57, s. 25; Led-sam v. Russell, (1847) 1 H. L. Cas. 687.

(a) s. 25, sub-s. 4.

(b) Per Lord Romilly, Norton's Patent, (1863) 1 Moo. P. C. N. S. 339; 9 Jur. N. S. 419; see also White-

house's Patent, (1830) 2 Moo P. C. 496; 1 W. P. C. 473; Erard's Patent, (1835) 1 W. P. C. 557; Downton's Patent, (1839) 1 W. P. C. 565; Derosne's Patent, (1844) 2 W. P. C. 1; 4 Moo. P. C. 417; Carp. P. C. 699; Woodcroft's Patent, (1841) 2 W. P. C. 18; 10 Jur. 363.

(c) McInnes' Patent, (1868) L. R. 2 P. C. 54; 37 L. J. P. C. 23; 5 Moo. P. C. N. S. 72.

(d) Cardwill's Patent, (1856) 10 Moo. P. C. 488; Darby's Patent, (1891) 8 R. P. C. 380; Shone's Patent, (1892) 9 R. P. C. 438.

(e) Shone's Patent, (1892) 9 R. P. C. 441.

The fact that an extension would prevent the public from using the invention, which is one of public importance—*e.g.*, a process for deodorising manure may weigh against the grant of the prayer of the petition.^(f)

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But the fact that the invention deals with a subject, *e.g.*, smoke prevention, which the public are by statute obliged to use, does not, though the public may practically be obliged to use the patentee's invention, raise an insuperable objection against the extension of the patent.^(g)

It is thus clear that a petitioner, in order to induce the Judicial Committee to recommend the Crown to grant the prayer of the petition, must satisfactorily prove two things, viz. :—

Two things
necessary to
obtain an
extension.

(i) The invention is meritorious.

(ii) He has been insufficiently remunerated, owing to no fault of his own.

(i) **Merit.** The applicant must make out a *prima facie* case of validity.^(h) For this purpose, a decision of the High Court of Justice, or the Court of the County Palatine of Lancaster, in favour of the validity of the patent will be sufficient.⁽ⁱ⁾

Invention must
be proved to be
independently
meritorious.

The invention must be shown to be independently meritorious—*e.g.*, it will not do to show that it could only be useful in conjunction with some later discovery.^(k) It is, however, not an objection to the grant of a prolongation or extension that the invention is an improvement on, and is intended to be used with, some previously patented invention,^(l) or that the original invention would not be used without it,^(m) provided that there is utility in the improvement.⁽ⁿ⁾

If an invention consist of several parts, and it appear that some part, or parts, is, or are, not meritorious, but that there is merit in the remaining part or parts, an extension will probably be recommended in respect of the meritorious part or parts alone.^(o)

Only part of
invention
meritorious.

^(f) McDougall's Patent, (1867) L.R. 2 R. P. C. 1; 5 Moo. P. C. 1; Sillar's Patent, (1882) G. P. C. 581; Morgan's Patent, (1843) 1 W. P. C. 739; Soames' Patent, (1843) 1 W. P. C. 734.

^(g) Foardes' Patent, (1855) 9 Moo. P. C. 376.

^(h) Erard's Patent, (1835) 1 W. P. C. 557; Kay's Patent, (1839) 1 W. P. C. 568; 3 Moo. P. C. 24.

⁽ⁱ⁾ See Bett's Patent, (1862) 7 L. T. N. S. 577; 9 Jur. N. S. 137; 1 Moo. P. C. N. S. 49.

^(k) Bett's Patent, (1862) 1 Eng. 335; 1 Moo. P. C. 49; 7 L. T. N. S. 577.

^(l) Bovill's Patent, (1863) 1 Moo.

P. C. N. S. 348; Soames' Patent, (1843) 1 W. P. C. 729.

^(m) Woodcroft's Patent, (1841) 1 W. P. C. 740; 3 Moo. P. C. 171; Galloway's Patent, (1843) 1 W. P. C. 727.

⁽ⁿ⁾ Bell's Patent, (1846) 2 W. P. C. 160; 10 Jur. 363.

^(o) Bodmer's Patent, (1881) 8 Moo. P. C. 282; Lee's Patent, (1881) 10 Moo. P. C. 226; Napier's Patent, (1881) L. R. 6 App. Cas. 174; 50 L. J. P. C. 40; (1886) Church's Patent, 3 R. P. C. 95. As to effect of an admission that one claim is bad see Burlingham's Patent, (1898) 15 R. P. C. 195.

**Grounds
for
Extension.**

Committee
does not decide
question of
validity.

The Judicial Committee will not recommend the extension of a patent which, on the face of it, appears to be invalid; (*p*) but they will not discuss or decide the question of validity, if it appear decidedly doubtful on the ground of lack of novelty, or utility, or from any other cause, (*q*) and evidence of these points may be given at the hearing. (*r*) In cases of doubt as to the validity of the patent, the Judicial Committee exercises its discretion, (*s*) and it will not refuse to act though there are proceedings pending in which the validity is in question, or there is a decision against the patent of a Court whose judgments are not binding on the Committee. (*t*) Though the Committee does not try the issue of validity, questions which go to validity may be material upon the question of merit. Thus, prolongation was refused where it appeared that the main merit of the invention lay not in the disclosure of a principle, but in the details of construction, and the petitioner had not given sufficient disclosure in his specification as to those details, and the evidence showed that all the articles constructed under the patent were made under the personal supervision of the patentee, who alone knew the details, and so the specification was insufficient. (*u*)

A new grant is
open to same
objections as
the old one.

If a new grant is allowed, it is of course open to the same objections, and may be annulled in the same manner as the old one; (*x*) and the Judicial Committee are not called on to discuss the question as to whether an extension, if granted, would avail the petitioner anything: that is left to the Courts of law. (*y*)

Merit in the
sense of utility
must be
proved.

There is an obvious distinction between the "merit of ingenuity and the merit of utility" of an invention; (*z*) and unless the Judicial Committee are satisfied that the invention

(*p*) Kay's Patent, (1839) 1 W. P. C. 568; 3 Moo. P. C. 24; Erard's Patent, (1835) 1 W. P. C. 557; McDougal's Patent, (1867) L. R. 2 P. C. 1; 37 L. J. P. C. 17; 5 Moo. P. C. N. S. 1.
(*q*) Hill's Patent, (1863) 9 Jur. N. S. 1209; 9 L. T. N. S. 101; 1 Moo. P. C. N. S. 258; 18 Newton, L. J. N. S. 109; Cocking's Patent, (1885) 2 R. P. C. 151; Stewart's Patent, (1886) 3 R. P. C. 7; Saxby's Patent, (1870) L. R. 3 P. C. 292; 7 Moo. P. C. N. S. 82; Lyon's Patent, (1894) 11 R. P. C. 537.

(*r*) *Ibid.*

(*s*) Per Sir William Erle, McInnes' Patent, (1868) L. R. 2 P. C. 54; 37 L. J. N. S. P. C. 23; 5 Moo. P. C. N. S. 72; Woodcroft's Patent, (1846) 2 W. P. C. 18; 10 Jur. 363; 28 Newton

L. J. C. S. 196; Pinker's Patent, (1848) 12 Jur. N. S. 433; Soames' Patent, (1843) 1 W. P. C. 729; 23 Newton, L. J. C. S. 462.

(*t*) Kay's Patent, (1839) 1 W. P. C. 568, 572 n; Heath's Patent, (1853) 2 R. P. C. 247; Jane Fox's Patent, (1892) 9 R. P. C. 411.

(*u*) Fountain Livet's Patent, (1892) 9 R. P. C. 327.

(*x*) Galloway's Patent, (1843) 1 W. P. C. 724; 7 Jur. 453.

(*y*) Per Lord Brougham, Woodcroft's Patent, (1841) 2 W. P. C. 18; 10 Jur. 363; 28 Newton, L. J. O. S. 196.

(*z*) Bett's Patent, (1862) 7 L. T. N. S. 577; 9 Jur. N. S. 137; 1 Moo. P. C. N. S. 49; Pinker's Patent, (1848) 12 Jur. N. S. 433.

possesses the latter, they will not recommend an extension ; (a) though mere simplicity of invention is not necessarily an objection to an extension, (b) yet the fact of great labour and ingenuity being required to produce the invention will go far to establish a case of utility strong enough to satisfy the Committee that the public is likely to derive a benefit from the invention sufficient to warrant an extension. (c)

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—

The test of utility is not the same for the purposes of prolongation as in an action of infringement or petition for revocation. In the former case commercial utility is of the utmost importance, but not so in the latter. (d) And generally in order to succeed, the petitioner must show that there is in the invention merit beyond that ordinary merit which would be sufficient to sustain a patent in the first instance—that is to say, there must be something beyond that merit which would, in an action for infringement, support a patent in the face of a plea of want of utility. (e) Consequently, because an invention is new, in the sense that a patent for it could be supported on the ground of novelty, it does not necessarily follow that it is sufficiently novel, having regard to prior inventions of a like character, to satisfy the Judicial Committee that the benefit conferred by it on the public is sufficient to warrant an extension. (f)

Test of utility
necessary for
an extension.

Thus, where there have been previous patents for somewhat analogous methods of attaining the same result as that achieved by the petitioner's patented invention, and the petitioner's invention has not been taken up by the public, though it has been advertised to a considerable extent, the Judicial Committee will not deem the invention to possess such a sufficient degree of novelty or merit as will justify them in recommending a prolongation. (g)

(a) Simister's Patent, (1842) 1 W. P. C. 721; 7 Jur. 451; 4 Moo. P. C. 164; 21 Newton, L. J. C. S. 465; Longmaid's Patent, 1 Eng. 347; Derosne's Patent, (1835) 2 W. P. C. 1; Carp. P. C. 699; 4 Moo. P. C. 417; 24 Newton, L. J. C. S. 459.

(b) Per Lord Watson, Hazeland's Patent, (1894) 11 R. P. C. 470.

(c) Hill's Patent, (1863) 9 L. T. N. S. 101; 9 Jur. N. S. 1209; 1 Moo. P. C. N. S. 258; 18 Newton, L. J. N. S. 109.

(d) Lawrence's Patent, (1892) 9 R. P. C. 83; McDougal's Patent, (1884) 2 R. P. C. 11; Pitman's Patent, (1871) L. R. 4 P. C. 84; 8 Moo. P. C. N. S. 293.

(e) See remarks of Grove, J., Stoney's Patent, (1888) 5 R. P. C. 520; see also Saxby's Patent, (1886) 3 R. P. C. 294; Bett's Patent, (1862) 1 Moo. P. C. N. S. 49; 9 Jur. N. S. 137; 7 L. T. N. S. 577.

(f) Stuart's Patent, (1886) 3 R. P. C. 7; Sillar's Patent, (1882) G. P. C. 581; M'Dougal's Patent, (1867) L. R. 2 P. C. 1; 37 L. J. N. S. P. C. 17; 5 Moo. P. C. N. S. 1; McInnes' Patent, (1868) L. R. 2 P. C. 54; 37 L. J. N. S. P. C. 23; 5 Moo. P. C. N. S. 72.

(g) Allan's Patent, (1867) L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 443; Stewart's Patent, (1885) 3 R. P. C. 7; Hall's Patent, (1895) 12 R. P. C. 400.

**Grounds
for
Extension.**
Extent of user
is an important
question.

The extent to which the invention has been used by the public is, in more ways than one, an important consideration. If there has been an extensive use by the public, of course this fact is unfavourable to the contention of an applicant for prolongation or extension, for though it shows that the invention is useful, it also shows that the patentee has had an opportunity of making profit out of it.^(h) On the other hand, if the invention has not been extensively used by the public, the presumption is against its utility, and therefore unfavourable to the applicant.⁽ⁱ⁾ In the words of Lord *Romilly*, the Judicial Committee "find much more difficulty in dealing with the case of a patent where it has not been used for fourteen years than in dealing with one where a user has taken place, because, assuming that there is no utility in the invention, there is nobody whose interest it is to oppose it; but where it has been used for a considerable number of years there are persons who always desire to get rid of the invention [patent], and from them their Lordships hear all the arguments which can properly be brought against the validity of the patent."^(k)

Presumption of
non-utility
arising from
limited use
may be
rebutted.

The presumption of non-utility arising from a limited use of the invention by the public is not in every case fatal, for it is often capable of being rebutted,^(l) even though there has been no user at all; ^(m) but strong evidence is required to do this.⁽ⁿ⁾

For example, in the case of *Southby's Patent*,^(o) the original invention which was patented in 1877 was of great merit, but had never been brought into practical use, because the patentee was not satisfied that he had brought the invention into such practical efficiency as could justify him in incurring the expense

^(h) *Downton's Patent*, (1839) 1 W. P. C. 565.

⁽ⁱ⁾ *Allan's Patent*, (1867) L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 443; *Herbert's Patent*, (1867) L. R. 1 P. C. 399; 4 Moo. P. C. 300; *Simister's Patent*, (1842) 1 W. P. C. 721; 7 Jur. 451; 4 Moo. P. C. 164.

^(k) *Allan's Patent*, (1867) L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 433.

^(l) *Norton's Patent*, (1863) 1 Moo. P. C. N. S. 339; 9 Jur. N. S. 419; *Bakewell's Patent*, (1862) 15 Moo. P. C. 385; *Wright's Patent*, (1839) 1 W. P. C. 575; *Jones' Patent*, (1840) 1 W. P. C. 577; *Allan's Patent*, (1867) L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 433; *Cocking's Patent*, (1885) 2 R. P. C. 151; *Berrington's Patent*, cited L. R.

1 P. C. 509; 4 Moo. P. C. N. S. 445; *Coryton*, 225; *Simister's Patent*, (1842) 1 W. P. C. 721; 7 Jur. 451; *Southworth's Patent*, (1837) 1 W. P. C. 486; *Herbert's Patent*, (1867) L. R. 1 P. C. 399; 4 Moo. P. C. N. S. 300; *Hughes' Patent*, (1879) L. R. 4 App. Cas. 174; 48 L. J. P. C. 20; *Semet and Solway's Patent*, (1894) 12 R. P. C. 10; *Roper's Patent*, (1887) 4 R. P. C. 201; *Southby's Patent*, (1891) 8 R. P. C. 433.

^(m) *Roper's Patent*, (1887) 4 R. P. C. 4; *Southby's Patent*, (1891) 8 R. P. C. 433.

⁽ⁿ⁾ *Allan's Patent*, (1867) L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 433.

^(o) (1891) 8 R. P. C. 433.

of putting it on the market. In 1885 the patentee took out a subsequent patent for an invention apparently essential to the working of his original machine, and which enabled such machine to be worked successfully. The Judicial Committee advised a prolongation of five years on the ground that the presumption of non-utility arising from non-user was rebutted, and that there might be some other way than that protected by the 1885 patent by which the machine might be successfully worked.

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The following facts also have been held to be sufficient evidence to rebut the presumption of non-utility arising from a limited user by the public: there was a special trade opposition; (*p*) the invention was of a special nature and could not easily be brought into public use; (*q*) the market and demand was necessarily limited; (*r*) experimental difficulties; (*s*) legal proceedings; (*t*) and the scarcity of labour. (*u*)

The applicant must show that, if a prolongation or extension be allowed, there is every likelihood of the invention being used by the public—*i.e.*, that the conditions owing to which the public use has hitherto been limited (if such be the case) have ceased to exist; otherwise the intention of the Crown that the patentee should be rewarded by the profits arising from the invention, during the further period of the monopoly could not take effect, and the Judicial Committee would not recommend the Crown to accede to the petitioner's request. (*x*)

Probability of
use in the
future must be
established.

(ii) **Insufficient remuneration owing to no fault of the patentee.**—In deciding whether the patentee has been sufficiently rewarded, the Judicial Committee take into consideration the benefit which has resulted and is likely to result to the public, as compared with that which has accrued to the patentee. (*y*)

Benefit accrued
to the public
compared with
that derived by
the patentee.

The petitioner must satisfy the Judicial Committee that he has, having regard to the particular circumstances of each case,

Petitioner
must prove
that he has

(*p*) Simister's Patent, (1842) 1 W. P. C. 721; 7 Jur. 451; 4 Moo. P. C. 161.

(*q*) Southworth's Patent, (1837) 1 W. P. C. 486; Jones's Patent, (1840) 1 W. P. C. 577; Hughes' Patent, (1879) L. R. 4 App. Cas. 174; 48 L. J. P. C. 20; Semet and Solway's Patent, (1894) 12 R. P. C. 10.

(*r*) Herbert's Patent, (1867) L. R. 1 P. C. 399; 4 Moo. P. C. N. S. 300.

(*s*) *Ibid.*

(*t*) Wright's Patent, (1839) 1 W. P. C. 575.

(*u*) Napier's Patent, (1861) 13 Moo. P. C. 543.

(*x*) Woodcroft's Patent, (1846) 2 W. P. C. 18; 10 Jur. 363; Bates' Patent, (1836) 1 W. P. C. 739; Foarde's Patent, (1855) 9 Moo. P. C. 376.

(*y*) Newton's Patent, (1861) 14 Moo. P. C. 156; Derosne's Patent, (1844) 2 W. P. C. 4; Mallet's Patent, (1866) L. R. 1 P. C. 308; Nussey and Leachman's Patent, (1890) 7 R. P. C. 22.

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Extension.**

used his best
endeavours to
make profit,

used his best endeavours to make the invention a pecuniary success, and that no circumstances under his control have led to his insufficient remuneration,^(z) but that he has at all times been willing to give the public the benefit of the invention.^(a)

Thus, in the case of *Roper's Patent*,^(b) the patentee of a captain's bridge constructed as a life-raft petitioned for prolongation on the ground that, owing to illness and other circumstances beyond his control, he had not been adequately remunerated. It was proved that for nearly eight years he had been practically incapacitated from business in consequence of a railway accident. The invention had been awarded prizes at exhibitions, but had never been brought into actual use. Under the circumstances, the Judicial Committee considered that, having regard to the meritorious nature of the invention, the difficulty of bringing it into actual use, the patentee's illness, and the fact that no opposition was offered on behalf of the Crown, the case was an exceptional one, and an extension for seven years should be granted. But prolongation was refused when it appeared that for twelve years before the patent was assigned to a certain petitioner no effort to work it or push it commercially had been made, and no sufficient excuse was forthcoming for the delay.^(c)

and has not
permitted open
infringements.

If infringements of the patent have been openly committed, it will be necessary for the petitioner to show that proceedings have been taken to protect the patent, as evidence of negligence on his part to do so will induce the Judicial Committee to refuse to recommend a prolongation or extension; ^(d) whereas if the expense of litigation necessary to maintain the patent has prevented the petitioner from deriving adequate profits from the invention this circumstance will tell in his favour.^(e)

Disputes by
co-owners.

The circumstance that the invention has not been brought into public use owing to disputes between the co-owners of a

^(z) Southworth's Patent, (1837) 1 W. P. C. 486; Kollman's Patent, (1839) 1 W. P. C. 564; Lowe's Patent, (1846) 2 W. P. C. 158; 10 Jur. 363; Norton's Patent, (1863) 1 Moo. P. C. N. S. 339; 9 Jur. N. S. 419; Patterson's Patent, (1849) 6 Moo. P. C. 469; 13 Jur. 593; Wield's Patent, (1871) L. R. 4 P. C. 89; 8 Moo. P. C. N. S. 300; Cardwell's Patent, (1856) 10 Moo. P. C. 488; Bakewell's Patent, (1862) 15 Moo. P. C. 385; Stewart's Patent, (1886) 3 R. P. C. 7.

^(a) Stewart's Patent, (1886) 3 R. P. C. 10.

^(b) (1887) 4 R. P. C. 201.

^(c) Dolbear's Patent, (1896) 13 R. P. C. 203.

^(d) Simister's Patent, (1842) 1 W. P. C. 724; 4 Moo. P. C. 164; 7 Jur. 451.

^(e) Petitt Smith's Patent, (1850) 7 Moo. P. C. 133; Heath's Patent, (1853) 2 W. P. C. 247; 8 Moo. P. C. 217.

patent will not induce the Judicial Committee to recommend a prolongation or extension.(f)

There does not appear to be any case reported in which an extension has been granted where the patentee has received more than £20,000 from the patent; but this is not a hard and fast rule, and possibly in a case of very special merit such a sum might be treated as inadequate remuneration.(g) In a case where the patentee and his assignees had received £25,000 from the invention prolongation was refused.(h)

The petitioner must lodge at the Council Office, not less than one week before the day for the hearing,(i) a statement of accounts as evidence of his contention that he has been insufficiently rewarded, having regard to the value of the invention to the public. Where the accounts are not lodged within the time specified by the Judicial Committee Rules, an adjournment of the hearing may be ordered on the request of the Attorney-General or other opponents.(k) The Judicial Committee insist that the statement of accounts shall be a full, clear, and accurate (l) balance-sheet, showing the whole *profit and loss* which has been derived or sustained in respect of the invention.(m) It is the petitioner's duty to satisfy the Committee, in a manner which admits of no controversy, as to the amount of remuneration which in every point of view the invention has brought to those who have introduced, or helped to introduce, it to the public, in order that their Lordships may be able to come to a conclusion whether that remuneration may fairly be considered a sufficient reward or not.(n) To use the language of Lord *Cairns*, "It is not for the Committee to send back the accounts for further particulars, nor to dissect the accounts for the purpose of surmising what may be their real outcome if they were differently cast; it is for the applicant to bring his accounts before the Committee in a shape which will leave no doubt as to what the remuneration has been that he has received."(o)

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Quantum of
adequate remuneration.

Accounts to be
lodged by the
petitioner and
their require-
ments.

(f) Patterson's Patent, (1849) 6 Moo. P. C. 469; 13 Jur. 593.

(g) Thomas' Patent, (1892) 9 R. P. C. 372.

(h) Carmont's Patent, (1897) 14 R. P. C. 239.

(i) Judicial Committee Rules, (1898) r. 3; p. 732 *post*.

(k) Johnson's and Atkinson's Patents, (1873) L. R. 4 P. C. App. Cas. 87; Chatwood's Patent, (1874) L. R. 4 P. C. App. Cas. 88 n.

(l) Clark's Patent, (1870) L. R. 3

P. C. 421; 7 Moo. P. C. N. S. 255; Hill's Patent, (1863) 1 Moo. P. C. N. S.

258; 9 Jur. N. S. 1209; 9 L. T. N. S. 101.

(m) Judicial Committee Rules, (1898)

r. 3; p. 732 *post*.

(n) Saxby's Patent, (1870) L. R. 3

P. C. 292; 7 Moo. P. C. N. S. 82;

Clark's Patent, (1870) L. R. 3 P. C.

421; 7 Moo. P. C. N. S. 255; Wield's

Patent, (1871) L. R. 4 P. C. 89; 8 Moo.

P. C. N. S. 300.

(o) Saxby's Patent, (1870) L. R. 3

P. C. 295; 7 Moo. P. C. 82.

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If this requirement is not attended to carefully, the Committee will most probably refuse to grant the petitioner leave to amend the accounts, *(p)* and will dismiss the petition altogether; *(q)* and the petitioner will not as a rule be excused on the ground that he has kept no such accounts, or has destroyed his books. *(r)*

Absence of books of account may sometimes be explained.

In some cases—*e.g.*, in the case of fire—the absence of books of account may be satisfactorily explained, and an affidavit of want of profits will then be accepted; *(s)* but in the absence of such books of account, whether owing to destruction by fire or otherwise, and of a reasonable explanation of such absence, everything must be taken most strongly against the petitioner. *(t)* Thus, where a statement made in the prospectus of an assignee company would, if true, necessitate the conclusion that the patentee had received as adequate remuneration more than he admitted, in the absence of his books, which had been destroyed, prolongation was refused. *(u)*

Sometimes losses need not be proved with strict accuracy.

Under special circumstances, where the invention is of indisputable great merit, it may not be necessary to prove the petitioner's losses with the strict accuracy usually required. *(x)*

Manner in which a patentee should keep his accounts from the first.

The following passage from the decision of the Judicial Committee, delivered by Lord *Hobhouse* in *Lake's Patent*, *(y)* indicates the way in which the patentee should keep his accounts from the beginning and present them to the Committee:—

“In this case their Lordships have come to the conclusion that the petition must be dismissed because it is not shown, and on the materials before the Committee it cannot be shown with propriety on this occasion, that the patentee has not been adequately remunerated. In order to show that, the patentee should keep his accounts in a way which would enable the Crown Officers to whom they are produced and this Committee, and indeed members of the public, to form some judgment on the question whether he has or has not received adequate remuneration.”

(p) *Newton's Patent*, (1884) (4) 4 L. R. 9 App. Cas. 592; 1 R. P. C. 177; 52 L. T. 329; *Yates and Kellett's Patents*, (1887) 4 R. P. C. 150.

(q) *Adair's Patent*, (1881) L. R. 6 App. Cas. 176; 50 L. J. P. C. 68; *Saxby's Patent*, (1870) L. R. 3 P. C. 292; 7 Moo. P. C. N. S. 82; *Bett's Patent*, (1862) 1 Moo. P. C. N. S. 49; 9 Jur. N. S. 137; 7 L. T. N. S. 577.

(r) *Yates and Kellett's Patent*, (1887) L. R. 12 App. Cas. 149; 4 R. P. C. 150.

(s) *Hutchinson's Patent*, (1861) 14 Moo. P. C. 222; *Marwick's Patent*, (1860) 13 Moo. P. C. 310; *Lowe's Patent*, (1852) 10 Jur. 363.

(t) *Yates and Kellett's Patent*, (1887) L. R. 12 App. Cas. 147; 4 R. P. C. 150; *Lawrence's Patent*, (1892) 9 R. P. C. 85.

(u) *Lawrence's Patent*, (1892) 9 R. P. C. 85.

(x) *Darby's Patent*, (1891) 8 R. P. C. 380.

(y) (1891) 8 R. P. C. 228; see also *Hughes' Patent*, (1898) 15 R. P. C. 371.

neration ; and not only should the accounts be kept in such a form, but they should be produced before this Committee in such a shape that it does not require long and minute investigation of supplemental accounts in order to understand the result of them.

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for
Extension.

“The principle on both points has been stated very clearly on several occasions by this Committee. In *Bett's Patent*, so far back as the year 1862 it was stated that ‘there can be no difficulty in a patentee beginning from the first to keep a patent account distinct and separate from any other business in which he may happen to be engaged. He knows perfectly well that if his invention is of public utility, and he has not been adequately remunerated, he will have a claim for an extension of the original term of his patent. It is not, therefore, too much to expect that he should be prepared, when the necessity arises, to give the clearest evidence of everything which has been paid and received on account of the patent.’ That refers to the mode in which the accounts should be kept. In *Saxby's Patent* this Committee made some observations on the mode in which the accounts should be produced. Lord *Cairns*, in delivering the judgment, said: ‘It is the duty of every patentee, who comes for the prolongation of his patent, to take upon himself the onus of satisfying this Committee, in a manner which admits of no controversy, on what has been the amount of remuneration which in every point of view the invention has brought to him, in order that their Lordships may be able to come to a conclusion whether that remuneration may fairly be considered a sufficient reward for his invention or not. It is not for this Committee to send back the accounts for further particulars, nor to dissect the accounts for the purpose of surmising what might be their real outcome if they were differently cast. It is for the applicant to bring his accounts before the Committee in a shape which will leave no doubt as to what the remuneration has been that he has received.’”

Thus, where a company being assignees of a patent kept books on a wrong system for the first eight years of the patent, and the accounts furnished to the Committee included certain entries, amounting to a considerable sum, as corrections of the books, which could not be checked from the accounts themselves without an examination of the books, the Judicial Committee held that the accounts were insufficient, and refused to allow the petitioners to call evidence to explain them.^(z)

Effect of keep-
ing accounts
on a wrong
system.

The Judicial Committee are by statute (a) required, when

Committee
have regard to

(z) *Lake's Patent*, (1891) 8 R. P. C. 227 ; see also *Hughes' Patent*, (1898) 15 R. P. C. 370.

(a) 46 & 47 Vict. c. 57, s. 25, sub-s. 4.

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the profits
made by the
patentee as
such.

deciding the question of adequacy of remuneration, to "have regard to the profits made by the patentee as such"; accounts which do not show this are consequently defective. Thus where it appeared that the patentee had assigned to a company for a considerable sum, both his business and also the patent in question, together with another one, and the petitioning assignee company presented general accounts of their business which showed a considerable profit, but failed to show what the patentee had received in respect of the patent alone, or what profit had been made by the petitioning company from the patent alone apart from its general business, the Committee refused to recommend a prolongation on the ground that, upon the materials before them, they could not come to the conclusion that the patentee had been inadequately remunerated by the patent.(b)

Advisability of
striking a
balance at the
end of each
year's
accounts.

It is most material for the Judicial Committee to know in what ratio the profits have increased or diminished from year to year; therefore it is advisable for the petitioner to strike a balance at the end of each year's accounts.(c)

The Committee are required to have regard to all the circumstances of the case.(d)

Total remuneration actually derived from, or which could have been derived from the patent, is an important question; consequently assignee's or licensee's profits must be disclosed.

One question always is, What has been the total remuneration derived from the patent, or which could have been derived from the patent? Consequently, when the patent has become vested in an assignee—*e.g.*, a company—the Committee require a disclosure, not only of the assignee's profits, but also of all the profits derived by his predecessors in title,(e) and also, when licences have been granted, a disclosure of not only the royalties received by the patentee, but also, where possible, some evidence as to the profits made by the licensees.(f) A petition has been dismissed on the ground that the manufacturing profits due to the use of the invention by an assignee of a share in the patent and free licensee under it were not shown.(g)

Though it be clear that the patentee himself has received no profits, it is still a fatal defect if the accounts do not disclose the profits made by his assignees or licensees.(h)

(b) Williams and Robinson's Patent, (1896) 13 R. P. C. 550. Butsee Parson's Patent, (1898) 15 R. P. C. 357, where the patentee was not responsible for the difficulty.

(c) Perkin's Patent, (1845) 2 W. P. C. 16, 17.

(d) 46 & 47 Vict. c. 57, s. 25, sub-s. 4.

(e) Deacon's Patent, (1887) 4 R. P. C. 119.

(f) Trotman's Patent, (1866) L. R.

1 P. C. 123; 3 Moo. P. C. N. S. 488; Saxby's Patent, (1870) L. R. 3 P. C. 298; 7 Moo. P. C. N. S. 82; Hill's Patent, (1863) 1 Moo. P. C. N. S. 258, 268; 9 L. T. N. S. 101.

(g) Thomas' Patents, (1892) 9 R. P. C. 367; Barff and Bowers' Patent, (1895) 12 R. P. C. 383; (1895) L. R. App. Cas. 675.

(h) Lane Fox's Patent, (1892) 9 R. P. C. 411.

In *Pitman's Patent* (*i*) the Committee laid down the rule for their future guidance to the effect that they would consider a failure to make a full disclosure of everything relating to the patent—*e.g.*, particulars as to profits on foreign patents—as absolutely fatal to the petitioner. Further, it is to be noticed that the direction in the Act of 1883 to the effect that the Judicial Committee, in coming to a conclusion, “shall have regard to the profits made by the patentee as such,” (*k*) in effect, specifies one particular class of profits as absolutely necessary; but there is nothing in the section of the Act to suggest that the Committee shall not consider the profits in relation to the patent arising from other sources, and consequently the accounts must disclose all profits arising from the working of foreign patents, as was the practice before the Act of 1883. (*l*) The profits, if any, arising from the sale of articles made under the patent expressly for exportation abroad must also be disclosed. (*m*)

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for
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Rule in Pit-
man's patent.

It was formerly the practice of the Judicial Committee, previous to the Act of 1883, not to recommend the prolongation of a patent for an invention the subject of a prior foreign patent, which had expired before the hearing of the petition, on the ground that they had no authority to recommend such prolongation. (*n*) Where, however, a foreign inventor held an English patent and also foreign patents in respect of the invention, one of which, though of later date than his English patent, had expired, (*o*) or was about to expire, (*p*) the Committee, in the exercise of their discretion, refused to recommend a prolongation. When the inventor was an English-born subject, the practice was that his application should not be unduly prejudiced by the fact that a foreign patent of later date than his English patent had expired. (*q*)

Former prac-
tice with
regard to in-
ventions
patented
abroad.

The expiration of foreign patents does not affect the validity of English patents granted after January 1, 1884, (*r*) but it is submitted that, notwithstanding the repeal of former Acts by

Present prac-
tice with
regard to in-
ventions
patented
abroad.

(*i*) (1871) L. R. 4 P. C. 84.

(*k*) s. 25 (4).

(*l*) *Newton's Patent*, (1884) L. R. 9 App. Cas. 592; *Johnson's Patent*, (1871) L. R. 4 P. C. 82; *Adair's Patent*, (1881) L. R. 6 App. Cas. 178; *Pieper's Patent*, (1895) 12 R. P. C. 293.

(*m*) *Hardy's Patent*, (1849) 6 Moo. P. C. 441.

(*n*) *Bodmer's Patent*, (1853) 8 Moo. P. C. 282; *Aube's Patent*, (1854) 9 Moo. P. C. 43; *Blake's Patent*,

L. R. 4 P. C. 535; 9 Moo. P. C. N. S. 373.

(*o*) *Newton's Patent*, (1862) 15 Moo. P. C. 176; 9 Jur. N. S. 109; *Normand's Patent*, (1870) L. R. 3 P. C. 193; 6 Moo. P. C. N. S. 477.

(*p*) *Normand's Patent*, (1870) L. R. 3 P. C. 193; 6 Moo. P. C. N. S. 477.

(*q*) *Bett's Patent*, (1862) 1 Moo. P. C. N. S. 49; 9 Jur. N. S. 137; 7 L. T. N. S. 577.

(*r*) p. 333 *ante*.