

The ordinary rules as to the invalidity of an instrument obtained by fraud, or executed by both parties under a mutual mistake, apply to licences (r). So, too, in proper cases, specific performance will be granted of agreements for the grant of licences (s). Fraud, mistake, specific performance.

Generally a licence to manufacture implies a licence to use (t), and a licence to vend gives the right to licence purchasers to use, or sell again, the article purchased (u). A licence merely to "use and exercise" may also from its general terms be extended so as to authorise manufacture and sale (x). But a personal licence to use certain goods, the property of the licensor, does not give the power to licence others to use them as on a distraint (y). If a licence only permits the making of an article of a particular kind an action for infringement will lie for making articles within the patent and not within the licence (z). Construction of licence.

So, too, in some cases an agreement in the form of a licence may make royalty payable on articles or processes not in fact within the patent (a).

Generally speaking a licence is strictly personal, and the rights granted by it cannot be transferred to others in the absence of special terms (b). The licensee may, of course, employ his own servants or agents to carry out the manufacture, but is not entitled to have the articles made for him by Assignability of licences.

(r) *Edison-Bell Phonograph Coy., Ltd. v. Rosenburg*, 16 R. P. C. 608; *Macdougall Brothers v. Partington*, 7 R. P. C. 216; *Ashworth v. Law*, 7 R. P. C. 231; *Rochen v. London Small Arms Coy.* (1877), 46 L. T. 577.

But this does not, of course, apply to such matters as a mutual mistake as to the validity of the patent. Cf. *Taylor v. Hare* (1805), Davies, 307.

(s) *Brake v. Rodermacher*, 20 R. P. C. 631.

(t) See, however, *Bassett v. Graydon*, 14 R. P. C. 704, H. L.

So in the case of a licence under a patent "for the metal fittings and the mode of applying them," where a royalty was fixed for each pair of metal plates it was held to include payment for using the mode of attachment. *Oxley v. Holden* (1860), 30 L. J. C. P. 60.

(u) *Thomas v. Hunt* (1864), 17 C. B. (N. S.) 183.

(x) *Dunlop Pneumatic Tyre Coy.,*

L.P.

Ltd. v. North British Rubber Coy., 21 R. P. C. 161, C. A.

(y) *British Mutoscope Coy. v. Homer*, 18 R. P. C. 177.

(z) *La Société d'Appareils, &c. d'Eclairage v. Midland Lighting Coy.*, 14 R. P. C. 419; *Dunlop Pneumatic Tyre Coy., Ltd. v. Buckingham*, 18 R. P. C. 43, C. A.

In the last-named case the licence was confined to tyres exactly like a deposited one. This tyre had a rim attached, but the Court held that as long as the actual tyres were the same the form of the rim might be varied. Cf. also *Roberts v. Graydon*, 21 R. P. C. 194.

(a) *Baird v. Neilson* (1842), 8 C. & F. 726.

(b) *British Mutoscope Coy. v. Homer*, 18 R. P. C. 177. Where a licence has been assigned *semble* the assignor cannot subsequently attack the patent, since to do so would depreciate the value of the licence. *Gonville v. Hay*, 21 R. P. C. 49.

an independent contractor (c). In the absence of express provisions the licensee may exercise his powers where and to what extent he will, and if a licence is assignable it can be assigned to a person with a more extensive business than the original licensee (d). An assignable licence can apparently be transferred to trustees for others, and the latter are then protected by it and bound by its terms (e). Even where a licence is not assignable the patentee if he accepts royalties from those to whom it was purported to be assigned, may be estopped from disputing the validity of the assignment (f). It would seem that there is no privity of contract between the patentee and the assignee of the licence (g).

**Terminability
of licences.**

The question of whether either party can terminate a licence depends in each case on its special terms. Generally, however, where a licence is expressed to be for a definite time, it cannot be revoked (h), except for acts bringing about forfeiture (i), nor can the licensee disclaim it (k). If the licensor conveys as beneficial owner he apparently cannot revoke the licence (l). It would also appear that a parol licence is *prima facie* terminable at will (m). The dicta and decisions in other

(c) See *Howard and Bullough, Ltd. v. Tweedale and Smalley*, 12 R. P. C. 519; *Dixon v. London Small Arms Coy.* (1875), 1 A. C. 632.

As to what is and is not manufacture by the licensee cf. these cases, and *Dunlop Pneumatic Tyre Coy., Ltd. v. Holborn Tyre Coy., Ltd.*, 18 R. P. C. 22; *Same v. Cresswell*, 18 R. P. C. 473.

In *Same v. North British Rubber Coy.*, 21 R. P. C. 161, C. A., it was held that an independent manufacturer was the licensee's agent. In this case, however, the tyres were manufactured abroad.

(d) *Bown v. Humber Coy.*, 6 R. P. C. 9. In this case the licence was only assignable together with the business carried on at certain premises, but it was held that the purchaser of such licence or business might also use the invention elsewhere.

(e) *Bower v. Hodges* (1853), 22 L. J. (C.P.) 194. In this case MAULE, J., expressed the view that a licence to A. and his assigns means a licence to A. and any person whom he may licence *sed quaere*.

(f) *Lawson v. Donald MacPherson & Coy.*, 14 R. P. C. 697.

(g) *Bagot Pneumatic Tyre Coy., Ltd. v. Clipper Pneumatic Tyre Coy., Ltd.*, 19 R. P. C. 69, C. A.; distinguishing *Werderman v. Société Generale d'Electricite* (1881), 19 Ch. D. 246, C. A.; but see *Dansk Rekytriffél v. Snell*, 25 R. P. C. 421.

(h) *Guyot v. Thomson*, 11 R. P. C. 541, C. A.; *Ward v. Livesey*, 5 R. P. C. 102.

From these cases it would seem that patent licences are in general "licences coupled with an interest." If provision is made for termination by certain parties in certain events there seems to be a presumption that the licence is not terminable otherwise. *Cutlan v. Dawson*, 14 R. P. C. 249, C. A.; *Guyot v. Thomson, supra*.

(i) *Ward v. Livesey, supra*.

A mere breach of covenant may not give this power. *Guyot v. Thomson, supra*.

(k) *Cutlan v. Dawson, supra*.

(l) *Guyot v. Thomson, ubi supra*. Per LINDLEY, L.J., at p. 554.

(m) *Coppin v. Lloyd*, 15 R. P. C. 373; *Coppin v. Palmer, ibid.*; *Crossley v. Dixon* (1863), 10 H. L. C. 293.

cases give no clear line of definition (*n*). If there is a provision that the licence is terminable on a certain date if certain provisions have not been complied with; acceptance of royalties after that date may estop the licencor from terminating it (*o*). Any party to a contract relating to the lease of or licence to use or work the article or patented process may after the patent, or all of the patents, by which the article or process was protected when the contract was made have ceased to be in force, determine such contract by three months' notice notwithstanding any agreement to the contrary (*p*).

The sale of an article by the patentee or his licencees gives, in the absence of special terms, a general licence to the purchaser or his successors to use it as he will (*q*). But if there were conditions limiting such licence which were a term of the sale, and known to the purchaser at the time of the sale, then acts infringing these conditions are not licenced (*r*). In the case of sub-purchasers it would appear that they are only bound by these conditions if they were aware of them at the time when they purchased. The patentee is also entitled, in addition to his remedy by an action for infringement (*s*), to bring an action for breach of the conditions against the immediate purchaser from him (*t*).

With regard to the covenant for quiet enjoyment it has been suggested that in the case of an exclusive licence it is a breach of this covenant if the vendor does not prevent others

(*n*) *E.g. cf. Cheetham v. Nuttall*, 10 R. P. C. 321, where the licence was held not to be terminable, and *Ridges v. Mulliner*, 10 R. P. C. 21, where it was held to be terminable.

(*o*) *Warwick v. Hooper* (1852), 2 Mac. & G.

(*p*) Sect. 38 (2).

(*q*) *Betts v. Wilmot* (1871), 6 Ch. App. 239; *Thomas v. Hunt* (1864), 17 C. B. (N. S.) 183.

Semble, where articles are sold in a half-finished state there is a licence to complete them. *Coppin v. Lloyd*, *Same v. Palmer*, 15 R. P. C. 373.

(*r*) *Incandescent Gas Light Coy., Ltd. v. Cantelo*, 12 R. P. C. 262. See also cases in next note.

(*s*) That a purchaser is bound by such conditions if known to him appears from *Incandescent Gas Light Coy., Ltd. v. Brodgen*, 16 R. P. C. 179, and from the judgment in *National Phonograph Coy. of Australia,*

Ltd. v. Menck, 28 R. P. C. 229, P. C.

In the last-named case it was also laid down that these conditions would not bind a sub-purchaser in the absence of notice at the time of purchase. But in *Badische, &c. v. Isler*, 23 R. P. C. 173, BUCKLEY, J., held that the purchaser with a limited licence could not give a greater licence to the sub-purchaser, and that, therefore, the latter's knowledge was immaterial. In the particular case, however, he held that the patentees having attached to the goods a label purporting to set out the conditions of resale, &c., were estopped from setting up other conditions. *Cf. Coppin v. Lloyd, Same v. Palmer*, 15 R. P. C. 373. See also on this subject *Gillette Safety Razor Coy., Ltd. v. Gamage, Ltd.*, 25 R. P. C. 492, and 782, C. A.

(*t*) *Crosthwaite v. Steel*, 6 R. P. C. 190.

Licence
by sale.

Duties of
licencor.

from infringing the patent (*u*). It is also a breach in the case of such a licence if the patentee himself makes under the patent (*x*). A licencor will be restrained from using threats against the licensee (*y*).

In the absence of express provisions making the performance of the covenant for quiet enjoyment a condition precedent to the covenant for the payment of royalties the Court will not construe it as such. A breach of the former covenant is therefore only available by way of counterclaim and not as a defence to an action for royalties (*z*). It would seem that there is not necessarily an obligation on a licencor to keep the patent in force, though this may be in some cases inferred from the general terms of the licence (*a*).

Estoppel on licensee.

In the case of a licence to make sell or use, other than the implied licence to use a definite article in general given by the sale of such article (*b*), the licensee is estopped from disputing the validity of the patent under which the licence is granted (*c*), and it is immaterial whether the licence is by deed or parol or whether or not it contains a covenant not to dispute validity (*d*). The general rule is that where the licensee could set up the licence in answer to an action for infringement he is estopped from disputing validity (*e*). If, however, the licence is a terminable

(*u*) *Mills v. Carson*, 10 R. P. C. 9, 16, C. A.

It is not necessary that an action should be brought in every case if the infringement is effectively kept down. *Dunlop Pneumatic Tyre Coy., Ltd. v. North British Rubber Coy.*, 21 R. P. C. 161, C. A.; *Guyot v. Thomson*, 11 R. P. C. 541, C. A.

There is no such obligation in the case of other licences. *Besseman v. Wright* (1858), 31 L. T. (o. s.) 213.

(*x*) *Rapid Steel Coy. v. Blankstone*, 24 R. P. C. 529.

(*y*) *Clarke v. Adie* (1873), 21 W. R. 456, 762; *Société, &c. des Glaces v. Tilghman's Patent Sand Blast Coy.* (1884), 25 Ch. D. 1.

(*z*) *Mills v. Carson*, 10 R. P. C. 9, C. A.

If, however, there is such a condition, and the patent has been allowed to lapse, royalties paid in ignorance of this may be recovered back. *Lines v. Usher*, 14 R. P. C. 206, C. A.

(*a*) *Lines v. Usher, supra*; *Mills v. Carson, supra*.

(*b*) Such general licence may be

restricted by terms agreed between the parties, *cf. Crossley v. Dixon* (1863), 10 H. L. C. 293, and see p. 248, *et seq.* Where the purchaser is sued for breach of such limited licence there is no estoppel. *Gillette Safety Razor Coy. v. Gamage*, 26 R. P. C. 245.

(*c*) *Crossley v. Dixon, supra*. The position of the licencor and licensee is similar to that of lessor and lessee. *Clarke v. Adie* (1877), 2 A. C. 423, 435.

The fact that a licensee cannot dispute validity is now so well established that it is unnecessary to refer to the earlier decisions, some of which are collected in W. P. C. at page 291, and which frequently contradicted each other. The fact that the patent has been held to be invalid in an action does not affect the estoppel. *Grover v. Millard* (1862), 8 Jur. (N. S.) 713.

(*d*) *Crossley v. Dixon, supra*; *Norton v. Brooks* (1861), 7 H. & N. 499; *Grover v. Millard* (1862), Jur. (N. S.) 713; *Mills v. Carson*, 10 R. P. C. 9, C. A.

(*e*) *Crossley v. Dixon, supra*.

one and the licensee in fact determines it, and an action is brought for infringement by acts committed after such determination, whether or not such action is in reference to articles procured under the licence, he can then dispute validity (*f*). This estoppel may, of course, be removed or modified by recitals, expressed to be by the licensor alone (*g*), or by covenants in the licence. It is doubtful whether it is affected by the fact that the patentee knew the patent to be bad when the licence was granted (*h*). The estoppel prevents any attack on the patentee's title to the monopoly purported to be granted by the Letters Patent at the time the licence was granted (*i*), but it does not prevent the licensee from alleging that the monopoly has since determined (*k*), *e.g.* from non-payment of fees or revocation of the patent, or that what he is in fact doing is not within the limits of such monopoly (*l*).

On this last ground continual attempts are made to refer to prior specifications and other publications nominally in order to show the limits of the monopoly granted by the patent, but really to show that if the patent covers the act complained of it is invalid on the ground of anticipation (*m*). Such efforts have been almost uniformly unsuccessful (*n*). The true rule is that evidence may be introduced to show what knowledge a workman skilled in the art had at the date of the grant, which knowledge both the person writing the specification and the person reading it would be presumed to have, in order to

Evidence to
limit scope of
patent.

(*f*) *Crossley v. Dixon*, *supra*; *Redges v. Mulliner*, 10 R. P. C. 21 26; *Dangerfield v. Jones* (1865), 13 L. T. 142; *Goucher v. Clayton* (1865), 13 L. T. 115.

(*g*) In *Haynes v. Malby* (1789), Davies 156, it was suggested that recitals as to validity only bound the licensor. This was questioned in *Bowman v. Taylor* (1834), 4 L. J. (K. B.) 58.

(*h*) In *Smith v. Scott* (1859), 28 L. J. (C. P.) 325, it was held that this did not affect the estoppel, but see *contra Lawes v. Purser* (1857), 26 L. J. (Q. B.) 25, 27. See also *Macdougall v. Partington*, 7 R. P. C. 216.

(*i*) *E.g.* pleas of no novelty, no utility, or insufficiency. See *per* BYLES, J., in *Trotman v. Wood* (1864), 16 C. B. (N. S.) 479.

(*k*) *Muirhead v. Commercial Cable Coy.*, 12 R. P. C. 39, C. A.

Where, however, the licence is for a fixed term royalties may still be payable in spite of such revocation. *African Gold Recovery Coy. v. Sheba Gold Mining Coy.*, 14 R. P. C. 660; *Mills v. Carson*, 10 R. P. C. 9, C. A.

But see provisions of s. 38 of Patents and Designs Act, 1907.

(*l*) *Davies v. Curtis and Harvey*, 20 R. P. C. 561, C. A.; *Clark v. Adie* (1877), 2 A. C. 423; *Young v. Hermand Oil Coy.*, 9 R. P. C. 381, H. L.

(*m*) A plea to this effect in an action for royalties was held bad in *Ashworth v. Law*, 7 R. P. C. 247.

(*n*) *Clarke v. Adie* (1877), 2 A. C. 423; *Jandus Arc Lamp Coy., Ltd. v. Johnson*, 17 R. P. C. 361; *Roberts v. Graydon*, 21 R. P. C. 194; and see *n. (q)*, *infra*.

enable the Court to construe the document properly (o), and where the specification is really capable of two meanings, one of which would include something which was previously well known, the Court will presume, as any properly skilled person reading the specification would presume, that it had the meaning which did not include such old matters (p). It is, therefore, necessary that the matter relied on should be matter of general common knowledge, and it seems extremely doubtful whether the proper way of giving evidence of this is by reference to specifications (q).

This estoppel can only be removed by the clearest words, thus a provision that the royalties are to cease if a patent is held void for want of novelty does not enable a licensee to raise the question of want of novelty as a defence to an action for royalties (r).

Royalties
cannot be re-
covered back.

It follows, of course, that money paid for royalties under a licence cannot be recovered back on the ground that the patent

(o) *Clarke v. Adie, ubi supra*; *Davies v. Curtis and Harvey*, 20 R. P. C. 581, C. A.; *Cheetham v. Nuttall*, 10 R. P. C. 321, 331.

(p) *Trotman v. Wood*, 16 C. B. (N. S.) 479; *Ashworth v. Law*, 7 R. P. C. 247.

(q) See *Clarke v. Adie* (1877) 2 A. C. 423, 431, 437, H. L.; *British Ore Concentration Coy., Ltd. v. Minerals Separation Coy.*, 26 R. P. C. 124, 138, C. A.

The decision of BUCKLEY, J., in *Sutcliffe v. Abbott*, 20 R. P. C., at p. 55, apparently only means that where a specification is referred to in the Particulars of Objections questions can be founded on it, to show that it, or matters contained in it, are matters of common knowledge. Cf. *British and American Shoe Machinery Coy., Ltd. v. Union Boot and Shoe Machinery, Ltd.*, 11 R. P. C. 367, 373, C. A.

See remarks of FARWELL, J., in *Jandus Arc Lamp Coy., Ltd. v. Johnson*, 17 R. P. C. 361, 370, on this case and point. *Crosthwaite v. Steel*, 6 R. P. C. 109; *Couchman v. Greener*, 1 R. P. C. 197, 199, C. A.; *Ashworth v. Law, supra*; *Hay v. Gonville*, 25 R. P. C. 161, 168; *McDougall v. Partington*, 7 R. P. C. 216.

And cf. cases where validity not attacked, as *British Vacuum Cleaner Coy., Ltd. v. Exton Hotel Coy.*, 25 R. P. C. 617. See also *Mackie v.*

Solvo Laundry Coy., 10 R. P. C. 68, 70.

In *Neil v. Macdonald*, 20 R. P. C. 213, certain specifications were quoted in the defence, but it does not appear that they were admitted.

Of course specifications referred to in the body of the specification may be looked at. See p. 118, n. (y).

So, too, no prior user, not sufficiently general to be part of the common knowledge of the trade, can be relied on in such cases. *Hay v. Gonville, supra*.

(r) *Mills v. Carson*, 10 R. P. C. 9 C. A.

A different rule prevails in the case of an agreement for sale, see *Nadel v. Martin*, 22 R. P. C. 41, H. L., and p. 10, n. (z), this may also apply where there is only an agreement for a licence and not an actual licence. *Henderson v. Shields*, 24 R. P. C. 108; *Bassett v. Graydon*, 14 R. P. C., per Lord HERSCHELL, at p. 709. See also *Wilson v. Union Oil Mills*, 9 R. P. C. 57.

It should be noted that if a patent is declared bad in the Court of first instance, but the judgment is reversed on appeal, even if this is by a (non-collusive) agreement, the licence remains in force. *Cheetham v. Nuttall*, 10 R. P. C. 321; cf. also *Commercial Development Corporation v. Atkins*, 10 R. P. C. 98.

was invalid (s) unless there are terms in the licence which would permit the licensee to raise the question of invalidity.

Again, where a licence is granted before the complete specification is put in, it is not open to the licensee to refuse to pay royalties because the complete specification includes less than the provisional (t). Even if no patent is granted it would seem that money paid cannot be recovered back, since the licensee has been protected from possible actions for infringement since the date of acceptance (u).

Royalties due under a licence carry interest (x). An assignee of half profits can have an account against the licensee provided that it is so taken that the assignor is bound (y). An account will not be ordered if it appears there are no profits (z). The Court are very unwilling to interfere with the finding of the Master as to the proper amount of royalties (a). Where the defendant has not appeared an order for an account may be made on motion (b). The covenant to render accounts is generally only auxiliary to the covenant to pay (c). There have been many cases as to the amount of royalty payable under licences, but they have turned so much on the wording of the particular agreement that no general rule can be deduced. A note of some of these, which may be useful in individual cases, is given below (d).

Miscellaneous
points as to
Royalties.

(s) *Taylor v. Hare* (1805), Davics, 307.

(t) *Otto v. Singer*, 7 R. P. C. 7.

(u) *Otto v. Singer*, *ubi supra*.

It should also be observed that the fact that the patentee has amended by disclaimer does not release the licensee from his obligations. *Haddan v. Smith* (1830), 19 L. J. (o. s.) 154.

Nor, where a licence is granted under several patents for their respective terms at a fixed royalty, is the royalty diminished where some of the patent have expired. *Siemens v. Taylor*, 9 R. P. C. 393.

(x) *Redges v. Mulliner*, 10 R. P. C. 23.

In *Gill v. Stone* (1911), 28 R. P. C. 19, a notice was given that interest at 5 per cent. would be claimed, and interest was allowed from the date when royalties became payable.

(y) *Bergmann v. Macmillan* (1881), 17 Ch. D. 423.

(z) *Bergmann v. Macmillan*, *supra*.

(a) *Alma Veneer Felt Coy., Ltd. v.*

Fisher, 14 R. P. C. 159, 167, C. A., and cases there quoted.

(b) *Pneumatic Tyre Coy., Ltd. v. Ferguson*, 11 R. P. C. 459.

(c) *Bower v. Hodges* (1853), 33 L. J. (o. r.) 194.

But the failure to keep proper books may be a material breach of the conditions and lead to forfeiture of the licence. *Ward v. Livesey*, 5 R. P. C. 102.

(d) *Edmunds v. Normandy* (1864), 12 W. R. 548. What were "profits" for royalty purposes.

Bagot Pneumatic Tyre Coy. v. Clipper Pneumatic Tyre Coy., 19 R. P. C. 69, C. A. What were "profits" for royalty purposes, and whether assignees could be sued.

Hall v. Bainbridge (1843), 5 Q. B. 233. Whether royalties had to be paid on orders taken though patented invention not in fact used.

Tielens v. Hooper (1850), 20 L. J. (ex.) 78. Whether a provision for a minimum payment per annum, with a

Legal
proceedings.

There seems no objection to the patentee suing for royalties or in the alternative for infringement in cases where the existence of a licence may be disputed (e). Where, however, it is found that the defendant is a licensee under a licence which still continues, an injunction will not be granted against using the invention, but only against using it otherwise than as provided by the licence, should the licensee have done this (f). Where the plaintiff denies the licence the defendant may plead alternatively that he is a licensee or if not that the patent is bad (g). Again, an equitable assignee of the licence may defend apart from the licensee, and can then dispute validly (h).

Agreement,
etc. not to use
invention.

Closely allied to this subject are the cases where a party is by agreement or judgment bound not to use a patented invention, or only to use it in a certain way. In such case the only question is whether what he does is within the claim, it does not matter whether such claim is sustainable, and, therefore, the validity of the patent is irrelevant (i).

Restrictive Conditions

Certain
conditions
forbidden.

The Act provides that it shall be unlawful to insert certain conditions in any contract made after the passing of the Act (j) in relation to the sale or lease of or licence to use or work any article or process protected by a patent, and that such conditions shall be null and void as being in restraint of trade and contrary to public policy (k). An exception is made where it

right to patentee to terminate licence if this was not paid, amounted to a covenant to pay such minimum amount.

Few v. M'Lush (1831), 1 S. IX. 732. Whether higher or lower royalty to be paid.

Goucher v. Clayton (1865), 13 L. T. 115. Whether higher or lower royalty to be paid for user after end of licence term, and whether royalty to be paid on renewal of patented parts.

Oxley v. Holden (1860), 30 L. J. (C.P.) 60. Whether royalty for articles covered royalty for fixing them.

Siemens v. Taylor, 9 R. P. C. 393. Whether full royalty continued to be payable when some of the patents had expired.

(e) *Haddan v. Smith*, *ubi supra*; *cf. Postcard Automatic Supply Coy. v. Samuel*, 6 R. P. C. 560.

(f) *Roger v. Cochrane*, 25 R. P. C. 9, O. H.

(g) *Wapshare Tube Coy., Ltd. v. Hyde Imperial Rubber Coy., Ltd.*, 18 R. P. C. 374.

(h) *Pidding v. Franks* (1849), 1 H. & Tw. 220.

(i) See for cases of agreement, *Hills v. Laming* (1854), 23 L. J. (EX.) 60; *MacDowjall v. Partington*, 7 R. P. C. 216, C. A.; *Howard v. Tweedale*, 13 R. P. C. 211; *Roberts v. Graydon*, 21 R. P. C. 194; *Hay v. Gonville*, 25 R. P. C. 161; *Watts v. Everitt Press Coy.*, 27 R. P. C. 718.

And for cases of estoppel by judgment: *Dudgeon v. Thomson* (1879), 3 A. C. 34, H. L.; *Thomson v. Moore*, 6 R. P. C. 426.

(j) 28th August, 1907.

(k) Sect. 38 (1). In interpreting these provisions of the Act it is very necessary to bear in mind the

can be shown that the purchaser or licensee could have obtained the article on fair terms without such conditions, *and* the contract provides that the purchaser or the licensee can free himself from such conditions by giving three months' notice and paying a sum or royalty to be assessed by an arbitrator appointed by the Board of Trade (l). Provision is also made for either party determining a contract made before the passing of the Act containing conditions prohibited by it, on giving three months' notice and paying such sums as may be agreed or settled by an arbitrator appointed by the Board of Trade (m). The insertion by the patentee in a contract made after the passing of the Act of any of the forbidden conditions is available as a defence to an action brought for the infringement of the patent to which the contract relates while the contract is in force (n). The conditions forbidden by the Act are those whose effect is—

- (a) To prohibit or restrict the purchaser, lessee, or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licensor or his nominees ; or
- (b) To require the purchaser, lessee, or licensee to acquire from the seller, lessor, or licensor or his nominees, any article or class of articles not protected by the patent (o).

evils that they were intended to combat, *i.e.* the imposition of onerous terms by owners of patents as a condition of obtaining the patented article or a licence under the patent. The words of the clause are wide enough to cover a great number of ordinary commercial contracts, since any article of a complicated nature is likely to have some parts protected by letters patent, which letters patent are often not owned by either of the parties to the contract. But the Courts would naturally be unwilling to adapt such an inconvenient interpretation, and would probably hold that the words "contract for the sale lease or licence" must be confined to contracts for a licence, and contracts *ejusdem generis*, that is to say, contracts made by some person who has special rights under the letters patent, and of which the main object is, either by sale, lease or licence, to give a right to infringe on such monopoly. A contract, for

example, to take a supply of cycles from a manufacturer would not be brought within this clause by the insertion of a condition that the cycle should have a patented form of tyre, such patent being owned by third parties, with whom neither of the parties had any special relation. But, on the other hand, a contract by the patentee or exclusive licensee for the sale of such tyres would be within this clause.

(l) Sect. 38 (1).

(m) Sect. 38 (3).

(n) Sect. 38 (4). This provision is not limited to cases of actions brought against parties to the contract. As to the pleading in such cases, see O. 53a, r. 10, & p. 169.

The term "patentee" has various meanings, see p. 291. Here it would probably include an equitable owner, and possibly a sole licensee. It would also seem to include predecessors in title of the present owner.

(o) Sect. 38 (1). It would seem

Conditions not within section.

The section does not affect any condition whereby a person is prohibited from selling any goods other than those of a particular person, or whereby the patentee reserves to himself or his nominees the rights to supply any parts needed for the repair of the article. Nor does it validate any contract which would otherwise be invalid, or affect any independent right of determining the contract or conditions (*p*).

Cases under old law.

Under the old law a clause that the licensee should only

that paragraph (*a*) must be construed as referring only to continuing covenants against using an article, which apart from this section would have entitled a licensor to an injunction against the licensee continuing to use such article; or to restrictive conditions a breach of which would have entitled the licensor to bring an action for infringement, and not to merely restrictive clauses as to purchase, a breach of which would only have given a right to damages. Unless this paragraph is so restricted paragraph (*b*) becomes meaningless, and it should be noted that paragraph (*b*) apparently contemplates as lawful a contract by which the purchaser or licensee agrees to take the articles covered by the patent solely from the seller or licensor, and, unless paragraph (*a*) is restricted as above suggested, these contracts would clearly be unlawful.

It should be observed that a clause requiring the purchaser or licensee not to use a non-patented process is not within the words of this section, and is apparently still lawful, as is a clause merely prohibiting sale.

Another difficult question is, to determine what is meant by an article "protected by a patent." If the section is held only to apply to the restricted class of contracts suggested above the difficulty does not arise, but, even if a wider interpretation is given to the section, the words "article protected by a patent" will probably be interpreted so as to be either confined to an article which is itself patented, or, if held to include articles produced by a patented process, will be confined to such articles as cannot practically be produced without the use of such patented process, or which the contract expressly contemplates as being so produced. The wider interpretation that it would include any article in

the production of which a patented process was in fact used, would render this clause so wide as to include nearly every manufactured article sold.

The further question arises as to whether "protected" means validly protected, or whether it simply means covered by the claims of the patent. The first interpretation would give rise to great complications, as the legality of a condition might then depend on whether a patent was valid, which patent might not be owned by either of the parties to the contract, but by a third person. The word "protected" in this relation has received no judicial interpretation, "protection" being generally used in the sense of protection against patent rights being lost or by others claiming them. *Cf. s. 4.*

Covenants which are void as being in restraint of trade are divisible, that is to say, if a portion of the covenant is lawful, that portion will be enforced, even although the covenant includes something which is not lawful. For example, if the above interpretation of paragraphs (*a*) and (*b*) is correct, a covenant to buy different classes of articles from the licensor would be enforceable as to articles covered by the patent, but not as to other articles. See *Mallan v. May* (1845), 12 L. J. (EX.) 376.

Further questions may arise as to articles which at the time of making the contract were within the patent, but afterwards become outside it owing to amendment of the specification. Covenants in restraint of trade, which were reasonable when made, are not affected by a change in the position of the parties which afterward renders them unnecessary for their protection. *Elves v. Crofts*, 10 C. B. 241.

(*p*) Sect. 38 (5).

make machines embodying the patented invention was held not unreasonable or in restraint of trade (q).

Compulsory Licences

The Act provides that any person interested may present a petition for the grant of a compulsory licence, or in the alternative for revocation of the patent, on the ground that the reasonable requirements of the public in respect of the patented invention have not been satisfied. For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied if by reason of default in manufacture, operation, or the grant of licences on reasonable terms, the demand for the article is not reasonably met, or any existing industry in this country, or the establishment of a new industry here, is unfairly prejudiced, or if any industry is unfairly prejudiced by the conditions attached by the patentee to sales or licences (r).

The petition is presented to the Board of Trade who may dismiss it if they are not satisfied that a *prima facie* case has been made out. Otherwise they refer it to the Court (s), who may, if the petitioners establish a case of default, order a licence to be granted on such terms as are just (t), or if of opinion that the reasonable requirements of the public cannot be satisfied by means of licences, order revocation (u). The grounds

(q) *Jones v. Lees* (1856), 1 H. & N. 189.

In the same case it was held that a plea that machines embodying the invention were unsaleable, was bad as only going to reducing the damages. See also *Mouchel v. Cubitt*, 24 R. P. C. 197.

These decisions may be still applicable.

(r) Sect. 24. The definitions in s. 24 (5) are probably not intended to be exhaustive. Little can be said as to this section until it has been judicially interpreted. But see note on s. 38.

Under s. 22 of the 1883 Act three petitions were heard. *Continental Gas Gluecht Petition*, 15 R. P. C. 727; *Levinstein's Petition*, 15 R. P. C. 732; *Gormully and Jeffrey's Petition*, 16 R. P. C. 641.

As to where an industry is so

prejudiced, see remarks of PARKER, J., in *Taylor's Patent*, 29 R. P. C. 296.

(s) Sect. 24 (2). The petition is tried by the special judge and there is no appeal, s. 92 (2).

Any person claiming an interest as an exclusive licensee or otherwise may appear, and also the Law Officer. It would seem that a mere licensee could not appear. But see "Patentee," p. 201. For procedure, see O. 53, rr. 7-9, and P. O. Rules 68-74.

(t) Sect. 24 (3). The order in itself operates as a licence, s. 24 (6). For the terms of such a licence, see *Levinstein's Petition*, *supra*.

(u) Sect. 24 (3). An order for revocation can only be made after three years from the date of a patent, and if the patentee fails to show satisfactory reasons for his default.

which would justify revocation as an alternative to a compulsory licence may be used as grounds for revocation on a petition to the Court, or as a defence to an action for infringement (x).

(x) Sect. 25 (2). See p. 213. For the present Act, see *Badische, &c. v. Thompson*, 21 R. P. C. 473.
a case where a plea was discussed
based on similar grounds before

CHAPTER XV

PATENT OFFICE PRACTICE

Application for Letters Patent

THE application for Letters Patent may be made by the true and first inventor alone or with others (*a*), or in the case of the death of the inventor by his legal representative (*b*). Application.

The application must contain a declaration that the applicant or one of the applicants claims to be the first and true inventor of the invention for which protection is desired (*c*). In the case of a deceased inventor the legal representative must make a declaration that he believes the deceased to have been the first and true inventor (*d*).

The application must also be accompanied by a provisional or complete specification (*e*).

In the case where a provisional specification is lodged the complete must follow within six months from the date of application (*f*). If the applicant chooses he may lodge a Procedure.

(*a*) Sect. 1 (*i*). As to who is the first and true inventor, see Chap. IV.

As it is a fatal objection to the patent that it was not granted to the first and true inventor it is better in a case of doubt to join all parties who have had anything to do with the invention. There are two forms for ordinary applications, "No. 1," where the applicant is the original inventor, "No. 1*a*," where he is a communicatee.

No. corporation, British or foreign, can apply on form No. 1 as the original inventor. A foreign corporation must therefore make a communication to some person who will then apply on form No. 1*a*. *Société Anonyme du Générateur du Temple's Application*, 13 R. P. C. 54.

A British corporation can apply on form 1*a* as communicatee.

As to the effect if any of a communicatee applying as original inventor, see p. 74.

As to applications under the International Convention, see p. 259.

(*b*) Sects. 49 and 93. Where the applicant dies after application, but before grant, the grant is made in the name of the personal representatives if the office have notice of his death.

(*c*) Sect. 1 (3).

(*d*) Sect. 43 (2).

(*e*) Sect. 1 (3).

(*f*) Sect. 5 (1). An extension of one month can be obtained on payment of £2, Patent Form 6.

Where there are joint applicants it is sufficient if one signs the complete specification, *Grenfell and McEvoy's Application*, 7 R. P. C. 151, but if it is brought to the knowledge of the C.-G. that they do not all agree he has no power to decide between them or to accept any specification. *Apostoloff's Application*, 13 R. P. C. 275.

Probably similar rules would apply

series of provisionals, and, provided that these are for cognate inventions, lodge one complete specification for all of them within six months of the date of the first application (*g*). The application and accompanying specification are referred to an examiner to report on. If he reports that the nature of the invention is not fairly described, or that the application, specification, or drawings, have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the Comptroller may refuse to accept the application, or assign to it some date later than that of the application, but not later than the date when these matters were put right (*h*). The applicant is then notified that his application has been accepted, and the period of provisional protection dates from the date given to his application (*i*). When the complete specification is left it is again referred to an examiner who may raise various objections dealt with below (*k*). When all these matters have been put right the complete specification will in general be accepted, and this must take place within twelve months from the date of application except in the case of an appeal from some requirement of the office. If the complete specification is not accepted within this time the application will become void (*l*).

The acceptance of the complete specification is advertised, the specifications are then open to public inspection, and opposition may be lodged within two months (*m*). On acceptance the applicant has all the rights which would be given by the sealing of the patent at the date of acceptance, except that no action can be brought till after the grant is actually made (*n*). If there is no opposition or if, in the case of opposition, the

to any subsequent amendments, etc., up to acceptance. Where the applicant who has made the declaration that he is the first and true inventor desires to abandon the application no grant will be made. *A. & B.'s Application*, 28 R. P. C. 454. As to the possible remedies of the co-applicant, see *Wool, Hide, and Skin Syndicate, Ltd. v. Riches*, 19 R. P. C. 127.

(*g*) Sect. 16, as to extension of time, see note (*f*). As to what are cognate inventions, see p. 262.

(*h*) Sect. 3.

(*i*) Sect. 3 (4). Sect. 4.

(*k*) Sect. 6.

(*l*) Sect. 6. An extension of one,

two, or three months can be obtained on payment of £2, £4, or £6, Patent Form 7.

(*m*) Sects. 9 and 11. The publication dates from the advertisement and not from the date when printed copies can be seen, which is slightly later. *Parson and Stoney's Application*, 27 R. P. C. 491; *Fox v. Astrachans, Ltd.*, 27 R. P. C. 387.

(*n*) Sect. 10. *E.g.* infringement after this date gives a cause of action. Articles made according to the specification may be marked "Patent," *R. v. Townsend*, 13 R. P. C. 265. Such rights do not exist after the expiration of time for sealing.

determination is in favour of the grant of the patent, the patent will be sealed on payment of the sealing fee (o). Generally speaking this should be done within fifteen months of the application (p).

The following objections may be raised by the Office :—

(a) That the application for a patent is not for any manner of new manufacture (q).

(b) That the use of the invention would be contrary to law or morality (r).

(c) That the application is for more than one invention (s).

Office objections and requirements.

(o) Sect. 12. This direction to seal is mandatory. In the absence of opposition the office cannot refuse a patent, or insist on amendment, once the complete is accepted though they may insert a statutory reference under sect. 8.

(p) Sect. 12 (2). The following are the grounds for extension of this time :—

Where there has been any extension of the time for leaving or accepting the complete the time for sealing is automatically extended for four months.

When the applicant has died within the period of sealing, his legal representatives may have the patent sealed at any time up to twelve months from the date of his death.

Where the sealing is delayed by opposition or appeal to the L. O. the patent may be sealed at such time as the L. O. may direct.

Where a collusive opposition has been lodged for the purpose of obtaining delay the L. O. will not direct sealing. *A. & B.'s Application*, 19 R. P. C. 403, 551. So, too, where the C.-G. required amendment and there was a delay of a year and ten months in complying with his requirements. *A. & B.'s Application*, 13 R. P. C. 63.

In other cases the Comptroller may extend the time for 1, 2, or 3 months on payment of a fee of £2, £4, or £6, Patents Form 11.

(q) This objection is generally raised on receipt of the application. As to what may be the subject of a patent, see SUBJECT-MATTER, p. 17, *et seq.*

The rule has been formulated that a patent can only be granted when "a material product of a substantial character is realised or effected." *Cooper's Application*, 19 R. P. C. 53. It cannot be granted for anything

in the nature of literary copyright, *ibid.* But a newspaper printed so as to leave a blank space down the middle to permit of easier folding might form the subject of an application, *ibid.*, but not an envelope printed with a particular arrangement of words intended to facilitate a special method of carrying on business. *Johnson's Application*, 19 R. P. C. 57. Again a method of indexing finger prints has been held not to be a manufacture. *Ward's Application*, 20 R. P. C. 79.

(r) Sect. 75. See *Pessers v. Haydon*, 26 R. P. C. 58.

(s) Sect. 12 (2). There are not many decisions on this point, but generally speaking an applicant will be entitled to include in one patent alternatives having the same object, and seeking the same advantage, *Jones's Application*, Griff. 265. Again, where there is a true combination claim the applicant can protect subordinate combinations for use in a similar way. *Jones's Application*, *ubi supra*, *Robinson's Application*, Griff. 267, but he may not be able to claim such subordinate combination for all purposes, *ibid.*, and *Hearson's Application*, Griff. 266. In the case of a new machine the applicant may claim all the parts separately, but where the machine is an old one claims for a number of different improvements in parts which do not directly co-act may constitute different inventions.

Robinson's Application, *supra*. *Z.'s Application*, 27 R. P. C. 285. If this objection is upheld the application must be divided and separate fees paid on each part, and each part will be treated subsequently as a separate application. The objection may be taken on application, or at any time up to acceptance. It applies to Convention Cases.

- (d) That the title does not properly describe the invention (t).
- (e) That the specification, provisional or complete, has not been prepared in the prescribed manner (u).
- (f) That drawings or further drawings are necessary to the specification, provisional or complete (x).
- (g) In the case of a chemical patent that samples or further samples should be lodged with the application (y).
- (h) That the invention particularly described in the complete specification is not substantially the same as that which is described in the provisional specification (z).

(t) Sect. 3 (2). This objection should be taken before the acceptance of the application. The Courts are now averse to holding a patent invalid because of a discrepancy between the title and the specification, but of course different considerations apply before the grant. For cases, see *Robinson's Application*, Griff. 267. *Brown's Application*, Griff. L.O.C. 1.

(u) Sect. 3 (2), s. 6 (2). This does not, however, authorise the Comptroller to interfere with the drafting otherwise than is provided by the Act or rules, see *Smith's Application*, Griff. 268.

Such objections, as that the invention is not fairly described, are separately mentioned in s. 3 (2). The requirements as to drawings are contained in rr. 19-26, and as to other documents in r. 6. The Act provides that all specifications must commence with a title, and that a complete specification must end with a claim, s. 2 (4), and the rules provide that such claim must be clear and succinct and separate from the body of the specification, r. 14. These requirements apply to the claims as a whole as well as to each individual claim, and although the mere fact of there being a large number of claims is not necessarily an infringement of this rule, it may be so if there is unnecessary repetition. *Bancroft's Application*, 23 R. P. C. 89. If the specification is prepared in the prescribed manner the office has no power to interfere with it or the claims, except under objections e, g, or h, or the provisions of s. 7 or s. 8.

(x) Sect. 2 (3). This objection may

be taken any time before acceptance. The drawings form part of the specification, but need not limit the scope of the claims as these may be quite general and not refer to them.

(y) Sect. 2 (5). This requirement may be made at any time up to the acceptance of the complete specification. The office may ask for such samples as may be necessary to test if the reactions really extend to all the bodies covered by the claims, and their discretion on this point will not be lightly interfered with. *J. Y. J.'s Application*, 28 R. P. C. 625. As to how the samples are to be supplied, see r. 36. A notice of samples having been furnished in connection with any application will be published in the journal, *ibid*.

It should be noted that the samples, unlike the drawings, form no part of the specification, which should therefore not refer to them. They in no way affect the construction of the specification or the scope of the patent, and it will be no defence to an action for infringement that the alleged infringement differs from the samples, if it comes within the claims.

(z) Sect. 6 (3). The criterion is the same as that for DISCONFORMITY, see Chapter VII.

If this objection is sustained the C.G. may (1) require the applicant to excise the disconforming part (2) may, with the consent of the applicant, cancel the provisional and treat the complete specification as a fresh application for a patent bearing the date on which it was left, or (3) allow the application to proceed for the original invention, and treat the claim

- (i) That the nature of the invention is not fairly described (a).
 (j) That the invention as described has been wholly or in part described or claimed in a specification, other than a provisional specification not followed by a complete specification, for British Letters Patent published before such application and bearing a date within fifty years of the date of the application (b).

Compliance with the requirements of the Act and Rules is a condition precedent to the grant of the patent, although in some cases the Comptroller may have a discretionary power to waive these requirements (c). An appeal lies against a refusal to accept an application or specification, and so indirectly against any office requirement (d).

The Act provides that after the complete specification is left search shall be made through all British specifications published before the date of such application and bearing date within fifty years of the same (e). If the examiner reports that the invention is wholly or in part described or claimed in any such prior specification the applicant is informed of this and given an opportunity of amending (f). If, however,

Statutory searches and references.

for the disconforming part as a fresh application of the date on which the complete specification was left.

(a) Sect. 3 (2). According to the Act this objection can only be taken with regard to the specification left with the application, but *cf. s. 6 (2)*, and *C.'s Application*, 7 R. P. C. 250. The objection does not extend to the description of how the invention is to be carried out.

(b) See *nn. (e) to (h), infra*.

(c) *Application under Section 103*, 23 R. P. C. 788.

(d) See *J. Y. J.'s Application*, 28 R. P. C. 625.

(e) Sect. 7. For the purposes of this section a specification is considered to be published at the date when it is open for public inspection. *Parson's and Stoney's Application*, 27 R. P. C. 491.

With regard to application under the International Convention it was decided, under the corresponding section of the Act of 1902, that this meant publication before the date of application in this country, and not before the date to which the patent when granted would be antedated. *Deutsche Gold, &c.'s, Application*, 24

R. P. C. 209; *cf. also Johnson's Application*, 24 R. P. C. 694.

This earlier Act did not give the C. G. any power to reject, and this interpretation of s. 7 of the present Act would seem to lead to strange results. Thus if an application were made abroad on the 1st January, 1911, and here under the International Convention on the 1st January, 1912, the C. G. would be entitled under s. 7 (4) to reject it if a similar patent had been applied for here say 1st March, 1911, and the complete specification published before the end of the year, although such a rejection would be in direct contradiction of the provisions of s. 91. The probable solution is that the powers given by s. 7 (4) being optional, see *P.'s Application, infra*, would not be exercised in such a case, nor does it appear that a reference could be necessary in the interests of the public to a specification which by reason of its date could have no effect on the scope or validity of the patent when granted.

(f) If the examiner reports that the description of the invention is not sufficient to enable him to make

the amendment is, in the Comptroller's opinion, unsatisfactory, he may decide whether any, and if so what, statutory reference to the prior specification should be inserted (*g*), and, if he is of opinion that the whole invention has been wholly and specifically claimed in any such prior specification, he may refuse the patent, but need not necessarily do so (*h*).

Further
search.

A further investigation is made among specifications which have been published after the date of the application and are such that the patent granted on them will bear an earlier date than that sought on the application in question. In this case, however, all that is considered is whether the invention has been claimed in the prior specification, and in no case can the patent be refused or an amendment compelled, the only power of the office being to insert a statutory reference (*i*). The reasons for these distinctions are clear, since the only way in which the matter covered by the further search could be raised against the patent if granted would be by pleading a prior grant, and this could only be done if (1) such matter formed

a search, the C. G. may require amendment and if necessary post-date the application in order to allow of the requirements as to search being properly carried out, r. 28. The rules direct the examiner, if he is of opinion that he has found specifications in which the invention has been wholly claimed or described, to make a provisional report, and if this is not reversed or altered the search does not proceed further, but the patent is refused or a statutory reference inserted as the case may be. If, however, such provisional report is reversed or altered a further search and report is made, r. 29. The applicant is given two months, after being informed of the result of a report, in which to amend his specification.

(*g*) The applicant has a right to a hearing, and receives ten days' notice of this, and after such hearing, or if the applicant does not desire to be heard, without a hearing, the C. G. decides whether reference to any, and if so to what, specifications should be made, rr. 30, 31. For form of statutory reference see r. 32.

A statutory reference may be made even if the specification in question is referred to in the body of the specification by way of disclaimer or

otherwise. *P.'s Application*, 23 R. P. C. 645.

(*h*) *P.'s Application, supra.*

(*i*) Sect. 8. This section avoids the difficulty as to Convention applications referred to in the note on s. 7, but difficulties may arise in the case where one patent is granted on several provisionals. For example, if A. puts in provisionals on the 1st January and the 1st March, and B. lodges an application on the 1st February for the same invention as is contained in A.'s provisional of the 1st March, a reference to A.'s specification might be ordered in B.'s, though the latter was really the first to apply for a patent for the invention in question. It must, however, be remembered that once B.'s patent was granted, A.'s could only be pleaded as a prior grant, and would therefore not affect B.'s patent unless valid, and for the purpose of determining the validity of A.'s patent the true date of his application for the second invention must be considered. It would, therefore, probably be held that a reference to A.'s specification would not be necessary in the interests of the public, as A.'s patent would not affect the scope or validity of B.'s.

the subject of a claim in the prior application ; (2) a patent had been granted on the application ; and (3) such prior patent was valid (*k*).

The statutory references under the section can be required after the acceptance of the complete specification, and even after the patent has been granted. The applicant must in all cases be given an opportunity of amending his specification (*l*).

The date of a patent is in general the date when the application was lodged (*m*), but the Comptroller has power in certain cases to postdate it (*n*). Where there are several provisional specifications and a single complete specification is lodged for all the applications, the patent bears the date of the earliest of the provisionals, but for the purposes of opposition and of determining the validity of the patent the novelty of each claim must be considered with regard to the date when the corresponding provisional was put in (*o*).

The Act provides that where his Majesty has entered into arrangements with the Government of any foreign State for the mutual protection of inventions, any person who has applied for protection for any invention in that state shall be entitled to a patent for his invention in priority to other applicants, and such patent shall have the same date as the date of application in the foreign state, provided that the application here is made within twelve months of the foreign application (*p*), and such patent shall not be invalidated by reason only of the publication of a description or of the use of the invention in the United Kingdom during this period (*q*). These provisions are brought into force by an Order in Council declaring them to be applicable

(*k*) See p. 75.

(*l*) Sect. 8 (2).

(*m*) Sect. 13. A patent lodged after office hours is dated as of the next day, *Matthew and Strange's Application*, 27 R. P. C. 288. All patents lodged the same day are considered as of the same date. *Cf. Dering's Application* (1880), 13 Ch. D. 393.

See also r. 12, but the office do not claim to be able to fix the order in which applications were put in.

(*n*) *I.e.* where application, etc., are not in order, s. 3 (2). Where there is not time to complete searches, r. 28, and also under the International Convention, *infra*.

In the case of disconformity the

patent may be post-dated to the date of lodging of the complete s. 6 (3) (*b*), and in any case this date has to be considered on the question of the novelty of the new matter, s. 42.

(*o*) Sect. 16, see p. 262.

(*p*) Sect. 91 (1).

(*q*) Sect. 91 (2).

It seems doubtful whether such patent would be good if some other person had applied for and actually obtained a patent in the interval. See *Main's Application*, 7 R. P. C. 13. See also *Deutsche Gold, &c., Application*, 24 R. P. C. 209, and p. 66, *n. (b)*.

to a particular state and continue in force so long as such Order in Council does (*r*). There is also power to apply these provisions by an Order in Council to any British possession with such variations or additions as may be stated in the Order (*s*).

The application for such patent must, according to the rules, be made by the person or persons by whom the first foreign application was made, or, in the case of any of such persons being dead, the application must be signed by the legal representative of such dead person, together with the other applicants, if any (*t*), and must be made within twelve months from the date of the first foreign application (*u*). The benefit of priority must be claimed in the application (*x*). It must be

(*r*) Sect. 91 (4).

The provisions are retrospective with regard to applications made in a foreign State before the date of the Order in Council. *Main's Application, supra.*

(*s*) S. 91 (5).

(*t*) R. 15, see *n. (u), infra.*

A communicatee from such first applicant cannot make such an application. A foreign corporation can apply, *Shallenberger's Application*, 6 R. P. C. 550; *Carey's Application*, 6 R. P. C. 552. Form 1c is to be used.

(*u*) R. 15. The rules confine the benefit of these provisions to cases where the application is made within twelve months of the first foreign application, and by persons making such first foreign application, but these rules would seem to be a direct contradiction of the provisions of the Act. The Act provides that where arrangements have been made with *any* state and notified by Order in Council any person applying in *such* state shall have twelve months from the date of such application in which to make his application in this country. These provisions are fixed by the Statute, and except in the case of British possessions, cannot be modified even by an Order in Council. The Order in Council has only the effect of bringing into force the provisions laid down by the Statute. The difference may be illustrated by considering the case of a person who has applied for a patent in Germany on, say, the 1st March, 1911, having previously

applied for a United States patent on the 1st January, 1911. The Act, coupled with the effect of the Order in Council notifying that arrangements have been made with Germany, give him to the 1st March, 1912, in which to apply for a patent, but the rules restrict the time to the 1st January, 1912. As the only power of the Board of Trade to make rules on this subject is given by s. 86, and the power there given is to make rules subject to the provisions of the Act, it would appear that the rule as to the application having to be made within twelve months of the first foreign application is *ultra vires*. The provision of s. 86 (2) to the effect that generally rules whilst in force are of the same effect as if they were contained in the Act would, it is submitted, not affect this result, as this only applies to rules made subject to the provisions of the Act. The rules discussed by the House of Lords in *Chartered Institute of Patent Agents v. Lockwood*, 11 R. P. C. 374, H. L., were not contrary to the provisions of the Act, and the *dicta* of the Lords in such case were probably only intended to apply to rules which were not so contrary. Where the first application has become abortive the period runs from the first effective application, *Van de Poole's Application*, 7 R. P. C. 69. No later date than that of the first foreign application can be given, *Scott's Application*, 27 R. P. C. 298.

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

accompanied by a declaration that a foreign application has been made in one of the countries to which these provisions apply, and such declaration shall specify all the foreign States or British possessions in which application has been made, together with the official date or dates of such applications (*y*). It must further be accompanied by a complete specification (*z*), and also by a copy of the specifications, drawings, or documents filed or deposited with the first foreign application; and these must be certified by the chief of the Patent Office of such foreign State or British possession or otherwise verified to the satisfaction of the Comptroller. These latter documents may, however, be left not later than three months after the application by permission of the Comptroller. Where any of the documents are in a foreign language a translation verified by statutory declaration or otherwise shall accompany (*a*). The ordinary rules as to time and manner of proceedings apply to a Convention application with the single exception that if the complete specification be not accepted within twelve months of the date of the first foreign application it shall be open to public inspection at the expiration of such twelve months (*b*).

Where owing to delay or mistake of the applicant the provisions of the rules as to time, etc., cannot be complied with, the Comptroller has power to refuse to give priority (*c*), and any person interested may appeal against his giving this priority to another person's patent (*d*). The foreign applicant is only entitled to have protected here that which is protected abroad (*e*).

The States which have joined the Convention are as follows :—

Austria, Belgium, Brazil, Cuba, Denmark, Dominica,

R. P. C. 213, and 20 R. P. C. 161, C. A., but an application may be amended so as to claim this priority within the twelve months, subject to r. 16 (see *n. (a), infra*).

(*y*) R. 15.

(*z*) Sect. 91 (3).

(*a*) R. 16, the extension may be for 1, 2, or 3 months, on payment of a fee of £2, £4, or £6.

(*b*) Sect. 91 (3), and rr. 17, 18.

(*c*) *Application under s. 103*, 23 R. P. C. 788.

(*d*) *Main's Application*, 7 R. P. C. 13.

(*e*) 1910*b*. The English rules of

interpretation will be applied to the foreign specification to ascertain what is the protection obtained abroad in the absence of evidence that other rules prevail there, *ibid.* A later decision, however, 1912 *A*, has fixed as the criterion not what protection has been obtained abroad, but what protection has been applied for.

But this gives the applicant no right to amend merely on the ground that his protection abroad is different, at any rate after the patent has been granted. *Vidal's Patent*, 15 R. P. C. 721.

France (with Algeria and Colonies), Germany, Great Britain (with Australia, Ceylon, New Zealand, Trinidad, and Tobago), Holland (with the Dutch Indies, Curaçao, and Surinam), Hungary (with Bosnia and Herzegovina), Italy, Japan, Mexico, Norway, Portugal (with the Azores and Madeira), Servia, Spain, Sweden, Switzerland, Tunis, and the United States.

Cognate inventions.

The Act provides that an applicant may put in two or more provisional specifications for inventions which are cognate or modifications of each other, and may then lodge one complete specification on the whole of these if the Comptroller is of opinion that the inventions may properly be included in one patent. The patent bears the date of the earliest of the applications, but in considering the validity of the patent or in proceedings on opposition regard should be had to the date of the provisional specifications relating to the several matters claimed (*f*).

Patents of addition.

Where a patent for an invention has been applied for or granted, the applicant or the patentee, as the case may be, in applying (*ff*) for a further patent in respect of any improvement in, or modification of, the invention may request in the application that the term of the new patent shall be limited to the term of the original patent. Such patent is termed a patent of addition. This patent of addition remains in force so long as the patent for the original invention remains in force, but no longer, and no renewal fees have to be paid on it. The objection cannot be raised to a patent of addition, once it has been granted, that it should have been the subject of an independent patent (*g*).

(*f*) Sect. 16. There is no definition of what is meant by cognate inventions, the question is one for the Comptroller in each case. It is believed that the rule generally followed by the office is to consider applications cognate in cases where, had the inventions forming the subject of the several applications been included in one application, such application would not have offended against the rule of being for more than one invention. See p. 255, note (*s*).

There is no provision made in the Act or the rules for the ear-marking of claims so as to show to which application they relate, and when any such patent has to be fought in the Courts considerable difficulty may arise from this circumstance, since the novelty of each claim has to be con-

sidered in respect to the date of the application on which it is founded. Further it may be that it will be open to the patentee to contend that the second application was a mere excess of caution, and that what is contained therein is merely a fair development of what was in the first application, and that therefore the validity of such further invention must be tested as at the date of the first application. Similar questions might, of course, arise in opposition cases. It would seem doubtful whether there is any appeal against a refusal to allow one complete specification to be lodged. Cf. Appeal, pp. 283 *et seq.*

(*ff*) Or by amendment prior to date of acceptance.

(*g*) Sect. 19. There is no attempt to define "improvement in or

Except for the fact that a patent of addition automatically expires with the original patent it would seem to be in all other respects similar to ordinary letters patent. It should therefore fulfil the requirements as to novelty and subject-matter as against all prior publications, including the original patent to which it is a patent of addition (*h*).

In the case of a patent for any improvement in instruments or munitions of war, the inventor may assign it to the Secretary of State for War, for the Admiralty, who may direct the specifications and drawings to be kept secret, and on the expiration of the patent to be delivered to the Government. No proceeding for revocation shall be brought in respect of any such patent, and no communication to any such Secretary of State or to any person authorised by him to investigate the matter, or anything done in such investigation, shall be deemed use or publication so as to affect the validity of *any* patent for the same (*i*).

Secret
patents.

Opposition.

The Act provides that any person (*k*) may within two months of the advertisement of the acceptance of the complete

Locus.

modification of." The term "improvement" in or on an invention has given rise to several cases on the meaning of agreements containing this phrase. See p. 9, note (*l*). It is clear that the criterion suggested in certain of these cases, *e.g. Davies v. Curtis and Harvey, Ltd.*, 20 R. P. C. at p. 572, C. A., that an improvement in or on an invention must be something which would be covered by the original claim cannot apply in the case of patents of addition, since in that case there could be no object in obtaining a patent of addition since this expires at the same time as the original patent. The only reported decision would seem to suggest that much the same criterion is applied as in the case of "cognate" inventions, 1910 *J*. These provisions therefore allow a procedure similar in effect to that of s. 16 to be applied to cases where the second application is made after the complete specification has been lodged on the first. The Act provides (s. 19 (3)) that a patent of addition shall remain in force so long as, but no longer than, the original patent. The words "in force" clearly refer to the duration and

not to the validity of the patents, otherwise in an action on the patent of addition the issue would be as to the validity, etc., of the original patent and not that of the patent of addition. An order revoking the original patent would, however, automatically terminate the patent of addition.

But of course the invalidation of a claim in a patent of addition will not bring down with it the original patent; this is a consideration which should lead to application for a patent of addition rather than the claiming of cognate inventions in one final specification, in any case where a valuable claim exists which ought not to be jeopardised by having a claim of possibly doubtful value put into company with it in the same specification.

(*h*) See *Rochford v. Dublin Theatre Coy.*, 29 R. P. C. 195, Ir.

A patent of addition can have a further patent of addition based on it, *McFeeleys Application*, 29 R. P. C. 356, L. O.

(*i*) See s. 30 where the subject is dealt with at length.

(*k*) See p. 264, *n.* (*m*).

specification give notice of opposition to the grant of the patent on certain specific grounds (*l*).

Locus.

Although the Act provides that persons may oppose the grant of a patent, it has been frequently decided under the 1883 Act on similar wording that the class of persons who may oppose is limited (*m*). The Act itself limits the persons who may oppose on the first or fourth of the grounds set out below (*n*). With regard to the second ground the persons who may oppose fall into two classes—firstly, those who have some interest in at least one of the patents on which the opposition is founded (*o*), and secondly those who have a manufacturing interest, *i.e.* are actually manufacturing according to the claims of the opposed application or of one of the earlier patents (*p*). A locus on the first, or probably the fourth ground, does not give a right to oppose on the second ground (*q*). Any person having

(*l*) Sect. 11. These grounds are dealt with separately. A patent will not be stopped merely because some general principle of Patent Law has been infringed if the objection cannot be brought within these grounds. *Newman's Application*, 5 R. P. C. 278; *Nahnsen's Application*, 17 R. P. C. 203.

Semble, an action may lie for malicious opposition, but special damage must be proved. The loss of the patent may be sufficient damage, *Haddan v. Lott* (1854), 15 C. B. 411.

(*m*) *R. v. Comptroller General, Ex parte Tomlinson*, 16 R. P. C. 233; *J. & J.'s Application*, 19 R. P. C. 555.

(*n*) *I.e.* to persons from whom the invention has been obtained or their successors in interest. This means legal representatives and does not include assignees of the invention. *Edmund's Application* (1886), Griff. 282; *Gascoine's Application*, 27 R. P. C. 78. *Spiel's Application*, 5 R. P. C. 281, though *semble* assignees might oppose on the fourth ground, *Gascoine's Application, supra*, but *cf.* *Bowden's Patent Syndicate, Ltd. v. Smith*, 21 R. P. C. 438, and 1910 *E*.

In *Heald's Application*, 8 R. P. C. 429, an employer opposed on the ground that the invention was communicated by a servant of his, who was the inventor, to the applicant, who was also a servant. Here, how-

ever, the alleged inventor also opposed.

(*o*) *Heath and Frost's Application* (1886), Griff. 290; *Gascoine's Application*, 27 R. P. C. 78.

An assignee of a patent or a licensee under it may oppose. *Hill's Application*, 5 R. P. C. 599. A person interested in one patent may oppose on others. *Stewart's Application*, 13 R. P. C. 627.

Presumably if the opposition on the patent in which he is interested wholly fails he would have no locus, but there is no case on this point. *Cf.* however, *Max Muller's Patent*, 24 R. P. C. 465, and other cases at p. 214, *n.* (*l*).

(*p*) *Meyer's Application*, 16 R. P. C. 526, 1911 *B*.

These decisions must be held to overrule, *Macevoy's Application*, 5 R. P. C. 285.

An assignee of the business giving the manufacturing interest may oppose. *Gascoine's Application*, 27 R. P. C. 78. Mere intention to manufacture is not sufficient. *Bairstow's Patent*, 5 R. P. C. 286; see also 1911 *B*.

The mere right to take out a patent here, *e.g.* an application in a Convention country, is not sufficient. *Meurs-Gerkin's Application*, 27 R. P. C. 565. See also *Nahnsen's Application*, 17 R. P. C. 203.

(*q*) *J. & J.'s Application*, 19 R. P. C. 555.

a practical and personal interest may oppose on the third ground, but not the man in the street (*r*).

The first ground of opposition is that the invention has been obtained from the opponent or from some person of whom he is the legal representative (*s*). Where the only dispute is as to which of two persons working together made the invention the issue is the same as whether in fact the opponent or the person he represents was the first and true inventor (*t*). It is not, however, generally sufficient for the opponent to show that he was the true and first inventor, he must in addition show that the applicant obtained the invention from him. Though this does not necessarily imply fraud (*u*), it means that the applicant, or an agent, must be fixed with the knowledge that the invention came from the opponent (*x*). On the other hand if the invention was obtained from the opponent it does not matter that there is some third person who was the true inventor, or that the opponent would not have been entitled to patent the invention (*y*). It only applies to cases where the invention has been obtained in this country, as if the applicant has obtained the invention abroad and brought it here he is in the eyes of the law the true and first inventor (*z*).

(*r*) See 1912 *B. & C.* Thus a later applicant for a patent may oppose. It is sufficient if the interest exists at the date of the hearing, *ibid.*, see also, 1911 *B.*

(*s*) See p. 264, *n.* (*n*).

(*t*) See Chapter IV.

A master cannot successfully oppose on the ground that the invention was made in his time and in consultation with his other servants, unless he can show that these in fact made it. *Herald's Application*, 8 R. P. C. 429.

Where a workman is employed to make a model for the purpose of carrying out an invention, and makes suggestions as to improvements in detail, these suggestions become the property of the master. *David and Woodley's Application* (1884), Griff. L. O. C. 26.

(*u*) 1910 *A.*

(*x*) 1910 *A.* *Edmund's Application* (1886), Griff, 282.

Where the opponent had assented to the application being made the patent was granted, there being no agreement as to opponent's rights. *Marshall's Application*, 5 R. P. C.

661, but *cf.* *Preston's and Ralston's Patent*, 26 R. P. C. 313.

(*y*) *Thwaite's Application*, 9 R. P. C. 515.

The fact that the opponent has supplied a machine to applicant does not prevent his opposing. *Ashton and Knowle's Application*, 27 R. P. C. 181.

(*z*) *Edmund's Application* (1886), Griff. 281; *Spiel's Application*, 5 R. P. C. 281; *Lake's Application*, 5 R. P. C. 415; *Higgin's Application*, 9 R. P. C. 74; *McNeil's Application*, 24 R. P. C. 680.

This applies in the case of convention applications, 1912 *A.* *Meurs-Gerkin's Application*, 27 R. P. C. 565.

This would apply even if the applicant was the party guilty of the fraud. *Higgin's Application, supra*; *McNeil's Application, supra*.

The tribunal will not investigate the question of the rights of the parties as fixed by agreements. *Spiel's Application, supra*; *McNeil's Application, supra*. See also TRUE AND FIRST INVENTOR, Chapter IV.

In the case of *Fiechter's Application* referred to in *Edmund's Application, supra*, the rule seems to have been

Where the invention patented is not identical with what was communicated it is permissible to appeal to prior knowledge to show that what was communicated was old (*a*). Where, however, something that was new has been communicated the tribunal will not be astute to find that there was no invention in this (*b*). The applicant in such case may be either directed to disclaim what he obtained from the opponent (*c*), or the patent may only be issued to the applicant and opponent jointly (*d*). The onus is, of course, on the opponent, who begins in oppositions on this ground (*e*). To discharge this onus it is not enough for him to show that there is a balance of evidence in his favour. He has to make so strong a case as to make the Comptroller or Law Officer of opinion that if a jury decided against him the verdict would be set aside as perverse (*f*).

Second
ground.

The second ground is that the invention has been claimed in any complete specification for a British patent which is or will be of prior date to the patent opposed (*g*), provided that the date of the application for such opposing patent was not more than fifty years prior to that of the patent opposed (*h*). The issue here is whether the inventions which have been claimed are the same. The fact of the later invention having been described in the earlier specification but not claimed is not

held not to apply if the applicant here only acted as agent for the foreigner. But see *Avery's Patent*, 4 R. P. C. 152, 322, C. A.

(*a*) *Ashton & Knowle's Application*, 27 R. P. C. 181. Cf. *Walker v. Hydrocarbon Syndicate*, 2 R. P. C. 3.

(*b*) *Ibid.*

(*c*) *Ibid.* *Paterson's Application* (1884), Griff. 295; *Thwaite's Application*, 9 R. P. C. 515.

This applies even where what was obtained from the opponent is only described and not claimed. *Hetherington's Application*, 7 R. P. C. 419.

(*d*) This course was formerly frequently adopted. (See *Eddie's Application* (1885), Griff. 279 *b*; *Russel's Patent*, (1857) 2 De G. & J. 130), and although it is now rarer, the Comptroller has power to adopt it.

Ashton & Knowle's Application, 27 R. P. C. 181. It may also be made a condition of the grant that a share of a patent be assigned; *Evans & Otway's Application* (1884), Griff. 279; *Garthwaite's Application* (1886), Griff. 284.

Where there are opposing applications the parties sometimes agree to both being granted. *Hatfield's Application* (1884) Griff. 288. For another order see *Luke's Application* (1886), Griff. 294.

(*e*) 1910 F.

(*f*) *Stewart's Application*, 9 R. P. C. 452.

There are a very large number of dicta to the effect that the opponent having the further resort of *scire facias* or petition the patent should not be refused if there is the slightest doubt, e.g. *Lowe's Patent* (1856), 25 L. J. (CH.) 456; *Tolson's Patent* (1856), 6 De G. M. & G. 422; *Ex parte Sheffield* (1873), 8 Ch. App. 237; *Russel's Patent* (1857), 2 De G. & J. 130; *Spence's Patent* (1858), 3 De G. & J. 523.

(*g*) The words of the present Act (see s. 11 (1) (*b*)) render obsolete the decision in *Johnson's Patent*, 24 R. P. C. 694, that the date of application in this country was to be considered and not the Convention date.

(*h*) Sect. 11 (1) (*b*).

sufficient (i), nor is the fact that what has been claimed in the earlier specification has been described in the later (k). The opposition may be founded on a specification on which no patent has yet been granted (l), or where the patent has lapsed (m), and the validity of such patent is immaterial (n). Although, as has been stated above, the opposition must generally be founded on a patent in which the opponent has some interest, he is yet allowed to join other patents in which he may have no interest (o).

In order to obtain a refusal of a patent on this ground a very clear case has to be made out, and the applicant is always given the benefit of any doubt, since the refusal of a patent is final whilst a contrary decision leaves it open to the opponent to test the question in the Courts by way of petition or otherwise (p). If, however, the Comptroller or Law Officer is of

(i) *Bartlett's Application*, 9 R. P. C. 511; *Von Buch's Application* (1887), Griff. L. O. C. 40. See also *Gozney's Application*, 15 R. P. C. 259. But see p. 274, note (u).

(k) *Teague's Application* (1884), Griff. 298; *Bartlett's Application*, 9 R. P. C. 514.

The effect of these decisions, however, is practically nullified by the practice established by *Francis's Application*, 27 R. P. C. 86, to the effect that in the course of an opposition the Comptroller may insist on any amendments, whether arising from the grounds of opposition or not, which the office could have required at an earlier stage. See on this point, p. 274, n. (u). Cf. also *Hetherington's Application*, 7 R. P. C. 419.

(l) As to references in such case, see p. 276.

(m) *Glossop's Application* (1884), Griff. 287; *Lancaster's Application* (1884), Griff. 293; *Holland Hall's Application*, 5 R. P. C. 284; *Stewart's Application*, 13 R. P. C. 627.

It is probable that a specification on which no patent has been or can be granted, (as might happen if the patent had been refused or the sealing fee not paid), would not be held to come within this sub-section.

(n) *Haythornethwaite's Application*, 7 R. P. C. 70; *Green's Application* (1885), Griff. 286; *Thornborough & Wilke's Application*, 13 R. P. C. 115.

In this case it was held, however, that the prior state of knowledge might be referred to show that the

opponent's specification should be given a limited construction. A similar decision was given in *Jones's Application* (1887), Griff. L. O. C. 33.

For this purpose the applicant is not limited to such prior knowledge as appears in British specifications, *Thornborough & Wilke's Application*, *supra*, but these are admitted as evidence of prior knowledge, and foreign specifications may also be quoted. It has been pointed out (in 1911 C.) that, except where a claim to a master patent has been made by the opponent, the quotation of such foreign specification and publications must necessarily be confined with narrow limits (i.e. to the cases where there is a real doubt as to the scope of the opponent's claims).

It is difficult to see, however, how the quotation of either British or foreign specifications can be justified unless a claim is set up to the master patent in view of the rule clearly laid down by the Courts that such specifications are not evidence of common knowledge and cannot be used to affect the *interpretation* of a specification. See p. 124, n. (e), and p. 246, n. (g), *Thornborough & Wilke's Application*, *supra*. The system by which a specification is subject to one set of rules of construction in the Courts and to another in the Patent Office is obviously open to objection.

(o) See p. 264, n. (o).

(p) *Chandler's Application* (1888), Griff. 274; *Stubb's Application* (1884), Griff. 298; *Nahsen's Application*,

opinion that there is no substantial difference between the two inventions it is his duty to refuse the patent (*q*).

What the opponent has to establish is that what is claimed in the later patent is the same invention as that previously patented. The fact that articles made under the later patent would be an infringement of a previous claim, though, of course, a necessary step towards this proof, is by no means sufficient, since the invention may be for an improvement on the earlier invention and not for that invention itself (*r*). The true test is rather, would the later patent prevent the carrying out of the invention claimed in the earlier patent in the way there indicated or in a way which it would require no invention or even ingenuity to suggest (*s*).

The question whether the later patent discloses subject-matter is not in issue. The only question is, are the inventions identical or only colourably different (*t*). On this question the tribunal will consider the question of mechanical equivalents (*u*), but mere resemblance in the result aimed at and mechanism used, not amounting to substantial identity, is not sufficient to justify refusal (*x*).

Although the question of the disconformity of the applicant's patent does not come directly in issue (*y*) the applicant will not be allowed a patent if the only distinguishing feature is something which does not appear in the provisional specification (*z*).

When patent
will be
refused.

One class of cases in which the power of stopping the later patent is exercised with some freedom is where the earlier patent claims the use of a class of substances or a class of arrangements and the later patent is for the use of a

17 R. P. C. 203; *Welch's Application* (1884), Griff. 301; *Jones's Application* (1887), Griff. L. O. C. 34. See also p. 266, n. (*f*).

(*q*) *Todd's Application*, 9 R. P. C. 487.

(*r*) *Sielaff's Application*, 5 R. P. C. 484; *Nahnsen's Application*, 17 R. P. C. 203.

(*s*) "Where there is an existing patent and (the Law Officers) can see fair ground for supposing that the construction of the later specification would interfere with the rights of the existing patent, the existing patentee is entitled to be protected." *Newman's Application*, 5 R. P. C., per WEBSTER, A. G. at p. 277.

(*t*) *Jones's Application* (1887), Griff.

L. O. C. 34; *Haythornethwaite's Application*, 7 R. P. C. 70; *Todd's Application*, 9 R. P. C. 487.

(*u*) *Smith's Application*, 13 R. P. C. 200; *Haythornethwaite's Application*, 7 R. P. C. 70.

(*x*) *Maxim & Silverman's Application*, 11 R. P. C. 315.

(*y*) *Newman's Application*, 5 R. P. C. 271.

(*z*) *Harvey's Application*, 8 R. P. C. 431; *Lancaster's Application*, 20 R. P. C. 366. See also *Francis's Application*, 27 R. P. C. 86.

The effect of this decision would seem to be that the office may during an opposition raise any objection to a specification, although it has been accepted.

particular member of such class. In such case if no ingenuity was needed to select this member the patent will generally be refused (a). The other cases of refusal on the second ground are chiefly those in which all that differentiates the later invention from the earlier is some trifling detail of no real utility. In some of such cases, too, this detail had not in the first instance been claimed as an essential part of the invention (b).

(a) The following are examples of refusal in the case of selection patents:—

The opponent had patented a stopper with a screw thread and an indiarubber ring fixed in a groove. Applicant applied for a patent for a similar stopper with the groove in a particular position which was said to give the minimum of contact between indiarubber and fluid. *Aire & Calder's Application*, 5 R. P. C. 345.

The opponent had patented the use of soluble salts of chromium for dyeing. Applicant applied for a patent for the use of one such soluble salt, viz. the bi-sulphite. The only advantage of this salt was that no alkali was necessary for precipitation, and this advantage was shared by another salt specifically mentioned in the former patent. *Wylie & Morton's Application*, 13 R. P. C. 97.

Opponent had patented a process for sintering carbons by passing a current through them in an inert gas. Applicant applied for a patent for the use of a direct current in this process. He alleged that the current ordinarily used was alternating, but that he had found there were great advantages in the direct. *Deutsche Gaslicht Actiengesellschaft's Application*, 26 R. P. C. 101.

Opponent had patented the use of supports in the walls of glass vacuum vessels, saying that they could be put in any position. The applicant applied for a patent for such bottle having one such support in a central position. *Van Wye's Application*, 26 R. P. C. 490.

Opponent had patented the construction of a form of armature with a frame of non-magnetic material. Applicant applied for a patent for making such frame of nickel steel (which was one of such materials of which there was only a small class), alleging it to be the best. *Bosch's Application*, 26 R. P. C. 710.

The following are examples of

selection patents which have been allowed:—

The opponent had patented a process for making smokeless powder out of insoluble nitro-cellulose, with or without a mixture of soluble nitro-cellulose. The applicant applied for a patent for smokeless powder made out of soluble and insoluble nitro-cellulose in certain specific proportions, and alleged that this gave a particularly favourable result. Patent granted, but reference ordered. *Curtis & André's Application*, 9 R. P. C. 495.

The opponent had patented safety explosives made from certain materials within a certain wide range of proportions. The applicant applied for a safety explosive for mines made with the same ingredients, and with special proportions coming within the range of the first patent. The Law Officer was of opinion that the safety aimed at by the opponent was safety in handling, and that the second patentee had been the first to draw the attention of the public to the fact that by forming an explosive with the constituents in special proportions you also got safety after ignition in a mine. The patent was allowed. In this case the opponents also alleged that they had been manufacturing in proportions near to that claimed by the later invention. This was held not to give any further ground of opposition. *Nahusen's Application*, 17 R. P. C. 203.

(b) The following are examples of refusals of patents where only some slight alteration or addition had been made:—

Application for a patent for a carburetter apparatus. The only variation from what had been previously patented was a slight alteration in the position of the pipes, making no functional difference. *Wallis & Ratcliff's Application*, 5 R. P. C. 347.

The opponent had patented an

Where it is sought to stop a combination claim by showing that the parts have been separately patented a very clear case must be made out (c). Probably the patent would not be stopped unless the tribunal were convinced that the applicant was only attempting to give an appearance of novelty by putting into one claim matters which had no connection with each other, and did not coact in any way (d).

apparatus for heating water in which one part was a cone. The applicant applied for a patent for an apparatus which was identical, except that the cone was rounded at the top. This made no difference in the operation. *Daniell's Application*, 5 R. P. C. 414.

The opponent had patented a process for treating cellulose as in paper making, and scraping it off the rolls when dry as a flimsy tissue. The applicant applied for a patent for the same process, but directed that it should be scraped off when damp. There was no real advantage in the change and the product was unaffected. *Boult's Application*, 10 R. P. C. 275. See, however, *Welch's Application* (1884), Griff. 301.

Where the only difference between the opponent's and applicant's inventions was that the latter substituted for one part of the opponent's an article in common daily use, i.e. a stopper with a metal rim, it was held that the inventions were identical. *Hedge's Application*, 12 R. P. C. 136.

Where the only difference between the opponent's and applicant's inventions was that the latter substituted a coil for an internal cylinder for heating water, which did not affect the advantages of the apparatus, it was held that there was no invention. *Smith's Application*, 13 R. P. C. 200.

Where the opponent had patented a crank brace having as one part an L-shaped piece, and the applicant had applied for a patent for an identical piece except that there was a joint in the L, which joint was of little, if any, use, it was held that the inventions were identical. It should be noted that in this case the distinguishing feature had not been made a part of the original claim. *Whittaker's Application*, 13 R. P. C. 580.

Where the applicant had taken the whole of the opponent's process but had added certain other processes which in the opinion of the Law Officer did not make a "reasonably

substantial and beneficial difference," it was held there was no invention. *Hodgkin's Application*, 23 R. P. C. 527. See also *Todd's Application*, 9 R. P. C. 487; *Lupton's Application*, 14 R. P. C. 261.

The following are examples of small additions held sufficient:—

The opponent had patented a certain form of blower for ventilating purposes. The applicant applied for a patent for a similar form of blower as an air compressor, adding a case-ment which served to equalise the pressure of the air blown out. Patent allowed with reference. *Tattersall's Patent*, 9 R. P. C. 150. See also *Cumming's Application* (1884), Griff. 277; *Welch's Application* (1884), Griff. 301.

(c) *Ross's Application*, 8 R. P. C. 477.

(d) *Fried Krupp's Application*, *ubi infra*.

The following are examples of such combination claims:—

A patent for the combination of previously patented rollers and pivots for movable partitions together with previously patented fastening means to hold such partitions shut. *Held*, not patentable. It should be noted that in this case the two integers performed entirely independent functions and were not in operation at the same time. *Bridge's Application*, 18 R. P. C. 257; *Harrild & Perkin's Application*, 17 R. P. C. 617. See also *Thomas & Prevost's Application*, 16 R. P. C. 69.

Application for a patent for forming grain carrying ships with double shelved sides and a deck which sloped approximately at the angle of rest of the cargo. Each feature separately was old, but the combination enabled a hold to be formed so that the sides were unbroken and exactly fitted the cargo all round, so as to prevent displacement. *Held*, patentable. *Fried Krupp Aktiengesellschaft's Application*, 25 R. P. C. 809. See also *Ross's Application*, 8 R. P. C. 477.

Again, patents for making an already patented article by a means not in itself patentable are not generally allowed (e).

The third ground of opposition is that the nature of the Third ground. invention or the manner in which it is to be performed is not sufficiently or fairly described or ascertained in the complete specification (f). This ground of opposition only dates from the recent Act, but the question of unfair or insufficient description had often previously to be considered in the course of oppositions on other grounds (g).

Subject to the opponent having a sufficient locus (h), this ground offers a wide opening for attack on the specification. Thus a description of an invention may be held to be unfair if it includes other inventions, even though these are not claimed (i). Again the question of utility may be raised by saying that the description of how to perform the invention must be unfair or insufficient, since it does not lead to the result claimed (k).

The fourth ground of opposition is that the complete Fourth specification describes or claims an invention other than that ground.

(e) In *Levy & Elliott's Application*, No. 21, 113, of 1907, unreported, it was held that where the same applicant had filed two specifications on the same day, one for a general method of construction and one for the application of this method to a previously patented article, the second patent must be refused. Cf. *Webster's Application*, 6 R. P. C. 163; *Wilson's Application*, 9 R. P. C. 512 n.

So a patent for making a previously patented article by a method old in itself has been refused. *Cruse's Application*, No. 9427 of 1910, unreported.

(f) Sect. 11 (1) (c). This ground only applies to cases where the invention claimed is not properly described, it does not allow the point to be raised that this is a different invention to that described in the application as originally lodged. *Serex's Patent*, 29 R. P. C. 284.

(g) See p. 268, n. (s). See also *Hetherington's Application*, 7 R. P. C. 419; *Francis's Application*, 27 R. P. C. 86; *Wadham's Application* 27 R. P. C. 172.

(h) It must be remembered that a locus to oppose does not necessarily give the right to raise all grounds (*J. & J.'s Application*, 19 R. P. C. 555), and it may be that it will be

held that where an opponent only justifies his opposition on this ground, say as auxiliary to an opposition on the second ground based on some patent in which he has an interest, he may not be allowed to attack the specification on the ground of insufficiency in matters having no connection with the invention described in the earlier patent.

(i) *Francis's Application*, *supra*. It is also an objection that the specification describes as common knowledge what is only disclosed in a particular specification. *Hopkin's Patent*, 27 R. P. C. 72. But see *contra Kilner's Application*, 8 R. P. C. 135.

So too the patentee has not the right to impose on the public his idea of the contents of a prior specification, and if he does so he may be required to refer to it specifically. *Atherton's Application*, 7 R. P. C. 547.

(k) See p. 79, n. (d).

The general tendency has been to avoid a trial of the truth of the applicant's statements as to increased utility, and not to decide disputes involving scientific evidence as to facts as far as possible, 1910 D. But cf. *Wylie & Morton's Application*, 13 R. P. C. 99. How far this will be possible in oppositions on the third ground remains to be seen.

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 lodging of the complete specification (*l*). This ground of opposition raises questions similar to those discussed under the head of disconformity, and where the new matter is such that it would be considered a fair development not amounting to disconformity there is no ground for opposition (*m*).

Amendment. The Comptroller can allow certain claims, while ordering others to be excised (*n*), and may require such amendment as he may think right either in the claims, or by way of disclaimer, or by alteration of the specification (*o*).

References. An order which is very frequently made during an opposition is for the insertion of a reference to some earlier specification, or to its subject matter, with or without a disclaimer. The origin of this form of amendment was doubtless that in cases where there was a dispute as to whether on a proper construction the applicant's claim covered anything which was claimed before it was felt that he ought to do away with the doubt by saying distinctly that he did not claim such earlier matter. The function of such a reference should, therefore, be confined to cases where the construction of the applicant's claim is doubtful (*p*). If it is clear that it covers what has been claimed

(*l*) Sect. 11 (1) (*d*). Where the two provisional specifications were filed on the same day it was held that no opposition lay on this ground, 1910 *A.*

(*m*) *Edward's Application*, 11 R. P. C. 461; *Millar's Application*, 15 R. P. C. 718.

In *Birt's Application*, 9 R. P. C. 489 it was held that the Law Officer had to decide what the applicant really meant when he filed his provisional, and that he might for this purpose look at contemporary documents such as the original drawings.

For another case where the opposition on this ground has failed, see *Anderson's Application*, 7 R. P. C. 323.

For cases where it has been successful, see *Wilson's Application*, 9 R. P. C. 512 *n.*; *McHardy's Application*, 8 R. P. C. 431; *Hudson's Application*, 22 R. P. C. 218.

(*n*) It was held in *Webster's Application*, 6 R. P. C. 163, that where there was a claim to a new article, a

second claim to its use in a manner forming the subject of a prior patent should not be allowed. See also *Athertson's Application*, 6 R. P. C. 547; *Wilson's Application*, 9 R. P. C. 512 *n.*

(*o*) See p. 274, *n.* (*u*).

Where the opposition is on the second ground only an amendment of the body of the specification may be ordered if a part of the description affects the construction of the claims, and *semble* even if it does not, but then only in exceptional cases. *Wadham's Application*, 27 R. P. C. 172; *Hetherington's Application*, 7 R. P. C. 419; *Francis's Application*, 27 R. P. C. 86.

In *Guest's Application*, 5 R. P. C. 312, an amendment was ordered excising references to alleged defects in a prior patented apparatus. *Aliter* if the prior patent is not specifically mentioned.

(*p*) *E.g.*, *Newman's Application*, 5 R. P. C. 271; *Lorrain's Application*, 5 R. P. C. 142; *Lynde's Application*, 5

before the patent should be refused or the claim excised. If it is clear it does not there is no ground for a reference. Infringement in itself is no more ground for a reference than for stopping the patent (*q*).

Although references are now ordered much more freely than formerly there are certain principles laid down by the earlier decisions which it is submitted should still apply. The main one is that the object of a reference being only to elucidate the true meaning of the claim, there is no need for such a reference where the specification and claims are properly drawn. The fact that the amount of invention is small is no ground in itself for the insertion of a reference, provided the specification and claim clearly show that it is only the small new part which is the subject of the patent (*r*).

The great change which has occurred on the question of the insertion of references in oppositions is that whereas formerly an opposition was treated as being a proceeding *inter partes* (*s*),

R. P. C. 664; *Steel's Application*, 8 R. P. C. 235.

(*q*) *Newman's Application*, 5 R. P. C. 271; *Stell's Application*, 8 R. P. C. 235; *Marsden's Application* (No. 1), 13 R. P. C. 87; *Marsden's Application* (No. 2), 14 R. P. C. 174.

A different view seemed to be taken in *Hoffman's Application*, 7 R. P. C. 92, but this has not been followed.

In *Hoskin's Application* (1884), Griff. 292, a reference was inserted on the ground that the later invention would never have been made but for the fact that the applicant had seen the earlier one, but it does not appear that the claims of the later patent were directed only to the points of difference.

Where the applicant sets out in his specification as new what has formed the subject of a prior patent a reference may be ordered. *Teague's Patent* (1884), Griff. 298, and in one case it was suggested it might be done where the reference was in the applicant's provisional specification. *Hookham's Application* (1886), Griff. L. O. C. 32.

(*r*) *Adam's Application*, 13 R. P. C. 548; *Anderson & McKinnell's Application* (1887), Griff. L. O. C. 23; *Lorrain's Application*, 5 R. P. C. 142; *Stell's Application*, 8 R. P. C. 235; *Marsden's Application* (No. 1), 13 R. P. C. 87; *Marsden's Application* (No. 2), 14 R. P. C. 174. See also

Brockie's Application, 25 R. P. C. 813, where earlier decisions were considered.

The rule was laid down most clearly by Sir Robert Finlay, S. G., in *Adam's Application*, *supra*, "... in some cases a reference to a prior patent may be desirable for the purpose of explaining what the claim of the applicant is. The applicant's claim may be worded in such a general way as to include not merely the improvement which he has effected, or thinks he has effected, but also details of construction which have formed the subject of a prior patent. . . . The amendment of the claim might be done, and it would be the most satisfactory and scientific way of doing it, by altering the language so as to direct the claim merely to those parts of the apparatus described which the applicant considers as his improvement. . . . I think that the same object which might have been achieved by properly limiting the claim in the first instance, or by embodying a proper amendment of the claim, may in substance be achieved by a reference to the prior patent."

(*s*) A reference to the earlier cases will show that this was so, although once an effective opposition has been launched the opponent was not *dominus litis* to the extent of being able to withdraw it whenever he wished, or to consent to an order being discharged, see p. 283, *n. (l)*.

so that unless the opponent could make out a fair case for the refusal of the patent with the specification in its original form he had no right to ask for the insertion of a reference (*t*), the Office now treat an opposition as giving them again all the powers they had before the acceptance of the specification, both as regards refusing the patent or requiring amendment or references to specifications whether these have been referred to by the opponent or not (*u*). This affects the order which may be made in very important respects. For example, the Office has a right to require a reference on the ground of the invention having been wholly or partly described in a former specification, even if it is not claimed therein (*x*), but this gives no ground for opposition (*y*).

Grounds for reference.

The rule laid down by the earlier Law Officers was that a reference will not be given merely for the purpose of drawing attention to a former patent, if the claim of the later patent is clear and is for some additional feature (*z*). There was also a great disinclination, even in a case where some amendment was necessary, to insert a reference to a former specification unless it was clear that this was practically the first publication on the subject (*a*). These claims that the prior specification relied on was the first publication on the subject were usually

(*t*) *Marsden's Application* (No. 1); 13 R. P. C. 87; *Marsden's Application* (No. 2), 14 R. P. C. 174; *Lorrain's Application*, 5 R. P. C. 142; *Stell's Application*, 8 R. P. C. 235; *Brockie's Application*, 25 R. P. C. 813.

These cases show that the opponent had to make out that, at least on some possible construction of the applicant's claim, he has established a case for refusal and so justified his opposition.

(*u*) *Hughes & Kennaugh's Application*, 27 R. P. C. 281.

In this case the patent was refused on a specification not cited by the opponent, but produced by the examiner. The decision was upheld by the Law Officer who, however, intimated that the better course would have been to have amended the notice of opposition by inserting this specification.

Of course, in the absence of opposition the applicant has the right to obtain a patent on the expiration of two months from acceptance, the only power remaining in the office being to

insert a statutory reference under s. 8. It is presumed that the office will only claim this extension of their powers in the case of there being some effective opposition, e.g. that it would not be exercised if the opponent failed to establish a locus. See also *Francis's Application*, 27 R. P. C. 86, C. G.; *Wadham's Application*, 27 R. P. C. 172.

(*x*) Sect. 7 (1) (4).

(*y*) Sect. 11 (1) (*b*). *Francis's Application*, 27 R. P. C. 86.

In some of the earlier cases, e.g. *Welch's Application*, 8 R. P. C. 442, it was said that a reference might be ordered where the invention had been either described or claimed in the earlier specification. *Von Buch's Application* (1887), Griff. L. O. C. 42; but see *contra Gozney's Application*, 5 R. P. C. 597.

(*z*) *Adam's Application*, 13 R. P. C. 548, and other cases quoted at p. 273, *n.* (*r*).

(*a*) *Guest's Application*, 5 R. P. C. 312; *Welch's Application*, 8 R. P. C. 442.

put forward by the use of the much-abused term "master patent," and there seems now to have grown up a tendency to treat the fact of the existence of a master patent as a separate ground for inserting a reference quite apart from any ambiguity in the applicant's claim, *i.e.* merely to draw attention to the existence of such master patent (*b*). It is somewhat difficult to reconcile this practice with the statutory grounds for opposition, unless it is said that it is impossible to properly describe a later invention without a reference to the earlier, which would, of course, be an entire reversal of the principles formerly applied (*c*).

There are several forms of reference which have been employed. The most stringent is a reference by name and number to an earlier specification, together with a disclaimer of anything claimed therein (*d*). Another form is a similar reference and disclaimer but the substance of the prior claim is set out instead of the name and number of the specification (*e*). Other forms are a statement that it has been proposed to do so and so (*f*), or a reference to a prior specification as showing a type of machine which has been formerly used or proposed (*g*), or a statement may be inserted that the later patent is for improvements in the type of articles shown in the earlier (*h*).

The object and effect of references are very liable to be misunderstood. No form of reference is in any way an admission that the later invention is an infringement of the earlier one. A reference coupled with a disclaimer of course does limit the claims, and a reference by the patentee himself, even without a disclaimer, has the effect of saying that "in construing my specification you must remember that certain things have been already done, and therefore if there is any doubt as to the

(*b*) *Hopkin's Patent*, 27 R. P. C. 72 C. G.

The general principles on which the office proceeds in inserting specific references are here laid down. See also *Adam's Application*, 13 R. P. C. 548; *Meyenberg's Application*, 22 R. P. C. 356; *Levinstein's Application*, 11 R. P. C. 348.

(*c*) *E.g. Adam's Application, supra.*

(*d*) The disclaimer need only be of what is claimed in the former patent. *Gozney's Application*, 5 R. P. C. 597.

(*e*) *Newton's Application*, 17 R. P. C.

123. The difference between these two forms of reference was here discussed.

(*f*) But see as to the disadvantages of this form, *Atherton's Application*, 6 R. P. C. 547.

(*g*) *E.g. Van Gelder's Application*, 9 R. P. C. 325.

(*h*) *E.g. Hoskin's Application* (1884), Griff. 292.

In *Anderton's Application* (1887), Griff. L. O. C. 25, instead of a reference being inserted the construction of the applicant's specification was agreed and placed on record.

Forms of reference.

Object and effect of references.

meaning of my claims you must take it that I have not claimed these *per se*" (i). But unless the reference is a specific one it does not incorporate the prior specification dealing with the matter disclaimed into the specification, or justify any reference to such an earlier specification in interpreting the later one. With regard to statutory references it seems very doubtful if these form any part of the specification or affect its construction in any way. They are merely a notice to the public by the Office that a reference to certain other specifications may be useful in enabling them to form an opinion as to the scope and validity of the later invention.

The inventor's objection to the insertion of such reference is usually a commercial one, namely, that if persons see that he has been compelled to give a reference to a prior specification they will think that the invention is of doubtful value, and also, if the reference is to an existing patent, will think that there is a grave danger of the later invention being held an infringement of the earlier one, and that therefore his patent, and possibly the articles manufactured under it, will by reason of the reference be more difficult to sell and of less commercial value.

Master
patent.

Where the opponent claims to be opposing on a master patent (k) he must clearly state this claim, and be prepared to support it with evidence (l). In fact in any case where the opponent requires a specific reference to a particular specification he should be prepared with evidence as to the prior state of knowledge (m).

Concurrent
applications.

Where a reference is sought to a specification which was not published at the time of the application special considerations

(i) See p. 118, n. (y).

(k) This was defined in *Hopkin's Patent*, 27 R. P. C. 72, as a patent for "the discovery of a new and important pioneer principle broadly claimed."

(l) *Southwell & Head's Application*, 16 R. P. C. 361.

A declaration under r. 4 or a statement under r. 40 must be filed clearly setting out what is said to be the master invention. It is not strictly necessary to file evidence in the first instance, but if the applicant challenges the opponent's claim the latter must be prepared with evidence dealing with the state of the art and prior

specifications. A mere reference to the office search is not sufficient to support the claim to a master patent. 1911 C. *Hopkin's Patent*, 27 R. P. C. 72.

At one time a practice existed of setting up a claim to a master patent at the hearing and offering to subsequently file a declaration in support of this claim. This practice was most inconvenient, and was clearly undesirable. Where such a claim to a master patent is set up the applicant has, of course, the right to file evidence contesting the claim.

(m) *Stell's Application*, 8 R. P. C. 235.

apply (*n*), since such specification would not be an anticipation of, nor in any way affect the scope or validity of, the later patent (*o*), unless it could be pleaded as a prior grant (*p*). Where the earlier patent has not been sealed at the date of the hearing the references ordered will be conditional on a patent being granted on the prior application (*q*), and no reference will be granted on the ground of anything that is merely described in the earlier specification (*r*).

The opposition must be lodged within two months of the date of advertisement of the acceptance of the complete specification (*s*), and must state the grounds on which the opponent relies (*t*). If all that the opponent requires is some amendment or reference, and, subject to this being agreed to, would be prepared to let the patent go, he should send a statement to that effect either with the notice of opposition or as soon after as may be (*u*). If the opposition is on the first ground the opponent *must* file evidence within fourteen days of the expiration of the above-mentioned two months (*x*), and he *may* do so in other cases if he thinks fit (*y*). Whether or not evidence is filed by the opponent the applicant has the right to file evidence, and the opponent may then file evidence in reply (*z*).

(*n*) *Gaunt's Application*, 14 R. P. C. 387.

A practice of granting references to concurrent applications had, however, grown up before the present Act, and in a recent decision it has been laid down that the fact that the applications are concurrent is in no case a bar to the refusal of the second patent, but only makes the tribunal exercise greater care, 1912 *D*.

(*o*) Except of course in the case of disconformity, cf. s. 11 (1) (*c*).

(*p*) See Chapter IV., pt. 2.

(*q*) 1910 *G*.

(*r*) See Chapter IV., pt. 2, and p. 258.

(*s*) Sect. 11 (1). *Newman's Application*, 5 R. P. C. 271.

(*t*) Rule 40. Form 8 must be used. The form must be signed by the opponent, but where it has been signed by his agent leave may be given to amend. See *Lake's Application* (1887), Griff. L. O. C. 35.

(*u*) Rule 40. This statement should show generally the nature of the amendments required, and the portion of the earlier specifications relied on. The notice may ask for different

alternatives, and if an order is made for any of these the opponent will in general get his costs unless the applicant has notified his willingness to make the alterations finally ordered. 1910 *H*. Where the opposition is on the third ground such notice is obligatory and should accompany the notice of opposition, r. 41 (2).

(*x*) Rule 41 (1). If this is not done the opposition will be considered as abandoned unless an extension of time is obtained.

(*y*) Rule 42.

(*z*) Rules 43, 44, 45. The applicant's evidence should be filed within fourteen days of the receipt of the opponent's evidence, or, if the opponent does not file evidence, within three months of the advertisement of acceptance. The opponent has a further fourteen days to file evidence in reply. All these times may be extended, r. 109. Further evidence may be filed by leave, r. 46. Unnecessary declarations may lead to the party responsible having to pay costs. *Brand's Application*, 12 R. P. C. 102.

Either party has the right to ask for a hearing, but if neither does so the Comptroller will decide the case without a hearing (a). Notice must be given, at least five days before the hearing, of any publication, not mentioned in the notice or declarations to which either party intends to refer (b).

At the hearing the applicant has the right to begin except where the opposition is on the first ground (c). The opposition is generally conducted on the declarations filed, but the Comptroller has power to take oral evidence, either from the deponents or from other persons, or to order the deponents to attend for cross-examination (d). As a general rule the tribunal attempts to avoid elaborate scientific evidence, as, if there is need for this, the proper course is probably to allow the patent and leave the parties to go to the Court (e).

The Comptroller has power, either at or before the hearing, to allow the notice of opposition to be amended either by adding fresh specifications (f), or an entirely new ground of opposition, even though the two months has elapsed (g), but such amendment is not a matter of right (h).

The Comptroller may at the hearing of an opposition allow or require such amendment as he thinks fit, and this is made without any formalities or advertisement (i). Such amendment, however, is not a matter of right, and the applicant who has claimed widely, and then on opposition seeks to cut his patent down to some small detail, is in danger of losing it altogether (k), or of having an order made for specific references which might have otherwise been avoided (l). This applies

(a) Rule 47. Each party who desires to be heard must leave form 9 before the date of the hearing, and if this is not done the Comptroller may refuse to hear him. Even if the opponent does not appear the custom is to have a hearing, and amendments may be allowed at such hearing.

(b) Rule 47.

(c) 1910 F.

(d) Sect. 77 (1).

(e) Cf. 1910 D., and *Lake's Application*, 6 R. P. C. 549.

(f) 1910 C.

(g) *Boehm's Application*, 23509 of 1908 (unreported). See also *Airen's Application*, 5 R. P. C. 349; *Daniel's Application*, 5 R. P. C. 414.

(h) 1910 C.

(i) This applies also to amendments asked for by notice under Rule 40 and made by consent.

(k) *Harrild & Perkin's Application*, 17 R. P. C. 617; *Lupton's & Place's Application*, 14 R. P. C. 261; *Thomas & Prevost's Application*, 16 R. P. C. 69; *Garnett's Application*, 16 R. P. C. 154; *Mill's Application*, 18 R. P. C. 322; *Crist's Application*, 20 R. P. C. 475.

(l) Where the main claim is anticipated and only a minimum of invention left great care will be taken that the claims are strictly limited, and the opponent's claim to a master patent will not be narrowly examined. *Sachse's Application*, 18 R. P. C. 221; *Hamilton's Application*, 19 R. P. C. 33.

particularly where this detail formed no part of the original claim (*m*).

The Act provides that any person who would have had the right to oppose may apply to the Comptroller to revoke a patent on any of the grounds on which he might have opposed (*n*). These "belated oppositions" are conducted in all respects like an ordinary opposition and the same orders as to amendment may be made as in the case of an opposition (*o*). No application may be made under this section when an action for infringement or proceedings for the revocation of the patent are pending in any Court, without the leave of the Court (*p*).

Application to revoke on opposition grounds.

Amendment.

Amendments may be made in the application, the commonest form being by the addition of fresh applicants or the omission of some of the original applicants. The persons to whom the patent is granted must, however, always include those who declared themselves to be the inventors except in the case of death.

Amendment of application or provisional.

There are no provisions for the amendment of a provisional specification, but it is the practice of the Office to allow amendment by excision.

The applications for amendment of the complete specification which may be made to the Comptroller (*q*) fall into the following classes:—

Different classes of amendment.

- (1) Applications made before acceptance. Here there are no formalities as to advertisement and no fixed rules as to the character of the amendment allowed (*r*).

(*m*) *Harrild & Perkin's Application, supra; Whittaker's Application, 13 R. P. C. 580.*

(*n*) Sect. 26.

(*o*) See pp. 272 *et seq.* See also *Hopkin's Patent, 27 R. P. C. 72, and p. 278.*

(*p*) Sect. 26 (1).

It is not the practice to permit a person who has opposed unsuccessfully to apply to revoke under this section. Nor is it the practice to permit an application under this section before the patent has been sealed.

(*q*) As to when applications may be made to the Comptroller, and as to applications to the Court, see AMENDMENT, p. 231.

(*r*) But the proposed amendment must not introduce a wider or different invention from that originally described. See *C.'s Application, 7 R. P. C. 250.* Subject to this, however, the practice of the office is generous to the inventor, and he is allowed to shape his claim so as to cover any material feature of his invention disclosed in the specification or drawings as originally filed, even if such feature were not claimed in the first instance, *Serex's Patent, 29 R. P. C. 287.* But it must be remembered that such changes may involve the necessity for further searches, for which there may be no time.

- (2) Applications to amend an accepted specification under the provisions of section 8 (s).
- (3) Applications for amendment during the course of an opposition or application to revoke under section 26 (t).
- (4) Applications made after acceptance (otherwise than as in (3)) provided that no action for infringement or proceeding before the Court for revocation is pending. Here the application must be to amend by way of disclaimer correction or explanation (u). The application must set out the proposed amendment and give reasons (x) for the application. The request and proposed amendment must be advertised and any person may, within one month of the first advertisement, oppose the amendment (y). Evidence may or may not be filed and the Comptroller may give his decision with or without a hearing (z).

Amendment
of specifica-
tion after
acceptance.

An amendment on application to the Comptroller may be by way of disclaimer, correction, or explanation, but must be such as not to make the specification claim an invention substantially larger than or different from that claimed before amendment (b). Since it has been decided that once an amendment is allowed its propriety cannot be further challenged (c), greater care has been exercised in criticising the allowability of proposed amendments (d). Generally an amendment which confines a claim by incorporating as additional essential elements matters described in the specification as intended to be used with the apparatus, etc., covered by the claim (e), or which disclaims

(s) See rr. 33-35.

(t) See pp. 272, 279.

(u) Sect. 21, rr. 60-67. Application to be made on Patent Form 17.

(x) *Ibid.* The reasons given will not be closely scrutinised. *Ashworth's Patent* (1886), Griff. L. O. C. 6.

(y) Sect. 21. There has been no general decision limiting the meaning of the term "any person" in this section, but see *Bell's Patent* (1887), Griff. L. O. C. 12. See also p. 264. Notice of Opposition to be on Patent Form 18.

(z) Opponent's evidence to be left within fourteen days of expiration of a month from first advertisement. Applicant's evidence within fourteen days of this, or, if opponent does not file evidence, within two months of first advertisement. Further pro-

ceedings as in the case of opposition, see p. 277. As to absence of any declaration by applicant, see *Ryland's Patent*, 5 R. P. C. 665.

(b) Sect. 21. For cases in the Courts where amendments have been held not to transgress this rule see *Kelly v. Heathman*, 7 R. P. C. 343; *Farbenfabriken, &c. v. Bowker*, 8 R. P. C. 396; *Moser v. Marsden*, 13 R. P. C. 24, H. L.; *Dick v. Tullis*, 13 R. P. C. 155, O. H.; *Perry v. Société des Lunetiers*, 13 R. P. C. 670.

(c) *Moser v. Marsden*, 13 R. P. C. 24, H. L.

(d) See *Knight v. Argyll's, Ltd.*, 29 R. P. C. 610.

(e) *Cochrane's Patent* (1885), Griff. 304; *Ashworth's Patent* (1886), Griff. L. O. C. 5; *Serrel's Patent*, 6 R. P. C.

some of the alternatives allowed by the specification (*f*), will be permitted. So a combination claim will in general be allowed by way of amendment when it is clear that the use of its various parts in combination was contemplated by the original specification (*g*). But it does not necessarily follow that a patentee will be allowed to change a claim, which has been deliberately drawn so as to cover a principle broadly, into one for some specific detail mentioned in the specification (*h*), and the difficulty is far greater where the particular means were not there mentioned (*i*). Of course these objections do not apply if it is merely a case of striking out one broad claim and leaving a narrower one. Generally speaking it will be assumed that the amendment makes some difference in the meaning of the specification, and it is for the applicant to show that it does not make it claim a substantially different invention (*k*). An amendment will not generally be allowed which excises or alters some statement of fact which was an essential part of the patentee's original statement of his invention (*l*), nor will one which incorporates subsequently-acquired knowledge (*m*). But if an ambiguous term has been used the patentee may define what he meant at the time of filing the original specification (*n*). It would seem that amendments will be more readily allowed where the patentee shows that the specification does not in

101. But the new claim must be in restriction of, and not in substitution for, the old, *ibid*.

(*f*) *Ryland's Patent*, 5 R. P. C. 665; *Dellwik's Patent*, 15 R. P. C. 862; *Nordenfeld's Patent* (1887), Griff. L. O. C. 18.

(*g*) *Kelly v. Heathman*, 7 R. P. C. 443; *Hattersley and Jackson's Patent*, 21 R. P. C. 233; *Golstein's Patent*, 27 R. P. C. 289.

(*h*) *Serrel's Patent*, 6 R. P. C. 101; *Lang's Patent*, 7 R. P. C. 469; *Ashworth's Patent* (1886), Griff. L. O. C. 5; *Parkinson's Patent*, 13 R. P. C. 509.

(*i*) *Nairn's Patent*, 8 R. P. C. 444; *Walker's Patent*, Griff. L. O. C. 5; *Hattersley and Jackson's Patent*, 21 R. P. C. 233.

In this last case the patentee had by a former amendment struck out one claim and all the letterpress referring to it. He then sought to amend again by making the remaining claim into a combination claim for the matters claimed in the two

original claims. It was held that he could not do so. See also *Ralston v. Smith* (1865), 11 H. L. C. 223.

It must be remembered that if the general form mentioned in the original specification is old, and the only novelty lies in the specific details, now for the first time introduced, the patentee is incorporating a new invention. Cf. DISCONFORMITY, p. 105.

(*k*) *Knight v. Argyll's, Ltd.*, 29 R. P. C. 610; *Vidal's Patent*, 15 R. P. C. 721.

Prior to the decision in *Moser v. Marsden*, 13 R. P. C. 24, H. L., a different view prevailed. See *Luke's Patent* (1887), Griff. L. O. C. 16.

(*l*) *Johnson's Patent*, 13 R. P. C. 659; *Alsop's Patent*, 24 R. P. C. 684.

(*m*) *Beck and Justice's Patent* (1886), Griff. L. O. C. 10.

(*n*) *Johnson's Patent*, 26 R. P. C. 780; *Farbenfabriken, &c. v. Bowker*, 8 R. P. C. 396.

fact express what he meant to express (*p*). An amendment will not be allowed suggesting demerits in prior patented processes, at any rate without evidence as to the truth of such suggestions (*q*).

In a proper case drawings, etc., may be added by way of amendment (*r*) or a drawing described in the letter press (*s*).

Leave to amend a matter of grace.

It must always be remembered that amendment is a matter of grace, not of right, and the tribunal takes into account a large range of matters, such as the nature of the specification (*t*), the age of the patent (*u*), the conduct of the patentee in making repeated amendments (*x*), or in lying by so as to let the trade start manufacture on the assumption that the patent is invalid (*y*), or in keeping in a claim to terrorise the trade (*z*), or in delaying the application after knowledge of infringement (*a*), etc. The tribunal has power to impose terms as a condition of allowing the amendment, though it rarely does so (*b*). An amendment will not be allowed if it has been decided by the House of Lords that there is a total lack of subject matter (*c*), or if the tribunal itself is so clear as to the lack of subject matter in the specification with the proposed amendments that it would refuse to grant a patent on it in a case of opposition (*d*). Again amendments or disclaimers may be required to be inserted as in an opposition (*e*). So, too, an amendment will not be permitted which is of such a vague character as to make

(*p*) *Johnson's Patent*, 13 R. P. C. 659; *Johnson's Patent*, 26 R. P. C. 780; *Allen's Patent* (1885), Griff. L. O. C. 3. See also *Birt's Application*, 9 R. P. C. 489, 491; *Beck and Justice's Patent* (1886), Griff. L. O. C. 10; *Farbenfabriken, &c. v. Bowler, supra*.

(*q*) *Hampson and Fucer's Patent* (1887), Griff. L. O. C. 13.

(*r*) *Lang's Patent*, 7 R. P. C. 469.

(*s*) *Morgan's Patent* (1886), Griff. L. O. C. 17.

(*t*) 1911 A. *Haddan's Patent* (1885), Griff. L. O. C. 12.

(*u*) Cf. *Klaber's Patent*, 22 R. P. C. 416.

(*x*) *Johnson's Patent*, 13 R. P. C. 659. See *contra*, *Lang's Patent*, 7 R. P. C. 469.

(*y*) *Allison's Patent*, 15 R. P. C. 408.

(*z*) *Ainsworth's Patent*, 13 R. P. C. 76; *Ashworth's Patent*, Griff. L. O. C. 5.

(*a*) *Corrigal v. Armstrong*, 20 R. P. C. 523.

(*b*) *Hearson's Patent*, 1 R. P. C. 213; *Allen's Patent* (1885), Griff. L. O. C. 3; *Ashworth's Patent* (1886), Griff. L. O. C. 5; *Ainsworth's Patent*, 13 R. P. C. 76; *Allison's Patent*, 15 R. P. C. 408; *Pitt's Patents*, 18 R. P. C. 478; *Davies Patent*, 28 R. P. C. 50.

(*c*) *Hennebique's Patent*, 28 R. P. C. 41. See also *Parkinson's Patent*, 13 R. P. C. 509.

It is submitted that this should not be done merely on a decision of a lower Court, since the patentee may wish to appeal on the question of subject-matter after removing the indefensible claim. Cf. also *Hoffman's Application*, 7 R. P. C. 92.

(*d*) 1911 A, but see *contra*, *Bell's Patent* (1887), Griff. L. O. C. 10.

(*e*) 1911 A, but see *Bell's Patent, supra*.

litigation necessary for its elucidation (*f*). An appeal to the Law Officer lies against any decision of the Comptroller (*g*), but if a decision refusing an amendment is not appealed against, no subsequent application for such amendment can be entertained unless the failure to appeal against the former decision is satisfactorily explained (*h*).

Besides the power to amend a specification by limiting the scope or making a correction in the description the Comptroller has also power to amend clerical errors in any application, patent, or specification, or in any matter on the register. Such a correction can be made at any time, whether legal proceedings are pending or not, and need not be advertised (*i*). Correction of clerical errors.

Appeal.

An appeal lies from any requirement made by an examiner to the Comptroller or to one of the persons who exercise his functions, and from such decision there is in all cases an appeal to the Law Officer (*k*). An appeal lies to the Law Officer also against a decision in an opposition (*l*), or with regard to amendment (*m*). These appeals must be lodged within fourteen days of the dates of the decision appealed against (*n*). In the case

(*f*) *Parkinson's Patent*, 13 R. P. C. 509.

(*g*) Sect. 21 (5).

(*h*) *Arnold's Patent* (1887), Griff. L. O. C. 5.

(*i*) Sect. 70.

Certain cases reported under the early practice when the amendment was made by the M. R. may throw some light on what alterations can be so made. See *Nickels' Patent* (1841), 4 Beav. 563; *Whitehouse's Patent* (1838), W. P. C. 473; *Sharp's Patent* (1840), W. P. C. 641.

Delay in making the application might be a ground for refusing it. *Jardine Blamond's Patent* (1860), 3 L. T. 800.

(*k*) That is to say there is always an appeal against the refusal of the comptroller to accept the specification if the requirement is not complied with. See *J. and J.'s Application*, 28 R. P. C. 625.

An appeal against a statutory reference under s. 7 is given by s. 7 (5), and the effect of s. 8 (1) is to apply the right of appeal so given to the case of references under s. 8,

since the provisions are not inconsistent.

(*l*) Sect. 11 (3). The withdrawal of the opponent does not give the applicant the right to have the comptroller's order set aside on appeal. *Kempton and Molan's Application*, 22 R. P. C. 573.

The Law Officer has power even after deciding such an appeal to grant a re-hearing, but will not do so merely because the opponent is willing to withdraw. *Thomas and Provost's Application*, 15 R. P. C. 257.

(*m*) Sect. 21 (5).

(*n*) L. O. R. r. 1. Where the C. G.'s decision does not definitely fix form of specification the time runs from the time when amended copy of specification is forwarded. *Chandler's Application*, Griff. 273; *Cooper and Ford's Application*, Griff. 276.

The time may be extended either by the Comptroller or Law Officer, r. 3. Notice of appeal may be signed by an agent. *Anderson's Application* (1887), Griff. L. O. C. 23.

Generally speaking the evidence is the same as that used below, but the

of an application to revoke a patent under sections 26 or 27 an appeal lies to the Court (o), and in a case where the order of the Comptroller has been for the revocation of the patent under section 26 the decision of the Court may be appealed against in the ordinary way. In other cases the decision of the Court is final (p). The Court for this purpose means the judge who is selected by the Lord Chancellor for the purpose (q). In the case of an application for the restoration of a patent the appeal is also to the Court, whose decision is final (r). The only form of appeal against an entry, or a refusal to make an entry, on the register is by moving to rectify the register (s). It has also been the practice to allow an appeal on matters not strictly covered by these provisions (t).

Restoration of Lapsed Patents.

In order to maintain a patent in force it is necessary to pay the renewal fees prescribed by the Act or Rules (u).

Law Officer may allow further declarations or oral evidence or cross-examination, rr. 8 and 9. The Law Officer has power to give costs and such order may be made a rule of Court, s. 40.

The Law Officer will not allow new grounds of opposition to be raised or fresh specifications to be quoted against the applicant. *Bailey's Application*, Griff. 269.

Nor will an opponent who has filed no evidence below on the charge of fraud be allowed to do so on appeal. *Huth's Application* (1884), Griff. 292.

These appeals are of the nature of re-hearings. *Stubb's Application*, Griff. 298.

The Law Officer has power to send a case back to the comptroller for re-hearing. *Warman's Application*, Griff. L. O. C. 43.

In one case it was held that where the Law Officer decided that the opponent was not entitled to be heard, the C. G.'s decision might still stand, but this seems to have been on the view that it was only necessary to show a locus if there was an appeal to the Law Officer. *Heath and Frost's Application*, Griff. 290.

(o) Sect. 26 (4); s. 27 (4). Such appeal must be lodged within one month, O. 53a, r. 4. The time runs in vacation, and though the Court has power to extend it, this will not

be done merely because agents or counsel have been dilatory. *Beldam's Patent*, 27 R. P. C. 758.

The appeal is by petition, and in a proper case a person who has not appeared below may present such petition. *Jonkergouw and Destrez's Patent*, 27 R. P. C. 540.

(p) Sect. 92 (2).

(q) *Ibid.*

(r) Sect. 20 (5), O. 53a, r. 4.

It is doubtful whether there is any appeal against a refusal of the comptroller to let an application for restoration go to advertisement, but such an appeal has been heard by consent. *Land's Patent*, 27 R. P. C. 481.

(s) Sect. 72.

(t) *E.g.* refusal of an application as not being for a manufacture or as being for more than one invention, see p. 255, n. (d).

(u) Sect. 65, rr. 52-54. The fees are £5, payable at end of fourth year, for fifth year, and increase each year by £1. A fee is in time if paid on the same day of the year as the patent is dated. *Williams v. Nash* (1859), 28 Beav. 93. See also *Watson v. Pearl* (1809), Davies, 325. A notification is sent to the patentee, or the person who paid last fee, one month before next fee is due. An extension of one, two, or three months may be obtained on payment of a fee of £1, £3 or £5.

Where a patent has become void owing to the failure of the patentee to pay these fees within the prescribed time an application may be made to the Comptroller for an order for the restoration of the patent, accompanied by a statement as to the circumstances which led to the omission. If it appears from such statement that the omission was unintentional, and no undue delay has occurred in the making of the application, the Comptroller shall advertise such application, and any person may oppose the same within two months from the first advertisement. After the expiration of two months from such advertisement the Comptroller will hear the case and may issue an order restoring the patent (x).

This procedure replaces the old procedure by private Bill, and the Comptroller will probably be largely guided in exercising his discretion by the considerations on which Committees decided whether such bills should be passed (y).

The rules provide that the order for restoration shall contain provisions protecting and preserving the rights of persons who have infringed the patent, or used, purchased, or sold any patented article, or installed patented machinery, between the date when the patent was advertised as void and the date of the order (z). The order also provides for an application being made to the Board of Trade within a year by any person who has expended money, time or labour on the subject-matter of the patent in the *bonâ fide* belief that it was void, for the assessment of the compensation which in their opinion should be awarded to him. If such money is not paid the patent becomes void, but the sum awarded cannot in that case be recovered (a).

(x) Sect. 20, and rr. 55-59. The fee on the application is £20. The rules as to leaving evidence, &c. are very similar to those in the case of oppositions. The hearing is necessary even in the absence of opposition. As to appeals, see p. 283.

(y) The fact that a patentee has acted under a misapprehension of law, e.g. as to the protection afforded by the patent in question or another patent, does not make the failure to pay unintentional. If the patentee knew that the fee has become payable and deliberately omitted to pay it, that is not within the section. *Land's Patent, 1910 I, & 27 R. P. C. 481.*

This procedure does not extend to all cases where a Private Act might

have been obtained, *ibid.* But a perusal of the preambles of the Private Acts passed for this purpose do not show any cases not coming within the term "inadvertence," except cases where letters, &c. had gone wrong. Relief was frequently granted where the omission was due to the fraud or carelessness of an agent.

The fact that failure to pay was caused by poverty is not in itself a reason for restoration, but the poverty of the applicant may have some bearing on whether the application to restore has been made without undue delay.

(z) R. 58, s. 20 (3).

(a) R. 59.

Registration of Title.

Register.

A register is kept at the Patent Office in which are entered the names and addresses of grantees of patents, notices of assignments, amendments, extensions, revocations, and such other matters as may be ordered (*b*). On it are entered changes of proprietorship, notifications of claims, etc. (*c*). No notice of a trust is to be entered (*d*), but notice of an equitable assignment of a patent, or of a share in a patent, will be entered (*e*). The register kept under former Acts is incorporated in and forms part of the register (*f*). This register is open to inspection by the public (*g*), who are deemed to have notice of any matter affecting the proprietorship entered therein (*h*). The register or a certified extract is *prima facie* proof of any matter directed or authorised to be entered therein (*i*).

A person desiring to be entered on the register as having an interest in a patent, or desiring to have a notification of a document entered upon the register, must produce the necessary documents to the Comptroller together with such proof of title as the Comptroller may require. The patentee and other persons appearing from the register to be interested will be notified, and may oppose the change (*k*).

(*b*) Sect. 28. The additional matters would seem to be date of grant, address for service (rr. 82-84), date of application in this country in the case of Convention patents (r. 83), notice of interest (rr. 85-90), notification of documents purporting to affect proprietorship (r. 91), notice of payment or nonpayment of fees (rr. 92-93).

(*c*) See last note. Also s. 71, and r. 85. The entry shows whether the interest is that of proprietor or mortgagee. See *Van Gelder Apsimon & Coy. v. Sowerby Bridge Flour Society, Ltd.*, 7 R. P. C. 208, C. A.

(*d*) Sect. 67.

(*e*) See *Stewart v. Casey*, 8 R. P. C. 258.

(*f*) Sect. 28 (2).

(*g*) Sect. 67 and r. 94.

(*h*) See p. 10.

(*i*) Sect. 28 (3).

(*k*) Any person may give notice at the Patent Office that he wishes to be notified as to any application for change of proprietorship, &c. of a patent. *Viola v. Sharpe*, 22 R. P. C. 23.

In case of opposition the C. G. will, if necessary, grant a hearing. The custom has grown up of the

opponent giving a written statement of his grounds of opposition, but such notice is not required by the Act or rules, and the opponent would not seem to be confined to the grounds so given. There is no power to grant costs on such opposition, nor is there any appeal, except by a motion for rectification.

In accordance with the decision in *Bowden's Patents Syndicate, Ltd. v. Smith*, 21 R. P. C. 438, no entry of change of proprietorship will be entered on a document bearing a date before that on which the patent was sealed, 1910 *E*; though a notification of such document may be entered, *ibid.*

Generally speaking the C. G. will not go behind the documents or consider equitable objections to them, but he may delay registering the change of proprietorship to allow these points to be raised in the Courts, *ibid.*

For a notification of a document to be entered on the register it must generally speaking refer to the particular patent. It is doubtful whether a document earlier than the application could ever be entered. *Parnell's Patent*, 5 R. P. C. 126. See also

Any person aggrieved (*l*) by any entry in the register, or by the non-insertion of any entry, may apply to the Court for rectification of the register (*m*). The Court may in such proceedings decide any question which is necessary or expedient in connection therewith (*n*). The Comptroller is to be served with notice, and may, and if the Court so direct shall, appear. Any order in such proceeding shall be served on the Comptroller, who shall thereupon make any necessary alteration in the register (*o*). Rectification
of the register.

Evidence and Costs.

Evidence is generally by means of Statutory declaration (*p*), but the Comptroller may, if he thinks fit, take the evidence Evidence
before the
comptroller.

Haslett v. Hutchinson, 8 R. P. C. 457.
As to what documents may be entered, see *Stewart v. Casey*, 8 R. P. C. 258.

An incomplete agreement should not be entered. *Fletcher's Patent*, 10 R. P. C. 252.

When a company, after selling a patent was dissolved before an assignment was executed, the C. G. registered the purchaser as proprietor. *Re Taylor's Agreement Trusts*, 21 R. P. C. 713. See also *Heath's Patent*, 29 R. P. C. 389.

(*l*) This expression is given a wide interpretation. Cf. *Manning's Patent*, 20 R. P. C. 74; *Stewart v. Casey*, 8 R. P. C. 258, C. A.; *Haslett v. Hutchinson*, 8 R. P. C. 457; *Fletcher's Patent*, 10 R. P. C. 252; *Horsley and Knighton's Patent* (1869), L. R. 8 Eq. 475, and the decisions on the corresponding section of the Acts referring to trade marks especially, *Apollinaris Co.'s Trade Mark*, R. P. C. 137, C. A.

Generally a wrongful entry will be expunged if it appears to complicate or adversely affect any person's title, see *Ex parte Green* (1857), 24 Beav. 145. Cases in which entries have been expunged are. Entry of later assignee, *Ex parte Green, supra*. *Morey's Patent* (1858), 25 Beav. 481.

Assignment by one of two copatentees of his share purporting also to give a release from claims by the other patentee. *Horsley and Knighton's Patent* (1869), L. R. 8 Eq. 475.

Entry of agreement expunged on ground (*inter alia*) that it did not show variations which had been agreed to by parties. *Haslett v. Hutchinson*, 8 R. P. C. 451.

Entry of agreement expunged on ground that it was not complete.

Fletcher's Patent, 10 R. P. C. 252.
Unsuccessful applications to expunge entries were made in *Manning's Patent, supra*; *Casey's Patents*, 8 R. P. C. 268; *Anderson v. Patent Oxonite Coy.*, 3 R. P. C. 279.

An order for rectification will not be made if the entry is correct at the time of hearing, though it was not so at the time when the proceedings commenced. *Manning's Patent*, 20 R. P. C. 74.

Where the entry is wrong in some particulars it may be ordered to be expunged instead of being rectified. *Haslett v. Hutchinson*, 8 R. P. C. 457.

(*m*) Sect. 72. No special procedure is prescribed, but the application is always made by motion, see cases in last note, and at least four clear days' notice must be given to the Comptroller, r. 113.

As this is not an appeal from the Patent Office the provisions of the Act as to reference to a particular Judge, evidence, and appeal do not apply. The motion for rectification may be heard with a motion or action by the patentee. *Anderson v. Patent Oxonite Coy.*, 3 R. P. C. 279.

According to the practice in trade mark cases the Scotch and Irish Courts have jurisdiction to make such orders, s. 94 (7), and s. 95 (3).

(*n*) Sect. 72 (3).

(*o*) Sect. 72 (4). As to the service of such orders, see r. 113. In view of the wording of this sub-section it is probably necessary to obtain a stay if there is an appeal. Formerly this was not so, see *Fletcher's Patent*, 10 R. P. C. 252.

(*p*) As to form and method of making these, see rr. 106 and 107.

vivá voce in lieu of or in addition to evidence by declaration, or allow any declarant to be cross-examined on his declaration (*q*). Generally speaking contests of evidence as to scientific facts are to be discouraged, and, if possible, such decision will be given as will enable the question to be raised in the Courts (*r*).

Costs.

The Comptroller has power to give costs in cases of opposition, revocation, or amendment, and any such order may be made a rule of Court. Where an opponent to the grant of a patent, or applicant for revocation, or any person giving notice of appeal from a decision of the Comptroller, neither resides or carries on business in the United Kingdom or the Isle of Man, the Comptroller may require such person to give security for costs (*s*).

Post, Time, etc.

Any communication to the Office, Comptroller, or other person may be made by post (*t*).

Whenever the last day for doing anything shall fall on a Saturday or a day when the Office is closed (both of which are termed excluded days) it may be done on the next day which is not an excluded day (*u*).

Patent Agents.

Nearly all acts which have to be done by an applicant or patentee may be done by his properly appointed agent (*x*). Any person, with certain statutory exceptions (*y*), may act as such an agent, but he must not use the term "Patent Agent" or describe himself as a patent agent unless he is on the

(*q*) Sect. 77. As to declarations by infants, lunatics, &c., see sect. 83.

(*r*) See 1910 *D*, where directions are given as to how experiments should preferably be performed.

(*s*) Sect. 39. It should be noted that apart from this section the C.-G. has no power over costs. Cf. *Kynoch v. National Arms Coy.* (1877), 37 L. T. 31.

(*t*) Sect. 81.

(*u*) Sect. 82 and rr. 110-111, which also state the days when the office is closed.

(*x*) Sect. 85. As to excepted matters see r. 9.

(*y*) Sect. 85. These are that the C.-G. need not recognise as an agent any person whose name has been

erased from the Register of Patent Agents, or who has been proved to the satisfaction of the Board of Trade, after he has had an opportunity of being heard, to have been guilty of such conduct as would have rendered him liable to be struck off the list had he been on it. Nor need he recognise as agent a company or firm if any such person is a director or manager of such company, or a partner in such firm. He *shall* not recognise as such agent any person who neither resides nor has a place of business in the United Kingdom. As to the procedure for the removal of names from the register, see Register of Patent Agents' Rules.

register (z). Any person who proves that prior to the 24th December, 1888, he had been *bond fide* practising as a patent agent is entitled to be registered; but until he is so registered he must not represent himself as a patent agent (a). Other persons may be admitted to the register on the passing of the necessary examinations (b).

General Powers of the Comptroller and Board of Trade.

The Comptroller has the general management of the Patent Office (c). A certificate granted by him as to any entry matter or thing which he is authorised by the Act or Rules to make or do is *prima facie* evidence of such matter or thing, and copies or extracts certified by him are evidence in all parts of the Empire without production of the originals (d).

General powers of the comptroller.

Where he has any discretionary power under the Act he shall not exercise it adversely to an applicant for a patent or

(z) Sect. 84. A description as "Patent Expert," or a statement that a man can do the work of a patent agent is not an offence. *Graham v. Eli and Ors*, 15 R. P. C. 259; *Graham v. Turner*, 29 R. P. C. 688. Nor is it an offence to sign a specification as "agent for the applicant." *Graham v. Fanta*, 9 R. P. C. 164.

Since the Act (or rather the 1883 Act) has created a new offence and fixed a penalty, no other form of procedure is open, and an action for an injunction to restrain a man from passing himself off as a patent agent will not lie. *Chartered Institute of Patent Agents v. Lockwood*, 11 R. P. C. 274, H. L.

(a) Sect. 84. *Storey v. Graham*, 16 R. P. C. 106.

(b) See Register of Patent Agents' Rules.

It may be useful to add a few remarks as to the duties and position of a patent agent. Any person undertaking work in this capacity, whether registered or not, warrants that he has the special knowledge and skill necessary for this purpose, and is liable in damages if by reason of his default in these matters his employer suffers loss; e.g. where patent agent, from ignorance of a decision on procedure, allowed a rival applicant to obtain a patent, he was held liable. *Lee v. Walker* (1871), 7 L. R. C. P. 121.

Again he is responsible if loss occurs from his negligence, e.g. if a patent becomes void through his failure to pay a fee or notify his employer. *Turnbull v. Cruikshank*, 22 R. P. C. 521, I. H.

In this case it was held that the defendant could not give evidence to show that the patent was invalid in order to limit the damages, *sed quaere*. It should also be remembered that there is no privilege for communications between a patent agent and his client, i.e. either can be questioned as to what passed between them, or be compelled to produce written communications, and this applies even where the patent agent is a solicitor if he is in fact acting in the former capacity. *Moseley v. Victoria Rubber Coy.*, 3 R. P. C. 355. Care should, therefore, be taken as to the contents of written communications to patent agents. Of course if the communication is for the purpose of obtaining information solely for the purpose of enabling the client's solicitor to advise him or prepare for litigation, or if the patent agent makes a report for this purpose, such documents are provided. See Annual Practice Notes to O. 31, r. 1.

(c) Sect. 63.

(d) Sects. 78 and 79. The seal of the Patent Office is judicially noticed, s. 64.

for amendment without giving such applicant an opportunity of being heard (e).

He may apply to the Law Officer for directions in any matter (f).

He may refuse to grant a patent for an invention the use of which would in his opinion be contrary to law or morality (g).

He may correct clerical errors in or in connection with any application, specification, or patent or in any matter entered on the register (h).

He may issue duplicates of lost patents (i).

He may accept the surrender of a patent (j).

He may allow amendment of any document as to the amendment of which there are no special rules (k).

He may enlarge the time for doing any act in the office for which a time is prescribed by the Rules only, except the three months between lodging a Convention application and lodging the necessary documents, the two months' time for opposition to the restoration of a patent and the times for lodging evidence in Petitions for compulsory Licence, where extension must be given by the Board of Trade (l).

He may dispense with any act, thing, signature, declaration, or evidence prescribed by the Rules only (m).

Comptroller
and law
officer acting
judicially.

A mandamus will not be granted against a Law Officer as to any proceedings before him, nor against the Comptroller in any matter where he has exercised his discretion or where, having a discretion, he has taken the directions of the Law Officer (n). A mandamus would, however, probably be granted in the case of failure to exercise any ministerial function or to do what he is directed to do by the Act—*e.g.* if he refused to seal a patent on a specification which has been accepted, and where there has been no opposition, and the applicant has complied with the necessary conditions for sealing. Nor will prohibition be granted as to any matter within the Comptroller's jurisdiction, though *semble* it might be if he entertained an application improperly made (o).

Powers of the
Board of
Trade.

The Board of Trade has power to make rules on certain matters, subject to the provisions of the Act, and to repeal

(e) Sect. 73, rr. 102–105.

(f) Sect. 74.

(g) Sect. 75.

(h) Sect. 70, see p. 283.

(i) R. 100.

(j) Sect. 26 (3), r. 77.

(k) R. 108.

(l) R. 109.

(m) R. 112.

(n) *R. v. Comptroller-General (ex parte Tomlinson)*, 16 R. P. C. 233, C. A.

(o) *Van Gelder's Patent*, 6 R. P. C. 23. In this case a rule *nisi* for a prohibition to the C.-G., against entertaining an application for amendment which had not been duly advertised, was granted, but was not proceeded with.

these and to make new rules. Such rules must be advertised and must be laid before both Houses of Parliament as soon as practicable after they are made. If either House of Parliament, within forty days after the rules have been laid before it, resolves that any rule ought to be annulled such rule shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under the rules, or to the making of any new rules. Generally rules while in force have the same effect as if they were contained in the Act (p).

The Board of Trade may do any act through certain officials, and orders sealed with their seal are *prima facie* evidence of such orders, and this evidence may be made conclusive by a certificate from the president (q).

The Patent Office is under the Board of Trade, who appoint the Comptroller and other officers, and may authorise other officers to carry out the Comptroller's duties or any of them (r).

Patentee.

The term "Patentee" frequently occurs in connection with Patent Office Practice. This term is defined in the Act as meaning "the person for the time being entitled to the benefit of the patent" (s), but this definition leaves many questions open to doubt. As it is the "Patentee" who may amend or surrender a patent, or who has to defend it, it would seem clear that the person or persons having the real interest should come within this term, and that, for defensive purposes at any rate, any one of them should be allowed to be heard. In fact such a view is taken and the "Patentee" is treated as a composite personality covering all persons having interests legal or equitable (t). For those purposes, however, where

(p) Sect. 86. Where these objects are set out.

In *Chartered Institute of Patent Agents v. Lockwood*, 11 R. P. C. 374, H. L., it was held by a majority of the House of Lords that the validity of rules so made could not be questioned in the Courts, but these observations were probably only intended to apply to rules coming within the provisions of this section. Cf. p. 260, n. (u).

As to the effect of the forms prescribed and the power to vary these see *Grenfell and McEvoy's Application*, 7 R. P. C. 151.

(q) Sect. 87.

(r) Sects. 62 and 63.

(s) Sect. 93. It must be remembered that the decisions as to who may bring an action, see p. 165, are not directly in point, as the Act nowhere directly refers to such persons as patentees, though in ss. 22 and 23 the word would seem to apply to the plaintiff. In s. 25 it would appear to refer to the original grantee.

(t) Cf. interlocutory observations of PARKER, J., in *Halschek's Patent*, 26 R. P. C. 234, and *Goldstein's Patent*, 27 R. P. C. 289, C. G. In *Jonkergouw and Destrez's Patent*, 28 R. P. C. 28,

notice has to be given to the patentee, only those persons appearing on the register as having an interest are considered.

Offences.

It is a misdemeanour to make, or cause to be made, a false entry in the register, or a writing falsely purporting to be a copy of any entry in such register, or to produce or lodge, or cause to be produced or lodged, in evidence any such entry or writing, knowing the entry or writing to be false (u).

Any person falsely representing that an article sold by him is a patented article is liable on summary conviction to a fine not exceeding five pounds. If the article has the word "patent" or "patented," or any other word implying that the article is patented, on it, this constitutes such an offence (x). It is also an offence punishable summarily with a fine not exceeding twenty pounds to use the words "Patent Office," or any other word suggesting that the user's place of business is officially connected with the Patent Office (y).

It is an offence to use, without the authority of his Majesty, in connection with any business, trade, calling, or profession, the Royal Arms, or arms so nearly resembling them as to be calculated to deceive, or to lead to the belief that the user is authorised to use the Royal Arms (z).

The Drafting of Specifications.

Provisional
specification.

The provisional specification has only to describe generally the nature of the invention, with the object of enabling the

the assignee of an equitable owner was held entitled to petition to set aside an order for revocation.

In the case of amendment all persons having legal or equitable interest should concur in the application, or give their consent to it either directly or by estoppel. But where an application is launched without all such consents it is not bad *ab initio*, but only defective for want of parties. *Goldstein's Application, ubi supra.*

It is not clear how far licensees come within this term, but *cf. Hatschek's Patent, supra.*

(u) Sect. 89 (1).

(x) Sect. 89 (2), (3).

It would seem that once the complete specification has been accepted articles made according to it may be marked "Patent." *R. v.*

Townsend, 13 R. P. C. 265 (Magistrate's decision), and *cf. s. 10.*

Convictions have, however, been obtained where articles were marked "Patent," and only provisional protection had been obtained. *R. v. Wallis*, 3 R. P. C. 1; *R. v. Crompton*, 3 R. P. C. 367.

(y) Sect. 89 (5). See also p. 289, n. (z).

(z) Sect. 90. See also 46 & 47 Vict. c. 57, s. 90, and 5 Ed. 7, c. 15, s. 68.

It has in many cases been recognised that "Patent" may sometimes form part of the name of the article and in such case it would probably not be held to be an offence. *Cf. Gridley v. Swinburne* (1888), 52 J. P. 971, and such cases as *Sykes v. Sykes* (1824), 5 D. & R. 292; *Cheavin v. Walker* (1877), 35 L. T. 757.

*Royal
Warrant
holders
Associat
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Ch. 10.*

invention which will be later defined and claimed by the Complete specification to be identified with the invention for which protection was sought at the date of application. Anything which is in the Provisional may be omitted or cut down in the Complete. It is therefore generally advantageous to draw the Provisional in wide terms. But it not infrequently happens that an invention supposed to be broadly new is not so, and that all that is new are certain improvements or details. In such a case if these specific improvements or details have not been foreshadowed in the provisional they cannot be embodied in the Complete without making the latter liable to the objection of disconformity. The best form of Provisional is therefore one which states the invention in broad terms while also giving the preferred form or forms as an example. It is useful to draft and settle some principal claims upon the invention before drafting the Provisional, since their phraseology and form are helpful in the preparation of that document. They should be wide enough in scope to permit of the fair development of the contents of the Provisional.

The objection of disconformity has been to a great extent abolished by the alterations in the new Act, and the difficulties in connection therewith are also somewhat diminished by the power given to make a series of applications for inventions which are cognate or are modifications of one another, and then to lodge one Complete for the whole. On the other hand the Patent Office are much stricter than formerly in insisting that a Complete specification shall be confined to what is foreshadowed by the Provisional.

The object of the Complete specification is two-fold, viz., ^{Complete} to define the invention and to describe the manner of performing ^{specification.} it. These two matters are not necessarily separate, and in many cases they cannot be separated. But it is generally well to state shortly what is the invention or improvement before condescending to details as to how it is to be carried out. Such statement should deal both with the object of the inventor and with the broad features of the means or methods employed to effect it, but should avoid all details. But care must be taken that this statement, short as it is, distinguishes the new step taken by the inventor from what has gone before, or the Office are likely to insist on amendments or references. If the invention comprises several features these should all be named.

It is then generally advisable to describe an example, and in all cases, except in process patents, this description should be accompanied by drawings. Such a description necessarily involves details which are not part of, or essential to the invention, and where there can be any doubt it is as well to state distinctly where this is so, or where details can be varied. Care should be taken to refer in the letterpress to any features of importance in the invention which are shown in the drawings. Of course it is unnecessary to describe in detail parts which are old and which have no reference to the new invention.

It must be remembered that the object of the specification is to teach the reader how to carry out the invention under all the circumstances under which it is to be applied, and a proper description should therefore not only give the necessary direction for its performance in the special example given, but also indicate, where necessary, how these directions should be varied to meet changing circumstances.

This is especially necessary where the patentee claims to have struck out some new line, since in such case the competent workman, whose general knowledge the patentee can usually call in aid to supplement any apparent deficiencies in description, would not know how far he could rely on such knowledge in the new circumstances.

But it is also very necessary in cases where the subject matter of the invention appears to be slight. Here to support the patent it will be necessary to argue that the change, though small, needed invention, and the difficulties of this argument are greatly increased if at the same time the patentee must contend that changes, apparently as great, would be obvious to any competent workman.

Terms of art, mathematical, and scientific phrases are quite permissible in a specification, but the greatest care must be taken that if they are employed they are used correctly. If there is any doubt as to this it is far better to describe what is necessary in simple terms. As a general rule it is better to avoid dealing with matters of merely scientific interest, or advancing theories as to how a process or apparatus works.

Description of
prior know-
ledge.

Any statement as to prior knowledge is fraught with pitfalls under the modern system of reference. If no reference is made to the existence of certain earlier specifications it may be said

that the applicant has not fairly stated what prior knowledge there was. If he refers to the substance of the specification it is said that he is trying to force on the public his own construction of a written document, and that he ought to refer them to the actual document (a). It has also been held that it is not a fair description to refer to something as being commonly done which only occurs in a single specification (b). Thus, unless the greatest care is exercised an applicant who may have made a small improvement may find himself forced to put in references to a number of prior specifications. Again, where such a reference is made, either originally or as the result of opposition, the person whose specification is named may object to a statement that the apparatus there described was defective (c). Probably the safest plan is to describe the invention as for improvements in "the type of apparatus, etc., which" setting out what was old, and to distinguish as far as possible the new matter in the claims, commencing these with "in a machine of the type described" or "on a machine having (here set out the old features) the use of (here insert the new)." Unnecessary multiplicity of claims should be specially avoided in such cases. Where possible the need for such statements as to prior knowledge should be reduced to a minimum by confining the description to those features which are new.

The description of how the invention is carried out is often followed by a statement either showing that the invention is not confined to apparatus, etc., having certain specified details, or, on the other hand, that no claim is made to certain matters that have been described as these are in themselves old, and this is followed by the claims themselves. Claims.

In drafting the claims the rules laid down in the chapter on construction are to be carefully borne in mind. It is especially necessary to remember that the addition of any non-essential details necessarily diminishes the scope of a claim, since a claim for the combination of details only protects the combination as a whole. Where there has been no previous search it is always well to have at least one of the claims drawn on the broadest possible lines which the draftsman thinks can be

(a) *Atherton's Application*, 6 R. P. C. 547.

(b) *Hopkin's Patent*, 27 R. P. C. 72, C. G.

(c) *Guest's Application*, 5 R. P. C. 312.

No such objection can be raised if there is no reference to a specific patent, *ibid.*

sustained, in order to have the benefit of the wider search, though, of course, before the specification is finally accepted such claim should, if necessary, be modified in accordance with what has been discovered. In drafting subsidiary claims their effect on the construction of main claims should always be carefully considered, but, on the other hand, it is not necessary to consider whether the additional matter in each claim would constitute subject-matter as against the other claims, since all the Court considers is whether there is any claim in the patent infringes the rule of claiming what was old, and not how the patentee chooses to divide up by his claims a monopoly to which he is entitled.

Although in reading a specification the body must be read before the claims, in drafting it it is advisable to settle the main claims before embarking on the description. It is above all things necessary to good draftsmanship that the writer should have clearly in his own mind what are the features for which he wishes to claim a monopoly, and he should therefore start by setting these out specifically, and he can then see that his description contains all the details necessary for the proper understanding of the inventions so claimed.

A very general tendency has grown up to qualify claims by the addition of "substantially as described," and, generally speaking, this is a wise practice. If the spirit of the invention disclosed by the specification has been taken these words seldom prevent success against an infringer who has varied the details, and on the other hand they ought to be extremely useful in preventing anticipation by something which approaches the necessarily short description of the invention at the beginning of the claim, but which does not produce the advantages of what is described in the specification.

"Substantially as described" is a dangerous phrase, however, when used, as it too frequently is, in the hope that it will serve to settle at some later date the exact extent or meaning of a claim of the purport of which the draftsman has no very clear notion. A claim should be set out and settled as if "substantially as described" were not there, and then these words may be added for greater safety.

It is often difficult to carry out the above rules, especially in cases where, as often happens, there is uncertainty as to whether certain integers or steps in a process are essential,

or where there is doubt as to the novelty of certain parts of the invention. In such case it is sometimes better to confine the specification to a statement of how the invention is to be carried out and to mention in the claims only what is known to be essential with the qualification "substantially as described."

With reference to the drafting of claims the English practice ^{Forms of claims.} lies midway between the German method, where the monopoly is usually defined by a single claim directed to the "new technical result" sought or produced, and the American system with its numerous claims for combinations of specific details. The general and convenient practice is to commence with a broad claim which is confined only to the essentials of the invention, and to follow this with successively narrowing subsidiary claims which are restricted by embodying as well further specific details. It is well, however, not to needlessly indulge in these subsidiary claims. Such claims are really of no value while the first claim remains in the specification since *ex hypothesi* they can only be infringed if the main claim is infringed, and therefore cannot help a plaintiff on the issue of infringement, while if the main claim is held invalid the action necessarily fails. Their principal use is that they permit of an amendment by simple disclaimer if it found that the main claim is too wide. It may be said that they do no harm, but this is not necessarily true, since the presence of these claims limiting the main claim by the addition of certain further details, necessarily prevents these details being read into the broader claim.

A quite different class of claims are those for variants on the main invention, and these should be freely inserted if there is no reason to doubt their novelty and utility.

A further class of claim is for the use of specific details without all the limitations to be found in the main claim. Here great care is necessary as such claims are peculiarly liable to attack. Moreover under modern practice they are often held to infringe the rule of a patent being confined to a single invention. Where expense is not too important it is generally better to protect these separately.

In addition there may be claims for a combination of matters separately claimed in other claims. These claims are of the nature of subsidiary claims, but are sometimes of

assistance in getting claims for different integers allowed in the same patent. For this purpose, however, these integers must form a true combination.

Generally speaking, it is better in the claims to define the monopoly by a description of the construction rather than of the function, but a functional claim may be advisable in the case where some new object is achieved, and it is desired to show that the means are of subsidiary importance. Sometimes, too, in a claim where the invention has been described, a reference to function is also introduced by way of further limitation.

CHAPTER XVI

NON-WORKING

THE recent Patent Act provides that at any time after the expiration of four years from the date of grant an application may be made to revoke a patent on the ground that the patented articles are wholly or mainly manufactured abroad, or that the patented process is wholly or mainly carried on abroad. If this is proved then, unless the patentee shows some satisfactory reason for the lack of manufacture in this country, an order may be made either revoking the patent or giving the patentee a certain time to start effective manufacture here. Revocation
for non-
working.

It should be noted that the power is a discretionary one, and that there is no obligation to make an order (a).

The section has been construed as meaning that the patentee must give this country a fair share of the manufacture that is carried on in proportion to its needs and commercial development. It is not necessary in order to comply with the section that more articles should be made in England than elsewhere (b).

The section has no application unless manufacture is being carried on somewhere, nor after it has really ceased (c), but if manufacture is being carried on abroad it is not itself a sufficient answer for the patentee to show that there is no demand in this country, since it is his duty to attempt to create a demand and to introduce the industry here (d). But the mere fact of part of the demand being satisfied by importation does not show that the section has been contravened (e).

(a) Sect. 27, as to the discretionary powers of the comptroller, see *Ilgner's Patent*, 26 R. P. C. 198.

(b) *Hatschek's Patents*, 26 R. P. C., p. 240. See also *Bremer's Patent*, *Högner's Patent*, 26 R. P. C. 447; *Boult's Patent*, 26 R. P. C. 424.

(c) *Jonkergouw and Destrez's*

Patent, 28 R. P. C. 423; *Boult's Patent*, 26 R. P. C. 424.

(d) *Boult's Patent*, 26 R. P. C. 387.

(e) *Hatschek's Patent*, *ubi supra*, pp. 242, 243.

The object of the section is to secure fair play, not protection, *ibid.*

Patented
article.

“ Patented article ” means an article coming within the claim of the Letters Patent, whether such article comes within the realm or not. The question to be considered is not, therefore, confined to the manufacture of the articles sold here (*f*), nor to articles made by, or with the licence of, the patentee (*g*). Thus manufacture by infringers abroad or in this country will be taken respectively against the patent or in his favour (*h*). In the case of a patent for improvements in parts of a machine, it is sufficient if the patentee manufactures such new parts here, even if there are claims for these parts in combination with the rest of the machine. If the patent is for a combination of old parts it would seem to be sufficient if the combination is made here (*i*).

Adequacy of
manufactures

The question of adequacy depends on the facts of the particular case (*k*), but in general the manufacture is not considered to be adequate if it is less than it would have been had the patentee not abused his monopoly or given a preference to foreign traders (*l*). The power to revoke being discretionary, an order may be refused if there is adequate manufacture at the time of the hearing, though there was not at the time of the application (*m*).

Reasons for
non-manu-
facture.

What is a satisfactory reason for non-manufacture here of course also depends on the circumstances of the particular case (*n*). The general tendency of the decisions has been to be lenient to the patentee who has made real efforts to get manufacture established here, but has failed from want of capital or support (*o*), especially if the only manufacture abroad has

(*f*) *Hatschek's Patents*, 26 R. P. C. 241.

(*g*) *Ibid.*

(*h*) *Bremer's Patent*, 26 R. P. C. 449; *Mercedes Daimler Patents*, 27 R. P. C. 768.

(*i*) *Lake's Patent*, 26 R. P. C. 447.

It has never been decided what proportion of the manufacturing processes must be performed in this country in order that the article made may be considered to be manufactured here. Some light may be thrown on the question by decisions under the Merchandise Marks Acts, e.g. *Tierney v. Williamson* (1900), 17 T. L. R. 174, 424. *Bischof v. Toler* (1896), 65 L. J. (M. C.) 1.

(*k*) *Hatschek's Patent*, *ubi supra*, p. 241.

(*l*) *Hatschek's Patents*, *ubi supra*, p. 241.

The tribunal will not generally criticise the plaintiff's prices, or consider whether a greater demand would be induced by a lower price, if it appears that the price was fixed *bonâ fide*. If, however, there was reason to think that it had been fixed for the purpose of checking the demand here, e.g. if it was higher than the price charged abroad different considerations would arise. *Kent's Patent*, 26 R. P. C. 670. See also *Bremer's Patent*, 26 R. P. C., at p. 460.

(*m*) *Jottrand's Patent*, 26 R. P. C. 830.

(*n*) *Hatschek's Patents*, *ubi supra*, p. 241.

(*o*) “ The Act of 1907 was never meant to penalise want of success where the patentee has done his best.” *Bremer's Patent*, 26 R. P. C. 465. See also *Weber's Patent*, 26 R. P. C. 300; *Taylor's Patent*, *infra*.

been in his country of origin (*p*). But a mere formal offer of licences is of little effect (*q*), and efforts which have not commenced till proceedings have been threatened are also usually disregarded (*r*). An obstacle created by the patentee himself, such as an agreement not to manufacture or grant licences here, is not a satisfactory reason, even where such agreement was prior to the new Act (*s*). Nor in general is a mistake by the patentee as to the requirements of the law a satisfactory reason (*t*).

The four years' grace is intended to give the patentee an opportunity of developing the industry, and both during and after this time he should endeavour, by the terms offered and the efforts employed, to give this country a fair start in the industry (*u*). There may be cases where, owing to the substances employed or the conditions of labour, it can be shown that commercial manufacture in this country is not practicable, though the latter reason would be very hard of proof (*x*), but the mere fact that the profits of manufacture here would be smaller than elsewhere would not constitute a satisfactory reason for non-manufacture, nor would the fact that there would be no profits, if this was due to the patentee having given foreign countries an unfair start (*y*).

The efforts should have been such as a reasonable and business-like man would have made. *Boult's Patent*, 26 R. P. C. 387.

(*p*) *Boult's Patent*, 26 R. P. C., at p. 386; *Taylor's Patent*, *infra*.

(*q*) *Hatschek's Patents*, *ubi supra*, p. 248. But the absence of such offer might prejudice the patentee. It is better to make the offer by letters addressed to persons likely to be interested, the form being varied according to their individual needs.

(*r*) *Johnson's Patent*, 26 R. P. C. at p. 58; *Fell's Patent*, 27 R. P. C. 29; *Boult's Patent*, *supra*.

(*s*) *Hatschek's Patent*, *ubi supra*, pp. 242, 244.

(*t*) *Worring and Kortenbach's Patent*, 26 R. P. C. 167.

(*u*) *Hatschek's Patent*, *ubi supra*, p. 242.

(*x*) *Hatschek's Patent*, *ubi supra*, p. 242; *Boult's Patent*, *ubi supra*, p. 387. *Kent's Patent*, 26 R. P. C. 670.

(*y*) *Hatschek's Patent*, *ubi supra*, p. 243.

Instances of reasons held satisfactory.

Where the patentees showed that for five years after the date of the patent they were perfecting the manufacture in their own country and at the end of that time, and before the date of the application, they had taken steps to have the articles manufactured here. *Boult's Patent*, 26 R. P. C. 383.

Where the patented improvements had been practically superseded, and there had been no real demand since the date of the Act, though a few parts had been manufactured and imported for use in old cars. *Osborne's Patent*, 26 R. P. C. 819.

Where the patentees immediately on the grant of the patent began genuine negotiations for the sale of the patent in this country, and had concluded them after about four years, and manufacture on a small scale was about to be commenced in this country, the article being one for which there was only a very limited and special demand. *Jott-rand's Patent*, 26 R. P. C. 830.

International
arrangements.

The Act provides that no order shall be made under this section which is at variance with any treaty convention arrangement or engagement, with any foreign country or British possession (z). The object of this provision is probably to allow of mutual arrangements being made for working in one country satisfying the requirements of another, but no such treaties have as yet been made (a).

Orders nisi.

The tribunal has power, where the applicant has established his case, either to revoke the patent forthwith or to make an order that it shall be revoked after a specified reasonable interval unless in the meantime it is shown to its satisfaction that manufacture to an adequate extent has been established

Where the demand both in this country and abroad was very small, and some manufacture had taken place here, the smallness of the demand was considered, under the circumstances, a reason for the delay in establishing the manufacture. The fact that a portion of the first machine was made abroad was also held to be satisfactorily explained by the desire of the patentees to have their first machines made of the best materials. *Kent's Patent*, 26 R. P. C. 666.

A patentee, who had at the time of the patent an established business in the United States, wrote letters to leading firms in the trade here offering licences, had one experimental plant built here, and tried unsuccessfully to establish an agency here. The patentee had a successful trade in the United States, and had sold some £30,000 worth of the patented apparatus. He had been threatened by a prior patentee with an action for infringement if he made installations in this country, and an agent of such prior patentee was the applicant for revocation. It was held that the patentee had shown a satisfactory reason for non-establishment of the industry here, and that the fact that he had been hampered by the applicant was one which the Court would take into account. It was further held that the patentee was not bound to apply for a compulsory licence. *Taylor's Patent*, 29 R. P. C. 296.

See also *Badische, &c. v. Thompson*, 21 R. P. C. 473; *Weber's Patent*, 26 R. P. C. 300; *Bremer's Patent*, *Högner's Patent*, 26 R. P. C. 449.

Reasons held not satisfactory.

Where the patentee had before the Act granted an exclusive licence to a foreign firm to manufacture abroad, and so precluded himself from manufacturing or granting licences here. *Hatschek's Patents*, 26 R. P. C. 228; but cf. *Bremer's Patent*, *Högner's Patent*, 26 R. P. C. 449.

Where the patentee alleged that it was impossible to manufacture a machine here on the ground that the necessary skilled workmanship and special tools were only to be found in America, the patent being for improvements in certain parts of sewing machines which were manufactured as a whole in that country. It was shown that, in fact, these machines were also made in Germany. *Johnson's Patent*, 26 R. P. C. 52.

Where the patentee alleged that it had been impossible to obtain the skilled labour necessary to manufacture the machine profitably here (the patent being for parts of a Yost typewriter, which was, in fact, manufactured in the United States), and further had advertised their willingness to grant licences under the patent in this country. *Fell's Patent*, 27 R. P. C. 25.

(z) Sect. 27 (2).

(a) The Fifth Article of the International Convention, however, provides that no patent shall be forfeited by reason of the importation by the patentee of articles made under it, and this would probably prevent the fact of importation *per se* being sufficient for revocation under this section, though such importation might be evidence to rebut the

here (b). If manufacture is not established within this time, then, if the patentee can show satisfactory reasons for his failure, a further extension not exceeding twelve months may be given to him in which to establish such manufacture. The power of granting an extension of time to the patentee will, in general, only be exercised when the patentee has made some efforts to introduce the manufacture before proceedings were started, and there seems a possibility of his efforts bearing fruit (c). If there is at the date of hearing a substantial working (and something had been done before the application), the proper course is to dismiss the application, not to make a conditional order (d).

The applicant has to make out a *prima facie* case before Procedure. a hearing is granted or the patentee is called on to answer (e). Generally speaking both sides must produce all their evidence before the Comptroller, and no fresh evidence may be produced on appeal unless special reasons are shown (f).

Any person may apply, probably even a common informer (g). The Act provides that the answer shall be made by the patentee (h), who is defined as the person for the time being entitled to the benefit of the patent (i). It would seem that under this definition the person or persons really affected by the application will be allowed to oppose it, whoever may have the legal title (k). Either party may appeal against any order

argument that the manufacture here was adequate. Cf. p. 299, n. (b).

(b) Sect. 27 (2), (3), see also p. 300, nn. (k) and (l).

(c) *Worring and Kortenbach's Patent*, 26 R. P. C. 165.

For an instance of this order and subsequent proceedings thereon, see *Weber's Patent*, 26 R. P. C. 300, 27 R. P. C. 30. See also *Taylor's Patent*, 29 R. P. C. 302.

(d) *Boult's Patent*, 26 R. P. C. at p. 386.

Where, however, nothing has been done before the date of the application immediate revocation may be ordered. *Fell's Patent*, 27 R. P. C. 29.

(e) *Hatschek's Patents, ubi supra*, at p. 245; *Lake's Patent*, 26 R. P. C. 443. He must, therefore, show (a) that the manufacture, &c. is carried on somewhere, (b) that it is wholly or mainly abroad. As to the certainty necessary in the applicant's case, cf. p. 174, nn. (m), (n), (o).

(f) *Hatschek's Patents, ubi supra*, p. 247; *Bremer's Patent*, 26 R. P. C. at p. 466.

In this case further evidence was allowed. See also *Jonkergouw and Destrez's Patent, infra*.

(g) Sect. 27 (1). See *Hatschek's Patent, ubi supra*, at p. 240.

The motives of the applicant are immaterial, but his conduct may be material if it has interfered with the development of the industry in this country. *Taylor's Patent*, 29 R. P. C. 296.

(h) Sect. 27 (2).

(i) Sect. 93.

(k) See *Jonkergouw and Destrez's Patent*, 28 R. P. C. 423, where the assignee of the equitable owners was allowed to appeal. The legal owners were made respondents to the petition. See also *Hatschek's Patents, ubi supra*, at p. 234; *Högner's Patent*, 26 R. P. C., at p. 150.

of the Comptroller. Such appeal is by petition to the special judge, whose decision is final. The law officer may be heard on such appeal (*l*).

The Act only provides for the revocation of the patent as a whole, and difficulties may arise where it appears that there is manufacture here under certain claims but not under others (*m*). Possibly in such a case the patentee might be given the option of having his patent revoked or of disclaiming those claims under which there was no manufacture.

Costs.

The Comptroller and the Court have both full power as to awarding costs (*n*). If revocation is granted the patentee has in general to pay the applicant's costs, unless the patentee, on being notified of the application, agrees not to oppose it (*o*). If the patentee succeeds the Comptroller or the Court may take into account in awarding costs the fact that at the date of the application there were reasonable grounds therefor (*p*). If the applicant, or in the case of an appeal the appellant, neither resides nor carries on business in the United Kingdom, the Comptroller may order him to give security for costs (*q*).

Procedure in High Court.

The ground of non-working can be raised in proceedings in the High Court either in a petition presented to the Court or as a ground of defence to an action (*r*). It would seem that where revocation of the patent is sought the Court would have the Comptroller's power to make a conditional order (*s*).

(*l*) Sect. 27 (4). See p. 283.

(*m*) The question arose in *Boult's Patent*, 26 R. P. C. 424, but was not decided.

(*n*) Sect. 39 (1). The Court may award a successful appellant costs before the comptroller. This was done in *Taylor's Patent*, 29 R. P. C. 296, and errata in same volume.

(*o*) See notice in Official Journal of 28th April, 1909, and *Taylor's Patent*, 26 R. P. C. 381.

(*p*) *Boult's Patent*, 26 R. P. C. 388 (no costs); *Osborne's Patent*, 26 R. P. C. 822 (modified costs given); *Jottrand's Patent*, 26 R. P. C. 834 (modified costs given).

In *Weber's Patent*, 26 R. P. C. 300,

27 R. P. C. 30, where an order was made that the patent should be revoked unless manufacture was established within a certain time, no costs were given.

In *Bremer's Patent* and *Hügner's Patent*, 26 R. P. C. 449, where the patentee succeeded on appeal, but had to get leave to introduce new evidence, the comptroller's order giving the applicant's costs was allowed to stand, and no costs were given in the appeal, except that the Attorney-General's costs were ordered to be borne by the parties equally.

(*q*) Sect. 39 (2).

(*r*) Sect. 25. See p. 174, and p. 213.

(*s*) O. 53a, r. 8.

CHAPTER XVII

PROLONGATION OF LETTERS PATENT

A PATENTEE may, in the manner provided by the Act and Rules, apply to the Court for an extension of the Letters Patent, on the ground that he has been inadequately remunerated by his patent (a). The Court here exercises the jurisdiction formerly possessed by the Judicial Committee of the Privy Council, and will doubtless in general be governed by the same considerations as influenced this body (b). Grounds for application.

The exercise of this power is a matter of grace. While, therefore, there are certain points which it is incumbent on the petitioner to establish, before the Court will feel itself entitled to act, the latter may be influenced by considerations which may be material to the particular case but which cannot be limited or defined generally (c).

The three points that it is essential for the applicant for an extension to prove are :— Essential matters.

1. That the invention in question is of real merit and utility to the public.

2. That there has been insufficient remuneration for such invention.

3. That such insufficiency of remuneration is not due to any lack of efforts on the part of those who have from time to time held the patent (d).

(a) See s. 18 and O. 53a, r. 3.

(b) The former Acts dealing with this subject were: 5 & 6 Will. IV. c. 83; 7 & 8 Vict. c. 69; 15 & 16 Vict. c. 83; 46 & 47 Vict. c. 57, s. 25.

In substance their provisions were identical with those of the present Act. Cf. *Newton's Patent* (1884), 9 A. C. 592.

(c) Sect. 18 (4), "a discretion influenced by every such circumstance

as would properly weigh on a sensible and considerate person in determining whether an extraordinary privilege, not of strict right, but rather of equitable reward should be conferred." *Hill's Patent* (1863), 1 Moo. (N. S.), at p. 265. See also p. 315.

(d) Of these points only the second is directly laid down by the Act (see s. 18 (5)), but the others have always been recognised as essential for success.

Merit.

The merit of the invention is primarily its value to the public, rather than the amount of ingenuity involved in it (*e*), *i.e.* what must be looked at are the comparative advantages the world enjoyed before and after the patentee's disclosure of his invention (*f*). The tribunal has always taken the view that before it will investigate other points it must be satisfied that the invention possesses such practical utility in a high degree (*g*). In judging of this attention has to be paid both to the quantum of the improvement and the generality of its application (*h*). Hence patents for inventions which confer a general advantage, *e.g.* which lead to an improvement relating to public health, safety or comfort (*i*), or which produce some new substance of general usefulness (*k*), are in a particularly favourable position when renewal is sought. Such patents, however, are necessarily only a small proportion of the whole,

(*e*) *Bell's Patent* (1862), 1 Moo. (N. S.) 61.

"The consideration which supports the grant of the monopoly granted by Letters Patent being, in fact, the disclosure of something of value to the public, it is only where this value largely exceeds the benefit derived by the patentee from his invention that the patentee can be said to have been inadequately remunerated." *Johnson's Patent*, 25 R. P. C., *per* PARKER, J., at p. 723.

"(The inventor) has received not more than £5000 or £6000 for a discovery which has actually conferred upon the country the benefit of millions, and which opens a source of national wealth and trade to which you can put no limit." *Kay's Patent* (1839), W. P. C. 572.

(*f*) The same rule applies as in other branches of Patent Law that the former knowledge must be considered without the light thrown on it by the later invention. *Cf.* p. 62.

(*g*) See *Saxby's Patent* (1870), 7 Moo. (N. S.) 82; *Stewart's Patent*, 3 R. P. C. 10; *Stoney's Patent*, 5 R. P. C. 518. *Cf.* also *Scott's Patent*, 23 R. P. C. 480.

"It must be something more than the fact of it being a good patent, and there must be some character of public interest established in the patent and its usefulness."

It is difficult, however, to see why the invention there in question did not satisfy this criterion.

See also as to what degree of merit is sufficient. *McCulloch's Patent*, 25 R. P. C. 692, O. H.; *Thorneycroft's Patent*, 16 R. P. C. 203. Unless evidence of merit is given the petition will be dismissed. *Kelly's Patent*, 17 R. P. C. 476.

(*h*) It must be noted that merit alone is here considered. The fact that the application of the invention is limited may help on other points. See p. 308, *n.* (*t*).

(*i*) Among cases of this class are:—

Foard's Patent (1855), 9 Moo. 356 (consumption of smoke); *Herbert's Patent* (1867), 4 Moo. (N. S.) 300 (light buoys); *Bischoff's Patent*, 1 R. P. C. 163 (purification of water); *Shone's Patent*, 9 R. P. C. 438 (drainage); *Lyon's Patent*, 11 R. P. C. 537 (disinfectant); *Currie and Timmis's Patent*, 15 R. P. C. 63 (railway signals); *Hart's Patent*, 25 R. P. C. 299 (improvements in ventilation chiefly of use in weaving factories); *McCulloch's Patent*, 25 R. P. C. 684, O. H. (treatment of sewage).

The fact that the invention is the only one that will enable persons to satisfy a statutory requirement is no reason for refusal of extension. *Foard's Patent, supra*; *Hart's Patent, supra*.

But it may be a reason for imposing terms as to licences. *Hart's Patent, supra*.

(*k*) *Cf.* *Cross, Beavan and Beadle's Patent*, 23 R. P. C. 485.

and in most cases a benefit to some particular trade is all that can be shown, though here generally the improvement made should be greater than would be necessary in the first class. It is very doubtful whether a patent would be extended if the only result achieved was one of no real utility, *e.g.* a new form of toy.

Although all that must be proved to establish merit is that the public have derived real benefit from the disclosure of the new invention, yet the Court considers that the degree of merit may depend on other circumstances. Thus it has been said that an invention only arrived at by experiment or research should receive more favourable consideration than one which was the result of a mere happy thought (*l*), and that an original inventor has more merit than the importer of something well known abroad (*m*). Again, it has often been given as a reason for refusal that the step made by the patentee was only a very small one in view of the prior knowledge (*n*), while on the other hand the fact that the invention involves the introduction, or first application, of a new principle is held to increase the merit (*o*).

The merit of the invention has to be judged by what is disclosed by the specification. If a further invention is needed to make the earlier one really useful, this diminishes merit (*p*), but the fact that new uses are found later does not have this effect but, on the other hand, may afford an additional reason for extension (*q*).

(*l*) *Cf. Poole's Patent* (1867), 4 Moo. (N. S.) 452; *Hill's Patent* (1863), 1 Moo. (N. S.) 258; *Johnson's Patent* (1871), 8 Moo. (N. S.) 282. But *cf. contra, Bell's Patent* (1862), 1 Moo. (N. S.) 49; *McCulloch's Patent*, 25 R. P. C. 684, O. H.

(*m*) *Claridge's Patent* (1851), 7 Moo. 394; *Soame's Patent* (1843), W. P. C. 729.

Where, however, the invention was new abroad, the importer, even if a mere conduit pipe, has the full merits of the inventor. *Cf. Claridge's Patent, supra*; *Berry's Patent* (1850), 7 Moo. 187; *Hutchinson's Patent* (1861), 14 Moo. 364, and in such case it is the foreign inventor's remuneration that is considered. *Peach's Patent*, 19 R. P. C. 658.

(*n*) *Wield's Patent* (1871), 8 Moo. (N. S.) 300. See also *Morgan's Patent* (1843), W. P. C. 737; *Lancaster's Patent* (1864), 2 Moo. (N. S.)

189; *Van Gelder's Patent*, 24 R. P. C. 169; *Johnson's Patent*, 25 R. P. C. 723.

But mere simplicity does not decrease merit. *Muntz's Patent* (1846), 2 W. P. C. 113; *Hazlands' Patent*, 11 R. P. C. 467. See also *Soame's Patent* (1843), W. P. C. 729; *Bell's Patent* (1862), 1 Moo. (N. S.) 49.

And a very small step may be sufficient if it is a *sine qua non* for success. *Johnson's Patent*, 25 R. P. C. 724.

(*o*) *Carr's Patent* (1873), 9 Moo. (N. S.) 379; *Stoney's Patent*, 5 R. P. C. 518.

(*p*) *Woodcroft's Patent* (1846), 2 W. P. C. 18; *Wield's Patent* (1871), 8 Moo. (N. S.) 300; *Bell's Patent* (1846), 2 W. P. C. 159; *Norton's Patent* (1863), 1 Moo. (N. S.) 339. See also *Woodcroft's Patent* (1841), W. P. C. 740.

(*q*) *Cf. Fountain Livets Patent*, 9 R. P. C. 327; *Woodcroft's Patent*,

Remunera-
tion.

Whether the remuneration of the patentee has been sufficient in view of the merit of the invention is clearly a pure question of fact (*r*). Sometimes a measure of the material or monetary advantages to the public can be arrived at which will give assistance (*s*), but in general the patentee relies in whole or in part on indirect evidence, *i.e.* he shows that certain causes have retarded the adoption of his invention and asks the tribunal to infer from this that he has not got the remuneration he deserves. These causes may in some cases be inherent in the invention, *i.e.* the invention may be one for which, although its utility may be great, there is only a very limited demand (*t*), or one which can only be adopted by displacing existing installations (*u*), or they may be accidental, *e.g.* want of funds (*x*), opposition of trade, etc. (*y*).

The profits of
all parties to
be considered.

The Act directs the Court to consider the profits of "the patentee as such" (*z*). This expresses the old practice which was to consider what profit has been made from the patent, and not what the inventor or the petitioner alone had received (*a*). It is therefore necessary to discover what have been the profits or losses of the various holders of the patent right (*b*), and in

supra; *cf.* also *McDougall's Patent* (1867), 5 Moo. (N. S.) 1; *McInne's Patent* (1868), 5 Moo. (N. S.) 72. Nor do improvements made by the patentee. *Galloway's Patent* (1843), W. P. C. 724; *Southby's Patent*, 8 R. P. C. 433, but see *contra*, *Nussey's Patent*, 7 R. P. C. 25.

(*r*) The largest remuneration in any case of prolongation was £20,000 (*Bett's Patent* (1864), 1 Moo. (N. S.) 49). In *Thomas's Patent*, 9 R. P. C. 372, the P. C. seemed to doubt whether under any circumstances £250,000 could be insufficient.

(*s*) *E.g.* *Kay's Patent*, see p. 306, *n.* (*e*); *Joy's Patent*, 10 R. P. C. 89.

(*t*) *E.g.* *Stoney's Patent*, 5 R. P. C. 518; *McCulloch's Patent*, 25 R. P. C. 684, O. H.

(*u*) *E.g.* *McCulloch's Patent*, *supra*; *Carr's Patent* (1873), 9 Moo. (N. S.) 379; *Bate's Patent* (1836), W. P. C. 739. See also *Errard's Patent* (1835), W. P. C. 557 (need of instructing workmen); *Newton's Patent* (1861), 14 Moo. 156 (expense of articles); *Smith's Patent*, 2 R. P. C. 14 (increased first cost); *Thompson's Patent*, 19 R. P. C. 565 (need of experiments); *Currie's Patent*, 15 R. P. C. 63 (railway signals); *Cross, Bevan & Beadle's*

Patent, 23 R. P. C. 485 (need of finding uses for new material).

(*x*) *E.g.* *Wright's Patent* (1839), W. P. C. 575.

(*y*) *Errard's Patent*, *supra*; *Southworth's Patent* (1837), W. P. C. 486; *Stafford's Patent* (1838), W. P. C. 563; *Robert's Patent* (1839), W. P. C. 573; *Jones's Patent* (1840), W. P. C. 577; *Cocking's Patent*, 2 R. P. C. 151; for other cases see *Swaine's Patent* (1837), W. P. C. 559 (difficulty in locating works); *Wright's Patent*, *supra* (need for perfecting other machinery); *Jones's Patent* (1840), W. P. C. 577 (need for experiments as to best form); *Napier's Patent* (1861), 13 Moo. 543 (disturbance in labour market); *Roper's Patent*, 4 R. P. C. 201 (illness of patentee); *Darby's Patent*, 8 R. P. C. 380 (difficulties in manufacture and agricultural depression).

(*z*) Sect. 18(4). These words were also in the 1833 Act, but not in the 1837 Act.

(*a*) *Cf.* *Trotman's Patent* (1860), 3 Moo. (N. S.) 494.

(*b*) *Cf.* *Trotman's Patent*, *supra*; *Barff's Patent*, 12 R. P. C. 383; *Car-mont's Patent*, 14 R. P. C. 239, and cases at p. 311, *n.* (*m*).

some cases it may also be proper to include the profits made by licencees (c).

A question which frequently arises is how far are the profits made from foreign patents to be taken into consideration. These clearly do not come within the words, "the profits of the patentee as such," and in the earlier days it was held that the question of whether profits had been made from other patents was irrelevant (d). But later a contrary view has prevailed in that it has been held that the fact of profits having been made, either by the petitioner or others, from such foreign patents, is a material fact which may influence the tribunal in the exercise of its discretion (e).

Profits from foreign patents.

The accounts must be presented in such a form that the Court can determine with certainty what remuneration has been received (f), and it is the duty of a patentee to keep from the first records that will enable him to fulfil these requirements (g).

Accounts.

(c) *T-Aman's Patent*, *supra*. See also *Shone's Patent*, 9 R. P. C. 438; *Fvness's Patent*, 2 R. P. C. 175; *Bernland's Patent*, 4 R. P. C. 489; *Thomas's Patents*, 9 R. P. C. 371, 373.

On the other hand in *Cross, Bevan & Beadle's Patent*, 23 R. P. C. 491, the view seemed to be taken that the gains and losses of licensees were irrelevant. Probably the question depends on the facts of each case. Cf. *Thomas's Patent*, *supra*. If an exclusive licence has been granted so that the licensee was practically an assignee (*Shone's Patent*, 9 R. P. C. 440), or if the patent was worked through a company in which the petitioner was interested, it would probably be held that the licensee's profits should be brought into account. If on the other hand the licences were offered generally, and taken by independent persons, then they would probably be excluded. Where the licensee is a petitioner they should be stated.

(d) *Poole's Patent* (1867), 4 Moo. (N. S.) 456.

(e) *Johnson's Patent* (1871), 8 Moo. (N. S.) 282; *Pitman's Patent* (1871), 8 Moo. (N. S.) 293; *Adair's Patent* (1881), 6 A. C. 176; *Newton's Patent* (1884), 9 A. C. 592; *Thomas's Patent*, 9 R. P. C. 372; *Barff's Patent*, 12 R. P. C. 383; *Willans & Robinson's Patent*, 13 R. P. C. 550; *Johnson's Patent*, 25 R. P. C. 727.

This applies even where the

petitioners have no interest in such patents. *Peach's Patent*, 19 R. P. C. 65; *Newton's Patent*, 1 R. P. C. 177.

The estimated profits up to the expiry of such foreign patents will be considered. *Johnson's Patent*, *supra*.

(f) The practice of the P. C. on this point in recent times was extremely severe to the petitioner. Whereas in the earlier cases every opportunity was given for the accounts to be supplemented or explained (see *inter alia* *Heath's Patent* (1853), 2 W. P. C. 257; *Markwick's Patent* (1860), 13 Moo. 310), in the later ones it was considered a sufficient reason for rejection that the accounts were incomplete, or in an unsatisfactory form, and no adjournment would be granted to repair this (e.g. *Yate's Patent*, 4 R. P. C. 140; *Peach's Patent*, 19 R. P. C. 65). The new rules provide for the accounts being investigated by an expert (see p. 318, n. (i)), and it is probable that there will be a return to the early practice in that the petitioner will be assisted by having any defects pointed out to him while it is possible to repair them, and that the rule as to accounts will be considered in view of its real object, viz. that the Court should be satisfied that the remuneration is insufficient (cf. *Darby's Patent*, 8 R. P. C. 380).

(g) *Bell's Patent* (1862), 1 Moo. (N. S.) 49; *Adair's Patent* (1881), 6 A. C. 176; *Duncan & Wilson's Patent*, 1 R. P. C. 257; *Lake's Patent*, 8

These accounts should show the whole of the receipts and outgoings in respect to the patent in question, distinguishing these as far as possible from those connected with other branches of his business (*h*).

The necessity for accuracy and clearness in these accounts has always been very strictly insisted on. It is for the petitioner to present the accounts in a form showing the remuneration and not for the Court to endeavour to disentangle the relevant figures (*i*). Accounts based on mere estimates of receipts and expenditure will usually be rejected (*k*).

Where the accounts appear unsatisfactory this point may be considered by the Court before other questions are gone into (*l*).

The accounts of receipts should include all receipts from

R. P. C. 227; *Hughes's Patent*, 15 R. P. C. 370; *Clark's Patent*, 16 R. P. C. 433; *Henderson's Patent*, 18 R. P. C. 449; *Lawrence & Kennedy's Patent*, 27 R. P. C. 252, O. H. (but in some cases absence of special account may be excused, *ibid*). And see *Lowe's Patent* (1846), 10 Jur. 363, where a prolongation was granted, although no accounts had been kept.

(*h*) Cf. *Bell's Patent*, *supra*.

(*i*) See *Saxby's Patent* (1870), 7 Moo. (N. S.) 82; *Willans & Robinson's Patent*, 13 R. P. C. 550; *Peach's Patent*, *supra*; *Lawrence & Kennedy's Patent*, *supra*.

The accounts of subsidiary patents should be kept distinct. *Willans & Robinson's Patent*, *supra*; *McClellan's Patent*, 15 R. P. C. 418; *Clark's Patent*, *supra*. This rule is occasionally relaxed, especially where the confusion is due to a *bona fide* attempt to give all information, cf. *Cross, Beavan & Beadle's Patent*, 23 R. P. C. 485, or where the fact of a loss is clear, *Darby's Patent*, 8 R. P. C. 380; or the invention is of exceptional merit. *Parson's Patent*, 15 R. P. C. 349. On the other hand, where the profits are very large the accounts should be exceptionally clear. *Thomas's Patent*, 9 R. P. C. 372.

Even where the accounts are honestly kept and honestly presented the petition may be refused if it is not possible to determine the remuneration. *Wuterich's Patent*, 20 R. P. C. 285; but cf. *Parson's Patent*, *supra*.

Where part only of the patent is of sufficient merit to warrant a renewal, the accounts should show the profits derived from this part separately. *Willacy's Patent*, 5 R. P. C. 690.

Semble there may be cases where the Court will unravel accounts. *Lake's Patent*, *supra*. See also *Parson's Patent*, *supra*, in which case the P. C. estimated the patentee's profit for themselves.

(*k*) *Bell's Patent*, *supra*; *Clark's Patent* (1870), 7 Moo. (N. S.) 255; *Lake's Patent*, *supra*; *Hughes's Patent*, *supra*; *Lawrence & Kennedy's Patent*, *supra*.

In *Saxby's Patent*, *supra*, the addition of a percentage on prime cost for establishment charges, expenses of fitting, etc., was objected to. But in cases of large businesses it is difficult to see how this method can be avoided.

In *Thomas's Patent*, 9 R. P. C. 367, the P. C. were not prepared to say that a lump sum for salaries, rent, etc., rendered the accounts insufficient.

As to cases where an estimated price is inserted for articles made for the patentees themselves, see *Thornycroft's Patent*, 16 R. P. C. 203.

(*l*) *Saxby's Patent*, *supra*; *Wield's Patent* (1871), 8 Moo. (N. S.) 300; *Lake's Patent*, *supra*.

But this course will not be followed unless the accounts are obviously unsatisfactory. *Houghton's Patent* (1870), 7 Moo. (N. S.) 309.

the invention, whether by the petitioner or others (*m*), and whether from the British or foreign patents (*n*).

It now seems clear that manufacturers' profits must be included (*o*), but fair charges for use of capital, etc., may be debited (*p*). In arriving at the remuneration received by the patentee as such the petitioner is generally allowed to make a deduction for the time given by the patentee to bringing the invention into use (*q*), but such allowance must be claimed in the petition or accounts (*r*). Various other expenses, such as expenses of experiments (*s*), law costs (*t*), commissions, etc. (*u*),

(*m*) See p. 308. A statement should be made of the amounts to be received under unexpired contracts. *Hill's Patent* (1863), 1 Moo. (N. S.) 158.

Remuneration to the patentee as director, etc., of a company working the patent should be included. *McClellan's Patent*, 15 R. P. C. 418.

Of course accounts of assignee companies should be included, though in *Deacon's Patent*, 4 R. P. C. 119, their absence was excused.

So profits of any person who is in the position of a partner should be shown. *Cf. Pieper's Patent*, 12 R. P. C. 295.

Where there is no evidence of the real value of shares these will be taken at face value. *Parson's Patent*, 15 R. P. C. 359; *cf. Carmont's Patent*, 14 R. P. C. 239.

(*n*) See p. 309.

(*o*) *Galloway's Patent* (1843), W. P. C. 729; *Muntz's Patent* (1846), 2 W. P. C. 113; *Hill's Patent* (1863), 1 Moo. (N. S.) 258; *Saxby's Patent* (1870), 7 Moo. (N. S.) 82; *Johnson's Patent* (1871), 8 Moo. (N. S.) 282; *Thomas's Patents*, 9 R. P. C. 307.

In *Bell's Patent* (1862), 1 Moo. (N. S.) 49, *semble* (from the headnote), these profits were excluded.

In *Duncan & Wilson's Patent*, 1 R. P. C. 257, the question was also considered, and the Court seemed to think that some proportion of the total profits might be excluded as the manufacturer's share, but that two-thirds was too much. *Semble*, some sum may in certain cases be deducted for patentee's profit as salesman. *Bailey's Patent*, 1 R. P. C. 1.

In *Saxby's Patent*, *supra*, it was said that even increase of business in other directions due to the patent business should be brought into account.

(*p*) *Soames' Patent* (1843), W. P. C.

729; *Perkin's Patent* (1845), 2 W. P. C. 6; *Hill's Patent* (1863), 1 Moo. (N. S.) 258; *Davies' Patent*, 11 R. P. C. 27; *Parson's Patent*, 15 R. P. C. 439.

(*q*) For cases where such deductions were allowed, see *Perkin's Patent* (1845), 2 W. P. C. 6 (£400 per annum); *Carr's Patent* (1873), 9 Moo. (N. S.) 379 (£400 p.a.); *Cocking's Patent*, 2 R. P. C. 151 (£300 p.a.); *Joy's Patent*, 10 R. P. C. 89 (£400 p.a.); *Hazeland's Patent*, 11 R. P. C. 467 (£117 p.a.). See also *Newton's Patent* (1861), 14 Moo. 156.

But such allowance will only be made when the patentee has really given his time. *Wield's Patent* (1871), 8 Moo. (N. S.) 300; *Furness's Patent*, 2 R. P. C. 173.

The claims under this head should not be exaggerated, *Clark's Patent* (1870), 7 Moo. (N. S.) 255, and it must be remembered that the patentee's efforts may bring future business, *ibid.* See also *Trotman's Patent* (1866), 3 Moo. (N. S.) 488.

There is no case where allowance has been made for time in experimenting before the patent was taken out, but this comes into account indirectly, see p. 307.

(*r*) *Bailey's Patent*, 1 R. P. C. 1.

(*s*) See *inter alia*, *Davies' Patent*, 11 R. P. C. 27.

(*t*) See *inter alia*, *Bell's Patent* (1862), 1 Moo. (N. S.) 49, but not costs of unsuccessful litigation, *ibid.* The costs of different suits should in general be shown separately, *ibid.*

For cases where such costs were disallowed on the ground that the litigation was not really connected with the patent in question, see *Saxby's Patent* (1870), 7 Moo. (N. S.) 82; *McClellan's Patent*, 15 R. P. C. 418.

(*u*) *Poole's Patent* (1867), 4 Moo. (N. S.) 452; *Davies' Patent*, 11 R. P. C. 27. But *cf. Pieper's Patent*, 12 R. P. C. 295.

have been allowed in different cases, and it is submitted that in general any expenses which a prudent man would have incurred for the purpose of obtaining the maximum profit should be allowed (*x*).

Efforts of
patentee.

The petitioner has to show that he and others who have or have had interests in the patent have used their best endeavours to bring it into use, and no extension will be granted unless this is the case (*y*).

An increased
demand
should be
shown.

The most favourable case for the petitioner is where the demand for the invention has increased in the later years of the patent. If there has been no practical user of the invention at all this affords a very strong presumption that it is of no great utility (*z*), and cogent evidence to the contrary effect is needed to rebut this presumption (*a*). But if there has been a growing demand for the invention this enables the petitioner to demonstrate its utility, and at the same time affords a probability that a moderate extension will enable the inventor to reap his reward (*b*).

Validity not
considered.

If it is clear to the Court that the patent is invalid no extension will be granted (*c*), at any rate of the invalid portion, but the Court will not decide on a question of doubtful validity (*d*), but will, where the patentee makes out a *prima facie*

(*x*) In *Lawrence & Kennedy's Patent*, 27 R. P. C. 252, O. H., it was doubted whether the sums spent in buying up other patents could be debited. It is submitted that if such purchases were really necessary to develop the manufacture the expenses of their acquisition can properly be taken into account.

(*y*) *Dolbear's Patent*, 13 R. P. C. 203; *Van Gelder's Patent*, 24 R. P. C. 169; *Paterson's Patent* (1845), 6 Moo. (N. S.) 469.

It is specially incumbent where the invention has been taken up abroad for the petitioner to show that efforts were made to get British manufacturers to adopt it. *Johnson's Patent*, 25 R. P. C. 709; cf. also *Henderson's Patent*, 18 R. P. C. 449; *Pieper's Patent*, 12 R. P. C. 295.

Semble in general the Court disapprove of agreements for exclusive use unless they are satisfied that this was the only way to get the invention adopted at all; *Darby's Patent*, 8 R. P. C. 384, see also p. 319, *n.* (*n*).

(*z*) *Bakewell's Patent* (1862), 15 Moo. 385; *Herbert's Patent* (1867), 4

Moo. (N. S.) 300; *Allan's Patent* (1867), 4 Moo. (N. S.) 443 (cases considered); *Hughes' Patent* (1879), 4 A. C. 174.

(*a*) For cases where this presumption has been rebutted, see *inter alia*. *Herbert's Patent*, *supra*, *Hughes' Patent*, *supra*, and cases referred to therein. *Roper's Patent*, 4 R. P. C. 201; *Southby's Patent*, 8 R. P. C. 433.

(*b*) *Stoney's Patent*, 5 R. P. C. 518; *Church's Patents*, 3 R. P. C. 95. Cf. also *Robert's Patent* (1839), W. P. C. 573.

The fact that there is no probability of benefit from the extension has been made the ground of refusal, e.g. in *Scott's Patent*, 23 R. P. C. 478; *Pinkus's Patent* (1843), 12 Jur. 233.

But even where there is a falling off of profits in the later years the Court will consider other evidence of a probability of increase. *Church's Patents*, 3 R. P. C. 95.

(*c*) *Woodcroft's Patent* (1846), 2 W. P. C. 18; *Bell's Patent* (1862), 1 Moo. (N. S.) 49.

(*d*) The question of prolongation where some claims are invalid has

case on this point, grant an extension (if other circumstances warrant this), and leave the question of validity to be decided in the ordinary way (e). This applies even where a Court has held the patent to be bad if the decision is under appeal (f).

In the earlier decisions extensions were granted to an assignee with practically the same freedom as to the original inventor, the tribunal taking the view that it was for the benefit both of inventor and the public that there should be the prospect of a proper reward for those persons who had assisted the inventor to develop the new manufacture (g).

Later it was said that the merit of an assignee was less than that of an inventor (h), and this doctrine was developed until it became practically impossible for a mere assignee to get an extension, unless the inventor still had some interest in the patent (i).

never been decided. *Burlingham's Patent*, 15 R. P. C. 195; but cf. *Simister's Patent* (1842), W. P. C. 721.

(e) *Kay's Patent* (1839), W. P. C. 568; *Woodcroft's Patent*, supra; *Pinkus's Patent* (1848), 12 Jur. 233; *Heath's Patent* (1853), 2 W. P. C. 257; *Bell's Patent*, supra; *Hill's Patent* (1863), 1 Moo. (N. S.) 258; *Lancaster's Patent* (1864), 2 Moo. (N. S.) 189; *Cocking's Patent*, 2 R. P. C. 151; *Stewart's Patent*, 3 R. P. C. 7; *Church's Patents*, 3 R. P. C. 95; *Johnson's Patent*, 25 R. P. C. 709.

In *Lyon's Patent*, 11 R. P. C. 539, unsuccessful defendants were allowed to produce new instances of prior user.

(f) *Lane Fox's Patent*, 9 R. P. C. 411; *Kay's Patent* (1837), W. P. C. 568.

In *Heath's Patent*, supra, also an extension was granted, although there was *lis pendens*.

(g) *Southworth's Patent* (1837), W. P. C. 486; *Wright's Patent* (1837), W. P. C. 561; *Jones's Patent* (1840), W. P. C. 577; *Galloway's Patent* (1843), W. P. C. 727; *Morgan's Patent* (1843), W. P. C. 737; *Woodcroft's Patent* (1846), 2 W. P. C. 18; *Porter's Patent* (1852), 2 W. P. C. 196; *Whitehouse's Patent* (1838), W. P. C. 473; *Markwick's Patent* (1860), 13 Moo. 310; *Napier's Patent* (1861), 13 Moo. 543; *Hutchinson's Patent* (1861), 14 Moo. 364; *Davies' Patent*, 11 R. P. C. 27; *McCulloch's Patent*, 25 R. P. C. 684, O. H.

Webster states that out of the first

seventeen extensions six were to assignees, and one was to an executrix (W. P. C. 725, n.).

(h) *Norton's Patent* (1853), 1 Moo. (N. S.) 339; cf. also *Normand's Patent* (1870), 6 Moo. (N. S.) 477; *Pitman's Patent* (1871), 8 Moo. (N. S.) 293; *Hopkinson's Patent*, 14 R. P. C. 5.

In *Claridge's Patents* (1851), 7 Moo. 394, it was said that whatever the assignee had done, all that could be considered was the merits of the original inventor (see also *Norton's Patent*, supra).

(i) In *Van Gelder's Patent*, 24 R. P. C. 169, it was said that there was no instance of a prolongation where the original inventor was dead and would have obtained no advantage were he alive; cf. also *Banff and Bower's Patent*, 12 R. P. C. 383; *Finch's Patent*, 15 R. P. C. 674. It is impossible to say whether or not this is so, but certainly there are precedents for granting extensions from which the original inventor could get no advantage, e.g. *Bodmer's Patent* (1849), 6 Moo. 468; *Galloway's Patent* (1843), W. P. C. 724.

In *McCulloch's Patent*, 25 R. P. C. 684, O. H., the Court refused to recognise this rule.

Where the assignee is a company in which the inventor has a large number of shares, the tribunal has been more favourable. See *Napier's Patent* (1861), 13 Moo. 543; *Houghton's Patent* (1871), 7 Moo. (N. S.) 309; *Bischoff's Patent*, 1 R. P. C. 62; *Church's Patents*, 3 R. P. C. 95;

It would certainly seem more advantageous to adopt to some extent the earlier practice, more particularly in the case of assignees who have really assisted in developing the manufacture, and have not merely come on the scene when the latter was in commercial existence (*k*).

The Court frequently makes it a term of extension that some payment shall be made to the original inventor or an interest in the renewed patent given to him (*l*).

Lapsing of
foreign
patents.

Another point which has frequently influenced the tribunal against granting an extension is that there have been foreign patents taken out which have lapsed or are on the point of lapsing (*m*). In recent times it has been said that this fact is of importance because British manufacturers would be prejudiced if the British patent were prolonged after the foreign ones had expired, since they would have to pay royalties, while foreigners would not (*n*). If this line of reasoning were followed out it would lead to the refusal of extension in all cases, since persons outside the realm are equally free to make without licence whether there have been foreign patents which have expired, or whether there never have been such patents at all. The objection originally arose in connection with a statutory provision that in certain cases British patents expired with foreign grants for the same invention (*o*), and it is submitted

Deacon's Patents, 4 R. P. C. 119; *Shone's Patent*, 9 R. P. C. 438; *Davies' Patent*, 11 R. P. C. 27; *Cross, Bevan, and Beadle's Patent*, 23 R. P. C. 485; *McCulloch's Patent*, 25 R. P. C. 684, O. H.

In *Clark's Patent*, 16 R. P. C. 431, where the inventor only held 6½ per cent. of the shares, this proportion was considered too small, and prolongation was refused.

In *Cocking's Patent*, 2 R. P. C. 151, an extension was granted to an inventor to whom the patent had been reassigned.

(*k*) Cf. *McCulloch's Patent*, *supra*; *Pitman's Patent*, *supra*; *Hopkinson's Patent*, 14 R. P. C. 5; *Henderson's Patent*, 18 R. P. C. 449; *Sellar's Patent* (1882), Goodeve, 581, in all of which the difference in position between assignees who have assisted in developing the invention and those who have bought as a commercial speculation was insisted on. But the decisions against assignees have extended to both classes. Cf. *Van*

Gelder's Patent, *supra*. See also *Quarrill's Patent* (1840), W. P. C. 740.

(*l*) e.g. *Whitthouse's Patent* (1838), W. P. C. 473 (£500 per annum to inventor); *Hardy's Patent* (1849), 6 Moo. 441 (£5000 to be paid to inventor); *Markwick's Patent* (1860), 13 Moo. 310 (annuity to inventor); *McCulloch's Patent*, 25 R. P. C. 684, O. H. (shares in company in place of proportion of profit).

Sometimes, however, the grant is made without the inventor having any interest, e.g. *Bodmer's Patent* (1849), 6 Moo. 460.

(*m*) *Norman's Patent* (1870), 6 Moo. (N. S.) 477; *Pieper's Patent*, 12 R. P. C. 295; *Henderson's Patent*, 18 R. P. C. 449.

(*n*) E.g. *Semet and Solvay's Patent*, 12 R. P. C. 10.

(*o*) This statute was 5 & 6 Will. IV. c. 83, and for discussions on its effect, see *Newton's Patent* (1862), 15 Moo. 176 (grant refused); *Blake's Patent* (1873), 9 Moo. (N. S.) 373 (grant

that it should not be considered as applicable to modern conditions (*p*).

Amongst other points which have influenced the tribunal against prolongation the following may be noted. The failure to disclose in the specification details essential to success (*q*), the fact that a prolongation would limit the use of an improvement patent (*r*), or an article useful for the public health (*s*), the conduct of the patentee in sleeping on his rights (*t*), or in keeping an invalid claim in his patent (*u*), in granting an exclusive licence (*x*), in supplying the demand in this country by importation (*y*) or in making statements as to the patent profits in a prospectus inconsistent with those in the petition (*z*), and Stock Exchange transactions in the shares of the assignee company (*a*). On the other hand the Court have been influenced in the petitioner's favour by the amount of energy he has shown in working to introduce the invention and in making improvements (*b*), and by the fact that he had been continually harassed by litigation (*c*). The Court will not consider an

Other points
influencing
the Court.

refused); *Bell's Patent* (1862), 1 Moo. (N. S.) 49 (grant allowed).

For other cases where subject has been discussed, see cases in *n*. (*m*) and *Johnson's Patent* (1871), 8 Moo. (N. S.) 282 (foreign patents not to prejudice British patentee *secus* if patentee has foreign domicile); *Poole's Patent* (1867), 4 Moo. (N. S.) 452; *Adair's Patent* (1881), 6 A. C. 176; *Darby's Patent*, 8 R. P. C. 384; *Shone's Patent*, 9 R. P. C. 438; *Parson's Patent*, 15 R. P. C. 439; *Thompson's Patent*, 19 R. P. C. 565, in all of which cases it was held that the fact that the foreign patents had expired, or were about to expire, did not prevent prolongation being granted.

This objection should be supported by proper evidence that British manufacturers would be unfairly handicapped by an extension. *Johnson's Patent*, 25 R. P. C. 709.

(*p*) Where, however, the patentee has allowed the foreign patents to lapse, *e.g.* by non-payment of fees, this may in some cases be fairly counted against him, either as showing that he has not made full use of his advantages, or that he has allowed British manufacturers to be handicapped, if there is any evidence that this has, in fact, occurred. In *Norden's Patent* (1872), 8 Moo. (N. S.) 306, the

fact that foreign patents had been allowed to lapse was held a bar to extension.

(*q*) *Fountain Livet's Patent*, 9 R. P. C. 327.

(*r*) *Norton's Patent* (1861), 1 Moo. (N. S.) 339.

(*s*) *McDougall's Patent* (1867), 5 Moo. (N. S.) 1; *Sillar's Patent* (1882), Goodeve, 581; *cf. contra, Foadre's Patent* (1855), 9 Moo. 376; *Hart's Patent*, 25 R. P. C. 299.

(*t*) *Simister's Patent* (1842), W. P. C. 721; *Pinkus's Patent* (1848), 12 Jur. 233; *cf. also Lodge's Patent*, 28 R. P. C. 379.

(*u*) *Simister's Patent, supra*.

(*x*) *Cardwell's Patent* (1856), 10 Moo. 488; see also *Darby's Patent*, 8 R. P. C. 384.

This, however, is often dealt with by making it a condition that the exclusive licence should be abandoned. See p. 319, *n*. (*r*).

(*y*) *Johnson's Patent* (1871), 8 Moo. (N. S.) 282.

(*z*) *Lawrence's Patent*, 9 R. P. C. 89.

(*a*) *Sillar's Patent* (1882), Goodeve, 581.

(*b*) *Southey's Patent*, 8 R. P. C. 433; *Trotman's Patent* (1866), 3 Moo. (N. S.) 488.

(*c*) *Heath's Patent* (1853), 2 W. P. C. 257.

allegation that the patent is invalid because fees were paid too late (*d*).

Uberrima fides.

The petitioner is bound to set before the Court fully and fairly all circumstances which might influence their decision (*e*). These include the history of the invention (*f*) (including any prior patents of a like kind taken out by the patentee (*g*)), the prior state of common knowledge (*h*), the improvement effected by the invention, all dealings with the patent, whether by assignment, licence or otherwise (*i*), the expenses and receipts in regard to the patent whether incurred by the petitioner or others (*k*), the existence of foreign patents, and the profits from the same (*l*).

Petitioner.

The person to petition must be the patentee, and in all reported cases the legal owners of the patent have been among the petitioners (*m*). As patentee includes the executors, administrators and assigns of the original grantee, petitions may be presented by such persons (*n*).

Court.

The petition must in England be presented to the High Court and heard by the special judge, whose decision is final (*o*). In Scotland the petition must be presented to the Court of Session (*p*), and in Ireland to the High Court (*q*), and apparently

(*d*) *Dolbear's Patent*, 13 R. P. C. 205.

(*e*) *Pitman's Patent* (1871), 8 Moo. (N. S.) 293; *Clark's Patent* (1870), 7 Moo. (N. S.) 255; *Horsey's Patent*, 1 R. P. C. 225.

(*f*) *Stanfield's Patent*, 15 R. P. C. 17.

(*g*) *Stanfield's Patent*, *supra*.

(*h*) *Semble*, this should include any relevant specifications known to the petitioner. *Fountain Livet's Patent*, 9 R. P. C. 327.

(*i*) *Horsey's Patent*, 1 R. P. C. 225; *Lane Fox's Patent*, 9 R. P. C. 411; *Ferranti's Patent*, 18 R. P. C. 518; *cf.* also *Deacon's Patent*, 4 R. P. C. 119.

In *Barff and Bower's Patent*, 12 R. P. C. 383, it was said that transactions in the shares of an assignee company should also be shown.

(*k*) See p. 308.

(*l*) *Johnson's Patent* (1871), 8 Moo. (N. S.) 282; *Pitman's Patent* (1871), 8 Moo. (N. S.) 293; *Adair's Patent* (1881), 6 A. C. 176; *Newton's Patent* (1884), 9 A. C. 592; *Willans and Robinson's Patent*, 13 R. P. C. 550.

If foreign patents have been re-

fused, this should appear. *Johnson's Patent*, 25 R. P. C. 709.

(*m*) Sect. 18 (1). See "Patentee," p. 291.

An extension may be granted to a foreigner residing abroad. *Newton's Patent* (1861), 14 Moo. 156.

(*n*) *e.g.* Executor: *Bodmer's Patent* (1849), 6 Moo. 467; Administrator: *Heath's Patent* (1853), 2 W. P. C. 257; Assigns: see p. 313.

Where petitioner died after the order the new grant was made to his executrix. *Porter's Patent* (1853), 2 W. P. C. 196.

It has been said that the personal representatives of a deceased inventor should be joined. *Willacy's Patent*, 5 R. P. C. 692 (adjournment for such representatives to be added). Also that a mortgagee of the patentee should be joined in order to give the opponents security for costs. *Church's Patent*, 3 R. P. C. 95. But the omission to do this does not necessarily lead to the rejection of the petition, *ibid.*

(*o*) Sect. 18 (1), and s. 92.

(*p*) Sect. 94.

(*q*) Sect. 95.

these decisions are also without appeal (*r*). There are no provisions as to the country in which the petition must be presented.

The petitioner must advertise in the prescribed manner his intention to apply for an extension and must present the petition at least six months before the expiration of the patent (*s*), and within a week of the publication of the last of the advertisements in the *London Gazette* (*t*). On the day named in the advertisement the petition shall come into the Court list, and the petitioner shall apply to the Court to fix a day (called in the Rules "the appointed day") for the hearing (*u*), which day shall be advertised (*x*).

The rules of procedure are contained in O. 53*a*, r. 3, which read with the rules of the Supreme Court, forms a code on this subject (*y*). The Court, however, has power to relax any of the requirements of the rules (*z*), though not of the Act (*a*).

Any person (*b*) may oppose the petition but must lodge a notice of his intention to do so before the day named in the first advertisements (*c*). The petitioner shall then serve a copy of the petition upon him (*d*), and the opponent must within three weeks lodge and serve written notice of objections (*e*),

(*r*) *Lawrence and Kennedy's Patent*, 27 R. P. C. 258, I. H.

(*s*) Sect. 18 (1). As to advertisements, see O. 53 *a*, r. 3 (*a*), (*b*), and (*c*). The Court has no power to hear a petition presented after this time. *Adam's Patent*, 16 R. P. C. 1.

The P. C. held in *Friese Green's Patent*, 24 R. P. C. 464, that there was no power to entertain a petition which had not been advertised; but see *contra*, *Lindon's Patent*, 14 R. P. C. 643; *Poyser's Patent*, 24 R. P. C. 157.

Though there is no other limit to the time for such petitions, it has always been the practice not to present them until near the time of expiry, and the P. C. has refused to hear a petition presented too soon. *Macintosh's Patent* (1836), W. P. C. 739.

In some cases, however, petitions dealing with patents expiring at different times have been entertained, e.g. *Johnson and Atkinson's Patents* (1873), L. R. 5 P. C. 87 (two patents, three years between them); *Thomas's Patents*, 9 R. P. C. 367 (seven patents, two and a half years between first and last).

As to advertisements, see O. 53*a*, r. 3 (*a*), (*b*), and (*c*).

(*t*) O. 53*a*, r. 3 (*d*).

(*u*) O. 53*a*, r. 3 (*f*).

(*x*) O. 53*a*, r. 3 (*g*).

(*y*) *Johnson's Patent*, 25 R. P. C. 391.

Summonses under this special jurisdiction are taken in Court. *Barton's Patent*, 29 R. P. C. 208.

(*z*) O. 53*a*, r. 3 (*g*).

(*a*) Cf. *Adam's Patent*, 16 R. P. C. 1; *Friese Green's Patent*, 24 R. P. C. 464.

(*b*) Sect. 18 (2). There are no decisions limiting the class of persons entitled to oppose. An alien residing abroad may oppose: *re Schlumberger* (1853), 9 Moo. 1.

(*c*) O. 53*a*, r. 3 (*j*). *Seem* this time may be extended, O. 53*a*, r. 3 (*s*), but in *Hopkinson's Patent*, 13 R. P. C. 114, an application to extend the time because the opponents had not seen the notice was refused.

A person giving such notice may be heard on the application to fix the appointed day, O. 53*a*, r. 3 (*o*).

(*d*) O. 53*a*, r. 3 (*k*).

(*e*) O. 53*a*, r. 3 (*l*).

The rules as to particulars of objections do not apply to these notices

otherwise he is deemed to have abandoned his opposition (*f*). After this time the petition comes into the list for hearing (*g*).

Petition and accounts.

The contents of the petition and accounts have been dealt with elsewhere (*h*). The accounts must be lodged a fortnight before the appointed day and the petitioner must give the Board of Trade facilities for inspecting the books, etc., on which they are based (*i*).

Hearing.

Even where the petition is not opposed and the Board of Trade raise no objections, the petitioner must give evidence as to merit, remuneration, etc. (*k*). The Board of Trade or the Comptroller may appear and raise any objections they think fit (*l*), but other opponents cannot raise objections other than those stated in their notice (*m*).

Order and condition.

The prolongation may be effected either by extending the original grant or by making a new grant (*n*). In either case the extended or new letters patent are usually vested in the person legally entitled to the grant at the time of the prolongation (*o*), but a new grant may be made to other persons, *e.g.* to

which are rather intended to indicate the grounds of objection than to give particulars, and although the opponent should give any instances of publication or prior user within his knowledge, he may give evidence of further instances discovered later. *Johnson's Patent*, 25 R. P. C. 392.

It is doubtful whether these objections are pleadings, and *semble* time runs in the Long Vacation. *Stearn's Patent*, 28 R. P. C. 664; *Barton's Patent*, 29 R. P. C. 208; *Johnson's Patent*, *supra*. Cf. also *Beldam's Patent*, 27 R. P. C. 758. The time may be extended. *Stearn's Patent*, *supra*.

(*f*) O. 53a, r. 3 (*m*).

(*g*) O. 53a, r. 3 (*p*).

(*h*) See p. 316 and p. 310.

(*i*) O. 53a, r. 3 (*i*). Opponents other than the Board of Trade have a right to obtain at their own expense copies of the accounts: O. 53a, r. 3 (*q*), but not to inspect the books: cf. *Bridson's Patent* (1851), 7 Moo. 499, though they may be allowed to do so at the hearing: *Lyon's Patent*, 11 R. P. C. 539.

(*k*) *Darby's Patent*, 8 R. P. C. 383; *Joy's Patent*, 10 R. P. C. 89.

In some cases before the P. C. account books were admitted in evidence without the writing being proved. *Swaine's Patent* (1837),

W. P. C. 559; and where the books could not be produced estimates were permitted. *Hazeland's Patent*, 11 R. P. C. 467; but the absence of books should be explained. *Lawrence's Patent*, 9 R. P. C. 55. See also *Lake's Patent*, 8 R. P. C. 227; *Yate's Patent*, 4 R. P. C. 150.

(*l*) O. 53a, r. 3 (*t*). This carries on the old practice. See *inter alia* *Fountain Livet's Patent*, 9 R. P. C. 327.

(*m*) O. 53a, r. 3 (*n*). But cf. p. 317. *n.* (*e*). The opponents were allowed to refer to fresh specifications, etc., in *Ball's Patent* (1879), 4 A. C. 171; *Stewart's Patent*, 3 R. P. C. 7.

The old rule was that only two counsel would be heard for the opponents unless there were separate and distinct grounds of opposition. *Woodcroft's Patent* (1841), 3 Moo. 171.

(*n*) Sect. 18 (5). Both courses are adopted in practice. In *Smith's Patent*, 2 R. P. C. 14, and *Cocking's Patent*, 2 R. P. C. 151, new grants were made so that the patents might be subject to the conditions of the 1883 Act as to compulsory licences.

As to effect of delay in obtaining the new grant, see *re Schlumberger* (1853), 9 Moo. 1.

(*o*) See *inter alia* *Wright's Patent* (1837), W. P. C. 561.

the original inventor (*p*), or conditions may be imposed varying or preserving the respective rights (*q*). Conditions may also be imposed in the public interest, *e.g.* as to licences (*r*), prices (*s*), or the use of the invention by the State (*t*).

Where the Court is of opinion that part only of the invention, or only some particular application thereof, is of such merit as would justify an extension, the extension may be granted for certain claims only, or for certain applications only (*u*).

The term of extension is entirely in the Court's discretion, but is limited to seven, or in exceptional cases, to fourteen years (*x*). The Court has no power to grant a second extension (*y*). Term of extension.

Costs may be given either to or against opponents (*z*), other Costs.

(*p*) *Bovill's Patent* (1863), 1 Moo. (N. S.) 348, and see p. 316, *n.* (*n*).

(*q*) *E.g. Church's Patent*, 3 R. P. C. 95 (mortgagee to have same security over new patent as he had over old).

Derosne's Patent (1844), 2 W. P. C. 1 (existing licensees to have same right under renewed patent).

Normandy's Patent (1855), 9 Moo. 452 (opponent to continue to receive royalties under certain licences).

In *Lancaster's Patent* (1864), 2 Moo. (N. S.) 189, the P. C. refused to impose conditions in favour of a person claiming to have assisted in making the invention.

See also cases in next note.

(*r*) *E.g. Shone's Patent*, 9 R. P. C. 438; (exclusive licence to be abandoned); *Lyon's Patent*, 11 R. P. C. 537 (exclusive licence to be abandoned); *Mallett's Patent*, (1866) 4 Moo. (N. S.) 175 (licences to any person on terms of existing licences); *Lyon's Patent*, *supra* (licences at 10 per cent. on selling price).

(*s*) *E.g. Hart's Patent*, 25 R. P. C. 299 (Board of Trade to have power to fix prices). See also *Hardy's Patent* (1849), 6 Moo. 441.

(*t*) *E.g.* Crown to have free use. *Pittitt Smith's Patent* (1850), 7 Moo. 133; *Hughes' Patent* (1879), 4 A. C. 174; *Napier's Patent* (1881), 6 A. C. 174 (where this condition was said to be usual).

The P. C., however, refused to impose this condition in *Lancaster's Patent*, *supra*, and *Carpenter's Patent* (1864), 2 Moo. (N. S.) 190 *n.*

(*u*) *Bodmer's Patent* (1853), 8 Moo. 282; *Lee's Patent* (1856), 10 Moo.

226; *Napier's Patent* (1881), 6 A. C. 174; *Church's Patent*, 3 R. P. C. 95; *Joy's Patent*, 10 R. P. C. 89; *Lodge's Patent*, 28 R. P. C. 365.

(*x*) Sect. 18 (5). The power to extend a patent for more than seven years was first given by 7 & 8 Vict. c. 69.

The only cases in which the P. C. or the Court have exercised their power of extending a patent for more than seven years are: *Stoney's Patent*, 5 R. P. C. 518; *Darby's Patent*, 8 R. P. C. 380; *Currie & Timmis's Patent*, 15 R. P. C. 63; *McCulloch's Patent*, 25 R. P. C. 684, O. H.

In each case the extension was for ten years. It is not possible to derive from these cases any rules as to when this power will be exercised. There are instances of longer extension by Act of Parliament.

(*y*) *Thompson's Patent* (No. 2), 26 R. P. C. 675, following *Goucher's Patent* (1866), 2 Moo. (N. S.) 532.

(*z*) O. 53a, r. 3 (*a*). Opponents were very seldom ordered to pay costs; but in *Downton's Patent* (1839), W. P. C. 565, they were ordered to pay the increased costs caused by opposition. Costs were given more freely where petitioners were unsuccessful. *Wield's Patent* (1871), 8 Moo. (N. S.) 300, though not always even then, *cf. Muntz's Patent* (1846), 2 W. P. C. 122; *Stewart's Patent*, 3 R. P. C. 7; *Ricci's Patent*, 23 R. P. C. 273.

In *Hopkinson's Patent*, 14 R. P. C. 5, one set of costs among seven opponents, the amount being fixed at £400.

than the Comptroller or the Board of Trade (a), but except under special circumstances only one set of costs will be given among all opponents (b).

Where a petition is withdrawn the opponents will in general be allowed their costs (c), but it is for the opponents to establish that there is any reason for allowing more than one set of costs (d).

(a) No costs can be given to these, O. 53a, r. 3 (u). In fact the former practice was that the Attorney-General did not ask for costs.

(b) O. 53a, r. 3 (v). See note (z), *supra*.

(c) *Morgan Brown's Patent*, 3 R. P. C. 212; *Imray's Patent*, 26 R. P. C. 11; *Stearn's Patent*, 28 R. P. C. 696.

(d) *Imray's Patent, supra*; *Stearn's Patent, supra*.

FORMS

PLEADINGS IN INFRINGEMENT ACTION,

FORM 1.

1912 S. No. 10000.

IN THE HIGH COURT OF JUSTICE,
CHANCERY DIVISION.

Mr. JUSTICE JONES.

Between William Smith, *Plaintiff*,
and
John Jones, *Defendant*.

Statement of Claim (a).

(1) The plaintiff is the registered proprietor of Letters Patent No. 44444* of the year 1900 granted to him for improvements in bicycle tyres (b).

(2) The said Letters Patent are and always have been good and valid (c).

(3) The specification of the said Letters Patent was duly amended in accordance with an order of the Comptroller General dated the 1st day of January, 1905.

(4) The original claims of the said specification were drafted in good faith and with reasonable skill and knowledge (d).

(5) In an action of *Smith v. Brown* (1910 S. No 1), a certificate of the validity of the said Letters Patent was granted on the 1st March, 1910 (e).

(6) The Defendant has infringed and threatens and claims the right to infringe the said Letters Patent in the manner appearing in the Particulars of Breaches delivered herewith, and will continue to infringe such Letters Patent unless he is restrained by the Order of this Honourable Court (f).

The Plaintiff claims—

1. An injunction to restrain the Defendant his servants and agents from infringing the said Letters Patent (g).
2. An inquiry as to damages or at the Plaintiff's option an account of profits (h).
3. Delivery up of the infringing articles (i).
4. Costs as between solicitor and client (k).
5. Such further or other relief as the Court may in the premises deem meet.

(a) Pp. 166-167. (d) P. 237, n. (y).

(b) P. 10.

(e) P. 200.

(g) Pp. 191-192.

(c) P. 188.

(f) Pp. 187-188, 191-192.

(h) Pp. 193-197.

(i) P. 198. (k) P. 200.

LAW OF PATENTS

FORM 2.

(Heading as in Form 1.)

PARTICULARS OF BREACHES DELIVERED WITH THE STATEMENT OF CLAIM (*l*).

(1) The Defendant has both before and after the issue of the Writ in this action infringed the said Letters Patent by the manufacture sale and use of bicycle tyres made in infringement of the claiming clauses of the said specification (*m*).

(2) For the purposes of the hearing the Plaintiff will rely on the following specific breaches :—

(a) The manufacture by the Defendant at his works at Blank Street, London, of such infringing tyres in the months of May and June, 1911.

(b) The sale on the 1st day of June, 1911, to James Johnson at the Defendant's said works of one bicycle tyre made in infringement of the said Letters Patent.

(c) The use on a bicycle ridden by the Defendant at the Blankshire sports on Whit Monday, 1911, of tyres made in infringement of the said Letters Patent. Each of the said tyres referred to in subparagraphs (*a*) (*b*) and (*c*) hereof were made in infringement of all the claiming clauses of the said Letters Patent.

(3) The Defendant has also threatened to infringe the said Letters Patent and has claimed the right to continue to make tyres in infringement of the claims of the said Letters Patent. Such threats and claims of right were made verbally on the 1st day of June, 1911, at interviews between the Defendant and the Plaintiff's solicitor William Robinson and in a letter addressed by the Defendant to the said William Robinson, and dated the 30th day of May, 1911 (*n*).

(4) The Plaintiff is unable to give further or better particulars of the Defendant's breaches until after he shall have obtained discovery, but will claim full relief for all such breaches.

FORM 3.

(Heading as in Form 1.)

DEFENCE AND COUNTERCLAIM.

Defence (*o*).

(1) The Defendant admits the allegations contained in paragraph 1 of the Statement of Claim and further admits that the said Letters Patent were duly amended as alleged (*p*). He denies that the original claims to the said Letters Patent were framed in good faith or with reasonable skill or knowledge.

(*l*) P. 167.

(*m*) This paragraph is usual, but would seem to be unnecessary.

(*n*) Pp. 187-188.

(*o*) P. 168.

(*p*) P. 169, *n.* (*e*).

(2) The Defendant denies that he has infringed or threatened or claimed the right to infringe the said Letters Patent as alleged or at all.

(3) The said Letters Patent are and always have been invalid and of no effect for the reasons appearing in the Particulars of Objections delivered herewith.

(4) Further the Defendant says that the manufacture of the articles the subject of the said Letters Patent has been during the whole life of the patent wholly carried on abroad. Such manufacture has been carried on by the X Company at their works at Boston, Massachusetts, in the United States of America (q).

(5) The Defendant also says that by reason of the failure of the patentee to supply the patented articles on reasonable terms the demand for the patented article is not fairly met.

Further, the industry of tyre-making in this country is unfairly prejudiced by the refusal of the Plaintiff to grant licences on reasonable terms, and also by reason of the conditions attached by the Plaintiff to the purchase of the said patented article as appears in the next paragraph hereof (r).

The reasonable requirements of the public would not now be satisfied by the grant of licences (s).

Particulars.

The Plaintiff's wholesale price for such tyres is £2 each, which is an unreasonable price. In a letter to the Defendant dated 1st August, 1911, the Plaintiff stated he would not supply any such tyres at less than the said price.

The Plaintiff by a letter dated 1st August, 1911, refused to grant a licence to the Defendant, and by a letter dated 1st September, 1911, refused to grant a licence to the A.B. Company, Ltd. The Defendant is unable until after he shall have obtained discovery to give further or better particulars of the Plaintiff's refusals.

(6) The Defendant will also rely on the fact that the Plaintiff has inserted in a contract, made on the 30th day of May, 1910, with E. F. of No. 1000, Canon Street, London, which contract is still in force, a requirement that the said E. F. should not purchase any tyres of any other person than the plaintiff (t).

Counterclaim.

By way of Counterclaim the Defendant repeats paragraphs 3, 4, and 5 of his Defence, and applies for the revocation of the said

(q) Pp. 169 and 174.

(r) P. 169.

(s) P. 169.

(t) It should be noted that there may be cases coming within s. 24 (5) (b) which are not within s. 38.

Letters Patent on the grounds set out therein. The Defendant has obtained the Attorney-General's fiat authorising him to petition for the revocation of the said Letters Patent (*u*).

FORM 4.

(Heading as in Form 1.)

PARTICULARS OF OBJECTIONS DELIVERED WITH THE DEFENCE (*x*).

The following are the Particulars of Objections on which the Defendant will rely :—

(1) The said alleged invention was not novel at the date of the grant of the said Letters Patent neither was it subject-matter for Letters Patent in view of the general common knowledge and practice of makers of bicycle tyres and workers in indiarubber generally, and in view of the facts set out below (*y*).

The further facts on which the Defendant will rely in support of the said objection are as follows : (*a*) The publication at the Patent Office, of the following specifications before the date of the said grant.

Number.	Year.	Patentee.	Parties relied on.	Claims against which quoted.
(1) 11111	1870	William Jones	Figs. 1 to 5 and the corresponding letterpress	All

(*b*) The publication at the offices of Messrs. A. B. and Co., Publishers of No. 1, Fleet Street (*z*), London, on about the 1st January, 1895, of "Bicycle Tyres and their Manufacture," by Joseph Robinson. The parts relied on are pages 62 to 64, which are relied on against all the claims of the said Letters Patent (*a*).

(*c*) A Lecture delivered by J. Thompson to the Institute of Mechanical Engineers on the 6th day of January, 1899, in which the alleged inventions claimed in each of the claiming clauses of the said Letters Patent were described.

(*d*) The exhibition of a tyre made in accordance with claims 1 to 3 of the said Letters Patent at the Coventry Bicycle Show in the month of January, 1899.

(*e*) The prior use of the alleged inventions claimed by the first three claiming clauses of the said Letters Patent by John Jones of No. 1, Green Street, London. Such prior use commenced on the 1st January, 1898, and continued till the 1st January, 1899. None of the tyres so made are now in existence, but a drawing showing the construction of such tyres is delivered herewith (*b*).

(*u*) Pp. 177, 211, 214. Par. 6 of the defence affords no ground for revocation, p. 213, *n. (s)*.

(*x*) Pp. 169, *et seq.*

(*y*) P. 170.

(*z*) P. 64, *n. (s)*.

(*a*) P. 171. Where possible pub-

lication at the Patent Office Library is alleged for case of proof.

(*b*) Pp. 171, 172. A tyre would probably not come within the term "apparatus," but the form is given for reference.

(*f*) The prior use by the Plaintiff himself of the alleged inventions claimed by each of the claiming clauses of the said Letters Patent. Such prior use took place at 1, Blue Street, London, and continued from the 1st January, 1899, up to the date of the grant of the said Letters Patent. The Defendant is unable to give further particulars of such use until after he shall have obtained discovery (*c*).

(3) The said William Smith was not the true and first inventor of the said alleged inventions forming the subject-matter of the said Letters Patent. The true and first inventor of the same was William Rogers, No. 1, King Street, London (*d*).

(4) The said alleged inventions were not useful. This objection is relied on against all the claims of the said Letters Patent (*e*).

(5) The specification of the said Letters Patent is insufficient in that it does not distinguish what is old from what is new (*f*).

(6) The specification of the said Letters Patent is insufficient in that it gives no sufficient directions to enable a competent workman to make the tyre shown in Fig. 6 thereof.

The specification is also insufficient in that it gives no sufficient directions for obtaining the best or any useful results from the method of constructing tyres set out on page 2, lines 15 to 25 of the said specification (*g*).

(7) The alleged invention claimed by claim 5 of the said Letters Patent is a substantially different invention from any invention described or foreshadowed in the provisional specification. Such further invention was not new at the date of the lodging of the complete specification in view of the sale by the Plaintiff to one John Williams at his works at 1, Blue Street, London, aforesaid on the 1st day of December, 1900, of a bicycle tyre made according to claim 5 of the complete specification (*h*).

(8) The alleged inventions claimed in claims 1 to 4 of the said Letters Patent had been the subject of a prior grant. Such prior grant is the subject of the first three claims of Letters Patent No. 55555 of 1899, granted to William James Smithers (*i*).

The Defendant will also allege that the Plaintiff was not the true and first inventor of the inventions claimed in such four claims in view of the prior application by the said William James Smithers for Letters Patent No. 55555 of 1899 for such inventions (*k*).

(*c*) P. 67, *n.* (*f*).

(*d*) P. 172.

(*e*) Pp. 172, 173.

(*f*) P. 173.

(*g*) *Ibid.*

(*h*) P. 174.

(*i*) Pp. 174, 175.

(*k*) P. 77. Besides the defences and objections here set out the following may also be raised. That the alleged invention was not for any manner of manufacture, p. 17, that it was contrary to law or morality, p. 214, *n.* (*s*), and sect. 75,

FORM 5.

(Heading as in Form 1.)

REPLY AND DEFENCE TO COUNTERCLAIM.

Reply.

(1) Save as hereinafter appears the Plaintiff joins issue on all the allegations contained in the Defence save in so far as the same consist of admissions.

(2) The Plaintiff further says with reference to the alleged prior grant to William James Smithers referred to in paragraph 8 of the Particulars of Objections delivered with the Defence, that the Letters Patent therein referred to were invalid for the reasons mentioned in the Particulars of Objections delivered herewith (l).

(3) The Plaintiff does not admit any of the allegations contained in paragraph 4 of the Defence. If the said patented articles are, or were, manufactured wholly or mainly abroad as alleged or at all, which is not admitted, the Plaintiff says that there is a satisfactory reason for the absence of manufacture in this country, viz. The Plaintiff has not had during the existence of the said Letters Patent any means to enable him to start manufacture. He has used his best endeavours, during the whole period since the date of the grant, to get firms in this country to take licences for the manufacture of the said patented articles, but none of such firms have been willing to take licences or to commence manufacture.

Particulars of the Plaintiff's Endeavours.

On the 1st August in each of the years 1908, 1909, 1910, 1911 and 1912 the Plaintiff inserted an advertisement in the Patent Office Journal inviting applications for licences under the said Letters Patent. The Plaintiff has also personally or by letter communicated with all the principal firms manufacturing tyres in this country with a view to getting them to adopt the said invention (m).

(4) The Plaintiff denies each and every allegation contained in paragraph 5 of the Defence except that his catalogue price for the said tyres is £2. The Plaintiff denies that £2 is an unreasonable price for such tyres.

(5) The Plaintiff does not admit any of the allegations contained in paragraph 6 of the Defence. If the said contract with E. F. was entered into, and if it contained the clause alleged, neither of which is

or mischievous to the state or hurtful to trade or generally inconvenient or prejudicial, p. 28, p. 252, n. (x), that the monopoly claimed was larger than the invention made, p. 19, that the specification contains material false suggestions or state-

ments, or that the Crown has been deceived, pp. 98-100. As to a plea of infringement without notice, see p. 197.

(l) Pp. 176-177.

(m) Pp. 300, 304.

admitted, the Plaintiff will rely on the fact that he was willing to enter into an agreement for the sale of tyres to the said E. F. on reasonable terms and without the insertion of such clause, and further on the fact that the said contract contains a clause giving the said E. F. the right to terminate such contract on the payment of such sum as may be fixed by an arbitrator appointed by the Board of Trade (*n*).

Defence to Counterclaim (o).

(1) The Plaintiff denies each and every allegation contained in paragraph 3 of the Defence.

(2) With reference to the allegations contained in paragraphs 4 and 5 of the Defence the Plaintiff repeats paragraphs 3, 4 and 5 of his Reply (*p*).

PETITION FOR REVOCATION.

FORM 6.

In the Matter of the Patents and Designs Act, 1907,
and
In the Matter of Letters Patent No. 55555 of 1910,
granted to John Smith (*q*).

To His Majesty's High Court of Justice.

The Humble Petition of William Jones of 1, Blank Street, London,
SHEWETH AS FOLLOWS :—

(1) Your petitioner is the true and first inventor of the invention forming the subject-matter of the said Letters Patent (*r*).

(2) The said Letters Patent were obtained in fraud of the right of your petitioner under the following circumstances. Your petitioner was in the employ of the said John Smith at the time when he made the said invention, and on the 1st day of January, 1910, he confidentially communicated such invention to the said John Smith in order to obtain his opinion as to whether it was of any practical utility or would be worth patenting. The said John Smith informed your petitioner that he did not think the said invention would be of any utility. Subsequently the said John Smith without any further communication to your petitioner and without your petitioner's consent applied for the said Letters Patent in his own name and with intent to deprive your petitioner of his just rights (*s*).

(*n*) P. 249, *n.* (*l*).

(*o*) Even if the reply is a simple traverse, the defence to counterclaim must deal with the allegations *seriatim*, see O. 21, and *Benbow v. Low* (1880), 13 Ch. D. 553.

(*p*) The facts alleged in par. 6 of the defence are also relied on in par. 5.

(*q*) See Chapter XI.

(*r*) P. 212, *n.* (*h*).

(*s*) P. 212.

Your petitioner therefore humbly prays for the revocation of the said Letters Patent No. 55555 and for a declaration that your petitioner is entitled to have Letters Patent granted to him for the said invention (*t*).

And your Petitioner will ever pray, &c.

It is intended to serve this petition on the said John Smith (*u*).

APPLICATION FOR RESTORATION OF LAPSED PATENT.

FORM 7.

In the Matter of the Patents and Designs Act, 1907,
and

In the Matter of Letters Patent No. 55555 of 1908.

I, John Smith, hereby apply for an order from the Comptroller for the restoration of the patent granted upon Application No. 55555 dated the 1st day of June, 1908. The circumstances which have led to the omission of the payment of the fee of £5 due on or before the 1st day of June, 1912, are as follows:—

In connection with my business as an engineer I am possessed of a number of patents. The business in connection with such patents, including the payment of the renewal fees when necessary, was left by me in the hands of my chief clerk XY, he applying to me from time to time for the necessary monies. In the beginning of November last my manager informed me that he was doubtful as to the honesty of the said XY, and I thereupon gave instructions for the accounts of the said XY to be examined. On the 5th November, 1912, the said XY came to me and admitted that he had been misappropriating monies placed in his hands and in particular he had appropriated the sum of £5 which had been given to him to pay the renewal fee on the said lapsed patent. On receiving such information I immediately instructed my patent agents, Messrs. A. & B., to take the necessary steps for the lodging of this present application (*x*).

(*t*) P. 216.

(*u*) P. 214.

(*x*) P. 284.

APPENDIX

PATENTS AND DESIGNS ACT, 1907 (7 EDW. 7, c. 29)

CHAPTER 29

An Act to consolidate the enactments relating to Patents for Inventions and the Registration of Designs and certain enactments relating to Trade Marks. A.D. 1907.

[28th August, 1907.]

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

PART I

PATENTS

Application for and Grant of Patent.

1.—(1) An application for a patent may be made by any person who claims to be the true and first inventor of an invention, whether he is a British subject or not, and whether alone or jointly with any other person. Application.

(2) The application must be made in the prescribed form, and must be left at, or sent by post to, the Patent Office in the prescribed manner.

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

(4) The declaration required by this section may be either a statutory declaration or not, as may be prescribed.

2.—(1) A provisional specification must describe the nature of the invention. Specifica-
tions.

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

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

A.D. 1907.

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

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

Proceedings
upon appli-
cation.

3.—(1) The Comptroller General of Patents, Designs, and Trade Marks (herein-after referred to as the comptroller) shall refer every application to an examiner.

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

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

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

Provisional
protection.

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

Time for
leaving com-
plete speci-
fication.

5.—(1) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within six months from the date of the application:

Provided that where an application is made for an extension of the time for leaving a complete specification, the comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for but not exceeding one month.

(2) Unless a complete specification is so left the application shall be deemed to be abandoned.

Comparison
of provi-
sional and
complete
specification.

6.—(1) Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner.

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

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

(a) refuse to accept the complete specification until it has been amended to his satisfaction ; or A.D. 1907.

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

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

(4) A refusal of the comptroller to accept a complete specification shall be subject to appeal to the law officer, who shall, if required, hear the applicant and the comptroller and may make an order determining whether and subject to what conditions (if any) the complete specification shall be accepted.

(5) Unless a complete specification is accepted within twelve months from the date of the application, the application shall (except where an appeal has been lodged) become void :

Provided that where an application is made for an extension of time for the acceptance of a complete specification, the comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for but not exceeding three months.

7.—(1) Where an application for a patent has been made and a complete specification has been left, the examiner shall, in addition to the other inquiries which he is directed to make by this Act, make a further investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed or described in any specification (other than a provisional specification not followed by a complete specification) published before the date of the application, and left pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application. Investigation of previous specifications in United Kingdom on applications for patents.

(2) If on investigation it appears that the invention has been wholly or in part claimed or described in any such specification, the applicant shall be informed thereof, and the applicant may, within such time as may be prescribed, amend his specification, and the amended specification shall be investigated in like manner as the original specification.

(3) If the comptroller is satisfied that no objection exists to the specification on the ground that the invention claimed thereby has been wholly or in part claimed or described in a previous specification as before mentioned, he shall, in the absence of any other lawful ground of objection, accept the specification.

(4) If the comptroller is not so satisfied, he shall, after hearing the applicant, and unless the objection is removed by amending the specification to the satisfaction of the comptroller, determine whether a reference to any, and, if so, what prior specifications ought to be made in the specification by way of notice to the public :

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

(5) An appeal shall lie from the decision of the comptroller under this section to the law officer.

(6) The investigations and reports required by this section shall not be held in any way to guarantee the validity of any patent, and no liability shall be incurred by the Board of Trade or any officer thereof by reason of, or in connexion with, any such investigation or report, or any proceeding consequent thereon.

Investigation of specifications published subsequently to application.

8.—(1) An investigation under the last preceding section shall extend to specifications published after the date of the application in respect of which the investigation is made, and being specifications which have been deposited pursuant to prior application; and that section shall, subject to rules under this Act, have effect accordingly.

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

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

(4) This section shall come into operation at such date as the Board of Trade may by order direct, and shall apply only to applications made after that date, and the order shall be laid before both Houses of Parliament.

Advertisement on acceptance of complete specification.

9. On the acceptance of the complete specification the comptroller shall advertise the acceptance; and the application and specifications with the drawings (if any) shall be open to public inspection.

Effect of acceptance of complete specification.

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

Opposition to grant of patent.

11.—(1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on any of the following grounds:—

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

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- (b) that the invention has been claimed in any complete specification for a British patent which is or will be of prior date to the patent the grant of which is opposed, other than a specification deposited pursuant to an application made more than fifty years before the date of the application for such last-mentioned patent; or
- (c) that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the complete specification; or
- d) that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification, but on no other ground.

(2) Where such notice is given the comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the opponent, if desirous of being heard, decide on the case.

(3) The decision of the comptroller shall be subject to appeal to the law officer, who shall, if required, hear the applicant and the opponent, if the opponent is, in his opinion, a person entitled to be heard in opposition to the grant of the patent, and shall decide the case; and the law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer with the consent of the Treasury may determine.

12.—(1) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, a patent shall, on payment of the prescribed fee, be granted to the applicant, or in the case of a joint application to the applicants jointly, and the comptroller shall cause the patent to be sealed with the seal of the Patent Office.

(2) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, provided that—

- (a) Where the comptroller has allowed an extension of the time within which a complete specification may be left or accepted, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent:
- (b) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct:
- (c) Where the patent is granted to the legal representative of an applicant who has died before the expiration of the time which would otherwise be allowed for sealing the patent, the patent may be sealed at any time within twelve months after the date of his death:
- (d) Where in consequence of the neglect or failure of the applicant to pay any fee a patent cannot be sealed within the period allowed by this section, that period may, on payment of the prescribed fee and on compliance with the prescribed conditions, be extended to such an extent as may be prescribed, and this provision shall

A.D. 1907. —	in such cases as may be prescribed and subject to the prescribed conditions, apply where the period allowed for the sealing of the patent has expired before the commencement of this Act.
Date of patent.	13. Except as otherwise expressly provided by this Act, a patent shall be dated and sealed as of the date of the application: Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification.
Effect, extent, and form of patent.	14.—(1) A patent sealed with the seal of the Patent Office shall have the same effect as if it were sealed with the Great Seal of the United Kingdom, and shall have effect throughout the United Kingdom and the Isle of Man: Provided that a patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only. (2) Every patent may be in the prescribed form and shall be granted for one invention only, but the specification may contain more than one claim; and it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.
Fraudulent applications for patents.	15.—(1) A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection. (2) 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 patent so revoked: Provided that no action shall be brought for any infringement of the patent so granted committed before the actual date when such patent was granted.
Single patent for cognate inventions.	16.—(1) Where the same applicant has put in two or more provisional specifications for inventions which are cognate or modifications one of the other, and has obtained thereby concurrent provisional protection for the same, and the comptroller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may accept one complete specification in respect of the whole of such applications and grant a single patent thereon. (2) Such patent shall bear the date of the earliest of such applications, but in considering the validity of the same and for the purpose of the provisions of this Act with respect to oppositions to the grant of patents, the court or the comptroller, as the case may be, shall have regard to the respective dates of the provisional specifications relating to the several matters claimed therein.
<i>Term of Patent.</i>	
Term of patent.	17.—(1) The term limited in every patent for the duration thereof shall, save as otherwise expressly provided by this Act, be fourteen years from its date. (2) A patent shall, notwithstanding anything therein or in this Act,

cease if the patentee fails to pay the prescribed fees within the prescribed times; provided that the comptroller, upon the application of the patentee shall, on receipt of such additional fee, not exceeding ten pounds, as may be prescribed, enlarge the time to such an extent as may be applied for but not exceeding three months. A.D. 1907.

(3) If any proceeding is taken in respect of an infringement of the patent committed after a failure to pay any fee within the prescribed time, and before any enlargement thereof, the court before which the proceeding is proposed to be taken may, if it thinks fit, refuse to award any damages in respect of such infringement.

18.—(1) A patentee may, after advertising in manner provided by rules of the Supreme Court his intention to do so, present a petition to the court praying that his patent may be extended for a further term, but such petition must be presented at least six months before the time limited for the expiration of the patent. Extension of term of patent.

(2) Any person may give notice to the court of objection to the extension.

(3) On the hearing of any petition under this section the patentee and any person who has given such notice of objection shall be made parties to the proceeding, and the comptroller shall be entitled to appear and be heard, and shall appear if so directed by the court.

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

(5) If it appears to the court that the patentee has been inadequately remunerated by his patent, the court may by order extend the term of the patent for a further term not exceeding seven, or, in exceptional cases, fourteen years, or may order the grant of a new patent for such term as may be specified in the order and containing any restriction, conditions, and provisions the court may think fit.

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

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

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

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

Restoration of lapsed Patents.

20.—(1) Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee Restoration of lapsed patents.

A.D. 1907. — may apply to the comptroller in the prescribed manner for an order for the restoration of the patent.

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

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

(4) Where such notice is given the comptroller shall notify the applicant thereof.

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

Amendment of Specification.

Amendment
of specifica-
tion by comp-
troller.

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

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

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

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

(5) The decision of the comptroller in either case shall be subject to an appeal to the law officer, who shall, if required, hear the person making the request to amend and, where notice of opposition has been given, the person giving that notice, if he is, in the opinion of the law officer, entitled to be heard in opposition to the request, and, where there is no opposition, the comptroller, and may make an order determining whether and subject to what conditions (if any) the amendment ought to be allowed.

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

(7) Leave to amend shall be conclusive as to the right of the party to

make the amendment allowed, except in case of fraud ; and the amendment shall be advertised in the prescribed manner, and shall in all courts and for all purposes be deemed to form part of the specification. A.D. 1907.
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(8) This section shall not apply when and so long as any action for infringement or proceeding before the court for the revocation of a patent is pending.

22. In any action for infringement of a patent or proceedings before a court for the revocation of a patent the court may by order allow the patentee to amend his specification by way of disclaimer in such manner, and subject to such terms as to costs advertisement or otherwise, as the court may think fit : Amendment
of specifica-
tion by the
court.

Provided that no amendment shall be so allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before the amendment, and where an application for such an order is made to the court notice of the application shall be given to the comptroller, and the comptroller shall have the right to appear and be heard, and shall appear if so directed by the court.

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

Compulsory Licences and Revocation.

24.—(1) Any person interested may present a petition to the Board of Trade alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied, and praying for the grant of a compulsory licence, or, in the alternative, for the revocation of the patent. Compulsory
licences and
revocation.

(2) The Board of Trade shall consider the petition, and if the parties do not come to an arrangement between themselves the Board of Trade, if satisfied that a *prima facie* case has been made out, shall refer the petition to the court, and, if the Board are not so satisfied, they may dismiss the petition.

(3) Where any such petition is referred by the Board of Trade to the court, and it is proved to the satisfaction of the court that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by the court to grant licences on such terms as the court may think just, or, if the court is of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, the patent may be revoked by order of the court :

Provided that an order of revocation shall not be made before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default.

(4) On the hearing of any petition under this section the patentee and any person claiming an interest in the patent as exclusive licensee or otherwise,

A.D. 1907. shall be made parties to the proceeding, and the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.

(5) For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied—

(a) if by reason of the default of the patentee to manufacture to an adequate extent and supply on reasonable terms the patented article, or any parts thereof which are necessary for its efficient working, or to carry on the patented process to an adequate extent or to grant licences on reasonable terms, any existing trade or industry, or the establishment of any new trade or industry in the United Kingdom is unfairly prejudiced, or the demand for the patented article or the article produced by the patented process is not reasonably met; or

(b) if any trade or industry in the United Kingdom is unfairly prejudiced by the conditions attached by the patentee before or after the passing of this Act to the purchase, hire, or use of the patented article or to the using or working of the patented process.

(6) An order of the court directing the grant of any licence under this section shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence and made between the parties to the proceeding.

Revocation
of patent.

25.—(1) Revocation of a patent may be obtained on petition to the court.

(2) Every ground on which—

(a) a patent might, immediately before the first day of January, one thousand eight hundred and eighty-four, have been repealed by *scire facias*; or

(b) a patent may be revoked under this Act either by the comptroller or as an alternative to the grant of a compulsory licence;

shall be available by way of defence to an action of infringement and shall also be a ground of revocation under this section.

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

(a) by the Attorney-General or any person authorised by him; or

(b) by any person alleging—

(i) that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims; or

(ii) that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee; or

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

Power of
comptroller
to revoke
patents on

26.—(1) Any person who would have been entitled to oppose the grant of a patent, or is the successor in interest of a person who was so entitled, may, within two years from the date of the patent, in the prescribed manner apply to the comptroller for an order revoking the patent

on any one or more of the grounds on which the grant of the patent might have been opposed : A.D. 1907.

Provided that when an action for infringement or proceedings for the revocation of the patent are pending in any court, an application under this section shall not be made except with the leave of the court. —
certain
grounds.

(2) The comptroller shall give notice of the application to the patentee, and after hearing the parties, if desirous of being heard, may make an order revoking the patent or requiring the specification relating thereto to be amended by disclaimer, correction, or explanation, or dismissing the application; but the comptroller shall not make an order revoking the patent unless the circumstances are such as would have justified him in refusing to grant the patent had the proceedings been proceedings in an opposition to the grant of a patent.

(3) A patentee may at any time by giving notice in the prescribed manner to the comptroller offer to surrender his patent, and the comptroller may, if after giving notice of the offer and hearing all parties who desire to be heard he thinks fit, accept the offer, and thereupon make an order for the revocation of the patent.

(4) Any decision of the comptroller under this section shall be subject to appeal to the court.

27.—(1) At any time not less than four years after the date of a patent and not less than one year after the passing of this Act, any person may apply to the comptroller for the revocation of the patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom. Revocation
of patents
worked out-
side the
United
Kingdom.

(2) The comptroller shall consider the application, and, if after enquiry he is satisfied that the allegations contained therein are correct, then, subject to the provisions of this section, and unless the patentee proves that the patented article or process is manufactured or carried on to an adequate extent in the United Kingdom, or gives satisfactory reasons why the article or process is not so manufactured or carried on, the comptroller may make an order revoking the patent either—

(a) forthwith; or

(b) after such reasonable interval as may be specified in the order, unless in the meantime it is shown to his satisfaction that the patented article or process is manufactured or carried on within the United Kingdom to an adequate extent :

Provided that no such order shall be made which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or British possession.

(3) If within the time limited in the order the patented article or process is not manufactured or carried on within the United Kingdom to an adequate extent, but the patentee gives satisfactory reasons why it is not so manufactured or carried on, the comptroller may extend the period mentioned in the previous order for such period not exceeding twelve months as may be specified in the subsequent order.

(4) Any decision of the comptroller under this section shall be subject to appeal to the court, and on any such appeal the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.

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*Register of Patents.*Register of
patents.

28.—(1) There shall be kept at the Patent Office a book called the register of patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may be prescribed.

(2) The register of patents existing at the commencement of this Act shall be incorporated with and form part of the register of patents under this Act.

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

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

*Crown.*Patent to
bind Crown.

29. A patent shall have to all intents the like effect as against His Majesty the King as it has against a subject :

Provided that any Government department may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on such terms as may, either before or after the use thereof, be agreed on, with the approval of the Treasury, between the department and the patentee, or, in default of agreement, as may be settled by the Treasury after hearing all parties interested.

Assignment
to Secretary
for War or
the Admi-
rality of cer-
tain inven-
tions.

30.—(1) The inventor of any improvement in instruments or munitions of war may (either for or without valuable consideration) assign to the Secretary of State for War or the Admiralty on behalf of His Majesty all the benefit of the invention and of any patent obtained or to be obtained for the invention ; and the Secretary of State or the Admiralty may be a party to the assignment.

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

(3) Where any such assignment has been made, the Secretary of State or the Admiralty may at any time before the publication of the complete specification certify to the comptroller that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

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

(5) The packet shall, until the expiration of the term during which a patent for the invention may be in force, be kept sealed by the comptroller, and shall not be opened save under the authority of an order of the Secretary of State or the Admiralty or of the law officer. A.D. 1907.

(6) The sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by the Secretary of State or the Admiralty to receive it, and shall if returned to the comptroller be again kept sealed by him.

(7) On the expiration of the term of the patent, the sealed packet shall be delivered to the Secretary of State or the Admiralty.

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

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

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

(11) The Secretary of State or the Admiralty may at any time waive the benefit of this section with respect to any particular invention, and the specifications, documents, and drawings shall be 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 the Admiralty, or to any person or persons authorised by the Secretary of State or the Admiralty to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

(13) Rules may be made under this Act, after consultation with the Secretary of State and the Admiralty, for the purpose of ensuring secrecy with respect to patents to which this section applies, and those rules may modify any of the provisions of this Act in their application to such patents as aforesaid so far as may appear necessary for the purpose aforesaid.

Legal Proceedings.

31.—(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 the case wholly or partially with his assistance; the action shall be tried without a jury unless the court otherwise directs. Hearing with assessor.

A.D. 1907.

(2) The Court of Appeal may, if they think fit, in any proceeding before them call in the aid of an assessor as aforesaid.

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

Power to counterclaim for revocation in an action for infringement.

82. A defendant in an action for infringement of a patent, if entitled to present a petition to the court for the revocation of the patent, may, without presenting such a petition, apply in accordance with the rules of the Supreme Court by way of counterclaim in the action for the revocation of the patent.

Exemption of innocent infringer from liability for damages.

83. A patentee shall not be entitled to recover any damages in respect of an infringement of a patent granted after the commencement of this Act from any defendant who proves that at the date of the infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent, and the marking of an article with the word "patent," "patented," or any word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed on, or otherwise applied to the article, shall not be deemed to constitute notice of the existence of the patent unless the word or words are accompanied by the year and number of the patent :

Provided that nothing in this section shall affect any proceedings for an injunction.

Order for inspection, etc., in action.

84. In an action for infringement of a patent, the court 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 may see fit.

Certificate of validity questioned and costs thereon.

85. In an action for infringement of a patent, the court may certify that the validity of the patent came in question ; and, if the court so certifies, then in any subsequent action for infringement the plaintiff in that action on obtaining a final order or judgment in his favour shall, unless the court trying the action otherwise directs, have his full costs, charges, and expenses as between solicitor and client.

Remedy in case of groundless threats of legal proceedings.

86. 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 infringement of the patent, any person aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as he has sustained thereby, if the alleged infringement to which the threats related was not in fact an infringement of any legal rights of the person making such threats :

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.

Miscellaneous.

Grant of patents to two or more persons.

87. Where, after the commencement of this Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interests therein as joint tenants, but, subject to any contract to the contrary, each

of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a licence without their consent, and, if any such person dies, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate.

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38.—(1) It shall not be lawful in any contract made after the passing of this Act in relation to the sale or lease of, or licence to use or work, any article or process protected by a patent to insert a condition the effect of which will be—

Avoidance of certain conditions attached to the sale, etc. of patented articles.

(a) to prohibit or restrict the purchaser, lessee, or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licensor or his nominees; or

(b) to require the purchaser, lessee, or licensee to acquire from the seller, lessor, or licensor, or his nominees, any article or class of articles not protected by the patent;

and any such condition shall be null and void, as being in restraint of trade and contrary to public policy:

Provided that this subsection shall not apply if—

(i) the seller, lessor, or licensor proves that at the time the contract was entered into the purchaser, lessee, or licensee had the option of purchasing the article or obtaining a lease or licence on reasonable terms, without such conditions as aforesaid; and

(ii) the contract entitles the purchaser, lessee, or licensee to relieve himself of his liability to observe any such condition on giving the other party three months notice in writing and on payment in compensation for such relief in the case of a purchase of such sum, or in the case of a lease or licence of such rent or royalty for the residue of the term of the contract, as may be fixed by an arbitrator appointed by the Board of Trade.

(2) Any contract relating to the lease of or licence to use or work any patented article or patented process, whether made before or after the passing of this Act, may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything in the same or in any other contract to the contrary, be determined by either party on giving three months notice in writing to the other party; but where any such notice is given determining any contract made before the passing of this Act, the party giving the notice shall be liable to pay such compensation as failing agreement may be awarded by an arbitrator appointed by the Board of Trade.

(3) Any contract made before the passing of this Act relating to the lease of or licence to use or work any patented article or process and containing any condition which, had the contract been made after the passing of this Act, would by virtue of this section have been null and void may, at any time before the contract is determinable under the last preceding subsection, and notwithstanding anything in the same or any other contract to the contrary, be determined by either party on giving three months notice in writing to the other party, but where any such notice is given the

A.D. 1907. party giving the notice shall be liable to pay such compensation as, failing agreement, may be awarded by an arbitrator appointed by the Board of Trade.

(4) The insertion by the patentee in a contract made after the passing of this Act of any condition which by virtue of this section is null and void shall be available as a defence to an action for infringement of the patent to which the contract relates brought while that contract is in force.

(5) Nothing in this section shall—

(a) affect any condition in a contract whereby a person is prohibited from selling any goods other than those of a particular person ; or

(b) be construed as validating any contract which would, apart from this section, be invalid ; or

(c) affect any right of determining a contract or condition in a contract exercisable independently of this section ; or

(d) affect any condition in a contract for the lease of or licence to use a patented article, whereby the lessor or licensor reserves to himself or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair.

Costs and security for costs.

39.—(1) The comptroller shall, in proceedings relating to an opposition to the grant of a patent or to an application for the amendment of a specification or the revocation of a patent, have power by order to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of the court.

(2) If a party giving notice of opposition to the grant of a patent or to the amendment of a specification, or applying to the comptroller for the revocation of a patent, or giving notice of appeal from any decision of the comptroller, neither resides nor carries on business in the United Kingdom or the Isle of Man, the comptroller, or, in case of appeal to the law officer, the law officer, may require such party to give security for costs of the proceedings or appeal, and in default of such security being given may treat the proceedings or appeal as abandoned.

Procedure on appeal to law officer.

40. The law officer may examine witnesses on oath and administer oaths for that purpose, and may make rules regulating references and appeals to the law officer and the practice and procedure before him under this Part of this Act ; and in any proceeding before the law officer under this Part of this Act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the court.

Provisions as to anticipation.

41.—(1) An invention covered by any patent applied for on or after the first day of January one thousand nine hundred and five shall not be deemed to have been anticipated by reason only of its publication in a specification left pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for the patent, or of its publication in a provisional specification of any date not followed by a complete specification.

(2) A patent shall not be held to be invalid by reason only of the invention in respect of which the patent was granted, or any part thereof,

having been published prior to the date of the patent, if the patentee proves to the satisfaction of the court that the publication was made without his knowledge and consent, and that the matter published was derived or obtained from him, and, if he learnt of the publication before the date of his application for the patent, that he applied for and obtained protection for his invention with all reasonable diligence after learning of the publication.

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

Discon-
formity.

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

Patent on
application
of represen-
tative of de-
ceased in-
ventor.

(2) Every such application must contain a declaration by the legal representative that he believes him to be the true and first inventor of the invention.

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

Loss or de-
struction of
patent.

45.—(1) The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor to apply for and obtain a patent in respect of the invention or the validity of any patent granted on the application, provided that—

Provisions
as to exhibi-
tions.

(a) the exhibitor, before exhibiting the invention, gives the comptroller the prescribed notice of his intention to do so; and

(b) the application for a patent is made before or within six months from the date of the opening of the exhibition.

(2) His Majesty may by Order in Council apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the Order.

46.—(1) The comptroller shall issue periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that he may deem generally useful or important.

Publication
of illustrated
journal,
indexes, etc.

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

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

Patent
Museum.

47.—(1) The control and management of the Patent Museum and its contents shall remain vested in the Board of Education, subject to such directions as His Majesty in Council may think fit to give.

(2) The Board of Education may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model, the amount to be settled, in case of dispute, by the Board of Trade.

Foreign
vessels in
British
waters.

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

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

Part II. of the Act, comprising sections 49 to 61 deals solely with the Subject of Designs.

PART III.

GENERAL.

Patent Office and Proceedings thereat.

Patent Office.
5 Edw. 7,
c. 15.

62.—(1) The Treasury may continue to provide for the purposes of this Act and the Trade Marks Act, 1905, an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

(2) The Patent Office shall be under the immediate control of the comptroller, who shall act under the superintendence and direction of the Board of Trade.

(3) Any act or thing directed to be done by or to the comptroller may be done by or to any officer authorised by the Board of Trade.

(4) Rules under this Act may provide for the establishment of branch offices for designs at Manchester or elsewhere, and for any document or thing required by this Act to be sent to or done at the Patent Office being sent to or done at any branch office which may be established.

Officers and
clerks.

63.—(1) There shall continue to be a comptroller-general of patents, designs, and trade marks, and the Board of Trade may, subject to the approval of the Treasury, appoint the comptroller, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may remove any of those officers and clerks.

(2) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and those salaries and the other expenses of the execution of this Act and the Trade Marks Act, 1905, shall continue to be paid out of money provided by Parliament.

A.D. 1907.

64. Impressions of the seal of the Patent Office shall be judicially noticed and admitted in evidence.

Seal of Patent Office.

Fees.

65. There shall be paid in respect of the grant of patents and the registration of designs, and applications therefor, and in respect of other matters with relation to patents and designs under this Act, such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade, so however that the fees prescribed in respect of the instruments and matters mentioned in the First Schedule to this Act shall not exceed those specified in that Schedule.

Fees.

Provisions as to Registers and other Documents in Patent Office.

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

Trust not to be entered in registers.

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

Inspection of and extracts from registers.

68. Reports of examiners made under this Act shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, unless the court or officer having power to order discovery in such legal proceedings certifies that such production or inspection is desirable in the interests of justice, and ought to be allowed.

Privilege of reports of examiners.

69.—(1) Where an application for a patent has been abandoned, or become void, the specifications and drawings (if any) accompanying or left in connexion with such application, shall not, save as otherwise expressly provided by this Act, at any time be open to public inspection or be published by the comptroller.

Prohibition of publication of specifications, drawings, etc. where application abandoned, etc.

(2) Where an application for a design has been abandoned or refused the application and any drawings, photographs, tracings, representations, or specimens left in connexion with the application shall not at any time be open to public inspection or be published by the comptroller.

70. 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 connexion with an application for a patent or in any patent or any specification;
- (b) cancel the registration of a design either wholly or in respect of any particular goods in connexion with which the design is registered;

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(c) correct any clerical error in the representation of a design or in the name or address of the proprietor of any patent or design, or in any other matter which is entered upon the register of patents or the register of designs.

Entry of assignments and transmissions in registers.

71.—(1) Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, the comptroller shall, on request and on proof of title to his satisfaction, register him as the proprietor of a patent or design.

(2) Where any person becomes entitled as mortgagee, licensee, or otherwise to any interest in a patent or design, the comptroller shall, on request and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner in the register of patents or designs, as the case may be.

(3) The person registered as the proprietor of a patent or design shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the patent or design and to give effectual receipts for any consideration for any such assignment, licence, or dealing: Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other personal property.

Rectification of registers by court.

72.—(1) The court may, on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of patents or designs of any entry, or by any entry made in either such register without sufficient cause, or by any entry wrongly remaining on either such register, or by an error or defect in any entry in either such register, make such order for making, expunging, or varying such entry as it may think fit.

(2) The court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connexion with the rectification of a register.

(3) The prescribed notice of any application under this section shall be given to the comptroller, who shall have the right to appear and be heard thereon, and shall appear if so directed by the court.

(4) Any order of the court rectifying a register shall direct that notice of the rectification be served on the comptroller in the prescribed manner, who shall upon the receipt of such notice rectify the register accordingly.

Powers and Duties of Comptroller.

Exercise of discretionary power by comptroller.

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

Power of comptroller to take directions of law officers.

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

Refusal to

75. The comptroller may refuse to grant a patent for an invention, or

to register a design, of which the use would, in his opinion, be contrary to law or morality. A.D. 1907.

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

Evidence, &c.

77.—(1) Subject to rules under this Act in any proceeding under this Act before the comptroller the evidence shall be given by statutory declaration in the absence of directions to the contrary; but in any case in which the comptroller thinks it right so to do, he may take evidence *vivâ voce* in lieu of or in addition to evidence by declaration or allow any declarant to be cross-examined on his declaration. Any such statutory declaration may in the case of appeal be used before the court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit. Evidence
before comp-
troller.

(2) In case any part of the evidence is taken *vivâ voce*, the comptroller shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as an official referee of the Supreme Court.

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

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

80.—(1) Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after they have been accepted or allowed at the Patent Office. Transmission
of certified
printed
copies of
specifica-
tions, &c.

(2) Certified copies of or extracts from any such documents and of any documents so transmitted in pursuance of any enactment repealed by this Act shall be given to any person on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

81. Any application, notice, or other document authorised or required Applications

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and notices
by post.Excluded
days.Declaration
by infant,
lunatic, etc.

to be left, made, or given at the Patent Office or to the comptroller, or to any other person under this Act, may be sent by post.

82. Where the last day fixed by this Act for doing anything under this Act falls on any day specified in rules under this Act as an excluded day, the rules may provide for the thing being done on the next following day not being an excluded day.

83.—(1) If any person is, by reason of infancy, lunacy, or other disability, incapable of making any declaration or doing anything required or permitted by or under this Act, the guardian or committee (if any of the person subject to the disability, or, if there be none, any person appointed by any court possessing jurisdiction in respect of his property, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability.

(2) An appointment may be made by the court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making of the declaration or the doing of the thing.

Register of Patent Agents.

Register
of patent
agents.

84.—(1) A person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act or an Act repealed by this Act.

(2) Every person who proves to the satisfaction of the Board of Trade that prior to the twenty-fourth day of December, one thousand eight hundred and eighty-eight, he had been bonâ fide practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(3) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

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

Agents for
patents.

85.—(1) Rules under this Act may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any person whose name has been erased from the register of patent agents, or who is proved to the satisfaction of the Board of Trade, after being given an opportunity of being heard, to have been convicted of such an offence or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom, and may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any company which, if it had been an individual, the comptroller could refuse to recognise as such agent.

(2) Where a company or firm acts as agents, such rules as aforesaid may authorise the comptroller to refuse to recognise the company or firm as agent if any person whom the comptroller could refuse to recognise as

an agent acts as director or manager of the company or is a partner in the firm. A.D. 1907.

(3) The comptroller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in the United Kingdom or the Isle of Man.

Powers, &c., of Board of Trade.

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

Power for Board of Trade to make general rules.

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

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

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

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

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

(f) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad :

(g) For regulating the keeping of the register of patent agents under this Act :

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

(2) General rules shall whilst in force be of the same effect as if they were contained in this Act.

(3) Any rules made in pursuance of this section shall be advertised twice in the official journal to be issued by the comptroller, and shall be laid before both Houses of Parliament as soon as practicable after they are made, and if either House of Parliament, within the next forty days after any rules have been so laid before that House, resolves that the rules or any of them ought to be annulled, the rules or those to which the resolution applies shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under the rules or to the making of any new rules.

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

Proceedings of the Board of Trade.

(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person 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

A.D. 1907. any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

Provision as to Order in Council.

88. An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if it had been contained in this Act; but may be revoked or varied by a subsequent Order.

Offences.

Offences.

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

(2) If any person falsely represents that any article sold by him is a patented article, or falsely describes any design applied to any article sold by him as registered, he shall be liable for every offence, on conviction under the Summary Jurisdiction Acts, to a fine not exceeding five pounds.

(3) If any person sells an article having stamped, engraved, or impressed thereon or otherwise applied thereto the word "patent," "patented," "registered," or any other word expressing or implying that the article is patented or that the design applied thereto is registered, he shall be deemed for the purposes of this section to represent that the article is a patented article or that the design applied thereto is a registered design.

(4) Any person who, after the copyright in a design has expired, puts or causes to be put on any article to which the design has been applied the word "registered," or any word or words implying that there is a subsisting copyright in the design, shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding five pounds.

(5) If any person uses on his place of business, or on any document issued by him, or otherwise, the words "Patent Office," or any other words suggesting that his place of business is officially connected with, or is, the Patent Office, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

Unauthorised assumption of Royal Arms.

90.—(1) The grant of a patent under this Act shall not be deemed to authorise the patentee to use the Royal Arms or to place the Royal Arms on any patented article.

(2) If any person, without the authority of His Majesty, uses in connexion with any business, trade, calling, or profession the Royal Arms (or arms so nearly resembling them as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised to use the Royal Arms, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds:

Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing such arms to continue to use such trade mark.

International and Colonial Arrangements.

International and Colonial

91.—(1) If His Majesty is pleased to make any arrangement with the government of any foreign state for mutual protection of inventions, or

designs, or trade marks, then any person who has applied for protection for any invention, design, or trade mark in that state shall be entitled to a patent for his invention or to registration of his design or trade mark under this Act or the Trade Marks Act, 1905, in priority to other applicants; and the patent or registration shall have the same date as the date of the application in the foreign state.

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arrange-
ments.

Provided that—

(a) The application is made, in the case of a patent within twelve months, and in the case of a design or trade mark within four months, from the application for protection in the foreign state; and

(b) Nothing in this section shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the actual date on which his complete specification is accepted, or his design or trade mark is registered, in this country.

(2) The patent granted for the invention or the registration of a design or trade mark shall not be invalidated—

(a) in the case of a patent, by reason only of the publication of a description of, or use of, the invention; or

(b) in the case of a design, by reason only of the exhibition or use of, or the publication of a description or representation of, the design; or

(c) in the case of a trade mark, by reason only of the use of the trade mark.

in the United Kingdom or the Isle of Man during the period specified in this section as that within which the application may be made.

(3) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act or the Trade Marks Act, 1905: Provided that—

(a) In the case of patents the application shall be accompanied by a complete specification, which, if it is not accepted within the twelve months from the application for protection in the foreign state, shall with the drawings (if any) be open to public inspection at the expiration of that period; and

(b) In the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under the Trade Marks Act, 1905.

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

(5) Where it is made to appear to His Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for His Majesty, by Order in Council, to apply the provisions of this section to that possession, with such variations or additions, if any, as may be stated in the Order.

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*Definitions.*Provisions
as to "the
court."

92.—(1) In this Act, unless the context otherwise requires, "the court" means, subject to the provisions as to Scotland, Ireland, and the Isle of Man, the High Court in England.

(2) Where by virtue of this Act a decision of the comptroller is subject to an appeal to the court, or a petition may be referred or presented to the court, the appeal shall, subject to and in accordance with rules of the Supreme Court, be made and the petition referred or presented to such judge of the High Court as the Lord Chancellor may select for the purpose, and the decision of that judge shall be final, except in the case of an appeal from a decision of the comptroller revoking a patent on any ground on which the grant of such patent might have been opposed.

Definitions.

93. In this Act, unless the context otherwise requires,—

"Law officer" means the Attorney-General or Solicitor-General for England :

"Prescribed" means prescribed by general rules under this Act :

"British possession" does not include the Isle of Man or the Channel Islands :

"Patent" means letters patent for an invention :

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

"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 :

"Inventor" and "applicant" shall, subject to the provisions of this Act, include the legal representative of a deceased inventor or applicant :

"Design" means any design (not being a design for a sculpture or other thing within the protection of the Sculpture Copyright Act, 1814) applicable to any article, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined :

"Article" means (as respects designs) any article of manufacture and any substance artificial or natural, or partly artificial and partly natural :

"Copyright" means the exclusive right to apply a design to any article in any class in which the design is registered :

"Proprietor of a new and original design,"—

(a) Where the author of the design, for good consideration,

54 Geo. 3,
c. 56.

executes the work for some other person, means the person for whom the design is so executed; and

(b) Where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired; and

(c) In any other case, means the author of the design; and where the property in, or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person.

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Application to Scotland, Ireland, and the Isle of Man.

94. In the application of this Act to Scotland—

Application
to Scotland.

- (1) In any action for infringement of a patent in Scotland the provisions of this Act with respect to calling in the aid of an assessor shall apply, and the action shall be tried without a jury, unless the court otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those courts; and for the purposes of the provisions so applied "court of appeal" shall mean any court to which such action is appealed:
- (2) Any offence under this Act declared to be punishable on conviction under the Summary Jurisdiction Acts may be prosecuted in the sheriff court:
- (3) Proceedings for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only, and service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act:
- (4) The provisions of this Act conferring a special jurisdiction on the court as defined by this Act shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland in any proceedings relating to patents or to designs; and with reference to any such proceedings, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of that Court:
- (5) Notwithstanding anything in this Act, the expression "the court" shall, as respects petitions for compulsory licences or revocation which are referred by the Board of Trade to the Court in Scotland, mean any Lord Ordinary of the Court of Session, and shall in reference to proceedings in Scotland for the extension of the term of a patent mean such Lord Ordinary:
- (6) The expression "Rules of the Supreme Court" shall, except in section ninety-two of this Act, mean act of sederunt:

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(7) If any rectification of a register under this Act is required in pursuance of any proceeding in a court, a copy of the order, decree, or other authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly :

(8) The expression " injunction " means " interdict."

Application to Ireland.

95. In the application of this Act to Ireland—

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

(2) The provisions of this Act conferring a special jurisdiction on the court, as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Ireland in any proceedings relating to patents or to designs ; and with reference to any such proceedings the term " the Court " means the High Court in Ireland :

(3) If any rectification of a register under this Act is required in pursuance of any proceeding in a court, a copy of the order, decree, or other authority for the rectification shall be served on the comptroller, and he shall rectify the register accordingly.

Isle of Man.

96. This Act shall extend to the Isle of Man, subject to the following modifications :—

(1) Nothing in this Act shall affect the jurisdiction of the courts in the Isle of Man in proceedings for infringement, or in any action or proceeding respecting a patent or design competent to those courts :

(2) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the court :

(3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered, at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Repeal, Savings, and Short Title.

Saving for prerogative.

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

Repeal and savings.

98.—(1) The enactments mentioned in the Second Schedule to this Act are hereby repealed to the extent specified in the third column of that schedule—

(a) As respects the enactments mentioned in Part I, of that schedule, as from the commencement of this Act ;

(b) As respects the enactments mentioned in Part II, of that schedule, as from the date when rules of the Supreme Court regulating the matters dealt with in those enactments come into operation ;

(c) As respects the enactments mentioned in Part III, of that schedule,

as from the date when rules under this Act regulating the matters dealt with in those enactments come into operation ;

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and the enactments mentioned in Part II. and Part III. of that schedule shall, until so repealed, have effect as if they formed part of this Act :

Provided that this repeal shall not affect any convention, Order in Council, rule, or table of fees having effect under any enactment so repealed, but any such convention, Order in Council, rule, or table of fees in force at the commencement of this Act shall continue in force, and may be repealed, altered or amended, as if it had been made under this Act.

(2) Except where otherwise expressly provided, this Act shall extend to all patents granted and all designs registered before the commencement of this Act, and to applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

99. This Act may be cited as the Patents and Designs Act, 1907, and shall, save as otherwise expressly provided, come into operation on the first day of January one thousand nine hundred and eight.

Short title
and com-
mencement.

SCHEDULES.

Section 65.

FIRST SCHEDULE.

FEES ON INSTRUMENTS FOR OBTAINING PATENTS AND RENEWAL.

(a) *Up to sealing.*

	£	s.	d.	£	s.	d.
On application for provisional protection	-	-	1 0 0			
On filing complete specification	-	-	3 0 0			
				<u>4</u>	<u>0</u>	<u>0</u>
<i>or</i>						
On filing complete specification with first application				4	0	0
On the sealing of the patent in respect of investigations as to anticipation	-	-	-	1	0	0

(b) *Further before end of four years from date of patent.*

On certificate of renewal	-	-	-	50	0	0
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(c) *Further before end of eight years from date of patent.*

On certificate of renewal	-	-	-	100	0	0
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Or in lieu of the fees of £50 and £100 the following annual fees :

Before the expiration of the fourth year from the date of the patent	10	0	0
" " " fifth	10	0	0
" " " sixth	10	0	0
" " " seventh	10	0	0
" " " eighth	15	0	0
" " " ninth	15	0	0
" " " tenth	20	0	0
" " " eleventh	20	0	0
" " " twelfth	20	0	0
" " " thirteenth	20	0	0

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Section 98.

SECOND SCHEDULE.

ENACTMENTS REPEALED.

PART I.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	The whole Act, except subsections (5), (6), and (7) of section twenty-six, section twenty-nine, subsections (2) and (3) of section forty-seven, and section forty-eight.
48 & 49 Vict. c. 63.	The Patents, Designs, and Trade Marks (Amendment) Act, 1885.	The whole Act.
49 & 50 Vict. c. 37.	The Patents Act, 1886 ..	The whole Act.
51 & 52 Vict. c. 50.	The Patents, Designs, and Trade Marks Act, 1888.	The whole Act.
1 Edw. 7. c. 18.	The Patents Act, 1901 ..	The whole Act.
2 Edw. 7. c. 34.	The Patents Act, 1902 ..	The whole Act.
7 Edw. 7. c. 28.	The Patents and Designs (Amendment) Act, 1907.	The whole Act.

PART II.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Subsections (5), (6), and (7) of section twenty-six, and section twenty-nine.

PART III.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Subsections (2) and (3) of section forty-seven and section forty-eight.

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FORM A.

FORM OF PATENT.

EDWARD VII, by the Grace of God, of the United Kingdom of Great Britain and Ireland and of the British Dominions beyond the Seas King, Defender of the Faith, Emperor of India: To all to whom these presents shall come greeting:

WHEREAS

hath declared that he is in possession of an invention for

that he claims to be 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 a patent might be granted unto him for the sole use and advantage of his said invention:

And whereas the said inventor (herein-after together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) 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 license, 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 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 license or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned:

Provided always that these letters patent shall be revocable on any of the grounds from time to time by law prescribed as grounds for revoking letters patent granted by Us and the same may be revoked and made void

A.D. 1907.

accordingly: 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 herein-before contained: Provided also that nothing herein contained shall prevent the granting of licenses 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 and to be sealed as of the

one thousand nine hundred

and

*
*Comptroller-General of Patents, Designs,
and Trade Marks.*



The form of a patent of addition varies slightly from the above.

* Here is to be inserted the name of the Comptroller-General.

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