

out ultimately to be in the right." In the same case the Master of the Rolls, Sir W. B. Brett, said (*g*): "There will be a hardship on the one side or on the other, and the question is on which side does the balance appear to lie? Now, if the trade of a defendant be an old and established trade, I should say that the hardship upon him would be too great if any injunction were granted. But where, as here, the trade of the defendant is a new trade, and he is the seller of goods to a vast number of people, it seems to me to be less inconvenient and less likely to produce irreparable damage to stop him from selling, than it would be to allow him to sell and merely keep an account, thus forcing the plaintiff to commence a multitude of actions against the purchasers."

The evidence to be used upon an application for an interlocutory injunction is upon affidavit.

Evidence on  
interlocutory  
application.

The affidavit should clearly point out in what the alleged infringement consists (*h*). If the plaintiff is the first inventor, he must distinctly swear to the fact, as also to the novelty and utility of the invention, and to the due filing of a sufficient specification (*i*). If the plaintiff is an assignee, he must swear to the best of his belief (*j*). The affidavits in either case must state the facts as at the time of swearing, and it is not sufficient to swear that the invention was believed to be new when the patent was granted (*k*). Affidavits on "information and belief" must state the sources of the information (*l*). An injunction granted prior to statement of claim will be dissolved if the statement of claim when delivered does not agree with the affidavits upon which the injunction was granted (*m*).

In the Chancery Division it is the practice to hear applications for interlocutory injunctions as motions in Court. In the

(*g*) At p. 292.

1895, 12 P. O. R. 310.

(*h*) *Hill v. Thompson*, 1817, 3 Mer. 624; *Lister v. Norton*, 1884, 1 P. O. R. 116.

(*j*) *Gardner v. Broadbent*, 1856, 2 Jur. N. S. 1041.

(*i*) *Hill v. Thompson*, 1817, 3 Mer. 624; *Sturtz v. De la Rue*, 1828 (per Lord Lyndhurst), 5 Russ. 329; *Whitton v. Jennings*, 1860, 1 Dr. & S. 110; *Clarke v. Nichole*,

(*k*) *Hill v. Thompson*, 1817, 3 Mer. 624.

(*l*) *The Saccharin Corporation v. Chemicals Co.*, 1898, 15 P. O. R. 55.

(*m*) *Stocking v. Llewellyn*, 1842, 3 L. T. 33.

King's Bench Division the application is heard by the Judge in Chambers upon a summons.

Forms of injunction upon undertaking as to damages, and of order refusing injunction upon terms, will be found in the Appendix.

Order for  
delivery up  
or destruc-  
tion.

After trial and judgment, and upon application for a perpetual injunction, when the nature of the infringing matter will permit of it, an order will be made that the articles (machinery or otherwise) be delivered up to the plaintiff or destroyed (*n*). This was done in *Plimpton v. Malcolmson* (ref. M.R., 28th Jan. 1876, B. 381) (*supra*). But where by reason of the nature of the invention such an order would be unreasonable, it will not be granted (*o*). An inquiry will, when necessary, be directed as to the articles manufactured which are in the defendant's possession, and that they be destroyed (*Betis v. De Vitre* (ref. V.-C. W., 1865, A. 119)). The defendant will also be ordered to make discovery upon oath of the articles or machinery which he may have in his possession, and which infringe the plaintiff's patent, so that they may be delivered up and destroyed (*p*). The right of property in the articles which infringe the patent remains in the infringer, although the Court may order the articles to be destroyed (*q*).

Discovery by  
defendant.

These mandatory orders are never made except after trial, and when the plaintiff has fully established to the satisfaction of the Court the validity of his patent and the fact of the defendant's infringement.

#### DAMAGES.

In addition to an injunction, the defendant may be entitled, when there has been actual infringement as distinguished from an intention to infringe, to either damages or an account of sales and profits.

(*n*) *Frearson v. Loe*, L. R. 9 Ch. D. at p. 67.

(*o*) *United Telephone Co. v. London and Globe Co.*, 1884, L. R. 26 C. D. 776; *Siddell v. Vickers*, 1888, 5 P. O. R. 101.

(*p*) *Westinghouse v. Lancashire and Yorkshire Ry. Co.*, 1884, 1 P. O. R. 253; *Edison-Bell Phonograph Co. v. Smith*, 1894, 11 P. O. R. 406.

(*q*) *Vavasseur v. Krupp*, 1878, L. R. 9 Ch. D. 351.

He is not entitled to both damages and an account, but he must elect which he will take (r).

In taking an account of profits, the plaintiff condones the infringement and does not complain of it, but claims all the profits as though they had been made by a trustee for him (s).

The measure of damage is not the profit made by the infringer, but is the loss which the plaintiff has actually sustained (t). The question of damages is not synonymous with an account of profits, the basis of calculation being entirely different. Measure of damage.

“The loss must be the natural and direct consequence of the respondent’s acts” (u); consequently the damages will be the estimated loss of profit incurred by the plaintiff by reason of the sale by the defendant of articles which infringed the plaintiff’s patent. Such a question must be one of considerable difficulty and can only be decided by a fair businesslike view of all the circumstances of the case.

A probable result of the sale by the defendant, of articles which infringe the plaintiff’s patent, is a reduction in price owing to the commercial competition, and a consequent loss of profit to the plaintiff; whether this source of damage may or may not be taken into consideration will depend upon the circumstances of the case.

In *The United Horseshoe and Nail Co. v. Stewart* (1886, 3 P. O. R. 143; 4 P. O. R. 130; 5 P. O. R. 260), loss of profit arising from such competition was not allowed. In that case the patent in question was one for a machine to produce horse-shoenails more cheaply than had been done before. Consequently anyone else could make nails in competition with the plaintiffs; they were only restrained from making them by means of that particular description of machine, and further the plaintiffs had always gone a little before the defendants in reducing their

(r) *Neilson v. Belts*, 1871, L. R. 5 H. L. 22; *De Vitre v. Belts*, 1873, L. R. 6 H. L. 321; *United Horseshoe and Nail Co. v. Stewart*, 1886, 3 P. O. R. 143; 5 P. O. R. 268.

(s) See note (r) and *The Saccharin Corporation v. Chemicals Co.*, 1900, 17 P. O. R. 615

(t) *United Horseshoe and Nail Co. v. Stewart*, 1886, 3 P. O. R. at p. 143; 5 P. O. R. at p. 267.

(u) Per Lord Macnaghten, *United Horseshoe and Nail Co. v. Stewart*, 1886, 5 P. O. R. at p. 268; see also *American Braided Wire Co. v. Thomson*, 1890, 7 P. O. R. 152.

price, and so continually kept the price lower than that quoted by the defendants. But it must be clear that the reduction in the plaintiff's prices has been the result of the defendant's competition, and not of the ordinary exigencies of trade (*x*).

In *The American Braided Wire Co. v. Thomson* (1890, 7 P. O. R. 152), the patent infringed was one for the manufacture of a particular form of bustle; no one else being able to put a similar bustle on the market without infringing that patent, the plaintiffs did not reduce their prices until compelled to do so by the defendants, and then only reduced them to the level quoted by the defendants. The official referee in his finding said: "But for the defendants' competition and their selling at lower prices the plaintiffs would, subject to the allowances mentioned in paragraphs 2, 3, and 4, have made the sales made by the plaintiffs and also those made by the defendants at the plaintiffs' original prices." Taking all these circumstances into consideration, the Court of Appeal held that the finding of the official referee was reasonable and fair, and that the plaintiffs were entitled to the full amount so found, including the loss of profit arising from the competition of the defendants.

Difference  
between  
damages and  
profits.

Therefore the investigation involved on an inquiry into damages is wider than on taking an account of profits, since in the former the loss incurred by the plaintiff by having his article shouldered out of the market must be considered, *i.e.*, his manufacturer's profits. But there may be cases in which the whole profit of the plaintiff is derived from the granting of licenses, and in such a case the damages might very properly be fixed at the amount which the defendants would have had to pay in royalties, as in such a case there could be no loss by reason of competition (*y*). These aspects of the question were clearly dealt with by the Court of Appeal in *The Pneumatic Tyre Co. v. The Puncture-Proof Pneumatic Tyre Co.* (1899, 16 P. O. R. 212), which has been followed in *The British Motor Syndicate v. Taylor and Sons* (1900, 17 P. O. R. 194, 730).

(*x*) *Alexander v. Henry*, 1895, 12 Eq. 85; *English and American Machinery Co. v. Union Boot and*

(*y*) *Penn v. Jack*, 1867, L. R. 5 *Shoe Co.*, 1896, 13 P. O. R. 67.

In estimating the amount of damage by competition, or by injuring the reputation of the plaintiff's goods, it is of course impossible to name any precise sum, and it will always be a matter largely for individual judgment and discretion.

In *Ungar v. Sugg* (1891, 8 P. O. R. 388), Wright, J., said: "No one can doubt that in this case there was substantial damage, and the difficulty and impossibility of stating the precise ground for assessing it at any particular figure does not seem to be a sufficient reason for giving only a nominal sum"; and Lord Esher, M.R., in the Court of Appeal, said (1892, 9 P. O. R. 117): "They were problematical damages, and had to be what is called guessed at: that is, not a mere guess, as if you were tossing up for the thing, but it must come to a mere question of what, in the mind of the person who has to estimate them, was a fair sum."

The estimation of loss by competition will depend, of course, on the facts of each particular case, but it is unlikely that such damages will be given against a mere user (z).

The fact that only part of the machine is an infringement is immaterial, since each thing produced by the assistance of such part is itself an infringement of the plaintiff's patent, and to that extent occasions damage by interfering with the plaintiff's trade.

The fact that a patentee has recovered judgment and damages against a manufacturer of infringing articles does not preclude him from taking further proceedings against the purchasers of infringing articles from such manufacturer (a). But the damages recoverable in respect of each infringement must be confined to that infringement only. Therefore, as the damages recoverable from the user may be a merely nominal amount, it may be wiser to take an account of profits in this case (b).

In aid of the inquiry as to damages, directed by the judgment for a perpetual injunction, the defendant must give full discovery, and will be required to set out the names and addresses of the persons to whom machines, made in infringement of the patent,

Discovery on inquiry into damages.

(z) *Boyd v. The Tootal Broadhurst Walker*, 1887, 4 P. O. R. 66.  
*Lee Co.*, 1894, 11 P. O. R. 185. (.) See *Gavioli v. Shepherd*, 1900,  
 (a) *United Telephone Co. v.* 17 P. O. R. 157.

have been sold (c) ; but not the names of the agents concerned in the transaction (d).

#### ACCOUNT OF SALES AND PROFITS.

Account of profits.

In cases where it is deemed to the advantage of the plaintiff, he may elect, in lieu of damages, to take an account of sales and profits; that is, to condone the infringement upon the footing that the defendant has been acting as the plaintiff's agent in selling or using the invention (e).

An inquiry as to profits is one which involves many questions of great difficulty (f), and in consequence is usually attended by a great expenditure both of time and money; "therefore, although the law is that a patentee has a right to elect which course he will take, as a matter of business he would generally be inclined to take an inquiry as to damages rather than launch upon an inquiry as to profits" (g).

Not where acquiescence.

The plaintiff will not be allowed to claim an account if he has tacitly permitted the defendant to infringe his patent, relying upon an ultimate account of profits. In *Crossley v. The Derby Gas Light Co.*, Lord Brougham said: "It is a principle of equity, that a party who claims a right should not lie by, and by his silence or acquiescence induce another to go on spending his money and incurring risk, and afterwards, if profit has been made, come and claim a share in that profit without having ever been exposed to share in the losses which might have been sustained. Upon this the defendants rely; but it was to be considered, on the other hand, whether the plaintiff did not explain the delay which has taken place, and whether the conduct of the defendants has not been such as to lull the plaintiff's suspicions to sleep."

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|--|---|
| <p>(c) <i>Murray v. Clayton</i>, 1872, L. R. 7 Ch. 570; L. R. 15 Eq. 115; <i>American Braided Wire Co. v. Thomson</i>, 1888, 5 P. O. R. 375; <i>Saccharin Corporation v. Chemicals Co.</i>, 1900, 17 P. O. R. 615.</p> <p>(d) <i>Murray v. Clayton</i>, 1872, L. R. 15 Eq. 115.</p> <p>(e) <i>Betts v. De Vitre</i>, 1873, L. R.</p> | <p>6 H. L. 319; <i>United Horsenail Co. v. Stewart</i>, 1886, 3 P. O. R. 143.</p> <p>(f) <i>Siddell v. Vickers</i>, 1889, 6 P. O. R. 464, 467; 9 P. O. R. 152.</p> <p>(g) Per Lindley, L.J., in <i>Siddell v. Vickers</i>, 9 P. O. R. at p. 163. And Romer, J., in <i>The Automatic Coal-Gas Reort Co. v. Salford</i>, 1897, 14 P. O. R. 471.</p> |
|--|---|

Where it appears at the trial that the defendant has made no profit, although the plaintiff may be entitled to damages, he will not be entitled to an account (*h*).

The plaintiff is entitled to full discovery on oath, including the names of customers supplied (*i*).

Where the defendant has acted in ignorance of the patent, and before action has offered to submit to an account and to pay to the plaintiff the amount of profits, the Court should exercise its discretion in disallowing costs (*k*), although it may grant the injunction. In such a case the plaintiff will proceed to an account at his peril, running the risk of nothing being found due.

Prior to the Judicature Acts it was held a rule in Courts of Equity that, in consequence of the terms of 21 & 22 Vict. c. 27, no relief could be awarded for damages or an account, unless an injunction could be granted at the same time; all other relief being merely incidental to the injunction (*l*). Thus, where a patent had expired after bill filed, but before an injunction could be granted, the Court declined to consider the question of damages (*m*). But now, in pursuance of sect. 24, sub-sect. 6, of the Judicature Act, 1873, a Court of Equity may give full relief; and so, wherever a court of law would, prior to the passing of the Act, have granted damages or an account, similar orders will be made by either branch of the High Court of Justice, irrespective of the question of injunction.

(*h*) *Bacon v. Spottiswood*, 1839, 1 Beav. 387.

34 Beav. 595; *Kedges v. Mulliner*, 1893, 10 P. O. R. 21, 28.

(*i*) *Saccharin Corporation v. Chemicals Co.*, 1900, 17 P. O. R. 615.

(*l*) *Price's Patent Candle Co. v. Bauwen's Patent Candle Co.*, 1858, 4 K. & J. 727.

(*k*) *Nunn v. D'Almeida*, 1865,

(*m*) *Betts v. Gallais*, 1870, L. R. 10 Eq. 392.

## CHAPTER XIX.

## PRACTICE IN AN ACTION FOR INFRINGEMENT.

**The writ.**

AN action for infringement is commenced by writ issued out of the High Court of Justice.

Subject to the special provisions of the Patents, &c. Acts, the rules of the Supreme Court apply to actions for infringement of patents and petitions for revocation (*a*).

The writ may be issued either in the King's Bench or in the Chancery Division, but the machinery of the latter tribunal is the more suitable for this class of case.

In nearly all actions for infringement, the writ is indorsed with a claim for (1) an injunction; (2) damages, or, in the alternative and at the option of the plaintiffs, an account of sales and profits; and (3) delivery up to the plaintiffs or destruction of all infringing articles in the possession of the defendants. If the patent has expired, there cannot, of course, be a claim for an injunction.

Service of a writ in Scotland for an infringement in England will be allowed (*b*).

## STATEMENT OF CLAIM.

**Statement of claim.**

Ord. XIX. rule 26, provides: "No technical objection shall be raised to any pleading on the ground of any alleged want of form;" but by rule 27 the power of the Court to strike out pleadings on the grounds that they are unnecessary, scandalous, or embarrassing, is preserved.

(*a*) *Haddan's Patent*, 1884, 54  
L. J. Ch. 126; Griff. P. C. 108.

(*b*) *Speckhart v. Campbell, Achnach & Co.*, Solr. Journ. Feb. 2nd, 1884.



Ord. XIX. rule 4, requires all material facts to be pleaded, and prohibits the pleading of evidence. Rule 5 is as follows:—  
 “The forms in Appendices (C., D., and E.), when applicable, and where they are not applicable forms of the like character, as near as may be, shall be used for all pleadings, and where such forms are applicable and sufficient, any longer form shall be deemed prolix, and the costs occasioned by such prolixity shall be disallowed to or borne by the party so using the same, as the case may be.”

The forms mentioned relate to pleadings in an action for the infringement of a patent, but there is no provision made for the case where infringement has only been threatened, nor for the case when a mandatory order or an account of sales and profits is required.

It is unnecessary to allege either that the plaintiff or the original patentee was the first and true inventor (c), or that the invention is new (d). If the specification has been amended, it is better to plead the fact, and that the original specification was framed in good faith and with reasonable skill and knowledge (e), since, by sect. 20 of the Act of 1883 (see p. 206, ante), no damages are recoverable in respect of infringements committed prior to the amendment unless the patentee can satisfy the Court that it was so framed.

Validity need not be pleaded.

Previous amendment should be pleaded.

If a certificate of validity has been granted in a previous action so as to entitle the plaintiff to solicitor and client costs under sect. 29 (6) of the Act of 1883, the certificate and the claim to such costs should be pleaded (f).

Also certificate of validity.

#### PARTICULARS OF BREACHES.

Particulars of breaches were required to be delivered in every action for the infringement of a patent by sect. 41 of the Patent Law Amendment Act, 1852; and now, by sect. 29 (1) of the Act of 1883, it is provided:—“*In an action for infringement of a*

Particulars of breaches. The statute.

(c) See *Ward v. Hill*, 1901, 18 P. O. R. 491.

(d) *Amory v. Brown*, 1869, L. R. 8 Eq. 664.

(e) *Kane and Pattison v. Boyle*, 1901, 18 P. O. R. 337.

(f) *The Pneumatic Tyre Co. v. Chisholm*, 1896, 13 P. O. R. 489.

patent the plaintiff must deliver with his statement of claim, or by order of the Court or the judge at any subsequent time, particulars of the breaches complained of; (4) at the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered; (5) particulars delivered may be from time to time amended by leave of the Court or a judge."

**Object of particulars.**

Particulars of breaches are particulars of the times, places, occasions, and manner in which the plaintiff says the defendant has infringed his letters patent. The defendant must have full, fair, and distinct notice of the case to be made against him (g). In *Batley v. Kynoch* (1874, L. R. 19 Eq. 231), Sir James Bacon, V.-C., said: "All that is required and provided by the Patent Law Amendment Act, 1852, which has made no alteration in the practice to be observed in these cases, is that the defendants shall not be taken by surprise, and it is the duty of the judge to take care that by the particulars of breaches they shall have full and fair notice of the case that they will have to meet."

It had undoubtedly prior to the passing of the Patent Law Amendment Act, 1852, been the practice of the Courts to compel plaintiffs to give particulars of breaches, and the cases which were then decided as to the sufficiency of particulars are applicable now; for then, as now, the object was that the defendant should be warned with reasonable certainty of the case that was to be made against him.

The plaintiff cannot be required to place a construction upon his patent in his particulars of breaches (h).

**How different from objections.**

The requirements of particulars of objections differ materially from those of particulars of breaches. In the case of objections taken by the defendant to the plaintiff's patent, it is essential that each objection should be set out in detail and that the defendant should be tied down to the particular instances of anticipation which he discloses in those particulars, since the

(g) *Needham v. Oxley*, 1863, 1 H. & M. 248; *Mandleberg v. Morley*, 1893, 10 P. O. R. 256. (h) *Wenham Co. v. Champion Gas Co.*, 1891, 8 P. O. R. 22.

objections to be taken by the defendant at the trial cannot otherwise lie within the plaintiff's knowledge, whereas in the case of particulars of breaches, to use the words of Bristowe, V.-C. (i): "You must always bear this in mind, that the plaintiff, asserting his patent, knows what he claims, and he says, 'I tell the public according to that which I am bound to do by the specification that which I do claim'; and the defendant well knows, or the defendants, as in this case, perfectly well know what they are doing." Consequently to fulfil the object for which such particulars are required, it is only necessary for the plaintiff to indicate what patent or portions of what patent he relies upon, and in what way he considers the defendant to have infringed, and if these two points be made clear without adducing specific instances, that will be sufficient.

When the patent consists of two or more processes, or distinct and separable inventions, particulars of breaches should distinguish which of the processes it is alleged has been infringed (k), and should particularly indicate what parts of the defendant's machine or manufactured article are claimed to constitute an infringement (l); but when the process was one entire invention, the Court declined to compel the plaintiff to point out the particular parts of the specification which were alleged to be infringed. Jervis, C.J., said: "If the two processes described in the specification are wholly distinct from each other, and the defendant's process may be an infringement of the one and not of the other, he ought to have better particulars; but if the whole is substantially one process, he is not entitled to them. . . . We must not make the particulars more complicated than the specification" (m).

Should point out what part of patent infringed.

(i) *Cheetham v. Oldham*, 1888, 5 P. O. R. at p. 626; see also *Talbot v. La Roche*, 1854, 15 C. B. at p. 321; *Ledgard v. Bull*, 1886, L. R. 11 App. Cas. 648; *Haslam v. Hall*, 1887, 4 P. O. R. 206.

(k) *Haslam v. Hall*, 1887, 4 P. O. R. 203; *Cheetham v. Oldham*, 1888, 5 P. O. R. at p. 628.

(l) *Lamb v. Nottingham Manufacturers' Co.*, 1874, Seton, 4th ed. 349.

(m) *Talbot v. La Roche*, 1854, 15 C. B. 310; see also *The Electric Telegraph Co. v. Nott*, 1847, 4 C. B. 462; *Tilghman's, &c. v. Wright*, 1884, Griff. P. C. 216; 1 P. O. R. 103; *Egleton v. Nichols*, 1890, 7 P. O. R. 423.

As a general rule it is not necessary to state the lines in the letterpress of the specification upon which the plaintiff relies, an indication of the claims being all that is required. In *Church v. Wilson* (1886, 3 P. O. R. 127) (n), Grove, J., said: "It seems to me that the plaintiffs have given more information indeed than is necessary; and merely to involve the information in some other form of words, or to mark the parts of the specification of which they complain, when there are claims, seems to me quite unnecessary. What it might be where the machines are not given, or where the specification has no specific claims, but only a description of the invention and a general claim of novelty, is a very different thing" (o).

When type only of infringement may be given.

Where the plaintiff's patent is of a simple nature, such, for instance, as the manufacture of a particular form of cartridge, and the articles made by the defendant must be infringements in every respect or not at all, it has been held sufficient to give one or two specific instances to denote the type of infringement complained of coupled with general words, so as not to confine the plaintiff to those particular instances at the trial of the action (p), but general words will not be allowed should they tend to embarrass the defendant (q).

Sometimes postponed until after discovery.

Further particulars of breaches will sometimes be postponed to discovery on the ground that the defendant knows the breaches which he has committed better than the plaintiff (r).

Where defendant is vendor.

Where an action is brought against the vendor of articles alleged to have been made by a process which infringed the plaintiffs' patent, a greater degree of precision is required in the particulars of breaches than if the defendant was the manufacturer himself.

In *Mandleberg v. Morley* (1893, 10 P. O. R. 260), Stirling, J., said: "Now if a manufacturer is attacked for infringing a

(n) See also *Cheetham v. Oldham*, 1888, 5 P. O. R. at p. 627.

(o) Note *Lamb v. Nottingham Manufacturers' Co.*, 1874, Seton, 4th ed. 349.

(p) *Talbot v. La Roche*, 1854, 1; O. B. 310; *Batley v. Kynock*, 1874,

L. R. 19 Eq. 229; *Tilghman v. Wright*, 1884, 1 P. O. R. 103.

(q) *The Patent Type Foundry Co. v. Richard*, 1860, 2 L. T. N. S. 259; *Church v. Wilson*, 1886, 3 P. O. R. 123.

(r) *Russell v. Hatfield*, 1885, Griff. P. C. 204; 2 P. O. R. 144.

patent by a particular process he does not want to be told in the shape of particulars, or otherwise, what the process is he is using. He knows what the process he is using is. But it is a very different thing with respect to a vendor. The vendor does not know with certainty what process is being used by the person from whom he himself buys, and who manufactures the article."

In that case the particulars of breaches alleged that: "The plaintiffs complain that each of the said letters patent of the plaintiffs have been infringed by the sale and exposure for sale by the defendants of each of the said garments, known as 'The Champion,' and 'The Distingué,' and by the sale and exposure for sale of other waterproof garments made by the manufacturers of 'The Champion,' 'The Distingué,' and 'The Tropical Odourless,' but not bearing their distinguishing names, but which unnamed garments are manufactured by similar processes to the three named garments." It was held that the reference to unnamed garments was not sufficiently specific, as it was not clear that the unnamed garments referred to were substantially the same as those which were specifically mentioned.

If the particulars delivered are too general, the defendant should apply for further and better particulars.

Further and better particulars.

If at the trial evidence is tendered which comes within the literal meaning of the particulars it will be admitted, notwithstanding that the particulars are too general, as the defendant should have objected to the particulars, and not have waited until the trial to take his objection (s).

The plaintiff having delivered particulars of breaches specifying certain sales by the defendant of rollers, and in particular to Shaw and Smith, the defendant, in answer to interrogatories, admitted sales to Hirst. Fry, J., in giving judgment, said: "In this case I think I must admit the evidence tendered in respect of Hirst's case. It is said that in respect of those cases which are not mentioned by name in the particulars of breaches, the plaintiff cannot give evidence. It may be that the particulars were not sufficient, or tended to embarrass. But the defendant

(s) *Hull v. Ballard*, 1856, 25 L. J. Ex. 304.

did not apply for amended particulars, according to the case of *Hull v. Collard*. It appears to me I have to inquire what is the meaning of the particulars. I find the case of Hirst is within the literal meaning of the particulars. If I had found that the case of Hirst was likely to create surprise, or likely to introduce any point not raised by Smith's or Shaw's case, I should probably have given an opportunity to the defendant to bring fresh evidence. I have asked whether there is any witness not here whom the defendants would desire to bring in respect of Hirst's case, and have received no satisfactory answer on that point, and must assume that there is no such witness" (t).

Conversely where the particulars of breaches complained only of infringement by user, the Court refused to enter into the question as to whether there had been infringement by manufacturing the articles complained of (u).

Particulars  
in other than  
infringement  
actions.

Particulars of breaches, as we have seen, may also be ordered in actions which are not strictly actions for the infringement of patents; this is done under the ordinary jurisdiction of the Court (x). In an action charging that the defendant falsely and maliciously wrote and told persons who had bought certain machines of the plaintiffs that the machines were infringements of his, the defendant's patents, the defendant having pleaded not guilty, the Court ordered the defendant to deliver particulars, showing in what part the plaintiffs' machines were an infringement of the defendant's patents, and pointing out by reference to the page and line of the defendant's specifications, which part of the inventions therein described he alleged to have been infringed (y).

Where claim  
for injunction  
only.

Where the plaintiff claiming an injunction, relies on certain acts of the defendant as evidence of an intention to infringe in the future, the defendant is entitled to full notice of the nature of the infringements he is alleged to be contemplating, especially where such acts have been committed since action brought (z).

(t) *Sykes v. Howarth*, 1879, L. R. 12 Ch. D. 826. Web. P. C. 269.

(u) *Henser v. Hardie*, 1894, 11 P. O. R. 421, 427. 4 Q. B. 213.

(z) See *The Shoe Machinery Co. v. Cutlan*, 1895, 12 P. O. R. 357.

(x) *Perry v. Mitchell*, 1840, 1

## STATEMENT OF DEFENCE.

The statement of defence in patent actions is now, under the rules of the Supreme Court, a very brief and concise document, giving no particulars or details whatever, and remitting the plaintiff to the particulars of objections and the answers to the interrogatories for information as to the case which is to be made against him. Under Order XIX. rule 5, the form given in Appendix (D.), sect. VI., is rendered obligatory. That form merely gives headings of defence which is all that is to be allowed; for instance:—“(1) That the defendant did not infringe the patent; (2) The invention was not new; (3) The plaintiff was not the first and true inventor; (4) The invention was not useful; (5) The patent was not assigned to the plaintiff.” And to these might be added:—“(6) That the provisional specification, and the complete specification, did not substantially refer to the same invention; (7) That the specification was not sufficient; (8) That the claim in the specification was not sufficient to distinguish what was new from what was old; and (9) That the invention was not proper subject-matter for letters patent.

Statement of defence.

Defences in an infringement action.

Whether a *Prior Grant* as distinguished from prior publication would invalidate a patent and so constitute a defence is doubtful (see p. 347).

It will be observed that any one of these defences will be sufficient to constitute a complete defence to an action; and that the greater portion of them are of a nature to require elaborate and costly evidence to prove or disprove them. Too much care cannot, therefore, be taken in preparing a statement of defence to avoid setting up defences which it is not expected will be satisfactorily proved at the trial, regard being had to the provisions of the rules of 1883 as to costs; otherwise, even if the defendant succeeds in the action, he may be mulcted in heavy costs to the other side.

The defence that the plaintiff was not the first and true inventor should not be set up unless it is intended to prove that somebody else was the inventor, as the issue that the invention was not new, and in consequence that it was not

Denial of first and true inventor.

invented by the plaintiff. should be raised under the other headings of defence (a).

**Subject-matter.**

Want of subject-matter should be specifically pleaded; it cannot be raised under the pleas of want of novelty or insufficiency (b). But where the plaintiffs altered their ground of attack so as to necessarily give a wider construction to their specification than had at first been necessary, the defendants were allowed to amend their defence by adding a plea of want of subject-matter (c).

A statement of defence alleged that if the specification were construed so as to make the defendant an infringer, the claims of invention would be bad for want of novelty, as including matters described in certain specifications (stating them). North, J., refused to strike out par. 2 under Order XIX. rule 27; the Court of Appeal dismissed the appeal with costs (d).

**Admission of infringement.**

A statement of defence admitted infringement in ten instances and no more; the plaintiffs elected to move for judgment upon such admissions; held that they were entitled to an enquiry as to damages as to these ten instances of infringement and no more, and that all evidence as to any other instances of infringement alleged to have been committed by the defendant must be excluded (e).

Where the defendants in an action for infringement have been indemnified by another person or company, such other person or company may be joined as a third party under Order XVI. rule 48, of the rules of the Supreme Court (f).

**Estoppel.**

Judgment having been recovered against the defendant in an action for infringement, such defendant cannot plead the invalidity of the patent as a defence to a subsequent action brought against him for an infringement of the same patent; he

(a) *Morgan v. Windover*, 1890, 7 P. O. R. 449; *Thomson v. MacDonald*, 1891, 8 P. O. R. 9; *Pneumatic Tyre Co. v. Casswell*, 1896, 13 P. O. R. 187.

(b) *The Househill Co. v. Neilson*, 1843, 1 Web. P. C. 677.

(c) *Crossthwaite v. Moorwood*, 1894, 11 P. O. R. 558.

(d) *Hocking v. Hocking*, 1886, Griff. P. C. 129; 3 P. O. R. 291.

(e) *United Telephone Co. v. Donohoe*, 1886, L. R. 31 Ch. D. 399.

(f) *Edison v. Holland*, 1886, L. R. 33 Ch. D. 497.



is estopped by the first judgment, and this is so, even though the first judgment was entered by consent (*g*), and the defendant will not even be allowed to raise the question of validity on new grounds (*h*).

But where the defendants in the second action are not the same as those in the first, there will be no estoppel (*i*), though in such a case, if the patent had been previously upheld by a court of co-ordinate or superior jurisdiction, strong additional evidence will be required in order to reverse the previous finding (*k*), and the court will usually hold itself bound by previous decisions in the question of the construction of the patent (*l*).

Similarly if the patent has been held invalid in a previous action it will be a bar to a subsequent action for infringement between the same parties (*m*). But if the ground of invalidity has been removed by amendment of the specification there will be no estoppel (*n*).

A licensee is estopped from questioning the validity of the licensor's patent (see p. 218 *et seq.*).

Where there are several defendants, an estoppel may operate against one and not against the others (*o*).

“An estoppel must be certain to every intent and not be taken by argument or inference” (*p*); so where a question of infringement was submitted to an arbitrator, who, in his award found that the letters patent were not illegal or void, in a subsequent

(*g*) *Thomson v. Moore*, 1889, 6 P. O. R. 426, 431, 441; 7 P. O. R. 325.

(*h*) *The Shoe Machinery Co. v. Cutlan*, 1896, 13 P. O. R. 145.

(*i*) *Goucher v. Clayton*, 1865, 11 Jur. N. S. 107; 34 L. J. Ch. 239; *Otto v. Steel*, 1886, 3 P. O. R. 109, 114.

(*k*) *Otto v. Steel*, 1886, 3 P. O. R. 109, 114; *Slazenger v. Feltham*, 1889, 6 P. O. R. 130; *Automatic Weighing Machine Co. v. Combined Co.*, 1889, 6 P. O. R. 120, 367; *Edison v. Holland*, 1889, 6 P. O. R.

243; *Shaw v. Day*, 1894, 11 P. O. R. 189; *The Shoe Machinery Co. v. Cutlan*, 1896, 13 P. O. R. 142.

(*l*) *Otto v. Steel*, 1886, 3 P. O. R. 114, and the numerous actions on the *Welch Patent*.

(*m*) *Horrocks v. Stubbs*, 1895, 12 P. O. R. 541.

(*n*) *Deeley's Patent*, 1894, 11 P. O. R. 76.

(*o*) *Heugh v. Chamberlain*, 1877, 25 W. R. 742; *Goucher v. Clayton*, 1865, 11 Jur. N. S. 107.

(*p*) Com. Dig. tit. Estoppel (E 4).

action for infringement against the same defendant, it was held that the arbitrator's award was not such a decision as to make an estoppel within the above cited rule (q).

#### PARTICULARS OF OBJECTIONS.

Particulars  
of objections.  
The statute.

Sect. 29, sub-sect. (2) of the Act of 1883, provides:—“ *The defendant must deliver with his statement of defence, or by order of the Court, or a judge at any subsequent time, particulars of any objections on which he relies in support thereof; (3) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it; and if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him; (4) At the hearing, no evidence shall, except by leave of the Court, or a judge, be admitted in proof of any alleged infringement or objection, of which particulars are not so delivered; (5) Particulars delivered may be from time to time amended, by leave of the Court, or a judge.*”

Wherever  
validity is  
in issue.

Particulars of objections are always ordered, whenever the validity of a patent is put in issue. Where it was a condition precedent to an agreement to assign letters patent, that the assignee should first satisfy himself as to the validity of the patent, in an action brought for specific performance of this agreement, and resisted by the assignee on the ground of his right under the condition precedent, it was held that the validity of the patent was at issue and that the plaintiff was entitled to particulars of objections (r).

It is not necessary for every one of two or more defendants defending in the same interest to deliver particulars of objections (s).

Any of the objections which we have discussed in previous chapters may be taken in order to upset a patent, but the particulars must set out those objections in such terms that the

(q) *Newall v. Elliot*, 1863, 32 L. J. Ex. 120.

(r) *Hazlehurst v. Rylands*, 1892, 9 P. O. R. 1.

(s) *Smith v. Cropper*, 1885, L. R. 10 App. Cas. 249, reversing L. R. 26 C. D. 700.

plaintiff may be informed what case he will have to meet at the trial of the action.

If it be pleaded that the patentee was not the true and first inventor it is submitted that particulars must be delivered as to who the defendant alleges to have been the true and first inventor. The case of *Russell v. Ledsam* (1843, 11 M. & W. 647), which has been referred to in various text-books as an authority to the contrary, was decided upon the construction of the Act 5 & 6 Will. IV. c. 83, s. 3, which required that "in any action brought against any person for infringing any letters patent, the defendant, on pleading thereto, shall give to the plaintiff a notice of any objections on which he means to rely at the trial of such action." The Act of 1883 requires particulars of the objections, which is considerably more than a mere notice. That this was the view taken by the Court is, it is submitted, clearly shown by the words of Parke, B., in refusing the application for the name of the true inventor. He treats it as though he were refusing an application for particulars of an allegation of prior user:—"On consideration of the matter, however, we think that we ought to abide by the cases of *Heath v. Unwin* (10 M. & W. 684) and *Boulnois v. Mackenzie* (4 Bing. N. C. 124), and that no particulars of the circumstances under which this invention may have been previously used should be required from the defendant." Moreover, it is to be remembered, as was pointed out in the cases of *Morgan v. Windover* and *Thomson v. McDonald* (see p. 341, ante), that the issue raised by this plea is not one of novelty, but a specific ground of attack in itself.

First and true inventor.

The objection to a patent which is generally relied upon is want of novelty, either on the ground of prior user, prior publication, or common knowledge.

The objection on the ground of prior user must state the time and place when such user occurred; but it will be observed that the persons by whom used is not mentioned in sub-sect. (3). The Act, however, does not direct that such particulars shall not be required. The Patent Law Amendment Act, 1852, sect. 41, required that the place of prior user should be given, and was silent as to times or persons. Notwithstanding this, in *Palmer*

Prior user.

*v. Cooper* (1853, 9 Ex. 231), Baron Alderson went even further than to require the names of the persons who had used the invention, and the present addresses of such persons were ordered to be given, "As otherwise the plaintiff would not know where to go for his evidence" (t).

The rule as to particulars is far more strict than it formerly was, and the early cases are of but little service in ascertaining the principle. In *Flower v. Lloyd* (1876, Solrs. Journal, p. 860), Field, J., said: "I cannot follow the cases which have been cited; we have advanced in our ideas since they were decided (u). If the defendants knew that their processes have been used by other persons in London and Birmingham, besides those specified, they must know the persons by whom they have been used, and must give more specific information. I do not say that they need give the name and address of every such person, but they must give fair information. If they can give no further information, the words in question are useless, and too indefinite, and must be struck out."

In *Boyd v. Farrar* (1888, 5 P. O. R. 35), the allegation of prior user "by articles made according to the supposed invention, being publicly exhibited in use by Messrs. J. H. & S., at their works," was held too general, so in *Siemens v. Karo* (1891, 8 P. O. R. 376), "by the general use of the Wenham regenerative gas lamp for several years prior to the patent," did not sufficiently particularize any variety of lamp. It is not necessary to refer to any particular article, but the defendant should specify the kind of article referred to in express terms, so that there may be no doubt what it is that he alleges to be an anticipation of the plaintiff's patent (x).

In *Scott v. Hull Steam Fishing Co.* (1896, 13 P. O. R. 210), Kay, L.J., said: "The object of giving particulars is that the other side may have an opportunity of meeting the particular

(t) See also *Birch v. Mather*, 1883, 22 C. D. 631; *Alliance Syndicate v. MacIvor's Patents*, 1891, 8 P. O. R. 321.

(u) *Bentley v. Keighley*, 7 M. & G. 652; *Palmer v. Wagstaff*, 8 Ex. 840.

(x) And see *Harris v. Rothwell*, 1886, 3 P. O. R. 243; *Boyd v. Horrocks*, 1886, 3 P. O. R. 285; *Boyd v. Farrar*, 1888, 5 P. O. R. 33; *Sidebottom v. Fielden*, 1891, 8 P. O. R. 272; *Dege's Patent*, 1895, 12 P. O. R. 451.

case of anticipation which is relied upon, but if from the particulars he cannot find out which is the particular case of anticipation relied on, the particulars are not sufficient."

The time and place at which the alleged prior user took place should be clearly defined, a general statement that the user continued from 1832 to 1862 was held in 1890 to be too general, and it was ordered that further particulars should be given (y).

Objections on the ground of prior publication stand very much upon the same footing as those on the ground of prior user. Prior publication.

If the prior publication is alleged to be in books or newspapers, the plaintiff is entitled to be told the name of the book or newspaper, and to be given such details of the books or newspapers as will enable them to be found and identified by the plaintiff.

Whether or not a defendant will be required to give particulars of lines and pages of the specifications upon which he relies in his objections or to point out specifically what part or parts of the plaintiff's specification he alleges to be affected thereby will depend upon the circumstances of the case and the nature of those specifications (z); where it appeared that the defendant had, figuratively speaking, "thrown at the head" of the plaintiff a large number of complicated specifications without any attempt at discrimination, further particulars were required (a), but if the defendant *bonâ fide* relies upon the whole of a specification, or any number of specifications in reason, and the subject-matter is simple, his particulars of objections will not be interfered with (b). In *Nettlefolds v. Reynolds* (1891, 8 P. O. R. 417), Lindley, L.J., said: "It appears to me, therefore, that the moment the learned Judge came to the conclusion, as he did in fact, that the defendant here had honestly done his

(y) *Smith v. Lang*, 1890, 7 P. O. R. 150.

(z) *Heathfield v. Greenway*, 1894, 11 P. O. R. 19.

(a) *Holliday v. Heppenstall*, 1889, 6 P. O. R. 320; *Sidebottom v. Fielden*, 1891, 8 P. O. R. 270;

*Heathfield v. Greenway*, 1894, 11 P. O. R. 19.

(b) *Siemens v. Karo*, 1891, 8 P. O. R. 376; *Nettlefolds v. Reynolds*, 1891, 8 P. O. R. 417; *Edison-Bell Phonograph Co. v. Columbia Phonograph Co.*, 1901, 18 P. O. R. 4.

best to give to the plaintiff that information that he is entitled to, unless the Court came to the conclusion that there was some grievous or some obvious mistake, he ought to be satisfied with that, and not to say, 'I shall order further particulars, because I know from experience that if you say you rely on the whole of the specification, when you come into court nine-tenths will not be referred to.' If the defendant is to be bound hand and foot to a particular page, and to a particular line, it will be perfectly impossible for him to defend his case, or to impeach the patent to the extent and in the manner in which he is entitled to do it."

In *Fowler v. Gaul* (1886, 3 P. O. R. 247), the defendants, by their particulars of objections, alleged (*inter alia*), "5. That the alleged invention was published prior to the patent by certain patents and the specifications thereof (naming them); 8. The plaintiff's specification claims some of the matters specified or patented in certain specifications (naming them)." The District Registrar, affirmed subsequently by the Judge in Chambers and Divisional Court, ordered "better particulars, showing in detail what part or parts of the patents or specifications respectively referred to in the 5th and 8th objections showed prior publication, and what parts were relied on as being claimed by the plaintiff's specification. In default of delivery, objections 5 and 8 to be struck out."

In *Plimpton v. Spiller* (1876, 20 Solrs. Journal, 860), the particulars were—"before the date of the alleged letters patent the alleged invention had been published in England in the 'Commissioners of Patents Journal,' of the 6th February, 1863, and in the 'Scientific American' of the 24th January, 1863, and in drawings and sketches deposited in the Patent Office library in July, 1865." Mr. Justice Field directed that the defendant should amend his particulars by stating the date of the American patent, and in whose name it had been granted. And also by giving the pages of the publications mentioned, but not the lines. And also by giving such written details as would enable the drawings mentioned to be identified, and to state whether the drawings were or were not contained in books, and what books.

The objection that the invention is not proper subject-matter in view of the common knowledge of the time when it was patented is a distinct allegation, and should be specifically pleaded (c). Want of subject-matter and Common knowledge.

Objections on the ground of common knowledge must be carefully distinguished from objections on the ground of prior publication; in the latter case every book or document must be particularized, as no instance of anticipation can be adduced at the trial of which particulars have not been delivered, but when the objection to a patent is based upon common knowledge, no particular instances need be referred to, as this objection can only be proved by the examination of witnesses and references to well-known standard works upon the subject (d). But specifications may not be used as evidence of common knowledge unless they have been referred to in the particulars of objections, either under the plea of anticipation or specifically under the objection at present under consideration (e).

The usual practice is to state in the particulars whether the specifications cited are referred to as anticipations or as evidence of common knowledge.

Particulars are not required of the allegation that "the patented invention is not useful." Want of utility.

The allegation that the specification is insufficient must be supported by particulars which indicate the alleged defect, and where a workman would meet with difficulty in carrying out the directions given (f). In *Heathfield v. Greenway* (1894, 11 P. O. R. 17), the following objections, viz.: "That the specification does not sufficiently describe and ascertain the nature of the invention, and Specification insufficient.

(c) *Holliday v. Heppenstall*, 1889, 6 P. O. R. 327; *Phillips v. The Ivel Cycle Co.*, 1890, 7 P. O. R. 82.

(d) *Holliday v. Heppenstall*, 1889, 6 P. O. R. 326; *English and American Machinery Co. v. Union Boot Co.*, 1894, 11 P. O. R. 367; *Boxwell v. Cochran*, 1895, 12 P. O. R. 170.

(e) *The Salvo Laundry Co. v. Mackie*, 1893, 10 P. O. R. 70;

*English and American Machinery Co. v. Union Boot Co.*, 1894, 11 P. O. R. 367; *Castner-Kellner Alkali Co. v. Commercial Development Co.*, 1899, 16 P. O. R. 276; *Sutcliffe v. Abbott*, 1903, 20 P. O. R. 55.

(f) *Crompton v. Anglo-American Brush Corpn.*, 1887, 4 P. O. R. 199; *Heathfield v. Greenway*, 1894, 11 P. O. R. 17; *Dege's Patent*, 1895, 12 P. O. R. 451.

the manner in which the same is to be performed ;” and, “That the said specification is ambiguous and framed in a manner calculated to mislead ;” were held to be too vague. A very typical and instructive instance of such an objection, where better particulars were ordered of the insufficiency, is to be found in *Dege's Patent* (1895, 12 P. O. R. 451).

**Discon-  
formity.**

When the objection is on the ground of want of conformity between the provisional and complete specification, the defendant ought to give such particulars as would inform the plaintiffs of the nature and scope of the alleged differences. This does not mean that the defendants must furnish the plaintiffs with the heads of what the defendants' argument will be at the trial, but only such information as the plaintiffs may reasonably require in order to know precisely the nature of the case that will be raised against them (*g*).

**Fraud.**

Order XIX. rule 6, of the Rules of the Supreme Court, 1883, provides : “In all cases in which the party pleading relies on any misrepresentation, fraud, breach of trust, wilful default, or undue influence, and in all other cases in which particulars may be necessary beyond such as are exemplified in the forms aforesaid, particulars (with dates and items, if necessary) shall be stated in the pleading: provided that if the particulars be of debt, expenses, or damages, and exceed three folios, the fact must be so stated, and a reference to full particulars already delivered or to be delivered with the pleading.”

Such an allegation of fraud might be involved where the plaintiff is alleged to have stolen the invention from someone else.

**Effect of  
particulars  
at the trial.**

Evidence will be admitted at the trial, provided the language of the particulars of objections is large enough to admit it; since the proper course for the plaintiff to take should the defendant deliver vague particulars is to issue a summons before a Judge in Chambers for further and better particulars, or, in the alternative, to have the objectionable words struck out.

In *Sugg v. Silber* (1876, L. R. 2 Q. B. D. 495), Mellish, L.J., said :—“The authorities cited by Mr. Cave were cases

(*g*) *Anglo-American Brush Corpn.* 153; *Heathfield v. Greenway*, 1894, v. *Crompton*, 1886, L. R. 34 C. D. 11 P. O. R. 20.



where objections had been taken to the notices of objection at the time when they were delivered, and further and better particulars were asked for. In my opinion there is a very large difference between a case where a judge has been applied to and has ordered further particulars in order to state an objection more specifically, and a case where at the trial the plaintiff asserts that the defendant ought to be prevented from availing himself of an objection. It is perfectly obvious that, if Mr. Cave was right in saying that the two questions are the same, and that wherever the Court would order further particulars because the objection had not been particularly specified, it would also hold that the party was precluded from raising it at the trial, nobody would be foolish enough to apply to a judge for further particulars."

In *Britain v. Hirsch* (1888, 5 P. O. R. 231), in the Court of Appeal, Cotton, L.J., said: "In my opinion, under the present Act of Parliament, it is within the discretion of a judge who hears evidence in a patent case to allow evidence to go beyond the particulars actually delivered."

The defendant will not be allowed at the hearing of the action to introduce evidence of prior user, not disclosed in the particulars of objection, although such evidence may have only come to his knowledge since the delivery of the particulars of objection. His proper course is to obtain leave by summons or by serving short notice of motion for leave to amend, when an order will be made upon the terms mentioned below; and with an added term to delay the trial should it appear just that the plaintiff should have time to investigate the new evidence (*h*), and such leave will only be granted if the new evidence has only been recently discovered, and could not with reasonable diligence have been discovered before (*i*).

Amendment  
of the  
particulars.

In *The Shrewsbury and Talbot Co. v. Morgan* (1896, 13 P. O. R. 75), Romer, J., refused leave to amend by adding an allegation of disconformity between the title and the claims after the

(*h*) *Daw v. Eley*, 1865, L. R. 1 Eq. 38; and see *Badische Anilin und Soda Fabrik v. Société Chimique*, 1897, 14 P. O. R. 881.  
(*i*) Per North, J., in *Moss v. Malings*, 1886, 3 P. O. R. 375.

question of infringement had been decided against the defendants.

Page-Wood, V.-C., in *Penn v. Bibby* (1866, L. R. 1 Eq. 548), permitted a defendant in his amended particulars, to preface his statement of the specific instances of alleged prior user, with the words "amongst other instances" in order to give him an opportunity to apply for leave to re-amend by inserting any further instances of prior user which he might discover.

In *Allen v. Horton* (1893, 10 P. O. R. 120) (*k*), the defendant amended his particulars of objections at the trial by leave of the Court; judgment was given for the defendant, but costs refused owing to the late stage at which the amendment was made.

The terms upon which amendment is permitted vary with the circumstances of the case, but the plaintiff should be at liberty, if he pleases, to discontinue the action, and to be in the same position as to costs, as if the proposed amended particulars had been delivered in the first instance (*l*); and the defendant should be put under such terms as to costs as to the judge or Court may seem just. The particulars of objections give notice to the plaintiff of the case which is to be made against him; and he should be able to discontinue or not, as he pleases, paying the defendant's costs. The defendant should not be permitted to keep back his most salient objections, and so to entice the plaintiff to proceed and incur costs, and then to amend his particulars at the last moment.

In *Pirrie v. York Street Spinning Company* (1894, 11 P. O. R. 431), leave to amend the particulars of objections was granted pending appeal.

The terms on which amendment will be allowed are a matter for the discretion of the Court, and it is of little use to appeal (*m*).

(*k*) See also *Westley Richards v. Perkes*, 1893, 10 P. O. R. 186.

(*l*) *Baird v. Moule's Patent Earth Closet Co.*, 1881, L. R. 17 Ch. D. 139, n.; and *Aveling v. Maclaren*, same page; also *Edison Telephone Co. v. Indiarubber Co.*, 1881, L. R. 17 Ch. D. 137; *Ehrlich v. Ihlee*,

1887, 4 P. O. R. 115; *Parker v. Maignen's Filter Co.*, 1888, 5 P. O. R. 207; *Badische Anilin und Soda Fabrik v. Société Chimique*, 1897, 14 P. O. R. 881.

(*m*) *Wilson v. Wilson*, 1899, 16 P. O. R. 316.

But the usual course is to direct that, should the plaintiffs elect to discontinue after receiving the amended particulars, all costs from the time of delivering the first set of particulars before amendment shall be the plaintiffs', the reason being that if the new particulars had been delivered at first there would have been no issue after that date (*n*). If the plaintiffs elect to continue the costs will depend on the particular circumstances, and there is no settled practice.

Forms of orders, for delivery of further particulars of objections, and for liberty to amend, will be found in the appendix (*o*).

## INTERROGATORIES.

Order XXXI. rule 1, of the rules of the Supreme Court provides that either party to an action, with leave of the Court or a judge, may interrogate the other party. Interrogatories.

Interrogatories must be relevant to the issue, and will not be allowed to be used for the purpose of cross-examination. Since it is not possible to say precisely what the issues between the parties are before the statement of defence is delivered, neither party, except under special circumstances, will be allowed to interrogate until that stage of the action has been reached (*p*).

Rule 26 provides that £5 or some further sum, should be brought into Court by the party desiring to interrogate before he shall be at liberty to do so.

The general rules as to interrogatories in ordinary actions apply equally to actions for infringement.

The plaintiff may interrogate the defendant, and the defendant must answer as to what infringement he has been guilty of; but where the defendant is asked concerning the customers whom he has supplied, it becomes material to ascertain from the pleadings whether the acts complained of are admitted. If the act complained of be not admitted, the defendant may be asked whether he has not supplied a certain definite article As to infringement.  
As to sales.

(*n*) *Ehrlich v. Ihlee*, 1887, 4 P. O. R. 117; *Wilson v. Wilson*, 1899, 16 P. O. R. 316.

(*o*) See Appendix.  
(*p*) *Mercier v. Cotton*, 1876, L. R. 1 Q. B. D. 442.

to anybody, and to whom—since by this means an admission, not necessarily of infringement but of the act complained of, may be obtained. But if the act complained of be admitted an enquiry as to the persons supplied only becomes relevant on the issue of damages and should be postponed until the enquiry. This principle was clearly stated by Chitty, J., in *Lister v. Norton* (1885, 2 P. O. R. 69 (q) ).

*Crossley v. Tomey* (1876, L. R. 2 Ch. D. 533) was an action to restrain infringement. The defendant in interrogatories was required to state whether he was not making articles in all respects identical with those of the plaintiff, and to set forth in what respects they differed, and by what process they were made. It was held that the defendant, who alleged prior user by himself and others, had sufficiently answered by stating that, save so far as the articles manufactured by him before the date of the patent were similar to those of the plaintiff, the articles he now made differed from those made by the plaintiff, but he could not show in what they differed without ocular demonstration.

An enquiry as to the names of persons who supplied a defendant who is merely a vendor will usually be inadmissible, since it is not relevant to any issue between the parties. But where the vendors sold a chemical product, which the plaintiffs had good reason to believe was manufactured in infringement of one of their patents for processes, the Court of Appeal allowed the interrogatory on the ground that the answers would probably enable the plaintiffs to ascertain whether the article were an infringement or not (r).

Plaintiff may take defendant through specification.

In *Benno Jaffé v. Richardson* (1893, 10 P. O. R. 136), the plaintiff administered interrogatories to the defendant, framing them upon the statements in his specification, which he alleged that the defendant had infringed, and thereby asked the defendant if he had used the processes described in the specification, taking them step by step. Some of these interrogatories

(q) And see *Tetley v. Easton*, 1856, 18 C. B. 643; *Lea v. Saxby*, 1875, 32 I. T. N. S. 731.

(r) *Saccharin Corpn. v. Haines*, 1898, 15 P. O. B. 346.

the defendant refused to answer, on the ground that they were not relevant until the patent was established. It was held by North, J., that the plaintiff was entitled to further answers.

But where the materiality of an interrogatory depends upon the construction of the patent, no answer need be given (s).

But neither may interrogate on construction. Plaintiff may interrogate on objections.

The fact that the defendant's particulars of objections are sufficient will not necessarily preclude the plaintiff from obtaining more detailed information by administering interrogatories. In *Birch v. Mather* (1883, L. R. 22 Ch. D. 631), Chitty, J., said: "The right to interrogate is conferred by the general orders, and I cannot say as a matter of principle that it can be laid down that the plaintiff is not entitled to interrogate the defendant, and *vice versa*, with reference to these matters which may be covered by the particulars. I hold, therefore, on the general question, that there is a right to deliver interrogatories, and provided the interrogatories are properly worded, interrogatories with reference to these very matters which ought to be covered by the particulars" (t).

The plaintiff is entitled to interrogate as to the names and addresses of the persons by whom the defendant alleges the invention was used prior to the date of the plaintiff's patent, also as to the places where such prior user occurred (u).

In a petition for revocation under sect. 26, interrogatories will be allowed to be administered by the petitioner to the respondent, inquiring into the manufacture, use, and sale of the patented article prior to the date of the patent (x).

Where a defendant alleged that his process was secret, he was bound to answer whether he used the materials mentioned in the specification, and whether he used any additional materials, but

Secret process.

(s) *Delta Metal Co. v. Maxim-Nordenfelt Guns Co.*, 1891, 8 P. O. R. 169; *Moseley v. The Victoria Rubber Co.*, 1886, 3 P. O. R. 357.

(t) See also *Alliance Pure Whitelead Syndicate v. MacIvor's Patents*, 1891, 8 P. O. R. at p. 322; *General Electric Co. v. Safety Light and Elevator Co.*, 1904, 21 P. O. R. 109.

(u) *Finnegan v. James*, 1875, L. R. 19 Eq. 72; *Crossley v. Tomey*, 1876, L. R. 2 Ch. D. 533; *Birch v. Mather*, 1883, L. R. 22 Ch. D. 629; *Alliance Pure Whitelead Syndicate v. MacIvor's Patents*, 1891, 8 P. O. R. 321.

(x) *Haddan's Patent*, 1884, 54 L. J. Ch. 126.

not to disclose the proportions in which he used the specified materials, or what the additional materials were (*y*).

“The mere plea of secret process is not sufficient to defeat discovery, but, on the other hand, interrogatories must not be made the means of unfair treatment of a man who is fighting fairly” (*z*).

**Privilege.**

Communications between a man and his patent agent are not privileged, consequently, where the plaintiff's patent agent also acted as his solicitor, he was ordered to answer interrogatories with reference to documents which passed between them at the time the specification was prepared, such communications having taken place in the relationship of patent agent, and not of solicitor, and client (*a*).

In the same case interrogatories which sought to compel the plaintiff to particularise the alleged breaches by stating what parts of the plaintiff's speculation were infringed by the defendants (the defendants having in answers to interrogatories disclosed what they had done) were disallowed on the ground that the defendants could for themselves compare the plaintiff's specification with what they admitted they had done.

**After judgment for plaintiff.**

After trial, and in pursuance of the terms of the judgment, if the plaintiff has been successful he is entitled to interrogate the defendant, or to require that the defendant “should make and file an affidavit stating what machines of the same construction as that supplied by him to A. or B., including such machines as are in his possession or power,” see *Seton*, 4th ed. p. 352. The answer or affidavit of the defendant must be complete. In *Murray v. Clayton* (1872, L. R. 15 Eq. 115), a patentee of improvements in brick-cutting machines, who was a manufacturer of the machines by an agent at the agent's works and not a licensor, having obtained a perpetual injunction against the defendants (who were also manufacturers of brick-cutting machines), from infringement, the defendants were ordered to file an affidavit stating the number of machines made by them

(*y*) *Renard v. Levinstein*, 1864, 3 N. R. 665.

(*z*) Per Kekewich, J., in *Ash-*

*worth v. Roberts*, 1890, 7 P. O. R. at p. 455.

(*a*) *Moseley v. Victoria Rubber Co.*, 1886, 3 P. O. R. 351.

since the date of the patent, and the names and addresses of the persons to whom the same had been sold, and of the agents concerned in the transactions. Upon motion to vary the order, it was held that the plaintiff was entitled to have discovery of the names and addresses of the purchasers, but not of the agents concerned, there being nothing to show that any agents had been employed.

In *Saccharin Corporation v. Chemicals Co.* (1900, 17 P. O. R. 614), the Court of Appeal decided that the plaintiff may demand discovery of the names of the defendants' customers, whether on an order for an account of profits or on enquiry as to damages (*b*).

Interrogatories for the examination of a plaintiff are on a different footing from those for the examination of a defendant in this respect, that a plaintiff is not entitled to discovery of the defendant's case, but a defendant may ask any questions tending to destroy the plaintiff's case (*c*).

Defendant  
may interro-  
gate to  
destroy  
plaintiff's  
case.

In determining whether a question is one of fact, and, therefore, to be answered, it makes no difference that it is asked with reference to a written document (*d*).

A defendant in a suit for infringement of a patent in order to prove that there was no novelty in the plaintiff's patent, interrogated the plaintiff as to the inventions described in the specifications of various patents, and asked him to show in what respects they differed from his. The plaintiff declined to answer these interrogatories on the ground that the questions were not questions of fact, and that they related to the plaintiff's case; the defendant excepted to the answer, and the exceptions were allowed (*e*).

A plaintiff in a patent suit was required by interrogatories to set out a correspondence between himself and a third party, and also to state the particulars of the infringement of his patent on which he relied. He refused to answer these questions on the ground that the defendant might obtain an order in chambers to inspect the correspondence: and that he had sufficiently set out

(*b*) And see *Ashworth v. Roberts*, Ch. 680.  
1890, 7 P. O. R. 455. (*d*) Ibid.

(*c*) *Hoffman v. Posthill*, L. R. 4 (*e*) Ibid.

the particulars of the infringement in his bill. These answers were held to be sufficient (*f*).

We have set out the effect of this case at length, because it is founded upon and exemplifies in many ways the principle upon which a defendant may examine a plaintiff. Lord Justice Giffard, in giving judgment, said: "As regards the case of *Daw v. Eley* (1865, 2 H. & M. 725), it must be always remembered that that was the case of a plaintiff exhibiting interrogatories to a defendant, and it was there held that the plaintiff could not call on the defendant to set forth the particulars of his defence. But when you come to the case of a defendant asking questions of a plaintiff, it is a very different thing. It is the defendant's business to destroy the plaintiff's case, and there the defendant has a right to ask all questions which are fairly calculated to show that the patent is not a good patent (*g*), or that what he alleges to be an infringement is not an infringement." Lord Justice Selwyn had said: "Our decision in this case will leave it entirely within the power of the learned Vice-Chancellor to order that all the costs occasioned by the interrogatories, the answer, the exceptions, the hearing the exceptions before him, and the hearing of this appeal, shall be dealt with as he, in his discretion, shall think fit; and if it shall appear that the power which the Court, for the purpose of justice and discovery, gives to the parties to administer interrogatories to each other has been abused, I have no doubt the learned Vice-Chancellor will take care that justice shall be done, and will make the party who is to blame pay all the costs of the improper exercise of his power."

Not before  
delivering  
defence.

The defendant will not be allowed to interrogate the plaintiff as to a prior user before delivering his defence, unless a very strong case is made out (*h*).

(*f*) *Hoffman v. Posthill*, L. R. 4 Ch. 680.

(*g*) *Rylands v. Ashley's Patent Bottle Co.*, 1890, 7 P. O. R. 175.

(*h*) See *Woolfe v. Automatic Picture Gallery Co.*, 1902, 19 P.

O. R. 163, where leave was refused.



## INSPECTION.

Sect. 30 of the Patents, &c. Act of 1883, provides: "*In an action for infringement of a patent, the Court or a judge may, on the application of either party, make such order for an injunction, inspection, or account, and impose such terms and give such directions respecting the same and the proceedings thereon, as the Court or a judge may see fit.*"

Inspection.  
The statute.

The power to order an inspection was always assumed by the Courts; in *Borill v. Moore* (1815, 2 Coop. Ch. Ca. 56 n.), Lord Eldon said: "There is no use in this Court directing an action to be brought, if it does not possess the power to have the action properly tried. The plaintiff has a patent for a machine used in making bobbin lace. The defendant is a manufacturer of that article; and, as the plaintiff alleges, he is making it with a machine constructed upon the principle of the machine protected by plaintiff's patent. Now the manufactory of the defendant is carried on in secret. The machine which the defendant uses to make bobbin lace, and which the plaintiff alleges to be a piracy of his invention, is in the defendant's own possession, and no one can have access to it without his permission. The evidence of the piracy, at present, is the bobbin lace made by the defendant. The witnesses say that this lace must have been manufactured by the plaintiff's machine, or by a machine similar to it in principle. This is obviously in a great measure conjecture. No Court can be content with evidence of this description. There must be an order that plaintiff's witnesses shall be permitted before the trial of the action to inspect the defendant's machine, and to see it work."

"The right to inspection is a right to be given at the discretion of the Court—to be exercised with a judicial discretion and with due regard to the interests of the parties concerned in the litigation (i).

The object which the Court has in view in all cases where an inspection is permitted, is to ensure that the true facts of the case

(i) Per Bristowe, V.-C. in *McDougal v. Partington*, 1890, 7 P. O. R. at p. 357.

shall be carefully sifted; but at the same time the Court will take care that the process of the law is not abused, and that an action for infringement shall not be made a means and lever for the discovery of other persons' secrets.

*Primâ facie*  
case must be  
made out.

The Court requires, before granting an order for inspection, that a *primâ facie* case shall be made out of infringement (*k*). And, when the interests of justice require, the inspection will be granted to scientific witnesses, who will be required to keep any secrets which they may have discovered, and which do not affect the question of infringement. In *Flower v. Lloyd* (1876, W. N. 169, 230), and *Swan v. Edlin-Sinclair Tyre Co.* (1903, 20 P. O. R. 435 (*l*)), the Court strictly limited the inspection to scientific men, and excluded the plaintiff from being present.

Inspection  
limited to  
experts.

In *Pigott v. The Anglo-American Telegraph Co.* (1868, 19 L. T. N. S. 46), it was alleged that an inspection would disclose important secrets. Giffard, V.-C., in refusing an order to inspect, said: "Of late years greater readiness has been shown by the equity Courts to allow inspection in patent cases than by the Courts of common law. But it has never been considered as a matter of right, nor have the equity Courts considered themselves as precluded from exercising a proper discretion in applications of this description. The Court ought to be satisfied of two things: that there really is a case to be tried at the hearing of the cause, and that the inspection asked for is of material importance to the plaintiff's case *as made out by his evidence.*"

In *Bailey v. Kynoch* (1874, L. R. 19 Eq. 92), Sir James Bacon, V.-C., said: "Upon the single point which is raised before me, there can be no doubt that the plaintiff in such a suit as this is entitled to an inspection of the means which the defendants employ in the manufacture of the articles alleged to be violations of the plaintiff's patent, when such inspection is

(*k*) *Bovill v. Moore*, supra; *The Singer Sewing Machine Co. v. Wilson*, 1865, 12 L. T. N. S. 140; *Shaw v. The Bank of England*, 1852, 22 L. J. Ex. 26; *Batley v. Kynoch*, 1874, L. R. 19 Eq. 90; *Germ Milling Co.*

*v. Robinson*, 1884, 55 L. J. Ch. 287; 1 P. O. R. 217; *Cheetham v. Oldham*, 1888, 5 P. O. R. 621.

(*l*) See also *The Plating Co. v. Farquharson*, 1879, Griff. P. C. 187.

essential for the purpose of enabling the plaintiff to prove his case; upon the materials before me that is not made out. There is no allegation by the plaintiff that he cannot make out his case without inspection. But there is on the part of the defendants a plain allegation that inspection is not necessary for the purposes of the suit; upon that only I must decide this question. I would rather not go into the other matters which have been referred to. The description in the specification and the allegation in the bill—but as I read both the description in the specification and the allegation in the bill—I find that the charge made by the plaintiff is that the cartridges, the right of manufacturing which is vested in him exclusively, have been imitated and copied by the defendant, and if that fact can be made out the plaintiff's case can be clearly established. The mode of making that out is by examination of the cartridges, the means by which they have been made, whether by a machine or hammer or a screw cannot signify in the least if the cartridges of the defendant when made are made upon the principle of the patent claimed by the plaintiff.”

Only where inspection essential for plaintiff's case.

In *Drake v. Muntz Metal Co.* (1886, 3 P. O. R. 43), before statement of claim application was made to Bacon, V.-C., that the defendants by their proper officer should make an affidavit verifying the machines and processes used by the defendant company in bending metal tubes since the date of the plaintiff's patent and for inspection. The Vice-Chancellor said that sect. 30 (*supra*) did not give him power to direct an affidavit to be made, but ordered inspection of the machines.

The Court, in the case of *The Patent Type Founding Co. v. Walter* (1860, 8 W. R. 353) (*m*), assumed the jurisdiction to order the defendant to deliver to the plaintiff a sample of the type made by him so that the plaintiff might have the same analysed, for the purpose of ascertaining whether the composition was similar to the plaintiff's patented composition.

In that case it was also held that laches sufficient to defeat the plaintiff's right to an interlocutory injunction was no bar to an order on the same motion for inspection.

(*m*) See also *Germ Milling Co. v. Robinson*, 1886, 3 P. O. R. 11.

In *Webb v. Kynoch & Co., Ltd.* (1898, 15 P. O. R. 273), inspection was ordered of the defendants' works as one of the conditions for the refusal to grant an interlocutory injunction.

In some cases, where it is necessary, the Court will order the defendant and the plaintiff to give mutual inspection, and to show both the patented machine and the alleged infringement at work, and to permit either party to take away any of the work or samples of the work which has been done in their presence (*n*).

Whether the plaintiff will be entitled to see the alleged infringing machine at work or not will depend upon the circumstances of the case (*o*).

Where the defendant has delivered to the plaintiff specimens of the alleged infringing articles, the latter is not entitled to see those articles in actual use on the defendant's premises (*p*).

No order will be made for inspection by the plaintiff of articles not within the control of the defendant, nor of exhibits which the defendant's witnesses will give in evidence (*q*).

In *McDougall v. Partington* (1891, 8 P. O. R. 351, 472) the plaintiff's right to inspection depended upon a contract which was the matter in dispute, and since he was unable to show that inspection was necessary to prepare his case, it was held that no inspection should be granted on the ground that the right depended upon the question to be determined at the trial.

Application,  
how made.

The application may be made on motion to the Court or by summons; it is usually made upon the application for an interim injunction, but it is immaterial at what stage of the proceedings the application is made. The evidence in support must be on affidavit, and a *prima facie* case of infringement must be made out, and that the inspection is material to the plaintiff's case.

(*n*) *Davenport v. Jepson*, 1862, 1 N. R. 307; see also *The Singer Sewing Machine Co. v. Wilson*, 1865, 5 N. R. 505; *The Germ Milling Co. v. Robinson*, 1886, 55 L. J. Ch. 288; 3 P. O. R. 11.

(*o*) *The Germ Milling Co. v. Robinson*, 1886, 3 P. O. R. 11;

*Drake v. Muntz Metal Co.*, 1886, 3 P. O. R. 43; *Sidebottom v. Fielden*, 1891, 8 P. O. R. 266.

(*p*) *Sidebottom v. Fielden*, 1891, 8 P. O. R. 266.

(*q*) *Garrard v. Edge*, 1889, 6 P. O. R. 372; also *Sidebottom v. Fielden*, 1891, 8 P. O. R. 266, 269.

Order L. of the Rules of the Supreme Court, 1883, contains some provisions as to inspection which must be noticed.

Rule 3 provides for the inspection of property and the taking of samples, or for "any observations to be made or experiment to be tried which may be necessary or expedient for the purpose of obtaining full information or evidence." Rule 4: "It shall be lawful for any judge, by whom any cause or matter may be heard or tried with or without a jury, or before whom any cause or matter may be brought by way of appeal, to inspect any property or thing concerning which any question may arise therein."

This last mentioned rule was introduced by the Rules 1883. Before, the parties must have consented to a view being had. In *Jackson v. The Duke of Newcastle* (1864, 33 L. J. Ch. 698), Lord Westbury said: "A judge is bound to pronounce his decision according to the evidence before him, but his inspection of the premises may bring him to a conclusion directly opposite to that which is established by the evidence."

The costs of an inspection depend on the circumstances, and are in the discretion of the Court (r). In *Ashworth v. English Card Clothing Co.* (1904, 21 P. O. R. 353), Joyce, J., allowed the costs of an inspection to the successful party, although it had taken place voluntarily and without an order of the Court, on the ground that circumstances showed that it had been necessary and proper.

Costs of  
inspection.

#### THE TRIAL.

The constitution of the Court which is to hear and determine patent actions is provided for by sect. 28, sub-sect. 1, of the Act of 1883: "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 hear and try the case wholly or partially with his assistance; the action shall be tried without a jury, unless the Court shall otherwise direct."

Statute.  
Assessors  
and juries.

Under the old statute, either party had an absolute right to

(r) *Mitchell v. The Darley Colliery Co.*, 1883, L. R. 10 Q. B. D. 457.

have the questions of fact decided by a jury, and the Court had no power to deprive them of this right (s).

Under the 57th section of the Judicature Act, 1873, the Court had power, without the consent of the parties, "in any such cause or matter requiring any prolonged examination of documents or accounts or *any scientific* or local *investigation* which cannot, in the opinion of the Court or a judge, conveniently be made before a jury, or conducted by the Court through its other ordinary officers, the Court or a judge may at any time, on such terms as may be thought proper, order any question or issue of fact, or any question of account arising therein, to be tried either before an official referee, to be appointed as hereinafter provided, or before a special referee to be agreed on between the parties; and any such special referee so agreed on, shall have the same powers and duties, and proceed in the same manner as an official referee. All such trials before referees shall be conducted in such manner as may be prescribed by rules of Court, and subject thereto in such manner as the Court or judge ordering the same shall direct."

May not be sent to a referee.

In the case of *Sarby v. The Gloucester Wagon Co.* (1880, W. N. 28), Mr. Justice Hawkins was of opinion that a patent case was a case which required a "prolonged scientific examination," and consequently he remitted the action to that which he considered the most proper tribunal for difficult scientific questions, "*the official referee.*" We are inclined to think that sect. 28 of the Patents, &c. Act, does away with this option. The words appear to read: "*The Court may employ an assessor, and shall do so on the application of either party, and shall try the case; and the action shall be tried without a jury, &c.*" The practice in the above mentioned case has never been followed.

In *Hallersley v. Hodgson* (1905, 22 P. O. R. 232) an assessor was employed to assist the judge.

Ord. XXXVI. rule 5 of the Rules of the Supreme Court provides: "The Court or a judge may direct the trial without a jury, of any cause, matter, or issue, requiring any prolonged examination of documents or accounts or any scientific or local examina-

(s) *Sugg v. Silber*, 1876, L. R. 1 Q. B. D. 362.

tion which cannot, in their or his opinion, conveniently be made with a jury"; and rule 6: "In any other cause or matter, upon the application of any party thereto, for a trial with a jury." These rules, together with the provisions of sect. 28 of the Patent Act, would show that the better opinion probably is that, unless a judge or the Court otherwise orders, the constitution of the Court shall be a judge sitting without a jury, and with or without an assessor.

The grounds of application for a trial by jury would be that the evidence shows a conflict of testimony in material parts, or that grave questions of credibility are likely to arise, or that a charge of fraud is made against either party. Reasons for having jury.

Mr. Hindmarch, at p. 291 of his celebrated work, says: "Few causes require so much care and industry in preparing for trial as patent actions, in which very nice points of law and difficult questions of fact must often be decided between the parties; and it will frequently happen that a party will succeed or fail in obtaining a verdict according to the industry with which he has got up his case for trial. Properly to understand the questions raised in such actions and prepare the necessary proofs, a competent knowledge, not only of law, but also of science in general and the useful arts, is essentially requisite."

Prior to the Act of 1883 the jurisdiction of the Palatine Court of Lancaster was "the jurisdiction of the old Court of Chancery within the boundary" (t), and its jurisdiction to award damages depended upon the provisions of Lord Cairns' Act (u), which limited that jurisdiction to cases where the Court had power to grant an injunction; consequently, where it was held that no injunction could under the circumstances be granted, the plaintiffs were unable to recover damages in that Court for the infringement of their patent (x). The Palatine Court of Lancaster.

(t) Per Jessel, M.R.; *Re Longdendale Cotton Spinning Co.*, 1878, L. R. 8 Ch. D. 152; 26 W. R. 491.

(u) 21 & 22 Vict. c. 27.

(x) *Proctor v. Bayley*, 1889, 6 P. O. R. 538, 545; see also upon this point, *Hindley v. Emery*, 1865,

L. R. 1 Eq. 52; *Davenport v. Rylands*, 1865, L. R. 1 Eq. 302; *Swaine v. Great Northern Rail. Co.*, 1863, 12 W. R. 391; *Wedmar v. Corporation of Bristol*, 1862, 11 W. R. 136; *Cory v. Thames Iron Co.*, 1862, 11 W. R. 589; *Catton v. Wyld*, 32 Beav. 266.

The Act of 1883 made no mention of the Palatine Court, defining the word "Court" as the High Court of Justice, and by the general repeal of previous Acts relating to letters patent, without excepting their application to proceedings in the Palatine Court, confined the jurisdiction of that Court to the general rule relating to proceedings in a Chancery action for the infringement of a right of any description, unless special jurisdiction could be found in the interpretation of the word "judge" in the Act of 1883.

In *Winter v. Baybut* (1884, 1 P. O. R. 76) the Vice-Chancellor held that the words "The Court or a judge" in the 19th section meant "The High Court or a judge with power to try actions for infringement," and consequently held that he had jurisdiction to give liberty to the plaintiff to apply for leave to amend his specification while an action for infringement was pending before him. But in *Proctor v. Sutton* (1888, 5 P. O. R. 184), Day, J., held that the same words in the 31st section meant "The Court or a judge thereof," and consequently that the Vice-Chancellor had no jurisdiction to grant a certificate of validity under that section.

If the latter be the correct interpretation, it would appear that the jurisdiction in patent actions given to the Vice-Chancellor under the provisions of the Acts which were repealed by the Act of 1883, was by that Act taken away.

The Chancery of Lancaster Act, 1890, s. 3, enacts:—

*"From and after the passing of this Act the Court of Chancery of the County Palatine of Lancaster (in this Act called the Lancaster Chancery Court), shall, as regards all persons, bodies corporate, and property within or becoming subject to its jurisdiction, have and exercise the like powers and jurisdiction, and in a similar manner, and subject to the same restrictions in all respects, as the High Court in its Chancery Division now has and exercises, or may, under or by virtue of any Act of Parliament hereafter passed, and not expressly enacting to the contrary hereof, have and exercise, in respect of all persons, bodies corporate, and property within its jurisdiction."*

The effect of this Act is to extend the meaning of the word



“Court” in the Patents, &c. Acts, to the Palatine Court so far as it relates to actions for infringement.

A grant of letters patent gives to the patentee a right which extends over the whole of the United Kingdom, and only a small portion of that right lies in the district which is within the jurisdiction of the Palatine Court, consequently the Chancery of Lancaster Act, 1890, does not give to that Court power to adjudicate upon a petition for revocation of letters patent since the whole of the property which is the subject of the petition does not lie within its jurisdiction.

A county court has no jurisdiction to try an action for infringement when the validity of the patent is in dispute (y). County Court has no jurisdiction.

As has been pointed out (p. 334, supra), the Chancery Division is to be preferred to the King’s Bench for the trial of patent cases, although they are sometimes tried on circuit with a jury, but with very unsatisfactory results. Chancery to be preferred to K. B. D.

It is no ground for postponing the trial of an action for infringement that a petition has been presented by the defendant or any other person under sect. 26 to revoke the patent.

We have seen that proceedings for revocation are similar to, and for the same purpose as, *scire facias* prior to the Act of 1883. In *Muntz v. Foster* (1843, 2 Web. P. C. 93, n.), it had been held that the fact of a writ of *scire facias* being pending was no ground for staying the action for infringement. Tindal, C.J., said: “As a general rule, a plaintiff has a right to have his cause go on for trial according to the ordinary course of business. Special circumstances may exist upon which the Court may see fit to interfere; but the present does not appear to us to be a case in which we ought to interfere by staying the proceedings in the action.” Revocation no reason for stay.

The ground of this decision was that the plaintiff in the action for infringement, being defendant in the proceedings by *scire facias*, had not the conduct of those proceedings, and that the defendant in the action for infringement might delay them; but where, in *Patteson v. Holland* (Hindmarch, 293), an action for

(y) *R. v. County Court Judge of Halifax*, 1891, L. R. 1 Q. B. 793; 1891, L. R. 2 Q. B. 263; 8 P. O. R. 338.

infringement had been tried, and a rule *nisi* for a new trial had been obtained and argued, and it appeared that another action was pending in that Court for another infringement of the same patent, and that a *scire facias* had been sued out to repeal the patent, the Court suspended their judgment upon the rule for a new trial, and ordered the trial of the other action to be postponed until after the trial of the *scire facias*.

And where a verdict had already gone for the Crown on *scire facias*, but a new trial was pending, the plaintiff was not permitted to proceed to trial with his action for infringement until the rule for the new trial in *scire facias* had been disposed of (z).

Right to  
begin.

In an action for infringement the plaintiff has the right of beginning and of replying, notwithstanding that the burden of proof may really be on the defendant, as, for instance, where the case principally turns upon questions of prior user or prior publication, which are introduced by the defendant. It sometimes happened that this privilege, particularly in cases of conflicting evidence, was of great value, and for the purpose of snatching it from the plaintiff the defendant did not wait for the plaintiff to commence his action, but commenced proceedings himself by *scire facias* to repeal the patent, so as to place himself in the position of plaintiff. But, by sect. 26, sub-sect. 7, of the Act of 1883, it is provided that in cases where it is sought to revoke a patent, "*The defendant shall be entitled to begin and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent, the defendant shall be entitled to reply.*"

In *Westley Richards v. Perkes* (1893, 10 P. O. R. 181) the fact of infringement was admitted, and the case turned upon the validity of the plaintiff's patent. Kay, L.J., stopped the plaintiff's counsel after having made out a *prima facie* case, the burden of proof as to invalidity being on the shoulders of the defendant, and in that case the learned judge gave leave to the defendant's counsel to reply on the whole case. Probably this was owing to the fact that the point that the alleged anticipa-

(z) *Smith v. Upton*, 1843, 6 M. & G. 251.

tion was never published was not taken by the plaintiff's counsel until he replied generally to the defendant's case.

The plaintiff must give evidence of the issues, which he is bound to prove. It is for him to support his patent and to establish its validity. He must prove his patent if the grant be denied. This is done by producing the patent itself, with the great seal—or, under the Act of 1883, the seal of the Patent Office—attached to it. Sect. 12, sub-sect. 2, provides that, "*A patent so sealed shall have the same effect as if it were sealed with the great seal of the United Kingdom*"; or under sect. 89, if it be not convenient or possible to produce the original, "*Printed or written copies or extracts, purporting to be certified by the Comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers, and other documents in the Patent Office, and of or from registers and other books kept there shall be admitted in evidence in all Courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals.*"

Onus of proof of issues.

If the plaintiff sues as assignee, or under any derivative title, and his title is denied, the entry from the register of patents may be proved in the manner suggested by the 89th section.

Assignments.

Under the 96th section "*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 primâ 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.*"

For instance, if an entry in the register is denied by the defendant, he may prove its omission by a certificate under the 96th section.

If the fact of infringement is denied, the plaintiff must be ready with evidence that the defendant has made, used, or sold the articles or process, and any one of these acts, as we have already seen, will satisfy the allegation of infringement, whether intentional or not (a).

The burden of proving infringement is strictly on the plaintiff, and if he does not satisfactorily prove it there is no necessity of

Infringement.

(a) See Chap. XVI., p. 275.

entering upon the defendant's case on other matters. The plaintiff must always give evidence, when the alleged infringement is the sale or use of an article, that it was not made by himself or his agents (b).

The plaintiff must, if the matter be put in issue, prove that the title, provisional specification and complete specification, correspond and substantially describe the same invention (c).

If it is alleged by the defendant that the invention is illegal or useless, the burden of proof is on the plaintiff.

So the plaintiff must be prepared, if he intends to claim damages, and not an account, to prove the damage which he has sustained. The usual course, however, is for an inquiry as to damages to be ordered.

**Insufficiency.** When the defendant alleges that there is a defect or insufficiency in the specification, the burden of proving that there is no such defect is on the plaintiff.

We have seen that it is for the jury to say whether a specification is sufficient or intelligible or not; it is for the Court to place a construction upon the language used in the specification. The plaintiff must therefore be prepared with evidence of an expert character as to the sufficiency of the specification; and in selecting this evidence the plaintiff cannot be better guided than by the judgment of Sir George Jessel in *Plimpton v. Malcolmson* (1876, L. R. 3 C. D. 531, and see also p. 125, et seq.). He must not select eminent engineers or celebrated chemists as the persons to whom the specification must be intelligible, but he must choose "ordinary workmen" in the particular branch of trade to which the invention refers—"not a careless man, but a careful man, though not possessed of that great scientific knowledge or power of invention which would enable him by himself unaided to supplement a defective description or correct an erroneous description." He may, of course, call eminent engineers, but their evidence can only be, "placing myself in the position of an ordinary workman I think it would or would not be intelligible or sufficient to me." If the specification be not sufficiently clear to be understood by an ordinary workman

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

(c) See Chap. VII.

(a witness for the plaintiff), witnesses will not be allowed to be called to explain the intention of the patentee.

An expert witness cannot be asked his opinion as to whether or not there has been infringement. That is a question for the jury, or the Court in the absence of a jury (*d*). Functions  
of expert  
witness.

The function of an expert was very clearly explained by Lindley, L.J., in *Brookes v. Steele and Currie* (1897, 14 P. O. R. 73). "It is necessary to examine the patent, and to ascertain first what the patented invention really is; and secondly whether the defendants have used that invention. In this, as in all cases, the nature of the invention must be ascertained from the specification, the interpretation of which is for the judge, and not for any expert. The judge may, and indeed generally must, be assisted by expert evidence to explain technical terms, to show the practical working of machinery described or drawn, and to point out what is old and what is new in the specification. Expert evidence is also admissible and is often required to show the particulars in which an alleged invention has been used by an alleged infringer, and the real importance of whatever differences there may be between the plaintiff's invention and whatever is done by the defendant. But, after all, the nature of the invention for which a patent is granted must be ascertained from the specification, and has to be determined by the judge and not by a jury, nor by any expert or other witness. This is familiar law, although apparently often disregarded when witnesses are being examined" (*e*).

The description of evidence which is admissible in an action for infringement has been considered in an earlier chapter (*f*); questions, however, which may be put to an expert witness in examination in chief differ to some extent from those which may be put in cross-examination. When the witness has stated in his examination that an ordinary workman would make a certain machine from the description contained in the specification, it is open to the counsel on the other side to cross-examine

(*d*) Per Lord Wensleydale, in *Smith, L.J., in The Ticket Punch Seed v. Higgins*, 1860, 8 H. L. Cas. 550. Register Co. v. Colley's Patent, Ltd., 1895, 12 P. O. R. 186.

(*e*) And see remarks of A. L. (*f*) See p. 293 et seq., ante.

him upon the specification, taking it line by line for the purpose of showing that what he said in the first instance was incorrect, although that method of questioning would not be permitted on examination in chief.

The Court will consider the circumstances of the case, the behaviour of the witnesses and their credibility, when considering the question of infringement or no infringement.

In *Clark v. Adie* (1877, L. R. 2 A. C. 337), Lord Blackburn said: "Whenever a man, knowing for the first time of an invention, either by seeing a machine at work or by reading a specification, proceeds to do what he never did before, and takes a part of the invention, it is always a very strong *argumentum ad hominem* to say: You are, by the very fact of taking this, making evidence against yourself that it was a new invention; otherwise, why did you take it? You are making evidence against yourself that at all events the part you took was new, or why did you take it? and whenever there is a case of theft or stealing knowingly, that observation ought to have some weight, although I think in practice it has more weight given to it than it ought to have. But where there is a case of an innocent infringement of property, by an unwitting use of this sort, that observation can have no weight against the party in the slightest degree, and I think it ought not to have any."

**Experiments.** Experiments conducted for the express purpose of manufacturing evidence, with a view to litigation, are to be looked at with distrust (*g*).

**Issue of true and first inventor.** When the defendant pleads that the grantee of the letters patent was not the true and first inventor, the onus of proof is entirely on him, and no evidence need be given by the plaintiff to establish a *prima facie* case (*h*).

**Novelty.** If it be pleaded that the invention was not new, it will be sufficient if the plaintiff gives some *prima facie* evidence of novelty (*i*). It will be sufficient to call one or two persons acquainted practically with the trade to which the invention

(*g*) *Young v. Fernie*, 1864, 4 Giff. 609; 12 W. R. 901.

(*h*) *Ward v. Hill*, 1901, 18 P. O. R. 490.

(*i*) *Turner v. Winter*, 1787, 1 T. R. 606; 1 Web. P. C. 77; *Westley*

*Richards v. Perkes*, 1893, 10 P. O. R. 181, 186.

refers, to say that they never heard of it, or saw or heard of its having been put in practice or published before the date of the patent. Gibbs, C.J., said: "The first witness, a man of considerable experience, had never seen locks with the lips so perforated; *primá facie* that is good evidence; but when the question is, whether this had existence previous to the patent, fifty witnesses proving that they never saw it before would be of no avail if one was called who had seen it and practised it" (k).

The plaintiff having given this *primá facie* evidence, the burden of proof as to prior user or prior publication is shifted to the defendant, and if he would invalidate the patent he must prove his case.

We have previously discussed what amounts to prior user and prior publication (l). The evidence which the defendant brings must be complete and satisfactory, and the question is one of fact.

If the defendant has succeeded in establishing a case against the plaintiff, the latter will be permitted, before the defendant sums up, to adduce rebutting evidence. In *Penn v. Jack and Others* (1866, L. R. 2 Eq. 317), Sir W. Page-Wood, V.-C., said: "I think the plaintiff is entitled to adduce evidence, in reply, for the purpose of rebutting the case set up by the defendants; and for this reason, that it is quite impossible for him to know what is the nature of the evidence which is to be produced. The defendants, who contest the validity of the invention, have in effect put in a plea denying the novelty of the plaintiff's patent; and the affirmative of the issue just raised in reality rests with the defendants who are not obliged to give the names of their witnesses. How can the plaintiff possibly meet such a case until he hears the evidence for the defence, and knows what their witnesses will prove? I should be very sorry to have to put the parties to all the expense and delay of a new trial, which I should have to direct, if this evidence were excluded. Besides which, the witnesses are at hand and ready, and the sensible and obvious course is to examine them now.

(k) *Manton v. Manton*, 1815, Dav. P. C. 350. (l) See Chap. V., ante.

The practice at common law is stated in Taylor on Evidence; and it appears that where, as here, several issues are joined, the plaintiff may content himself with adducing evidence in support of those issues which he is bound to prove, reserving the right of rebutting his adversary's proofs, in the event of the defendant establishing a *prima facie* case with respect to the issues which lie upon him. In support of this proposition, *Shaw v. Beck* (1853, 8 Ex. 392) is cited, where Parke, B., used the following expression: 'But Abbott, C.J., laid down what appears to me to be a more reasonable rule, by holding that the defendant was bound to prove his plea, and that the plaintiff might answer it by additional evidence.' Other instances are also mentioned, all showing the wide discretion given to the judge in allowing evidence to be given by the plaintiff in reply. The plaintiff has put in his letters patent as formal evidence of his title. The defendants then plead want of novelty, and give, in proof of the issues thus raised by them, special evidence, which the plaintiff is entitled to rebut, by evidence in reply. Regarding this case as one of an affirmative plea, the burden of proving which rests on the defendants, I feel bound to admit the evidence proposed to be given by the plaintiff in reply."

Defendant  
may not  
bring new  
evidence.

Although the plaintiff may, as of right, rebut the case made by the defendant upon any issue which rests with the defendant, where the plaintiff has given such rebutting evidence, the defendant will not be allowed to strengthen the case which he had made by adducing further evidence; and this will apply with greater force when the defendant's counsel has summed up the evidence which has been offered (*m*).

No objection  
to particulars  
at trial.

At the hearing of the action, no objection will be allowed either to the particulars of objections, or to the particulars of breaches, and any evidence will be received which they are wide enough to admit of. If there is any vagueness or insufficiency in the particulars, the party requiring further information must apply for it to a Judge in Chambers, within reasonable time before the trial of the action; but they will not be allowed to permit the opposite side to go to trial, and then to submit that for want of suffi-

(*m*) *Penn v. Jack*, 1866, L. R. 2 Eq. 314.



cient particularity in the objection, the evidence is not admissible (n).

Where the defendant alleged a secret process in an action for infringement, the hearing was conducted *in camera* and the shorthand notes of the trial impounded by order of the Court (o). Where secrecy required.

QUESTIONS FOR COURT AND JURY.

We have seen that, as a rule, actions for the infringement of letters patent are directed to be tried before the Court without a jury. Still, under special circumstances, the parties, or either of them, may obtain an order to try before a jury. Under these circumstances it will still be material to consider what are the questions which the Court should leave to the jury, and which are left to the decision of the Court.

As to the specification. The construction is for the Court (p); Construction. and the rules of construction are similar to those which govern the construction of other documents (q).

It is for the jury to say whether the specification is intelligible (r) or not, and it is for the Court to direct the jury as to the class of persons to whom it must be intelligible (s). Intelligibility.

It is for the jury to say whether the specification is sufficient or not, that is, whether it contains a sufficient description of the invention; but it is for the Court to inform the jury the degree of sufficiency which the law requires in specifications (t). Sufficiency.

The novelty of the invention is a question for the jury. Novelty. Questions of prior user or prior publication are always questions of fact, and it is for the jury to compare what has been done before and what is set up as being new, and to say whether or not they are identical. And so any document which is said to amount to prior publication must be construed by the Court, but it is for the jury to compare it with the specification and to say whether the described matter is the same or not (u).

(n) See p. 350, ante.

(o) *Badische Anilin und Soda Fabrik v. Levinstein*, 1883, L. R. 24 Ch. D. 156.

(p) Ante, p. 126.

(q) Ante, p. 128.

(r) Ante, p. 126.

(s) Ante, pp. 125, 134.

(t) Ante, pp. 126, 134.

(u) Ante, p. 88.

**Utility.** The utility of the invention is also for the jury, subject to the directions of the Court as to the degree of utility which the law requires for the purpose of supporting the validity of a patent (x).

**Infringement.** The question of infringement is for the jury. In *De la Rue v. Dickenson* (1857, 7 E. & B. 755), Campbell, C.J., said: "There may well be a case where the judge may and ought to take upon himself to say that the plaintiff has offered no evidence to be left to the jury to prove infringement, as if there were a patent for a chemical composition, and the evidence was that the defendant had constructed and used a machine for combing wool. But, if the evidence has a tendency to show that the defendant has used substantially the same means to obtain the same result as specified by the plaintiff, and scientific witnesses have sworn that the defendant actually has used such means, the question becomes one of fact, mixed with law, which the judge is bound to submit to the jury."

In *Seed v. Higgins* (1860, 30 L. J. Q. B. 317), Lord Chelmsford in the House of Lords said: "What the defendant had done in any case was of course a question of fact, but whether, on proof of certain acts having been done by a defendant, the plaintiff had any case to go to a jury, was a question for the judge."

#### CERTIFICATES.

**Certificate of validity.**

Sect. 31 of the Patents, &c. Act, 1883, is as follows:—"In an action for infringement of a patent, the Court or a judge may certify that the validity of the patent came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges and expenses as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same."

Similar provisions were contained in 5 & 6 Will. IV. c. 83, and also in the 43rd section of the Patent Law Amendment Act, 1883.

(x) Ante, p. 102.

The object of these sections is to prevent patentees of important inventions being ruined by successive actions which they are bound to bring to restrain infringements, manufacturers banding themselves together to defeat a patentee's rights in this manner.

The Act of William IV. cited above gave the patentee a right to treble costs, but this was taken away by 5 & 6 Vict. c. 97, which gave him full costs; and now, as we have seen, costs as between solicitor and client are substituted for full costs.

To acquire the protection of the 31st section a certificate is requisite, and this should be applied for at the trial of the action, and the application must be made to the Court or judge who has tried the cause (*y*).

The Court has no power to order full costs upon the first trial in which the validity of the patent came in question, the words of the statute being "in any subsequent action for infringement" (*z*).

When a certificate of validity has once been granted, the Court will not grant another in a subsequent action upon the same patent (*a*).

Upon the trial of the second action the record of the first action with the endorsement must be produced, but not before the verdict, in such a manner as to prejudice the second trial (*b*).

It does not appear clear whether or not a certificate might be granted, in an action to restrain threats, that the validity of the patent came in question. This point arose in *Crampton v. The Patents Investments Co.* (1888, 5 P. O. R. 382), which was an action under sect. 32. In that case it was held that the defendant's patent was valid, and had been infringed; application was made by the counsel for the defendant for a certificate under sect. 31. Field, J. (p. 404), said: "I entertain great doubt whether I have jurisdiction, and I think the safer course will be for me to give a certificate without prejudice to the validity of it, if it should come into operation."

(*y*) *Gillett v. Green*, 1841, 7 M. & W. 347.

(*z*) *Penn v. Fernie*, 1866, L. R. 3 Eq. 308.

(*a*) *Edison v. Holland*, 1889, 6 P. O. R. 243.

(*b*) *Newall v. Wilkins*, 1851, 17 L. T. 20.

Judge will  
protect  
public.

In obtaining this certificate the plaintiff and the country are the parties, not the defendant, and the judge is bound to protect the interests of the country and to see that the certificate is not given when the validity of the patent has not, in fact, been proved to the satisfaction of the Court; otherwise, there is nothing to prevent collusive actions being merely brought for the purpose of obtaining this valuable privilege—a privilege which can be used as an enormous lever, preventing persons from incurring the risk of a conflict with the patentee (c).

When  
granted.

The practice seems to be to grant the certificate where the plaintiff is quite ready to fight the validity of the patent, even though the fight should not actually take place through the non-appearance or the submission of the defendant; but the Court ought to be satisfied that the withdrawal of the defendant from the contest is not the result of collusion, and *prima facie* evidence should be given in such cases.

In *Haydock v. Bradbury* (1887, 4 P. O. R. 74) the validity of the patent was put in issue by the defence, but the defendant not appearing at the trial, the validity of the patent was not seriously contested. *Prima facie* evidence of validity was given, and judgment was given for the plaintiff and a certificate of validity granted (d).

In *The Delta Metal Co. v. Maxim Nordenfelt Co.* (1891, 8 P. O. R. 248), after the trial had been in progress for some days, the parties agreed to a compromise in the following terms:—"Judgment for plaintiffs on validity of patent. Plaintiffs to be at liberty to ask the judge for a certificate. Judgment for defendants on infringement. Plaintiffs to pay 30% towards the defendants' costs. No other action to be brought on plaintiffs' patent against defendants or their customers."

Judgment was given upon the terms of the compromise. In answer to an application of plaintiffs' counsel for a certificate of

(c) *Stocker v. Rogers*, 1843, 1 C. & K. 99; see also *Peroni v. Hudson*, 1884, 1 P. O. R. 261. *land Acetylene Syndicate*, 1900, 17 P. O. R. 534; *Brooks v. Lycett*, 1903, 20 P. O. R. 390; *Consolidated Pneumatic Tool Co. v. Churchill*, 1905, 22 P. O. R. 367.

(d) Also *United Phonograph Co. v. Young*, 1894, 11 P. O. R. 492; *Acetylene Illuminating Co. v. Mid-*

validity, Collins, J., said: "I am not asked to pronounce any opinion, and I do not pronounce any opinion. It has unquestionably been brought in question, and you have arranged between yourselves how it is to be decided. You will hand the terms in—I do not do anything. I simply give judgment in accordance with the terms of your consent; that is all." Certificate granted.

In *Chaaburn's Telegraph Co. v. Robinson* (1905, 22 P. O. R. 468), the action was brought upon two patents. As to one of them, the defendants submitted to an injunction before any evidence was given. Evidence was then given in support of the validity of both patents, and the witnesses were not cross-examined. The defendants then submitted, as the result of a compromise, to pay a fixed sum as damages and to become the licensees of the plaintiffs. Farwell, J., granted a certificate in respect of each patent.

In *Cloughten v. Foster* (1904, 21 P. O. R. 17), however, a similar case, the certificate was refused.

In *Morris and Bastert v. Young* (1895, 12 P. O. R. 464), the defendants attacked the validity of the patent only on the assumption that it was wide enough to cover what they were doing. The House of Lords held that there was no infringement, and that the patent was valid on a narrow construction, and therefore refused a certificate of validity.

In neither of the two first-mentioned cases was the validity of the patent put to the test, and it must be surmised that the certificates were granted in those cases owing to the fact that the judgment of Erle, J., in *Stocker v. Rogers*, referred to above, was not brought under the notice of the judge on account of the acquiescence by the defendant, and in consequence the *ratio decidendi* of that judgment was not properly taken into consideration by the Court.

In the first of the cases (*Haydock v. Bradbury*), Kekewich, J., said: "Unless there is some authority to the contrary, I do not see why you should not have a certificate where the defendant retires from the contest." The counsel for the plaintiff intimated that he did not know of any authority on the point, and a certificate was accordingly granted; and in none of the subse-

quent cases was the matter seriously argued, since there was no opposition.

The cases of *The Delta Metal Co. v. The Maxim Nordenfett Co.*, and those that followed (*supra*), seem to fall exactly within the evil contemplated by Erle, J., and which he considered so important to avoid.

No certificate that the validity has come into question will be granted when the Court has declared that the patent is invalid (*e*).

No appeal.

No appeal will lie from a granting or refusing to grant a certificate that the validity of the patent came in question; such appeal not being from a judgment or order within sect. 19 of the Judicature Act (*f*).

The subsequent action.

“In any subsequent action for infringement:” A certificate of validity granted in one action will not affect the costs in another, although decided at a later date, provided that the latter proceedings were instituted before the grant of the certificate in the earlier action (*g*).

When solicitor and client costs are given.

“Unless the Court or judge trying the action certifies that he ought not to have the same.” This clause gives unlimited discretion to the judge, a discretion which is exercised in view of the facts of each particular case; so where the second action was vexatious (*h*), or where litigation was the natural consequence of the vague and lax manner in which the specification had been drawn up (*i*), costs as between solicitor and client were refused (*k*).

In *Otto v. Steel* (1886, 3 P. O. R. 120), solicitor and client costs were refused on the ground that the validity of the patent

(*e*) *Acetylene Illuminating Co. v. United Alkali Co.*, 1902, 19 P. O. R. 234.

(*f*) *Haslam v. Hall*, 1888, L. R. 20 Q. B. D. 491; 5 P. O. R. 144.

(*g*) *The Automatic Weighing Machine Co. v. The International Hygienic Soc.*, 1889, 6 P. O. R. at p. 480; *Saccharin Corp'n. v. Anglo-*

*Continental Co.*, 1900, 17 P. O. R. 320.

(*h*) *Proctor v. Sutton*, 1888, 5 P. O. R. 184.

(*i*) *Automatic Weighing Machine Co. v. National Exhibitions Association*, 1891, 8 P. O. R. 352.

(*k*) See also *Boyd v. The Tootal Broadhurst Lee Co.*, 1894, 11 P. O. R. at p. 185.

was attacked on new grounds entirely; but it is unlikely that this case will be followed at the present day (*l*).

The burden is on the defendant to show cause why he should not pay solicitor and client costs under this section (*m*).

The fact that the validity of the patent was not brought into question in the second action is merely one of the circumstances to be considered by the judge in exercising his discretion, and will not preclude the granting of solicitor and client costs. This is now decided, although in some older cases it had been doubted.

In *The Welsbach Incandescent Gas Light Co. v. The Daylight Incandescent Mantle Co.* (1899, 16 P. O. R. 353), Byrne, J., said: "The rule applies to all actions for infringement, and not necessarily to actions disputing the validity of the patent, and, unless some very special reason is shown, I see no reason to depart from what the section says" (*n*).

In two recent cases, however, where the issue in the second action was merely one of infringement, solicitor and client costs were refused by Farwell, J. (*o*).

Sect. 29 of the Act of 1883, after providing for the delivery of particulars of breaches and objections, enacts:—(6.) "On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant, and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a judge to have been proven, or to have been reasonable and proper without regard to the general costs of the case." Statute.  
Certificates of  
particulars.

It is important, therefore, to ask for a certificate that the particulars of breaches or of objections, as the case may be, were

(*l*) See *Fabrique de Produits Chimiques v. Lafitte*, 1899, 16 P. O. R. 68; *v. Townsend*, 1886, 3 P. O. R. 10; *United Telephone Co. v. St. George*, 1886, 3 P. O. R. 321; *United Telephone Co. v. Patterson*, 1889, 6 P. O. R. 142; *Fabrique de Produits Chimiques v. Lafitte*, 1899, 16 P. O. R. 68.

(*m*) *United Telephone Co. v. Patterson*, 1889, 6 P. O. R. 142; see also *United Telephone Co. v. St. George*, 1886, 3 P. O. R. at p. 339; *The Welsbach Incandescent Gas Light Co. v. The Daylight Incandescent Mantle Co.*, 1899, 16 P. O. R. 354.

(*n*) See also *United Telephone Co. v. Dawson*, 1902, 19 P. O. R. 173; *Edison-Bell Phonograph Co. v. Waterfield*, 1902, 19 P. O. R. 330.

reasonable and proper. The application should be made at the conclusion of the trial, although the omission to do so does not preclude the successful party from obtaining it, provided he applies within a reasonable time, and he is subject to the costs incurred by the delay (*p*).

The certificates granted under this section must not be confused with the certificate under sect. 31. The object of sect. 29 is to provide what costs shall be payable in the action itself, and the object of sect. 31 is to provide for the costs of future actions.

Each item  
should be  
certified.

Care must be taken at the trial to ask the judge to certify as to each particular breach mentioned in the particulars of breaches, and as to each particular objection; and no costs of witnesses, or of, and incidental to, such breach or objection, as is not specially certified for, will be allowed (*q*).

Apportion-  
ment of costs.

Where the plaintiff is successful on some issues and the defendant on some, the costs should be apportioned, the plaintiff receiving a certificate as to the particulars of breaches and the defendant as to the particulars of objections. In *Badische Anilin Fabrik v. Levinstein* (1885, L. R. 29 Ch. D. 418; 2 P. O. R. 118), in the Court of Appeal, Bowen, L.J., said: "I am of opinion in this case that the plaintiffs should have the costs occasioned by the issues raised by the particulars of breaches, and that in respect of all the other costs the costs in the action should follow the usual result and be awarded to the successful party. It seems to me that without laying down any hard and fast line, or trying to fetter our discretion at a future period in any other case, we are acting on a sensible and sound principle, namely, the principle that the parties ought not, even if right in the action, to add to the expenses of an action by fighting issues in which they are in the wrong. It may be very reasonable with regard to their own interest, and may help them in the conduct of the action, that they should raise issues in which, in the end, they are defeated, but the defendant

(*p*) *Rowcliffe v. Morris*, 1886, 3 P. O. R. 147; *Duckett v. Sankey*, 1899, 16 P. O. R. 360.

(*q*) *Honiball v. Bloomer*, 1854, 10 Exch. 538; see also *Losh v. Hague*, 1839, 5 M. & W. 387; *Parnell v. Mort, Liddell & Co.*, 1885, L. R. 29 Ch. D. 325; *Longbottom v. Shaw*, 1889, 6 P. O. R. 510.



who does so does it in his own interest, and I think he ought to do it at his own expense. The order, therefore, I think ought to be as I have stated."

Costs will be apportioned both where the patent is held to be invalid and the acts alleged to be infringements proved (r), and where the plaintiff fails on the issue of infringement and succeeds in upholding his patent (s), but in each of these cases the issues must be perfectly distinct (t). In *Kaye v. Chubb* (1887, 4 P. O. R. 300), Lord Esher, M.R., said: "Where a plaintiff brings an action on a patent and there is a real struggle, and an expensive struggle, as to whether there is an infringement or not, and the plaintiff proves the infringement, but fails because his patent is a bad one, I am not going to say that the person who has proved the infringement is not to have the costs of that issue; but in this particular case I cannot see that there are any material costs different from the costs of the cause which the defendants would be entitled to under the opinion to which I have finally come."

In cases of great difficulty the apportionment has been much simplified by the judge at the trial making an order that the entire taxed costs are to be divided between the parties in definite proportions (u).

Where the act of infringement was admitted before the trial,

(r) *Ibid.* See also *Young v. Rosenthal*, 1884, 1 P. O. R. 41; *Phillips v. Ivel Cycle Co.*, 1890, 7 P. O. R. at p. 85; *Binnington v. Hill*, 1891, 8 P. O. R. at p. 332; *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syn.*, 1894, 11 P. O. R. at p. 653; but note *United Telephone Co. v. Harrison*, 1882, L. R. 21 Ch. D. 720, 747; and *Blakey v. Latham*, 1889, 6 P. O. R. 29, 38; also in C. A., 6 P. O. R. 184, 190; *Badische Anilin und Soda Fabrik v. Société Chimique*, 1897, 14 P. O. R. 891; *Kane v. Boyle* 1899, 16 P. O. R. 443.

(s) *Tweedale v. Ashworth*, 1890, 7 P. O. R. at p. 435; *Nobel's Ex-*

*plosives Co. v. Anderson*, 1894, 11 P. O. R. at p. 128; *The Sunlight Incandescent Gas Light Co. v. The Incandescent Gas Light Co.*, 1897, 14 P. O. R. 775; *Dunlop Pneumatic Tyre Co. v. Wapshare Tube Co.*, 1900, 17 P. O. R. 458; *White v. Hartley*, 1903, 20 P. O. R. 275; *Pilkington v. Massey*, 1904, 21 P. O. R. 712.

(t) *Kaye v. Chubb*, 1887, 4 P. O. R. at p. 300; *Ellington v. Clark*, 1888, 5 P. O. R. 328; *Parkinson v. Simon*, 1894, 11 P. O. R. 238, 256.

(u) *Incandescent Gas Light Co. v. Sunlight Incandescent Co.*, 1896, 13 P. O. R. 345; *Monnet v. Beck*, 1897, 14 P. O. R. 850.

the plaintiffs were not allowed any costs on that issue, their patent being held to be invalid (*x*).

Where the plaintiffs brought an action for infringement of two patents, but abandoned their case as to one of them at the trial of the action, it was held that the plaintiffs should pay all costs incurred by the defendants so far as occasioned by the claim to the patent so abandoned, although successful in the remainder of their action (*y*). And a similar apportionment may be made where the plaintiff succeeds on one patent and fails on another (*z*).

Where case  
not tried out.

If an action be not tried out, it is obvious that a difficulty may arise as to costs, since the parties have had no opportunity to prove or disprove their particulars. Where the defendant does not appear, there is little difficulty concerning the particulars of breaches, and the Court will usually certify apparently on the ground that the non-appearance is evidence that they are reasonable (*a*).

As to par-  
ticulars of  
objections.

As to the particulars of objections, the practice is now well settled that the Court will not certify unless the defendants can actually show that they are reasonable and proper; and so, where the action came on for hearing, and the plaintiff's case broke down by reason of certain of the particulars, the Court would not go through all the particulars with a view to ascertaining whether they were reasonable and proper, and a certificate was granted only as to those upon which the action was decided (*b*).

The same principle applies where the plaintiff abandons the action before trial, and no certificate will be granted (*c*) unless

(*x*) *Westley Richards v. Perkes*, 1893, 10 P. O. R. at p. 194.

(*y*) *Hocking v. Fraser*, 1886, 3 P. O. R. 3; see also *Edison v. Woodhouse*, 1886, 3 P. O. R. 167, 178.

(*z*) *Brooks v. Lamplugh*, 1898, 15 P. O. R. 52.

(*a*) *Brooks v. Hall*, 1904, 21 P. O. R. 29; *Saccharin Corporation v. Skidmore*, 1904, 21 P. O. R. 31.

(*b*) *Longbottom v. Shaw*, 1888, 5 P. O. R. 497, 502; 6 P. O. R. 143, 147; *Boyd v. Horrocks*, 1889, 6 P. O. R. 152, 162; *Garrard v. Edge*, 1889, 6 P. O. R. 372, 563; 7 P. O. R. 139; *Acetylene Illuminating Co. v. United Alkali Co.*, 1902, 19 P. O. R. 233.

(*c*) *Mandleberg v. Morley*, 1895, 12 P. O. R. 37; *Middleton v. Bradley*, 1895, 12 P. O. R. 391;

the Court had some opportunity of examining into the nature of the particulars (*d*). In *Middleton v. Bradley* (1895, 12 P. O. R. 392), Stirling, J., said: "It is said that where there is no trial there is no opportunity of getting a decision of the Court as to the propriety of the particulars, but I am not satisfied that that is so. It may be that a motion has been made in the action, in which evidence has been adduced which would enable the Court or a judge to certify. It may be that some interlocutory application of some kind, perhaps with reference to these very particulars, may have been made in which the Court or a judge had an opportunity of being satisfied as to the propriety or the reasonableness of the particulars, and the general language of sect. 29 does not seem to me to be limited to cases in which the action is brought to trial." And in *Kerr v. Crompton* (1902, 19 P. O. R. 11), Hall, V.-C., said: "In these cases the Court never directs or allows the action or the summons to be set down for the purpose of examining whether the particulars are reasonable and proper; but if the Court has gone into the matter, and knows enough about it to grant a certificate, then it does not matter whether it was at the trial or in some interlocutory proceedings that the Court obtained materials on which to found a certificate."

Where one of the items in the particulars of objections is relied on as an anticipation, but fails in this capacity, the Court may nevertheless certify for it, if it has been useful in illustrating the state of the art or otherwise (*e*).

No mention is made in sect. 29 to a petition for revocation, so probably in such case the provisions of that section will be held not to apply (*f*); but as the Court has a discretion in the matter of costs, the petitioner might nevertheless be deprived of the costs of such particulars as were unreasonable.

In petition  
for revoca-  
tion.

No costs were allowed a defendant who was successful by

*Wilcox and Gibbs Sewing Machine Co. v. Janes*, 1897, 14 P. O. R. 523. *v. Commercial Development Co.*, 1899, 16 P. O. R. 276.

(*d*) *Middleton v. Bradley*, 1895, 12 P. O. R. 392; *Kerr v. Crompton*, 1902, 19 P. O. R. 11. (*f*) *Gaulard v. Gibbs' Patent*, 1888, 5 P. O. R. 525, 537; cf. *Partridge's Patent*, 1903, 20 P. O. R. 459.

(*e*) *The Castner-Kellner Alkali Co.*

reason of anticipations only put in by amendment of his particulars of objections at the trial of the action (*g*).

We have seen that, since the Judicature Acts, the Common Law Division and the Chancery Division can either of them grant full relief in an action for the infringement of a patent, granting both an injunction and damages, or an account. In former times the Common Law Courts merely inquired into damages, and if less than 40s. was recovered a question arose as to whether or not County Court costs should not alone be allowed; but now in every patent case an injunction may be granted, and this removes the case from the operation of 30 & 31 Vict. c. 142, s. 5.

Higher and  
lower scale  
costs.

The Rules of the Supreme Court provide for cases where the higher scale and lower scale of costs are to be allowed; and in future, notwithstanding that an injunction is granted, it will be necessary to ask the judge at the trial to certify for costs on the higher scale.

Order LXV. r. 8, provides: "In causes and matters commenced after these rules come into operation, solicitors shall be entitled to charge and be allowed the fees set forth in the column headed 'lower scale' in Appendix N. in all causes and matters, and no higher fees shall be allowed in any case, except such as are by this order otherwise provided for; and in causes and matters pending at the time when these rules come into operation, to which the higher scale of costs previously in force was applicable, the same scale shall continue to be applied."

Rule 9.—"The fees set forth in the column headed 'higher scale' in Appendix N. may be allowed, either generally in any cause or matter, or as to the costs of any particular application made, or business done, in any cause or matter, if, on special grounds arising out of the nature and importance, or the difficulty or urgency of the case, the Court or a judge shall, at the trial or hearing, or further consideration of the cause or matter, or at the hearing of every application therein, whether the cause or matter shall or shall not be brought to trial or hearing, or to further consideration (as the case may be), so order;

(*g*) *Allen v. Horton*, 1893, 10 P. O. R. 412.

or if the taxing officer, under directions given to him for that purpose by the Court or a judge, shall think that such allowance ought to be made upon such special grounds as aforesaid."

Costs on the higher scale are only allowed in cases of exceptional difficulty, where a special class of witnesses was necessary for making clear the points at issue (*h*).

In *Gadd v. The Mayor, &c. of Manchester* (1892, 9 P. O. R. 535), Lindley, L.J., said: "I think costs on the higher scale ought only to be given where there are cases of very unusual difficulty and skill—antiquarian research and things of that kind. The idea of giving costs on the higher scale in all patent cases is one that I will not sanction."

In *The Wenham Gas Co. v. The Champion Gas Co.* (1891, 8 P. O. R. 320), costs on the higher scale were refused on the ground that the necessity for scientific evidence was largely due to the unfortunate wording of the specification.

The principles upon which costs on the higher scale should be allowed and the costs of briefing three counsel were discussed, and the authorities considered, by Buckley, J., in *The Dunlop Pneumatic Tyre Co. v. The Wapshare Tube Co.* (1900, 17 P. O. R. 459) (*i*), where both were allowed. But in the majority of cases in recent times they have been refused (*k*).

And three  
counsel.

The costs of the shorthand notes are usually agreed between the parties before the trial commences, but in default of such an arrangement they will not be allowed unless they have been of material assistance to the Court in shortening the amount of time the case has taken, or otherwise (*l*).

Shorthand  
notes.

(*h*) *Ellington v. Clark*, 1888, 5 P. O. R. 319, 328; *The Automatic Weighing Machine Co. v. The Combined Co.*, 1889, 6 P. O. R. 367, 372; *Farbenfabriken vorm. F. Bayer & Co. v. Bowker*, 1891, 8 P. O. R. 389, 397; *Hopkinson v. St. James' Electric Light Co.*, 1893, 10 P. O. R. 46, 62.

*Commercial Cable Co.*, 1895, 12 P. O. R. 64.

(*k*) On this point, see the list of authorities cited in *Bradford Dyers' Association v. Bury*, 1902, 19 P. O. R. 126.

(*l*) See, e.g. *Castner-Kellner Alkali Co. v. Commercial Development Co.*, 1899, 16 P. O. R. 275; *The Palmer Tyre, Ltd. v. The Pneumatic Tyre Co., Ltd.*, 1899, 16 P. O. R. 496.

(*i*) And see *Muirhead v. Com-*

Public  
authorities.

Under the Public Authorities Protection Act, 56 & 57 Vict. c. 61, a public authority is entitled to costs as between solicitor and client, and this applies to actions for infringement (*m*).

No appeal  
on costs.

Sect. 49 of the Judicature Act, 1873, provides that there shall be no appeal as to costs; but this was held not to apply where the costs were a matter of right, and not discretionary (*n*). Under the Rules of Court which were in operation prior to the 24th October, 1883, the question of higher or lower scale was a matter of right (*o*). Hence, in *Re Terrell* (1882, L. R. 22 C. D. 473), the Court of Appeal held that there was an appeal; but now it will be observed that the order is in the absolute discretion of the judge, and therefore it is submitted there is no appeal.

Directors of  
companies.

The directors of a limited company, whose servants have infringed a patent, may be ordered to pay costs personally.

In *Spencer v. The Ancoats Vale Co.* (1889, 6 P. O. R. 46), it was ordered that costs on the higher scale should be paid by the defendant company, and by the directors in the event of the company not paying (*p*).

Minutes of  
judgment.

Judgment having been recovered, minutes of judgment should be prepared. The minutes will be in accordance with one or other of the precedents given hereafter. We have drawn attention in previous pages to those points which should be attended to in preparing these minutes. Care should be exercised, when an account is directed to be taken, that provision be made for the payment of costs to the plaintiff up to and including the hearing, otherwise the payment of all costs will be delayed until the final account has been taken, which in some cases has been known to amount to a delay of years.

Stay.

A stay will be put upon a judgment pending appeal when the

(*m*) *Chamberlain and Hookham v. The Mayor, &c. of Bradford*, 1900, 17 P. O. R. 762; *British Thomson-Houston Co. v. Manchester*, 1903, 20 P. O. R. 471; *Chamberlain and Hookham v. Huddersfield*, 1901, 18 P. O. R. 456; cf. *New Conveyor Co. v. Edinburgh Commissioners*, 1904, 21 P. O. R. 147.  
 (*n*) *Turner v. Hancock*, 1879, L. R. 20 Ch. D. 303, C. A.  
 (*o*) Rules of S. C., 1875.  
 (*p*) See also *Betts v. De Vitre*, 1868, L. R. 3 Ch. 429.

matter at issue is of great importance, and when in the event of the judgment being reversed great injury would otherwise be incurred by the defendant; but in such cases the defendant is ordered to keep an account, and to bring his appeal without delay (q).

The usual course with regard to costs is for the solicitor to the successful party to give an undertaking to return the costs in the event of a successful appeal (r). In *Ackroyd & Best v. Thomas* (1904, 21 P. O. R. 412), where the solicitors refused the undertaking, Joyce, J., stayed the payment of the costs, but refused to stay the taxation.

## PRACTICE ON APPEAL.

Under Order LVIII. rule 4, the Court of Appeal has all the powers and duties as to amendment and otherwise of the High Court, together with full discretionary power to receive further evidence upon questions of fact, such evidence to be either by oral examination in Court, by affidavit, or by deposition taken before an examiner or commissioner. Such further evidence may be given without special leave upon interlocutory application, or in any case as to matters which have occurred after the date of the decision from which the appeal is brought. Upon appeals from a judgment after trial or hearing of any cause or matter upon the merits, such further evidence (save as to matters subsequent as aforesaid) shall be admitted on special grounds only, and not without special leave of the Court.

As to further evidence, in *Hinde v. Osborne* (1885, 2 P. O. R. 47), Lindley, L.J., said: "The power given to the Court of Appeal to hear fresh evidence is an extremely valuable one, and is given by Ord. LVIII. r. 4. I cannot understand that as

Principle of further evidence.

(q) *The North British Rubber Co. v. Macintosh*, 1894, 11 P. O. R. 477, 489; see also *Hocking v. Fraser*, 1886, 3 P. O. R. 7; *Kaye v. Chubb*, 1887, 4 P. O. R. 27; *Proctor v. Bennis*, 1887, 4 P. O. R. 363; *Lyon v. Goddard*, 1893, 10 P. O. R. 135; *Ducketts v. Whitehead*, 1895, 12 P. O. R. 191; and see p. 319, ante. For form of order, see *Lyon v. Goddard*, 1893, 10 P. O. R. at p. 136.

(r) *The Ticket Punch Register Co. v. Colley's Patents, Ltd.*, 1895, 12 P. O. R. 10.

meaning that the Court of Appeal ought to grant leave to adduce fresh evidence, simply because a man has failed at the trial and he thinks he can get more evidence, which, if he had got it before, would have enabled him to succeed on the trial. That cannot be. There must be some ground shown to satisfy the Court that there is some evidence now forthcoming, which with due diligence he could not have got; and it must therefore, in accordance with the usual practice, be evidence, not merely swearing by affidavits or anything of that kind, but something in the nature of the production of a lost document, or something of that sort, which will not expose the parties to a mere flood of affidavits made up to meet the blots and defects which have been disclosed "upon the first trial" (s).

Amendment  
of par-  
ticulars.

As to amendment of pleadings and particulars, in *Cropper v. Smith* (1884, L. R. 26 C. D. 710), Bowen, L.J., said: "Now, I think it is a well established principle that the object of Courts is to decide the rights of the parties, and not to punish them for mistakes they make in the conduct of their cases by deciding otherwise than in accordance with their rights. Speaking for myself, and in conformity with what I have heard laid down by the other Division of the Court of Appeal, and by myself as a member of it, I know of no kind of error or mistake which, if not fraudulent or intended to overreach, the Court ought not to correct, if it can be done without injustice to the other party. Courts do not exist for the sake of discipline, but for the sake of deciding matters in controversy, and I do not regard such amendment as a matter of favour or of grace."

In *The Shoe Machinery Co. v. Cutlan* (1895, 12 P. O. R. 530), the Court of Appeal refused to allow amendment of the particulars of objections by adding seven new anticipating specifications. They based their decision on the fact that no satisfactory explanation was forthcoming as to why these specifications had not been found before. But in *Pirrie v. York St. Spinning Co.* (1894, 11 P. O. R. 431), the Court allowed a

(s) And see *Nadel v. Martin*, 5 P. O. R. 226; *Spencer v. Ancoats Rubber Co.*, 1889, 6 P. O. R. 46; *Blakey v. Latham*, 1889, 6 P. O. R. at p. 186.



similar application, which was supported, however, by affidavits by the applicant's patent agents, that a diligent and careful search had been made, and that the new specifications could not have been discovered in spite of proper care.

On appeal to the House of Lords, it was held in a case where the Court of Appeal had held the specification bad and for the defendant on the infringement issue, but the House had reversed the decision on the specification and upheld it on the infringement issue, that each party must pay their own costs of the appeal (*t*).

(*t*) *Moore v. Bennett*, 1884, 1 P. O. R. at p. 148; *Griff. P. C.* at p. 161; see also as to costs on reversal of decision of C. A. by House of Lords, *The United Horse-nail Co. v. Stewart*, 1888, 5 P. O. R. 260, 269.

## APPENDIX.

### STATUTES.

#### STATUTE OF MONOPOLIES (1623).

[21 JAC. I. C. 3.]

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

FOR as much as your most excellent Majesty, in your royal judgment, and of your blessed disposition to the weal and quiet of your subjects, did in the year of our Lord God 1610, publish in print to the whole realm, and to all posterity, that all grants and monopolies and of the benefit of any penal laws, or of power to dispense with the law, or to compound for the forfeiture, are contrary to your Majesty's laws, which your Majesty's declaration is truly consonant, and agreeable to the ancient and fundamental laws of this your realm. And whereas your Majesty was further graciously pleased expressly to command that no suitor should presume to move your Majesty for matters of that nature: yet, nevertheless, upon misinformations and untrue pretences of public good many such grants have been unduly obtained and unlawfully put in execution, to the great grievance and inconvenience of your Majesty's subjects contrary to the laws of this your realm, and contrary to your Majesty's most royal and blessed intention, so published as aforesaid: For avoiding whereof and preventing of the like in time to come, be it enacted, that all monopolies and all commissions, grants, licences, charters, and letters patent heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working, or using of anything within this realm or the dominion of Wales, or of any other monopolies, or of power, liberty, or faculty, to dispense with any others, or to give licence or toleration to do, use, or exercise anything against the tenor or purport of any law or statute; or to give or make any warrant for any such

All monopolies, &c., shall be void.

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

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

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

All persons disabled to use monopolies, &c.

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

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

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

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

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

What new patents to be good.

7. Provided also, that this Act or anything therein contained shall not in anywise extend or be prejudicial to any grant or privilege, power, or authority whatsoever heretofore made, granted, allowed, or confirmed by any Act of Parliament now in force, so long as the same shall so continue in force.

Proviso.

8. Provided also, that this Act shall not extend to any warrant or privy seal made or directed, or to be made or directed, by His

Warrants granted to justices saved.

Majesty, his heirs or successors, to the justices of the Courts of the King's Bench or Common Pleas and barons of the Exchequer, justices of assize, justices of oyer and terminer and gaol delivery, justices of the peace, and other justices for the time being, having power to hear and determine offences done against any penal statute, to compound for the forfeitures of any penal statute depending in suit and question before them, or any of them respectively, after plea pleaded by the party defendant.

Charters  
granted to  
corporations  
saved.

9. Provided also, that this Act or anything therein contained shall not in anywise extend or be prejudicial unto the city of London, or to any city, borough, or town corporate within this realm, for or concerning any grants, charters, or letters patent to them, or any of them made or granted, or for or concerning any custom or customs used by or within them or any of them; or unto any corporation, companies, or fellowships of any art, trade, occupation, or mystery, or to any companies or societies of merchants within this realm erected for the maintenance, enlargement, or ordering of any trade or merchandise; but that the same charters, customs, corporations, companies, fellowships, and societies, and their liberties, privileges, powers, and immunities, shall be and continue of such force and effect as they were before the making of this Act, and of none other; anything before in this Act contained to the contrary in any wise notwithstanding.

PATENTS, DESIGNS AND TRADE MARKS ACTS,  
1883—1902, CONSOLIDATED.

*Being—*

46 & 47 Vict. c. 57.—An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks.

48 & 49 Vict. c. 63.—An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

49 & 50 Vict. c. 37.—An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions.

51 & 52 Vict. c. 50.—An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

1 Ed. VII. c. 18.—An Act to amend the law with reference to International Arrangements for Patents.

2 Ed. VII. c. 34.—An Act to amend the law with reference to applications for patents and compulsory licenses, and other matters connected therewith.

NOTE.—The general text of the Act of 1883 is adhered to. The repealed parts are printed in italics, and the additions in heavier type. The amending Act and section are quoted in the margin.

Be it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords, spiritual and temporal, and Commons, in the present Parliament assembled, and by the authority of the same, as follows:—

PART I.—PRELIMINARY.

1. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1883. Short title.

2. This Act is divided into parts, as follows:—

PART I.—Preliminary.

PART II.—Patents.

PART III.—Designs.

PART IV.—Trade Marks.

PART V.—General.

Division of  
Act into  
parts.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the 31st day of December, 1883. Commence-  
ment of Act.

## PART II.—PATENTS.

*Application for and Grant of Patent.*

Persons entitled to apply for patent.  
Joint application.

4.—(1) Any person, whether a British subject or not, may make an application for a patent (see p. 16).

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

*Act, 1885, s. 5.*

Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor; be it therefore enacted and declared that it has been and is lawful under the principal Act to grant such a patent.

Application and specification.

5.—(1) An application for a patent must be made in the form set forth in the first schedule to this Act, or in such other form as may be from time to time prescribed; and must be left at, or sent by post to, the Patent Office in the prescribed manner (see pp. 18, 108, 159).

Declaration.

(2) An application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or complete specification (see pp. 18, 108, 160).

*Act, 1885, s. 2.*

The declaration may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed (see p. 160).

Provisional specification.

(3) A provisional specification must describe the nature of the invention, and be accompanied by drawings, if required (see pp. 108, 115).

Complete specification.

(4) A complete specification, whether left on application or subsequently, must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required (see pp. 109, 124).

The same drawings may accompany both specifications.

*Act, 1886, s. 2.*

The requirement of this sub-section as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the complete specification refers to the drawings which accompanied the provisional specification. And no patent heretofore sealed shall be invalid by reason only that the complete specification was not accompanied by drawings, but referred to those which accompanied the provisional specification (see p. 109).

(5) A specification, whether provisional or complete, must com-

mence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed (see p. 109).

6. The comptroller shall refer every application to an examiner, who shall ascertain and report to the comptroller whether the nature of the invention has been fairly described, and the application, specification, and drawings (if any) have been prepared in the prescribed manner, and the title sufficiently indicates the subject-matter of the invention (see p. 161).

Reference of application to examiner.

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

Power for comptroller to refuse application or require amendment.

Repealed Act, 1888, s. 2.

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

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

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

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

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

7.—(1) *If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the comptroller may refuse to accept the application, or require that the application, specification or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with (as to the whole of this section, see Chap. VIII.).*

Power of comptroller to refuse application or require amendment.

Act, 1888, s. 2.

(2) *When the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer.*



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

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

(5) If, after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made, accompanied by a specification bearing the same or a similar title, the comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon.

Time for leaving complete specification.

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

Act, 1885, s. 3.

A complete specification may be left within such extended time, not exceeding one month after the said (*nine*) six months, as the comptroller may on payment of the prescribed fee allow. (Time reduced to six months by Act 1902, section one, subsection eight.)

When specification deemed abandoned.

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

Comparison of provisional and complete specification.

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

Power of comptroller to refuse until amended.

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

Power of law officer.

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

When specification void.

(4) Unless a complete specification is accepted within twelve months from the date of application, then (save in the case of an appeal having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months, become void.

A complete specification may be accepted within such extended time, not exceeding three months after the said twelve months, as the Comptroller may on payment of the prescribed fee allow. *Act, 1885, s. 3.*

(5) Reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding [*other than an appeal to the law officer under this Act*], unless the Court or officer having power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed. *Reports of examiners to be private. Act, 1888, s. 3.*

1.—(1) Where an application for a patent has been made and a complete specification has been deposited by the applicant, the examiner shall forthwith, in addition to the inquiries which he is directed to make by the Patents, Designs, and Trade Marks Act, 1883 (in this Act referred to as the principal 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 deposited pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application (see Chap. VIII.). *The Act of 1902.*

(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) The examiner shall report to the Comptroller the result of his investigations in such manner as the Board of Trade may direct.

(4) The provisions of sub-section five of section nine of the principal Act, as amended by any subsequent enactment, shall apply to reports under this section.

(5) 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.

(6) If the Comptroller is not so satisfied, he shall, after hearing the applicant, and unless the objection be 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.

(7) An appeal shall lie from the decision of the Comptroller under this section to the law officer.

(8) Section eight of the principal Act and section three of the Patents, Designs, and Trade Marks (Amendment) Act, 1885 (which regulate the time for depositing a complete specification), shall have effect as if references therein to the period of nine months were references to the period of six months.

(9) 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.

(10) The Board of Trade, with the sanction of the Treasury, may prescribe an additional fee not exceeding one pound in respect of the investigation mentioned in this section, which shall be payable on the sealing of the patent.

(11) 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.

Limitation as to anticipation.

2. An invention covered by any patent granted on an application to which section one of this Act applies shall not be deemed to have been anticipated by reason only of its publication in a specification deposited pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for a patent therefor, or of its publication in a provisional specification of any date not followed by a complete specification (see p. 94).

Advertisement on acceptance of complete specification.

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

Opposition to grant of patent.  
Time and grounds for.

11.—(1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or on the ground that the invention has been patented in this country on an application of prior date [*or on the ground of an examiner having reported to the Comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title and accompanying a previous application*], or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other

Repealed Act, 1888, s. 4.

Act, 1888, s. 4.

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 (as to the whole of this section, see Chap. IX.).

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

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

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

12.—(1) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, the Comptroller shall cause a patent to be sealed with the seal of the Patent Office (as to this section, see p. 7). Sealing of patent. When sealed.

(2) A patent so sealed shall have the same effect as if it were sealed with the great seal of the United Kingdom. Great seal abolished for patents.

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

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

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

A complete specification may be left and accepted within such extended times, not exceeding one month and three months respectively after the said nine months and twelve months respectively, as the Comptroller may, on payment of the prescribed fee allow, and where such extension of time has been allowed, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act (see p. 172). Extension of time for sealing. Act, 1885, s. 3.

13. Every patent shall be dated and sealed as of the day of the application: provided that no proceedings shall be taken in respect Date of patent.

of an infringement committed before the publication of the complete specification: provided also, that in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application (see pp. 7, 173).

Application abandoned, specification not to be published.

*Act, 1885, s. 4.*

When an application for a patent has been abandoned, or become void, the specification or specifications and drawings (if any) accompanying or left in connection with such application, shall not at any time be open to public inspection or be published by the Comptroller [*this does not apply to applications under sect. 103; see 1 Edw. VII. c. 181 (1)*].

#### *Provisional Protection.*

Provisional protection.

14. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the same; and such protection from the consequences of use and publication is in this Act referred to as provisional protection (see p. 173).

#### *Protection by Complete Specification.*

Effect of acceptance of complete specification.

15. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification: provided that an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him (see p. 173).

#### *Patent.*

Extent of patent.

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

Term of patent.

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

Causes on failure of payments.

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

Exception by application to Comptroller.

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

Extension of time for payment upon terms.

(4) Thereupon the Comptroller shall, if satisfied that the failure has arisen from any of the above-mentioned causes, on receipt of

the prescribed fee for enlargement, not exceeding ten pounds, enlarge the time accordingly, subject to the following conditions:

- (a) The time for making any payment shall not in any case be enlarged for more than three months. (a) Period of extension.
- (b) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement. (b) Damages for infringement in the interval.

*Amendment of Specification (see Chap. X.).*

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

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

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

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

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

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

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

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

Leave conclusive except in case of fraud; amendment forms part of specification.

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

Repealed Act, 1888, s. 5.

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

Proceedings pending. Act, 1888, s. 5.

(10) The foregoing provisions of this section do not apply when and so long as any action for infringement or proceeding for revocation of a patent is pending.

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

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

Restriction on recovery of damages.

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

Advertisement of amendment.

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

#### *Compulsory Licences (see Chap. XIV.).*

Repealed. See Act of 1902, s. 3, substituted therefor.

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

- (a) *The patent is not being worked in the United Kingdom; or*
- (b) *The reasonable requirements of the public with respect to the invention cannot be supplied; or*
- (c) *Any person is prevented from working or using to the best advantage an invention of which he is possessed,*

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

The Act of 1902.

3. Section twenty-two of the principal Act (relating to the grant of compulsory licences by the Board of Trade) is hereby

repealed, and the following provisions shall be substituted therefor:—

Amendment  
of law re-  
lating to  
compulsory  
licences.

- (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;
- (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 Judicial Committee of the Privy Council, 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 Judicial Committee, and it is proved to the satisfaction of the Judicial Committee that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by an Order in Council to grant licences on such terms as the said Committee may think just, or, if the Judicial Committee are 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 in Council;
 

Provided that no order of revocation shall 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, 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) If it is proved to the satisfaction of the Judicial Committee that the patent is worked or that the patented article is manufactured exclusively or mainly outside the United Kingdom, then, unless the patentee can show that the reasonable requirements of the public have been satisfied, the petitioner shall be entitled either to an order for a compulsory licence or, subject to the above proviso, to an order for the revocation of the patent;



- (6) For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied if, by reason of the default of the patentee to work his patent or to manufacture the patented article in the United Kingdom to an adequate extent, or to grant licences on reasonable terms, (a) any existing industry or the establishment of any new industry is unfairly prejudiced, or (b) the demand for the patented article is not reasonably met;
- (7) An Order in Council 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;
- (8) His Majesty in Council may make rules of procedure and practice for regulating proceedings before the Judicial Committee under this section, and, subject thereto, such proceedings shall be regulated according to the existing procedure and practice in patent matters. Any Order in Council or any order made by the Judicial Committee under this Act may be enforced by the High Court as if it were an order of the High Court;
- (9) The costs of and incidental to all proceedings under this section shall be in the discretion of the Judicial Committee, but in awarding costs on any application for the grant of a licence the Judicial Committee may have regard to any previous request for, or offer of, a licence made either before or after the application to the Committee;
- (10) For the purposes of this section three members of the Judicial Committee shall constitute a quorum;
- (11) This section shall apply to patents granted before as well as after the commencement of this Act.

*Register of Patents (see p. 222).*

Register of patents.  
Where to be kept and contents.

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

Is evidence.

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

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

*Fees* (see "Instructions to Applicants" and the Patents Rules 1903 and 1905).

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

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

*Extension of Term of Patent* (see Chap. XII.).

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

(2) Any person may enter a caveat, addressed to the registrar of the Council at the council office, against the extension. Entry of caveat.

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

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

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

(6) It shall be lawful for her Majesty in Council to make, from time to time, rules of procedure and practice for regulating pro- Power to make rules for such proceedings.

ceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.

Costs.

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

*Revocation (see Chap. XIV., p. 253).*

Abolition of scire facias.

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

Revocation of patent.

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

How revocation obtained. Grounds of revocation.

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

Petition for revocation, who may present.

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

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

(b) Any person authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland :

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

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

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

Plaintiff must deliver and be bound by particulars.

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

Amendment of particulars.

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

Patentee though defendant has privileges of plaintiff at trial.

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

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

Where patent revoked for fraud, first true inventor may obtain patent.

*Crown (see p. 14).*

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

Patent to bind Crown.

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

Exceptions.

*Legal Proceedings.*

28.—(1) In an action or proceeding for infringement or revocation of a patent, the Court may, if it thinks fit, and shall, on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance; the action shall be tried without a jury unless the Court shall otherwise direct (see pp. 364, 367).

Hearing with assessor.  
By Court.

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

Court of Appeal or Privy Council may sit with assessors.  
Assessors' fees.

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

29.—(1) In an action for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the Court or the judge, at any subsequent time, particulars of the breaches complained of (see p. 335).

Delivery of particulars of breaches;

(2) The defendant must deliver, with his statement of defence, or, by order of the Court or a judge, at any subsequent time, particulars of any objections on which he relies in support thereof (see p. 344).

of objections.

(3) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes

Grounds must be stated.

it, and if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him.

Evidence  
must not go  
beyond  
particulars.

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

Amendment.

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

Costs.

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

Order for in-  
spection, &c.  
in action.

30. In an action for infringement of a patent, the Court or a judge may on the application of either party, make such order for an injunction, inspection, or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a judge may see fit (see p. 359).

Certificate  
that validity  
questioned.

31. In an action for infringement of a patent, the Court or a judge may certify that the validity of a patent came in question; and if the Court or a judge so certifies, then in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses, as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same (see p. 376).

Remedy in  
case of  
groundless  
threats of  
legal pro-  
ceedings.

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

#### Miscellaneous.

Patent for one  
invention  
only.

33. Every patent may be in the form in the first schedule to this Act, and shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in any

action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention (see p. 161).

34.—(1) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to his legal representative (see pp. 18, 160). Patent on application of representative of deceased inventor.

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

35. A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection (see p. 30). Patent to first inventor not invalidated by application in fraud of him.

36. A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place, or part only (see p. 211). Assignment for particular places.

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

38. The law officers may examine witnesses on oath, and administer oaths for that purpose under this part of this Act, and may, from time to time, make, alter, and rescind rules, regulating references and appeals to the law officers, and the practice and procedure before them under this part of this Act; and in any proceeding before either of the law officers under this part of this Act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the Court (see p. 186). Proceedings and costs before law officer.

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

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

(b) Patent must be applied for.

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

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

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

It shall be lawful for her Majesty, by Order in Council, from time to time to declare that sections 39 and 57 of the Patents, Designs, and Trade Marks Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order, in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the condition, specified in the said sections, of giving notice to the Comptroller of his intention to exhibit, and shall be so relieved, either absolutely or upon such terms and conditions as to her Majesty in Council may seem fit (see p. 99).

Publication of illustrated journal, indexes, &c.

40.—(1) The Comptroller shall cause to be issued periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that the Comptroller may deem generally useful or important (see p. 173).

Copies to be on sale.

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

Continuation of publication.

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

Patent museum.

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

Power to require models on payment.

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

Foreign vessels in British waters.

43.—(1) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of her Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man (see p. 302).

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

44.—(1) The inventor of any improvement in instruments or munitions of war, his executors, administrators, or assigns (who are in this section comprised in the expression the inventor), may (either for or without valuable consideration) assign to her Majesty's principal secretary of state for the War Department (hereinafter referred to as the secretary of state), on behalf of her Majesty, all the benefit of the invention and of any patent obtained or to be obtained for the same; and the secretary of state may be a party to the assignment (as to this section, see p. 15). Assignment to Secretary for War of certain inventions.

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

(3) Where any such assignment has been made to the secretary of state, he may at any time before the application for a patent for the invention, or before publication of the specification or specifications, certify to the Comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret. Power of Secretary of State for War to keep invention secret on certifying that it is in public interest to do so.

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

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

(6) Such sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by writing under Delivery of packet under secretary of



state's authority during term. the hand of the secretary of state to receive the same, and shall if returned to the Comptroller be again kept sealed by him.

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

Foregoing subsections to apply where patent applied for but specifications not published. (8) Where the secretary of state certifies as aforesaid after an application for a patent has been left at the Patent Office, but before the publication of the specification or specifications, the application, specification or specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the Comptroller, and such packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the secretary of state.

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

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

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

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

#### *Existing Patents.*

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

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

(3) In all other respects (including the amount and time of payment of fees) this Act shall extend to all patents granted before the

commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto, if this Act had not been passed.

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

Documents left at great seal Patent Office deemed left at Patent Office on commencement of this Act.

*Definitions.*

46. In and for the purposes of this Act—

Definitions of

“Patent” means letters patent for an invention :

“Patent ;”

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

“Patentee ;”

“Invention” means any manner of new manufacture the subject of letters patent and grant of privilege within sect. 6 of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter 3, intituled, “An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof”), and includes an alleged invention (see p. 38).

“Invention ;”

In Scotland “injunction” means “interdict.”

“Injunction” in Scotland.

PART III.—DESIGNS.

*Registration of Designs.*

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

Application for registration of designs.

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

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

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

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

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

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

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

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

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

Certificate of  
registration.

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

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

*Copyright in Registered Designs.*

Copyright on  
registration.

50.—(1) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during five years from the date of registration.

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

Marking  
registered  
designs.

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

Inspection of  
registered  
designs.

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

Act, 1888, s. 6.

“Provided that where registration of a design is refused on the ground of identity with a design already registered, the

applicant for registration shall be entitled to inspect the design so registered."

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

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

Information as to existence of copyright.

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

Cesser of copyright in certain events.

*Register of Designs.*

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

Register of designs.

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

*Fees.*

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

Fees on registration, &c.

*Industrial and International Exhibitions.*

57. The exhibition at an industrial or international exhibition certified as such by the Board of Trade, or the exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registra-

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

tion thereof, provided that both the following conditions are complied with; namely:—

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

*Act, 1886, s. 3.* “And whereas it is expedient to provide for the extension of this section to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows:—

“It shall be lawful for her Majesty, by Order in Council, from time to time to declare that sections 39 and 57 of the Patents, Designs, and Trade Marks Act, 1883, or either of those sections shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions specified in the said sections of giving notice to the Comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to Her Majesty in Council may seem fit.”

*Legal Proceedings.*

Penalty on piracy of registered design.

*Act, 1888, s. 7.*

58. During the existence of copyright in any design—

- (a) It shall not be lawful for any person without the licence or written consent of the registered proprietor to apply, or cause to be applied, such design or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale to any article of manufacture or to any substance artificial or natural, or partly artificial and partly natural; and
- (b) It shall not be lawful for any person to publish or expose for sale any article of manufacture or any substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor.

Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract debt by action in any court of competent jurisdiction: Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds.

*Act, 1888, s. 7.*

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

Action for damages.

### *Definitions.*

60. In and for the purposes of this Act—

Definition of  
“design,”  
“copyright.”

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

“Copyright” means the exclusive right to apply a design to any article of manufacture or to any such substance as aforesaid in the class or classes in which the design is registered.

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

Definition of  
proprietor.

NOTE.—The provisions of this Act relating to trade marks are almost wholly repealed by the Trade Marks Act, 1905, which will come into operation on April 1st, 1906.

PART IV.—TRADE MARKS.

*Registration of Trade Marks.*

Application  
for registra-  
tion.

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

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

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

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

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

Act, 1888, s. 8. “(6) Where an applicant for the registration of a trade mark otherwise than under an international convention is out of the United Kingdom at the time of making the application he shall give the Comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given.”

Limit of time  
for proceeding  
with applica-  
tion.

Act, 1888, s. 9.

63. Where registration of a trade mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant [*the application shall be deemed to be abandoned*], “the Comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the Comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned.”

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

Conditions of registration of trade mark.

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

Repealed.

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

Act, 1888, s. 10.

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

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

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

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

Act, 1888, s. 10.

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

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

“(c) *A distinctive device, mark, brand, heading, label, or ticket ; or*

“(d) *An invented word or invented words ; or*

“(e) *A word or words having no reference to the character or quality of the goods, and not being a geographical name.*

“(2) *There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.*

“(3) *Provided as follows :*

“(i.) *A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the*



right of any owner of the same name to use that name or the foreign equivalent thereof;

“(ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade mark before the thirteenth day of August, one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act.”

Connexion of trade mark with goods.

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

Registration of a series of marks.

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

Trade marks may be registered in any colour.

Act, 1888, s. 11.

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

Advertisement of application.

Act, 1888, s. 12.

68. Every application for registration of a trade mark under this part of this Act shall as soon as may be after its receipt be advertised by the Comptroller, unless the Comptroller refuse to entertain the application.

Opposition to registration.

Act, 1888, s. 13, sub-ss. 1, 2.

69.—(1) Any person may within [*two months*] one month or such further time not exceeding three months as the Comptroller may allow, of the [*first*] advertisement of the application, give notice in duplicate at the Patent Office of opposition to registration of the trade mark, and the Comptroller shall send one copy of such notice to the applicant.

Act, 1888, s. 13, sub-s. 3.

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

Repealed.

Act, 1888, s. 13, sub-s. 4.

[(3) *If the applicant sends such counter-statement, the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall require him to give security in such manner and to such amount as the Comptroller may require for such costs as may be*

awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made, or such further time as the Comptroller may allow, the opposition shall be deemed to be withdrawn.

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

“(3) If the applicant sends such counter-statement the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the Comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.

*Act, 1888,  
s. 13, sub-s. 4.*

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

“(5) If the applicant abandons his application after notice of opposition in pursuance of this section he shall be liable to pay to the opponent such costs in respect of the opposition as the Comptroller may determine to be reasonable.

“(6) Where the opponent is out of the United Kingdom he shall give the Comptroller an address for service in the United Kingdom.”

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

*Assignment and transmission of trade mark.*

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

*Conflicting claims to registration.*

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

*Restrictions on registration.*

Act, 1888,  
s. 14.

(2) Except as aforesaid the Comptroller shall not register with respect to the same goods or description of goods a trade mark [so nearly resembling] having such resemblance to a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive.

Further  
restriction on  
registration.  
Act, 1888,  
s. 15.

73. It shall not be lawful to register as part of or in combination with a trade mark any words the [exclusive] use of which would by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a court of justice, or any scandalous design.

Saving for  
power to pro-  
vide for entry  
on register of  
common  
marks as  
additions to  
trade marks.

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

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

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

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

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

Repealed.  
Act, 1888.  
s. 16.

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

Act, 1888,  
s. 16.

“(2) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

“Provided that a person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.”

(3) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or

were, before the thirteenth day of August one thousand eight hundred and seventy-five, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods.

*Effect of Registration.*

75. [*Registration of a trade mark shall be deemed to be equivalent to public use of the trade mark.*]

Registration equivalent to public use.

“Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been, the date of the registration.”

Act, 1888, s. 17.

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

Right of first proprietor to exclusive use of trade mark.

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

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

“77a. In an action for infringement of a registered trade mark, the Court or a judge may certify that the right to the exclusive use of the trade mark came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs; charges, and expenses as between solicitor and client, unless the Court or judge trying the subsequent action certifies that he ought not to have the same.”

Certificate to exclusive use, and costs thereon.

Act, 1888, s. 18.

*Register of Trade Marks.*

78. There shall be kept at the Patent Office a book called the Register of Trade Marks, wherein shall be entered the names and addresses of proprietors of registered trade marks, notifications of

Register of trade marks.

assignments and of transmissions of trade marks, and such other matters as may be from time to time prescribed.

Removal of  
trade mark  
after fourteen  
years unless  
fee paid.

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

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

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

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

Act, 1888,  
s. 19, sub-s. 1.  
Act, 1888,  
s. 19, sub-s. 2.

(5) Where a trade mark has been removed from the register for nonpayment of the fee or otherwise, such trade mark shall nevertheless for the purpose of any application for registration during [*the five years*] one year next after the date of such removal, be deemed to be a trade mark which is already registered, "unless it is shown to the satisfaction of the Comptroller that the nonpayment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark."

#### *Fees.*

Fees for  
registration,  
&c.

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

account of her Majesty's exchequer in such manner as the Treasury may from time to time direct.

*Sheffield Marks.*

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

Registration  
by Cutlers'  
Company of  
Sheffield  
marks.

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

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

Repealed.  
Act, 1888,  
s. 20, sub-s. 1.

“(2) The Cutlers' Company shall enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade marks entered before the first day of January, One thousand eight hundred and eighty-nine in respect of metal goods either in the register established under the Trade Marks Registration Act, 1875, or in the register of trade marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January, One thousand eight hundred and eighty-four, but which have not been entered in either of the said other registers.”

Act, 1888,  
s. 20, sub-s. 1.

(3) An application for registration of a trade mark used [on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a

Act, 1888,  
s. 20, sub-s. 2.

*cutting edge*] on metal goods shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company :

- (4) Every application so made to the Cutlers' Company shall be notified to the Comptroller in the prescribed manner, and unless the Comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner :
- (5) If the Comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court :
- (6) Upon the registration of a trade mark in the Sheffield register the Cutlers' Company shall give notice thereof to the Comptroller, who shall thereupon enter the mark in the register of trade marks ; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the Comptroller on that day.

Repealed.  
Act, 1888,  
s. 20, sub-s. 3.

- [(7) *The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the register of trade marks, the effect of such registration, and the assignment and transmission of rights in a registered trade mark shall apply in the case of applications and registration in the Sheffield register ; and notice of every entry made in the Sheffield register must be given to the Comptroller by the Cutlers' Company, save and except that the provisions of this sub-section shall not prejudice or affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register :]*

Act, 1888,  
s. 20, sub-s. 3.

- (7) The provisions of this Act and of any general rules made under this Act with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade marks on metal goods by the Cutlers' Company, and to all matters relating thereto ; and this Act and any such general rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield register, for the Comptroller, the Patent Office, and the Register of Trade Marks, respectively ;

and notice of every entry, cancellation, or correction, made in the Sheffield register shall be given to the Comptroller by the Cutlers' Company: Provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register.

- (8) Where the Comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used [*on Act, 1888, cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge*], on metal goods, he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company: s. 20, sub-s. 2.
- (9) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' register of corporate trade marks, and thereupon all marks entered therein shall, unless entered in the Sheffield register, be deemed to have been abandoned:
- (10) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of two or more trade marks:
- (11) A body of persons, corporate or not corporate, may (notwithstanding anything in the Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of a trade mark or trade marks:
- (12) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the Comptroller, who shall have power to confirm, reverse, or modify the decision, but the decision of the Comptroller shall be subject to a further appeal to the Court:
- (13) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Company's Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield register.
- “(14) For the purposes of this section the expression ‘metal goods’ means all metals, whether wrought, unwrought, Act, 1888, s. 20, sub-s. 4.



or partly wrought, and all goods composed wholly or partly of any metal.

“(15) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield register, a certificate under the hand of the master of the Cutlers’ Company shall have the same effect as the certificate of the Comptroller.”

#### PART V.—GENERAL.

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

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

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

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

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

“In his absence.”  
Repealed by  
Act, 1902,  
s. 4.

Officers and  
clerks.

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

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

Seal of  
Patent Office.

84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence (see p. 7).

Trust not to  
be entered in  
registers.

85. There shall not be entered in any register kept under this Act, or be receivable by the Comptroller, any notice of any trust expressed, implied or constructive (see p. 223).

Refusal to  
seal, &c., in  
certain cases.

86. The Comptroller may refuse to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality (see p. 170).

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the Comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design or trade mark, in the register of patents, designs or trade marks, as the case may be. The person for the time being entered in the register of patents, designs or trade marks, as proprietor of a patent, copyright in a design or trade mark, as the case may be, shall, subject to the provisions of this Act and to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with, the same and to give effectual receipts for any consideration for such assignment, license or dealing. Provided that any equities in respect of such patent, design or trade mark may be enforced in like manner as in respect of any other personal property (see p. 223).

Entry of assignments and transmissions in registers

Act, 1888, s. 21.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and to such regulations as may be prescribed; 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 (see p. 223).

Inspection of and extracts from registers.

Act, 1888, s. 22.

89. Printed or written copies or extracts, purporting to be certified by the Comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals (see pp. 223, 369).

Sealed copies to be received in evidence.

90.—(1) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person, or of any other particulars from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit (see p. 224).

Rectification of registers by Court.

Act, 1888, s. 23.

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

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

91. The Comptroller may, on request in writing accompanied by the prescribed fee (see p. 224),

- (a) Correct any clerical error in or in connection with an application for a patent, or for registration of a design or trade mark; or
- (b) Correct any clerical error in the name, style, or address of the registered proprietor of a patent, design or trade mark;
- (c) Cancel the entry or part of the entry of a trade mark on the register: Provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark.
- (d) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the design or trade mark to be registered.

*Act, 1888,  
s. 24.*

Alteration of registered mark.

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

Notice to be given.

(2) Notice of any intended application to the Court under this section shall be given to the Comptroller by the applicant; and the Comptroller shall be entitled to be heard on the application.

Comptroller to alter in accordance with order.

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

Falsification of entries in registers.

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

Exercise of discretionary power by Comptroller.

94. Where any discretionary power is by this Act given to the Comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent (see p. 171).

Power of Comptroller to take directions of law officers.

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

96. A certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone (see p. 369). Certificate of Comptroller to be evidence.

97.—(1) Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office, or to the Comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post (see p. 160). Applications and notices by post.

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

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

99. If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any Court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted (see pp. 18, 160). Declaration by infant, lunatic, &c.

100. Copies of all specifications, drawings, and amendments, left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the Transmission of certified printed copies of specifications, &c.

same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

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

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

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

Alteration of forms.

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

General rules;

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

to be laid before Parliament and advertised.

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

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

102. The Comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general 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. Annual reports of Comptroller.

102a.—(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 Board of Trade. Act, 1888, s. 25.

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

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

*International and Colonial Arrangements (see p. 34).*

103.—(1) If her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such state shall be entitled to a patent for his invention, or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants; and such patent or registration shall have the same date as the [*date of protection obtained*] date of the application in such foreign state. International arrangements for protection of inventions, designs, and trade marks. Act, 1885, s. 6.

Provided that his application is made, in the case of a patent within (*seven*) twelve months, and in the case of a design or trade mark within four months, from his applying for protection in the foreign state with which the arrangement is in force. Time. The Act of 1901, s. 1, sub-s. 1.

Provided that nothing in this section contained shall entitle the No protection

prior to specification or registration.

patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

The Act of 1901, s. 1, sub-s. 2.

(2) An application under that section (*Sect. 103*) shall be accompanied by a complete specification, which, if it be not accepted within the period of twelve months, shall, with the drawings (if any), be open to public inspection at the expiration of that period (*see p. 163*).

Publication at or use in exhibition not to invalidate patent or trade mark.

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

Application under this section to be made in same manner as ordinary application.

(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 [*but see Act of 1901, s. 1, sub-s. 2, above*]: Provided that, in the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act :

Application of this section.

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

Provision for colonies and India.

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

Effect of Order in Council.

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

*Offences (see p. 173).*

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

Penalty on falsely representing articles to be patented.

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

Definition of false representation under this section.

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

Penalty on unauthorised assumption of royal arms.

*Scotland, Ireland, &c.*

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

Saving for Courts in Scotland.

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

Definition of "Court of Appeal."

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

Summary proceedings in Scotland.

109.—(1) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only (see p. 255).

Proceedings for revocation of patent in Scotland.

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

Service in Scotland.



Reservation  
of remedies in  
Ireland.

110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only (see p. 255).

General  
saving for  
jurisdiction of  
Courts.

111.—(1) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of the said Court; and with reference to any such proceedings in Ireland, the term "the Court" and "the Court of Appeal" respectively mean the High Court of Justice in Ireland and her Majesty's Court of Appeal in Ireland.

Rectification  
of register.

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

Isle of Man.

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

Jurisdiction  
of Courts.

(1) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those Courts:

Punishments.

(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:

Offences and  
penalties  
treated as in  
England  
under this  
Act.

(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.

Jurisdiction  
of Lancashire  
Palatine  
Court.

Act, 1888,  
s. 26.

112a. "The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks the registration whereof is applied for in the Manchester Office, have the like jurisdiction under this Act as her Majesty's High Court of Justice in England, and the expression 'the Court' in this Act shall be construed and have effect accordingly (see p. 365).

“ Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases.”

*Repeal; Transitional Provisions; Savings.*

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

Repeal and saving for past operation of repealed enactments, &c.  
Exceptions.

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

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

Former registers to be deemed continued.

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

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

Saving for existing rules.

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

Saving for prerogative.

*General Definitions.*

General definitions.

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

“ Person.”

“ Person ” includes a body corporate :

“ Court.”

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

“ Law officer.”

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

“ Treasury.”

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

“ Comptroller.”

“ Comptroller ” means the Comptroller-General of patents, designs, and trade marks :

“ Prescribed.”

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

“ British possession.”

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

“ Legislature.”

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

“ Summary conviction ” as applied to Ireland.

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

Register of patent agents.

Act, 1888, s. 1.

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

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

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

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

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

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## SCHEDULES.

### THE FIRST SCHEDULE.

#### FORMS OF APPLICATION, &c.

Forms A, B and C of this First Schedule are altered by the substitution of those given in the Patent Rules, 1903 (*post*).

### THE THIRD SCHEDULE.

Section 113.

#### *Enactments Repealed.*

21 James 1, c. 3 (1623).—The Statute of Monopolies. In part; namely, sections 10, 11 and 12.

5 & 6 Will. 4, c. 62 (1835) [In part].—The Statutory Declarations Act, 1835. In part; namely, section 11.

5 & 6 Will. 4, c. 83 (1835).—An Act to amend the law touching letters patent for inventions.

2 & 3 Vict. c. 67 (1839).—An Act to amend an Act of the fifth and sixth years of the reign of King William the Fourth, intituled "An Act to amend the law touching letters patent for inventions."

5 & 6 Vict. c. 100 (1842).—An Act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.

6 & 7 Vict. c. 65 (1843).—An Act to amend the laws relating to the copyright of designs.

7 & 8 Vict. c. 69\* (1844) [In part].—An Act for amending an Act passed in the fourth year of the reign of his late Majesty, intituled "An Act for the better administration of justice in his Majesty's Privy Council, and to extend its jurisdiction and powers." In part; namely, sections 2 to 5, both included.

13 & 14 Vict. c. 104 (1850).—An Act to extend and amend the Acts relating to the copyright of designs.

15 & 16 Vict. c. 33 (1852).—The Patent Law Amendment Act, 1852.

16 & 17 Vict. c. 5 (1853).—An Act to substitute stamp duties for fees on passing letters patent for inventions, and to provide for the purchase for the public use of certain indexes of specifications.

\* *Note.*—Sects. 6 and 7 of this Act are repealed by the Statute Law Revision (No. 2) Act, 1874.

16 & 17 Vict. c. 115 (1853).—An Act to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act.

21 & 22 Vict. c. 70 (1858).—An Act to amend the Act of the fifth and sixth years of her present Majesty, to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.

22 Vict. c. 13 (1859).—An Act to amend the law concerning patents for inventions with respect to inventions for improvements in instruments and munitions of war.

24 & 25 Vict. c. 73 (1861).—An Act to amend the law relating to the copyright of designs.

28 & 29 Vict. c. 3 (1865).—The Industrial Exhibitions Act, 1865.

33 & 34 Vict. c. 27 (1870).—The Protection of Inventions Act, 1870.

33 & 34 Vict. c. 97 (1870).—The Stamp Act, 1870. In part; namely, section 65, and in the Schedule the words and figures, "Certificate of the registration of a design . . . £5 0 0. And see section 65."

38 & 39 Vict. c. 91 (1875).—The Trade Marks Registration Act, 1875.

38 & 39 Vict. c. 93 (1875).—The Copyright of Designs Act, 1875.

39 & 40 Vict. c. 33 (1876).—The Trade Marks Registration Amendment Act, 1876.

40 & 41 Vict. c. 37 (1877).—The Trade Marks Registration Extension Act, 1877.

43 & 44 Vict. c. 10 (1880).—The Great Seal Act, 1880. In part; namely, section 5.

45 & 46 Vict. c. 72 (1882).—The Revenue, Friendly Societies, and National Debt Act, 1882. In part; namely, section 16.

## PATENTS, ETC. ACT, 1885.

48 &amp; 49 VICT. c. 63.

*An Act to amend the Patents, Designs, and Trade Marks Act, 1883.*

BE IT ENACTED by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :

1. This Act shall be construed as one with the Patents, Designs, and Trade Marks Act, 1883 (in this Act referred to as the principal Act).

This Act may be cited as the Patents, Designs, and Trade Marks (Amendment) Act, 1885, and this Act and the principal Act may be cited together as the Patents, Designs, and Trade Marks Acts, 1883 and 1885.

2. Whereas sub-section 2 of section 5 of the principal Act requires a declaration to be made by an applicant for a patent to the effect in that sub-section mentioned, and doubts have arisen as to the nature of that declaration, and it is expedient to remove such doubts : Be it therefore enacted that :

Amendment  
of sect. 5,  
sub-sect. 2.

The declaration mentioned in sub-section 2 of section 5 of the principal Act may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed.

3. Whereas under the principal Act, a complete specification is required (by section 8) to be left within (*nine*) ~~six~~ months, and (by section 9) to be accepted within twelve months, from the date of application, and a patent is required by section 12 to be sealed within fifteen months from the date of application, and it is expedient to empower the Comptroller to extend in certain cases the said times : Be it therefore enacted as follows :

Amendment  
of sects. 8  
and 9.  
Time reduced  
to six months  
by Act of  
1902.

A complete specification may be left and accepted within such extended times, not exceeding one month and three months respectively after the said (*nine*) ~~six~~ and twelve months respectively as the Comptroller may on the payment of the prescribed fee allow, and where such extension of time has been allowed, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent ; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act.

Abandoned  
application.

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

Joint patent.

5. Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor; be it therefore enacted and declared that it has been and is lawful under the principal Act to grant such a patent.

Amendment  
of sect. 103,  
sub-sect. 1.

6. In sub-section 1 of section 103 of the principal Act, the words "date of the application" shall be substituted for the words "date of the protection obtained."

## PATENTS, ETC. ACT, 1886.

49 &amp; 50 VICT. c. 37.

*An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects Exhibitions.*

WHEREAS by section 5 of the Patents, Designs, and Trade Marks Act, 1883, specifications, whether provisional or complete, must be accompanied by drawings if required, and doubts have arisen as to whether it is sufficient that a complete specification refers to the drawings by which the provisional specification was accompanied, and it is expedient to remove such doubts:

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

1. This Act may be cited as the Patents Act, 1886, and shall be construed as one with the Patents, Designs, and Trade Marks Acts, 1883 and 1885, and, together with those Acts, may be cited as the Patents, Designs, and Trade Marks Acts, 1883 to 1886. Title

2. The requirement of sub-section 4 of section 5 of the Patents, Designs, and Trade Marks Act, 1883, as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the complete specification refers to the drawings which accompanied the provisional specification. And no patent heretofore sealed shall be invalid by reason only that the complete specification was not accompanied by drawings, but referred to those which accompanied the provisional specification. Explanation  
of sect. 5, sub-  
sect. 4 of  
principal Act.

3. Whereas by section 39 of the Patents, Designs, and Trade Marks Act, 1883, as respects patents, and by section 57 of the same Act as respects designs, provision is made that the exhibition of an invention or design at an industrial or international exhibition, certified as such by the Board of Trade, shall not prejudice the rights of the inventor or proprietor thereof, subject to the conditions therein mentioned, one of which is that the exhibitor must, before exhibiting the invention, design, or article, or publishing a description of the design, give the Comptroller the prescribed notice of his intention to do so: Extension of  
sect. 39 of  
principal Act.



And whereas it is expedient to provide for the extension of the said sections to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows:

It shall be lawful for her Majesty, by Order in Council, from time to time to declare that sections 39 and 57 of the Patents, Designs, and Trade Marks Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, of giving notice to the Comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to her Majesty in Council may seem fit.

## PATENTS, DESIGNS, ETC. ACT, 1888.

*An Act to amend the Patents, Designs, and Trade Marks Act, 1883.*

[24th December, 1888.]

WHEREAS it is expedient to amend the Patents, Designs, and Trade Marks Act, 1883, hereinafter referred to as the principal Act: 46 & 47 Vict. c. 57.

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

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

(2) The Board of Trade shall, as soon as may be after the passing of this Act, and may from time to time, make such general rules as are in the opinion of the Board required for giving effect to this section, and the provisions of section 101 of the principal Act shall apply to all rules so made as if they were made in pursuance of that section.

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

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

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

2. For section seven of the principal Act the following section shall be substituted, namely:— Amendments of 46 & 47 Vict. c. 57.

"7.—(1) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject matter of the invention, the Comptroller may refuse to accept the application, or require that the application, specification or drawings be amended before he proceeds with the application; and in the S. 7, as to applications.

latter case the application shall, if the Comptroller so directs, bear date as from the time when the requirement is complied with.

“(2) Where the Comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer.

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

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

“(5) If, after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made accompanied by a specification bearing the same or a similar title, the Comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon.”

S. 9, as to disclosure of reports of examiners.

3. In sub-section 5 of section 9 of the principal Act the words “other than an appeal to the law officer under this Act” shall be omitted.

S. 11, as to opposition to grant of patent.

4. In sub-section 1 of section 11 of the principal Act the words from “or on the ground of an examiner” to “a previous application,” both inclusive, shall be omitted, and there shall be added in lieu thereof the following words, namely, “or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification.”

S. 18, as to amended specifications.

5. For sub-section 10 of section 18 of the principal Act the following sub-section shall be substituted, namely—

“(10) The foregoing provisions of this section do not apply when, and so long as, any action for infringement or proceeding for revocation of a patent is pending.”

S. 52, as to inspection of designs.

6. After sub-section 1 of section 52 of the principal Act the following words shall be added; namely,

“Provided that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered.”

S. 58, as to piracy of registered designs.

7.—(1) In section 58 of the principal Act the words “or cause to be applied” shall be added after the word “apply.”

(2) To the same section the following words shall be added:  
 “Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds.”

8.—(1) In sub-section 2 of section 62 of the principal Act, for the words “the Patent Office in the prescribed manner” shall be substituted the words “such place and in such manner as may be prescribed.” S. 62, as to application for registration.

(2) To the same section of the principal Act the following sub-section shall be added:—

“(6) Where an applicant for the registration of a trade mark otherwise than under an international convention is out of the United Kingdom at the time of making the application he shall give the Comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given.”

9. In section 63 of the principal Act, for the words “the application shall be deemed to be abandoned” shall be substituted the words “the Comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and, if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the Comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned.” S. 63, as to limit of time for proceeding with application.

10.—(1) For section 64 of the principal Act the following section shall be substituted, namely:— S. 64, as to fancy words.

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

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

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

“(c) A distinctive device, mark, brand, heading, label, or ticket; or

“(d) An invented word or invented words; or

“(e) A word or words having no reference to the character or quality of the goods, and not being a geographical name.

“(2) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use

of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

“(3) Provided as follows:—

“(i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof:

“(ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act.”

S. 67, as to colours of trade marks.

11. In section 67 of the principal Act the words “or colours” shall be added after the word “colour” in each place where that word occurs.

S. 68, as to advertisement of applications.

12. In section 68 of the principal Act after the word “Comptroller” shall be added the words “unless the Comptroller refuse to entertain the application.”

S. 69, as to opposition to registration.

13.—(1) In sub-section 1 of section 69 of the principal Act for the words “two months” shall be substituted the words “one month or such further time, not exceeding three months, as the Comptroller may allow.”

(2) In the same sub-section the word “first” shall be omitted.

(3) In sub-section 2 of the same section for the words “two months” shall be substituted the words “one month.”

(4) For sub-sections 3 and 4 of the same section the following sub-sections shall be substituted; namely,

“(3) If the applicant sends such counter-statement the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the Comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.

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

“(5) If the applicant abandons his application after notice of opposition in pursuance of this section he shall be liable to pay to

the opponent such costs in respect of the opposition as the Comptroller may determine to be reasonable.

“(6) Where the opponent is out of the United Kingdom he shall give the Comptroller an address for service in the United Kingdom.”

14. In sub-section 2 of section 72 of the principal Act, the following words shall be added at the beginning of the sub-section, namely, “except as aforesaid,” and for the words “so nearly resembling” shall be substituted the words “having such resemblance to.” S. 72, as to restrictions on registration.

15. In section 73 of the principal Act the word “exclusive” shall be omitted. S. 73, as to restriction on registration.

16. For sub-section 2 of section 74 of the principal Act the following sub-section shall be substituted; namely, S. 74, as to additions to trade marks.

“(2) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

“Provided that a person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.”

17. For section 75 of the principal Act the following section shall be substituted; namely, S. 75, as to effect of registration.

“Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January, one thousand eight hundred and seventy-six, to have been the date of the registration.”

18. After section 77 of the principal Act the following section shall be added and numbered 77A; namely, Certificate as to exclusive use and costs thereon.

“In an action for infringement of a registered trade mark the Court or a judge may certify that the right to the exclusive use of the trade mark came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the subsequent action certifies that he ought not to have the same.”

19.—(1) In sub-section 5 of section 79 of the principal Act, for the words “the five years” shall be substituted the words “one year.” Amendments of 46 & 47 Vict. c. 57.

S. 79, as to removal of trade mark from the register.

(2) To the same sub-section the following words shall be added; namely, "unless it is shown to the satisfaction of the Comptroller that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark."

S. 81, as to Sheffield marks.

20.—(1) For sub-section 2 of section 81 of the principal Act the following sub-section shall be substituted:

"(2) The Cutlers' Company shall enter in the Sheffield register in respect of metal goods as defined in this section, all the trade marks entered before the first day of January, one thousand eight hundred and eighty-nine, in respect of metal goods either in the register established under the Trade Marks Registration Act, 1875, or in the register of trade marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January, one thousand eight hundred and eighty-four, but which have not been entered in either of the said other registers."

38 & 39 Vict. c. 91.

(2) In sub-sections 3 and 8 of the same section, for the words "on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge," shall be substituted the words "on metal goods."

(3) For sub-section 7 of the same section the following sub-section shall be substituted:

"(7) The provisions of this Act and of any general rules made under this Act with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade marks on metal goods by the Cutlers' Company, and to all matters relating thereto; and this Act and any such general rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield register, for the Comptroller, the Patent Office, and the registrar of trade marks respectively; and notice of every entry, cancellation, or correction made in the Sheffield register shall be given to the Comptroller by the Cutlers' Company: Provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register."

(4) To the same section the following sub-sections shall be added; namely,

“(14) For the purposes of this section the expression ‘meta goods’ means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.

“(15) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield register a certificate under the hand of the master of the Cutlers’ Company shall have the same effect as the certificate of the Comptroller.”

21. In section 87 of the principal Act, after the words “subject to,” shall be added the words “the provisions of this Act and to.” S. 87, as to entry of assignments, &c.

22. In section 88 of the principal Act, after the words “subject to,” shall be added the words “the provisions of this Act and to.” S. 88, as to inspection.

23. In section 90 of the principal Act, after the words “of the name of any person,” shall be added the words “or of any other particulars.” S. 90, as to rectification of register.

24. To section 91 of the principal Act the following sub-section shall be added; namely, S. 91, as to correction of errors.

“(d) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the design or trade mark to be registered.”

25. After section 102 of the principal Act the following section shall be added and numbered 102A; namely, Proceedings of Board of Trade.

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

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

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

26. After section 112 of the principal Act the following section shall be added and numbered 112A; namely, Jurisdiction of Lancashire Palatine Court.

“The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks, the registration whereof is applied for in the Manchester Office, have the like jurisdiction under this Act as her Majesty’s High Court of Justice in England, and the expression



'the Court' in this Act shall be construed and have effect accordingly.

"Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases."

Construction  
of principal  
Act.

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

Commence-  
ment of Act.

28. This Act shall, except so far as is by this Act otherwise specially provided, commence and come into operation on the first day of January, one thousand eight hundred and eighty-nine.

Short title.

29. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1888, and this Act and the Patents, Designs, and Trade Marks Acts, 1883 to 1886, may be cited collectively as the Patents, Designs, and Trade Marks Acts, 1883 to 1888.

## THE PATENTS ACT, 1901.

(1 ED. VII. c. 18.)

*An Act to amend the Law with reference to International Arrangements for Patents.* [17th August, 1901.]

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:—

1.—(1) In the first proviso to sub-section one of section one hundred and three of the Patents, Designs, and Trade Marks Act, 1883 (which section relates to the time for making applications for protection under international arrangements), the words "twelve months" shall be substituted for the words "seven months."

International  
arrange-  
ments.  
46 & 47 Vict.  
c. 57.

(2) An application under that section shall be accompanied by a complete specification, which, if it be not accepted within the period of twelve months, shall, with the drawings (if any), be open to public inspection at the expiration of that period.

2.—(1) This Act may be cited as the Patents Act, 1901, and may be cited and shall be construed as one with the Patents, Designs, and Trade Marks Acts, 1883 to 1888.

Short title,  
construction,  
and com-  
mencement.

(2) This Act shall come into operation on the first day of January, one thousand nine hundred and two.

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## THE PATENTS ACT, 1902.

(2 ED. VII. c. 34.)

*An Act to amend the Law with reference to Applications for Patents and Compulsory Licenses, and other matters connected therewith.*

[18th December, 1902.]

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 :

Examination of previous specifications in United Kingdom on applications for patents. 46 & 47 Vict. c. 57.

1.—(1) Where an application for a patent has been made and a complete specification has been deposited by the applicant, the examiner shall forthwith, in addition to the inquiries which he is directed to make by the Patents, Designs, and Trade Marks Act, 1883 (in this Act referred to as the principal 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 deposited pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application.

(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) The examiner shall report to the Comptroller the result of his investigations in such manner as the Board of Trade may direct.

(4) The provisions of sub-section five of section nine of the principal Act, as amended by any subsequent enactment, shall apply to reports under this section.

(5) 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.

(6) If the Comptroller is not so satisfied, he shall, after hearing the applicant, and unless the objection be 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.

(7) An appeal shall lie from the decision of the Comptroller under this section to the law officer.

(8) Section eight of the principal Act and section three of the Patents, Designs, and Trade Marks (Amendment) Act, 1885 (which regulate the time for depositing a complete specification), shall have effect as if references therein to the period of nine months were references to the period of six months. 48 & 49 Vict. c. 63.

(9) 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.

(10) The Board of Trade, with the sanction of the Treasury, may prescribe an additional fee not exceeding one pound in respect of the investigation mentioned in this section, which shall be payable on the sealing of the patent.

(11) 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.

2. An invention covered by any patent granted on an application to which section one of this Act applies shall not be deemed to have been anticipated by reason only of its publication in a specification deposited pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for a patent therefor, or of its publication in a provisional specification of any date not followed by a complete specification. Limitation as to anticipation.

3. Section twenty-two of the principal Act (relating to the grant of compulsory licenses by the Board of Trade) is hereby repealed, and the following provisions shall be substituted therefor:— Amendment of law relating to compulsory licenses.

(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 license, or, in the alternative, for the revocation of the patent;

(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 Judicial Committee of the Privy Council, 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 Judicial Committee, and it is proved to the satisfaction of the Judicial Committee that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by an Order in Council to grant licenses on such terms as the said Committee may think just, or, if the Judicial Committee are of opinion that the reasonable requirements of the public will not be satisfied by the grant of licenses, the patent may be revoked by Order in Council ;
- Provided that no order of revocation shall 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, 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) If it is proved to the satisfaction of the Judicial Committee that the patent is worked or that the patented article is manufactured exclusively or mainly outside the United Kingdom, then, unless the patentee can show that the reasonable requirements of the public have been satisfied, the petitioner shall be entitled either to an order for a compulsory license or, subject to the above proviso, to an order for the revocation of the patent ;
- (6) For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied if, by reason of the default of the patentee to work his patent or to manufacture the patented article in the United Kingdom to an adequate extent, or to grant licenses on reasonable terms, (a) any existing industry or the establishment of any new industry is unfairly prejudiced, or (b) the demand for the patented article is not reasonably met ;
- (7) An Order in Council directing the grant of any license under this section shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a license and made between the parties to the proceeding ;
- (8) His Majesty in Council may make rules of procedure and practice for regulating proceedings before the Judicial

Committee under this section, and, subject thereto, such proceedings shall be regulated according to the existing procedure and practice in patent matters. Any Order in Council or any order made by the Judicial Committee under this Act may be enforced by the High Court as if it were an order of the High Court ;

- (9) The costs of and incidental to all proceedings under this section shall be in the discretion of the Judicial Committee, but in awarding costs on any application for the grant of a license the Judicial Committee may have regard to any previous request for, or offer of, a license made either before or after the application to the Committee ;
- (10) For the purposes of this section three members of the Judicial Committee shall constitute a quorum ;
- (11) This section shall apply to patents granted before as well as after the commencement of this Act.

4. In sub-section four of section eighty-two of the principal Act (which relates to the performance of the duties of the Comptroller by other officers under the direction of the Board of Trade) the words " in his absence " shall be repealed. Performance of Comptroller's duties.

5. This Act may be cited as the Patents Act, 1902, and may be cited and shall be construed as one with the Patents, Designs, and Trade Marks Acts, 1883 to 1901. Short title and construction.

INTERNATIONAL CONVENTION FOR THE PRO-  
TECTION OF INDUSTRIAL PROPERTY.

SIGNED AT PARIS, MARCH 20, 1883.

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[*Ratifications exchanged at Paris, June 6, 1884.*]

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I.—*International Convention.*

His Majesty the King of the Belgians, his Majesty the Emperor of Brazil, his Majesty the King of Spain, the President of the French Republic, the President of the Republic of Guatemala, his Majesty the King of Italy, his Majesty the King of the Netherlands, his Majesty the King of Portugal and the Algarves, the President of the Republic of Salvador, his Majesty the King of Servia, and the Federal Council of the Swiss Confederation.

Being equally animated with the desire to secure, by mutual agreement, complete and effectual protection for the industry and commerce of their respective subjects and citizens, and to provide a guarantee for the rights of inventors, and for the loyalty of commercial transactions, have resolved to conclude a convention to that effect, and have named as their plenipotentiaries, that is to say:—

His Majesty the King of the Belgians: the Baron Beyens, Grand Officer of His Majesty's Royal Order of Leopold, Grand Officer of the Legion of Honour, his Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ;

His Majesty the Emperor of Brazil: M. Jules Constant, Count de Villeneuve, member of his Majesty's Council, his Majesty's Envoy Extraordinary and Minister Plenipotentiary at the Court of his Majesty the King of the Belgians, Commander of the Order of Christ, Officer of his Majesty's Order of the Rose, Chevalier of the Legion of Honour, &c. ;

His Majesty the King of Spain: his Excellency the Duke de Fernan-Nuñez, de Montellano et del Arco, Count de Cervellon, Marquis de Almonacir, Grandee of Spain First Class, Chevalier of the Distinguished Order of the Golden Fleece, Grand Cross of the Order of Charles III., Chevalier de Calatrava, Grand Cross of the Legion of Honour, Senator of the Kingdom, his Majesty's Ambassador Extraordinary and Plenipotentiary at Paris, &c. ;

The President of the French Republic: M. Paul Challemel-

Lacour, Senator, Minister for Foreign Affairs; M. Hérisson, Deputy, Minister of Commerce; M. Charles Jagerschmidt, Minister Plenipotentiary of the First Class, Officer of the National Order of the Legion of Honour, &c.;

The President of the Republic of Guatemala: M. Crisanto-Medina, Officer of the Legion of Honour, his Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.;

His Majesty the King of Italy: M. Constantin Rössman, Commander of his Majesty's Orders of Saints Maurice and Lazarus, and of the Crown of Italy, Commander of the Legion of Honour, Councillor of the Italian Embassy at Paris, &c.;

His Majesty the King of the Netherlands: the Baron de Zuylen de Nyevelt, Commander of his Majesty's Order of the Netherlands Lion, Grand Cross of his Majesty's Grand Ducal Order of the Oaken Crown, and of the Golden Lion of Nassau, Grand Officer of the Legion of Honour, his Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.;

His Majesty the King of Portugal and the Algarves: M. Jose da Silva Mendes Leal, Councillor of State, Peer of the Realm, Minister and Honorary Secretary of State, Grand Cross of the Order of St. James, Chevalier of the Order of the Tower and Sword of Portugal, Grand Officer of the Legion of Honour, his Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.; M. Fernand de Azevedo, Officer of the Legion of Honour, First Secretary of the Portuguese Legation at Paris, &c.;

The President of the Republic of Salvador: M. Torres-Cañedo, corresponding member of the French Institute, Grand Officer of the Legion of Honour, his Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.;

His Majesty the King of Servia: M. Sima M. Marinovitch, Chargé d'Affaires of Servia *ad interim*, Chevalier of the Royal Order of Takovo, &c.;

And the Federal Council of the Swiss Confederation: M. Charles Edouard Lardy, Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.; M. J. Weibel, Engineer at Geneva, President of the Swiss Section of the Permanent Commission for the Protection of Industrial Property;

Who, having communicated to each other their respective full powers found in good and due form, have agreed upon the following articles:—

#### ARTICLE I.

The Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland con-



stitute themselves into a union for the protection of industrial property.

#### ARTICLE II.

The subjects or citizens of each of the contracting states shall, in all the other states of the union, as regards patents, industrial designs or models, trade marks and trade names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Consequently they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each state.

#### ARTICLE III.

Subjects or citizens of states not forming part of the union, who are domiciled or have industrial or commercial establishments in the territory of any of the states of the union, shall be assimilated to the subjects or citizens of the contracting states.

#### ARTICLE IV.

Any person who has duly applied for a patent, industrial design or model, or trade mark in one of the contracting states, shall enjoy, as regards registration in the other states, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

Consequently, subsequent registration in any of the other states of the union before expiry of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another registration, by publication of the invention, or by the working of it by a third party, by the sale of copies of the design or model, or by use of the trade mark.

The above-mentioned terms of priority shall be six months for patents, and three months for industrial designs and models and trade marks. A month longer is allowed for countries beyond sea.

#### ARTICLE V.

The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the states of the union shall not entail forfeiture.

Nevertheless, the patentee shall remain bound to work his patent in conformity with the laws of the country into which he introduces the patented objects.

## ARTICLE VI.

Every trade mark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the union.

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

## ARTICLE VII.

The nature of the goods on which the trade mark is to be used can in no case be an obstacle to the registration of the trade mark.

## ARTICLE VIII.

A trade name shall be protected in all the countries of the union, without necessity of registration, whether it form part or not of a trade mark.

## ARTICLE IX.

All goods illegally bearing a trade mark or trade name may be seized on importation into those states of the union where this mark or name has a right to legal protection.

The seizure shall be effected at the request of either the proper public department or of the interested party, pursuant to the internal legislation of each country.

## ARTICLE X.

The provisions of the preceding article shall apply to all goods falsely bearing the name of any locality as indication of the place of origin, when such indication is associated with a trade name of a fictitious character, or assumed with a fraudulent intention.

Any manufacturer or trader in such goods, established in the locality falsely designated as the place of origin, shall be deemed an interested party.

## ARTICLE XI.

The high contracting parties agree to grant temporary protection to patentable inventions, to industrial designs or models, and trade marks, for articles exhibited at official or officially recognised international exhibitions.

## APPENDIX.

## ARTICLE XII.

Each of the high contracting parties agrees to establish a special government department for industrial property, and a central office for communication to the public of patents, industrial designs or models, and trade marks.

## ARTICLE XIII.

An international office shall be organised under the name of "Bureau International de l'Union pour la protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property).

This office, the expense of which shall be defrayed by the governments of all the contracting states, shall be placed under the high authority of the central administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the states of the union.

## ARTICLE XIV.

The present Convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the union.

To this end conferences shall be successively held in one of the contracting states by delegates of the said states. The next meeting shall take place in 1885 at Rome.

## ARTICLE XV.

It is agreed that the high contracting parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of industrial property, in so far as such arrangements do not contravene the provisions of the present Convention.

## ARTICLE XVI.

States which have not taken part in the present Convention shall be permitted to adhere to it at their request.

Such adhesion shall be notified officially through the diplomatic channel to the government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses, and admission to all the advantages stipulated by the present Convention.

## ARTICLE XVII.

The execution of the reciprocal engagements contained in the present Convention is subordinated, in so far as necessary, to the

observance of the formalities and rules established by the constitutional laws of those of the high contracting parties who are bound to procure the application of the same, which they engage to do with as little delay as possible.

#### ARTICLE XVIII.

The present Convention shall come into operation one month after the exchange of ratifications, and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the government commissioned to receive adhesions. It shall only affect the denouncing state, the Convention remaining in operation as regards the other contracting parties.

#### ARTICLE XIX.

The present Convention shall be ratified, and the ratifications exchanged in Paris, within one year at the latest.

In witness whereof the respective Plenipotentiaries have signed the same, and have affixed thereto their seals.

Done at Paris the 20th March, 1883.

(Signed)

(L.S.)	BEYENS.
(L.S.)	VILLENEUVE.
(L.S.)	DUK DE FERNAN-NUNEZ.
(L.S.)	P. CHALLEMEL-LACOUR.
(L.S.)	CH. HERISSON.
(L.S.)	CH. JAGERSCHMIDT.
(L.S.)	CRIBANTO-MEDINA.
(L.S.)	RESSMAN.
(L.S.)	BARON DE ZUYLEN DE NYEVELT.
(L.S.)	JOSE DA SILVA MENDES LEAL.
(L.S.)	F. D'AZEVEDO.
(L.S.)	J.-M. FORRES-CAICEDO.
(L.S.)	SIMA M. MARINOVITCH.
(L.S.)	LARDY.
(L.S.)	J. WEIBEL.

II.—*Final Protocol.*

ON proceeding to the signature of the Convention concluded this day between the Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia, and Switzerland, for the protection of industrial property, the undersigned Plenipotentiaries have agreed as follows:—

(1) The words “industrial property” are to be understood in their broadest sense; they are not to apply simply to industrial products, properly so called, but also to agricultural products (wines, corn, fruits, cattle, &c.), and to mineral products employed in commerce (mineral waters, &c.).

(2) Under the word “patents” are comprised the various kinds of industrial patents recognised by the legislation of each of the contracting states, such as importation patents, improvement patents, &c.

(3) The last paragraph of Article II. does not affect the legislation of each of the contracting states as regards the procedure to be followed before the tribunals, and the competence of those tribunals.

(4) Paragraph 1 of Article VI. is to be understood as meaning that no trade mark shall be excluded from protection in any state of the union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of that state; provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in said country of origin. With this exception, which relates only to the form of the mark, and under reserve of the provisions of the other articles of the Convention, the internal legislation of each state remains in force.

To avoid misconstruction, it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order in the sense of the last paragraph of Article VI.

(5) The organisation of the special department for industrial property mentioned in Article XII. shall comprise, so far as possible, the publication in each state of a periodical official paper.

(6) The common expenses of the international office, instituted by virtue of Article XIII., are in no case to exceed for a single year a total sum representing an average of 2,000 fr. for each contracting state.

To determine the part which each state should contribute to this total of expenses, the contracting states, and those which may afterwards join the union, shall be divided into six classes, each

contributing in the proportion of a certain number of units, namely:—

1st class . . . . .	25 units.
2nd class . . . . .	20 „
3rd class . . . . .	15 „
4th class . . . . .	10 „
5th class . . . . .	5 „
6th class . . . . .	3 „

These co-efficients will be multiplied by the number of states in each class, and the sum of the result thus obtained will supply the number of units by which the total expense has to be divided. The quotient will give the amount of the unit of expense.

The contracting states are classed as follows, with regard to the division of expense:—

1st class . . . . .	France, Italy.
2nd class . . . . .	Spain.
3rd class . . . . .	Belgium, Brazil, Portugal, Switzerland.
4th class . . . . .	Holland.
5th class . . . . .	Servia.
6th class . . . . .	Guatemala, Salvador.

The Swiss Government will superintend the expenses of the international office, advance the necessary funds, and render an annual account, which will be communicated to all the other administrations.

The international office will centralise information of every kind relating to the protection of industrial property, and will bring it together in the form of a general statistical statement which will be distributed to all the administrations. It will interest itself in all matters of common utility to the union, and will edit, with the help of the documents supplied to it by the various administrations, a periodical paper in the French language dealing with questions regarding the object of the union.

The numbers of this paper, as well as all the documents published by the international office, will be circulated among the administrations of the states of the union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired either by the said administrations or by societies or private persons, will be paid for separately.

The international office shall at all times hold itself at the service of members of the union, in order to supply them with any special information they may need on questions relating to the international system of industrial property.

The administration of the country in which the next conference is

to be held will make preparations for the transactions of that conference, with the assistance of the international office.

The director of the international office will be present at the meetings of the conferences, and will take part in the discussions, but without the privilege of voting.

He will furnish an annual report upon his administration of the office, which shall be communicated to all the members of the union.

The official language of the international office will be French.

(7) The present final protocol, which shall be ratified together with the Convention concluded this day, shall be considered as forming an integral part of, and shall have the same force, validity, and duration as the said Convention.

In witness whereof the undersigned Plenipotentiaries have drawn up the present protocol.

(Signed)

BEYENS.

VILLENEUVE.

DUC DE FERNAN-NUNEZ.

P. CHALLEMEL-LACOUR.

CH. HERISSON.

CH. JAGERSCHMIDT.

CRISANTO-MEDINA.

RESSMAN.

BARON DE ZUYLEN DE NYEVELT.

JOSE DA SILVA MENDES LEAL.

F. D'AZEVEDO.

J.-M. TORRES-CAICEDO.

SIMA M. MARINOVITCH.

LARDY.

J. WEIBEL.

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III.—*Accession of her Majesty's Government to the Convention signed at Paris, March 20, 1883.*

THE undersigned, Ambassador Extraordinary and Plenipotentiary of her Majesty the Queen of the United Kingdom of Great Britain and Ireland to the French Republic, declares that her Britannic Majesty, having had the International Convention for the protection of industrial property, concluded at Paris on the 20th March, 1883, and the protocol relating thereto, signed on the same date, laid before her, and availing herself of the right reserved by

Article XVI. of that Convention to states not parties to the original Convention, accedes, on behalf of the United Kingdom of Great Britain and Ireland, to the said International Convention for the protection of industrial property, and to the said protocol, which are to be considered as inserted word for word in the present declaration, and formally engages, as far as regards the President of the French Republic and the other high contracting parties, to co-operate on her part in the execution of the stipulations contained in the Convention and protocol aforesaid.

The undersigned makes this declaration on the part of her Britannic Majesty with the express understanding that power is reserved to her Britannic Majesty to accede to the Convention on behalf of the Isle of Man and the Channel Islands, and any of her Majesty's possessions, on due notice to that effect being given through her Majesty's Government.

In witness whereof the undersigned, duly authorised, has signed the present declaration of accession, and has affixed thereto the seal of his arms.

Done at Paris, on the 17th day of March, 1884.

(Signed) (L.S.) LYONS.

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#### IV.—*Declaration of Acceptance of Accession.*

HER Majesty the Queen of the United Kingdom of Great Britain and Ireland, having acceded to the International Convention relative to the protection of industrial property, concluded at Paris, March 20, 1883, together with a protocol, dated the same day, by the declaration of accession delivered by her Ambassador Extraordinary and Plenipotentiary to the Government of the French Republic; the text of which declaration is word for word as follows:—

(Here is inserted the text of No. III. in English.)

The President of the French Republic has authorised the undersigned, President of the Council, Minister for Foreign Affairs, to formally accept the said accession, together with the reserves which are contained in it concerning the Isle of Man, the Channel Islands, and all other possessions of her Britannic Majesty, engaging as well in his own name as in that of the other high contracting



parties to assist in the accomplishment of the obligations stipulated in the Convention and the protocol thereto annexed, which may concern the United Kingdom of Great Britain and Ireland.

In witness whereof the undersigned, duly authorised, has drawn up the present declaration of acceptance, and has affixed thereto his seal.

Done at Paris, the 2nd April, 1884.

(L.S.)      (Signed)      JULES FERRY.

For the names of the countries in which protection may now be obtained under the Convention, see the official "Instructions to Applicants."

## THE PATENTS RULES, 1903.

DATED JANUARY 12, 1903.

[*N.B.—These rules have been modified by the Patents Rules, 1905, as noted in italics.*]

By virtue of the provisions of the Patents, Designs, and Trade Marks Acts, 1883 to 1902, the Board of Trade do hereby make the following Rules:—

*Short Title.*

1. These Rules may be cited as the Patents Rules, 1903. Short title.

*Commencement.*

2. These Rules shall come into operation from and immediately after the 12th day of January, 1903. Commencement.

*Interpretation.*

3. In the construction of these Rules—

“United Kingdom” includes the Isle of Man;

“Foreign application” means an application by any person for protection of his invention in a foreign state or British possession to which by any Order in Council for the time being in force the provisions of Section 103 of the Act of 1883 as amended by any subsequent Act have been declared applicable;

“Convention application” means an application in the United Kingdom under the provisions of Section 103 of the Act of 1883 as amended by any subsequent Act.

Save as aforesaid, any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively.

Interpre-  
tation.

*Fees.*

4. The fees to be paid under the said Acts shall be those specified in the list of fees in the First Schedule to these Rules. First  
Schedule.

*Forms.*

5. The forms contained in the Second Schedule to these Rules may, as far as they are applicable, be used in any proceedings under the said Acts or under these Rules, and so far as they relate to the same subject matter shall be substituted for the forms in the First Schedule to the Act of 1883. Second  
Schedule

*Applications for Patents.*

Application  
by representa-  
tive of  
deceased  
inventor.

6. In the case of an application for a patent by the legal representative of a person who has died possessed of an invention, the probate of his will, or the letters of administration granted of his estate and effects, or an official copy of such probate or letters, shall be produced at the Patent Office in proof of the applicant's title as such legal representative and must be supported by such further evidence as the Comptroller may require.

Address for  
service.

7. Every application for a patent shall be accompanied by a statement of an address (hereinafter referred to as "the address for service") to which all notices, requisitions, and communications of every kind may be sent by the Comptroller or by the Board of Trade, and such statement shall thereafter be binding upon the applicant until a substituted address for service shall be furnished by him to the Comptroller. The Comptroller may in any particular case require that the address for service be in the United Kingdom.

Order of  
recording  
applications.

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

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

9. [*This rule is repealed by Rule 5 of the Patents Rules, 1905 (q.v.).*]

Extension of  
time for  
leaving and  
accepting  
complete  
specification.

10. An application for extension of time for leaving or accepting a complete specification shall be made on Form U or on Form V, as the case may require, and shall state in detail in what circumstances and upon what grounds such extension is applied for, and the Comptroller may require the applicant to substantiate such allegations by such proof as the Comptroller may think necessary.

Notice and  
advertise-  
ment of  
acceptance.

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

Inspection  
of complete  
specification.

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

*Applications under the International Convention.*

Convention  
applications.

13. Every Convention application shall contain a declaration that foreign application has been made for protection of the

invention to which such Convention application relates, and shall specify all the foreign states or British possessions in which such foreign applications have been made, and the official date or dates thereof respectively. The application must be made within twelve months from the date of the first foreign application, and must be accompanied by a complete specification, and signed by the person or persons by whom such first foreign application was made. If such person, or any of such persons, be dead, the application must be signed by the legal representative of such dead person, as well as by the other applicants, if any.

14. Every Convention application, in addition to the specification left therewith, must be accompanied by a copy or copies of the specification, and drawings or documents filed or deposited by the applicant in the Patent Office of the foreign state or British possession in respect of the first foreign application, duly certified by the official chief or head of the Patent Office of such foreign state or British possession as aforesaid, or otherwise verified to the satisfaction of the Comptroller. If any specification or other document relating to the application is in a foreign language, a translation thereof shall be annexed thereto and verified by statutory declaration or otherwise to the satisfaction of the Comptroller.

Foreign specification, &c. to accompany application.

15. If the complete specification left with the application be not accepted within twelve months from the date of the first foreign application, it shall, with the drawings, if any, be open to public inspection at the expiration of that period.

Public inspection.

16. Save as aforesaid and as provided by Rule 52, all proceedings in connection with a Convention application shall be taken within the times and in the manner prescribed by the said Acts or these Rules for ordinary applications.

Proceedings.

#### *Size, &c. of Documents.*

17. [*This rule is repealed by Rule 15 of the Patents Rules, 1905.*]

#### *Drawings accompanying Specifications.*

*Rules 18—24 are repealed by Rules 16—24 of the Patents Rules, 1905.*

#### *Statutory Declarations and Affidavits.*

25. The statutory declarations and affidavits required by these Rules, or used in any proceedings thereunder, shall be headed in the matter or matters to which they relate and shall be drawn up in the first person, and shall be divided into paragraphs consecu-

Form, &c. of statutory declaration and affidavit.

tively numbered, and each paragraph shall so far as possible be confined to one subject. Every statutory declaration or affidavit shall state the description and true place of abode of the person making the same, and shall be written or printed bookwise, and shall bear the name and address of the person leaving it and shall state on whose behalf it is left.

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

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

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

#### *Industrial or International Exhibitions.*

Industrial or international exhibitions.

27. Any person desirous of exhibiting an invention at an industrial or international exhibition, or of publishing any description of the invention during the period of the holding of the exhibition, or of using the invention for the purpose of the exhibition in the place where the exhibition is held, may, after the Board of Trade have issued a certificate that the exhibition is an industrial or international one, give to the Comptroller notice on Form O of his intention to exhibit, publish, or use the invention, as the case may be. For the purpose of identifying the invention in the event of an application for a patent being subsequently made, the inventor shall furnish to the Comptroller a brief description of his invention, accompanied, if necessary, by drawings, and such other information as the Comptroller may in each case require.

#### *Exercise of Discretionary Powers by the Comptroller.*

Exercise of discretionary powers by Comptroller.

28. Before exercising any discretionary power given to the Comptroller by the said Acts or these Rules adversely to the applicant for a patent or for amendment of a specification, the Com-

troller shall give ten days' notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before the Comptroller. Notice of hearing.

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

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

31. The decision or determination of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified by him to the applicant, and to any other person who appears to him to be affected thereby. Decision to be notified to parties.

#### *Opposition to Grants of Patents.*

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

33. Where the ground of an opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation be left at the Patent Office within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the applicant's complete specification, the opposition shall be deemed to be abandoned. Evidence in support of allegation that invention has been obtained from opponent.

34. Where the ground of an opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, the Comptroller may request or allow any person who has made a statutory declaration in the matter to which the opposition relates to attend before him at the hearing of the case and make oral explanations with respect to such matters as the Comptroller may require. Attendance of declarant on Comptroller.

35. Where the ground or one of the grounds of opposition is that the invention has been patented in this country on an application of Particulars of prior patent.

prior date, the number and date of such prior application shall be specified in the notice.

Opponent's  
evidence.

36. Except in the case provided for in Rule 33, statutory declarations need not be left in connexion with an opposition, but the opponent may, within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the applicant's complete specification, leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant copies thereof.

Applicant's  
evidence.

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

Evidence in  
reply.

Applicant's  
evidence if  
opponent  
does not  
leave  
statutory  
declarations.

38. If the opponent does not leave statutory declarations in support of his opposition, the applicant may (if he desires so to do) within three months from the date of the advertisement of the acceptance of his complete specification, leave at the Patent Office statutory declarations in support of his application, and on so leaving shall deliver to the opponent copies thereof.

Opponent's  
evidence.

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

Evidence in  
reply.

Closing of  
evidence.

40. No further evidence shall be left on either side except by leave, or on the requisition of the Comptroller.

Hearing.

41. On completion of the evidence (if any), or at such other time as he may see fit, the Comptroller shall appoint a time for the hearing of the case, and shall give the parties ten days' notice at the least of such appointment. If either party does not desire to be heard, he shall as soon as possible notify the Comptroller to that effect. If either party desires to be heard he must leave Form E at the Patent Office. The Comptroller may refuse to hear either party who has not left Form E prior to the date of hearing. If either party intends to refer at the hearing to any publication other than a specification mentioned in the notice of opposition, he should, unless the same has been referred to in a statutory declara-

tion already filed, give to the other party and to the Comptroller five days' notice at the least of his intention, together with details of each publication to which he intends to refer. After hearing the party or parties desirous of being heard, or if neither party desires to be heard, then without a hearing the Comptroller shall decide the case and notify his decision to the parties.

*Amendment of Specification.*

42. A request for leave to amend a specification must be signed by the applicant and shall contain an address for service in the United Kingdom. When not made in pursuance of an order of the Court or a judge the request must, where a patent has been sealed, also contain a statement that no action for infringement nor proceeding for revocation of the patent is pending. The request must be accompanied by a duly certified copy of the original specification and drawings, showing in red ink the proposed amendment, and shall be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner (if any) as the Comptroller may in each case direct.

Request for leave to amend.

43. Where a request for leave to amend is made in pursuance of an order of the Court or a judge, an office copy of the order shall be left with the request at the Patent Office.

Leave by order of Court.

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

Notice of opposition.

Copy for the applicant.

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

Opponent's evidence.

46. Upon such declarations being left, and such copies being delivered, the provisions of Rules 37, 40 and 41 shall apply to the case, and the further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated.

Further proceedings.

47. If the opponent does not leave statutory declarations in support of his opposition, the applicant may (if he desires so to do) within two months from the date of the first advertisement of the application for leave to amend, leave at the Patent Office statutory

Applicant's evidence if opponent does not leave



statutory declarations. declarations in support of his application, and on so leaving shall deliver to the opponent copies thereof.

Further proceedings. 48. Upon such declarations being left, and such copies being delivered, the provisions of Rules 39, 40, and 41 shall apply to the case, and further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated.

Requirements on amendment. 49. Where leave to amend is given the applicant shall, if the Comptroller so require, and within a time to be limited by him, leave at the Patent Office a new specification and drawings as amended, to be prepared in accordance with Rules 17 to 23.

Advertisement of amendment. 50. Every amendment of a specification shall be advertised forthwith by the Comptroller in the official journal of the Patent Office, and in such other manner (if any) as the Comptroller may direct.

#### *Register of Patents.*

Entry of grant. 51. Upon the sealing of a patent the Comptroller shall cause to be entered in the Register of Patents the name, address and calling of the patentee as the grantee thereof, and the title of the invention, together with the address for service.

Entry in respect of Convention application. 52. The patent granted on any Convention application shall be entered in the register as dated of the date on which the first foreign application was made, and the payment of renewal fees, and the expiration of the patent, shall be reckoned as from the date of the first foreign application.

Alteration of address. 53. If a patentee send to the Comptroller on Form R notice of an alteration in his address, the Comptroller shall cause the register to be altered accordingly, and may require the altered address to be in the United Kingdom.

Request for entry of subsequent proprietorship. 54. Where a person becomes entitled to a patent, or to any share or interest therein, by assignment or by transmission, or other operation of law, a request for the entry of his name in the register as such complete or partial proprietor of the patent, or of such share or interest therein, as the case may be, shall be addressed to the Comptroller, and left at the Patent Office.

Form and signature of request. 55. Such request shall be on Form L and shall in the case of individuals be made and signed by the person requiring to be registered as proprietor, or by his agent duly authorised to the satisfaction of the Comptroller, and in the case of a body corporate by its agent, authorised in like manner.

Particulars to be stated in request. 56. Every such request shall state the name, address, and calling of the person claiming to be entitled to the patent, or to any share or interest therein, as the case may be, and the particulars of the

assignment, transmission, or other operation of law, by virtue of which he claims to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom, the patent, or such share or interest therein as aforesaid, has been assigned or transmitted.

57. Every assignment, and every other document containing, giving effect to, or being evidence of, the transmission of a patent or affecting the proprietorship thereof as claimed by such request, except such documents as are matters of record, shall, unless the Comptroller in his discretion otherwise directs, be produced to him together with the request, and such other proof of title as he may require for his satisfaction. Production of documents of title and other proof.

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

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

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

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

61. Upon the issue of a certificate of payment under Rule 68, the Comptroller shall cause to be entered in the register a record of the date of payment of the fee on such certificate. Entry of date of payment of fees on issue of certificate.

62. If a patentee fails to make any prescribed payment within the prescribed time, or any enlargement thereof duly granted, there shall be duly entered in the register a notification of such failure. Entry of failure to pay fees.

63. An attested copy of every license granted under a patent, or of any other document purporting to affect the proprietorship of a patent, shall be left at the Patent Office with a request on Form M that a notification thereof may be entered in the register. The accuracy of such copy shall be certified as the Comptroller may direct, and the original document shall at the same time be produced and left at the Patent Office if required for further verification. Entry of notification of license, or other document.

64. The register of patents shall be open to the inspection of the Hours of

inspection of register. public on every week day except Saturday between the hours of ten and four, and on Saturday between the hours of ten and one, except on the days and the times following:—

(a) Christmas Day, Good Friday, the day observed as his Majesty's birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England; or

(b) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office;

(c) Times when the register is required for any purpose of official use.

Certified copies of documents.

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

#### *Payment of Fees for Continuance of Patent.*

Payment of fees for continuance of patent.

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

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

Enlargement of time for payments.

67. An application for an enlargement of the time for making a prescribed payment shall state in detail the circumstances in which the patentee by accident, mistake or inadvertence has failed to make such payment, and the Comptroller may require the patentee to substantiate by such proof as he may think necessary the allegations contained in the application for enlargement.

Certificate of payment.

68. On due compliance with the terms of Rule 66, and as soon as may be after such respective periods as aforesaid, or any enlargement thereof respectively duly granted, the Comptroller shall issue a certificate that the prescribed payment has been duly made.

#### *Compulsory Licenses and Revocation of Patents.*

Petition for grant of compulsory license or revocation of patent.

69. A petition to the Board of Trade for an order under section 3 of the Patents Act, 1902, shall show clearly the nature of the petitioner's interest and the ground or grounds upon which he claims to be entitled to relief, and shall state in detail the circum-

stances of the case, the terms upon which he asks that an order may be made, and the purport of such order, and the name and address of the patentee and any other person who is alleged in the petition to have made default.

70. The petition and an examined copy thereof shall be left at the Patent Office accompanied by affidavits or statutory declarations in proof of the allegations contained in the petition together with any other documentary evidence in support, and the petitioner shall simultaneously with, or as soon as may be after, the leaving of such petition deliver to the patentee and any other person who is alleged in the petition to have made default, copies of the petition and of such affidavits or statutory declarations and other documentary evidence in support.

To be left with evidence at Patent Office.

71. The persons to whom such copies are delivered by the petitioner, may within fourteen days after being invited to do so by the Board of Trade leave at the Patent Office their affidavits or statutory declarations in answer, and if they do so shall deliver copies thereof to the petitioner; and the petitioner may within fourteen days from such last-mentioned delivery leave at the Patent Office his affidavits or statutory declarations in reply, and if he does so shall deliver copies thereof to the patentee or any other person alleged in the petition to have made default, such last-mentioned affidavits or statutory declarations being confined to matters strictly in reply.

Opponent's evidence.

Evidence in reply.

The times prescribed by this rule may be altered or enlarged by the Board of Trade, if they think fit, upon such notice to parties interested and upon such terms, if any, as they may direct.

72. No further evidence than as aforesaid may be left by either side at the Patent Office except by leave or on requisition of the Board of Trade and upon such terms, if any, as the Board may think fit.

Closing of evidence.

73. The Board of Trade shall consider the petition and the evidence, with a view to satisfying themselves whether a *prima facie* case has been made out for proceeding further with the petition, and if they are not so satisfied they shall dismiss the petition.

Power of Board of Trade to dismiss petition.

74. If they are so satisfied, they shall consider whether there is any probability of an arrangement being come to between the parties, and if it appears to them that there is any reasonable probability that such an arrangement can be come to, they may take such steps as they consider desirable to bring it about, and in the meanwhile may defer the reference of the petition to the Judicial Committee of the Privy Council.

Arrangements between parties.

75. If the Board are not of opinion that there is a reasonable probability of any arrangement being come to between the parties,

Reference of petition to Judicial Committee.

and are satisfied that a *prima facie* case has been made out by the petitioner, they shall refer the petition to the Judicial Committee, with copies of any affidavits, statutory declarations, or other documentary evidence which may have been furnished under the foregoing rules, and with certified copies of all entries in the Register of Patents relating to the patent in question and any other information in the possession of the Board which it appears to them may be of service to the Judicial Committee in ascertaining what persons should be made parties to the proceedings before the Committee, and the Board shall give written notice to the parties that the petition has been referred to the Judicial Committee.

*General.*

Power of amendment, &c.

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

General power to enlarge time.

77. The times prescribed by these Rules for doing any act, or taking any proceeding thereunder, other than the times for lodging evidence referred to in Rule 33 or in the procedure in these Rules relating to compulsory licenses and revocation of patents, may be enlarged by the Comptroller if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

Power to dispense with evidence.

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

Hours of business.

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

Christmas Day, Good Friday, the day observed as his Majesty's birthday, the days observed as days of public fast or thanksgiving, or as holidays at the Bank of England, and days which

may from time to time be notified by a placard posted in a conspicuous place at the Patent Office.

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

#### *Agency.*

81. With the exception of the signing of the following documents, namely, applications for patents, requests for leave to amend applications, specifications, or letters patent, authorisations of agents, notices of oppositions, requests for issue of duplicate letters patent, notices of abandonment of or of intention not to proceed with applications, surrenders of letters patent, and petitions for compulsory license and revocation of patent, all communications to the Comptroller under the said Acts and these Rules may be signed by and all attendances upon the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller, and, if he so require it, resident in the United Kingdom. The Comptroller shall not be bound to recognise as such agent, or to receive further communications from any person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the register of patent agents, kept under the provisions of the Patents, Designs, and Trade Marks Act, 1888, relating to the registration of patent agents, and not since restored. In any particular case, the Comptroller may, if he think fit, require the personal signature or presence of an applicant, opponent, or other person. Agency.

#### *Repeal.*

82. All general rules relative to Patents heretofore made by the Board of Trade under the Patents, Designs, and Trade Marks Acts, 1883 to 1901, and in force on the 12th day of January, 1903, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to anything done under such rules, or to any application or other matter then pending. Repeal.

Dated the 12th day of January, 1903.

G. W. BALFOUR,  
*President of the Board of Trade.*

## THE FIRST SCHEDULE.

## LIST OF FEES PAYABLE ON AND IN CONNEXION WITH LETTERS PATENT.

	£	s.	d.	£	s.	d.
1. On application for provisional protection .....	1	0	0			
2. On filing complete specification.....	3	0	0			
	—————			4	0	0
or						
3. On filing complete specification with first application.....				4	0	0
4. On appeal from Comptroller to Law Officer. By appellant				3	0	0
5. On notice of opposition to grant of patent. By opponent...				0	10	0
6. On hearing by Comptroller. By applicant and by opponent respectively.....				1	0	0
On application to amend specification :—						
7. Up to sealing. By applicant .....				1	10	0
8. After sealing. By patentee.....				3	0	0
9. On notice of opposition to amendment. By opponent .....				0	10	0
10. On hearing by Comptroller. By applicant and by opponent respectively.....				1	0	0
11. On application to amend specification during action or proceeding. By patentee .....				3	0	0
12. On application to the Board of Trade for a compulsory license. By person applying .....				1	0	0
13. On opposition to grant of compulsory license. By opponent				1	0	0
On certificate of renewal :—						
14. Before the expiration of the 4th year from the date of the patent and in respect of the 5th year.....				5	0	0
15. Before the expiration of the 5th year from the date of the patent and in respect of the 6th year.....				6	0	0
16. Before the expiration of the 6th year from the date of the patent and in respect of the 7th year.....				7	0	0
17. Before the expiration of the 7th year from the date of the patent and in respect of the 8th year.....				8	0	0
18. Before the expiration of the 8th year from the date of the patent and in respect of the 9th year.....				9	0	0
19. Before the expiration of the 9th year from the date of the patent and in respect of the 10th year .....				10	0	0
20. Before the expiration of the 10th year from the date of the patent and in respect of the 11th year .....				11	0	0
21. Before the expiration of the 11th year from the date of the patent and in respect of the 12th year .....				12	0	0

22. Before the expiration of the 12th year from the date of the patent and in respect of the 13th year .....	£	s.	d.
	13	0	0
23. Before the expiration of the 13th year from the date of the patent and in respect of the 14th year .....	14	0	0

## On enlargement of time for payment of renewal fees:—

24. Not exceeding one month.....	1	0	0
25. Not exceeding two months .....	3	0	0
26. Not exceeding three months .....	5	0	0
27. For every entry of an assignment, transmission, agreement, license, or extension of patent.....	0	10	0
28. For duplicate of letters patent.....each	2	0	0
29. On notice to Comptroller of intended exhibition of a patent under Section 39 .....	0	10	0
30. Search or inspection fee.. .....	0	1	0
31. For office copies.....every 100 words (but never less than one shilling)	0	0	4
32. For office copies of drawings, cost according to agreement			
33. For certifying office copies, MSS. or printed .....	0	1	0
34. On postal request for printed specification .....	0	0	8

## On request to Comptroller to correct a clerical error:—

35. Up to sealing .....	0	5	0
36. After sealing .....	1	0	0
37. For certificate of Comptroller under Section 96 .....	0	5	0
38. For altering address in register .....	0	5	0
39. For enlargement of time for filing complete specification, not exceeding one month.....	2	0	0

## Forenlargement of time for acceptance of complete specification:—

40. Not exceeding one month.....	2	0	0
41. Not exceeding two months .....	4	0	0
42. Not exceeding three months .....	6	0	0

(And see the list of fees in the Schedule to the Patents Rules, 1903.)

G. W. BALFOUR,  
*President of the Board of Trade.*

12th January, 1903.

Approved;

H. T. ANSTRUTHER,  
H. W. FORSTER,  
*Lords Commissioners of his Majesty's Treasury.*



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## Patents, Designs, and Trade Marks Acts, 1883 to 1902.

[PATENT.]

## FORM A.

*(To be accompanied by two copies of Form B or of Form C.)***Application for Patent.**

(a) do hereby declare that in possession of an invention the title of which is (b) that (c) claim to be the true and first inventor thereof; and that the same is not in use by any other person or persons to the best of knowledge and belief; and humbly pray that a Patent may be granted to for the said invention.

Dated day of 19 .  
(d) \_\_\_\_\_

NOTE.—One of the two forms on the back hereof or a separate authorization of agent should be signed by the applicant or applicants.

*To the Comptroller,  
The Patent Office, 25, Southampton Buildings,  
Chancery Lane, London, W.C.*

- (a) Here insert (*in full*) name, address, and calling of applicant or applicants.  
(b) Here insert title of invention.  
(c) In the case of more than one applicant, state whether all, or if not, who is or are the inventor or inventors.  
(d) To be signed by applicant or applicants. In the case of a Firm, each member of the Firm must sign.

*(1.) Where application is made through an Agent (Rule 81).*

hereby appoint of to act as Agent in respect of the within application for a Patent, and request that all notices, requisitions, and communications relating thereto may be sent to such Agent at the above address.

day of 19 .  
\* \_\_\_\_\_

\* To be signed by applicant or applicants.

*(2.) Where application is made without an Agent (Rule 7).*

hereby request that all notices, requisitions, and communications in respect of the within application may be sent to at

day of 19 .  
† \_\_\_\_\_

† To be signed by applicant or applicants.

## Patents, Designs, and Trade Marks Acts, 1883 to 1902.

[PATENT.]

FORM A1.

*(To be accompanied by two copies of Form B or of Form C.)***Application for Patent for Inventions communicated from abroad.**

I (a) of in the county of do hereby declare that I am in possession of an invention the title of which is (b) which invention has been communicated to me by (c) that I claim to be the true and first inventor thereof; and that the same is not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons to the best of my knowledge and belief; and I humbly pray that a Patent may be granted to me for the said invention.

Dated day of 19 .  
(d) ———

NOTE.—One of the two forms on the back hereof or a separate authorization of agent should be signed by the applicant or applicants.

*To the Comptroller,*

*The Patent Office, 25, Southampton Buildings,  
Chancery Lane, London, W.C.*

- (a) Here insert (in full) name, address, and calling of applicant.  
(b) Here insert title of invention.  
(c) Here insert name, address, and calling of communicator.  
(d) To be signed by applicant or applicants.

(1.) *Where application is made through an Agent (Rule 81).*

hereby appoint of to act as Agent in respect of the within application for a Patent, and request that all notices, requisitions, and communications relating thereto may be sent to such Agent at the above address.

day of 19 .  
\* ———

\* To be signed by applicant or applicants.

(2.) *Where application is made without an Agent (Rule 7).*

hereby request that all notices, requisitions, and communications in respect of the within application may be sent to at

day of 19 .  
† ———

† To be signed by applicant or applicants.

Patents, Designs, and Trade Marks Acts, 1883 to 1902.

[PATENT.]

FORM A2.

*(To be accompanied by two copies of Form C.)*

**Application for Patent under International and Colonial  
arrangements.**

(a) do hereby declare that I (or we) have made applications for protection of my (or our) invention of (b)

in the following Foreign States and on the following official dates, viz.: (c) and in the following British Possessions and on the following official dates, viz.: (d)

That the said invention was not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons before the (e) to the best of knowledge, information, and belief, and humbly pray that a patent may be granted to for the said invention in priority to other applicants, and that such patent shall have the date (f).

(g)——

NOTE.—If the application be made through an agent a proper authorization should be supplied: if not, an address for service to which communications may be sent should be furnished.

*To the Comptroller,*

*The Patent Office, 25, Southampton Buildings,  
Chancery Lane, London, W.C.*

(a) Here insert (*in full*) name, address, and calling of applicant, or of each of the applicants.

(b) Here insert title of invention.

(c) Here insert the name of each Foreign State, followed by the official date of the application in each respectively.

(d) Here insert the name of each British Possession, followed by the official date of the application in each respectively.

(e) Here insert the official date of the earliest foreign application.

(f) Here insert the official date of the earliest foreign application.

(g) Signature of applicant or of each of applicants.

## APPENDIX.

To be issued with Form A or A1.  
 Patents, Designs, and Trade Marks Acts, 1883 to 1902.  
 FORM B.

**Provisional Specification.**  
*(To be furnished in Duplicate.)*

(a)

(b)

do hereby declare the nature of this invention to be as follows:—(c)

(a) Here insert title verbally agreeing with that in the application form.

(b) Here insert (*in full*) name, address, and calling of applicant or applicants as in application form.

(c) Here begin description of the nature of the invention. The continuation of the specification should be upon wide-ruled paper of the same size, on one side only, with a margin of two inches on the left hand of the paper. The specification and the duplicate thereof must be dated (thus): "Dated this day of \_\_\_\_\_, 19\_\_\_\_," and signed at the end.

---

Patents, Designs, and Trade Marks Acts, 1883 to 1902.

[Where provisional specification has been left, quote No. and date.

No. \_\_\_\_\_  
 Date \_\_\_\_\_ ]

[PATENT.]

FORM C.

**Complete Specification.**

*(To be furnished in Duplicate—one unstamped.)*

(a)

(b)

do hereby declare the nature of this invention and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement:

(c)

(a) Here insert title verbally agreeing with that in the application form.

(b) Here insert (*in full*) name, address, and calling of applicant or applicants as in application form.

(c) Here begin full description of invention. The continuation of the specification should be upon wide-ruled paper of the same size, on one side only, with a margin of two inches on the left hand of the paper. The completion of the description should be followed by the words: "Having now particularly described and ascertained the nature of my said invention, and in what manner the same is to be performed, I declare that what I claim is:" After which should be written the claim or claims numbered consecutively. The specification and the duplicate thereof must be dated (thus): "Dated this \_\_\_\_\_ day of \_\_\_\_\_, 19\_\_\_\_," and signed at the end.

---

Patents, Designs, and Trade Marks Acts, 1883 to 1902.

FORM C1.

**Postal Request for Printed Specification.**

To the Comptroller-General.

Please send one copy of Specification, No.            Year            to

(Name in full) \_\_\_\_\_

(Address) \_\_\_\_\_

[PATENTS, 7½d.]

[½d. STAMP.]

*The Comptroller-General,  
The Patent Office, 25, Southampton Buildings,  
London, W.C.*

Patents, Designs, and Trade Marks Acts, 1883 to 1902.

[PATENT.]

FORM D.

**Form of Opposition to Grant of Patent.**

*(To be accompanied by an unstamped copy.)*

\* I

hereby give notice of my intention to oppose the grant of Letters  
Patent upon application No.            of            , applied for by  
upon the ground †

(Signed) † \_\_\_\_\_

My address for service in the United Kingdom is:—

*To the Comptroller,  
The Patent Office, 25, Southampton Buildings,  
Chancery Lane, London, W.C.*

\* Here state (in full) name and address.

† Here state upon which of the grounds of opposition permitted by section 11 of the Act of 1883, as amended by section 4 of the Act of 1888, the grant is opposed.

‡ To be signed by opponent.

## Patents, Designs, and Trade Marks Acts, 1883 to 1902.

[PATENT.]

FORM E.

## Form of Notice that Hearing before the Comptroller will be attended.

*(Oppositions to the Grant of Patents or to Amendments.)*

SIR,

of (a) hereby give notice that the hearing in reference to will be attended by myself or by some person on my behalf.

\_\_\_\_\_  
Sir,  
Your obedient Servant,  
(Signed) \_\_\_\_\_

*To the Comptroller,  
The Patent Office, 25, Southampton Buildings,  
Chancery Lane, London, W.C.*

(a) Here insert address.

## Patents, Designs, and Trade Marks Acts, 1883 to 1902.

[PATENT.]

FORM F.

## Form of Application for Amendment of Specification.

\*

seek leave to amend the specification of Letters Patent No. of 1 , as shown in red ink in the certified copy of the original specification hereunto annexed.

† I declare that no action for infringement or proceeding for revocation of the Letters Patent in question is pending.

My reasons for making this amendment are as follows: ‡

(Signed) § \_\_\_\_\_

My address for service in the United Kingdom is:—

*To the Comptroller,  
The Patent Office, 25, Southampton Buildings,  
Chancery Lane, London, W.C.*

\* Here state (in full) name and address of applicant or patentee.

† These words are to be struck out when Letters Patent have not been sealed, or when, if Letters Patent have been sealed, the application is made in pursuance of an order of the Court or a Judge.

‡ Here state reasons for seeking amendment; and where the applicant is not the patentee, state what interest he possesses in the Letters Patent.

§ To be signed by applicant.

N.B.—No amendment is permissible that would make the invention substantially larger or substantially different (section 18 of the Act of 1883); nor, so long as any action for infringement or proceeding for revocation of a patent is pending, may the application be made except by leave of the Court or a Judge under section 19 of the Act of 1883. If the application is made by such leave, this should be stated, and an office copy of the order of the Court or Judge should accompany the application.

Patents, Designs, and Trade Marks Acts, 1883 to 1902.

[PATENT.]

FORM G.

**Form of Opposition to Amendment of Specification.**

*(To be accompanied by an unstamped Copy.)*

\*

hereby give notice of objection to the proposed amendment of the specification of Letters Patent No.        of 1        for the following reason : †

(Signed) \_\_\_\_\_

My address for service in the United Kingdom is :—

*To the Comptroller,  
The Patent Office, 25, Southampton Buildings,  
Chancery Lane, London, W.C.*

\* Here state (in full) name and address of opponent.

† Here state reason of opposition.

Patents Act, 1902.

[PATENT.]

FORM H.

**Form of Application for Grant of Compulsory License or Revocation of Patent.**

*(To be accompanied by an unstamped Copy.)*

\*

hereby request you to bring to the notice of the Board of Trade the accompanying petition for the grant of a license to me by †

(Signed) \_\_\_\_\_

NOTE.—The petition must clearly set forth the facts of the case and be accompanied by an examined copy thereof. See Form H1.

*To the Comptroller,  
The Patent Office, 25, Southampton Buildings,  
Chancery Lane, London, W.C.*

\* Here state (in full) name and address of applicant.

† Here state name and address of patentee, and number and date of his Patent.



Patents Act, 1902.

FORM H1.

**Form of Petition for Grant of Compulsory License or  
Revocation of Patent.**

To the LORDS of the COMMITTEE of PRIVY COUNCIL for TRADE.

The petition of (a) of in the county of , being a person interested in the matter of this petition as hereinafter described:—

Sheweth as follows:—

1. A patent dated No. was duly granted to for an invention of (b)

2. The nature of my interest in the matter of this petition is as follows:—(c)

3. (d)

The evidence which I propose to leave at the Patent Office accompanying this petition is as follows:—(e)

Having regard to the circumstances above stated, the petitioner alleges that by reason of the aforesaid default the reasonable requirements of the public with respect to the invention patented as above stated have not been satisfied.

Your petitioner therefore prays that an order may be made granting to him a compulsory license on the terms following, viz. :—(f)

or that the said patent may be revoked.

(Signed) ———

NOTE.—In pursuance of the requirements of Rule 70, the petitioner must deliver to the patentee and to any other person alleged to have made default, copies of the petition and of the affidavits or statutory declarations and other documentary evidence in support.

(a) Here insert (in full) name, address, and calling.

(b) Here insert title of invention.

(c) Here state fully the nature of petitioner's interest.

(d) Here state in detail the circumstances of the case under section 3 of the said Act, and show that it arises by reason of the default of the patentee, or, as the case may be, of any other person claiming an interest in the Patent as exclusive licensee or otherwise to work his Patent or to manufacture the patented article in the United Kingdom to an adequate extent, or to grant licenses on reasonable terms. The statement of the case should give the names and addresses of any persons who are alleged in the petition to have made default. The paragraphs should be numbered consecutively.

(e) Here state what affidavits or statutory declarations together with any other documentary evidence will be left at the Patent Office with the petition as required by Rule 70.

(f) Here state the terms as to the amount of royalties, security for payment, or otherwise, upon which the petitioner claims to be entitled to the relief in question.

## Patents Act, 1902.

[PATENT.]

## FORM I.

**Form of Opposition to Petition for Grant of Compulsory License or Revocation of Patent.**

(a)  
hereby give notice of opposition to the petition of

for the grant of a compulsory License under Patent No.        of  
1       , or the revocation of the said patent. The grounds upon  
which I oppose the said application are as follows, viz. :—(b)

(Signed) \_\_\_\_\_

NOTE.—In pursuance of the requirements of Rule 71, copies of  
the affidavits or statutory declarations in reply to the evidence left  
with the petition must be delivered to the petitioner.

*To the Comptroller,  
The Patent Office, 25, Southampton Buildings,  
Chancery Lane, London, W.C.*

(a) Here state (in full) name and address.

(b) Here state fully the grounds of opposition.

(When stamped this Form must be sent at once to the Patent Office.)

Patents, Designs, and Trade Marks Acts, 1883 to 1902.

## FORM J.

**Application for Certificate of Payment or Renewal.**

hereby transmit the fee prescribed for the continuation in  
force of \*        Patent No.       , of 1       , for a further period  
of

Name † \_\_\_\_\_  
Address \_\_\_\_\_

*To the Comptroller,  
The Patent Office, 25, Southampton Buildings,  
Chancery Lane, London, W.C.*

\* Here insert name of patentee.

† Here insert name and full address.

(This part of the Form to be filled in at the Patent Office.)

[PATENT.]

**Certificate of Payment or Renewal.**

Letters Patent No.        of 1       .

1       .

This is to certify that        did this        day of        19       ,  
make the prescribed payment of        l. in respect of a period  
of        from        and that by virtue of such payment the rights  
of the patentee remain in force.\*

(Seal.)

*The Patent Office, London.*

\* See section 17 of the Patents, Designs, and Trade Marks Act, 1883.

## Patents, Designs, and Trade Marks Acts, 1883 to 1902.

[PATENT.]

FORM K.

Form of Application for Enlargement of Time for Payment of  
Renewal Fee.

SIR,

I HEREBY apply for an enlargement of time for        month  
in which to make the        payment of        upon my Patent,  
No.        of 1        .

The circumstances in which the payment was omitted are as  
follows (a) :—

I am, Sir,  
Your obedient Servant,

---

(b)

To the Comptroller,  
The Patent Office, 25, Southampton Buildings,  
Chancery Lane, London, W.C.

- (a) The circumstances must be stated in detail; see Rule 67.  
(b) Here insert full address to which receipt is to be sent.
- 

## Patents, Designs, and Trade Marks Acts, 1883 to 1902.

[PATENT.]

FORM L.

## Form of Request to enter Name upon the Register of Patents.

I (a)  
hereby request that you will enter (b)        name (c) in the  
Register of Patents :—

(d)        claim to be entitled (e)        of the Patent No.  
of 1        , granted to (f)        the title of which is (g)  
by virtue of (h)

And in proof whereof I transmit the accompanying (i)        with  
an attested copy thereof.

I am, Sir,  
Your obedient Servant,

---

To the Comptroller,  
The Patent Office, 25, Southampton Buildings,  
Chancery Lane, London, W.C.

- (a) Or We. Here insert (in full) name, address, and description.  
(b) My or our.  
(c) Or names.  
(d) I or We.  
(e) Here insert the nature of the claim, c.g., as Assignee.  
(f) Here give name and address of person to whom Patent was granted.  
(g) Here insert title of the invention.  
(h) Here specify the particulars of such document, giving its date, and the parties to the same, and showing how the claim here made is substantiated.  
(i) Here insert the nature of the document.

Patents, Designs, and Trade Marks Acts, 1883 to 1902.

[PATENT.]

FORM M.

**Form of Request to enter Notification of License or other Document in the Register of Patents.**

SIR,

I HEREBY transmit an attested copy of (a) under Patent No.        of 1       , as well as the original document for verification, and I have to request that a notification thereof may be entered in the Register.

I am, Sir,

Your obedient Servant,

(Signed) \_\_\_\_\_

(b)

*To the Comptroller,*

*The Patent Office, 25, Southampton Buildings,  
Chancery Lane, London, W.C.*

(a) Here insert a description of the nature of the document.

(b) Here insert full address.

Patents, Designs, and Trade Marks Acts, 1883 to 1902.

[PATENT.]

FORM N.

**Application for Duplicate of Patent.**

Date

SIR,

I REGRET to have to inform you that the Patent dated \*  
No.        granted to  
for an invention the title of which is †  
has been ‡

I beg therefore to apply for the issue of a duplicate of such Patent. §

(Signature of Patentee.)

*To the Comptroller,*

*The Patent Office, 25, Southampton Buildings,  
Chancery Lane, London, W.C.*

\* Here insert date, number, full name, and address of grantee.

† Here insert title of invention.

‡ Here insert the word "destroyed" or "lost," as the case may be, and state, in full, the circumstances of the case which must be verified by statutory declaration.

§ Here state interest possessed by applicant in the Patent.

## Patents, Designs, and Trade Marks Acts, 1883 to 1902.

[PATENT.]

FORM O.

## Notice of Intended Exhibition of an Unpatented Invention.

\*

hereby give notice of my intention to exhibit a            of            at  
the            Exhibition, which †            of            19            , under the pro-  
visions of the Patents, Designs, and Trade Marks Acts, 1883 to  
1902.

‡            herewith enclose a brief description of my invention  
(Signed) \_\_\_\_\_

*To the Comptroller,  
The Patent Office, 25, Southampton Buildings,  
Chancery Lane, London, W.C.*

\* Here state (in full) name and address of applicant.

† State "opened" or "is to open."

‡ This description of invention should be accompanied by drawings if neces-  
sary.

## Patents, Designs, and Trade Marks Acts, 1883 to 1902.

[PATENT.]

FORM P.

## Form of Request for Correction of Clerical Error.

SIR,

I HEREBY request that the following clerical error (a)  
in the (b)            No.            of 1            , may be corrected in the  
manner shown in red ink in the certified copy of the original  
(b)            hereunto annexed.

Signature \_\_\_\_\_

Full Address \_\_\_\_\_

*To the Comptroller,  
The Patent Office, 25, Southampton Buildings,  
Chancery Lane, London, W.C.*

(a) Or errors.

(b) Here state whether in application, specification, or register.

Patents, Designs, and Trade Marks Acts, 1883 to 1902.

[PATENT.]

FORM Q.

**Certificate of Comptroller-General.**

The Patent Office,  
London,  
19 .

I, \_\_\_\_\_, Comptroller-General of Patents, Designs, and Trade Marks, hereby certify

To \*

\* Here insert (in full) name and address of person requiring the certificate.

---

Patents, Designs, and Trade Marks Acts, 1883 to 1902.

[PATENT.]

FORM R.

**Form of Notice for Alteration of an Address in Register.**

SIR,

(a)

hereby request that  
altered as follows:—

address now upon the Register may be

(b)

—  
Sir,

Your obedient Servant,  
—

*To the Comptroller,*

*The Patent Office, 25, Southampton Buildings,  
Chancery Lane, London, W.C.*

(a) Here state (in full) name or names and address of applicant or applicants.

(b) Here insert full address.

---

## Patents, Designs, and Trade Marks Acts, 1883 to 1902.

[PATENT.]

FORM S.

Form of Application for Entry of Order of Privy Council  
in Register.

(a)

hereby transmit an office copy of an Order in Council with reference  
to (b)

---

 Sir,

 Your obedient Servant,
 

---

*To the Comptroller,*
*The Patent Office, 25, Southampton Buildings,  
Chancery Lane, London, W.C.*

(a) Here state (in full) name and address of applicant.

(b) Here state the purport of the order.

## Patents, Designs, and Trade Marks Acts, 1883 to 1902.

[PATENT.]

FORM T.

## Form of Appeal to Law Officer.

I, (a) hereby give notice of my intention to appeal to the  
Law Officer from (b) of the Comptroller of the day  
of 19 , whereby he (c)  
No. (d) of the year 1 (d)

Signature \_\_\_\_\_

Date \_\_\_\_\_

N.B.—This notice must be sent to the Comptroller-General at  
the Patent Office, London, W.C., and a copy of the same to the  
Law Officers' Clerk at Room 549, Royal Courts of Justice, London.

(a) Here insert (in full) name and address of appellant.

(b) Here insert "the decision" or "that part of the decision," as the case may be.

(c) Here insert "refused [or allowed] application for Patent," or "refused [or allowed] application for leave to amend Patent," or otherwise, as the case may be.

(d) Insert number and year.

Patents, Designs, and Trade Marks Acts, 1883 to 1902.

[PATENT.]

FORM U.

**Form of Application for Extension of Time for leaving a Complete Specification.**

SIR,

hereby, in respect of application No.            dated            ,  
apply for one month's extension of time in which to leave a  
Complete Specification.

The circumstances in and grounds upon which this extension is  
applied for are as follows (a) :—

\_\_\_\_\_  
Sir,  
Your obedient Servant,  
(b) \_\_\_\_\_

*To the Comptroller,  
The Patent Office, 25, Southampton Buildings,  
Chancery Lane, London, W.C.*

- (a) The circumstances and grounds must be stated in detail ; see Rule 10.  
(b) To be signed by applicant or applicants or his or their agent.

Patents, Designs, and Trade Marks Acts, 1883 to 1902.

[PATENT.]

FORM V.

**Form of Application for Extension of Time for Acceptance of a Complete Specification.**

SIR,

hereby apply for            months extension of time for  
the acceptance of the Complete Specification upon application  
No.            dated

The circumstances in and grounds upon which this extension is  
applied for are as follows (a) :—

\_\_\_\_\_  
Sir,  
Your obedient Servant,  
(b) \_\_\_\_\_

*To the Comptroller,  
The Patent Office, 25, Southampton Buildings,  
Chancery Lane, London, W.C.*

- (a) The circumstances and grounds must be stated in detail ; see Rule 10.  
(b) To be signed by applicant or applicants or his or their agent.



## APPENDIX.

## FORM W.

## 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 is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief:

And whereas the said inventor hath humbly prayed that a patent might be granted unto him for the sole use and advantage of his said invention:

And whereas the said inventor (hereinafter 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 that these our letters patent are on this condition, that, if at any time during the said term it be made to appear to us, our heirs, or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything hereinbefore contained: Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided; and also if the said patentee shall not supply, or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything hereinbefore contained: Provided also that nothing herein contained shall prevent the granting of 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

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*Comptroller-General of Patents,  
Designs, and Trade Marks.*

[Seal of Patent Office.]

G. W. BALFOUR,  
*President of the Board of Trade.*

12th January, 1903.

\* Here is to be inserted the name of the Comptroller-General.

## THE PATENTS RULES, 1905.

DATED OCTOBER 20, 1904.

By virtue of the provisions of the Patents, Designs, and Trade Marks Acts, 1883 to 1902, the Board of Trade do hereby make the following Rules:—

### SHORT TITLE.

Short title. 1. These Rules may be cited as the Patents Rules, 1905.

### COMMENCEMENT.

Commencement. 2. These Rules shall come into operation from and immediately after the 31st day of December, 1904.

### INTERPRETATION.

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

### APPLICATIONS FOR PATENTS.

Claims. 4. The statement of the invention claimed, with which a complete specification must end, shall be clear and succinct as well as separate and distinct from the body of the specification.

5. For Rule 9 of the Patents Rules, 1903, the following Rule shall be substituted:—

One invention. When a specification comprises several distinct matters, they shall not be deemed to constitute one invention by reason only that they are all applicable to or may form parts of an existing machine, apparatus, or process.

Applications for separate patents by way of amendment. Where a person making application for a patent has included in his specification more than one invention, the Comptroller may require or allow him to amend such application and specification and drawings or any of them so as to apply to one invention only, and the applicant may make application for a separate patent for any invention excluded by such amendment.

Every such last-mentioned application may, if the Comptroller at any time so direct, bear the date of the original application, or such date between the date of the original application and the date of the application in question, as the Comptroller may direct, and shall otherwise be proceeded with as a substantive application in the

manner prescribed by the said Acts and by any Rules thereunder for the time being in force.

Where the Comptroller has required or allowed any application, specification or drawings to be amended as aforesaid, such application shall, if the Comptroller at any time so direct, bear such date, subsequent to the original date of the application and not later than the date when the amendment was made, as the Comptroller shall consider reasonably necessary to give sufficient time for the subsequent procedure relating to such application.

#### PROCEDURE UNDER SECTION 1 OF THE PATENTS ACT, 1902.

6. If after the leaving of any complete specification the Examiner reports that the nature of the invention is not sufficiently disclosed and defined to enable him to make the investigation prescribed by sub-section 1, and the Comptroller has required amendment of the specification and drawings, or either of them, the application shall, if the Comptroller at any time so direct, bear such date, subsequent to its original date and not later than the date when the requirement is complied with, as the Comptroller may consider reasonably necessary to give sufficient time for the subsequent procedure relating to such application.

Power of  
Comptroller  
to post-date.

7. When the Examiner in prosecution of the investigation prescribed by sub-section 1, finds that the invention claimed in the specification under examination has been wholly claimed or described in one or more specifications within the meaning of the sub-section in question, he shall, without any further prosecution of the investigation, make a provisional report to that effect to the Comptroller.

Provisional  
report in  
case of  
complete  
anticipation.

If the provisional report of the Examiner made under this Rule be not reversed or altered, it shall be deemed a final report, and the application shall be dealt with as provided by sub-section 6. If, however, such provisional report be reversed or altered, the investigation prescribed by sub-section 1 shall be continued, and a further report shall be made to the Comptroller, and the specification shall be dealt with as provided in sub-section 5 or sub-section 6, as the case may require.

8. The time within which an applicant may leave his amended specification under sub-section 2 shall be two months from the date of the letter informing him that the invention claimed has been wholly or in part claimed or described in any specification or specifications within the meaning of sub-section 1.

Time for  
leaving  
amended  
specification.

In any special case the Comptroller may, if he think fit, enlarge the time prescribed by this Rule.

Extension of  
time.

Hearing  
by the  
Comptroller  
under sub-  
section 6.

9. When the applicant for a patent has been informed of the result of the investigation of the Examiner, made under the provisions of sub-section 1, and the time allowed by Rule 8 for amendment of his specification has expired, the Comptroller, if he is not satisfied that no objection exists to the specification on the ground that the invention claimed therein has been wholly or in part claimed or described in a previous specification within the meaning of that sub-section, shall inform the applicant accordingly and appoint a time for hearing him, and shall give him ten days' notice at the least of such appointment. The applicant shall as soon as possible notify the Comptroller whether or not he desires to be heard. The Comptroller shall, after hearing the applicant, or without a hearing, if the applicant has not attended a hearing appointed or has notified that he does not desire to be heard, determine whether reference ought to be made in the applicant's specification to any, and, if so, what, prior specification or specifications by way of notice to the public.

Reference  
to prior  
specification.

10. When under sub-section 6 the Comptroller determines that a reference to a prior specification ought to be made by way of notice to the public, the form of reference shall be as follows and shall be inserted after the claims :—

Reference has been directed in pursuance of section 1, sub-section 6, of the Patents Act, 1902, to the following specification of Letters Patent No.        granted to        .

Where the reference is inserted as the result of a provisional report under Rule 7, a statement to that effect shall be added to the reference.

#### APPEAL.

Appeal to  
Law Officer.

11. Every decision of the Comptroller under the foregoing Rules shall be subject to an appeal to the Law Officer.

#### SEALING OF PATENT AND PAYMENT OF FEE.

Sealing of  
patent and  
payment of  
fee.

12. If the applicant for a patent desires to have a patent sealed on his application, he must, on or before the last day on which a patent can lawfully be sealed, pay the prescribed sealing fee; and if such fee be not paid, no patent shall be sealed.

The prescribed sealing fee should be paid by leaving at the Patent Office Form X in the Second Schedule to these Rules, duly stamped.

#### FEES.

First  
Schedule.

13. To the fees specified in the First Schedule to the Patents Rules, 1903, shall be added the Fee specified in the First Schedule hereto.