

Term of Patent.

17.—(1) The term limited in every patent for the duration thereof shall, save as otherwise expressly provided by this Act, be ^{Term of patent.} *(fourteen)* sixteen years from its date.

By sect. 6 of the Act of 1919 it was enacted—

“(1) The term limiting the duration of patents shall be increased from fourteen to sixteen years, and accordingly in sub-sect. (1) of sect. 17 of the principal Act, for the word ‘fourteen’ there shall be substituted the word ‘sixteen.’

“(2) Any patent the original term of which had not expired at the date of the commencement of this Act shall have effect as if the term mentioned therein was sixteen years instead of fourteen years, subject to the following conditions:—

(a) any licence existing at that date which has been granted for the term of the patent shall be treated as having been granted for the term as so extended if the licensee so desires;

(b) if the patent would, apart from this section, have expired on or before the first day of January nineteen hundred and twenty, the patent shall, during the period of extension, be subject to all the provisions by this Act substituted for sect. 24 of the principal Act (except sub-sect. (5) thereof) as if the patent had been endorsed ‘licences of right.’

“(3) Where any party to a contract with the patentee or any other person, entered into before the nineteenth day of November nineteen hundred and seventeen, is subjected to loss or liability by reason of the extension of the term of any patent under the provisions of this section, the Court shall have power to determine in what manner and by which parties such loss or liability shall be borne.”

(2) A patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to pay the prescribed fees within the prescribed times; provided that the Comptroller, upon the application of the patentee, shall, on receipt of such additional fee, not exceeding ten pounds, as may be prescribed, enlarge the time to such an extent as may be applied for, but not exceeding three months.

(3) If any proceeding is taken in respect of an infringement of the patent committed after a failure to pay any fee within the prescribed time, and before any enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it

thinks fit, refuse to award any damages in respect of such infringement.

Extension of
term of
patent.

18.—(1) A patentee may, after advertising in manner provided by Rules of the Supreme Court his intention to do so, present a petition to the Court praying that his patent may be extended for a further term, but such petition must be presented at least six months before the time limited for the expiration of the patent.

Provided that the Court may in its discretion extend such period within which a petition may be presented.

(2) Any person may give notice to the Court of objection to the extension.

(3) On the hearing of any petition under this section the patentee and any person who has given such notice of objection shall be made parties to the proceedings, and the Comptroller shall be entitled to appear and be heard, and shall appear if so directed by the Court.

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

(5) If it appears to the Court that the patentee has been inadequately remunerated by his patent, the Court may by order extend the term of the patent for a further term not exceeding (*seven*) five or, in exceptional cases, (*fourteen*) ten years, or may order the grant of a new patent for such terms as may be specified in the order and containing any restriction, conditions, and provisions the Court may think fit.

(6) Where, by reason of hostilities between His Majesty and any foreign state, the patentee as such has suffered loss or damage (including loss of opportunity of dealing in or developing his invention owing to his having been engaged in work of national importance connected with such hostilities) an application under this section may be made by originating summons instead of by petition, and the Court in considering its decision may have regard solely to the loss or damage so suffered by the patentee:

Provided that this sub-section shall not apply if the patentee is a subject of such foreign state as aforesaid, or is a company the business whereof is managed or controlled by such subjects or is carried on wholly or mainly for the benefit or on behalf of such subjects, notwithstanding that the company may be registered within His Majesty's Dominions. (Sub-sect. 6 was added by sect. 7 of the Act of 1919.) (See pp. 246, 269.)

Patents of
addition.

19.—(1) Where a patent for an invention has been applied for or

granted, and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement in or modification of the invention, he may, if he thinks fit, in his application for the further patent, request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired.

(2) Where an application containing such a request is made, a patent (hereinafter referred to as a patent of addition) may be granted for such term as aforesaid.

(3) A patent of addition shall remain in force so long as the patent for the original invention remains in force, but no longer, and in respect of a patent of addition no fees shall be payable for renewal.

Provided that, if the patent for the original invention is revoked, then the patent of addition shall, if the Court or Comptroller so orders, become an independent patent, and the fees payable, and the dates when they become payable shall be determined by its date, but its duration shall not exceed the unexpired term of the patent for the original invention. (Proviso added by the Act of 1919.) (See pp. 56, 167.)

(4) The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject for a patent of addition, and the validity of the patent shall not be questioned on the ground that the invention ought to have been the subject of an independent patent. (See p. 168.)

Restoration of lapsed Patents.

20.—(1) Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may apply to the Comptroller in the prescribed manner for an order for the restoration of the patent. Restoration
of lapsed
patents.

(2) Every such application shall contain a statement of the circumstances which have led to the omission of the payment of the prescribed fee.

(3) If it appears from such statement that the omission was unintentional and that no undue delay has occurred in the making of the application, the Comptroller shall advertise the application in the prescribed manner, and within such time as may be prescribed any person may give notice of opposition at the Patent Office.

(4) Where such notice is given the Comptroller shall notify the applicant thereof.

(5) After the expiration of the prescribed period the Comptroller

shall hear the case and (*subject to an appeal to the Court*) issue an order either restoring the patent or dismissing the application : Provided that in every order under this section restoring a patent such provisions as may be prescribed shall be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent had been announced as void in the illustrated official journal.

(6) An appeal shall lie from the decision of the Comptroller under this section to the Court. (**Sub-section added by the Act of 1919.**) (*See p. 170.*)

Amendment of Specification.

Amendment
of specifica-
tion by
Comptroller.

21.—(1) An applicant or a patentee may at any time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of, and the reasons for, the proposed amendment. (*See p. 196.*)

(2) The request and the nature of the proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment. (*See p. 203.*)

(3) Where such a notice is given the Comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case. (*See p. 204.*)

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

(5) The decision of the Comptroller in either case shall be subject to an appeal to the law officer, who shall, if required, hear the person making the request to amend and, where notice of opposition has been given, the person giving that notice, if he is, in the opinion of the law officer, entitled to be heard in opposition to the request, and, where there is no opposition, the Comptroller, and may make an order determining whether and subject to what conditions (if any) the amendment ought to be allowed.

(6) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment. (*See p. 198.*)

(7) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall be advertised in the prescribed manner,

and shall in all Courts and for all purposes be deemed to form part of the specification: (*See p. 206.*)

Provided that the Court shall be entitled in construing a specification as amended to refer to the specification as accepted and published. (**Proviso inserted by the Act of 1919.**) (*See p. 103.*)

(8) This section shall not apply when and so long as any action for infringement or proceeding before the Court for the revocation of a patent is pending. (*See p. 207.*)

22. In any action for infringement of a patent or proceedings before a Court for the revocation of a patent the Court may by order allow the patentee to amend his specification by way of disclaimer correction or explanation in such manner, and subject to such terms as to costs, advertisement or otherwise, as the Court may think fit: **Amendment of specification by the Court.**

Provided that no amendment shall be so allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before the amendment, and where an application for such an order is made to the Court, notice of the application shall be given to the Comptroller, and the Comptroller shall have the right to appear and be heard, and shall appear if so directed by the Court. (*See p. 209.*)

23. Where an amendment of a specification by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before (*the disclaimer, correction, or explanation*) the date of the decision allowing the amendment, 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. (*See p. 211.*) **Restriction on recovery of damages.**

24.—(1) *Any person interested may present a petition to the Board of Trade alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied, and praying for the grant of a compulsory licence, or, in the alternative, for the revocation of the patent.* **Compulsory licences and revocation.**

(2) *The Board of Trade shall consider the petition, and if the parties do not come to an arrangement between themselves the Board of Trade, if satisfied that a prima facie case has been made out, shall refer the petition to the Court, and, if the Board are not so satisfied, they may dismiss the petition.*

(3) *Where any such petition is referred by the Board of Trade to the Court, and it is proved to the satisfaction of the Court that the*

reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by the Court to grant licences on such terms as the Court may think just, or, if the Court is of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, the patent may be revoked by order of the Court :

Provided that an order of revocation shall not be made before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default.

(4) On the hearing of any petition under this section the patentee, and any person claiming an interest in the patent as exclusive licensee or otherwise, shall be made parties to the proceeding, and the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.

(5) For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied—

(a) if by reason of the default of the patentee to manufacture to an adequate extent and supply on reasonable terms the patented article, or any parts thereof which are necessary for its efficient working, or to carry on the patented process to an adequate extent or to grant licences on reasonable terms, any existing trade or industry, or the establishment of any new trade or industry in the United Kingdom is unfairly prejudiced, or the demand for the patented article or the article produced by the patented process is not reasonably met ;

(b) if any trade or industry in the United Kingdom is unfairly prejudiced by the conditions attached by the patentee before or after the passing of this Act to the purchase, hire, or use of the patented article or to the using or working of the patented process.

(6) An order of the Court directing the grant of any licence under this section shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence and made between the parties to the proceeding.

Sect. 2 of the Act of 1919 enacted as follows :—

For section twenty-four of the principal Act, the following section shall be substituted :—

24.—(1) At any time after the sealing of a patent the comptroller shall, if the patentee so requests, cause the patent to be indorsed with the words "licences of right," and a corresponding entry to be made in the register, and thereupon—

(a) any person shall at any time thereafter be entitled as of right to a licence under the patent upon such terms as, in

Provision as
to patents
indorsed
'licences of
right.'

default of agreement, may be settled by the comptroller on the application of either the patentee or the applicant:

Provided that any licence the terms of which are settled by agreement shall be deemed, unless otherwise expressly provided, to include the terms and conditions specified in paragraphs (c) and (d) of this sub-section as if they had been imposed by the comptroller thereunder in like manner as if the terms had been settled by the comptroller: (*See p. 238.*)

(b) in settling the terms of any such licence the comptroller shall be guided by the following considerations:—

(i) he shall, on the one hand, endeavour to secure the widest possible user of the invention in the United Kingdom consistent with the patentee deriving a reasonable advantage from his patent rights;

(ii) he shall, on the other hand, endeavour to secure to the patentee the maximum advantage consistent with the invention being worked by the licensee at a reasonable profit in the United Kingdom;

(iii) he shall also endeavour to secure equality of advantage among the several licensees, and for this purpose may, on due cause being shown, reduce the royalties or other payments accruing to the patentee under any licence previously granted:

Provided, that, in considering the question of equality of advantage, the comptroller shall take into account any work done or outlay incurred by any previous licensee with a view to testing the commercial value of the invention or to securing the working thereof on a commercial scale in the United Kingdom: (*See p. 239.*)

(c) any such licence the terms of which are settled by the comptroller may be so framed as to preclude the licensee from importing into the United Kingdom any goods the importation of which, if made by persons other than the patentee or those claiming under him, would be an infringement of the patent, and in such a case the patentee and all licensees under the patent shall be deemed to have mutually covenanted against such importation: (*See p. 238.*)

(d) every such licensee shall be entitled to call upon a patentee to take proceedings to prevent the infringement of the patent, and if the patentee refuses, or neglects to do so within two months after being so called upon, the licensee

may institute proceedings for the infringement in his own name as though he were patentee, making the patentee a defendant. A patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings. Service on him may be effected by leaving the writ at his address for service given on the register : (*See pp. 225, 238.*)

- (e) if in any action for infringement of a patent so indorsed the infringing defendant is ready and willing to take a licence upon terms to be settled by the comptroller, no injunction against him shall be awarded, and the amount recoverable against him by way of damages (if any) shall not exceed double the amount which would have been recoverable against him as licensee if the licence had been dated prior to the earliest infringement :

Provided that this paragraph shall not apply where the infringement consists of the importation of infringing goods : (*See p. 373.*)

- (f) the renewal fees payable by the patentee of a patent so indorsed shall, as from the date of the indorsement, be one moiety only of the fees which would otherwise have been payable.

(2) The comptroller shall, before acting on any request to indorse a patent made by the patentee under this section, advertise such request in the Illustrated Official Journal (Patents), and shall satisfy himself that the patentee is not precluded by contract from making such request, and for that purpose shall require from the patentee such evidence, by statutory declaration or otherwise, as he may deem necessary :

Provided that a patentee shall not be deemed to be so precluded by reason only of his having granted a licence under the patent where the licence does not limit his right to grant other licences. (*See p. 239.*)

(3) Any person, alleging that a request under this section has been made contrary to some contract in which he is interested, may apply to the comptroller within the prescribed time and in the prescribed manner, and the comptroller, if satisfied of the truth of such allegation, shall refuse to indorse the patent pursuant to the request or shall cause the indorsement, if already made, to be cancelled.

Any order under this sub-section shall be subject to appeal to the court. (*See p. 240.*)

- (4) All indorsements of patents under this section shall be

entered on the register of patents and shall be published in the Illustrated Official Journal (Patents), and in such other manner as to the comptroller may seem desirable for the purpose of bringing the invention to the notice of manufacturers.

(5) If at any time it appears that in the case of a patent so indorsed there is no existing licence the comptroller may, if he thinks fit, on the application of the patentee and on payment by him of the unpaid moiety of all renewal fees which have become due since the indorsement, after due notice cancel the indorsement, and in that case the patentee's rights and liabilities shall be the same as if no such indorsement had been made. (*See pp. 238, 241.*)

25.—(1) Revocation of a patent may be obtained on petition to the Court. (*See p. 293.*) Revocation of patent.

(2) Every ground on which—

(a) a patent might, immediately before the first day of January, one thousand eight hundred and eighty-four, have been repealed by scire facias; (or

(b) a patent may be revoked under this Act either by the Comptroller or as an alternative to the grant of a compulsory licence;)

shall be available by way of defence to an action of infringement and shall also be a ground of revocation under this section.

(3) A petition for revocation for a patent may be presented—

(a) by the Attorney-General or any person authorised by him; or

(b) by any person alleging—

(i) that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims; or

(ii) that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee; or

(iii) that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention. (*See p. 294.*)

26.—(1) Any person who would have been entitled to oppose the grant of a patent, or is the successor in interest of a person who was so entitled, may, within two years from the date of the patent, in the prescribed manner apply to the Comptroller for an order revoking the patent on any one or more of the grounds on which the grant of the patent might have been opposed. Power of Comptroller to revoke patents on certain grounds.

Provided that when an action for infringement or proceedings

for the revocation of the patent are pending in any Court, an application under this section shall not be made except with the leave of the Court.

(2) The Comptroller shall give notice of the application to the patentee, and after hearing the parties, if desirous of being heard, may make an order revoking the patent or requiring the specification relating thereto to be amended by disclaimer, correction, or explanation, or dismissing the application; but the Comptroller shall not make an order revoking the patent unless the circumstances are such as would have justified him in refusing to grant the patent had the proceedings been proceedings in an opposition to the grant of a patent.

(3) A patentee may at any time, by giving notice in the prescribed manner to the Comptroller, offer to surrender his patent, and the Comptroller may, if after giving notice of the offer and hearing all parties who desire to be heard he thinks fit, accept the offer, and thereupon make an order for the revocation of the patent. (*See pp. 194, 303.*)

(4) Any decision of the Comptroller under this section shall be subject to appeal to the Court. (*See p. 190.*)

Revocation
of patents
worked out-
side the
United
Kingdom.

27.—(1) *At any time not less than four years after the date of a patent and not less than one year after the passing of this Act, any person may apply to the Comptroller for the revocation of the patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom.*

(2) *The Comptroller shall consider the application, and, if after inquiry he is satisfied that the allegations contained therein are correct, then, subject to the provisions of this section, and unless the patentee proves that the patented article or process is manufactured or carried on to an adequate extent in the United Kingdom, or gives satisfactory reasons why the article or process is not so manufactured or carried on, the Comptroller may make an order revoking the patent either—*

(a) *forthwith; or*

(b) *after such reasonable interval as may be specified in the order, unless in the meantime it is shown to his satisfaction that the patented article or process is manufactured or carried on within the United Kingdom to an adequate extent:*

Provided that no such order shall be made which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or British possession.

(3) *If within the time limited in the order the patented article or process is not manufactured or carried on within the United Kingdom*

to an adequate extent, but the patentee gives satisfactory reasons why it is not so manufactured or carried on, the Comptroller may extend the period mentioned in the previous order for such period not exceeding twelve months as may be specified in the subsequent order.

(4) Any decision of the Comptroller under this section shall be subject to appeal to the Court, and on any such appeal the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.

Sect. 1 of the Act of 1919 repealed the above section and substituted the following:—(See pp. 274, 426.)

27.—(1) Any person interested may at any time apply to the comptroller alleging in the case of any patent that there has been an abuse of the monopoly rights thereunder and asking for relief under this section. **Provisions for the prevention of abuse of monopoly rights.**

(2) The monopoly rights under a patent shall be deemed to have been abused in any of the following circumstances:—

(a) If at any time after the expiration of four years from the date of the patent, the patented invention (being one capable of being worked in the United Kingdom), is not being worked within the United Kingdom on a commercial scale, and no satisfactory reason can be given for such non-working: (See p. 274.)

Provided that, if an application is presented to the comptroller on this ground, and the comptroller is of opinion that the time which has elapsed since the date of the patent has by reason of the nature of the invention or for any other cause been insufficient to enable the invention to be worked within the United Kingdom on a commercial scale, the comptroller may adjourn the application for such period as will in his opinion be sufficient for that purpose: (See p. 289.)

(b) If the working of the invention within the United Kingdom on a commercial scale is being prevented or hindered by the importation from abroad of the patented article by the patentee or persons claiming under him, or by persons directly or indirectly purchasing from him, or by other persons against whom the patentee is not taking or has not taken any proceedings for infringement: (See p. 281.)

(c) If the demand for the patented article in the United Kingdom is not being met to an adequate extent and on reasonable terms: (See p. 282.)

(d) If, by reason of the refusal of the patentee to grant a licence or licences upon reasonable terms, the trade or

industry of the United Kingdom or the trade of any person or class of persons trading in the United Kingdom, or the establishment of any new trade or industry in the United Kingdom, is prejudiced, and it is in the public interest that a licence or licences should be granted: (*See p. 282.*)

- (e) If any trade or industry in the United Kingdom, or any person or class of persons engaged therein, is unfairly prejudiced by the conditions attached by the patentee, whether before or after the passing of this Act, to the purchase, hire, licence, or use of the patented article, or to the using or working of the patented process:

Provided that, for the purpose of determining whether there has been any abuse of the monopoly rights under a patent, it shall be taken that patents for new inventions are granted not only to encourage invention but to secure that new inventions shall so far as possible be worked on a commercial scale in the United Kingdom without undue delay. (*See p. 284.*)

(3) On being satisfied that a case of abuse of the monopoly rights under a patent has been established, the comptroller may exercise any of the following powers as he may deem expedient in the circumstances:—

- (a) He may order the patent to be indorsed with the words "licences of right" and thereupon the same rules shall apply as are provided in this Act in respect of patents so indorsed, and an exercise by the comptroller of this power shall entitle every existing licensee to apply to the comptroller for an order entitling him to surrender his licence in exchange for a licence to be settled by the comptroller in like manner as if the patent had been so indorsed at the request of the patentee, and the comptroller may make such order; and an order that a patent be so indorsed may be made notwithstanding that there may be an agreement subsisting which would have precluded the indorsement of the patent at the request of the patentee: (*See pp. 241, 284.*)

- (b) He may order the grant to the applicant of a licence on such terms as the comptroller may think expedient, including a term precluding the licensee from importing into the United Kingdom any goods the importance of which, if made by persons other than the patentee or persons claiming under him, would be an infringement of the patent, and in such case the patentee and all licensees

for the time being shall be deemed to have mutually covenanted against such importation. A licensee under this paragraph shall be entitled to call upon the patentee to take proceedings to prevent infringement of the patent and if the patentee refuses, or neglects to do so within two months after being so called upon, the licensee may institute proceedings for infringement in his own name as though he were the patentee, making the patentee a defendant. A patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings. Service on him may be effected by leaving the writ at his address for service given on the register : (*See pp. 225, 285.*)

In settling the terms of a licence under this paragraph the comptroller shall be guided as far as may be by the same considerations as are specified in section twenty-four of this Act for his guidance in settling licences under that section :

- (c) If the comptroller is satisfied that the invention is not being worked on a commercial scale within the United Kingdom, and is such that it cannot be so worked without the expenditure of capital for the raising of which it will be necessary to rely on the patent monopoly, he may, unless the patentee or those claiming under him will undertake to find such capital, order the grant to the applicant, or any other person, or to the applicant and any other person or persons jointly, if able and willing to provide such capital, of an exclusive licence on such terms as the comptroller may think just, but subject as hereinafter provided : (*See p. 286.*)
- (d) If the comptroller is satisfied that the objects of this section cannot be attained by the exercise of any of the foregoing powers, he may order the patent to be revoked, either forthwith or after such reasonable interval as may be specified in the order, unless in the meantime such conditions as may be prescribed in the order with a view to attaining the objects of this section are fulfilled, and the comptroller may, on reasonable cause shown in any case, by subsequent order extend the interval so specified :
- Provided that the comptroller shall make no order for revocation which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or British possession : (*See p. 289.*)

(e) If the comptroller is of opinion that the objects of this section will be best attained by making no order under the above provisions of this section, he may make an order refusing the application and dispose of any question as to costs thereon as he thinks just. (*See p. 290.*)

(4) In settling the terms of any such exclusive licence as is provided in paragraph (c) of the last preceding sub-section, due regard shall be had to the risks undertaken by the licensee in providing the capital and working the invention, but, subject thereto, the licence shall be so framed as—

(a) to secure to the patentee the maximum royalty compatible with the licensee working the invention within the United Kingdom on a commercial scale and at a reasonable profit ;

(b) to guarantee to the patentee a minimum yearly sum by way of royalty, if and so far as it is reasonable so to do, having regard to the capital requisite for the proper working of the invention and all the circumstances of the case ;

and, in addition to any other powers expressed in the licence or order, the licence and the order granting the licence shall be made revocable at the discretion of the comptroller if the licensee fails to expend the amount specified in the licence as being the amount which he is able and willing to provide for the purpose of working the invention on a commercial scale within the United Kingdom, or if he fails so to work the invention within the time specified in the order. (*See p. 287.*)

(5) In deciding to whom such an exclusive licence is to be granted the comptroller shall, unless good reason is shown to the contrary, prefer an existing licensee to a person having no registered interest in the patent. (*See p. 287.*)

(6) The order granting an exclusive licence under this section shall operate to take away from the patentee any right which he may have as patentee to work or use the invention and to revoke all existing licences, unless otherwise provided in the order, but on granting an exclusive licence the comptroller may, if he thinks it fair and equitable, make it a condition that the licensee shall give proper compensation to be fixed by the comptroller for any money or labour expended by the patentee or any existing licensee in developing or exploiting the invention. (*See p. 287.*)

(7) Every application presented to the comptroller under this section must set out fully the nature of the applicant's interest and the facts upon which the applicant bases his case and the relief which he seeks. The application must be accompanied by

statutory declarations verifying the applicant's interest and the facts set out in the application.

(8) The comptroller shall consider the matters alleged in the application and declarations, and, if satisfied that the applicant has a bona fide interest and that a prima facie case for relief has been made out, he shall direct the applicant to serve copies of the application and declarations upon the patentee and upon any other persons appearing from the register to be interested in the patent, and shall advertise the application in the Illustrated Official Journal (Patents).

(9) If the patentee or any person is desirous of opposing the granting of any relief under this section, he shall, within such time as may be prescribed or within such extended time as the comptroller may on application further allow, deliver to the comptroller a counter statement verified by a statutory declaration fully setting out the grounds on which the application is to be opposed.

(10) The comptroller shall consider the counter statement and declarations in support thereof and may thereupon dismiss the application if satisfied that the allegations in the application have been adequately answered, unless any of the parties demands a hearing or unless the comptroller himself appoints a hearing. In any case the comptroller may require the attendance before him of any of the declarants to be cross-examined or further examined upon matters relevant to the issues raised in the application and counter statement, and he may, subject to due precautions against disclosure of information to rivals in trade, require the production before him of books and documents relating to the matter in issue.

(11) All orders of the comptroller under this section shall be subject to appeal to the Court, and on any such appeal the law officer or such other counsel as he may appoint shall be entitled to appear and be heard. (*See p. 291.*)

(12) In any case where the comptroller does not dismiss an application as hereinbefore provided, and

(a) if the parties interested consent, or

(b) if the proceedings require any prolonged examination of documents or any scientific or local investigation which cannot in the opinion of the comptroller conveniently be made before him ;

the comptroller may at any time order the whole proceedings or any question or issue of fact arising thereunder to be referred to an arbitrator agreed on by the parties, or in default of agreement

appointed by the comptroller, and, where the whole proceedings are so referred, the award of such arbitrator shall, if all the parties consent, be final, but otherwise shall be subject to the same appeal as the decision of the comptroller under this section, and, where a question or issue of fact is so referred, the arbitrator shall report his findings to the comptroller. (*See p. 291.*)

(13) For the purposes of this section, the expression "patented article" includes articles made by a patented process. (*See p. 272.*)

And sect. 3 of the Act of 1919 added the following new section:—

Enforcement
of order for
grant of
licence.

27A. Any order for the grant of a licence under this Act shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence executed by the patentee and all other necessary parties. (*See pp. 240, 289.*)

Register of Patents.

Register of
patents.

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

(2) The register of patents existing at the commencement of this Act shall be incorporated with and form part of the register of patents under this Act.

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

(4) Copies of deeds, licences, and any other documents affecting the proprietorship in any letters patent or in any licence thereunder, must be supplied to the Comptroller in the prescribed manner for filing in the Patent Office. (*See p. 241.*)

Crown.

Patent to
bind Crown.

(29. *A patent shall have to all intents the like effect as against His Majesty the King as it has against a subject :*

Provided that any Government Department may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on such terms as may, either before or after the use thereof, be agreed on, with the approval of the Treasury, between the department and the patentee, or, in default of

agreement, as may be settled by the Treasury after hearing all parties interested.)

The above section was repealed by sect. 8 of the Act of 1919, which substituted the following:—

“29.—(1) A patent shall have to all intents the like effect as against His Majesty the King as it has against a subject: Right of Crown to use patented inventions.

“Provided that any Government department may, by themselves or by such of their agents, contractors, or others as may be authorised in writing by them at any time after the application, make, use or exercise the invention for the services of the Crown on such terms as may, either before or after the use thereof, be agreed on, with the approval of the Treasury, between the department and the patentee, or, in default of agreement, as may be settled in the manner hereinafter provided. And the terms of any agreement or licence concluded between the inventor or patentee and any person other than a Government department, shall be inoperative so far as concerns the making, use or exercise of the invention for the service of the Crown: (*See p. 397.*)

“Provided further that, where an invention which is the subject of any patent has, before the date of the patent, been duly recorded in a document by, or tried by or on behalf of, any Government department (such invention not having been communicated directly or indirectly by the applicant for the patent or the patentee), any Government department, or such of their agents, contractors, or others, as may be authorised in writing by them, may make, use and exercise the invention so recorded or tried for the service of the Crown, free of any royalty or other payment to the patentee, notwithstanding the existence of the patent. If in the opinion of the department the disclosure to the applicant or the patentee, as the case may be, of the document recording the invention, or the evidence of the trial thereof, if required, would be detrimental to the public interest, it may be made confidentially to counsel on behalf of the applicant or patentee, or to any independent expert mutually agreed upon. (*See p. 399.*)

“(2) In case of any dispute as to the making, use or exercise of an invention under this section, or the terms therefor, or as to the existence or scope of any record or trial as aforesaid, the matter shall be referred to the court for decision, who shall have power to refer the whole matter or any question or issue of fact arising thereon to be tried before a special or official referee or an arbitrator upon such terms as it may direct. The court, referee, or arbitrator, as the case may be, may, with the consent of the parties, take into consideration the validity of the patent for the purposes

only of the reference and for the determination of the issues between the applicant and such Government department. The court, referee, or arbitrator, further in settling the terms as aforesaid, shall be entitled to take into consideration any benefit or compensation which the patentee, or any other person interested in the patent, may have received directly or indirectly from the Crown or from any Government department in respect of such patent. (*See p. 400.*)

“(3) The right to use an invention for the services of the Crown under the provisions of this section or any provisions for which this section is substituted shall include, and shall be deemed always to have included, the power to sell any articles made in pursuance of such right which are no longer required for the services of the Crown. (*See p. 401.*)

“(4) Nothing in this section shall affect the right of the Crown or of any person deriving title directly or indirectly from the Crown to sell or use any articles forfeited under the laws relating to the customs or excise.” (*See p. 401.*)

Assignment
to Secretary
for War or
the Admiralty
of certain
inventions.

30.—(1) The inventor of any improvement in instruments or munitions of war may (either for or without valuable consideration) assign to the Secretary of State for War or the Admiralty on behalf of His Majesty all the benefit of the invention and of any patent obtained or to be obtained for the invention; and the Secretary of State or the Admiralty may be a party to the assignment.

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

(3) Where any such assignment has been made, the Secretary of State or the Admiralty may at any time before the publication of the complete specification certify to the Comptroller that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4) If the Secretary of State or the Admiralty so certify the application and specifications, with the drawings (if any), and any amendment of the complete specification, and any copies of such documents and drawings shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the Comp-

troller in a packet sealed by authority of the Secretary of State or the Admiralty.

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

(6) The sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by the Secretary of State or the Admiralty to receive it, and shall if returned to the Comptroller be again kept sealed by him.

(7) On the expiration of the term of the patent, the sealed packet shall be delivered to the Secretary of State or the Admiralty.

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

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

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

(11) The Secretary of State or the Admiralty may at any time waive the benefit of this section with respect to any particular invention, and the specifications, documents, and drawings shall be henceforth kept and dealt with in the ordinary way.

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

(13) Rules may be made under this Act, after consultation with

the Secretary of State and the Admiralty, for the purpose of ensuring secrecy with respect to patents to which this section applies, and those rules may modify any of the provisions of this Act in their application to such patents as aforesaid so far as may appear necessary for the purpose aforesaid. (*See p. 155.*)

Legal Proceedings.

Hearing with
assessor.

31.—(1) In an action or proceeding for infringement or revocation of a patent, the Court may, if it think fit, and shall on the request of (*either*) all of the parties to the proceeding, call in the aid of an assessor specially qualified, and try the case wholly or partially with his assistance; the action shall be tried without a jury, unless the Court otherwise directs. (**Amended by Act of 1919.**)

(2) The Court of Appeal may, if they think fit, in any proceeding before them, call in the aid of an assessor as aforesaid.

(3) The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Court of Appeal, as the case may be, and be paid as part of the expenses of the execution of this Act. (*See p. 375.*)

Power to
counterclaim
for revocation
in an action
for infringe-
ment.

32. A defendant in an action for infringement of a patent, if entitled to present a petition to the Court for the revocation of the patent, may, without presenting such a petition, apply in accordance with the Rules of the Supreme Court by way of counterclaim in the action for the revocation of the patent. (*See pp. 298, 377.*)

Power of
court to
grant relief
in respect of
particular
claims.

32A. Notwithstanding anything to the contrary appearing in section twenty-three of this Act, if the court in any action for infringement of a patent finds that any one or more of the claims in the specification, in respect of which infringement is alleged, are valid, it shall, subject to its discretion as to costs and as to the date from which damages should be reckoned, and to such terms as to amendment as it may deem desirable, grant relief in respect of any of such claims which are infringed without regard to the invalidity of any other claim in the specification. In exercising such discretion, the court may take into consideration the conduct of the parties in inserting such invalid claims in the specification or permitting them to remain there. (**Added by sect. 9 of the Act of 1919.**) (*See pp. 74, 82, 211.*)

Exemption
of innocent
infringer
from liability
for damages.

33. A patentee shall not be entitled to recover any damages in respect of any infringement of a patent granted after the commencement of this Act from any defendant who proves that at the date of the infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent, and the marking of an article with the word "patent," "patented," or any

word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed on, or otherwise applied to the article, shall not be deemed to constitute notice of the existence of the patent unless the word or words are accompanied by the year and number of the patent.

Provided that nothing in this section shall affect any proceedings for an injunction. (*See pp. 331, 333, 372.*)

34. In an action for infringement of a patent, the plaintiff shall be entitled to relief by way of injunction and damages but not to an account of profits, but subject as aforesaid (Act of 1919, sect. 10), the Court may on the application of either party make such order for an injunction (*inspection or account*) or inspection, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court may see fit. (Amended by the Act of 1919.) (*See p. 354.*)

Order for inspection, &c., in action.

35. In an action for infringement of a patent, the Court may certify that the validity of any claim in the specification of the patent (*the patent*) came in question; and, if the Court so certifies, then in any subsequent action for infringement of such claim the plaintiff in that action on obtaining a final order or judgment in his favour shall, unless the Court trying the action otherwise directs, have his full costs, charges, and expenses as between solicitor and client so far as that claim is concerned. (Amended by the Act of 1919.) (*See pp. 325, 383, 387.*)

Certificate of validity questioned and costs thereon.

36. Where any person claiming (*to be the patentee of an invention*) to have an interest in a patent, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as he has sustained thereby, if the alleged infringement to which the threats related was not in fact an infringement of (*any legal rights of the person making such threats*) the patent:

Remedy in case of groundless threats of legal proceedings.

(*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.*)

Provided that this section shall not apply if an action for infringement of the patent is commenced and prosecuted with due diligence. (This proviso substituted for the above by the Act of 1919.) (*See pp. 304, 309.*)

Miscellaneous.

Grant of patents to two or more persons.

37. Where, after the commencement of this Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interest therein as joint tenants, but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a licence without their consent, and, if any such person dies, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate. (*See p. 219.*)

Avoidance of certain conditions attached to the sale, &c., of patented articles.

38.—(1) It shall not be lawful in any contract made after the passing of this Act in relation to the sale or lease of, or licence to use or work, any article or process protected by a patent to insert a condition the effect of which will be—

(a) to prohibit or restrict the purchaser, lessee, or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licensor or his nominees; or

(b) to require the purchaser, lessee, or licensee to acquire from the seller, lessor, or licensor, or his nominees, any article or class of articles not protected by the patent;

and any such condition shall be null and void, as being in restraint of trade and contrary to public policy.

Provided that this sub-section shall not apply if—

(i) the seller, lessor, or licensor proves that at the time the contract was entered into the purchaser, lessee, or licensee had the option of purchasing the article or obtaining a lease or licence on reasonable terms, without such conditions as aforesaid; and

(ii) the contract entitles the purchaser, lessee, or licensee to relieve himself of his liability to observe any such condition on giving the other party three months' notice in writing and on payment in compensation for such relief in the case of a purchase of such sum, or in the case of a lease or licence of such rent or royalty for the residue of the term of the contract, as may be fixed by an arbitrator appointed by the Board of Trade.

In any action, application, or proceedings under this Act no person shall be estopped from applying for or obtaining relief by reason of any admission made by him as to the reasonableness of

the terms offered to him under sub-sect. (1) (i). (This paragraph was inserted by the Act of 1919.) (See pp. 233, 235.)

(2) Any contract relating to the lease of or licence to use or work any patented article or patented process, whether made before or after the passing of this Act, may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything in the same or in any other contract to the contrary, be determined by either party on giving three months' notice in writing to the other party; but where any such notice is given determining any contract made before the passing of this Act, the party giving the notice shall be liable to pay such compensation as failing agreement may be awarded by an arbitrator appointed by the Board of Trade. (See p. 236.)

(3) Any contract made before the passing of this Act relating to the lease of or licence to use or work any patented article or process and containing any condition which, had the contract been made after the passing of this Act, would by virtue of this section have been null and void may, at any time before the contract is determinable under the last preceding sub-section, and notwithstanding anything in the same or any other contract to the contrary, be determined by either party on giving three months' notice in writing to the other party, but where any such notice is given the party giving the notice shall be liable to pay such compensation as, failing agreement, may be awarded by an arbitrator appointed by the Board of Trade. (See p. 236.)

(4) The insertion by the patentee in a contract made after the passing of this Act of any condition which by virtue of this section is null and void shall be available as a defence to an action for infringement of the patent to which the contract relates brought while that contract is in force. (See pp. 237, 331, 333.)

(5) Nothing in this section shall—

(a) affect any condition in a contract whereby a person is prohibited from selling any goods other than those of a particular person; or

(b) be construed as validating any contract which would, apart from this section, be invalid; or

(c) affect any right of determining a contract or condition in a contract exerciseable independently of this section; or

(d) affect any condition in a contract for the lease of or licence to use a patented article, whereby the lessor or licensor reserves to himself or his nominees the right to supply

such new parts of the patented article as may be required to put or keep it in repair. (*See pp. 233, 284.*)

Chemical products and substances intended for food or medicine.

38A.—(1) In the case of inventions relating to substances prepared or produced by chemical processes or intended for food or medicine, the specification shall not include claims for the substance itself, except when prepared or produced by the special methods or processes of manufacture described and claimed or by their obvious chemical equivalents: Provided that, in an action for infringement of a patent where the invention relates to the production of a new substance, any substance of the same chemical composition and constitution shall in the absence of proof to the contrary be deemed to have been produced by the patented process. (*See pp. 144, 158.*)

(2) In the case of any patent for an invention intended for or capable of being used for the preparation or production of food or medicine, the comptroller shall, unless he sees good reason to the contrary, grant to any person applying for the same, a licence limited to the use of the invention for the purposes of the preparation or production of food or medicine but not otherwise; and, in settling the terms of such licence and fixing the amount of royalty or other consideration payable, the comptroller shall have regard to the desirability of making the food or medicine available to the public at the lowest possible price consistent with giving to the inventor due reward for the research leading to the invention.

Any decision of the comptroller under this sub-section shall be subject to appeal to the court.

(2) This section shall apply only to patents applied for after the passing of this Act. (**This section was added by sect. 11 of the Act of 1919.**) (*See p. 35.*)

Costs and security for costs.

39.—(1) *The Comptroller shall, in proceedings relating to an opposition to the grant of a patent or to an application for the amendment of a specification or the revocation of a patent, have power by order to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of the Court.*

(2) *If a party giving notice of opposition to the grant of a patent or to the amendment of a specification, or applying to the Comptroller for the revocation of a patent, or giving notice of appeal from any decision of the Comptroller, neither resides nor carries on business in the United Kingdom or the Isle of Man, the Comptroller, or, in case of appeal to the law officer, the law officer may require such party to give security for costs of the proceedings or appeal, and in default of such security being given may treat the proceedings or appeal as abandoned.*

(Repealed by sect. 12 of the Act of 1919. See sect. 73A substituted therefor.)

40. The law officer may examine witnesses on oath and administer oaths for that purpose, and may make rules regulating references and appeals to the law officer and the practice and procedure before him under this Part of this Act; and in any proceeding before the law officer under this Part of this Act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the Court. (*See p. 192.*)

Procedure on appeal to law officer.

41.—(1) An invention covered by any patent applied for on or after the first day of January One thousand nine hundred and five shall not be deemed to have been anticipated by reason only of its publication in a specification left pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for the patent, or of its publication in a provisional specification of any date not followed by a complete specification. (*See p. 72.*)

Provisions as to anticipation.

(2) A patent shall not be held to be invalid by reason only of the invention in respect of which the patent was granted, or any part thereof, having been published prior to the date of the patent, if the patentee proves to the satisfaction of the Court that the publication was made without his knowledge and consent, and that the matter published was derived or obtained from him, and, if he learnt of the publication before the date of his application for the patent, that he applied for and obtained protection for his invention with all reasonable diligence after learning of the publication.

By sect. 13 of the Act of 1919 it was enacted that at the end of sub-sect. (2) of sect. 41 of the principal Act, the following proviso should be added:—

Provided that the protection afforded by this sub-section shall not extend to a patentee who has commercially worked his invention in the United Kingdom otherwise than for the purpose of reasonable trial of the invention prior to the application for the patent.

(2) This section (*i.e.* the proviso above) shall not apply in the case of patents granted before the passing of this Act. (*See p. 66.*)

42. A patent shall not be held to be invalid on the ground that the complete specification claims a further or different invention to that contained in the provisional, if the invention therein claimed, so far as it is not contained in the provisional, was novel at the date when the complete specification was put in, and the applicant was the first and true inventor thereof. (*See p. 90.*)

Disconformity.

Patent on application of representative of deceased inventor.

43.—(1) If any person claiming to be inventor of an invention die without making an application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative. (*See p. 213.*)

(2) Every such application must contain a declaration by the legal representative that he believes him to be the true and first inventor of the invention.

Loss or destruction of patent.

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

Provisions as to exhibitions.

45.—(1) The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, or the reading of a paper by an inventor before a learned society, or the publication of the paper in the society's transactions, shall not prejudice the right of the inventor to apply for and obtain a patent in respect of the invention or the validity of any patent granted on the application, provided that—

(a) the exhibitor, before exhibiting the invention, or the person reading such paper or permitting such publication, give, the Comptroller the prescribed notice of his intention to do so; and

(b) the application for a patent is made before or within six months from the date of the opening of the exhibition, or the reading or publication of such paper.

(2) His Majesty may by Order in Council apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition of giving notice to the Comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the Order. (*See p. 76.*)

Publication of illustrated journal, indexes, &c.

46.—(1) The Comptroller shall issue periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that he may deem generally useful or important.

(2) Provision shall be made by the Comptroller for keeping on

sale copies of such journal, and also of all complete specifications of patents in force, with any accompanying drawings.

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

47.—(1) The control and management of the Patent Museum **Patent Museum.** and its contents shall remain vested in the Board of Education, subject to such directions as His Majesty in Council may think fit to give.

(2) The Board of Education may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model, the amount to be settled, in case of dispute, by the Board of Trade.

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

(2) This section shall not extend to vessels of any foreign State of which the laws do not confer corresponding rights with respect to the use of inventions in British vessels while in the ports of that State, or in the waters within the jurisdiction of its Courts.

(See p. 149.)

PART II.—DESIGNS.

(This Part of the Act is not relevant to this Work.)

PART III.—GENERAL.

Patent Office and Proceedings thereat.

62.—(1) The Treasury may continue to provide, for the purposes **Patent Office.** of this Act and the Trade Marks Act, 1905, an office with all **5 Edw. 7, c. 15.** requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

(2) The Patent Office shall be under the immediate control of the Comptroller, who shall act under the superintendence and direction of the Board of Trade.

(3) Any act or thing directed to be done by or to the Comptroller may be done by or to any officer authorised by the Board of Trade.

(4) Rules under this Act may provide for the establishment of branch offices for designs at Manchester or elsewhere, and for any document or thing required by this Act to be sent to or done at the Patent Office being sent to or done at any branch office which may be established.

Officers and clerks.

63.—(1) There shall continue to be a Comptroller-General of patents, designs, and trade marks, and the Board of Trade may, subject to the approval of the Treasury, appoint the Comptroller, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may remove any of those officers and clerks.

(2) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and those salaries and the other expenses of the execution of this Act and the Trade Marks Act, 1905, shall continue to be paid out of money provided by Parliament.

Seal of Patent Office.

64. Impressions of the seal of the Patent Office shall be judicially noticed and admitted in evidence. (*See p. 5.*)

Fees.

Fees.

65. There shall be paid in respect of the grant of patents and the registration of designs, and applications therefor, and in respect of other matters with relation to patents and designs under this Act, such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade; so, however, that the fees proscribed in respect of the instruments and matters mentioned in the First Schedule to this Act shall not exceed those specified in that Schedule.

Provisions as to Registers and other Documents in Patent Office.

Trust not to be entered in registers.

66. There shall not be entered in any register kept under this Act, or be receivable by the Comptroller, any notice of any trust expressed, implied or constructive. (*See p. 242.*)

Inspection of and extracts from registers.

67. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee. (*See p. 244.*)

68. Reports of examiners made under this Act shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, unless the Court or officer having power to order discovery in such legal proceeding certifies that such production or inspection is desirable in the interests of justice, and ought to be allowed.

Privilege of reports of examiners.

Provided that on application being made by any person in the prescribed form the Comptroller may disclose the result of a search made under section seven or eight of this Act on any particular application for the grant of a patent. (Proviso inserted by Act of 1919.) (See p. 166.)

69.—(1) Where an application for a patent has been abandoned, or become void, the specifications and drawings (if any) accompanying or left in connection with such application, shall not, save as otherwise expressly provided by this Act, at any time be open to public inspection or be published by the Comptroller. (See p. 74.)

Prohibition of publication of specification, drawings, &c., where application abandoned, &c.

(2) Where an application for a design has been abandoned or refused the application and any drawings, photographs, tracings, representations, or specimens left in connection with the application shall not at any time be open to public inspection or be published by the Comptroller.

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

Power for Comptroller to correct clerical errors.

- (a) correct any clerical error in or in connection with an application for a patent or in any patent or any specification ;
- (b) cancel the registration of a design either wholly or in respect of any particular goods in connection with which the design is registered ;
- (c) correct any clerical error in the representation of a design or in the name or address of the proprietor of any patent or design, or in any other matter which is entered upon the register of patents or the register of designs. (See p. 245.)

71.—(1) Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, the Comptroller shall, on request and on proof of title to his satisfaction, register him as the proprietor of a patent or design.

Entry of assignments and transmissions in registers.

(2) Where any person becomes entitled as mortgagee, licensee, or otherwise to any interest in a patent or design, the Comptroller shall, on request and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner in the register of patents or designs, as the case may be.

(3) *The person registered as the proprietor of a patent or design shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person have power absolutely to assign, grant licences as to, or otherwise deal with, the patent or design and to give effectual receipts for any consideration for any such assignment, licence, or dealing: Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other personal property. (Repealed by sect. 16 of the Act of 1919, which re-enacted the following section in its place.)*

71.—(1) Where a person becomes entitled by assignment, transmission, or other operation of law to a patent or to the copyright in a registered design, he shall make application to the Comptroller to register his title, and the Comptroller shall, on receipt of such application and on proof of title to his satisfaction, register him as the proprietor of such patent or design and shall cause an entry to be made in the prescribed manner on the register of the assignment, transmission, or other instrument affecting the title. (*See p. 213.*)

(2) Where any person becomes entitled as mortgagee, licensee, or otherwise to any interest in a patent or design, he shall make application to the Comptroller to register his title, and the Comptroller shall, on receipt of such application and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner in the register of patents or designs, as the case may be, with particulars of the instrument, if any, creating such interest.

(3) The person registered as the proprietor of a patent or design shall, subject to the provisions of the Act and to any rights appearing from the register to be vested in any other person, have power absolutely to assign, grant licences as to or otherwise deal with the patent or design, and to give effectual receipts for any consideration for any such assignment, licence or dealing:

Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other personal property. (*See pp. 242, 320.*)

(4) Except in applications made under section twenty-two of this Act, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of sub-sections (1) and (2) aforesaid, shall not be admitted in evidence in any Court in proof of the title to a patent or copyright in a design or to any interest therein unless the Court otherwise directs. (*See pp. 242, 320, 379, 404.*)

72.—(1) The Court may, on the application in the proscribed manner of any person aggrieved by the non-insertion in or omission from the register of patents or designs of any entry, or by any entry made in either such register without sufficient cause, or by any entry wrongly remaining on either such register, or by an error or defect in any entry in either such register, make such order for making, expunging, or varying such entry as it may think fit. Rectification of registers by Court.

(2) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of a register.

(3) The prescribed notice of any application under this section shall be given to the Comptroller, who shall have the right to appear and be heard thereon, and shall appear if so directed by the Court.

(4) Any order of the Court rectifying a register shall direct that notice of the rectification be served on the Comptroller in the prescribed manner, who shall upon the receipt of such notice rectify the register accordingly. (*See p. 245.*)

Powers and Duties of Comptroller.

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

73A.—(1) The Comptroller shall, in any proceedings before him under this Act, have power by order to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of Court.

(2) If any party giving notice of any opposition under this Act, or applying to the Comptroller for the revocation of a patent, or giving notice of appeal from any decision of the Comptroller under this Act, neither resides nor carries on business in the United Kingdom or the Isle of Man, the Comptroller, or in case of appeal to the law officer or the Court, the law officer or the Court may require such party to give security for the costs of the proceedings or appeal, and in default of such security being given may proceed to treat the proceedings or appeal as abandoned. (**Added by sect 12 of the Act of 1919 to replace sect. 39.**) (*See p. 193.*)

Power of
Comptroller
to take direc-
tions of law
officers.

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

Annual
reports of
Comptroller.

Evidence
before Comp-
troller.

Certificate of
Comptroller
to be evidence.

Evidence of
documents in
Patent Office.

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

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

An appeal shall lie from the decision of the Comptroller under this section to the law officer. (Act of 1919, sect. 17.)

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

Evidence, &c.

77.—(1) Subject to rules under this Act in any proceeding under this Act before the Comptroller, the evidence shall be given by statutory declaration, in the absence of directions to the contrary; but in any case in which the Comptroller thinks it right so to do, he may take evidence *vivâ voce* in lieu of or in addition to evidence by declaration, or allow any declarant to be cross-examined on his declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

(2) In case any part of the evidence is taken *vivâ voce*, the Comptroller shall, in respect of requiring the attendance of witnesses and taking evidence on oath, and discovery and production of documents (Act of 1919), be in the same position in all respects as an official referee of the Supreme Court. (*See p. 192.*)

78. A certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *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. (*See p. 379.*)

79. Printed or written copies or extracts, purporting to be certified by the Comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, and other documents in the Patent Office, and of or from registers and other books kept

there, shall be admitted in evidence in all Courts in His Majesty's dominions, and in all proceedings, without further proof or production of the originals. (*See pp. 244, 378.*)

80.—(1) Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after they have been accepted or allowed at the Patent Office. Transmission of certified printed copies of specifications, &c.

(2) Certified copies of or extracts from any such documents and of any documents so transmitted in pursuance of any enactment repealed by this Act shall be given to any person on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals. (*See p. 379.*)

81. 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 post. Applications and notices by post.

82. Where the last day fixed by this Act for doing anything under this Act falls on any day specified in rules under this Act as an excluded day, the rules may provide for the thing being done on the next following day not being an excluded day. Excluded days.

83.—(1) If any person is, by reason of infancy, lunacy, or other disability, incapable of making any declaration or doing anything required or permitted by or under this Act, the guardian or committee (if any) of the person subject to the disability, or, if there be none, any person appointed by any Court possessing jurisdiction in respect of his property, may make such declaration, or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability. Declaration by infant, lunatic, &c.

(2) An appointment may be made by the Court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making of the declaration or the doing of the thing.

Register of Patent Agents.

84.—(1) *A person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business,* Register of patent agents.

by any document issued by him or otherwise, unless he is registered as a patent agent in pursuance of this Act or an Act repealed by this Act.

(2) *Every person who proves to the satisfaction of the Board of Trade that prior to the twenty-fourth day of December, One thousand eight hundred and eighty-eight, he had been bonâ fide practising as a patent agent, shall be entitled to be registered as a patent agent in pursuance of this Act.*

(3) *If any person knowingly describes himself as a patent agent in contravention of this section, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.*

(4) *In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom. (Repealed by sect. 18 of the Act of 1919, which enacted the following section in its place):—*

84.—(1) No person shall practise, describe himself, or hold himself out, or permit himself to be described or held out, as a patent agent, unless—

(a) in the case of an individual, he is registered as a patent agent in the register of patent agents ;

(b) in the case of a firm every partner of the firm is so registered ;

(c) in the case of a company which commenced to carry on business as a patent agent after the seventeenth day of November nineteen hundred and seventeen, every director and the manager (if any) of the company is so registered ;

(d) in the case of a company which commenced to carry on business as a patent agent before that date, a manager or a director of the company is so registered : .

Provided that in the last-mentioned case the name of such manager or director shall be mentioned as being a registered patent agent in all professional advertisements, circulars or letters in which the name of the company appears.

(2) Every individual not registered as a patent agent before the fifteenth day of July nineteen hundred and nineteen who proves to the satisfaction of the Board of Trade that prior to the first day of August nineteen hundred and seventeen he was bonâ fide practising as a patent agent, whether individually or as member of a firm, or as a manager or director of an incorporated company, shall be entitled to be registered as a patent agent if he makes an application for the purpose within such time as may be fixed by the Board of Trade, unless after giving an applicant an opportunity of being heard the Board of Trade are satisfied that he has whilst so practising been guilty of such

misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom.

(3) If any person contravenes the provisions of this section, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds, and in the case of a company every director, manager, secretary, or other officer of the company who is knowingly a party to the contravention shall be guilty of a like offence and liable to a like fine.

(4) For the purposes of this section, the expression "patent agent" means a person, firm, or company carrying on for gain in the United Kingdom the business of applying for or obtaining patents in the United Kingdom or elsewhere.

(5) Nothing in this section shall be taken to prohibit solicitors from taking such part as they have heretofore taken in any proceedings under this Act.

(6) No person not registered before the fifteenth day of July nineteen hundred and nineteen shall be registered as a patent agent unless he be a British subject.

85.—(1) Rules under this Act may authorise the Comptroller to refuse to recognise as agent in respect of any business under this Act any person whose name has been erased from the register of patent agents, or who is proved to the satisfaction of the Board of Trade, after being given an opportunity of being heard, to have been convicted of such an offence, or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom, and may authorise the Comptroller to refuse to recognise as agent in respect of any business under this Act any company which, if it had been an individual, the Comptroller could refuse to recognise as such agent. **Agents for patents.**

(2) Where a company or firm acts as agents, such rules as aforesaid may authorise the Comptroller to refuse to recognise the company or firm as agent if any person whom the Comptroller could refuse to recognise as an agent acts as director or manager of the company or is a partner in the firm.

(3) The Comptroller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in the United Kingdom or the Isle of Man.

Powers, &c., of Board of Trade.

Power for Board of Trade to make general rules.

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

- (a) For regulating the practice of registration under this Act :
- (b) For classifying goods for the purposes of designs :
- (c) For making or requiring duplicates of specifications, drawings, and other documents :
- (d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, and other documents :
- (e) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications, and other documents in the Patent Office ; and providing for the inspection of indexes and abridgments and other documents :
- (f) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad :
- (g) For regulating the keeping of the register of patent agents under this Act :
- (h) generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the Comptroller, or of the Board of Trade.

(2) General rules shall whilst in force be of the same effect as if they were contained in this Act.

(3) Any rules made in pursuance of this section shall be advertised twice in the official journal to be issued by the Comptroller, and shall be laid before both Houses of Parliament as soon as practicable after they are made, and if either House of Parliament, within the next forty days after any rules have been so laid before that House, resolves that the rules or any of them ought to be annulled, the rules or those to which the resolution applies shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under the rules or to the making of any new rules.

Proceedings of the Board of Trade.

87.—(1) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

(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.

88. An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if it had been contained in this Act ; but may be revoked or varied by a subsequent Order. Provision as to Order in Council.

Offences.

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

(2) If any person falsely represents that any article sold by him is a patented article, or falsely describes any design applied to any article sold by him as registered, he shall be liable for every offence, on conviction under the Summary Jurisdiction Acts, to a fine not exceeding five pounds.

(3) If any person sells an article having stamped, engraved, or impressed thereon or otherwise applied thereto the word "patent," "patented," "registered," or any other word expressing or implying that the article is patented or that the design applied thereto is registered, he shall be deemed for the purposes of this section to represent that the article is a patented article or that the design applied thereto is a registered design.

(4) Any person who, after the copyright in a design has expired, puts or causes to be put on any article to which the design has been applied the word "registered," or any word or words implying that there is a subsisting copyright in the design, shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding five pounds.

(5) If any person uses on his place of business, or on any document issued by him, or otherwise, the words "Patent Office," or any other words suggesting that his place of business is officially connected with, or is, the Patent Office, he shall be liable on conviction

under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

Unauthorised
assumption of
Royal Arms.

90.—(1) The grant of a patent under this Act shall not be deemed to authorise the patentee to use the Royal Arms or to place the Royal Arms on any patented article.

(2) If any person, without the authority of His Majesty, uses in connection with any business, trade, calling or profession the Royal Arms (or arms so nearly resembling them as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised to use the Royal Arms, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing such Arms to continue to use such trade mark.

International and Colonial Arrangements.

International
and Colonial
arrangements.

91.—(1) If His Majesty is pleased to make any arrangement with the Government of any foreign State for mutual protection of inventions, or designs, or trade marks, then any person who has applied for protection for any invention, design, or trade mark in that State or his legal representative or assignee (a), shall be entitled to a patent for his invention or to registration of his design or trade mark under this Act or the Trade Marks Act, 1905, in priority to other applicants; and the patent or registration shall have the same date as the date of the application in the foreign State.

Provided that—

(a) The application is made, in the case of a patent within twelve months, and in the case of a design or trade mark within four months, from the application for protection in the foreign State; and

(b) Nothing in this section shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the actual date on which his complete specification is accepted, or his design or trade mark is registered, in this country.

(2) The patent granted for the invention or the registration of a design or trade mark shall not be invalidated—

(a) in the case of a patent, by reason only of the publication of a description of, or use of, the invention; or

(b) in the case of a design, by reason only of the exhibition or use

(a) Extended to representative or assignee by the 4 & 5 Geo. 5, c. 18, and the 1911 Convention.

of, or the publication of a description or representation of, the design; or

(c) in the case of a trade mark, by reason only of the use of the trade mark,

in the United Kingdom or the Isle of Man during the period specified in this section as that within which the application may be made.

(3) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act or the Trade Marks Act, 1905: Provided that—

(a) In the case of patents the application shall be accompanied by a complete specification, which, if it is not accepted within the twelve months from the application for protection in the foreign State, shall with the drawings (if any) be open to public inspection at the expiration of that period: and

(b) In the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under the Trade Marks Act, 1905.

(4) The provisions of this section shall apply only in the case of those foreign States with respect to which His Majesty by Order in Council declares them to be applicable, and so long only in the case of each State as the Order in Council continues in force with respect to that State.

(5) Where it is made to appear to His Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, (*and*) or trade marks, patented or registered in this country, it shall be lawful for His Majesty, by Order in Council, to apply the provisions of this section to that possession, with such variations or additions, if any, as may be stated in the order. (*See pp. 26, 153.*)

Definitions.

92.—(1) In this Act, unless the context otherwise requires, “the Court” means, subject to the provisions as to Scotland, Ireland, and the Isle of Man, the High Court in England. Provisions as to “the Court.”

(2) Where by virtue of this Act a decision of the Comptroller is subject to an appeal to the Court, or a petition may be referred or presented to the Court, the appeal shall, except in the case of a petition for the revocation of a patent under section twenty-five of this Act, and, subject to and in accordance with Rules of the Supreme Court, be made and the petition referred or

presented to such judge of the High Court as the Lord Chancellor may select for the purpose. (*and the decision of that judge shall be final, except in the case of an appeal from a decision of the Comptroller revoking a patent on any ground on which the grant of such patent might have been opposed.*) (See p. 247.)

An appeal shall not lie from any decision of such judge except in the case of an order revoking or confirming the revocation of a patent. (See p. 194.)

Definitions.

93. In this Act, unless the context otherwise requires,—

“Law Officer” means the Attorney-General or Solicitor-General for England:

“Prescribed” means prescribed by general rules under this Act:

“British possession” does not include the Isle of Man or the Channel Islands:

“Patent” means letters patent for an invention:

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

“Patentee” means the person for the time being entered on the register as the grantee or proprietor of the patent:

(Definition substituted by sect. 19 of the Act of 1919).

(See pp. 8, 256.)

“Invention” means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled “An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof”), and includes an alleged invention: (See pp. 3, 29.)

“Inventor” and “applicant” shall, subject to the provisions of this Act, include the legal representative of a deceased inventor or applicant:

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

“Design” means only the features of shape, configuration, pattern, or ornament applied to any article by any industrial

process or means, whether manual, mechanical, or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction, or anything which is in substance a mere mechanical device. (Definition substituted by the Act of 1919.)

“Article” means (as respects designs) any article of manufacture and any substance artificial or natural, or partly artificial and partly natural :

“Copyright” means the exclusive right to apply a design to any article in any class in which the design is registered.

“Proprietor” of a new (*and*) or original design,—

(a) Where the author of the design, for good consideration executes the work for some other person, means the person for whom the design is so executed ; and

(b) Where any person acquires the design or the right to apply the design to any article, either exclusively of any person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired ; and

(c) In any other case, means the author of the design ; and where the property in, or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person.

“Working on a commercial scale” means the manufacture of the article or the carrying on of the process described and claimed in a specification for a patent in or by means of a definite and substantial establishment or organisation, and on a scale which is adequate and reasonable under all the circumstances. (This definition was added by sect. 19 of the Act of 1919.) (*See p. 274.*)

Application to Scotland, Ireland, and the Isle of Man.

94. In the application of this Act to Scotland—

(1) In any action for infringement of a patent in Scotland the provisions of this Act with respect to calling in the aid of an assessor shall apply, and the action shall be tried without a jury, unless the Court otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts ; and for the purposes of the provisions so

**Application
to Scotland.**

applied "Court of Appeal" shall mean any Court to which such action is appealed. (*See p. 324.*)

- (2) Any offence under this Act declared to be punishable on conviction under the Summary Jurisdiction Acts may be prosecuted in the sheriff Court.
- (3) Proceedings for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only, and service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act: (*See p. 294.*)
- (4) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland in any proceedings relating to patents or to designs; and with reference to any such proceedings, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of that Court:
- (5) *Notwithstanding anything in this Act, the expression "the Court" shall, as respects petitions for compulsory licences or revocation which are referred by the Board of Trade to the Court in Scotland, mean any Lord Ordinary of the Court of Session, and shall in reference to proceedings in Scotland for the extension of the term of a patent mean such Lord Ordinary:)*
- (5) Notwithstanding anything in this Act the expression "the Court" shall in reference to proceedings in Scotland for the extension of the term of a patent mean any Lord Ordinary of the Court of Session. (**This sub-section substituted by Act of 1919.**)
- (6) The expression "Rules of the Supreme Court" shall, except in section ninety-two of this Act, mean Act of sederunt:
- (7) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court, a copy of the order, decree, or other authority for the rectification, shall be served on the Comptroller, and he shall rectify the register accordingly:
- (8) The expression "injunction" means "interdict."

**Application
to Ireland.**

95. In the application of this Act to Ireland—

- (1) All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent

as if the same had been granted to extend to Ireland only :

- (2) The provisions of this Act conferring a special jurisdiction on the Court, as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Ireland in any proceedings relating to patents or to designs ; and with reference to any such proceedings the term "the Court" means the High Court in Ireland :
- (3) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court, a copy of the order, decree, or other authority for the rectification shall be served on the Comptroller, and he shall rectify the register accordingly :

96. This Act shall extend to the Isle of Man, subject to the Isle of Man. following modifications :—

- (1) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man in proceedings for infringement, or in any action or proceeding respecting a patent or design competent to those Courts :
- (2) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court :
- (3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered, at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Repeal, Savings, and Short Title.

97. Nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof. (See p. 3.) **Saving for prerogative.**

98.—(1) The enactments mentioned in the Second Schedule to this Act are hereby repealed to the extent specified in the third column of that schedule— **Repeal and savings.**

- (a) As respect the enactments mentioned in Part I. of that Schedule, as from the commencement of this Act ;
- (b) As respects the enactments mentioned in Part II. of that Schedule, as from the date when Rules of the Supreme

Court regulating the matters dealt with in those enactments come into operation ;

- (c) As respects the enactments mentioned in Part III. of that Schedule, as from the date when rules under this Act regulating the matters dealt with in those enactments come into operation ;

and the enactments mentioned in Part II. and Part III. of that Schedule shall, until so repealed, have effect as if they formed part of this Act :

Provided that this repeal shall not affect any convention, Order in Council, rule, or table of fees having effect under any enactment so repealed, but any such convention, Order in Council, rule, or table of fees in force at the commencement of this Act shall continue in force, and may be repealed, altered or amended, as if it had been made under this Act.

(2) Except where otherwise expressly provided, this Act shall extend to patents granted and all designs registered before the commencement of this Act, and to applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

Short title
and com-
mencement.

99. This Act may be cited as the Patents and Designs Act, 1907, and shall, save as otherwise expressly provided, come into operation on the first day of January one thousand nine hundred and eight.

Sects. 21 and 22 of the Act of 1919—

Construction,
printing, and
repeal.

21.—(1) This Act shall, except where otherwise expressly provided, apply to patents granted and applications for and specifications relating to patents made and deposited, and designs registered, before as well as after the passing of this Act.

(2) Where by this Act any enactments or words are directed to be added to or omitted from the principal Act, or to be substituted for any other enactments or words in the principal Act, copies of the principal Act printed under the authority of His Majesty's Stationery Office after such direction takes effect may be printed with the enactments or words added or omitted, or substituted for other enactments or words as such direction requires, and with the sections, sub-sections, and paragraphs thereof numbered in accordance with such directions ; and the principal Act shall be construed as if it had at the time at which such direction takes effect been made with such addition, omission, or substitution.

(3) A reference in any Act of Parliament or other instrument to the principal Act shall, unless the context otherwise requires, be construed to refer to the principal Act as amended by this Act.

(4) The Patents and Designs Act, 1908, is hereby repealed.

22.—(1) This Act may be cited as the Patents and Designs Act, 1919, and the principal Act and this Act may be cited together as the Patents and Designs Acts, 1907 and 1919. Short title
and com-
mencement.

(2) The provisions by sections one and two of this Act substituted for sections twenty-seven and twenty-four of the principal Act shall not come into operation until such time, not being later than one year after the passing of this Act, as may be fixed by order of the Board of Trade (*b*), except so far as the provisions so substituted for the said section twenty-four are by sub-section (2) of section six of this Act applied to the patents therein mentioned; and the provisions of this Act relating to the terms on which an invention or registered design can be made, used or exercised by or on behalf of a Government department shall not come into operation until such time as may be fixed by order of the Board of Trade (*c*); save as aforesaid this Act shall come into operation on the passing thereof.

STATUTORY RULES AND ORDERS, 1920, No. 338.

PATENTS FOR INVENTIONS.

THE PATENTS RULES, 1920, DATED FEBRUARY 25TH, 1920.

By virtue of the provisions of the Patents and Designs Acts, 1907 and 1919 (7 Edw. 7, c. 29, and 9 & 10 Geo. 5, c. 80), hereinafter referred to as the "Acts," the Board of Trade, hereinafter referred to as the "Board," do hereby make the following Rules:—

SHORT TITLE.

1. These Rules may be cited as the Patents Rules, 1920. Short title.

COMMENCEMENT.

2. These Rules shall come into operation from and immediately after the 31st March, 1920, with the exception of such of them as relate to procedure under sects. 24 and 27 of the Acts, which shall come into operation at such date as the Board may by Order direct. Provided that those relating to the procedure under sect. Commence-
ment.

(*b*) S. R. & O., No. 413 of 1920, brought these sections into operation on 1st April, 1920. on 21st January, 1920; and S. R. & O., No. 658 of 1920, brought sub-sects. (1), (2) and (4) into operation on 23rd April, 1920.

(*c*) S. R. & O., No. 59 of 1920, brought sub-sect. (3) into operation

24 shall come into operation immediately as regards patents which but for the passing of the Patents and Designs Act, 1919, would have expired between the date of the passing of that Act and the 1st January, 1920; and those relating to the payment of renewal fees before the expiration of the fourteenth year from the date of a patent and in respect of the fifteenth year, and those relating to the disclosure of result of search under sects. 7 or 8 of the Acts, shall have effect as from the passing of the Patents and Designs Act, 1919, but the fees which have become due in respect thereof may be paid at any time before the 1st May, 1920.

INTERPRETATION.

Interpreta-
tion.

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 sect. 91 of the Acts are applicable;

“Convention Application” means an application in the United Kingdom under sect. 91 of the Acts;

“Office” means the Patent Office;

“Journal” means the Illustrated Official Journal (Patents).

FEEES.

First
Schedule.

4. The fees to be paid under the Acts, so far as the Acts relate to Patents, shall be those specified in the First Schedule to these Rules.

Second
and Third
Schedules.

5. The forms herein referred to are those contained in the Second and Third Schedules to these Rules and such forms shall be used in all cases to which they are applicable, and may be modified as directed by the Comptroller to meet other cases.

DOCUMENTS.

Size, &c., of
documents.

6. All documents and copies of documents, except drawings, sent to or left at the Office or otherwise furnished to the Comptroller or to the Board shall be written, type-written, lithographed or printed in the English language (unless otherwise directed) in large and legible characters with deep permanent ink upon strong wide-ruled white paper, and, except in the case of statutory declarations and affidavits, on one side only, of a size of approximately 13 inches by 8 inches, leaving a margin of at least one inch and a half on the left-hand part thereof, and the signatures thereto must be written

in a large and legible hand. Duplicate documents shall at any time be left, if required by the Comptroller.

At the top of the first page of a specification a space of about two inches should be left blank.

7. Any application, notice, or other document authorised or required to be left, made, or given at the Office, or to the Comptroller, or to any other person under the Acts or these Rules, may be sent by a prepaid or official paid 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 sending, it shall be sufficient to prove that the letter was properly addressed and put in the post. **Leaving and serving documents.**

A letter addressed to a patentee at his address as it appears on the register of patents or at his address for service or to any applicant or opponent in any proceedings under the Acts or these Rules, at the address appearing on the application or notice of opposition or given for service as hereinafter provided shall be deemed to be sufficiently addressed.

8. Every applicant or opponent in any proceedings under the Acts or these Rules, and every person who shall hereafter become a patentee, shall give an address for service in the United Kingdom, and such address may be treated, for all purposes connected with the patent, as the actual address of such applicant, opponent or patentee. **Address for service.**

If any patentee desires to have two addresses for service entered in the register a request therefor shall be made on Patents Form No. 31 in respect of each patent.

The Comptroller may require any patentee, who does not reside in the United Kingdom, to give an address for service within the United Kingdom, and such address may be treated as the actual address of the patentee for all purposes connected with such patent.

AGENCY.

9. With the exception of the signing of the following documents, namely, applications for patents, for the revocation of patents, for the grant of a licence under a patent, for the indorsement of a patent "licences of right," for the refusal of a request for the indorsement of a patent "licences of right," for the cancellation of such indorsement, for the restoration of lapsed patents, requests for leave to amend applications or specifications, authorisations of agents, notices of oppositions, requests for issue of duplicate letters patent, and surrenders of letters patent, all **Agency**

communications to the Comptroller under the Acts and these Rules relating to patents 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 resident or having a place of business in the United Kingdom. In any particular case, the Comptroller may, if he think fit, require the personal signature or presence of an applicant, opponent, or other person.

The Comptroller shall not be bound to recognise as such agent, or to receive further communications in respect of any business under the Acts from, any person whose name, by reason of his having been adjudged guilty of conduct discreditable to a patent agent, has been erased from the register of patent agents kept under the provisions of the Acts and not since restored.

APPLICATIONS FOR THE GRANT OF PATENTS.

Form of application.

10. An application for a patent, other than a Patent of Addition or a Secret Patent, shall be made on one of the Patents Forms, Nos. 1, 1A, 1B or 1B* as the case may be. An application for a Patent of Addition shall be made on Patents Form No. 1c. 1c*, 1c**, 1c*† or 1c***, and an application for a Secret Patent on Patents Form No. 1d.

Application by representative of deceased inventor.

11. 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 the will, or the letters of administration granted of the estate and effects, or an official copy of such probate or letters, shall be produced at the Office in proof of the applicant's title to be regarded as legal representative and be supported by such further evidence as the Comptroller may require.

Order of recording applications.

12. 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 are delivered in the ordinary course of post.

Applications left at the Office otherwise than through the post shall be in like manner numbered in the order of their receipt at the Office.

One invention.

13.—(1) 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

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. **patents by way of 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 Acts and by these Rules.

Where the Comptroller has required or allowed any application or specification or drawings or any of them 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.

(2) Where the same applicant has put in two or more provisional specifications for inventions which he believes to be cognate or modifications one of the other and the Comptroller is of opinion that such inventions are not cognate or modifications one of the other, the applicant may divide the complete specification left in connection with his application into such number of complete specifications as may be necessary to enable the application to be proceeded with as two or more separate applications for patents for different inventions.

14. 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. **Claims.**

APPLICATIONS UNDER THE INTERNATIONAL CONVENTION.

15. Every Convention application shall contain a declaration that a 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 by whom such first foreign application was made or by his legal representative or assignee. **Convention applications.**

Foreign specification, &c., to accompany application.

16. In addition to the specification left with every Convention application a copy or copies of the specification or specifications 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, must be left at the Office at the same time as the application or within such further time thereafter not exceeding three months as the Comptroller may allow. 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.

An application for extension of time for leaving the copy or copies of the foreign specification or specifications, translations, drawings or documents shall be made on Patents Form No. 5.

Public inspection.

17. If the complete specification left with the application be not accepted within twelve months from the date of the first foreign application, it shall nevertheless be open to public inspection at the expiration of that period.

Proceedings.

18. Save as aforesaid and as provided by Rule 87 all proceedings in connection with a Convention application shall be taken within the times and in the manner prescribed by the Acts or those Rules for ordinary applications.

DRAWINGS (a).

General.

19. Drawings, when furnished, should accompany the provisional or complete specification to which they refer, except in the case provided for by Rule 26. No drawing or sketch such as would require the preparation for the printer of a special illustration for use in the letterpress of the specification when printed may appear in the specification itself.

Requirements as to paper, &c.

20. Drawings must be made on pure white, hot-pressed, rolled, or calendered strong paper of smooth surface, good quality, and medium thickness, without washes or colours, in such a way as to admit of being clearly reproduced on a reduced scale by photography. Mounted drawings may not be used.

Size of drawings and arrangement of figures.

21. Drawings must be on sheets which measure 13 inches from top to bottom and are either from 8 inches to 8½ inches or

(a) NOTE.—Copies of Instructions may be had on application to the Patent Office as to the Preparation of Drawings

from 16 inches to 16½ inches wide, the narrower sheets being preferable. A clear margin must be left half an inch from the edges of the sheet.

If there are more figures than can be shown on one of the smaller sized sheets, two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large figure is required, it should be continued on subsequent sheets. There is no limit to the number of sheets that may be sent in, but no more sheets should be employed than are necessary. The figures should be numbered consecutively throughout and without regard to the number of sheets. They should be separated by a sufficient space to keep them distinct.

22. Drawings must be prepared in accordance with the following requirements:—

Drawings to be suitable for reproduction.

- (a) They must be executed with absolutely black ink.
- (b) Each line must be firmly and evenly drawn, sharply defined, and of the same strength throughout.
- (c) Section lines, lines for effect, and shading lines should be as few as possible, and must not be closely drawn.
- (d) Shading lines must not contrast too much in thickness with the general lines of the drawing.
- (e) Sections and shading should not be represented by solid black or washes.
- (f) They should be on a scale sufficiently large to show the invention clearly, and only so much of the apparatus, machine, &c., should appear as effects this purpose. If the scale is given, it should be drawn, and not denoted by words. No dimensions should be marked on the drawings.
- (g) The figures should be drawn in an upright position in regard to the top and bottom of the sheet.
- (h) Reference letters and numerals, and index letters and numerals used in conjunction therewith, must be bold, distinct and not less than one-eighth of an inch in height. The same letters or numerals should be used in different views of the same parts. Where the reference letters or numerals are shown outside the figure, they must be connected with the parts referred to by fine lines.

23. Drawings must bear the name of the applicant (and, in the case of drawings left with a complete specification after one or more provisional specifications, the numbers and years of the applications) in the left-hand top corner; the number of sheets

Drawings to bear name of applicant, &c., but no descriptive matter.

of drawings sent, and the consecutive number of each sheet, in the right-hand top corner; and the signature of the applicant or his agent in the right-hand bottom corner. Neither the title of the invention nor any descriptive matter shall appear on the drawings.

Copies of drawings.

24. A facsimile or "true copy" of the original drawings shall be filed at the same time as the original drawings, prepared strictly in accordance with the above Rules, except that the reference letters or numerals and leading lines thereto should be in black-lead pencil. In the case of a hand-made drawing this copy may be on tracing cloth. Where drawings are filed in connection with a Convention application a second "true copy" of the original drawings must be filed.

Marking of originals and true copies.

The words "original" or "true copy" must in each case be marked at the right-hand top corner, under the numbering of the sheet.

Condition of drawings on delivery.

25. Drawings must be delivered at the Office free from folds, breaks, or creases which would render them unsuitable for reproduction by photography.

Provisional drawings used for complete specification.

26. If an applicant desires to adopt the drawings lodged with his provisional specification as the drawings or part of the drawings for his complete specification, he shall refer to them in the complete specification as those left with the provisional specification.

EXTENSION OF TIME FOR LEAVING COMPLETE SPECIFICATION.

Extension of time for leaving complete specification.

27. An application for one month's extension of time for leaving a complete specification shall be made on Patents Form No. 6.

PROCEDURE UNDER SECTION 7 OF THE ACTS.

Power of Comptroller to post-date.

28. 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-sect. 1, and the Comptroller requires amendment of the specification and drawings, or any 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.

Provisional report in

29. When the Examiner in prosecution of the investigation prescribed in sub-sect. 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, he shall, without any further prosecution of the investigation, make a provisional report to that effect. case of complete anticipation.

If the provisional report of the Examiner made under this Rule be not reversed or altered, it may be deemed a final report, and the application shall be dealt with as provided by sub-sect. 4. If, however, such provisional report be reversed or altered, the investigation shall be continued, and a further report shall be made, and the specification shall be dealt with as provided in sub-sect. 3 or sub-sect. 4, as the case may require.

30. The time within which an applicant may leave his amended specification under sub-sect. 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-sect. 1. Time for leaving amended specification.

Application for an extension of time for leaving the amended specification shall be made on Patents Form No. 7, but no such extension of time shall be granted which would extend beyond the date prescribed by the Acts and Rules for the acceptance of the specification, and any fees payable under these Rules for the extension of time for acceptance of a specification shall be paid in addition to the fees for an extension of time under this Rule.

31. When the applicant for a patent has been informed of the result of the investigation of the Examiner, made under the provisions of sub-sect. 1, and the time allowed 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, and in the event of the invention claimed being wholly and specifically claimed in any specification to which the investigation has extended, whether he should refuse to grant a patent, and shall inform the applicant accordingly. As an Hearing by the Comptroller under sub-sect. 4.

alternative to the insertion of a reference to a prior specification, the Comptroller may prescribe or permit such amendments of the specification as will be to his satisfaction and, in such case, the applicant must elect, within such time as may be fixed by the Comptroller, whether he agrees to the amendments or to the insertion of a reference. If no communication is received within the prescribed time or such further time as may be allowed, the references will be inserted. Application for an extension of the time fixed by the Comptroller under this Rule shall be made in the manner prescribed in Rule 30.

Reference
to prior
specification.

32. When under sub-sect. 4 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 sect. 7, sub-sect. 4, of the Patents and Designs Acts, 1907 and 1919, to specification No. of 1 .”

Where the reference is inserted as the result of a provisional report under Rule 29, a statement to that effect shall be added to the reference.

PROCEDURE UNDER SECTION 8 OF THE ACTS.

Procedure
under
sect. 8.

33. Where on the extended investigation provided for by sect. 8 of the Acts it appears that the invention claimed in any specification deposited pursuant to an application is wholly or in part claimed in any published specification deposited pursuant to a prior application, the applicant shall be informed of the result of such extended investigation, and shall, within two months from the date of the letter so informing him, apply for leave to amend his specification by way of disclaimer, stating specifically what amendments he is prepared to make in it to remove the objection of anticipation, or if he considers that no amendments are necessary, inform the Comptroller accordingly.

Application for an extension of time for leaving the amended specification shall be made on Patents Form No. 7, but no such extension of time shall be granted which would extend beyond the date prescribed by the Acts and Rules for the acceptance of the specification, and any fees payable under these Rules for the extension of time for acceptance of a specification shall be paid in addition to the fees for an extension of time under this Rule.

The Comptroller shall consider any amendments submitted by the applicant for this purpose, and may allow the necessary amendments to be made.

34. If, at the expiration of the said two months, or such further time as the Comptroller may allow, the Comptroller is not satisfied that the invention claimed by the applicant is not wholly or in part claimed in the specification or specifications cited, he 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 and shall inform the applicant accordingly. As an alternative to the insertion of a reference to a prior specification, the Comptroller may prescribe or permit such amendments of the specification as will be to his satisfaction and, in such case, the applicant must elect, within such time as may be fixed by the Comptroller, whether he agrees to the amendments or to the insertion of a reference. If no communication is received within the prescribed time or such further time as may be allowed, the references will be inserted. Application for an extension of the time fixed by the Comptroller under this Rule shall be made in the manner prescribed in Rule 30.

Hearing by
Comptroller.

35. When, under sub-sect. 2, the Comptroller determines that 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 to
prior specifi-
cation.

“Reference has been directed, in pursuance of sect. 8, sub-sect. 2, of the Patents and Designs Act, 1907 and 1919, to specification No. of 1 .”

36. When, after any accepted specification has been published, any amendment has been made, or any reference inserted therein, under either of the last two preceding Rules, notice thereof shall be advertised in the Journal.

Advertise-
ment of
amendments.

DISCLOSURE OF RESULT OF SEARCH.

37. Application for disclosure of the result of a search made under sects. 7 or 8 of the Acts may be made, on Patents Form No. 9, at any time after the acceptance of the specification.

Disclosure of
result of
search.

CHEMICAL INVENTIONS.—TYPICAL SAMPLES AND SPECIMENS.

38. Where under sect. 2, sub-sect. (5), of the Acts, before the Chemical

inventions—
Typical
samples and
specimens.

acceptance of the complete specification left on any application for a patent for a chemical invention, the Comptroller in any particular case considers it desirable to require typical samples or specimens to be furnished, such samples or specimens must, if so required by the Comptroller, be supplied in duplicate.

The fact that such samples or specimens have been furnished shall be notified to the public by a statement to that effect on the complete specification and in connection with the advertisement of acceptance of same in the Journal.

The samples or specimens must, unless other directions are specially given, be supplied in glass bottles of a total height not exceeding 3 inches, and of an external diameter of $1\frac{1}{2}$ inches, and the bottles must be securely closed by well-fitting stoppers, and sealed. Each bottle must have an adhesive or otherwise securely attached label bearing a description which clearly identifies the sample with the substance described in the specification. Labels which are not secured to the bottle by an adhesive should be 3 inches wide and not more than 4 inches long.

Where samples or specimens of colouring matters are required to be supplied, they must be accompanied by samples or specimens of materials printed or dyed with such colouring matters; such last-mentioned samples or specimens must be as flat as possible, and firmly attached to cards 13 inches long by 8 inches broad. The cards must bear a full description of the processes by which the respective dyed or printed effects were produced, including the compositions and strengths of the various baths, the temperatures, duration of treatment, degree of exhaustion of the dye baths, in the case of dyed fabrics the percentage of colouring matter fixed on, in the case of prints the composition of the printing paste, and other necessary information. This description must also clearly identify the substance used with that described in the specification.

Samples of poisonous, corrosive, explosive, or easily inflammable substances must be clearly marked as such.

ACCEPTANCE OF SPECIFICATIONS.

Extension
of time for
accepting
complete
specification.
Notice and
advertise-
ment of
acceptance.

39. An application for extension of time for accepting a complete specification shall be made on Patents Form No. 8.

40. 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 Journal.

41. After 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 Office upon payment of the prescribed fee. **Inspection of specification.**

OPPOSITION TO GRANT OF PATENT.

42. A notice of opposition to the grant of a patent shall be given on Patents Form No. 10, and shall state the ground or grounds on which the person giving such notice (herein called the opponent) intends to oppose the grant, and must be signed by him. Such notice shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the opponent's interest, the facts upon which he bases his case and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the applicant. **Notice of opposition.**
Copy for applicant.

43. If the applicant is desirous of contesting the opposition, he shall within 14 days of the receipt of such copies, or such further time as the Comptroller may allow, leave at the Office a counter-statement fully setting out the grounds upon which the opposition is contested and on so leaving shall deliver to the opponent a copy thereof. **Counter-statement.**

44. The opponent may within 14 days from the delivery of such copy, or within such further time as the Comptroller may allow, leave at the Office evidence by way of statutory declarations in support of his case and, on so leaving, shall deliver to the applicant a copy thereof. **Opponent's evidence.**

45. Within 14 days from the delivery of such copy, or if the opponent does not leave any evidence, within 14 days from the expiration of the time within which the opponent's evidence might have been filed, or within such further time as the Comptroller may in either case allow, the applicant may leave at the Office statutory declarations in answer and, on so leaving, shall deliver to the opponent a copy thereof; and within 14 days from such delivery or within such further time as the Comptroller may allow, the opponent may leave at the Office statutory declarations in reply and, on so leaving, shall deliver to the applicant a copy thereof. Such last-mentioned declarations shall be confined to matters strictly in reply. **Applicant's evidence.**
Evidence in reply.

46. No further evidence shall be left on either side except by leave, or on requisition, of the Comptroller. **Closing of evidence.**

47. Where a document in a foreign language is referred to in any statement or declaration filed in connection with an opposition, an attested translation in duplicate shall be furnished. **Translations of documents in foreign languages.**

Hearing.

48. 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 forthwith notify the Comptroller to that effect. If either party desires to be heard he must leave Patents Form No. 11 at the Office. The Comptroller may refuse to hear either party who has not left Patents Form No. 11 prior to the date of hearing. If either party intends to refer at the hearing to any publication other than a specification or publication already mentioned in the proceedings, he should 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.

Costs in uncontested cases.

49. In the event of an opposition being uncontested by the applicant, the Comptroller in deciding whether costs should be awarded to the opponent shall consider whether proceedings might have been avoided if reasonable notice had been given by the opponent to the applicant before the opposition was filed.

SEALING OF PATENT AND PAYMENT OF FEE.**Sealing of patent and payment of fee.**

50. If the applicant for a patent desires to have a patent sealed on his application, he shall within the period allowed by sect. 12 of the Acts pay the sealing fee by leaving at the Office Patents Form No. 12.

Extension of time for sealing.

51. Where for any reason a patent cannot be sealed within the period allowed by sect. 12, the applicant may apply to the Comptroller on Patents Form No. 13 for an extension of such period not exceeding three months.

FORM OF PATENT.**Form of patent.**

52. A patent, except in the cases provided for in Rules 53 and 54, may be in the Form A, in the Third Schedule to these Rules.

Form of patent of addition.

53. A patent of addition may be in the Form B, in the Third Schedule to these Rules.

Form of patent to legal representatives of deceased inventor and others

54. Where a patent is granted to the legal representatives of a deceased inventor, or in any case in which the applicants have asked to be treated for the purpose of the devolution not only of the legal but also of the beneficial interest in such patent as joint tenants, the form of the patent shall be modified so as to

show clearly that the persons to whom the grant is made are to be treated for the purpose of the devolution not only of the legal but also of the beneficial interest in the patent as joint tenants.

RENEWAL FEES.

55. If a patentee intends, at the expiration of the fourth year **Renewal fees.** from the date of his patent or of any succeeding year during the term of the patent, to keep the same in force, he shall before the expiration of such year pay the prescribed annual renewal fee by leaving at the Office Patents Form No. 14. The patentee may pay all or any of such prescribed annual renewal fees in advance. An application for an enlargement of time for payment of any fee under this Rule shall be made on Patents Form No. 15.

56. On due compliance with the terms of Rule 55, the Comptroller shall issue a Certificate that the prescribed payment has **Certificate of payment of fees.** been duly made.

57. At any time not less than one month before the date when **Notice as to renewal fees.** any renewal fee will become due in respect of any patent, the Comptroller shall send to the patentee or patentees, whose names appear in the Register of Patents, at his or their address or addresses for service, or to the address of the person or persons who paid the last renewal fee, a notice reminding him or them of the date when such fee will become due, and of the consequences of the non-payment thereof.

RESTORATION OF LAPSED PATENTS.

58. Where any patent has become void owing to the failure **Restoration of lapsed patents.** of the patentee to pay any prescribed fee within the prescribed time the patentee may apply to the Comptroller on Patents Form No. 16 for an order for the restoration of the patent. Every such application shall be accompanied by one or more statutory declarations verifying the statements contained in such application. If the Comptroller entertains the application, he shall advertise it in the Journal, and in such other manner as in his opinion is desirable.

59. At any time within two months from the first of such **Opposition.** advertisements in the Journal any person may give notice of opposition at the Office on Patents Form No. 17. Such notice shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the opponent's interest, the facts upon which he bases his case and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the applicant.

**Further
procedure.**

60. Upon such notice of opposition being given and copy thereof transmitted to the applicant the provisions of Rules 43 to 49 shall apply to the case, and the further proceedings thereon shall be regulated in accordance with such provisions as if they were herein repeated.

Hearing.

61. If no opposition to the application is entered the Comptroller shall at the expiration of the opposition period appoint a time for hearing the applicant and, if satisfied with the evidence adduced, issue an Order restoring the patent.

Order.

62. In every Order of the Comptroller restoring a patent, provisions shall be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent has been announced as void in the Journal. Such provisions shall restrain the patentee from commencing or prosecuting any action or other proceeding, and from recovering any damage:—

(1) In respect of any infringement of the patent which shall have taken place after the date on which the patent was announced in the Journal to be void and before the date of the order.

(2) In respect of the use or employment at any time thereafter of any mechanism, machine, machinery, process or operation actually made or carried on within the United Kingdom or of the use, purchase, or sale of any article manufactured or made in infringement of the patent after the date of the said announcement and before the date of the order. Provided that such use, purchase, sale, or employment is by the person or corporation by or for whom such machine or machinery or article was bonâ fide manufactured or made, or such mechanism, machine, machinery, process or operation was bonâ fide made or carried on, his or their executors, administrators, successors, or vendees or his or their assigns respectively.

(3) In respect of the use, employment, or sale at any time thereafter by any person or corporation entitled for the time being under the preceding paragraph to use or employ any machine, machinery, mechanism, process, or operation of any improved or additional machine, machinery, mechanism, process, or operation or of the use or sale of any article manufactured or made by any of the means aforesaid in infringement of the patent; provided that the use or employment of any such improved or additional machine, machinery, mechanism, process, or operation shall be limited to the buildings, works or premises existing at the time being or afterwards erected of the person or corporation by or for whom such machine, machinery,

mechanism, process or operation was made or carried on within the meaning of the preceding paragraph, his or their executors, administrators, successors or assigns.

63. The Order shall further provide that if any person within one year after the date thereof make an application to the Board for compensation in respect of money, time, or labour expended by the applicant upon the subject-matter of the patent in the bonâ fide belief that such patent had become and continued to be void, it shall be lawful for the Board, after hearing the parties concerned or their agents, to assess the amount of such compensation if in their opinion the application ought to be granted, and to specify the party by whom and the day on which such compensation shall be paid, and if default shall be made in payment of the sum awarded, then the said patent shall become void, but the sum awarded shall not in that case be recoverable as a debt or damages.

AMENDMENT OF SPECIFICATIONS UNDER SECTION 21 OF THE ACTS.

64. A request to the Comptroller for leave to amend a specification, except when such request is made under Rules 33 or 34, shall be made on Patents Form No. 18. The request must be accompanied by a duly certified printed copy of the original specification and drawings, showing in red ink the proposed amendment in such manner as to indicate clearly the alteration desired, and shall be advertised by publication of the request and the nature of the proposed amendment in the Journal, and in such other manner (if any) as the Comptroller may in each case direct.

Request for leave to amend.

65. A notice of opposition to the amendment shall be on Patents Form No. 19. Such notice shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the opponent's interest, the facts upon which he bases his case and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the applicant.

Notice of opposition.

Copy for the applicant.

66. Upon such notice of opposition being given and copy thereof transmitted to the applicant the provisions of Rules 43 to 49 shall apply to the case, and the further proceedings thereon shall be regulated in accordance with such provisions as if they were herein repealed.

Further proceedings.

67. Where leave to amend is given the applicant shall, if the Comptroller so require, and within a time to be limited by him,

Requirements on amendment.

leave at the Office a new specification and drawings as amended, to be prepared in accordance with Rules 6 and 19 to 25.

Advertisement for amendment.

68. Particulars of all amendments of specifications allowed and made under sect. 21 shall be advertised forthwith by the Comptroller in the Journal, and in such other manner (if any) as the Comptroller may direct.

LICENCES OF RIGHT.

Request for indorsement "licences of right."

69. A request to the Comptroller to indorse a patent with the words "licences of right" shall be made upon Patents Form No. 20. Such request shall be accompanied by a statutory declaration and such other evidence as the Comptroller may deem necessary to show that the patentee is not precluded by contract from making such request.

Application for refusal of request.

70. Upon receipt of such request it shall be advertised in the Journal and any person alleging that such request has been made contrary to some contract, in which he is interested, may apply to the Comptroller upon Patents Form No. 21, within one month from the date of the advertisement, for the refusal of the request. Such application shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the applicant's interest, the facts upon which he bases his case, and the relief which he seeks. A copy of the application and of the statement will be transmitted by the Comptroller to the patentee.

Further procedure.

71. Upon such application being made and a copy thereof transmitted to the patentee, the provisions of Rules 43 to 49 shall apply *mutatis mutandis* to the further proceedings thereon.

Application to settle terms of licence.

72. An application to the Comptroller for settlement of the terms of a licence under a patent which has been indorsed "licences of right" shall be made upon Patents Form No. 22. Such application shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the applicant's interest, the facts upon which he bases his case and the terms of the licence which he is prepared to grant or accept. A copy of the application and of the statement will be transmitted by the Comptroller to the patentee or the applicant for the licence, as the case may be. Upon such application being made and copy thereof transmitted to the patentee or applicant for the licence, as the case may be, the provisions of Rules 43 to 49 shall apply *mutatis mutandis* to the further proceedings thereon.

Application for cancella-

73. An application by a patentee for the cancellation of an indorsement under sect. 24 of the Acts shall be made upon

Patents Form No. 23 and shall be advertised by the Comptroller in the Journal and in such other manner, if any, as he deems desirable. Such application should be accompanied by Patents Form No. 14 in respect of the unpaid moiety of all renewal fees which have become due since the indorsement.

74. At any time within one month from the first of such advertisements in the Journal any person may give notice of opposition at the Office on Patents Form No. 24. Such notice shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the opponent's interest, the facts upon which he bases his case and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the patentee.

75. Upon such notice of opposition being given and a copy thereof transmitted to the patentee, the provisions of Rules 43 to 49 shall apply *mutatis mutandis* to the further proceedings thereto.

PROCEDURE UNDER SECTION 26 OF THE ACTS.

76. An application for the revocation of a patent under sect. 26 of the Acts shall be made on Patents Form No. 25. Such application shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the applicant's interest, the facts upon which he bases his case and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the patentee.

77. Upon such application being made and copy thereof transmitted to the patentee the provisions of Rules 43 to 49 shall apply *mutatis mutandis* to the further proceedings thereon.

78. A notice of an offer by a patentee to surrender his patent under sect. 26 of the Acts shall be given on Patents Form No. 26, and shall be advertised by the Comptroller in the Journal and in such other manner, if any, as he deems desirable.

PROCEDURE UNDER SECTION 27 OF THE ACTS.

79. An application to the Comptroller for an Order under sect. 27 of the Acts shall be made on Patents Form No. 27 and shall show clearly the nature of the applicant's interest, the facts upon which he bases his case and the relief which he seeks. The application shall be accompanied by statutory declarations verifying the applicant's interest and the facts set out in the application.

Advertisement of application.

80. If the Comptroller upon consideration of the application decides that it may proceed, it shall be advertised in the Journal and the applicant shall upon receipt of directions from the Comptroller serve a copy of the application and of the declarations upon the patentee and upon any other persons appearing from the Register to be interested in the patent.

Service of documents.

Counter-statement.

81. The patentee or any person desirous of opposing the application shall within 14 days from the advertisement of the application in the Journal, or such further time as the Comptroller may allow, deliver to the Comptroller a counter-statement verified by a statutory declaration fully setting out the grounds on which the application is opposed. A copy of the counter-statement and of the declaration shall at the same time be delivered to the applicant by the opponent.

Application for hearing.

82. A demand for hearing by any of the parties shall be made upon Patents Form No. 28 which must be left at the Office within 14 days from the date of the delivery of the counter-statement and declaration.

Hearing.

83. Upon receipt of such demand, the Comptroller shall appoint a time for hearing the case and shall give all the parties ten days' notice at the least of such appointment. Any party who does not desire to be heard shall forthwith notify the Comptroller to that effect. Every person who desires to be heard, except the person applying for the hearing, must leave Patents Form No. 11 at the Office, and the Comptroller may refuse to hear any person who has not left Patents Form No. 11 prior to the date of the hearing. If no application for a hearing has been received from any party and the Comptroller is of opinion that a hearing is necessary, he shall appoint a time for hearing the case and the procedure shall be the same as that set out above. After hearing the party or parties, or without a hearing if no hearing is necessary, the Comptroller shall decide the case and notify his decision to the parties.

Application by licensee to surrender a licence under sect. 27 (3) (a).

84. An application by an existing licensee, under a patent which has been indorsed "licences of right" under the provisions of sect. 27, sub-sect. 3 (a) of the Acts, or an Order of the Comptroller entitling the licensee to surrender his licence in exchange for a licence to be settled by the Comptroller, shall be made upon Patents Form No. 22 as provided in Rule 72, and the further proceedings thereon shall be regulated in accordance with the provisions contained in Rule 72 as if it were herein repealed.

PATENTS FOR FOOD OR MEDICINE.

85. An application to the Comptroller under sect. 38A (2) of the Acts for a licence to use an invention for the purposes of the preparation or production of food or medicine shall be made on Patents Form No. 29. The procedure to be followed shall be the same as that prescribed in Rules 79 to 83 for an application under sect. 27 of the Acts.

Patents for food or medicine.

REGISTER OF PATENTS.

86. Upon the sealing of a patent the Comptroller shall cause to be entered in the Register of Patents the name, address, and nationality of the patentee as the grantee thereof, the title of the invention, the date of the patent, and the date of the grant thereof, together with the address for service.

Entry of grant.

87. 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. The date of the application in this country shall also be entered in the register.

Entry in respect of Convention application.

88. If a patentee send to the Comptroller on Patents Form No. 30 notice in respect of a patent of an alteration in his name or address or address for service, the Comptroller shall cause the register to be altered accordingly, and may require the altered address to be in the United Kingdom.

Alteration of address.

89. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to any interest therein, as mortgagee or licensee, application for the entry in the register of his name as proprietor or part proprietor of the patent, or of a notice of such interest, as the case may be, shall be made on Patents Form No. 32 or Patents Form No. 33, as the case may be, and shall in the case of individuals be made and signed by the person requiring to be registered as proprietor or part proprietor, or by his agent, and in the case of a body corporate by its agent.

Application for entry of subsequent proprietorship.

Form and signature of request.

90. 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 application, except such documents as are matters of record in the United Kingdom, shall, unless the Comptroller in his discretion otherwise directs, be produced to him together with the application, and he may call for such other proof of title or written consent 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 in the United Kingdom, an official or certified copy thereof shall in like manner be produced to the Comptroller.

Copies for office.

91. The application shall be accompanied by an attested copy of the assignment or other document or copy above required to be produced.

Entry of notice of interest.

92. The notice of interest in the patent of any person other than the proprietor or part proprietor entered in the register in pursuance of the application shall be such as may appear applicable to the circumstances of the particular case.

Entry of notification of document.

93. Application for entry in the Register of notification of any document (not already provided for) purporting to affect the proprietorship of a patent shall be made on Patents Form No. 34. Such application shall be accompanied by an attested copy of the document, the accuracy of such copy being certified as the Comptroller may direct, and the original document shall at the same time be produced and left at the Office if required for further verification.

Entry of date of payment of fees on issue of certificate.

94. Upon the issue of a certificate of payment under Rule 56, the Comptroller shall cause to be entered in the register a record of the date of payment of the fee on such certificate.

Hours of inspection of register.

95. The register of patents shall be open to the inspection of the public on every day on which the Office is open to the public during the time it is so open except at such times when the register is required for any purpose of official use.

CORRECTION OF CLERICAL ERRORS.

Correction of clerical errors.

96. A request for the correction of a clerical error in or in connection with an application for a patent, or in any patent or specification, or in any matter which is entered upon the register of patents, shall be made on Patents Form No. 35.

CERTIFICATES.

Certificates and certified copies of documents.

97. A request for a certificate of the Comptroller as to any entry, matter or thing which he is authorised by the Acts or any of these Rules to make or do, shall be made on Patents Form No. 36.

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 Office, or of or from registers and other books kept there, may be furnished by the Comptroller on payment of the prescribed fee.

SECRET PATENTS.

98. When it has been decided by the Admiralty, Secretary of State for War or the President of the Air Council that it is advisable to take out a secret patent for any invention assigned under sect. 30 of the Acts, and an application for such patent has been made on Patents Form No. 1D, accompanied by a certificate of the Admiralty, Secretary of State or the President of the Air Council under sect. 30 (3) of the Acts, the Comptroller shall not communicate the application or any documents relating thereto to any member of his staff other than a deputy or special examiner or examiners, who shall make the required investigations and reports required by the Acts to be made in the case of other applications for patents. Secret patents.

Unless and until such invention is re-assigned to the inventor by the Admiralty, Secretary of State or the President of the Air Council—

- (1) No copy of any specification or any other document or drawing relating thereto shall in any manner whatever be published or open to the inspection of the public.
- (2) The application for the patent, and the acceptance of any specification relating to the invention shall not be advertised, nor shall the grant of the patent for such invention be open to opposition under sect. 11 of the Acts; but the Comptroller shall cause a patent to be sealed in respect of every such invention as soon as may be after the acceptance of the complete specification relating thereto.
- (3) Every such secret patent shall be registered in a confidential register at the Office, and no details or particulars relating thereto shall at any time be published as required by the Acts for ordinary patents. Nor shall any entry be made in the ordinary Register of Patents in respect of any such patent or any assignment thereof.
- (4) No fees shall be payable in respect of any secret patent, and every such patent, notwithstanding the non-payment of such fees, shall remain in force for the full period of 16 years from its date.

99. When an application has been made otherwise than as provided by the last preceding rule for a patent for an invention, and such application is still pending, and a certificate under sect. 30 (3) of the Acts is furnished to the Comptroller by the Admiralty, Secretary of State or the President of the Air Council, Certificate of secrecy after application.

the provisions of such rule shall, so far as is practicable, having regard to the date of such certificate, apply to such application and to all documents relating thereto.

Re-assignment.

100. In the event of any secret patent being re-assigned to the inventor by the Admiralty, Secretary of State or the President of the Air Council, it shall be removed from the Confidential Register of secret patents; all fees that would have been thereafter payable if the same had not been a secret patent shall be paid in respect thereof; and the patent shall remain in force only for the same term, and subject to the same conditions as to payments of fees and otherwise as if it had not been a secret patent.

LOST PATENT.

Lost patent.

101. An application for a duplicate of a patent which has been lost or destroyed shall be made on Patents Form No. 37, and in accordance with the directions thereon.

INDUSTRIAL OR INTERNATIONAL EXHIBITIONS.

Industrial or international exhibitions.

102. 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 have issued a certificate that the exhibition is an industrial or international one, give to the Comptroller notice on Patents Form No. 38 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.

PUBLICATION OF INVENTIONS BEFORE LEARNED SOCIETIES.

Publication of inventions before learned societies.

103. Any person desirous of publishing an invention by reading a paper before a learned Society or of permitting publication of the paper in such Society's transactions may give the Comptroller notice on Patents Form No. 38 of his intention to publish the invention as provided in Rule 102.

EXERCISE OR DISCRETIONARY POWERS BY THE COMPTROLLER.

Exercise of discretionary

104. Before exercising any discretionary power given to the Comptroller by the Acts or these Rules adversely to the applicant

for a patent or for amendment of a specification, the Comptroller shall give ten days' notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before the Comptroller.

powers by
Comptroller.
Notice of
hearing.

105. Within five days from the date on which 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.

106. 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.

107. 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.

STATUTORY DECLARATIONS AND AFFIDAVITS.

108. 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 consecutively 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, typed, lithographed or printed bookwise and shall bear the name and address of the person leaving it and shall state on whose behalf it is left.

Form, &c.,
of statutory
declaration
and affidavit.

109. The statutory declarations and affidavits required by the Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows:—

Manner in
which, and
persons
before whom,
declaration or
affidavit is to
be taken.

(a) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;

(b) In any other part of 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.

GENERAL.

Power of amendment, &c.

110. Any document for the amending of which no special provision is made by the 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 and in such manner as the Comptroller may think fit.

General power to enlarge time.

111. The times prescribed by these Rules for doing any act, or taking any proceeding thereunder, other than the times prescribed by Rules 16 and 55, may be enlarged by the Comptroller if he thinks fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

Days and hours of business.

112. The Office shall be open to the public every weekday 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 Office.

Excluded days.

113. Whenever the last day fixed by the Acts, or by these Rules, for doing any thing shall fall on a day when the Office is not open or on a Saturday, which days shall be excluded days for the purposes of the Acts and these Rules, it shall be lawful to do any such thing on the day next following such excluded day, or days if two or more of them occur consecutively.

Powers to dispense with evidence, signature, &c.

114. 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 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 to make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, and upon the production of such other evidence, and

subject to such terms as he may think fit, to dispense with any such act or thing, document, declaration, or evidence.

APPLICATIONS TO AND ORDERS OF COURT.

115. Four clear days' notice of every application to the Court **Applications to Court.** under sect. 72 of the Acts for rectification of the register of patents shall be given to the Comptroller.

Where any Order has been made by the Court under the Acts **Orders of Court.** revoking a patent or extending the term of a patent, or allowing a patentee to amend his specification or affecting the validity or proprietorship of a patent or any rights thereunder, the person in whose favour such order has been made shall forthwith leave at the Office an office copy of such order together with Patents Form No. 39. The specification shall thereupon be amended or the register rectified or the purport of such Order shall otherwise be duly entered in the register as the case may be.

REPEAL.

116. All general rules relative to Patents heretofore made by **Repeal.** the Board of Trade under the Patents and Designs Act, 1907, and in force on the 31st day of March, 1920, 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.

Dated the 25th day of February, 1920.

A. C. Geildes,
President of the Board of Trade.

SCHEDULES.

Sect. 65.

FIRST SCHEDULE.

FEEs ON INSTRUMENTS FOR OBTAINING PATENTS AND RENEWAL.

(a) *Up to sealing.*

	£	s.	d.	£	s.	d.
On application for provisional protection.....	1	0	0			
On filing complete specification	3	0	0			
	<hr/>			4	0	0
or						
On filing complete specification with first application				4	0	0
On the sealing of the patent in respect of investigations as to anticipation				1	0	0

		<i>(b) Further before end of four years from date of patent.</i>				
On certificate of renewal			£	s.	d.
				50	0	0
		<i>(c) Further before end of eight years from date of patent.</i>				
On certificate of renewal			100	0	0
<hr/>						
Or in lieu of the fees of £50 and £100 the following annual fees:—						
Before the expiration of the 4th year from the date of the patent...				10	0	0
" " 5th " " " ...				10	0	0
" " 6th " " " ...				10	0	0
" " 7th " " " ...				10	0	0
" " 8th " " " ...				15	0	0
" " 9th " " " ...				15	0	0
" " 10th " " " ...				20	0	0
" " 11th " " " ...				20	0	0
" " 12th " " " ...				20	0	0
" " 13th " " " ...				20	0	0
<hr/>						

FORMS IN PROCEEDINGS IN AN ACTION FOR INFRINGEMENT.

Indorsement on Writ.

The plaintiff claims:—

- (1) An injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's letters patent No. of .
- (2) Damages for such infringement.
- (3) That the defendant be ordered to deliver up to the plaintiff or to destroy all articles made in infringement of the said letters patent, and in the defendant's possession or power.
- (4) Costs.

Notice of Motion for Interlocutory Injunction.

In the High Court of Justice.

Chancery Division.

Between A. B. Plaintiff,

and

C. D. Defendant.

Take notice that this honourable Court will be moved [*if short notice of motion*, by leave granted] on the day of , or so soon thereafter as counsel can be heard, by counsel for the above-named plaintiff, that an injunction may be awarded against the defendant to restrain the said defendant, his servants or agents, until the trial of this action or further order, from either directly

or indirectly making, using, or putting in practice the invention described in the specification and drawings filed under the letters patent granted to the plaintiff [*or assignor, or other predecessor in title of plaintiff*], and numbered _____, or that such further order may be made in the premises as to the Court may seem meet.

Interlocutory Order to Restrain Infringement of Patent.

Upon motion, &c., by counsel for the plaintiff, and upon hearing counsel for the defendant [*or reading an affidavit of service of notice of this motion on the defendant; or, if moved ex parte before the defendant has appeared*], the writ of summons issued in this action on the _____ day of _____] [*enter affidavits in support and in opposition, if any*], and the plaintiff, by his counsel, undertaking to abide by any order this Court may make as to damages, in case this Court should hereafter be of opinion that the defendant shall have sustained any, by reason of this order, which the plaintiff ought to pay [*if so, and also undertaking to accept short notice of motion to dissolve the injunction hereby awarded*], let an injunction be awarded to restrain the defendant T. under further order, from manufacturing any tube expanders similar to the tube expander which has been purchased by the defendant B., as in the plaintiff's writ mentioned, or otherwise constructed so as to imitate or resemble the roller expanding tool described in the specification in the plaintiff's letters patent in the said writ mentioned, and to restrain the defendants T. and B., their agents, &c., from selling or offering for sale, or otherwise parting with the custody of any tube expanders, or parts of any tube expanders, which have been so manufactured by the said defendant T. Liberty to either party to apply to expedite the hearing.

Interlocutory Injunction for Infringement refused on Terms.

Upon motion, &c., for injunction to restrain &c., and the defendant, by his counsel, undertaking to keep an account of all moneys received or to be received by him, by reason of the sale or use of the parlour or roller skates in the writ mentioned, this Court does not think fit to make any order upon the said motion, but does order that the costs of the said motion be costs in the cause.

Inspection, Notice of Motion for.

[*Title as before.*]

Take notice that this honourable Court will be moved [*if in the Chancery Division*, before his lordship, Mr. Justice], on the part of the plaintiff, that the plaintiff, his solicitors and agents, ^{and}/_{or} two scientific witnesses, to be named in the notice hereinafter mentioned, may be at liberty at all seasonable times, and as often as may be requisite, upon giving three days' previous notice in writing to the defendants' solicitors, to enter into and upon the business premises of the defendants, where the process of decorating or printing tin or metal plates is carried on by the defendants as stated in the plaintiff's statement of claim in this action, and to inspect and examine there the whole of the process by which such printed and decorated tin and metal plates are manufactured by the defendants; and to take, on paying the reasonable charges of the defendants for the same, samples of such plates, and upon and during such inspection to make such observations as may be necessary and expedient for the purpose of obtaining full information and evidence of the mode by which such plates are manufactured by the defendants; and that the defendants may be ordered to permit the plaintiff, his solicitors and agents, and two persons to be named as aforesaid, to enter into and upon their said premises for the purposes aforesaid, and that the costs of this application may be costs in the action (a).

Inspection, where for a Process and to take Samples.

[*Title as above.*]

[*Formal parts as above*] to enter in and upon the business premises of the defendants, where the manufacture of is carried on by the defendants, as mentioned in the statement of claim in this action, and to inspect and examine there the machines used by the said defendants in the manufacture of , and the process by which is manufactured by the said defendants, and that the said machines ^{or}/_{and} process may be put to work upon such inspection, and that the plaintiff, his servants or agents, may be at liberty to take samples of the made or to be made by the said machines or process, upon paying to the defendants their reasonable charges for the same.

(a) *Flower v. Lloyd*, 1876, A. 1254; as to inspection, see p. 354 *et seq.*

Inspection of Plaintiff's Patented Process by Defendant.

[*Form of Order given in Griffin, P. C., at p. 106.*]

"That A. B. and one other indifferent person appointed by him and C. D., one of the defendant's solicitors, be at liberty at all such times and as often as in the opinion of the said A. B. be requisite, on giving 3 days' notice to the plaintiffs to enter into some business premises to be selected by the plaintiffs, where the process or mode of working referred to in the specification mentioned in the statement of claim can be seen at work, and to inspect and examine there the whole of the machinery fitted in such mill, and to take such samples of the finished and unfinished products of the working of such machinery as in the opinion of the said A. B. may be necessary for the purposes of this action, And it is ordered that such machinery be put to regular work upon such inspection. The costs of this application are to be costs in the action" (*b*).

Inspection, and Order for Delivery by Defendant of Samples for Analysis.

[*Title as above.*]

[*Formal parts as above*] may be at liberty, upon giving three days' previous notice in writing to the defendant's solicitors, to enter upon the defendant's premises, and to inspect the type there used by the said defendant in his printing processes, as mentioned in the statement of claim in this action; and that the defendant may be ordered to permit the plaintiff, his solicitors and agents, and one person to be named as aforesaid, to enter upon his premises for the purpose aforesaid, and that said defendant may be further ordered to deliver to the plaintiff a competent part of the said type so used, on payment of a fair price for the same, and that the costs of this application may be costs in the action (*c*).

(*b*) *The Germ Milling Co. v. Robinson*, 55 L. J. Ch. 287; 3 R. P. C. at p. 14.

(*c*) This was the notice of motion in *The Patent Type Founding Co. v. Walter*, reported at 5 H. & N. 192; 29 L. J. Ex. 207; 6 Jur. N. S. 103; 1 L. T. Rep. N. S. 382. The samples of type in this case were required for the purpose of analysis.

Notice of motion for inspection must be supported by affidavit; a fair *prima facie* case of validity and

infringement must be made out. The order for inspection is frequently made upon the application for interlocutory injunction, and is sometimes made to include a cross order that the plaintiff shall permit the defendant to see and inspect the patented machine at work, and also to take samples: *Amies v. Kelsey*, 22 L. J. Q. B. 84. The affidavit should show that there is such property or machinery as is required to be inspected, that the

Order for Inspection of Defendants' Process by Experts.

Let I. and C., of, &c., be at liberty at all reasonable times, and as often as requisite, on giving three days' notice to the defendants, to enter into the business premises of the defendants, where the process of decorating or printing tin and metal plates is carried on by the defendants, as stated in the plaintiff's statement of claim, and mentioned in the said affidavits, or some of them, and to inspect and examine there the whole of the process by which such printed and decorated tin (*d*) and metal plates are manufactured by the defendants, and to take, on paying the reasonable charges of the defendants for the same, samples of such plates, and upon and during such inspection to make such observations as may be necessary and expedient for the purpose of obtaining full information and evidence of the mode by which such plates are manufactured by the defendants (*e*).

Statement of Claim.

1. The plaintiff is the registered legal owner of letters patent No. , granted to him in respect of an invention entitled " ."
2. The defendant has infringed and threatens to infringe the said letters patent in the manner appearing in the particulars of breaches delivered herewith.
3. The plaintiff claims:—
 - (1) An injunction to restrain the defendant, his servants and agents, from infringing the said letters patent.
 - (2) An inquiry as to the damages sustained by the plaintiff by reason of such infringement.
 - (3) That the defendant may be ordered to deliver up forthwith to the plaintiff all articles in his possession or power made

inspection is necessary for the purpose of the action: *Shaw v. Bank of England*, 22 L. J. Ex. 26. It should also show what the patent is for, so that the Court or judge may see that there is necessity for the inspection. The order will not be granted on the plaintiff's application unless the Court is satisfied that it is essential to enable him to prove his case: *Batley v. Kynoch*, L. R. 19 Eq. 90; *Meadows v. Kirkmann*, 29 L. J. Ex. 205. In *The Singer Manufacturing Company v. Wilson*, 13 W. R. 560, the Court refused to give the plaintiff

inspection of the defendant's stock before judgment, but ordered the defendant to verify by affidavit all the different kinds of sewing machines which he had sold since the last disclaimer entered by the plaintiff, and to produce one of each sort for inspection.

(*d*) No order will be made on this application for the inspection of books, for which a separate order must be obtained: *Vidi v. Smith*, 3 E. & B. 969.

(*e*) *Flower v. Lloyd*, C. A., 5th July, 1876, A. 1254.

in infringement of the said letters patent, or that the said articles may be ordered to be destroyed.

(4) Costs.

Signed
Delivered.

[Plea to be used where specification has been amended].

On the day of the plaintiff applied at the Patent Office for leave to amend the specification describing the said invention, and such leave was duly granted on the day of (or on the day of in an action entitled the Hon. Mr. Justice granted to the patentee leave to amend his complete specification). The specification as originally filed was framed in good faith and with reasonable skill and knowledge.

[To be used where a certificate of validity has been granted in a previous action.]

The plaintiff claims full costs, charges and expenses as between solicitor and client. In an action brought by the plaintiff against X. for infringement, Mr. Justice certified that the validity of the patent came into question.

Particulars of Breaches.

FORM 1.

In the High Court of Justice,
Chancery Division.

Between A. B. Plaintiff,

and

C. D. Defendant.

The following are the particulars of the breaches complained of in the statement of claim herein :—

1. The defendant on or about the day of at his factory at , in the county of , manufactured acetate of soda by the process and with the use of the machinery and appliances which form the subject-matter of all of the claiming clauses in the specification of the plaintiff's patent.

2. On the day of the defendant sold to John Smith, of , one parcel containing tons of acetate of soda manufactured by the defendant by the process and with the use of the machinery and appliances which form the subject-matter of the plaintiffs' patent, and in infringement of all the claiming clauses

thereof. The plaintiff will rely upon this sample as an instance of the type of the infringement committed by the defendants.

Signed.

Delivered the day of .

To

Defendant's solicitor.

**Particulars of Breaches.—Where two or more types of
Infringement complained of.**

FORM 2.

[Formal parts as above.]

1. The defendant, between the days of and or thereabouts, manufactured at his factory at , in the county of , sewing machines, which sewing machines contained shuttles which are infringements of the third claiming clause of the complete specification of the plaintiff's patent.

The defendant, on or about the day of , at his shop at , in the county of , sold a sewing machine which contained such a shuttle to .

The plaintiff will rely upon this machine as an instance of this type of infringement committed by the defendant.

2. The defendant, on or about the day of , in his workshop at , in the county of , by himself, his servants or agents, manufactured sewing machines, which sewing machines contain parts for bobbin-winding which are an infringement of the fifth claiming clause of the complete specification of the plaintiff's patent.

The defendant, on or about the day of , at his shop at , sold a sewing machine, which contained a bobbin-winding apparatus, to .

The plaintiff will rely upon this machine as an instance of this type of infringement committed by the defendant.

Defence and Counterclaim.

*[N.B.—One set of Particulars of Objections will serve Defence
and Counterclaim.]*

In the High Court of Justice,
Chancery Division.

Mr. Justice

Between A. B. Plaintiff,

and

C. D. Defendant.

1. The defendant denies that the plaintiff is the legal owner of the letters patent sued on.

2. If the defendant has manufactured (sold *or* used) the articles (or process) as alleged in the particulars of breaches, the same were manufactured (sold *or* used) by leave and licence of the patentee under the following circumstances:—(*set forth particulars*).

3. The defendant has not infringed the said letters patent as alleged, or at all.

4. The said letters patent are invalid for the reasons appearing in the particulars of objections delivered herewith.

5. At the date of the said letters patent the apparatus made by the defendant and complained of in this action was not novel (*f*).

6. The defendant will rely as a defence upon the fact that in a contract dated the day of and made between the patentee of the one part and of the other part, which contract was in force when this action was commenced, there existed the following conditions, which have been rendered void by the Statute 7 Ed. VII. c. 29, p. 38 (*g*):—

(*Set forth the objectionable clauses.*)

7. As an answer to the plaintiff's claim for damages, the defendant will rely upon the fact that at the date of the alleged infringement, he was not aware nor had he reasonable means of making himself aware of the existence of the plaintiff's letters patent.

Counterclaim.

The defendant repeats paragraph 4 of his defence and counterclaims for revocation of the plaintiff's letters patent.

The defendant is entitled to counterclaim for revocation by reason that:—

(a) The defendant is duly authorised by His Majesty's Attorney-General for England.

(b) The letters patent sued on were obtained in fraud of the defendant's rights (or in fraud of the rights of X. through whom the defendant claims). Particulars of the said fraud are as follows:—(*set them forth*).

(c) The defendant (or X., through whom the defendant claims an interest in the business of carried on at) had prior to the date of the said letters patent publicly manufactured (sold *or* used) the articles as claimed in the

(*f*) See p. 119.

(*g*) See p. 331.

claiming clauses (No.) of the specification of the said letters patent, as set forth in paragraph of the particulars of objections delivered herewith.

— — —

**Particulars of Objections in an Action for Infringement
or Petition for Revocation.**

In the High Court of Justice,
Chancery Division.

Mr. Justice

Between A. B. Plaintiff,
and

C. D. Defendant.

(Or Title of Petition.)

Take notice, that the defendant (*or* petitioner) will, on the trial of this cause, rely on the following objections to the validity of the letters patent sued upon:—

1. The said (*name the original patentee*) was not the true and first inventor of the alleged invention. The true and first inventor thereof was J. S. of .

2. The said alleged invention was not new at the date of the said letters patent. It had been published:—

(a) By the public manufacture (*sale or use*) of (*articles*) constructed in accordance with the said invention from the year to the present day at by the defendant (*or some other, naming him*) of . Articles so manufactured are now in existence and may be inspected by the plaintiff at .

(b) By the public manufacture (*sale or use*) of (*articles*) constructed in accordance with the said invention from the year to the at by J. S. of . The said articles are no longer in existence. A description and drawings of the said articles are delivered with these particulars.

(c) By the public manufacture (*sale or use*) of (*product*) by means of the patented process at by of from the year until the year . A description of the said process and drawings of the apparatus used accompanies these particulars. The process is no longer in use, but the apparatus is in the possession of . The defendant will endeavour to obtain inspection of the apparatus by the plaintiff.

(d) By the deposit in the Patent Office Library of the follow-

ing specification of letters patent granted in foreign countries :—

Name.	Date and Number.	Country.	Claims of plaintiffs' specification against which relied on.
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(e) By the publication of the following specifications of British letters patent.

Name.	Date and Number.	Parts relied on.	Claims of plaintiffs' specification against which relied on.
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(f) By the deposit in the Library of the British Museum in the year of a work bearing the title " " by and in particular by the passage commencing at p. l. and ending at p. l. .

3. The said alleged invention was not proper subject-matter for letters patent having regard to the common general knowledge at the date thereof. The defendant will rely upon the specifications set forth under paragraph 2 hereof as part of the common general knowledge of the art.

4. The said alleged invention was not useful.

5. The specification is insufficient to enable the invention properly to be carried into effect. The plaintiffs will rely upon the passage p. l. to p. l. , wherein no sufficient directions are given for (*state particulars of insufficiency*).

6. The specification gives directions which are misleading and dangerous. If the directions on p. , l. to p. , l. are carried out an explosion is liable to occur (*or other reasons*).

7. The claims of the said specification (and claim—in particular) do not sufficiently define the monopoly which the patentee intends to claim.

8. The subject-matter of the said letters patent was the subject-matter of a prior grant of letters patent to J. S., dated and numbered which letters patent were and are good and valid

Order for Further and Better Particulars of Objections.

Let the defendants on or before the day of deliver to the plaintiffs further and better particulars of the matters alleged in paragraph of the particulars of objections giving :—

(a) A description, accompanied by drawings, of the prior user alleged.

(b) The names and addresses of the persons by whom the articles mentioned are alleged to have been manufactured.

(c) The claims against which each of the prior publications alleged.

(d) The pages of the prior publications relied on.

And in default of the delivery of such particulars let the said paragraph be struck out.

**Order for Liberty to amend Particulars of Objections by
adding Fresh Objections upon Terms.**

Let the plaintiff, within six weeks from the date of this order, elect whether he will discontinue this suit, and if the plaintiff shall elect to discontinue this suit, and shall give notice thereof to the defendants within six weeks from the date of this order, refer it to the taxing master to tax the defendants their costs up to and including the 23rd February, 1875 (*delivery of the original particulars of objection*), and to tax the plaintiff's cost of this suit subsequently to the said 23rd February, 1875, to the date of this order, and the taxing master is to set off the costs of the plaintiff and of the defendants to be so respectively taxed, and certify to which of them the balance after such set-off is due, and let such balance be paid by the party from whom, to the party to whom the same shall be certified to be due. And if the plaintiff shall not give notice to the defendants of his discontinuance of this suit within the time aforesaid let the defendants be at liberty to add to the particulars of objections to the validity of the plaintiff's letters patent, &c., which have been already delivered by the defendants, the following further objections to be relied on by the defendants at the hearing of this cause, viz. (*particulars of new objections proposed to be introduced by amendment*). And let defendants, Moules, &c. Co., pay to the plaintiff, A. F. Baird, his costs of this application to be taxed, &c., liberty to apply (*h*).

**Notice of Motion for Leave to amend Specification where
Action for Infringement, or Petition for Revocation
Pending.**

In the High Court of Justice,
Chancery Division.

Mr. Justice

(*Title of action or petition.*)

Take notice that this Honourable Court will be moved on
at o'clock or soon thereafter as counsel can be heard, by

(*h*) See *Baird v. Moules, &c., Co.*, L. R. 17 Ch. D. 139, n.

counsel on behalf of the plaintiff (*or* respondent) that the plaintiff (*or* respondent) be granted leave to amend the complete specification upon which his letters patent No. of were granted, by (*state nature of amendment*) as indicated in red ink in the King's Printer's copy of the specification delivered herewith.

Order allowing Application to amend to Proceed.

This motion coming before the Court on the day of and upon hearing counsel for the plaintiff (*or* respondent) and counsel for the defendant (*or* petitioner), and upon reading the copy of the specification with the proposed amendments indicated thereon the Court doth order that the application of the plaintiff (*or* respondent) be allowed to proceed and that this motion shall stand for hearing in the non-witness (witness) list on the day of (*fix date late enough to allow of applicant fulfilling requirements of Ord. LIIIA., r. 23*), and the plaintiff (*or* respondent) shall within days deliver to the defendant (*or* petitioner) copies of the affidavits in support of his application; and the defendant (*or* petitioner) shall within days of such delivery deliver to the plaintiff (*or* respondent) copies of his affidavits in answer; and in the event of any third party giving notice of opposition to the amendment in accordance with the Statute and Rules in that behalf made and provided the plaintiff (*or* respondent) shall within days of receipt of such notice deliver to such person copies of the affidavits in support of his application, and such person shall within days of such delivery deliver to the plaintiff (*or* respondent) and to the defendants (*or* petitioners) copies of his affidavits in opposition, and within days of such delivery the plaintiff (*or* respondent) shall deliver to such person copies of his affidavits in reply to the opposition.

And the costs of this motion up to and including this order shall be the defendant's (*or* respondent's) costs in the cause (*or as directed*).

Final Order allowing Amendment of the Specification on Terms.

This motion coming on for final hearing in the non-witness list on the day of and upon hearing counsel on behalf of the plaintiff (*or* respondent), counsel on behalf of the defendant (*or* petitioner), and counsel on behalf of A. B. an opponent to the opposition, and counsel on behalf of C. D. an opponent and counsel on behalf of the Comptroller-General of Patents and upon reading

the specification and proposed amendments and the pleadings and particulars in the action (*or* petition) of and the affidavits of P., Q., S., T., and R., and upon the plaintiffs (*or* respondents) undertaking to seek no relief from the defendants (*or* petitioners) or from purchasers from them in respect of anything done prior to the date of the notice of motion on this application the Court doth Order that the said specification be amended by (*state amendment*); and it is Ordered that the plaintiffs (*or* respondents) pay to the defendants (*or* petitioners) and the Comptroller-General their costs of this application, and that the opponents A. B. and C. D. (*costs as directed*). And it is Ordered that the defendant may within days amend his defence and particulars of objections (and the petitioner shall within days hereof elect whether he shall withdraw his petition and in the event of such withdrawal the respondent shall pay to the petitioner his costs of the petition up to the date of such withdrawal *or as directed*).

Minutes of Judgment for Plaintiff in Default of Defence, Order for Inquiry as to Damages, Injunction and Costs.

Let the defendants, Robert F. Chisholm and Joseph Lawrence, trading as R. F. Chisholm and Co., their servants and agents, be restrained during the continuance of the letters patent, No. 14,563 of 1890, and any extension thereof, from infringing the said letters patent, of which the plaintiff company are owners. Let an inquiry be made as to the damages sustained by the plaintiff company by reason of the infringement of the said letters patent by the defendants. Order payment by the defendants of the amount awarded within fourteen days after such amount has been ascertained. Let the defendants deliver up to the plaintiffs all tyres and parts of tyres in their possession or power made in infringement of the said letters patent. Let it be referred to the taxing master to tax the plaintiffs' costs of this action up to and including this judgment as between solicitor and client. Let the costs of the inquiry as to damages be reserved. Liberty to apply (*i*).

(i) *Pneumatic Tyre Co. v. Chisholm*, 13 R. P. C. at p. 489.

Final Judgment—Recital of Evidence—Injunction—Inquiry as to Damages—Order for Destruction—Costs as between Solicitor and Client—Liberty to apply.

The following Order was settled by the late Master of the Rolls, Sir George Jessel, personally, in the case of Plimpton v. Spiller, reported L. R. 6 Ch. D. 412.

In the High Court of Justice, 1876 P. 69.
Chancery Division.

Thursday the 19th day of April, 1877.

Master of the Rolls.

Mr. Clowes, Reg.

Between J. L. P. Plaintiff,

and

A. F. S. and T. C. Defendants.

This action, coming on for trial the 11th and 12th days of April, 1877, and this day before this Court, in the presence of counsel for the plaintiff and the defendants, upon hearing an order, dated the 4th of August, 1876, an affidavit of A. F. S. filed the 15th March, 1876; an affidavit of J. I., filed the 16th February, 1877, the bill, Evidence. answers, orders, records for trial, and the certificate of the Master Certificate. of the Rolls, the judge before whom the questions of fact were tried, that the validity of the letters patent of the 25th day of August, 1865, granted to A. V. N., and numbered 2190 hereinafter mentioned, came in question in the cause of P. v. M., 1875, P. 39, and upon hearing the said letters patent, and a certified printed copy of the specifications and drawings, filed under the said letters patent, and the indenture of assignment, dated the 10th day of January, 1866, and made between the said A. V. N., therein described, of the one part, and the plaintiff, J. L. P., of the other part, and registered in the Great Seal Patent Office on the day of the date thereof, the printed shorthand note of the evidence taken orally before this Court on the trial of the said action of P. v. M., 1875, P. 39; of A. V. N., F. J. B., J. I., J. L. P., E. A. C., R. C. M., W. W. H. and E. J. C. W. and the exhibits marked 1, 2, and 4, then produced; the examination of H. J. A., W. B. P., W. G. A., A. F. S., J. I., T. M. W., G. B., C. P. B. S., E. E., W. S. M. and H. L., taken orally before this Court, on the 11th, 12th, and 19th days of April, 1877, and the exhibits marked: 1. 2. 4. A. B. C. D. E. F. G. H. I. L. M. N. O. P. E. E. 2. S. 1. S. 2. E. E. 1. E. E. 3. W. S. M. 1. W. 1. and W. 2. and the two catalogues and donation book produced to W. G. A., and the volume of the year 1863, of Jewitt's Book of Illustrations to the Report of the American Commissioners of Patent, and the "Scientific American" for the years

1863 and 1865; the records from the Court of Bankruptcy of an assignment, dated the 11th August, 1865, by W. S. M., for the benefit of his creditors, and of a composition deed by the said W. S. M., in the year 1869, and what was alleged by counsel on both sides, and this Court being of opinion that the plaintiff has proved the breaches complained of, in the particulars of breaches delivered by him in this action, doth order that an injunction be awarded to restrain the defendants, their servants, agents, and workmen during the continuance of the letters patent, granted to A. V. N., dated the 25th day of August, 1865, and numbered 2190, and any extension of the term thereof, from using, or exercising, or causing or permitting to be used or exercised, the invention described in the hereinbefore mentioned specification and drawings, filed under the said letters patent, and from selling, letting for hire, or making any profitable use, or permitting the sale, letting for hire, or profitable use of any roller or runner skates not made by the plaintiff, or his licensees, and having applied thereto rollers or runners in manner described and for the purposes mentioned in the said specification, or fitted with any apparatus for causing the skate to run in a curved line, in the manner described in the said specifications and drawings, or differing therefrom only colourably, and by the substitution of mere mechanical equivalents, and it is ordered that it be referred to the official referee in rotation, to inquire what sum of money is fit to be awarded to the plaintiff, to be paid by the defendants in respect of any damage sustained by the plaintiff up to the day of the date of this order, from the manufacture, sale, or letting for hire of skates, being the same as the "Spiller" Skates, and "Wilson" Skates, in the pleadings in this action, and in the said order dated the 4th August, 1876, mentioned, or of any other skates made in infringement of the said letters patent, or otherwise from the sale, or use by the defendants of the said invention, or any apparatus in imitation of, or being only a colourable deviation from the said invention. And it is ordered that the defendants, A. F. S. and T. C., do pay to the plaintiff, J. L. P., such sum of money as upon such inquiry shall be found fit, to be awarded to the plaintiff for such compensation as aforesaid, within twenty-one days after service of the official referee's report of the result of the said inquiry. And it is ordered, that the defendants, A. F. S. and T. C., do deliver up on oath to the plaintiff, or break up, or otherwise render unfit for use, all roller skates, or parts of roller skates so manufactured, or let for hire by, or by the order, or for the use of the defendants in infringement of the said letters patent as aforesaid, which are in the possession, custody, or power

Payment of amount.

Destruction.

of the defendants, do either of them, or their, or either of their, servants or agents. And it is ordered, that the said defendants, **Full costs.** A. F. S. and T. C. do pay to the plaintiff, J. L. P., his full costs, to be taxed by the taxing master as between solicitor and client, including all costs, charges, and expenses. And any of the parties **Liberty to apply.** are to be at liberty to apply, as they may be advised.

W. C.

Entered.

G. L.

Registrar's Office, Entering Lib. B. Seal.

Certificates necessary under Order LIIIa., Rule 22.

[Form of judgment for perpetual injunction, accounts of profits and damages as above.]

It is certified that the plaintiff has proved to the satisfaction of the Court the breaches mentioned in the particulars of breaches delivered by him, and numbered respectively 1, 2, 3, 4, and 5, and that the particulars numbered 6 and 7 were, in the circumstances of the case, reasonable and proper.

[Form of judgment for defendant as above.]

It is certified that the defendant has proved to the satisfaction of the Court the objections mentioned in the particulars of objections delivered by him, and numbered respectively 1, 2, 3, 4, and 5, and that the objections numbered 6 and 7 were, in the circumstances, reasonable and proper.

Certificate of Validity under Sect. 35 of the Patents and Designs Act, 1907.

I hereby certify, pursuant to the 35th section of the Patents and Designs Act, 1907, that upon the trial of this action, the validity of the letters patent (*or* that the validity of Claim 3 of the specification of the letters patent) in the pleadings mentioned, dated the day of , and numbered , granted to , (amended by disclaimer allowed the day of ,) and now vested in , came into question.

Dated this day of .

Signature of Judge .

FORMS IN AN ACTION TO RESTRAIN THREATS.

Indorsement on Writ.

The plaintiff's claim is:—

Injunction.

1. For an injunction restraining the defendant from, by circulars, advertisements, or otherwise, threatening with legal proceedings or liability persons manufacturing, using, or selling stoves invented by the plaintiff, alleging the same to be infringements of letters patent in which the defendant claims an interest. The said threats being to the prejudice of the plaintiff.

Damages.

2. For damages in respect of the injury sustained by the plaintiff by reason of the circulars, advertisements, or other threats of the defendant.

Interlocutory Injunction to restrain Threats.

A particular circular.

Upon motion, &c., let an injunction be granted to restrain the defendant personally, or by his servants, agents, and workmen, by circulars, letters, or otherwise, from threatening any person with legal proceedings or liability in respect of the manufacture, use, sale, or purchase of a certain tap union of which the plaintiff was the patentee, and from interfering by such threats or otherwise with the manufacture, use, sale, or purchase of the plaintiff's invention (*j*).

[*Another Form.*]

Upon motion, &c., let an injunction be granted to restrain the defendant personally or by his servants, agents, and workmen, until further order, from issuing the circular dated 15th December, 1888, and from, by means of circulars, letters, or otherwise, threatening any person with proceedings or liability in respect of the following papers manufactured by the plaintiff (*k*).

Form of Injunction.

This Court does order and adjudge that the defendants *Parker and Smith*, their agents, travellers, and servants, be perpetually restrained from threatening the plaintiff or his customers with legal proceedings for the alleged infringement by him or them of the defendants' letters patent No. , of , by reason of the manufacture, sale, or use, of the plaintiff's hair-binder, known as

(*j*) *Challender v. Royle*, L. R. 36
Ch. D. 425.

(*k*) *Colley v. Hart*, 6 R. P. C. 17.

the " Peigne Attache " or " Simple Attache " hair-binder (being the exhibit V. M. 1 produced to the plaintiff at the trial), and from circulating, by letters, advertisements, or other means any statements to the effect that the plaintiff's said hair-binder is made in infringement of the defendants' said letters patent (1).

FORMS IN A PETITION TO THE HIGH COURT FOR REVOCATION.

Petition of Revocation.

In the High Court of Justice,
Chancery Division,

In the matter of letters patent granted to _____ of _____, dated _____, and numbered _____, and in the matter of the Patents and Designs Act, 1907, sect. 25.

To his Majesty's High Court of Justice.

The humble petition of
SHEWETH as follows:—

1. Your petitioner is duly authorised by his Majesty's Attorney-General in England to present this petition (*if so, if not, your petitioner claims to be entitled to present this petition by reason of the matters appearing hereafter in paragraphs 7 or 8, which set forth the circumstances*).

2. Your petitioner is a manufacturer of cigar cases, and has gained a high reputation in the trade and with the public for his goods. Your petitioner has recently commenced to manufacture and has entered into contracts with retailers to supply to them quantities of cigar cases made with spring clips to hold each cigar in place.

3. The respondent is a manufacturer of cigar cases who carries on his manufacture at _____, in Belgium, and thence imports large numbers of cigar cases to his place of business at _____, Fleet Street, London.

4. The respondent claims to have a monopoly in the right to manufacture and sell cigar cases with spring clips of whatever construction, and bases his claim upon letters patent granted to him on the _____ day of _____, and numbered _____, of _____.

5. The said letters patent are wholly invalid by reason of the matters set forth in the particulars of objections accompanying this petition.

6. By reason of the wide and comprehensive claims made in the

(1) *Mountain v. Parker and Smith*, 20 R. P. C. at p. 774.

specification, the retailers are afraid to purchase the goods manufactured by your petitioner and some have asked to be released from their contracts.

7. The said letters patent were obtained in fraud of the rights of your petitioner:—On the day of your petitioner purchased from J. S. his goodwill and business of manufacturing cigar cases, together with the right to join with him in applying for letters patent for an invention which was the same as the invention subsequently patented by the respondent. The respondent was at the time an employee of the said J. S. and applied for and obtained the said grant of letters patent without the consent of the said J. S. or of your petitioner (*or other allegations of fraud*).

8. Prior to the date of the said letters patent your petitioner had publicly manufactured and sold articles constructed according to the alleged invention subsequently patented by the respondent (as set forth in the particulars of objections accompanying this petition).

The form of Particulars of Objections is similar to that used in an action for infringement.

FORMS USED IN OBTAINING THE FIAT OF THE ATTORNEY-GENERAL.

The Memorial of the Petitioner (*m*).

In the matter of the Patents and Designs Act, 1907,

and

In the matter of letters patent granted to A. B. for an
invention entitled No. of .

(Set forth in numbered paragraphs all the matters alleged in the petition, amplifying them in detail. It is desirable that a bonâ fide statement should be made as to the state of affairs, and the memorial is not to be treated as in the nature of a mere pleading. Set forth also matters of this kind.)

1. On the day of , the said (*naming the respondent*) commenced an action for infringement of the said letters patent against your memorialist, and on the day of , Mr. Justice gave judgment pronouncing the said letters patent invalid, but holding that had they been valid the articles manufactured by your memorialist would have infringed them.

(*m*) On Judicature paper.

2. Your memorialist is the grantee of letters patent No. _____ of Grantee of letters patent. _____, for an invention entitled _____, the infringement alleged in the hereinbefore-mentioned action (which was admitted) consisted in manufacturing cigar cases in accordance with the specification of the said letters patent of _____, and it is impossible to use your memorialist's said invention of _____ without infringing the said letters patent of (*naming the respondent*), assuming the said letters patent to be valid.

3. Your memorialist is seriously hampered in his trade by reason that no persons who are estopped as aforesaid from denying the validity of the said letters patent, by reason of licences granted to them by the said (*respondent*), can purchase from your memorialist cigar cases made in pursuance of his said letters patent of _____ . Hampered in trade.

4. The following documents are sent herewith :—

Documents.

The specification of A. B. No. _____ of 19 ____ .

C. D. No. _____ of 19 ____ .

E. F. No. _____ of 19 ____ .

Copy writ, pleadings, and objections in the action.

Copy judgment of Mr. Justice _____, dated _____ .

5. Your memorialist humbly requests you will authorise him to Application. petition the Court for revocation of the said letters patent of (*the respondent*) of _____ .

Declaration of Applicant verifying Statements in his Memorial to his Majesty's Attorney-General (n).

In the matter of the Patents and Designs Act, 1907,

and

In the matter of letters patent granted to _____ for an invention entitled _____ No. _____, dated _____ .

I _____, of _____, do solemnly and sincerely declare as follows :—

That the several statements contained in the paper writing now produced and shown to me and marked A., purporting to be a memorial addressed by myself to his Majesty's Attorney-General of England (*or* Ireland, *or* Lord Advocate of Scotland), are true as therein set forth.

That the questions proposed to be raised by the petition and particulars of objections upon which revocation of the said letters patent is sought, are not and cannot be raised in any legal proceedings now pending in the United Kingdom.

And I make this solemn declaration conscientiously believing

(n) On Judicature paper.

the same to be true and by virtue of the provisions of the Statutory Declarations Act, 1835.

Declared at .

Certificate of Solicitor (o).

In the matter of the Patents and Designs Act, 1907,
and

In the matter of letters patent granted to for an invention
entitled No. , dated .

Between A. B. Petitioner,

and

C. D. Respondent.

I, of , solicitor for the above-named petitioner, do hereby certify that the said petitioner is a fit and proper person to be a petitioner in this matter, and that he is competent to answer the costs of all proceedings in connection with the said petition.

**FORMS IN PETITION FOR EXTENSION OF TERM
OF PATENT**

(SEE ORD. LIIIA., R. 3).

Advertisement of Intention to present Petition.

In the High Court of Justice,
Chancery Division.

Mr. Justice Sargant.

In the matter of the Patents and Designs Act, 1907,
and

In the matter of letters patent granted to , of , and
bearing date the of , and numbered .

Notice is hereby given that it is the intention of to present a petition to the High Court of Justice praying that the term of the said letters patent may be extended. And notice is further given that on the day of at , or so soon thereafter as counsel may be heard, the said intends to apply to the Court for a day to be fixed before which the petition shall not be in the paper for hearing. Notices of objection must be lodged before the date above mentioned at the chambers of Mr. Justice Sargant, Room No. . Documents requiring service upon the said

(o) On foolscap.

pursuant to the Rules of the Supreme Court, Order LIIIA., rule 3,
may be served at the office of the solicitor to the said

Dated this day of

Solicitor to the said

Address for service

—
Petition.

In the High Court of Justice,
Chancery Division.

Mr. Justice Sargant.

In the matter of the Patents and Designs Act, 1907,
and

In the matter of letters patent dated the day of ,
numbered and granted to A. B., of , for the invention
of “ ”

To his Majesty's High Court of Justice.

The humble petition of A. B., of , and of C. D. of ,
SHEWETH as follows:—

1. On the day of letters patent numbered , were
granted to your petitioner A. B., for an invention entitled

2. Your petitioner C. D. has become entitled to a half share in
the said letters patent under the circumstances hereinafter
appearing.

SET FORTH (a) *The history of the Art with special reference to the
invention.*

(b) *The special utility and advantages of the invention.*

(c) *The circumstances under which the patent was
obtained and the rights of C. D. created.*

(d) *All information relating to foreign patents.*

(e) *The rights of third parties, such as licensees, etc.*

(f) *The difficulties with which the patentee has had to
contend in getting his invention taken up.*

(g) *The fact of insufficient remuneration, generally
stated without special reference to accounts.*

Your petitioners have given public notice by advertisement caused
to be inserted in the “London Gazette” and in metropolitan and
provincial newspapers pursuant to the rules in such cases made and
provided, that it is their intention to apply to this Honourable Court
for an extension of the term of the said letters patent.

Your petitioners therefore humbly pray that the said letters patent
may be extended for a further term of fourteen years, or for such
other term as to this Honourable Court shall seem fit.

And your petitioners will ever pray, &c.

Affidavit as to Advertisements.

[Heading as above.]

I, of , solicitor, make oath and say as follows :—

1. I am acting as solicitor for the petitioners A. B. and C. D. in the petition for extension of the above-mentioned letters patent.

2. Pursuant to the directions given by the Honourable Mr. Justice Sargant, I caused the advertisement of which a copy is contained in the Schedule hereto to be inserted in the issues of the "London Gazette" of [date] and in the issues of [name papers and give dates]. Copies of the issues of the said newspapers containing the said advertisements are now produced to me and marked respectively.

The Schedule above referred to
(Set forth copy of advertisement.)

Notice of Opposition to Petition.

[Heading as above.]

Notice is hereby given that J. K. and Co., Ltd., of , intend to oppose the petition for extension of the term of the above-mentioned letters patent presented on the day of and returnable on the day of , and require due notice of all proceedings in reference to the above-mentioned letters patent.

Dated this day of .

(Signed.)

Solicitors for and on behalf of J. K. and Co., Ltd., aforesaid.

Notice of Grounds of Objection.

[Heading as above.]

Notice is hereby given of the several grounds of the objection of J. K. and Co., Ltd., of to the granting of the prayer of the said petition, that is to say :—

Patent held
invalid in a
court of law.

1. The said letters patent are null and void, and a judgment was given against the validity of the said letters patent in a certain cause in the Court of , wherein the petitioner was plaintiff and defendant.

Patent
revoked.

2. The said letters patent were revoked by the judgment of the Court of , in a petition for revocation presented by .

Want of
novelty.

3. The alleged invention was not new at the date of the said letters patent. The opponent will refer to the following publications in support of this contention [set them forth].

4. The alleged invention is of no use to the public, or not of so much public utility as to be a sufficient consideration for any prolongation of the term granted by the said letters patent. **Want of utility.**

5. The said petitioner does not possess sufficient merit to entitle him to a prolongation of the term granted by the said letters patent. **Denial of merit.**

6. The said petitioner is not entitled to (the whole of) the privilege granted by the said letters patent (by assignment or otherwise). **Title of petitioner.**

7. The petitioner has been sufficiently remunerated and rewarded for all his expenses, labour, and ingenuity respecting the said invention. **Remuneration.**

8. If the petitioner has failed to obtain a sufficient amount of remuneration or reward he has only failed to do so in consequence of his own gross negligence. **Negligence of petitioner.**

9. The petitioner has permitted infringements of the said letters patent, and has not taken any proceedings to restrain such infringements. **Negligence in restraining infringements.**

10. The allegations contained in the said petition are not true in substance or in fact. **Denial of statements in petition.**

Dated the day of

(Signed.)

Solicitors for said J. K. and Co., Ltd.

SOME HINTS FOR DRAFTING ASSIGNMENTS AND LICENCES.

(1) Assignment.

Recitals.

1. Act of Assignment.
2. Consideration :—
 - (a) Cash payment or cash and shares.
 - (b) Annual fixed royalty, so long as patent is not revoked or declared invalid) (*coupled with covenant numbered 16*).
 - (c) Royalty upon each article made (and sold) by the assignee or his licensees so long as patent is not revoked or declared invalid (*coupled with covenant numbered 16*).
 - (d) Provision for minimum royalty per annum, to cease if patent revoked or declared invalid.
 - (e) Any other consideration agreed upon between the parties.

Covenants.

3. Covenant by assignor as to validity (*very onerous and seldom inserted*).
4. Covenant that assignor has done no act or thing or omitted to do any act or thing which might be held to be an abuse of monopoly rights under sect. 27 of the Acts of 1907 and 1919, nor done any act prior to the date of the patent which might render the patent liable to revocation under sect. 25.
5. Covenant by assignor that no "hostile person" as defined in the Order made by the Board of Trade dated 30th October, 1918, had at any time since the 4th August, 1914, any interest, share or right whatsoever in the letters patent.
6. Covenant by assignor to assign future improvements. ("*Improvements*" should be defined,—*the following alternative definitions are suggested*: "Improvements shall mean any manufacture, the use of which if by persons other than the owner of the letters patent hereby assigned, or their licensees, would involve an infringement of the said letters patent," or "Improvements shall mean any invention which if used with the patented invention assigned would make it cheaper or more effective or in any way preferable," or "Improvements shall mean any invention which relates to the art to which the assigned invention relates.")
7. Covenant by assignor to instruct assignee or his servants in the

manufacture, with such provisions for remuneration, &c., as may be agreed.

8. Covenant by assignee to keep accounts and permit inspection of books (*not necessary when the consideration is a fixed sum*).

9. Covenant by assignee to pay the consideration punctually (*onerous*).

10. Covenant by assignee to pay renewal fees and not to do or omit to do any act or thing which might be held to be an abuse of monopoly rights under sect. 27 of the Acts of 1907 and 1919. (*This is necessary only when the assignor retains an interest by way of royalties or otherwise.*)

11. Covenant by assignee not to amend the specification without the consent of the assignor, such consent not to be withheld unreasonably. (*This may be necessary where the assignor retains an interest by way of royalties, or otherwise, which ceases on the patent being declared void. The assignee might amend the specification and thereby render the patent void, and on the other hand it may be necessary to amend to preserve the validity.*)

12. Covenant by assignee not to re-assign without the consent of the assignor.

13. Covenant by assignee to do his best to push the invention and to supply the public to the extent of the demand. (*This is often necessary when the assignor is paid by royalties, and the assignee carries on a rival process or manufacture and acquires the patent merely to maintain a monopoly and prevent competition.*)

14. Covenant by assignee that he will not by exporting to foreign countries, where foreign patents exist for the same invention, infringe such foreign patents or imperil their validity.

15. Covenant by assignor that in dealing with foreign patents he will make provision for the prevention of importation into this country, and for the protection of the assignee.

16. Covenant by assignee that he will sue infringers and that he will defend the validity and existence of the patent, and that he will use his best endeavours in all courts and at all times to maintain its validity and existence for the full term for which it was granted. (*Necessary when the consideration is a reserved royalty with or without a provision for a minimum.*)

Agreement for a General Licence (*not usually under seal*).

(1) Grant of licence for term of patent or less.

(2) Alternative considerations :—

(a) A cash payment—cash or shares.

- (b) An annual fixed royalty, so long as patent is not revoked or declared invalid.
- (c) Royalty upon each article made and sold so long as patent is not revoked or declared invalid.
- (d) Provision for minimum royalty.
- (e) Any other consideration agreed upon between the parties.
- (3) Warranty of validity by grantor (*should not be inserted save in extraordinary circumstances*). Alternatively recite that grantor has done nothing and knows of nothing which would render the patent invalid.
- (4) Warranty by the licensor that no "hostile person" as defined in the Order made by the Board of Trade dated 30th October, 1918, had at any time since the 4th August, 1914, any interest, share or right whatsoever in the letters patent.
- (5) Agreement by grantor to communicate all "improvements" (*see clause 6 of "assignment" (ante)*), whether patented or not, which he may make or which shall come into his possession, and that the licensee shall have the full use of such improvement during the term of the licence, with or without further payment, as may be agreed, *or* the obligation to communicate improvements may be mutual and may extend to all other licensees under the letters patent.
- (6) Agreement by grantor to instruct licensee and his servants in the manufacture with such provision for remuneration as may be agreed.
- (7) Provision for keeping accounts, inspection of books and payment of royalties.
- (8) Agreement by grantor to pay renewal fees.
- (9) Agreement by licensee not to export, and in so far as he is able, to prevent exportation of the patented article to foreign countries where patents exist for the same article.
- (10) Agreement by the licensee to mark all articles sold with the number of the patent.
- (11) Conditions as to selling prices, &c., with a declaration that any breach of these conditions will constitute infringement. (*But beware of making terms which might bring into operation section 38.*)
- Agreement by grantor that in granting future licences he will bind the future licensees by a similar clause.
- (12) Agreement by the licensor to lend his name for the purpose of proceeding against infringers, on being properly secured by the licensees against liability for costs.

Exclusive Licence (*may be under seal or not*).

- (1) Grant of exclusive licence for term of patent or less (with or without power to sub-licence).
 - (2) Alternative considerations :—
 - (a) A cash payment, cash or shares.
 - (b) An annual fixed royalty so long as patent is not revoked or declared invalid.
 - (c) Royalty upon each article made (and sold) so long as patent is not revoked or declared invalid.
 - (d) Minimum annual royalty, to cease if patent revoked or declared invalid, or if minimum not paid, licence to become general only.
 - (e) Any other consideration agreed upon.
 - (3), (4), (5), (6), (7), (8), (9), (10), and (11) *As in general licence.*
 - (12) Agreement by licensee not to do or omit to do any act or thing which might be held to be an abuse of monopoly rights under sect. 27 of the Acts of 1907 and 1919.
 - (13) Agreement by licensor, that in dealing with foreign patents he will make provision for the prevention of importation into this country, and for the protection of the licensee.
 - (14) Agreement by licensee not to export or permit exportation of the patented article to countries or colonies where patents exist for the same invention.
 - (15) Agreement by the licensor not to amend the specification of the invention without the consent of the licensee, such consent not to be unreasonably withheld.
 - (16) Agreement by the licensor to lend his name for the purpose of proceeding against infringers, on being properly secured by the licensees against liability for costs.
 - (17) Agreement by the licensees to finance and carry on proceedings against infringers and to defend proceedings directed against the validity or existence of the patent.
-

INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

Signed at Washington, June 2, 1911.

[British Ratification deposited at Washington, April 1, 1913.]

(Translation.)

Union Convention of Paris of March 20, 1883, for the Protection of Industrial Property, revised at Brussels on December 14, 1900, and at Washington on June 2, 1911.

(Between the United Kingdom, Germany, Austria, Hungary, Belgium, Brazil, Cuba, Denmark, Dominica, Spain, the United States, France, Italy, Japan, Mexico, Norway, the Netherlands, Portugal, Sweden, Switzerland, and Tunis (see Treaty Series, 1913, No. 8), and New Zealand and Czecho-Slovakia have since adhered to the Convention.)

ARTICLE 1.

The contracting countries constitute themselves into a Union for the protection of industrial property.

By a final Protocol it was agreed that—

The words "industrial property" are to be taken in their broadest sense; they extend to all productions of the agricultural industries (wines, corn, fruits, cattle, &c.) and of the mining industries (minerals, mineral waters, &c.).

ARTICLE 2.

The subjects or citizens of each of the contracting countries shall in all the other countries of the Union, as regards patents, utility models, industrial designs or models, trade-marks and trade names, indications of origin, and the suppression of unfair competition, enjoy the advantages that their respective laws now grant, or may 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 conditions and formalities imposed on native subjects or citizens. No obligation as to the possession of a domicile or establishment in the country where protection is claimed shall be imposed on those who enjoy the benefits of the Union.

By a final Protocol it was agreed that—

(a) Under the word "patents" are comprised the various kinds of industrial patents recognised by the legislation of each of the contracting countries, such as importation patents, improvement patents, &c., whether for processes or for products.

(b) It is understood that the provision of article 2, which exempts the subjects or citizens of the Union countries from the obligation as to the possession of a domicile and establishment, is of the nature of an interpretation, and is consequently to apply to all rights resulting from the Convention of the 20th March, 1883, before the present Act comes into operation.

(c) It is understood that the provisions of article 2 do not affect the legislation of each of the contracting countries as regards the procedure to be followed before the tribunals and the competence of those tribunals, nor as regards the election of domicile or appointment of an authorised agent which may be laid down in laws as to patents, utility models, trade-marks, &c.

ARTICLE 3.

Subjects or citizens of countries not forming part of the Union, who are domiciled or who have real and effective industrial or commercial establishments in the territory of any of the countries of the Union, shall be assimilated to the subjects or citizens of the contracting countries.

ARTICLE 4.

(a) Any person who has duly applied for a patent, the registration of a utility model, industrial design or model, or trade-mark, in one of the contracting countries, or his legal representative or assignee, shall enjoy, for the purposes of registration in other countries, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

(b) Consequently, subsequent registration in any of the other countries of the Union before the expiration 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.

(c) The above-mentioned periods of priority shall be twelve months for patents and utility models, and four months for industrial designs and models and trade-marks.

(d) Any person desiring to take advantage of the priority of a previous application must make a declaration giving particulars as to the date of such application and the country in which it was made. Each country will determine for itself the latest date at which such declaration must be made. The particulars referred to shall be stated in the publications issued by the competent authority, and in particular in the patents issued and the specifications relating thereto. The contracting countries may require any person making a declaration of priority to produce a copy of the application (with the specification, drawings, &c.) previously made, certified as correct by the authority by whom it was received. Such copies shall not require any legal authentication. They may also require that the declaration shall be accompanied by a certificate from the proper authority showing the date of the application, and also by a translation. No other formalities may be required for the declaration of priority at the time of application. Each of the contracting countries shall decide for itself what consequences shall follow the omission of the formalities prescribed by the present article, but such consequences shall in no case be more serious than the loss of the right of priority.

(e) At later stages, further proof in support of the application may be required.

By a final Protocol was added—

It is understood that when an industrial design or model is registered in a country in virtue of a right of priority based on the registration of a utility model, the period of priority shall not exceed that fixed by article 4 for industrial designs and models.

ARTICLE 4 bis.

Patents applied for in the various contracting countries by persons admitted to the benefits of the Convention in the terms of articles 2 and 3 shall be independent of the patents obtained for the same invention in the other countries, whether such countries be or be not parties to the Union.

This stipulation must receive a strict interpretation; in particular, it shall be understood to mean that patents applied for during the period of priority are independent, both as regards the grounds for refusal and for revocation, and also as regards their normal duration.

The stipulation shall apply to all patents already existing at the time when it shall come into effect.

The same stipulation shall apply in the case of the accession of new countries, to patents in existence, either on one side or the other, at the time of accession.

ARTICLE 5.

The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the countries 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, but with this reservation: that the patent shall not be liable to revocation on account of failure to work it in any country of the Union until after the expiration of three years from the date of application in that country, and then only in cases where the patentee cannot show reasonable cause for his inaction.

Articles 6-10 are omitted as having no reference to Patents.

ARTICLE 11.

The contracting countries shall, in conformity with the legislation of each country, accord temporary protection to patentable inventions, to utility models, and to industrial designs or models, as well as to trade-marks, in respect of products which shall be exhibited at official, or officially recognised, international exhibitions held in the territory of one of them.

ARTICLE 12.

Each of the contracting countries agrees to establish a special Government department for industrial property and a central office for communication to the public of patents, utility models, industrial designs or models, and trade-marks.

This department shall, as far as possible, publish an official periodical paper.

Articles 13-19 are omitted, having reference to the establishment of the International Office at Berne.

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