

it is desirable, certain infringements contemplated may be excluded from its operation. Thus, when the defendant had before trial accepted orders for infringing machines, and the plaintiff at the trial elected to take an account of profits in lieu of damages, the defendant agreeing to bring into the account any machines then under order, the Court granted an injunction, and made it operate immediately, but suspended its operation as to orders then accepted but not executed till the hearing of appeal, if notice of appeal should be given within three days of the drawing up of the order.<sup>(f)</sup> But where the infringing machines had been ordered since the commencement of the action, though they were not completed before judgment, no stay of the injunction was allowed.<sup>(g)</sup>

Perpetual  
Injunction.

fringements  
may be  
exempted from  
injunction.

It is not usual for the Court to stay the injunction. In special and important cases, however, when it is obvious that, if an appeal which will be made, is successful, the injury caused to the defendant by the injunction continuing would be great, without any corresponding advantage to the plaintiff, the Court will suspend the operation of the injunction, and possibly also the taking of an account or inquiry as to damages pending the appeal.<sup>(h)</sup>

Stay of injunc-  
tion pending  
an appeal.

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

Injunction to  
restrain  
threatened  
infringements.

If a plaintiff, after having obtained an injunction, amends the specification, the injunction becomes inoperative, and in the event of fresh infringements by the defendant the plaintiff must proceed *de novo*.<sup>(l)</sup>

Injunction  
becomes in-  
operative if the  
specification is  
amended.

<sup>(f)</sup> Lyon v. Goddard, (1893) 10 R. P. C. 135; see also Ducketts v. Whitehead, (1895) 12 R. P. C. 191.

<sup>(g)</sup> Lyon v. Goddard (2), (1893) 10 R. P. C. 348.

<sup>(h)</sup> North British Rubber Co. v. Macintosh, (1894) 11 R. P. C. 489; Franklin, Hocking and Co. v. Fraser, (1885) 3 R. P. C. 7; Young v. Morris, (1894) 11 R. P. C. 214; National Opalite Glazed Brick and Tile Syndi-

cate v. Ceralite Syndicate, (1896) 13 R. P. C. 658.

<sup>(i)</sup> Frearson v. Loe, (1878) L. R. 9 Ch. D. 48; Dowling v. Billington, (1890) 7 R. P. C. 191; The Shoe Machinery Co. v. Cutlan, (1895) 12 R. P. C. 342; see also pp. 504, 516 *ante*.

<sup>(k)</sup> Dowling v. Billington, (1890) 7 R. P. C. 191.

<sup>(l)</sup> Dudgeon v. Thompson, (1879) L. R. 3 App. Cas. 34.

Perpetual Injunction.

Breach of injunction.

Motion for committal.

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

In all cases of motion for committal, where the liberty of the subject is involved the strictest proof is necessary, both as regards the fact of infringement(*n*) and proper and accurate compliance with the rules relating to service.(*o*) The copy of the order served must be accurate in every particular.(*p*) It is to be observed that there is a distinction between the procedure on attachment and committal. In the latter, which is the appropriate remedy when a defendant has done something which the Court has ordered him not to do and therefore applies to breach of an injunction in a patent case, service of the order is not absolutely necessary, and a defendant may be committed if the Court is satisfied that the order was brought to his knowledge, although not formally served upon him. In the case of attachment, which is the appropriate remedy where a defendant has failed to do something which the Court ordered him to do, the procedure requires the service of the order by producing the original or an office copy, and leaving an accurate copy with the person served.(*q*)

The following circumstances illustrate the necessity for accurate proof of the fact of infringement. An injunction was granted, and the defendant undertook to continue a previous undertaking not to part with infringing articles in his possession or under his control in this country, and the plaintiff on motion to commit failed to show that certain articles alleged to have been parted with, in breach of the undertaking, were, in fact, in the possession of, or under the control of, the defendant on the date on which the injunction was obtained, the Court refused an order for committal, but gave no costs, on the ground that the circumstances were suspicious and the plaintiff was justified in bringing on the motion.(*r*)

Breach of injunction

There may be cases in which a breach of an injunction of

(*m*) *Plimpton v. Spiller*, (1876) L. R. 4 Ch. D. 288; *Thompson v. Moore*, (1889) 6 R. P. C. 426, 445; *Farbenfabriken vorm F. Bayer v. Laporte*, (1894) 11 R. P. C. 190; *Lyon v. Goddard*, (1894) 11 R. P. C. 113.

(*n*) *Dick v. Haslam*, (1891) 8 R. P. C. 196; *Edison-Bell Phonograph Co. v. Smith*, (1894) 11 R. P. C. 164.

(*o*) R. S. C. 1883, Ord. lxvii. r. 1;

*Taylor v. Roe*, 68 T. R. 213; *re Evans*, 9 T. R. 109; *Hall v. Trigg*, (1897) L. R. 2 Ch. at p. 222.

(*p*) *Re Holt*, (1879) L. R. 11 Ch. D. 168.

(*q*) R. S. C. 1883, Ord. lxvii. r. 1; see also *re Holt*, (1879) L. R. 11 Ch. D. 168.

(*r*) *Edison-Bell Phonograph v. Smith*, (1894) 11 R. P. C. 164.

the Court is not only justifiable but a positive duty. Thus, *James*, L.J., in reference to a case in which the majority of the Court of Appeal confirmed an injunction restraining the master of a ship from using certain patented pumps, with which the ship was exclusively fitted, said: "In the absence of the owners it appears to me that the Court could not make a mandatory injunction as to the equipment of the ship. And, that being so, I cannot concur in granting an injunction to restrain the master from doing what it appears to me to be his plain duty to do. Whatever appliances there may happen to be on board, however they came there—pumps, anchors, fire extinguishers, stolen or not stolen, pirated or not pirated—it is his bounden duty to use them according to the exigencies of navigation for the safety of ship, cargo, and life. To the master when out at sea (injunction or no injunction) *salus navis est suprema lex*. And, for myself, I believe that a master would be practically as safe in disobeying an injunction under a pressing emergency as he would be in shooting a mutineer. And in my opinion, if a single life was lost through the master's neglect to use such appliances, the injunction would be no defence to an indictment for manslaughter."<sup>(s)</sup>

**Perpetual Injunction.**

may under certain circumstances be justifiable.

It is doubtful whether, on a motion for sequestration against a company and committal against the directors for breach of a perpetual injunction, the Court has power to order an account of profits or the delivering up of the infringing articles.<sup>(t)</sup>

It is a complete answer to a motion for committal for breach of a perpetual injunction restraining infringements of a patent to show that, since the injunction, the patent has expired, and that the acts complained of were done subsequently to such expiration,<sup>(u)</sup> or that, since the injunction was granted, the specification has been amended and so the injunction has become inoperative.<sup>(v)</sup>

Expiry of the patent is an answer to a motion for committal.

When the defendant after injunction does something different to what he did before injunction, and the plaintiff wishes to restrain him on the ground that in the opinion of the plaintiff it is an infringement, the usual way to raise the question is by motion to commit.<sup>(y)</sup> In one such case, where it appeared that the article complained of was

Acts done since injunction granted, which are different in nature though similar to those in respect of which the injunction was granted.

<sup>(s)</sup> *Adair v. Young*, (1879) L. R. 12 Ch. D. 21; *Basset v. Graydon*, (1897) 14 R. P. C. 701.

<sup>(t)</sup> *Spencer v. The Ancoats Vale Rubber Co.*, (1889) 6 R. P. C. 67.

<sup>(u)</sup> *Daw v. Ely*, (1867) L. R. 3 Eq. 497.

<sup>(v)</sup> *Dudgeon v. Thompson*, (1879) L. R. 3 App. Cas. 34.

<sup>(y)</sup> *Plimpton v. Spiller*, (1877) L. R. 4 Ch. D. 286; *Lancashire Explosives Co. v. Roburite Explosives Co.*, (1896) 13 R. P. C. 435.

Account or  
Damages—  
General.

different from that in respect of which the injunction was originally granted, the Court, being of opinion that the new article was also an infringement, but not deciding the question, did not make an order for committal, but upon the plaintiff giving an undertaking as to damages granted an injunction restraining the manufacture of the new article until further order, and this course was subsequently approved of by the Court of Appeal.<sup>(z)</sup> And in another case<sup>(a)</sup> the Court dismissed the motion with costs on the ground that what the defendant did was no infringement.

Contempt of  
Court.

It is not a contempt of Court to publish, after a judgment has been obtained, advertisements asking for evidence of the anticipation and publication of the subject-matter of the patent,<sup>(b)</sup> or for subscriptions towards the expenses of an appeal.<sup>(c)</sup> But it is a contempt for either party by advertisements to issue a representation of an *ex parte* statement of proceedings in Court for the purpose of his own profit.<sup>(d)</sup>

Solicitor and  
client's costs.

Solicitor and client's costs may, on a motion to commit for breach of an injunction, be given to a successful plaintiff,<sup>(e)</sup> but not to a successful respondent.<sup>(f)</sup>

Where it appeared that the acts complained of had not been done vexatiously, but in the probable belief—an erroneous one—that the defendants were entitled to do what they did, solicitor and client's costs were refused, but costs on the higher scale were given.<sup>(g)</sup>

#### ACCOUNT OR DAMAGES.

Account or  
damages may  
be awarded to  
a successful  
plaintiff,

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

but he cannot  
have both  
against

An inquiry as to damages and an account of profits are not reconcilable, for, if an account be taken of profits, the infringe-

<sup>(z)</sup> *Plimpton v. Spiller*, (1876) L. R. 4 Ch. D. 286.

<sup>(a)</sup> *Lancashire Explosives Co. v. Roburite Explosives Co.*, (1896) 13 R. R. C. 435.

<sup>(b)</sup> *Plating Co. v. Farquharson*, (1881) L. R. 17 Ch. D. 49.

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

<sup>(d)</sup> *Edlin v. Pneumatic Tyre and Brook's Cycle Agency* (2), (1893) 10 R. P. C. 317.

<sup>(e)</sup> *Plating Co. v. Farquharson*, (1881) L. R. 17 Ch. D. 49.

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

<sup>(g)</sup> *Spencer v. The Ancoats Vale Rubber Co.*, (1889) 6 R. P. C. 46, 68.

ment is thereby condoned.<sup>(h)</sup> A plaintiff therefore cannot have both an account and damages against the same defendant; he must choose one or the other,<sup>(i)</sup> and this rule applies to every case of infringement.<sup>(k)</sup>

Account or  
Damages—  
General.

the same  
defendant,  
though he may  
have an  
account  
against one  
defendant and  
damages  
against  
another.

As regards different defendants to the same action, or to consolidated actions, the plaintiff may have an account of profits against one of such defendants and damages against the other.<sup>(l)</sup> It has never been held that an account directed against a manufacturer of a patented article licenses the use of that article in the hands of all purchasers. The patent is a continuing patent, and there is no reason why the article should not be followed in every man's hand, until the infringement is got rid of. So long as the article is used, there is continuing damage.<sup>(m)</sup>

When the action is brought in the early days of the patent, before the patentee has established a course of dealing in the patented article, the successful plaintiff would probably prefer an account of profits, because of the difficulty he would, under such circumstances, have in showing the damage he has sustained by the wrongful acts of the defendant. On the other hand, as a rule, when the plaintiff has an established course of business in the patented article, it is more to his interest to elect to take damages in lieu of an account of profits, because of the great difficulty there always is in taking the account of profits due to the infringement of patent rights. Thus *Lindley, L.J.*, in *Siddell v. Vickers*,<sup>(n)</sup> in stating his experience in matters of account, used the following words of warning: "I do not know any form of account which is more difficult to work out, or may be more difficult to work out, than an account of profits. One sees it—and I personally have seen a good deal of it—in partnership cases, when the capital of a deceased or outgoing partner has been left in the trade; an account has been directed of the profits made in respect of capital, which is something like the profits made in respect of an invention, and the difficulty of finding out how much profit is attributable to any

When damages  
are preferable  
to an account  
of profits, and  
vice versa.

<sup>(h)</sup> *Neilson v. Betts*, (1871) L. R. 5 H. L. 22, per Lord Westbury.

<sup>(i)</sup> *Neilson v. Betts*, (1871) L. R. 5 H. L. 22; *Watson v. Holliday*, (1882) 30 W. R. 747; *Siddell v. Vickers*, (1892) 9 R. P. C. 153, 162.

<sup>(k)</sup> *De Vitre v. Betts*, (1873) L. R. 6 H. L. 319; *Vidi v. Smith*, (1854) 3 E. & B. 969; *Holland v. Fox*, (1854) 3 E. & B. 977.

<sup>(l)</sup> *Penn v. Bibby*; *Penn v. Fernie*,

(1866) L. R. 3 Eq. 308; 36 L. J. Ch. 277; *United Telephone Co. v. Walker*, (1887) 4 R. P. C. 67; *Boyd v. Tootle Broadhurst, & Co.*, (1894) 11 R. P. C. 175.

<sup>(m)</sup> Per Page Wood, V.C., *Penn v. Bibby*, *Penn v. Jack*, *Penn v. Fernie*, (1866) L. R. 3 Eq. 308; 36 L. J. Ch. 277.

<sup>(n)</sup> (1892) 9 R. P. C. 162.

**Account or Damages—General.** one source is extremely great—so great that accounts in any form very seldom result in anything satisfactory to anybody. The litigation is enormous, the expense great, and the time consumed is out of all proportion to the advantage ultimately attained; so much so that in partnership cases, I confess, I never knew an account in that form worked out with satisfaction to anybody. I believe in almost every case people get tired of it, and get disgusted. Therefore, although the law is that a patentee has a right to elect which course he will take, as a matter of business he would generally be inclined to take an inquiry as to damages rather than launch upon an inquiry as to profits.”(o)

**Distinction between an account of profits and an inquiry as to damages.**

There is a well-marked distinction between an account of profits and an inquiry as to damages, which must not be lost sight of in dealing with particular cases, and which arises from the fact that there is no necessary relationship between the two. Thus in some cases the greater the profit made by the infringer the less may be the damages sustained by the patentee, and in other cases the less the profit accruing to the infringer the greater the damage inflicted upon the patentee, *e.g.*, where the infringer undersells the patentee he may be satisfied with a very small profit with the object of ultimately getting the trade in his own hands, but the damage thereby inflicted upon the patentee may be very great.(p)

**Order by agreement for payment of a proper royalty is sometimes preferable to an account or damages.**

Where a plaintiff is not desirous of taking an inquiry as to damages it is sometimes well for the parties to agree to an order for an inquiry as to what would be a proper royalty, and that such sum should be accepted in lieu of damages. Such a course may save endless expense and time as against an account of profits in the ordinary way.(q)

**Effect of delay in bringing the action.**

An unexplained delay in bringing action may affect a plaintiff's right to an account of profits, or damages,(r) by barring the right altogether,(s) or limiting it to an account of profits, made since the commencement of the action,(t) for it is a principle of equity that a party who claims a right shall not lie by, and, by his silence or acquiescence, induce another to go on expending his

(o) See also *Crossley v. Derby Gas Co.*, (1829) 1 W. P. C. 119; *Automatic Coal Gas Retort Co. v. Mayor, &c., of Salford*, (1897) 14 R. P. C. 471.

(p) Per Chitty, J., *Howard v. Tweedales*, (1896) 13 R. P. C. 214.

(q) *Automatic Coal Gas Retort Co. v. Mayor, &c., of Salford*, (1897) 14 R. P. C. 471.

(r) *Crossley v. Derby Gas Co.*, (1829) 1 W. P. C. 120; *Harrison v. Taylor*, (1865) 11 Jur. N. S. 408; *Sayers v. Collyer*, (1885) L. R. 28 Ch. D. 103.

(s) *Crossley v. Derby Gas Co.*, (1829) 1 W. P. C. 120; *Harrison v. Taylor*, (1865) 11 Jur. N. S. 408.

(t) *Sayers v. Collyer*, (1885) L. R. 28 Ch. D. 103.

money and incurring risk, and afterwards, if profit be made, come and claim a share in that profit without having been exposed to the losses which might have been sustained. *(u)* **Account or Damages—General.**

An account of profits or an inquiry as to damages may now be had, notwithstanding the fact that the action is commenced or judgment is delivered after the expiration of the patent, and the plaintiff is, therefore, not entitled to an injunction. *(x)* Formerly the right to an account or damages was ancillary to the right to an injunction, and if an injunction could not be granted, *e.g.*, if the patent had expired before, *(y)* or during, *(z)* the litigation, or there was no evidence of any intention on the part of the defendant to repeat the infringement, *(a)* the plaintiff could not have an account, *(b)* except in the case of fraud. *(c)* Lord Cairns' Act empowered the Court of Chancery to award damages, and any division of the High Court is now entitled to award damages or grant an account of profits independently of any right on the part of the plaintiff to an injunction; *(d)* and it would appear that the Court of the County Palatine of Lancaster has now a similar jurisdiction. *(e)*

When an account of profits or an inquiry, as to damages is ordered the account or the inquiry, in the absence of provision to the contrary, goes up to the date of the assessment, if the cause of action is a continuing one, as the infringement of a subsisting patent is; *(f)* and articles manufactured for export must be brought into the inquiry. *(g)* **Account of profits or inquiry as to damages usually goes up to the assessment.**

As a rule, where a plaintiff has become possessed of the patent by assignment, the assessment is only ordered from the date of the registration of the assignment. *(h)* **Assessment where the plaintiff is an assignee.**

But where it appeared that the plaintiffs had taken over a business and certain patents, and succeeded to the rights of their predecessors, they were held to be entitled, in estimating the

*(u)* Crossley *v.* Derby Gas Co., (1829) 1 W. P. C. 120.

*(x)* 21 & 22 Vict. c. 27, s. 2; 36 & 37 Vict. c. 66, s. 16; Betts *v.* Gallais, (1870) L. R. 10 Eq. 392; R. S. C. (1883) Ord. xv. r. 1; York *v.* Stowers, (1883) W. N. p. 174.

*(y)* Smith *v.* G. W. Ry. Co., (1854) Macr. P. C. 209; S. C. Kay 417.

*(z)* Price's Patent Candle Co. *v.* Bauwen's Patent Candle Co., (1858) 4 K. & J. 727; but see Fox and Dellestable, (1866) 15 W. R. 194.

*(a)* Proctor *v.* Bayley, (1889) 6 R. P. C. 538.

*(b)* Smith *v.* G. W. Ry. Co., (1854) Macr. P. C. 203; Price's Patent Candle

Co. *v.* Bauwen's Patent Candle Co., (1858) K. & J. 727.

*(c)* Crossley *v.* Derby Gas Co., (1829) 1 W. P. C. 119.

*(d)* R. S. C. (1883) Ord. xv. r. 1; York *v.* Stowers, (1883) W. N. 174.

*(e)* 53 & 54 Vict. c. 23, s. 3; 21 & 22 Vict. c. 27; 36 & 37 Vict. c. 66, s. 16.

*(f)* R. S. C. (1883) Ord. xxxvi. r. 58; Fritz *v.* Hobson, (1880) L. R. 14 Ch. D. 542. As to ascertainment of damages in Queen's Bench Division, see R. S. C. (1885) Ord. xxxvi. r. 57.

*(g)* Lyon *v.* Goddard, (1894) 11 R. P. C. 113.

*(h)* Ellwood *v.* Christy, (1865) 18 C. B. N. S. 494.

**Account or Damages—General.** damages and loss of sales consequent on the competition of the defendants, to take into account the total quantities sold by the defendants before the plaintiffs acquired such business.(i)

Assessment does not extend to infringements committed within certain periods.

The account of profits or inquiry as to damages does not include anything due to infringements committed within certain periods of time unless the Court otherwise directs, viz.:—

- (1) Infringements prior to the publication of the complete specification.(k)
- (2) Infringements prior to an amendment of the specification, unless the Court is satisfied that the original claim was framed in good faith and with reasonable skill and knowledge.(l)
- (3) Infringements committed after a failure to make any payment in respect of keeping the patent on foot within the prescribed time and before the enlargement thereof.(m)

Time within which amount found due is to be paid.

The order for the account or inquiry as the case may be, usually states the time within which the amount found due must be paid after it has been duly certified ;(n) but sometimes the time within which such payment is to be made is reserved for further consideration,(o) and the costs of taking the account or instituting the inquiry are usually so reserved.(p)

Disclosure by the defendant of number of infringing articles sold and names and addresses of his customers and also prices.

On an account of profits or an inquiry as to damages the defendant must disclose the number of the infringing articles he has made, and the names and addresses of the persons to whom and the prices at which he has sold them, in spite of the fact that he thereby exposes his customers to attack from the plaintiff, and himself to a consequent loss of trade.(q)

(i) *United Horseshoe and Nail Co. v. Stewart*, (1888) L. R. 13 App. Cas. 401, 417.

(k) pp. 503 *ante*, 644 *post*.

(l) pp. 271 *ante*, 646 *post*; 46 & 47 Vict. c. 57, s. 20. *Semble* this section would include an account of profits as well as damages. In *Wenham Gas Co. v. Champion Gas Lamp Co.*, (1890) 7 R. P. C. 313, the inquiry was limited to damages in respect of infringements since the date of amendment. In *Hopkinson v. St. James's Electric Lighting Co.*, (1893) 10 R. P. C. 43, an account of profits was allowed from the date of the patent, the patentee having stated in evidence that he had framed the original claim in good faith with reasonable skill and knowledge.

(m) 46 & 47 Vict. c. 57, s. 17, sub-s. 4 (b); p. 645 *post*.

(n) *Westinghouse v. Lancashire and*

*Yorkshire Ry. Co.*, (1884) 1 R. P. C. 253; 11 W. R. 852; *Young v. Fernie*, *Bovill v. Crate*, *Needham v. Oxley*, *Cunningham v. Colling*, *Seton*, 4th ed. p. 355.

(o) *Hocking v. Fraser*, (1886) 3 R. P. C. 7; *Betts v. Noel*, *Seton* 4th ed. p. 355; *Davenport v. Rylands*, (1865) L. R. 1 Eq. 302; *Pemberton*, 4th ed. p. 484.

(p) *United Telephone Co. v. Fleming*, (1886) 3 R. P. C. 268; *United Telephone Co. v. Patterson*, (1889) 6 R. P. C. 145.

(q) *Murray v. Clayton*, (1872) L. R. 15 Eq. 115; *American Braided Wire Co. v. Thompson* (2), (1888) 5 R. P. C. 375; *United Telephone Co. v. Walker*, (1887) 4 R. P. C. 66; *Leather-Cloth Co. v. Hirschfield*, (1863) 1 H. & M. 295; *Adair v. Young*, (1879) L. R. 11 Ch. D. 136; 12 Ch. D. 13; *Powell v. Birmingham Vinegar Brewery Co.*, (1896) 14 R. P. C. 1.



The very object for which the plaintiff desires the names of the defendant's customers may be to enable him to follow the infringing articles in the hands of such customers.

Account or  
Damages—  
Account.

**Account.**—When the plaintiff elects to take an account of profits he establishes a different relationship between himself and the defendant to that which exists between them on an inquiry as to damages. In the former case by electing to take an account of profits he condones the infringement,<sup>(r)</sup> and adopts that which was done by the defendant,<sup>(s)</sup> and claims for himself the profits made by the infringer from the use of the invention; in the latter case the defendant is treated all through the inquiry as a wrongdoer. Thus by electing to take an account it may be said that the plaintiff constitutes the defendant his agent as regards the acts whereby he, by the use of the invention, has made a profit or the reverse, and the question always is what in profit or loss was the result of the course of conduct actually pursued by the defendant, and not what might have been the profit had he pursued a different line of conduct. Consequently, the plaintiff is not entitled to an account of, and compensation for, the actual losses he may have sustained through the wrongful acts of the defendant; he is only entitled to an account and payment over to him of the actual profits, if any, derived from the defendant's use of the invention,<sup>(t)</sup> and, if the defendant has made profit by the illegal use of the patented invention, the fact that he might have made a profit otherwise—*e.g.*, by the sale of articles not manufactured by a machine the subject-matter of the patent—is quite immaterial.<sup>(u)</sup> The true test of comparison is to take the ratio of the profit derived when the invention was used with the profit which would have been derived had the defendant used that which, looking at all the circumstances of the case, he would most probably have used had he not illegally adopted the invention.<sup>(x)</sup>

Difference in  
relationship of  
the plaintiff to  
the defendant  
on the taking  
of an account  
to that which  
exists between  
them on an  
inquiry as to  
damages.

On the taking of the account the defendant may be compelled to disclose the profits arising from his business before he commenced to manufacture the articles to which the patent refers by the application of the patented process or machine, as well as since, if such information is necessary to put the Court in a

Profits of  
defendant's  
business before  
infringement  
as well as  
since.

<sup>(r)</sup> Neilson *v.* Betts, (1871) L. R. 5 H. L. 22.

<sup>(s)</sup> American Braided Wire Co. *v.* Thompson, (1890) 7 R. P. C. 158.

<sup>(t)</sup> Ellwood *v.* Christy, (1865) 18 C. B. N. S. 494.

<sup>(u)</sup> United Horseshoe and Nail Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 401.

<sup>(x)</sup> Siddell *v.* Vickers, (1892) 9 R. P. C. 152.

**Account or Damages—Account.** position to estimate what proportion of the total profits made by him since the commencement of the infringement is due to his wrongful acts. (*y*)

**Extent of account of profits.**

An inquiry as to profits made by an infringer extends to all profits, including those which accrued since the defendant became aware of the plaintiff's claim to the patent, as well as those which accrued before he became aware of such claim. (*z*)

The account also extends, not merely to the profits made by the sale of the pirated article, but also to all profits incidentally derived from its use. For example, where a defendant was sued for the infringement of a patent for gas-meters, and was ordered to account for profits made by him, the account was made to include the benefit derived by way of saving effected by the use of the piratical gas-meters. (*a*)

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

**Production of books and administration of interrogatories.**

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

**Bankruptcy of defendant.**

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

**Plaintiff in the habit of supplying on royalty articles consisting of patented and non-patented parts.**

Where the plaintiff is in the habit of supplying to his customers a complete instrument at a fixed royalty, and that instrument consists of patented and non-patented parts, it is proper, in estimating the amount to which he is entitled, to deduct from the royalty a sum in consideration of the non-patented portion of the infringing instrument. (*f*) Consequently, where the plaintiff elects to claim profits made by an unauthorised use of his invention it becomes material to ascertain how much of it was actually appropriated, in order to determine

(*y*) *Siddell v. Vickers*, (1889) 6 R. P. C. 464.

(*z*) *Davenport v. Rylands*, (1865) L. R. 1 Eq. 302, 308; *United Horse-shoe and Nail Co. v. Stewart*, (1888) L. R. 13 App. Cas. 401.

(*a*) *Crossley v. Derby Gaslight Co.*, (1829) 1 W. P. C. 119; see also *Houshill Co. v. Neilson*, (1843) 1 W. P. C. 697 n.

(*b*) *Bacon v. Spottiswoode*, (1839) 1 Beav. 382.

(*c*) *Bergmann v. McMillan*, (1881) L. R. 17 Ch. D. 423; *Sanitas Co. v. Condy*, (1887) 4 R. P. C. 530.

(*d*) *Saxby v. Easterbrook*, (1872) L. R. 7 Ex. 207.

(*e*) *Watson v. Holliday*, (1882) 30 W. R. 747; 31 W. R. 536; 52 L. J. Ch. 543; *Bankruptcy Act*, (1883) s. 37.

(*f*) *United Telephone Co. v. Walker*, (1887) 5 R. P. C. 61, 63.

what proportion of the net profits realised by the infringer was attributable to the use of the plaintiff's invention.<sup>(g)</sup>

**Damages.**—Before Lord *Cairns'* Act there was no jurisdiction in the Court of Chancery to give damages, and the old form of decree always gave the plaintiff an account of profits, but after Lord *Cairns'* Act jurisdiction was conferred on the Court to give damages, and in *Hills v. Evans* <sup>(h)</sup> Lord *Westbury* pronounced a decree giving the plaintiff both damages and profits, which course was held to be wrong in *Neilson v. Betts* <sup>(i)</sup> and *De Vitre v. Betts*,<sup>(k)</sup> in which the House of Lords settled finally that the successful plaintiff in an action of infringement of a patent is entitled, at his election, to damages or an account of profits, but not to both, which is the state of the law now,<sup>(l)</sup> and this relief may be obtained in either division of the High Court,<sup>(m)</sup> or in the Court of the County Palatine of Lancaster.<sup>(n)</sup>

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

The rate at which the plaintiff has accepted compensation for damages from non-litigants does not govern the assessment of the amount recoverable by action from the defendant.<sup>(p)</sup>

The measure of damages to which a successful plaintiff is entitled is the actual loss sustained by him by reason of the unlawful acts of the defendant, which loss must be the natural and direct consequence of the defendant's acts,<sup>(q)</sup> *i.e.*, the question is by how much would the plaintiff have been better off if there had been no infringement.<sup>(r)</sup> The plaintiff is not entitled to receive anything in respect of the annoyance and vexation he experiences from the necessity of having to establish his right in a Court of law, the award of the costs of the action being the only way the Court will attempt to recompense him in respect of such annoyance and vexation.<sup>(s)</sup>

<sup>(g)</sup> *United Horseshoe and Nail Co. v. Stewart*, (1888) L. R. 13 App. Cas. 412.

<sup>(h)</sup> (1862) 4 De G. F. & J. 288.

<sup>(i)</sup> (1871) L. R. 5 H. L. 1; 40 L. J. Ch. 317.

<sup>(k)</sup> (1873) 6 H. L. 319; 21 W. R. 705.

<sup>(l)</sup> Per Lindley, L.J., *Siddell v. Vickers*, (1892) 9 R. P. C. 162.

<sup>(m)</sup> p. 601 *ante*. <sup>(n)</sup> p. 601 *ante*.

<sup>(o)</sup> *Dicks v. Brooks*, (1880) L. R. 15 Ch. D. 39; *United Telephone Co. v. Sharples*, (1885) 2 R. P. C. 28; *Sanitas*

*Co. v. Condy*, (1887) 4 R. P. C. 530; *Cole v. Saqui*, (1888) 5 R. P. C. 489, 496.

<sup>(p)</sup> *Boyd v. Tootal Broadhurst, &c., Company*, (1894) 11 R. P. C. 175.

<sup>(q)</sup> *United Telephone Co. v. Walker*, (1887) 4 R. P. C. 67.

<sup>(r)</sup> *Boyd v. Tootal Broadhurst, &c., Co.*, (1894) 11 R. P. C. 175; *Penn v. Jack*, (1867) L. R. 5 Eq. 81; 37 L. J. Ch. 136.

<sup>(s)</sup> *United Horseshoe and Nail Co. v. Stewart*, (1888) L. R. 13 App. Cas. 401, 416; 5 R. P. C. 260.

Account or  
Damages—  
Damages.

Damages in  
lieu of an  
account of  
profits.

Assessment is  
not affected by  
amount  
accepted from  
non-litigants.

Measure of  
damages.

Account or  
Damages—  
Damages.

From the above it is clear that it is important to establish what is the plaintiff's usual course of dealing with the invention, *e.g.*, the price at which he usually sells the patented article, or the amount of royalties he generally accepts from licensees authorised to use the invention.

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

Reduction of  
price by the  
plaintiff.

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

<sup>(t)</sup> *Davenport v. Rylands*, (1865) L. R. 1 Eq. 308.

<sup>(u)</sup> *United Horseshoe and Nail Co. v. Stewart*, (1888) L. R. 13 App. Cas. 401, 413, 417; *Ellwood v. Christy*, (1865) 18 C. B. N. S. 494; *Penn v.*

*Jack*, (1866) L. R. 5 Eq. 81; *Alexander v. Henry*, (1895) 12 R. P. C. 360.

<sup>(x)</sup> *United Horseshoe and Nail Co. v. Stewart*, (1888) L. R. 13 App. Cas. 401; 5 R. P. C. 260.

But when it can be shown that the plaintiff has not reduced his price below that of the infringing defendant, and that the plaintiff's reduction has been consequent upon the defendant's, the Court, in estimating the amount of damages, will consider that the plaintiff, but for the defendant's wrongful acts, would have made all the sales effected by the defendant at the original and not at the lowered price.<sup>(y)</sup> A reduction, however, may be allowed to the defendant in consideration of the increase of sales by reason of the diminution of price, as also by reason of his business connection.<sup>(z)</sup>

Account or  
Damages—  
Damages.

When the patentee of machinery, who does not grant licences, claims damages from an infringing manufacturer who competes with him by selling the same class of goods as those made by the patented machine and in the same market, the profit made by the infringer is of no consequence. However large his gains, he is only liable in nominal damages so long as his illegal sales do not injure the trade of the patentee; and however great his loss he cannot escape from liability to make full compensation for the injury which his competition may have occasioned. Every sale of goods manufactured without licence by patented machinery is, and must be, treated as an illegal transaction in a question with the patentee; and its inherent illegality is not affected by the circumstance that the infringement consisted in using a small and, it may be, the least useful part of the invention.<sup>(a)</sup>

Damages when  
it is not the  
plaintiff's usual  
course of busi-  
ness to grant  
licences.

When it is the plaintiff's usual course of business to grant licences, the measure of damage becomes the loss of royalties sustained by him through the defendant's acts; that is to say, the profit rent and royalties for the entire period during which the infringing article was in the hands of the defendant, whether it was or was not in use during the whole of that time.<sup>(b)</sup>

Damages when  
it is the plain-  
tiff's usual  
course of busi-  
ness to grant  
licences.

And where the plaintiff is in the habit of granting licences he cannot claim by way of damages a manufacturing profit, or any sum beyond the ordinary royalty; moreover, he will not be entitled to recover anything from the manufacturer if he has received the full royalty from the user.<sup>(c)</sup> And further it

<sup>(y)</sup> American Braided Wire Co. v. Thompson, (1890) 7 R. P. C. 47, 152; (1890) W.N. 68; L. R. 44 Ch. D. 274; Alexander v. Henry, (1895) 12 R. P. C. 360.

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

<sup>(a)</sup> Per Lord Watson, United Horse-shoe and Nail Co. v. Stewart, (1888) L. R. 13 App. Cas. 413; 5 R. P. C. 267.

<sup>(b)</sup> United Telephone Co. v. Walker, (1889) 4 R. P. C. 63; English and American Machinery Co. v. Union Boot and Shoe Machine Co., (1895) 13 R. P. C. 64.

<sup>(c)</sup> Penn v. Jack, (1867) L. R. 5 Eq. 81.

**Account or Damages— Damages.** cannot always be taken for granted that the licences which it is presumed the plaintiff would have granted, had the defendant not infringed, would have been in force till the expiration of the patent; with regard to the duration of such supposed licences, the Court must make the best estimate it can, having regard to all the circumstances of the case, *e.g.*, the average duration of licences granted by the plaintiff about the time the defendant's acts were committed. (*d*)

A patentee who has obtained an injunction cannot be compelled to accept from an infringer desirous of continuing the use of the invention the same royalties he accepts from other and licensed users. (*e*)

Damages may be recovered either against a manufacturer or a user, or both, until the full amount has been recovered.

Damages for infringement may be recovered against either a manufacturer or a user, or both, until the full measure of damage which is the total loss of the profit which the plaintiff would have made had the infringing machine been supplied by him has been recovered. (*f*)

For example, if a patentee obtains an injunction and damages against an infringing manufacturer, and the manufacturer does not pay the damages, it is open to the patentee to claim from a purchaser of the manufacturer what is due to him by way of damages in respect of the purchase of infringing machines; (*g*) and the acceptance by the plaintiff of agreed damages from an infringing manufacturer of the patent article in respect of his wrongful acts, does not preclude the plaintiff from following the article in the hands of a purchaser from such manufacturer and claiming damages from him, for the payment of agreed damages by the manufacturer does not make the article "free" in the hands of a purchaser. (*h*) A plaintiff's right to damages against a defendant user is not affected by the fact that the user had no notice of the patent; (*i*) such a user cannot be heard to say that, if he had had notice of the patent, he might have bought articles other than those which infringe the patent and which would have done as well for him. (*k*)

(*d*) *English and American Machinery Co. v. Union Boot and Shoe Machinery Co.*, (1895) 13 R. P. C. 64.

(*e*) *Penn v. Bibby*, (1866) L. R. 3 Eq. 310, 312; *Penn v. Jack*, (1867) L. R. 5 Eq. 81.

(*f*) *Penn v. Bibby*, (1866) L. R. 3 Eq. 308; *Penn v. Jack*, (1867) L. R. 5 Eq. 81; *United Telephone Co. v. Walker*, (1889) 4 R. P. C. 63; *United Horseshoe and Nail Co. v. Stewart*, (1888) L. R. 13 App. Cas. 401; *American*

*Braided Wire Co. v. Thompson*, (1890) 7 R. P. C. 47, 152; *Boyd v. Tootal Broadhurst, & Co.*, (1894) 11 R. P. C. 175.

(*g*) *Cropper v. Smith*, (1883) L. R. 24 Ch. D. 305, 312.

(*h*) *United Telephone Co. v. Walker*, (1887) 4 R. P. C. 63, 67.

(*i*) *Boyd v. Tootal Broadhurst, & Co.*, (1894) 11 R. P. C. 147.

(*k*) *Ibid.*

In cases where it appears that the defendant has infringed during the interval between a former decision adverse to the validity of the patent and its reversal on appeal, and further, that the defendant's wrongful acts were committed on the strength of that former decision, it is submitted that the defendant would be allowed to give evidence on this point in reduction of damages.<sup>(l)</sup>

**Destruction or Delivery up of Infringing Articles.**

It is open to question whether a Judge of the Chancery Division has jurisdiction to order an inquiry as to damages to be referred to a Judge and jury.<sup>(m)</sup>

Damages in respect of infringements committed on the strength of a judgment adverse to the patent.

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

Reference of inquiry to a Judge and jury.

Costs of a former discontinued action.

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

Omission to ask for damages at the trial.

#### DESTRUCTION OR DELIVERY TO PLAINTIFF OF INFRINGING ARTICLES.

In addition to an injunction restraining the defendant from infringing the patent in future, and an account of profits or damages at his option, a successful plaintiff in an action for infringement may under the present practice obtain an order of the Court directing an inquiry as to how many of the infringing articles are in the possession of the defendant, and ordering further that all such articles shall be destroyed in the presence of the plaintiff or delivered up to him,<sup>(p)</sup> or that they shall be

Power of the Court to order the destruction or delivery to the plaintiff of infringing articles.

<sup>(l)</sup> pp. 503, 504 *ante*; *Arkwright v. Nightingale*, (1785) 1 W. P. C. 61.

<sup>(m)</sup> *American Braided Wire Co. v. Thompson*, (1888) 5 R. P. C. 696.

<sup>(n)</sup> *United Telephone Co. v. Tasker*, (1889) 6 R. P. C. 38.

<sup>(o)</sup> *Edison v. Holland*, (1888) 5 R. P. C. 483.

<sup>(p)</sup> *Betts v. De Vitre*, (1865) 34 L. J. Ch. 289, 291; S. C. 11 Jur. N. S. 9, 217; *Seton*, 4th ed. p. 354; *Washburn*

and *Moen Manufacturing Co. v. Patterson*, (1884) 1 R. P. C. 157, 162; *Tangye v. Stott*, (1865) 14 W. R. 386; *Frearson v. Loe*, (1878) L. R. 9 Ch. D. 48, 67; *Otto v. Steel*, (1886) 3 R. P. C. 109, 120; *Emperor of Austria v. Day*, (1861) 3 De G. F. & J. 217; *Young v. Fernie*, (1866) L. R. 1 H. L. 63; *Pemberton* 4th ed. p. 484; *Edison v. Holland*, (1888) 5 R. P. C. 483.

**Destruction or Delivery up of Infringing Articles.**

delivered up or destroyed.<sup>(q)</sup> It is to be observed that the practice of the Court in granting orders for the delivering up or destruction of the defendant's goods is of modern growth and does not rest upon any statutory penalty of forfeiture for infringement. No forfeiture of goods can rest upon a grant of letters patent.<sup>(r)</sup> It would appear doubtful whether the Court has jurisdiction to make an order for the delivering up of the defendant's goods to the plaintiff, and it may very well be that a defendant whose goods are compulsorily taken or destroyed by the plaintiff, though under an order of the Court, has a right of action under s. 4 of the Statute of Monopolies in respect of an illegal forfeiture. The question does not appear to have been discussed in any of the decided cases where the Court has made an order for destruction or delivery up, and there is much to be said in favour of the right of action above referred to.<sup>(s)</sup>

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

Form of order.

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

When an infringing article is composite.

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

Under the following circumstances, an order for delivery up was refused:—The infringing machines consisted of two distinct parts, one of which was an infringement of the patent, and the other was not; the machines had been manufactured

<sup>(q)</sup> *Badische Anilin und Soda Fabrik v. Levinstein*, (1883) L. R. 24 Ch. D. 176; *Plimpton v. Malcolmson*, Seton, 4th ed. p. 354.

<sup>(r)</sup> *Waltham v. Austin*, 8 Co. Rep. 125a, 127b; 2 Inst. 47; *Horne v. Ivy*, 1 Sid. 441; 1 Vent. 47; *Hastings' Patent*, Noy 183.

<sup>(s)</sup> But see *Peck v. Hindes*, (1898) 14 Tim. L. R. 164; 15 R. P. C. 113.

<sup>(t)</sup> *Hocking v. Fraser*, (1886) 3 R. P. C. 7.

<sup>(u)</sup> *Otto v. Steel*, (1886) 3 R. P. C. 120; *Washburn and Moen Manufacturing Co. v. Patterson*, (1884) 1 R. P. C. 191.

<sup>(x)</sup> *Needham v. Oxley*, (1878) 8 L. T. N. S. 604; 11 W. R. 852; *Pemberton*, 4th ed. p. 485; Seton, 4th ed. pp. 352, 353.



abroad and imported into this country, and the defendants dismantled them and kept the separate parts stored in a warehouse.<sup>(y)</sup> Also where the infringing part was a portion of a complicated apparatus the defendant was not ordered to deliver up the whole machine on his undertaking to remove the infringing part.<sup>(z)</sup>

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

Loss caused to defendant.

#### COSTS.

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

Discretion of Court or Judge.

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

Necessity for certificate of particulars, and validity.

<sup>(y)</sup> *United Telephone Co. v. London and Globe Telephone and Maintenance Co.*, (1884) L. R. 26 Ch. D. 766, 776.

<sup>(z)</sup> *Automatic Weighing Machine Co. v. Feasby*, (1893) 10 R. P. C. 442.

<sup>(a)</sup> *Edison v. Holland*, (1888) 5 R. P. C. 459, 483.

<sup>(b)</sup> R. S. C. (1883) Ord. lxx. r. 1.

<sup>(c)</sup> 46 & 47 Vict. c. 57, s. 29, sub-s. 6;

p. 650 *post*; *Longbottom v. Shaw*, (1889) 6 R. P. C. 513. This provision does not apply to the Court of the County Palatine of Lancaster, as that Court is not a Court within the meaning of 46 & 47 Vict. c. 57, s. 29 (6); see p. 618 *post*.

<sup>(d)</sup> 46 & 47 Vict. c. 57, s. 31; p. 650 *post*.

Costs.  
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In the words of Sir George *Jessel*, M.R. : “ Where a plaintiff comes to enforce a legal right, and there has been no misconduct on his part, or omission or neglect which could induce the Court to deprive him of his costs, the Court has no discretion, and cannot take away the plaintiff’s right to costs. There may be misconduct of many sorts : for instance, there may be misconduct in commencing the proceedings, or some miscarriage in the procedure, or any oppressive or vexatious mode of conducting the proceedings, or other misconduct which will induce the Court to refuse costs ; but where there is nothing of the kind the rule is plain and well settled, and is as I have stated it.” (e)

Ignorance does not exempt from liability to pay costs.

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

When defendant admits and undertakes to discontinue infringement.

Although a defendant admits infringement and promises to discontinue the acts complained of and not to repeat them, the plaintiff is not bound to rely on such promises, but may obtain the injunction of the Court or such other relief as may be necessary.(i) In such a case, if the defendant would avoid the costs of the action he must, at the time he admits the infringement, offer to pay all the costs incurred up to that period.(k)

Where the plaintiff failed to prove infringement, though the defendant admitted a discontinued infringement before action and offered to pay what was reasonable, the plaintiff was condemned in the costs of the action.(l)

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

(e) *Cooper v. Whittingham*, (1880) L. R. 15 Ch. D. 504.

(f) p. 505 *ante*.

(g) p. 465 *ante*.

(h) *Wittman v. Oppenheim*, (1884) L. R. 27 Ch. D. 260; *Upmann v. Forrester*, (1883) L. R. 24 Ch. D. 231; *Burgess v. Hateley*, (1859) 26 Beav. 249; *Cooper v. Whittingham*, (1880) L. R. 15 Ch. D. 504; *Davenport v. Rylands*, (1865) L. R. 1 Eq. 302;

*Collins v. Walker*, (1859) 7 W. R. 222. (i) pp. 505, 506 *ante*.

(k) *Burgess v. Hateley*, (1859) 26 Beav. 249; *Geary v. Norton*, (1846) 1 De G. & S. 9, 12; *Fradella v. Weller*, (1831) 2 Russ & M. 247; *Nunn v. D’Albuquerque*, (1865) 34 Beav. 595; *Colburn v. Simms*, (1843) 2 Hare, 543; *Jenkins v. Hope*, (1895) 13 R. P. C. 57.

(l) *Fletcher v. Glasgow Gas Co.* (1887) 4 R. P. C. 386.

plaintiff was held to be entitled not only to an injunction but to his costs of the suit.<sup>(m)</sup>

Costs.

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

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

When plaintiff's conduct is oppressive.

Where the plaintiff seeks leave by summons or otherwise to withdraw the action, the Court imposes such terms as to costs as under the circumstances seem reasonable.<sup>(r)</sup>

When plaintiff withdraws action.

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

Separate issues.

<sup>(m)</sup> Geary v. Norton, (1846) 1 De G. & S. 9.

<sup>(n)</sup> United Telephone Co. v. London and Globe Telephone and Maintenance Co., (1884) 1 R. P. C. 117.

<sup>(o)</sup> Proctor v. Bayley, (1889) 6 R. P. C. 106.

<sup>(p)</sup> 6 R. P. C. 538.

<sup>(q)</sup> Nunn v. D'Albuquerque, (1865) 34 Beav. 595.

<sup>(r)</sup> Boake, Roberts & Co. v. Stevenson, (1894) 12 R. P. C. 228; Wilcox and Gibbs' Sewing Machine Co. v. Janes, (1897) 14 R. P. C. 523; Bethell v. Gage, (1897) 14 R. P. C. 699.

**Costs.**

Issues  
abandoned at  
the trial.

Apportion-  
ment of costs.

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

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

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

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

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

And in another instance the action was dismissed with costs, but the Court directed that the plaintiff should have his costs, which were incurred by reason of the defendant disputing the

<sup>(s)</sup> *Thompson v. The American Braided Wire Co.*, (1889) 6 R. P. C. 518.

<sup>(t)</sup> *Simmonds v. Hitchman*, (1885) L. R. 29 Ch. D. 417; see also *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 297; see

also *Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co.*, (1897) 14 R. P. C. 776, 777.

<sup>(u)</sup> *Westinghouse v. Lancashire and Yorkshire Ry. Co.*, (1884) 1 R. P. C. 229, 254.

validity of the patent.<sup>(x)</sup> In one case the Court of Appeal awarded the general costs to the defendant, but gave the costs of the issue of novelty, which was not decided, to neither side.<sup>(y)</sup>

Costs.  
 ———  
 Apportionment of costs continued.

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

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

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

<sup>(x)</sup> Nordenfelt v. Gardner, (1884) 1 R. P. C. 61, 75.

<sup>(y)</sup> Needham v. Johnson, (1884) 1 R. P. C. 49, 59.

<sup>(z)</sup> Boyd v. Horrocks, (1889) 6 R. P. C. 528.

<sup>(a)</sup> Moore v. Bennett, (1884) 1 R. P. C. 129.

<sup>(b)</sup> p. 617 *post*.

<sup>(c)</sup> Garrard v. Edge W. N. 1890, pp. 43, 68.

Costs.  
 Apportion-  
 ment of costs  
 continued.

particulars were disallowed on the ground that they were "improper, vexatious, or unnecessary."

Sometimes when the plaintiff succeeds on the issue of validity, but fails on the issue of infringement, though the plaintiff gets the chief part of the costs relative to validity, yet he does not get them all, the costs of some of the particulars of objections being given to the defendant on the ground that such particulars were reasonable and proper, and necessary for the purpose of defining the ambit of the claim.(d)

The proper form of order when the plaintiff is given the costs of the issue of validity, and the defendant the general costs of the action, was discussed in *Shoe Machinery Co. v. Cutlan*.(e)

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

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

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

A rule was stated by *Fry, J.*, in *Wegman v. Corcoran*.(i) to the effect that where the plaintiff fails on the issue of validity, but succeeds on other issues, the Court gives the general costs of the action to the defendant, but as regards certain issues raised by the one side or the other, the Court apportions the costs according to the success of the parties.

(d) *Nobel's Explosives Co. v. Anderson*, (1894) 11 R. P. C. 128.

(e) (2) (1896) 13 R. P. C. 148, 398; see also *Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co.*, (1897) 14 R. P. C. 775, 776.

(f) *Kaye v. Chubb*, (1887) 4 R. P. C. 289, 300, 303.

(g) *Blakey v. Latham*, (1889) 6 R. P. C. 184, 190.

(h) *Pooley v. Pointon*, (1885) 2 R. P. C. 167; *Lawrence v. Perry*, (1885) 2 R. P. C. 179; *Lawrie v. Baker*, (1885) 2 R. P. C. 213; *Lister v. Norton*, (1886) 3 R. P. C. 199.

(i) (1879) 27 W. R. 357.

This rule was approved and applied by the Court of Appeal in *Badische Anilin und Soda Fabrik v. Levinstein*.<sup>(k)</sup> In this case Bowen, J., said: "I am of opinion, in this case, that the plaintiffs should have the costs occasioned by the issues raised by the particulars of breaches, and that in respect of all the other costs the costs in the action should follow the usual result, and be awarded to the successful party. It seems to me that without laying down any hard-and-fast line, or trying to fetter our discretion at a future period in any other case, we are acting on a sensible and sound principle, namely, the principle that parties ought not, even if right in the action, to add to the expenses of an action by fighting issues in which they are in the wrong. It may be very reasonable as regards their own interest, and may help them in the conduct of the action, that they should raise issues in which in the end they are defeated; but the defendant who does so does it in his own interest, and I think he ought to do it at his own expense."<sup>(l)</sup>

Costs.

Apportionment of costs continued.

Other Judges have, however, held that a plaintiff who has failed to substantiate his patent, but has succeeded on the issue of infringement, may be deprived of his costs of that issue, on the ground that in the opinion of the Court the issue was not sufficiently distinguished from the rest of the case,<sup>(m)</sup> or that the costs of the issue were trifling,<sup>(n)</sup> or on the ground that there can be no infringement of an invalid patent, and that it is consequently impossible for the plaintiff to succeed on the issue of infringement if the patent is bad.<sup>(o)</sup> In one case where the infringement was admitted and the defendant succeeded on the ground of want of novelty he was awarded the costs of the anticipations proved and the plaintiff the costs of the issue of infringement, but no other costs.<sup>(p)</sup>

It is provided by s. 29 sub.-s. 6 of the Act of 1883 <sup>(q)</sup> that on taxation of costs regard shall be had to the particulars delivered by the plaintiff and the defendant, and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or

Certificate of particulars is necessary on taxation.

<sup>(k)</sup> (1885) L. R. 29 Ch. D. 366, 418, 420.

<sup>(l)</sup> (1885) L. R. 29 Ch. D. 419; see also *Boyd v. Horrocks*, (1889) 6 R. P. C. 152, 162; *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate*, (1894) 11 R. P. C. 638; 12 R. P. C. 258, 303.

<sup>(m)</sup> *Guilbert-Martin v. Kerr*, (1887) 4 R. P. C. 23.

<sup>(n)</sup> *Kay v. Chubb*, (1887) 4 R. P. C. 289.

<sup>(o)</sup> *Edison v. Holland*, (1888) 5 R. P. C. 483; *Blakey v. Latham*, (1888) 6 R. P. C. 29; *United Telephone Co. v. Harrison*, (1882) L. R. 21 Ch. D. 720.

<sup>(p)</sup> *Bennington v. Hill*, (1891) 8 R. P. C. 327; *cf. Westley Richards v. Perkes*, (1893) 10 R. P. C. 194.

<sup>(q)</sup> p. 650 *post*.

**Costs.**

a Judge to have been proven or to have been reasonable and proper, without regard to the general costs of the case.

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

Omission to ask for certificate at the trial.

If either party omits to ask at the trial for a certificate as to the reasonableness and propriety of his particulars, it is submitted that he may obtain it afterwards on summons in chambers,<sup>(s)</sup> or on motion in Court.<sup>(t)</sup>

Power of Court of Appeal and House of Lords to grant a certificate of particulars.

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

The House of Lords on the same principle has a similar jurisdiction.<sup>(y)</sup>

Court of the County Palatine of Lancaster.

The Court of the County Palatine of Lancaster is not a Court, nor is the Vice-Chancellor a Judge within the meaning of

<sup>(r)</sup> *Cole v. Saqui*, (1888) 5 R. P. C. 489, 497.

<sup>(s)</sup> *Judic. Act*, (1873) s. 39; R. C. S. (1883) Ord. xlv. rr. 2, 17, 18; Ord. liv. r. 1.

<sup>(t)</sup> *Rowcliffe v. Morris*, (1886) 3 R. P. C. 145.

<sup>(u)</sup> *Cole v. Saqui*, (1889) 6 R. P. C. 41, 45; *Humpherson v. Syer*, (1887) 4 R. P. C. 416.

<sup>(x)</sup> *Cole v. Saqui*, (1889) 6 R. P. C. 45.

<sup>(y)</sup> *Morris v. Young*, (1895) 12 R. P. C. 465.



s. 29 sub.-s. 6 of the Act of 1883,<sup>(z)</sup> but it must be remembered that his Honour has power over the costs of particulars irrespective of any certificate.<sup>(a)</sup> It is his Honour's practice to certify the particulars in respect of which the parties are to receive costs or otherwise.<sup>(b)</sup>

Costs.

It is to be observed that the Act of 1883<sup>(c)</sup> provides that the Court may grant the certificate as to particulars in two distinct cases—*i.e.*, (1) when the particulars have been proven, and (2) where in the opinion of the Court or a Judge they were reasonable and proper. Neither party to an action of infringement can, whether the action is brought to trial or is discontinued at an earlier step, be allowed the costs of his particulars on taxation unless he is provided with the certificate of the Court or a Judge as to them.<sup>(d)</sup> The provisions of s. 29 of the Act of 1883 as to certificates of particulars are different in this respect to those of the somewhat analogous section of the repealed Act of 1852, which were only applicable when there had been an actual trial in Court, and, consequently, under that Act, when the action was discontinued, or judgment was allowed to go by default, or the action was dismissed for want of prosecution, no certificates were given, but the costs of particulars were dealt with in the ordinary way.<sup>(e)</sup> Now, however, in all cases when the Court has not the materials necessary to enable it to grant the certificate, the successful party is, consequently, deprived of the costs of his particulars.<sup>(f)</sup>

Certificate as to particulars is granted in two distinct cases.

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

Certificate when action is not tried out on all the issues raised.

<sup>(z)</sup> *Proctor v. Sutton Lodge Chemical Co.*, (1888) 5 R. P. C. 184.

<sup>(a)</sup> *Parnell v. Mort, Liddell and Co.*, (1885) L. R. 29; Ch. D. 325; 2 R. P. C. 55; *Garnett v. Bradley*, (1878) L. R. 3 App. Cas. 944.

<sup>(b)</sup> *Cheetham v. Oldham*, (1890) 7 R. P. C. 124; *Horrocks v. Stubbs*, (1886) 3 R. P. C. 240; *Parnell v. Mort, Liddell and Co.*, (1885) L. R. 29 Ch. D. 325; 2 R. P. C. 55; see also 53 & 54 Vict. c. 23, s. 3.

<sup>(c)</sup> s. 29, sub-s. 6.

<sup>(d)</sup> *Middleton v. Bradley*, (1895) 12 R. P. C. 390.

<sup>(e)</sup> *Batly v. Kynock*, (1875) L. R. 20 Eq. 632; *Rothwell v. King*, (1887) 4 R. P. C. 397; *Greaves v. The Eastern Counties Ry. Co.*, (1859) 1 E. & E. 961; 28 L. T. Q. B. 290; *Stevens v. Keating*, (1850) 1 Mac. & G. 659.

<sup>(f)</sup> *Middleton v. Bradley* (1895) 12 R. P. C. 390; *Mandleberg v. Morley*, (1893) 11 R. P. C. 1; 12 R. P. C. 35; *Wilcox and Gibbs' Sewing Machine Co. v. James*, (1897) 14 R. P. C. 524.

<sup>(g)</sup> *The Germ Milling Co. v. Robinson*, (1886) 3 R. P. C. 254.

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Rule that Court will only certify such particulars as the materials before the Court enable it to say are reasonable and proper.

them.(h) The rule is that the Court will only certify with regard to such of the particulars as the materials before the Court at the time the certificate is asked for enable it to say that such particulars have either been proven or are reasonable and proper,(i) and where the Court disposes of the action on one point it will not hear the case further for the purpose of deciding whether the other particulars should be certified or not.(k)

The working of this rule in practice is well illustrated by the course pursued by the Court under the various circumstances hereafter detailed. Where the plaintiffs failed in their action on the ground of the invalidity of the patent being established by one of their own witnesses, judgment was given for the defendants without their being called upon to go into their defence, and the Judge held that he must decide which of the particulars of objection were reasonable and proper in regard to the case so far as it had gone, and a certificate was granted to the defendant in respect of those particulars only which the Judge specifically mentioned. It was also held that the plaintiffs not being entitled to any costs, they were not entitled to any certificate in respect of their particulars of breaches.(l) And where at the trial the plaintiff's case broke down on account of his first witness in cross-examination being unable to distinguish the alleged invention from a previous specification, and the action was accordingly dismissed, the defendant was allowed a certificate which was limited to the particulars involved in the decision of the Court.(m) Where a case broke down on account of the impossibility of supporting the first claim of the patent, and the action was dismissed without the defendants being called on, *Kay, J.*, refused to give a certificate with regard to the particulars of objections, but gave costs on the higher scale and liberty to apply with regard to the costs of the particulars of objections.(n) On the other hand, in another case, where the same learned Judge at the end of the

(h) *Longbottom v. Shaw*, (1888) 5 R. P. C. 497; (1889) 6 R. P. C. 143.

(i) *Mandleberg v. Morley* (1895) 12 R. P. C. 35, and cases there referred to; *Middleton v. Bradley*, (1895) 12 R. P. C. 390; *Wilcox and Gibbs' Sewing Machine Co. v. James*, (1897) 14 R. P. C. 524; *Bethell v. Gage*, (1897) 14 R. P. C. 699; but see p. 621 *post*.

(k) *Boyd v. Horrocks*, (1889) 6 R. P. C. 162; *Longbottom v. Shaw*, (1889) 6 R. P. C. 143; *Mandleberg v. Morley*, (1895) 12 R. P. C. 35.

(l) *The Germ Milling Co. v. Robinson*, (1886) 3 R. P. C. 254.

(m) *Griffin v. Feaver*, (1889) 6 R. P. C. 396; see also *Albo-Carbon Light Co. v. Kidd*, (1887) 4 R. P. C. 535; *Oddy v. Smith*, (1888) 5 R. P. C. 503; *Slazenger v. Feltham*, (1889) 6 R. P. C. 130; *Boyd v. Horrocks*, (1889) 6 R. P. C. 152, 162.

(n) *Rowcliffe v. The Longford Wire, Iron, and Steel Co.*, (1887) 4 R. P. C. 281, 288.

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plaintiff's case intimated that he would not call on the counsel for the defendant, and gave judgment in his favour, he not only refused a certificate in regard to the particulars of objections, but also refused to give liberty to apply.<sup>(o)</sup> On taxation of the costs in the latter case the taxing-master allowed the costs relating to or governed by the defendant's particulars, including the costs of the witnesses, but the Judge, on summons, varied the master's order by disallowing those costs, on the ground that the words of the Act are precise, and that as no certificate had been granted at the trial they could not be allowed.<sup>(p)</sup> *Kay*, J., in giving his decision, said: "There might well be a case where the matter was decided against the plaintiff without calling upon the defendant's counsel, and yet the Court, relying upon the evidence obtained by the defendant by cross-examining the witnesses, might think it right to look at the particulars of objections, and allow the costs of such particulars as were in fact made out by the cross-examination. I can quite understand that case occurring, and therefore I do not say that there might not be, in such a case as this, or in a similar case like that which I have just described, propriety in the Court looking into the particulars of objections, and saying whether they were reasonable or not, having regard to the specification."<sup>(q)</sup> Since these remarks were uttered there have been cases<sup>(r)</sup> in which the Court, being satisfied on the materials before it has granted the certificate as to particulars of objections, though the case was decided before the defendant had an opportunity of giving any evidence.

And the certificate has been given as to some of the defendant's objections, though the question of validity of the patent was not decided, on the ground that such particulars were necessary for the purpose of defining the ambit of the plaintiff's claim.<sup>(s)</sup> So also a certificate has been given with reference to the plaintiff's particulars of breaches, though the defendant did not appear at the trial.<sup>(t)</sup>

When the action is brought in respect of the infringement of several patents, and succeeds as to some but fails as to others,

Though validity is not decided, objections may be certified on the ground that they were necessary to the decision of the ambit of the claim.

Action in respect of several patents.

<sup>(o)</sup> *Longbottom v. Shaw*, (1888) 5 R. P. C. 497, 502.

<sup>(p)</sup> *Longbottom v. Shaw*, (1889) 6 R. P. C. 510; *Garrard v. Edge*, (1889) 6 R. P. C. 372, 563; (1890) 7 R. P. C. 139; but see *Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co.*, (1897) 14 R. P. C. 776.

<sup>(q)</sup> (1889) 6 R. P. C. 513.

<sup>(r)</sup> *Heyes v. Hallmark*, (1891) 9 R. P. C. 25; *Lees v. West London Cycle Stores*, (1892) 9 R. P. C. 300; *Singer v. Rudge Cycle Co.*, (1894) 11 R. P. C. 463, 585.

<sup>(s)</sup> *Jardine v. King, Mendham and Co.*, (1896) 13 R. P. C. 428.

<sup>(t)</sup> *Pneumatic Tyre Co. v. Chisholm*, (1896) 13 R. P. C. 488.

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the Court will certify as to the particulars on which either party has succeeded, but will refuse to certify as to the particulars on which he failed.<sup>(u)</sup>

Effect of certificate of validity given in a prior action.

It is provided by s. 31 of the Act of 1883 that "in an action for infringement of a patent the Court or a Judge may certify that the validity of the patent came in question; and if the Court or a Judge so certifies, then, in any subsequent action for infringement, the plaintiff in that action, in obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses, as between solicitor and client, unless the Court or Judge trying the action certifies that he ought not to have the same."<sup>(x)</sup>

When certificate of validity may be given.

The certificate may be given notwithstanding the fact that the patent has expired at the date of the judgment.<sup>(y)</sup>

Threats action.

As we have seen,<sup>(z)</sup> the validity of the patent may be called in question in an action brought to restrain the continuance of threats of proceedings in respect of infringements, but it is doubtful whether a certificate can be given in such an action under the above power.<sup>(a)</sup>

Petition for revocation.

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

Power of Court of Appeal and House of Lords and Court of the County Palatine of Lancaster to grant a certificate of validity.

It is submitted that the Court of Appeal, if it reverses a decision of the Court below against the patent, has power to grant a certificate that the validity has come in question, though it is not a "Court" within the meaning of the section. It is the duty of the Court of Appeal to make such order as the Judge who heard the case ought to have made, and, in the event of the Court of Appeal reversing the decision below

<sup>(u)</sup> Brooks v. Lamplugh, (1897) 15 R. P. C. 33.

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

<sup>(y)</sup> Sunlight Incandescent Gas Lamp

Co. v. Incandescent Gas Light Co., (1897) 14 R. P. C. 776.

<sup>(z)</sup> p. 453 ante. <sup>(a)</sup> p. 458 ante.

<sup>(b)</sup> Bovill v. Hadley, (1864) 17 C. B. N. S. 435.

<sup>(c)</sup> 15 & 16 Vict. c. 83, s. 43.

<sup>(d)</sup> p. 389 ante.

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on the question of validity, it is presumed that a certificate would be granted, on the ground that the finding should have been the other way.<sup>(e)</sup> The House of Lords also for the same reason has a similar jurisdiction.<sup>(f)</sup>

Should the Court of Appeal or House of Lords not grant the certificate, application for one may be made to the Judge of the Court below who tried the case,<sup>(g)</sup> and in one instance the Court of Appeal granted no certificate, but gave the appellant leave to apply to the Judge below.<sup>(h)</sup>

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

If a certificate that the validity of the patent was called in question is not asked for at the trial, it may probably be obtained by subsequent summons in chambers,<sup>(l)</sup> or on motion in Court.<sup>(m)</sup>

Omission to ask for certificate of validity at the trial.

If a certificate be granted there is no appeal, as it is not a judgment or order against which an appeal lies.<sup>(n)</sup>

It seems that the grant of a certificate is discretionary in the Court or Judge.<sup>(o)</sup>

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

It was held under the Act of 1835 that no certificate ought to be given when no evidence on the question of validity was

Certificate when no evidence on issue of validity is offered.

<sup>(e)</sup> R. S. C. (1883) Ord. lviii. r. 4; *Cole v. Saqui*, (1889) 6 R. P. C. 45; *Humpherson v. Syer*, (1887) 4 R. P. C. 416.

<sup>(f)</sup> *Morris v. Young*, 465.

<sup>(g)</sup> *Cropper v. Smith*, 2 R. P. C. 61.

<sup>(h)</sup> *Otto v. Linford*, (1881) 46 L. T. N. S. 35.

<sup>(i)</sup> *Proctor v. Sutton Lodge Chemical Co.*, (1888) 5 R. P. C. 184.

<sup>(k)</sup> 53 & 54 Vict. c. 23, s. 3.

<sup>(l)</sup> Judic. Act, (1873) s. 39; R. S. C. (1883), Orders liv. and lv.

<sup>(m)</sup> *Rowcliffe v. Morris*, (1886) 3 R. P. C. 145.

<sup>(n)</sup> *Haslam v. Hall*, (1888) L. R. 20 Q. B. D. 491; (1888) 5 R. P. C. 144; *Cropper v. Smith*, (1885) 2 R. P. C. 63.

<sup>(o)</sup> 46 & 47 Vict. c. 57, s. 31.

<sup>(p)</sup> *Haslam v. Hall*, (1888) 5 R. P. C. 28; *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 113, 120; *Badische Anilin und Soda Fabrik v. La Société des Usines du Rhône*, (1897) 14 R. P. C. 892.

## Costs.

offered, and judgment was entered for the plaintiff by consent;(q) but where the defendant offered evidence against the novelty of the invention, which failed, and was prevented from offering further evidence affecting the validity of the patent on other grounds, it was held that a certificate ought to be given.(r)

And under the Act of 1883, where a defendant by his pleadings denied the validity of the patent, but did not appear at the trial, *Kay, J.*, holding that s. 31 of the Act of 1883 only applied when the patent is established in a case contested in Court, refused to grant a certificate; but (s) *Kekewich, J.*, under similar circumstances, in the absence of authority to the contrary, granted the certificate,(t) and pointed out that if a defendant, by non-appearance at the trial, could deprive a successful plaintiff of the right to a certificate as to the validity of the patent, the plaintiff might be put to the trouble of proving it all over again. And *Day, J.*, in a more recent case, followed the course adopted by *Kekewich, J.*(u) Also, where a case was settled by a compromise between the parties, *Collins, J.*, granted the certificate on the ground that the validity had undoubtedly been brought in question, though the parties had arranged between themselves how it was to be decided.(x)

Certificate of validity may be given though plaintiff fails on the issue of infringement.

It is not necessary that the plaintiff should be completely successful in the action to obtain a certificate of validity. The certificate has been given in many cases where the plaintiff, though successful on the issue of validity, has failed on that of infringement.(y)

Certificate where defendant admits validity on a certain construction of the specification.

There does not appear to be any case in which a certificate of validity has been given where the defendant has admitted the validity of the patent upon a certain specific construction of the specification found by the Court to be the true construction and to exclude the alleged infringement from the claim; and in such a case it is submitted that no certificate would be given.(z) If, however, the defendant should, besides admitting validity, subject to a proviso as to construction, alternatively

(q) *Stocker v. Rodgers*, (1843) 1 Car. & K. 99.

(r) *Gillett v. Wilby*, (1839) 1 W. P. C. 270.

(s) *Peroni v. Hudson*, (1884) 1 R. P. C. 261, 263; *Stocker v. Rodgers*, (1843) 1 Car. & K. 99.

(t) *Haydock v. Bradbury*, (1887) 4 R. P. C. 74.

(u) *Edison-Bell Phonograph Corporation v. Edison Phonograph Co.*, (1893) 11 R. P. C. 33.

(x) *Delta Metal Co. v. Maxim-Nordenfelt Guns and Ammunition Co.*, (1891) 8 R. P. C. 247.

(y) *Tweedale v. Ashworth*, (1890) 7 R. P. C. 426; 8 R. P. C. 49; 9 R. P. C. 121; *Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co.*, (1897) 14 R. P. C. 776.

(z) *Morris v. Young*, (1895) 12 R. P. C. 464, 465.

plead invalidity upon another construction, and succeed with reference to the special construction without arguing his case upon the other construction, it is submitted the Court might grant the certificate, though the case of validity was not contested in Court.(a)

Costs.  
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Where a certificate of validity has been granted in a previous action, it will not usually be granted again at the conclusion of a subsequent action.(b) And if it is desired to claim solicitor and client's costs, the certificate ought, strictly speaking, to be pleaded in the subsequent action, though they may be given if the writ and statement of claim ask for them. (c)

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

Meaning of  
"subsequent  
action."

Under the Act 1852 the order on a motion for a new trial of an action subsequent to one in which a certificate of validity had been obtained was held not to be a "decree, decretal order or final judgment," and the plaintiff was not entitled to full costs.(e) It is submitted that such an order, or an order on motion to commit for breach of an injunction, would not be a "final order or judgment" within s. 31 of the Act of 1883, and, therefore, under the present practice the plaintiff could not on the strength of a certificate of validity claim solicitor and client's costs, if successful in resisting a motion for a new trial, or obtaining an order for committal for breach of an injunction.(f)

It is to be noticed that the Act of 1883 provides that a plaintiff possessed of a certificate that the validity of his patent has been questioned is, in a subsequent action on obtaining a final order or judgment, to have his costs as between solicitor and client, *unless the Court or a Judge trying the action certifies*

Solicitor and  
client costs are  
not always  
given though a  
certificate of  
validity has  
been obtained  
in a prior  
action.

(a) Haydock v. Bradbury, (1887) 4 R. P. C. 74; Edison-Bell Phonograph Corporation v. Edison Phonograph Co. (1893) 11 R. P. C. 33; Delta Metal Co. v. Maxim-Nordenfelt Guns and Ammunition Co., (1891) 8 R. P. C. 247; Morris v. Young, (1895) 12 R. P. C. 465.

(b) Edison v. Holland, (1888) 6 R. P. C. 285.

(c) Pneumatic Tyre Co. v. Chisholm, (1896) 13 R. P. C. 488.

(d) Automatic Weighing Machine Co. v. Combined Weighing Machine Co., (1889) 6 R. P. C. 120; Automatic Weighing Machine Co. v. International Hygienic Society, (1889) 6 R. P. C. 480; Penn v. Bibby, (1866) L. R. 3 Eq. 308; Bovill v. Hadley, (1864) 17 C. B. N. S. 435.

(e) Bovill v. Goodier, (1866) Griff. L. O. C. 49.

(f) Spencer v. The Ancoats Vale Rubber Co., (1889) 6 R. P. C. 46, 48.

Costs.

that he ought not to have the same. Therefore, it is left to the discretion of the Court to deprive a successful plaintiff in a subsequent action of his full costs, if it is of opinion that he ought not to have them. The object of the enactment was to prevent patentees being put under the necessity of bringing repeated actions to determine their rights after the patent has been once established. There are many circumstances under which it might be improper that a plaintiff succeeding in a subsequent action should have solicitor and client costs, notably if it is proved that the first action was collusive<sup>(g)</sup> or vexatious,<sup>(h)</sup> or the defendant is otherwise able to discharge the burden which is on him of showing cause why he should not pay solicitor and client costs.<sup>(i)</sup>

The intention seems to be to protect patentees from being harassed by having to support their patents again after they have been contested and declared valid, and not to affect the question of the costs of the issue of infringement where the evidence before the Court is totally distinct from that which was presented in the former action, or there are other substantially new questions to be decided with reference to the patent or the specification.

For instance, where a certificate as to validity had been obtained, *Pearson, J.*, in a subsequent action, refused to give full solicitor and client costs on the ground that the patent was attacked on grounds which were not raised in the prior proceedings, but he granted the plaintiff a fresh certificate of validity, specifying to what extent the patent had been questioned.<sup>(k)</sup> But *Romer, J.*, gave solicitor and client costs where in the subsequent action the patent was unsuccessfully contested on a point of ambiguity of specification which was not raised on the former occasion.<sup>(l)</sup>

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

<sup>(g)</sup> *Davenport v. Rylands*, (1865) L. R. 1 Eq. 309.

<sup>(h)</sup> *Proctor v. Sutton Lodge Chemical Works*, (1888) 5 R. P. C. 184.

<sup>(i)</sup> *United Telephone Co. v. Patterson*, (1889) 6 R. P. C. 142; *United*

*Telephone Co. v. St. George*, (1886) 3 R. P. C. 339.

<sup>(k)</sup> *Otto v. Steel*, (1886) 3 R. P. C. 109, 120.

<sup>(l)</sup> *Automatic Weighing Machine Co. v. Fearby*, (1893) 10 R. P. C. 447.



which, however, did not take place, in consequence of a compromise between the parties. *(m)* Costs.

The fact that a defendant does not deny the validity of the patent, but only disputes the question of infringement, will not necessarily induce the Court to deprive the plaintiff of full solicitor and client costs if he hold a certificate of validity; *(n)* but, on the other hand, though the plaintiff hold a certificate that the validity of his patent was questioned in a prior action he will not be awarded full solicitor and client costs in a subsequent action where the only question raised is one of infringement, and the necessity for the subsequent action arises is, in the opinion of the Court, from the lax manner in which the patentee's specification was drawn. *(o)*

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

When scientific evidence is necessary, proper fees to experts will be allowed; *(q)* but only the fees of experts which relate to qualifying to give evidence in the particular case and to attendance in Court for the purpose of giving evidence should be allowed. Fees which relate to experiments performed to educate an expert apart from the special case should be disallowed. *(r)*

An allowance may also be made in respect of the preparation of drawings or models when they are required; *(s)* but the Court will not order such drawings and models to be given up to the party ordered to pay the costs of them. *(t)* If the drawings and models are not really necessary, no allowance

*(m)* *Betts v. De Vitre*, (1864) 11 Jur. N. S. 11.

*(n)* *The United Telephone Co. v. Pattinson*, (1889) 6 R. P. C. 140; *Davenport v. Rylands*, (1865) L. R. 1 Eq. 302, 308; *Pneumatic Tyre Co. v. West London Rubber and Tyre Co.*, (1898) 15 R. P. C. 129.

*(o)* *Automatic Weighing Machine Co. v. International Hygienic Society*, (1889) 6 R. P. C. 480; *Automatic Weighing Machine Co. v. National Exhibitions Association*, (1891) 8 R. P. C. 352.

*(p)* *Smith v. Buller*, (1874) L. R. 19 Eq. 475.

*(q)* *Smith v. Buller*, (1874) L. R. 19 Eq. 473; *Batley v. Kynock*, (1875) L. R. 20 Eq. 632; *Musgrave v. Hicks*, (1886) 3 R. P. C. 49.

*(r)* *Leonardt v. Kallé*, (1895) 12 R. P. C. 306.

*(s)* *Batley v. Kynock*, (1875) L. R. 20 Eq. 632; *Musgrave v. Hicks* (1886) 3 R. P. C. 49; *Horrocks v. Stubbs*, (1886) 3 R. P. C. 221.

*(t)* *Horrocks v. Stubbs*, (1886) 3 R. P. C. 241.

Solicitor and client costs when defendant does not dispute validity.

Party and party costs.

Scientific evidence and experts' fees.

Drawings and medals.

## Costs.

will be made in respect of them on taxation—*e.g.*, where drawings were only used for the purpose of being affixed to the margin of copies of evidence supplied to counsel, the costs of their preparation were disallowed, although the opposite party had asked for and been supplied with copies of them.<sup>(u)</sup>

## Three Counsel.

The costs of three counsel may sometimes be allowed,<sup>(x)</sup> but this should only be done when the case is one of multifarious issues, and matters on which different minds might be properly employed, as it were dividing the labour among counsel; they should not be allowed in cases, though of great difficulty, where it is necessary for each counsel to get up the whole case.<sup>(y)</sup>

## Shorthand notes.

A Judge has no power in the absence of arrangement to order shorthand notes of the evidence to be taken.<sup>(z)</sup> Where shorthand notes are taken it is the usual and proper course for the parties to agree beforehand that the costs of them shall be costs in the cause, or to make some other mutual arrangement as to them. When this is not done the Court will sometimes give the costs of the shorthand notes as part of the costs in the action, and the necessary application should be made at the trial.<sup>(a)</sup> But such an order is only made in exceptional cases.<sup>(b)</sup>

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

## Inquiry as to damages.

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

<sup>(u)</sup> *Smith v. Buller*, (1875) L. R. 19 Eq. 473.

<sup>(v)</sup> *Monnet v. Beck*, (1897) 14 R. P. C. 850; *Pneumatic Tyre Co. v. Ixion Patent Pneumatic Tyre Co.*, (1897) 14 R. P. C. 875; *Badische Anilin und Soda Fabrik v. La Société Chimique des Usines du Rhône*, (1897) 14 R. P. C. 892.

<sup>(y)</sup> *Leonardt v. Kallé*, (1895) 12 R. P. C. 306.

<sup>(z)</sup> *Hilleary v. Taylor*, (1887) L. R. 36 Ch. D. 262; *Nobel's Explosives Co. v. Anderson*, (1894) 11 R. P. C. 129.

<sup>(a)</sup> *Earl De La Warr v. Miles*, (1881) L. R. 19 Ch. D. 80; *Bowen v. Centaur Cycle Co.*, (1891) 8 R. P. C. 113; *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System*, (1896) 13 R. P. C. 333; *Incandescent Gas Light Co. v. Sunlight Gas Lamp Co.*,

(1896) 13 R. P. C. 346; *Monnet v. Beck*, (1897) 14 R. P. C. 850; *Pneumatic Tyre Co. v. Ixion Patent Pneumatic Tyre Co.*, (1897) 14 R. P. C. 875.

<sup>(b)</sup> *Ibid.*; *Kelly v. Bayles*, 18 L. R. 13 Ch. D. 693.

<sup>(c)</sup> *Collyer v. Isaacs*, (1882) 45 L. T. N. S. 567; 30 W. R. 71; *London and South-Western Ry. Co. v. Groom*, (1881) L. R. 20 Ch. D. 589; *Woodward v. Sansom*, (1887) 4 R. P. C. 178.

<sup>(d)</sup> *Stark v. Midland Ry. Co.*, (1881) L. R. 16 Ch. D. 81; *United Telephone Co. v. Fleming* (2), (1886) 3 R. P. C. 282; *Moss v. Malings*, (1886) 3 R. P. C. 379; *United Telephone Co. v. Faulkner*, (1886) 3 R. P. C. 282 n; *Cole v. Saqui*, (1888) 5 R. P. C. 497; *Needham v. Oxley*, Seton 4th ed. p. 353.

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

Costs.

It is the duty of the officer of the Court before whom an inquiry as to damages or an account of profits is heard to take notes of the evidence, and if shorthand notes are taken no costs of them will in the absence of agreement between the parties be allowed.<sup>(g)</sup>

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

Costs on the higher scale.

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

Where an action was of a complicated nature, the Court, considering that special industry and learning and much time and expense had been employed in preparing it for trial, directed the taxing-master to allow all or any part of the plaintiff's costs on the higher scale if he thought fit; <sup>(k)</sup> and costs on the higher scale have been allowed in many patent cases, on the ground that the case of the successful party being of exceptional difficulty has involved a protracted examination of witnesses, the calling of expert evidence, or the preparation of drawings and models,<sup>(l)</sup> whether the patent has been previously supported or

<sup>(e)</sup> *Burdett v. Hay*, (1863) 4 De G. J. & S. 41; Seton, 4th ed. p. 172.

<sup>(f)</sup> *Rothwell v. King* (2), 4 P. O. B. 76.

<sup>(g)</sup> *Unguan v. Sugg*, (1892) 9 R. P. C. 113.

<sup>(h)</sup> S. C. R. (1883) Ord. lxx. r. 9.

<sup>(i)</sup> *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 310.

<sup>(k)</sup> *Fraser v. Province of Brescia*

*Steam Tramways Co.*, (1887) 56 L. T. N. S. 771; 3 Times R. 587.

<sup>(l)</sup> *Westinghouse v. L. & Y. Ry. Co.*, (1884) 1 R. P. C. 103; *Easterbrook, F. G. W. Ry. Co.*, (1885) 2 R. P. C. 212; *Watling v. Stevens*, (1886) 3 R. P. C. 43; *Otto v. Steel*, (1886) 3 R. P. C. 120; *Wenham v. May*, (1887) 4 R. P. C. 310; *Kaye v. Chubb*, (1887) 4 R. P. C. 289; *Ellington v. Clark*,

Stay Pend- not; though costs on the higher scale have been refused where  
ing Appeal. complications of the case were due to the unfortunate wording  
of both an original and an amended specification, (*m*) and in  
many other cases.

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

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

#### STAY PENDING APPEAL.

Stay is not  
usual.

If the party who has been unsuccessful in a patent action  
intends to enter notice of appeal he may sometimes succeed in  
obtaining an order from the Court staying the proceedings on  
the judgment till the hearing and determination of the appeal, (*s*)  
though a stay is by no means the general rule. (*t*)

Application for  
a stay.

The application must in the first instance be made to the  
Court below and not to the Court of Appeal; (*u*) but if the

(1888) 5 R. P. C. 528; *Edison v. Holland*, (1888) 5 R. P. C. 459; *Blakey v. Lathom*, (1889) 6 R. P. C. 29; *Automatic Weighing Machine Co. v. International Hygienic Society*, (1889) 6 R. P. C. 475; *Tweedale v. Ashworth*, (1890) 7 R. P. C. 426; *Farbenfabriken vorm F. Bayer and Co.*, (1891) 8 R. P. C. 389; *Hopkinson v. St. James' and Pall Mall Electric Light Co.*, (1892) 10 R. P. C. 46; *Edison-Bell Phonograph Co. v. Smith*, (1894) 11 R. P. C. 161; *Hookham v. Johnson*, (1897) 14 R. P. C. 525; but see *Leonardt v. Kallé*, (1895) 12 R. P. C. 120.

(*m*) *Wenham Gas Co. v. Champion Gas Lamp Co.*, (1890) 7 R. P. C. 313.

(*n*) *Hudson v. Osgerby*, (1884) 32 W. R. 566.

(*o*) *Grafton v. Watson*, (1884) 51 L. T. N. S. 141; *Cardiff Steamship Co. v. Barwick*, (1885) 53 L. T. N. S. 56.

(*p*) *Peroni v. Hudson*, (1884) 1 R. P. C. 261.

(*q*) *Spettigue's Trusts*, (1884) 32 W. R. 385; *The Horace*, (1884) L. R. 9 P. D. 86.

(*r*) *Crampton v. The Patents Investment Co.*, (1888) 5 R. P. C. 282, 404.

(*s*) *Adair v. Young*, (1879) L. R. 11 Ch. D. 136; *Woodward v. Sansom*, (1886) 3 R. P. C. 366; *Humpherson v. Syer*, (1887) 4 R. P. C. 189; *Proctor v. Bennis*, (1887) 4 R. P. C. 363; *Otto v. Steel*, (1886) 3 R. P. C. 121.

(*t*) *Edge v. Johnson*, (1892) 9 R. P. C. 142; *Lancashire Explosives Co. v. Roburite Explosives Co.*, (1895) 12 R. P. C. 483.

(*u*) *Otto v. Lindford*, (1880) L. R. 18 Ch. D. 394; *Cropper v. Smith*, (1883) L. R. 24 Ch. D. 305.

Court of First Instance refuse to make an order staying proceedings, an application may be made to the Court of Appeal, and an application of this nature is not properly an appeal motion, and need not be brought within twenty-one days after the refusal of the Court below. *(x)*

Stay Pending Appeal.

Sometimes, pending an appeal, the Court in its discretion will grant a stay of an injunction on the undertaking of the defendant to keep an account, *(y)* and where there is a special reason *(z)* the Court, in view of an appeal, orders the taxation of costs, and, if the appeal is not heard before the completion of the taxation, the money to be paid over on the personal undertaking of the solicitor to return it in the event of the appeal succeeding; *(a)* but though this is frequently done it is not the usual order. *(b)* Neither is it usual to stay an inquiry as to damages or the taking of an account pending an appeal, *(c)* though frequently a stay is granted in respect of an order for the delivery up or destruction of the defendant's goods. *(d)*

Circumstances which induce the Court to grant a stay.

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

Costs of application for a stay.

*(x)* Cropper *v.* Smith, (1883) L. R. 24 Ch. D. 305.

*(y)* Hocking *v.* Fraser, (1886) 3 R. P. C. 7; North British Rubber Co. *v.* Gormully, Jeffrey and Co., (1896) 13 R. P. C. 691; 14 R. P. C. 283.

*(z)* Pneumatic Tyre Co. *v.* East London Rubber Co., (1897) 14 R. P. C. 590.

*(a)* Ticket Punch Register Co. *v.* Colley's Patents, (1895) 12 R. P. C. 10.

*(b)* Per Lindley, L.J., *Badische Anilin und Soda Fabrik v. Johnson*, (1897) 14 R. P. C. 418.

*(c)* Chadburn *v.* Mehan, (1895) 12 R. P. C. 135.

*(d)* English and American Machinery Co. *v.* Union Boot and Shoe Machine Co., (1894) 11 R. P. C. 142; *Howes v. Webber*, (1895) 12 R. P. C. 470.

*(e)* Cooper *v.* Cooper, (1875) L. R. 2 Ch. D. 493; *Merry v. Nickalls*, (1873) L. R. 8 Ch. App. Cas. 205.

*(f)* *Adair v. Young*, (1879) 11 Ch. D. 6.

*(g)* *Adair v. Young*, (1879) L. R. 11 Ch. D. 136.

# APPENDIX.

## APPENDIX.

### STATUTE OF MONOPOLIES (1623).

[21 JAC. I. c. 3.]

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

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

All monopolies, &c., shall be void.

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

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

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

All persons  
disabled to use  
monopolies, &c.

3. And be it further enacted by the authority aforesaid, that all person and persons, bodies politic and corporate whatsoever, which now are or hereafter shall be, shall stand and be disabled and incapable to have, use, exercise, or put in use any monopoly, or any such commission, grant, licence, charter, letters patents, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, or any liberty, power, or faculty, grounded or pretended to be grounded upon them, or any of them.

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

4. And be it further enacted by the authority aforesaid, that if any person or persons at any time after the end of forty days next after end of this present session of Parliament shall be hindered, grieved, disturbed, or disquieted, or his or their goods or chattels any way seized, attached, distrained, taken, carried away, or detained, by occasion or pretext of any monopoly, or of any such commission, grant, licence, power, liberty, faculty, letters patents, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, and will sue to be relieved in or for any of the premises, that then and in every such case, the same person and persons shall and may have his and their remedy for the same at the common law, by any action or actions to be grounded upon this statute; the same action and actions to be heard and determined in the Courts of King's Bench, Common Pleas, and Exchequer, or in



any of them, against him or them by whom he or they shall be so hindered, grieved, disturbed or disquieted, or against him or them by whom his or their goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained; wherein all and every such person and persons which shall be so hindered, grieved, disturbed, or disquieted, or whose goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained, shall recover three times so much as the damages which he or they sustained by means or occasion of being so hindered, grieved, disturbed, or disquieted, or by means of having his or their goods or chattels seized, attached, distrained, taken, carried away, or detained, and double costs; and in such suits, or for the staying or delaying thereof, no essoin, protection, wager of law, aidprayer, privilege, injunction, or order of restraint, shall be in any wise prayed, granted, admitted, or allowed, nor any more than one im-  
 parlance: And if any person or persons shall, after notice given that the action depending is grounded upon this statute, cause or procure any action at the common law, grounded upon this statute, to be stayed or delayed before judgment, by colour or means of any order, warrant, power, or authority, save only of the Court wherein such action as aforesaid shall be brought and depending, or after judgment had upon such action, shall cause or procure the execution of or upon any such judgment to be stayed or delayed by colour or means of any order, warrant, power, or authority, save only by writ of error or attain; that then the said person and persons so offending shall incur and sustain the pains, penalties, and forfeitures ordained and provided by the Statute of Provision and Præmunire made in the sixteenth year of the reign of King  
 Richard the Second.

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

16 Rich. II. c. 5.

5. Provided nevertheless, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patents and grants of privilege for the term of one and twenty years or under heretofore made, of the sole working or making of any manner of new manufacture within this realm, to the first and true inventor or inventors of such manufactures, which others at the time of the making of such letters patents and grants did not use, so they be not contrary to the law, nor mischievous to the State, by raising of the prices of commodities at home, or hurt of trade, or generally inconvenient, but that the same shall be of such force as they were or should be, if this Act had not been made, and of none other: and if the same were made for more than one and twenty years, that then the same for the term of one and twenty years only, to be accounted from the date of the first letters patents and grants thereof made, shall be of such force as they were or should have been

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

if the same had been made, but for term of one and twenty years only, and as if this Act had never been had or made, and of none other.

Exception of  
future letters  
patent.

6. Provided also, and be it declared and enacted, That any declaration before mentioned shall not extend to any letters patents and grants of privilege for the term of fourteen years or under hereafter to be made of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patents and grants shall not use, so as also they be not contrary to the law, nor mischievous to the State, by raising prices of commodities at home, or hurt of trade, or generally inconvenient: the said fourteen years to be accounted from the date of the first letters patent, or grant of such privilege hereafter to be made, but that the same shall be of such force as they should be if this Act had never been made, and of none other.

Grants con-  
firmed by Act  
of Parliament  
saved.

7. Provided also, and it is hereby further intended, declared, and enacted by authority aforesaid, That this Act or any thing therein contained shall not in any wise extend, or be prejudicial to any grant or privilege, power, or authority whatsoever heretofore made, granted, allowed, or confirmed by any Act of Parliament now in force, so long as the same shall so continue in force.

Warrants  
granted to  
justices saved.

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

Charters  
granted to  
corporations  
saved.

9. Provided also, and it is hereby further intended, declared, and enacted, That this Act or any thing therein contained shall not in any wise extend or be prejudicial unto the city of London, or to any city borough or town corporate within this realm, for or concerning any grants, charters, or letters patents, to them or any of them made or granted, or for or concerning any custom or customs used by or within them or any of them: or unto any corporations, companies, or fellowships of any art, trade, occupation, or mystery, or to any companies or societies of merchants within this realm, erected for the maintenance, enlargement, or ordering of any trade of merchandise; but that the same charters, customs, corporations, companies, fellowships, and societies, and their liberties, privileges,

powers and immunities shall be and continue of such force and effects as they were before the making of this Act, and of none other; any thing before in this Act contained to the contrary in any wise notwithstanding.(a)

(a) The remaining sections of this Act have been repealed by either the Statute Law Revision Act (1863), or the Patents, Designs, and Trade Marks Act (1883), and are, therefore, not printed here.

**PATENTS, DESIGNS, AND TRADE MARKS  
ACT, 1883.**

[46 & 47 VICT. c. 57.]

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

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

BE it enacted by the Queen's Most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :

**PART I.**

**PRELIMINARY.**

- Short title.**        1. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1883.
- Division of Act into parts.**    2. This Act is divided into parts, as follows :
- Part I.—PRELIMINARY.  
Part II.—PATENTS.  
Part III.—DESIGNS.  
Part IV.—TRADE MARKS.  
Part V.—GENERAL.
- Commencement of Act.**        3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December one thousand eight hundred and eighty-three.

PART II.

PATENTS.

*Application for and Grant of Patent.*

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

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

5. (1) An application for a patent must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed; and must be left at, or sent by post to, the Patent Office in the prescribed manner. Application and specification.

(2) An application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or complete specification.(b)

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

(4) A complete specification, whether left on application or subsequently, must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required.(c)

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

6. The Comptroller shall refer every application to an examiner, who shall ascertain and report to the Comptroller whether the nature of the invention has been fairly described, and the application, specification, and drawings, (if any) have been prepared in the prescribed manner, and the title sufficiently indicates the subject-matter of the invention. Reference of application to examiner.

7. (1) *If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the Comptroller may require that the application, specification, or drawings be amended before he proceeds with the application.* Power for Comptroller to refuse application or require amendment.

(a) 48 & 49 Vict. c. 63, s. 5, p. 681 post.

(b) 48 & 49 Vict. c. 63, s. 2, p. 680 post.

(c) 49 & 50 Vict. c. 37, s. 2, p. 682 post.

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

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

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

(5) *If, after an application has been made, but before a patent has been sealed, an application is made, accompanied by a specification bearing the same or a similar title, it shall be the duty of the examiner to report to the Comptroller whether the specification appears to him to comprise the same invention; and, if he reports in the affirmative, the Comptroller shall give notice to the applicants that he has so reported.*

(6) *Where the examiner reports in the affirmative, the Comptroller may determine, subject to an appeal to the law officer, whether the invention comprised in both applications is the same, and if so he may refuse to seal a patent on the application of the second applicant.(d)*

Time for leaving complete specification.

8. (1) *If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within nine months from the date of application.(e)*

(2) *Unless a complete specification is left within that time the application shall be deemed to be abandoned.*

Comparison of provisional and complete specification.

9. (1) *Where a complete specification is left after a provisional specification, the Comptroller shall refer both specifications to an examiner for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification.*

(2) *If the examiner reports that the conditions hereinbefore contained have not been complied with, the Comptroller may refuse to accept the complete specification unless and until the same shall have been amended to his satisfaction; but any such refusal shall be subject to appeal to the law officer.*

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

(4) *Unless a complete specification is accepted within twelve months from the date of application, then (save in the case of*

(d) 51 & 52 Vict. c. 50, s. 2, p. 684 *post*.

(e) 48 & 49 Vict. c. 62, s. 3, p. 682 *post*.

an appeal having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months, become void.(f)

(5) Reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, *other than an appeal to the law officer under this Act*, (g) unless the Court or officer having power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed.

10. On acceptance of the complete specification the Comptroller shall advertise the acceptance; and the application and specification or specifications, with the drawings (if any), shall be open to public inspection. Advertisement on acceptance of complete specification.

11. (1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or on the ground that the invention has been patented in this country on an application of prior date, *or on the ground of an examiner having reported to the Comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title, and accompanying a previous application, but on no other ground.*(h) Opposition to grant of patent.

(2) Where such notice is given the Comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the person so giving notice, if desirous of being heard, decide on the case, but subject to appeal to the law officer.

(3) The law officer shall, if required, hear the applicant and any person so giving notice, and being, in the opinion of the law officer, entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made.

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

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

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

(f) 48 & 49 Vict. c. 63, s. 3, p. 680 *post*.

(g) *Ibid.* (h) 51 & 52 Vict. c. 50, s. 4, p. 685 *post*.

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

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

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

Date of patent. 13. Every patent shall be dated and sealed as of the day of the application: Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification: Provided also, that in case of more than one application for a patent for the same invention the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application.<sup>(k)</sup>

*Provisional Protection.*

Provisional protection. 14. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the same; and such protection from the consequences of use and publication is in this Act referred to as provisional protection.

*Protection by Complete Specification*

Effect of acceptance of complete specification. 15. After the acceptance of a complete specification, and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification: Provided that an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him.

*Patent.*

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

(i) 48 & 49 Vict. c. 63, s. 3, p. 680 *post*.  
 (k) 48 & 49 Vict. c. 63, s. 4, p. 681 *post*.



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

(2) But every patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to make the prescribed payments within the prescribed times.

(3) If, nevertheless, in any case, by accident, mistake, or inadvertence, a patentee fails to make any prescribed payment within the prescribed time, he may apply to the Comptroller for an enlargement of the time for making that payment.

(4) Thereupon the Comptroller shall, if satisfied that the failure has arisen from any of the above-mentioned causes, on receipt of the prescribed fee for enlargement, not exceeding ten pounds, enlarge the time accordingly, subject to the following conditions:

(a) The time for making any payment shall not in any case be enlarged for more than three months.

(b) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

#### *Amendment of Specification.*

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

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

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

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

(5) Where no notice of opposition is given, or the person so giving notice does not appear, the Comptroller shall determine whether and

subject to what conditions, if any, the amendment ought to be allowed.

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

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

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

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

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

Power to dis-  
claim part of  
invention  
during action,  
&c.

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

Restriction  
on recovery of  
damages.

20. Where an amendment by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge.

Advertisement  
of amendment.

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

#### *Compulsory Licences.*

Power for  
Board to order  
grant of  
licences.

22. If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licences on reasonable terms—

(a) The patent is not being worked in the United Kingdom; or

(l) 51 & 52 Vict. c. 50, s. 5, p. 685 *post*.

(b) The reasonable requirements of the public with respect to the invention cannot be supplied; or

(c) Any person is prevented from working or using to the best advantage an invention of which he is possessed,

the Board may order the patentee to grant licences on such terms as to the amount of royalties, security for payment, or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

#### *Register of Patents.*

23. (1) There shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmission of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed.

(2) The register of patents shall be *prima facie* evidence of any matters of this Act directed or authorised to be inserted therein.

(3) Copies of deeds, licences, and any other documents affecting the proprietorship in any letters patent or in any licence thereunder, must be supplied to the Comptroller in the prescribed manner for filing in the Patent Office.

#### *Fees.*

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

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

#### *Extension of Term of Patent.*

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

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

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 the counsel on the petition.

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

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

(6) It shall be lawful for her Majesty in Council to make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.

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

#### *Revocation.*

Revocation of  
patent.

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

(2) Revocation of a patent may be obtained on petition to a Court.

(3) Every ground on which a patent might, at the commencement of this Act, be repealed by *scire facias* shall be available by way of defence to an action of infringement and shall also be a ground of revocation.

(4) A petition for revocation of a patent may be presented by—

(a) The Attorney-General in England or Ireland, or the Lord Advocate in Scotland :

- (b) Any person authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland :
- (c) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims :
- (d) Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee :
- (e) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

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

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

(7) The defendant shall be entitled to begin, and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent the defendant shall be entitled to reply.

(8) Where a patent has been revoked on the ground of fraud, the Comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.

*Crown.*

27. (1) A patent shall have to all intents the like effect as against her Majesty the Queen, her heirs and successors, as it has against a subject. Patent to bind Crown.

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

*Legal Proceedings.*

Hearing with  
assessor.

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

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

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

Delivery of  
particulars.

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

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

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

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

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

(6) On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a Judge to have been proven or to have been reasonable and proper, without regard to the general costs of the case.

Order for  
inspection, &c.,  
in action.

30. In an action for infringement of a patent, the Court or a Judge may on the application of either party make such order for an injunction, inspection, or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a Judge may see fit.

Certificate of  
validity  
questioned and  
costs thereon.

31. In an action for infringement of a patent, the Court or a Judge may certify that the validity of the patent came in question;

and if the Court or a Judge so certifies, then in any subsequent action for infringement the plaintiff in that action on obtaining a final order or judgment in his favour shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or Judge trying the action certifies that he ought not to have the same.

32. Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale, or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats: Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

Remedy in case of groundless threats of legal proceedings.

#### *Miscellaneous.*

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

Patent for one invention only.

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

Patent on application of representative of deceased inventor.

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

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

Patent to first inventor not invalidated by application in fraud of him.

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

Assignment for particular places.

Loss or destruction of patent.

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

Proceedings and costs before law officer.

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

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

39. The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention, or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely—

(a) The exhibitor must, before exhibiting the invention, give the Comptroller the prescribed notice of his intention to do so; and

(b) The application for a patent must be made before or within six months from the date of the opening of the exhibition.<sup>(m)</sup>

Publication of illustrated journal, indexes, &c.

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

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

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

(m) 49 & 50 Vict. c. 37, s. 3, p. 682 *post*.



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

Patent  
Museum.

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

Power to re-  
quire models  
on payment.

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

Foreign  
vessels in  
British waters.

(2) But this section shall not extend to vessels of any foreign State of which the laws authorise subjects of such foreign State, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign State, or in the waters within the jurisdiction of its Courts, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign State.

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

Assignment to  
Secretary for  
War of certain  
inventions.

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

(3) Where any such assignment has been made to the Secretary of State, he may at any time before the application for a patent for

the invention, or before publication of the specification or specifications, certify to the Comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

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

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

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

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

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

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

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

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

(12) The communication of any invention for any improvement

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

*Existing Patents.*

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

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

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

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

*Definitions.*

46. In and for the purposes of this Act—

“Patent” means letters patent for an invention :

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

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

In Scotland “injunction” means “interdict.”

Definitions  
of patent,  
patentee, and  
invention.

## PART III.

## DESIGNS.

*Registration of Designs.*

Application for  
registration of  
designs.

47. (1) The Comptroller may, on application by or on behalf of any person claiming to be the proprietor of any new or original design not previously published in the United Kingdom, register the design under this part of this Act.

(2) The application must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, the Patent Office in the prescribed manner.

(3) The application must contain a statement of the nature of the design, and the class or classes of goods in which the applicant desires that the design be registered.

(4) The same design may be registered in more than one class.

(5) In case of doubt as to the class in which a design ought to be registered, the Comptroller may decide the question.

(6) The Comptroller may, if he thinks fit, refuse to register any design presented to him for registration, but any person aggrieved by any such refusal may appeal therefrom to the Board of Trade.

(7) The Board of Trade shall, if required, hear the applicant and the Comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

Drawings, &c.,  
to be furnished  
on application.

48. (1) On application for registration of a design the applicant shall furnish to the Comptroller the prescribed number of copies of drawings, photographs, or tracings of the design, sufficient, in the opinion of the Comptroller, for enabling him to identify the design; or the applicant may, instead of such copies, furnish exact representations or specimens of the design.

(2) The Comptroller may, if he thinks fit, refuse any drawing, photograph, tracing, representation, or specimen which is not, in his opinion, suitable for the official records.

Certificate of  
registration.

49. (1) The Comptroller shall grant a certificate of registration to the proprietor of the design when registered.

(2) The Comptroller may, in case of loss of the actual certificate, or in any other case in which he deems it expedient, grant a copy or copies of the certificate.

*Copyright in Registered Designs.*

Copyright on  
registration.

50. (1) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have

copyright in the design during five years from the date of registration.

(2) Before delivery on sale of any articles to which a registered design has been applied, the proprietor must (if exact representations or specimens were not furnished on the application for registration) furnish to the Comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so the Comptroller may erase his name from the register, and thereupon his copyright in the design shall cease.

51. Before delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark, or with the prescribed word or words, or figures, denoting that the design is registered; and if he fails to do so the copyright in the design shall cease, unless the proprietor shows that he took all proper steps to ensure the marking of the article. Marking registered designs.

52. (1) During the existence of a copyright in a design, the design shall not be open to inspection except by the proprietor, or a person authorised in writing by the proprietor, or a person authorised by the Comptroller or by the Court, and furnishing such information as may enable the Comptroller to identify the design, nor except in the presence of the Comptroller, or of an officer acting under him, nor except on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof. Inspection of registered designs.

(2) When the copyright in a design has ceased, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.

53. On the request of any person producing a particular design, together with its mark of registration, or producing only its mark of registration, or furnishing such information as may enable the Comptroller to identify the design, and on payment of the prescribed fee, it shall be the duty of the Comptroller to inform such person whether the registration still exists in respect of such design, and if so, in respect of what class or classes of goods, and stating also the date of registration, and the name and address of the registered proprietor. Information as to existence of copyright.

54. If a registered design is used in manufacture in any foreign country and is not used in this country within six months of its registration in this country, the copyright in the design shall cease. Cesser of copyright in certain events.

(n) 51 & 52 Vict. c. 50, s. 6, p. 685 *post*.

*Register of Designs.*

Register of designs.

55. (1) There shall be kept at the Patent Office a book called the Register of Designs, wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may from time to time be prescribed.

(2) The register of designs shall be *prima facie* evidence of any matters by this Act directed or authorised to be entered therein.

*Fees.*

Fees on registration, &c.

56. There shall be paid in respect of applications and registration and other matters under this part of this Act such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury shall from time to time direct.

*Industrial and International Exhibitions.*

Exhibition at industrial or international exhibition not to prevent or invalidate registration.

57. The exhibition at an industrial or international exhibition, certified as such by the Board of Trade, or the exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof, provided that both the following conditions are complied with, namely:—

- (a) The exhibitor must, before exhibiting the design or article, or publishing a description of the design, give the Comptroller the prescribed notice of his intention to do so; and
- (b) The application for registration must be made before or within six months from the date of the opening of the exhibition.(o)

*Legal Proceedings.*

Penalty on piracy of registered design.

58. During the existence of copyright in any design

- (a) It shall not be lawful for any person without the licence or written consent of the registered proprietor to apply (o)

(o) 49 & 50 Vict. c. 37, s. 3, p. 682 *post*.

such design or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale, to any article of manufacture or to any substance artificial or natural or partly artificial and partly natural ; and

- (b) It shall not be lawful for any person to publish or expose for sale any article of manufacture of any substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor.

Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract debt by action in any Court of competent jurisdiction.<sup>(p)</sup>

59. Notwithstanding the remedy given by this Act for the recovery of such penalty as aforesaid, the registered proprietor of any design may (if he elects to do so) bring an action for the recovery of any damages arising from the application of any such design, or of any fraudulent or obvious imitation thereof for the purpose of sale, to any article of manufacture or substance, or from the publication, sale, or exposure for sale by any person of any article or substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, such person knowing that the proprietor had not given his consent to such application.

Action for damages.

#### *Definitions.*

60. In and for the purposes of this Act—

“Design” means any design applicable to any article of manufacture, or to any substance artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for a sculpture, or other thing within the protection of the Sculpture Copyright Act of the year 1814 (fifty-fourth George the Third, chapter fifty-six).

Definition of “design,” “copyright.”

“Copyright means the exclusive right to apply a design to any

<sup>(p)</sup> 49 & 50 Vict. c. 37, s. 3, p. 682 *post*.

article of manufacture or to any such substance as aforesaid in the class or classes in which the design is registered.

Definition of proprietor.

61. The author of any new and original design shall be considered the proprietor thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor, and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person or otherwise, and also every person on whom the property in such design or such right to the application thereof shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been acquired, and to that extent, but not otherwise.

## PART IV.

### TRADE MARKS.

#### *Registration of Trade Marks.*

Application for registration.

62. (1) The Comptroller may, on application by or on behalf of any person claiming to be the proprietor of a trade mark, register the trade mark.

(2) The application must be made in the form set forth in the First Schedule of this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, *the Patent Office in the prescribed manner.*(*q*)

(3) The application must be accompanied by the prescribed number of representations of the trade mark, and must state the particular goods or classes of goods in connection with which the applicant desires the trade mark to be registered.

(4) The Comptroller may, if he thinks fit, refuse to register a trade mark, but any such refusal shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the Comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(5) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court; and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.(*q*)

(*q*) 51 & 52 Vict. c. 50, s. 8, p. 686 *post*.



63. Where registration of a trade mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant, *the application shall be deemed to be abandoned.*(r) Limit of time for proceeding with application.

64. (1) *For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars :* Conditions of registration of trade mark.

(a) *A name of an individual or firm printed, impressed, or woven in some particular or distinctive manner ; and*

(b) *A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark ; or,*

(c) *A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use.*

(2) *There may be added to any one or more of these particulars any letters, words, or figures, or combination of letters, words or figures, or of any of them.*

(3) *Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy five may be registered as a trade mark under this part of this Act.*(s)

65. A trade mark must be registered for particular goods or classes of goods. Connection of trade mark with goods.

66. When a person claiming to be the proprietor of several trade marks which, while resembling each other in the material particulars thereof, yet differ in respect of (a) the statement of the goods for which they are respectively used or proposed to be used, or (b) statements of numbers, or (c) statements of price, or (d) statements of quality, or (e) statements of names of places, seeks to register such trade marks, they may be registered as a series in one registration. A series of trade marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade marks composing a series shall be deemed and treated as registered separately. Registration of a series of marks.

67. A trade mark may be registered in any colour,(t) and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour.(t) Trade marks may be registered in any colour.

68. Every application for registration of a trade mark under this part of this Act shall as soon as may be after its receipt be advertised by the Comptroller.(u) Advertisement of application.

(r) 51 & 52 Vict. c. 50, s. 9, p. 686 *post.*

(s) 51 & 52 Vict. c. 50, s. 10, p. 686 *post.*

(t) 51 & 52 Vict. c. 59, s. 11, p. 687 *post.*

(u) 51 & 52 Vict. c. 50, s. 12, p. 687 *post.*

Opposition to registration.

69. (1) Any person may within *two months (x)* of the *first (x)* advertisement of the application, give notice in duplicate at the Patent Office of opposition to registration of the trade mark, and the Comptroller shall send one copy of such notice to the applicant.

(2) Within *two months (y)* after receipt of such notice or such further time as the Comptroller may allow, the applicant may send to the Comptroller a counter statement in duplicate of the grounds on which he relies for his application, and if he does not do so shall be deemed to have abandoned his application.

(3) *If the applicant sends such counter statement, the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall require him to give security in such manner and to such amount as the Comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made or such further time as the Comptroller may allow, the opposition shall be deemed to be withdrawn.*(z)

(4) *If the person who gave notice of opposition duly gives such security as aforesaid, the Comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court.*(z)

Assignment and transmission of trade mark.

70. A trade mark, when registered, shall be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill.

Conflicting claims to registration.

71. Where each of several persons claims to be registered as proprietors of the same trade mark, the Comptroller may refuse to register any of them until their rights have been determined according to law, and the Comptroller may himself submit or require the claimants to submit their rights to the Court.

Restrictions on registration.

72. (1) Except where the Court has decided that two or more persons are entitled to be registered as proprietors of the same trade mark, the Comptroller shall not register in respect of the same goods or description of goods a trade mark identical with the one already on the register with respect to such goods or description of goods.

(2) (a) The Comptroller shall not register with respect to the same goods or description of goods a trade mark *so nearly resembling (a)* a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive.

Further restriction on registration.

73. It shall not be lawful to register as part of or in combination with a trade mark any words the exclusive use of which would by

(x) 51 & 52 Vict. c. 50, s. 13, sub-s. 1 & 2, p. 687 *post*.

(y) 51 & 52 Vict. c. 50, s. 13, sub-s. 3, p. 687 *post*.

(z) 51 & 52 Vict. c. 50, s. 13, sub-s. 4, p. 687 *post*.

(a) 51 & 52 Vict. c. 50, s. 14, p. 688 *post*.

reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a Court of justice, or any scandalous design.

74. (1) Nothing in this Act shall be construed to prevent the Comptroller entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade mark—

*Saving for power to provide for entry on register of common marks as additions to trade marks.*

(a) In the case of an application for registration of a trade mark used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures, though the same is common to the trade in the goods with respect to which the application is made ;

(b) In the case of an application for registration of a trade mark not used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made ;

(2) *The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register.*(b)

(3) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or were, before the thirteenth day of August one thousand eight hundred and seventy-five, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods.

#### *Effect of Registration.*

75. *Registration of a trade mark shall be deemed to be equivalent to public use of the trade mark.*(c)

*Registration equivalent to public use.*

76. The registration of a person as proprietor of a trade mark shall be *prima facie* evidence of his right to the exclusive use of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of this Act.

*Right of first proprietor to exclusive use of trade mark.*

(b) 51 & 52 Vict. c. 50, s. 16, p. 688 *post*.

(c) 51 & 52 Vict. c. 50, s. 17, p. 688 *post*.

Restrictions on actions for infringement, and on defence to action in certain cases.

77. A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade mark unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the thirteenth day of August one thousand eight hundred and seventy-five, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The Comptroller may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused.<sup>(d)</sup>

#### *Register of Trade Marks.*

Register of trade marks.

78. There shall be kept at the Patent Office a book called the Register of Trade Marks, wherein shall be entered the names and addresses of proprietors of registered trade marks, notifications of assignments and of transmissions of trade marks, and such other matters as may be from time to time prescribed.

Removal of trade mark after fourteen years unless fee paid.

79. (1) At a time not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade mark, the Comptroller shall send notice to the registered proprietor that the trade mark will be removed from the register unless the proprietor pays to the Comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee; and if such fee be not previously paid he shall at the expiration of one month from the date of the giving of the first notice send a second notice to the same effect.

(2) If such fee be not paid before the expiration of such fourteen years the Comptroller may after the end of three months from the expiration of such fourteen years remove the mark from the register, and so from time to time at the expiration of every period of fourteen years.

(3) If before the expiration of the said three months the registered proprietor pays the said fee together with the additional prescribed fee, the Comptroller may, without removing such trade mark from the register, accept the said fee as if it had been paid before the expiration of the said fourteen years.

(4) Where after the said three months a trade mark has been removed from the register for nonpayment of the prescribed fee, the Comptroller may, if satisfied that it is just so to do, restore such trade mark to the register on payment of the prescribed additional fee.

<sup>(d)</sup> 51 & 52 Vict. c. 50, s. 18, p. 688 *post*.

(5) Where a trade mark has been removed from the register for nonpayment of the fee or otherwise, such trade mark shall nevertheless for the purpose of any application for registration during the *five years (e)* next after the date of such removal, be deemed to be a trade mark which is already registered.*(e)*

#### *Fees.*

80. There shall be paid in respect of applications and registration and other matters under this part of this Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of her Majesty's Exchequer in such manner as the Treasury may from time to time direct.

Fees for registration, &c.

#### *Sheffield Marks.*

81. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company) and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers, and assistants of the company, the following provisions shall have effect:

Registration by Cutlers' Company of Sheffield marks.

(1) The Cutlers' Company shall establish and keep at Sheffield a new register of trade marks (in this Act called the Sheffield register):

(2) *The Cutlers' Company shall enter in the Sheffield register, in respect of cutlery, edge tools, or raw steel and the goods mentioned in the next sub-section, all the trade marks entered before the commencement of this Act in respect of cutlery, edge tools, or raw steel, and such goods in the register established under the Trade Marks Registration Act, 1887, belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such register, in respect of the same goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the register established under the Trade Marks Registration Act, 1875.**(f)*

(3) An application for registration of a trade mark used on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel

*(e)* 51 & 52 Vict. c. 50, s. 19, p. 688 *post*.

*(f)* 51 & 52 Vict. c. 50, s. 20, sub-s. 1, p. 689 *post*.

*and iron combined, whether with or without a cutting edge,(g)* shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company :

- (4) Every application so made to the Cutlers' Company shall be notified to the Comptroller in the prescribed manner, and unless the Comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner :
- (5) If the Comptroller gives notice of objection as aforesaid the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court :
- (6) Upon the registration of a trade mark in the Sheffield register the Cutlers' Company shall give notice thereof to the Comptroller, who shall thereupon enter the mark in the register of trade marks ; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the Comptroller on that day.
- (7) *The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the register of trade marks, the effect of such registration, and the assignment and transmission of rights in a registered trade mark shall apply in the case of applications and registration in the Sheffield register ; and notice of every entry made in the Sheffield register must be given to the Comptroller by the Cutlers' Company, save and except that the provisions of this sub-section shall not prejudice or affect any life, estate, and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register.(h)*
- (8) Where the Comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge,(i)* he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company :
- (9) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' register

(g) 51 & 52 Vict. c. 50, s. 20, sub-s. 2, p. 689 *post.*

(h) 51 & 52 Vict. c. 50, s. 20, sub-s. 3, p. 689 *post.*

(i) 51 & 52 Vict. c. 50, s. 20, sub-s. 2, p. 689 *post.*

of corporate trade marks, and thereupon all marks entered therein shall, unless entered in the Sheffield register, be deemed to have been abandoned :

- (10) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of two or more trade marks :
- (11) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of a trade mark or trade marks :
- (12) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the Comptroller, who shall have power to confirm, reverse, or modify the decision, but the decision of the Comptroller shall be subject to a further appeal to the Court :
- (13) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Company Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield register.<sup>(k)</sup>

## PART V.

### GENERAL.

#### *Patent Office and Proceedings thereat.*

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

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

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

(4) Any act or thing directed to be done by or to the Comptroller

(k) 51 & 52 Vict. c. 50, s. 20, sub-s. 4, p. 690 *post*.

may, in his absence, be done by or to any officer for the time being in that behalf authorised by the Board of Trade.

Officers and clerks.

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

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

Seal of Patent Office.

84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence.

Trust not to be entered in registers.

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

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

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

Entry of assignments and transmissions in registers.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the Comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade mark, in the register of patents, designs, or trade marks, as the case may be. The person for the time being entered in the register of patents, designs, or trade marks, as proprietor of a patent, copyright in a design or trade mark, as the case may be, shall, subject to (l) any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the same and to give effectual receipts for any consideration for such assignment, licence, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property.

Inspection of and extracts from registers.

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

(l) 51 & 52 Vict. c. 50, s. 21, p. 690 *post*.

(m) 51 & 52 Vict. c. 50, s. 22, p. 690 *post*.



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

Sealed copies to be received in evidence.

90. (1) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person<sup>(n)</sup> from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

Rectification of registers by Court.

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

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

91. The Comptroller may, on request in writing, accompanied by the prescribed fee:—

Power for Comptroller to correct clerical errors.

- (a) Correct any clerical error in or in connection with an application for a patent, or for registration of a design or trade mark; or
- (b) Correct any clerical error in the name, style, or address of the registered proprietor of a patent, design, or trade mark;
- (c) Cancel the entry or part of the entry of a trade mark on the register: Provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark.<sup>(o)</sup>

92. (1) The registered proprietor of any registered trade mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

Alteration of registered mark.

(2) Notice of any intended application to the Court under this

<sup>(n)</sup> 51 & 52 Vict. c. 50, s. 23, p. 690 *post*.  
<sup>(o)</sup> 51 & 52 Vict. c. 50, s. 24, p. 690 *post*.

section shall be given to the Comptroller by the applicant; and the Comptroller shall be entitled to be heard on the application.

(3) If the Court grants leave, the Comptroller shall, on proof thereof and on payment of the prescribed fee, cause the register to be altered in conformity with the order of leave.

Falsification  
of entries in  
registers.

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

Exercise of  
discretionary  
power by  
Comptroller.

94. Where any discretionary power is by this Act given to the Comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

Power of  
Comptroller  
to take  
directions of  
law officers.

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

Certificate of  
Comptroller to  
be evidence.

96. A certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *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.

Applications  
and notices  
by post.

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

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

Provision  
as to days  
for leaving  
documents at  
office.

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

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

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

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

(a) For regulating the practice of registration under this Act:

(b) For classifying goods for the purposes of designs and trade marks:

(c) For making or requiring duplicates or specifications, amendments, drawings, and other documents:

(d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, amendments and other documents:

(e) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office; and providing for the inspection of indexes and abridgments and other documents:

(f) For regulating (with the approval of the Treasury) the

Transmission of certified printed copies of specifications, &c.

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

presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad :

(g) Generally for regulating the business of the Patent Office and all things by this Act placed under the direction or control of the Comptroller, or of the Board of Trade.

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

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

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

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

Annual  
reports of  
Comptroller.

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

*International and Colonial Arrangements.*

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

103. (1) If Her Majesty is pleased to make any arrangement with the Government or Governments of any foreign State or States for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such State, shall be entitled to a patent for his invention or to registration of his design or trade mark (as the case may be) under this Act, in priority to other

(p) 51 & 52 Vict. c. 50, s. 25, p. 690 *post*.

applicants; and such patent or registration shall have the same date as the *date of the protection obtained (q)* in such foreign State.

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

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

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

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

(4) The provisions of this section shall apply only in the case of those foreign States with respect to which Her Majesty shall from time to time by Order in 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 the State.

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

Provision for colonies and India.

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

(q) 48 & 49 Vict. c. 63, s. 6, p. 68i post.

*Offences.*

Penalty on  
falsely repre-  
senting articles  
to be patented.

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

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

Penalty on  
unauthorised  
assumption  
of Royal arms.

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

*Scotland ; Ireland ; &c.*

Saving for  
Courts in  
Scotland.

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

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

Summary  
proceedings in  
Scotland.

108. In Scotland any offence under this Act to be punishable on summary conviction may be prosecuted in the sheriff court.

Proceedings  
for revocation  
of patent in  
Scotland.

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

(2) Service of all writs and summonses in that action shall be

made according to the forms and practice existing at the commencement of this Act.

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

111. (1) The provisions of this Act conferring a special jurisdiction on the court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean any Division of the said Court; and with reference to any such proceedings in Ireland, the terms "the Court" and "the Court of Appeal" respectively mean the High Court of Justice in Ireland and Her Majesty's Court of Appeal in Ireland. General saving for jurisdiction of Courts.

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

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

Isle of Man.

- (1) Nothing in this Act shall affect the jurisdiction of the courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those courts:
- (2) The punishment for a misdemeanor under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court;
- (3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.<sup>(r)</sup>

*Repeal; Transitional Provisions; Savings.*

113. The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not— Repeal and saving for past operation of

(r) 51 & 52 Vict. c. 50, s. 26, p. 690 *post*.

repealed  
enactments,  
&c.

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

Former  
registers to  
be deemed  
continued.

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

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

Saving for  
existing rules.

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

Saving for  
prerogative

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

#### *General Definitions.*

General  
definitions.

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

“ Person ” includes a body corporate :

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

<sup>(s)</sup> 51 & 52 Vict. c. 50, s. 27, p. 691 *post*.



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

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

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

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

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

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

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

## SCHEDULES.

### THE FIRST SCHEDULE.

#### FORMS OF APPLICATION, &c.

*Form A.(u)*

Form of Application.

*Form B.(u)*

Form of Provisional Specification.

*Form C.(u)*

Form of Complete Specification.

<sup>(t)</sup> 51 & 52 Vict. c. 50, s. 1, p. 684 *post*.

<sup>(u)</sup> For forms A, B, and C, the Board of Trade have, under the powers conferred by s. 101, sub-s. 2, of the Act, substituted the forms A, A1, A2, B and C, which will be found at pp. 744-751 *post*.

*Form D.*

Form of Patent.

[This form will be found at p. 741 *post.*]*Form E.*

Form of Application of Registration of Design.

*Form F.*

Form of Application for Registration of Trade Mark.

## THE SECOND SCHEDULE.

Fees on instrument for obtaining Patents and Renewal.

These fees are all included in the List of Fees given in the First Schedule to the Patent Rules, 1890; *see* p. 839 *post.*

## THE THIRD SCHEDULE.

*Enactments repealed.*

21 James I. c. 3. [1623.]	The Statute of Monopolies. In part; namely,— Sections ten, eleven, and twelve.
5 & 6 Will. IV. c. 62. [1835.] In part.	The Statutory Declarations Act, 1835. In part; namely,— Section eleven.
5 & 6 Will. IV. c. 83. [1835.]	An Act to amend the law touching letters patent for inventions.
2 & 3 Vict. c. 67. [1839.]	An Act to amend an Act of the fifth and sixth years of the reign of King William the Fourth, intituled "An Act to amend the law touching letters patent for inventions."
5 & 6 Vict. c. 100. [1842.]	An Act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
6 & 7 Vict. c. 65. [1843.]	An Act to amend the laws relating to the copyright of designs.

7 & 8 Vict. c. 69.(a) [1844.] In part.	An Act for amending an Act passed in the fourth year of the reign of His late Majesty, intituled "An Act for the better administration of justice in His Majesty's Privy Council, and to extend its jurisdiction and powers." In part ; namely,— Sections two to five, both included.
13 & 14 Vict. c. 104. [1850.]	An Act to extend and amend the Acts relating to the copyright of designs.
15 & 16 Vict. c. 83. [1852.]	The Patent Law Amendment Act, 1852.
16 & 17 Vict. c. 5. [1853.]	An Act to substitute stamp duties for fees on passing letters patent for inventions, and to provide for the purchase for the public use of certain indexes of specifications.
16 & 17 Vict. c. 115. [1853.]	An Act to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act.
21 & 22 Vict. c. 70 1858.]	An Act to amend the Act of the fifth and sixth years of Her present Majesty, to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
22 Vict. c. 13. [1859.]	An Act to amend the law concerning patents for inventions with respect to inventions for improvements in instruments and munitions of war.
24 & 25 Vict. c. 73. [1861.]	An Act to amend the law relating to the copyright of designs.
28 & 29 Vict. c. 3. [1865.]	The Industrial Exhibitions Act, 1865.
33 & 34 Vict. c. 27. [1870.]	The Protection of Inventions Act, 1870.
33 & 34 Vict. c. 97. [1870.]	The Stamp Act, 1870. In part ; namely,— Section sixty-five, and in the Schedule the words and figures, "Certificate of the registration of a design . . £5 0 0 And see section 65."
38 & 39 Vict. c. 91. [1875.]	The Trade Marks Registration Act, 1875.
38 & 39 Vict. c. 93. [1875.]	The Copyright of Designs Act, 1875.
39 & 40 Vict. c. 33. [1876.]	The Trade Marks Registration Amendment Act, 1876.
40 & 41 Vict. c. 37. [1877.]	The Trade Marks Registration Extension Act, 1877.
43 & 44 Vict. c. 10. [1880.]	The Great Seal Act, 1880. In part ; namely,— Section five.
45 & 46 Vict. c. 72. [1882.]	The Revenue, Friendly Societies, and National Debt Act, 1882. In part ; namely,— Section sixteen.

(a) Note.—Sections six and seven of this Act are repealed by the Statute Law Revision (No. 2) Act, 1874.

PATENTS, DESIGNS, &c., AMENDMENT ACT, 1885.

48 & 49 VICT. c. 63.

*An Act to amend the Patents, Designs, and Trade Marks Act, 1883.*

[14th August, 1885.]

BE it enacted by the Queen's Most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons in this present Parliament assembled, and by the authority of the same, as follows :

Construction  
and short  
title.

1. This Act shall be construed as one with the Patents, Designs, and Trade Marks Act, 1883 (in this Act referred to as the principal Act).

This Act may be cited as the Patents, Designs, and Trade Marks (Amendment) Act, 1885, and this Act and the principal Act may be cited together as the Patents, Designs, and Trade Marks Act, 1883 and 1885.

Amendment  
of s. 5 of  
46 & 47 Vict.  
c. 57.

2. Whereas sub-section two of section five of the principal Act requires a declaration to be made by an applicant for a patent to the effect in that sub-section mentioned, and doubts have arisen as to the nature of that declaration, and it is expedient to remove such doubts ; be it therefore enacted that :

5 & 6 W. IV.  
c. 62.

The declaration mentioned in sub-section two of section five of the principal Act may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed.

Amendment  
of ss. 8, 9, and  
12 of 46 & 47  
Vict. c. 57.

3. Whereas under the principal Act a complete specification is required (by section eight) to be left within nine months, and (by section nine) to be accepted within twelve months, from the date of application, and a patent is required by section twelve to be sealed within fifteen months from the date of application; and it is expedient to empower the Comptroller to extend in certain cases the said times ; be it therefore enacted as follows :

A complete specification may be left and accepted within such extended times, not exceeding one month and three months respectively after the said nine and twelve months respectively as the Comptroller may on payment of the prescribed fee allow, and where such extension of time has been allowed a further

extension of four months after the said fifteen months shall be allowed for the sealing of the patent; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act.

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

Specifications,  
&c., not to be  
published  
unless applica-  
tion accepted.

5. Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor; be it therefore enacted and declared that it has been and is lawful under the principal Act to grant such a patent.

Power to  
grant patents  
to several per-  
sons jointly.

6. In sub-section one of section one hundred and three of the principal Act the words "date of the application" shall be substituted for the words "date of the protection obtained."

Amendment  
of s. 103 of  
46 & 47 Vict.  
c. 57.

PATENTS ACT, 1886.

49 & 50 VICT. c. 37.

*An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions. [25th June, 1886.]*

46 & 47 Vict.  
c. 57.

WHEREAS by section five of the Patents, Designs, and Trade Marks Acts, 1883, specifications, whether provisional or complete, must be accompanied by drawings, if required, and doubts have arisen as to whether it is sufficient that a complete specification refers to the drawings by which the provisional specification was accompanied, and it is expedient to remove such doubts:

Be it therefore enacted by the Queen's Most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons in this present Parliament assembled, and by the authority of the same, as follows:

Short title and  
construction.  
46 & 47 Vict.  
c. 57.  
48 & 49 Vict.  
c. 63.

1. This Act may be cited as the Patents Act, 1886, and shall be construed as one with the Patents, Designs, and Trade Marks Acts, 1883 and 1885, and, together with those Acts, may be cited as the Patents, Designs, and Trade Marks Acts, 1883 to 1886.

The same  
drawings may  
accompany  
both specifica-  
tions.

2. The requirement of sub-section four of section five of the Patents, Designs, and Trade Marks Act, 1883, as to drawings shall not be deemed to be insufficiently complied with by reason only that, instead of being accompanied by drawings, the complete specification refers to the drawings which accompanied the provisional specification. And no patent hitherto sealed shall be invalid by reason only that the complete specification was not accompanied by drawings, but referred to those which accompanied the provisional specification.

Protection  
of patents  
and designs  
exhibited at  
international  
exhibitions.

3. Whereas by section thirty-nine of the Patents, Designs, and Trade Marks Act, 1883, as respects patents, and by section fifty-seven of the same Act as respects designs, provision is made that the exhibition of an invention or design at an industrial or international exhibition, certified as such by the Board of Trade, shall not prejudice the rights of the inventor or proprietor thereof, subject to the conditions therein mentioned, one of which is that the exhibitor

must, before exhibiting the invention, design, or article, or publishing a description of a design, give the Comptroller the prescribed notice of his intention to do so :

And whereas it is expedient to provide for the extension of the said sections to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows :

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

PATENTS, DESIGNS, AND TRADE MARKS ACT,  
1888.

51 & 52 VICT. c. 50.

*An Act to amend the Patents, Designs, and Trade Marks Act, 1883.  
[24th December 1888.]*

46 & 47 Vict.  
c. 57.

WHEREAS it is expedient to amend the Patents, Designs, and Trade Marks Act, 1883, hereinafter referred to as the principal Act :

Be it therefore enacted by the Queen's Most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :

Register of  
patent agents.

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

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

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

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

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

s. 7, as to  
applications.

2. For section seven of the principal Act the following section shall be substituted, namely :

"7. (1) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner,



or that the title does not sufficiently indicate the subject-matter of the invention, the Comptroller may refuse to accept the application, or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the Comptroller so directs, bear date as from the time when the requirement is complied with.

Amendments  
of 46 & 47 Vict.  
c. 57.  
—  
s. 7, as to  
applications.

“ 2. Where the Comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer.

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

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

“(5) If, after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made, accompanied by a specification bearing the same or a similar title, the Comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon.”

3. In sub-section five of section nine of the principal Act the words “other than an appeal to the law officer under this Act” shall be omitted.

s. 9, as to dis-  
closure of  
reports of  
examiners.

4. In sub-section one of section eleven of the principal Act the words from “or on the ground of an examiner” to “a previous application,” both inclusive, shall be omitted, and there shall be added in lieu thereof the following words, namely, “or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification.”

s. 11, as to  
opposition to  
grant of  
patent.

5. For sub-section ten of section eighteen of the principal Act the following sub-section shall be substituted, namely:

s. 18, as to  
amended  
specifications.

“(10) The foregoing provisions of this section do not apply when and so long as any action for infringement or proceeding for revocation of a patent is pending.”

6. After sub-section one of section fifty-two of the principal Act the following words shall be added, namely:

s. 52, as to  
inspection of  
designs.

“Provided that where registration of a design is refused on the ground of identity with a design already registered, the ap-

plicant for registration shall be entitled to inspect the design so registered."

s. 58, as to piracy of registered designs.

7. (1) In section fifty-eight of the principal Act the words "or cause to be applied" shall be added after the word "apply."

(2) To the same section the following words shall be added: "Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds."

s. 62, as to application for registration.

8. (1) In sub-section two of section sixty-two of the principal Act for the words "the patent office in the prescribed manner" shall be substituted the words "such place and in such manner as may be prescribed."

(2) To the same section of the principal Act the following sub-section shall be added:

"(6) Where an applicant for the registration of a trade mark otherwise than under an international convention is out of the United Kingdom at the time of making the application he shall give the Comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given.

s. 63, as to limit of time for proceeding with application.

9. In section sixty-three of the principal Act for the words "the application shall be deemed to be abandoned" shall be substituted the words "the Comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and, if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the Comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned."

s. 64, as to fancy words.

10. (1) For section sixty-four of the principal Act the following section shall be substituted, namely:

"64. (1) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:

"(a) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

"(b) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or

"(c) A distinctive device, mark, brand, heading, label, or ticket; or

"(d) An invented word or invented words; or

"(e) A word or words having no reference to the character or quality of the goods, and not being a geographical name.

"(2) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures,

or combination of letters, words, or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

“(3) Provided as follows :

“(i) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof :

“(ii) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act.”

11. In section sixty-seven of the principal Act the words “or colours” shall be added after the word “colour” in each place where that word occurs. s. 67, as to colours of trade marks.

12. In section sixty-eight of the principal Act after the word Comptroller shall be added the words “unless the Comptroller refuse to entertain the application.” s. 68, as to advertisement of applications.

13. (1) In sub-section one of section sixty-nine of the principal Act for the words “two months” shall be substituted the words “one month or such further time, not exceeding three months, as the Comptroller may allow.” s. 69, as to opposition to registration.

(2) In the same sub-section the word “first” shall be omitted.

(3) In sub-section two of the same section for the words “two months” shall be substituted the words “one month.”

(4) For sub-sections three and four of the same section the following sub-sections shall be substituted, namely—

“(3) If the applicant sends such counter-statement the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the Comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.

“(4) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court, and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.

“(5) If the applicant abandons his application after notice of opposition in pursuance of this section, he shall be liable to pay to the opponent such costs in respect of the opposition as the Comptroller may determine to be reasonable.

“(6) Where the opponent is out of the United Kingdom he shall give the Comptroller an address for service in the United Kingdom.”

s. 72, as to  
restrictions on  
registration.

14. In sub-section two of section seventy-two of the principal Act, the following words shall be added at the beginning of the sub-section—namely, “except as aforesaid,” and for the words “so nearly resembling,” shall be substituted the words “having such resemblance to.”

s. 73, as to  
restriction on  
registration.

15. In section seventy-three of the principal Act the word “exclusive” shall be omitted.

s. 74, as to  
additions to  
trade marks.

16. For sub-section two of section seventy-four of the principal Act the following sub-section shall be substituted, namely—

“(2) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

“Provided that a person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.”

s. 75, as to  
effect of  
registration.

17. For section seventy-five of the principal Act the following section shall be substituted, namely—

“Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been, the date of the registration.”

Certificate as  
to exclusive  
use and costs  
thereon.

18. After section seventy-seven of the principal Act the following section shall be added, and numbered 77A, namely—

“In an action for infringement of a registered trade mark the Court or a Judge may certify that the right to the exclusive use of the trade mark came in question, and if the Court or a Judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or Judge trying the subsequent action certifies that he ought not to have the same.”

19. (1) In sub-section five of section seventy-nine of the principal

Act, for the words the "five years" shall be substituted the words "one year."

Amendments  
of 46 & 47  
Vict. c. 57,  
s. 79, as to  
removal of  
trade mark  
from the  
register.

(2) To the same sub-section the following words shall be added, namely: "Unless it is shown to the satisfaction of the comptroller that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark."

20. (1) For sub-section two of section eighty-one of the principal Act, the following sub-section shall be substituted:

s. 81, as to  
Sheffield  
marks.

"(2) The Cutlers' Company shall enter in the Sheffield register, in respect of metal goods, as defined in this section, all the trade marks entered before the first day of January one thousand eight hundred and eighty-nine in respect of metal goods either in the register established under the Trade Marks Registration Act, 1875, or in the register of trade marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in either of the said other registers."

38 & 39 Vict.  
c. 91.

(2) In sub-sections three and eight of the same section, for the words "on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge," shall be substituted the words "on metal goods."

(3) For sub-section seven of the same section the following sub-section shall be substituted:

"(7) The provisions of this Act and of any general rules made under this Act with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade marks on metal goods by the Cutler's Company, and to all matters relating thereto; and this Act and any such general rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield register, for the comptroller, the Patent Office, and the Register of Trade Marks, respectively; and notice of every entry, cancellation, or correction made in the Sheffield register shall be given to the comptroller by the Cutlers' Company: Provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register."

(4) To the same section the following sub-sections shall be added; namely—

(14.) For the purposes of this section the expression “metal goods” means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.

(15.) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield register a certificate under the hand of the master of the Cutlers’ Company shall have the same effect as the certificate of the comptroller.

s. 87, as to  
entry of  
assignments,  
&c.

21. In section eighty-seven of the principal Act, after the words “subject to,” shall be added the words “the provisions of this Act and to.”

s. 88, as to  
inspection.

22. In section eighty-eight of the principal Act, after the words “subject to,” shall be added the words “the provisions of this Act and to.”

s. 90, as to  
rectification of  
register.

23. In section ninety of the principal Act, after the words “of the name of any person,” shall be added the words “or of any other particulars.”

s. 91, as to  
correction of  
errors.

24. To section ninety-one of the principal Act the following sub-section shall be added; namely,

“(d) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the design or trade mark to be registered.”

Proceedings  
of Board of  
Trade.

25. After section one hundred and two of the principal Act the following section shall be added and numbered 102A; namely,

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

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

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

Jurisdiction of  
Lancashire  
Palatine Court.

26. After section one hundred and twelve of the principal Act the following section shall be added and numbered 112A; namely,

“The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to

trade marks the registration whereof is applied for in the Manchester office, have the like jurisdiction under this Act as her Majesty's High Court of Justice in England, and the expression 'the Court' in this Act shall be construed and have effect accordingly.

"Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases."

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

28. This Act shall, except so far as is by this Act otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine. Commencement of Act.

29. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1888, and this Act and the Patents, Designs, and Trade Marks Acts, 1883 to 1886, may be cited collectively as the Patents, Designs, and Trade Marks Acts, 1883 to 1888. Short title.

INTERNATIONAL CONVENTION FOR THE PROTECTION  
OF INDUSTRIAL PROPERTY.

SIGNED AT PARIS, MARCH 20, 1883.

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RATIFICATIONS EXCHANGED AT PARIS, JUNE 6, 1884.

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I.

*International Convention.*

SA Majesté le Roi des Belges, Sa Majesté l'Empereur du Brésil, Sa Majesté le Roi d'Espagne, le Président de la République Française, le Président de la République de Guatemala, Sa Majesté le Roi d'Italie, Sa Majesté le Roi des Pays-Bas, Sa Majesté le Roi de Portugal et des Algarves, le Président de la République de Salvador, Sa Majesté le Roi de Serbie, et le Conseil Fédéral de la Confédération Suisse,

Egalement animés du désir d'assurer, d'un common accord, une complète et efficace protection à l'industrie et au commerce des nationaux de leurs Etats respectifs et de contribuer à la garantie des droits des inventeurs et de la loyauté des transactions commerciales, ont résolu de conclure une Convention à cet effet et ont nommé pour leurs Plénipotentiaires, savoir :

Sa Majesté le Roi des Belges: M. le Baron Beyens, Grand Officier de son Ordre Royal de Léopold, Grand Officier de la Légion d'Honneur, &c., son Envoyé Extraordinaire et Ministre Plénipotentiaire à Paris ;

Sa Majesté l'Empereur du Brésil: M. Jules Constant, Comte de Villeneuve, Membre du Conseil de Sa Majesté, son Envoyé Extraordinaire et Ministre Plénipotentiaire près Sa Majesté le Roi des Belges, Commandeur de l'Ordre du Christ, Officier de son Ordre de la Rose, Chevalier de la Légion d'Honneur, &c. ;

Sa Majesté le Roi d'Espagne: Son Excellence M. le Duc de Fernán-Nuñez, de Montellano et del Arco, Comte de Cervellon,



INTERNATIONAL CONVENTION FOR THE PROTECTION  
OF INDUSTRIAL PROPERTY.

SIGNED AT PARIS, MARCH 20, 1883.

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RATIFICATIONS EXCHANGED AT PARIS, JUNE 6, 1884.

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I.

*International Convention.*

HIS Majesty the King of the Belgians, His Majesty the Emperor of Brazil, His Majesty the King of Spain, the President of the French Republic, the President of the Republic of Guatemala, His Majesty the King of Italy, His Majesty the King of the Netherlands, His Majesty the King of Portugal and the Algarves, the President of the Republic of Salvador, His Majesty the King of Servia, and the Federal Council of the Swiss Confederation,

Being equally animated with the desire to secure, by mutual agreement, complete and effectual protection for the industry and commerce of their respective subjects and citizens, and to provide a guarantee for the rights of inventors, and for the loyalty of commercial transactions, have resolved to conclude a Convention to that effect, and have named as their Plenipotentiaries, that is to say:—

His Majesty the King of the Belgians: the Baron Beyens, Grand Officer of His Majesty's Royal Order of Leopold, Grand Officer of the Legion of Honour, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ;

His Majesty the Emperor of Brazil: M. Jules Constant, Count de Villeneuve, member of His Majesty's Council, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at the Court of His Majesty the King of the Belgians, Commander of the Order of Christ, Officer of His Majesty's Order of the Rose, Chevalier of the Legion of Honour, &c. ;

His Majesty the King of Spain: His Excellency the Duke de Fernan-Nuñez, de Montellano et del Arco, Count de Cervellon,

Marquis de Almonacir, Grand d'Espagne de Première Classe, Chevalier de l'Ordre Insigne de la Toison d'Or, Grand-Croix de l'Ordre de Charles III., Chevalier de Calatrava, Grand-Croix de la Légion d'Honneur, &c., Sénateur du Royaume, son Ambassadeur Extraordinaire et Plénipotentiaire à Paris ;

Le Président de la République Française : M. Paul Challemel-Lacour, Sénateur, Ministre des Affaires Etrangères ; M. Hérisson, Député, Ministre du Commerce ; M. Charles Jagerschmidt, Ministre Plénipotentiaire de Première Classe, Officier de l'Ordre National de la Légion d'Honneur, &c. ;

Le Président de la République de Guatemala : M. Crisanto Medina, Officier de la Légion d'Honneur, &c., son Envoyé Extraordinaire et Ministre Plénipotentiaire à Paris ;

Sa Majesté le Roi d'Italie, M. Constantin Ressiman, Commandeur de ses Ordres des Saints Maurice et Lazare et de la Couronne d'Italie, Commandeur de la Légion d'Honneur, &c., Conseiller de l'Ambassade d'Italie à Paris ;

Sa Majesté le Roi des Pays-Bas : M. le Baron de Zuylen de Nyevelt, Commandeur de son Ordre du Lion Néerlandais, Grand-Croix de son Ordre Grand Ducal de la Couronne de Chêne et du Lion d'Or de Nassau, Grand Officier de la Légion d'Honneur, &c., son Envoyé Extraordinaire et Ministre Plénipotentiaire à Paris ;

Sa Majesté le Roi de Portugal et des Algarves : M. Jose da Silva Mendes Leal, Conseiller d'Etat, Pair du Royaume, Ministre et Secrétaire d'Etat Honoraire, Grand-Croix de l'Ordre de Saint-Jacques, Chevalier de l'Ordre de la Tour et de l'Epée de Portugal, Grand Officier de la Légion d'Honneur, &c., son Envoyé Extraordinaire et Ministre Plénipotentiaire à Paris ; M. Fernand de Azevedo, Officier de la Légion d'Honneur, &c., Premier Secrétaire de la Légation de Portugal à Paris ;

Le Président de la République de Salvador ; M. Torres-Cañedo, Membre Correspondant de l'Institut de France, Grand Officier de la Légion d'Honneur, &c., son Envoyé Extraordinaire et Ministre Plénipotentiaire à Paris ;

Sa Majesté le Roi de Serbie : M. Sima M. Marinovitch, Chargé d'Affaires par intérim de Serbie, Chevalier de l'Ordre Royal de Takovo, &c. ;

Et le Conseil Fédéral de la Confédération Suisse : M. Charles-Edouard Lardy, son Envoyé Extraordinaire et Ministre Plénipotentiaire à Paris ; M. J. Weibel, Ingénieur à Genève, Président de la Section Suisse de la Commission Permanente pour la Protection de la Propriété Industrielle :

Lesquels, après s'être communiqué leurs pleins pouvoirs respectifs,

Marquis de Almonacir, Grandee of Spain First Class, Chevalier of the Distinguished Order of the Golden Fleece, Grand Cross of the Order of Charles III., Chevalier de Calatrava, Grand Cross of the Legion of Honour, Senator of the Kingdom, His Majesty's Ambassador Extraordinary and Plenipotentiary at Paris, &c. ;

The President of the French Republic : M. Paul Challemel-Lacour, Senator, Minister for Foreign Affairs ; M. Hérrison, Deputy, Minister of Commerce ; M. Charles Jagerschmidt, Minister Plenipotentiary of the First Class, Officer of the National Order of the Legion of Honour, &c. ;

The President of the Republic of Guatemala : M. Crisanto Medina, Officer of the Legion of Honour, his Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ;

His Majesty the King of Italy : M. Constantin Ressman, Commander of His Majesty's Orders of Saints Maurice and Lazarus, and of the Crown of Italy, Commander of the Legion of Honour, Councillor of the Italian Embassy at Paris, &c. ;

His Majesty the King of the Netherlands : the Baron de Zuylen de Nyevelt, Commander of His Majesty's Order of the Netherlands Lion, Grand Cross of His Majesty's Grand Ducal Order of the Oaken Crown, and of the Golden Lion of Nassau, Grand Officer of the Legion of Honour, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ;

His Majesty the King of Portugal and the Algarves : M. Jose da Silva Mendes Leal, Councillor of State, Peer of the Realm, Minister and Honorary Secretary of State, Grand Cross of the Order of St. James, Chevalier of the Order of the Tower and Sword of Portugal, Grand Officer of the Legion of Honour, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ; M. Fernand de Azevedo, Officer of the Legion of Honour, First Secretary of the Portuguese Legation at Paris, &c. ;

The President of the Republic of Salvador : M. Torres-Cañedo, corresponding member of the French Institute, Grand Officer of the Legion of Honour, his Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ;

His Majesty the King of Servia : M. Sima M. Marinovitch, Chargé d'Affaires of Servia *ad interim*, Chevalier of the Royal Order of Takovo, &c. ;

And the Federal Council of the Swiss Confederation ; M. Charles Edouard Lardy, Envoy Extraordinary and Minister Plenipotentiary, at Paris, &c. ; M. J. Weibel, Engineer at Geneva, President of the Swiss Section of the Permanent Commission for the Protection of Industrial Property :

Who, having communicated to each other their respective full

trouvés en bonne et due forme, sont convenus des Articles suivants :—

#### ARTICLE I.

Les Gouvernements de la Belgique, du Brésil, de l'Espagne, de la France, du Guatemala, de l'Italie, des Pays-Bas, du Portugal, du Salvador, de la Serbie, et de la Suisse sont constitués à l'état d'Union pour la protection de la Propriété Industrielle.

#### ARTICLE II.

Les sujets ou citoyens de chacun des Etats Contractants jouiront, dans tous les autres Etats de l'Union, en ce qui concerne les brevets d'invention, les dessins ou modèles industriels, les marques de fabrique ou de commerce et le nom commercial, des avantages, que les lois respectives accordent actuellement ou accorderont par la suite aux nationaux.

En conséquence, ils auront la même protection que ceux-ci et le même recours légal contre toute atteinte portée à leurs droits, sous réserve de l'accomplissement des formalités et des conditions imposées aux nationaux par la législation intérieure de chaque Etat.

#### ARTICLE III.

Sont assimilés aux sujets ou citoyens des Etats Contractants les sujets ou citoyens des Etats ne faisant pas partie de l'Union qui sont domiciliés ou ont des établissements industriels ou commerciaux sur le territoire de l'un des Etats de l'Union.

#### ARTICLE IV.

Celui qui aura régulièrement fait le dépôt d'une demande de brevet d'invention, d'un dessin ou modèle industriel, d'une marque de fabrique ou de commerce, dans l'un des Etats Contractants, jouira, pour effectuer le dépôt dans les autres Etats, et sous réserve des droits de tiers, d'un droit de priorité pendant les délais déterminés ci-après.

En conséquence, le dépôt ultérieurement opéré dans l'un des autres Etats de l'Union avant l'expiration de ces délais ne pourra être invalidé par des faits accomplis dans l'intervalle, soit, notamment, par un autre dépôt, par la publication de l'invention ou son exploitation par un tiers, par la mise en vente d'exemplaires du dessin ou du modèle, par l'emploi de la marque.

powers, found in good and due form, have agreed upon the following Articles:—

#### ARTICLE I.

The Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland constitute themselves into a Union for the Protection of Industrial Property.

#### ARTICLE II.

The subjects or citizens of each of the Contracting States shall, in all the other States of the Union, as regards patents, industrial designs or models, trade-marks and trade names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each State.

#### ARTICLE III.

Subjects or citizens of States not forming part of the Union, who are domiciled or have industrial or commercial establishments in the territory of any of the States of the Union, shall be assimilated to the subjects or citizens of the contracting States.

#### ARTICLE IV.

Any person who has duly applied for a patent, industrial design or model, or trade-mark in one of the Contracting States, shall enjoy, as regards registration in the other States, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

Consequently, subsequent registration in any of the other States of the Union before expiry of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another registration, by publication of the invention, or by the working of it by a third party, by the sale of copies of the design or model, or by use of the trade-mark.

Les délais de priorité mentionnés ci-dessus seront de six mois pour les brevets d'invention, et de trois mois pour les dessins ou modèles industriels, ainsi que pour les marques de fabrique ou de commerce. Ils seront augmentés d'un mois pour les pays d'outre-mer.

#### ARTICLE V.

L'introduction par le breveté, dans le pays où le brevet a été délivré, d'objets fabriqués dans l'un ou l'autre des Etats de l'Union, n'entraînera pas la déchéance.

Toutefois le breveté restera soumis à l'obligation d'exploiter son brevet conformément aux lois du pays où il introduit les objets brevetés.

#### ARTICLE VI.

Toute marque de fabrique ou de commerce régulièrement déposée dans le pays d'origine sera admise au dépôt et protégée telle quelle dans tous les autres pays de l'Union.

Sera considéré comme pays d'origine le pays où le déposant son principal établissement.

Si ce principal établissement n'est point situé dans un des pays de l'Union, sera considéré comme pays d'origine celui auquel appartient le déposant.

Le dépôt pourra être refusé, si l'objet pour lequel il est demandé est considéré comme contraire à la morale ou à l'ordre public.

#### ARTICLE VII.

La nature du produit sur lequel la marque de fabrique ou de commerce doit être apposée ne peut, dans aucun cas, faire obstacle au dépôt de la marque.

#### ARTICLE VIII.

Le nom commercial sera protégé dans tous les pays de l'Union sans obligation de dépôt, qu'il fasse ou non partie d'une marque de fabrique ou du commerce.

#### ARTICLE IX.

Tout produit portant illicitement une marque de fabrique ou de commerce, ou un nom commercial, pourra être saisi à l'importation dans ceux des Etats de l'Union dans lesquels cette marque ou ce nom commercial ont droit à la protection légale.

The above-mentioned terms of priority shall be six months for patents and three months for industrial designs and models and trade-marks. A month longer is allowed for countries beyond sea.

#### ARTICLE V.

The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the States of the Union shall not entail forfeiture.

Nevertheless, the patentee shall remain bound to work his patent in conformity with the laws of the country into which he introduces the patented objects.

#### ARTICLE VI.

Every trade-mark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the Union.

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the Union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

#### ARTICLE VII.

The nature of the goods on which the trade-mark is to be used can in no case be an obstacle to the registration of the trade-mark.

#### ARTICLE VIII.

A trade-name shall be protected in all the countries of the Union, without necessity of registration, whether it form part or not of a trade-mark.

#### ARTICLE IX.

All goods illegally bearing a trade-mark or trade-name may be seized on importation into those States of the Union where this mark or name has a right to legal protection.

La saisie aura lieu à la requête soit du Ministère Public, soit de la partie intéressée, conformément à la législation intérieure de chaque Etat.

#### ARTICLE X.

Les dispositions de l'Article précédent seront applicables à tout produit portant faussement, comme indication de provenance, le nom d'une localité déterminée, lorsque cette indication sera jointe à un nom commercial fictif ou emprunté dans une intention frauduleuse.

Est réputé partie intéressée tout fabricant ou commerçant engagé dans la fabrication ou le commerce de ce produit, et établi dans la localité faussement indiquée comme provenance.

#### ARTICLE XI.

Les Hautes Parties Contractantes s'engagent à accorder une protection temporaire aux inventions brevetables, aux dessins ou modèles industriels, ainsi qu'aux marques de fabrique ou de commerce, pour les produits que figureront aux Expositions Internationales officielles ou officiellement reconnues.

#### ARTICLE XII.

Chacune des Hautes Parties Contractantes s'engage à établir un service spécial de la Propriété Industrielle et un dépôt central, pour la communication au public des brevets d'invention, des dessins ou modèles industriels et des marques de fabrique ou de commerce.

#### ARTICLE XIII.

Un office international sera organisé sous le titre de "Bureau International de l'Union pour la Protection de la Propriété Industrielle."

Ce bureau, dont les frais seront supportés par les Administrations de tous les Etats Contractants, sera placé sous la haute autorité de l'Administration Supérieure de la Confédération Suisse, et fonctionnera sous sa surveillance. Les attributions en seront déterminées d'un commun accord entre les Etats de l'Union.

#### ARTICLE XIV.

La présente Convention sera soumise à des révisions périodiques en vue d'y introduire les améliorations de nature à perfectionner le système de l'Union.



The seizure shall be effected at the request of either the proper Public Department or of the interested party, pursuant to the internal legislation of each country.

#### ARTICLE X.

The provisions of the preceding Article shall apply to all goods falsely bearing the name of any locality as indication of the place of origin, when such indication is associated with a trade-name of a fictitious character or assumed with a fraudulent intention.

Any manufacturer of, or trader in, such goods, established in the locality falsely designated as the place of origin, shall be deemed an interested party.

#### ARTICLE XI.

The High Contracting Parties agree to grant temporary protection to patentable inventions, to industrial designs or models, and trade-marks, for articles exhibited at official or officially recognised International Exhibitions.

#### ARTICLE XII.

Each of the High Contracting Parties agrees to establish a special Government Department for industrial property, and a central office for communication to the public of patents, industrial designs or models, and trade-marks.

#### ARTICLE XIII.

An international office shall be organised under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property).

This office, the expense of which shall be defrayed by the Governments of all the Contracting States, shall be placed under the high authority of the Central Administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the Union.

#### ARTICLE XIV.

The present Convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the Union.

A cet effet, des Conférences auront lieu successivement, dans l'un des Etats Contractants, entre les Délégués des dits Etats.

La prochaine réunion aura lieu en 1885, à Rome.

#### ARTICLE XV.

Il est entendu que les Hautes Parties Contractantes se réservent respectivement le droit de prendre séparément, entre elles, des arrangements particuliers pour la protection de la Propriété Industrielle, en tant que ces arrangements ne contreviendraient point aux dispositions de la présente Convention.

#### ARTICLE XVI.

Les Etats qui n'ont point pris part à la présente Convention seront admis à y adhérer sur leur demande.

Cette adhésion sera notifiée par la voie diplomatique au Gouvernement de la Confédération Suisse, et par celui-ci à tous les autres.

Elle emportera, de plein droit, accession à toutes les clauses et admission à tous les avantages stipulés par la présente Convention.

#### ARTICLE XVII.

L'exécution des engagements réciproques contenus dans la présente Convention est subordonnée, en tant que de besoin, à l'accomplissement des formalités et règles établies par les lois constitutionnelles de celles des Hautes Parties Contractantes qui sont tenues d'en provoquer l'application, ce qu'elles s'obligent à faire dans le plus bref délai possible.

#### ARTICLE XVIII.

La présente Convention sera mise à exécution dans le délai d'un mois à partir de l'échange des ratifications et demeurera en vigueur pendant un temps indéterminé, jusqu'à l'expiration d'une année à partir du jour où la dénonciation en sera faite.

Cette dénonciation sera adressée au Gouvernement chargé de recevoir les adhésions. Elle ne produira son effet qu'à l'égard de l'Etat qui l'aura faite, la Convention restant exécutoire pour les autres Parties Contractantes.

#### ARTICLE XIX.

La présente Convention sera ratifiée, et les ratifications en seront échangées à Paris, dans le délai d'un an au plus tard.

To this end, Conferences shall be successively held in one of the Contracting States by Delegates of the said States. The next meeting shall take place in 1885, at Rome.

## ARTICLE XV.

It is agreed that the High Contracting Parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of Industrial Property, in so far as such arrangements do not contravene the provisions of the present Convention.

## ARTICLE XVI.

States which have not taken part in the present Convention shall be permitted to adhere to it at their request.

Such adhesion shall be notified officially through the diplomatic channel to the Government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses, and admission to all the advantages stipulated by the present Convention.

## ARTICLE XVII.

The execution of the reciprocal engagements contained in the present Convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the Constitutional laws of those of the High Contracting Parties who are bound to procure the application of the same, which they engage to do with as little delay as possible.

## ARTICLE XVIII.

The present Convention shall come into operation one month after the exchange of ratifications, and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the Government commissioned to receive adhesions. It shall only affect the denouncing State, the Convention remaining in operation as regards the other Contracting Parties.

## ARTICLE XIX.

The present convention shall be ratified, and the ratifications exchanged in Paris, within one year at the latest.

En foi de quoi les Plénipotentiaires respectifs l'ont signée et y ont apposé leurs cachets.

Fait à Paris, le 20 Mars, 1883.

(Signé)

(L.S.)	BEYENS.
(L.S.)	VILLENEUVE.
(L.S.)	Duc DE FERNAN-NUÑEZ.
(L.S.)	P. CHALLEMEL-LACOUR.
(L.S.)	CH. HÉRISON.
(L.S.)	CH. JAGERSCHMIDT.
(L.S.)	CRISANTO-MEDINA.
(L.S.)	RESSMAN.
(L.S.)	Baron DE ZUYLEN DE NYEVELT.
(L.S.)	JOSE DA SILVA MENDES LEAL.
(L.S.)	F. D'AZEVEDO.
(L.S.)	J.-M. TORRES-CAICEDO.
(L.S.)	SIMA M. MARINOVITCH.
(L.S.)	LARDY.
(L.S.)	J. WEIBEL.

## II.

### *Final Protocol.*

Au moment de procéder, à la signature de la Convention conclue, à la date de ce jour, entre les Gouvernements de la Belgique, du Brésil, de l'Espagne, de la France, du Guatemala, de l'Italie, des Pays-Bas, du Portugal, du Salvador, de la Serbie, et de la Suisse, pour la protection de la Propriété Industrielle, les Plénipotentiaires soussignés sont convenus de ce qui suit :

1. Les mots " Propriété Industrielle " doivent être entendus dans leur acception la plus large, en ce sens qu'ils s'appliquent non seulement aux produits de l'industrie proprement dite, mais également aux produits de l'agriculture (vins, grains, fruits, bestiaux, &c.), et aux produits minéraux livrés au commerce (eaux minérales, &c.).

2. Sous le nom de " Brevets d'Invention " sont comprises les diverses espèces de brevets industriels admises par les législations des Etats Contractants, telles que brevets d'importation, brevets de perfectionnement, &c.

3. Il est entendu que la disposition finale de l'Article II. de la Convention ne porte aucune atteinte à la législation de chacun des Etats Contractants, en ce qui concerne la procédure suivie devant les Tribunaux et la compétence de ces Tribunaux.

In witness whereof the respective Plenipotentiaries have signed the same, and have affixed thereto their seals.

Done at Paris, the 20th March 1883.

(Signed)

(L.S.)	BEYENS.
(L.S.)	VILLENEUVE.
(L.S.)	Duc DE FERNAN-NUÑEZ.
(L.S.)	P. CHALLEMEL-LACOUR.
(L.S.)	CH. HÉRISSON.
(L.S.)	CH. JAGERSCHMIDT.
(L.S.)	CRISANTO-MEDINA.
(L.S.)	RESSMAN.
(L.S.)	Baron DE ZUYLEN DE NYEVELT.
(L.S.)	JOSE DA SILVA MENDES LEAL.
(L.S.)	F. D'AZEVEDO.
(L.S.)	J.-M. TORRES-CAICEDO.
(L.S.)	SIMA M. MARINOVITCH.
(L.S.)	LARDY.
(L.S.)	J. WEIBEL.

## II.

### *Final Protocol.*

On proceeding to the signature of the Convention concluded this day between the Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia, and Switzerland, for the protection of Industrial Property, the undersigned Plenipotentiaries have agreed as follows:—

1. The words "Industrial Property" are to be understood in their broadest sense; they are not to apply simply to industrial products, properly so called, but also to agricultural products (wines, corn, fruits, cattle, &c.), and to mineral products, employed in commerce (mineral waters, &c.).

2. Under the word "patents" are comprised the various kinds of industrial patents recognised by the legislation of each of the Contracting States, such as importation patents, improvement patents, &c.

3. The last paragraph of Article II. does not affect the legislation of each of the Contracting States as regards the procedure to be followed before the Tribunals, and the competence of those Tribunals.

4. Le paragraphe 1<sup>er</sup> de l'Article VI. doit être entendu en ce sens qu'aucune marque de fabrique ou de commerce ne pourra être exclue de la protection dans l'un des États de l'Union par le fait seul qu'elle ne satisferait pas, au point de vue des signes qui la composent, aux conditions de la législation de cet Etat, pourvu qu'elle satisfasse, sur ce point, à la législation du pays d'origine et qu'elle ait été, dans ce dernier pays, l'objet d'un dépôt régulier. Sauf cette exception, qui ne concerne que la forme de la marque, et sous réserve des dispositions des autres Articles de la Convention, la législation intérieure de chacun des Etats recevra son application.

Pour éviter toute fausse interprétation, il est entendu que l'usage des armoiries publiques et des décorations peut être considéré comme contraire à l'ordre public, dans le sens du paragraphe final de l'Article VI.

5. L'organisation du service spécial de la Propriété Industrielle mentionné à l'Article XII. comprendra, autant que possible, la publication, dans chaque Etat d'une feuille officielle périodique.

6. Les frais communs de Bureau International institué par l'Article XIII. ne pourront, en aucun cas, dépasser, par année, une somme totale représentant une moyenne de 2000 fr. par chaque Etat Contractant.

Pour déterminer la part contributive de chacun des États dans cette somme totale des frais, les Etats Contractants et ceux qui adhèreraient ultérieurement à l'Union seront divisés en six classes contribuant chacune dans la proportion d'un certain nombre d'unités, savoir :—

1 <sup>e</sup> classe	.	.	.	.	.	.	25 unités.
2 <sup>e</sup> classe	.	.	.	.	.	.	20 „
3 <sup>e</sup> classe	.	.	.	.	.	.	15 „
4 <sup>e</sup> classe	.	.	.	.	.	.	10 „
5 <sup>e</sup> classe	.	.	.	.	.	.	5 „
6 <sup>e</sup> classe	.	.	.	.	.	.	3 „

Ces coefficients seront multipliés par le nombre des États de chaque classe, et la somme des produits ainsi obtenus fournira le nombre d'unités par lequel la dépense totale doit être divisée. Le quotient donnera le montant de l'unité de dépense.

Les Etats Contractants sont classés ainsi qu'il suit, en vue de la répartition des frais :—

1 <sup>e</sup> classe	.	.	.	.	.	France, Italie.
2 <sup>e</sup> classe	.	.	.	.	.	Espagne.
3 <sup>e</sup> classe	.	.	.	.	.	Belgique, Brésil, Portugal, Suisse.
4 <sup>e</sup> classe	.	.	.	.	.	Pays-Bas.
5 <sup>e</sup> classe	.	.	.	.	.	Serbie.
6 <sup>e</sup> classe	.	.	.	.	.	Guatemala, Salvador.

4. Paragraph 1 of Article VI. is to be understood as meaning that no trade-mark shall be excluded from protection in any State of the Union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of that State; provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in said country of origin. With this exception, which relates only to the form of the mark, and under reserve of the provisions of the other Articles of the Convention, the internal legislation of each State remains in force.

To avoid misconstruction, it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order, in the sense of the last paragraph of Article VI.

5. The organisation of the special Department for Industrial Property mentioned in Article XII. shall comprise, so far as possible, the publication in each State of a periodical official paper.

6. The common expenses of the International Office, instituted by virtue of Article XIII., are in no case to exceed for a single year a total sum representing an average of 2000 fr. for each Contracting State.

To determine the part which each State should contribute to this total of expenses, the Contracting States, and those which may afterwards join the Union, shall be divided into six classes, each contributing the proportion of a certain number of units, namely:—

1st class	. . . . .	25 units.
2nd class	. . . . .	20 „
3rd class	. . . . .	15 „
4th class	. . . . .	10 „
5th class	. . . . .	5 „
6th class	. . . . .	3 „

These co-efficients will be multiplied by the number of States in each class, and the sum of the result thus obtained will supply the number of units by which the total expense has to be divided. The quotient will give the amount of the unit of expense.

The Contracting States are classed as follows, with regard to the division of expense:—

1st class	. . . . .	France, Italy.
2nd class	. . . . .	Spain.
3rd class	. . . . .	Belgium, Brazil, Portugal, Switzerland.
4th class	. . . . .	Holland.
5th class	. . . . .	Servia.
6th class	. . . . .	Guatemala, Salvador.

L'Administration Suisse surveillera les dépenses du Bureau International, fera les avances nécessaires et établira le compte annuel, qui sera communiqué à toutes les autres Administrations.

Le Bureau International centralisera les renseignements de toute nature relatifs à la protection de la Propriété Industrielle et les réunira en une statistique générale qui sera distribuée à toutes les Administrations. Il procédera aux études d'utilité commune intéressant l'Union et rédigera, à l'aide des documents qui seront mis à sa disposition par les diverses Administrations, une feuille périodique, en langue Française, sur les questions concernant l'objet de l'Union.

Les numéros de cette feuille, de même que tous les documents publiés par le Bureau International, seront répartis entre les Administrations des Etats de l'Union, dans la proportion du nombre des unités contributives ci-dessus mentionnées. Les exemplaires et documents supplémentaires qui seraient réclamés, soit par les dites Administrations, soit par des Sociétés ou des particuliers, seront payés à part.

Le Bureau International devra se tenir en tout temps à la disposition des membres de l'Union, pour leur fournir, sur les questions relatives au service international de la Propriété Industrielle, les renseignements spéciaux, dont ils pourraient avoir besoin.

L'Administration du pays où doit siéger la prochaine Conférence préparera avec le concours du Bureau International, les travaux de cette Conférence.

Le Directeur du Bureau International assistera aux séances des Conférences et prendra part aux discussions sans voix délibérative. Il fera, sur sa gestion, un Rapport annuel, qui sera communiqué à tous les membres de l'Union.

La langue officiel du Bureau International sera la langue Française.

7. Le présent Protocole de Clôture, qui sera ratifié en même temps que la Convention conclue à la date de ce jour, sera considéré comme faisant partie intégrante de cette Convention, et aura même force, valeur et durée.

En foi de quoi, les Plénipotentiaires soussignés ont dressé le présent Protocole.

(Signé) BEYENS.	RESSMAN.
VILLENEUVE.	Baron DE ZUYLEN DE NYEVELT.
Duc DE FERNAN-NUÑEZ.	JOSE DA SILVA MENDES LEAL.
P. CHALLEMEL-LACOUR.	F. D'AZEVEDO.
CH. HÉRISSE.	J.-M. TORRES-CAICEDO.
CH. JAGERSCHMIDT.	SIMA M. MARINOVITCH.
CRISANTO-MEDINA.	LARDY. J. WEIBEL.



The Swiss Government will superintend the expenses of the International Office, advance the necessary funds, and render an annual account; which will be communicated to all the other Administrations.

The International Office will centralise information of every kind relating to the protection of Industrial Property, and will bring it together in the form of a general statistical statement, which will be distributed to all the Administrations. It will interest itself in all matters of common utility to the Union, and will edit, with the help of the documents supplied to it by the various Administrations, a periodical paper in the French language dealing with questions regarding the object of the Union.

The numbers of this paper, as well as all the documents published by the International Office, will be circulated among the Administrations of the States of the Union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired, either by the said Administrations or by Societies or private persons, will be paid for separately.

The International Office shall at all times hold itself at the service of members of the Union, in order to supply them with any special information they may need on questions relating to the international system of Industrial Property.

The Administration of the country in which the next Conference is to be held will make preparations for the transactions of that Conference, with the assistance of the International Office.

The Director of the International Office will be present at the meetings of the Conferences, and will take part in the discussions, but without the privilege of voting.

He will furnish an annual Report upon his administration of the office, which shall be communicated to all the members of the Union.

The official language of the International Office will be French.

7. The present Final Protocol, which shall be ratified, together with the Convention concluded this day, shall be considered as forming an integral part of, and shall have the same force, validity, and duration as the said Convention.

In witness whereof, the undersigned Plenipotentiaries have drawn up the present Protocol.

(Signed) BEYENS.

VILLENEUVE.

DUC DE FERNAN-NUÑEZ.

P. CHALLEMEL-LACOUR.

CH. HÉRISSON.

CH. JAGERSCHMIDT.

CRISANTO-MEDINA.

RESSMAN.

BARON DE ZUYLEN DE NYEVELT.

JOSE DA SILVA MENDES LEAL.

F. D'AZEVEDO.

J.-M. TORRES-CAICEDO.

SIMA M. MARINOVITCH.

LARDY.

J. WEIBEL.

## III.

*Accession of Her Majesty's Government to the Convention signed at Paris,  
March 20, 1883.*

The Undersigned, Ambassador Extraordinary and Plenipotentiary of her Majesty the Queen of the United Kingdom of Great Britain and Ireland to the French Republic, declares that her Britannic Majesty, having had the International Convention for the Protection of Industrial Property, concluded at Paris on the 20th March 1883, and the Protocol relating thereto, signed on the same date, laid before her, and availing herself of the right reserved by Article XVI. of that Convention to States not parties to the original Convention, accedes, on behalf of the United Kingdom of Great Britain and Ireland, to the said International Convention for the Protection of Industrial Property, and to the said Protocol, which are to be considered as inserted word for word in the present Declaration, and

## IV.

*Declaration of Acceptance of Accession.*

Sa Majesté la Reine du Royaume Uni de la Grande-Bretagne et d'Irlande ayant accédé à la Convention Internationale, relative à la protection de la Propriété Industrielle, conclue à Paris le 20 Mars 1883, et suivie d'un Protocol en date du même jour, en vertu de l'Acte d'Accession délivré par son Ambassadeur Extraordinaire et Plénipotentiaire près le Gouvernement de la République Française; acte dont la teneur suit ici, mot pour mot:—

(Here is inserted the text of No. III. in English.)

Le Président de la République Française a autorisé le Soussigné, Président du Conseil, Ministre des Affaires Etrangères, à accepter formellement la dite accession, y compris les réserves qui y sont contenues, concernant l'Île de Man, les Îles de la Manche et toutes autre possession de Sa Majesté Britannique, s'engageant, tant en son nom qu'au nom des autres Hautes Parties Contractantes, à concourir à l'accomplissement des obligations stipulées dans la Convention et le Protocole y annexé, qui pourront concerner le Royaume Uni de la Grande-Bretagne et d'Irlande.

En foi de quoi, le Soussigné, dûment autorisé, a dressé le présent Acte d'Acceptation et y a fait apposer son cachet.

Fait à Paris, le 2 Avril 1884.

(L.S.) (Signé) JULES FERRY.

formally engages as far as regards the President of the French Republic and the other High Contracting Parties to co-operate on her part in the execution of the stipulations contained in the Convention and Protocol aforesaid.

The Undersigned makes this Declaration on the part of her Britannic Majesty with the express understanding that power is reserved to her Britannic Majesty to accede to the Convention on behalf of the Isle of Man and the Channel Islands, and any of her Majesty's possessions, on due notice to that effect being given through her Majesty's Government.

In witness whereof the Undersigned, duly authorised, has signed the present Declaration of Accession, and has affixed thereto the seal of his arms.

Done at Paris, on the 17th day of March 1884.

(L.S.) (Signed) LYONS.

#### IV.

##### *Declaration of Acceptance of Accession.*

Her Majesty the Queen of the United Kingdom of Great Britain and Ireland, having acceded to the International Convention relative to the Protection of Industrial Property, concluded at Paris, March 20, 1883, together with a Protocol dated the same day, by the Declaration of Accession delivered by her Ambassador Extraordinary and Plenipotentiary to the Government of the French Republic, the text of which Declaration is word for word as follows:—

(Here is inserted the text of No. III. in English.)

The President of the French Republic has authorised the Undersigned, President of the Council, Minister for Foreign Affairs, to formally accept the said Accession, together with the reserves which are contained in it concerning the Isle of Man, the Channel Islands, and all other possessions of her Britannic Majesty, engaging as well in his own name, as in that of the other High Contracting Parties, to assist in the accomplishment of the obligations stipulated in the Convention and the Protocol thereto annexed, which may concern the United Kingdom of Great Britain and Ireland.

In witness whereof the Undersigned, duly authorised, has drawn up the present Declaration of Acceptance, and has affixed thereto his seal.

Done at Paris, the 2nd April 1884.

(L.S.) (Signed) JULES FERRY.

## PATENTS RULES, 1890.

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

### SHORT TITLE.

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

### COMMENCEMENT.

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

### INTERPRETATION.

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

### FEES.

4. The fees to be paid under the above-mentioned Acts shall be those specified in the list of fees in the First Schedule to these Rules.

### FORMS.

Forms. Alterations. 5. The Forms A, B, and C in the First Schedule to the Act of 1883 shall be altered or amended by the substitution therefor of the Forms A, A<sub>1</sub>, A<sub>2</sub>, B, and C in the Second Schedule to these Rules.<sup>(a)</sup>

Application. 6. (1.) An application for a patent containing the declaration mentioned in sub-section 2 of section 5 of the Act of 1883 and section 2 of the Act of 1885 shall be made either in the Form A or the Form A<sub>1</sub>, or the Form A<sub>2</sub>, set forth in the Second Schedule to these Rules as the case may be.<sup>(b)</sup>

Specification. (2.) The Form B<sup>(c)</sup> in such Schedule of provisional specification and the Form C<sup>(d)</sup> of complete specification shall respectively be used.

(a) pp. 744-751 *post*.  
(c) p. 750 *post*.

(b) pp. 744-748 *post*.  
(d) p. 751 *post*.

(3.) The remaining forms other than A, A<sub>1</sub>, A<sub>2</sub>, B, and C, set forth in the Second Schedule to these Rules, may, as far as they are applicable, be used in any proceedings under these Rules.<sup>(e)</sup> Other forms.

## GENERAL.

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

Christmas Day.

Good Friday.

The day observed as her Majesty's birthday.

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

8. An application for a patent must be signed by the applicant, but all other communications between the applicant and the Comptroller and all attendances by the applicant upon the Comptroller 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. Agency.

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

10. All documents and copies of documents, except statutory declarations and affidavits, sent to or left at the Patent Office or otherwise furnished to the Comptroller or to the Board of Trade shall be written or printed in large and legible characters and, unless otherwise directed, in the English language, upon strong, wide, ruled paper (on one side only), of a size of 13 inches by 8 inches, leaving a margin of two inches on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the Comptroller. Size, &c., of documents.

11. Before exercising any discretionary power given to the Comptroller by the said Acts adversely to the applicant for a patent or for amendment of a specification, the Comptroller shall give ten days' notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before Exercise of discretionary power by Comptroller.  
Notice of hearing.

(e) pp. 752-771 post.

the Comptroller. Statutory declarations and affidavits shall be in the form for the time being in use in the High Court of Justice.

Notice by applicant.

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

Comptroller may require statement, &c.

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

Decision to be notified to parties.

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

Industrial or International Exhibitions.

15. Any person desirous of exhibiting an invention at an industrial or international exhibition, or of publishing any description of the invention during the period of the holding of the exhibition, or of using the invention for the purpose of the exhibition in the place where the exhibition is held, shall, after the Board of Trade have issued a certificate that the exhibition is an industrial or international one, give to the Comptroller notice, in writing, of his intention to exhibit, publish, or use the invention, as the case may be.

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

Power of amendment, &c.

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

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

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

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

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

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

APPLICATION WITH PROVISIONAL OR COMPLETE SPECIFICATION.

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

Order of recording applications.

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

19. Where a person making application for a patent includes therein by mistake, inadvertence, or otherwise, more than one invention, he may, after the refusal of the Comptroller to accept such application, amend the same so as to apply to one invention only, and may make application for separate patents for each such invention accordingly.

Application for separate patents by way of amendment.

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

20. An application for a patent by the legal representative of a person who has died possessed of an invention shall be accompanied

Application by representative of deceased inventor.

by an official copy of or extract from his will, or the letters of administration granted of his estate and effects in proof of the applicant's title as such legal representative, and must be supported by such further evidence as the Comptroller may require.

Notice and advertisement of acceptance.

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

Inspection on acceptance of complete specification.

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

#### APPLICATION ON COMMUNICATION FROM ABROAD.

Communication from abroad.

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

#### INTERNATIONAL AND COLONIAL ARRANGEMENTS.

24. The term "foreign application" shall mean an application by any person for protection of his invention in a foreign State or British Possession to which by any Order of her Majesty in Council for the time being in force the provisions of section 103 of the Patents, Designs, and Trade Marks Act, 1883, have been declared applicable.

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

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

- (1.) A copy or copies of the specification, and drawings or documents corresponding thereto, filed or deposited by the



applicant in the Patent Office of the foreign State or British Possession in respect of the first foreign application duly certified by the official chief or head of the Patent Office of such foreign State or British Possessions as aforesaid, or otherwise verified to the satisfaction of the Comptroller ;

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

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

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

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

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

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

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

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

Size of drawings.

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

Quality of ink.

To ensure their satisfactory reproduction, the drawings must be executed with *absolutely black Indian-ink; the same strength and colour of fine and shade lines to be maintained throughout.* Section lines, and lines for effect, or shading lines, must not be closely drawn. A specimen drawing is inserted in illustration of this requirement.<sup>(f)</sup> Reference figures and letters must be bold, distinct, not less than  $\frac{1}{8}$  of an inch in height; and the same letters should be used in different views of the same parts. In cases of complicated drawings, the reference letters must be shown outside the figure, and connected with the part referred to by a fine line.

Scale of drawings.

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

Drawings to bear name of applicant, &c.

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

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

Restrictions as to wood engravings.

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

Copies of drawings.

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

Provisional

33. If an applicant desires to adopt the drawings lodged with his

(f) See Official Rules.

provisional specification as the drawings for his complete specification, drawings used he should refer to them as those "left with the provisional speci- for complete specification. cation."

OPPOSITION TO GRANTS OF PATENTS.

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

35. On receipt of such notice the copy thereof shall be transmitted by the Comptroller to the applicant. Copy for applicant.

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

37. Within 14 days after the expiration of two months from the date of the advertisement of the acceptance of a complete specification, the opponent may leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant a list thereof. Opponent's evidence.

38. Within 14 days from the delivery of such list the applicant may leave at the Patent Office statutory declarations in answer, and on so leaving shall deliver to the opponent a list thereof, and within 14 days from such delivery the opponent may leave at the Patent Office his statutory declarations in reply, and on so leaving shall deliver to the applicant a list thereof. Such last-mentioned declarations shall be confined to matters strictly in reply. Applicant's evidence. Evidence in reply.

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

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

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

41. On completion of the evidence, or at such other time as he may see fit, the Comptroller shall appoint a time for the hearing of the case, and shall give the parties 10 days' notice at the least of Notice of hearing.

such appointment. If the applicant or opponent desires to be heard he must forthwith send the Comptroller an application on Form E.<sup>(h)</sup> The Comptroller may refuse to hear either party who has not sent such application for hearing. If neither party applies to be heard the Comptroller shall decide the case and notify his decision to the parties.

Disallowance of opposition in certain cases.

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

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

Decision to be notified to parties.

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

#### CERTIFICATES OF PAYMENT OR RENEWAL.

Payment of fees of 50*l.* and 100*l.* for continuance of patent.

45. If a patentee intends at the expiration of the fourth or eighth year from the date of his patent to keep the same in force, he shall, before the expiration of such fourth or eighth year, as the case may be, subject as hereinafter provided, pay the prescribed fee of 50*l.* or 100*l.*, as the case may be.

As to patents granted before commencement of Act.

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

Payment of annual fees in lieu of 50*l.* and 100*l.*

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

The form J <sup>(i)</sup> in the Second Schedule, duly stamped, should be used for the purpose of this and the patent referred to in Rule 45.

Certificate of payment.

48. On due compliance with these Rules, and as soon as may be after such respective periods as aforesaid, or any enlargement

(h) p. 753 *post.*

(i) p. 759 *post.*

thereof respectively duly granted, the Comptroller shall issue a certificate that the prescribed payment has been duly made.

ENLARGEMENT OF TIME.

49. An application for an enlargement of the time for making a prescribed payment shall state in detail the circumstances in which the patentee by accident, mistake, or inadvertence has failed to make such payment, and the Comptroller may require the patentee to substantiate by such proof as he may think necessary the allegations contained in the application for enlargement.

Enlargement of time for payments.

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

Extension of time for leaving and accepting complete specification.

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

In other cases.

AMENDMENT OF SPECIFICATION.

52. A request for leave to amend a specification must be signed by the applicant or patentee (hereinafter in Rules 54, 55, and 58 called the applicant) and accompanied by a duly certified printed copy of the original specification and drawings, showing in red ink the proposed amendment, and shall be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner (if any) as the Comptroller may in each case direct.

Request for leave to amend.

Advertisement.

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

Notice of opposition.

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

Copy for the applicant.

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

Opponent's evidence.

Further proceedings.

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

Requirements thereon.

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

Leave by order of Court.

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

Advertisement of amendment.

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

#### COMPULSORY LICENCES.

Petition for compulsory grant of licences.

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

To be left with evidence at Patent Office.

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

Directions as to further proceedings unless petition refused.

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

Procedure.

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

Petitioner's evidence.

Patentee's evidence.

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

Evidence in reply.

65. The petitioner within 14 days from such delivery shall leave at the Patent Office his affidavits or statutory declarations in reply,

and deliver copies thereof to the patentee; such last-mentioned affidavits or declarations shall be confined to matters strictly in reply.

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

#### REGISTER OF PATENTS.

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

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

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

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

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

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

Copies for  
Patent Office.

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

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

Body  
corporate.

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

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

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

Entry of pay-  
ment of fees on  
issue of  
certificate.

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

Entry of  
failure to pay  
fees.

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

Entry of  
licences.

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

Hours of  
inspection of  
register.

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

(a) Christmas Day, Good Friday, the day observed as her Majesty's birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England ; or

(b) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office ;



(c) Times when the register is required for any purpose of official use.

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

#### POWER TO DISPENSE WITH EVIDENCE, &c.

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

#### REPEAL.

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

Dated the 31st day of March 1890.

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

## RULES REGULATING THE PRACTICE AND PROCEDURE ON APPEAL TO THE LAW OFFICERS.

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

II. Such notice shall state the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and if so, what part of such decision.

III. A copy of such notice of intention to appeal shall be sent by the party so intending to appeal to the law officers' clerk, at Room 549, Royal Courts of Justice, London; and when there has been an opposition before the Comptroller, to the opponent or opponents; and when the Comptroller has refused to seal a patent on the ground that a previous application for a patent for the same invention is pending, to the prior applicant.

IV. Upon notice of appeal being filed, the Comptroller shall forthwith transmit to the law officers' clerk all the papers relating to the matter of the application in respect of which such appeal is made.

V. No appeal shall be entertained of which notice is not given within fourteen days from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave, upon application to the law officer.

VI. Seven days' notice, at least, of the time and place appointed for the hearing of any appeal, shall be given by the law officers' clerk unless special leave be given by the law officer that any shorter notice be given.

VII. Such notice shall in all cases be given to the Comptroller and the appellant; and, when there has been an opposition before the Comptroller, to the opponent or opponents; and, when the Comptroller has refused to seal a patent on the ground that an application for a patent for the same invention is pending, to the prior applicant.

VIII. The evidence used on appeal to the law officer shall be the same as that used at the hearing before the Comptroller; and no further evidence shall be given, save as to matters which have occurred or come to the knowledge of either party, after the date of the decision appealed against, except with the leave of the law officer upon application for that purpose.

IX. The law officer shall, at the request of either party, order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person, who has made a declaration, in the matter to which the appeal relates, unless in the opinion of the law officer there is good ground for not making such order.

X. Any person requiring the attendance of a witness for cross-examination shall tender to the witness whose attendance is required a reasonable sum for conduct-money.

XI. Where the law officer orders that costs shall be paid by any party to another he may fix the amount of such costs, and if he shall not think fit to fix the amount thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained.

XII. If any costs so ordered to be paid be not paid within fourteen days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment under the provisions of section 38 of the Act.

XIII. All documentary evidence required, or allowed by the law officer to be filed, shall be subject to the same regulations, in all respects, as apply to the procedure before the Comptroller, and shall be filed in the Patent Office, unless the law officer shall order to the contrary.

XIV. Any notice or other document required to be given to the law officers' clerk, under these Rules, may be sent by a prepaid letter through the post.

HENRY JAMES, A.-G.

FARRER HERSCHELL, S.-G.

## PATENT CASES BEFORE THE JUDICIAL COMMITTEE.

NOTE.—*The following Rules must be considered as repealed in so far as they are at variance with the Privy Council Rules, 1898.(a)*

*Rules to be observed in Proceedings before the Right Honourable the Lords of the Judicial Committee of the Privy Council under the Act of the 5th and 6th William IV., intituled "An Act to amend the Law touching Letters Patent for Inventions," cap. 83.*

### RULE I.

A party intending to apply by petition, under section 2 of the said Act, shall give public notice by advertising in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carries on any manufacture of anything made according to his specification, or near to or in which he resides, in case he carries on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to petition his Majesty under the said section, and shall in such advertisements state the object of such petition, and give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day, notice must be given of any opposition intended to be made to the petition; and any person intending to oppose the said application shall lodge notice to that effect at the Council Office, on or before such day so named in the said advertisements, and having lodged such notice shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

### RULE II.

A party intending to apply by petition, under section 4 of the said Act, shall, in the advertisements directed to be published by

(a) p. 731 *post*.

the said section, give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day *caveats* must be entered; and any person intending to enter a *caveat* shall enter the same at the Council Office, on or before such day so named in the said advertisements; and having entered such *caveat*, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

## RULE III.

Petitions under section 2 and 4 of the said Act must be presented within one week from the insertion of the last of the advertisements required to be published in the *London Gazette*.

## RULE IV.

All petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of section 4 of the said Act, and the 1st and 2nd of these Rules and the matters in such affidavits may be disputed by the parties opposing upon the hearing of the petitioner.

## RULE V.

All persons entering *caveats* under section 4 of the said Act, and all parties to any former suit or action touching letters patent in respect of which petitions shall have been presented under section 2 of the said Act, and all persons lodging notices of opposition under the 1st of these Rules, shall respectively be entitled to be served with copies of petitions presented under the said sections, and no application to fix a time for hearing shall be made without affidavit of such service.

## RULE VI.

All parties served with petitions shall lodge at the Council Office, within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions.

## RULE VII.

Parties may have copies of all papers lodged in respect of any application under the said Act, at their own expense.

## RULE VIII.

The Registrar of the Privy Council, or other officer to whom it

may be referred to tax the costs incurred in the matter of any petition presented under the said Act, shall allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

#### RULE IX.

A party applying for an extension of a patent, under section 4 of the said Act, must lodge at the Council Office six printed copies of the specification, and also four copies of the balance-sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the Lords of the Committee at the hearing. In the event of the applicant's specification not having been printed, and if the expense of making six copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only of such specification and drawing will be deemed sufficient.

All copies mentioned in this Rule must be lodged not less than one week before the day fixed for hearing the application.

The Judicial Committee will hear the Attorney-General, or other counsel, on behalf of the Crown, against granting any application made under either the 2nd or 4th section of the said Act, in case it shall be thought fit to oppose the same on such behalf.

# PRIVY COUNCIL RULES, 1898.

## ORDER IN COUNCIL.

Whereas by the 25th section of an Act of Parliament passed in the 46th and 47th years of her Majesty's reign, intituled "The Patents, Designs, and Trade Marks Act, 1883," it is amongst other things enacted that a patentee may, after advertising in manner directed by any rules made under the said 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; that 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 that it shall be lawful for her Majesty in Council to make from time to time rules of procedure and practice for regulating the 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:

And whereas her Majesty in Council has deemed it expedient to make rules for regulating proceedings in such petitions:

Her Majesty is therefore pleased by and with the advice of her Privy Council to approve of the several rules and regulations contained in the Schedule hereunto annexed, and to order as it is hereby ordered that on and after January 1, 1898, the same be respectfully observed.

Whereof all persons whom it may concern are to take notice and govern themselves accordingly.

C. L. PEEL.

### THE SCHEDULE ABOVE REFERRED TO.

*Rules to be observed in Proceedings before the Judicial Committee of the Privy Council under the Patents, Designs, and Trade Marks Act, 1883, section 25.*

#### I.

A party intending to apply by petition under section 25 of the Act shall give public notice by advertising 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 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.

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.

## II.

A petition under section 25 of the Act must be presented within one week from the publication of the last of the advertisements required to be published in the *London Gazette*.

The petition must be accompanied with an affidavit or affidavits of advertisements having been published according to the requirements of the 1st of these Rules. The statements contained in such affidavit or affidavits may be disputed upon the hearing.

The petitioner shall apply to the Lords of the Committee to fix a time for hearing the petition, and when such time is fixed the petitioner shall forthwith give public notice of the same by advertising once at least in the *London Gazette* and in two London newspapers.

## III.

A party presenting a petition under section 25 of the Act must 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 eight copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only shall be deemed sufficient.



The petitioner shall also lodge at the Council Office eight copies of the balance-sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the Lords of the Committee at the hearing. He shall also furnish three copies of the said balance-sheet for the use of the Solicitor to the Treasury, and shall 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.

All copies mentioned in this Rule must be lodged and furnished not less than fourteen days before the day fixed for the hearing.

#### IV.

A party intending to oppose a petition under section 25 of the Act must enter a *caveat* at the Council Office before the day on which the petitioner applies for a time to be fixed 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.

The petitioner shall serve copies of his petition on all parties entering *caveats* in accordance with this Rule, and no application to fix a time for hearing shall be made without affidavit of such service.

All parties intending to oppose a petition shall within three weeks after such copies are served on them respectively lodge at the Council Office eight printed copies of the grounds of their objections to the granting of the prayer of the petition.

#### V.

Parties shall be entitled to have copies of all papers lodged in respect of any petition under section 25 of the Act at their own expense.

All such petitions and all statements of grounds of objection shall 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 shall be printed in a form convenient for binding along with such petitions.

#### VI.

Costs incurred in the matter of any petition under section 25 of the Act shall be taxed by the Registrar of the Privy Council, or

other officer deputed by the Lords of the Judicial Committee of the Privy Council to tax the costs in the matter of any petition, and the Registrar or such other officer shall have authority to allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses.

#### VII.

The Lords of the Committee may excuse petitioners and opponents from compliance with any of the requirements of these Rules, and may give such directions in matters of procedure and practice under section 25 of the Act as they shall consider to be just and expedient.

#### VIII.

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 any petition under section 25 of the Act. 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.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1888.

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REGISTER OF PATENT AGENTS RULES, 1889.

For the purpose of giving effect to the provisions of the Patents, Designs, and Trade Marks Act, 1888, relating to the registration of patent agents, the Board of Trade, by virtue of the provisions of the said Act, hereby make the following Rules :—

1. A Register shall be kept by the Institute of Patent Agents, subject to the provisions of these Rules and to the orders of the Board of Trade, for the registration of patent agents in pursuance of the Act. Register to be kept.

2. The Register shall contain in one list all patent agents who are registered under the Act and these Rules. Contents of Register.

Such list shall be made out alphabetically, according to the surnames of the registered person, and shall also contain the full name of each registered person, with his address, the date of registration, and a mention of any honours, memberships, or other additions to the name of the registered person which the Council of the Institute may consider worthy of mention in the Register. The Register shall be in the Form 1 in Appendix A., (a) with such variations as may be required.

3. The Institute shall cause a correct copy of the Register to be, once every year, printed, under their direction, and published and placed on sale. Such correct copy shall, in the year 1889, be printed and published at as early a date as is possible, and in every year subsequent to the year 1889, shall be printed and published on the 31st day of January. A copy of the Register for the time being purporting to be so printed and published shall be admissible as evidence of all matters stated therein, and the absence of the name of any person from the Register shall be evidence, until the contrary is made to appear, that such person is not registered in pursuance of the Act. Printed copies to be published annually, and to be evidence of contents of Register.

4. The Institute shall appoint a Registrar, who shall keep the Registrar.

(a) p. 772 post.

Register in accordance with the provisions of the Act, and these Rules, and, subject thereto, shall act under the directions of the Institute, and the Board of Trade.

Registration of persons who were patent agents prior to the passing of this Act.

5. A person who is desirous of being registered in pursuance of the Act, on the ground that prior to the passing of the Act he had been *bonâ fide* practising as a patent agent, shall produce or transmit to the Board of Trade a statutory declaration in the Form 2 in Appendix A. ; (b) provided that the Board of Trade may, in any case in which they shall think fit, require further or other proof that the person had prior to the passing of the Act been *bonâ fide* practising as a patent agent. Upon the receipt of such statutory declaration or of such further or other proof to their satisfaction as the case may be, the Board of Trade shall transmit to the Registrar a certificate that the person therein named is entitled to be registered in pursuance of the Act, and the Registrar shall on the receipt of such certificate cause the name of such person to be entered in the Register.

Final qualifying examination for registration.

6. Subject to the provisions of the Act in favour of every person who proves to the satisfaction of the Board of Trade that prior to the passing of the Act he had been *bonâ fide* practising as a patent agent, no person shall be entitled to be registered as a patent agent, unless he has passed, and produces or transmits to the Registrar a certificate under the seal of the Institute that he has passed, such final examination as to his knowledge of patent law and practice and of the duties of a patent agent as the Institute shall from time to time prescribe.

Exemption of pupils and assistants from preliminary examination.

7. Any person who has been for at least seven consecutive years continuously engaged as a pupil or assistant to one or more registered patent agents, and any person for the time being entitled to practise as a Solicitor of the Supreme Court of Judicature in England or Ireland, or as a law agent before the Court of Session in Scotland, shall be entitled to be registered without passing any examination other than the final examination provided for in the last preceding Rule. The Registrar shall before registering the name of any such person as a patent agent (in addition to the final examination certificate) require proof satisfactory to the Registrar that such person has been for at least seven consecutive years continuously engaged as such pupil or assistant, or is entitled to practise as such Solicitor or Law Agent.

Qualifications of persons generally for registration.

8. Any person who is not qualified under Rule 7 must, in order to be entitled to present himself for the final qualifying examination, be—

A person who has passed one of the preliminary examinations

(b) p. 772 *post*.

mentioned in Appendix B.,(c) or such other examination as the Institute shall, with the approval of the Board of Trade, by regulation prescribe.

9. The Institute shall hold at least once in the year, commencing with the first day of July 1889, and in every other succeeding year, a final qualifying examination, which shall be the final qualifying examination required under Rules 6 and 7; and the Institute shall, subject to these Rules, have the entire management and control of all such examinations, and may from time to time make regulations with respect to all or any of the following matters, that is to say—

Final qualifying examinations to be held by the Institute.

- (a.) The subjects for and the mode of conducting the examination of candidates;
- (b.) The times and places of the examinations, and the notices to be given of examinations;
- (c.) The certificates to be given to persons of their having passed the examinations;
- (d.) The appointment and removal of examiners, and the remuneration, by fees or otherwise, of the examiners so appointed; and
- (e.) Any other matter or thing as to which the Institute may think it necessary to make regulations for the purpose of carrying out this Rule.

10. The Registrar shall from time to time insert in the Register any alteration which may come to his knowledge in the name or address of any person registered.

Corrections of names and addresses in Register.

11. The Registrar shall erase from the Register the name of any registered person who is dead.

Erasure of names of deceased persons.

12. The Registrar may erase from the Register the name of any registered person who has ceased to practise as a patent agent, but not (save as hereinafter provided) without the consent of that person. For the purposes of this Rule the Registrar may send by post to a registered person to his registered address a notice inquiring whether or not he has ceased to practise or has changed his residence, and if the Registrar does not within three months after sending the notice receive an answer thereto from the said person, he may, within fourteen days after the expiration of the three months, send him by post to his registered address another notice referring to the first notice, and stating that no answer has been received by the Registrar; and if the Registrar either before the second notice is sent receives the first notice back from the dead letter office of the Postmaster-General, or receives the second notice back from that office, or does not within three months after sending the second notice receive any answer thereto from the said person, that person shall, for the purposes of

Erasure of names of persons who have ceased to practise.

(c) p. 773 *post.*

this Rule, be deemed to have ceased to practise, and his name may be erased accordingly.

Erasure of names for non-payment of fees.

13. If any registered person shall not, within one month from the day on which his annual registration fee becomes payable, pay such fee, the Registrar may send to such registered person to his registered address a notice requiring him, on or before a day to be named in the notice, to pay his annual registration fee; and if such registered patent agent shall not within one month from the day named in such notice pay the registration fee so due from him, the Registrar may erase his name from the Register: provided that the name of a person erased from the Register under this Rule may be restored to the Register by direction of the Institute or the Board of Trade on payment by such person of the fee or fees due from him, together with such further sum of money, not exceeding in amount the annual registration fee, as the Institute or the Board of Trade (as the case may be) may in each particular case direct.

Registrar to act on evidence.

14. In the execution of his duties the Registrar shall, subject to these Rules, in each case act on such evidence as appears to him sufficient.

Erasure of incorrect or fraudulent entries.

15. The Board of Trade may order the Registrar to erase from the Register any entry therein which is proved to their satisfaction to have been incorrectly or fraudulently inserted.

Erasure of names of persons convicted of crimes, and persons found guilty of disgraceful conduct.

16. If any registered person shall be convicted in her Majesty's dominions or elsewhere of an offence which, if committed in England, would be a felony or misdemeanor, or after due inquiry is proved to the satisfaction of the Board of Trade to have been guilty of disgraceful professional conduct, or having been entitled to practise as a Solicitor or Law Agent shall have ceased to be so entitled, the Board of Trade may order the Registrar to erase from the Register the name of such person. Provided that no person shall be adjudged by the Board of Trade to have been guilty of disgraceful professional conduct unless such person has received notice of, and had an opportunity of defending himself from, any charge brought against him.

Restoration of erased name.

17. (1.) Where the Board of Trade direct the erasure from the Register of a name of any person, or of any other entry, the name of the person or the entry shall not be again entered in the Register, except by order of the Board of Trade.

(2.) The Board of Trade may in any case in which they think fit restore to the Register any name or entry erased therefrom either without fee, or on payment of such fee, not exceeding the registration fee as the Board of Trade may from time to time fix, and the Registrar shall restore the name accordingly.

(3.) The name of any person erased from the Register at the request or with the consent of such person shall, unless it might, if

not so erased, have been erased by order of the Board of Trade, be restored to the Register by the Registrar on his application and on payment of such fee, not exceeding the registration fee, as the Institute shall from time to time fix.

18. For the purpose of exercising in any case the powers of erasing from and of restoring to the Registrar the name of a person, or an entry, the Board of Trade may appoint a committee consisting of such persons as they shall think fit. Every application to the Board of Trade for the erasure from, or restoration to, the Registrar of the name of any patent agent shall be referred for hearing and inquiry to the committee, who shall report thereon to the Board of Trade, and a report of the committee shall be conclusive as to the facts for the purpose of the exercise of the said powers by the Board of Trade.

Inquiry by Board of Trade before erasure of name from Register.

19. Any person aggrieved by any order, direction, or refusal of the Institute or Registrar may appeal to the Board of Trade.

Appeal to Board of Trade.

20. A person who intends to appeal to the Board of Trade under these Rules (in these Rules referred to as the appellant) shall, within fourteen days from the date of the making or giving of the order, direction, or refusal complained of, leave at the office of the Institute a notice in writing signed by him of such his intention.

Notice of appeal.

21. The notice of intention to appeal shall be accompanied by a statement in writing of the grounds of the appeal, and of the case of the appellant in support thereof.

Case on appeal.

22. The appellant shall also immediately after leaving his notice of appeal at the Institute send by post a copy thereof with a copy of the appellant's case in support thereof addressed to the Secretary of the Board of Trade, 7 Whitehall Gardens, London.

Transmission of notice of appeal to Board of Trade.

23. The Board of Trade may thereupon give such directions (if any) as they may think fit for the purpose of the hearing of the appeal.

Directions as to hearing of appeal.

24. Seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing of the appeal shall be given to the appellant and the Institute and the Registrar.

Notice of hearing of appeal.

25. The appeal may be heard by the President, a Secretary, or an Assistant Secretary of the Board of Trade, and the decision and order thereon of the President, Secretary, or Assistant Secretary, as the case may be, shall be the decision of the Board of Trade on such appeal. On the appeal such decision may be given or order made in reference to the subject-matter of the appeal as the case may require.

Hearing and decision of appeal.

26. The fees set forth in Appendix C.(d) to these Rules shall be paid in respect of the several matters, and at the times and in the

Fees.

manner therein mentioned. The Board of Trade may from time to time, by orders signed by the Secretary of the Board of Trade, alter any of, or add to, the fees payable under these Rules.

Alteration of regulations.

27. Any regulation made by the Institute under these Rules may be altered or revoked by a subsequent regulation. Copies of all regulations made by the Institute under these Rules shall, within twenty-eight days of the date of their being made, be transmitted to the Board of Trade, and if within twenty-eight days after a copy of any regulation has been so transmitted, the Board of Trade by an order signify their disapproval thereof, such regulation shall be of no force or effect; and if, after any regulation under these Rules has come into force, the Board of Trade signify in manner aforesaid their disapproval thereof, such regulation shall immediately cease to be of any force or effect.

Report to Board of Trade.

28. The Institute shall once every year in the month of December transmit to the Board of Trade a Report stating the number of applications for registrations which have been made in the preceding year, the nature and results of the final examinations which have been held, and the amount of fees received by the Institute under these Rules, and such other matters in relation to the provisions of these Rules, as the Board of Trade may from time to time, by notice signed by the Secretary of the Board of Trade and addressed to the Institute, require.

Definitions.

29. In these Rules, unless the context otherwise requires—

“The Act” means the Patents, Designs, and Trade Marks Act, 1888.

“The Institute” means the Institute of Patent Agents, acting through the Council for the time being.

“The Registrar” means the Registrar appointed under these Rules.

“Registered patent agent” means any agent for obtaining patents in the United Kingdom whose name is registered under the Act and these Rules.

Commencement.

30. These Rules shall commence and come into operation on the 12th day of June 1889, but at any time after the making thereof any appointment or regulations may be made and things done for the purpose of bringing these Rules into operation on the said day.

Title.

31. These Rules may be cited as the Register of Patent Agents Rules, 1889.

By the Board of Trade,

COURTENAY BOYLE,

Assistant Secretary, Railway Department.

The 11th day of June 1889.



## FORM OF PATENT.(e)

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

Whereas *John Smith*, of *29 Perry Street, Birmingham*, in the county of *Warwick*, *Engineer*, hath by his solemn declaration represented unto us that he is in possession of an invention for "*Improvements in Sewing Machines*," that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief:

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

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

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

Know ye, therefore, that We, of our especial grace, certain knowledge, and mere motion do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial licence, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great

(e) This form appears as Form D. in the First Schedule to the Patents, Designs, and Trade Marks Act, 1883.

Modifications of this form are necessary to meet special cases, and at the Patent Office eight modified forms are kept in stock:

- A. Grant to a single inventor.
- B. Grant to several joint applicants, all being inventors.
- C. Grant to importer.
- D. Grant to several joint applicants only some of whom are inventors.

E. Grant to the legal representative of an inventor who has died possessed of an invention, in respect of which he has made an application.

EE. Grant to legal representatives of an inventor who has died possessed of an invention, in respect of which he has made an application.

F. Grant to a female applicant.

G. Grant to several joint applicants where one of the original applicants is dead.

Britain and Ireland, and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention, during the term of fourteen years from the date hereunder written of these presents : And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for us our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, licence or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law, for his damages thereby occasioned : Provided that these our letters patent are on this condition, that, if at any time during the said term it be made to appear to us, our heirs or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything hereinbefore contained : Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided ; and also if the said patentee shall not supply or cause to be supplied for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything hereinbefore contained : Provided also that nothing herein contained shall prevent the granting of licences in such manner and for such

considerations as they may by law be granted : And lastly, we do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee. In witness whereof we have caused these our letters to be made patent this                                      one thousand eight hundred and                                      and to be sealed as of the                                      one thousand eight hundred and



FORMS.(b)

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form A.

(To be accompanied by two copies of Form B.  
or of Form C.)

PATENT.

APPLICATION FOR PATENT.

(a) Here insert name and full address and calling of applicant or applicants.

(a) \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

\_\_\_\_\_ do hereby declare that \_\_\_\_\_ in possession of an invention the title of which is (b) \_\_\_\_\_

(b) Here insert title of invention.

\_\_\_\_\_  
\_\_\_\_\_

(c) In the case of more than one applicant, state whether all, or if not, who is or are the inventor or inventors.

that (c) \_\_\_\_\_ the true and first inventor \_\_\_\_\_ thereof; and that the same is not in use by any other person or persons to the best of \_\_\_\_\_ knowledge and belief; and \_\_\_\_\_ humbly pray that a Patent may be granted to \_\_\_\_\_ for the said invention.

Dated \_\_\_\_\_ day \_\_\_\_\_ 18

(d) To be signed by applicant or applicants. In the case of a Firm, each member of the Firm must sign.

(d) \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

NOTE.—Where application is made through an Agent (Rule 8), the authorisation on the back (if used) should be signed by the applicant or applicants.

To the COMPTROLLER,  
Patent Office, 25 Southampton Buildings,  
Chancery Lane, London, W.C.

(b) The following forms A. to V. are contained in the Second Schedule to the Patent Rules 1890.

For the convenience of applicants, suggested forms of authorisation to an Agent and statement of address respectively are printed below :—

(1) *Where application is made through an Agent (Rule 8).*

\_\_\_\_\_ hereby appoint \_\_\_\_\_

of \_\_\_\_\_

to act as \_\_\_\_\_ Agent in respect of the within application for a Patent, and request that all notices, requisitions, and communications relating thereto may be sent to such Agent at the above address.

\_\_\_\_\_ day of \_\_\_\_\_ 18

\* \_\_\_\_\_  
 \_\_\_\_\_  
 \_\_\_\_\_  
 \_\_\_\_\_

\* To be signed by applicant or applicants.

(2) *Where application is made without an Agent (Rule 9).*

\_\_\_\_\_ hereby request that all notices, requisitions, and communications in respect of the within application may be sent to \_\_\_\_\_ at \_\_\_\_\_

\_\_\_\_\_ day of \_\_\_\_\_ 18

† \_\_\_\_\_  
 \_\_\_\_\_  
 \_\_\_\_\_  
 \_\_\_\_\_

† To be signed by applicant or applicants.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form A 1.

(To be accompanied by two copies of Form B. or of Form C.)

APPLICATION FOR PATENT FOR INVENTION  
COMMUNICATED FROM ABROAD.

PATENT.

(a) Here insert name and full address and calling of applicant.

I (a) \_\_\_\_\_  
of \_\_\_\_\_ in the  
county of \_\_\_\_\_ do hereby declare that I

(b) Here insert title of invention.

am in possession of an invention the title of which is (b)

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

(c) Here insert name, address, and calling of communicant.

which invention has been communicated to me by (c)

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

that I claim to be the true and first inventor thereof; and that the same is not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons to the best of my knowledge and belief; and I humbly pray that a Patent may be granted to me for the said invention.

Dated \_\_\_\_\_ day of \_\_\_\_\_ 18 \_\_\_\_\_

(d) To be signed by applicant or applicants.

(d) \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

NOTE.—Where application is made through an Agent (Rule 8) the authorisation on the back (if used) should be signed by the applicant or applicants.

To the COMPTROLLER,  
Patent Office, 25 Southampton Buildings,  
Chancery Lane, London, W.C.

For the convenience of applicants, suggested forms of authorisation to an Agent and statement of address respectively are printed below :—

(1) *Where application is made through an Agent (Rule 8).*

\_\_\_\_\_ hereby appoint \_\_\_\_\_  
of \_\_\_\_\_  
to act as \_\_\_\_\_ Agent in respect of the within application for a Patent, and request that all notices, requisitions, and communications relating thereto may be sent to such Agent at the above address.

\_\_\_\_\_ day of \_\_\_\_\_ 18 \_\_\_\_\_

\* \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

\* To be signed by applicant or applicants.



(2) *Where application is made without an Agent (Rule 9).*

\_\_\_\_\_ hereby request that all notices, requisitions, and communications in respect of the within application may be sent to \_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_ at \_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_ day of \_\_\_\_\_ 18 \_\_\_\_\_

† \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

† To be signed by applicant or applicants.

PATENT.
---------

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form A 2.

APPLICATION FOR PATENT UNDER INTERNATIONAL  
AND COLONIAL ARRANGEMENTS.

(a) Here  
insert name  
and full address  
and calling of  
applicant, or of  
each of the  
applicants.

(a)

do hereby declare that I (or we) have made foreign applications for  
protection of my (or our) invention of (b)

(b) Here  
insert title of  
invention.

in the following Foreign States and on the following official dates  
viz. : (c)

(c) Here  
insert the  
names of each  
Foreign State  
followed by  
the official  
application in  
each re-  
spectively.

and in the following British Possessions and on the following official  
dates, viz. : (d)

(d) Here  
insert the  
names of each  
British Pos-  
session fol-  
lowed by the  
official date of  
the application  
in each re-  
spectively.

(e) Here  
insert the  
official date of  
the earliest  
foreign  
application.

That the said invention was not in use within the United King-  
dom of Great Britain and Ireland and the Isle of Man by any other  
person or persons before the (e)



to the best of                    knowledge, information and belief, and  
humbly pray that a patent may be granted to                    for the said  
invention in priority to other applicants, and that such patent shall  
have the date (f)

(f) Here  
insert the  
official date of  
the earliest  
foreign  
application.

(g) \_\_\_\_\_

(g) Signature  
of applicant or  
of each of  
applicants.

To the COMPTROLLER,  
Patent Office, 25 Southampton Buildings,  
Chancery Lane, London. W.C.

To be issued with Form A, A 1, or A 2.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form B.

PROVISIONAL SPECIFICATION.

(To be furnished in Duplicate.)

(a) Here  
insert title as  
in declaration.

(a) \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

(b) Here  
insert name  
and full address  
and calling of  
applicant or  
applicants as in  
declaration.

(b) \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

(c) Here  
insert short  
description of  
invention.

do hereby declare the nature of this invention to be as follows:—(c)

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

NOTE.—No stamp is required on this document, which must form the commencement of the Provisional Specification; the continuation to be upon wide-ruled foolscap paper (but on one side only) with a margin of two inches on left hand of paper. The Provisional Specification and the "Duplicate" thereof must be signed by the applicant or his agent, on the last sheet, the date being first inserted as follows:

" Dated this \_\_\_\_\_ day of \_\_\_\_\_ 18 \_\_\_\_\_ "

To the COMPTROLLER,  
Patent Office, 25 Southampton Buildings,  
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Where provisional specification has been left, quote No. and date.

No. \_\_\_\_\_  
Date \_\_\_\_\_

Form C.

COMPLETE SPECIFICATION.

(To be furnished in Duplicate—one unstamped.)

PATENT.

(a) \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

(a) Here insert title as in declaration.

(b) \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

(b) Here insert name and full address and calling of applicant or applicants as in declaration.

do hereby declare the nature of this invention and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement :

(c) \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

(c) Here insert full description of invention, which must end with a distinct statement of claim or claims, in the following form:—

“ Having now particularly described and ascertained the nature of my said Invention, and in what manner the same is to be performed, I declare that what I claim is  
Here 1.  
state 2.  
distinctly 3.  
the features of novelty claimed.”

NOTE.—This document must form the commencement of the Complete Specification; the continuation to be upon wide-ruled foolscap paper (but on one side only) with a margin of two inches on left hand of paper. The Complete Specification and the “ Duplicate ” thereof must be signed by the applicant, or his agent, on the last sheet, the date being first inserted as follows:

“ Dated this \_\_\_\_\_ day of \_\_\_\_\_ 18 \_\_\_\_\_ ”

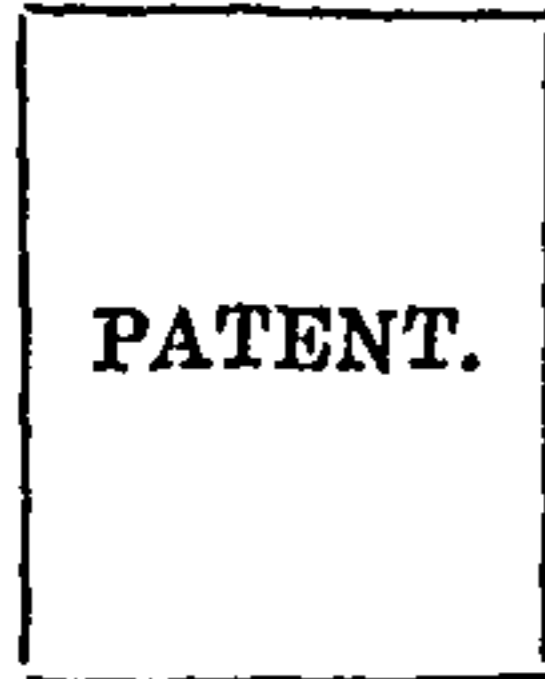
To the COMPTROLLER,  
Patent Office, 25 Southampton Buildings,  
Chancery Lane, London, W.C.

## PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

## Form D.

## FORM OF OPPOSITION TO GRANT OF PATENT.

(To be accompanied by an unstamped copy.)



\* Here state  
name and full  
address.

\* I \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

hereby give notice of my intention to oppose the grant of Letters  
Patent upon application No. \_\_\_\_\_ of \_\_\_\_\_, applied  
for by \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

† Here state  
upon which of  
the grounds of  
opposition per-  
mitted by  
s. 11 of the  
Act the grant  
is opposed.

upon the ground † \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

‡ Here insert  
signature of  
opponent.

(Signed) ‡ \_\_\_\_\_

To the COMPTROLLER,  
Patent Office, 25 Southampton Buildings,  
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form E.

FORM OF APPLICATION FOR HEARING BY THE  
COMPTROLLER.

PATENT.

*In Cases of Refusal to Accept, Opposition, or Applications for  
Amendments, &c.*

SIR,

\_\_\_\_\_ of (a) \_\_\_\_\_ (a) Here in-  
sert address.

\_\_\_\_\_

hereby apply to be heard in reference to

and request that I may receive due notice of the day fixed for the  
hearing.

\_\_\_\_\_  
Sir,  
Your obedient Servant,

To the COMPTROLLER,  
Patent Office, 25 Southampton Buildings,  
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form F.

PATENT.

FORM OF APPLICATION FOR AMENDMENT OF SPECIFICATION OR DRAWINGS.

\* Here state name and full address of applicant or patentee.

\* \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

seek leave to amend the specification of Letters Patent No. \_\_\_\_\_ of 188\_\_\_\_, as shown in red ink in the copy of the original specification hereunto annexed \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

† Here state reasons for seeking amendment; and where the applicant is not the patentee, state what interest he possesses in the letters patent.

My reasons for making this amendment are as follows † \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

(Signed) † \_\_\_\_\_

‡ To be signed by applicant.

To the COMPTROLLER,  
Patent Office, 25 Southampton Buildings,  
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form G.

FORM OF OPPOSITION TO AMENDMENT OF SPECIFICATION OR DRAWINGS.

PATENT.

(To be accompanied by an unstamped copy.)

\* \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

\* Here state name and full address of opponent.

hereby give notice of objection to the proposed amendment of the specification or drawings of Letters Patent No. \_\_\_\_\_

of 188\_\_\_\_\_ for the following reason : † \_\_\_\_\_

† Here state reason of opposition.

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

(Signed) \_\_\_\_\_

To the COMPTROLLER,  
Patent Office, 25 Southampton Buildings,  
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form H.

PATENT.

FORM OF APPLICATION FOR COMPULSORY GRANT  
OF LICENCE.

(To be accompanied by an unstamped copy.)

\* Here state \*  
name and full  
address of  
applicant.

---



---



---

hereby request you to bring to the notice of the Board of Trade

† Here state  
name and ad-  
dress of  
patentee, and  
number and  
date of his  
patent.

the accompanying petition for the grant of a licence to me by †

---



---



---



---

(Signed) \_\_\_\_\_

NOTE.—The petition must clearly set forth the facts of the case and be accompanied by an examined copy thereof. See Form next page.

To the COMPTROLLER,  
Patent Office, 25 Southampton Buildings,  
Chancery Lane, London, W.C.



PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form H 1.

FORM OF PETITION FOR COMPULSORY GRANT OF LICENCES.

To the LORDS of the COMMITTEE of PRIVY COUNCIL for  
TRADE.

The petition of (a) \_\_\_\_\_ of \_\_\_\_\_  
in the county of \_\_\_\_\_, being a  
person interested in the matter of this petition as hereinafter de-  
scribed :—

Sheweth as follows :—

1. A patent dated \_\_\_\_\_ No. \_\_\_\_\_  
was duly granted to \_\_\_\_\_  
for an invention of (b)

2. The nature of my interest in the matter of this petition is as  
follows :—(c)

3. (d)

Having regard to the circumstances above stated, the petitioner  
alleges that by reason of the aforesaid default of the patentee to  
grant licences on reasonable terms (e)

Your petitioner therefore prays that  
an order may be made by the Board of  
Trade (f)

or that the petitioner may have such other  
relief in the premises as the Board of  
Trade may deem just.

(a) Here in-  
sert name, full  
address, and  
description.

(b) Here in-  
sert title of  
invention.

(c) Here  
state fully the  
nature of  
petitioner's  
interest.

(d) Here  
state in detail  
the circum-  
stances of the  
case under  
s. 22 of the  
said Act, and  
show that it  
arises by  
reason of the  
default of the  
patentee to  
grant licences  
on reasonable  
terms. The  
statement of  
the case should  
also show as  
far as possible  
that the terms  
of the proposed  
order are just  
and reasonable.  
The para-  
graphs should  
be numbered  
consecutively.

(e) Here  
state the  
ground or  
grounds on  
which relief is  
claimed in the  
language of  
s. 22, sub-ss.  
(a), (b), or (c),  
as the case  
may be.

(f) Here  
state the pur-  
port and effect  
of the proposed  
order and the  
terms as to the  
amount of  
royalties,  
security for  
payment, or  
otherwise,  
upon which the  
petitioner  
claims to be  
entitled to the  
relief in  
question.