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The "Westminster" Series

PATENTS, DESIGNS AND TRADE MARKS

THE LAW AND COMMERCIAL USAGE

OF

PATENTS, DESIGNS AND TRADE MARKS

BY

KENNETH R. SWAN, B.A. (Oxon.)

OF THE INNER TEMPLE BARRISTER-AT-LAW

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PREFACE

Though Patents, Designs and Trade Marks cannot be said to be very intimately related to one another from a purely legal point of view—at any rate not to the degree to which their previous collocation in a single Act of Parliament would seem to imply—nevertheless they undoubtedly possess affinities of a practical kind, amply justifying their traditional association. Lodged together under the roof of the Patent Office and jointly supervised by the Comptroller-General of Patents, Designs, and Trade Marks, they are not unnaturally linked in the public mind as the three principal forms of monopoly, the aim and object of which is eminently *commercial*. No excuse, therefore, is needed for uniting these subjects in the compass of a single volume.

Nor is excuse needed for producing a treatise of this nature at the present time. Such radical changes have been effected by recent legislation in the law of patents, designs, and trade marks, that existing works upon these subjects published prior to the passing of the Patents and Designs Act, 1907, and the Trade Marks Act, 1905, respectively, have been rendered to a great extent obsolete.

In producing this book, the author's aim has been not only to present the existing law accurately, and as fully as is possible in a volume of this size, but also to present it in such a form as to be readily comprehensible to the layman

unfamiliar with legal phraseology, and of value to those engaged in the trades and industries concerned with the patenting of inventions and the registering of designs and trade marks. In pursuance of this object, and particularly in dealing with patents, the writer has endeavoured to handle the subject from a commercial, as well as a legal, point of view; paying regard both to the interest of the inventor and registered proprietor on the one hand, and of the general public on the other. For the guidance of those interested in exploiting their inventions abroad, two chapters have been added to the Patents section of the book, touching upon the subject of foreign patents and containing a synopsis of the patent laws of the United States of America, Germany and France, together with information in tabular form as to the term, fees and conditions as to working of patents in the more important of the other foreign countries.

Since to have printed *in extenso* the text of the two Statutes, with their respective Board of Trade Rules, now governing the law and procedure in regard to patents, designs and trade marks, would have added unpleasantly to the bulk of this volume, the author has endeavoured to give instead a comprehensive epitome of their provisions, adding such references to individual sections as will enable the reader, if he so desires, to refer to the Acts themselves.

Similarly, in regard to case-law, as the present volume is not intended to be in the strictest sense a legal text-book solely for the use of lawyers, the pages have not been encumbered with a mass of references to decided cases; on the contrary, cases have been somewhat sparingly cited, and are introduced rather for the purpose of illustration than as authority for statements of law.

A list of the cases cited and the places where they are reported will be found on p. xi. At the end of each of the three sections of the book a table is appended giving the forms and fees prescribed for the various applications to the Patent Office in regard to patents, designs and trade marks respectively.

KENNETH R. SWAN.

7, CROWN OFFICE ROW,
INNER TEMPLE, E.C.
March, 1908.

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KEY TO ABBREVIATED REFERENCES TO THE REPORTS.

App. Cas.	Law Reports (New Series) Appeal Cases.
B. & Cr.	Barnewall & Cresswell's Reports.
Griff. Pat. Cas.	Griffin's Patent Cases.
H. L. C.	House of Lords Cases.
L. J. Ch.	Law Journal Reports (New Series) Chancery.
L. J. C. P.	" " " " Common Pleas.
L. J. Ex.	" " " " Exchequer.
L. J. Q. B.	" " " " Queen's Bench.
L. R. Ch. D.	Law Reports, Chancery Division.
L. R. H. L.	" " House of Lords.
L. T. (N. S.)	Law Times Reports (New Series).
M. & Cr.	Mylne & Craig's Reports.
R. P. C.	Reports of Patent, Design and Trade Mark Cases.
W. P. C.	Webster's Reports of Patent Cases.

NOTE.

Owing to a recent change, Patent, Design and Trade Mark Fee Stamps and Forms are now procurable at the New Stamp Office, Room 32, in the Patent Office, 25, Southampton Buildings, Chancery Lane, instead of, as hitherto, at the Stamps Department of the Law Courts.

PATENTS, DESIGNS AND TRADE MARKS.

PART I.

LETTERS PATENT.

INTRODUCTION.

General.—The grant of letters patent for inventions is the survival of one of the most dearly cherished and most grievously abused of the ancient prerogatives of the Crown; the prerogative in virtue of which the sovereign claimed in olden times the power to regulate the trade of the country generally, and to grant monopolies and special commercial privileges in favour of particular persons and places. But, like most of the royal prerogatives, its glory has long since departed. It is now vested in and entirely controlled by a Government Department. Since 1883, the grant of patents has been regulated by the Board of Trade, and the royal prerogative wielded by its officer, the Comptroller-General of Patents, Designs and Trade Marks.

Even the patent itself appears to have suffered a corresponding diminution of its ancient lustre. It is no longer the impressive-looking document of former days, elaborately engrossed on parchment, sometimes with picturesque

embellishments, and with the Great Seal dangling fr it by a silken ribbon. It is now merely a plain printed et, bearing the red wafer seal of the Patent Office. Nev he- less, though its appearance be mean and common ce, there is certainly no lack of dignity in its language. The terms of the grant are worthy of study. After reciting the humble prayer of the inventor that a patent may be granted unto him for the sole use and advantage of his invention, it continues in these words :—

"Know ye, therefore, that We, of our especial grace, certain knowledge, and mere motion, do by these presents, for us, our heirs and successors, give and grant unto the said patentee our special licence, full power, sole privilege and authority, that the said patentee by himself, his agents or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise and vend the said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention during the term of fourteen years from the date hereunder written of these presents."

In spite of the profession of perfect disinterestedness on the part of the Crown conveyed in the opening phrases above quoted, the grant of letters patent may be viewed essentially as a commercial bargain between the sovereign and the subject. The inventor, for his part, undertakes to enrich the common stock of knowledge by publishing his invention and by teaching the community how to do some new and useful thing, or how to achieve some known result in a new and better way; while, in return, the Crown agrees to grant the inventor, by way of reward, the exclusive right to exercise his invention for his own benefit, without fear of competition for the space of fourteen years.

In principle this method of encouraging and rewarding useful invention may be said to be economically sound; for, provided a reasonable period of monopoly is fixed, it is eminently calculated to ensure that the profit reaped by the inventor shall be in direct proportion to the utility of his invention and the energy with which he proceeds to put it into practice. But in reality many factors operate to disturb the equal balance of advantage both on the side of the public and on the side of the patentee. The slowness of the public to appreciate and take up a new idea, the lack of business ability for which the name of "inventor" is proverbial, and, it must be added, ill-judged legislation all tend to minimise the gain of the patentee, if not to deprive him of it altogether.

On the roll of unrewarded merit there are the names of not a few patentees whose inventions, now universally adopted to the inestimable advantage of the public, have never brought them adequate recompense nor even, in some cases, bare recognition. Lord Dudley, who invented and patented the process of making iron by means of pit-coal fuel, spent his whole life and fortune in all but futile efforts to bring his process into use. Henry Cort, who, a hundred years later, extended Dudley's invention to the making of bar iron by pit-coal, and who is now justly regarded as the founder of the iron industry, derived no profit from his patents. Amongst the pioneers of the steam engine, Savery, Newcomen, Watt, Trevithick and Woolf, the only one who obtained any adequate recompense for his labours was Watt, and that only owing to the prolongation of his patent by Parliament. Few men have, through their inventions, made a more substantial contribution to our national prosperity than the three inventors of spinning machinery, Hargreave, Arkwright and Crompton. Yet none of these profited from their patents.

Sometimes it happens, on the other hand, that the balance of advantage is on the side of the patentee, though such a result is scarcely consistent with the legitimate use of a patent monopoly. Latter-day commercial methods have, however, shown that in the hands of unscrupulous proprietors a British patent can be turned to great profit for the patentee without a corresponding benefit to the public. Patents have occasionally been acquired not for the purpose of establishing a new manufacture "within the realm," but for an exactly opposite purpose, viz., as a means of suppressing the manufacture in this country, whilst the invention is being worked abroad and the patented article imported into England and sold at exorbitant prices. A signal instance of this abuse is afforded by the history of the telephone and aniline dye industries, both of which have been checked in England through the unscrupulous tactics of the foreign owners of British patents. Taking advantage of their monopoly simply to prevent manufacture in this country, powerful foreign companies built up their businesses on the Continent and in America on such a gigantic scale that, even after the expiration of the British patents, they continued to monopolise our markets, owing to the impossibility of creating and fostering these industries at home in the face of such formidable competition from well-established industries abroad. This abuse of our patent laws and the means provided for its remedy will be discussed fully in the chapter dealing with compulsory licences.

The term of fourteen years appears to have been originally arrived at by doubling the seven years' term of apprenticeship. It was in fact a compromise between the inventor and the apprentice. Ordinarily an apprentice was precluded from competing in the same trade with his master till the expiry of his seven years' term. In the case of the founder of a new industry an additional period of protection was clearly merited; accordingly a further

period of seven years was allowed, it being thought that to debar apprentices for a longer time from the free practice of their trade would be too great a hardship and discouragement to them. Though fixed in this somewhat arbitrary fashion, the period of fourteen years seems to have met with general approval amongst other civilised nations, all of whose patent systems are, directly or indirectly, modelled on the pattern of our own in this as also in other respects. Longer periods have been adopted in America, where the term is seventeen years, in Canada, where it is eighteen years, and in Belgium and Spain, where it is twenty years; but, with these exceptions, the period of monopoly in other countries is commonly fourteen or fifteen years.

If during the allotted period the inventor has not reaped a fair return for the advantages which the lapse of his patent will place at the disposal of the public, it is always open to him to apply for an extension of the term of his patent. This privilege, however, is jealously guarded and only conceded when the invention is one of conspicuous merit. On the whole, if any inference may be drawn from the small number of successful petitions for prolongation recorded in recent years, it is the general conclusion that at the present time a really meritorious invention is capable, under proper management and ordinarily favourable conditions, of earning a fair measure of success and profit for its inventor within the normal term of his patent.

Historical.—For practical purposes the law of patents begins with the famous Statute of Monopolies, passed in the twenty-first year of James I.'s reign. Numerous records, it is true, are to be found of grants of letters patent prior to this date, but few of these have anything to do with inventions. By far the greater number relate to grants of mere trade monopolies for manufactures wholly devoid of novelty and invention, an expedient to which the

Tudor sovereigns freely resorted as a ready means of replenishing a depleted exchequer. To such an extent had these oppressive grants been multiplied, that, in the latter years of Elizabeth's reign, there were few of the common necessities of everyday life which were not farmed out as private monopolies. To allay the storm of public indignation aroused by this abuse, James I. found it politic on coming to the throne to issue a proclamation denouncing the practice of granting monopolies for existing industries and promising to grant no more. But the promise was soon broken and the evil revived. After repeated remonstrances, the patience of the Commons was at length exhausted, and in 1624 the Statute of Monopolies was passed, finally suppressing this unconstitutional and oppressive practice. Although, as Lord Coke is careful to point out, "this Act maketh patents no better than they should have been if the Act had not been passed," nevertheless the fact remains, that it is upon this enactment that our patent law is founded, and what precedes it is now of purely historic interest.

Turning to the provisions of this Statute, it will be seen that after in general terms declaring monopolies, grants and letters patent for the sole buying, selling or using of anything within this realm to be contrary to the law and utterly void and of none effect, the Act goes on in the sixth section to exclude from this wholesale prohibition legitimate grants of letters patent for *invention*. The important words are as follows:—

"Provided also that any declaration before mentioned shall not extend to any letters patent and grants of privilege for the term of fourteen years or under, hereafter to be made of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patent and

grants shall not use, so as also they be not contrary to the law, nor mischievous to the State, by raising prices of commodities at home, or hurt of trade, or generally inconvenient; the said fourteen years to be accounted from the date of the first letters patent or grant of such privilege hereafter to be made, but that the same shall be of such force as they should be if this Act had never been made, and of none other."

But the Statute of Monopolies, though it effectually checked the grant of illegal patents, does not appear to have had a stimulating effect upon applicants for the grant of patents for invention, despite the inducement held out to them of an assured monopoly for fourteen years, instead of, as formerly, a monopoly revocable at the caprice of the sovereign. Up to the middle of the eighteenth century the yearly number of patents granted rarely ran to double figures, and as late as the middle of the nineteenth the issue did not exceed 500 per annum. This was mainly due to the extreme costliness and intricacy of the procedure for obtaining a patent. The fees for the three patents required to cover the United Kingdom (for Scotland and Ireland at that time issued separate patents) usually amounted to £500 or more; so that the luxury of a patent was quite beyond the means of the great majority of inventors.

The first radical improvement in this respect was effected by the Patent Law Amendment Act of 1852, which simplified the procedure and considerably reduced the fees. The benefit of this reduction, however, was to some extent counterbalanced by the simultaneous prohibition of the practice, which had hitherto prevailed, of including more than one invention in a patent. On the other hand, the scope of a patent was extended to cover the entire United Kingdom, the Isle of Man and the Channel Islands, thus obviating the expense of procuring additional patents for

Scotland and Ireland. It should be observed, in passing, that the Channel Islands have since been excluded from the purview of a British patent. To the Act of 1852 we also owe our system of requiring the inventor to file with his application a provisional or complete specification describing the nature of the invention and of according him protection as from that date.

In the early days of patent grants there was no hard and fast rule requiring the patentee to specify the exact nature of his invention; sometimes a clause compelling him to do so within a certain time was inserted in the patent grant, on the other hand he was sometimes expressly absolved from the necessity of describing his invention at all. In 1730, however, the lodging of a specification of the invention within a certain time after the grant was made a condition of validity. This change had an important influence upon the subsequent development of our patent system. The lodging of a specification came to be regarded as the consideration for the grant, to the obscuration of the earlier view, represented by the Statute of Monopolies, that the consideration for the grant of a patent is the setting up of a new manufacture in the realm. Once this view was lost sight of, and the theory gained acceptance that a valid patent might be obtained on condition that the inventor lodged a description of a new and useful invention, the barrier was removed to the granting of British patents to foreigners and others not intending to work the invention within the realm.

The period within which the patentee was required to enrol his specification was at first variable, but was later fixed at six months. As soon as the patent was granted, the patentee was protected; the grant did not, however, date back to the time of application. Hence there was a *hiatus* of several weeks between the date of application and grant, during which the inventor ran the risk of anticipa-

tion. It was to eliminate this risk that the institution of the provisional specification with its accompanying provisional protection was designed.

Finally, it is to the Act of 1852 that we owe the centralisation of all the administrative part of patent business in the office of the Comptroller-General (formerly the Commissioner) of Patents.

The Patents, Designs and Trade Marks Act of 1883 was primarily a consolidating measure. The principal change that it made in the substantive law was the provision for the grant of compulsory licences in cases where, through neglect of the patentee to work the patented invention, the needs of the public were not adequately met. It also provided for the further reduction of fees and introduced several changes affecting procedure. The amending Acts of 1885, 1888 and 1901 were concerned solely with minor changes in procedure and practice. A reform of considerable importance was introduced by the Act of 1902, viz., the inauguration at the Patent Office of a system of examination as to the novelty of the invention claimed in patent applications; before this, the attention of the Patent Office examiners had been confined to the correction of purely formal defects in the application.

But all the patent legislation of the last twenty years sinks into insignificance as compared with the revolutionary changes effected by the Patents and Designs Act, 1907.

This Act is both a consolidating and an amending Act. It sweeps away all previous legislation on the subject of patents and designs, and, whilst re-enacting the main part of the Patents Acts, 1883 to 1902, introduces several innovations of a radical nature. One of the most important of these is the greatly increased jurisdiction given to the Comptroller. Previously his duties were mainly administrative. Though called upon to exercise judicial functions in opposition proceedings, his power to refuse a patent on

the ground of anticipation was exceedingly restricted, and, in the absence of public opposition, no such power existed. The new Act, however, not only empowers the Comptroller to refuse applications for patents on his own initiative on the ground of anticipation, but has conferred upon him the entirely new jurisdiction of entertaining applications to revoke patents already granted, a power hitherto wielded by no tribunal inferior to a judge of the High Court. Further, the grounds upon which a patent may be revoked have been extended. It is now a ground of invalidation that a patented invention is worked exclusively or mainly outside the United Kingdom, a provision which seems to be practically identical with the compulsory working clauses that appear in most of the foreign patent codes.

The provisions relating to the grant of compulsory licences have also been remodelled and the jurisdiction of the Privy Council in this matter, as also its jurisdiction to entertain petitions for the prolongation of patents, has been transferred to the High Court. Another important change, which should contribute to protect the public from the annoyance of trumpery actions for infringement, unwittingly committed, is the exemption of the innocent infringer from liability to pay damages in respect of such infringements. To the list of innovations designed for the protection of the public must be added one which very seriously abridges the freedom hitherto enjoyed by the patentee in making terms with those who wish to buy or use his invention. A clause has been introduced into the Act condemning as void or voidable a certain class of restrictive covenants, viz., those pledging the user of the invention to deal solely with the patentee or his nominee in articles other than the patented article. It remains to be seen how the provisions of this clause, framed as they were to meet the needs of a comparatively

small section of the trading community, will work as applied to the whole. Amongst the innovations more especially designed for the benefit of the inventor is the institution of *patents of addition*, enabling him to obtain a cheap form of protection for minor improvements upon an invention already patented by him. The inventor is now also safeguarded, upon certain conditions, against any prejudicial effect upon the validity of his patent arising from the unauthorised publication of the nature of his invention prior to the date of his applying for its protection.

The statutory bond, formerly uniting trade marks with patents and designs, having been severed by the Trade Marks Act of 1905, the first named topic is now, with the exception of the provisions relating to the international protection of trade marks, wholly excluded from the Patents and Designs Act. It should be added that the important changes effected by this Act have necessitated the formulation of a fresh set of Rules the purport of which, though not explicitly referred to, is given in the following pages.

With this brief survey of the development of our patent system, we may now proceed to consider in detail the various aspects of the subject, beginning with the consideration of the elements that constitute a patentable invention.

CHAPTER I.

THE ESSENTIALS OF PATENTABLE INVENTION.

Invention.

A discussion of the attributes of patentable invention would be premature without first arriving at a clear conception of the meaning which, in patent law, has been attached to the word "invention." The Patents and Designs Act of 1907 defines it simply by referring back to the Statute of Monopolies, which states that patents may be granted for the sole working or making of "any manner of new manufactures." Hence it is really "manufacture" that has to be defined. From earliest times the Courts have placed a liberal interpretation on this word, construing it to embrace not only the *mode of manufacture*, whether by process or by machine, but also the *manufactured article* and, in short, practically every form of ingenious device and appliance useful in the manufacturing arts.

The statement that a "manufactured article" can be protected by letters patent is, however, not altogether free from ambiguity, and requires some qualification. If the manufactured article is, for example, an improved form of lock or umbrella or golf ball, no one would hesitate in saying that that could be protected absolutely by patent. But to the inventor who asks, in reference to some new chemical product, say artificial indiarubber, "Can I patent it so as absolutely to preclude others from using it?" it is not possible to give an authoritative answer. Strangely enough, the question whether a product can be claimed

per se, though it has been raised, has never been definitely decided in the Courts. Since, however, it is a matter of the highest practical importance, particularly to inventors concerned with the patenting of new metallurgical and chemical products, it is worth while hazarding a solution of the problem.

The true view appears to be that a new product can be protected in either or both of two ways. It can be claimed for all purposes, as produced by some specific process, or it may be claimed absolutely for certain specific purposes. But a claim to monopolise a new product, apart from its process of manufacture on the one hand, or its useful application on the other, could not, it is submitted, be sustained. To illustrate these propositions, it will be helpful to take a concrete case. Assume that A. is the first to produce gilt iron wire and that he does so by placing a tube of gold upon an iron core and drawing them down together to the required degree of fineness through drawplates. His claim to the new article, gilt iron wire, cannot debar B. from manufacturing a similar material, by passing iron wire through an electrolytic gilding bath and imparting the gilt coating in that manner. But it is also open to A. to claim gilt iron wire, no matter how it is manufactured, for certain specific uses, *e.g.*, for spectacle rims, for gold lace, etc. To support this further claim, however, there must be further ingenuity in the application of the product. In some new products there is no room for ingenuity in the application, the application being self-evident. A claim, for example, by the inventor of saccharin to monopolise this material, howsoever made, for sweetening purposes, could not, if this view is correct, be upheld. On the other hand, a new metallic powder, capable of various novel and ingenious uses, might be protected absolutely for specified purposes quite apart from its method of manufacture.

From these considerations it is obvious that the broadest

protection for a new product of this kind would be obtained by claiming it as far as possible in both the above ways:—(1) as qualified by its process of manufacture, and (2) absolutely for special new and ingenious uses. It is also plain that, in the instances given above, a claim for a new form of lock or umbrella is in reality a claim for these articles as qualified by their particular method of construction.

There are certain things on the border line of invention and, therefore, sometimes confused with it, which the law excludes from the domain of patentable invention. In the first place we must clearly distinguish between *discovery* and invention. Faraday could not have patented electro-magnetic induction, nor Harvey the principle of arterial circulation. A patentee must have done something more than make a discovery. He must, in the words of Lord Lindley, "make some addition not only to knowledge, but to previously known inventions, and must use his knowledge and ingenuity so as to produce either a new and useful thing or result, or a new method of producing an old thing or result."

Again, it is a well-known aphorism in patent law that a man cannot patent a principle. Some recognisable principle underlies every invention, and the inventor may be the first to apply it or he may be applying it for the thousandth time, but in a novel form. Where an inventor is also the discoverer of the principle underlying his invention, he is sometimes apt to claim the principle itself, or, what amounts to the same thing, every method tried and untried of applying it. But this is not permitted. The Courts have laid it down, time after time, that a man cannot patent a principle *per se*, but only when coupled with some practical method of carrying it into effect. No matter how simple and obvious the method of operation may be when once the underlying principle is indicated, it is nevertheless essential that some specific method of applying it should be

described. Generally, if the claims are skilfully drawn, this may be done without materially limiting the scope of the patent. For the rule is, that where an inventor is the first to enunciate the principle, his patent will be treated by the Courts as a pioneer or master patent and its claims will be liberally construed, whilst the claims of subsequent inventors who carry out the same principle by a different mode will be narrowly scrutinised to see whether in effect, although the mode is not exactly the same, the difference is only colourable.

The law on this point is clearly stated by Mr. Justice Wills in the case of *Easterbrook* v. *Great Western Railway*. "Although," said the learned judge, "there cannot be a patent for an idea or principle apart from its physical embodiment in adequate apparatus, yet, if the specification discloses the idea, and shows a method by which it can be carried out and does not limit the claim of the patentee, any apparatus, which by different mechanical means carries out the same idea, is an infringement of the patent, though the method, and even the purpose to which the principle or idea is applied, be different from those embodied in the specification."

Again, it has been held that the discoverer of a new element, such as argon or radium, or a new natural substance, is not entitled to a patent for that alone; though, of course, its ingenious application to some useful purpose could be patented.

Further, a patentable invention must be distinguished from a mere design, which is properly protected not by letters patent but by registration. If, however, the design is of practical utility, as in the case of a cam, the shape of which determines the movement of associated mechanism, that is proper matter for a patent, provided it is claimed in such connection. In *Moss* v. *Malings* the shaping of the handle of a tennis racquet with two opposite grooves to give

the player a firmer grip was held to be good subject matter for a patent. Similarly the particular shape of a steel rail or the form of groove in a gun barrel may be validly patented.

Finally, an invention which contemplates a breach of the law or which is intended for illegal or mischievous purposes is not good subject matter for a patent. Thus an application to patent an improved form of man-trap or infernal machine would probably be refused by the Patent Office.

The Patent Office has also intimated that applications will not be accepted for inventions, the only material product of which consists in a printed sheet, ticket or the like for use in carrying out some scheme of business. An improved system of letter-filing would, therefore, apparently prove unacceptable subject matter.

Having taken this preliminary survey of what lies within the domain of invention in the patentable sense, we are now in a position to consider the two essentials which an invention must possess to fit it for protection by letters patent. These are Novelty and Utility. To avoid confusion as to the use of terms, it should be pointed out here that novelty as applied to invention is capable of being regarded in two ways. Every device which is not identical with what has been done before is, strictly speaking, novel. Novelty in this sense is a matter of fact, and admits of absolute proof. But novelty may also be regarded as a matter of degree. For example, when the defence is raised by an alleged infringer that the plaintiff's invention is not new, what is usually meant is that the *degree* of novelty, that is to say the inventive advance beyond what is old, is not sufficient to support a valid patent. Novelty in this sense, or, as it is sometimes termed, "subject matter," does not admit of absolute proof, but like all questions of degree, it is open to difference of opinion. The distinction between

absolute and comparative novelty must therefore be clearly kept in view.

It will be most convenient to deal with the attributes of a patentable invention under three heads:—(1) *Novelty;* (2) *Degree of Novelty* or *Subject Matter;* (3) *Utility.*

CHAPTER II.

THE ESSENTIALS OF PATENTABLE INVENTION (*continued*).

NOVELTY.

THE first point to be observed with regard to novelty is that the invention must be new *at the date when the patent is applied for;* publication prior to that date is, generally speaking, fatal to the validity of the grant. Formerly this rule was without exception, and an inventor was liable to have his patent vitiated by premature public disclosure in any form, whether authorised or not, and even though involving a breach of confidence on the part of the publisher. The Act of 1907 has, however, introduced an important modification of the old rule with respect to unauthorised publication. Section 41, sub-section (2) provides that an inventor shall not have his patent invalidated solely on the ground of prior publication, if he can prove to the satisfaction of the Court that the publication was made without his knowledge and consent. But he must also show that the matter published was derived from himself and that he applied for and obtained protection for his invention with all reasonable diligence after learning of the publication, assuming that he heard of it before his application was lodged. It seems scarcely necessary to observe that the fact that an inventor is unaware of the prior publication of somebody else's invention, identical with his, will not save his own patent from invalidation; otherwise, as Mr. Justice Grove said, a man might get a patent for exclusive ignorance instead of exclusive knowledge.

As soon as the application has been lodged and what

is termed "provisional protection" obtained, the inventor may proceed to use or describe his invention in public, without fear of prejudicing the validity of his patent. For the grant of a patent is retrospective, and dates back to the time of application.

Nevertheless gratuitous disclosure, even after provisional protection has been obtained, is to be avoided where the invention, as is usually the case, has not attained perfect finality. For later on, it may possibly be thought advisable to abandon the first application altogether and apply afresh for an improved form of the same thing. In that event any publication made on the strength of provisional protection obtained through the abandoned application might seriously interfere with the scope of the later form of specification.

Secondly, the invention must be new *within the realm;* that is, within the United Kingdom and the Isle of Man. Publication or use elsewhere does not rob an invention of its novelty in the eye of the law. Hence it is that a person, who is merely the first to introduce an invention into England, stands on an equal footing with an inventor as regards his eligibility for a patent.

Thirdly, it is important that the *whole* of the invention claimed should be new; lack of novelty in any one claim, no matter how sound and meritorious the other claims may be, is fatal to the entire patent, unless the defect can be cured by amendment. An inventor drafting his own specification cannot be too careful in clearly limiting his claims to the novel features of his invention. Through failure to observe this rule many valuable patents have been lost. In cases, however, where that which is erroneously claimed as new is strictly appurtenant to and forms merely a subsidiary part of the real substance of the invention, the Courts have relaxed the rule in favour of the patentee. Thus, in *Plimpton* v. *Spiller*, where the patentee

had claimed first, "a mode of applying rollers and runners to the footstand of skates, so that they might be cramped or turned so as to cause the skate to run in a curved line by the canting or tilting of the footstand," and secondly, "the mode of securing the runners and making them reversible," it was held that the want of novelty in the second claim did not invalidate the patent, because the second claim must be read as claiming a subsidiary invention, to be used only in connection with the principal invention. Again, in the more recent case of *Parker* v. *Satchwell*, a patent for "an improved device for holding or retaining ladies' hair" was held not to be vitiated by the fact that two of its claims were devoid of novelty, since both were subsidiary claims and clearly appendant to the "improved device."

So much for a general statement of the principles governing the requirement of novelty. It remains to consider next what amount of publicity will suffice to rob an invention of its novelty so as to impair the validity of a subsequent patent grant. This subject will be conveniently dealt with under two heads :—Prior Public User and Prior Publication in Books, Specifications and the like.

Publication by Prior User.

It is fatal to the validity of a patent, if it is proved that the invention has been worked or used in public either by the inventor himself or by someone else prior to the date of patenting. But mere experimental user will not constitute an invalidating anticipation. In patent actions where prior user is alleged, it frequently turns out that the user cited was nothing more than an unsuccessful experiment and not a real use of the invention at all. The fact that an invention has been abandoned or has led to no commercial result is strong presumptive evidence of its

experimental nature, but it may be rebutted by showing that the abandonment was due to other causes. The Haskell Golf Ball case (*Haskell Golf Ball Co.* v. *Hutchinson*) affords an excellent illustration of these points. In this case, amongst a number of witnesses called to prove prior user, the most important was a certain Captain Stewart who stated that nearly thirty years before the date of the plaintiffs' patent he had made golf balls of wound rubber thread with a cover of gutta percha. He had given away some to his friends, and sold some, and had disclosed to at least one person the method of construction. He continued to make these balls from time to time until 1879, but he made none after that date. There was evidence to show that he ceased making this style of ball because it was not popular. It had no "click," and, according to the sentiment of the day, golf without a "click," was not golf at all, but waste of time.

Upon these facts the judge who tried the case at first instance held that what Captain Stewart had done amounted to more than mere incomplete experimental user and that it consequently invalidated the plaintiffs' patent. He also pointed out that there is a considerable difference between an experimental user of an invention by a patentee himself and by some person other than the patentee. For if the effect of the patent is to stop *others* from doing what they did before, even though the manufacture was only tentative, then it is clearly bad, inasmuch as it violates the express language of the Statute of Monopolies. It should be added that this decision was upheld by the Court of Appeal and has been finally affirmed by the House of Lords.

How slight a degree of prior user serves to invalidate a subsequent patent is shown by the decision in *Carpenter* v. *Smith*, where a patent for a lock was upset by evidence that a single lock of the same pattern had existed for several years upon a gate facing the public highway. In

another case (*Taylor's Patent*) a single fire-grate in a private house, but exhibited to the view of all and sundry of the inventor's friends, was held to be sufficient publication to debar the inventor from subsequently obtaining a valid patent. A patent, however, will not be invalidated on the score of prior user by disclosure in confidence to the inventor's friends or to workmen or assistants employed in working the invention provided they are bound over to secrecy. But manufacture by workmen who are under no obligation of secrecy is undoubtedly publication and will invalidate the patent subsequently obtained, unless the patentee can avail himself of the provisions of s. 41, referred to at the beginning of the chapter.

Sometimes the patentee's own experiments have been held to amount to prior user, particularly where it can be shown that he derived profit from them, the inference being that if the invention is capable of being turned to profitable account it can no longer be considered to be in an experimental stage. Thus, where an inventor in the fulfilment of a contract for the erection of a pier had devised a novel form of travelling crane and had publicly used it upon the works for several months before taking any steps to patent it, such user was considered to amount to a dedication of the invention to the public, and a patent was refused (*re Adamson's Patent*).

On the other hand, where an invention is of such a character that, in order to establish its utility, experimental user in public is unavoidable, considerable latitude is allowed by the Courts to enable the inventor to test the soundness of his theories before embodying them in a patent. So, in *Newall* v. *Elliott*, the inventor of a machine for paying out a submarine cable, who had tested the utility of his invention in the execution of a Government contract, succeeded in maintaining his patent in spite of the fact that he had derived profit from the undertaking.

Presumably the experimental use of a flying machine, which must almost necessarily take place in public, would not deprive an inventor of his patent rights; but in such a case it would certainly be a wise precaution to obtain provisional protection first.

How far a new process or machine may be commercially used *in secret* by the inventor without prejudicing the validity of a patent subsequently obtained for it, is a matter upon which there is no definite judicial pronouncement.

The question arose in the old case of *Betts* v. *Menzies*, but its solution was unnecessary for the decision of the case and consequently it remained unsolved. The patentee had, before applying for his patent, manufactured a quantity of the patented article for stock, but none had been sold; hence there was no publication and the manufacture was, in effect, a secret user. It was argued that by this means the patentee was extending the period of his monopoly and that such a practice was contrary to public policy. In dealing with this argument Lord Campbell said: "If it could be shown that the effect was really to extend the time of the monopoly, that would be fatal. But the defendant has entirely failed in showing that; because any person might have used this manufacture lawfully until the patent was sealed and the fourteen years had begun to run."

Whether secret commercial user of a newly-invented process will prejudice a subsequent patent for it depends, of course, largely upon the character of the product. If the article is such that the public can infer from inspection or analysis the process by which it is made, that will certainly constitute publication. But the article may be of such a character, *e.g.*, a high vacuum tube, that it supplies no clue to the method of manufacture. In such a case the process remains a secret and, in the writer's opinion (no matter how much profit the inventor may have made) it is

capable of being subsequently sold to the public in return for a fourteen years' monopoly.

But, however closely guarded it may be, a commercial monopoly depending upon a secret process is at best exceedingly precarious, seeing that the inventor runs the double risk of having his secret betrayed by an employee or guessed by an independent experimenter. In this connection it is worth while to observe that the special provisions of s. 41 (see p. 18), appear to favour the security of secret working, in so far as they protect the proprietor of an invention from the invalidating consequences of unauthorised publication, such as might result from a breach of confidence on the part of one of his employees.

Secret user by the inventor himself must be distinguished from secret user for profit by others. The latter would undoubtedly constitute a vitiating anticipation on the principle, already stated, that a man cannot by taking out a patent prevent others from continuing to do what they did before. Thus, in *Tennant's Case*, a patent for a bleaching process was invalidated on the ground of prior user upon proof that, for several years before the date of the plaintiff's application, a manufacturer had secretly used a bleaching liquor prepared in the manner described in the plaintiff's specification.

But the importation and sale in the United Kingdom of a product manufactured abroad under a secret process will not debar a man, who discovers or learns the secret, from patenting it here and thereby preventing its continued importation under pain of infringement.

Publication by Documents.

The most usual defence in an action for infringement is the plea that the patent sued upon is invalid on the ground that the alleged invention has already been

described and claimed in certain prior specifications or anticipated by description in some scientific book or treatise. By industrious research in the Patent Office Library, it is always possible to bring to light some publication bearing at least a specious resemblance to the patent it is desired to upset; and it is extraordinary to find what prophetic and far-sighted inventors these prior patentees become when their specifications are read in the kindly light of subsequent knowledge and by the willing mind of the patent wrecker. But the Court looks narrowly at all so-called "paper" anticipations to see whether in fact they disclose adequate information for the practical working of the invention, or whether the alleged prior publication is merely a scientific speculation or a general and vague proposition left for others to work out in detail and translate into practical shape. The publication on paper of the possibility of doing something is, it need hardly be said, not nearly such cogent proof of anticipation as the achievement in fact, evidenced by prior user.

The Courts have laid down with some particularity the degree of intelligibility required in specifications or other documents relied on as anticipations. The description need not be so lucid and detailed as to enable any ordinary workman to perform the invention. It will suffice if it is explicit enough to enable a person with a willing mind and highly skilled in the particular art, and guided solely by the information conveyed and such knowledge as he possessed at the time, to carry out what is subsequently claimed as a new invention. But if such a person has to exercise any invention or ingenuity, or to make experiments in order to attain that end, the prior specification will not be held to be an anticipation.

Thus, in the old case of *Betts* v. *Menzies*, the patent sued upon was for the production of a material capable of application to many useful purposes by compressing

together thin sheets of lead and tin. A prior specification describing precisely the same principle was relied upon as an anticipation. In the earlier specification, however, no instructions were given as to the relative thickness of the metallic sheets, the degree of pressure to be applied and similar details upon which information was required for the practical working of the invention. It was held that, since it would require some experiment before a successful result could be obtained from the meagre description given, this specification did not constitute an anticipation.

Descriptions in text-books, as a rule, carry less weight as evidence of anticipation than those contained in technical treatises, such as specifications or trade journals, for the reason that the text-book writer is generally concerned rather with principles than practice.

A drawing or plan of a machine, unaccompanied by explanatory letterpress, will amount to publication, if it is sufficiently explicit to be intelligible to a competent engineer. But a photograph or print illustrating some novel process of photography or engraving would not, unless it clearly revealed the process by which it was produced, by itself constitute an anticipation.

An invention may be anticipated partly by one specification and partly by another, but novelty cannot be successfully impugned by piecing together a number of specifications. "If," said Lord Justice James, "it requires a mosaic of extracts from specifications and treatises spread over a number of years to prove the defendant's contention, that contention stands thereby self-condemned."

Once the identity of the invention, previously described, with that subsequently claimed has been established, a very small amount of publicity is sufficient to rob the later invention of its novelty.

A single copy of a book on the public shelves of the Patent Office Library will constitute publication, provided

the description is in a language generally understood. It need not be proved that anyone has read the book; the fact that it is accessible to the public is sufficient. But where, as in the case of *Plimpton* v. *Malcolmson*, the book containing the anticipation was lodged in a private room at the Patent Office and not entered in the library catalogue, it was held that there was no publication. It is impossible to lay down any hard and fast rule as to what amounts to publication. The question will always be whether, on the whole evidence, there has been such a publication as to make the description a part of the public stock of information.

By premature disclosure in a lecture or communication to a learned society an inventor may unwittingly deprive himself of his rights; but if the only publication alleged is a communication made in confidence, that does not prejudice the subsequent application for a patent.

Prior to 1885, abandoned provisional specifications were open to public inspection and might, therefore, be cited as anticipations of subsequent inventions, and indeed may still be cited as anticipating any patent dated earlier than January 1st, 1905.

Since 1885, however, the rule has been that where an application for a patent has been abandoned or become void, the specifications and drawings accompanying such application shall not at any time be open to public inspection or be published by the Comptroller.

The Patents Act of 1902, which came into force at the beginning of the year 1905, provided that no invention patented after that date should be deemed to be anticipated by reason only of its publication in a specification which is more than fifty years old, or by its publication in a provisional specification of any date not followed by a complete specification. This provision is retained by the Patents and Designs Act of 1907, s. 41 (1).

The patentee who is anxious to assure himself of the novelty of his invention will do well, either personally or through his patent agent, to make a thorough search through the Patent Office records before filing his application. The complete indexes and abridgments of specifications enable this to be done with some certainty, though where the subject matter belongs to one of the more popular fields of invention, *e.g.*, automatic couplings, the great mass of specifications bearing on the subject renders the task of searching exceedingly laborious.

International Arrangements.

Before leaving the subject of anticipation it is necessary to refer to the special rules regulating applications by persons who have already applied for patents in foreign countries. Section 91 of the Patents and Designs Act of 1907 provides that any person who has applied for protection for an invention in any one of the foreign countries with which His Majesty has been pleased to make arrangements for the mutual protection of inventions shall be entitled to a patent for the same invention in this country in priority to anyone applying in the meanwhile, provided that he applies within *twelve* months from the date of his foreign application. The effect of this is to give the foreign applicant conditional "provisional protection" in this country for the space of twelve months, so that publication of the invention in the United Kingdom by description or use during this period will not invalidate a patent subsequently granted.

By a series of Orders in Council the provisions of this section have been made applicable to all States belonging to the International Convention and to certain British colonies besides. For a complete list see p. 239. In alluding to the countries to which this section applies, it

will be convenient to refer to them compendiously as Convention countries. Similarly, applications under s. 91 are referred to as Convention applications.

Exhibitions.

The publication, and even the use, of an unpatented invention at an industrial or international exhibition, certified by the Board of Trade, will not prejudice the right of the inventor to subsequently obtain a valid patent provided the folfowing conditions are complied with, namely :—

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

(*b*) The application for a patent must be made before or within 6 months from the date of the opening of the exhibition.

For the purpose of identifying the invention in the event of an application for a patent being subsequently made, the inventor must furnish the Comptroller with a brief description of his invention, accompanied, if necessary, by drawings and such other information as the Comptroller may require.

Compliance with the above conditions will also protect an inventor against prejudice to his patent rights through the unauthorised publication or use of his invention during the period of the exhibition anywhere outside the exhibition precincts.

In the case of exhibitions held outside the United Kingdom, an Order in Council is usually issued relieving the exhibitor from these conditions.

CHAPTER III.

THE ESSENTIALS OF PATENTABLE INVENTION (*continued*).

Subject Matter and Utility.

Nothing is more difficult in a treatise on patent law than to convey an accurate idea of the *degree* of novelty and inventiveness required to make a valid patent. Innumerable judicial pronouncements have been given on this point, but all of them hark back to the same fundamental proposition, that there must be some fresh idea, some distinct advance upon what is old, and that the advance must be such as may reasonably be presumed to have called forth an appreciable degree of inventive faculty or ingenuity to achieve it. What that degree is remains indefinite. There is no absolute criterion, and it is therefore useless to attempt to frame a scientific formula to express its exact quantity. Every case must be considered on its own merits and with reference to its own special circumstances. It may safely be predicted, however, that an invention which embodies some new principle or produces a new result in a new way will certainly afford good subject matter. But inventions of this character are comparatively rare. In the vast majority of cases the invention sought to be patented consists in some small improvement in or adaptation of known devices. In dealing with inventions of this class, it is often impossible, even for skilled practitioners, to say with certainty whether the margin of fresh subject matter is sufficient to sustain a patent, for judges themselves are not infrequently at variance on this

head. The only way to form a sound judgment upon this important point is, by careful study of the decided cases, to familiarise oneself with the attitude of the legal mind towards this question. Below are given brief abstracts of some of the more typical cases, lying on either side of the hazy dividing line, which separates and distinguishes good from bad subject matter. By contrasting these examples the reader will obtain a more reliable notion of what constitutes sufficiency of invention than any number of abstract propositions could convey. Before proceeding to examine these cases, a few observations are called for upon the general principles which have governed their decision.

It is not necessary that an invention should have been the result of experiment or research. Many valuable inventions have flashed upon the mind in a moment, or have been the result of mere accident. Such was Röntgen's discovery of the power of the peculiar rays, emitted by a Crookes tube, to penetrate opaque bodies; an observation which led to the invention of X-ray photography. On the other hand, it sometimes happens that an inventor, through failure to appreciate and take advantage of what has already been done in his own line of research, arrives after tedious experiment at a point inappreciably in advance of results already attained.

The simplicity of the idea, when regarded in the light of accomplished fact, is no true test of the invention or the degree of ingenuity required in its conception. "If the apparatus be valuable by reason of its simplicity," said Lord Herschell in the case of *Siddell* v. *Vickers*, "there is a danger of being misled by that very simplicity into the belief that no invention was needed to produce it. But experience has shown that not a few inventions, some of which have revolutionised the industries of this country, have been of so simple a character that, when once they were made known, it was difficult to understand how the

idea had been so long in presenting itself, or not to believe that it must have been obvious to everyone."

The fact that a patented article has been a great or sudden commercial success raises a strong presumption that there has been ingenuity exercised in surmounting the obstacles that previously prevented the want, whether generally realised till then or not, from being met. But popularity is not conclusive evidence that real inventiveness has been called into play, any more than commercial failure is proof to the contrary.

It is no disparagement nor is it technically a limitation of an invention to call it an "improvement." All patentable inventions are in reality "improvements"; and in drafting specifications the invention is almost universally described as "relating to improvements" in such and such an art. The word "improvement" has sometimes been employed to denote that class of invention which is admittedly subordinate to and a mere development of some preceding invention, effecting the same result in a better or cheaper way; as, for instance, when an inventor himself takes out patents for improvements on his original device. It is not, however, a term of art, and has too indefinite a scope to be helpful for the purpose of classification. It may be added that the word is used in s. 19 of the Act of 1907 as designating suitable subject matter for a patent of addition (see p. 90).

Similarly, the word "combination" has been somewhat arbitrarily applied. Essentially every invention may be regarded as a combination, from the simplest contrivance to the most intricate piece of mechanism. Even though the patented thing be physically indivisible into its component elements, *e.g.*, an improved form of corrugation for iron plates, the invention is nevertheless a combination, if not of distinct material parts, at least a combination of old and new ideas embodied in material form. But in legal

phraseology the word combination has come to bear a rather restricted and specialised meaning. In this sense, it is commonly applied to inventions consisting of an assemblage of clearly distinguishable parts which, though all may be old, have never before been similarly combined. A "combination claim" is a claim embracing this conjunction of parts as a whole, and is contrasted with a claim for some component part. Used in this sense, the expression, a "combination" invention, though not a scientific definition, affords, however, a convenient description for a fairly well defined class of inventions.

A combination may consist of a dozen elements, eleven of which have been previously combined for the same purpose, but if the twelfth has not been used in that conjunction before, that will form a novel combination and may be good subject matter, provided the variation shows ingenuity and produces a better result. The variation introduced may be either by way of addition, substitution or subtraction. Mere rearrangement of the component parts of an old combination has in some cases been held sufficient to support a patent. Thus, in the case of *Patent Exploitation, Ltd.* v. *Siemens Brothers & Co., Ltd.*, the patent sued upon related to improvements in galvanic batteries, the invention consisting in a combination of the well-known elements of a primary cell, so arranged as to form an unspillable and portable battery, capable of being stored for a long period without loss of efficiency. The case went to the House of Lords and in his judgment Lord Davey, adopting the language of Sir George Jessel in a previous case, said :—"Where a slight alteration in a combination turns that which was practically useless before into that which is very useful and very important, judges have considered that though the invention was small, yet the result was so great as fairly to be the subject of a patent, and as far as a rough test goes, I know of no better."

With these preliminary observations we may proceed to the cases themselves. Those chosen for illustration are all more or less "border-line" cases. They are ranged in various categories merely to facilitate comparison; the headings do not profess to be either strictly scientific or exhaustively complete.

1. *The Application of an Old Principle, Process or Machine in a New, but Analogous, Manner.*

Baxter v. *Marsden.*—The patentee's invention related to stone and ore crushing machines, the object of the invention being the application of top-driving instead of bottom-driving to a double screen machine. Double screen stone crushers had previously been driven from the bottom; single screen machines had, however, been top-driven and evidence was forthcoming that top-driving and bottom-driving were two interchangeable alternatives familiar to engineers. *The patent was held invalid.*

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Taylor v. *Annand.*—The patent was for a device for printing late news in newspapers and consisted substantially of a short movable drum mounted on an auxiliary shaft and holding firmly on its surface a fudge box of ordinary movable type, so arranged that the face of the type was curved and concentric with the drum. Small auxiliary cylinders had been previously employed in colour printing and for certain other purposes, but it had never been suggested that they might be used to overcome the difficulty of printing stop press news. The setting of type with a cylindrical surface was old. The mounting of a fudge box on a cylinder was old. Prior to this invention, however, there was no known machine that would do in any practical or efficient way the special work done by the improved machine described in this patent. *The patent was held good.*

2. *The Application of an Old Principle, Process or Machine to a New, but Analogous, Substance.*

Brook v. *Aston.*—In this case the patentee claimed "causing yarns of *wool or hair*, whilst distended and kept separate, to be subjected to the action of rotatory beaters or burnishers, whereby the fibre is closed and strengthened and the surface effectually polished." It was proved that precisely the same method had been previously employed in the finishing of *cotton and linen* yarns. *The patent was held invalid.*

Similarly, a process for preserving smoked or dried meat by treating it with bisulphide of lime being well known, it was held that to preserve *fresh* meat by identically the same process was not patentable subject matter.

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Pirrie v. *York Street Flax Spinning Co.*—The invention related to improvements in the wet spinning of flax and similar yarns and consisted substantially in adapting to the wet spinning of flax a thin flexible tube of paper, a device which had long been used in the dry spinning of cotton and other yarns. In effecting this adaptation to the wet spinning process, some subsidiary devices, requiring a certain amount of ingenuity, were necessitated to prevent the moist paper tube from collapsing or losing its shape. The invention resulted in some technical advantages and the process was cheaper. *The patent was held good.*

3. *The Application of an Old Substance or Thing to a Novel, but Analogous, Use.*

Case v. *Cressy.*—The invention related to improvements in the construction and arrangement of breakwaters or groynes for the seashore and consisted in a fence formed by inserting braced uprights in holes, pouring in cement and finally screening the intermediate space by horizontal

planks. Rapidity in construction, superior to that attained by existing methods of erecting shore-groynes, was claimed as the feature of the invention. It was admitted that there was no special novelty in this mode of construction, and that a groyne so constructed and erected on land and used for land purposes would not be subject matter for a patent. *The patent was held invalid.*

The attachment of C springs to the front instead of to the rear of a carriage; applying to the heel of a boot an iron plate formerly used on the toe, and the conversion of a fixed rubber heel-pad into a revolving one, by making a hole in the middle and putting a screw through, have all similarly been held to be deficient in subject matter.

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Newton v. *Vaucher*.—The plaintiff's invention consisted in the use of soft metal for lining the journal boxes or bearings of machinery, the object being to diminish friction. The use of soft metal for lining certain parts of machinery for the purpose of making them air and water-tight was well known. *The patent was held good.*

In the often-quoted American braided wire case (*American Braided Wire Co.* v. *Thomson*), the invention, which was ultimately upheld in the House of Lords, consisted in applying to ladies' bustles and dress improvers, steel wire braided or plaited in a tubular form. Wire plaited in this fashion was not new, it had been used for garters, satchel handles, perches for bird cages, pillows, and a number of other purposes; but had never before been applied to bustles. The invention claimed was not simply the application of braided wire to bustles, but its application in a specified manner and there was some ingenuity displayed in the manner of clamping the tubular braided wire into the desired shape of the bustle.

4. *The Application of a New, but Analogous, Substance or Form of Substance to an Old Purpose.*

Albo-Carbon Light Co. v. *Kidd.*—The patentee claimed the use of solid naphthaline prepared in the form of sticks, rods, or pellets, for the enrichment of combustible gas. Previously, naphthaline in solution had been used for enriching gas. It was also proved that naphthaline in granular form or in the form of sticks was a thing well known for some time prior to the date of the patent, though the patentee was not aware of this. *The patent was held invalid.*

Similarly, in *McLay* v. *Lawes*, the use of calcium sulphate, precipitated in a state of fine division during the manufacture of tartaric acid, for making lagging for boilers, was held not to be good subject matter in view of the fact that native gypsum, chemically the same substance but differing slightly in its physical condition, had previously been used for the same purpose.

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Hayward v. *Hamilton.*—The invention in this case related to "improvements in pavement lights," and consisted substantially in a glass prism, so shaped that it was capable of bending the light obliquely in any desired direction so as to illuminate parts of the underlying room not directly beneath it; while at the same time it presented a flat surface flush with the ground. Glazed pavement lights were old, and prisms had been previously used as deck lights on board ship. In the latter case, however, the prism was not of the same form as the plaintiff's, nor was it used precisely for the same purpose, its function being to throw the light *both* ways. *The patent was held good.*

Similarly, in *Hinks* v. *Safety Lighting Co.*, the substitution of a flat wick for a solid round wick in a lamp was considered sufficient subject matter to support a patent, because in spite of the apparent smallness of the invention

it had the advantage of largely increasing the illuminating power of the lamp.

5. A Combination.

Wood v. *Raphael.*—The patentee's invention related to pince-nez, and claimed the combination of (1) a bridge rigid with the rim; (2) pivoted placquets; and (3) spring arms attached to the rim of the glasses. Evidence showed that eye-glasses combining features (1) and (3), were perfectly well known at the date of the patent, and that pivoted placquets had been applied to eye-glasses with spring as distinct from fixed bridges. No special ingenuity was required to adapt pivoted placquets to eye-glasses with fixed bridges. *The patent was held invalid.*

In *Williams* v. *Nye* the inventor had devised an improved mechanism for making sausages, by joining together two previously known machines, a mincing machine and a stuffing machine. The combination of these two machines was effected by prolonging the screw which forced the meat forward into the mixing apparatus so that it forced the meat, after being minced, still further on into the sausage skin. It was held that there was not such substantial exercise of inventive faculty as to make this good subject matter for a patent.

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Anti-Vibration Incandescent Lighting Co. v. *Crossley.*—The patent was for improvements in and relating to the suspension of incandescent gas lamps. The object of the invention was to avoid vibration and was effected by fitting the gas burner with a flexible connecting tube and suspending it by one or more elastic cords or springs. The claim was confined to this combination of well-known devices. There was evidence that numerous expedients had been tried to mitigate vibration, and that the patented contrivance

was more effectual for the purpose than any other in use. *The patent was held good.*

The variation of a combination by substitution introduces the question of "equivalents." It may be stated as a general rule that there is no patentable invention in taking a known combination and substituting for one of its parts something which is a well-known mechanical or chemical alternative. A modification, however, which subsequently comes to be recognised as an equivalent device, but which was not recognised as such at the time, would not fall within this rule.

In dealing with the question of equivalents it is necessary to differentiate clearly between their bearing upon cases of anticipation and cases of infringement. Though there may be no subject matter in varying a combination by the replacement of a spring by a screw, yet it does not follow that a device so modified would constitute an infringement of the other. That depends upon the ambit of the claims alleged to be infringed. If the scope of the plaintiff's patent is wide—for example, if it is a pioneer or master patent—then to achieve the same result by means of a well-known equivalent will be an infringement. But if its scope is narrow owing to the fact that the ground has already been well covered by invention, and there are numerous other devices of a very similar nature, the variation of the combination by the introduction of an equivalent, producing an appreciably better result, would probably be no infringement. But, even so, where the equivalent adopted is an obvious one, *e.g.*, the substitution of a hinge for a slide or a screw for a nail, that would not constitute such a difference as to obviate infringement. Dealing with this point in *Bunge* v. *Higginbottom* (an instructive case upon the doctrine of equivalents), Lord Justice Vaughan Williams observed:—"No one would say that if there was a patent for a machine for making bricks,

in which part of the process consisted in moving cutting wires against clay, the moving of clay against cutting wires was such a difference in the combination as to negative an infringement."

The following are some cases in which the substituted device has been held to be a well-known equivalent: the use of steel hoops instead of whalebone in a petticoat; the substitution of a hinge for a slide in a lamp; the substitution of a pivot for a hinge in a nail-making machine; the substitution of a gauze strainer for a metal strainer in a beer barrel tap.

Generally speaking, the application of a well-known thing to a well-known use is not good subject matter for a patent. But there are one or two instances in which this rule has been departed from. An interesting illustration of this is the famous case of *Muntz* v. *Foster*, where the patent was for "an improved manufacture of metal plates, for sheathing the bottoms of ships, or other such vessels." Muntz's invention was based upon the discovery that an alloy, consisting of certain proportions of copper and zinc, was less liable than ordinary copper sheathing to oxidation and was consequently more durable. The wearing away through oxidation was, however, just enough to keep the bottom of the vessel clean. There was evidence to show that plates of a similar composition of copper and zinc had previously been specified as good for sheathing, but not in view of the particular quality discovered by the plaintiff. *The patent was held good.* In summing up, Chief Justice Tindal said:—"I look upon it that there is as much merit in discovering the hidden and concealed virtue of a compound metal, as there would be in discovering an unknown quality which a natural earth and stone possessed."

It is hard to dispute the soundness of the reasoning underlying this decision, but if pushed to its logical conclusion, it might well bring about a strange state of things.

For example, suppose in the above case that the ship-builders had used this particular alloy of copper and zinc and were continually using it from time to time, without fully appreciating its advantages; Muntz could apparently, upon taking out his patent, have stopped them from doing what they had previously been accustomed to do. On the other hand, it is not easy to see how this result is reconcilable with the language of the Statute of Monopolies, which says that a patent is only to be granted for a manufacture "which others at the time of making such letters patent shall not use."

Utility.

Finally an invention must possess utility. It must do what it professes to do, and that must be a useful thing. Otherwise the patentee has got his patent on false pretences, or, to adopt the legal phraseology, the Crown has been deceived. A very slight amount of utility is, however, sufficient to satisfy legal requirements. Inferiority in quality does not argue want of utility, if the product can be produced more cheaply. But if the only professed merit of the process is that it is cheaper, and it turns out in fact to be more costly, the patent would be bad for want of utility. On the other hand no objection could be taken to a patent for making thimbles out of platinum, if it were the fact that thimbles so made were especially useful for the purpose specified. Again, utility does not signify merely industrial usefulness. Ingenious toys are useful, and an improvement in a spinning top may be as good subject matter for a patent as an improvement in a spinning jenny.

An invention may still be reckoned a useful improvement, even though in some salient quality it is inferior to previously attained results. In *Welsbach Incandescent Gas Light Co., Ltd.* v. *New Incandescent (Sunlight Patent) Gas Lighting Co.*, the plaintiffs' mantle, made of almost pure thoria, was

admittedly inferior in illuminating power to mantles hitherto made; it had, however, distinct advantages in point of rigidity and durability. But even apart from these latter qualities, the plaintiffs' invention was useful in two ways; it offered the public the opportunity of making with thoria an appliance which, up to that date, it had been suggested could only be made with zirconia and the oxides of certain other rare metals. It afforded a useful choice of another substance capable of being used in making incandescent gas mantles. In the sequel, the utility of this invention was still further vindicated, since, aided by a subsequent discovery that a small percentage of ceria will increase the luminosity, it led to the possibility of making a mantle, which was not only durable and stable, but possessed also a high illuminating power. This case also illustrates the rule that comparison with other known methods is not a test of utility.

The utility of an invention must be judged by reference to the state or knowledge at that time. But an invention which, though of no apparent or immediate utility when first patented, subsequently formed the basis of an improvement of a highly beneficial nature, could scarcely be held invalid for want of utility. It is no argument of inutility that an invention has been superseded by improvements and thereby become obsolete; for most inventions are liable to such displacement and are merely "stepping stones to higher things." Nor is the fact that it has never been tried or put into practice any proof of inutility of an invention.

Where a person has infringed an invention, he will have a hard task in convincing the Court that it is not useful. For, as Mr. Justice Kay said, in *Lucas* v. *Miller*, "Better evidence of the utility of an invention cannot possibly be had than the fact that the defendant has attempted to infringe it." Consequently, the cases in which a patent

has been held bad for lack of utility are comparatively rare.

One of the classic cases on the subject of utility is *Easterbrook* v. *Great Western Railway*. There the invention claimed consisted of improvements in machinery and apparatus for actuating and controlling railway points and signals, the professed object being to prevent the possibility of conflict between the points and signals. It was proved, however, at the trial that the patentee's apparatus could be so worked as to give conflicting signals or signals conflicting with the points. Consequently it was held that the Crown had been deceived and the patent was invalid, as the invention was not only not useful, but positively dangerous. Similarly, in the more recent case of the *Sirdar Rubber Co.* v. *Wallington*, one of the several grounds of invalidity proved against the plaintiffs' patent, which was for an improved method of fitting rubber tyres to the rims of wheels, was that if the directions given in the specification were carried out, the result would be impracticable and useless.

Even if only one of several claims is deficient in utility, that will be fatal to the whole. But this rule is sometimes relaxed, as in the case of partial failure of novelty, where the feature wrongly claimed is not an essential part of the invention, and is useless only in the sense that it is unnecessary and superfluous. Thus, in *Lewis* v. *Marling*, the patent was for an improved machine for shearing woollen cloth, and the patentee claimed, amongst other things, a brush for raising the wool on the surface of the cloth to be shorn. It was proved that this brush was entirely useless and no machines were ever constructed with it attached. Since, however, the brush was not described as an essential feature of the invention, want of utility in this respect did not vitiate the patent.

CHAPTER IV.

THE SPECIFICATION.

Assuming the applicant to be the true and first inventor and that his invention possesses the requisite degree of novelty and utility, there is still a further requirement that he must fulfil in order to obtain a valid patent. It is an inevitable condition of the grant that he shall inform the public as to the nature of his invention and in what manner it is to be performed. In other words he must frame and publish a specification of his invention. The specification must convey information sufficiently full and explicit to enable the public (as soon as the monopoly expires) to work the invention without further assistance from the inventor. This is virtually the price the patentee pays for his privilege; it is the very essence of the bargain, and, therefore, it is all important that the specification should be complete in its information and free from ambiguity; otherwise it may be said that the Crown has been deceived and the patent may be revoked. But the specification also bears another aspect. It is a public prohibition. It fences round the ground which, for the time being, is the inventor's private domain, whereon the public may not enter without leave, under pain of an action for trespass or, as it is technically termed, *infringement*. Thus the specification has a twofold function; first, to describe the characteristic features and operation of the invention, and secondly, to define its limits.

In drafting a specification, these two aspects must be steadfastly kept in view. Too frequently an inventor, over-confident of the entire novelty of his ideas, seeks to enclose

in the ambit of his claims ground to which others have already established their right. Inventors are a proverbially sanguine race and their confident assurance of the unimpeachable novelty of their inventions should always be received with caution and tested by independent investigation. A glance at the admirably classified abridgments of specifications in the Patent Office Library produces a wonderfully sobering effect, and is always a wise precaution, before filing an application for a patent. A good plan of procedure is first to draft a rough description of the invention and then to visit the Patent Office Library. Examination of prior specifications will not only reveal the extent to which the ground has already been covered, and so enable the inventor to confine the scope of his claims to what is new, but it will also show him wherein lies the real strength of his own invention, so that he may give to what is essential due point and emphasis. It may even possibly suggest further improvements and useful modifications not hitherto thought of.

The specification must be explicit. Inventors are sometimes apt to frame their specifications in such vague and indefinite language that their object seems to be rather the mystification than the enlightenment of the public. Doubtless the intention is to secure a broad patent, enabling them possibly to reap where they have not sown. But such ambiguity constitutes the weakness and not the strength of a patent. Similarly a specification sometimes claims in general terms several ways of working the invention, and then describes in detail one which turns out to be an inferior method and of little practical use for commercial purposes. A patentee, who attempts in this way to get more than he gives, defeats his own object. For it is a fundamental axiom in patent law that the patentee is bound to specify the best method known to him of performing his invention. This is not only his duty but his best policy;

for otherwise he runs the risk of a rival finding out the improved method of working and patenting it in his stead.

A specification must not embrace more than one invention. Devices essentially distinct are not deemed to constitute one invention merely because they are applicable to or form parts of a single process or machine. For example, an improved form of bicycle tyre and an improved form of bicycle saddle could not be included in one specification. The test seems to be that if one invention is complete without the other, it must be separately patented. But alternative devices for effecting the same object will be treated as one invention. This rule is, however, purely directory, and after a patent has been sealed, no objection can be taken to it in any legal proceeding on the ground that it comprises more than one invention. If the application is faulty in this respect, the applicant will probably be required to amend it so as to confine it to one invention; in which case the subject matter excluded from the original application may be embodied in one or more subsidiary applications which will bear even date with the original application or some date intermediate between that and the date of the subsidiary application, according as the Comptroller may direct.

Since elementary errors of this kind delay acceptance, and may, if they are of a serious nature, cause the Comptroller to post-date the application to the time when they are amended, it is desirable that they should be avoided.

The mistake is sometimes made of regarding the specification as a mere technical description of the invention. If that were so, no one would be better qualified to frame it than the inventor himself. A specification is, however, essentially a legal document, amenable to the same rules of construction that apply to other legal documents. Professional advice is therefore desirable, especially where the subject matter is of a complex nature. But where the

invention is simple and admits of being simply described, there is no reason why a man of average intelligence, setting out with the honest intention of describing his invention and acquainted with what has already been done in that particular field of invention, should not with the help of a few simple rules succeed in framing a perfectly sound specification.

Some of these rules have already been touched upon; a more detailed discussion of the form and construction of the specification is given in the following pages, where the subject is dealt with under five heads:—(1) Title; (2) Provisional Specification; (3) Complete Specification; (4) Claims; (5) Drawings.

Title.

In the days when a patent was granted on the faith of the description of the invention conveyed in the title alone, the Courts narrowly scrutinised the title to see whether its promise was fulfilled and justified in the subsequent specification. A discrepancy between the title and specification was fatal to the validity of the patent. The institution of the provisional specification followed by a more careful surveillance on the part of the Patent Office examiner has rendered the chance of a patent being upset nowadays through a defect in the title extremely remote. Indeed, since the Act of 1883, there has been no instance of a patent being invalidated on this ground. As, however, the same degree of vigilance enjoined upon the Patent Office examiner in discovering and correcting discrepancies between the provisional and complete specifications, has not in the past proved by any means a guarantee against the patent being subsequently invalidated on the ground of disconformity, it cannot be assumed that the danger of a defective title is wholly removed.

For the guidance of those inventors who essay the

drafting of their own specifications the following rules should be observed.

The title should not be so broad as to suggest that the invention has a wider scope than it has in fact. Thus, where a man accompanied his application with the title "a method or methods of more completely lighting cities, towns and villages," and it transpired, when his specification was subsequently enrolled, that his invention consisted simply in a new street lamp, it was held that the title was too wide, and his patent was revoked. It is scarcely likely, however, that such a title would be visited at the present time with more serious consequences than a discreet pruning by the Patent Office examiner. But where the title contains a positive misstatement, the consequences may be more serious. For example, where the title was "a machine for an expeditious and correct mode of giving a fine edge to knives, razors, scissors and other cutting instruments," and it was found that the machine would not sharpen scissors, the patent was held bad. Similarly, where the title was "certain improvements in the flageolet, whereby the fingering will be rendered more easy and notes produced that were never before produced," the addition of only one note to the gamut was held insufficient fulfilment of the promise of the title.

On the other hand, a too narrow title has proved fatal to a patent. In *Croll* v. *Edge*, the title was "improvements in the manufacture of gas for the purpose of illumination and in apparatus used when transmitting and measuring gas." In his specification the patentee had extended the scope of the title by modifying the latter part of it as follows:—"and in apparatus used *therein and* when transmitting and measuring gas" in order to make the specification cover an improved method of making gas retorts. This extension was held inadmissible.

On the whole, the applicant will do well to frame his title

broadly, provided the wording is not so pretentious as to be misleading. Vagueness or generality is not in itself an objection, if the scope of the invention is made sufficiently clear in the accompanying specification. Generic terms should be used in preference to specific terms. For example "improvements in hooks and eyes for fastening gaiters" would be better phrased "an improved fastening device for gaiters and similar articles of apparel." Where no generic term can be found comprehensive enough for the purpose, it is useful to add the expression "and the like." It is not permissible, however, to use the word "etc." by way of enlarging the scope of the title.

Fancy titles and trade names, such as "The Hercules Braces" or "The Flamingo Fountain Pen," are not admissible, nor is it allowable to include in the title the inventor's name or the word "Patent."

Provisional Specification.

The provisional specification is simply an expansion of the title. Its function is to describe the nature of the invention, with sufficient precision to make it clear, when the complete specification is subsequently filed, that the subject matter therein claimed is identical with that for which the patent was originally sought. Minute particularity is not required. It is sufficient to state the essential and characteristic features of the invention. The general object in view should be set out, but it is not necessary to specify any particular method of working. Should certain methods of operation be indicated, the applicant is not confined to these, nor bound to include them in his complete specification.

Great care should be taken to ensure that the provisional specification is wide enough to allow for developments. It is better to err by making it too broad than too narrow, for it is always possible either tacitly to drop in the complete

specification anything subsequently found to be impracticable or to expressly disclaim it, provided that by so doing the character of the invention is not altered.

An inventor will find it a good rule in drafting his provisional specification to formulate clearly in his mind the claims which he intends to put forward, so that he may be sure of making the ambit of the provisional specification wide enough to cover them.

As soon as an applicant has had his provisional specification accepted he obtains what is termed "provisional protection"; that is to say, no publication or use of the invention by himself or by others between the date of the application and the sealing of the patent will prejudice the validity of the grant.

Provisional protection is popularly regarded as though it were an advantage exclusively incidental to application by provisional specification. That is a misapprehension. It is immaterial whether the specification accompanying the application be provisional or complete, the applicant enjoys provisional protection equally in either case. The advantages which are associated in the popular mind with provisional protection are, in reality, advantages flowing from the almost invariable practice of lodging, in the first instance, a provisional specification. This practice is only departed from in exceptional cases, as, for example, where the applicant is a foreign patentee applying under the rules of the International Convention, or where there is some reason for obtaining the grant with as little delay as possible. Having made this clear, the inaccuracy may be condoned if in future the term "provisional protection" is, for brevity's sake, used to signify the effect of an application accompanied by a provisional specification.

Chief amongst the advantages incidental to an application by provisional specification are, firstly, the latitude afforded to the inventor for developing his idea without forfeiting

his right of priority or jeopardising his patent by public user, and, secondly, the possibility of deferring the printed publication of the specification ; for the provisional is only published in conjunction with the complete specification, and if the application is abandoned altogether, the provisional specification is never published.

Few inventions are ripe for practical use as soon as they are ripe for patenting ; yet it is undesirable to delay the application, while details are being worked out and put into practical shape, for fear the invention be forestalled. The provisional specification solves this difficulty. Under cover of the provisional protection so obtained, a process can be put to the test of working on an industrial scale or a new product placed on the market and adapted to meet commercial requirements, and the necessary modifications and improvements suggested by practical experience can be embodied in the complete specification. *Six* months from the date of application, with a further extension of *one* month upon payment of a fine, is the limit of time allowed for the lodging of the complete specification. Unless it is lodged within that time, the application is deemed to be abandoned. Possibly the modifications required to adapt the invention to practical use may be of such a radical nature and so far depart from the inventor's original idea, that it may be thought advisable to abandon the first application and file a second for the invention in its improved form. Provisional protection affords leisure for debating this question, and in the event of it being decided to abandon the application, the applicant may do so without further expense and without disclosure of the abortive specification.

Provisional protection is a great boon to the poor inventor, who applies for his patent in the hope of finding some capitalist to assist him in the exploitation of his invention and in the payment of subsequent patent fees. For the sum of £1 he is afforded the space of 6 months within

which he can solicit financial aid, unreservedly divulging the secret of his invention without prejudice to his patent.

The advantage gained by the deferred publication of the specification is not, of course, felt where the sale or use of the invention necessarily involves disclosure of the nature or working of the invention. But where, as is often the case, it is desired to keep an invention secret as long as possible, the suspension of the obligation to publish is of the greatest value. Apparently the utmost period for which the publication of the specification can be postponed is rather more than 15 months from the date of application.

In the ordinary course of events a complete specification is accepted two or three months after it is lodged, which, as has been pointed out, may be six or seven months after the application. It is printed for publication 15 days after acceptance. The acceptance of the complete specification can, however, be protracted by application in proper form to 12 months from the date of application or upon payment of fines to 15 months. The applicant is now relieved by the Act of 1907 from the necessity of assigning any reason in support of his request for delay.

There is some ground for saying that the time of publication might possibly be postponed still further, without prejudicing the subsequent patent, by the simple manœuvre of abandoning the first application, and (before this abandonment is signified by overpassing the time specified for filing the complete specification) filing a second provisional specification in identical terms with the first. It has been held that the provisional protection obtained on the first application enures for the benefit of the subsequent application made during the currency of that provisional protection. The case upon which this view is based (*Lister* v. *Norton*) is an old one, and must be looked upon as of doubtful authority. So far as it goes, however, it clearly supports the view above indicated.

The inventor who applies by lodging a provisional specification suffers the disability that he cannot sue in respect of any infringement committed prior to the publication of his complete specification. From this time, however, infringement becomes legally actionable; though, even so, no action can be commenced until the patent has been sealed. Except for his disability to institute proceedings for infringement, an applicant acquires, on the acceptance of his complete specification, all the other privileges and rights of a fully fledged patentee.

The Complete Specification.

The office of the complete specification is to put the public in possession of the invention in its entirety. The provisional specification (assuming one to have been lodged in the first instance) has already given a general outline of the nature of the invention; the complete specification must fill in the details and furnish full instructions as to the working. In the language of the Statute, the complete specification must "particularly describe and ascertain the nature of the invention and in what manner it is to be performed."

In drafting his complete specification, the applicant cannot do better than take a copy of the provisional to work upon, particularising, amplifying, modifying and amending it to the extent required to bring it up to date and make it perfectly clear and explicit. Vague and general expressions used in the provisional, but proving in the light of practical experience to be unnecessarily wide or requiring closer definition, should be suitably qualified. Alternative processes and equivalent devices and materials, which have been found to give equally good or superior results, should also be described, particularly in the case of "combination" inventions, since, unless they are

specifically included, they may leave an opening for a rival patent.

Analogous objects to which the invention is applicable may also be specified, provided they fall within the general purview of the provisional specification.

The rule is that the complete specification should embrace only such improvements and developments as directly flow from and are strictly supplemental to the invention foreshadowed in the provisional specification. The nature and essence of the invention must be preserved unchanged. Formerly any deviation from this rule involved the patentee in the charge of "disconformity," which, if proved, was fatal to his patent. The Act of 1907 has introduced a salutary amendment on this point, by declaring that in future mere disconformity shall not be treated as a ground of invalidation. Moreover, to eliminate, as far as possible, the defect of disconformity, the Act further authorises the Comptroller to deal with specifications which err in this respect in one of three ways. He may

(*a*) refuse to accept the complete specification until it has been amended to his satisfaction; or

(*b*) (with the consent of the applicant) cancel the provisional specification and treat the application as having been made on the date at which the complete specification was left: or (if the complete specification comprises an invention not included in the provisional), he may

(*c*) allow the original application to proceed in respect of subject matter common to both provisional and complete specification and treat the claim for the surplus matter as an application made on the date when the complete specification was left.

Although, in view of the above provisions, disconformity is no longer a fatal defect, it is, nevertheless, desirable that

it should be avoided, and that the specifications should be correctly framed in the first instance, rather than doctored into doubtful validity in the Patent Office. Consequently it may still be useful for guidance in drafting specifications to recall some of the cases in which the line of legitimate development or variation has been held to have been overstept.

In *United Telephone Co.* v. *Harrison & Co.*, a patent of Edison was attacked on the ground of disconformity for the following reason. The provisional specification described various telephonic apparatus operating electrically. In his complete specification, however, Edison included a claim for a method of recording the undulations of a diaphragm and for subsequently reproducing them. This was a perfectly distinct idea, the idea of the phonograph, which is purely mechanical, in which electricity plays no part and concerning which no hint was given in the provisional specification. The patent was held bad for disconformity.

In *Savage Bros.* v. *Brindle*, the patent related to improvements in "roundabouts." The patentee described and claimed in his complete specification certain mechanism consisting of rods and guides sliding radially on a platform so as to permit of the model horses moving either *independently* or collectively in a radial direction under the action of centrifugal force. In his provisional specification he had excluded *independent* radial movement. There was held to be fatal disconformity.

In *Castner Kellner Alkali Co.* v. *Commercial Development Corporation*, a similar contradiction between the provisional and complete specification led to the invalidation of a valuable patent for "an improved electrolytic apparatus for producing caustic soda." The provisional specification laid stress upon the mercury cathode being "stationary" and described apparatus for keeping the mercury at rest. The

complete specification included a claim for apparatus in which the mercury was kept moving.

The inventor is at liberty to dispense in the complete specification with details not of the essence of the invention; but where the thing omitted is represented in the provisional specification as an integral part of the invention, its omission in the complete specification has been held in the past to constitute a fatal disconformity. Thus in an old case, *Bailey* v. *Roberton*, the patentee described a process for preserving meat or fish by coating it with a preparation of bisulphite of lime and gelatine. In the complete specification the claim was for using bisulphite of lime alone for this purpose. It was held that gelatine being an integral part of the invention as set out in the provisional specification, a claim for the use of bisulphite of lime alone was a claim for an invention wider than and essentially different from that originally foreshadowed.

Where an invention consists in obtaining a new result by novel means, and is properly described in the provisional specification, it is perfectly legitimate to lay emphasis in the complete specification on the importance of certain old features, not specially described in the provisional specification.

In determining what may be safely added, by way of development, in the complete specification, a good test is afforded by considering whether the proposed addition would, in itself, constitute good subject matter for a separate patent; if it would, then it is safer to patent it separately.

In that event care must be taken to draft the claims of the first patent so as clearly to exclude the subject matter of the second. If this precaution is not taken, the danger of a conflict between the two patents will seriously affect the chance of subsequently disposing of either. No one would buy patent No. 2, if doubt existed as to his right to work under it without a licence from the owners of patent

No. 1, and the value of the latter would be depreciated owing to the ambiguity of its scope.

If the inventor, shortly after filing his provisional specification, succeeds in working out important developments of his invention, it may be worth his while at once to lodge another provisional specification covering these improvements instead of waiting till he is ready to file his complete specification. For by so doing he will obviate the risk which otherwise exists of some rival inventor patenting these improvements and subsequently opposing the original inventor's application on the fourth ground of opposition, mentioned on p. 95. The Act of 1907 has introduced a special provision, in s. 16, enabling an applicant to protect the development of his invention in the above manner. It provides, in effect, that where the same applicant has put in two or more provisional specifications for inventions which are cognate or modifications one of the other, these may, with the sanction of the Comptroller, be united in a single complete specification and be covered by a single patent. A patent granted in these circumstances will bear the date of the earliest of the applications, but in considering the validity of the patent in any proceedings in which it is called in question, the Court or the Comptroller, as the case may be, will pay regard to the respective dates of the provisional specifications.

The general statement that a complete specification must be clear and explicit involves the compliance with certain more or less definite requirements which may fitly be expressed in the form of rules.

1. *The specification must be intelligible to workmen of good average understanding and skill in the particular art concerned.*

The specification of an electro-chemical process may be incomprehensible to a competent mechanic, or a description

of an improved power loom may convey little meaning to a skilled carpenter; but that is no condemnation of it. Each art has its own technology and vocabulary, and the patentee is entitled to assume that the reader is familiar with the terms current in that art to which his invention belongs. The language should be sufficiently plain, however, to enable a man equipped with such knowledge to grasp the nature of the invention without the necessity of making experiments to discover what the invention is or how it works. But experiments for this purpose must not be confused with the preliminary experimental trial and practice that are usually essential to gaining proficiency in new and difficult operations.

The instructions given must be explicit, but well-known and obvious details need not be described. The common sense of the inventor must determine how far it is necessary to particularise.

Two illustrations will be instructive on this point. In *Hinks* v. *Safety Lighting Co.* the patentee, in describing an improved form of gas burner, specified that for the admission of the air "a circular hole is made in the cone or deflector through which the circular flame passes." Nothing was said as to the position or size of the hole, and there was no indication in the drawings to show at what point the air was to be admitted. The efficiency of the burner depended upon the regulated admission of air. It was proved that there was no common knowledge which would enable a workman to say, without experiment, where the air-hole should be. The specification was held bad for insufficiency. On the other hand, in *Patent Exploitation, Ltd.* v. *Siemens*, the omission to specify that there should be a vent-hole at the top of a galvanic battery for the escape of the gases given off, was held not to be a fatal objection, since the necessity for providing such a hole was well known.

2. *All ambiguous expressions must be defined.*

If to attain success it is necessary to use some particular form of the material specified or to apply it in a particular way, this should be clearly stated. Thus, in *Wegmann* v. *Corcoran*, in describing a new process for grinding meal by means of rollers, the patentee specified that the rollers should be covered with china. It was proved that several common kinds of china would not produce the desired result, and the patent was held bad on the ground of ambiguity.

So, for example, if nickel is specified, without further direction, and it turns out that to answer the purpose the metal must be prepared in some special way, not obvious and as to which no hint is given, that will be a bad specification.

3. *The specification must be framed in good faith.*

The inventor must disclose to the public the best method of performing his invention with which he is acquainted at the time of filing his complete specification. If he knows a better method than the one specified, his patent will be vitiated by omitting a description of that way. In the language of Lord Coleridge in *Heath* v. *Unwin*, "If the inventor, knowing of two equivalent agents for effecting the end, could, by the disclosure of one, preclude the public from the other, he might for his own profit force upon the public an expensive and difficult process, keeping back the simple and cheap one, which would be directly contrary to the good faith required from every patentee in his communication with the public."

4. *The specification must not contain false statements or misleading suggestions.*

It has already been shown that a misstatement as to the utility or novelty of an essential part of the invention is

fatal to validity, and similarly any other error going to the essence of the invention is equally fatal.

The patentee is not required to propound any theory accounting for the phenomena of his invention, and unless it is necessary for the better understanding of its practical working, theory is better left out of the specification. Provided the invention is sound and useful, however, the fact that the patentee gives an unsound theory will not, according to a recent decision, be fatal to the validity of his patent. But where the theory propounded in the specification is positively misleading or used to mask the piracy of another's invention, or to bolster up the pretence of novel effects alleged to be produced by some trifling or specious modification of a well-known process, that would undoubtedly be a sufficient reason for holding the patent invalid.

An instance of a misleading specification is afforded by the old case of *Savory* v. *Price*. The patent was for making *Seidlitz* powder. Elaborate recipes were given for preparing the 3 ingredients of which the powder was compounded. These ingredients in reality were nothing more than Rochelle salt, carbonate of soda, and tartaric acid. The specification gave the impression that a laborious process was required for the production of these ingredients, whereas, in fact, they might be bought ready-made at any chemist's shop. The specification was held to be bad.

A more recent illustration is to be found in the case of *Owen's Patent*. This patent was for "an improved manufacture of artificial stone, marble and the like." In his specification the patentee, after describing a well-known process for making artificial stone, which consisted in mixing dry sand and unslaked lime in a mould box which was tightly closed and placed in a cylinder, the cylinder being afterwards filled with water into which steam was introduced to give heat and pressure, proceeded to point out two alleged defects in this process. First, he said,

large quantities of air and gas were forced into the mould box and produced cracks in the stone; secondly, that owing to insufficient temperature the stone was soft and friable and required to be kept some time before it was fit to use. These alleged defects he proposed to remedy by using distilled water and by introducing superheated steam through heating coils, thereby avoiding the direct admission of steam or air into the water and at the same time obtaining a higher temperature. Evidence showed that the use of water deprived of air was unnecessary and that the high temperature specified produced no practical advantage. The patent was accordingly held bad.

5. *The patentee must specify wherein his invention lies.*

This, it will be said, is properly the function of the claims. That is true, but since the claims frequently do little more than refer back to the invention "as hereinbefore described," it is essential that there should be no ambiguity upon this point in the specification itself.

No new process or machine can be described without at the same time describing a great many things that are old; the patentee must, therefore, take care that he clearly differentiates between what is old and new. He is not, of course, expected to disclaim things that are well-known and obviously old. If, for example, he had occasion to introduce a hinge into his machinery, it would be absurd for him to point out that the hinge is not new. Nevertheless, if he should, in fact, claim a manifestly old thing, the absurdity of his doing so will not save him from the consequence.

Where an invention consists of a new combination of old, or partly old, elements, especial care must be taken to restrict the claim to the combination, or to such subordinate parts as are new. A general claim to the invention as described, is liable to be construed as a claim to the component parts as well as to the whole.

Thus, in *Haws* v. *Harding*, the specification described an improved watering-pot of a canister shape with a carrying handle and a tipping handle, and claimed in the compass of a single claim:—(1) the canister shape; (2) the make, shape and position of the tipping handle; (3) the introduction of the particular handle. The patentee added, "This new invention forms a watering-pot that is much easier to carry and tip" and then proceeded to expatiate in detail upon further advantages. It was held that this was a claim for a combination *plus* a claim for these three things as separate elements and, these elements being individually old, the patent was invalid. Similarly, where a new result is obtained by a certain series of well-known processes, the patentee should make it plain that it is the sequence and not the individual steps for which novelty is claimed.

If, on the other hand, the invention depends upon some modification in one of the steps in a well-known sequence of operations, or in some part of a well-known mechanical device, the inventor cannot claim the entire combination as new, but must restrict himself solely to the particular improvement.

It is not uncommon for a patentee, who has invented some slight improvement upon an existing process or machine, so to frame his specification as to lead the public to suppose that his is a pioneer or master patent and to confuse the improvement with the more important invention upon which it is grafted. If an application framed upon these lines is opposed by the true master patentee. the Comptroller will usually require a specific disclaimer inserted in the subsequent specification referring by number and date to the prior patent, or else a general disclaimer of the subject matter covered by the prior patent. Disclaimers will be discussed more in detail in the chapter dealing with Opposition; here it is sufficient to say that it is far preferable to draft the specification in the first instance in such a

way that there is no need for the Patent Office subsequently to amend it by means of disclaimers and references.

A convenient manner of defining the scope of the invention is to refer at the beginning of the specification to the existing state of the art or to the particular process to which the improvement relates. When, however, particular reference is made to some prior patent, the subsequent patentee should not go out of his way to point out defects in the previous process, but content himself with stating that his invention is an improvement thereon.

Claims.

The complete specification must conclude with a distinct statement of the invention claimed, to which the public may turn to ascertain how nearly they may approach the patentee's preserve without exposing themselves to an action for infringement. Claims are not concerned with a detailed description of the invention nor with its operation and advantages; their sole purpose is to indicate in the plainest possible manner the scope and limits of the patentee's monopoly. They are intended to convey more precise information on this point than can be gathered from the preceding description. Their function is not to claim anything that is not claimed in the specification, but to *disclaim* something. They should form an independent and succinct summary of the invention, and do more than merely refer the reader back to the body of the specification. A claim, for example, for "A galvanic battery constructed substantially as hereinbefore described" would appear hardly to comply with the statutory requirement that the claim shall be a "distinct statement." As, however, this provision is purely directory, such a claim as the above would involve no worse consequences than possible amendment at the hands of the Comptroller. Though literally distinct from the

specification, the claims are not to be construed independently of the foregoing letterpress; they are an integral part of it and must be read in close context with the description, each being mutually supplemental to the other in supplying deficiencies and clearing up ambiguities.

In *Edison & Swan* v. *Woodhouse* the patentee claimed the use of hydro-carbon gas, carbon gas and carbonic gas for certain purposes. Objection was taken that these general terms included gases, such as carbonic acid, which were quite unsuitable. Upon this Lord Lindley said: "Every claim in every patent must be read and construed with reference to the specification and not as if the claim was an isolated sentence having no connection with or reference to what precedes it. To see what is meant by carbon gas we must turn to the specification, and when we do, we cannot conceive that anyone reading the specification fairly, with a view to understanding it, would ever dream for a moment that carbonic oxide or carbonic acid would answer the purpose and could be meant by carbon gas." A valid claim can never cover more than is described in the specification. It is not, therefore, in reality a limitation of the claim to qualify it with the expression "as hereinbefore described." Indeed, so far from limiting the scope of the invention, the addition of these words might even have the effect of extending it, for without them a claim may easily embrace something less than the invention specified. These words are, therefore, only useful as a safeguard against the patentee claiming something which is not described in the specification and which consequently, if included in the claim, might invalidate the patent.

In an invention consisting of a combination of well-known elements it is usually impracticable, in the small compass of the claim, to indicate the novel arrangement of parts which characterises the invention without referring back to the specification. Where possible, however, the

claim should speak for itself and give a separate and distinct statement of the invention. It must be focussed upon the precise point of novelty which constitutes the invention. Because a man has introduced some variation or improvement into a known apparatus, that does not entitle him to claim the whole apparatus. This point is well brought out by Lord Hatherley in the case of *Harrison* v. *Anderston Foundry Co.* "It is not competent," said his Lordship, "for a man to take a well-known existing machine and, having made some small improvement, to place that before the public and say 'I have made a better machine. There is the sewing machine invented by so-and-so. I have improved upon that. That is mine. It is a much better machine than his.' That will not do. You must state clearly and distinctly what it is in which you say you have made an improvement."

An applicant is not restricted to any number of claims; but unnecessary multiplicity of claims or prolixity of language should be avoided. Thus in *Bancroft's Application*, where the specification concluded with 23 claims framed on the American principle of attempting to deal with every possible contingency, exception was taken to it by the Patent Office on the ground that such multiplicity of claims, involving as it did a good deal of repetition, offended against the rule that claims must be "clear and succinct." On appeal the Comptroller's decision was upheld by the judgment of both Law Officers and the number of claims was accordingly reduced to five.

A defect in a single claim, whether it be in point of novelty or utility, is sufficient to invalidate the entire patent, unless, as has already been pointed out, the claim is a subsidiary one and does not enlarge the scope of the main claim upon which it depends, or unless it is capable of being cured, in the manner explained in another chapter, by amendment.

Drawings.

Drawings should accompany the specification, where they are needed to assist or illustrate the letterpress description. They are looked upon as forming part of the specification. Consequently, when a claim is made for the invention "substantially as described," these words refer to the description given in the drawings no less than that in the letterpress. An arrangement shown only in the figures, and necessary to the utility of a machine, has been held to be incorporated in the claim by such a phrase as the above. Where several devices are described in the specification and it is only found necessary to illustrate one particular device, the drawing will not be taken as in any way restricting the claims. The drawings must be line drawings, executed in black ink on smooth white paper of medium thickness without tone or colour, and adapted for reproduction by the process of photolithography. They may be drawn to scale or in perspective. The drawings must be furnished in duplicate, one marked "Original" and the other "True copy." Applicants intending to make their own drawings are recommended first to study carefully the rules issued by the Patent Office regulating the form and preparation of drawings. These requirements are extremely precise and failure to comply with them will involve the applicant in delay and trouble.

Specimens.

Following the practice of the German Patent Office, the framers of the Act of 1907 have introduced a provision enabling the Comptroller, when he thinks it desirable, to require the deposit of typical samples and specimens of the invention. This provision applies only to applications relating to chemical inventions, and is designed to check the filing of purely speculative claims for products, the

manufacture of which, though deducible on theoretical grounds, has never been actually tried. Where specimens are required, they must be furnished before the acceptance of the complete specification. The fact that samples or specimens have been furnished is notified to the public by a statement to that effect printed on the complete specification.

CHAPTER V.

THE CONSTRUCTION OF THE SPECIFICATION.

THE same rules which govern the construction of other legal documents are equally applicable to the interpretation of a patent specification. The language will be given its ordinary and natural meaning, technical and scientific terms being interpreted, by the help of expert evidence, according to their common usage amongst those versed in the art or manufacture under consideration.

In reading the specification, the Court will place itself in the position of a person acquainted with the technology of the subject as it was understood at the time when the specification was framed. As science advances, scientific terms are constantly undergoing modification. The tendency is to closer definition. Special terms become generic as fresh species are discovered. Language, therefore, which at the date of the invention was accurate and explicit, sometimes appears in the light of later knowledge to be vague and insufficient. This is well illustrated by the case of the *Badische Anilin und Soda Fabrik* v. *Levinstein*. There an action was brought for the infringement of a patent for certain methods of preparing colouring matter from naphthylamine. The defendant contended that there were two well-known forms of naphthylamine, designated respectively "alpha" and "beta" naphthylamine, of which the latter was unsuitable for the process, and that, as the specification did not say which of these was to be employed, it was consequently bad for insufficient description. It was proved, however, that the "alpha" variety was the only

commercial form of naphthylamine recognised at the date of the patent, and that the "beta" form only existed at that time as a costly laboratory product known to a few expert chemists. The Court held that, having regard to the state of knowledge at that time, the specification was sufficiently explicit.

If the patentee finds it necessary to coin new words or to employ ordinary or technical terms in an unusual and special sense, the Court will construe them in the sense intended, provided the specification makes their meaning perfectly clear. Where the language of the specification is ambiguous and admits of two interpretations, both equally sensible, the Court will be disposed to adopt that version which is most favourable to the validity of the patent. Thus, in *Reason Manufacturing Co.* v. *Moy*, the claim was for "the construction and arrangement of electrical fuse and cut-out boxes or covers which automatically prevent access being obtained to more than one at a time." Had this been construed as a broad claim for all arrangements effecting that result in an automatic manner, the patent could not have been sustained; but the Court was disposed to take it with the whole specification as a claim for the particular construction and arrangement described. On the same principle, where a patentee describes his invention as being an improvement on what he has already patented, the Court will not readily construe the specification as claiming over again anything which formed the subject of the former patent.

This judicial attitude towards an ambiguous specification has given rise to the idea that the Court will always place a benevolent construction upon a specification. But such an idea is based upon a misapprehension of the law. It is a common rule of construction applicable to all documents alike, that where the language is ambiguous an interpretation which gives effect and validity to the document should

be adopted in preference to one which would make it futile or void. But if the meaning is free from doubt, the doctrine of benevolent construction has no place, and the attitude of the Court towards the inventor is strictly impartial.

In delivering judgment in the galvanic cell case, *Patent Exploitation, Ltd.* v. *Siemens*, Lord Davey said:—

> "My Lords, I disclaim putting either a benevolent or malevolent interpretation on the specification, or being astute either to uphold or invalidate the patent. I am of opinion that a specification, like any other document, should be construed by the Court according to the fair meaning of the language used, after being informed by the evidence of the nature of the subject matter, the state of knowledge at the date of the patent and the meaning of any scientific or technical words that are found in it."

Following another well-recognised canon of construction, the Court will endeavour to give an effective meaning to every part of the specification. Thus, where two claims appear upon one view to claim identically the same thing, but upon another view one may be regarded as the broader claim, the Court will be disposed to adopt the latter construction, even though such reading of the claim involves the patentee in claiming what is old. Mere redundancy of claims, however, is not a vital fault, nor will palpable errors or mistakes unlikely to mislead the public be allowed to affect the validity of the patent.

In the case of *Beard* v. *Egerton* it was sought to upset a valuable patent on the ground of an error in the specification. The patent was for a new photographic process. The specification, after describing the process for coating the plate with a sensitive film of iodine, directed that, just before the moment of using the plate in the camera, it was to be treated with nitric acid and rubbed lightly with pounce. Such treatment at this stage would obviously have ruined

the plate by removing the film. The Court held that it was clearly the intention of the inventor that the polishing process should precede the sensitising process, and construed the specification accordingly. Similarly, obvious errors in the drawings, such as would not mislead any competent workman, do not militate against the validity of the patent.

On the other hand, where the patentee has deliberately claimed something that is not new, the Court will not put a forced construction on the specification, as not intending to claim what is old, simply because it was foolish or suicidal of the patentee to claim it.

The rules of construction adopted by the Courts in dealing with combination patents are of a somewhat special nature. Allusion has already been made to the rule that where a patentee desires to claim only a novel arrangement of old elements, he must specifically confine his claim to the combination, otherwise the Court may construe his claim as covering also the component parts. But there is also another important point of construction affecting combination patents to be noticed. It concerns the attitude of the Courts in reference to two distinct types of combination invention, known respectively as the "*Proctor* v. *Bennis*" type and the "*Curtis* v. *Platt*" type.

The case of *Proctor* v. *Bennis* is a typical illustration of a combination invention in which there is not only novelty in the machine, but novelty also in the effect and result produced. The invention in this case was a combination of tappets, shafts and springs in connection with an intermittently and radially acting flap or door, the whole forming a new kind of mechanical stoker. Throwing coal on to a furnace by the intermittent radial action of a flap or door was new, and nothing of the kind had been done before. The defendants had taken the underlying principle of this invention, merely varying it by the substitution of mechanical equivalents for some of the main features

of the plaintiff's apparatus. The Court held that, as the plaintiff was the first to enunciate the principle of an intermittent radial stoker, he was entitled to have his claims broadly construed so as to prevent others from evading his patent by the use of obvious mechanical equivalents.

In *Curtis* v. *Platt* the patent was for improvements in spinning mules. A spinning mule was a well-known machine for producing well-known results. The patentee's invention consisted in a novel arrangement of parts, and it was held that he must be tied down strictly to the precise arrangement which he claimed. For where the essence of an invention is itself nothing more than the substitution of mechanical equivalents in a well-known machine, the patentee cannot prevent another from using the same machine in which the parts are differently combined, or modified by the substitution of a different set of mechanical equivalents. His claim would not, however, be construed so narrowly as to disable him from stopping a mere colourable imitation of his apparatus.

The rule of construction embodied in these two cases is well stated by Lord Hatherley in these words:—

> "Where a thing is wholly novel and one which has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and jealously upon any other machines for effecting the same object to see whether or not they are merely colourable contrivances for evading what has been done before. When the object itself is one which is not new, but the means only are new, one is not inclined to say that a person who invents a particular means of doing something that has been known to all the world long before has the right to extend very largely the interpretation of those means which he has adopted for carrying it into effect."

CHAPTER VI.

WHO MAY APPLY FOR A PATENT.

ANY person, whether he be a British subject or not, may make an application for a patent, *provided he is the true and first inventor or applies jointly with the true and first inventor.*

The expression "true and first inventor" includes, as has been already pointed out, any person importing from abroad an invention which at the time of introduction is new within the realm. Hence it is common to see a specification headed "communicated from abroad," the applicant in such a case being usually a patent agent. The importer need not, however, be the agent of the foreign inventor. The manner in which he obtains the secret of the invention is quite immaterial. It may be by fair or unfair means. That is not enquired into by the Patent Office. But the foreign inventor has this protection against any person stealing his invention and patenting it in England, that under s. 91 of the Act of 1907, he can, by applying within 12 months of the date of his first foreign patent, get an antedated British patent and so defeat any application that may have been lodged during that period in fraud of his rights.

No exception is taken to the personal status of the applicant. An infant, an alien and a married woman are all equally eligible as patentees. The Patent Office is also indifferent to the mental condition of the applicant. If, however, he is a certified lunatic, the application must be made through his guardian or committee.

A corporate body stands on a different footing, since, being merely a legal entity and having no mind, it is incapable of invention. A company, therefore, must be associated in the application with the real inventor, whether he be a member of the company or not. To this rule there are two exceptions; (1) A corporation may be the sole applicant where it is the importer of the invention, for example, where it applies in respect of an invention communicated from abroad: (2) A foreign corporation which has obtained letters patent in a country belonging to the International Convention may apply for a British patent in its corporate name under s. 91 above mentioned. Applications by a corporation must be made under the company's seal.

As the result of a recent decision it appears that where a company owning letters patent is wound up, the patents merge in the Crown and *ipso facto* cease to exist.

A firm, as such, cannot apply for a patent, but a joint application may be made by all the individual members of the firm or by some member on their behalf, subject to the rule requiring the true and first inventor to be a party to the application (except in the case of an invention imported or communicated from abroad). Should an inventor die before applying for his patent, his legal representative can make an application on his behalf. The time limit within which such an application was formerly required to be made has now been abolished.

Frequently applications are made in the joint names of the inventor and some other person acting in the capacity of capitalist, who by becoming co-patentee retains some control over subsequent dealings with the patent. It should, however, be pointed out that, apart from any express agreement to the contrary, co-patentees have each the right to work the patent on their own account without the consent of the other and without accounting for profits. A capitalist,

therefore, who enters into an arrangement with an inventor, even though he be joined as co-patentee, will do well to have a carefully drawn agreement defining their respective rights as to the sharing of profits, the granting of licences and the disposal of the patent in the event of mutual disagreement.

The true and first inventor is not the man who first conceives the idea, but he who first publishes his invention. Thus, to cite an old case, a certain Dr. Hall discovered a new method of making object glasses for refracting telescopes, but kept his discovery a secret and never put it into practical use, so that when he died, the world was none the wiser for his invention. Some time afterwards, the optician Dollond invented the same thing and patented it. It was held that Dollond was the true and first inventor (*Dollond's Case*).

Difficult questions sometimes arise where an inventor employs an assistant to work out his ideas and put them into practical shape. It frequently happens that a workman, engaged to elaborate the details of an invention, makes some improvement or introduces some novel feature which in itself would be good subject matter for a patent. In such a case the question may be asked : Is the inventor who originated the fundamental idea and sketched out the lines of research or the assistant who devised an ingenious method of realising the desired end, properly entitled to patent the perfected invention? The true answer to the question must depend upon the precise facts in each case, but the principle seems to be this. If the improvements suggested by the workman are strictly accessory to the main principle, tending to carry it out in a better manner, such improvements are the property of the inventor of the original principle and may be embodied in his patent. Thus in a recent case (*Smith's Patent*) an inventor, Y, having conceived an idea for an improved method of ginning cotton,

engaged and paid a mechanical engineer, S, to prepare working drawings and to elaborate the details. The engineer subsequently took out a patent for the machine. Y presented a petition for revocation and the patent was revoked, the judge holding that Y was the moving spirit and the real initiator of the idea, worked out through the instrumentality of S.

On the other hand, in *Marshall and Naylor's Patent*, it was the employee who was held to be the true and first inventor. The facts were briefly these. A workman in the employ of a company was asked by one of the directors to invent a tap which would, by the introduction of steam into cold water, give hot, warm or cold water as required. The employee worked upon the idea, made drawings and models and perfected in all its details a tap which answered the desired purpose. By way of remuneration the company paid him £10 for overtime work on the models and subsequently without the workman's knowledge a patent for the tap was taken out in the joint names of the director and another. On hearing of this, the workman petitioned to revoke the patent, and an order revoking it was accordingly made.

It is plain, therefore, that the mere relationship of master and servant does not disqualify a servant from taking out a patent in his own name for an invention made by him during his term of service, notwithstanding that the invention may be germane to his employers' business and have been carried out in the time and with the money and materials of his employers. But the question is a very different one, whether an employee who has taken out patents in such circumstances could, upon parting company with his employers, legally insist upon retaining and enforcing against them the patents he has taken out for inventions made whilst in their employ and at their expense. In view of recent decisions it seems that he could not, and that in such a case the Court would probably direct that the

patentee should hold the patents solely as trustee on behalf of his late employers.

In order, however, to guard against difficulties of this kind, business men and companies, engaging chemists or mechanics to work out improvements in their factories, will be well-advised to enter into an express agreement with them, clearly reserving to themselves all the products of their employee's invention. This is usually done by obtaining from the inventor an undertaking to assign, when desired, all patents for inventions or improvements which he may make whilst in their employment, or even after leaving their employment, in so far as they are germane to their business.

A less drastic form of agreement would be that the employer should have the option of being joined as co-patentee of any inventions that the inventor might make during his term of service.

Having now ascertained who may properly apply for letters patent, the next step is to consider the means necessary to be taken for obtaining the grant.

CHAPTER VII.

HOW TO OBTAIN A PATENT.

For the various steps that have to be taken in the course of patenting, special printed forms are prescribed. These forms, each of which is distinguished by a particular number, according to the nature of the application, may be obtained on personal application at the Inland Revenue Office, Royal Courts of Justice, Room No. 6, Strand, London; or, at a few days' notice and upon prepayment of the value of the stamp, at any Money Order Office in the United Kingdom. For convenient reference a complete list of these forms, with their distinctive numbers and appropriate fee, is given in Appendix A, page 236.

Assuming that the applicant desires to apply in the usual way by filing in the first instance a provisional specification, he will obtain Form No. 1 (which must be impressed with a £1 stamp) and two copies of Form No. 2, unstamped. These forms must be filled up in accordance with the directions contained in the marginal notes. Form No. 1 must be signed by the applicant or applicants personally; in most of the other communications the signature of the authorised agent, if a patent agent is employed, is sufficient. Upon the back of this form the applicant must state to whom he desires communications from the Patent Office relative to the application to be addressed.

The formal part of Form No. 2 must be filled up so as to exactly agree in all particulars with Form No. 1. The provisional specification is begun at the foot of the form and

continued on sheets of foolscap of similar size, and with a margin of at least 1½ inches. It must be written with ink in large legible characters and must be dated and signed at the end. The several sheets should be fastened together at the top left-hand corner, and addressed to the Comptroller, Patent Office, 25, Southampton Buildings, Chancery Lane, London, W.C. They may be left at the Patent Office by hand or posted. The certificate of receipt issued when the application is lodged does not confer provisional protection; this follows upon acceptance, but dates as from the day of application.

An application in respect of an invention communicated from abroad is required to be made upon Form No. 1a, and applications claiming priority under international or colonial arrangements upon Form No. 1b. Special forms are also prescribed for applications for patents of addition and for secret patents (*qu. v.*).

As soon as an application is lodged, the accompanying specification and drawings are at once submitted to one of the Patent Office examiners, who reports to the Comptroller whether the nature of the invention is fairly described and whether the application, specification and drawings have been prepared in the prescribed manner; whether the title sufficiently indicates the subject matter of the invention, and whether the specification comprises one invention only. If defective in any of these particulars, the papers are returned for correction and the application will not be proceeded with until the required amendment is made. If serious amendment is required, the Comptroller may direct that the application bear date as from the time when the requirement is complied with. The applicant is duly notified of the acceptance of the provisional specification.

The complete specification is begun on Form No. 3 and continued, like the provisional, on supplementary sheets. It must be furnished in duplicate, one copy bearing a £3

stamp. In the ordinary course the complete specification must be lodged within 6 months from the date of application. One month's extension of time can be obtained by applying on Form No. 6, impressed with a £2 stamp.

The complete specification having been duly lodged, the application again comes before the examiner for scrutiny as to its compliance with formal requirements. His duty is to see that the nature of the invention is fairly described, and that the title sufficiently indicates the subject matter of the invention, and that there is no disconformity between the provisional and complete specifications. If faulty in any of these respects, the Comptroller may refuse the application altogether, or he may require the defects to be amended before proceeding with the application. He may also, if he thinks fit, post-date the application to the time when the required amendment is made.

The decision of the Comptroller is subject to appeal to the Law Officer, who, after hearing the applicant and the Comptroller, will finally determine the question at issue.

Up to this point the attention of the Patent Office has been confined to seeing that the application and specification are in due form, and prior to 1905 the duties of the examiners went no further. The Patents Act, 1902, however, introduced an important innovation which came into force on the 1st of January, 1905, requiring a limited investigation to be made as to the alleged novelty of the invention claimed.

The rules regulating this practice have been substantially re-enacted in s. 7 of the Patents and Designs Act, 1907, and provision is made in s. 8 for considerably extending the scope of the investigation. As the latter section does not come into operation at once, but at some future date to be fixed by the Board of Trade, it will be convenient to deal with the procedure prescribed under

these two sections separately. The practice under s. 7 is shortly as follows:—

As soon as it has been ascertained that the complete specification deposited is in due form, a search is at once made to discover whether the invention claimed has been wholly or in part claimed or described in any specification (other than a provisional specification not followed by a complete specification) published within the 50 years preceding the application in question. If on investigation it appears that the invention has been wholly or in part claimed or described in a preceding specification, the examiner informs the applicant who, if the objection is well founded, will be wise to amend his specification so as to avoid trenching on the ground covered by the prior specification. The time within which an applicant may leave his amended specification is 2 months from the date of the letter informing him of the anticipation.

In due course the examiner reports to the Comptroller the result of his investigations. If the Comptroller is satisfied that the objection has been removed or that it is unfounded, he accepts the specification. If, however, he is not so satisfied, the applicant is given an opportunity of appearing before him and arguing his case. If the applicant does not desire a hearing, or if after a hearing he does not succeed in removing the Comptroller's objection by amending the specification to his satisfaction, the Comptroller has two courses open to him. He may direct that a reference to the anticipating specification or specifications be inserted by way of notice to the public, or if he is satisfied that the invention claimed by the applicant has been claimed *wholly and specifically* in a prior specification, he may refuse to grant a patent at all.

Where the Comptroller determines that a reference must be inserted, it is inserted after the claims in the following form:—"Reference has been directed in pursuance of

s. 7, sub-s. 4, of the Patents and Designs Act, 1907, to specification No. ——, of ——."

If the examiner finds that a specification has been *wholly* anticipated, without further investigation he makes what is called a "provisional" report to the Comptroller. When the official reference is inserted as the result of a provisional report, a statement to that effect is added to the reference.

The reports made by examiners as the result of their investigation as to novelty are not published or open to inspection, unless the Court certifies that their production or inspection is desirable in the interests of justice.

The power which the Comptroller now wields, of refusing, at this stage, the grant of a patent, is newly conferred by the Act of 1907. Previously, the utmost that the Comptroller could do by way of condemning a patent was to brand it with the official reference. At the same time, it is to be observed, his power of refusal is narrowly restricted, its exercise being confined to cases in which there is entire and specific identity in the claims of the two specifications. Instances, therefore, in which the Comptroller can refuse the grant outright must necessarily be extremely rare. On the other hand, the mere existence of this ultimate power of refusal renders it probable that the penultimate expedient of requiring the insertion of the official reference will be rather more freely used.

Whenever, as the result of the Comptroller's decision, an official reference is inserted in the specification it is a very serious matter for the patentee. For it plainly signifies to the public that, in the opinion of the Comptroller, the patent is invalid, and there is very small chance of commercial success for a patent upon which the Patent Office has set this mark of disapproval. In fact an applicant, whose specification has been thus branded, will scarcely find it worth his while to persevere in his application. Should

he do so, he will probably have to face opposition from the proprietor of the patent to which attention is called by the reference, coupled with the practical certainty of defeat. For the opponent will be asking the Comptroller's decision on a matter which is already *res judicata*, the Comptroller having already committed himself to the opinion that the applicant claims something which is claimed or described in the opponent's specification.

The decision of the Comptroller under this section is subject to appeal to the Law Officer, whose judgment is final in the matter.

Though not infallible, this investigation by the Patent Office into the novelty of the applicant's invention appears, on the whole, to be beneficial, inasmuch as it frequently results in the conversion of a bad specification into a good one by suitable amendment of the claims and more precise definition of the scope of the invention. The statistics for the year 1906 show that more than 50 per cent. of the complete specifications accepted by the Comptroller were amended as the result of official investigation, and it may be safely assumed that in the great majority of cases the amendment was for the better.

It should be remembered, however, that searches carried out by the Patent Office examiners, though thorough as far as they go, are not exhaustive. The investigation is confined to prior specifications, and leaves unexplored the vast continent of general scientific literature. The inventor must not, therefore, take the acceptance of his application by the Patent Office as being in any way a guarantee of the validity of his patent on the score of novelty.

The object of the new procedure prescribed under s. 8 is to extend the investigation under the preceding section to specifications published *after* the date of the application in respect of which the investigation is made, but deposited pursuant to a *prior* application. It is

expressly provided that, for the purposes of this section, one application shall be deemed to be prior to another, if the patent when granted will be of prior date. This is clearly intended to bring Convention applications within the scope of the section. This being so, it follows that in a large number of cases the search cannot be finally completed until a considerable time after the patent, the fate of which hangs upon the investigation, has been granted. Thus, to take an illustration, if A applies for a patent on November 1st, the investigation as to the novelty of this invention cannot, at the earliest, be concluded till October 31st in the following year, for a Convention applicant might file an application upon that date and obtain a patent antedating A's patent.

If, as the result of this extended investigation under this section, an anticipating specification comes to light, the applicant, who perhaps by this time will have had his patent sealed, will be informed of it, and will have 2 months within which to decide what amendment (if any) he is prepared to make. The procedure consequent upon his refusal to make any required amendment is substantially the same as under the preceding section. It should be observed, however, that although the Comptroller has the same power of amendment under this section as under the preceding one, he has no power as the result of an extended investigation to revoke his acceptance of a specification or cancel a patent already granted.

Assuming that the specification has satisfactorily run the gauntlet of examination on the score of novelty, it is then ripe for acceptance.

Normally the complete specification must be accepted within 12 months from the date of application, but this period may be extended for a further 3 months by special application upon Form No. 7, stamped with the appropriate fee. If not accepted within this period the application

becomes void, save where extra delay is occasioned by an appeal from the Comptroller's refusal to accept.

As soon as a specification is accepted the applicant receives a formal notice of the fact from the Comptroller and the acceptance is duly advertised in the official journal of the Patent Office. When this stage is reached, the specification and drawings are open to public inspection and, pending publication in print, may be seen at the Patent Office upon payment of a small fee. Specifications are printed about 15 days after the advertisement of the acceptance of the complete specification. From the date when acceptance is advertised, the public have a space of 2 months within which they may oppose the grant of a patent upon the application. The whole subject of Opposition, which is of great importance, is fully dealt with in the following chapter. Here it is sufficient to remark that the grounds of opposition are strictly limited and that no one is entitled to be heard in opposition unless his interest is clearly affected by the proposed grant.

In the absence of opposition the applicant will proceed to take the final step, that is, to get his patent sealed. Except in cases of appeal or opposition or death of the applicant, a patent must be sealed within 15 months, or, if extension of time has been allowed for leaving or accepting a complete specification, within 19 months from the date of application.

In the exceptional case of an applicant dying before the expiration of the period for sealing, an extension of 12 months from the date of his death will be allowed to the legal representative.

To procure the sealing of his patent an applicant must make a special application. This is done by leaving at the Patent Office Form No. 10 stamped with £1. Care should be taken to ensure that this form, duly stamped, reaches the Patent Office at such a date as to permit of the sealing

of the patent within the prescribed time, otherwise it will be necessary to apply for an extension of time, which means the payment of an additional fee. The applicant is advised to pay the sealing fee after the date of the acceptance of his complete specification, and before the expiration of the period allowed for opposition. If this is done, the patent will as a rule be sealed about 10 weeks after the date of acceptance. Omission to pay the sealing fee deprives the applicant of his patent, and the invention becomes public property, the specification having been published.

As soon as an applicant has had his specification accepted, his monopoly begins; as soon as his specification is published, the manufacture and sale of articles made in accordance with it are counted as infringements, though his right to sue for damages in respect of such infringement is deferred until his patent is sealed.

In due course the document representing the formal patent grant is forwarded to the patentee. But, as has been pointed out, the patentee cannot feel perfect security that the Patent Office has said its last word on the subject until the period for the "extended investigation" has expired.

The patent is antedated to the date of application, and, in the case of a Convention application, to the date of the first application abroad.

The fees paid up to this point (£5 in all), to obtain the grant of a patent, are sufficient to sustain it till the end of the 4th year. If the patentee intends to keep his patent in force beyond this period, he must pay further fees. These increase on a gradually advancing scale as the term of the patent advances. Before the expiration of the 4th year and in respect of the 5th year the fee is £5; for the 6th year £6; for the 7th year £7 and so on until the 14th year, when it is £14. The sum total of Patent Office fees required to obtain a patent and keep it in force for the full term of 14 years amounts to £100.

These fees may be paid annually as they fall due, or wholly or partly in advance. The continuance of the patent is conditional upon their punctual payment. The patentee is warned by a note on the patent itself that, as the payment of these renewal fees is regulated by Act of Parliament, a fee cannot be received a *single day* after it is due. If by accident or inadvertence the payment has been omitted, application may be made to the Comptroller, on Form No. 14, and an extension of time, not exceeding three months, may be obtained. For this extension the fees payable are £1 for one month, £3 for two months and £5 for three months. Patentees are notified by the Comptroller a month in advance of the date when the renewal fee is due. Upon payment of the fee, the Comptroller issues a certificate that the prescribed payment has been made.

Formerly a patent which had lapsed through neglect to pay the renewal fees could only be revived by special Act of Parliament. Section 20 of the Act of 1907 now empowers the Comptroller to restore patents that have lapsed from this cause. To obtain this indulgence, application must be made on Form No. 15, showing that the omission was unintentional and that no undue delay has occurred since it was discovered. The statements contained in the application must be verified by statutory declaration. The application will be advertised so that anyone desiring to oppose it may do so, on giving notice to that effect within the prescribed time. In due course the Comptroller will hear the case and make an order restoring the patent or dismissing the application. His decision is subject to an appeal to the Court.

In every order of the Comptroller restoring a patent a provision is inserted for the protection of persons who may have availed themselves of the subject matter of the patent after it was announced as void in the Journal.

Applications under the International Convention.

In order to take advantage of s. 91 of the Patents and Designs Act, 1907, a foreign patentee or applicant must apply in England within 12 months of the date of his first foreign application. The application must be made on Form No. 1b, signed by the foreign patentee and accompanied by a *complete* specification, corresponding substantially with, though not necessarily a *verbatim* translation of, the foreign specification. The applicant must also supply a copy of the specification and drawings as filed in the Patent Office of the foreign country, duly certified by the chief patent official in that country, or otherwise verified to the Comptroller's satisfaction. If the specification is in a foreign language, a certified translation must also be included with the papers. If the complete specification left with the application is not accepted within 12 months from the date of the first foreign application, it is laid open to public inspection at the expiration of that period. In other respects Convention applications (as applications under s. 91 are commonly called) are subject to the same rules of procedure as ordinary applications. The patent, when issued, bears the date of the first foreign application.

An applicant entitled to claim the privileges of the Convention may do so notwithstanding he has filed an application in the first instance without doing so, provided he signifies his altered intention before the expiration of 12 months from the date of his first foreign application.

It will be convenient here, though the subject belongs properly to the following chapter, to allude briefly to the position of the Convention applicant in regard to opposition proceedings. Prior to the Act of 1907, perplexing questions had arisen as to the right of a Convention applicant to oppose a rival application lodged in between the dates of

his foreign and English application, and also as to the right of the intervening applicant to oppose the Convention applicant.

These difficulties have been swept away by the new Act. Section 11, which sets out the various grounds of opposition, is so worded as to give the Convention applicant, beyond any doubt, a *locus standi* for opposing an intervening application covering the same invention.

If the time for opposition is past, the Convention applicant may, within 2 years from the date of the rival patent, apply to the Comptroller under s. 26 to revoke it (see p. 186).

Further, it should be observed that the new regulations for an extended investigation as to novelty have an important bearing with regard to applications under s. 91.

Even after the grant of a patent to an ordinary applicant, the Comptroller may require a specific reference or perhaps even the objectionable official reference to be inserted in his specification in view of a Convention patent applied for since, but destined ultimately to antedate, the patent already granted.

The advantageous position which, in the present state of the law, the foreign inventor, applying for a British patent under s. 91, occupies *vis à vis* the British applicant cannot be regarded as entirely satisfactory. In the past, the English law has always ranked the importer of a foreign invention on an equal footing with the actual inventor. Now, however, it is manifest that the privileges granted to foreign patentees under this section seriously abridge the rights which the importer has hitherto enjoyed. No one applying for a patent, as importer of an invention recently patented abroad, can feel secure of obtaining an indefeasible grant until after the expiration of 12 months from the date when the invention was first patented abroad.

In these circumstances it is worth while considering

whether, in certain cases, it is not the English inventor's best policy to lodge his first application in some foreign Convention country, say Belgium (where the initial fees are not high), and thereby obtain a *quasi* provisional protection in the United Kingdom for 12 months, instead of for the normal period of 6 months.

Patents of Addition.

It is seldom that an invention of any importance can be adequately protected by a single patent. Improvements upon the original conception are evolved from time to time and require to be separately patented. Hitherto every additional patent meant an additional drain, just as heavy as the first, upon the patentee's purse; for even though improvements entirely supersede the invention as originally patented, it is nevertheless, as a rule, essential for the preservation of the monopoly to keep all the patents alive.

To lighten this burden of expense, which weighed more particularly on the poor inventor, the Act of 1907 has adopted the principle, long familiar in foreign patent systems, of granting "patents of addition."

The whole *raison d'être* of a patent of this kind is that it shall be cheaper than the ordinary patent. The initial cost of obtaining a patent of addition will be normal, but the patentee is relieved from the payment of renewal fees. On the other hand, a pátent of addition is only granted for the residue of the term of the original patent and will only remain in force so long as the latter remains in force.

A patent of addition may be obtained by application on Form No. 1c, in respect of any "improvement in or modification of" the original invention, whether it has actually been patented or only a patent applied for. Where the improvement is evolved at an early stage, *i.e.*, before a complete specification has been filed in respect of the

original invention, the inventor has the option of getting his two provisional specifications combined in a single complete specification, under s. 16 (see p. 57), or of applying for a patent of addition.

After the Comptroller has allowed a patent of addition to be granted, no question may be subsequently raised as to the propriety of its being so treated.

Register of Patents.

As soon as a patent has been granted, the name and address of the patentee and the title of his invention are entered in the Register of Patents. This is an official record, kept at the Patent Office, of all incidents and transactions affecting the validity and proprietorship of letters patent. Memoranda of amendments and payment of renewal fees, and other facts of which the Patent Office has direct cognisance, are entered as a matter of course; assignments, licences, extensions and revocations are only recorded upon notice and evidence being furnished to the Comptroller in the prescribed form.

The value of registration is that it affords good evidence of title. Before acquiring a patent or any right under a patent, a purchaser should satisfy himself by an inspection of the Register that the patentee's title is good and unencumbered. No interest or claim which does not appear upon the Register can be set up in derogation of a right that has been duly registered.

Registration is not compulsory. An assignee may register his assignment or not as he chooses; but if he does not do so, he runs the risk of having his title defeated by someone else who innocently takes a subsequent assignment from the same patentee, and does register it.

To obtain registration of an assignment, the deed and any other document affecting the proprietorship of the

patent must be forwarded to the Patent Office together with a request on Form No. 27, stamped with a 10*s.* stamp, giving particulars of the assignment. Copies of the original documents must also be furnished. These should be written on foolscap and impressed with a 1*s.* stamp.

In the case of a licence, the notification is required to be made on Form No. 28, accompanied by the licence and an attested copy. If the licensee does not wish the terms of the licence publicly disclosed, he may put these into a separate document and import them into the licence merely by reference.

The Comptroller will not accept for registration any simple notice or declaration of trust, but this rule does not exclude the registration of documents directly affecting the proprietorship of a patent, for instance, an equitable assignment or licence, not under seal, but evidenced by a written agreement. A note of a mortgage may be registered, although the mortgagor remains on the Register as the legal patentee.

Agreements entered into respecting a patent, which has been applied for but not yet granted, are capable of registration, but it is extremely doubtful whether an agreement made prior to the application for a patent would be accepted for registration, as until an application has been lodged there are no sure means of identifying the invention mentioned in the agreement with that afterwards patented.

The Register is open to public inspection during the usual business hours of the Patent Office, and certified copies of any entry may be had on payment of the prescribed fee.

Under s. 72 of the Act of 1907, anyone aggrieved by omissions or erroneous entries in the Register may apply to the Court to have such errors corrected. If the mistake is merely a clerical error it can be put right by making written request to the Comptroller on Form No. 30.

Any person interested in a particular patent may, on payment of a small fee, leave at the Patent Office a request to be informed when any attempt is made to register an assignment or other document affecting the patent in question. In the event of application being made to register any dealings with the patent, the person interested will be duly notified and the registration suspended for a few days so as to afford him an opportunity of taking steps to prevent the registration if he desires to do so.

CHAPTER VIII.

OPPOSITION.

UNTIL the complete specification has been accepted by the Comptroller, the public have no means of ascertaining the scope of the applicant's claims. The only clue to the nature of the invention is that afforded by the title, published upon receipt of the application, in the Illustrated Official Journal of Patents. If the title is such as to raise apprehension in the mind of any member of the public that the patent sought to be obtained is likely to prove injurious to his own patent rights, he should at once forward to the Comptroller a request, accompanied by a blank form, No. 31 (5*s.* stamp), for notification as soon as the complete specification is accepted. Otherwise, since the time of acceptance is always uncertain, he may through inadvertence miss the official advertisement of acceptance and so let slip his chance of opposing the grant.

The grounds upon which the grant of a patent may be opposed are strictly limited by Statute, and fall under the following four heads :—

(1) That the applicant has obtained the invention from the opponent or from a person of whom he is the legal representative.

(2) That the invention has been claimed in any complete specification for a British patent, which is or will be of prior date to the patent, the grant of which is opposed (except specifications 50 or more years old).

(3) That the nature of the invention or the manner in

which it is to be performed is not sufficiently or fairly described and ascertained in the complete specification.

(4) That the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification.

No opposition on other grounds than these is entertained.

An intending opponent has two months from the date when acceptance is advertised within which to give notice of opposition. Before doing so he will, of course, inspect the applicant's specification to ascertain whether he has good ground for opposition. This he may do at once upon payment of a fee of 1*s*. Fifteen days later the specification is printed and may be seen, free of charge, in the Patent Office Library or purchased for the sum of 8*d*. at the Sales Branch of the Patent Office.

In notifying the Comptroller of his intention to oppose, the opponent must fill up Form No. 8, stating the grounds of opposition and, having stamped it with a 10*s*. stamp, lodge it at the Patent Office together with an unstamped copy. Notice of opposition must be signed by the opponent in person; his agent's signature is not sufficient. Where the person giving notice of opposition does not desire the patent should be refused, but merely that the specification be amended, he should include with the notice of opposition a statement to that effect, indicating the general nature of the amendment desired. Where the opponent relies on the first ground of opposition, he must in all cases file evidence in support of his contention within 14 days after the expiration of the two months allowed for giving notice of opposition, otherwise the opposition will be deemed to

have been abandoned. This evidence takes the form of a written declaration upon oath, which is substantially the same thing as an affidavit. The opponent may support his own testimony by that of any other witness who has personal knowledge of the facts. Any person making a declaration may be required by the Comptroller to attend at the hearing to supplement his declaration by oral evidence on oath. The filing of declarations is only obligatory in cases of opposition on the first ground.

Where the ground of opposition is that the invention has been claimed in a specification of prior date, the number and date of the prior patent or application must be specified in the notice. References to any other specifications on which the opponent intends to rely should also be included in the notice, unless it is the intention to file a declaration, in which case they will be cited in the declaration. If the ground of opposition is that the nature of the invention is not fairly described, the notice of opposition should be accompanied by a written statement indicating in what respects the specification is defective. Where special pleas are raised, as, for example, where the opponent claims to have his patent construed as a master patent, declarations are necessary; they are also useful where the specifications are long and the subject matter intricate, as they serve to define the precise point at issue. If the opponent wishes to file a declaration he must do so within 14 days after the expiration of the period allowed for giving notice of opposition, and at the same time deliver a copy to the applicant, who may within 14 days thereafter file a declaration in answer; to which the opponent can reply by a further declaration within another 14 days. No further evidence may be filed except by leave or request of the Comptroller.

Should the opponent file no declaration, the applicant may take the initiative and file a declaration justifying his application and showing by reference to other specifications

that the opponent's claims must be construed narrowly and that, so construed, they do not constitute an anticipation. The applicant's declaration must be left within 3 months from the date of the advertisement of his complete specification, and may be followed in the manner above described by declarations in answer and reply.

On completion of the evidence the Comptroller will appoint a time for hearing the case. Both parties must notify the Comptroller whether or not they desire to be present or represented at the hearing. The failure of an opponent to appear at the hearing or the withdrawal of his opposition does not exonerate the applicant from satisfying the Comptroller that there is no substance in the alleged ground of opposition; and it is possible that upon the evidence of the declarations alone the applicant's patent might be refused, even if the opponent were not present to argue his case. Oppositions, therefore, cannot be safely ignored.

If either party intends to refer at the hearing to any publication other than a specification mentioned in the notice of opposition or the statutory declarations, he must give both the Comptroller and his adversary at least 5 days' notice of his intention.

In the event of neither party appearing, the Comptroller will decide the case upon the evidence, and in due course notify the parties of his decision.

Opposition cases are heard in the Comptroller's Court at the Patent Office by the Comptroller or by the Chief Examiner, sitting in his stead. Some member of the examining staff, through whose hands the application in question has passed, is also usually present in case his assistance is required. The parties may argue their case in person, or they may be represented by their patent agent or by counsel. The usual practice is for the applicant to begin and, after the opponent has put his

case, he has the right to reply. Where, however, the ground of opposition is fraud on the part of the applicant, the Comptroller may require to hear the opponent first. Each party pays a hearing fee of £1.

Formerly the powers of the Comptroller with regard to the taking of evidence were exceedingly limited; the great extension of his judicial functions, however, by the Act of 1907 has necessitated a corresponding enlargement of his powers in this respect. He may now take oral evidence upon oath, allow the declarant to be cross-examined on his declaration and require the attendance of witnesses by writ of subpœna. He has also power to award such costs as he may think reasonable and in certain cases to require security for costs to be given.

An appeal lies from the Comptroller's decision to the Law Officer. Notice of appeal must be given within 14 days, stating the gist of the decision appealed from and saying whether the appeal is from the whole or only from part of the decision. No further evidence is allowed, except by special permission of the Law Officer.

The Law Officer has power to award costs, and the usual practice, where costs are given, is to fix them at a certain amount.

Having thus briefly outlined the course of procedure in opposition cases, it remains to consider more in detail the several grounds upon which the grant of a patent may be opposed.

The *first* ground, namely, that the applicant has obtained the invention from the opponent or from some person of whom he is the legal representative, raises the issue of "true and first inventor." Oppositions of this kind fall roughly into two classes:—(1) those in which the opponent's denial of the applicant's right to claim the invention amounts virtually to an allegation of fraud, and (2) those in which the opponent claims that he is entitled

to a share in the patent, in recognition of his right as co-inventor with the applicant.

An allegation of fraud is a serious matter and should not be put forward without good reason; and the refusal of a grant upon this ground will only be secured upon cogent proof of the applicant's fraud being furnished. The piracy complained of must have been committed in this country; no allegation of fraud committed abroad will be entertained. In a case of opposition to the grant of a patent to the importer of a foreign invention, on the ground that the invention had been fraudulently obtained, the Attorney-General said:—"I think the Comptroller has no jurisdiction to enquire into the circumstances under which the invention was obtained by the importer. Of course there may be cases in which the relations between the parties may be such that the person who has first imported the invention may be guilty of some breach of contract or breach of duty towards the person from whom he has obtained the invention abroad; and the importer may be liable to proceedings in respect of the breach of any such contract or duty, but in my opinion these are matters which the Comptroller and the Law Officer cannot inquire into, but must form the subject of independent proceedings in this country or abroad, as the case may be."

The simplest course for a foreign inventor to take in such a case, assuming it is not too late, would be to apply under s. 91 for a British patent to be antedated to the date of his foreign patent. This would give him a *locus standi* for opposing on the second ground. If, however, the patent he desires to oppose has already been granted, it is still open to him to apply under s. 26 to revoke it (see p. 186).

The commonest instances of opposition on the first ground are afforded by disputes between employer and employee, or between the inventor who conceived the idea

and the assistant engaged to put it into practical shape. The principle underlying the decision of these cases has already been discussed, and here need only be recalled briefly. The "true and first inventor" is the original projector of the practical idea, and no matter whether he be master or workman, he alone is entitled to the grant; nor is the principle affected by the fact that, in the case of a workman originating the idea, the invention was carried out with his employer's tools and material and in his employer's time.

If upon the evidence it appears that both the applicant and opponent had some share in the invention, the usual practice is to direct a patent to be sealed in their joint names. Where the opponent had already applied for a patent in respect of the same subject matter, the equivalent result was effected by causing each patentee to assign to the other a joint interest in his patent.

An opponent relying on this ground of opposition, if he wishes to patent the invention himself, should lose no time in applying. Section 15 of the Act provides that "a patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection." But upon final refusal to seal a patent to the applicant, the period of the provisional protection will cease, and any subsequent exercise of the invention would prejudice an application of later date. In order, therefore, to get a valid patent granted to himself, the opponent should make his application before the date of the hearing.

In the event of the decease of the intending opponent, this ground of opposition is available to his "legal representative," that is, his executor or administrator. Attempts

to attach an extended meaning to these words have been made without success.

By far the most usual ground of opposition is the *second*, namely, to put it shortly, that the applicant's invention has been anticipated wholly or in part.

Prior to 1907, opposition on this ground could only be based upon a completed patent or an accepted complete specification. Now, however, it is sufficient to allege that the applicant claims an invention claimed in any previously filed complete specification or even in one subsequently filed, provided the patent to be granted in respect of it will antedate the applicant's patent. Apparently it is not necessary that the specification, relied on as an anticipation, should have been actually *accepted* by the Comptroller.

This alteration in the law is, as has been pointed out, chiefly beneficial to the Convention applicant and will no doubt contribute, with the new practice of extended investigation, to remove what has always been a blemish in the English patent system, namely, the possibility of the co-existence of patents for identical subject matter.

For simplicity's sake, in what follows, the complete specification relied on as an anticipation will be alluded to as though it had already been consummated in a completed patent of prior date.

It is not every member of the public that can oppose upon this ground. The opponent must possess what is termed a *locus standi*. He must have some definite and direct interest in the prior patent which he alleges to be an anticipation of the applicant's invention. He need not necessarily be the owner or licensee of the patent relied on; nor is the right to oppose affected by the fact that the patent has expired. A *locus standi* was successfully established by a manufacturer in respect of an expired patent in which he had been interested and under which he had worked. It has also been held that a person who has been

prevented from working an invention owing to the existence of a patent may oppose an application for a second patent covering the same subject matter. The professional interest of a patent agent in a patent is not, however, of such a character as to entitle him to oppose. Having established his *locus standi* in respect of some particular patent, the opponent is at liberty to refer to other specifications for the purpose of strengthening his case, provided due notice is given. No specification published more than 50 years prior to the application against which the opposition is directed will be deemed an anticipation.

The issue to be tried upon this ground of opposition is a simple one, involving solely the question whether, putting the specifications side by side, it appears that the applicant is claiming over again what has already been claimed in an earlier specification. A device which is described, but not claimed, will not constitute an anticipation for the purpose of opposition. In considering this question, it is very necessary to ascertain the precise scope of the prior patent upon which the opponent relies as an anticipation. If its claims are wide and vague, the applicant may, in his declaration, refer to kindred specifications and adduce evidence as to the state of the art, with a view to placing a narrowing construction upon the specification cited in opposition; and this is usually done, where the opponent claims that his patent is entitled to be construed broadly as a master patent. But the applicant is not permitted to impugn the validity of any of the patents cited as anticipations. If, in the Comptroller's opinion, there is no substantial difference between the invention claimed by the applicant and that claimed in the earlier specification, effect being given to the doctrine of mechanical equivalents to the extent of refusing to recognise mere colourable differences, the patent will be refused. If, on the other hand, there are distinguishing features, the Comptroller

will determine whether, after eliminating from the applicant's claims all that is merely a repetition of prior claims, there still remains a residue of patentable invention.

The Comptroller's duty is two-fold; to safeguard the public and to protect the patentee, whose interest is particularly affected by the application. He must see that the applicant does not acquire patent rights which will mislead the public. A patent, containing claims which are a mere repetition of the claims of an earlier patent, is manifestly an imposture. A specification of what is in reality a minor improvement, but so worded as to convey the impression that the patentee lays claim to the wider invention upon which his device is merely a graft, is similarly misleading. Moreover it is detrimental to the value of the patent upon which it claims to have improved, in so far as it tends to usurp its position in the public eye. Where an applicant claims what is old, and the scope of his claims cannot conveniently be brought within due bounds either by excision or by the addition of restrictive words, the Comptroller will direct the insertion of a disclaiming clause. Amendment by disclaimer has been characterised as unscientific; it has, however, the merit of being a clear and compendious form of amendment.

Disclaimers are of two kinds, *general* and *specific*. A general disclaimer is a statement, such as is frequently inserted quite voluntarily in a specification, to the effect that the patentee is aware that certain things have already been done and that he lays no claim to these things. When inserted at the instance of an opponent, the disclaimer is usually drawn to exclude, by general descriptive language, the invention covered by the opponent's patent.

An applicant whose specification errs on the side of claiming too much will do well, as a rule, to assent to the insertion of an innocuous disclaimer; for, though the amendment narrows the ambit of his patent, it often results

in the conversion of a bad patent into a good one; whereas by obstinately resisting a reasonable amendment, an applicant runs the risk of having a disclaimer inserted in a more objectionable form than might otherwise be the case.

A specific disclaimer, or, as it is sometimes called, a specific reference, is a clause referring by number and date to the opponent's patent. It is usually in the following form, "I am aware of Letters Patent No. —— of the year —— granted to —— and I make no claim to anything described or claimed therein."

The Comptroller and Law Officer have always shown themselves very reluctant to insert specific disclaimers, and have only resorted to them in extreme cases, where milder forms of amendment were insufficient for the protection of the public. It is not improbable, however, that the more frequent and familiar use of the specific reference fostered by the new procedure (introduced by the Patents Act of 1902), will tend to relax the stringency which has hitherto regulated the insertion of this form of reference in opposition cases.

The fact that the opponent's patent is a master patent has usually been considered a good reason for directing a specific reference; the object being to warn the public that the applicant's invention is subordinate to and cannot be used without a licence under the earlier patent. But special disclaimers will not be sanctioned merely for the purpose of advertising an antecedent patent, and an opponent is not entitled to have his patent referred to by name, if a general form of disclaimer is sufficient warning to the public.

Finally, in regard to this ground of opposition it may be laid down as a general rule of practice that the seal will not be withheld from the applicant's patent unless a clear case is made out and it is proved to the satisfaction of the

Comptroller or the Law Officer, as the case may be, that the applicant's claims are practically identical with those of the prior patent. If, by amendment or disclaimer, this objection can be removed, although it involves the whittling down of the applicant's claims to a very small compass, yet, so long as there is left a recognisable fragment of the invention originally claimed, the applicant will be allowed the benefit of the doubt without prejudice to the question whether the distinguishing feature is sufficient to constitute patentable subject matter. For the Law Officer's refusal to grant a patent is final. The injury, therefore, if his decision is wrong, is irremediable; whereas, by allowing the patent to be sealed, he does not debar the opponent from taking the opinion of a higher judicial tribunal by subsequently applying to the Court to revoke the patent.

The *third* ground of opposition, viz., insufficiency of specification, is new. In the majority of cases it will be relied upon merely as an alternative to the preceding ground; the applicant will be put in the dilemma, that he is either claiming what is old, or else his specification and claims are too vague and require amendment and clearer definition. Presumably an opponent would be required to possess the same *locus standi* in this as in the previous case.

The *fourth* ground of opposition is that the complete specification describes and claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification,

This provision is intended to guard against a species of patent plagiarism which is liable to occur when there are many working concurrently in one particular field of invention. An applicant, who files only a provisional

specification in the first instance, is permitted to embody in his final specification legitimate developments of the invention originally foreshadowed; but if these improvements happen to be identical with the subject matter disclosed in another specification published in the interim upon an application of later date, there is a strong presumption raised that the first applicant has filched these improvements from the specification of the latter applicant.

No objection of disconformity will be entertained by the Patent Office after a specification has been accepted. Hence, but for this remedy, the applicant might successfully appropriate the fruit of another's ingenuity.

An illustration of an opposition upon this ground is afforded by the case of *Wilson's Patent*. A provisional specification filed by W described various forms of bicycle tyre. The complete specification described and claimed, in connection with the tyres, several methods of fastening which were not alluded to in the provisional specification. B opposed the grant to W on the ground that these fastening devices were not described in W's provisional specification and that they formed the subject of an application made by him in the interval between the filing of W's provisional and complete specification. The opposition went before the Attorney-General on appeal, and he ordered the excision of a part of W's specification, an amendment of the claims and the insertion of a disclaiming clause to the effect that the methods of fastening mentioned in his specification formed no part of the invention claimed.

An opposition instituted collusively, with the object of delaying the grant of the patent beyond the date when it would ordinarily have to be sealed, will, if the design is detected, result in the grant being refused altogether.

CHAPTER IX.

PATENT RIGHTS.

Their Legal Value.

Having traced out in detail the various steps by which an invention may be patented, it is now time to ascertain precisely what are the rights which the grant of letters patent confers.

Regarded from the point of view of the original grantor, viz., the Crown, the right conferred by a patent is not a permissive but a prohibitive right. It does not *give* the patentee the right to use the invention; that is a right which he would have in common with everyone else if there were no patent at all. The real privilege that the patentee enjoys, in virtue of his patent, is the power of preventing others from using his invention without his consent. Even the inventor himself may fall under the ban of the patentee. For, although an inventor must necessarily be a party to the application for a patent (except in the case of an imported invention), as soon as the patent has been granted, his connection with it is no longer necessary. He may at any time divest himself of his patent rights, and upon so doing may himself be restrained from exercising his invention as effectually as any other member of the public.

The monopoly conferred by a patent is co-extensive with the United Kingdom (including the Isle of Man but not the Channel Islands), and any person, no matter what his nationality may be, who manufactures, sells, offers for

sale or uses the invention within this territory without the patentee's consent, renders himself liable to an action for infringement. There is, however, a single exception to this general statement which should be mentioned. Section 48 of the Patents and Designs Act of 1907 provides that a patent shall not prevent the use of an invention for the purposes of navigation of a foreign vessel within the territorial waters of the United Kingdom, or the use of an invention in such a vessel for any other purpose, provided it is not used in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom. This provision is conditional upon reciprocal treatment being accorded to British vessels by the foreign State.

The normal term of a patent is 14 years, with a possible extension in exceptional cases for a further 7 or even 14 years. A patent may lapse through default in the payment of renewal fees, or it may be revoked on the ground of invalidity or abuse of its privileges by the patentee, or it may be surrendered or revert to the Crown; but if not extinguished in one of these ways, it will continue to the end of the prescribed term, no matter through whose hands it passes, or to what extent its privileges may be distributed or sub-divided.

A patentee does not forfeit his rights through neglect to enforce them, except in so far as, by virtue of the Statute of Limitations, he is debarred from suing in respect of infringements committed more than 6 years prior to the commencement of the action.

It is scarcely necessary to add that the loss or destruction of the letters patent does not affect the existence of the patent rights. The patentee may at any time apply to the Comptroller to have a duplicate sealed.

Though difficult to assign to any definite category of property, a patent is capable of being dealt with to a great

extent like an ordinary chattel. It may be sold or mortgaged or disposed of by will. It may be seized by the sheriff in levying execution, or distrained for arrears of rent. In the event of the patentee dying intestate or becoming bankrupt, the patent will vest in his administrator or trustee in bankruptcy, as the case may be.

Since the patentee is the only person possessing the right to sue in the event of infringement, it is important that there should be no doubt as to who may be properly so designated. According to the legal definition, the patentee is "the person for the time being entitled to the benefit of the patent." He may be the assignee, mortgagee, executor, administrator or trustee in bankruptcy of the person to whom the patent was originally granted. The enforcement of the rights of a patentee and the acts which constitute a breach thereof belong properly to the topic of infringement and will be considered later.

As soon as an applicant has had his complete specification accepted, he is entitled to mark his goods with the word "patent." This he may continue to do even after the expiration of the term, provided it is done in such a manner (as, for example, by adding the date of the patent), that the public will not be misled into thinking that the goods are manufactured under an existing patent.

In consequence of the new clause in the Act of 1907 exempting the innocent infringer from liability to pay damages and providing that the mere appearance of the word "patent" or "patented" upon the patented article shall not, unless accompanied by number and date, be deemed notice that the article is patented, patentees will do well in future to mark the patented article, where possible, in such a manner as to prevent the defence of innocent infringement being set up.

Any person improperly using the word "patent" or

"patented" is liable, upon summary conviction, to a fine not exceeding £5 for each offence.

There is no limit to the number of persons in whom rights in a single patent may simultaneously exist. Where a patent is vested in two (or more) persons, each may use the invention to the fullest extent without the consent of the other and without accounting for profits. But no licence may be granted without the consent of all the joint patentees. Formerly the interest of a joint patentee, if not severed in his life-time, vested on his death completely in the surviving patentee by virtue of the Common Law rule of survivorship applicable to all cases of joint ownership. Such a state of things was manifestly unfair, and the Act of 1907 has accordingly modified the law in its application to such a case. Section 37 provides that, whereas the patent shall, as before, devolve upon the surviving patentee, the *beneficial interest* of the deceased patentee shall devolve upon his personal representatives; in other words, the surviving patentee will be treated as trustee of the profits arising from the patent to the full extent of the deceased's interest in it.

Where a patent is jointly owned, it is usual and very expedient to have some agreement clearly defining the respective interests of the joint patentees and their mutual rights and liabilities. Thus, in the common case of an alliance between an inventor and a capitalist, an agreement should be drawn up, preferably before the patent is issued, dealing with the following points:—(1) The respective parts to be played by inventor and capitalist: (2) Repayment of moneys advanced, together with interest: (3) Share of profits; (4) Possible improvements: (5) Payment of patent fees; (6) Taking out of foreign and colonial patents; (7) Power of terminating the agreement; (8) Right of parties to exercise the invention after termination of the agreement.

It is usual for the capitalist to undertake to finance the invention up to a given amount or for a certain period, the inventor agreeing on his part to devote time to the practical development and working of the invention. To avoid the possibility of a deadlock, one or other of the two parties should be given the controlling voice in deciding questions of policy, such as the granting of licences, the acquisition of patents for improvements and the suing of infringers.

The repayment of money advanced and interest is usually made a first charge upon the net profits derived from the invention. Owing to the widely differing views held as to the meaning of the words "net profits," great care should be taken to remove all ambiguity upon this head. Subject to this charge, the profits may then be shared or otherwise disposed of, as the parties may think fit.

Provision must be made with regard to improvements upon the original invention. This is usually done by stipulating that the inventor shall, at the request of the capitalist, apply for patents for improvements in their joint names, and that all such subsidiary patents shall be subject to the terms and conditions of the main agreement.

Before proceeding to discuss the means by which interests in patents may be negotiated, a few pages may, perhaps with advantage, be devoted to the consideration of the commercial value of patents.

The Commercial Value of Patent Rights.

It will not be taking an unduly sordid view of the aims of the average inventor, if it be assumed that he applies for a patent in order to make money out of it, either by working it himself or by disposing of it by sale or licence. This being so, it is worth while to consider, in the interest equally of the inventor and the capitalist who

seeks to make money by investing in patents, what are the conditions which favour the attainment of this object. Fortunes have been made and fortunes have been lost through trafficking in patents, and unhappily the latter has been the more frequent experience. The need is all the greater, therefore, for formulating with as much precision as possible some rules for guidance in discriminating between patents which have, and those which have not, the potentiality of commercial success.

In the first place, it is necessary to dispel a delusion. Letters patent are sometimes looked upon as a species of property that is intrinsically valuable; they are offered and not infrequently accepted as security for loans, and figure as a valuable asset in companies' balance sheets, though the inventions they cover may be wholly untried or undeveloped beyond an experimental stage. The fact that large sums of money have been spent in obtaining the grant, and that all the machinery of the Patent Office, combined with the skill of the best patent agents, has been invoked to ensure validity, is vaguely supposed to make a patent a thing of inherent value. This is an entire fallacy. A patent is merely evidence of the inventor's title to certain property which may be worth much, little, or nothing at all. A considerable majority of the patents granted every year must be relegated to the last category—as worth nothing at all; as being, from a commercial point of view, no better than title deeds to "castles in Spain." The statistics disclosed in the Comptroller-General's Annual Report show that, on an average, only slightly over 50 per cent. of the patents applied for are sealed and continue in force to the end of the 4th year. Slightly over 30 per cent. are kept on foot to the end of the 5th year and then, by a rapid declension, the numbers fall as the life of the patent advances, until at the close of the 14 years only a fraction over 4 per cent. are surviving. The abandonment

of 50 per cent. of the patents applied for, before even the payment of a single renewal fee, affords a fairly strong inference that the abandoned patents were found to be of little or no commercial value. Furthermore, it is notorious that numbers of patents are kept alive at a loss for many years in the hope of ultimate success, before the owner can resign himself to the conclusion that there is no profit to be got out of them.

Yet it must not be supposed that because this large proportion of patented inventions is abandoned as commercially valueless, there is any implication that they are devoid of merit ; the fact being that many of the most ingenious and meritorious inventions cannot, for one reason or another, be worked at a profit, while other inventions possessing little claim to either novelty or ingenuity may, through favouring conditions, prove sources of great wealth.

The pecuniary value of a patent depends, in fact, not so much upon the intrinsic merit of the invention, though that should certainly be present, as upon a multitude of external conditions affecting the chances, at a given moment, of turning a particular contrivance to profitable account.

Among the factors that most decisively affect the commercial value of a patent is the timeliness of the invention. If the invention is one which meets a recognised and keenly-felt want, then, assuming it to be workable and the patent technically valid, it is tolerably safe to predict that there is money in it, and that the attainment of commercial success depends only on the exercise of ordinary business ability.

Moreover, when the want is really pressing and there is already a large demand, or the potentiality of such is evident, then even a small but genuine improvement may become the basis of a highly remunerative patent. Such may be the result even though the improvement extends no further than, perhaps, providing means of slight economy

in some established manufacture or technical process, or the attainment of a superior product, or the acceleration of the rate of production. It is a noteworthy fact that most of the instances of fortunes being made out of patents have been cases where the improvement was of quite a minor, not to say trivial, character.

On the other hand, where there is no pre-existing demand, success is much more problematical. If the invention results in a product that is entirely novel, as was the case, for example, with the phonograph, there may be doubt as to whether it will hit the public taste. The unpreparedness of the public and their slowness to appreciate the value of new things is one of the heaviest handicaps upon the true pioneer invention, and often destroys its value entirely for a considerable part of the patent's term. In such a case the commercial success of the invention depends largely upon the skill of those interested in the patent in exploiting it and in educating the public up to the pitch of appreciation requisite to create the necessary demand. Often a new fashion has to be set or a new habit acquired before an invention can be turned to profitable account.

Having obtained satisfactory assurance as to the existence or at least the prospect of a sufficient demand, the next point to consider is the ability of the invention to meet it. And here a word of caution may be interjected with regard to immature inventions. Inventors are prone, and not unnaturally, to patent their ideas as soon as they have taken sufficiently tangible shape to admit of their embodiment in a specification. But, even though the idea be a good one, the first form which it takes in the inventor's mind is seldom the form which is ultimately found to succeed in practice, and a considerable amount of experimentation is usually required before the practical form is evolved. It is these theoretical patents, mere inventions on paper, of which the investor in patents must beware;

they are a drug in the market and mainly accountable for the large proportion of patents that are abandoned at an early stage. Even laboratory demonstration and small scale working are apt to be misleading as to commercial practicability; for unforeseen difficulties not infrequently arise simply in attempting to carry out on a large scale what has already been done with perfect success in a small way.

With this preliminary caution we may proceed to notice some of the chief points which affect the question of commercial workability. Assuming that the invention under consideration is a new process or method of manufacture, a most material enquiry will be as to its economy. Will the working cost be low enough to enable it to compete successfully with existing methods of manufacture; or, if that is not the case, will the product be so superior as to warrant a higher selling price? If the invention requires the carrying out of a difficult operation, dependent for its success on very exact conditions, will the "margin of safety" be wide enough to make the process practical under the ordinary working conditions of a factory?

Where the patentee looks to the granting of licences as a source of revenue, it is necessary to consider whether prolonged and costly experimental demonstration will be needed to convince the manufacturer of the merits of the invention; and whether the installation of the new process will entail the drawback of a wholesale "scrapping" of existing plant and machinery, and the erection of new plant and machinery on an extensive scale.

In addition to the foregoing there are still other, perhaps less obvious, conditions that affect the commercial success of a patent. The backwardness or want of enterprise in contributive and auxiliary industries, upon which the inventor is dependent for his raw materials, is sometimes a serious obstacle to immediate success. Thus, to take an illustration from the history of electric lighting, it was not

any lack of the elements of commerciality in the early form of the electric lamp, but the imperfect and inadequate methods for producing and distributing the current to illuminate it, and the general backwardness and unpreparedness of the various industries upon which the electric lighting engineer is dependent, for his copper cables, his insulating materials, his measuring instruments and the like, that so greatly retarded the immediate commercial success of this form of illumination.

Again, restrictive legislation or the necessity for obtaining the compliance of Government officials or a local authority may sometimes seriously hamper the introduction of a meritorious invention. For example, a patent for a new telegraphic instrument of undoubted utility could not be said to be commercially valuable in England, unless the Post Office were willing to sanction its use; for although fourteen years may be ample time within which to capture the general public, it has been known to be all too brief a period within which to overcome the inertia of a Government Department.

Limited applicability and consequent small demand are also matters to be taken into consideration where the invention is of such a character as to appeal to a very small section of the public, or when the chances for using it are infrequent; as, for instance, they would be if the use of the invention were dependent upon the undertaking of large works, such as the construction of railways, canals or docks.

Again, the ease with which a patent can be evaded and the difficulty of tracing and checking infringements are factors which have to be taken into account in estimating the profit-earning capacity of a patent. The experience of the owners of the Welsbach patents for incandescent gas mantles affords an instructive lesson upon this point. Once the secret of making these articles was known, their manufacture became an easy operation which almost anyone

could perform with the aid of a few simple appliances. The high prices at which these mantles were sold, compared with the small cost of manufacture, naturally offered strong inducement to infringers, and infringement became rife. The market was flooded with a quantity of pirated mantles and the resources of the patentees were sorely taxed for some time by having to fight a host of petty infringers, not worth powder and shot, but capable, nevertheless, of doing great damage to the patentees' trade.

Another important matter to be taken into consideration is the likelihood of the invention being superseded by improvements. This, of course, is a very problematical question, and one upon which theorising can be of little assistance. It seldom happens that a successful invention controls the market for the full term of the patent. Continuity of monopoly depends largely upon the skill with which the specification and claims are framed, but still more upon the business ability of the proprietors of the master patent and their astuteness in acquiring control of all improvements which threaten to supersede it or otherwise weaken or undermine their monopoly.

Sufficient has perhaps been said to emphasise the point that in dealing with patents as a commercial investment the greatest circumspection must be used, and that, generally speaking, patent exploitation is a highly speculative undertaking. Nevertheless, to the shrewd manufacturer who invests in patents as a means of securing a monopoly in inventions and improvements germane to his own business, they frequently prove to be an asset of the greatest value. And though to the capitalist, who sees in patent exploitation the means of speedy enrichment, the experience is not seldom one of disillusionment, yet there are plenty of patents to be found which, when properly financed and backed by good business ability, are capable of yielding a handsome return on the capital invested.

CHAPTER X.

AMENDMENT.

Allusion has already been made to the amendment which a specification may undergo at the hands of the Comptroller at the various stages of a patent application, either because it fails to comply with the statutory requirements as to form, or because it clashes with what has already been claimed in some prior specification. Such amendments are, as a rule, of an involuntary nature, forced upon the applicant as a condition of the grant of his patent. The present chapter is concerned more particularly with the procedure regulating the amendment of specifications at the instance of the applicant or patentee himself, and with a fuller consideration of the general principles upon which amendment is allowed.

Prior to 1884, the only mode by which a patentee was able to alter the text of his specification, once his patent had been sealed, was by disclaimer. This form of amendment, which meant simply the erasure or excision of certain parts of the specification and claims, was of course useless for clearing up ambiguity or for limiting a claim which required, not merely excision, but the addition of qualifying words. The defects of the existing machinery for amendment were remedied by s. 18 of the Patents, Designs and Trade Marks Act of 1883, the provisions of which are, with slight alteration, embodied in ss. 21 and 22 of the Patents and Designs Act of 1907.

The effect of these sections may be briefly summarised as follows. An applicant or a patentee may at any time

amend his specification, claims or drawings, by way of disclaimer, correction or explanation; provided that the amendment does not 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. It should be observed that this power to amend only applies to the complete specification; no amendment of a provisional specification, beyond the correction of clerical errors, is allowed.

A request for leave to amend must be made on Form No. 17, signed by the applicant or the registered proprietor of the patent, and accompanied by a certified copy of the specification showing clearly in red ink the proposed amendments. The stamp fee for an application to amend, made before the patent is sealed, is £1 10*s*.; after sealing, the fee is £3. The charge for certifying the printed copy is 1*s*. The corrections should be clear, and additional matter which cannot be written upon the printed copy should be written upon a separate sheet and attached to the print.

The applicant must state his reasons for desiring the amendment. Reasons commonly given are, that the applicant is advised that his specification does not define the nature of his invention with sufficient clearness, or that his claims are too broad, and he wishes to restrict them.

The nature of the proposed amendment and the reasons assigned for it are in due course advertised in the Illustrated Official Journal and in any other manner that the Comptroller may direct, in order that the public may have the opportunity, should they so desire, of opposing the amendment. Proposed amendments, whether allowed or not, are advertised all the same. Hence, if an inventor, ignorant of the rules governing amendment, seeks to amend his specification by embodying in it some new material, and the amendment is refused on the ground that it enlarges

the scope of the patent, he may find that this publication has debarred him from subsequently patenting this subsidiary matter by a separate application, which he might have done successfully in the first instance.

Notice of opposition to the amendment must be given within one month from the date of advertisement. It must be on Form No. 18 (stamp 10*s*.), signed by the opponent and stating the grounds on which he opposes. He may bring evidence in support of his opposition by filing a declaration within 14 days after the expiration of the period allowed for notifying his opposition. The subsequent proceedings follow the same lines as those already indicated in the case of oppositions to grant. The parties, if they wish to be heard, come before the Comptroller, who determines whether and subject to what condition, if any, the amendment shall be allowed.

Anyone wishing to be informed as soon as an application for amendment of a specification is entered, should forward a blank Form No. 31 (5*s*. stamp) with a request for such information.

The above-described procedure applies only so long as there is no litigation afoot affecting the patent sought to be amended. Where there is an action for infringement, or a proceeding for revocation pending, the patentee's right to amend is considerably curtailed. In the first place he must obtain the permission of the Court and secondly, having obtained permission, he is only allowed to amend his specification by way of disclaimer and not, as he might have done in the absence of legal proceedings, by way of correction and explanation. Such explanation, however, in the body of the specification as is required for the purpose of defining the disclaimer will be allowed. If the proposed amendment goes beyond what the Court considers to be a fair disclaimer, or if the proposed amendment appears to be futile and of no avail to save the patent, leave to amend

will be refused. The Court has absolute discretion to grant or withhold permission and to impose such terms as to costs and otherwise as it thinks fit. In an action for infringement where the plaintiff desires to amend his specification, the terms usually imposed are that he shall pay all the costs of the action up to the application and waive all claim to relief in respect of any infringement committed prior to the amendment. Due notice of an application to the Court for leave to amend must be given to the Comptroller to enable him to appear, if he so desire, and oppose the application.

Where a patentee has applied to the Patent Office to amend his specification, there being at the time no action for infringement or proceeding for revocation pending, the application can proceed without the leave of the Court, notwithstanding that an action is subsequently begun, before the amendment is completed. An action ceases to be "pending" as soon as judgment has been given; the fact that an appeal has been lodged does not make it necessary for the patentee to go to the Court for leave to amend.

Seeing how doubtful and difficult a matter it is to amend a specification after litigation has begun, it is well for a patentee, before launching his writ for infringement, to pause and consider whether amendment is required as a safeguard against the attack that will almost inevitably be made upon the validity of his patent.

Generally speaking, carefully drawn specifications should need no amendment, for the function of amendment is to correct mistakes and to clear up ambiguities which, if the specification were well drawn, would not occur. The commonest mistake into which applicants fall is that of claiming more than they are entitled to, a tendency against which the Patent Office examination and the chance of public opposition provide a partial corrective. So far, however, from striving to avoid these defects, some patentees

are prone to draw their claims as widely and vaguely as they can, consistently with the requirements of the Patent Office examiners, their aim being rather to obtain broad and pretentious claims than a really sound patent. This is shortsighted policy, for it must be remembered that amendment is not allowed as a matter of course. In giving judgment in a recent case (*Klaber's Patent*), Lord Justice Romer strongly deprecated the practice of patentees unduly widening the scope of their claims, thereby preventing the public from properly gathering what the true invention is, and perhaps intimidating them into yielding to unjust claims.

No amendment is allowed which would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed in the unamended specification. This is an invariable rule, applicable no less to amendments made before the sealing of the patent than afterwards. The Law Officer's decision as to the conformity of an amendment with the above rule is final, and an amendment cannot subsequently be impeached on the ground that it enlarges or varies the scope of the invention claimed. Of the three forms of amendments ordinarily available, namely, disclaimer, correction and explanation, the most important is undoubtedly amendment by disclaimer. Speaking of this form of amendment in *Ralston* v. *Smith*, Lord Westbury says:—"The object of the Act authorising disclaimers was plainly this: that when you have in your specification a sufficient and good description of a useful invention, but that description is imperilled or hazarded by something being annexed to it which is capable of being severed, leaving the original description in its integrity good and sufficient without the necessity of addition, then you may, by the operation of a disclaimer, lop off the vicious matter and leave the original invention as described in the specification untainted and unimpaired by that vicious excess."

A specification which claims the use of A, B and C, as separately suitable for a certain purpose, may be amended by a disclaimer eliminating A and B. But a disclaimer which renounces A, B and C individually, but claims them in combination, would not be permitted, since that would be an invention substantially different from the invention originally claimed. It is a question to be decided upon the facts of each case, how far a patentee can throw overboard the substance of his claims without entirely destroying the substratum or altering the character of his invention.

Dellwik's Patent is an example of the extreme limit to which a disclaimer may go. There the patentee claimed the use of chromium, niobium, wolfram, cobalt, copper, platinum and other elements for making "incandescents" for gas burners. A petition for revocation having been brought by the Incandescent Gas Lighting Company, the proprietors of the patent applied with leave of the Court to amend their specification by disclaiming all the above named elements with the exception of chromium. In allowing the amendment the Law Officer said: "It is perfectly true in this case that the patentee desires to throw a very large part of his cargo overboard, but I confess that I think, for all that, it is a case of disclaimer. It may be a case of disclaiming six-sevenths or nine-tenths or ninety-nine hundredths of what was contained in the original patent, but for all that he is not introducing anything new; he is merely retaining one of the elements which formed the subject of the alleged invention contained in the original patent."

This case affords a good illustration of a patent in which the claims are clearly severable and therefore admit of amendment by disclaimer. The same indulgence will not, however, be extended to a patentee who claims in broad terms a combination or general arrangement of mechanical parts, and subsequently, under the stress of opposition,

seeks to amend his claim by a disclaimer, restricting it to some trifling feature of the combination originally claimed. Thus in *Lupton and Place's* application the claim as it originally stood was for "the construction and formation of hinged joints for the dobbies of looms, such joints having grooves and projections and horns or hooks as illustrated in the drawings and for the purposes described." Upon opposition it appeared that the only feature for which the applicants could claim novelty was the use of a V-shaped groove instead of a rectangular groove. An amendment put forward with the object of confining the claim to this feature was not allowed, and the seal was refused, the Law Officer observing that if all that the applicants wanted was a patent for such an improvement as making the groove V-shaped instead of square, they ought to have said so in the first instance.

Amendment by *correction* and *explanation* follows the same rule as amendment by disclaimer; it must not widen or vary the scope of the claims. Where, in the case of a specification which claimed "a process for preparing colouring matters," an application was made to substitute the words "a manufacture of" for the words "a process for," in order to bring the British and foreign specifications into conformity, the amendment was refused on the ground that it enlarged the claim. A patentee is not permitted to make such copious alterations and additions as to amount practically to the rewriting of his specification, nor may he introduce, under the pretext of amendment, the fruit of subsequently acquired knowledge.

If the letter-press is ambiguous for want of drawings, these may be added by way of amendment.

As soon as an amendment has been allowed, it becomes an integral part of the specification, and the specification must thenceforward be read and construed as though it had originally been filed in the amended form, without reference

to the part struck out. Recourse may, however, be had to the superseded parts to explain any ambiguity arising out of the amendment.

In an action brought for infringement of an amended patent, the plaintiff cannot obtain damages in respect of any infringement committed prior to the amendment, unless he gets from the judge a certificate stating that the specification as originally drawn was framed "in good faith and with reasonable skill and knowledge."

Under s. 70 of the Patents and Designs Act, 1907, the Comptroller has power to correct any clerical errors in connection with the application for a patent or in the specification and to make alterations in the name or address of the registered proprietor.

Advantage may be taken of this procedure to modify the application form by the addition or removal of the name of a co-applicant. To obtain corrections of this kind application must be made on Form No. 30, bearing a 5*s*. stamp, if the patent is not yet sealed, and a £1 stamp after sealing.

CHAPTER XI.

INFRINGEMENT.

THERE is one form of flattery which even the vanity of an inventor does not relish, and that is the flattery of imitation. It is, however, the inevitable reward of a successful invention and the most signal mark of admiration that the public are wont to pay to inventive achievement. One might almost say "Happy the inventor whose patent is infringed," for that is the surest sign that he has devised something of utility and worth.

This may be thought a somewhat cynical reflection upon commercial morality of the present day, but, if proof were needed, the reports of patent cases show that it is not unjustified. There appears to be a curious moral obliquity in the general feeling and attitude of the public towards the infringement of a patent; a lapse of common honesty akin to that which excuses poaching and induces otherwise law-abiding and scrupulous folk to cheat the Customs House officials. As soon as an invention of real value is placed upon the market, it is at once marked down as fair game by a host of greedy infringers. If the patent is a strong one, attempts will be made to evade it; if it is weak, it will be openly defied. Indeed, the greatest safeguard against infringement often lies, not in the patent, but in the character of the invention. Inventions which are most easily performed are naturally most readily pirated. Herein lay the weakness of the Welsbach monopoly and the cause of the promiscuous infringement to which those patents were exposed. The requirement of costly plant to work an

invention, or of complicated mechanism or delicate manipulation, often affords far greater security against infringement than the patent itself.

But the present chapter is concerned more particularly with the legal aspect of the question, namely the extent to which a patentee is legally entitled to protection against infringement.

Infringement may be broadly defined as a trespass or unauthorised encroachment upon the protected area of the invention. To get a more accurate idea of what constitutes an act of infringement one must refer back to the terms of the patent itself. There, after conferring on the patentee the sole right to make, use, exercise and vend the invention, the grant goes on to enjoin that the public shall not "either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, licence or agreement of the said patentee in writing under his hand and seal."

It is clear from the above that there are in reality two points to be determined before pronouncing any act to be an infringement; first, whether the thing alleged to be a piracy is, as a scientific fact, the same or substantially the same as the patented invention; second, whether the act complained of falls within the general category of infringing acts. These will be dealt with in order; and first, as to the identity of the alleged infringement with the patented invention.

As regards infringement which consists in the direct and undisguised adoption of the patented invention, little need be said. If it is anything more than pilfering behind the patentee's back, it generally implies a challenge to the patentee to come forward and put the validity of his

patent to the test of litigation by instituting proceedings for infringement.

The infringer is, however, usually less candid in his methods. He takes the substance of the invention and introduces specious modifications and variations which, he claims, differentiate it from what is patented. The question then becomes simply one of construction: does the patent, upon a fair reading of the specification and claims, cover what is being done by the alleged infringer?

The extent to which a patent may be construed to cover colourable copies of the precise invention specified has been the subject of discussion in a previous chapter, dealing with the construction of specifications. A brief recapitulation here of the principles already discussed must suffice.

Where the object to which an invention is directed is entirely novel, and the inventor describes certain ways of effecting that object without restricting himself to the exact methods specified, a person who compasses the same result, by means analogous to those described, is guilty of infringement. The substitution, addition or omission of one or more parts of a mechanical or chemical combination, or the variation of the steps in a process, will still be an infringement notwithstanding that the change produces a more efficient and economical result. It may be the improvement is so marked that, taken by itself, it might well form the foundation of a separate patent. But that will not make it any the less an infringement, when used in conjunction with and for the purpose of the invention covered by the master patent.

This was the principle laid down in *Proctor* v. *Bennis* already alluded to (p. 71). Another good illustration of the same principle is afforded by the case of *Sandow, Ltd.* v. *Szalay*. There the patent related to "improvements in dumb-bells for physical culture exercises." The striking

feature of novelty was that the dumb-bell was split longitudinally into two halves separated by a spring, or something in the nature of a spring, capable of being compressed by the grip of the hand and of resuming its original position after the grasp of the hand is relaxed. In his provisional specification, the patentee expressly mentioned air springs as a possible form of spring; this was therefore clearly contemplated as an equivalent device, but the complete specification omitted any mention of air springs: the second claim, however, mentioned resilient means of expansion generally. The defendant's dumb-bell had inflated india-rubber balls between the halves of the dumb-bell at each end. It was held at first instance by Mr. Justice Byrne, that the specification claimed a combination consisting not in the invention of mere details, but embodying a new principle or idea, and that the defendant had infringed by taking the essence and substance of the invention, varying it only by the substitution of a mechanical equivalent for the type of spring specified in the the complete specification.

This decision was reversed by the Court of Appeal, which held that in view of certain evidence as to the state of knowledge at the date of the patent, the plaintiff was not entitled to have his specification construed broadly, and consequently the defendant had not infringed. The decision of the Lords Justices was also influenced by the omission to include air springs in the complete specification, which was taken as an indication that this idea had been intentionally abandoned. The case went to the House of Lords, where the judgment of Mr. Justice Byrne was restored, their Lordships holding that the result achieved was novel and that the patent had been infringed.

In cases of this kind where the object or result is strikingly novel, the doctrine of mechanical and chemical equivalents is liberally applied in favour of the master

patentee. In this connection, however, it should be remarked that to constitute an infringement the equivalent must have been known and generally recognised as such at the date of the patent. This was the decision in *Heath* v. *Unwin*. There the patentee claimed "the use of carburet of manganese in any process whereby iron is converted into cast steel." The patentee used carburet of manganese separately prepared by heating together oxide of manganese and carbonaceous material. The defendant did not use any single substance answering the description of carburet of manganese, but he put some oxide of manganese and coal tar separately into the crucible with the iron. It was not known at the time that the effect of this would be the formation of carburet of manganese in the crucible before actual union with the iron; and that coal tar and oxide of manganese were in fact a chemical equivalent for the carburet of manganese claimed by Heath. The House of Lords held that there was no evidence of infringement.

On the other hand where the object is not new, but the merit of the invention resides in the discovery of new means for producing some known result, the patentee cannot claim the same latitude in the interpretation of his specification, and an imitator may come very close to the claims of the patent without rendering himself liable for infringement. This was the effect of the decision in *Curtis and Platt*, the facts of which are shortly set out on p. 72.

The same principle is well illustrated by the more recent case of *Bailey* v. *Airey & Co.* The patent in this case related to improved apparatus for use in the production of acetylene gas. Now, at the date of the patent the generation of acetylene by the hydration of carbide of calcium was well known: the purification of the gas by passing it through water was well known too. It was also common knowledge that certain advantages were secured in using for the purpose of hydration the water which had been used for

washing the gas. All these things being thoroughly understood, the patentee devised a particular arrangement of parts by which these various operations were satisfactorily performed. The defendant attained precisely the same results by an arrangement in which the parts regulating the passage of the water through the apparatus for the purpose of hydration and purification were differently disposed. It was held that the object and purpose of the invention being old, the patentee must be tied down to his particular arrangement, and as this had not been taken by the defendant, there was no infringement.

A patentee who contends for a broad interpretation of his specification often finds himself on the horns of a dilemma. In flinging his net wide enough to catch the infringer, he runs the risk of being himself tripped up on the ground of anticipation. In other words he is forced to choose between a narrow construction, which would exclude what the defendant does, and a broad construction leading probably to the invalidation of his patent as claiming what is old.

When a patentee describes a combination which, besides being new in itself, comprises subordinate features which are also novel, the question frequently arises whether the claim should be construed to cover solely the combination as a whole, or whether it extends to the subordinate novelties. If the claim is clearly confined to the combination as a whole, then the patent is not infringed by the taking of a subordinate part, notwithstanding that that feature may be novel and essential even to the degree of being separately patentable. But this general statement requires some qualification. To take an abstract case. Suppose a combination to consist of three integers, A, B and C, and that A and B are new, but not specifically claimed, the patentee confining his claim to the entire combination. Whether the taking of A and B will amount to infringement will depend simply upon the relative importance

of C in the combination. If the omission or variation of C does not materially affect the general success of the combination, and if A, B and X would answer substantially as well, then the taking of A and B would undoubtedly constitute an infringement. This is merely another way of saying that it is an infringement to take the substance and essence of the patented invention, even though the claim is framed to claim these essentials only in conjunction with certain accidentals.

On the other hand, where the patentee has made a clear and valid claim to a subordinate part, however unimportant it may be relatively to the whole combination, that part cannot be taken and used in a similar combination without infringing the patent as a whole.

Leaving now the question of the identity of the alleged infringement with the patented invention, it remains to consider what form of dealing with the patented article constitutes an act of infringement. According to the terms of the grant the patentee has the sole right of making, using, exercising and vending the invention within the United Kingdom. Mere possession therefore of a pirated article does not constitute an infringement; but the acquisition or possession of articles for trade purposes with the intention of using them in trade would be an invasion of the patentee's right. The advertisement or exhibition of pirated goods with a view to sale is an infringement.

The true criterion seems to be that the act must be directly injurious to the patentee. He could not restrain a person from constructing a machine according to his specification, purely for experimental purposes, to ascertain whether it would work in the manner specified or whether it could be improved upon. But very slight commercial use of an experimental machine is sufficient to constitute infringement. The use of pirated articles for making experiments for the instruction of pupils has been held to

be an infringement where the effect was to defraud the patentee of his rightful royalty.

The manufacture or sale of an article which is adapted to be used for infringing purposes, but at the same time is suitable for other uses, is not an infringement, and it is immaterial what the intention of the maker or seller may be. For example, the sale of the cover for a cycle tyre, adapted and intended to be used in a combination which infringed the Dunlop patents was held not to be actionable. But there is judicial authority for saying that if the component parts of substantially the entire patented article are manufactured and sold in such a manner as to be adapted for putting together to form the whole, the fact that they are sold piecemeal will not save such a sale from being an infringement.

Possibly the infringement may be committed as a transitional step or phase in the process of manufacture of an article which in its final shape is quite free from the charge of infringement. This was the effect of the decision in *Saccharin Corporation* v. *Anglo-Continental Chemical Works*. The patentee's process was for the manufacture of ortho-toluene-sulpho-chloride, which requires to go through certain chemical changes before it is converted into saccharin. The article imported was saccharin, and this was held to be an infringement on the ground that, by the sale of saccharin, in the course of the production of which the patented process had been used, the patentee was deprived of some part of the whole profit and advantage of his patent, and the importer was indirectly making use of the invention.

A patented article may be repaired without licence from the patentee, provided the repair is not so radical as to amount practically to a re-making of the article. This point arose in connection with the Dunlop patents, the infringement complained of consisting in the repair of four old

Dunlop tyres. In one case the old wires only were retained, in the others the old canvas and wires were kept, but the tyres were provided with new canvas linings. It was held that this amounted to a reconstruction of the tyres, and was therefore an invasion of the patentee's rights.

Infringement by the *use* (as distinct from the manufacture or sale) of a patented invention raises some points requiring consideration. Owing to the variety of forms which an invention may assume, such as a process, a product, a machine or a particular application, "the use of an invention" or "the right to use an invention" are somewhat ambiguous expressions. In common parlance, a person who manufactures according to a patent or who sells the patented product may be said to use the invention. But when the licence conferred by a patentee is expressly limited to the right to *use*, as distinct from manufacture and sale, any departure from the bare user of the invention by the person licensed will constitute an infringement.

The sale or transfer of the patented article when unauthorised by the patentee, will confer no right of user upon the person acquiring possession of it. Thus, where a patented machine—a mutoscope—was taken from the licensee under a distress warrant and sold, it was held that the purchaser, though rightful owner of the machine, could not use it without infringing the patent (*British Mutoscope Co.* v. *Homer*).

It has already been pointed out that where a patented article is sold subject to express limitations as to its use, and these conditions are brought to the notice of the public, any act which is inconsistent with these limitations will constitute an infringement. As to the extent to which a patentee may go in imposing restrictive conditions upon the use of a patented invention see p. 179.

The purchaser of a patented article should also bear in mind that there are geographical limits to his right of user.

Importation is deemed to be a use of the invention within the meaning of the patent, and the fact that the patented article has been lawfully purchased from the foreign patentee does not make its introduction into the United Kingdom any the less an infringement, unless the foreign and British patents are in the hands of one and the same owner, in which case the sale of the article in one country implies a licence to use it in the other. It is only the actual importer who is liable for infringement; the foreign manufacturer is beyond the clutches of the patentee, if what he does falls short of actual importation. In *Saccharin Corporation* v. *Reitmeyer*, an action for infringement failed against a foreign manufacturer who delivered the goods, intended for importation into England, at the foreign port, notwithstanding that the contract of sale was made in England and the defendant was aware of the intended destination of the goods.

Mere transport of the pirated article within the United Kingdom constitutes a use of the invention within the meaning of the patent. Thus in *Betts* v. *Neilson* the House of Lords held that plaintiff's patent was infringed by the simple conveyance through England, for purposes of exportation, of beer bottles sealed with the plaintiff's patent metal capsules.

An article which has been manufactured, sold or imported in defiance of a patent exposes not only the original infringer, but every other person into whose hands it may come, to a separate action for infringement. The taint of its illegal origin is not cured by sale or transfer, and ignorance that it is a pirated article does not make it any the less technically an infringement, though it may now, in virtue of a new provision in the Act of 1907, exonerate the innocent offender from the liability to pay damages (see p. 151).

On the other hand it may be stated as a general proposi-

tion, that the authorised sale of a patented article carries with it a general licence to resell, and also to use it for all the purposes covered by the patent. It is questionable, however, whether the sale of a patented article, applicable to two distinct purposes, covered by distinct patents, would entitle the purchaser of the article to use it for either purpose indifferently.

CHAPTER XII.

ACTION FOR INFRINGEMENT.

A PATENTEE who finds his patent is being infringed should consider well before he embarks upon legal proceedings, for few forms of litigation are more costly than a patent action, and none are more uncertain in their issue. Moreover, until he has definitely resolved to bring an action, he should abstain altogether from attempting to stop infringement by dint of threats. In other matters of dispute a certain amount of intimidation may be practised with impunity, and a strongly worded solicitor's letter often produces a wholesome moral effect, even where no action is seriously contemplated. But where patents are concerned, bluff is a dangerous game. The threat of legal proceedings, unless followed with reasonable promptness by the institution of a *bonâ fide* action for infringement, is apt to recoil upon the threatener's own head in the shape of a counter-action for damages and an injunction. This special form of action, known as an action "to restrain threats" will be discussed presently. Here the patentee is merely cautioned, in passing, to refrain from breathing forth threatenings against an alleged infringer, unless he is prepared to carry his threats into execution.

If, however, he seriously contemplates bringing an action, his first step should be to obtain good evidence of the infringement. This he may do by purchasing, either directly or indirectly, the infringing article, or by securing the evidence of some person who is able to describe, from having seen it in actual use, the process or machine which

is alleged to be a piracy of the patented invention. But a patentee must be careful that, in procuring evidence of infringement, he does not go so far as to instigate the infringement; for where the infringing article is made by the order and in accordance with the directions of the patentee or his agent, the manufacturer will not be liable as an infringer. In some instances it is impossible to get direct evidence of infringement. For example, the owner of a patented process for the synthesis of indigo finds the market flooded with artificial indigo which he strongly suspects to have been made in accordance with his patented process; but as the manufacture of the competing article is carried on by a secret process, and inspection and analysis of the product afford no clue to the method employed, no conclusive evidence of infringement is procurable. In these circumstances all the patentee can do is to set up a good *primâ facie* case. The fact that the defendant is manufacturing artificial indigo on a commercial scale, and that the plaintiff's is the only known commercial process of manufacture will afford a sufficiently strong presumption of infringement to throw the burden of proof upon the defendant, requiring him to show that his method of manufacture is different from the patented process.

For the purpose of proving infringement, an accumulation of evidence is unnecessary. Clear proof of one or two sales of the pirated article, is sufficient, at the outset, to establish the fact that the patent is being infringed. Later on, when the plaintiff obtains inspection of the defendant's books, he will be able to ascertain and prove the full extent to which infringement has been carried, and, if successful in the action, to recover damages in respect of all infringements knowingly committed. Armed with satisfactory evidence of infringement, his next step should be to place the matter in the hands of his solicitor, and preferably a solicitor who is, or is associated with, a patent agent and is conversant

with the peculiarities of patent litigation. A critical examination of the case by a practitioner of sound experience is a very necessary corrective to the sanguine enthusiasm of the inventor, when it comes to weighing the chances of success in a patent action.

To view the position fairly, a patentee should endeavour to place himself mentally in the position of the infringer and proceed carefully to study his specification with the object of detecting beforehand any weak points that are discoverable in it; for he may be certain that if such flaws exist, they will not escape the acumen of his adversaries. An exhaustive search for anticipations should be made at the Patent Office Library, and if anything is found dangerously trenching upon the claims, and likely to impair the validity of the patent, the specification should be suitably amended before the writ is issued; for once the action has been begun, amendment can only be obtained with the sanction of the Court, and then only in the limited form of disclaimer. At the same time a patentee must not overlook the fact that he may fail to recover damages for any infringement committed prior to amendment, unless he satisfies the Court that the original specification was framed in good faith and with reasonable skill and knowledge, and that the specification as amended still covers what is complained of as an infringement.

An action for infringement having been definitely determined upon, the patentee should at once consider the advisability of retaining the services of one or more men of distinction in the particular field of science or industry to which the invention relates, to give expert evidence on his behalf. When the case involves the discussion of scientific matters of an abstruse or technical nature, evidence of this kind is imperatively required to present the case adequately to the Court; and, as specialists of the highest scientific standing are not numerous, their services

are eagerly canvassed, and the failure of the plaintiff to retain this evidence on his side, will almost inevitably result in its being arrayed against him. The general subject of evidence will be discussed later on; here it is mentioned only to emphasise the importance of considering at an early stage the expediency of securing the assistance of witnesses of this calibre.

Having escorted the patentee so far, the writer may safely commit him to the guidance of professional advisers in the subsequent conduct of legal proceedings. It is outside the scope of the present treatise to thread the intricacies of a patent action. The following outline is merely intended to furnish the uninitiated with some clue as to the normal stages through which a patent action passes, and to mark the chief features which distinguish it from other forms of litigation.

The Tribunal.

Actions for infringement of patent are tried in England by a judge of the High Court of Justice or by the Vice-Chancellor of the Palatine Court of the County of Lancaster; in Scotland, by any Lord Ordinary of the Court of Session, and in Ireland, by a judge of the High Court.

The County Courts have no jurisdiction to entertain any action wherein the validity of a patent comes in question. For a patent is a fránchise and s. 56 of the County Courts Act, 1888, excludes from the cognisance of the County Courts any legal proceeding in which the title to a franchise is put in issue.

Formerly, the practice was to try patent actions with judge and jury on the Common Law side; but now, in accordance with statutory provision, they are tried without a jury, unless the Court otherwise directs; and though the King's Bench Division still retains its competence to deal

with patent cases, the usual practice is to enter them in the Chancery Division, where the machinery is better suited to this type of action than on the Common Law side.

The judge may try the case alone, or he may, on his own initiative, call in the aid of an assessor. If either of the parties request it, he is bound to sit with an assessor.

The Parties.

A patentee, suing for infringement, should join as co-plaintiffs all those who have any legal share in the patent. If unwilling to become plaintiffs, they may be joined as defendants. The equitable owners of a patent are not entitled to sue without joining, as a party to the action, the person who is the legal owner of the patent at the date of the writ. A licensee cannot institute proceedings for infringement except in conjunction with the patentee, but there is authority for saying that an exclusive licensee is entitled to use the name of the patentee for this purpose.

All persons infringing the patent, whether by manufacture, use or sale, may be made defendants to the action. A master is liable for infringements committed by his servants or workmen notwithstanding that the acts complained of were done in disobedience to his orders, provided that they were not done outside the general scope of their employment.

Interlocutory Injunction.

If the infringement is of a serious nature and likely to continue, and the plaintiff is desirous of putting an immediate stop to it, he can, after issuing the writ, apply at once to the Court for an interim or interlocutory injunction, restraining the defendant from committing further infringement until the trial. But no injunction can be obtained

until a writ has been issued and the action thereby set on foot. In cases of extreme urgency an injunction will be granted in the absence of the other side, but such an order will only be made to bridge over the few days that must necessarily elapse before the defendants can, upon due notice, be got to appear and oppose it, if they so desire.

To obtain an interlocutory injunction, the applicant must make out a good *primâ facie* case that the patent is valid, that it is being infringed, and that there is threatened continuance of infringement. The fact that a patent has been worked for several years uninterruptedly, or that its validity has been upheld in a previous case, is usually accepted as good presumptive evidence of validity. In cases of doubt the Court will take into account the balance of convenience. The inability of the defendant to pay damages, in the event of the plaintiff succeeding in the action, might influence the Court to grant an injunction; on the other hand, where interference with the defendant's business would involve him in serious loss or hardship, without proportionately protecting the plaintiff, an interlocutory injunction would probably be refused. Undue delay on the part of the plaintiff in bringing his action, after knowledge that his patent was being infringed, is also a reason for refusing to grant an injunction at this stage.

When granting an interlocutory injunction, the practice of the Court is always to require the plaintiff to enter into an undertaking with the defendant to recoup him for any loss he may suffer in consequence of the injunction, if the plaintiff is unsuccessful in his action and the prohibition, therefore, turns out to have been wrongly imposed.

If, to avoid an injunction, the defendant offers to keep an account of all the alleged infringing articles manufactured and sold, this alternative is usually accepted by the Court.

Pleadings.

The form of the pleadings in patent actions is prescribed by Statute. The statement of claim must be accompanied by "particulars of breaches"; that is, a statement of one or more *specific* acts of infringement committed by the defendant. The defendant, if he disputes the validity of the patent sued upon, must deliver with his defence "particulars of objections"; that is to say, a statement of the various grounds upon which validity is impugned. The usual grounds are:—

(1) *Want of novelty*, by reason of (*a*) prior publication, or (*b*) prior user.
(2) *Want of subject matter.*
(3) *Want of utility.*
(4) *That the invention is insufficiently described.*
(5) *That the patentee is not the true or first inventor.*

The latter defence, if it is anything more than a formal plea, usually involves the imputation of fraud.

(6) *Any ground upon which the patent can be revoked* (*e.g.*, that the invention is worked exclusively or mainly outside the United Kingdom).
(7) *That the patentee has entered into an agreement* (affecting the patent) *containing a restrictive covenant that is null and void under s.* 38 *of the Act of* 1907.

Where prior publication is pleaded, full particulars of the specification or treatise relied on should be set out, and where the whole is not relied on, the particular passages should be specified. The defendant will be precluded at the trial from citing, except by special leave of the Court, any publication not referred to in the particulars of objections.

Counterclaim for Revocation.

By a special provision in the Act of 1907, a defendant may now couple with his defence to the infringement action

a counterclaim for the revocation of the patent. It must be remembered, however, that unless he has a *locus standi* for presenting a petition to the Court (see p. 184), he should fortify himself by procuring the Attorney-General's *fiat*.

Inspection and Discovery.

Personal inspection of the defendant's method of manufacture is sometimes essential to enable the patentee to prove infringement. Where the plaintiff finds difficulty in establishing this part of his case, he may apply for an order to inspect the alleged infringing plant or machinery. The application may be made at any stage of the proceedings, and though inspection cannot be demanded as a matter of right, the Court will usually make the order, if it is satisfied that there is good presumptive evidence of infringement and that there is really a case to be tried. For the object of inspection is confined strictly to procuring evidence for the trial, and the Court is careful to guard against abuse of this procedure; consequently any application savouring of an inquisitive prying into the trade secrets of a rival manufacturer will be refused. Nevertheless, the fact that inspection must necessarily involve the disclosure of trade secrets will not deter the judge from making an order, where he deems inspection desirable in the interests of justice. In some instances this objection has been overcome by arranging for an independent expert to make an inspection and report to the Court upon the facts.

A defendant is equally entitled to an order for inspection of the plaintiff's premises, where needful for the proof of his case. Interrogatories may be administered in patent proceedings, as in other actions, with the object of eliciting admissions from the other side which will simplify the issues and relieve the parties from the expense of calling unnecessary evidence at the trial. The ordinary rules

prevail also as regards disclosure of documents relevant to the matters in issue. For example, all books of account relating to the manufacture, purchase or sale of alleged infringing articles must be produced, and where infringement is admitted or proved, the Court has even ordered the defendant to disclose the names and addresses of customers, such information being necessary to enable the plaintiff to investigate the amount of profits.

It should be observed that the rule exempting from inspection all communications between solicitor and client does not apply to communications between an inventor and his patent agent.

Evidence.

The notoriously heavy expense of patent litigation is chiefly due to the panoply of evidence with which it is thought necessary to load every patent action. It is no exaggeration to say that half the cost of a patent trial is ordinarily expended in fees to expert witnesses and in experimentation for the purpose of evidence. No doubt this is in a great measure inevitable; but it cannot be denied that the evil has been considerably aggravated by a judicial system which devolves upon judges, selected without any regard to their scientific attainments, the task of adjudicating upon matters of a highly technical nature. Commercial cases, shipping cases, matrimonial cases and bankruptcy proceedings have each their respective and distinct tribunals presided over by judges specially qualified for such work. Patent actions, on the other hand, though no less important and involving knowledge no less technical and specialised, have hitherto been dealt with by judges appointed without reference to any such special qualification.

Hence a considerable amount of time is inevitably expended in explaining the fundamental facts and principles belonging to the particular branch of science or

technology upon which the case rests and with which a judge chosen on the strength of his scientific qualifications would naturally be familiar. Further, there is always the danger that these explanations emanating as they do from witnesses called to support contrary views of the case, may be misapprehended; in other words, that axioms may be mistaken for argument and *vice versâ*.

So long as this system continues, patent actions must continue to be an unduly prolix and costly kind of litigation. It seems, however, that a welcome change in this respect is at hand. Amongst the innovations contemplated by the recent Act, is the allocation of all patent actions to a single judge of the High Court, to be chosen by the Lord Chancellor. This reform, as soon as it is carried into effect, should do much to reduce the length, and consequently the expense, of patent actions.*

Although, owing to the above cause, the tendency has been to overburden patent actions with evidence, yet it is impossible to overrate the importance of the *rôle* which evidence plays in the success or failure of a patent action, and the need for the discriminating choice of those witnesses from whom the necessary evidence is to be obtained.

Besides the ordinary type of witness called to prove the purchase of an infringing article or the fact of a prior user, there is, first and foremost, that familiar and indispensable appendage of all patent actions, the expert witness. Generally speaking, expert witnesses are of two distinct types. There is the trade expert who speaks from practical experience of the industry or manufacture to which the invention relates, who is familiar with its technical terms and whose intimate knowledge of the subject has been acquired quite independently of the exigencies of a law-

* Since the above paragraph was printed, this reform has been carried into effect; the first of the Judges specially appointed for the hearing of patent actions being Mr. Justice Parker.

suit. Then there is the philosophical expert, who may either be a specialist in some particular branch of science or like the famous philosopher of whom it was said: "Science is his hobby, omniscience his foible"—a specialist in all its branches. It is this last named versatile, almost protean, type of scientist who figures most conspicuously in the modern patent action. However simple and homely the subject matter of an invention may be, it is not beyond his ingenuity to discover profound and subtle scientific principles to characterise its operation and give it distinction. He is equally at home in expounding the principle of an alternating current electricity meter or in explaining in scientific terms the compensation of stresses and strains effected by a novel method of lacing leather gaiters. The function of an expert witness is to give evidence on questions of fact; as to novelty, utility, the meaning of scientific terms and technical phrases and the like. His opinion as to whether there has been infringement is inadmissible, as such a question involves placing a construction upon the language of the specification which is a matter for the judge alone. It is, however, permissible to ask a witness what meaning the specification conveys to his mind. For, as Lord Bowen once observed, "the state of a man's mind is as much a matter of fact as the state of his digestion."

A not inconsiderable item of cost, which has usually to be taken into account under the head of evidence, is the cost of making experiments, both before the case comes on and during its progress, for the purpose of proving or refuting the various contentious points that arise in the course of the argument. Although such experiments are often very useful, it should be remembered that the Court is wont, as a general rule, to look with distrust upon experiments performed with a view to manufacturing evidence for the trial, and too much reliance, therefore,

should not be placed on evidence of this kind. Occasionally experiments are carried out at the instance of the judge. When, for example, doubts are raised as to the ability of the invention to perform what is claimed for it, the patentee may be required to work the invention in open Court, or if this is impracticable the judge may direct a test to be performed in the presence of an independent expert who afterwards makes his report. Models and diagrams are sometimes of great service in elucidating the subject matter of the invention. In order to make them available as evidence, models must be put to the witness during his examination, whereupon they become exhibits to his evidence, and are marked for future reference with his initials and, if there are several exhibits put to the same witness, with a number after the letters, thus "J. S.^{3}" These exhibits must be carefully preserved intact even after the trial, in case they may be wanted again for the purpose of an appeal.

The Trial.

The hearing of patent cases, according to the usual mode of trial at the present time, namely by a judge of the Chancery Division without a jury, is an undoubted improvement upon the previous practice which required the submission of questions of fact to the jury, the judge dealing only with questions of law. For in the ordinary patent action the issues of law and fact are so closely interwoven that their severance and independent determination is a matter of extreme difficulty. Moreover, as in such cases the evidence is largely argumentative and relative to matters of opinion, and as the questions of fact are mainly questions of science, they are, to say the least of it, as likely to be well dealt with by a judge as by a jury.

In cases of technical difficulty the judge is at liberty to call in the aid of a scientific expert, as assessor, to guide

his judgment on the technical parts of the case. When this course is taken, the usual practice is for the assessor to embody his opinion in a written report upon which the judge bases his decision, and which, in the event of an appeal, is open to perusal by the Court of Appeal. As an alternative to trying the case with the help of an assessor, the judge may send the issues of fact to be tried before an official or special referee.

Where the defendant alleges that his process is no infringement of the plaintiff's patent, but a secret process, and that to divulge it in open Court would be highly prejudicial to his business, the judge may order the case to be heard *in camerâ*.

The Remedies.

A plaintiff who has succeeded in proving infringement and in upholding the validity of his patent has a two-fold remedy. He is entitled to pecuniary compensation for loss sustained in consequence of the defendant's wrongful acts, and further, if need be, to the protection of the Court against any future encroachment upon his patent. By way of compensation, he may have, at his option, either damages or an inquiry as to profits made by the infringer through the unauthorised use of the invention. These remedies are alternative, but a plaintiff who has obtained judgment and damages against one co-defendant is not precluded from taking an inquiry as to profits against another. Owing to the extreme difficulty and expense involved in conducting an inquiry as to profits, this form of remedy is discouraged by the Courts, and is only resorted to in exceptionally simple cases.

By far the most usual practice is to take an order for damages. These the judge may assess off-hand, where the loss is easily calculable or merely nominal damages are asked for; otherwise an inquiry is directed. This inquiry

is referred to one of the masters in the Chancery Division, who, after examining into the facts, assesses the damages at a sum which, in his opinion, represents the loss naturally and directly flowing from the defendant's infringement. The true measure of damage appears to be the extent to which the infringement has interfered with the sale of the patented article or the profits of the patentee; and where the evidence fails to prove any such interference or direct pecuniary loss, no damages will be awarded. In estimating the loss due to infringement, it cannot be inferred that the plaintiff would have sold all the pirated articles sold by the defendant. But the effect of the infringer's competing sales in lowering the plaintiff's prices would be a matter properly to be taken into account.

Where the infringement relates only to part of the entire article as sold, the patentee's claim for damages is restricted to his loss of profit on that part alone. Thus in a recent case, *Clement Talbot, Ltd.* v. *Wilson*, the defendants purchased a French motor-car fitted with some patented accessories of the plaintiffs, motor-car manufacturers in London, without their licence. On enquiry as to damages, it was held that the measure of damages was the loss of profit on the sale of the patented accessories only, and not the loss of profit on the sale of the whole motor-car.

The Statute of Limitations precludes the plaintiff from recovering damages for infringements committed more than 6 years before the date of the action. Also it should be remembered that where a specification has been amended, no damages can be recovered for infringements anterior to the date of amendment, unless the Court certifies that the specification, as originally drawn, was framed in good faith and with reasonable skill and knowledge.

By electing to take an account of profits, a plaintiff virtually condones the infringement and treats the infringer as his agent. Sometimes an intermediate course is adopted,

the plaintiff agreeing to take, in lieu of damages or an account of profits, an inquiry as to what would be a proper sum for the defendant to pay by way of royalty upon all the infringements committed. This is, in effect, granting an *ex post facto* licence to the infringer, and proves in many cases of the manufacture or sale of pirated articles a convenient form of compensation.

An important change in the law affecting a patentee's right to recover damages for infringement has been introduced by the Act of 1907. It is now a good defence to a claim for damages for the infringement of any patent *granted after the 31st of December*, 1907, that the defendant was unaware of the existence of the patent, when he committed the infringement. The Act states further that the marking of an article with the word "patent" or "patented" shall not be deemed to constitute notice of the existence of the patent, unless accompanied by the year and number of the patent.

This has long been the law in regard to the infringement of registered designs, and the decisions in design cases as to the kind of notice and knowledge required to deprive the defendant of this plea will doubtless be taken by the Courts as a guide in applying the same principle to patents.

The second remedy to which a successful plaintiff is usually entitled is a perpetual injunction restraining the defendant, his agents and workmen from infringing the patent during the residue of its term. The granting of an injunction is purely a matter for the discretion of the Court; and where damages are sufficient to meet the needs of the case, or the likelihood of the infringement being repeated is remote, no injunction will be granted. An injunction is essentially a precautionary measure, and is only warranted by the danger of future infringement. Past infringement is usually accepted by the Court as sufficient evidence of the infringing propensity of the defendant to justify the

granting of an injunction, unless the infringement committed is manifestly an isolated act and not likely to be repeated. Even though no actual infringement has been committed, an injunction will be granted where an infringement is clearly threatened. If the defendant consents to judgment, the practice is to substitute for an injunction an undertaking by the defendant to refrain from infringing. This is done to obviate the danger of misrepresentation that the injunction has been "granted" by the Court after investigating the merits of the patent.

An injunction is dissolved by the determination of the period of the patent. But when, in anticipation of this event, a manufacturer had made large quantities of pirated goods with the intention of flooding the market as soon as the patent expired, he was restrained even after the lapse of the patent from disposing of the goods so manufactured.

Disobedience to an injunction renders the offender liable to committal to prison for contempt of Court, and, in the case of a corporation, to an order for sequestration against the company and attachment of the directors.

In addition to an injunction and damages the order of the Court usually includes a direction for the delivery up to the plaintiff or destruction of all infringing articles. Where the infringement consists in a subordinate part of the whole, the order is confined to the infringing part. It should be noted that the property in articles delivered up to the plaintiff under order of the Court remains in the defendant; the latter cannot, however, take advantage of this fact by setting off their value against the damages, which he is condemned to pay in the action. Should the defendant succeed on appeal, he is entitled to the return of the articles delivered up.

If, on the other hand, the defendant is successful in the action, he will be entitled to judgment on one or both of the following grounds, as the case may be, viz., (1) that

what he has done is outside the scope of the plaintiff's patent, or (2) that the plaintiff's patent is invalid.

Assuming that the defendant succeeds upon the latter issue and that he has coupled with his defence a counter-claim for revocation, he will be entitled to an order revoking the plaintiff's patent. The Court may, however, suspend the order for a few days to give the plaintiff time to amend his specification, if it thinks the invalidity of the patent capable of being cured by amendment.

Costs.

The general costs of a patent action are dealt with in the usual way, the unsuccessful party being compelled to pay the costs of the successful party; but the judge has discretion to deviate from this rule by depriving a successful, though undeserving, litigant of his costs, or by apportioning them between the parties as he thinks fit. The following special points of practice should, however, be observed. A successful plaintiff in a patent action cannot get the costs of his particulars of breaches, nor can a successful defendant get the costs of his particulars of objections unless at the conclusion of the trial he applies and obtains the judge's certificate that such particulars were reasonable and proper.

If the plaintiff has complained of acts of infringement which he has failed to substantiate, the costs entailed by raising these issues will fall upon him and the judge will restrict his certificate to those particulars which have been actually proved. Similarly where the defendant has cited in his particulars of objections specifications which were not referred to in the argument or has alleged a prior user as to which no evidence was offered at the trial, he will get no costs in respect of these particulars.

When the trial results in the validity of the patent being

upheld, the plaintiff is entitled to a certificate from the judge stating that the validity of the patent came in question. The advantage of obtaining this certificate is that the patentee can, in the event of his succeeding in any subsequent action for the infringement of the same patent, obtain from the defendant costs as between solicitor and client. A certificate that the validity of the patent came in question may be granted even though the issue of validity is not tried out at the trial, either by reason of the defendant's failing to appear or consenting to judgment; but no certificate will be given in respect of a patent, the claims of which have been held to be wholly or partly invalid.

Appeals.

From the final judgment of a Court of First Instance an appeal lies to the Court of Appeal within 3 months. A decision upon an interlocutory point may be appealed from within 14 days. Fresh evidence may only be introduced in the Court of Appeal by special leave, and such leave is not easily obtained. If the case is carried up to the House of Lords, the appeal must be lodged within a year after the judgment appealed from; and, unless the appellant proceeds *in formâ pauperis*, he must within a week of the presentation of the appeal, enter into a recognisance to the amount of £500, and further pay a deposit of £200 or furnish sureties for that amount, as a guarantee of his ability to pay the respondent's costs, should the appeal fail.

CHAPTER XIII.

ACTION TO RESTRAIN THREATS.

The need for providing the public with a weapon of defence against the unjustifiable pretensions of patentees was recognised at a very early date. Section 4 of the Statute of Monopolies declares that any person hindered, grieved, disturbed or disquieted by the pretext of any monopoly or grant of letters patent may have his remedy by action at Common Law upon that Statute and recover treble damages and double costs. Although this section still remains unrepealed, no advantage seems to have been taken of it, and even the alluring prospect of treble damages has proved insufficient to tempt litigants to deviate from the beaten track and adopt this somewhat archaic form of action.

Prior to the Patents, Designs and Trade Marks Act of 1883, the course ordinarily resorted to was a suit at Common Law, analogous to the action for slander of title, the remedy asked for being an injunction, restraining the defendant from uttering threats, and damages. To succeed in this action the plaintiff must show not only that the insinuations made by the defendant are untrue, but that they were uttered in bad faith with the object of injuring the plaintiff. Owing to the extreme difficulty of proving that the threats complained of were actuated by malicious intent, this remedy, though still subsisting, affords very inadequate protection to the public. Threats uttered by the owner of a patent in the honest belief that his rights are being infringed, when in point of fact they are not, and the

patent is worthless, are no less harassing to a manufacturer or tradesman than threats inspired by malice. The right policy of law is obviously that the threatener should be obliged to justify his pretensions by the test of an action, with as little delay as possible. To adopt Lord Bowen's metaphor, the sword of Damocles should either not be suspended at all or it should fall at once.

This was, in substance, the purpose of the statutory remedy introduced by s. 32 of the Act of 1883, which is now re-enacted in s. 36 of the Patents and Designs Act, 1907. The section is as follows:—"Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats." Up to this point it is clear that the statutory remedy is merely a simplification of the Common Law action for threats, relieving the plaintiff from the necessity of proving bad faith on the part of the defendant and only requiring him to show that there has been no infringement of the patent, and that the threat is, therefore, unjustified. An important qualification, however, follows in the proviso to the section, which states that the section shall only apply, "if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent." Thus, by promptly carrying his threats into execution, the patentee may entirely avert any liability under this section; and, notwithstanding that the threats may prove to have

been utterly baseless and the patent invalid, the commencement and diligent prosecution of an action for infringement will afford him a complete defence.

As regards the manner of threatening, the language of the Statute is extremely wide, and may be taken to include practically every kind of document which conveys either directly or impliedly a threat of legal proceedings. Threats contained in a solicitor's letter or in correspondence marked "without prejudice," and even verbal threats have been held to be actionable. An intimation in answer to an enquiry respecting a recent invention, that the writer considered it to be an infringement of his patent and intended to stop its sale, was considered to be an actionable threat. Again, a single threat has been deemed sufficient cause for granting an injunction; for until a threat is withdrawn, its effect is looked upon as continuing.

To afford ground, however, for an action under this section, the threats must be directed to some particular person or persons or must refer to some specific act of infringement committed or intended to be committed. A general warning to the public that a certain patent has been infringed, and that the owners of the patent intend to take drastic measures to put a stop to infringements, would not come within the category of actionable threats. Everybody has still the right to issue a general caution to pirates not to pirate, and to infringers not to infringe, and to warn the public that the patent to which the patentee is entitled and under which he claims is one which he intends to enforce. But if the threat conveyed in a general circular or advertisement is clearly aimed at some particular person, its apparent generality will not absolve the threatener from liability under this section. Moreover an apparent caution is sometimes a covert threat. Thus, in the recent case of *Craig* v. *Dowding*, the defendant wrote to one of the plaintiff's customers to the following

effect: "The article being sold and advertised by you is regarded as an infringement. We therefore request you to cease advertising and selling the article in question." This was held to be a threat within the meaning of the Act.

Similarly whenever, to quote Lord Justice Lindley, the warning may be paraphrased: "Friend, I have got a patent and I intend to protect it; do not infringe it:" that amounts to an actionable threat.

In considering whether an action is commenced with due diligence, the Court looks to the lapse of time ensuing upon the issue of the threat; the date of the alleged infringement, evoking the threat, does not affect the question. Provided that a *bonâ fide* action for infringement is instituted and diligently prosecuted, its discontinuance before trial will not prevent its being a good answer to an action for threats. How many stages beyond the issue of the writ it would be necessary to carry an infringement action to substantiate its *bonâ fide* character, must depend upon the circumstances of the case. Nor does it matter if the action is carried to trial and fails. The Statute does not say that the action must be prosecuted successfully. Unsuccessful prosecution will do, provided it is with due diligence.

But when the patent upon which the threat is based is notoriously invalid, so that any action that may be instituted for infringement is obviously bound to fail, that is a mere sham action and does not satisfy the requirement of the Statute.

The trial of an action for threats necessarily involves the simultaneous trial of the ordinary issues of an infringement action; consequently, where the patentee justifies his threats by launching an action for infringement, the usual practice is to stay the action for threats until the trial of the other action. If infringement is

proved, the action for threats vanishes; if, on the other hand, it is held that there has been no infringement, the plaintiff in the threats action will be entitled to damages, unless the patentee satisfies the Court that he commenced and prosecuted his action for infringement with due diligence.

CHAPTER XIV.

NEGOTIATION OF PATENTS BY SALE AND LICENCE.

In considering the disposal of his patent rights, a patentee has, broadly speaking, two courses open to him. The first is to sell his patent outright, the second is to grant licences to one or more persons to use the invention. His desire is naturally, if a purchaser can be found, to dispose of his patent outright for cash; but that, unhappily for the sanguine inventor, is an ambition seldom gratified except in the case of inventions which may be bought for a comparatively small outlay. He has usually to be content with a bargain involving payment in a gradual and often precarious form.

It would be idle to attempt to formulate in the abstract the course which an inventor should pursue in setting about the disposal of his patent. That must be determined by the circumstances of each case. But one piece of advice of universal applicability may be given to inventors, and that is to see that, before beginning the campaign, their inventions are in a practical and commercial shape. Where possible, evidence of actual working should be forthcoming and estimates of cost prepared, showing what economies may be reasonably expected to be realised or what profits made, when the invention is worked on a commercial scale. Models are often very helpful in explaining the principle of mechanical inventions, if the actual machine is not immediately producible, as they

convey far more to the ordinary lay mind than any number of mechanical drawings.

Where the invention consists in a process of manufacture, *e.g.*, a chemical process, and those whom it is desired to interest in it wish to see it in operation, the demonstration should be as complete as is practicable. Many good inventions have failed to attain commercial success simply through careless or inadequate exhibition of their merits. The inventor is apt to assume, in favour of his invention, many things which a cautious purchaser will refuse to take for granted. No precaution, therefore, should be neglected for ensuring the presentation of the invention in its most finished and attractive form.

Assuming that, as the result of due attention to these points, the inventor finds himself in favourable touch with a prospective purchaser or user of the invention, we may proceed to consider from a legal standpoint the various ways of disposing of his patent right, by assignment or licence, which lie open to the patentee. Concurrently with presenting the legal aspect of these matters, the opportunity will be taken to point out the practical results which flow from either method of dealing, and some of the contingencies which a business man should keep in view in determining which course to adopt.

It should be remembered that an inventor has no exclusive property in his invention until he has patented it. He may prevent others from fraudulently patenting his inventive ideas, but he has no remedy for the theft of them until they have been incorporated in letters patent. An inventor need not, however, wait to open negotiations until his patent has been granted. As soon as he has obtained provisional protection, he may safely proceed at once to negotiate for the sale of his rights. An agreement made at this stage is, of course, conditional upon a patent being obtained, and usually contains an undertaking

on the part of the applicant to use his best endeavours to procure the grant of a valid patent and, having obtained it, to assign it to the purchasers.

In obedience to the general rule that rights conferred by a document under seal can only be transferred under seal, the assignment of a patent must be effected by deed. But an informal agreement (contained, for example, in letters of offer and acceptance) to sell a patent in return for a sum of money or other fixed consideration will, if necessary, be enforced by the Courts, and the recalcitrant party compelled to execute a proper assignment.

A complete assignment transfers all the property and rights conferred by a patent to the assignee, who thenceforward stands in the position of the original patentee. The assignment may be to an individual or a corporation, or to any number of persons, each of whom as joint-owners of the patent will be entitled to exercise the full rights of a patentee; with the exception, introduced by s. 37 of the Act of 1907, that a joint-patentee cannot grant a licence without the concurrence of his co-owners.

If he chooses, the patentee may assign only a part of his patent rights. In bargaining, however, for the sale of a fractional share of a patent, it should be borne in mind that a man who purchases a tenth share in a patent can use the invention as freely as the owner of the other nine-tenths. Or again, a patentee may dispose of his rights for a particular district of the United Kingdom. He may, for example, make an absolute assignment of his patent rights for Scotland, so that, apart from express restriction, the assignee would have a perfectly independent right to work the invention, to grant licences and to sue for infringement anywhere north of the Tweed. It is obvious, however, that in all cases of partial assignment, resulting in co-ownership of a single patent, some restriction upon independent action and provision for co-operation is

essential, particularly in reference to such matters as payment of renewal fees, amendment and litigation, in regard to which the inaction or independent action of one of the co-patentees might imperil the existence or validity of the patent.

In selling a patent outright, the patentee should endeavour to get, if not the whole, at least a considerable part of the purchase money paid as soon as the assignment is completed. The balance may be paid by instalments of fixed amount, or calculated upon the quantity of patented goods manufactured. In the latter case, as there is no implied undertaking that the assignee will manufacture at all under the patent, it may be desirable to stipulate that the yearly royalty should not in any event be less than a certain minimum amount. A purchaser should consider the advisability of inserting in the deed of assignment provisions to the following effect:—

1. That the vendor will instruct the purchaser in the working of the invention and afford him such information and assistance as may be necessary to enable him to carry out the invention to the best advantage.
2. That the vendor (if he is the inventor) will keep the purchaser informed of all improvements he may make during the term of the patent and, at the purchaser's request, assign to him the benefit of such improvements.
3. That the vendor will refrain from engaging in or fostering any work antagonistic or prejudicial to the success of the invention sold.

As there is no implied warranty upon the part of the vendor that the patent is valid, if the assignee wishes to make this a term of the contract, it should be expressly provided for.

Where licences have already been granted by the vendor, they must be set out and the assignment made subject to

them. The concurrence of the assignee is not, however, necessary in executing a deed of licence, the terms of which have already been agreed to by the patentee prior to assigning his patent.

A patent may be assigned by way of mortgage, but the mortgagor in possession still remains the legal patentee, and can sue for infringement without joining the mortgagee as co-plaintiff.

The vendor who receives payment in full upon the assignment of his patent rights is not concerned with the subsequent fate of the patent; it is immaterial to him whether it is infringed or whether renewal fees are paid. But when the arrangement is that the purchase price shall be paid by instalments of royalties depending upon the subsistence of the patent, the vendor who has made an absolute assignment is at a disadvantage, inasmuch as the patent is no longer under his control. Indeed, in such a case it becomes a matter for serious consideration whether it is not the better course to grant a licence instead of making an assignment. For, in order to safeguard himself, the vendor would have to encumber the assignment with so many conditions as to the payment of renewal fees, amendment and the bringing or defending of actions, as to virtually reduce the assignee to the position of a licensee: whereas by granting a licence, the patentee retains direct control over the patent and transfers to the licensee just so large or small a share of its privileges as he wishes to part with. On the other hand, the scope of a licence may be so wide as to place the licensee practically in the position of sole proprietor of the patent.

The various forms of licence may be conveniently considered under three heads; General, Exclusive and Restricted.

General Licence.—A general licence, in its fullest form, confers on the licensee the right to "make, use, exercise

and vend" the invention anywhere within the United Kingdom. It places no restriction upon the patentee's power of granting other licences on similar or different terms, and gives the licensee no control whatever over the patent itself. Its effect is simply to exempt the licensed user of the invention, on certain conditions, from the consequences of what would otherwise be infringement.

In granting a general licence, a patentee should bear in mind that the terms granted to the first licensee will in all probability have a direct effect upon those subsequently obtainable from other licensees. For subsequent licensees will usually insist upon getting a licence on terms no less favourable than those of the licence already granted, knowing well that in order to get his invention introduced into practical use, a patentee is apt to agree to take a smaller royalty than he would otherwise be disposed to accept, were his invention of proved utility. Before, therefore, acceding to a first licence on terms highly preferential to the licensee, a patentee should carefully consider the likelihood of such a licence prejudicing his chance of getting better terms from subsequent licensees.

It is open to question how far a licensee, who is empowered "to manufacture and sell" the patented article, is entitled to sell *without* manufacturing. For example, a manufacturer licensed to manufacture and sell, provided he paid a certain royalty on all patented articles made by him, might find it more convenient to purchase the goods ready-made in Germany and merely to sell in England, thus evading the payment of royalty. The possibility of an evasion of this kind should be considered and provided for accordingly.

Exclusive Licence.—An exclusive licence is, from a competitive point of view, as valuable as a complete assignment of the patent. It gives the licensee full power to use the invention, coupled with the assurance that no further

licences will be granted in derogation of his monopoly. Even the patentee may be restrained by an exclusive licensee from using the invention, unless his right to do so is expressly reserved. But, in assenting to any such reservation, the licensee should be careful to see that the right to use the invention is a personal right only, and does not extend to the patentee's assigns. Otherwise the patentee, though debarred from granting additional licences, might by subdividing his patent amongst several persons seriously diminish the value of the exclusive licence. Indeed, such a result might come about automatically by the devolution of the patent upon the death of the patentee, his rights becoming vested in several joint owners, each equally at liberty to work the invention on his own account.

Since, in granting an exclusive licence upon terms of royalty based on manufacture, the patentee stakes everything upon the licensee's possessing the industry and ability required to work the invention to the best advantage, it is always a wise precaution in such cases to stipulate for a minimum annual payment, as a safeguard against mismanagement and lack of enterprise on the part of the manufacturer.

The unqualified sale of a patented article by a person licensed to sell it conveys a free licence to use not only to the purchaser, but to all subsequent possessors. But the purchaser of a patented article from a licensed manufacturer abroad obtains no right to introduce it into the United Kingdom.

Restricted Licence.—A licence may be restricted in many ways. The right to use the invention may be confined to a particular locality, or the terms of the licence may sanction the use of the invention only in its application to one of several purposes covered by the patent. Conditions as to price are frequently attached to licences, prohibiting the licensee from selling under a certain figure.

A licensee using the invention otherwise than in accordance with the terms of the licence is liable to an action for infringement, like any other member of the public who uses the invention without authority. Thus, where licensees were sanctioned under a patent to manufacture a certain kind of lamp for lighting purposes, and they used the lamp also for heating purposes in the form of a stove, this was held to be an infringement.

Conditions may be imposed affecting not only the manufacture and use by the licensee himself, but also by subsequent users into whose hands the patented article may come. *Incandescent Gas Light Co.* v. *Brogden* affords a good illustration of such a limited licence. It appears from that case that it was made a condition of the sale of Welsbach mantles, that they should only be used in conjunction with a particular kind of burner. The defendant bought some mantles from a general dealer, and, though he was aware of the conditions attaching to their use, used them on burners other than those prescribed. This was held to be an infringement of the patent rights in the article. Had he used the mantles on unauthorised burners in ignorance of these conditions, the case would have been different; for, unless the conditions of a restricted licence are brought to the knowledge of the public, they cannot be restrained from using the article as though its use were unconditional.

The recent case of *Badische Anilin und Soda Fabrik* v. *Isler* also bears on the same point. Dye-stuff was sold in packages to which was attached a label headed "Important Notice" and stating that the purchaser of the dye was not licensed to resell it, except in the unopened original package, in unchanged condition and with the label intact, and no persons other than the purchasers of such packages were licensed to use the dye therein contained. This was held to be a sufficient notice and binding on the

purchaser, notwithstanding he did not buy direct from the patentees.

It should be observed that a restrictive condition, such as that imposed in the *Welsbach* case, would probably now be held void under s. 38 as being in restraint of trade and contrary to public policy. For this aspect of restrictive covenants the reader is referred to p. 179, where the subject is fully discussed.

The drafting of licences is not safe in unprofessional hands. The numerous contingencies, which the circumstances of each case involve, require the knowledge and experience of highly trained professional men to foresee and adequately provide for. Here it is impossible to do more than indicate some of the more vital points to be borne in mind.

The grant of a licence should be made under seal; but an agreement not under seal, which has been acted upon and treated as a completed licence, will be binding as between the parties.

A licensee has no power to bring an action in his own name against an infringer. He must join the licensor as co-plaintiff. This appears to be the rule even in the case of an exclusive licensee, though the point has never been directly decided.

It is a well-recognised principle that the licensee may not call in question the validity of the patent under which he holds a licence. The fact, therefore, that the patent is infringed, and treated as worthless by other members of the public, does not entitle the licensee to treat it as invalid and to refuse to pay royalty. The cases even go so far as to show that a licensee may be liable to pay royalty after the patent has been declared invalid by judgment of the Court. To avoid such a paradoxical position, the licensee should see that there is a clear provision inserted for the termination of his obligation to pay royalty, upon the patent

being adjudged invalid by the High Court, unless the decision is reversed upon appeal.

With regard to covenants, it should be observed that a licence is not assignable unless expressly stated to be so. This may be done simply by making the grant to the licensee, his executors or assigns. The covenant to pay royalty should be coupled with an undertaking on the part of the licensee to produce his accounts for inspection and for verification of the amount of royalty payable.

The possibility of the specification needing amendment and the incidence of the payment of renewal fees should also be clearly provided for.

As a check upon the licensee and to facilitate the detection of infringement, it is sometimes useful to insist upon the licensee marking all articles made under the patent with a distinguishing mark.

A licence may be granted for the term of the patent or for any less period, and may be made revocable upon notice in writing or upon breach of any of the covenants.

It is usual to make non-payment of royalty a cause of forfeiture. In the licensee's interest, on the other hand, the payment of royalty should be made conditional upon the subsistence of the patent. In a case where the licensee had agreed to pay royalty in the form of fixed yearly sums, the fact that the patent had lapsed through neglect by either party to pay the renewal fees was held not to absolve the licensee from the obligation to continue the payment of royalty until the expiration of term specified in the agreement.

Assignment to the Secretary of State for War or the Admiralty.

Section 30 of the Patents and Designs Act, 1907, lays down special rules in regard to the assignment to the War Office

or Admiralty of inventions relating to improvements in "instruments or munitions of war," the object of such regulations being to keep the nature of the invention secret.

Inventors of torpedoes, military balloons, quick-firing guns and the like, who naturally look to the Government as the likeliest purchaser of their inventions, should communicate their project to the Secretary of State for War or the Admiralty as the case may be, *before publication of the specification.* Indeed, this step may be safely taken even before obtaining provisional protection, since it is specially provided that neither the communication of the invention to the Secretary of State, nor anything that may be done to investigate its merits, shall prejudice the validity of a patent subsequently granted.

Where such an assignment is effected before obtaining provisional protection, application for a patent is made upon Form No. 1D, accompanied by a certificate from the Secretary of State for War or the Admiralty, as the case may be. The specification and drawings are delivered to the Comptroller in a sealed packet, and so kept during the term of the patent; and upon its expiring, the packet is re-delivered to the War Office or the Admiralty.

The application for a secret patent is not advertised; nor is the patent entered in the ordinary Register, but in a Confidential Register of secret patents. No fees are payable in respect of secret patents, and no proceedings of opposition to or for revocation of such patents will be entertained by the Comptroller or the Court.

CHAPTER XV.

LIMITATIONS ON PATENT RIGHT.

Compulsory Licences.

(1) *Retrospective.*—One of the most remarkable features in the history of our Patent Law is the entire freedom which, until comparatively recent times, has been allowed to the patentee in the exercise of his monopoly. The use he made of his patent privilege, once it had been validly granted, seems to have been a matter of indifference, at least as far as the intervention of the Courts was concerned. This is all the more surprising, as it would appear that, had they chosen to exercise the right, the Courts possessed, from the very first, ample jurisdiction to check the abuse of patent monopolies by the simple expedient of revoking the grant when patentees used their privileges to the public detriment instead of to the public advantage. For the whole *raison d'être* of a valid grant of letters patent is that the patentee is going to benefit the community by his invention and by the establishment of new industries in the country. The Statute of Monopolies expressly states that the grant is made for the working or making of new manufactures in the realm, and stipulates amongst other conditions that it shall not be "mischievous to the State by raising prices of commodities at home or hurt of trade or generally inconvenient." Hence, if the patentee used his patent not to foster but to impede the growth of new industries in the country, it might well be argued that therein lay a

sufficient ground for revocation. Perhaps, had the point been raised while the feeling against monopolies still ran high, the Courts might have taken this view.

It was not, however, until some two centuries later that the question arose, and during that interval the views of the judges as to the grounds upon which a petition for revocation could succeed had become stereotyped, and their interpretation of the Statute of Monopolies had lost its elasticity. Failure to work an invention in this country had come to be regarded as fatal to the grant, only if the cause of failure lay in the inherent uselessness of the invention. And similarly the proviso of the Statute of Monopolies, directed against patents proving mischievous or harmful to trade, was construed by the Courts as only justifying revocation in so far as these results were directly referable to the inutility of the subject matter of the patent.

But it was not only with the judges of the High Court that the power lay to protect the public against the abuse of patent rights. The Privy Council also, it seems, possessed jurisdiction for this purpose. The patent grant itself provided (the clause has recently been omitted) that if at any time during the term of the patent it was made to appear to six or more of the Privy Council that the grant was prejudicial or inconvenient to the general community, the patent should be void. No procedure was, however, prescribed for obtaining the annulment of a patent by this means, and consequently no use was made of this expedient for keeping patent monopolies within bounds. Yet instances were not wanting of patentees who made use of their privileges very much to the prejudice and inconvenience of the general public. A flagrant example of this was the practice of foreign inventors to take out British patents solely for the purpose of reserving our markets for goods manufactured abroad, and without the least intention of working the invention in England. Shielded from

competition, the owners of the patents were free to offer their foreign-made goods over here at prices which, if not prohibitive, at least placed the British public at a disadvantage as compared with the buyer of similar goods on the continent.

The hardship of this state of things was keenly felt. As, however, the Courts professed themselves powerless to check the abuse, and no one of sufficient enterprise was found to evoke the latent jurisdiction of the Privy Council, it was plainly a matter for fresh legislation.

Two forms of remedy presented themselves for consideration: namely, to compel the patentee to work the invention himself, or to constrain him to license others who desired to use it. In most foreign countries, America being a notable exception, compulsory working was the rule, and the patentee was required to put the invention into practice within the specified number of years on pain of forfeiture. But, although undoubtedly effective as a cure for this kind of abuse, the system of compulsory working has its disadvantages. It bears hardly upon the inventor who, in spite of his efforts to get his invention taken up and worked in the country, fails to comply with the statutory requirements, either through lack of enterprise on the part of the commercial community, or through want of sufficient means to establish the industry himself. Hence, for the poor inventor, compulsory working too often spells compulsory confiscation.

For these amongst other reasons, public opinion in England was on the whole averse to the system of compulsory working in vogue on the continent. It was thought that the solution of the difficulty lay in the exaction of compulsory licenses from the patentee, who refused voluntarily to work his invention in the United Kingdom. Accordingly, in the Patents, Designs and Trade Marks Act of 1883, a clause was introduced empowering the

Board of Trade, on the petition of any person interested, to compel a defaulting patentee, under certain circumstances, to grant licences on such terms as it thought fit.

A patentee was to be considered in default, if

(*a*) The patent was not being worked in the United Kingdom.

(*b*) The reasonable requirements of the public with respect to the invention were not supplied, or

(*c*) Any person was prevented from working to the best advantage an invention of which he was possessed.

Little relief, however, resulted from this provision. The onus of proof cast upon the petitioner was very heavy and considerable doubt existed as to the nature and extent of the evidence required. Further the procedure prescribed was both clumsy and expensive, involving, as it did, firstly, a preliminary hearing of the Board of Trade, secondly, a full hearing of the evidence by a referee to whom the petition was referred if a *primâ facie* case had been made out, and thirdly a final consideration of the case by the Board of Trade in the light of the referee's report.

It is scarcely surprising, therefore, that few people availed themselves of a procedure which offered at once so uncertain a prospect of success and such an unbounded vista of law costs. In the course of the nineteen years during which these provisions continued in force only four petitions were presented, and of these only two were successful. These cases, so far as they are relevant to the existing state of the law, will be referred to later on.

The Patents Act of 1902 repealed the section of the Act of 1883 relating to compulsory licences and introduced a fresh set of provisions dealing with the matter. The referee was abolished. Petitions were, as before, to be presented in the first instance to the Board of Trade. If a good *primâ facie* case was made out, the petition was to be referred to the Judicial Committee of the Privy Council, who, if they were

of the opinion that the reasonable requirements of the public with regard to the invention had not been satisfied, were empowered to grant licences, or (if this did not meet the needs of the case) to revoke the patent altogether. The Act further defined what was meant by failure to meet "the reasonable requirements of the public."

So far from removing the principal defect of the previous procedure, namely its great expense, the Act of 1902 went from bad to worse, for proceedings before the Judicial Committee of the Privy Council are notorious for their high scale of costs. The Act was foredoomed to failure, and it duly fulfilled its fate, no one being found courageous enough to present a petition under its provisions, which were accordingly repealed by the Patents and Designs Act, 1907.

It cannot be said that the new Act has by any means removed the difficulties that beset a petitioner for a compulsory licence. True, it has introduced a beneficial change by substituting the High Court for the Privy Council, as the tribunal before which the petition is ultimately tried; in other respects, however, it has left the procedure much the same as before.

(2) *Present Law.*—The law of compulsory licences, as it now stands, in s. 24 of the Act of 1907, may be shortly summarised as follows:—

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, the revocation of the patent. "Any person interested" denotes a person whose *commercial* interests are prejudiced by the patentee's default.

If the good offices of the Board of Trade fail to bring about a settlement between the parties, and the petitioner appears to have a fair cause of complaint, the petition will

be referred to the Court for adjudication. The Court may make an order for compulsory licence or revocation, according to the requirements of the case.

In order to comply with the terms of the International Convention, it is stipulated that no order of revocation shall be made before the expiration of 3 years from the date of the patent or if the patentee gives satisfactory reasons for his default.

Besides the patentee, all persons claiming an interest in the patent, as exclusive licensees or otherwise, should be made parties to the proceedings.

The reasonable requirements of the public are deemed not to have been satisfied if, by reason of the default of the patentee to work his invention to an adequate extent, 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 is not reasonably met. A patentee is considered not to be working his invention in the required manner, if he refuses—

(1) to manufacture the patented article to an adequate extent and supply it on reasonable terms;
(2) to supply on reasonable terms any parts of the patented article which are necessary for its efficient working;
(3) to carry on the patented process to an adequate extent;
(4) to grant licences on reasonable terms;
or if (5) he has attached such conditions, either before or after the passing of the Act, to the purchase, hire or use of the patented invention as to unfairly prejudice any trade or industry in the United Kingdom.

The petitioner has still a heavy task before him. To prove that the needs of the public, that is, the consuming public, are not adequately met, seems to open up an almost boundless enquiry. To prove that the patentee's default is

prejudicial to some particular section of the manufacturing public, though less indefinite, presents a sufficiently arduous task to deter any but the most pertinacious and public-spirited.

The first successful petition for a compulsory licence—*Lerinstein's Petition*—succeeded on the somewhat special ground that the petitioner was prevented by the default of the respondents from using to the best advantage a certain patented process of which he was possessed for the manufacture of dyestuffs, but to work which involved the use of ingredients patented by the respondents. There was an express provision in the Act of 1883 for a case of this kind (see p. 174). In the Act of 1907 there is no such express provision, and the question therefore arises, whether such a grievance as this would come within the more general wording of the new legislation; in other words, whether the individual hardship suffered by a single representative of a trade or industry will afford ground for a petition. The natural construction of the words suggests that it would not. The expression "any trade or industry" appears to be used in the collective sense. Hence, it seems, the refusal of a patentee to grant a licence to an individual trader D, after granting licences to A, B and C in the same trade, would not justify a petition on the part of D, unless he could show that, notwithstanding the licences already granted, the needs of the public were not adequately met.

The mere fact that the patentee has already granted licences and even exclusive licences does not, of course, preclude the Court from ordering the grant of additional licences. Thus in *Hulton and Bleakley's Petition*, where the proprietors of the *Manchester Evening Chronicle* petitioned for licence to use certain type setting mechanism for printing late news, the Board of Trade made an order for compulsory licence notwithstanding that the patentees had already granted an exclusive licence to a rival newspaper. In this

case the royalty paid for the exclusive licence was trifling. How the Court will deal with a case in which a large sum of money has been paid for an exclusive licence, remains to be seen.

In *Gormully and Jeffrey's Petition*, the evidence showed that an exclusive licence had been granted by the respondents for a premium of £70,000. The difficulty of having to deal with this situation was, however, averted by the collapse of the petition, on the respondents offering to supply the patented article on reasonable terms. Were the Court to make an order for the grant of an additional licence, where a heavy premium had already been paid for an exclusive licence, the terms imposed would probably be so arranged as to compensate the original licensee, as far as the circumstances warranted, for the loss of his exclusive rights. In the case last mentioned, the referee expressed the opinion that where a compulsory licence was ordered, the patentee would as a rule be entitled to a royalty corresponding to a full manufacturer's profit. The petitioner would therefore have to be content with reaping incidental and collateral advantages accruing from the use of the invention.

An order of the Court directing the grant of a compulsory licence will operate as if it were an ordinary deed of licence made between the parties, and any breach in its observance may be remedied in the usual way. It may also, if necessary, be summarily enforced by applying to the Court for a writ of mandamus.

In addition to the provisions for compulsory licensing, the Act of 1907 has also adopted, in a modified form, the principle of compulsory working. The fact that a patented invention is worked exclusively or mainly outside the United Kingdom is now a ground of forfeiture, quite irrespective of the consideration whether the public demand for the patented article is met or not. Section 27, which

deals with this subject, is discussed under the head of Revocation (Chap. XVI.). But it is relevant here to remark that as the evidence which would justify the grant of a compulsory licence would, in the majority of cases, equally justify the revocation of the patent under s. 27, it is not easy to see what inducement there is to tempt the manufacturer to petition for a compulsory licence, when he can obtain the same facilities for manufacturing *royalty free* by applying to the Comptroller to revoke the patent.

Since, however, revocation under s. 27 cannot take place until the patent is 4 years old, in the case of a *recent* patent a compulsory licence might be the only available remedy.

Annulment of Contracts containing Restrictive Conditions.

The provisions embodied in s. 38 of the Act of 1907 have no statutory antecedents; they are entirely novel, and indicate a somewhat ominous change in the attitude of the Legislature towards the patentee. Hitherto he has been on the whole legislated for as a public benefactor; this section regards him rather in the light of a potential spoliator of the public; and unfortunately latter-day commercial methods have shown that the change of view is not altogether without warrant.

The section is aimed at the abuse of the power, which a patent sometimes gives a patentee, of getting into his grasp the control of an entire industry in all its branches.

Thus, to take a concrete instance, suppose an American inventor devises a machine for manufacturing boots, which is so great an improvement upon all existing machines, that it becomes at once a *sine quâ non* to the boot manufacturer. The invention is taken up by the boot trade in America and patented in England. The British manufacturer is

consequently obliged either to make terms for the use of the invention, or to submit to being undersold by his competitors. The owners of the patent, being in a paramount position, can make what terms they choose. They accordingly stipulate that as a condition of using the machine the British licensee shall buy from them or their nominees not only the patented machine and its accessories, but also all the leather, thread, and other raw material which he uses in his manufacture. Licences on these terms are perforce accepted by all the principal boot manufacturers in the United Kingdom, with the result that the destinies of the British boot-trade are henceforth entirely in the hands of its American rivals.

The case imagined is not unlike the condition of things which recently occurred in the English boot-trade, and this section in the Act is largely due to agitation from that quarter.

The gist of the provisions contained in s. 38 is given below in as succinct and clear a form as their somewhat intricate and involved nature will permit. Until they have received the consideration of the Court, it is premature to attempt to analyse or discuss them in detail.

Sub-section (1) relates to contracts for the sale or lease of, or licence to use, any article or process protected by patent, and provides that in such agreements restrictive covenants of a certain kind shall be treated as null and void. For brevity's sake the purchaser, lessee, and licensee may be referred to compendiously as the "customer."

Two types of covenant are condemned under this sub-section, viz., covenants the effect of which is:—

(*a*) To prohibit or restrict the customer from using any article, whether patented or not, or any patented process, supplied or owned by any person other than the patentee or his nominees.

(*b*) To compel the customer to acquire from the patentee

or his nominees anything except what is protected by the patent.

The sub-section, however, is not intended to affect any stipulation in a contract prohibiting a person from *selling* any goods other than those of a particular manufacturer or dealer. Nor will it affect any condition that a patentee may insert in his contract, reserving to himself the sole right to repair the patented article or to supply new parts when required.

This sub-section is not retrospective, and therefore only applies to contracts made *after* the passing of the Act (Aug. 28th, 1907). Moreover it contains a saving clause to the effect that such restrictive conditions shall not be treated as null and void, provided:—

(*a*) The patentee proves that the customer had the option of making the bargain on reasonable terms without such conditions, and

(*b*) The contract contains a provision enabling the customer to cancel the restrictive conditions by giving 3 months' notice in writing, and paying the patentee suitable compensation.

The amount of the compensation is to be fixed by an arbitrator appointed by the Board of Trade.

The insertion of any condition which is made null and void by this sub-section may be pleaded as a defence to an action for infringement of the patent to which the contract relates, provided the contract is still in force when the action is brought.

Sub-section (2) provides that any contract relating to a licence to use a patented invention may, at any time after the expiration of the patent or all the patents concerned, be terminated by either party upon 3 months' notice in writing *plus* the payment of suitable compensation.

This sub-section applies to *all* contracts whether made before or after the passing of the Act.

Sub-section (3) relates to contracts of licence made *prior* to the passing of the Act, and provides that any condition, which (if made subsequent to the Act) would have been null and void under sub-s. (1), may be determined by either party giving 3 months' notice in writing and payment of compensation.

CHAPTER XVI.

REVOCATION OF PATENTS.

A PATENT is open to attack either on account of its own intrinsic defects or owing to the default of its proprietor; in other words, either because the monopoly was improperly granted in the first instance or because, though rightly granted, it has been improperly used. It will be convenient to consider these grounds of revocation separately.

A. DEFECTIVE GRANT.

The presumption upon which a grant of letters patent proceeds is that the applicant is the true and first inventor, that his invention is both new and useful, and that he has given a fair and sufficient description of it in his specification. If any one of these conditions is lacking, the patent is granted, as the saying goes, "upon a false suggestion" to the Crown; that is, in plain language, it has been obtained by false pretences. Disconformity was also, formerly, a ground of invalidation, but s. 42 of the Act of 1907 provides that mere discrepancy between the provisional and complete specification shall not in the future invalidate a patent, assuming that the extra matter causing the discrepancy is novel and original. True and first inventorship, novelty and utility have all been thoroughly discussed, and nothing, therefore, need be added with reference to the merits of these several grounds of attack. That part of the law of revocation is simple enough. The procedure for putting the law in motion is,

however, not so simple; and unfortunately the Act of 1907 has by no means tended to simplify it.

Under the present law, an application to revoke a patent on the ground of defective grant may be made either to the Court or to the Comptroller. Here again it is necessary to divide the subject and deal first with the proceedings before the Court.

1. *Revocation upon petition to the Court.*—An application to the Court for the revocation of a patent takes the form of petition; the patentee and all other persons interested in the patent being made respondents to it. To avoid the bringing of petitions upon idle pretexts and by irresponsible people, the Statute has restricted the right of petitioning for revocation to the following persons:—

(A) Any person alleging—

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

(2) 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;

(3) 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.

(B) The Attorney-General or any person authorised by him.

Where the plea is that the patent was obtained fraudulently, the petitioner must prove his case up to the hilt; for an allegation of fraud is a serious matter, and if put forward lightly and without sufficient proof will result in the petitioner having to pay all costs occasioned by that issue. Where, however, the petitioner succeeds in proving that he has been defrauded of his rights, the Court will revoke the

patent, and order a fresh patent to be sealed to the petitioner bearing the same date as that revoked.

The jurisdiction of the Court to transfer the patent to the successful petitioner is confined to cases where fraud is established. If the patent has been sealed in the wrong name through some mistake not involving moral culpability, the Court will probably effect the same result by ordering the wrongful patentee to hold the patent in trust for the petitioner.

The authorisation, technically termed the "fiat," of the Attorney-General is not granted as a matter of course; the applicant must present a memorial showing that there is a good *primâ facie* case and containing certificates from a barrister and a solicitor as to the propriety of the petition and the ability of the petitioner to defray the cost. The Attorney-General will not grant his *fiat* if there are proceedings pending in which the issues proposed to be raised in the petition could be tried.

A petitioner, once he has established his *locus standi* on any particular ground, can rely at the hearing on all grounds of attack to which the patent is exposed, provided they are duly set out in the particulars of objections delivered with the petition. A petition is tried by a judge of the Chancery Division, and usually with witnesses; but, where the respondent does not appear, the Court may order the patent to be revoked simply upon affidavit evidence. The general character of the evidence is similar to that required for the determination of the issue of validity in an infringement action. The respondent has the right to begin and, if the petitioner tenders evidence, the right to reply.

Where there is an action for infringement pending in respect of the same patent, the Court will, as a rule, order the hearing of the petition and the action to come on simultaneously.

It appears from a recent decision (*North Eastern Marine*

Engineering Co. v. *Leeds Forge Co.*) that a patent may be revoked notwithstanding it has expired. Such a proceeding might be necessitated in the case of a person menaced, though not actually threatened, with an action for infringement in respect of the use of an article alleged to have been made in infringement of a patent since lapsed.

After a petition for revocation has been launched, a patentee can only amend his specification by leave of the Court, and then only by disclaimer. If the defects cannot be cured by amendment and the patent appears hopelessly bad, the patentee may avert the expense of the petition being brought to trial by surrendering his patent. This he can now do under sub-s. (3) of s. 26 of the Act, by giving notice to the Comptroller on Form No. 23.

Apparently through some oversight, the right of appeal which formerly existed in cases of petition to the Court has been taken away by s. 92. This will probably be shortly corrected by an amending Act.

2. *Revocation on application to the Comptroller.*—Section 26 provides that any person who would have been entitled to oppose the grant of a patent (or is the successor in interest of a person so entitled) may, within 2 years from the date of the patent, apply to the Comptroller to revoke the patent on any one or more of the grounds on which it might have been opposed For the various grounds of opposition see p. 94. This procedure is an innovation of the Act of 1907. Its intention is to give a second chance to those persons, who might have successfully contested the grant of the patent, but who have inadvertently allowed the opportunity to pass.

An application for revocation under this section must be made on Form No. 22, bearing a £2 stamp and accompanied by an unstamped duplicate. Where the ground of application is that the patentee obtained the invention from the person applying for revocation, evidence by way

of statutory declaration must be filed with the application; in other cases the filing of evidence is optional. The rules regulating the filing of further evidence and the hearing of the case before the Comptroller are the same as those prescribed for the conduct of opposition proceedings.

The Act stipulates that the Comptroller shall not revoke the patent unless the circumstances are such as would have justified his refusing the seal in opposition proceedings. It further states that no application for revocation may be made to the Comptroller while proceedings for infringement or revocation are pending elsewhere, except by leave of the Court.

An order of the Comptroller revoking a patent is subject to appeal to a judge of the Chancery Division, and thence to the Court of Appeal and the House of Lords. If, however, the Comptroller's decision is in favour of the patentee, there is no right of appeal (at least until the law is amended) beyond the judge of the Chancery Division.

B. Default of the Patentee.

Section 27 embodies the continental principle of compulsory working in a modified form, the intention being that there shall be no forfeiture unless there has been a clear default on the part of the patentee.

After August 28th, 1908 (the operation of the section is deferred for a year from the passing of the Act), the fact that an invention, which has been patented in England for *four* or more years, is worked exclusively or mainly outside the United Kingdom will be ground for revocation, and anyone may apply to the Comptroller to have it revoked on that ground. Upon such an application being made, the Comptroller will institute an enquiry. If as the result of his enquiry he is satisfied that the complaint is justified, it will then lie with the patentee to prove that

the invention *is* worked to an adequate extent in the United Kingdom or give satisfactory reasons for his default. In the absence of such proof or explanation, the Comptroller may make an order revoking the patent forthwith, or contingently upon the patentee's failure to amend his default within a certain specified time. If the Comptroller takes the latter course, and the invention is still not being worked to an adequate extent at the end of the specified period, the Comptroller may, on satisfactory reasons being given, extend the period of grace for another 12 months, but no further.

The Comptroller's decision under this section is subject to appeal to a judge of the Chancery Division, with whom the final determination of the matter rests.

For details of the procedure in instituting revocation proceedings under ss. 26 and 27 see the Patents Rules, 1908.

CHAPTER XVII.

PROLONGATION.

In fixing the term of 14 years as the duration of a patent, the assumption of the legislature has been that this period of monopoly is long enough to enable a patentee, under normal conditions, to obtain a remuneration from the public proportionate to the merit of his invention. Experience seems, on the whole, to have proved the reasonableness of this assumption, and the adoption of a similar period of protection (generally 15 years) by most other countries possessing patent laws is also good testimony to the same effect.

Accidental causes, however, occasionally operate to falsify the justness of this calculation, and the meritorious inventor finds himself at the close of the period of protection still battling against public indifference, a loser instead of a gainer by the bargain; or, if not a loser, at least success comes so late that the harvest is reaped in the main by others, leaving the inventor no adequate recompense for his service to the public. A hardship of this nature is met by the legislative provision empowering the Crown in certain cases to extend the term of the patent for a further period not exceeding seven, or, in exceptional cases, fourteen years.

Until the passing of the recent Act, a patentee, desiring to obtain this indulgence, presented his petition to the Crown through the medium of the Privy Council, and all proceedings relative to the prolongation of patents were conducted before the Judicial Committee of that body.

The Patents and Designs Act, 1907, has transferred this jurisdiction from the Privy Council to the High Court. Subject to new rules adapting the practice to the changed tribunal, the procedure and principles governing the presentation of petitions for prolongation remain substantially unaltered.

A patentee who wishes to get his patent extended must lodge his petition at least 6 months before his patent expires. Prior to lodging his petition, he must give public notice of his intention of so doing by advertising in the prescribed manner, stating the object of the petition and the time when he intends to have it heard, so as to afford opportunity for public opposition. Intending opponents must give notice of the grounds of their objections in the form prescribed by the rules.

Previously, when petitions were presented to the Privy Council, the Crown was represented at the hearing by the Attorney-General, who, if he did not actively oppose the petition, performed a useful function by subjecting the petition to closer criticism and investigation than it might otherwise encounter in the absence of public opposition. The position of the Attorney-General is now taken by the Comptroller, who will watch the proceedings in the interest of the general public.

To secure a favourable decision, the patentee must satisfy the Court on two heads; first, that the invention is one of conspicuous merit, and secondly, that he has received inadequate remuneration for it. The extension of the term of a patent must be looked upon as a very exceptional privilege, and the exceedingly small number of cases in which the petitioner has been successful indicates the jealousy which which this indulgence is guarded. Since the beginning of the year 1884 up to the present time, fifty-four petitions for extension have been presented and of these only six have been granted. These figures

show that in the past the Privy Council has refused to postpone the public's right to the enjoyment of an invention except under very special circumstances, and there is no reason for supposing that the judges of the High Court will depart from this precedent.

In considering the merit of an invention, the Court will not go into the question of validity. Utility, on the other hand, is all-important, and one of the difficulties which the petitioner has usually to overcome is to rebut the presumption of non-utility which arises from the non-success of the invention. The petitioner must be furnished with strong evidence on this part of the case and be prepared to show that the causes which militated against success are not inherent in the invention.

For example, its adoption may involve the discarding of existing plant and machinery, and the erection of new plant at an outlay which manufacturers are loth to incur; or it may be of such a character as to appeal to a very limited section of the public. Thus, where the railway companies were the patentee's only possible customers, and the non-success or belated success of the invention was ascribed to indifference and lack of enterprise on their part, this was accepted as a satisfactory explanation.

In the case of *Parson's patent*, for which an extension of five years was granted, the failure to win commercial success within the period of the patent was not so much due to want of enterprise on the part of the public, as to the need for prolonged and costly experimentation in order to surmount the mechanical difficulties involved in the application of the turbine principle to marine propulsion.

Again, the sheer novelty of the invention may be a bar to its success, at any rate for a while. This was shown to be the fact in the case of *Cross, Beaven and Beadle's Petition* for the extension of their patent for viscose. This substance, which is a soluble form of cellulose, was discovered by the

petitioners, and was a perfectly new material at the date of the patent. Analogy suggested its use at once for several obvious purposes; but there were, besides, many less obvious but important uses, such as the manufacture of artificial silk, to which it was also applicable; and a considerable amount of time had necessarily to be spent before these could be ascertained and the trades in them created.

In addition to the public utility of the invention, the Court will take into account the personal merit of the inventor. He must show that he has taken energetic steps to make his invention profitable and to introduce it into public notice. Ill-health, litigation or lack of funds will, however, be accepted as a reasonable excuse for default in this respect.

Although the merit of importation is admittedly inferior to that of actual invention, there is a precedent for the granting of an extension to a patentee who is only an importer.

The question of what is adequate remuneration is always one of the greatest difficulty. It is almost hopeless to attempt to appraise the value of an invention or to assess, even approximately, the amount of remuneration it deserves. Refusal to grant an extension has in the past usually been based on other grounds than that the remuneration has been inadequate. No universal rule can be laid down. Granting that the invention is meritorious enough to justify extension at all, remuneration to be adequate is bound to be on a fairly liberal scale. Hitherto, £20,000 has been the largest sum held to be insufficient for the inventor's deserts.

In laying his case before the Court, it is the duty of the petitioner to satisfy it as to the actual amount of profit he has realised from his invention. For this purpose he must submit the fullest accounts which it is in his power to

render. Faulty or inadequate accounts have in many cases proved to be the rock upon which the petition has foundered. The rule is that the petitioner seeking the grace and favour of the Crown is bound to strict truth and the utmost candour and frankness. He should therefore put the Court in possession of all the facts, and give a complete history of his dealings with the patent from its inception down to the latest period for which accounts are obtainable. If he manufactures and sells other goods besides the patented article, the accounts should show to what extent his ordinary manufacturing profit has been due to the patent. Profits from foreign patents, profits derived from working by licence and profits realised by the sale or working of subsidiary inventions are all relevant to the inquiry, and should all be fully disclosed in the accounts. The statement must show the profits or losses made year by year. Under the head of expenditure must be shown the actual money expended; estimates will not be accepted. Further, the accounts must be presented in such a shape that it is apparent on the face of them what remuneration the patentee has received in respect of the patent for which extension is sought.

In arriving at the net profit, the petitioner is allowed to include in deductions from gross profits a reasonable amount of remuneration for his own time and labour spent in working and pushing the invention.

The petitioner need not necessarily be the inventor; an assignee or any other person who is for the time being entitled to the benefit of the patent is equally competent to apply for extension. But the Court will only grant an extension to an assignee, where it is assured that the original inventor will directly or indirectly benefit thereby, and where the assignee has assisted the inventor with funds or otherwise in perfecting or exploiting his invention. An extension will not be granted when the original inventor

has died after having made an assignment of all his interest in the patent, so that neither he nor his estate can derive any advantage from the extension.

A company, or any other assignee, who has acquired a patent purely as a commercial adventure, is not entitled to prolongation on the ground of failure to make profits, when the inventor himself could have no legitimate interest in making such an application. But the case is different when, as was shown in *Parson's Petition*, the interests of the inventor are bound up with those of the company, and the company can claim the merit of having assisted in the development and introduction of the invention.

The period for which extension will be granted depends mainly upon the character of the invention. In rare cases an extension of 10 years has been allowed. Thus, in *Stoney's Petition*, where the invention related to sluices and flood gates for controlling the flow of water in canals, the chances of its use being extremely limited and depending in a great measure upon the construction of fresh canals, a long period seemed to be necessary to give the patentee a fair prospect of remuneration. Similarly in the case of *Currie and Timmis's Patent*, which related to the working of railway signals by electricity, an extension of 10 years was granted in view of the great difficulty that always exists in getting an invention of that character adopted, and the certainty that it could only be very gradually introduced and, perhaps, only in the case of new railways.

Seven years has been granted in a few instances, but latterly the longest period of extension, even for such meritorious inventions as the turbine or the discovery of viscose, has been a period of five years. The usual practice in granting an extension is to seal a fresh patent to run for the period allowed.

The costs are entirely in the discretion of the Court. In

the past, the practice has been to encourage fair opposition, in the interest of public policy, by awarding such costs to successful opponents as may be a reasonable contribution to the expenses to which they have been put. They are usually awarded in a lump sum, to be divided amongst the opponents where there are several.

CHAPTER XVIII.

MISCELLANEOUS.

The Patent Office.

The Patent Office is situated at 25, Southampton Buildings, Chancery Lane, W.C., and is presided over by the Comptroller-General of Patents, Designs and Trade Marks, assisted by the Chief Examiner and a numerous staff of examiners and clerks of various grades. It is under the immediate control of the Board of Trade, which from time to time issues Rules regulating the practice of the Office. These Rules, being authorised by Act of Parliament, have the same force and effect as if they formed part of the Act itself. A useful *resumé* of the practice is published by the Patent Office under the title "Instructions to Applicants for Patents."

The routine of the Patent Office, in so far as it directly affects the patentee, has already been discussed in the course of the preceding chapters; for a fuller insight into its inner working the reader is referred to the Comptroller-General's Annual Report, which furnishes a mass of detailed information bearing on the general administration of the Patent Office and the use made of it by the public. From this report it will be seen that, regarded as a lucrative department of the Board of Trade, the Patent Office is an eminently prosperous concern. In spite of its heavy working expenses, considerably augmented recently by extensions to premises and increase of staff, it nevertheless contrives to hand over to the Exchequer a yearly profit amounting

on an average to £100,000. This sum is principally derived from fees paid upon patents, which, in 1906, exceeded £250,000; designs and trade marks in the same year contributing an additional £20,000.

As some misapprehension exists in regard to the scope of the functions of the Patent Office, it may be mentioned here that it does not undertake to give legal advice or opinions in patent matters; to do this would be to encroach upon the province of professional men. Nor will it examine specifications or make searches before an application has been filed. Neither is it within the power of the Comptroller to give pecuniary assistance to enable indigent inventors to obtain patents, or to reduce or remit any of the prescribed fees.

The Office refuses also to recommend any particular patent agent for employment by an applicant.

Patent Office Library and Publications.

Attached to the Patent Office is a free public library, open daily from 10 a.m. to 10 p.m., except on Sundays and Bank Holidays.

In addition to a complete collection of British specifications, supplemented by name and subject-matter indexes and abridgments of specifications, the library contains the full or abridged patent specifications of all the most important foreign countries, also the leading British and foreign scientific journals, transactions of learned societies, and text-books of Science and Art.

In searching for the invention of any particular person, the Name Indexes, published as part of the Illustrated Official Journal of Patents, should be consulted.

Where only the subject-matter of the invention is known, the Abridgment Class and Index Key should be first referred to, to ascertain where the subject-matter is classified in the

Patent Office publications. The whole range of patentable inventions is divided into 146 classes. Having ascertained to which class the invention belongs, the corresponding volumes of Abridgments of Specifications, each of which is furnished with name and subject-matter indexes, should then be examined. In the case of recent specifications for which abridgment volumes have not yet been published, the annual and monthly subject-matter indexes and the Illustrated Official Journal must be consulted.

British specifications can be purchased at the Sale Branch of the Patent Office for the uniform price of 8*d*. each. Foreign and colonial specifications can only be obtained by applying to the patent office of the country in which the patent was granted.

Illustrated volumes of Abridgments of Specifications may be bought for 1*s*. per volume. At present there are ten of these volumes, covering the period from 1617 to 1908, in each of the 146 classes. Anyone wishing to keep himself abreast of the march of invention in his own particular field of work cannot do better than procure and study these Abridgments from time to time as the sections are published

Patent Agents.

Patent agents, properly so called, form a small and well-defined *coterie* of practitioners, qualified to advise inventors in all matters relating to patents. At the beginning of 1907, the total number on the register was 255.

Prior to 1888 anyone, no matter how little qualified he might be, was at liberty to designate himself a "patent agent." In that year, however, an Act was passed prohibiting any person from so describing himself unless he is registered as a patent agent in pursuance of the Act, and making any person who falsely assumes the title of "patent agent" liable, on summary conviction, to a fine, not

exceeding £20. Persons practising *bonâ fide* as patent agents prior to the passing of the Act were entitled to be registered without further evidence of their competence; but subsequently admission to the roll of patent agents has been confined to those who have qualified themselves by passing the examinations prescribed by the Chartered Institute of Patent Agents, an association founded in 1882 and incorporated in 1891. Fellows of the Institute are entitled to describe themselves as "Chartered Patent Agents."

The patent agent's business is to prepare specifications, to act as intermediary between the inventor and the Patent Office in the various stages of application, to make searches for novelty and to advise generally in all dealings with patents. In cases of opposition, he may appear in the Comptroller's Court and argue the matter on behalf of his client. He also usually undertakes, when the patent has been procured, to keep the inventor informed as to the date when the renewal fees fall due.

If the inventor contemplates taking out foreign patents, he should place himself in the hands of a firm that is in communication with reliable agents in the principal foreign countries, through whose instrumentality the applications for foreign patents can be made.

Few applicants for patents can afford to dispense with the services of a patent agent. Care should be taken, however, to select an agent or firm that has had wide experience and, preferably, experience in the particular field of science to which the invention relates.

The inventor should, as a rule, avoid persons who style themselves "patent experts," "inventors' agents" or, in fact, by any other name than "patent agent"; and all persons advertising their services in connection with patents for abnormally low rates should be distrusted.

The charges made by patent agents do not conform, like

solicitors' charges, to any fixed standard. For a scale of the fees that an inventor might expect a firm of good standing to charge for obtaining a complete British patent in a normal case, see p. 238.

The Comptroller may refuse to recognise as an agent any person whose name has been erased from the register of patent agents or who has been guilty of misconduct justifying erasure. This rule applies not only to the case of an agent acting in his individual capacity, but also where he is a member of a firm.

The Comptroller will also refuse to have dealings with any agent residing outside the United Kingdom.

Offences under the Patents Act.

Any person who falsely represents that an article sold by him is a patented article, as, for example, by stamping it with the word "patent" or "patented," is liable on summary conviction to a fine not exceeding £5 for each offence.

Any person who describes his place of business as "Patent Office," or uses other words suggesting that it is officially connected with the Patent Office, is liable to a fine not exceeding £20. The same penalty attaches to the unauthorised assumption of the Royal Arms by the patentee or others in connection with the sale of a patented article.

"Patent Medicines."

The term "patent medicine," which has in the past been loosely used to signify not only medicine actually protected by letters patent, but also all manner of unpatented proprietary medicines, may not be legitimately used in this sense any longer. Any person representing a medicine as patented when it is not, renders himself liable to a penalty of £5 in respect of each article bearing such false description.

The best way to retain a monopoly in the sale of a nostrum or specific is to keep the prescription secret and to sell it under a registered trade mark.

It should be added that proprietary medicines are subject to a twofold tax. Any person dealing in them must take out a licence (5*s*. a year), and there is also an *ad valorem* duty levied upon each bottle, box or packet of the medicine sold, in the form of stamps to be procured from the Secretary of Stamps and Taxes, Inland Revenue, Somerset House.

CHAPTER XIX.

FOREIGN PATENTS.

If an invention is worth patenting in England, it is usually worth patenting in one or more foreign countries.

This generalization must, however, be accepted with caution, and the policy of applying for foreign patents very closely scrutinized before the inventor incurs the heavy outlay entailed in patenting abroad on an extensive scale.

But assuming that the policy is unquestioned, the problem that confronts the inventor, namely, how ultimately to *profit* by his foreign patents, is still a perplexing one. The first point to settle is the country or countries in which protection shall be obtained. This must, of course, depend primarily upon the nature of the invention; but there are also other considerations which have to be taken into account, *e.g.* the commercial status of the country, its established industries, its trade connections and so forth.

Indiscriminate patenting in all the principal countries is, as a rule, sheer waste of money. Of the forty odd countries (exclusive of British colonies) which grant patents at the present time, those which are of any value to the English inventor from a commercial point of view are comparatively few. The statistics disclosed in the Comptroller-General's Annual Report, showing the number of applications for patents emanating from various foreign countries, afford a very fair indication of the commercial activity of these countries respectively and their enterprise in regard to patents. Ranked according to this criterion, the following

are the first ten countries which should engage the inventor's attention.

The United States of America, Germany and France stand out as pre-eminently the most important; then follow Austria-Hungary, Switzerland, Belgium, Italy, Sweden, Russia and Denmark. Amongst British colonies, Australia, Canada and New Zealand, as a rule, present the most hopeful field for patent exploitation. The staple and established industries of a country are also very relevant matters for consideration. For, where the invention relates to an industry or manufacture already carried on in that country, or there is demand for the patented article already existing, negotiation of the patent is comparatively simple, provided its utility is easily demonstrated or its success has been proved elsewhere. But to establish new industries and create a new demand in a foreign country is an undertaking which few inventors, occupied as they presumably are with the same task at home, find themselves able to cope with successfully.

But even though a country offers no prospect of working the invention successfully on the spot, either through lack of materials or because of other adverse local conditions, it should not be at once dismissed from the mind as unprofitable from a patenting point of view.

It may still be expedient to take out a patent there, simply for the sake of securing a close market for the importation of the patented article from a neighbouring country, where the facilities for manufacture are greater.

An improved process for making cement may, for instance, be well worth protecting in a country entirely devoid of the materials for cement manufacture. It is true that a patent used merely as a pretext for importation and not worked in the country is generally liable to forfeiture after three years, but in some cases the advantage reaped during the three years of grace may still

be sufficient to give an abundant return for the expenditure on the patent. Moreover, even after the forfeiture of a patent in such a case, there is nothing to hinder the inventor from continuing to import. For if he has not a monopoly, he has, at least, the assurance of an open market for importation. On the other hand, the almost inevitable consequence of his neglect to patent the invention himself will be that someone else will patent it to his prejudice.

Again, the selection of the countries in which patents are to be applied for must be guided, in some measure, by the plan upon which the inventor intends to dispose of them when obtained. Patents are sometimes disposed of to best advantage by offering them in *groups*; this is particularly the case with inventions relating to articles of international commerce, or where the market is controlled by a trade combination comprising, maybe, manufacturers of different nationalities. Hence, in determining the countries in which protection will be sought, it is very desirable to take a preliminary survey of the ramifications of the trade under consideration, and the commercial relationships of the principal firms or companies engaged in it.

A French manufacturer, for example, who imports into Belgium and Spain will naturally be anxious to acquire the Belgian and Spanish rights as an adjunct to the French patent, in order, as far as possible, to cover the whole area of his market. On the same principle a Canadian patent, though perhaps valueless for the purpose of exploiting separately, is often of considerable value as a supplement to the American rights. Similarly, the closely interwoven commercial interests of the Germanic countries make it advisable, as a rule, when a German patent is applied for, to protect the invention also in Austria and Hungary, and to dispose of these patents *en bloc*.

The negotiation of foreign patents is too vast a subject to be adequately discussed in these pages; there is, however,

one observation directly arising out of the foregoing illustrations which may be added with advantage. The inventor must not fall into the mistake of selling his rights for any one country without carefully considering the effect it will have on his patents in other countries. This precaution is needed especially in dealing with inventions relating to articles in which there is a large international trade. For a manufacturer will not, as a rule, purchase a new machine or a new process unless he can use it throughout his manufacture, both for foreign markets as well as for his home trade. If, therefore, the overhasty disposal of one or more of the less important foreign patents has had the effect of closing the markets in those countries to the prospective purchaser of the patent in another, perhaps more important, country, so that the latter, should he acquire the patent, can only employ the invention for that portion of his output which finds its market at home, that will seriously damage the value of the patent, if it does not destroy its chance of sale altogether. In dealing with inventions of this character, the inventor's wisest policy is generally not to sell the patents outright, but to grant an exclusive right of manufacture to the principal manufacturer in each country together with a general licence to import, use and sell the product or manufactured article under the patents in the various countries to which his trade extends.

Since the adhesion of practically all the important countries to the International Convention, the application for foreign patents is not now a matter of such urgency as it was formerly. The inventor can act with more deliberation. He has a space of twelve months from the date of filing his application at home for considering the policy of protecting his invention abroad, and, in the meanwhile, he may publish and use it to any extent without prejudicing his claim to a patent in any of the countries belonging to the Union.

Another point which naturally weighs with the inventor, in considering the application for foreign patents, is the cost of obtaining the patent and of keeping it alive. Besides the bare fees payable to the patent office, there are, of course, the patent agent's charges for preparing the specification in a foreign language to be taken into account. A list of charges such as would be normally made by a firm of good standing for obtaining a complete patent in the more important countries is given in the Table at the end of Chapter XX.

In many countries the patent office refuses to hold communication with a foreign applicant except through the medium of a representative domiciled in the country; this is the rule, for instance, in Germany. But even in countries where there is no legal requirement to this effect, it is advisable to deal with the foreign patent authorities through such a local agent. English firms of patent agents are, as a rule, in touch with competent and responsible representatives in various foreign countries, through whom the application may be made, and all subsequent business with the patent office transacted.

But it is often desirable to employ these foreign agents as something more than a mere conduit pipe of communication with the foreign patent office. They naturally have a more intimate knowledge of the idiosyncrasies of their own patent laws than many English patent agents can be expected to possess, and much time and expense would often be saved if they were given a freer hand in the drafting of the specification and claims so as to meet the requirements of their own peculiar practice.

This suggestion is particularly pertinent with reference to applications in Germany and America, where the ideas of what constitutes good subject-matter for embodying in a single application, and the form in which it should be claimed, differ as widely from the English view as they do

from one another. For instance, in the case of a German application, instead of sending a copy of the English specification with claims cut and dried for translation and filing, the inventor would do well to transmit to the German agent through his English agent a full scientific description of the invention, indicating its novel features and emphasizing the salient points desired to be covered by the claims. With this material before him the German agent could, assuming him to be competent in his profession, draft a specification and claims in accordance with the requirements of German practice. The draft would of course be returned to the English agent for correction and approval. An application framed in this way would run far less risk of encountering the numerous objections from the German Office that so frequently form a stumbling block to the British applicant and occasion him unnecessary expense and annoyance.

Compulsory working clauses appear in nearly all the foreign patent codes, the United States being a notable exception. The prescribed period within which the invention has to be put into operation differs in various countries. In France and Italy it is two years from the granting of the patent; in Belgium it is one year from the commencement of working abroad. On the other hand, Clause III. of the Protocol to the International Convention, as amended by the Act of Brussels in 1900, stipulates that no patent shall be revoked for non-working until after the expiration of at least 3 years from the date of application. The British inventor, therefore, owning patents in France, Italy or Belgium can avail himself of the greater latitude allowed by the Convention in spite of the domestic laws of these countries. The danger of revocation, however, for non-working is not very serious, provided the patentee has honestly endeavoured to get his invention worked and has not used it simply as a means for retaining a close market for goods manufactured

and imported from abroad. A patentee, who has tried and failed to get his invention worked, should place the fact on record by advertising or otherwise publicly signifying his willingness to sell the patent or to grant licences on reasonable terms. Working by advertisement, as this proceeding is sometimes called, is extremely common and reduces compulsory working to a very simple matter. All the patentee has to do is to instruct the foreign representative to insert the necessary notices in suitable trade journals at a reasonable time before the expiry of the prescribed period. The cost is usually from £5 to £10 in each country.

The advertisements should of course be preserved and their insertion officially certified, in case they may be needed in future revocation proceedings.

The International Convention.

The importance of the International Convention, in its bearing upon the rights of inventors seeking protection in foreign countries, calls for a somewhat more detailed account of its scope and provisions than has hitherto been given.

The "International Convention for the Protection of Industrial Property" was ratified at Paris in 1884. It has since been amended and supplemented by the Act of Brussels (1900) which came into force in 1902. Amongst the countries appearing as original signatories to the Convention the most notable, besides Great Britain, are Belgium, France, Italy, Portugal, Spain and Switzerland. The following countries, with the omission of a few States of minor importance, have subsequently become members of the Union:—Norway and Sweden (1885), United States of America (1887), New Zealand (1891), Denmark (1894), Japan (1899), Germany (1903), the Commonwealth of Australia (1907). A complete list of the Convention States is given at p. 239.

The aim of the contracting States is to safeguard the rights of owners of patents, trade marks and designs in foreign countries, and as far as possible to co-ordinate and assimilate in certain respects the working of the various patent systems. The provisions affecting the rights of patentees are contained in the first five Articles; the remainder are mainly concerned with trade mark rights.

Articles II. and III. stipulate in general terms that in all matters relating to patents, trade marks and designs, equal and impartial treatment shall be accorded to citizens and foreigners, provided the latter are subjects of a contracting State or are domiciled or have *effective and serious* industrial establishments in the territory of one of the States of the Union. Article IV. gives the inventor a period of 12 months from the date of his first application, within which to apply for a patent in any other of the contracting States, without suffering prejudice by reason of publication in the interim. The English law is brought into conformity with this requirement by s. 91 of the Patents and Designs Act, 1907.

The form of application, required by English practice to entitle a foreign patentee to this privilege, has already been discussed in a foregoing chapter (p. 88).

Each country has its own regulations. In France and Belgium the privilege need not be specifically claimed and no special form of application is required; it is desirable, however, at any rate to refer to the previous application. In Germany and Italy, on the other hand, the claim to priority must be specifically made and the date of application officially certified.

According to English practice an application under s. 91 must be in the name of the foreign patentee; in other countries, however, at least in those that entertain an application by an assignee, the assignee of the foreign patentee has an equal right to claim priority under the

Convention. Article IV. provides that patents asked for in the different contracting States by persons admitted to the benefit of the Convention shall be independent of patents obtained for the same invention in other States, whether adherent to the Union or not. Hence a French patent or a Belgian patent of importation, granted to a British subject, will not expire upon the lapse of the corresponding British patent, but continue to the full extent of the original term.

Article V. states that the introduction by the patentee into the country where the patent has been granted of articles manufactured in one or other of the States of the Union shall not entail forfeiture. The patentee, however, remains subject to the obligation to work his patent in conformity with the laws of the country into which he introduces the patented articles. And where, as in Germany, the patentee is deemed not to have fulfilled this requirement, unless the bulk of the patented article consumed in Germany is manufactured by German labour, importation on a large scale would be considered inconsistent with the adequate discharge of this obligation, and thus, in an indirect way, might lead to the forfeiture of the patent.

The Convention is supplemented by a Protocol which, as amended by the Act of Brussels, provides in Clause 3*b*, that a patentee shall not suffer revocation by reason of non-working until the expiration of the minimum term of 3 years from the date of application, and then only if he fails to justify the cause of his inaction.

As has already been pointed out, the provisions of the Convention conflict in several respects with the domestic legislation of the various countries belonging to the Union. Considerable misapprehension seems to exist as to the effect of this conflict, and the question whether an applicant can safely rely on the Convention in defiance of the internal

law of the country is treated as a moot point. The answer, however, appears to the writer to be tolerably plain. So long as a State remains a party to the Convention, it is bound by the terms of the Convention. To withhold the protection accorded by international agreement would constitute a grave breach of international obligation. It is true that there is no legal sanction to enforce the observance of these obligations, but the refusal by a contracting State to extend the full privileges secured by the Convention to any person entitled to claim them would at least involve the antecedent withdrawal of that State from the Union; and this can only take effect, according to Article XVIII., after the lapse of one year from the date of renunciation.

An International Office in connection with the Convention has been established at Berne in Switzerland, and publishes a monthly periodical entitled *La Propriété Industrielle*, which furnishes a comprehensive review of the changes that occur from time to time in the patent laws of various countries, and useful notes upon legal decisions of international interest.

CHAPTER XX.

FOREIGN PATENT LAWS.

UNITED STATES OF AMERICA.

Term of Patent.—The term of a patent for the United States of America is seventeen years reckoned from the date when the patent is issued. Patents granted prior to 1898 expire at the expiration of the term of a previously granted foreign patent for the same invention, or, if there is more than one foreign patent, with the expiration of the term of the one having the shortest term. Patents granted since 1898 are unaffected by the prior expiration of foreign patents.

Subject Matter.—Subject to certain conditions as to prior publication, a patent will be granted to any person, whether citizen or alien, who is the original inventor of "any new and useful art, machine, manufacture or composition of matter or any new and useful improvement thereof." This enumeration of patentable inventions may be taken to include everything that would constitute good subject matter for an English patent.

Who May Apply.—The applicant must be the *original inventor* in the strictest sense of the word; hence the importer of an invention cannot make a good application. To establish his claim to originality, the invention must be one which was not already *known or used by others in the United States, or patented or published in print there, or elsewhere, prior to the date when the applicant first conceived his invention in a practical shape.* This rule, it will be

observed, differs in two important respects from the British law, according to which latter (*a*) the invention need only be novel within the realm, and (*b*) novelty is destroyed by publication even by the inventor himself at any time before the date of application.

Prior Publication of Invention.—In the United States, however, assuming the applicant to be the original and true inventor, a limited amount of publication preceding the application does not debar him from subsequently obtaining a patent. The extent to which an invention may be published by foreign patent or otherwise prior to application, without prejudicing the inventor's right to a patent, may be summarised in the following rules.

The original inventor can obtain an American patent provided his invention has not been -

(*a*) used or sold in the United States by himself or others for more than *two* years prior to his application,

(*b*) nor published in print in the United States or elsewhere by himself or others for more than *two* years prior to his application,

(*c*) nor patented elsewhere by himself more than *twelve* months before his application, unless in such case the United States patent issue before the foreign patent is granted,

(*d*) nor patented elsewhere by others more than *two* years before his application.

It will be observed that provision (*c*) brings the United States law into conformity with the terms of Article IV. of the International Convention, as amended by the Brussels Act of 14th December, 1900.

Since, according to the British law, a patent bears the date not of issue but of application, a British patentee, desiring an American patent, should lodge his petition within twelve months after his application in England. If this limit is overstepped by a month or so, it might still be

possible to obtain a United States patent, provided the British grant could be deferred until the United States patent is issued. But owing to the extreme dilatoriness of the United States Patent Office, and the impossibility, except when the grant is opposed, of getting the sealing of the British patent deferred beyond fifteen months from the date of application, this cannot be looked upon as a practicable plan. A collusive opposition instituted for the purpose of delaying the sealing of the British patent would probably result, if detected, in the refusal of the Patent Office to seal it at all.

Date of Patent. Although in the United States a patent granted upon a convention application is not antedated as in England, yet for the purpose of protecting the applicant against the effect of prior publication, the United States application is deemed to be contemporaneous with the foreign application. If an inventor dies before applying, the right devolves upon his executors and administrators in trust for those entitled at law or under the deceased inventor's will.

Joinder of Inventions.- The practice of the United States Patent Office with regard to the joinder of similar inventions in one specification is very stringent. The rule of the Courts is that where the inventions are kindred and auxiliary, and capable of being used in connection with each other and to serve a common end, they may be embraced in a single specification. But in order to facilitate the task of examination and classification, the Patent Office has adopted a stricter practice, prohibiting the joinder, for example, of a process and a product in the same patent unless they are to such an extent inseparable, that the existence of one is dependent upon the other. A process may be joined with its inevitable product or with the apparatus by which it alone can be performed.

The following statement may be regarded as authoritative

on this point. "If the machine and manufacture are so related that the former cannot operate without producing the latter, and the latter can only be produced by the former, both may be united in one patent: but this is an exception to the general rule which forbids the joinder of the machine and its product in one application. The same rule applies in the case of a process and its product." Similarly, if an inventor has devised two pieces of mechanism, the Patent Office Rules require a separate application for each machine unless one cannot be regarded as an operative instrument without the other.

Claims.—The United States style of claiming clause is distinctive, and certain strict rules have to be observed to conform with the practice of the Patent Office in this respect. Thus "functional" claims, such as the German practice requires, are inadmissible. The invention must be described and claimed not in terms of its operation, but according to the construction of the article and the arrangement of its parts. This principle is responsible for the peculiar style of claiming clause in vogue in the United States, framed upon what is usually known as "the house that Jack built" pattern, according to which the claims proceed cumulatively, each claim introducing a single additional feature of construction until the whole invention has been covered.

Where, for example, the invention depends upon a combination of several elements, A, B, C and D, of which A is the principal novel feature, a series of claims will be employed, each covering a distinct combination of A with one or more of the other elements. The view prevails in the United States that an invention is not sufficiently protected unless every possible combination is specifically claimed and every contingency provided for. This naturally leads to a great multiplicity of claims, so that in cases of complex inventions, specifications have sometimes been

filed containing over a hundred claims and patents granted thereon.

Further, the Patent Office requires that each claim shall be precise and complete in itself. Hence, individual claims containing alternatives are not allowable, nor may elements be imported into a claim by reference to the specification or to another claim. It should be observed that in the United States the invalidity of one or more of the claims does not, as in English law, vitiate the entire patent.

Drawings.—The rule with regard to drawings is that when the nature of the case admits of drawings the applicant must furnish them. The specifications of inventions quite unsuited for illustration may, nevertheless, be required to be accompanied by drawings, for the question is not whether the invention can be understood without drawings, but whether it is capable of being illustrated. Specimens and models must be furnished if required by the Patent Office.

Application.—The fee payable on application is $15.

The specification must be signed by the applicant and attested by two witnesses, and must be accompanied by an oath of inventorship sworn before a diplomatic or consular officer of the United States, or before a notary public, judge or magistrate who has an official seal and is authorised to administer an oath. When the oath is taken before a notary, judge or magistrate, his authority must be certified by a United States diplomatic or consular officer. This oath, besides affirming that the applicant is the original and true inventor, should state in what other countries he has applied for or obtained patents, giving the dates of the applications or patents.

Issue to Assignee.—Though an application can only be made in the name of the original inventor, the applicant can, by lodging a short assignment, cause the patent to issue in the name of himself and an assignee, or of an assignee alone.

A British inventor can deal directly with the United States Patent Office, but he will do best to appoint an agent in the United States to act for him.

Examination.—The application must be completed and prepared for examination within a year after filing; otherwise it is regarded as abandoned. The application being complete, the specification is in due course subjected to examination, and an exhaustive search is made, ranging through the patents and scientific publications of foreign countries as well as those of the United States.

When, on examination, a claim for a patent is rejected for want of novelty or on the ground of some formal defect, the Commissioner notifies the applicant, giving him briefly the reasons for rejection and such information as may enable him to amend and renew his application. If the applicant persists in his claim without alteration, the Commissioner orders a re-examination of the case. If the decision is still adverse, the applicant has a right of appeal to the examiners-in-chief and thence to the Commissioner, and finally to the Supreme Court of the District of Columbia.

Interference.—Whenever an application is made which, in the opinion of the Office, would interfere with any pending application or with any unexpired patent, the Commissioner gives notice to the parties and directs the primary examiner to proceed to determine the question of priority of invention. This proceeding is somewhat analogous to an English case of opposition, the issue being, however, as to priority in conceiving the invention, not in applying for a patent for it. Where the applicant is a foreigner, and he is put in interference with a citizen of the United States, he is at a disadvantage, since he must show that the date when he disclosed his invention in the United States antedates the conception of the rival United States applicant. In cases of interference the applicant's right of appeal formerly

terminated with the Commissioner, but now extends to the Supreme Court of the District of Columbia.

Allowance and Issue.—Having passed safely through the ordeal of examination, the patent is "allowed," and will issue upon payment by the applicant of the final fee of $20; this he must pay within six months after receiving notice of allowance. In the event of the applicant's failure to pay this fee within the time limited, anyone interested in the patent may, within two years after the date of allowance, adopt and prosecute the application to its issue. In such a case the Patent Office requires the payment of a fresh application fee.

After payment of the final fee, no further taxes whatever are payable. When the patent is granted, the specification is printed and copies can be obtained for a small sum.

Caveat.—An inventor who has not completely worked out his idea in detail, but is anxious to record his claim for a patent at the earliest possible moment, may lodge a caveat at the Patent Office. A caveat is in the nature of a provisional specification, and is filed in the "confidential archives" of the Office and preserved in secrecy for one year. This does not afford the same protection as a provisional specification filed with an application in England; the caveator is, however, entitled to notice if an application is received by the Patent Office for a patent covering what appears to be substantially the same subject matter. The application is withheld from examination, and the caveator has three months in which to prepare and file his full specification. If the inventions prove to be identical, a patent is sealed to the inventor who can establish priority; otherwise the applications proceed in the ordinary way.

Assignment.—Patents are assignable by an instrument in writing; but an assignment is void against a subsequent purchaser or mortgagee unless recorded in the Patent Office within three months.

Marking of Patented Articles.—Patented articles must be marked with the word "patented," together with the date of the patent, either on the article itself or on the package; otherwise no damages for infringement can be recovered, except on proof that the defendant was duly notified of infringement and persisted in infringing after such notice.

Importation of patented articles from abroad does not invalidate a patent, and there are no conditions compelling the patentee to work his invention in the United States.

Prolongation of a patent can only be obtained by Act of Congress.

GERMANY.

Germany grants patents to its subjects and to foreigners alike; but, where the applicant is not resident in the country, he must appoint a representative residing in Germany to act on his behalf in all dealings with the Patent Office.

Kinds of Patents.—German patents are of three denominations:

(1) Patents for original inventions
(2) Patents for improvements,
(3) Patents for "useful models."

These will be dealt with in order.

Patents for Original Invention.—All inventions susceptible of industrial use are patentable, with the exception of:

(1) Inventions which are contrary to law and public morals,
(2) Inventions relating to articles of food, whether for nourishment or luxury,
(3) Medicines,
(4) Substances produced by chemical processes, in so far as the invention does not relate to a distinct process of manufacture.

Term of Patent.—The term of the patent is 15 years,

reckoned from the day after the application is lodged, and is unaffected by the prior expiration of foreign patents. No prolongation is allowed.

Novelty.—The invention must be new. It will not be considered new if it has been described in a printed publication in any country during the 100 years last preceding the application, or has been so publicly used within the realm, that an expert could carry out the alleged invention without exerting any inventive faculty. Invention will not be found if the method employed to achieve an old result is the mere logical deduction from what was well known to those conversant with the art, unless the new method reveals some unexpected commercial or industrial superiority over the old. Although, to amount to an anticipation, the printed publication need not have been actually introduced into Germany, it must be of such a character, *e.g.*, a foreign patent specification or a well-known scientific or technical journal, that it may be regarded as being within the knowledge of the German public.

Secret use of a process or manufacture in Germany will not debar its being subsequently patented, but the patent so granted will be of no effect against a person who at the time of the application was already using the invention. Germany now being a party to the International Convention, publication consequent on a patent application in a foreign country, also belonging to the Convention, will not prejudice the German application, provided it is lodged within twelve months of the foreign application (or the earliest of several foreign applications).

Applicant.—The person who first applies for a patent is entitled to the grant. He need not necessarily be the inventor. Anyone who is legitimately possessed of an invention answering to the above conditions may apply for a patent. But if the applicant has appropriated the invention of another without his consent, the latter can oppose

and lodge a rival application, and if successful he can demand a patent dated as of the day preceding the publication of the prior application, provided he made his application within a month of the decision.

Specification.—The application, which must be in the German language, has to be accompanied in the usual way by a specification and drawings. The specification may embrace only one invention; and an invention is only regarded as being one and indivisible if it is governed by a single inventive idea; otherwise the novel features are considered as "aggregated," not "combined," inventions. This differs widely from the American view according to which a single application will suffice, if the *embodied* invention is one coherent thing with co-operative parts.

The specification should be framed so as to bring out as prominently as possible the technical effects and scientific features of the invention, as the Patent Office, consisting of men more conversant with the theoretical than the practical side of science, is apt to lay greater stress upon the originality and ingenuity of the invention than upon its commercial or industrial advantages.

Claims.—The specification must conclude with one or more claiming clauses. German practice is, however, opposed to multiplicity of claims; the theory of the Patent Office being that a single invention (for no application can comprise more than one invention) is capable of being claimed in a single clause. Hence the applicant should frame a broad functional claim, describing and claiming the means employed to compass the desired end. This may be followed by one or more constructional claims embodying, as generically as possible, the principal features of the invention in their organic combination. Supplementary claims are allowed only in so far as they are embraced within or constitute a modification of the fundamental invention, and they should refer to the main claim

specifically. Product claims are not allowed when the product is merely the characteristic result of the process already covered by a claim; nor are they necessary, for in Germany a process claim protects the product made directly by that process.

In the case of mechanical inventions, models are sometimes required, and in the case of chemical processes, specimens of the product.

Modifications can be introduced at any time prior to publication.

Application.—The fee payable upon application is 20 marks. When the applicant does not reside in Germany, he must employ a resident agent, duly authorised by power of attorney and registered in the Imperial Office.

As soon as the application is filed, it is subjected to examination on the score of novelty and patentability. If defective in point of form or open to objection on the ground of prior publication, the papers are returned to the applicant with a request for amendment or reply within a stated time. If no reply is made within the prescribed time, the application is considered withdrawn. If the applicant amends or meets the objections, the case is re-considered, and, should the application still be unsatisfactory, this procedure may be repeated until the Office has before it all the information and material for consideration that can be brought to bear upon the case. The department of the Patent Office concerned with applications then gives its final decision. If this is unfavourable to the applicant, he may appeal to the Appeal Department. Assuming the decision of the Patent Office to be favourable and that it considers that the grant can be allowed, it notifies the applicant that his application is ready for publication, whereupon the invention is provisionally protected against infringement.

Publication will, at the request of the applicant, be

deferred for three months and in special cases for 6 months from the date of such notification. For two months after publication the application is open to public opposition; and within this same time the applicant must pay the first yearly tax of 30 marks. In the event of the application being successfully opposed, this tax will be refunded. After the two months have expired, the patent is finally allowed and issued to the applicant. The specification is printed and copies can be purchased for a small sum. To sustain the patent, yearly renewal fees must be paid; 50 marks for the second year; 100 marks for the third year, and so on, the fees rising by annual increments of 50 marks. These taxes must be paid before the anniversary of the date of the patent, but six weeks' grace is allowed without penalty, and a further six weeks upon payment of a fine of 10 marks.

A patentee, who proves lack of means, can obtain postponement of the payment of the taxes for the first and second year until the third year, and if the patent is then dropped, these taxes will be entirely remitted.

Patent of Addition.—If the invention relates to the improvement or further development of an invention already protected by a patent in favour of the applicant, he can apply for a patent of addition upon which it is only necessary to pay the filing fee and the first annuity. The patent of addition has a term corresponding with the residual term of the parent patent and, if the latter is allowed to lapse, will expire with it. But in the event of the principal patent being annulled, the patent of addition survives and becomes an independent patent, upon which renewal fees are payable. In such a case its duration and the date on which the taxes fall due will correspond with the duration and date of the principal patent, but the amount of the taxes payable on a surviving patent of addition is determined by the date of its own commencement.

Patent for Useful Model.—This form of patent is applicable to inventions the novelty of which consists in some new form or shape or arrangement of well-known elements, but which does not possess the requisite degree of ingenuity to warrant the grant of a full patent. The term for a patent of this kind is three years, extensible to six years in all. There is no examination as to novelty before the grant of this form of patent.

Where the invention is of this description, and can boast of no "notable new technical effect," but merely a more convenient arrangement of parts, the inventor will be well advised to apply for a patent for a useful model in the first instance instead of trying to obtain a full patent, which after a long and expensive fight may have to be given up.

Annulment.—A patentee is liable to have his patent declared null on the following grounds:—

(1) That the subject matter was not patentable, either because it does not fall within the category of patentable inventions or because it lacked novelty at the date of application. (This objection can only be raised within the first five years of the life of the patent.)

(2) That the invention forms the subject of a patent of prior date. (This objection may be raised against a patent at any time by any person.)

(3) That the essential features of the invention have been fraudulently taken from the work of another inventor. (This ground of objection is only open to the person aggrieved.)

If the patent is found to be defective only in a partial degree on any of the above grounds, its scope will be limited to a corresponding extent.

Revocation.—A patent can be revoked at the end of three years from the date of the official publication of the grant if—

(1) The patentee neglects to put the invention into

practice within the realm to an adequate extent, or at any rate fails to do all in his power to ensure the attainment of that object.

(2) If it appears in the interest of the community that licences should be granted, and the patentee declines to grant them for reasonable compensation or adequate security.

If the patentee is unable to comply with the requirements of actual working in Germany, he should instruct his representative to advertise in suitable trade journals his willingness to sell the patent or to grant licences under it upon reasonable terms, and he should repeat this as often as possible until the invention is actually being worked. The necessary amount of advertising can usually be carried out at the cost of about £5 each time.

The German patent law is designed to promote industries on German soil and to give employment to German workmen, and in interpreting the rules for the compulsory working of patented inventions this object is kept clearly in view.

Importation does not directly entail forfeiture; there is no provision of the German law to this effect, and indeed such a provision would violate Article V. of the International Convention, if the imported articles come from a country which is a party to the Convention; but if the importation of patented articles from abroad is carried on to such an extent as to interfere appreciably with the domestic manufacture, that is considered by the Courts a good ground for revoking the German patent. It should, however, be added that importation, over which the patentee has no control and for which he is not directly or indirectly responsible, will not endanger the validity of his patent.

Infringement.—Infringers who knowingly infringe can be proceeded against for damages, or can be punished by a fine not exceeding 5,000 marks or by imprisonment not exceeding

one year. The Court may award damages, in addition to the penalty, up to 10,000 marks.

France.

Patentable Invention.—A patent of invention may be obtained in France by an applicant, whether he be a French citizen or a foreigner, who is the inventor or is entitled to assume the rights of inventor of (1) a new industrial product or (2) a new method of manufacture or a new application of known methods. Excluded from the category of patentable inventions are:—pharmaceutical compounds, medicines, financial schemes or systems of business, and inventions contrary to good morals.

Novelty.—The invention must be new in the sense that it has not been published in France or abroad, prior to the date of application, to such an extent as to enable a competent person to carry it out in the light of such information. France being a signatory to the International Convention, an inventor, who has already applied for protection in Great Britain or any other Convention country, can claim a priority of 12 months in accordance with the provisions of Article IV. If the applicant desires to avail himself of this privilege, the previous foreign application should be specifically referred to.

Term of Patent.—Patents of invention are granted for 5, 10 or 15 years, the term of the patent being reckoned from the filing of the application. According to the Statute law of France, the term of the French patent is dependent upon and expires with a previously obtained foreign patent or that one of several which has the shortest term; this rule, however, must be taken as superseded, in the case of patentees entitled to claim the benefit of the Convention, by the stipulation, assented to by the contracting States, for the *independent* duration of patents in different countries of

the Union. Prolongation can only be obtained by a special act of the legislature.

Taxes.—The patent is subject to a yearly tax of 100 francs payable in advance. A receipt showing that the first year's tax has been paid must accompany the application. Beyond this instalment of the yearly taxes, no other Government fees are payable, in the ordinary course, to obtain the grant of the patent. Subsequent taxes fall due on the anniversary of the date of application. Three months' grace is allowed within which to make payment, a fine of 5 francs being levied for each month that the tax is overdue.

Patents of Addition.—Besides patents of invention the Government grants *certificates of addition* for improvements upon or modifications of the original invention. This form of patent only requires the payment of a single tax of 20 francs. It expires with the parent patent, no matter whether the latter is annulled or lapses from any other cause.

The owner of the parent patent is entitled to a certificate of addition in priority to any rival applicant, provided he applies for it within a period of twelve months from the date when his original patent was granted; during that period he has a paramount right to patent improvements on his own invention. No other applicant can obtain a valid patent for an improvement until after the expiration of 12 months. A rival inventor can, however, lodge an application during that period with the specification in a sealed packet, accompanied by the request that it shall not be opened until the 12 months have expired. When that time arrives, the seal is broken and, if the application is in order, the patent will be granted, but subject always to any application which may have been lodged in the meanwhile by the original patentee.

Application.—The application is addressed to the Minister of Agriculture and Commerce and must be accompanied by a receipt for the first year's tax and by the specification (in French) and drawings in duplicate.

The regulations regarding the form in which these documents should be presented are exceedingly precise and must be closely followed. The specification must conclude with a *résumé*, containing a succinct statement of the fundamental principles of the invention, and of any secondary features that characterise it. Claims are not recognised as having any legal significance. The scope of the invention is determined from the specification itself. If the applicant is a foreigner, he should appoint a specially authorised agent in France. As soon as the application is deposited, it is examined to see that it complies with formal requirements, but there is no examination as to the novelty or merit of the invention or the accuracy of the specification. If any irregularity is found, the applicant is notified and given an opportunity of explaining or arguing his case before the technical committee. If a patent is refused on the ground of irregularity, half the tax will be returned. An application may be withdrawn within 2 months from the date of filing, in which case the whole tax will be refunded.

If the application is in order, it is allowed; and the applicant is thereupon notified of the number and date of his patent, and the specification is printed and copies can be purchased for a small sum.

Before publication, proofs of the specification are submitted to the applicant, who has 3 months within which to make corrections. When once a patent has been granted, it is incapable of amendment.

Issue of Patent.—The issue of a patent, which usually takes place six or nine months after application, can by request be delayed till one year from the date of application, but this benefit cannot be claimed by those applicants who avail themselves of Article IV. of the Convention.

The law expressly states that patents are issued without any guarantee as to the genuineness, novelty or merit of

the invention. In token of this, if the patent be mentioned, the words *sans guarantie du Gouvernement* must be added, these words usually being represented by their initials "S.G.D.G."

Annulment.—A French patent is liable to be annulled if the invention lacks novelty or covers matter not patentable under the law, or is not sufficiently described in the specification, or if the title is misleading, or if the patentee is neither the actual inventor nor entitled to assume the inventor's rights (*ayant droit*).

Working.—A patent is liable under the Statute law to be revoked if the patentee does not work his invention in France within the period of two years from the date of the signature of the patent, or if he ceases to work it during two consecutive years, unless a good reason for such inactivity can be advanced. But a patentee who can claim the benefit of the Convention presumably runs no risk of forfeiture for non-working until the lapse of three years from the date of grant.

If the patentee is unable himself to work the invention in France, and fails to induce others to take it up and work it within the prescribed period, he should cause advertisements to be inserted in some suitable technical journals and in one or more of the principal daily papers, notifying the public that he is willing to dispose of his patent rights or grant licences upon reasonable terms. The insertion of these advertisements together with any results in the way of answers should be officially certified in case they may be required as evidence in future proceedings for revocation. These advertisements should be repeated as often as possible, at any rate each two years, until the invention is in actual work. The cost of working by advertisement in France is usually about £10.

Importation.—Importation into France of articles made abroad, similar to those covered by the French patent, is

also a ground of forfeiture, unless they are introduced from a country which is a party to the International Convention.

This exception in favour of Convention countries is now so wide as to reduce the rule to comparative unimportance. In cases, however, where the rule still applies, special authorisation may be obtained from the Minister of Commerce and Industry for the importation of (1) models of machinery or (2) models of objects for official exhibitions.

In reference to the attitude of France towards the International Convention, it has already been noticed that in two other important matters besides that of importation, viz., (1) the dependence of French patents upon the duration of foreign patents and (2) the period within which the invention is required to be worked, the French domestic law conflicts with the international law as embodied in the Convention. In the foregoing pages the opinion has been expressed that an applicant belonging to one of the States of the Union is entitled to rely on and take advantage of the provisions of the Convention, in spite of the internal law of France and notwithstanding the application was not initially ear-marked as a Convention application. This view appears to be justified not only upon principles of international law, but to be borne out by judicial pronouncement in a case recently decided in the French Courts. The case, it is true, decided a different point, but the view stated above follows as an *à fortiori* inference from that decision. In an action for infringement brought by the owners of a French patent for an invention relating to the manufacture of carbide of calcium, the defendants raised by way of defence the plea that the plaintiffs' patent was invalidated by reason of the patentees having imported into France carbide of calcium manufactured in Italy. The contention of the defendants was that the plaintiffs, being domiciled Frenchmen, could not avail themselves of the privileges of the

Convention, which, it was argued, contemplated importation only by a foreign patentee. The French Courts decided that the Article of the Convention relating to importation makes no distinction between *French* patentees and *foreign* patentees, and that to read any such distinction into it would be to misconstrue the character of the Convention, the terms of which are general and "give in the common interest the same rights to all persons belonging to the Convention."

This decision has since been endorsed by the enactment of June, 1906, declaring that French subjects may claim the application in their favour, in France, Algeria, and the French colonies, of provisions of the International Convention in all cases where these provisions are more favourable than the French law for protecting patent rights, and especially in connection with the claim to priority and compulsory working of patents.

Infringement.—Infringement is punished by a penalty varying from 100 to 2,000 francs; if the infringement is repeated, the delinquent may be imprisoned. This penalty is exacted without prejudice to the patentee's claim for damages actually sustained.

TABLE OF COST, ETC., OF FOREIGN PATENTS.

The following charges include the cost of specifications, translations, drawings; notarial, consular and government fees; first year's tax (where annual taxes are payable), and agency charges at home and abroad for ordinary cases, where the specification is not of unusual length or the drawings numerous.

Country.		Term of Patent.	First Cost.	Taxes payable subsequent to grant, including agency at home and abroad.	Conditions as to Working.
Argentine Republic		5, 10 or 15 years	10 years £45	£4 10*s.* annually	Within 2 years of issue of patent. Time may be extended for good reasons.
Australian Commonwealth	C	14 years	£22 1*s.*	At 7th year £8	None.
Austria		15 years	£15 15*s.*	First year £4, afterwards increasing yearly to £31 8*s.* for the last year	Within 3 years from grant. (Similar to German law.)
Belgium	C	20 years	£8 8*s.*	Second year £2, afterwards increasing 10*s.* yearly	Within 1 year from date of commercial working elsewhere. Time may be extended to 2 years.
Brazil	C	15 years	£31 10*s.*	Second year £5 5*s.*, increasing yearly to £17 12*s.* for the last year	Within 3 years from grant.

Canada		18 years	£21	At the end of the 6th year £10 10*s*. At the end of the 12th year £10 10*s*.	Within 2 years. May be commuted, upon application within 6 months from issue of patent, to granting of compulsory licences.
Cape of Good Hope		14 years	£25	At 3rd year £13 13*s*. „ 7th „ £23 3*s*.	None.
Denmark	C	15 years	£15 15*s*.	First 3 years £2 10*s*. yearly Next 3 „ £4 „ „ 3 „ £7 „ „ 3 „ £13 „ Last 3 „ £19 „	Within 3 years. Time may be extended or patentee relieved of obligation for good reasons.
France	C	15 years	£14 14*s*.	£5 yearly	Within 2 years from signing of patent.
Germany	C	15 years	£18 18*s*.	Second year £4, afterwards increasing £2 10*s*. yearly	Within 3 years from grant.
Hungary		15 years	£14 14*s*.	First year £4 8*s*., increasing yearly to £23 10*s*. for last year	Within 3 years from grant.
India		14 years	£25	At 4th, 5th, 6th, 7th and 8th years £7 10*s*. Each following year £12 10*s*.	None.

C signifies that the country is a member of the International Convention for the Protection of Industrial Property.

TABLE OF COST, ETC., OF FOREIGN PATENTS—(*continued*).

Country.		Term of Patent.	First Cost.	Taxes payable subsequent to grant, including agency at home and abroad.	Conditions as to Working.
Italy	C	1 year to 15 years	£25	£3 second and third years £4 each of next 3 years £5 ,, ,, 3 ,, £6 ,, ,, 3 ,, £7 ,, ,, 3 ,,	If originally granted for 5 years or less, must be worked within 1 year, otherwise within 2 years.
Japan	C	15 years	£35	£3 at end of first and second years. Afterwards increasing 10*s.* each third year.	Within 3 years of grant.
Mexico	C	20 years	£36 15*s.*	5th year £13 13*s.* 10th ,, £18 18*s.* 15th ,, £24 3*s.*	None; but if not worked within 3 years of grant, compulsory licences obtainable.
Natal		14 years	£25	At 3rd year £8 3*s.* ,, 7th ,, £13 3*s.*	None.
New Zealand		14 years	£15 15*s.*	At 4th year £7 12*s.* ,, 7th ,, £12 12*s.*	None.
Norway	C	15 years	£16 16*s*	£2 10*s.* second year, afterwards increasing 10*s.* yearly	Within 3 years of grant. Time may be extended for good reasons.

Portugal	C	1 to 15 years	1 year £15 5 years £20 10 years £25 15 years £30	None.	Within 3 years of grant.
Russia		15 years	£26 5*s.*	£4 second year, increasing gradually up to £46 10*s.* for 15th year	Within 5 years of grant.
Spain	C	5, 10 or 20 years	£21	£2 10*s.* second year, afterwards increasing 10*s.* yearly	Within 3 years of grant.
Sweden	C	15 years	£18 18*s.*	Yearly, 2nd to 5th years £3, 6th to 10th £4 10*s.*, 11th to 15th, £6.	Within 3 years. Time may be extended.
Switzerland	C	15 years	£16 16*s.*	£2 10*s.* second year, increasing 10*s.* annually	Within 3 years from grant.
Transvaal		14 years	£26 5*s.*	At 3rd year £4 12*s.*, increasing 10*s.* each year	None.
U. S. A.	C	17 years	£26 5*s.*	None.	None.

C signifies that the country is a member of the International Convention for the Protection of Industrial Property.

APPENDIX A.

TABLE 1.—PATENT FORMS AND FEES.

Form.	Proceeding.	Fee.
Patents Form	No. 1.—Application for Patent	£1
,,	No. 1A.—Application for Patent communicated from abroad	£1
,,	No. 1B.—Application for Patent under International and Colonial arrangements	£1
,,	No. 1C.—Application for Patent of Addition	£1
,,	No. 1D.—Application for Secret Patent	—
,,	No. 2.—Provisional Specification	—
,,	No. 3.—Complete ,,	£3
,,	No. 4.—Appeal to Law Officer	£3
,,	No. 5.—Application for extension of time under Rule 16 for 1, 2 or 3 months, respectively	£2, £4, or £6
,,	No. 6.—Application for extension of Time for leaving Complete Specification	£2
,,	No. 7.—Application for extension of Time for acceptance of Complete Specification for 1, 2 or 3 months, respectively	£2, £4, or £6
,,	No. 8.—Opposition to Grant of Patent.	10*s.*
,,	No. 9.—Notice that Hearing will be attended	—
	(*a*) on opposition to Grant, Restoration, Amendment or Surrender of Patent	£1
	(*b*) on Revocation proceedings under ss. 26 and 27	£2
,,	No. 10.—Notice of Desire to have Patent sealed	£1
,,	No. 11.—Application for extension of Time for sealing of Patent, where period allowed for sealing of Patent will expire after commencement of Act for 1, 2 or 3 months, respectively	£2, £4, or £6

Form.	Proceeding.	Fee.
Patents Form	No. **12**.—Application where period allowed for the Sealing of the Patent has expired before the commencement of the Act	£10
,,	No. **13**.—Application for Certificate of Payment or Renewal according to age of Patent	£5 to £14
,,	No. **14**.—Application for Enlargement of Time for Payment of Renewal Fee for 1, 2 or 3 months, respectively . .	£1, £3, or £5
,,	No. **15**.—Application for restoration of a lapsed Patent	£20
,,	No. **16**.—Notice of opposition to an application for restoration of a lapsed patent	£5
,,	No. **17**.—Application to amend Specification before or after sealing, respectively	£1 10*s*. or £3
,,	No. **18**.—Opposition to Amendment of Specification	10*s*.
,,	No. **19**.—Application for Grant of Compulsory Licence or Revocation of Patent	£1
,,	No. **20**.—Petition for Grant of Compulsory Licence or Revocation of Patent	—
,,	No. **21**.—Opposition to petition for Grant of Compulsory Licence or Revocation of Patent	£1
,,	No. **22**.—Application to the Comptroller for an Order for the Revocation of a Patent under s. 26 of the Act . .	£2
,,	No. **23**.—Offer to Surrender a Patent .	£1
,,	No. **24**.—Application for Revocation of a Patent under s. 27 of the Act . .	£2
,,	No. **25**.—Notice for alteration of Name or Address or Address for Service in Register	5*s*.
,,	No. **26**.—Request to enter two Addresses for Service on Register .	5*s*.
,,	No. **27**.—Request to enter Name upon the Register of Patents . . .	10*s*.
,,	No. **28**.—Request to enter Notice of Interest in the Register . . .	10*s*.
,,	No. **29**.—Request to enter Notification of Document in Register . . .	10*s*.
,,	No. **30**.—Request for Correction of Clerical Error before or after sealing, respectively	5*s*. or £1

PATENT FORMS AND FEES (*continued*).

Form.	Proceeding.	Fee
Patents Form No. **31**.	—Request for Certificate of Comptroller	5*s*.
,, No. **32**.	—Application for Duplicate of Patent	£2
,, No. **33**.	—Notice of Intended Exhibition of Unpatented Invention	10*s*.
,, No. **34**.	—Application for Entry of Order of Court	10*s*.
,, No. **35**.	—On postal request for printed Specification	8*d*.
Search or inspection fee	each	1*s*.
For office copies	every 100 words (but never less than one shilling)	4*d*.
For office copies of drawings	(cost according to agreement.)	
For certifying office copies, MSS. or printed	each	1*s*.

TABLE 2.—COST OF OBTAINING A BRITISH PATENT.

The following may be taken as a normal scale of charges for obtaining a complete British patent in an ordinary case, where the specification does not call for an unusual expenditure of time in its preparation. These charges are exclusive of the cost of making drawings and of any amendments necessitated by objections raised by the Patent Office on the ground of anticipation or otherwise; they also exclude the cost of meeting any opposition that may be brought against the application.

Preparing and settling the complete specification and making the necessary copies; stamp duty and agency	£12	12	0
Sealing the patent, if allowed	2	2	0
Total	**£14**	**14**	**0**

If provisional protection is applied for in the first instance, the cost will be as follows:—

Provisional Application.—Preparing and settling provisional specification and making the necessary copies; stamp duty and agency	£5	5	0
Completing the Application.—Preparing and settling the complete specification and making the necessary copies; stamp duty and agency	£10	10	0
Sealing the patent, if allowed	2	2	0
Total	**£17**	**17**	**0**

The cost of drawings, and of answering any objections the Comptroller may raise on account of prior specifications, and of meeting any opposition, will be in accordance with the amount of work involved.

TABLE 3.—CONVENTION COUNTRIES.

The following is a complete list of the countries which have up to the present time subscribed to the Articles of the International Convention for the Protection of Industrial Property, ratified at Paris in 1884 and amended by the Brussels Act of 1900.

Belgium
Brazil
Cuba
Denmark with the Faroe Islands
France, with Algeria and Colonies
Germany
Great Britain, with the Commonwealth of Australia (including Tasmania)
Ceylon
New Zealand
Trinidad and Tobago
Italy
Japan
Mexico
Netherlands, with the
Dutch East Indies
Surinam
Curaçoa
Norway
Portugal, with the Azores and Madeira
Santa Domingo
Servia
Spain
Sweden
Switzerland
Tunis
United States of America

Under this Convention, an applicant for a patent in any one of the contracting States may obtain priority in any of the other States.

Similar arrangements, for the mutual protection of inventions, designs and trade marks, have been made between Great Britain on the one side, and each of the following States and Colonies on the other :—

Ecuador (designs and trade marks only). Greece (designs and trade marks only). Honduras. Paraguay. Roumania (designs and trade marks only). Uruguay.

PART II.

COPYRIGHT IN DESIGN.

INTRODUCTION.

The protection of copyright in design has formed the subject of a surprisingly large number of enactments. Glancing back at these, and particularly the earlier of them, one cannot help being struck by the meticulous spirit in which Parliament appears to have handled this matter. Indeed, a sorrier spectacle of piecemeal legislation it would be hard to find anywhere in the Statute-book.

The first of these Acts, evoked by the wholesale piracy of designs then prevalent in the cotton trade, was passed in 1787. It went no further than was absolutely necessary to meet the immediate needs of the case, by granting a monopoly for 2 months in new patterns for printing on linens, cottons, calicoes and muslins. In 1794 this period of protection was extended to 3 months.

By a further instalment of legislation in 1859 a similar degree of protection was accorded to designs for fabrics of wool, silk and hair; and Ireland, hitherto excluded, was brought within the scope of the Acts.

In the same year a more liberally conceived measure was passed, granting to the proprietor of any new and original design, applicable to the purposes specified in the Act, the sole right of user for 12 months, or, in certain cases, for 3 years. The purposes specified covered practically all the

uses to which designs are applicable. This Act also contained a provision making the infringer of a registered design liable to a penalty of £5 to £30 for each offence.

By an Act of 1842, registration was extended to all ornamental designs; at the same time, in order to prevent a person from unduly monopolising a design in respect of all manner of articles, a system of classification was adopted. Thirteen classes of articles were drawn up, and the applicant was required to specify the class or classes for which he claimed registration. This Act also provided that the plaintiff in an action for infringement should have the option of claiming damages instead of a penalty.

In the following year registration was further extended to embrace *useful* as well as *ornamental* designs.

The Designs Act of 1850 introduced a species of provisional protection for designs which enabled the proprietor to publish his design without harmful consequences; he could not, however, without jeopardising his title, sell or offer for sale any article bearing the design, until registration was completed. The advantages of this provision seem to have been somewhat questionable and it was subsequently dropped.

With a view to facilitating the means of legal redress, an Act of 1858 sanctioned the institution of infringement proceedings in the County Courts.

In 1865 a measure was passed, granting provisional protection to designs exhibited at industrial exhibitions.

An important administrative change was effected in 1875, when the business of the Board of Trade in regard to designs was transferred to the Patent Office and the duties of the registrar of designs were vested in the Commissioner of Patents.

The Patents, Designs and Trade Marks Act of 1883 swept away all previous legislation on the subject of designs and

formulated the law afresh. The period of copyright obtainable by registration was made, for all designs, an invariable period of 5 years, and this term was not capable of extension. Provisional protection was abolished and the distinction between useful and ornamental designs was discarded, the Legislature recognising that the purpose of the design is irrelevant to the question of its registrability.

This Act was repealed by the Patents and Designs Act of 1907, which now, in Parts II. and III., as supplemented by the Board of Trade Rules, embodies the whole of the statutory civil law of copyright in designs. The most radical innovation introduced by the new Act is the provision enabling the proprietor of a registered design to extend the period of his registration for 2 further terms of 5 years each, thus virtually enlarging the maximum period of copyright in designs to 15 years. It should also be noted that a branch office for the registration of printed or woven designs on textile piece goods, handkerchiefs and shawls has been established at Manchester, under the control, for the time being, of the Keeper of Cotton Marks. The other changes are mainly of a minor character, tending to assimilate the legal practice in regard to designs to that already prevailing in the case of patents.

CHAPTER I.

REGISTRABLE DESIGNS.

Every new and original design, not hitherto published in the United Kingdom, is capable of registration.

This statement sums up in a single sentence the greater part of the law regulating the registration of designs. But, like most general statements of law, it stands in need of explanation and commentary.

In the first place it is obviously desirable to get at the outset a clear notion of the precise meaning attached by the Legislature and the Courts to the word "design." To the layman the word appears simple and obvious enough. Actual cases, however, have shown that it is not altogether free from the danger of misapprehension. The definition of the word furnished by the Statute is as follows:—

"'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."

Although scarcely a definition in the true sense, the above statement affords a fairly comprehensive catalogue of the various forms which a design may assume. It is

plain also from the wording that the only kind of design contemplated by the framers of the Act is a design applicable to manufactured articles. Drawings, engravings, photographs and pictures generally are not within the statutory definition. Copyright in these is governed by a different set of Statutes.

Of the four words used to describe the various applications of a design, "pattern" is the term which may properly be used to denote a design as applied to fabrics, wall papers, china, etc.; "shape" and "configuration" mean much the same thing and suggest rather the outline and general form of an object; "ornament" is appropriate to a design when applied in a superficial, partial or accessory manner. But no hard and fast meaning need be attached to these terms, and an applicant who states in his application that his design is for one or the other does not thereby limit the scope of his copyright. It should be observed that the thing registered is not the article to which the design is applied, but the design as applied to the article. The distinction is obvious enough when the design is for a pattern or ornament, but when the design is for the shape of a thing the distinction is reduced, as Lord Justice Lindley put it, to "the difference between the shape of a thing and a thing of that shape."

The use of the word "ornament" in the above definition implies no antithesis to "usefulness." The aim and object of a design may be purely æsthetic, or purely utilitarian, or both, but as far as the copyright in a design is concerned, its purpose is wholly immaterial. All that the Courts are concerned with is its outward and visible appearance. Hence, if two designs are identical to the eye, it cannot be pleaded as a defence to an action for infringement that the objects they compass are different, or that the one is useful and the other is useless. Conversely, the fact that two designs compass the same end is quite irrelevant

to the consideration of the question whether the one is identical with or a fraudulent or obvious imitation of the other.

This was the principle laid down in the often quoted House of Lords case, *Hecla Foundry Co.* v. *Walker & Co.* The plaintiffs were the owners of a registered design for a kitchen range fire door, with a moulding on the top which served to exclude cold air. This moulding fitted into another moulding on the range when the door was closed. The infringement complained of was a range fire door with a moulding which had the same effect, but did not fit into the moulding on the range. The Courts below had allowed the purpose, for which the moulding was intended, to influence their decision. The House of Lords, disapproving this ground of decision, ruled that the object which the designer may have in view in adopting a particular shape ought not to be regarded in considering what is the design protected, and whether there has been an infringement of that design.

The utility of a design, on the other hand, is no disqualification; though, where the importance of a particular shape resides in its utility, it becomes a serious question whether it is not better to protect it by patent instead of by registration. Mistakes, resulting in the loss of copyright, have sometimes been made by attempting to protect by registration so-called designs, that are in reality processes or methods of manufacture. A good instance of such a case is furnished by *Moody* v. *Tree*. There the design registered was a picture of a basket, and underneath was the statement that the claim was for "the pattern of the basket, consisting in the osiers being worked in singly and all the butt ends being outside." The basket had no recognisable novelty in its shape, configuration or ornamentation; nor in its pattern, according to the proper significance of that word. Its virtue lay merely in the

process by which it was made, and that, if novel and useful, might form good subject matter for letters patent; but the Court held that it was not capable of being registered as a design. It is not the intention of the Statute that processes, which cannot, either for want of novelty or want of utility or for some other reason, be protected by patent, should by a specious transformation be protected as designs.

Similar questions arose in two subsequent cases, both relating to designs for ladies' corsets, viz., *Cooper* v. *Symington* and *In re Bayer's Design*.

In the former case the plaintiffs had registered a design for a new style of corset. The novelty consisted substantially in the method of lacing the corset so as to facilitate the removal of the busks. The lacings were diagonal, and so arranged that when the corset was fastened, it had the appearance of being laced together (though in reality it was fastened by clasps and studs), and looked precisely like the old laced corset. It was held that this was not a new or original design capable of registration under the Statute. In *Bayer's Design* the application stated that the novelty consisted in "a corset having the gores or gussets cut horizontally and from the front of the busk towards the back of the corset, as shown in the representations." The registered sketch showed a straight-fronted corset in which the seams were not exactly horizontal, but the gussets tapered towards the front. It was held that the representation attached to the application illustrated a method of manufacture, and that there was no design capable of registration.

Cases will readily occur to the reader in which the particular form of an article might be equally fitting subject matter for letters patent and for registration as a design, *e.g.*, an aeroplane, a new form of screw propeller, or a photographic screen ruled in some new fashion for half-tone

engraving, or in fact any other invention in which the shape or pattern is the determining factor of its utility. Where, however, an invention appears equally suitable for protection by copyright or patent, the very marked difference in the scope of protection afforded in either case must not be overlooked. An aeroplane, for instance, regarded purely as a design, presents a meaningless assemblage of parts; meaningless, because the appeal is solely to the eye and not to the intelligence. The protection secured by registering it as a design will be confined to the superficial aspect of the object, as stereotyped in the representation accompanying the application. Consequently, anyone minded to steal the invention could do so, provided he could give his machine an appearance sufficiently unlike the registered design. In the case of a patented invention, however, no colourable alteration of shape will avail the infringer if the principle of the invention has been taken. Hence it is plain that when utility is an important function of the design, registration is a very inadequate means of protection.

An actual instance of the co-existence of design and patent rights in the same subject matter not long ago came under judicial consideration in the case of *Werner Motors, Ltd.* v. *Gamage*. On November 18, 1901, the plaintiffs registered a design applicable for the pattern of a motor-cycle frame. Previously, on November 8, they had applied for a patent for a frame for motor-cycles similar to that shown in the design. It was contended by the defendants that, a patent having been granted on the application, the registration of the design was invalidated by reason of the prior grant of exclusive rights to the article. The Court, however, affirming the principle that the rights in a patent and a design are distinct and may co exist, held that in the above circumstances the registration of the design was valid, as it had been completed before the actual grant of

the patent. The question whether the registration of a design would debar the proprietor or a stranger from *subsequently* obtaining a valid patent for the mechanical advantages flowing from the use of a similar design was raised but not decided.

It is obvious that the co-existence of copyright and patent right in the same article might lead to somewhat curious results in the event of their becoming vested in different proprietors. The assignee of the patent might find himself exposed to an action, at the instance of the owner of the registered design, for manufacturing an article, which, though in accordance with the specification of his patent, infringed the other's copyright by reason of its appearance.

The Court was not blind to these difficulties, but declined to meet them prematurely. Lord Justice Romer, however, addressing himself to the case of the possible interference of patent right and copyright, expressed the opinion that the difficulty might be met by saying that the right, second in point of time, must be held subject to the first.

Novelty and Originality.—Having thus far ascertained the legal meaning of "design," it still remains to consider what is meant by the requirement that the design shall be "new and original" and "not hitherto published within the United Kingdom." If there is any distinction in meaning between the words "new" and "original," and so far the Courts have failed to discover any, there is authority for saying that the design need not be *both* new and original.

In considering the novelty or originality of a design, it must always be borne in mind that it is not the abstract design but its *application* to the manufactured article that must be novel. To demand originality of design in the abstract sense of the word would be to seriously curtail the designer's freedom of choice and place too heavy a tax on his creative ingenuity. As it is, he is at liberty to select from the multitude of objects that surround him any that

strikes him as affording a good design for commercial application. Nature teems with such ready-made designs, and mankind has been busy applying them ever since the world began.

A discussion upon this aspect of the requirement of originality arose in the case of *Saunders* v. *Wiel*. There it was not a natural but a well-known artificial object, to wit, Westminster Abbey, which had been appropriated in miniature as the design for a spoon handle. The objection was raised that this miniature model of the Abbey was not a design within the meaning of the Act, or if it was, that it was not "new and original." The Court, however, overruled both these objections, holding that the novelty and originality of a design are not destroyed by its being taken from a source common to mankind or from some natural object. But it seems open to doubt whether the taking of a natural object itself, and the adaptation of it with little or no change to some ornamental purpose, would constitute subject matter for registration. For example, it is questionable whether the mounting of a Brazilian butterfly as a brooch, or an Egyptian scarab as a scarf pin, would be registrable as a valid design.

The design must be new and original with reference to the kind of article for which it is registered. A design for the shade of a gas lamp can hardly be new, if it was old for an oil lamp. The character and use of the articles being closely analogous, there must be substantial difference between the designs as applied to them respectively. A leading case in point is *Le May* v. *Welch*. There the Court had to consider the design of a collar, the cut of which differed in two or three trifling features from previous patterns of collars. The Court held that the difference was not substantial enough to constitute registrable novelty, and Lord Justice Bowen observed: "It is not every mere difference of cut, every change of outline, every change of

length or breadth or configuration in a simple and most familiar article of dress like this, which constitutes novelty of design. To hold that, would be to paralyse industry and make the Act a trap to catch honest traders. There must be not mere novelty of outline, but a substantial novelty in design, having regard to the nature of the article."

On the other hand, in *Rollason's Design* (which related to the ornamentation of a tombstone), Lord Herschell pointed out that if by a slight variation of an old design a much more attractive and pleasing effect is produced upon the eye, protection should not be denied to the more successful designer.

A combination of old shapes or patterns will afford good subject matter for registration, provided there is some degree of originality in the manner of combining them. But mere aggregation of old designs will not pass muster as a new design.

A variation of the material upon which the design is impressed does not constitute novelty. Thus, in *Bach's Design*, a rose-shaped lamp-shade, made in linen, having been registered for goods in Class 12, it was held that a lamp-shade of the same design but made in china, registered in Class 4, was deficient in novelty and the registration was expunged.

In *Clarke's Design* a particular form of lamp-shade, previously used for gas and oil lamps, was subsequently registered in respect of electric lamps. The only feature of novelty was the omission of the chimney which, in the case of electric lighting, was superfluous. The Court held that the novelty of the application did not satisfy the requirements of the Statute. As a corollary to the foregoing cases, it should be added that the fact of the articles or materials to which the design is applied falling in different classes does not constitute a difference in the eyes

of the Court, if in reality the nature and use of the articles are the same or closely analogous.

Where, on the other hand, the articles are not of similar character, a design which is old in respect of one may be new as applied to the other: in other words, what is old for a coal scuttle may be new for a bonnet. In *Walker, Hunter & Co.* v. *Falkirk Iron Co.*, the registration of a design for the shape of an iron door applicable to a kitchen range was upheld, although wooden doors of the same shape for sideboards and other articles of furniture were old.

Though the law is averse to a stranger or rival taking a design already registered in one class and registering it in another for a closely analogous purpose, the same objection does not exist where the proprietor of a design wishes to do the same thing. Prior to 1908, however, the proprietor of a registered design who wished thus to extend his registration to other classes, laid himself open to the charge of self-anticipation. To meet this hardship, a special provision is introduced in s. 50 of the Patents and Designs Act, 1907, to the effect that in such circumstances the subsequent registration shall not be invalidated,

(*a*) on the ground of the design not being a new and original design, by reason only that it has been previously registered by the applicant in another class;

(*b*) on the ground of the design having been previously published in the United Kingdom, by reason only that it has been applied to goods of any class in which it was so previously registered.

The requirement of novelty in the sense that the design intended for registration must not have been previously published in the United Kingdom is, in the main, identical with the rule as to prior publication in the case of patentable inventions. Stated compendiously, the rule is that the

printed publication of the design, or the sale or exhibition for commercial purposes of any article bearing the design, is fatal to subsequent registration of a valid copyright. To save unnecessary repetition, the reader is referred for further information on this head to Part I., Chap. II., where the subject of anticipation by prior publication and prior user is fully dealt with. As in the case of patented inventions, so also with designs, the stringency of the rule previously prevailing in regard to prior publication has been somewhat relaxed by the Act of 1907. Section 55 provides that neither confidential disclosure of a design by the proprietor to any other person, nor disclosure by the person confided in, in breach of good faith, shall prejudice the subsequent registration of the design. A special provision is also made to the effect that the acceptance of a first and confidential order for goods, bearing a new and original textile design, shall not be a bar to subsequent registration. The reason why this indulgence is confined to designers in the textile trade is not very apparent. True, the number of applications emanating from that source largely preponderates over those coming from other trades, yet this in itself scarcely seems to be a sufficient ground for making the distinction.

Industrial and International Exhibitions.

Publicity given to a design, either by showing it at an Industrial or International Exhibition or by publicly describing it elsewhere during the period of the exhibition, will not prejudice its subsequent registration provided that:—

(*a*) The exhibitor gives the Comptroller 7 days' previous notice of his intention to exhibit or publish the design;

(*b*) The application for registration is made within 6

months from the date of the opening of the exhibition.

The notice to the Comptroller must be accompanied by a description and drawing of the design sufficient for the purpose of identification.

This privilege may be claimed in the case of all exhibitions certified by the Board of Trade, or any other exhibition to which these provisions may be extended by Order in Council. In the latter case compliance with the above conditions may be dispensed with.

CHAPTER II.

REGISTRATION.

Who May Register.

The rule regulating the right to register a design allows any person, claiming to be the *proprietor* of a new and original design, to apply for registration. The Act recognises four different grounds upon which the claim to proprietorship may be based. The proprietor may be :—

1. *The author of the design.*—That is, the person who first conceives the design and embodies it in concrete form. Though the point has never been clearly decided, the cases seem to indicate that the importer of a design is not, as in patent law, on the same footing as the true author of the design. In practice, however, where there is no evidence that the design, though published abroad, has been previously published in England, it would be extremely hard to upset a registration by an applicant who claimed to have independently invented the design in question.

2. *The person who orders the design and pays for it.*—Doubtful questions, such as arise in the case of invention as to the respective rights of master and workman, cannot arise in the case of designs. If the master is not the author of the design, he has at least commissioned the work and paid for it, and can therefore claim proprietorship on that score.

3. *The purchaser of a design or the right to use it either exclusively or to a limited extent.*—In other words, the assignee or licensee of the original proprietor. No assign-

ment or licence, however, can be registered until the original proprietorship has been duly entered on the Register. With reference to this class of proprietorship, it should be observed that the acquisition of the right to sell merely the article to which the design is applied, even though it be an exclusive right, is not the same thing as the acquisition of copyright in the design, and will not therefore support a claim to registration (*Jewitt* v. *Eckhardt*).

4. *The person on whom the property in a design devolves.*—The copyright in a design being personal property, it devolves, in the case of the proprietor's death, upon his personal representatives, and in the event of bankruptcy, upon his trustee.

Application.

As registered designs are not ordinarily open to public inspection until some time after the date of registration (5 years in the case of designs in Classes 13, 14 and 15, and 2 years in the case of other designs), the intending applicant has not the same opportunity, as an applicant for a patent, of satisfying himself that his idea has not been anticipated. He may, however, employ the Patent Office to make a search for him, by applying on Form Designs No. 21, accompanied by 2 copies of the design, and stating the class in which it is proposed to register it. The Comptroller will then inform him whether it is identical with, or an obvious imitation of, any design the copyright in which is still subsisting.

The procedure of applying for registration is simple enough. The applicant must first decide upon the class or classes of goods for which he desires to register. A list of the 16 classes is given at p. 277. He may register the same design in all or any of the classes; but a separate form and fee is required for each class. In case of doubt as to the class in which a design ought to be registered, the applicant may refer to the Patent Office to decide the

question. The design may be registered either for a single article or for a set of articles, *e.g.*, a dinner service. In the former case, the application must be made on Form Designs No. 2; in the latter, on Form Designs No. 3. The stamp duty on these forms is 5*s.* and 10*s.* respectively.

An application for the registration of a lace design in Class 9 must be made on Form Designs No. 4 (stamp 1*s.*), or, in the case of a set, on Form Designs No. 5 (stamp 2*s.*). For the registration of printed or woven designs on textile piece goods or on handkerchiefs and shawls (comprised in Classes 13, 14 and 15) special provisions have now been made: see p. 258.

The applicant must state the nature of the article to which the design is to be applied and, if the Comptroller so requires, the purpose for which it is to be used and the material of which it is to be made. He may also be required by the Comptroller to indorse on the application a brief statement of the novelty claimed for the design.

The application must be accompanied by *three* or, where the design is applied to a set, *four* identical drawings, photographs or specimens of the design, drawn or mounted on ordinary foolscap paper. Drawings may be executed in ink or pencil (fixed), but rough sketches will not be accepted. To insure compliance with the minute requirements of the Patent Office in regard to drawings, etc., a copy of the "Instructions" issued by the Office regarding the registration of designs should be procured and studied.

If it is desired to secure a date of registration at the earliest possible moment, only one sketch of the design (sufficient to identify it) need be sent upon application. In this case the design, if accepted, will eventually be registered as of the date when the sketch was received; but no certificate of registration will be issued until three exact drawings, photographs or specimens have been sent in substitution for the sketch. The application papers

being all in order, they should be sent by hand or by prepaid post addressed to the Comptroller of the Patent Office (Designs Branch) 25, Southampton Buildings, Chancery Lane, London.

There is no opportunity given to the public to oppose an application to register a design; the only objections that the applicant is liable to encounter are those emanating from the Patent Office. The Comptroller may refuse to register the design. But if so, he will notify the applicant of his objections, and the latter has then one month within which to apply for a hearing so that he may appear personally or by his agent to argue the case. When registration is refused on the ground of identity with some design already registered, the applicant is entitled to inspect the design cited as anticipating his own. If, after hearing what the applicant has to say, the Comptroller still refuses to register the design, the applicant may appeal to the Board of Trade. Notice of appeal must be given on Form Designs No. 25, within a month after the Comptroller's decision.

An application, not completed, owing to neglect on the part of the applicant, within twelve months from the date of filing, will be deemed to have been abandoned. The applicant is notified of the expiry of this period, and has 14 days' grace within which to complete his application. If no hitch occurs in the application, a certificate of registration is sealed in due course and forwarded to the applicant, dated as of the day of application.

The Manchester Office.

A Manchester Branch Office for Designs has now been established and is located, for the time being, at the Trade Marks Registry of the Patent Office, 48, Royal Exchange, Manchester, under the superintendence of the Keeper of

Cotton Marks. It is concerned with the registration of designs in the following classes :—

Class 13.—Printed or woven designs on textile piece goods (other than checks or stripes).

„ 14.—Printed or woven designs on handkerchiefs and shawls (other than checks or stripes).

„ 15.—Printed or woven designs (on textile piece goods or on handkerchiefs or shawls), being checks or stripes.

An application for registration in any of the above classes may be lodged either at the London or the Manchester Office. It must be furnished in duplicate and accompanied by *six* representations or specimens of the design.

For Classes 13 and 14 the appropriate form is Designs (Manchester) No. 1 (stamp 2*s.* 6*d.*); for Class 15 the form is Designs (Manchester) No. 2 (stamp 1*s.*).

The Manchester Register contains entries concerning all designs registered in these classes. These entries also appear in the London Register.

International and Colonial Arrangements.

An applicant who has already registered his design in one or other of the Convention States can obtain a British registration of the same date as his foreign application (or the first of them, where there are several), provided he applies in England within 4 months after such foreign application.

The names of the countries belonging to the International Convention, or with which some similar preferential arrangement exists, are given on page 239.

Duration of Copyright.

Registration confers the exclusive right to apply the registered design to any article in the class specified for a period of *five* years.

Prior to 1908 this was the limit of protection allowed. By virtue of the Patents and Designs Act of 1907, however, the time may be extended for two further periods of 5 years each.

To obtain extension of the period of copyright for a second term of 5 years, application may be made at any time after the registration of the design by lodging Form Designs No. 8 (stamp £1); but the extension will not be granted unless the application be made at least a week before the expiration of the original period of 5 years. Where the proprietor possesses several design copyrights expiring simultaneously, he may include them all on one form. This first extension can be demanded as a matter of right under s. 52 (2) of the Act. The second extension for a third period of 5 years is left within the discretion of the Comptroller; it will not, however, be refused unless there are special reasons against granting the extension. This final extension may be applied for at any time not less than 6 months and not more than 12 months before the expiration of the second period of 5 years. The form to be used is Designs No. 9, and the fee is 10*s*. If the Comptroller grants the application, the registered proprietor will be duly notified of the fact, and he must then lodge Form Designs No. 10 (stamp £1 10*s*.) at least a week before the current copyright period expires.

Extensions of the period of copyright are advertised in the Illustrated Official Journal (Patents).

The term of protection cannot be extended beyond 15 years.

Cancellation for Non-User.

No conditions, beyond the payment of fees, are attached to the continuance of copyright in design. But if a registered design is used in manufacture exclusively or mainly outside the United Kingdom, the proprietor runs the same risk of having his registration cancelled as the patentee whose patent is worked mainly abroad, with this

difference, however, that in the case of a design no period of grace is allowed; the application to annul may be made *at any time* after the registration. In other respects, the procedure is precisely the same as that prescribed for the revocation of patents on this ground.

The Register.

A Register of Designs is kept at the Patent Office, containing representations, or specimens, of registered designs, names and addresses of proprietors of registered designs, notifications of assignments and similar matters. In order to get his name entered on the Register, a person who has become entitled either by assignment or by licence to use a registered design, must make his request to the Comptroller either conjointly with the registered proprietor on Form Designs No. 11 (No. 12 for Lace) or, if he cannot get the registered proprietor to join with him, then upon Form Designs No. 13. In the latter case the application must be accompanied by a full statement of the circumstances in which he claims to be entitled to an interest in the design. The Comptroller may require the statement to be verified by statutory declaration. The fee on registration of assignment is the same as that required for the original registration.

(*a*) *Inspection of the Register.*—The Register of Designs is not accessible to the public as freely as is the Register o Patents. The general rule is that in the case of ordinary designs inspection is not permitted until 2 years after registration and, in the case of Manchester designs, not before 5 years. During these periods, however, the Register may be inspected by the proprietor of the design and by persons authorised by the proprietor, the Comptroller or the Court. A person entitled to inspect a design, before the close time has expired, must furnish the Comptroller

with sufficient information to enable it to be identified. Inspection takes place in the presence of an official of the Patent Office and no copy of the design is allowed to be taken.

After the expiration of the close time, the design becomes open to public inspection generally, and copies may be taken on payment of a small fee. Particulars as to the duration and scope of any copyright may be obtained from the Comptroller upon request on Form Designs No. 19, accompanied by information enabling the identification of the design in question.

(*b*) *Rectification.*—The Comptroller has ample power to make clerical amendments in the entry in the Register at the instance of the proprietor of the design; amendments, for instance, such as the correction of an error in the representation of the design or in the name of the proprietor (Form Designs No. 17), or the entry of a new address (Form Designs No. 16). He may also, at the proprietor's request, cancel the registration altogether, or restrict the scope of the design to particular goods. Corrections of this kind can be effected by forwarding to the Comptroller a request on Form Designs No. 18 (stamp 1*s.*).

The power to rectify the Register, where someone else's design is concerned, at the instance of a "person aggrieved" is reserved to the Court. The rules regulating this procedure are the same in the case of designs as in the case of patents. Any person hampered in his trade or prevented from doing what he deems he has a right to do, by the registration of a particular design, is a "person aggrieved" within the meaning of the Act. An obvious example would be a person threatened with an action for infringement. Anyone coming to the Court with a legitimate grievance of this kind is entitled to attack the obnoxious design on all the grounds upon which registration can at any time be attacked, *e.g.*, want of novelty, defective title, or invalidity through non-user.

The powers conferred under this section are exceedingly wide, enabling the Court not only to expunge the name of a person wrongfully registered, but at the same time to substitute on the Register the name of the lawful proprietor of the design (*Grocott's Design*).

An application to rectify the Register is made either by summons or motion in the High Court, and 4 clear days' notice must be given to the Comptroller, in case he may wish to appear and oppose the application.

CHAPTER III.

MARKING.

All goods to which a registered design is applied must, before delivery on sale, be marked with the prescribed marks of registration. Every article must be marked with the word "REGISTERED" or with the abbreviation "REGD" or "RD," and also (except in the case of designs registered in Classes 9, 13, 14 and 15) with the number appearing on the certificate of registration.

If the mark cannot be conveniently placed on the article itself it may be put on a label attached to or a wrapper containing the article. In the case of trimmings and lace, it will be sufficient to place the mark on the packet in which the material is put up for sale. But where a number of articles are manufactured in a single piece and subsequently cut up and retailed separately, each unit must have its own individual marking. Thus in *Hothersall* v. *Moore* it was held that the placing of a single mark upon the corner of a square of a dozen dusters woven together, but afterwards cut up and hemmed separately, was not sufficient. For the result was that only one duster ultimately bore the mark "Regd," and the other eleven dusters went out to the public without any indication that they were the subject of a registered design. An article sold before it is completely finished must nevertheless be marked, if it is completed as far as the design is concerned.

Care should be taken to affix the mark to that part of the article to which the design is applied or at least to place it where it will not be misleading. In *Lea* v. *Price*

the registered design was for a lamp head to be attached to arc gas lamps. The registration mark was placed not on the lamp head at all, but on a metal ring at the base of the glass globe some little distance from the lamp head. It was held that the marking did not comply with the requirements of the Act. This decision is, however, balanced by two other decisions on the other side of the line. A butter dish consisting of two parts, the dish and the lid, was held to be sufficiently marked by being stamped only on the dish, though the registered design was confined to the lid. For without the dish the lid was useless (*Fielding* v. *Hawley*).

A similar point arose in the more recent case of *Ingram* v. *Edwards*. There the registered design was for an electrolier bracket. The objection was taken that the article was marked only on the "cup," a detachable part adjacent to the burner and not novel in design. The judge left it to the jury to say whether the bracket would be a complete article without the cup, and the jury finding that it would not, the objection was overruled.

The consequences of failure to comply with the statutory requirement as to marking are not now so serious as they were formerly. Whereas, prior to the Act of 1907, defective marking entailed forfeiture of the copyright in the design, now the only result is that the careless proprietor loses his right to recover damages for infringement or the penalty as the case may be. This rule is, however, relaxed if he can show that he took all proper steps to ensure the marking of the article, or if he can prove that infringement took place after the infringer had become aware of the existence of the copyright in the design. It has been held that to issue orders for the marking of the articles, without seeing that the orders were properly executed, was not taking "all proper steps" within the meaning of the Act. But where a proprietor had had the dies for stamping

the articles with the registration mark duly prepared and sent to his manufacturer in Germany, who accidentally used some other dies belonging to the same proprietor, the Court held that reasonable care had been taken.

Articles of registered design must be marked in the regulation manner even though they are destined solely for export and use abroad.

The Board of Trade is empowered to modify or dispense with the statutory requirements as to marking as regards any description of article, where such modification is shown to be expedient in the interests of any particular trade or identity.

Any person falsely describing as "registered" any design applied to an article sold by him is liable, on summary conviction, to a fine not exceeding £5 for every offence.

CHAPTER IV.

INFRINGEMENT.

Registration confers the exclusive privilege, during the period of copyright, of applying the registered design to any article or substance in the class in which it is registered, and every act done in contravention of this right constitutes an infringement. It should be observed that, according to the statutory definition of copyright, the monopoly is limited to the right to *apply* the design. Hence, but for the express provision in another part of the Act, the proprietor's right of redress would be only against the manufacturer, *i.e.*, the person who *applied* the design. To meet the obvious necessity of providing a remedy also against the *sale* of articles bearing a pirated design, the Act expressly includes in the category of infringer the vendor who sells or offers for sale the pirated article, knowing it to be an infringement. With this prefatory observation, it will be well to proceed straight to s. 60 of the Patents and Designs Act, 1907, which deals with the subject of infringement. The first part of the section must be quoted *verbatim*, as the wording is important.

"During the existence of copyright in any design it shall not be lawful for any person—

(*a*) For the purposes of sale, to apply or cause to be applied to any article, in any class of goods in which the design is registered, the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or,

(*b*) Knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale such article."

The latter part of the section states that any act done in contravention of this prohibition renders the offender liable to pay either damages or a penalty and to be restrained from further infringement by injunction.

Some comment is needed both as to *who is an infringer* and as to *what constitutes infringement* within the meaning of the above section.

(*a*) *Infringer.*—First, as to the infringer, it is to be noticed that the section is only concerned with piracy which results in, or aims at, the *sale* of the pirated article. The application of a pirated design to an article for the manufacturer's own use or delectation, though doubtless an infringement, does not expose the infringer to the pains and penalties of this section. There is further a clear differentiation between two classes of infringer: (*a*) the *manufacturer* who applies the design and (*b*) the *seller* who disposes of the article to which the pirated design has been applied.

Provided the manufacture is for purposes of sale, it is immaterial whether the manufacturer acted innocently or not. Experience has shown that, in nine cases out of ten, infringement of this kind is deliberate. Hence the law declines to accept the plea of ignorance. A prudent manufacturer, who is in doubt whether a design, which he desires to adopt, does not too closely resemble a design already registered, will apply to the Patent Office, submitting a specimen of the design proposed to be used, and obtain the opinion of the Comptroller on the question (Form Designs No. 21). The words "or do anything with a view to enable the design to be so applied," at the end of sub-section (*a*),

are doubtless introduced into the Act to meet the facts of a case like *Potter* v. *Braco de Prata Printing Co.*, for which no remedy was provided under the previous Act. In that case the plaintiff had registered a new design for printing calicoes. The defendants, adopting a similar design, manufactured the calico and engraved suitable printing rollers in this country, but the actual printing was done in Portugal. It was held that there was no actionable infringement.

With the seller, however, the case stands differently. It is not part of his business to enquire into the question whether the design applied to the goods supplied to him for sale is registered or not, or, if registered, whether it is applied with the sanction of the proprietor. The law, therefore, refuses to penalise a vendor unless it is shown that he was aware that he was infringing or unless, after being made aware of the fact, he continues to sell the pirated article. To bring the seller within the section, it must be proved that he had specific knowledge; and this may be difficult unless the proprietor takes steps to inform the seller of the fact that the design is applied without his consent. Accordingly, if the proprietor hears of the sale of articles pirating his design and there is reason to apprehend repetition of the infringement, he should at once notify the seller that he is infringing, mentioning the number of his registered design, and ask for an undertaking not to infringe in future. If the undertaking is refused, even though no further sales ensue immediately, an action for injunction may then be brought with a fair certainty, provided that the infringing character of the articles is proved, of getting an injunction and costs; whereas, if the writ is launched without previous warning, the plaintiff runs considerable risk, even though he gets his injunction, of being deprived of his costs.

But the Court discourages the bringing of actions where the infringement is of a trivial character, and where there is

no serious danger of the offence being repeated. Thus, in *Jan* v. *Grossman*, the defendant had purchased three infringing powder puffs, one of which he had sold to an unknown customer and another to the plaintiff, on which occasion he was informed for the first time that the puffs were an infringement. The defendant thereupon promised to sell no more and removed the third puff from his shop window. The plaintiff asked for a written undertaking not to infringe, which the defendant declined to give. The plaintiff accordingly commenced an action. No legal infringement could be proved, since at the time of sale the defendant was unaware that the design was registered. The judge, characterising the proceedings as trumpery, refused an injunction and dismissed the action with costs.

Apparently the purchaser or user of an article to which a pirated design has been applied, even though he has full knowledge of its illicit origin, is not liable under the section, or indeed guilty of any sort of infringement under the Act.

(*b*) *Infringement.*—The section quoted above mentions three kinds of imitation as constituting an infringement: an exact facsimile, a fraudulent imitation and an obvious imitation.

No comment is needed as to the first of these. The second, "fraudulent imitation," is applicable to the case of a man who knows a design to be registered and deliberately goes and imitates it; perhaps disguising his imitation under the cloak of specious differences. It must be distinguished from conscious imitation animated by the desire to improve upon an old pattern and produce something better on the same general lines.

In the absence of circumstances suggesting fraud, the imitation, to be actionable, must be "obvious." The question of similarity is for the eye alone, and must be determined by placing the designs side by side and asking whether they are substantially alike in all those essential

features wherein the novelty of the registered design resides. It is also relevant to consider whether they are so similar as to be mistaken one for the other when met with apart.

Contrasting the expressions "fraudulent imitation" and "obvious imitation," the inference to be drawn from the wording of the section seems to be this. Where the circumstances point to deliberate plagiarism on the part of the defendant, the burden of proving that the later design is not an imitation of the other is upon the defendant, and the Court will, in such a case, be more inclined to see identities than differences between the two designs. In other words, where a registered design has been chosen as a model upon which to form a new design, more pronounced originality and novelty may be required to be shown than where the similarity is purely accidental. In considering the question of infringement, attention must be focussed on those features of the registered design for which novelty is claimed, to the exclusion of such features as are old and commonplace.

In *Walker* v. *Scott*, the plaintiff had registered a design for a cyclist's tin oil can of oval shape, the feature of novelty being that the edges at the top and bottom were rounded off so that there were no sharp corners. The defendant manufactured an oil can of the same shape and general appearance, but with the edges left sharp. This was held to be no infringement.

A more recent case illustrating the same point is the Helter Skelter Tower case (*Staples* v. *Warwick*). The plaintiff's registered design consisted of a conical tower in the form of a lighthouse with a spiral slide wound round it, so that a person, seated or lying on a mat, could slide from top to bottom. The defendant constructed a tower with a precisely similar spiral slide, but instead of being in the form of a lighthouse it was in the form of a mediæval machicolated tower. Had the plaintiff been the first to

devise this particular variety of "giddy go-round," doubtless the defendant's tower would have been held to be an obvious imitation. It appeared, however, that the conical tower with a corkscrew slide round it was old. The Court, therefore, confining its attention to a comparison of the lighthouse and the mediæval fortress, held that there was no infringement.

These cases also illustrate the rule that, in determining the question of infringement, it is material to see what the state of knowledge was at the time when the design, alleged to be infringed, was registered.

It should be observed that the Act provides no remedy against piracy which consists in applying the registered design to articles *outside the registered class or classes*. Indeed, such a form of plagiarism is not an actionable infringement of copyright at all. Thus the somewhat paradoxical position arises, that a design which has been held devoid of novelty as applied to a particular substance, say china, in view of the prior registration of the same design applied to linen, may, nevertheless, be freely used without infringement because the two substances, china and linen, happen to fall in different classes.

The Remedies for Infringement.

When an offence under s. 60 has been committed, the proprietor of the design has the option of bringing an action either for damages or for the statutory penalty. The penalty recoverable is a sum not exceeding £50 for each offence, subject to the proviso that the total sum recoverable in respect of any one design shall not exceed £100. In determining whether he will ask for a penalty or for damages, the plaintiff must be guided by the circumstances of the case. If the infringement has caused him heavy loss and he can prove what his loss has been, he

should ask for damages. Damages, however, can only be recovered to the amount of such loss as can be proved. A penalty, on the other hand, is awarded quite irrespectively of the actual loss sustained, and will be heavy or light according to the conduct of the defendant. In cases of deliberate and persistent infringement, where the actual loss has not been large enough to warrant heavy damages, the plaintiff's best policy is to ask for the infliction of a penalty. In either case, a successful plaintiff is also entitled to an injunction against the repetition of the offence.

The person entitled to bring an action is the proprietor of the registered design; a licensee, therefore, as he falls within that category, can protect his own interests without the intervention of the licensor, provided his name is duly entered on the Register. But a mere agent for sale of the article bearing the registered design, even though his agency is exclusive, is not entitled to sue for infringement.

Tribunal.

An action for infringement of copyright in design may be brought in the County Court or in the High Court. In a clear case of infringement where the plaintiff sues for a penalty, or where the damage does not exceed £100, the cheaper and more expeditious machinery of the County Court will, as a rule, be found most convenient.

If the action is brought in the High Court, it is usually set down on the Chancery side, unless the parties desire the facts to be tried by a jury, in which case it will be entered in the King's Bench Division.

The Chancery Court of the County Palatine of Lancaster has concurrent jurisdiction with the High Court, and causes of action arising in the County Palatine will usually be dealt with by this Court.

An appeal lies in the ordinary way to the Court of Appeal,

and finally to the House of Lords. From a decision of a County Court judge the appeal is in the first instance to the Divisional Court.

The provisions of the Patents and Designs Act of 1907 are declared to extend to Scotland and Ireland, and the term "Court," as used in the Act, is defined as including the High Court in Ireland and any Lord Ordinary of the Court of Session in Scotland. These Courts have, therefore, equal competence with the English Courts in trying actions for infringement of design. The Irish Courts have, however, doubted their competence to entertain an application to rectify the Register.

Procedure.

The procedure in actions for infringement of design is modelled upon the procedure in patent actions. As soon as he has issued his writ, the plaintiff may apply for an interlocutory injunction to restrain infringement until the hearing of the action. Success in this application will depend upon the plaintiff making out a good *primâ facie* case. The defendant may escape being put under an injunction by undertaking to keep an account of the manufacture or sale of the articles alleged to be infringements.

The plaintiff must decide at the outset whether he will claim the statutory penalty or damages; he cannot leave it uncertain, nor can he claim both. The choice of remedy makes no difference in the procedure, except that, if the plaintiff sues for a penalty, he cannot compel the defendant to answer interrogatories tending to show that he has infringed.

In his defence, the defendant may rely on all grounds of invalidity that can be urged against the plaintiff's copyright. The Act of 1907 expressly provides that the fact of the design being used exclusively or mainly outside the

United Kingdom may be used as a defence to an action for infringement.

There is not the same scope for expert witnesses in a design action as there is in a patent action, but the evidence of one or two experts in the trade is, as a rule, useful to guide the judge's eye in comparing two designs and in distinguishing between what is old and new. Where the case is tried by jury, the question of identity, or fraudulent or obvious imitation, will be a matter for the jury to decide.

A successful plaintiff is entitled to damages or a penalty, whichever he has elected to ask for, and also to an injunction and delivery up of the infringing articles. The Court will grant a "certificate of validity," as in a patent action, where the plea of invalidity has been raised without success.

To protect the public against the annoyance of receiving threats of legal proceedings from proprietors of designs of questionable validity, the Act of 1907 provides the person intimidated in this manner with the same remedy that exists in the case of patents (see Part I., Chapter XIII.).

APPENDIX B.

TABLE 1.—DESIGN FORMS AND FEES.

Form	Proceeding	Fee. £	s.	d.
Form Designs No. 1.	—Authorisation			
,, No. 2.	—Application for registration of design, not being lace and except articles in Classes 13 to 15	0	5	0
,, No. 3.	—Application for registration of set of designs, not being lace	0	10	0
,, No. 4.	—Application for registration of a design to be applied to lace . . .	0	1	0
,, No. 5.	Application for registration of design to be applied to a set of lace articles .	0	2	0
,, No. 6.	—Application for entry of address for service in Register	0	1	0
,, No. 7.	—Request for statement of grounds of decision under Rule 33 . . .	0	5	0
,, No. 8.	—Extension of copyright for second period	1	0	0
,, No. 9.	—Application for extension of copyright for third period	0	10	0
,, No. 10.	—Extension of copyright for third period	1	10	0
,, No. 11.	—Joint request by registered proprietor and assignee, &c., to enter the name of assignee, &c., in the Register .	Same as registration fee.		
,, No. 12.	—Joint request by registered proprietor and assignee of design in Class 9 to enter the name of assignee in the Register			
,, No. 13.	—Request to enter name of subsequent proprietor, &c., in the Register under Rule 44	0	10	0
,, No. 14.	—Form of declaration in support of statement of case accompanying Form Designs No. 13	—		
,, No. 15.	—Form of application under Rule 49 to vacate entry of name of mortgagee or licensee in Register	0	1	0

DESIGN FORMS AND FEES (*continued*).

Form	Proceeding	Fee. £	s.	d.
Form Designs No. **16**.	—Form of application for alteration of address or address for service in Register	0	1	0
,, No. **17**.	—Form of request for correction of clerical error in application to register, or for correction of clerical error under s. 70	0	1	0
,, No. **18**.	—Form of application by registered proprietor to cancel entry in Register .	0	1	0
,, No. **19**.	—Request for search under s. 57 when registration number is supplied .	0	1	0
,, No. **20**.	—Request for search under s. 57 when registration number is not supplied	0	2	6
,, No. **21**.	—Request for search under Rule 60 .	0	2	6
,, No. **22**.	—Request for certificate for use in legal proceedings or other special purpose	0	5	0
,, No. **23**.	—Request for cancellation of registration under s. 58	1	0	0
,, No. **24**.	—Notice of intended exhibition of an unregistered design	0	5	0
,, No. **25**.	—Appeal from Comptroller to the Board of Trade	0	5	0
,, No. **26**.	—Request for the Register to be altered in pursuance of an Order of the Court	0	5	0
,, No. **27**.	—Application for copy of Certificate of Registration	0	1	0
Form D. O. No. **1**.	—Certificate of Registration . . .		—	
Designs (Manchester) No. **1**.	—Application for registration of design in Class 13 or Class 14 .	0	2	6
,, ,, No. **2**.	—Application for registration of a design in Class 15 . . .	0	1	0
,, ,, No. **3**.	—Notice to Keeper under Rule 87	0	2	6
Inspection of Register or design where inspection is permitted, except inspection under the second paragraph of s. 56 (1) of the Act, for each quarter of an hour .		0	1	0
Office copy of design . .	(cost according to agreement)		—	
For Office copy of documents, every 100 words . . .	(but never less than 1s.)	0	0	4
For certifying Office copies, MSS. or printed . . .		0	1	0

The fees to be paid on any proceeding at the Manchester Office are the same as for the similar proceeding at the London Office

TABLE 2.—CLASSIFICATION OF GOODS.

CLASS 1.—Articles composed wholly of metal or in which metal predominates, not included in Class 2.

CLASS 2.—Jewellery.

CLASS 3.—Articles composed wholly of wood, bone, ivory, papier maché, or other solid substances not included in other classes, or of materials in which such substances predominate.

CLASS 4.—Articles composed wholly of glass, earthenware, or porcelain, bricks, tiles, or cement, or in which such materials predominate.

CLASS 5.—Articles composed wholly of paper (except paper hangings), card-board, mill-board or straw-board, or in which such materials predominate.

CLASS 6.—Articles composed wholly of leather or in which leather predominates, and bookbinding of all materials.

CLASS 7.—Paper hangings.

CLASS 8.—Carpets and rugs in all materials, floorcloths, and oil-cloths.

CLASS 9.—Lace.

CLASS 10.—Hosiery.

CLASS 11.—Millinery and wearing apparel, including boots and shoes.

CLASS 12.—Ornamental needlework on muslin or other textile fabrics.

CLASS 13.—Printed or woven designs on textile piece goods (other than checks or stripes).

CLASS 14.—Printed or woven designs on handkerchiefs and shawls (other than checks or stripes).

CLASS 15. Printed or woven designs (on textile piece goods or on handkerchiefs or shawls) being checks or stripes.

CLASS 16.—Goods not included in other classes.

PART III.

TRADE MARKS.

INTRODUCTION.

Though it has been the custom from earliest times for merchants to distinguish the goods of their own manufacture from those of their rivals by affixing to them some special symbol or device, by way of trade mark, it is only since a comparatively recent date that an exclusive right to a particular trade mark has come to be recognised by the Courts as *property* capable of being legally protected against infringement; and only within the last 50 years that this right has obtained statutory recognition, and the use of trade marks been made the subject of legislative enactment. This is all the more surprising in view of the early attention bestowed by the Legislature upon two other important species of "intellectual" property, viz. patents and literary copyright. More than a hundred years after the famous Statute of Monopolies (1624) and eight years after the passing of the first Copyright Act (1734) we find Lord Hardwicke, the then Lord Chancellor, refusing to grant an injunction at the suit of a maker of playing cards, to restrain the defendant from manufacturing and selling cards bearing the counterfeit of the plaintiff's mark, on the ground, amongst others, that he knew of no instance of the granting of an injunction to restrain one trader from

using the same mark as another, and that to impose such restraint would be fraught with mischievous consequence. This observation, however, he qualifies by the remark that if it were done with fraudulent design or to draw away customers from the rival trader, whose mark is thus appropriated, that might be sufficient to maintain an action.

In the earliest authentic instance of a successful attempt to restrain trade mark piracy, the case of *Sykes* v. *Sykes* in 1824, we find that fraud was made the basis of the action. Deceit and fraudulent misrepresentation were causes of action well known to the Common Law, and this was presumably the form of action most nearly suited to the circumstances of this case. For, at a time in the development of our egal system, when forms of action were stereotyped and their number strictly limited, the complaint had, perforce, to be framed to fit the action instead of, as now, the action framed to suit the complaint. If, therefore, the merchant, despoiled of his trade mark, could not bring his grievance under the head of fraud, there was no other form of action available at Common Law. The Courts of Chancery also exercised a concurrent jurisdiction in cases of this kind, and their ability to grant an injunction restraining the continuance of a fraud proved a very valuable supplement to the award of damages, the only form of redress obtainable at that time in the Common Law Courts. But even the Chancery judges for a while retained the doctrine that fraudulent intention was a necessary ingredient in an action for infringement of trade mark, and refused to grant an injunction unless the plaintiff first proved his case in the Common Law Courts. Gradually, however, the view gained ground that the owner of a trade mark has a genuine *proprietary* interest in his mark which he is entitled to have protected against invasion and infringement like any other right of property. The case of

Millington v. *Fox*, decided in 1834, definitely established the principle that a trader has a good right of action against any person who wrongfully assumes his trade mark, even in the absence of proof of fraudulent intent. The decision of this case signalises the full recognition, at least in the Chancery Courts, of trade marks as property capable of legal protection.

The fusion of the principles of Common Law and Equity, effected by the Judicature Act of 1873, brought the Common Law Courts into line with the Chancery ; so that in the Common Law action, which still survives under the name of a "passing off" action, the plaintiff is no longer required to prove fraud, but merely that the "get up" of the defendant's goods actually did mislead, or was calculated to mislead, the public into believing them to be the goods of the plaintiff's manufacture.

The proprietary right of a trader to the exclusive use of his particular mark having been judicially recognised, the next step was to provide adequate means for its protection. Infringement was very rife, particularly through the importation of spuriously marked goods from abroad. But the extreme costliness of the procedure entailed by the Common Law action and the uncertainty of success except in the clearest cases discouraged the public from invoking the aid of the Courts. For, in order to prove his case, the plaintiff in an action for infringement of trade mark had, in the first place, to show that his mark had acquired a public reputation, and that goods bearing it were associated in the public mind with goods of the plaintiff's manufacture as distinct from those of all other manufacturers. To prove this, it was necessary to summon a cloud of witnesses and array a mass of evidence, the cost of which usually devolved upon the plaintiff, even though he were successful, since in most cases the infringers were mere men of straw. That this burden should be put upon traders seeking to

protect their legitimate rights was naturally felt to be a great hardship and evoked loud complaint from the mercantile community. A Parliamentary Commission was summoned in 1862, to consider the amendment of the law with a view to remedying these grievances. The outcome of their report was the passing of the Merchandise Marks Act of 1862 and later the Trade Marks Registration Act of 1875. The object of the first Act was to arm the Courts with summary jurisdiction to deal with the grosser forms of trade mark piracy, such as the deliberate forgery of a mark, and to make certain other fraudulent dealings with trade marks punishable as criminal offences. This Act was amended by the Merchandise Marks Act of 1887 which, as amended by the Acts of 1891 and 1894, still remains in force.

The Trade Marks Registration Act of 1875 introduced a new era in the history of trade mark law, and the principles which it formulated have, in the main, been adhered to up to the present day.

The object of this Act was two-fold. It was designed to afford protection to the trader on the one hand, and to the public on the other, against the abuse of trade mark rights. A register of trade marks was established and placed under the control of the Commissioner, afterwards the Comptroller, of Patents. Registration was not obligatory, but it was made a condition precedent to the bringing of an action for infringement of trade mark. The appearance of a trade mark on the register was accepted as presumptive evidence of the right of the registered owner to the exclusive use of that mark upon the goods in respect of which it was registered; and, after 5 years, registration was treated as conclusive evidence of the registered owner's title to his trade mark. This relieved the plaintiff in an action for infringement of trade mark from the necessity he had previously been under of first proving his exclusive title to the trade mark in

question. In the interest of the public, on the other hand, the Act required the publication of all registered trade marks and their definite appropriation to certain classes of goods, so that any member of the public might know, by inspecting the register, the precise features and scope of any particular trade mark for which an exclusive right of use was claimed.

All trade marks, however, were not admitted to the register. To be capable of registration the Act required that the mark should possess certain "essential particulars." Precisely what these "essential particulars" were is now unimportant, since they have undergone modification in subsequent Statutes; but it should be observed that there was one serious flaw in the catalogue of registrable trade marks, which greatly detracted from the value of the new Act to the commercial community. It excluded from registration all marks consisting of "fancy names" or, as they are more generically termed, "word-marks"—a species of trade mark which has always been exceedingly popular and extensively used. An exception was, however, made in favour of word-marks which had been used prior to the passing of the Act.

The aim of the Act was to limit, for the future, the kind of trade mark in respect of which exclusive rights could be acquired; but, in discountenancing the use of word-marks, the Legislature had gone too far. No sooner had the Act come into force than its framers perceived that it shut out from protection numerous traders who had already acquired valuable rights in marks, devoid of the prescribed "essential particulars" and therefore incapable of registration. To remove this injustice, a short Act was passed in the following year to the effect that owners of old marks, registration of which was refused, might upon satisfactory proof of title obtain a certificate of refusal which placed them practically in the same position as regards the

institution of proceedings for infringement as if their mark had been registered. The removal of the ban upon the registration of new word-marks was not effected till 1883.

The Act of 1875 has been dealt with at some length because its provisions, though long since repealed, embody the principles and plan which have, with comparatively minor modifications, formed the basis of all later legislation.

The subsequent amendments of the law may be treated in a more summary manner. The Patents, Designs and Trade Marks Act of 1883 repealed the Act of 1875, but re-enacted it again without substantial alteration beyond sanctioning the registration of trade marks consisting of "fancy words" or words not in common use, but geographical names and words describing or commending the quality of goods were expressly barred from registration.

Desirable as was the amendment of the Act of 1875 in regard to the qualified admission of word-marks, the phraseology chosen could not have been more unfortunate. The Courts were driven to despair in their endeavours to agree upon a definite meaning to be attached to the expression "fancy word." Ultimately it was decided that the word must be "obviously meaningless" to the average Englishman, and that it must be "notoriously inappropriate" to the character of the goods. Words containing the slightest glimmering of a meaning were rejected as either descriptive or deceptive. "Bovril" passed muster, but "Triticumina," as applied to wheat meal bread and biscuits, was rejected as descriptive.

An amending Act of 1888 abolished this troublesome phrase and substituted for it "an invented word or invented words." But this change did not much improve matters, at any rate for a while. For, following the previous decisions, the Courts still adhered to the view that the "invented word" must be a word having no reference to the character

or quality of the goods. Thus, such words as "Emolliolorum" as applied to harness paste, "Satinine" as applied to starch and soap, and "Electrozone" as applied to electrically treated chemical substances, were held to be descriptive. The "Somatose" case (*Farbenfabriken Application*) may be quoted as an illustration of the absurd length to which this view was pushed. The word "Somatose" was sought to be registered as applied to a new extract of meat. Registration was refused and the decision of the Comptroller was upheld by Mr. Justice North, who considered the word descriptive "in that it had reference to the applicability of the goods to the human body"; "Somatose" being, so it was alleged, suggestive of "sōmatos," the genitive case of the Greek word for "body." Things had come to such a pass that it was hard indeed to find any "invented word" that would be proof against the discovery of some covert allusion or hidden meaning sufficient to destroy its registrability. Fortunately, at this juncture, the House of Lords was called upon, in the famous "Solio" case, to interpret the meaning of this much canvassed expression. The Eastman Photographic Company sought to register the word "Solio" in connection with photographic printing. The Comptroller refused to register the word, on the ground of its supposed derivation from "Sol" (Sun), and his decision was affirmed by the Court of First Instance and the Court of Appeal. Undeterred, however, the applicants appealed to the House of Lords. The appeal succeeded, and their Lordships ordered the registration of the word, holding that "Solio" was clearly an "invented word" within the meaning of the Act. Several of the earlier cases were reviewed and disapproved, and the principle was laid down that, provided the trade mark was a newly coined and genuinely invented word, the requirement of the Statute was fulfilled, and it was no objection to a word that it might be traced to a foreign

origin or contain a covert or skilful allusion to the character and quality of the goods.

This decision re-opened the register to a large number of word-marks which, had the trend of previous decisions remained unchecked, would undoubtedly have been excluded. But in spite of this, there were still a great many valuable trade marks disqualified from registration by the existing law. The statutory restriction placed upon the registration of word-marks was designed to counteract any attempt to monopolise the use of words which are essentially common property and which everybody has an equal right to use. "There is a perpetual struggle going on," said Lord Justice Fry, "to enclose and appropriate certain little strips of the great open common of the English language." In endeavouring to combat this tendency, the Legislature had prescribed a test which was by no means infallible in distinguishing between trade marks suitable and unsuitable for registration. Consequently, many widely used and recognised trade marks were excluded. To protect these from piracy the trader had to fall back upon the Common Law action against the infringer for "passing off his goods as and for the goods of the plaintiff": or else he could have recourse, if the circumstances justified it, to proceedings under the Merchandise Marks Act of 1887. In either case he was put to the expense of proving the reputation of his mark.

Moreover, in other respects also the working of the Trade Marks Acts proved unsatisfactory. The practice had grown up of requiring the applicant for registration of a trade mark to *disclaim* everything except the "essential particular" of the mark. This was injurious to the applicant in two ways. The effect of such a disclaimer was held to be that the applicant lost all exclusive right to use the matter disclaimed notwithstanding that it had come to be associated in the public mind with goods of his manufacture.

Even in a "passing off" action the plaintiff was debarred from urging an exclusive claim to matter he had been obliged to disclaim for purposes of registration.

The refusal by the English Office to register a trade mark without the insertion of a disclaimer had also an injurious effect upon applications to register the same mark in foreign countries, and was made the ground of refusal to register such marks although they might be, and not infrequently were, registered afterwards upon the application of a rival trader.

Another serious drawback in the existing state of the law was the liability to which traders were exposed of having their marks struck off the register even after the lapse of 5 years, on the ground that at the time of registration the mark failed to comply with the requirements of the Statute. Section 76 of the Act of 1883 declared, in what at the time appeared to be unequivocal language, that, after 5 years, registration should be conclusive evidence of the registered owner's right to the exclusive use of the trade mark. Nevertheless the Courts succeeded, with strange perversity, in interpreting this to mean that registration, after 5 years, was conclusive evidence of his right only so long as his mark remained on the register, but that it did not debar any "aggrieved" member of the public from applying, even after the expiry of 5 years, to expunge the mark from the register on the ground that it had been improperly registered in the first instance.

The Trade Marks Act of 1905 deals with all these points. With the object of allowing the public greater latitude in the choice of a registrable trade mark, it has slightly remodelled the list of "essential particulars," so that it now admits to the register every mark deserving registration; that is, every mark which is in fact used or can be used as an honest and effective trade mark. It modifies

the practice with regard to disclaimers and introduces a clause giving the proprietor of a trade mark that has been registered for 7 years absolute security against attack on the ground of initial defect in the registration of the mark. In addition to these changes there are various other salutary amendments of a minor character which will be alluded to in due course. The Act is a comprehensive one. It is an attempt to codify the entire civil law dealing with trade marks. The only section of the law which it does not embrace is that relating to the protection of trade marks under the International Convention. It was found impossible to transplant this from its old setting in s. 103 of the Patents, Designs and Trade Marks Act of 1883 (now s. 91 of the Patents and Designs Act, 1907, and it consequently remains there). With this one exception, however, the whole of trade mark law is now to be found in the Act of 1905, and all the provisions relating to trade marks in preceding Acts (except the Merchandise Marks Acts) are accordingly repealed.

Though the statutory connection between trade marks and patents has been severed, the registration of trade marks still forms an important branch of the work discharged by the Patent Office and remains under the direct supervision of the Comptroller-General. It should be added that where reference is made to this official in the following pages, he will usually be designated by his statutory title of "Registrar."

CHAPTER I.

MEANING OF TRADE MARK.

THE habitual association of trade marks with letters patent, as kindred topics, suggests perhaps a closer affinity between these subjects than in reality exists. Indeed, from a legal point of view, trade marks have but little in common with patents. Both, it is true, confer monopolies; but with that the likeness begins and ends. In other respects a comparison between these two species of monopoly is marked rather by contrasts than by analogies.

A patent monopoly is based upon the material and inherent character of the patented article by whomsoever manufactured or sold; a trade mark, on the other hand, has a purely personal significance and denotes only that the goods are manufactured or sold by some particular person or persons: whenever it comes, as by usage it sometimes does, to signify the goods themselves irrespective of their origin, it ceases at once to be an effective trade mark. Registration of a trade mark is not, like a patent, granted as a reward of merit. The public derive no benefit from it beyond the assurance which it conveys that the proprietor of the mark is responsible for the quality of the goods to which it is applied. But a trade mark is not in any sense a guarantee of quality; it warrants neither excellence nor uniformity. A man who buys goods bearing a certain mark which he has been accustomed to associate with first rate quality, has no actionable grievance against the vendor, if the goods turn out to be of inferior quality. No doubt, in practice, a trade mark comes to be regarded

by the public and is generally treated as a guarantee that the quality is up to a certain standard, but it should be remembered that that is a purely gratuitous assumption, and if the public act upon it, they do so at their own risk.

The monopoly granted by a patent has a strictly limited duration; but the monopoly secured by a trade mark continues so long as the trader is minded to keep up its registration, or so long as he has skill and industry to keep his mark before the public as the symbol of his manufacture.

Finally, in the case of a patent, it is registration, in the shape of the patent grant, that actually confers the monopoly; without it the inventor has no legal right to the exclusive use of his invention. But registration of a trade mark on the other hand is, in a large number of cases, nothing more than the official endorsement of a right already existing and created by dint of public user of the mark. It is in the nature of collateral security, furnishing the trader with a cheaper and more direct remedy against infringers. Cancel the registration, and he has still his right, enforceable at Common Law, to restrain the piracy of his trade mark, provided, of course, he can prove that such piracy amounts to an imposition upon the public.

The foregoing comparison serves to indicate broadly the general nature and function of trade marks. For an accurate definition we may turn to the third section of the Trade Marks Act of 1905.

After premising that a "mark" shall include a "device, brand, heading, label, ticket, name signature, word, letter, numeral, or any combination thereof," the Act proceeds to define a trade mark as—

> "A mark used or proposed to be used upon or in connection with goods for the purpose of indicating that they are the goods of the proprietor of such trade mark by virtue of manufacture, selection certification, dealing with or offering for sale."

This definition (the first attempt of the Legislature to define a trade mark, crystallises into comparatively simple and definite shape the effect of the numerous cases in which the legitimate scope and character of a registrable trade mark have been judicially determined. Simple and precise though the language be, it requires, nevertheless, a little expansion and analysis to explain its full significance.

In the first place it is to be observed that actual use of a trade mark or at least a *bonâ fide* intention to use it in connection with certain definite goods continues to be, as it always has been, the only legitimate basis and justification of admission to the Register. By way of introduction to this proposition it should perhaps have been explained that, for the purpose of registration, merchantable goods are arranged in various classes, some 50 in number; and an applicant for registration is required to specify the class, or, if the class is large and miscellaneous, the particular *description* of goods in respect of which he desires to register his mark. This classification is designed to correspond approximately to the conventional grouping of commodities in commerce, whilst at the same time the classes are made as comprehensive as possible, in order to avoid multiplicity of registration. But, like all methods of classification, it has its defects. A glance at the various classes shows at once that there is considerable overlapping, necessitating in many cases the registration of a trade mark for the same commodity in two or more classes. Thus, for instance, a trade mark for a new effervescing powder possessing medicinal as well as nutritious properties would have to be registered in Class 3, viz., "Chemical substances prepared for use in medicine and pharmacy," as well as in the Food Class.

The proprietor of a trade mark registered in a particular class is not entitled to the exclusive use of the mark in respect of all goods comprised in the class, simply because

he has registered the mark for the whole class without discrimination. To substantiate his claim, he must show actual user. If in fact the mark is used only in connection with a small group of the goods falling within a multifarious class, it becomes an encumbrance on the Register, and any person hampered by it may apply to have it removed or the registration confined to the goods actually traded in. Thus, in the case of *Hart's Trade Mark*, a trader had registered a Red Rose Device for the whole of Class 42, that is for "Substances used as food or ingredients in food," but had in practice only used the mark for part of the class and not for condensed milk, which he had dealt in under different marks. Another trader, who had for some time been using the same device in connection with condensed milk, subsequently applied to register it. On being refused, on the ground that the mark was already registered for the whole of Class 42, he applied to the Court to have this obstructive mark expunged, or limited so as to exclude condensed milk. The Court decided that the registered mark must be limited in the way desired, and that the applicant was entitled to have his mark entered on the Register in respect of condensed milk.

In the absence of actual user, a *bonâ fide* intention to use the mark in respect of the goods in question is essential to the validity of the registration. In the case of a new trade mark tendered for registration, an intention to use will ordinarily be presumed. If, however, it is proved that the applicant does not in fact intend to use the mark himself in the way of trade, but only for the purpose of obstructing others from using it, registration may be refused or, if allowed, may be subsequently impugned.

The registration of the words "Hunyadi Janos" by the Apollinaris Co. may be cited as a case in point. This mark was the property of Mr. Saxlehner, the owner of the spring from which "Hunyadi Janos" water came. In

order to prevent the importation into England of mineral water labelled with this mark, the Apollinaris Co., with the assent of Mr. Saxlehner, registered the words "Hunyadi Janos" in England as their own trade mark. They did not use, nor did they intend to use, the label themselves. It was held that the registration was improper and must be expunged (*Apollinaris Co.'s Trade Mark*).

By s. 37 of the Act of 1905, any person "aggrieved" may apply to have a registered mark removed from the Register on the ground that it was registered without any *bonâ fide* intention to use it, or on the ground that it has not in fact been used in connection with the goods for which it was registered during the five years immediately preceding the application. The registered owner may, however, save his mark if he can adduce reasons justifying such non-user.

The statutory definition of a trade mark postulates further that the trade mark must be used "upon or in connection with" the goods. Mere association of goods with a particular mark is not sufficient; to draw the definition as wide as that would involve the inclusion of advertisements, trade circulars and the like within the category of trade marks. The connection between a trade mark and the goods to which it is applied must be exceedingly intimate. Strictly speaking, the mark should be physically attached or affixed to the goods themselves, for example by being impressed or branded upon them or attached in the form of a label, tally or wrapper. The important point is that the mark should go to the market with the goods, that it should be upon them when they come under the purchaser's eye, so that he may identify them as coming from a particular trade source.

The question, how close the connection between goods and trade mark must be, has occasioned considerable controversy in the Courts. A good illustration is afforded

by the "Yorkshire Relish" case (*In re Powell's Trade Mark*). In that case the manufacturers of the well-known sauce had been in the habit of stencilling the words "Yorkshire Relish" on the four sides of the large wooden packing cases containing the bottles. The bottles themselves also bore distinctive labels with a different mark. The question raised was whether this use of the words "Yorkshire Relish" constituted a user of the words as a trade mark. The Courts held that it did not, the ground of their decision being that it was not the words on the packing case that sold the goods but the mark on the bottles. Whatever might be the result, were these facts to be retried with reference to the definition contained in the Act of 1905, it is clear that the same principle applied to the use of a branded packing case in connection with goods of another kind might well lead to an entirely different conclusion. For instance, the use of a distinctive mark upon a case containing fruit or tobacco would, beyond doubt, be a use of the mark "in connection with" the goods within the meaning of the statutory definition.

A trade mark may consist of several physically separated parts, the registration covering only the entire combination. The component parts of the trade mark must, however, all be used together, though they need not necessarily be connected or even visible at the same time. Thus, in *Crompton & Co.'s Trade Mark*, the registered mark consisted of three different sized labels, used by pasting the largest and smallest on different sides of the outside wrappers of bundles of yarn and the medium label on the inside wrappers. This was held to be a legitimate method of using the mark.

The inclusion of marks of certification in the category of trade marks also deserves note. Prior to 1906, the name "trade mark" was applicable only to marks affixed to goods *traded in by the person affixing the mark:* it might be

the manufacturer, the retailer, the selector or any other person dealing with the goods in the way of trade. The Act of 1905, however, authorises the registration, subject to the approval of the Board of Trade, of certain special marks, which are not trade marks in the above sense, but are marks used by persons or associations who undertake the analysis or standardization of goods submitted to them, without having any commercial interest in the articles themselves. As an instance of such a mark might be cited the monogram "N." signifying that the goods have been analysed or standardized by the National Physical Laboratory at Teddington, or the letters "L.R." used upon shipbuilding materials to denote that they have been passed by Lloyd's surveyors.

So much for the statutory definition. There is, however, one important attribute, omitted from the definition, which a mark must nevertheless possess in addition to those already mentioned, in order to be effective as a trade mark, and that is *distinctiveness*. A trade mark must distinguish or be capable of distinguishing the goods of the owner of the mark from the goods of all others. It must not be of such a character as to lend itself to confusion with somebody else's trade mark, or to encroachment upon the rights of the public generally. In other words, no person may lay claim to an exclusive right in a mark which will clash with a mark already appropriated by another, or which tends to monopolise words or symbols that may fairly be reckoned as public property and therefore unbefitting individual appropriation.

Recognising the necessity of safeguarding the rights of the public in this respect, the Legislature has, ever since the first Trade Marks Registration Act of 1875, laid it down as a condition of registration that a trade mark must possess certain distinctive characteristics, termed in the Act "essential particulars," of which at least one must be

present to qualify the mark for registration. The list of "essential particulars," prescribed by the earlier Acts, has undergone no radical alteration in the Act of 1905. Such changes as have been introduced have all been made either with the object of clearer definition or of enlarging the "area of registration," so as to admit to the Register as nearly as possible all marks which are in fact distinctive and effective trade marks.

Since, for the adequate protection of a new mark, registration is of the utmost importance, it is very necessary, in selecting a mark, to see at the outset that it possesses the requisite characteristics to qualify it for registration. This point is frequently overlooked, with the consequence that traders, who have gone to considerable expense in advertising and creating a market for their goods under some newly invented trade mark, discover upon subsequently applying to register it that it cannot be registered, either because it fails to comply with the provisions of s. 9 of the Act, that is to say, it is deficient in some "essential particular," or because it too nearly resembles some mark already upon the Register. To avert the risk of refusal on the latter score, an applicant can easily take the precaution of searching the Register himself or of having an official search made (see p. 320).

To obtain a thorough grasp of the conditions with which a trade mark must comply in order to be proof against objection under s. 9 is, however, not quite so simple a matter. This is a fundamental section and will require somewhat detailed discussion; it will, therefore, be best to defer its consideration for a separate chapter.

CHAPTER II.

QUALIFICATION FOR REGISTRATION.

SECTION 9 of the Trade Marks Act of 1905 provides that a registrable trade mark must contain or consist of at least *one* of the following essential particulars:—

(1) The name of a company, individual or firm represented in a special or particular manner.

(2) The signature of the applicant for registration or some predecessor in his business.

(3) An invented word or invented words.

(4) A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or surname.

(5) Any other distinctive mark; but a name, signature or word or words other than such as fall within the descriptions in the above paragraphs (1), (2), (3) and (4), shall not, except by order of the Board of Trade or the Court, be deemed a distinctive mark.

Provided always that any special or distinctive word or words, letter, numeral or combination of letters or numerals, used as a trade mark by the applicant or his predecessors in business before the thirteenth day of August, 1875, which has continued to be used (either in its original form or with additions or alterations not substantially affecting the identity of the same) down to the date of the application for registration, shall be registrable as a trade mark under this Act.

For the purpose of discussion it will be convenient to take this section in detail, dealing with the sub-sections in order.

(1) The Name of a Company, Individual, or Firm Represented in a Special or Particular Manner.

This sub-section requires little comment. It should be observed however, that it is not permissible to register under this head the name of a fictitious or mythological person as the name of an "individual." Thus "Trilby" has been held not to be a name within the meaning of the sub-section, and such names as "Hamlet," "Jupiter" and "Venus" would similarly be inadmissible in this category of trade mark; but there is no reason why they should not be registered as "words" under sub-s. (4) provided they are neither descriptive nor geographical. Further, the name should be registered in the nominative case. Under the old sub-section (from which the new sub-section does not materially differ) the Courts held that the registration of a name in the possessive case, *e.g.*, "Pirie's Parchment Bank," was bad.

The applicant is not limited to his own name; but if he seeks to register the name of some well-known person, living or recently deceased, the Registrar usually requires to be satisfied that the proper consent has been obtained before allowing the registration to proceed.

The name may be printed, woven or impressed; but the lettering must be distinctive; ordinary typographic printing or even common fonts of ornamental type will not be so considered.

(2) The Signature of the Applicant for Registration or some Predecessor in His Business.

This "essential particular" is merely a specialised form of the preceding one. The signature must be that actually

used, as the *bonâ fide* trading style, in the ordinary course of business. Descriptive trading styles such as the "Millenium Baking Coy." or the "Anti-Corpulency Soap Syndicate" will not be accepted. But these names, if represented in a "special and particular manner," could, of course, be registered under sub-s. (1).

A signature has always been a popular form of trade mark. But, unless its characters are unusually bold and fantastic, the margin or protection it gives is narrow. For the exclusive right conferred by registration is confined to the use of the name solely in the distinctive form in which it is registered, and other persons bearing the same name are equally entitled to come and register their signatures as trade marks. If, therefore, Mr. Brown or Mr. Jones relies upon his autograph for a trade mark, he is likely to find it very inadequate security.

Generally speaking, every man has a right to use his own name in connection with his business. But this proposition cannot be allowed to pass without qualification. For instance, where a man uses his own name or assumes somebody else's name for the purpose of trading upon another's reputation and dishonestly profiting by the goodwill of another's business, the law will interfere to stop this abuse. Thus, to take an old case, where a man named Martin associated himself with a person named Day for the purpose of carrying on business as manufacturers and vendors of boot blacking, manifestly with the object of trading upon the reputation of the old-established firm of Day & Martin, they were restrained by injunction from so doing.

The Courts grant this relief, quite apart from any right the plaintiff may have under the Trade Marks Act, acting upon the well-known principle that no man has a right to represent or "pass off" his goods as the goods of another; and whether the public are deceived by the name of the

vendor or by the "get up" of the goods is immaterial as affecting the principle.

More recent examples of the application of this principle are to be found in *Valentine Meat Extract Co.* v. *Valentine Extract Co., Ltd.*, and *J. & J. Cash, Ltd.* v. *Joseph Cash & Co.* In the former case, the defendant company (one of the directors of which bore the name Valentine) was absolutely restrained by injunction from using the name "Valentine" in connection with extract of meat. In the latter case, in view of the evidence that to the ordinary purchaser "Cash's Frillings" meant the plaintiffs' goods, the defendant was restrained from selling frillings under the name "Joseph Cash & Co.," without taking reasonable precautions to clearly distinguish his business and frillings from those of the plaintiffs.

(3) An Invented Word or Invented Words.

The history of the controversy that has raged round the interpretation of the expression "invented word" and its predecessor "fancy word" has been briefly sketched in the introductory chapter. Having reached a point of hypercriticism at which it was impossible to predicate of any word that it was an "invented word" within the meaning of the Act, the trend of judicial decisions was opportunely turned by the decision of the House of Lords in the "Solio" case (*Eastman Photographic Materials Co.'s Application*). The principles laid down in that case govern the interpretation to be placed upon the expression "invented word" in this sub-section.

The word must be one hitherto unknown to the English vocabulary and not occurring at any rate in the more commonly understood foreign languages. The fact, however, that the root or one or more syllables of the word may be recognisable as English or foreign words will not

disqualify the word; but there must be some genuine invention about it. A mere variation in the orthography or termination of a word will not do. For example, "Panoram" as applied to photographic cameras and films, and "Absorbine" as applied to absorbent ointment, were held not to be genuinely "invented words."

The coalition of two or more well-known words into a single portmanteau word, such as "Cheapandgood," does not constitute an "invented word"; and misspelling does not improve the case, if to the ear the words are still merely common words run together. Thus the word "Uneeda" was held not to be an "invented word"; and similarly "Phiteesi" would not comply with the requirements of the sub-section. But a combination of words from a foreign language, so little known in this country as to be meaningless to all but a few scholars, would probably pass muster as an "invented word." Thus, "Mazawattee" (*In re Densham's Trade Mark*) was held to be properly registrable, though both "maza" and "wattee" are well-known words in Hindustani and Cingalese respectively.

The word should be newly coined at the date when it is adopted as a trade mark: it need not, however, necessarily be the invention of the applicant. The following are examples of words upheld by the Courts as "invented words": *Kynite*, for explosives: *Tachytype*, for typographical machines: *Neostyle*, for stationery: *Kodak*, for cameras. Examples of words expunged as not falling within this sub-section or its prototypes are:— *Somatose*, for an extract of meat: *Perle*, for cloth: *Satinine*, for starch and soap: *Panoram*, for cameras: *Bioscope*, for cinematograph apparatus; but the last-named was disqualified on the ground that it was not new when first used by the applicant as a trade mark.

(4) **A Word or Words having no Direct Reference to the Character or Quality of the Goods, and not being according to its Ordinary Signification a Geographical Name or a Surname.**

It is obvious that if words descriptive or commendatory of the quality of the goods were allowed to be registered as trade marks, the rights of the public might be very seriously abridged. For example, to take a gross case, it would be manifestly unfair to the rest of the commercial community if any one person were allowed to monopolise the word "best" as applied to butter, or "fresh" as applied to eggs. But it is not only in the case of such obviously descriptive or encomiastic phrases as these that registration has been refused in the past. Construing the wording of the old sub-section, "having no reference to," in the strictest possible sense, the Courts were astute to disqualify many words as being descriptive which to the ordinary lay mind can at most be regarded as remotely allusive, and then only by putting upon them a somewhat strained and far-fetched interpretation.

Thus "John Bull," as applied to beer, was held by the Court of First Instance to be a mark having reference to the character and quality of the goods, the allusion being extracted in the following somewhat circuitous manner. After referring to the Century Dictionary, which explains the name as denoting "the coarse burly form and bluff nature ascribed to the typical Englishman," the judge observed: "without going further, you at once have some description or designation of the article, either that it is made in England or that its character is that which suits Englishmen." In more recent times, the Court has refused to sanction the registration of "Nectar" as applied to tea; and "Century," as applied to printing machinery, has been held to be disqualified, as being a commendatory phrase

importing that the article was the best made in the century. The introduction into the Act of 1905 of the qualified expression "having no *direct* reference" is clearly designed to counteract the overstringent tendency of previous decisions and to inaugurate a somewhat milder censorship over this class of trade mark.

The principle of refusing to allow anyone to acquire by registration the exclusive right to use a geographical name as a trade mark is obviously reasonable. To permit a boot-maker, for instance, to register the name "Northampton" as his trade mark and so prevent any competitor in that locality from using the name "Northampton" in connection with his goods would be a manifest encroachment upon the just rights of the latter and a limitation upon the freedom of trade. But where the name is adopted and used without any geographical significance, it will not be disqualified merely because it happens to be the name of a coral reef in the Pacific Ocean or a peak of the Himalayas. There could be no possible objection, for example, to "Sahara" stoves, or to a tobacconist registering "Matterhorn" or "Monte Rosa" cigarettes. "St. Paul's" as applied to soap has been held not to be geographical, and "Magnolia" as applied to a new antifriction metal, though objectionable on other grounds, was held not to be disqualified by the fact that there were several obscure places in America bearing that name. But the mere obscurity of the place cannot be pleaded in defence of the trade mark if the name is really a local name, and chosen because of the connection of the article with the locality. An instance of this is to be found in the case of the word "Apollinaris" given to the water from a spring known as the Apollinaris spring.

It sometimes happens that a name, not originally descriptive, acquires in course of time a secondary meaning and becomes the ordinary appellation of the goods to which it is applied. A classic instance of this is furnished by the

"Linoleum" case (*Linoleum Co.* v. *Nairn*). The word "Linoleum" was coined by the inventor to designate a new kind of oilcloth. The invention was patented. Upon the expiry of the patent, the assignees of the inventor's rights strove to retain a monopoly of the word. It was held, however, that "Linoleum" was the only name by which that particular kind of floorcloth was known, and consequently, the word being descriptive, no claim to its exclusive use could be maintained.

Similarly in the "Magnolia" case, alluded to above, the Court of Appeal refused to allow the ex-patentees to monopolise the name "Magnolia" after the expiration of the patent, and laid down the general principle that "when an article is made under a patent or a secret process, the manufacturer cannot, after the patent has expired or the secret process been discovered, claim a monopoly in a name which does not distinguish the article as being of his manufacture." Other instances of a similar kind of expropriation have occurred in the case of the names "Singer," as applied to sewing machines, and "Dunlop," as applied to pneumatic tyres. But where a person invents a new article and at the same time invents a new name to designate it, but does not patent it or keep the process secret, so that others are at liberty to manufacture the same article under any name they choose, it is doubtful whether the above rule would apply to preclude the inventor from establishing a monopoly in the word and registering it as his trade mark.

These were, in substance, the facts in the "Vaseline" case (*In re Chesebrough's Trade Mark*); with this difference, that before applying to register the name, the inventor had already established a reputation as sole manufacturer of "Vaseline," and though the same material was sold under other names, such as "petroleum jelly," "unguentum petrolei" and the like, his was the only manufacture desig-

nated by the word of his own invention. In view of these facts, the Court of Appeal held the word "Vaseline" to be properly registered as a trade mark. The decision was, however, the other way in the somewhat analogous case of *Leonard & Ellis's Trade Mark*. There the inventors of an improved lubricating oil to which they had applied the newly coined name "Valvoline" had used the word not as a trade mark, *i.e.*, to designate oil of their own manufacture, but rather as describing the character of the oil itself. It should be added, moreover, that "Valvoline" was the only name by which this particular kind of oil was known. Upon these facts the word was held to have been improperly registered.

(5) **Any other Distinctive Mark; but a Name, Signature, or Word or Words, other than such as fall within the Descriptions in the above Paragraphs (1), (2), (3) and (4), shall not, except by Order of the Board of Trade or the Court, be deemed a Distinctive Mark.**

This comprehensive sub-section has been not inaptly likened to Aaron's snake, in that it swallows up all the other sub-sections. In the first place, it includes every species of mark, not already mentioned in the foregoing sub-sections, such as pictorial and ornamental devices, letters, numerals and the like, distinctiveness being made the sole condition of registration. Secondly, it admits to the Register, subject to the approval of the Board of Trade, any name-marks or word-marks which, though inadmissible under the preceding sub-sections, can nevertheless lay claim to distinctiveness in the sense that they distinguish the goods of the proprietor of the trade mark from goods manufactured by others.

The first part of the section calls for little comment except in reference to the requirement of distinctiveness.

Whether a mark is distinctive or not is a question to be determined solely by comparison with other marks used or registered in connection with the same description of goods. In making such comparison the Courts have regard to the appearance of the marks as they are in actual use, for the likelihood of deception will largely depend upon the method of branding, impressing or embossing a mark or upon the colour in which a mark is printed.

In the case of device-marks, distinctiveness should reside in the broad outlines of a design rather than in a number of small details. For example, a bell has been held to be non-distinctive where a bee-hive was already registered for the same class of goods; and a mere difference in *species* between birds or animals appearing in similar postures as trade marks upon competitive goods has been held to be an insufficient element of distinctiveness.

A picture or device may lose its distinctive character through sheer popularity as an advertising medium, though never actually used as a trade mark. Thus Gainsborough's famous portrait of the Duchess of Devonshire was held not to be distinctive as a trade mark for millinery, as it had long been in common use in the hat and millinery trade for all purposes except by impression on the goods themselves (*Louise* v. *Gainsborough*).

Where an ornamental or pictorial device has been registered, no mark will be regarded as distinctive which consists in a description of such device. For instance, where the device of a star had been registered as a trade mark for glass, the words "Red Star Brand" subsequently registered by a rival glass merchant were held not to be distinctive, and the mark was accordingly expunged (*Société, etc., des Verreries de l'Etoile's Trade Mark*).

Trade marks which consist in pictorial representations of the goods to which they are applied are not considered distinctive and will be refused registration. In judging of the

distinctiveness of word-marks, the test of both eye and ear must be applied. Words may be spelt very differently but sound much the same.

The following words have been held to resemble each other so closely as to be calculated to deceive:—

Cocoatina	and	Cocaotine	as	applied	to beverage
Stephen's	,,	Steel pens	,,	,,	,, ink
Apollinaris	,,	Apollinis	,,	,,	,, mineral waters
Secotine	,,	Securine	,,	,,	,, gum
Tabloid	,,	Tablone	,,	,,	,, drugs
Iron-ox	,,	Iron-oxide	,,	,,	,, tonic

On the other hand, the Courts have held that in the case of the following words there was sufficient dissimilarity to negative the probability of confusion:—

Ivy	and	Ivory	as	applied	to soap
Colloline	,,	Cocosoline	,,	,,	butter
Lancashire	,,	Lanco	,,	,,	,, belting
Pianola	,,	Neola	,,	,,	,, mechanical piano players

Word-marks as applied to cotton piece goods are declared by Statute (s. 64, sub-s. (10) of the Act of 1905) to be non-distinctive and may not be registered for such goods except in combination with some other device. For to the Oriental, unacquainted with our language, one English word looks much like another of the same length. Line headings also, as applied to cotton piece goods, have lost their distinctive character owing to the infinite multiplicity of this kind of marking; a cotton mark, therefore, consisting of a line heading alone is similarly disqualified from registration.

Prior to 1906, colour was not taken into account as conferring distinctiveness upon a mark. Consequently many trade marks, which were in fact distinctive, were excluded from the Register. Take for example the familiar "Red,

White and Blue" label—a tricolour flag—distinguishing the coffee of a well-known firm. Deprived of its colour, this mark appears simply as three parallelograms placed side by side, a commonplace geometrical figure, devoid of distinctiveness. Apart from colour, therefore, it was incapable of registration. The Act of 1905 has altered this rule, and gives to colour its proper value as an element of distinctiveness. Section 10 provides that a trade mark may be limited in whole or in part to one or more specified colours, and in such case the limitation as to colour will be taken into consideration in deciding whether the mark possesses the requisite distinctiveness. If no particular colour is specified, the mark is deemed to be registered indifferently for all colours.

The second part of the section introduces an innovation of considerable importance. It marks the recognition of the fact, hitherto ignored by the Legislature, that there are trade marks (chiefly word and name marks) which when tested by the criteria of distinctiveness prescribed in the preceding sub-sections are found wanting, but which, none the less, have acquired as a commercial fact a distinctive character and have become effective and valuable trade marks. Experience has shown that words which are descriptive or geographical in their primary sense sometimes acquire, by long association with the manufacture of a particular person or firm, a secondary meaning that is as distinctive as any trade mark could be. Two instances will illustrate this. "Camel Hair," as applied to machine belting, is obviously descriptive and therefore *primâ facie* incapable of registration. It was, however, claimed by Messrs. Reddaway, who had for many years sold belting under this description, that the words had become distinctive. As the result of a "passing-off" action brought by that firm to protect their alleged right to the exclusive use of these words, it was finally held in the House of Lords

that the words "Camel Hair," as used in the trade, had in fact become distinctive and designated the goods of Messrs. Reddaway as distinct from the goods of all others (*Reddaway* v. *Banham*).

Similarly, in the "Stone Ale" case (*Thompson* v. *Montgomery*), a name primarily geographical acquired a distinctive meaning. There it was held by the House of Lords that the local name "Stone," as applied to ale, designated ale brewed or sold by the plaintiffs, who had carried on business as brewers at Stone in Staffordshire for upwards of a century. The Court accordingly granted them a perpetual injunction against a rival brewer, who had established himself in the same town with the intention of selling his ale as "Stone Ale" and so trading on the plaintiffs' reputation.

But in neither case could the owners of these marks, successful though they were in vindicating their right to exclusive user, obtain registration under the old Acts; for "Camel Hair" was plainly descriptive, and "Stone" was undeniably a geographical name. The latter part of sub-s. (5) is designed to remedy this anomaly and to render such marks registrable, subject to the Court being satisfied as to their distinctive character. "Yorkshire Relish" may be quoted as another instance of a mark previously unregistrable, though held by the Courts to be distinctive.

The list of "essential particulars" concludes with a saving clause concerning what are known as "old marks," *i.e.*, marks used prior to the first Registration Act of 1875. Its application is confined to marks consisting of words, letters, numerals, or combinations of these. Device-marks are not within the proviso. The mark must be "special and distinctive" and must have been continuously used without substantial alteration down to the date of application for registration. A word can only be properly registered as an old mark, if it has been used

alone as a mark, before 1875, and not if it has been used merely in combination with other words. Thus, in *Richards* v. *Butcher*, the word "Monopole" was held to have been wrongly registered as an old mark, the evidence being that, prior to 1875, it had never been used as a trade mark except in conjunction with other words or devices.

Few trade marks consist simply of the "essential particular." There is usually combined with it a certain amount of non-distinctive matter of an ornamental or literary kind to give the mark completeness. According to the practice which prevailed prior to the Act of 1905, an applicant was in all cases required to "disclaim" any exclusive right to these supplementary features or, as it was termed, "added matter." These disclaimers were endorsed upon the certificate of registration.

This practice was open to objection on several grounds. It was misunderstood by the foreign trade mark officials, when it was sought to register the mark abroad, and rendered it impossible in many cases to register a mark abroad in the same form in which it was registered in England. Further it was held by the Courts that when a person had disclaimed the "added matter" for the purposes of registration, he was thereby precluded from afterwards asserting an exclusive claim to it in a "passing-off" action.

The practice in this respect has accordingly been altered by the Act of 1905, and disclaimers are now only required in exceptional cases. Section 15 provides that if a trade mark contains parts not separately registered by the proprietor as trade marks, or if it contains matter common to the trade or otherwise of a non-distinctive character, the Registrar (or the Court) *may* require a disclaimer as the condition of registration.

Disclaimers are, therefore, no longer required as a matter of course. It is left to the discretion of the Registrar to

determine when they are needful, and he will only insist upon their insertion in cases where there appears, upon the face of the trade mark, matter which, in his opinion, is liable to mislead the public into the belief that they are precluded from using what is in reality common property. Such a case might occur when the "essential particular" was combined with a device or words bearing a *prima facie* stamp of distinctiveness, but which in fact were open to the trade. Where the trade mark gives prominence to such common-place and obvious devices as cup and saucer or syphon and glass for beverages, or heaped fruit and flowers for perfumery, a disclaimer will still most likely be required. Also, in cases where the trade mark combines with other features a single initial letter or several letters, the Registrar will usually require a disclaimer of the exclusive use of the letters or will append a statement to the effect that the mark shall not interfere with the *bonâ fide* use by any person of his own initials.

The Act further provides that in cases where a disclaimer is required, it shall not affect any rights of the proprietor of the mark other than those arising out of the registration. He cannot sue for infringement of trade mark where only the words disclaimed have been taken; but he is not precluded, as formerly, from relying on them in a "passing-off" action, and adducing evidence to show that they signify goods of his manufacture as distinct from all others.

The difficulty with regard to registration abroad is met by a rule enabling the Registrar to omit from the certificate of registration all reference to any disclaimers appearing on the Registrar in cases where the certificate is required for obtaining registration in a foreign country.

CHAPTER III.

RESTRICTIONS ON REGISTRATION.

"EVER since Courts of Equity have interfered to protect traders in the exclusive use of marks and words which they have lawfully appropriated for the purpose of distinguishing their goods, it has been an established principle that this protection is not to be extended to persons whose case is not founded in truth." Thus does Lord Macnaghten, in the leading case of *Eno* v. *Dunn*, sum up the law with regard to deceptive trade marks. Reduced to the more peremptory language of the Statute, the rule appears as follows:—"It shall not be lawful to register as a trade mark or part of a trade mark any matter, the use of which would, by reason of its being calculated to deceive or otherwise, be disentitled to protection in a Court of Justice, or would be contrary to law or morality, or any scandalous design."

The most obvious case in which deception is likely to arise is, of course, where the mark tendered for registration is identical with or closely resembles one already registered or used in connection with the same description of goods. The "same description of goods" is, however, a phrase capable of a narrow or wide construction according to the circumstances. The case alluded to above, *Eno* v. *Dunn*, may be quoted as an illustration of the utmost limit to which it can be stretched. The facts were shortly these. Mr. Eno had registered "Fruit Salt" as his trade mark for a powder used in producing an effervescing drink; and, as such, "Eno's Fruit Salt" had a wide reputation. Ten years later Mr. Dunn applied to register in the same class

of goods the words "Dunn's Fruit Salt Baking Powder." The application was opposed on the ground that the words "Fruit Salt" were clearly calculated to deceive, and the Comptroller refused to register the mark. The opponent's contention was that the public would suppose that Eno's Fruit Salt formed an ingredient in Dunn's Fruit Salt Baking Powder, and consequently a batch of badly made baking powder might seriously injure the credit of the effervescing powder. This supposition, though seemingly improbable, was nevertheless given colour by some evidence to the effect that certain persons had, in fact, attempted to use Eno's Fruit Salt as baking powder, and apparently with success. The case eventually went to the House of Lords, and though the decision was not unanimous, it was decided by the majority that Mr. Dunn's mark was "calculated to deceive" in the sense that it was not free from reasonable risk of causing deception. That being so, the Comptroller was held to be justified in the exercise of his discretion in refusing to register it.

Similarly in a recent case (*Compagnie Industrielle des Petroles' Application*), registration of the word "Motricine" was applied for in Classes 47 and 50 for spirit for motive power purposes. The proprietors of the trade mark "Motorine," which had previously been registered in Class 47 for lubricating oil, opposed the application on the ground that the similarity of the two words was likely to cause confusion, which would be not only damaging to the proprietors of "Motorine," but a source of danger to the public. The Court held that the danger was a real one and refused to allow the word to be registered.

In estimating the danger of deception, it is not only the careful customer that the law has in view, but also, to use the phrase that has been often employed, "the unwary purchaser." But that expression must not be taken to mean the "ignorant customer," who knows nothing or very

little about the usage of the trade with regard to the "get-up" of the kind of goods in question. Lord Justice Romer emphasised this point in *Payton & Co.* v. *Titus Ward & Co.*, and observed that the kind of customer that the Courts ought to think of in these cases is the customer who knows what is common to the trade and is familiar with the distinguishing characteristics of the plaintiff's goods.

A mark tendered for registration may be adjudged deceptive on account of its resemblance not only to marks already registered, but also to unregistered marks in common use, and even to marks which are not strictly trade marks, such as advertising circulars and pictorial posters which have become associated in the popular mind with the goods of a particular firm. Thus, in the case of the *Sphincter Grip Trade Mark*, registration of a design representing a length of armoured fire hose, tied into an elaborate knot, was refused on the ground of its resemblance to a design shown in an advertisement of similar goods issued by a rival firm.

The mere verbal description of a device or design already registered will not be accepted, nor is the application less objectionable because the description is in a foreign tongue. In the leading case of *Dewhurst's Trade Mark* the applicants applied to register in connection with cotton goods certain words in Burmese characters, meaning "The Golden Fan Brand." There was already on the Register a design representing a golden fan, entered in respect of similar goods. Notwithstanding that the applicants had obtained the consent of the owner of this trade mark, the Court refused to allow registration.

The fact that a conflicting mark is sought to be registered in a *different class* will be no answer to the objection that it is likely to deceive, if in fact both marks relate to goods usually associated in the ordinary course of trade or likely to compete with one another. Thus the

word "Kodak," which had been registered by the Eastman Photographic Co. for cameras, was held not to be registrable by another company in respect of cycles. On the other hand, similar marks are sometimes allowed to be registered in the same class where the character of the goods is so widely different as to make the danger of confusion or deception very remote. So, where an oil and colour manufacturer had registered the mark "Rainbow" for all goods in Class I., excepting mineral dyes, and subsequently a photographer sought to register the same word in respect of photographic plates, which also fall within Class I., the latter was held entitled to registration, it being proved that he had sold photographic plates under the trade mark "Rainbow" for several years, and that the word had not been used by anyone else in connection with the photographic trade (*Hare's Trade Mark*).

Similarly in the converse case registration has been refused. Thus, in *Pomril, Ltd.'s Application*, it was sought to register a mark for cider consisting of the representation of an apple sliced in half, with "Pomril" written across it. The Comptroller declined to register this mark owing to the danger of its conflicting with another cider mark, already on the Register, consisting of the words "The Apple Brand."

The question of what amounts to deceptive similarity between two marks has already been sufficiently discussed (p. 305) in dealing with the subject of distinctiveness. It is only necessary to add that, in judging whether a mark is likely to mislead the public, the Registrar and Court look primarily to the "essential particulars." A mark is not "calculated to deceive" which resembles another only in features that are common to the trade.

In view of the Act of 1905, the general rule forbidding the registration of identical or similar marks for the same description of goods requires qualification. The Legis-

lature, recognising the fact that in some classes of goods, where the market is almost exclusively local, no harm can come of allowing two traders in widely separated markets to use the same registered trade mark, has expressly provided for the relaxation of this rule in exceptional cases. These exceptions, which are dealt with by sections 19—21 of the Act of 1905, may be summarised as follows:—

An old mark, proved to the satisfaction of the Registrar to have been in use before August 13th, 1875, may be registered in spite of its similarity to one already on the Register.

An applicant who seeks to register a new mark (*i.e.*, a mark not used prior to 1875) in the same circumstances must obtain the leave of the Court, and leave will only be granted if he can show that there is no danger of his mark clashing with or being mistaken by the public for the mark already on the Register. But the consent of the owner of the conflicting registered trade mark will not, in itself, be sufficient to satisfy the Court.

In the case of several persons claiming to be the proprietors of and desiring to register the same mark or nearly identical marks in respect of the same description of goods, two courses are open. The rival claimants may agree between themselves as to the delimitation of their respective rights, and if such arrangement appears satisfactory to the Registrar, he may direct registration to proceed subject to these terms. If no amicable arrangement can be agreed upon, the Comptroller will refuse to proceed with the registration and refer the applicants to the Court, and the Court may order the registration of these similar marks subject to such conditions and limitations as it may think fit to impose.

Where, in pursuance of the above sections, two or more persons are registered proprietors of the same or

substantially the same trade mark, no right of exclusive user is acquired (except so far as their respective rights may have been determined by the Court) by any one as against the other or others. As regards the rest of the world, however, each has the same rights as if he were sole registered proprietor of the mark in question.

Hitherto, in the case of an application to register an "old mark" where it is proved that the mark has been used by more than three different persons or firms in respect of the same kind of goods, it has been treated as open to the trade and registration refused. This is known as the "Three Mark Rule" and doubtless still applies in the case of "old marks." Whether the same rule will be observed also in regard to new marks is not clear.

In a recent case (*Hudson's Application*) a manufacturer of whistles, who had used the words "The Thunderer" upon a certain type of whistle for a considerable number of years, applied to register the name as his trade mark. Another whistle-maker who had also sold whistles under the same title applied shortly afterwards to register the same mark. The Comptroller referred these conflicting claims to the Court for determination in accordance with s. 20 of the Act. The evidence at the trial showed that, besides the two claimants, four or five other firms had been selling "Thunderer" whistles for a considerable time past. The judge accordingly held that the mark was public property, and that neither claimant could register either an exclusive or concurrent right to its use.

The restriction imposed by ss. 19—21 upon the registration of identical or similar trade marks applies only to cases where the marks belong to different owners. When the marks are the property of the same person, registration will generally be allowed on condition that they are entered on the Register as "associated" marks. This form of registration is an innovation of the Act of 1905, and its

effect is simply to make the groups of similar marks, so registered, assignable and transmissible only as a whole; for all other purposes they are regarded as separately registered. For instance, if the owner of a trade mark desires to register the entire mark and also a portion of it separately, he can now do so, provided each possesses the requisite qualifications. The parent mark and its offspring will then each have all the incidents of an independent trade mark, except that one cannot be disposed of without the other.

In the case of several trade marks, substantially identical and for substantially the same description of goods, but differing in respect of: -

(*a*) Statements of the goods for which they are to be used;

(*b*) Statements of number, price, quality or names of places;

(*c*) Colour,

or in any other way which does not affect the identity of the trade mark, the whole series can be registered in a single registration. All marks so registered in a series will also be treated as associated marks.

Returning from this digression to the subject of trade marks "calculated to deceive," it should be noted that there are other causes of possible deception besides resemblance between rival marks. For example, a word-mark might be held to be deceptive if, without being directly descriptive, it was nevertheless so far suggestive as to convey to the public a misleading notion of its quality, composition or origin. Thus the mark "Eton" upon cigarettes made in London, and the mark "Forrest" upon watches not made by Forrest, have been held to be deceptive. Objection has also been taken to a mark on the ground that the words "trade mark," printed across a portion of it, were so placed as to mislead anyone into

thinking that only that part of the mark was registered and that the remainder was open to the public.

The purity of the Register is to be preserved not only by excluding marks calculated to deceive, but also marks which would be "contrary to law or morality, or containing any scandalous design." But sentimental objections to a trade mark on the ground that it is scandalous will not be entertained. A firm of wine merchants having registered the word "Quaker" as a trade mark for fermented liquors and spirits, the Secretary of the Society of Friends applied to remove the word from the Register, on the ground that it was scandalous and liable to deceive. It was held that, there being no rule of total abstinence in the Society of Friends, the objection was not well founded (*Ellis & Co.'s Trade Mark*).

As an additional safeguard against the use of misleading trade marks, certain words and devices are expressly debarred from registration, or only allowed upon the Registrar being satisfied that their use is justified. By the Trade Mark Rules registration will not be allowed of any mark embodying the following words or devices, unless they can be claimed as old marks:—

(*a*) The Royal Arms or Royal Crests, or Arms or Crests so nearly resembling them as to be misleading;
(*b*) British Royal Crowns;
(*c*) British National Flags;
(*d*) The word "Royal" or any other words, letters or devices calculated to lead persons to think that the applicant has Royal patronage or authorization.

The Registrar is also authorized to refuse applications for the registration of trade marks embodying:—

(*a*) The words "Patent," "Patented," "By Royal Letters Patent," "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To Counterfeit this is Forgery," or words to like effect;

(*b*) Representations of their Majesties or of any member of the Royal Family.

If the Armorial Bearings of any Foreign State or of any City or Borough or Society, etc., or the name or representation of any living or recently deceased person appear upon the trade mark, the Registrar may require to be satisfied that these representations are used with proper consent or justification.

Ornamental or coloured groundwork, such as tartans or checks, cannot be claimed as part of a mark unless such groundwork is included within the mark by some border or lines.

Where there appears on the face of a trade mark the name or description of the goods to which it is applied, the Registrar may refuse to register the mark in respect of any other goods than those so named or described. If, therefore, the applicant intends to use the same mark with suitable variation of description for other kinds of goods, that should be expressly stated in the application in order to obtain registration in other classes.

CHAPTER IV.

REGISTRATION.

A. Entry upon the Register.

Having decided what is permissible as a trade mark, the next question to consider is the procedure for getting the mark registered. Any person, firm or company, whether British or foreign, claiming to be the proprietor of a trade mark, may apply to register it within the United Kingdom. If an application has already been made in any of the foreign countries or colonies belonging to the International Convention or with whom arrangements exist for the mutual protection of trade marks, the applicant is entitled to priority of date (similar to that accorded in the case of patents and designs) provided that the British application is made within *four* months from the date of the first effective application abroad, and that the mark is otherwise registrable under the Act of 1905.

Where the mark intended for registration is a new one, the applicant will do well to take the precaution of making a preliminary search before lodging his application, in order to ascertain whether there is already on the Register any mark which is likely to clash with that which he proposes to adopt. This he may do either by making a search himself or by applying to the Registrar to cause an official search to be made. In the latter case he must forward a request upon Form T. M. No. 28 (stamp 10*s*.), accompanied by two representations of the proposed mark, each mounted on half a sheet of foolscap. Anyone, however, is at liberty to make a search himself amongst the classified

representations of trade marks at the Trade Marks Branch of the Patent Office, a charge of 1s. being made for every quarter of an hour spent in searching. Besides the general index of collected trade marks, there is a divisional index of devices and an alphabetically arranged index of words. It must not be assumed that all the words contained in this index are protected by registration, for it includes not only registered word-marks, but also words forming *part* of a trade mark. Complete searches amongst the classified collections of cotton marks (viz. Classes 23, 24, and 25) can only be made at the Manchester Branch Office.

As it is desirable, before adopting an "invented word" as a trade mark, that its registrability should be beyond controversy, the Office invites the submission of newly coined words for the Registrar's consideration. The Registrar will, of course, only express an opinion as to how far the word submitted complies with the requirements of s. 9, and will make no search for the purpose of ascertaining whether any other person has a similar registered mark, unless a search fee is paid.

Applications for the registration of all marks, except Sheffield and cotton marks (as to which see pp. 330—331), must be addressed to the Registrar, The Patent Office, Trade Marks Branch, 25, Southampton Buildings, London, W.C. In making the initial application and at all succeeding stages the appropriate stamped forms must be used. These forms (a list of which is given on page 349) are not supplied by the Patent Office, but can be purchased on personal application at the Inland Revenue Office, Royal Courts of Justice (Room No. 6) in London, or, at a few days' notice and upon pre-payment of the value of the stamp, at any Money Order Office in the United Kingdom.

The ordinary application is made upon Form T.M. No. 2, bearing an impressed stamp of 10*s*. A special form (T.M. No. 5) is allotted for applications to register a

name or word only registrable as a trade mark with the sanction of the Board of Trade under s. 9, sub-s. 5; and a special form (T.M. No. 6) is required for applications to register standardisation marks expressly authorised by s. 62 of the Act. A separate application form must be used for each class in cases where the same trade mark is claimed in more than one class of goods.

The Patent Office publishes a "Guide to the Classification of Goods," which will be of assistance to any applicant who finds difficulty in determining to which of the stereotyped classes the goods, for which he uses his mark, belong.

To identify his mark, the applicant has to furnish *five* representations of it, one affixed to the form of application and four additional facsimile copies, each mounted on Form T.M. No. 3. The representations may be made in any suitable medium, such as ink or paint, but in no case may they be executed in pencil. Marks consisting of or including words printed in other than Roman characters should be accompanied by a translation and likewise a phonetic transliteration. Where an application is made for the registration of a series of marks, a representation of each of the marks of the series must be affixed to the principal form and also to each of the four additional forms.

To entitle an "old mark" to registration as such, there must have been continuous user since August 13th, 1875, in the United Kingdom and in connection with the goods specified in the application. An applicant seeking to register such a mark must vouch for these facts and should further state how it has been used, whether as a label or by branding, embossing, etc. The Registrar may require a sworn declaration verifying the applicant's assertions upon these points. Where the name or description of certain goods appears upon the face of the trade mark, but the applicant intends in practice to vary these particulars

in using the mark for other goods, a statement to this effect should be appended to the application, otherwise the Registrar may decline to register the mark in respect of any goods other than those specified on the mark itself.

In due course, after an application has been lodged, the Registrar notifies the applicant whether it is acceptable or not. Should the Registrar refuse the mark or only accept it conditionally or subject to amendment, the applicant may, by sending in a request upon Form T.M. No. 4, obtain from the Registrar a statement in writing of the grounds of his decision and the materials upon which it is based. If he is dissatisfied with the decision, he may appeal at his option to the Board of Trade or the Court.

As soon as an application has been accepted, it is advertised in the *Trade Marks Journal*. For this purpose the applicant must, on receiving a formal demand from the Registrar, furnish a wood or copper block engraving of his mark (except in the case of cotton marks, for which no blocks are required). Care must be taken to have the blocks made within the prescribed dimensions. The largest space available for the insertion of a single block is $5\frac{1}{2}$ ins. broad by $7\frac{1}{2}$ ins. deep. No charge is made for the insertion of a block not exceeding two inches in breadth or depth; but if the block exceeds these dimensions, a small charge is made for every inch of additional space taken. The block having been prepared, it should be sent to the Trade Marks Branch of the Patent Office accompanied by the paper marked "Form R. Adv. 3," and the representation of the mark sent for the guidance of the applicant in preparing the block.

Anyone desiring to oppose the registration of the trade mark has one month from the date of advertisement within which to lodge his notice of opposition. Notice is given by filing Form T.M. No. 7, together with an unstamped duplicate which the Registrar sends on to the applicant.

The ordinary grounds of opposition are :—(*a*) That the mark is not characterised by any "essential particular" as required by s. 9; (*b*) that the mark is identical with or closely resembles one already registered by the opponent; (*c*) that it will interfere with his using a mark he has hitherto been accustomed to use: (*d*) that it is otherwise calculated to mislead the public.

If the registration is opposed on the ground that the proposed mark resembles a mark already on the Register, the opponent must specify the number of the mark relied on and the date of the Journal in which it was advertised. The applicant has one month from the date of the receipt of notice of opposition within which to file a counter statement. Each party has then a further period within which to file evidence by sworn declaration. In lieu of or in addition to these statutory declarations the Registrar may permit the parties to give oral evidence at the hearing. The decision of the Registrar is subject to appeal to the Court or, with the consent of the parties, to the Board of Trade. The Registrar and, in the case of an appeal, the appellate tribunal have power at any stage of the proceedings, whether before or after acceptance, to correct any error in the application or permit the applicant to amend his application upon such terms as they think fit. They have also power to award such costs as they may consider reasonable.

An application for registration of a trade mark must be completed within 12 months. Whenever through default of the applicant this period is exceeded, the Registrar notifies the applicant of the fact and specifies a period, usually 14 days, within which the application must be completed. If not completed within this time, the application will be deemed to have been abandoned.

After the expiration of the time allowed for opposition, the Registrar will, in the absence of opposition, proceed to

register the trade mark; but a trade mark cannot in any event be entered on the Register until after the lapse of one month from the date of its advertisement in the Journal. The entry on the Register specifies the date of registration (*i.e.*, the date of application), the goods in respect of which the mark is registered and gives the usual particulars identifying the proprietor. Notifications of assignment, disclaimers, conditions and limitations affecting the use of the mark are also entered. As soon as registration is completed, the Registrar forwards to the applicant a certificate on Form O, No. 2. Special certificates are issued for use in procuring registration abroad or for the purposes of litigation, and may be obtained by application upon the prescribed forms. In the case of an "old mark" not registrable under the Act, the applicant may obtain a certificate of refusal, which gives him a status in an action for infringement equivalent to that conferred by registration.

The cost of registration varies so widely according to the nature of the goods and the number of classes for which the mark is to be registered, that a general statement will be of little use. The table of forms, given at page 349, contains a complete list of fees, and will furnish any information that may be desired on this head.

B. Renewal of Registration.

A trade mark that has been duly registered will remain upon the Register without further payment for a period of 14 years. At the expiration of this time the registration may be continued by the payment of a renewal fee (£1 for every class in respect of which the goods are registered) for another period of 14 years; and so long as the renewal fees are duly paid at intervals of 14 years, registration may be indefinitely prolonged. The renewal fee must be paid not less than 2 months nor more than 3 months

before the period of registration expires. If the renewal fee is not paid at the proper time, the Registrar sends a notice to the proprietor of the mark, warning him of the approaching expiry of his registration. If after receiving two such notices the proprietor still allows the date of expiry to pass without paying the renewal fee, the Registrar advertises the fact in the Journal. After the appearance of this advertisement, the registered proprietor has still one month's grace within which, upon payment of a fine of £1 in addition to the renewal fee, he may save his registration from lapsing. Upon the renewal of a registration, the proprietor of the mark is notified and the fact is advertised in the Journal. Marks which have lapsed through non-payment of the renewal fee are removed from the Register, and an entry made of the removal and its cause.

To obviate the risk of improper use being made of a recently lapsed mark, as, for instance, by a rival immediately adopting and registering the same mark, s. 31 of the Act provides that a trade mark which has lapsed in this way shall nevertheless, for the purpose of any application for registration, for one year after its removal be deemed to be still upon the Register. If, however, the Registrar is satisfied that there has been no *bonâ fide* trade user of the mark during the 2 years immediately preceding the removal, he is at liberty to waive the application of this rule.

C. Rectification of the Register.

(1) *By the proprietor of the mark.*

The Act invests the Registrar with ample powers to rectify or alter entries in the Register upon the application of the registered proprietor. Section 32 provides for the correction of errors in name or address, for the cancellation of an entry, or for its limitation by entering a disclaimer or by striking out some of the goods or classes of

goods for which the mark was originally registered. Where an application is made to enter a disclaimer or memorandum, the proposed entry must be first advertised in the Journal, so that anyone who desires may have the opportunity of opposing it.

Section 33 provides for the entry upon the Register of notifications of changes in proprietorship by assignment or devolution. A request to register an assignment may be made jointly by the assignor and assignee (Form T.M. No. 16), or alone by the person claiming to be entitled by assignment or otherwise. In the latter case, the claimant must make his request for registration in Form T.M. No. 18, and at the same time furnish a statement giving full particulars of the origin of his title. If in the opinion of the Registrar his claim is well-founded, he will be required to file a statutory declaration (Form T.M. No. 19) verifying the statements upon which his claim is based.

Applications to amend the registered mark (as distinct from the entry in the Register) are looked upon with less favour. Small changes, however, by way of addition to or alteration in the mark are permitted, provided that the change does not substantially affect the identity of the mark. For example, the addition of the word "Limited," or the substitution of a new name and address, are alterations that will usually be allowed. All such alterations must be advertised in the Journal, though no provision is made in the Act enabling anyone to oppose them.

(2) *Upon a hostile application.*

In virtue of s. 36 any person aggrieved by a wrongful entry, error or omission in the Register may apply to have the entry expunged or varied or the error rectified in any other way that may be necessary. An application to rectify the Register under the provisions of this section is made by motion to the Court. The definition of the expression an "aggrieved person" has occasioned some

little difficulty in the past; the meaning, however, seems to be this. Whenever a trader, by dint of a wrongly registered trade mark, narrows the area of business open to his rivals and thereby excludes, or, with reasonable probability, will in future exclude a rival from trading in such goods as he desires to trade in, that rival is an "aggrieved person." Anyone threatened with proceedings for alleged infringement or accused of passing off his goods as those of the complainant would be an obvious instance of a person aggrieved.

In the case of fraud in the registration or transmission of a registered mark, the Registrar may himself apply to the Court for rectification.

An opponent may apply to rectify on numerous grounds. For instance, he may contend that the mark contains none of the "essential particulars" prescribed by s. 9; that it is descriptive or has reference to the character and quality of the goods; that it was common to the trade at the date of registration; that it was improperly registered as an old mark; that it was calculated to deceive owing to its similarity to a mark already on the Register, that it is otherwise of a deceptive character; that the registration was obtained by fraud. In fact every legal ground of objection to the registration is open to him, provided the mark has not been on the Register for more than 7 years. After 7 years a mark is only open to attack on the limited ground that the original registration was deceptive or fraudulent. Prior to the Act of 1905, a mark was liable to be expunged on the ground that it had been improperly registered, no matter how many years it had been on the Register. The provision contained in the Patents, Designs and Trade Marks Act of 1883, that registration should be deemed conclusive evidence of title after the lapse of 5 years, was construed by the Courts to mean merely that the defendant in an action for infringement was debarred from

relying on the plea of invalidity in the case of a trade mark which had been on the Register for 5 years. He was not, however, precluded from applying to rectify the Register by expunging the mark. Hence it became the common practice to retort to an action for infringement by a motion to rectify the Register, in cases where the mark sued upon was more than 5 years old.

The Act of 1905 has made an important change in this respect, so that now a mark, which is immune from attack in an action for infringement, is equally immune from attack by a motion to rectify the Register. A further beneficial amendment is the provision that a mark cannot be expunged from the Register on the ground that it was improperly registered, if its registration can be justified under the Act of 1905.

In deciding whether a mark shall be removed from the Register, the Court observes a distinction between a registration which is inherently illegal and one which, though it might have been objected to at the date of registration, has ceased to be objectionable. Thus the Court is not bound to expunge a mark upon the motion of an unmeritorious applicant (a trader, for instance, who has flagrantly infringed it) merely because the original registration might have been opposed on the ground of prior user by someone who, at the time of the motion to rectify, had discontinued his user. Upon an application to rectify, the Court has also the right to require the entry of a disclaimer to the exclusive use of any part of the mark.

The removal of a trade mark on the ground of non-user has already been alluded to (p. 291). It is only necessary here to recapitulate briefly that a mark may be removed by the Court upon the application of any person aggrieved, if (1) it was registered without any *bonâ fide* intention to use it and there has been no actual user, or if (2) there has been no *bonâ fide* use made of it during the 5 years

immediately preceding the application for its removal. In the exercise of its discretion the Court will take into consideration any special circumstances which may justify the non-user of a trade mark.

Sheffield Marks.

The Sheffield Register of Corporate Marks, kept by the master, warden and commonalty of the Cutlers' Company in Hallamshire in the County of York, dates back to a time considerably before the introduction of a general system of registration by the Act of 1875. Being an efficient working system for the registration of cutlery and kindred marks, it was preserved in its integrity by the early Trade Marks Acts and engrafted upon the general system; and the Sheffield Register, though continued as a separate record, was closely co-ordinated with the principal Register. It is now, by virtue of the Act of 1905, declared for all purposes to form part of the London Register.

The only point requiring special note in regard to Sheffield marks is the manner of applying for registration. The procedure is briefly as follows. All applications for the registration of marks used on *metal goods* by persons carrying on business in or within 6 miles of Hallamshire must be directed to the Cutlers' Company. The expression "metal goods" includes all metals whether wrought, unwrought or partly wrought, and all goods composed wholly or partly of any metal. The application must be made in duplicate on Form T.M. No. 2, and forwarded to the Cutlers' Hall, Sheffield. Requests to enter Old Corporate Marks should be made on Form Sheffield No. 1, bearing a £5 stamp. Upon receipt of an application, the Cutlers' Company notifies the Registrar, and entry on the Sheffield Register is subject to his approval. As soon as the mark is entered by the Cutlers' Company, a corresponding entry is made on

the Register in London. The mark is registered as of the date of application to the Cutlers' Company.

Applications for registration of marks on metal goods by persons carrying on business *beyond* the 6 miles radius must be made to the Registrar in the usual way. A notification of such applications is sent to the Cutlers' Company.

An appeal lies from every decision of the Cutlers' Company direct to the Court.

Cotton Marks.

The Manchester Branch Office for the registration of cotton marks has been in existence since the Trade Marks Registration Act of 1875. It was established by the Rules made in pursuance of that Act and it has now, for the first time, obtained direct statutory recognition. The principal officer of the Manchester Branch is designated "The Keeper of Cotton Marks." The section of the Register which deals with marks upon goods falling within classes 23, 24 and 25 is styled "The Manchester Register," and a duplicate copy of it is kept at the Manchester Branch.

According to the present classification, the cotton goods comprised in these three classes are as follows:—

Class 23. (*a*) Cotton yarn.
(*b*) Sewing cotton.

Class 24. Cotton piece goods of all kinds (such as cotton shirtings, long cloth).

Class 25. Cotton goods not included in Classes 23, 24 or 38 (such as cotton lace, cotton braids, cotton tapes).

Applications for marks upon goods of this character should be made upon Form Cotton No. 1 (stamp 10*s*.), and should be accompanied by an unstamped duplicate and also by four additional representations of the mark on Form

Cotton No. 2. The application must be addressed to the Keeper of Cotton Marks, 48, Royal Exchange, Manchester.

Every application to the Manchester Branch is notified to the Registrar in London. If no objection is raised by him, the mark is forthwith advertised in the Journal by the Manchester Branch. The registration fee must be paid to the Keeper of Cotton Marks, who thereupon notifies the Registrar, and the registration is duly completed.

An exceedingly comprehensive record is kept at the Manchester Branch of all applications for the registration of cotton marks, whether accepted, lapsed or rejected; and this record is open to public inspection.

In the case of cotton piece goods and cotton yarn, no mark will be accepted for registration which consists of a word or words alone (whether invented or not). Line headings, unless combined with some other distinctive device, are also disqualified from registration in connection with cotton piece goods. The Act of 1905 further stipulates that in no case shall the registration of a cotton mark give any exclusive right to the use of any word, letter, numeral, line heading or any combination thereof.

Questions of novelty or difficulty arising out of applications to register cotton marks may be settled by the Manchester Branch in consultation with the Trade and Merchandise Marks Committee, appointed by the Manchester Chamber of Commerce.

Appeals to the Court from the Registrar's decision will usually, in the case of cotton marks, be heard by the Chancery Court of the County Palatine of Lancaster.

CHAPTER V.

EFFECT OF REGISTRATION.

THE registration of a trade mark is no idle formality. The advantages it confers are of a very substantial and valuable kind. What these advantages are will be best shown by considering registration from three aspects; first, as a means of establishing an exclusive right to a trade mark; secondly, in facilitating its assignment; and thirdly, as a protection of the mark against infringement.

TITLE ACQUIRED BY REGISTRATION.

Before the introduction of a general system of registration by the Act of 1875, any person who laid claim to an exclusive right to use a particular mark was required to justify his claim. This he could only do by proving that he had used the mark to such an extent that it had come to be identified in the public mind exclusively with goods of his manufacture. Manifestly a reputation of this kind could only be established by lapse of time, and there was always the danger, meanwhile, that the prescriptive acquisition of an exclusive right might be frustrated by some rival adopting the same mark. The object of registration is to enable a trader to establish his right to exclusive use from the outset, that is, from the very day that he adopts the mark; to establish instantaneously a right which previously could only be acquired by the lapse of a considerable time. Registration is, in fact, the means of *creating* a trade mark right, and in the great majority of

cases trade mark rights are originated in this way; it is only comparatively seldom that registration is the record of a "fait accompli," of an exclusive right already acquired by use. But registration is, nevertheless, based upon use. There must be either actual use or a *bonâ fide* intention to use the mark in order to justify its registration; otherwise it is in the nature of an imposture upon the public and may be expunged upon the application of any person aggrieved.

Although by registration the title of a claimant to the use of a trade mark is at once established, the security which registration gives is, at any rate for a time, of a partial kind. In the words of the Act, registration is at first only *primâ facie* evidence of title. It may be attacked, as has been shown in the previous chapter, on various grounds. The onus, however, of proving that the mark was improperly registered is upon the person attacking it, and in cases of doubt the presumption is always in favour of the validity of the registration. After the lapse of 7 years, the position of the registered proprietor is improved, and his title may only then be impugned on the special grounds that the original registration was fraudulent or that the mark is calculated to deceive or consists of a scandalous design. After seven years, therefore, a registered proprietor may be said to be fairly secure in the exclusive right to his registered mark.

It is expressly stipulated, however, by the Act that registration shall in no case entitle the registered proprietor to interfere with anyone entitled by registration to the concurrent use of the same mark, or to restrain any unregistered trader who has used the identical mark in connection with the same goods continuously from a date anterior to the registration. It is also expressly provided that no registration shall interfere with any *bonâ fide* use by a person of his own name or place of business or that of

any of his predecessors in business, or the use by any person of any *bonâ fide* description of the character or quality of his goods. The latter proviso will effectually prevent the maintenance by registration of an exclusive right, originally established under cover of a patent, to a name which, like "Linoleum," has by common usage become descriptive.

Assignment.

A registered trade mark is capable of being transferred by assignment, like any other personal property; subject to this qualification, however, that it can only be transferred in conjunction with the goodwill of the business concerned in the goods for which it is registered. The reason for this rule is obvious. The essence of a trade mark is that it denotes the origin of the goods to which it is applied; it cannot therefore be divorced from the goods with which it has previously been connected, and attached to goods proceeding from a different source, without becoming deceptive. So intimately are the two related, that, even without express mention of them, the trade marks of a business will automatically pass to the purchaser of the goodwill.

If the goodwill is transferred merely for a portion of the goods covered by the registration of the trade mark, the assignee will acquire an exclusive right in the mark only to the extent of the goodwill assigned. It is not possible, as with patents, to grant a licence to use a trade mark, except in the sense that an arrangement is possible whereby the goodwill of a business might be leased for a period. The fact that a trade mark can only be used by the proprietor of the goodwill precludes the possibility of a licence in the sense of a subordinate co-existing right of user. With the determination of the goodwill of a business the right to use the trade mark of the business also determines.

When trade marks are the property of a partnership and the partnership is dissolved, they may be dealt with in one of two ways. They may either be bought out and out by one of the partners, or they may be apportioned. To get them apportioned, the parties must apply to the Registrar who is specially empowered by s. 23 of the Act to permit an apportionment of the trade marks among the persons severally continuing the business, subject to such conditions and modifications as he may think necessary in the public interest. The operation of this section presupposes the possibility of so apportioning the marks, that *different* marks are allotted to each of the former partners. If, however, they desire to have the right of using identical marks in their several capacity, this privilege can only be secured by application to the Court (See p. 315).

As a condition of allowing the apportionment amongst several persons of marks previously used by a single firm, the Registrar would probably stipulate that the marks should be registered as "associated," so that, for the purposes of any subsequent assignment, they could only be dealt with *en bloc*.

Assignments should be duly notified to the Registrar with a request to enter them upon the Register. The entry of an assignment is not, however, a condition precedent to the right to sue for infringement of trade mark; but the Court would probably insist upon seeing that the assignment had been duly registered before giving judgment for an assignee.

In the event of death of a registered proprietor, his trade marks devolve upon his personal representative; in the case of bankruptcy, they pass to his trustee.

Infringement.

Registration is, with one exception, a condition precedent to the institution of proceedings to restrain infringement of

a trade mark. The single exception is that in favour of the proprietor of an "old mark" who has applied for registration and been refused; a certificate of refusal granted in such case being deemed for the purpose of litigation equivalent to registration.

An action for infringement of trade mark, reserved as it is exclusively for those who have availed themselves of the Registration Acts, is therefore essentially the *statutory* remedy as distinct from the Common Law remedy, viz., the "passing off" action, available indifferently for the protection of registered and unregistered marks. Contrasted with the action for infringement, the Common Law action (a brief account of the origin and development of which will be found in the introductory chapter) has much wider scope and greater elasticity, inasmuch as it serves not only to check the direct piracy of a trade mark, but also to suppress other forms of commercial plagiarism by which the goods of one trader are palmed off upon the public as the goods of another. It involves, however, one serious drawback: it places the owner of the mark under the necessity of proving that his mark has acquired such a wide and distinctive reputation, that the use of it by another is calculated to impose upon the public.

The owner of a registered mark, on the other hand, is under no such obligation. All he has to do is to produce his certificate of registration. It then rests with the defendant, if he challenges the right which the certificate imports, to prove that the mark was improperly registered. The grounds upon which a registered mark can be impeached, before and after the lapse of 7 years, have already been stated. Such objections as can be taken to the validity of registration may be relied on by way of defence to the action.

Assuming that the registration is unimpeachable, the

only matter then to be tried is the question of infringement, that is, whether the mark complained of is the same or substantially the same as the registered mark. If the marks are not absolutely identical, their similarity must be such as to render the risk of their confusion extremely probable. The subject of deceptive resemblance has been fully discussed in the preceding pages, and it is only necessary to add that the same considerations which operate to disqualify a mark for registration on the ground of its deceptive similarity to a mark already registered are equally applicable in determining the question of infringement. This, however, should be noted, that, to constitute an infringement, the method of *applying* the marks need not necessarily be identical in both cases. Thus a registered trade mark used by application to the goods in the ordinary way may be infringed by the representation of the same mark upon a circular or invoice or poster used in connection with the same class of goods. The Court is expressly empowered, in trying the question of infringement, to admit evidence of the usage of the trade in respect to the "get up" of the goods for which the mark is registered, and of any trade marks or "get up" legitimately used in connection with the same class of goods by other persons.

Proof of actual deception is not required to support an action for infringement nor does it avail the defendant that the infringement was committed without fraudulent intent. A person who misapplies another's mark to his goods is none the less an infringer because the purchaser buying the goods from him is aware of their true origin; for the goods may pass on into other hands where their spurious character is not known and may consequently cause deception.

In practice it is usual to add a claim for "passing off" in an action for infringement, so that, should the plaintiff

fail to substantiate the valid registration of his mark, he may fall back upon his Common Law rights. Thus, in the famous "Yorkshire Relish" case (*Powell* v. *Birmingham Vinegar Brewery Co.*), the House of Lords held that the mark had been improperly registered and must be expunged, but they granted an injunction, all the same, restraining the defendants from using the words "Yorkshire Relish" and thereby passing off their goods as and for the goods of the plaintiffs. And there are other cases in which a man may succeed in a "passing off" action, though he fails in his action for infringement. For instance, the facts may show that though the mark complained of does not infringe the mark as registered, yet it bears a deceptive resemblance to the mark as actually used by the plaintiff in the course of his trade.

On the other hand, an action for infringement may succeed in circumstances where a "passing off" action would be hopeless. Take the case of a newly registered mark, the adoption of which is so recent that it has not yet acquired a reputation in connection with the goods to which it is applied; the registered proprietor can, nevertheless, obtain an injunction against an infringer in virtue of the statutory right conferred by registration.

But it must be remembered that the statutory action for infringement is strictly confined to those cases in which the thing pirated is the registered trade mark; for other forms of piratical trading upon the goodwill and reputation of the plaintiff the proper remedy is the "passing-off" action. A trader is consequently dependent upon his action at Common Law to restrain such forms of dishonest competition as the imitation by a rival of the general style and "get up" of his goods or the use or adoption of a personal or local name in a way calculated to mislead the public.

In a "passing-off" action, as in an action for infringement, fraudulent motive need not be proved, nor, if the

circumstances all point strongly to the likelihood of deception, is it essential to adduce any particular instance in which the public has been deceived; though a case is, of course, considerably strengthened when such evidence is forthcoming.

CHAPTER VI.

MISCELLANEOUS.

Action for Infringement—The Trial and Tribunal.

Actions for infringement of trade mark are tried in the Chancery Division of the High Court or, in the case of "cotton marks," in the County Palatine Court of Lancaster. The decisions of these Courts are subject to appeal in the ordinary way to the Court of Appeal and finally to the House of Lords.

In the normal Chancery action the plaintiff fortifies the plea of infringement by adding a claim for "passing off," so that, whilst he enjoys the advantages of the statutory action, he is not cramped by its limitations. As soon as the writ has been issued, an interlocutory injunction may be applied for, to restrain the use of the infringing mark until the hearing of the action. This is usually granted upon terms; the plaintiff undertaking, in the event of his failing in the action, to indemnify the defendant for any loss sustained in consequence of the injunction.

The action is tried by a judge without a jury. The form of relief granted to a successful plaintiff is substantially the same as that awarded in a patent action, viz. an injunction and damages or, at the option of the plaintiff, an account of profits. The Court will also order the delivery up of all spuriously marked articles for erasure of the mark or, where that is impracticable, the destruction of the goods themselves.

If the validity of registration has been called in question at the trial, the Court will grant a certificate to that effect,

which will entitle the plaintiff to costs as between solicitor and client in any subsequent proceedings for the infringement of the same mark.

When a "passing off" action is brought, not as an adjunct to an action for infringement but to restrain some form of trade piracy outside the scope of the Trade Marks Act, the case is set down and tried in the King's Bench Division.

The County Courts have no jurisdiction to entertain an action for infringement of trade mark. In Scotland and Ireland the Courts competent to entertain proceedings for infringement of trade mark are the Court of Session and the High Court of Justice respectively.

The Merchandise Marks Act.

Besides being exposed to a civil action, a trade mark pirate is liable to the severer penalty of criminal proceedings, when his conduct is tainted with an intention to defraud.

The Merchandise Marks Act of 1887 (supplemented by the Acts of 1891 and 1894) renders liable to criminal prosecution any person, firm or company, guilty of the following offences:—

(1) Forging a trade mark or making or having in possession any die or instrument for that purpose;
(2) Falsely applying to goods any trade mark or any mark so nearly resembling a trade mark as to be calculated to deceive;
(3) Applying any false trade description to goods.

A person convicted of any of the foregoing acts is guilty of a criminal offence, unless he proves that he acted without intent to defraud.

Persons selling or exposing for sale or having in their possession goods to which a forged or fraudulent trade mark or description has been applied are also guilty of an

offence under the Act, unless they can prove that they have taken reasonable precautions or have otherwise acted innocently, and are willing to give all information in their power as to the persons from whom the goods were obtained.

A not uncommon instance of the application of a false trade mark is the refilling of empty wine or spirit bottles, bearing the label of a well-known firm, with wine or spirit of a different or inferior brand. A person who knowingly uses the mark of another cannot claim that he acted "innocently" merely because he had no positively fraudulent intent. Thus, where a manufacturer of mineral waters, for the sake of economy and convenience, used bottles embossed with the name of another maker, putting his own labels upon them, it was held that he had not acted "innocently" within the meaning of the Merchandise Marks Act, notwithstanding no fraud was intended and no one was misled (*Thwaites & Co.* v. *M'Evilly*).

A false trade description embraces any untrue or deceptive statement with reference to the quantity, quality or origin of the goods. It must, however, be a written or printed statement; an oral misrepresentation, though it might be actionable on other grounds, is not a false trade description within the meaning of the Merchandise Marks Act. A familiar instance of a false trade description relative to quantity is the sale of tea in packets labelled "a ¼lb. of tea," which, however, only scale a quarter of a pound when weighed with the lead-paper wrapper.

Some instances of false trade descriptions as to quality which have resulted in the successful prosecution of the offender are:—the sale of margarine under the description "French Produce—Guaranteed Pure Butter"; the sale of New Zealand mutton as "Welsh"; of machine-cut tobacco as "hand-cut," and of Turkish cigarettes as "Egyptian."

A propos of the first of these misdescriptions it may be

mentioned here that the Butter and Margarine Act, 1907, has introduced a new provision with regard to the marking of wrappers, etc., used in connection with margarine. It is an offence under the Act to sell margarine under any other name than either "margarine," or a name combining the word "margarine" with a fancy or other descriptive name approved by the Board of Agriculture and Fisheries and printed in type not larger than and in the same colour as the word "margarine." A name will not be approved by the authorities for use in connection with margarine if it refers to or is suggestive of butter or anything connected with the dairy interest.

A trade description, however, is not false unless it is deceptive. No one dreams for a moment that "Bath buns" come from Bath or "Swiss rolls" from Switzerland, or that "Patent leather" is protected by letters patent. There are dozens of similar titles which have lost their original significance and have become purely descriptive. Whether such a change has taken place is a question of fact to be determined by evidence as to custom and trade usage. "Harris" as applied to tweeds, and "Shetland" as applied to shawls, are descriptive of a particular style of fabric, but they retain, nevertheless, some local significance. "Havannah" as applied to cigars, and "Dresden" as applied to china, have been held to be false trade descriptions when applied to goods manufactured in England. If, however, such trade description is qualified by the addition of the maker's name and address, its misleading character is, of course, counteracted. Convention and trade usage may, on the other hand, cause a description to be deceptive which is technically correct. Thus "soda crystals" was held to be a false trade description as applied to a parcel of alkali consisting mainly of sulphate of soda (otherwise known as Glauber's salt) which is undeniably a crystalline salt, it being proved

that "soda crystals" was the conventional trade description for common washing soda, that is, carbonate of soda.

The Merchandise Marks Act further prohibits the importation of spuriously marked foreign goods, or foreign goods marked so as to suggest a British or foreign origin from which they are not in fact derived, unless they are accompanied by a definite indication of the country where the goods were made or produced. Hence the familiar inscription "made in Germany." Imported goods which bear no marks whatever are not subject to the Act and, therefore, require no statement or indication of their origin.

The Act contains special provisions with regard to the marking of watches, with the object of clearly differentiating between foreign-made watches and those made in the United Kingdom.

A prosecution under the Merchandise Marks Acts may be brought by any member of the public, or it may be instituted at the instance of the Board of Trade or the Board of Agriculture. The defendant has the option of being dealt with summarily or upon indictment. The punishment on indictment is a fine and imprisonment not exceeding 2 years. On summary conviction imprisonment is limited to 4 months with or without hard labour and the fine to £20 for a first offence and to 6 months and £50 for any subsequent conviction. Prosecutions must be commenced within a year from the time when the prosecutor becomes aware of the offence, but in no case later than 3 years from the date of its commission.

Other Penal Offences.

Any person who falsely represents that he is a Royal warrant-holder or a contractor to the Government is liable, on summary conviction, to a penalty not exceeding £20.

Any person who represents a trade mark as registered

which is not so, is liable for every offence, on summary conviction, to a fine not exceeding £5.

Anyone making or causing to be made a false entry in the Register of Trade Marks is guilty of a misdemeanour.

Deceptive Use of Names and Trading Styles.

No one can be restrained from using his own name in connection with his business, provided he does not make it a handle for deception. But where a man is found to be using his name dishonestly for the purpose of trading upon another's reputation, reaping, in fact, where he hath not sown, the Courts will grant an injunction restraining him at least from using his name in such a manner as to mislead the public. The case against a man who has taken an assumed or fancy name for the same dishonest purpose is still stronger. The Courts have gone so far in such a case as to restrain him absolutely from using the name in any shape or form in that particular line of business in which confusion is likely to occur. In all such cases, however, the plaintiff must remember that success in an action at law depends upon his satisfying the Court that deception is likely to arise, in other words, that his (the plaintiff's) name is pre-eminently associated in the public mind with the goods in question.

The same principle applies to the assumption of a trading style by a firm or company. The name must not resemble any existing trading style so closely as to lead to ambiguity and confusion. The case of *Massam* v. *Thorley's Cattle Food Co.* may be cited as a good illustration of this principle. Joseph Thorley for many years manufactured and sold extensively an article called "Thorley's Food for Cattle," made according to a secret recipe; and down to the time of his death he was the only person who made the food. His executors continued the business. Shortly after

his death a company was formed by other persons under the name of J. W. Thorley's Cattle Food Co., in which J. W. Thorley, a brother of the deceased, took a shilling share. J. W. Thorley knew the secret of the manufacture and was employed by the Company to superintend it. The Company sold the same article under the name of "Thorley's Food for Cattle." It was held that they were not at liberty to use this name unless they took such precautions as would prevent purchasers from supposing that the article sold by them was manufactured at the original establishment of Joseph Thorley.

But the same reluctance which the Courts have shown in admitting to the Register words having a descriptive or geographical significance also characterises their attitude towards the recognition of any claim to monopolise, under cover of a trading style, words that are simply descriptive of the goods traded in or the locality in which the business is carried on. Thus, upon an application of the Daimler Motor Co. to restrain another concern from trading as the Daimler Wagon Co., Ltd., the Court refused to grant an injunction on the ground that "Daimler" was a word descriptive of a particular construction of motor, which anyone trading in motors of that type was at liberty to use. This was in 1901. In 1907 the Daimler Motor Co. again applied to the Court to restrain another Company from trading under the style "London Daimler Co., Ltd." It was held on this second application that the term "Daimler" was no longer indicative of a particular type of motor, the original "Daimler" pattern having become obsolete and having been entirely abandoned in England since the last action was tried. An injunction was accordingly granted.

In the case of limited liability companies, there exists an additional safeguard against plagiarism of this kind by virtue of the Companies Act of 1862. Section 20 of that

Act empowers the Registrar to refuse to register the name of any company which is identical with that by which an existing company is already registered, or so nearly resembles it as to be calculated to deceive.

International and Colonial Arrangements.

Great Britain being a signatory to the International Convention (ratified at Paris in 1884 and supplemented by the Brussels Act of 1900), British subjects can avail themselves of the privilege of priority under the provisions of the Convention in practically all civilised countries. To obtain this privilege the application in the foreign country must be made within 4 months of the English application. Foreign subjects of Convention States, applying in England, have a corresponding privilege. But applications must conform to the English practice, and the trade mark tendered for registration must be one registrable under the Act of 1905. A list of the Convention States and other countries with whom similar arrangements have been made for the international protection of trade marks is given on page 239.

A foreigner, suing in the British Courts for infringement or "passing off," is in precisely the same position in the eye of the law as a British subject; a similar equality is accorded under Article X. *bis* of the Convention to British subjects suing in the courts of foreign States belonging to the Union.

APPENDIX C.

TRADE MARK FORMS AND FEES.

Form.	Proceeding	Fee. £	s.	d.
TM No. 1.	—Form of authorisation of Agent . . .	—		
,, No. 2.	—Application for registration of Trade Mark .	0	10	0
,, No. 3.	—Additional Representation of Trade Mark .	No stamp.		
,, No. 4.	—Request for statement of grounds of decision under s. 12(3)	0	10	0
,, No. 5.	—Application for registration of Special Trade Mark under s. 9 (5)	0	10	0
,, No. 6.	—Application for registration of Special Trade Mark under s. 62	0	10	0
,, No. 7.	—Notice of Opposition to application for registration	1	0	0
,, No. 8.	—Counter-statement to opposition to application for registration	0	10	0
,, No. 9.	—Application for hearing in cases of opposition	1	0	0
,, No. 10.	—Application to the Board of Trade for hearing under Rule 38	1	0	0
,, No. 11.	—Fee for Registration of a Trade Mark . .	1	0	0
,, No. 12.	—Renewal of Registration before notice has been given by Registrar	1	0	0
,, No. 13.	—Renewal of Registration after notice has been given by Registrar	1	0	0
,, No. 14.	—Additional fee to accompany renewal fee within one month after advertisement of non-payment of renewal fee . . .	0	10	0
,, No. 15.	—Restoration of Trade Mark where removed for non-payment of fee	1	0	0
,, No. 16.	—Joint request by registered proprietor and assignee to register assignee as subsequent proprietor	1	0	0
,, No. 17.	—Form of Declaration (only to be furnished when requested by Registrar) by assignee in support of Form TM No. 16 . . .	—		
,, No. 18.	—Request to enter name of subsequent proprietor upon register	1	0	0

TRADE MARK FORMS AND FEES—*continued.*

Form.	Proceeding.	Fee. £	s.	d.
TM No. **19.**	—Form of Declaration (only to be furnished when requested by Registrar) in support of Statement of Case accompanying Form TM No. 18	—		
,, No. **20.**	—Application for alteration of address on Register	0	5	0
,, No. **21.**	—Application to permit an apportionment of Trade Marks	5	0	0
,, No. **22.**	Request for correction of clerical error or amendment of application	0	5	0
,, No. **23.**	—Request to enter change of name of registered proprietor	0	5	0
,, No. **24.**	Application to cancel entry on register	0	5	0
,, No. **25.**	—Request to strike out goods from those for which a mark is registered	0	5	0
,, No. **26.**	—Request to enter disclaimer or memorandum	0	5	0
,, No. **27.**	—Application to add to or alter a Trade Mark	1	0	0
,, No. **28.**	—Request for search under Rule 95	0	10	0
,, No. **29.**	Appeal from Registrar to Board of Trade	1	0	0
,, No. **30.**	—Notice of Order of Court for alteration of Register	0	10	0
,, No. **31.**	—Request for general certificate	1	0	0
,, No. **32.**	Request for certificate of refusal to register	1	0	0
,, No. **33.**	—Request for certificate of registration for use in obtaining registration abroad	0	5	0
,, No. **34.**	—Request for certificate of registration for use in legal proceedings	1	0	0
	For inspecting register in connection with any particular trade mark, for every quarter of an hour	0	1	0
	For making a search amongst the classified representations of trade marks, for every quarter of an hour	0	1	0
	For office copies, every 100 words (but never less than one shilling)	0	0	4
	For certifying office copies MS. or printed matter	0	10	0
	An additional stamp duty of one shilling is also charged under the Stamp Act upon certified copies of certain documents.			

These Stamped Forms are not supplied by the Patent Office, but can be purchased on personal application at the Inland Revenue Office, Royal Courts of Justice (Room No. 6), Strand, London, W.C., or, at a few days' notice and upon pre-payment of the value of the stamp, at any Money Order Office in the United Kingdom.

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