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ON

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JORDAN & SONS, 120 CHANCERY LANE, LONDON, W.C.

A
Practical Treatise
ON
PATENTS, TRADE MARKS
AND
DESIGNS,

WITH A
Digest of Colonial and Foreign Patent Laws;

· THE TEXT OF THE
PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888
(CONSOLIDATED);

THE RULES, FEES, AND FORMS RELATING TO PATENTS, DESIGNS, AND TRADE MARKS (CONSOLIDATED); THE INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY; PRECEDENTS OF AGREEMENTS, ASSIGNMENTS, LICENCES, MORTGAGES, &c.; AND A FULL ANALYTICAL INDEX.

BY

DAVID FULTON, A.M.I.C.E.,

Fellow of the Chartered Institute of Patent Agents, and of the Middle Temple,

BARRISTER-AT-LAW.

JORDAN & SONS,
Companies' Registration Agents, Printers, and Publishers,
120 CHANCERY LANE, LONDON, W.C.

1894

P R E F A C E.

THIS work is intended to constitute a complete and concise guide to the Patents, Designs, and Trade Marks Acts of 1883 to 1888. While it is hoped that the work will be found of sufficient fulness to serve as a handy text-book for the use of the Legal Profession and of Patent Agents, the chief object of the writer has been to convey to Inventors, Patentees, Manufacturers, Traders, and the public generally a clear and definite explanation of the nature and scope of the privileges conferred by those Acts, and of the procedure by which such privileges are obtained. The author has, therefore, tried to select and enlarge more particularly upon those questions which a long and varied personal experience has shown him to be the chief points of practical interest to those to whom the book is mainly addressed.

While acknowledging the learned labours of Dr. EDMUNDS upon Patents, and of Mr. SEBASTIAN upon Trade Marks, it may be noted that, so far as the writer is aware, the present is the first and only existing treatise in which all three subjects of the

Patents, Designs, and Trade Marks Acts have been discussed with reasonable fulness by the same author.

It may, therefore, be claimed that there is room for such a work, as, irrespective of the statutory *vinculum* which exists between Patents, Designs, and Trade Marks, it not unfrequently happens that those who are interested in one of these subjects are also to some extent interested in the others.

The contents of the book have been arranged in their relative order of importance. Part I. relates to Patents; Part II. to Trade Marks; Part III. to Designs. In addition to these, Part IV. presents, in alphabetical order, Concise Digests of all Patent Laws in Foreign Countries and in the Colonies. These have been prepared from the latest available information, and the chief characteristics of each law have been grouped under certain specific headings with which it is essential that British patentees should make themselves acquainted.

Following these will be found the Acts of 1883 to 1888 in a consolidated form, and the Rules framed by the Board of Trade from 1890 to 1893 have also been consolidated and added. The essential portions of the International Convention have been incorporated, and the work concludes with some simple precedents of Agreements, Assignments, Licences, and Mortgages of Inventions and Patents, together with extracts from certain Statutes bearing upon the interpretation and construction of such documents.

With a view to abolishing foot-notes, and to obviate needless multiplication of references, the author has been sparing in his allusions to decisions, and has selected as illustrations only those cases which bear directly and unmistakably upon the points under consideration. All important rulings which have been reported up to the time of going to press have also been noted, as well as all recent changes in the rules, fees, and procedure, so that the work will be found well up to date.

In the tabulated list of cases cited, a short note is appended to each, stating the essential point or points affected by the ruling.

To prevent the work from exceeding the prescribed limits, purely litigious proceedings in Patent matters have not been specifically dealt with, and have been but briefly referred to in the Trade Marks and Designs portions. To have enlarged upon these matters would not only have unduly swelled the bulk of the book, but would also have been to some extent out of place in view of its specific and practical nature and objects. Besides, the essentials in such actions, so far as mere procedure is concerned, are now so well known to both branches of the profession that the necessity for their separate treatment has largely disappeared. The important factor is that those having the conduct of such actions should thoroughly understand the principles which govern the patentability and limits of an invention, or the registrable nature

and the extent of possible claims in or under a Trade Mark or Design, and these principles it is hoped will be clearly apparent from a study of the matter constituting the body of the book.

As the volume deals with what are practically three distinct heads of subject-matter, a separate Index has been prepared for each part, so as to avoid confusion, and the Tables of Cases have been arranged upon the same principle.

DAVID FULTON.

3 ESSEX COURT, TEMPLE,
July, 1894.

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B. & S.	.	.	-	Best & Smith's Reports.
C. B. N. S.	.	.	-	Common Bench Reports, New Series.
C. & P.	.	.	-	Carrington & Payne's Reports.
Dav. P. C.	.	.	-	Davies' Patent Cases.
De G. J. & S.	.	.	-	De Gex, Jones & Smith's Reports.
De G. & J.	.	.	-	De Gex & Jones's Reports.
De G. M. & G.	.	.	-	De Gex, Macnaughten & Gordon's Reports.
Dig.	.	.	-	Sebastian's Digest of Trade Mark Cases.
E. & B.	.	.	-	Ellis & Blackburn's Reports.
Griff. P. C.	.	.	-	Griffin's Patent Cases (pub. 1887).
Griff. A. P. C.	.	.	-	Griffin's Patent Cases before Comptroller-General and Law Officers (pub. 1888).
Good. P. C.	.	.	-	Goodeve's Patent Cases.
H. Bl.	.	.	-	H. Blackstone's Reports.
H. & N.	.	.	-	Hurlstone & Norman's Exchequer Reports.
Johns.	.	.	-	Johnson's Reports.
L. J. Ch.	.	.	-	Law Journal Reports, Chancery.
L. R. Ch. App.	.	.	-	Law Reports, Chancery Appeals.
L. R. Q. B. D.	.	.	-	Law Reports, Queen's Bench Division.
L. R. Ch. D.	.	.	-	Law Reports, Chancery Division.
L. T. N. S.	.	.	-	Law Times Reports, New Series.
N. Lon. Jour.	.	.	-	Newton's London Journal of Arts and Sciences.
Popham	.	.	-	Popham's Reports.
P. O. R.	.	.	-	Reports of Patent, Design, and Trade Mark Cases.
Q. B.	.	.	-	Queen's Bench Reports.
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W. R.	.	.	-	The Weekly Reporter.

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Bloxam v. Elsee -	1 Web. P. C. 132.	14	Alien enemy as British patentee.
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Boulton v. Watt -	2 H. Bl. 493	28	Claim for principle must be coupled with means for carrying into practical effect.
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Felton v. Greaves -	3 Car. & P. 611.	37	Bad title invalidates patent.
Foxwell v. Bostock -	4 De G. J. & S. 298.	46	In combination patents, old parts should be differentiated from new.
Gandy v. Reddaway -	2 P. O. R. 49.	50	True reading of claim sometimes settled by extraneous evidence.
Garthwaite's Patent (<i>re</i>).	Griff. P. C. 284.	59	Grant disputed before Comptroller or law officer might be issued jointly to opponent and applicant.
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Green's Patent (<i>re</i>) -	Griff. P. C. 286.	61	First applicant might formerly have incorporated subject-matter of second application by other inventor. Remedied now by third ground of opposition. (<i>See re</i> Hetherington.)
Guest v. Barrow -	5 P. O. R. 312.	61	In opposition cases, references to prior patents must not be forced on applicant.
Hampton's Patent (<i>re</i>)	Griff. A.P.C. 13.	57, 68	Caution should be exercised in accepting Comptroller's decision <i>in toto</i> before time for appeal expires.
Hancock v. Somervell	39 N. Lon. Jour. 158.	32	Publication of product not disclosing mode of manufacture will not bar grant of patent for mode of manufacture.
Harris v. Rothwell -	4 P. O. R. 225.	34	British patent anticipated by German prints in Patent Office Library.

Title of Case.	Where reported.	Pages in this book.	Chief point or points affected by decision.
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Heald's Patent (<i>re</i>) -	8 P. O. R. 429.	59	Invention of servant is not necessarily property of master.
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Lake's Patent (<i>re</i>) -	5 P. O. R. 415.	59	Comptroller or law officer not bound to notice transactions abroad.
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Pharmaceutical Society v. Piper.	L. R. 1893, 1 Q. B. 686.	89	"Patent Medicines" held to mean medicines protected by letters patent.

Title of Case.	Where reported.	Pages in this book.	Chief point or points affected by decision.
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Redges <i>v.</i> Mulliner -	10 P. O. R. 21.	74	Discontinuance of licence.
Reg. <i>v.</i> Cutler -	14 Q. B. 372	50	Failure of claimed alternative vitiates patent.
Rex <i>v.</i> Metcalf -	1 Web. P. C. 141.	37	Incorrect title vitiates patent.
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Vickers <i>v.</i> Siddell -	7 P. O. R. 292.	40	Disconformity between provisional and complete.
Vorwerk <i>v.</i> Evans -	7 P. O. R. 265.	24	Claim for new product sustainable.
Wenham <i>v.</i> May -	4 P. O. R. 303.	21	Essential of patented combination considered as protected <i>per se.</i> (<i>Proctor v. Bennis, supra.</i>)
Williams <i>v.</i> Nye -	7 P. O. R. 62	19	Mere stringing together of known parts not patentable combination.
Young <i>v.</i> Rosenthal -	1 P. O. R. 33	51	Effects of word "substantially" as used in claims.

PART II.—TRADE MARKS.

Title of Case.	Where reported.	Pages in this book.	Chief point or points affected by decision.
Adams's Mark (<i>re</i>) -	9 P. O. R. 174.	120	Held that word "patent" in <i>old</i> mark was an essential that could not be removed by amendment.
Allsopp & Sons' Mark (<i>re</i>).	5 P. O. R. 316.	120	Old marks may to a limited extent be amended.
American Tobacco Co. v. Guest.	9 P. O. R. 218.	125	Innocent infringer of registered mark not always cast in costs.
Apollinaris Co.'s Marks (<i>re</i>).	8 P. O. R. 137.	119	"Aggrieved persons" defined.
Baker v. Rawson -	45 Ch. D. 519.	119	Mark represented on registration as old, when really not so.
Burgess v. Burgess -	3 De G. M. & G. 896.	96	Defendant restrained from using sign similar to plaintiff's, though of same name.
Californian Fig Syrup Co.'s Mark (<i>re</i>).	6 P. O. R. 126.	105	Foreign mark registered abroad is not <i>on that account alone</i> registrable here.
Carter Medicine Co.'s Mark (<i>re</i>)	9 P. O. R. 401.	104	Foreign mark registered abroad is not <i>on that account alone</i> registrable here.
Cartier v. May - -	Dig. 200	125	Breach of injunction, direct and indirect.
Cheavin v. Walker -	5 Ch. D. 863	109	Article described in trade mark (or otherwise) as "patent" when no patent exists or patent expired considered in equity as deceptively described.
Churton v. Douglas -	Johns. 174	140	A person must not use his own name so as to deceive.
Condy v. Mitchell -	37 L.T.N. S. 268.	122	On dissolution of partnership, unless otherwise provided, each partner may use partnership marks.
Edwards v. Dennis -	30 Ch. D. 454	103, 110, 119, 121	If registration of mark is wrongful from the first, mark may be expunged at any time.
Grossmith's Mark (<i>re</i>)	60 L.T.N. S. 612.	117	Period of non-user of mark, amounting to abandonment.
Guinness, Son & Co.'s Marks (<i>re</i>).	5 P. O. R. 316.	120	Old marks may to a limited extent be amended.
Hanson v. Harrison -	9 P. O. R. 186.	122	Rights of partners, when separated, to marks of partnership business.
Hendriks v. Montague	17 Ch. D. 643.	140	A company registering under the Companies Acts cannot appropriate the name of an existing unregistered company.
Holloway v. Holloway	13 Beav. 209	95	A man's own name must not be so used as to be an instrument of fraud.

Title of Case.	Where reported.	Pages in this book.	Chief point or points affected by decision.
Hudson's Mark (<i>re</i>) -	32 Ch. D. 311.	118	Mark common to trade not registrable.
Hyde's Mark (<i>re</i>) -	7 Ch. D. 724	119	Mark common to trade not registrable.
James's Mark (<i>re</i>) -	33 Ch. D. 392.	107	An arbitrarily applied shape of goods may sometimes be registered as a mark in spite of rule against pictorial representations. ("Dome" blacklead.)
Jones's Mark (<i>re</i>) -	53 L.T.N.S.	122	Trade mark used in joint adventure belongs to neither party after transaction closed.
Leather Cloth Co. (<i>re</i>)	4 De G. J. & S. 137.	124	Not necessary to show that infringer of mark had intent to defraud.
Linoleum Co. v. Nairn	7 Ch. D. 834	128	Invented name for new patented product or article becomes public property after expiry of patent.
Montgomery v. Thompson.	8 P. O. R. 361.	138	A mark even when expunged as improperly registered may remain a good "common-law" trade mark.
Orr-Ewing v. Johnstone	7 App. Ca. 219.	126	A name or word may infringe a mark consisting of a picture.
Palmer's Mark (<i>re</i>) -	21 Ch. D. 53.	118	Five years' undisturbed registration is <i>prima facie</i> evidence of exclusive right, but if registration is improper <i>ab initio</i> it may at any time be cancelled.
Ransome v. Graham -	51 L. J. Ch. 897.	92	Definition of accepted principles in trade mark cases.
Read v. Richardson -	45 L. T. N. S. 54.	127	A dog's head on a beer label held to bar all other labels showing a dog's head, no matter how unlike the first.
Reddaway v. Bentham	2 P. O. R. 503.	137	An unregistered and unregistrable mark or word may constitute a good "common-law" trade mark.
Reddaway v. Peek -	3rd April, 1894.	110, 119	Mark registered for goods not dealt in by proprietor can be struck off at any time. (Edwards v. Dennis, <i>supra</i> .)
Reg. v. Ellinger -	Manchester P. C., July, 1893.	135	Combination mark consisting of various items must not be infringed by combination of similar general appearance, even although items differ.
Reg. v. Hughes <i>et al.</i>	London Daily Chronicle, 24th Oct., 1893.	134	Forged trade mark labels; punishment of printer having guilty knowledge.
Rivière (<i>in re</i>) -	53 L. J. Ch. 455.	119	"Aggrieved persons" defined.
Seixo v. Provezende -	L. R. 1 Ch. 192.	126	A name or word may infringe a mark consisting of a picture.

Title of Case.	Where reported.	Pages in this book.	Chief point or points affected by decision.
Shipwright v. Clements	19 W. R. 599	121	Trade mark inseparable from business.
Singer Co. v. Loog -	8 App. C. 15	137	A name never actually impressed on the goods as a mark may, nevertheless, constitute a trade mark, and as such may be infringed.
Singer Co. v. Spence -	10 P. O. R. 297.	128, 137	Patentee of expired patent cannot restrain use of his name to describe the principle or article made according to former patent, but he may do so when such use of name might lead the public to believe him to be the manufacturer.
Singer v. Wilson -	2 Ch. D. 434	124	In action for infringement all that is necessary is to show that mark has been taken.
Slazenger v. Feltham	6 P. O. R. 531.	129	Use of trade mark identified with patent which has been declared invalid.
Southern v. How -	Popham, 144	91	First recorded trade mark case. (<i>Temp. Elizabeth.</i>)
Spratt v. Ward -	11 Ch. D. 240	125	Trade mark cases usually heard by judge without jury.
Turton v. Turton	42 Ch. D. 128	140	Where no <i>mala fides</i> is shown, mere liability to confusion between two businesses of the same name will not justify an injunction.
Upmann v. Forester -	24 Ch. D. 231	124, 125	Innocent infringer of trade mark.
Van Duzer (<i>re</i>) -	34 Ch. D. 623	98	Registrable invented or fancy words must convey no meaning to average Englishmen, or must be non-descriptive and non-deceptive.
Wood's Mark (<i>re</i>) -	32 Ch. D. 247	119	A registered mark allowed by owner to be applied to different makers' goods becomes vitiated and may be cancelled.
Worthington's Mark (<i>re</i>)	14 Ch. D. 8	126	A mark not the same in detail but having the general appearance of a registered mark is considered an infringement.
Wotherspoon v. Currie	L. R. 5 H. L. 508.	139	A geographical name, long in use, may be sustained by first long user. (<i>Montgomery v. Thompson.</i>)
Wragg's Mark (<i>re</i>) -	29 Ch. D. 551	118, 119	Marks common to trade or previously used by others, not registrable, and if registered may be expunged. (<i>Re Thowlis & Blakey v. Hughes & Young</i> , 10 P. O. R. 369.)

PART III.—DESIGNS.

Title of Case.	Where reported.	Pages in this book.	Chief point or points affected by decision.
Adams v. Clementson	L. R. 12 Ch. 714.	148	Portrait of eminent person applied to manufactured articles held not to be registrable design. (But see judgment dissenting from this in Saunders v. Weil, <i>infra</i> .)
Bach's Design (<i>re</i>) -	6 P. O. R. 376.	150	Mere change of material, shape of article remaining the same, does not constitute new design.
Blank v. Footmann -	5 P. O. R. 653.	149, 151	Exhibiting unregistered design to customer, taking order, and leaving sample, held to be publication. Method of marking goods in bulk. (See also <i>re</i> Sherwood; Heinrichs v. Bastendorff; Winfield v. Snow.)
Cooper v. Symington	10 P. O. R. 264.	145	Design of old appearance obtained by new device held to be invention, not design: <i>e.g.</i> corset busks marked to imitate lacing, but actually secured by studs and eyes.
Harrison v. Taylor -	4 H. & N. 815.	145	New combination of old patterns may form new design: <i>e.g.</i> , placing large-space honeycomb fabric (old) over small-space honeycomb fabric (also old).
Hecla Foundry v. Walker.	6 P. O. R. 554.	142, 143	Designs to be judged by the eye. Utility to be ignored.
Heindrichs v. Bastendorff.	10 P. O. R. 160	149, 151	Merely showing unregistered design to one or two persons, not publication. Slight error in marking goods not material.
Hothersall v. Moore -	9 P. O. R. 27	146, 151	Obvious combination of old patterns held invalid (old centrepiece and old border in a duster). Insufficient marking in bulk. Publication in one class is publication in all.
Johnson v. Bailey -	11 P. O. R. 21.	152	Failure of manufacturer to keep die in good order, resulting in imperfect marking of goods, held to destroy copyright.
Le May v. Welch -	L. R. 28 Ch. D. 24.	146	Limits of what will constitute design. (Collar containing combination of three characteristics, all separately old in collars, held not a new design.)

Title of Case.	Where reported.	Pages in this book.	Chief point or points affected by decision.
Moody v. Tree . . .	9 P. O. R. 333.	144	Design not to be confounded with patentable invention.
Morris Wilson v. Coventry Co.	8 P. O. R. 353.	165	Design actions conducted on lines of patent actions.
Potter v. Braco de Prata.	8 P. O. R. 218.	155	Registration protects goods in United Kingdom only.
Saunders v. Weil . . .	10 P. O. R. 29	148, 165	View of public building (Westminster Abbey) applied to manufactured articles (spoons) held a registrable design. (Judgment in <i>Adams v. Clementson</i> , <i>supra</i> , dissented from.)
Sherwood v. Decorative Co.	4 P. O. R. 207.	153, 155	Manisty, J., on "obvious" and "fraudulent" imitation. Maximum aggregate of penalties.
Sherwood's Design (<i>re</i>)	9 P. O. R. 268.	150	Two globes of new design sold three days before registration held prior publication.
Smith v. Hope Bros. . .	6 P. O. R. 200.	148	Limits of design. (A scarf in which the sole new feature was one or two additional folds or pleats, held not to show a registrable design.)
Smith v. Lewis, Roberts & Co. . .	5 P. O. R. 611.	154	Innocent retailer unwittingly selling goods of registered design held not liable.
Tyler v. Sharp . . .	11 P. O. R. 35.	147	Even where design appears slight, commercial success will weigh with the Court in deciding upon validity of registration.
Walker v. Scott . . .	9 P. O. R. 482.	144	Mere modification of shape of existing thing may constitute new design. (Example: rounding the formerly sharp edges of a cyclist's oil-can.)
Winfield v. Snow . . .	8 P. O. R. 15.	149	Pattern exhibited to customer and order taken fortnight before registration, held to be publication.
Wittmann v. Oppenheim.	L. R. 27 Ch. D. 260.	152	Mistake in marking by manufacturer, the proprietor having supplied correct die held not to destroy copyright.
Woolley v. Broad . . .	9 P. O. R. 208.	164	Exclusive licensee of registered design cannot take action alone for infringement.

PART I.—PATENTS.

CHAPTER I.

INTRODUCTION.

AT the present day Patents, Designs, and Trade Marks are granted and registered under the provisions of "The Patents, Designs, and Trade Marks Acts, 1883 to 1888." The union of the three species of property in the titles of these Acts seems to imply a closeness of similarity which does not really exist. A few words will serve to differentiate them.

Existing
law of
Patents,
Designs,
and Trade
Marks.
Patents,
Trade
Marks, and
Designs
differ-
entiated.
Patent.

Where a Patent has been granted, say for a new description of lamp, the manufacture and sale of the lamp become a monopoly, and every lamp of the same or substantially the same construction which is made and sold by others, without leave or licence, is a distinct damage and loss to the Patentee.

But where a trader has registered a Trade Mark for a lamp which is not the subject-matter of a Patent, all the world may make and sell precisely the same lamp, with this restriction only, that they must not sell it under the registered trade mark, for this would be to represent the article as having been made by the owner of the trade mark.

Trade
Mark.

A Design, on the other hand, like a Patent, has reference to the specific substance or *corpus* of an article, but rather from an artistic or configurative than from a functional point of view. Thus the patented portion of the lamp might relate to a new automatic safety extinguisher, which might be made and applied and be operative in several

Design.

forms and still be within the scope of the Patent, while the Design Copyright might refer to the decorative stand supporting the lamp, which could not be varied from the registered design without going outside the limit of protection.

To follow the subjects of this work in their relative order of importance, it is proposed to treat First, of PATENTS; Secondly, of TRADE MARKS; and, Thirdly, of DESIGNS.

CHAPTER II.

THE ORIGIN AND HISTORY OF PATENT LAW.— THE PATENT LAW AMENDMENT ACT, 1852.— THE PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

TO ASSIST the reader to a proper understanding of Patent Law as now existing, it may not be unprofitable to give a short sketch of its earlier history.

Origin of
Letters
Patent for
Inventions.

Crown
Grants.

First re-
corded
Patent for
Invention.

Letters Patent for Inventions are the offspring, or rather the survival, of the ancient Royal Grants of Monopoly. From the earliest times it has been recognised that the Sovereign was at liberty to exercise the prerogative of making special grants to subjects. These grants were made known by "Open Letters," or *Litteræ Patentes*, addressed to all subjects of the realm, so that the privileges granted should not be questioned from want of knowledge. It is evident that from the first, new inventions, new manufactures, and advances in arts and sciences, were considered favourable subjects for protection by these Royal Grants. It may be said that the first Patent for an Invention of which we have record was issued by King Edward III. in favour of an alleged discovery of the philosopher's stone.

With lapse of time, however, the perverted custom of granting monopolies in the exercise of trades and in the sale of goods grew to such an outrageous extent, that in the reign of Elizabeth a vast number of commodities, representing in some cases the merest necessities of life, were in the hands of patentees or monopolists, who used their powers in the harshest and most arbitrary manner to enforce their rights. The supplies of coal, salt, vinegar, iron, steel, bottles, glass, lead, oil, tin, sulphur, pots, brushes, currants, and numbers of other products, natural and artificial, home and foreign, were governed by monopolists, who stood so little on conscience that, in certain places, that prime necessity of life, salt, rose from sixteen pence a bushel to fifteen shillings. According to the historian Hume, a list of these things, read in the House of Commons, brought to his feet an indignant member, who vowed to his astounded hearers that if things were allowed to go on at this rate "bread itself would be reduced to a monopoly."

Early trade monopolies and their abuse.

But this represents the high-water mark of monopolies, and in the succeeding reign of James I. the whole vicious system was done away with by the famous *Statute of Monopolies*. At one stroke of the pen the bulk of these unjust and restrictive privileges was declared "utterly void and of none effect, and in no wise to be put in use or execution." One of the exceptions to the general extinction of monopolies was made by Sections 5 and 6 of the Statute, in favour of Patents for Inventions, then in force and thereafter to be granted, and this is still the basis upon which patent rights stand at the present day. For example, by the 6th Section the term of a patent is limited to fourteen years, and the subject-matter is shortly defined as "any manner of new manufactures, which others at the time of making such letters patents and grants shall not use." The patent must be granted to the true and first inventor; the invention must be novel; the privilege must not be contrary to law, nor mischievous to the State, nor hurtful to trade, nor generally inconvenient. The term

Statute of Monopolies (21 Jac. 1. c. 3), 1624.

Monopolies abolished.

Sections 5 and 6 reserve patents for inventions and become the basis of patent right.

Subject-matter and conditions of Patents defined.

of fourteen years seems to have been fixed by doubling the usual period of apprenticeship—*i.e.*, seven years.

Reasons for fixing the duration of patent right.

Probably the draftsman of the section reasoned that if the inventor of a new manufacture trained an apprentice in the art for seven years, it was but just that he should have the services of the skilled workman, at skilled workman's wages, for another seven years, before the pupil should be at liberty to exercise the art for his own personal advantage. Indeed, under the earliest practice it was customary to insert a proviso in the grant, requiring the inventor to take apprentices during the last seven years of the term, if he had not done so before.

After-history of patent law.

The privilege of Letters Patent for Inventions, having been thus saved from the general wreck of Monopolies brought about by the Statute of James I., thereafter passed through a long period of comparative obscurity, to endeavour to trace which would only weary without instructing the reader. As to the procedure in obtaining a patent, this became a model of circumlocution.

Circumlocutive procedure in early times.

Petitions, declarations, reports, references, warrants, stamps, bills, and seals were bandied about from office to office, existing only for the extraction of fees from the patentee. The Home Office, the Law Officers' Chambers, the Patent Bill Office, the Signet Office, the Privy Seal Office, the Letters Patent Office, and finally the Lord Chancellor's Office, each appeared in turn with mystic powers and itching palm. Nor must the Enrolment Office, the Petty Bag Office, and the Office of the Rolls Chapel be forgotten, although these were chiefly repositories of the enrolments and beyond the purview of the patentee.

Lord Coke instances this multiplication of fee-exacting offices as an example of "the wisdom of prudent antiquity, that whatsoever should pass the great seal should come through so many hands, to the end that nothing should pass the great seal . . . that was against law or inconvenient." But we moderns may be pardoned for surmising that institutions for which so clever an apologist could only find so meagre an excuse were ripe for removal.

Separate patents for England, Scotland, and Ireland.

England, Scotland, and Ireland had each its separate patent, the fees for protection in all three amounting to

about £300. With the addition of attorneys' and other charges, the entire cost to the patentee of a patent covering the United Kingdom cannot, in those days, have been less than from £500 to £700. *In re Kay's Patent* (1 Web. P. C. 568) the accounts showed the patent to have cost £500. Up to the reign of Queen Anne no Specification seems to have been required, but after 1711 the enrolment of a Specification became compulsory.

As time went on, and as the volume of patent business increased, the attention of legislators was directed more and more to projected improvements in the patent law. Slight changes in the procedure were made, and the power of entering a disclaimer of any part of his Specification was granted to the patentee by 5 & 6 Will. IV. c. 38. The right of application for extension of the term of fourteen years was provided for under 7 & 8 Vict. c. 69. Following these Acts, there came—

5 & 6 Will.
IV. c. 38.
(Dis-
claimer.)
7 & 8 Vict.
c. 69. (Ex-
tension.)

THE PATENT LAW AMENDMENT ACT, 1852.

The changes effected by this Act were important.

One patent now covered Great Britain and Ireland, the Channel Islands, and the Isle of Man. The whole business of the Commissioners of Patents was conducted in one office under a responsible head. The stages of procedure were reduced to—(1) The Application, with Provisional or Complete Specification; (2) Giving notice of intention to proceed with the application; (3) Applying for the Warrant and Seal; and (4) Filing the Complete Specification (if this had not been done at the time of application). This option of filing a provisional description of the invention at the time of application, and following it up within six months afterwards with a Complete Specification, was a new element in patent procedure which has proved extremely satisfactory in practice.

Patent Act
of 1852.

One patent
for the
United
Kingdom.

Introduc-
tion of
Provisional
Specifica-
tion.

Under the Act of 1852 the mere stamp duties payable on obtaining a patent amounted to £25, and the sums payable at the end of the third and seventh years respectively were £50 and £100, so that the total amount

Fees under
Act of 1852.

payable in stamps alone, on a patent obtained and kept in force for the full term of fourteen years, was £175.

Agitation
for changes
in pro-
cedure.

Examina-
tion system
considered.

In course of time an agitation sprang up calling chiefly for a reduction of the stamp duties, and for the adoption of the American system of examination into novelty and patentability. This agitation gathered force as years went on, and finally resulted in the passing of the present Act of 1883. A careful consideration of much conflicting testimony led the framers of the Bill to exclude the examination system. There is no reasonable doubt that, in spite of the popular clamour for its adoption, the system of examination, as now in force in America and Germany, has many evils which will always militate against its adoption here. That any examiner, whether principal or secondary, should have the power to pare down claims or absolutely to refuse the grant of a patent, is going too far. In many cases, no doubt, the examiners are able to refer to a prior invention, the same or nearly the same as that of the applicant, and in such a case no sensible man could feel aggrieved at the refusal of his application. But where, as is sometimes the case in America, and very frequently the case in Germany, the examiner exercises a perverse ingenuity in discovering anticipations and analogies that are apparent to no one but himself, and exhibits a crass determination not to be convinced of his error, the drawbacks of the examination system become too apparent to be ignored. Besides, apart from rejections on the score of anticipation, it is not unusual for a manufacturer who has invented some apparently slight but really important and valuable advance in his art to have his application for a patent in those countries met by the objection that it is not patentable subject-matter, advanced possibly by an official who knows absolutely nothing of the industry in question, and who is quite incapable of appreciating the advantages and importance of the invention submitted to him. Thus it has frequently happened that inventions which have realised large sums of money in royalties in England have been refused protection in America and in Germany on the plea of lack of novelty or of patentability. It may seem, and no doubt it is, a pity that

patents should be granted over and over again for the same thing; but the writer is persuaded that more injustice would be done than good effected by the adoption of the system of examination, if accompanied with the power of arbitrary refusal or arbitrary dictation as to the form the Claims shall assume. As to the supposed security of patents which have been granted under the examination system, it is sufficient to state that as large, if not indeed a larger, proportion of patents granted in the United States are declared invalid in courts of law than is the case with patents granted in this country.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

If the reader has followed the foregoing historical *résumé*, it will have been noted that the Act of 1852 made no real change in the principles of patent law. It was merely an amending Act, by which the procedure was simplified, the cost decreased, the United Kingdom placed under the scope of one patent, the principle of the Provisional Specification adopted, and sundry regulations promulgated relating to the conduct of litigation.

Act of 1852
not an
originating
Act.

No change was effected in fundamental principles, and no attempt made to define afresh the subject-matter of patents. For a definition of the expression "Invention" the reader of the Act was referred to the old Statute of Monopolies. As in the case of the Act of 1852, so it is with the Act of 1883. By this Act the procedure has been still further simplified. The fees and stamps on the obtaining of a complete patent are reduced from £25 to £4, while the fees for maintaining the patent in force during the full term of fourteen years have, under recent Rules, been reduced from £150 to £95.

Patents,
Designs,
and Trade
Marks Acts,
1883 to 1888.

Procedure
simplified
and fees
reduced.

These and sundry provisions having reference to the regulations of legal proceedings, the amendment of Specifications, oppositions, &c., represent the bulk of the changes made by the present Acts.

Having thus glanced broadly at the origin and development of patents for inventions up to the present day, we can now with greater profit proceed to discuss the present

patent law. It will be found that almost every phase of the subject which need be touched upon can be grouped under one of the following headings:—

1. Procedure in Obtaining Patents.
2. Who may be a Patentee.
3. Subject-Matter of Patents.
4. The Specifications (Provisional and Complete).
5. Oppositions to Applications.
6. Sealing of the Patent.
7. Amendment of Specifications.
8. Assignments, Licences, &c.
9. Extension of Patents.

CHAPTER III.

PROCEDURE IN OBTAINING PATENTS.

Application
for patent.

How to fill
in forms.

Signature of
applicant.

AS FAR as the merely formal steps are concerned, an application for a patent is a very simple matter. The respective forms and stamps are on sale at all postal money order offices in the United Kingdom, and when filled in can be delivered or posted direct to the Patent Office in London. The application papers consist of a declaration (Form A), stamped with £1, in which the applicant must insert his full name, address, and occupation, and give the title of the invention. He must declare that he is the true and first inventor; that the same is not in use by any other person or persons to the best of his knowledge and belief; and must sign his name at the foot of the form. If the inventor wishes to apply for provisional protection only, he will receive with Form A two unstamped copies of Form B, upon which he should write and sign his Provisional Specification. The declaration and two copies may then be posted to the Comptroller-General at the Patent Office, and the business is complete.

By return of post the applicant will receive his certificate of filing, and in the next week's issue of the *Illustrated Official Journal (Patents)* the application is advertised. In about three weeks or a month afterwards (granted that his Specification is sufficiently intelligible, and that his papers have been filled up according to the instructions given) he will receive the certificate of acceptance, and this also is advertised. The Specification itself is kept secret during the term of provisional protection. At any time within nine months from the date of his application the applicant may file his Complete Specification. The form for this (Form C) can also be purchased at a postal money order office. These forms are supplied in duplicate, and one copy bears a stamp of £3. The Complete Specification must be prepared in accordance with this form and upon the lines and limits laid down by the Provisional. It should conclude with a clear statement of what the inventor claims as new, and should, when necessary or desirable, be accompanied by line drawings executed in indian ink, and without the use of colour or brush shading, so as to be suitable for reproduction by photo-lithography. Such drawings are to be made on cardboard sheets, in duplicate, size 13 inches in height by 8 inches in width, or, if this is too small, 13 inches in height by 16 inches in width. A marginal line should be placed round the sheets half an inch from the outer edge. On one of the copies of the drawing (marked "Original") the reference lettering should be in indian ink; the other copy should be marked "true copy," and the lettering should be in blue pencil. Both copies should be signed. When the Complete Specification has been dispatched to the Patent Office, a certificate of filing will in due course be received by the applicant. The examiners in the Patent Office now compare the Provisional with the Complete Specification, and if they accord with one another, and are properly prepared in compliance with the Rules, a certificate of acceptance is issued and advertised in the aforesaid Official Journal. About three weeks afterwards the Complete, together with the Provisional Specification, is generally printed and

Certificate of filing.

Advertisement of application.

Acceptance.

Complete Specification.

Drawings.

Differences in duplicate copies of drawings.

Comparison by examiners of Provisional with Complete.

Acceptance of Complete.

Publication of Specifications.

24 drawings

Period for
opposition.

published. Within two months from the date of the Journal in which such advertisement appears, any person interested in so doing may give notice of opposition to the application. But if these two months should pass without opposition being offered, a patent is sealed and issued to the applicant.

Sealing of
Patent.

Provisional
Specifica-
tion may be
dispensed
with.

The foregoing is an exact account of the procedure when a Provisional Specification only is filed with the application, and afterwards followed up by a Complete Specification. But it should be said here that the applicant has the option of filing a Complete Specification in the first instance instead of a provisional description. Each course has its advantages, and the simplest plan will be to lay these in order before the reader.

Advantages
of filing
Provisional
Specifica-
tion with
application.

First.—If application is made for provisional protection only in the first instance, the advantages are that the preliminary cost is less, while the applicant has nine months during which he may, without fear, test the value of his invention either publicly or privately, improve upon the details, make searches as to its novelty, sell or agree to sell his discovery or its products, and, in short, deal with his invention just as if he had a patent, except in this respect, that he has no right of action against infringers until he has obtained his patent, and then only in respect of infringements committed after publication of his Complete Specification (Patent Act, Section 13). To these should be added the consideration that, as the Provisional Specification may be a document much less exact in its terms than a Complete Specification, an application for provisional protection may be filed at a stage in the conception of the invention when it might be impossible or injudicious to give full details.

Time is also given to consider the subject of foreign patents. Lastly, if the invention should prove disappointing, the application may be abandoned without incurring further expense, and without rendering the invention public property, seeing that the Specifications of all abandoned applications are never published, but remain secret. Therefore, if the applicant should afterwards be able to remedy the defects in his invention, there is nothing to prevent him from renewing and completing

his application, granted that he has not in the meantime published his idea, or that some other inventor has not crept in after the date of his first, but before the date of his second application. In practice the vast majority of applications are accompanied in the first instance by a Provisional Specification only.

Secondly.—If application is made accompanied by a Complete Specification, the advantages which exist are much less obvious. Where an agent is employed, there is, no doubt, some slight saving in agency fees. The total stamp amounts are the same in either case—viz., £4. The acceptance and publication of the Complete places the applicant at once in a position to deal with infringers as soon as he gets his patent into his hands. On the whole, it may be said that a Complete Specification should accompany the application only where the details of the invention are fully worked out, and where the applicant has no reasonable doubt of the novelty, utility, and assured practical success of his invention.

Filing Complete in first instance.

In the foregoing description of the mode of procedure it has been assumed that the Provisional and Complete Specifications are prepared by the inventor himself. But, if the writer may be allowed to express an opinion, grounded upon long experience, the preparation of the Specification by the inventor himself is not a course to be recommended. No prudent man attempts to draw a conveyance, mortgage, will, or other legal instrument without the assistance of a properly qualified adviser, and this care is no less essential in the case of Patent Specifications. The fatal facility with which any person, fired by some crude idea, can rush into a post-office, buy a form, scribble a few incoherent lines, and breathlessly post the whole to the Comptroller, is by no means an unmixed benefit, and has its result in a flood of rubbish poured into the Patent Office every year. Probably a very large proportion of the applications thus made would never have been filed at all had they been submitted in the first instance to the calmer judgment of an experienced and properly trained patent agent.

Some reasons for the employment of Patent Agents.

But, apart from this, should the invention really con-

tain some valuable subject-matter, the assistance of a professional adviser would in many instances have enabled the inventor to reap results of which his own precipitancy and self-confidence have deprived him. Undoubtedly there are many inventions so simple that a plain man using plain language can express the gist of his invention sufficiently well to satisfy requirements. But in all cases the burden is laid upon the applicant, that the Specification and Claims shall be prepared with "reasonable skill and knowledge," and if these essentials are wanting, nothing can save the patent from being upset should it come to be tested in a court of law.

To return from this digression, it has been said that, where a Provisional Specification has been first filed, the Complete should be lodged before the expiry of the succeeding nine months. If, from any excusable cause, this term should elapse without the Complete being filed, an additional month within which to lodge the Complete may be had upon payment of a fine of £2. If no Complete is filed within the extreme allotted time—that is, within ten months from the date of application—the application is considered to be abandoned.

The examination of the Complete Specification has already been referred to. If the examiner should report that the Complete Specification does not properly describe the invention, or goes beyond the Provisional, or that the claims are absent or imperfect, or that more than one invention is claimed, the Comptroller may refuse to accept the Specification until these faults have been corrected. If the applicant disputes the justice of these objections, he may appeal to the Law Officer, who will either sustain or rebut the Comptroller's decision.

Oppositions will be treated under the heading specially devoted to that subject (see Chapter VIII.).

If no opposition is entered, or if the opposition is unsuccessful, the patent is issued and dated as of the day of application.

The patent is granted for fourteen years, and covers the United Kingdom of Great Britain and Ireland and the Isle of Man.

Time for filing Complete may be extended for one month.

Duties of the examiners with regard to Complete Specification.

Comptroller's objections to Specifications may be appealed against.

Patent dated as of date of application.

Duration of patent.

At the end of the fourth year, annual payments are required to keep the patent in force. According to the most recent scale the annual fees are as follows:—

Renewal fees on patent.

	£	s.	d.
Before the end of the fourth year, and in respect of the fifth year	5	0	0
Before the end of the fifth year, and in respect of the sixth year	6	0	0
Before the end of the sixth year, and in respect of the seventh year	7	0	0
Before the end of the seventh year, and in respect of the eighth year	8	0	0
Before the end of the eighth year, and in respect of the ninth year	9	0	0
Before the end of the ninth year, and in respect of the tenth year	10	0	0
Before the end of the tenth year, and in respect of the eleventh year	11	0	0
Before the end of the eleventh year, and in respect of the twelfth year	12	0	0
Before the end of the twelfth year, and in respect of the thirteenth year	13	0	0
Before the end of the thirteenth year, and in respect of the fourteenth year	14	0	0

If by accident the payment of an annual tax should be overlooked, an extension of time of from one to three months can be had to pay the annuity, on payment of the following fines:—

Time to pay renewal fees on patent may be extended from one to three months.

	£	s.	d.
On extension of time for one month	1	0	0
" " " two months	3	0	0
" " " three months	5	0	0

In the event of the Letters Patent being lost or destroyed, the Comptroller may, on a satisfactory explanation of the disappearance of the original, cause a duplicate to be sealed and issued on payment of a fee of £2.

Duplicate of lost Letters Patent may be obtained.

The question of Amendments of Specifications will be treated under its proper heading (see Chapter X.).

CHAPTER IV.

WHO MAY BE A PATENTEE.

Persons
entitled to
become
patentees.

ANY person, of either sex, whether a British subject or an alien, may be a patentee. Even those who are generally considered under legal disabilities, such as infants and lunatics, may become patentees, so long as the necessary documents are prepared in the prescribed manner. No inquiry is made by the Patent Office as to the age, sanity, or coverture of the applicant.

It is submitted that exceptions to this general rule exist in the case of the Sovereign, on the principle that the Crown cannot make a grant to itself. Again, although many such patents exist, it may be doubted whether a beneficed clergyman can legally become a patentee, in view of the prohibition from trading under 1 & 2 Vict., Cap. 106, Sections 28 to 30. The question whether an alien enemy is incapacitated as a patentee was raised, but not decided, in *Bloxam v. Elsee* (1 Web. P. C. 132). The probability is that he would not be ousted on that account alone.

Joint
patentees.

Two or more persons may make a joint application for a patent, and it is provided that an application may legally be made by the inventor or inventors in conjunction with another or with others who are not joint inventors. Thus an invention may be patented in the joint names of the inventor and a capitalist with whom he has agreed to associate himself. The name or names of the actual inventor or inventors should, however, be specified in the declaration.

Inventor
and non-
inventor.

Importers.

The term "Inventor" is not under the Act confined to a person who evolves an invention from his own mind. The term is also used to designate one who first introduces or imports an invention from abroad. A patent granted to such an applicant would be perfectly

valid if it could be shown to be unknown and unpublished in this country at the date of the application. However, if the invention has been previously patented or protected abroad, the foreign inventor has the privilege, in those countries which have become parties to the International Convention, of making an application here within six months and obtaining the same date as that of the original patent abroad. In countries "beyond the sea"—such, for example, as America—an additional month is allowed.

Rights of foreign inventors under International Convention.

If an inventor should die before applying for a patent, his legal representatives may make the application, and if his death should occur after the application, but before completing, his legal representatives may proceed and obtain the grant of the patent.

Rights of legal representatives of deceased inventor or applicant.

A person resident in this country may patent in his own name an invention communicated to him by the actual inventor abroad. In such cases it is usual, though not essential, to indicate the source from which the knowledge has been derived.

Communicated inventions.

CHAPTER V.

SUBJECT-MATTER OF PATENTS.

IT HAS been said that neither in the Patent Law Amendment Act of 1852, nor in the more recent Acts of 1883 to 1888, has any attempt been made to define the meaning of the term "Invention." In both instances the reader is referred back to the ancient Statute of Monopolies. Referring, then, to Section 6 of this Statute, we find that letters patent and grants of privilege are limited in favour of "the sole working or making of any manner of new manufactures

Definition of "Invention."

Statute of Monopolies, Section 6.

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 grant, 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.”

“Invention” means new manufacture.

Therefore the subject-matter of letters patent must be some “*manner of new manufactures.*” It is very unlikely that the old draftsman in setting down this definition of subject-matter had any glimpse of the magnitude of the interests that would be created by this Section 6 of his Bill. The clause was the earliest legislative recognition of the public policy of allowing temporary privileges to the inventors of new manufactures. It is the basis of our present law, and the cradle of the still more gigantic patent system in force across the Atlantic.

“Manufacture” means both manner of making and product.

The discussions that have taken place upon the true meaning of the “working or making of any manner of new manufactures” only prove how unintentionally well chosen and comprehensive the expression really is. “Manufacture” has been held to be synonymous with “invention,” and to mean not only the process of making, but also the thing produced. For example, “manufacture” as applied to hatting might mean (a) the machinery by which the hat is made, or (b) the successive steps or processes to which the hat body is subject, or (c) the hat itself. It was admitted, says Chief Justice Eyre in *Boulton v. Bull* (1795, 2 H. Bl. 482), that “manufacture” is applicable not only to things made, but to the practice of making; to principles carried into practice in a new manner; to new results of principles carried into practice. Thus the term excludes a mere barren principle, no matter how great the discovery may be, so long as no immediate practical result useful to individuals or to trade is brought about. In other words, the mere laying bare of a physical law or force which has been in existence since the world began, no matter how tremendously it may increase the scope of our knowledge and the sum of our wealth, cannot be patented. Thus, to instance extreme

But does not include bare principle.

cases, Newton could not have patented his discovery of the laws of gravity; nor Harvey his, of the circulation of the blood; nor Franklin his, of electricity. But lesser minds coming after these great intellects may, by cunning devices, put these newly awakened Titans into harness, so that they shall grind corn, pump water, or carry messages, and for these devices patents will be granted.

At one time it was doubted whether the language of the statute extended to processes, but the decision in *Crane v. Price* (1842, 4 M. & G. 580) affirmed emphatically that it did. Therefore a process, whether it be chemical or mechanical, is good subject-matter for a patent.

Manufacture includes processes. *Crane v. Price.*

For the purpose of splitting up subject-matter into a few heads which may repay separate examination, it will serve to consider patentable inventions as divisible into the following six classes, viz. :—

- (1) New and useful machines or things, for new or old purposes, and improvements in existing machinery or things.
- (2) New and useful combinations of mechanical parts or of materials.
- (3) Improvements in existing manufactures, processes, or parts of processes.
- (4) Novel and useful results of chemical and mechanical processes.
- (5) New or improved processes, for which special machinery may or may not be necessary.
- (6) New principles, when coupled with a mode of carrying the same into practical effect.

Classes of subject-matter.

A short examination of each of these heads, with an example attached, will assist the reader to understand them more fully.

(1) *New and Useful Machines for New or Old Purposes, and Improvements in Existing Machinery.*

A new machine or contrivance may also be for an entirely new purpose, or it may be for use in connection with an old purpose. The first is an extremely rare

New or improved machinery.

class of invention. The second is most common. As an example of the first, take the subject of the transmission of speech over a long distance by electricity. Here was a new purpose, and the telephone, with its vibrating plates, transmitter and receiver, formed a new apparatus for this new purpose. Therefore the telephone was a patentable invention of the highest order—namely, a new apparatus for a new purpose. As an example of a new machine for an old purpose, one of many will suffice. Sewing is among the oldest of arts. But the first sewing machine was an absolutely new contrivance for this old purpose: therefore it formed patentable subject-matter.

Improvements in existing machinery may be said to form the bulk of patented inventions. For example, there are hundreds of patented improvements on the original sewing machine. Indeed, in all classes of machinery of which large quantities are used, an improvement which to an outsider may seem but a very slight advance is often the source of fortune to its inventor, and is patentable subject-matter. In *Moser v. Marsden* (10 P. O. R. 350) Lopes, L.J., says that a new mode of using an old machine by altering it, involving the exercise of invention and ingenuity in its application, is good subject-matter for a patent. In the above case, in which the Court of Appeal affirmed the validity of the patent for the well-known Moser “raising” machine, the evidence showed that the advance effected by the patentee upon prior inventions for the same object, although apparently slight, had *practically* been exceedingly successful, and this had great weight with the Court in supporting the patent. Additions to or improvements on existing patented machinery or things may also be made, and in their turn patented. If the improvement is separable from, and is no essential part of the existing patented machine or thing, it may be made and sold separately. But if it forms an integral part of the machine or thing, and is useless apart from it, it would evidently be of little advantage to the inventor, as he could not make use of the original invention without the sanction of the original patentee. On the other

Consideration given to great practical success of slight improvement.

Improvements on existing patented inventions.

hand, the original patentee could not make use of the improvement without the permission of the second patentee, and, as a consequence, the second patentee might find his reward in selling or licensing to the original patentee.

(2) *New and Useful Combinations of Mechanical Parts, and of Materials.*

Although patents are granted for combinations, it must be said at the outset that a combination to warrant a patent should show invention. Obvious combinations are not good subject-matter. Therefore, in every case it is necessary to take the merits into consideration, to decide whether or not the effecting of the combination shows the exercise of invention. And, first, take the simplest form of combination—viz., the mere coupling together of two well-known things which have heretofore acted separately, but which on being connected give a continuous operation. A good example of this is to be found in *Williams v. Nye* (7 P. O. R. 62). The plaintiff in this case had merely taken a well-known mincing-machine and an equally well-known machine for filling skins, and connected them together, so that the mincing and filling operations were continuous, instead of being interrupted as before. The result was a sausage-making machine which was proved to be most useful, meritorious, and economical. Nevertheless, the Judges of the Court of Appeal expressed themselves as satisfied that there had been no such exercise of the inventive faculty as to make the plaintiff's machine subject-matter for a patent. Even where the combination was apparently not quite so easy to effect, the patent could not be upheld. In *Saxby v. Gloucester Waggon Co.* (L. R. 72, Q. B. D. 305) a decision adverse to the patent was grounded on the same objection, although this was less obvious than in *Williams v. Nye*.

Combinations.

Combination must show "invention."

Still, even this simplest type of combination—viz., the connecting of two well-known machines—might be patentable if the method and means used to connect them required invention. For example, merely to place a folding machine in line with a printing machine so as to print and fold continuously instead of separately as

before, would not be invention if nothing more were done. But if the continuous printing and folding involved some necessary transmitting mechanism, requiring design and the exercise of invention, to pass each printed sheet to the folders, then the combination would be patentable subject-matter.

Combina-
tion of a
concretion
and an
abstraction
not patent-
able.

It is unsound to claim the combination of a concrete thing with an abstract property or qualification. Chief Baron Pollock in trying, although not very happily, to express this, once said, "You cannot have a valid claim for the combination of $2\frac{1}{2}d.$ with a pound of butter." An example will help the point to be better understood. We will suppose that rollers covered with porcelain were well known as being the best rollers that could be used for crushing grain. Suppose it were afterwards discovered that to make one roller run a little faster than the other produced a grinding as well as a crushing effect, which vastly improved the result, by separating the germ from the starch part of the grain. Here is a real invention. It cannot be said that the idea is unpatentable. But, at all events, the claim that was really made—viz., "The combination of porcelain rollers with *differential velocity*"—proved to be untenable.

Almost the largest class of patented inventions is that of combinations of mechanism. These may consist of combinations of mechanical parts or groups of parts. The combination may consist of mere rearrangement, addition, or subtraction. The parts or the groups must not be independent of each other, nor must the connection of the groups be known or obvious. The combination may consist entirely of old parts or groups, and in such a case the patentee is usually tied somewhat closely to the arrangement shown and described. Therefore, an infringer might, by changing the combination to a greater or less extent, place himself outside of the scope of the patentee's claims.

Combina-
tions which
include new
element.

On the other hand, a combination may include an entirely new element, which is, however, dependent for its utility upon its connection with the combination. Here the patentee is in a better position, and any attempt to

evade or use an equivalent for the described combination, so long as the new element is pirated, will be severely scrutinised by the Court. A good example of this was instanced in the case of *Proctor v. Bennis* (4 P. O. R. 333). The subject of the patent was a mechanical stoker for feeding coal into boiler furnaces. Before the date of Proctor's patent, mechanical stokers had been in use in which there was a reciprocating fuel-pusher working horizontally, and drawn slowly back and shot quickly forward by an arrangement of springs, shafts, and tappets. Proctor had an arrangement of springs, shafts, and tappets almost identical with what had been used before, but instead of a sliding pusher he had a flap, hung vertically upon a hinge pivot. It was shown at the trial that the circular sweep of the pivoted flap had great advantages over the horizontal pusher, as being a more close approximation to the swinging and spreading action of hand stoking. The pivoted flap was not claimed separately for the specific purpose, as, strictly speaking, it ought to have been, but was claimed in combination with the specified arrangement of shafts, springs, and tappets, the latter having almost no feature of novelty. The defendant had altered this arrangement so as to differ from that of Proctor, but had appropriated the pivoted flap, evidently relying upon this not having been separately claimed. This, however, did not save him. In spite of the fact that no specific separate claim had been made for the hinged flap, this was described in the judgment as the "pith and marrow" of the invention, and the decision was, that the defendant, having taken the gist of the invention, although he avoided the actual combination shown and claimed, must be held to have infringed.

In *Wenham v. May* (4 P. O. R. 303) the patentee had invented a gas lamp in which wire gauze screens were used in certain specified positions, the said gauze screens being claimed "as described and shown." The defendants also used gauze screens, but not in the same positions as in the plaintiff's lamp, their defence being, practically, that they had not infringed the specific combination claimed. It was held that both upon the evidence and the Specifica-

*Proctor v.
Bennis.*

*Wenham v.
May.*

tion, the object of the plaintiff's invention was to equalise and regulate the regenerative air-currents by means of wire gauze screens, irrespective of the specific arrangement, and that the defendants by adopting such gauze screens had infringed the essence of the plaintiff's patent. A lesson on the essential of an apparatus or combination may also be had from a consideration of the *Automatic Weighing Machine Company's* case (9 P. O. R. 41).

In passing from mechanical combinations to those of materials we enter another field. A number of possible examples could be easily suggested. Thus, different materials may be mechanically mixed so as to produce new and useful results, such as linoleum floorcloth for example. New compositions of colours, varnishes, and cements might be so produced. In the same manner, the combination of two materials, viz., caoutchouc with a woven fabric, results in a new product, *i.e.* a waterproof cloth; or the combination of two or more metals results in a new alloy. All of these are patentable.

(3) *Improvements in Existing Manufactures, Processes, or Parts of Processes.*

In order to differentiate the selected heads that have been set down as representing the main divisions of subject-matter, and so to avoid repetition, it will be necessary to consider the word "manufacture," not always in the broad and general terms extracted from the Statute of Monopolies, but sometimes in its narrower and more generally understood sense.

Restricted meaning of "manufacture."

"Manufacture" under the present heading must therefore be taken to represent the "making of anything by hand or by art," such, for instance, as the weaving of cut pile fabrics, the making of lead piping, or the production of gas.

For example, in the manufacture of pile fabrics, instead of the usual plan of weaving the pile in loops and cutting these loops by an after operation, an inventor might produce a new method of weaving pile fabrics face to face in a double web, and cut the pile by the after

operation of separating one fabric from the other, thus saving time both in the weaving and in the pile-cutting. Another inventor might propose to cut the pile in the very act of weaving, each pick as it is beaten up being severed by a series of knives worked from the healds. Both of these inventions would be patentable improvements in that special manufacture.

Again, take the production of lead piping. For many purposes, lead, although it makes so convenient and cheap a tubing, is unsuitable. Metals of a higher cost have therefore to be used. But suppose a cheap and easy method were invented of thinly lining the interior of the lead pipe in the course of manufacture with this superior metal, so that all the advantages of the more expensive metal were obtained at the cost of only a slight increase in the price of the lead tubing. Here would be a patentable improvement in the manufacture of such tubing, based both upon the mechanism, if new mechanism had been devised, and also in respect of the new product—viz., the lined lead tubing.

Then to glance at a supposititious improvement in the manufacture of gas. The improvement might relate to the retorts, or to the purifiers, or to the materials distilled in the retorts; or the inventor might make an entire change in the process, and, as has been lately done, manufacture gas from a mixture of decomposed steam or water gas and vaporised oil.

Just as an inventor may effect a radical change in the whole of a mechanical or chemical manufacture or process, so the invention may relate to a part only of the process.

(4) *Novel and Useful Results of Chemical and Mechanical Processes.*

It was at one time doubtful whether a new product, apart altogether from its mode of manufacture, could be maintained as good subject-matter for a patent. It may, however, be safely taken that when, by mechanically mixing or chemically compounding selected substances in a new manner, products are obtained having novel and useful qualities, such products are patentable.

A new product is patentable.

Examples of patentable products.

In examples of mechanical admixtures of materials, resulting, for instance, in a new artificial stone, or a new cement, where there is no invention in the process of mixing or making, but only in the selection of the materials, clearly the materials separately and apart from each other cannot be claimed as destined for that purpose. It is only when amalgamated and formed into the new and useful thing, whether artificial stone or cement, that they become appreciable subject-matter. Therefore the proper object to which to direct the claim is the product. In the same manner, the novel result of a chemical process, such as a new dye, is a product capable of being patented. But the results of mere changes or variations in operations capable of indefinite change are doubtful subject-matter, even when the product is something appreciably different from what has been produced before. For example, although a number of patents are taken out for so-called new cloths, produced merely by a rearrangement of the ordinary operations of a weaver's loom, it is more than doubtful whether any such patent could be sustained, unless the result exhibited an advance of such importance as to justify the maintaining of the patent. But, to go a step further than this, if an undoubtedly new article—that is, a new product—is produced by the operation of specially designed mechanism, the opinions expressed on the bench are all in favour of a claim being made for the product itself as well as for the mechanism by which it is produced. For example, in *Vorwerk v. Evans* (7 P. O. R. 265) the claim for the product was sought to be declared bad by the defendants. It may be explained that the object of the invention was to produce a waistband for ladies' skirts and petticoats. Before the date of the patent, waistbands had been cut from woven material to the required circular shape, of course with considerable waste of material. The patentees invented a mode of weaving such waistbands to the required curved shape, and a specially designed loom, with sectional warps and conical drawing rollers, was designed and described in the specification. Now, no such waistband had ever been so made or woven before. It was an entirely new article

of manufacture. A specific claim was made for it. The defendants attacked this claim, but Cotton, L.J., in giving judgment, defended such a claim and said, "If there is a new thing produced, and that is useful and complies with other requirements, then in my opinion there could be a thoroughly good patent taken out for that."

(5) *New or Improved Processes for which Special Machinery May or May Not be Necessary.*

If the result or product of a process is good subject-matter for a patent, it is clear that a new or improved process itself, whether applied to the making of a new product or to the manufacture of an old product, is equally good subject-matter. Where both process and product are new, both may be claimed: where the product is old and the process new, the process can be claimed. Thus in *Stevens v. Keating* (2 Web. P. C. 182) Pollock, C.B., said, "The real invention may not be so much for the thing when produced, as for the mode in which it is produced, and its novelty may consist not so much in its existence as a new substance, as in its being an old substance produced by a different process." Processes.

As far as processes generally are concerned, the old case of *Crane v. Price* (1 Web. P. C. 393) settled the point that a new process is a patentable invention. Chemical processes also may be said to stand upon a more favourable footing than mechanical processes, in respect of anticipation by analogous processes.

In the case of *Badische Anilin v. Lovenstein* (4 P. O. R. 449) it was held that the prior use of an analogous chemical invention will not go far as an anticipation of an after invention. The cause of this is, probably, that analogy and deduction in chemistry are not so obvious as in mechanical operations. This same rule holds good in cases of alleged infringement. Thus, in *Nobel's Explosives Co. v. Anderson* (11 P. O. R. 113) the plaintiffs, who had claimed the use of a *soluble* nitro-cellulose in the manufacture of a certain explosive, were unable to succeed against the defendant, who used *insoluble* nitro-collulose.

Analogy
does not go
far in
chemistry.

A process may be new and the product may be new, yet the process may be worked by apparatus which has been in common use before, and cannot be claimed merely because of its application to a new purpose. But in some cases the apparatus for carrying out the process may require to be specially devised, and then it may constitute a separate invention.

Patent
might con-
tain claims
for new
apparatus,
new pro-
cess, and
new
product.

Thus there might be an invention in which apparatus, process, and product may all be new, and in such a case each may constitute subject-matter for a separate claim.

(6) *A New Principle Coupled with a Mode of Carrying the Same into Practical Effect.*

Bare
principles
not
patentable.

It has again and again been laid down by the highest authorities that a principle *per se* cannot be patented. In practice, one of the difficulties attending the general application of the rule is, whether the particular invention under consideration is or is not within the vague lines which define a principle.

It is undoubtedly true that the discovery of an abstract and fundamental law of nature or of a natural or scientific truth—such, for example, as the law of gravity, the circulation of the blood, the principles of electricity—cannot be validly patented. But, although our knowledge of these things is the result of logical reasoning, thoughtful observation, and well-weighed deduction, nevertheless they are in no sense inventions. Columbus, although he discovered America, did not invent it. But, passing from these landmarks in human progress to the consideration of smaller issues, it is questionable whether it is not too much the custom to seek to narrow down the field of invention, by describing as principles, and therefore as unpatentable, matters which are really improvements legitimately due to invention, and relating rather to practice than to principle. Take, for example, the well-known “hot-blast” case of *Neilson v. Harford* (1 Web. P. C. 295), which is quoted so often as a test case on this very matter of principle. The action was tried in 1841, at a time when patent actions were remarkably rare,

Neilson v.
Harford.

and when judges had but little opportunity of making acquaintance with technical matters. The invention was simple. Prior to the date of Neilson's patent, iron-smelters had used a blast of *cold air* to blow up the smelting furnaces. Neilson's improvement was that he *heated* the blast. The advantages which have been derived by the iron industry of this country from this simple advance have been held to be incalculable. Fortunately for the patentee, the Court held that his claim was not for the hot blast *per se*, but for the hot blast in conjunction with the means by which the blast was heated. Otherwise it is perfectly plain, from the observations of the judges, that had it been construed that Neilson claimed "heating the air-blast of smelting furnaces" irrespective of any air-heating means, his patent would have been considered bad, as laying claim to a principle.

Principle must be claimed in conjunction with means for carrying into effect; but such means need not show invention.

It was not and cannot be pretended that the air-heating means involved any invention at all. Neilson briefly alluded to a heating box as a suitable means. But the invention lay altogether in the use of a hot blast. The least intelligent of ironmasters, when once told in three words what the object of the invention was—viz., to "heat his blast"—would have had no difficulty in constructing at once a more or less efficient heating means, such as a heating box, or a cylinder, or a heating coil, or a jacketed flue. He would have been astounded if he had been told that the patentable part of the invention lay, not in the grand secret of heating the air-blast, but in the self-evident heating means at his feet, although this had scarcely given him any trouble to devise, and had called for the exercise of no invention at all. During the hearing of the above case of *Neilson v. Harford*, Alderson, B., said, "I take it that the difference between a patent for a principle and a patent that can be supported is, that you must have an embodiment of the principle in some practical mode, described in the Specification, of carrying the invention into practical effect, and then you take out your patent, not for the principle, but for the mode of carrying the principle into effect." It is useless to speculate whether the Court, constituted as it is to-day, might not, in the

Rule for drawing claims in patents for principles.

case of *Neilson v. Harford*, have given a different ruling upon the question as to whether the mere heating of the blast fell within the domain of principle. The precedent has been established, and all that can be said is, that wherever it is a question of claiming anything which seems to be of the nature of a principle, the rule is to claim it in conjunction with, and as effected by, the means for carrying the principle into effect, however simple and self-evident such means may be.

Boulton & Watt v. Bull.

Practically the same conclusions were arrived at in the case of *Boulton & Watt v. Bull* (2 H. Bl. 493), the plaintiffs being the patentees of the separate condenser in steam engines. This difference, however, might be noted, that the means for carrying into effect the principle or plan of separate condensation were not self-evident, like the air-heater, but might have called for the exercise of the inventive faculties. Still more so was this the case in

Otto v. Linford.

Otto v. Linford (146 L. T., N. S. 35). One of the chief features of this invention was what Jessel, M.R., called the "idea," or principle, of putting a cushion of air between the explosive mixture and the piston of a gas engine, so as to regulate or make gradual what would otherwise be a sudden shock. "Of course," said his Lordship, "that could not be patented. I do not read the patent so; I read the patent as being to the effect that the patentee tells us that there is the idea which he wishes to carry out; but he also describes other kinds of machines which will carry it out, and he claims to carry it out substantially by one or other of these machines. That is the subject of a patent." It will, however, be evident to the reader that the mere "idea" of interposing this elastic fluid cushion in the cylinder would be but a half-told tale if the ingenious mechanism for carrying it into effect were not also described and shown.

Jessel, M.R., on the patenting of a principle.

Alderson, B., on the same.

Alderson, B., whose remarks in *Neilson v. Harford* have already been quoted, said in the later case of *Jupe v. Pratt* (1 Web. P. C. 145), "You cannot take out a patent for a principle. You may take out a patent for a principle coupled with a mode of carrying the principle into effect. . . . If you have done that, then you are

entitled to protect yourself from all other modes of carrying the same principle into effect, that being treated by the jury as a piracy of your original invention." The *Automatic Weighing Machine Company*—who were patentees of a weighing machine having three essential parts, a weighing apparatus, an indicating apparatus, and a *break between the two* which was closed up by the insertion of a coin so as to make the machine act automatically—have had more than a dozen actions against various infringers, who, while adopting the principle of their machine, used in some cases strikingly different apparatus. But the *Company* have nearly always been successful, and have practically established that any mechanism carrying out their principle is an infringement (see 9 P. O. R. 41, and 10 P. O. R. 442).

The application of an old article to a new use is sometimes patentable, but it will depend upon the amount of invention involved in effecting the new application. Thus in *Ehrlich v. Ihlee* (5 P. O. R. 437), although circular cards had long been used in looms, their application to mechanically played musical instruments was held to be patentable.

Old things
applied to
new uses
sometimes
patentable.

The mere substitution of one material for another to effect a like purpose is not patentable. For example, the manufacture of stair-rods from mahogany instead of brass would not be patentable, and an application for such has been refused.

In *Harwood v. Great Northern Railway Company* (2 B. & S. 194, 22) a patent for fishplates, to connect the rails of permanent way, was held to be bad because a similar mode had been in vogue for connecting timber baulks. Inventions having immoral or illegal objects are also unpatentable.

CHAPTER VI.

FURTHER ELEMENTS IN SUBJECT-MATTER:
INVENTION, NOVELTY, AND UTILITY.

THE remaining necessary elements in subject-matter are INVENTION, NOVELTY, and UTILITY.

INVENTION.

The amount of invention necessary to make an improvement fit subject-matter for a patent has to some extent been already treated in the last chapter, under the foregoing heads of Subject-Matter. But upon this point it is absolutely impossible to give any general rule. Each case must be judged upon its own merits, and the reported decisions are always governed by the special circumstances of each case, so that an attempt to generalise from them would only mislead. For example, an argument that the improvement was obvious and the advance but little has been met successfully by showing the great demand for and large sale of the article, or that, although similar articles had been made in large quantities by various manufacturers before, the so-called *obvious* improvement had never suggested itself to them.

Instances in which alleged "obvious" nature of invention may be rebutted.

NOVELTY.

Every invention for which a patent is obtained must also possess the element of novelty. The grant of a patent being upon the assumption that it is "*a new manufacture*" which the inventor is giving to the public, anything which disproves this view militates against the validity of the grant.

The whole of the subject-matter of claims must be new.

It is therefore of the utmost importance that the novelty of the invention should be established before the expense of obtaining a patent is incurred. And it must

be remembered that if it should transpire that the subject of even one only of the claims is old, the whole patent is invalid, at least until amendment of the Specification has been effected. For example, in a recent case tried in the Court of Session, Scotland (*Murchland v. Nicholson*, 10 P. O. R. 417), the patentee of an apparatus for milking cows brought an action for infringement. Unluckily, however, for the plaintiff, it turned out that the fifth claim in his Specification, for a quite unimportant detail, was not novel. The whole patent was therefore held to be invalid. The Lord Chief Justice Clerk, in delivering judgment, said, "I cannot but regret that the complainer, who, I think, had a good and patentable invention, should have made a claim which is bad in an unimportant detail of his apparatus. Unfortunately, the law is, as stated by the Lord Ordinary, that this claim being bad, the whole patent must fall."

One bad claim vitiates the whole patent.

The broad rule is that if the invention has by any means whatever become known to the public, either by prior use or by prior publication, no patent can be afterwards granted for it. The reason is that in such circumstances the patentee has nothing to give to the public in return for the grant from the Crown, nor can the public be deprived of the right freely to use what they already possess.

Nature of patentee's contract with the Crown.

PRIOR USE.

Prior use by the public, or even by the inventor himself, if effected in a public manner, will destroy the validity of a patent granted after the date of such prior use. As to prior use by the inventor himself, such use to prevail against his right to a patent must be open and undisguised. Mere experiments in his own closet or workshop, or mere confidential disclosure to or experimental user by another, will not destroy the inventor's right to a patent. For example, in *Morgan v. Seaward* (1 Web. P. C. 171) the patentee had invented a paddle-wheel, and had two pairs of such wheels made for him by an engineer, whom he had cautioned to keep silence. The wheels were made, packed, and exported before the date of the patent; but,

Experimental prior use not publication.

in spite of these facts, the patent was sustained. The bulk of cases go to show that the inventor is allowed a reasonable latitude in experimenting with his invention, even although such experiments should be known to one or two besides himself. But this doctrine must not be pushed too far.

Secret
prior use by
another will
not vitiate
patent
granted to
independ-
ent
inventor.

Prior use by some one who has practised the invention secretly, and in a mode known only to himself, will not invalidate a patent granted to a subsequent independent inventor. In *Dollond's Patent* (2 H. B. 43) the fact of a similar object-glass for telescopes having been made in 1720, in a manner which was an undisclosed secret, did not upset the patent. It may be said also that it is possible to obtain a valid patent for a process which one's next-door neighbour may have used for years, but used only as a personal and jealously guarded secret.

Prior use might sometimes constitute merely prior existence. But where the new article, although seen and handled by several persons before the date of the patent, did not on the face of it disclose the secret of production, the patent has been upheld. Thus in *Hancock v. Somervell* (39 New. Lon. Jour. 158) the alleged anticipation amounted to this, that samples of the invention (which was a shoe of vulcanised rubber) were sent up and down for the purpose of attracting customers, although not actually sold. It could not be shown that the secret of the manufacture was discovered or made known by or to any of those who saw the sample shoes, and as a result the patent was upheld.

Publication
under pro-
visional
protection
afterwards
abandoned.

Another incident of prior user, or it might be of prior publication, falls to be considered under the following not unusual circumstances. It sometimes happens that an applicant, after having obtained provisional protection for an invention, and after having under such provisional protection advertised and sold articles made in accordance with the invention, determines for some reason to drop the first provisional during the currency of the protection, and obtains a fresh provisional protection for substantially the same invention.

Under such circumstances it has been asked if such

publication, under the first provisional, does not destroy the novelty of the invention as protected under the second application.

There are two cases under the former Act of 1852, in which it was held that, assuming the invention in the two provisional specifications to be the same, the abandonment of the first provisional specification did not void a patent, granted, *within the original period of provisional protection*, upon the second application, even if actual user and publication could be shown to have taken place during the currency of the first provisional protection, and before the second application was made.

The cases referred to are those of *Oxley v. Holden* (8 C. B. R., New Series, 666) and *Lister v. Norton* (3 P. O. R. 199). Mr. Justice Chitty in the latter case held himself bound by the decision in *Oxley v. Holden*, and pointed out that such a conclusion might very fairly be drawn from the wording of the 8th Section of the Act of 1852.

*Oxley v.
Holden.
Lister v.
Norton.*

This section said that during provisional protection the invention might be "used and published without prejudice to *any* letters patent to be granted for the same." On the other hand, Section 14 of the present Act (corresponding to Section 8 of the Act of 1852) says, after referring to the acceptance of the application, that the invention may be publicly used "without prejudice to *the* patent to be granted for the same." Some authorities are inclined to hold that the use of the definite article identifies the patent with the original application, and that if this is abandoned in favour of a re-application, public user in the interval will vitiate novelty. Others see no material difference between the effect of Section 14 of the present Act and Section 8 of the former Act, and therefore maintain that the rulings referred to above would remain unchanged in the case of applications made under the present Act.

The old and
the present
Sections
compared.

No decision has yet been given on the point, but it is submitted that if the matter were again considered under the present Statute, there is a strong probability that the former rulings would not be sustained.

Probable
effect of
present Act.

PRIOR PUBLICATION.

Publication
in book,
periodical,
or drawing.

Book must
be acces-
sible to the
public.

Publication
may be
made in a
foreign
language.

Publication
by drawing.

An invention may be published in this country, by being described in some newspaper or book, or in the specification of some prior patent. It is not necessary that such newspaper or book should have been issued in this country. It might be a foreign book or newspaper, and be printed in a foreign language. The publication might even be effected by an engraving, if the invention should be unmistakably set forth therein. But it will not suffice to prove the mere existence of such book or publication in this country. It should be proved that it has been actually seen and consulted by members of the public, or has been in such a situation that it was at the disposal of anyone who cared to see or consult it. Thus, if a book in a public library stood in its proper place on the shelves, and figured in the catalogue, it would not be necessary to prove specifically that it had ever been read or consulted by a member of the public. Its presence would be considered as publication. In *Harris v. Rothwell* (4 P. O. R. 225) a knitting machine patent was declared invalid because of the presence, in the Patent Office Library, of two German specifications which described a similar knitting machine. It was not considered essential to prove that they had ever been really consulted (see also *United Horse Nail Company v. Stewart and Company*, 2 P. O. R. 122). But if, instead of being shelved and catalogued, the book had been lying in some back room, and its presence unknown until disinterred by some chance finder, that would not be considered to be an anticipatory publication (*Otto v. Steel*, 3 P. O. R. 109).

A drawing in a prior specification, illustrating, without any description, the subject-matter of a subsequent invention, will be held to be publication (*Herrburger v. Squires*, 6 P. O. R. 194); but the meaning of the drawing must be unmistakable, and no favourable construction will be put upon anything uncertain. When the anticipation consists of descriptive matter only, the description must be such as to enable a competent person to carry the invention into effect. Consequently there can be but

few unmistakable letterpress, descriptive anticipations of mechanism, unless it is of the most simple construction.

The field which should be most carefully scanned in searches to establish or to break down a claim to novelty is that afforded by the published specifications of home and foreign patents. The classified indexes and class abridgments of subject-matter which are now published, and which, together with the specifications, can be consulted at the Patent Office Library or in the public libraries of most large towns, render this task of searching comparatively easy.

UTILITY.

The remaining element in subject-matter is, Utility. The invention may be novel and most ingenious, but unless it fulfils a useful purpose, and is useful and beneficial to the public, a valid patent cannot be obtained. And by "Utility" is not meant the mere capacity to be put to a useful purpose. Mr. Justice Grove, in charging a jury, said that in his opinion "Utility means an invention better than the preceding knowledge." In other words, a machine, however ingenious, which performed a given operation in an inferior and faulty manner as compared with an existing machine, would not be good subject-matter.

Invention must be useful.

"Utility" means increased serviceableness.

The utility of an invention is always a question of fact and a matter of proof. The commercial success of a patent will have great weight in attesting its utility, and Chief Justice Tindal has remarked that better evidence of the utility of an invention could not possibly be had than the fact that attempts were being made to infringe it.

Utility matter of proof.

In drawing the claims of an invention, care should be taken to confine the invention within its limits of usefulness. The natural desire to cover as much ground as possible has often led to the making of claims which break down when put to the test.

For example, an inventor, having practically proved the utility of his invention as applied to three things, might, by analogy, be led to conclude that it would be equally useful as applied to a fourth. If practice should

prove that he has overlooked several objections, and that it is not useful for this fourth purpose, his fourth claim would constitute a fatal flaw in his patent.

In the *United Horse Nail Co. v. Swedish Horse Nail Co.* (6 P. O. R. 8) a patent was declared void, because the sixth claim referred to a mode of punching nail-blanks, which the evidence showed could not be carried out in an economical and useful manner.

If a patent is granted for an improvement upon an existing patent which has been shown to be lacking in utility, the improvement will remain good if it is in itself a useful invention.

CHAPTER VII.

PROVISIONAL AND COMPLETE SPECIFICATIONS AND CLAIMS.

HAVING thus reviewed the essentials of subject-matter of patentable inventions, it will now be competent to proceed to a consideration of the Specifications. In the foregoing pages the origin of the Specification has been indicated, and an attempt made to contrast the advantages and disadvantages of filing a Provisional or Complete Specification with the application. In the following references to the Specification, it will be assumed that the ordinary course of filing a Provisional with the application would be followed.

THE TITLE.

Title must describe nature of invention.

In drawing or filing in the declaration, the first thing that requires to be settled is *the title* of the application. This is an important point, and care should be exercised in choosing a title which will accurately

describe the nature of the invention. The Patent Office examiners will decline to accept a title which is not, in their opinion, properly descriptive, and the Comptroller has power to decline to date and number such imperfect application, so that the applicant may find himself greatly delayed and hampered by defects in his title.

Function of examiners with regard to title.

In choosing a title, directness and simplicity of expression are to be preferred to the vague generalities that are sometimes used. The title should be wide enough to cover all that the applicant has really invented, without stretching aimless tentacles towards improbable uses which the Specification fails to make out. For example, in *Cochrane v. Smethurst* (Dav. P. C. 354) the invention really consisted in an improved street-lamp, but the patentee had entitled it "A method or methods of more completely lighting cities, towns, and villages." It was held that the title was too wide. Again, in *Felton v. Greaves* (3 Car. and P. 611) the patent was held to be bad, because the title contained a reference to certain articles to which the invention turned out not to be applicable.

Title should not be too vague.

But, in avoiding this danger, care must be taken not to run to the opposite extreme of making the title so narrow as not to fully cover the field of the invention. In *Oxley v. Holden* (8 C. B., N. S., 666, 705) the title was "Improvements in the Doors and Sashes of Carriages." In his Specification the patentee said that, although he had shown and described his invention as applicable to carriage doors and windows, the improvements were applicable to any descriptions of doors and windows subject to vibration. It was sought to dispute the patent on the score of disconformity between the title and body of the Specification, and the Court so far sustained the contention as to hold the patent to be good only within the limits of the title, that is to say, only as applied to carriage doors and windows.

Nor should title be too restricted.

In *Rea v. Metcalf* (2 Stark. R. 249) the patent was upset because of what was alleged to be a misdescription of the nature of the invention in the title. A brush made to diminish towards the point by the arrangement

Misdescription in title.

of hairs of unequal length, was called in the title a "tapered brush," which it really was if looked at broadly. Lord Ellenborough directed the jury that it was not a "tapered," but an unequal brush, and upon these grounds the verdict went against the patentee.

It must be said, however, that this case happened in the days when, as has been said, the Courts exercised ingenuity not to save, but to upset patents. It may safely be submitted that such a decision would be impossible at the present time.

A form of title, which at any rate possesses the demerit of being unnecessarily cumbrous and awkward, is where the applicant seeks to explain at length, technical terms or names of machines in his title. Thus, instead of saying "Improvements in Carding Engines," to say "Improvements in that class of machinery, for preparing, drawing out and cleaning textile fibres, known as Carding Engines," is a pedantic excess of quite unnecessary caution. Patent Specifications are addressed to people having knowledge of the arts and manufactures, and if one were to stop to explain to the uninitiated the meaning of every technical term used, the drafting of such documents would be laborious indeed.

"Fancy"
titles.

Another mistaken fashion of drawing a title, much in vogue with inventors who prepare and file their own Specifications, is to use a fancy name in describing the invention. Thus in examining the Official Journal one frequently comes upon such titles as "The 'Simplex' Bottle-Stopper," or "Smith's 'Triumphal' Cue-Tip." All such titles are disallowed by the Comptroller-General, and the applicant requested to amend his papers in this respect.

THE PROVISIONAL SPECIFICATION.

Since the time of its introduction under the Amendment Act of 1852, the Provisional Specification accompanying the application has been made use of in the bulk of cases, in so far at least as the applications of British inventors are concerned. Under the present Act the conditions governing the Provisional Specification are practically the

same as before. Now, as then, the Provisional Specification must accurately *ascertain* the nature of the invention. This does not mean that a mere intimation of the inventor's object will suffice. It must be a clear and sufficient record of the proposed mode in which the invention is to be carried out. The rule to be followed is this, that "the Provisional Specification must state distinctly and intelligibly the whole nature of the invention, so that the Comptroller may be apprised of the improvement and of the means by which it is carried into effect."

Function of Provisional Specification.

Not that all details are to be minutely described or indicated too carefully; on the contrary, the chief value of the period of Provisional Protection is to enable these details to be elaborated or created in the light of practical experiment. It is a sketch which must contain the gist, the grouping, and the main arrangement of the finished picture—that is to say, the Complete Specification—which will be afterwards amplified from it. And just as the making of an effective sketch is sometimes a truer test of the artist's power than the painting of a finished picture, it must not be considered that anything will suffice for a Provisional Specification, and that all faults can be remedied in preparing the Complete Specification. The Provisional should rather correspond to a well-prepared and broadly laid foundation, upon which the superstructure of the Complete may afterwards be reared with some promise of stability.

Provisional to be looked upon as a foundation for the Complete Specification.

The Provisional remains a secret document until it is published with the Complete Specification. If no Complete Specification is filed, the Provisional Specification is destroyed, and its contents remain secret.

Provisional never published unless followed by Complete.

THE COMPLETE SPECIFICATION.

The Provisional Specification having broadly described the improvement, it remains for the Complete Specification to "*particularly* describe and ascertain the nature of the invention, and in what manner the same is to be performed."

In considering a Provisional Specification, in furtherance of which it is intended to construct a Complete Specification, the first duty of the draftsman is to ascertain and digest the contents of the Provisional, and then to see that the matter of the Complete, upon which it is proposed to found claims, does not extend beyond the scope of the Provisional. Certain writers have doubted whether, under the Act of 1883, the mere fact of disconformity between the Provisional and Complete Specifications would now invalidate a patent. But recent cases have entirely disposed of any such doubts. In *Vickers v. Siddell* (7 P. O. R. 292), Lord Halsbury, L.C., is responsible for the following dictum:—

There must be conformity between Provisional and Complete.

“It is suggested that the new machinery of the Comptroller and the examiners has superseded the power of raising any objection to the conformity of the Provisional and the Complete Specifications. I am unable to take that view. I think it is an essential condition of a good patent that the invention described in the Provisional should be the same as that in the Complete Specification, and I think the third Sub-section of Section 26 preserves this as a ground upon which a patent may be revoked.”

This deliverance was followed in the case of *Nuttall v. Hargreaves* (8 P. O. R. 450), in which the plaintiff's patent was declared invalid upon the ground of disconformity. The patent was for a beer-tap, and one of the claimed features of novelty was a wire-gauze strainer in the tap to prevent the passage of impurities. This strainer was not referred to in the Provisional Specification at all, and this was held to establish fatal disconformity. In the still more recent case of *Lane Fox v. Kensington and Knightsbridge Electric Lighting Co.* (9 P. O. R. 221), a decision adverse to the patentee was founded chiefly on similar grounds.

These recent cases being under the present Act, and pointing so unmistakably to the fatal effect of disconformity between the Provisional and Complete, it will be unnecessary to disinter any of the prior cases under the old Act, in which precisely the same deductions were drawn. It will therefore be essential to guard carefully

against claiming any important part of the invention as a novel feature which is not foreshadowed in the Provisional Specification. If it should be decided to include such excess features in the description for the purpose of making the whole more complete, it would be a point of prudence expressly to disclaim them, lest the usual terminating phrase of a Claim, such as "substantially as hereinbefore described," &c., or as "herein described," might, in the case of one or certain of the Claims, be held to include the new matter.

It cannot be impressed too strongly upon inventors that in Patent Specifications honesty of purpose and directness of expression are best. The patentee or patent agent who seeks to import into a Patent Specification those ambiguously cunning phrases which are so common in many other legal documents gets but little consideration at the hands of the Court. Obviously, unless the actual words employed were presented for consideration, it is impossible to say how far expressions used in the Provisional Specification would warrant amplification and separate claims in the Complete. It can only be said that all that is necessary is to show that an improvement was suggested, or could reasonably be said to be within the limits of the language used in the Provisional Specification, and, if this is so, such an improvement is good subject-matter for the Claims. Apart from this, it may be said that where a general descriptive sketch of a newly invented machine or article has been given in the Provisional, and details which have been afterwards designed in perfecting the invention should present in themselves features of novelty, rendering them specially useful for that particular machine or article, such details may be separately claimed for that specific purpose, although it would not do to claim them generally for that and for other purposes.

Specifications must be drawn in the most strict good faith.

Some latitude allowed in claiming improvements suggested during provisional protection.

As an illustration of this it will suffice to refer to the case of *Lucas v. Miller* (2 P. O. R. 155). The subject-matter of the plaintiff's patent was an improved bicycle lamp. After his Provisional was filed, a further improvement suggested itself in the form of clip washers, for

more easily suspending the lamp to the hub of the driving wheel. These washers, although not mentioned in the Provisional, were fully described in the Complete Specification, and were claimed as part of the combination. The defendant pointed out the discrepancy between the Provisional and Complete, and disputed the validity of the patent on that ground. But Kay, J., held that these suspending washers, by virtue of their close functional connection with the lamp, constituted an improvement which the inventor was right in making and was perfectly entitled to claim.

Specifi-
tion must
contain
sufficient
and full
instructions
for working
the inven-
tion.

Another point to be observed in preparing the Complete Specification is, that it must be sufficient and full.

When an applicant files his Complete he is fulfilling his part of a contract with the public. On the one hand, he gains the exclusive monopoly of his invention for a fixed period of fourteen years. For that privilege he undertakes, by means of his Specification, so to instruct the public that at the end of his monopoly they will be able to use his invention as fully and advantageously as himself. Therefore, any ambiguity, suppression, or misdirection is a breach of faith, which only requires to be laid bare to destroy the privilege.

Specifi-
tion must
be prepared
with reason-
able skill
and
knowledge.

Accordingly, all Specifications should be prepared in as transparently honest a manner as possible, and with all the marks of anxiety on the part of the patentee thoroughly to instruct his readers in the best methods, known to him at the time, of carrying his invention into effect. Reasonable skill and knowledge must be apparent in the preparation of the Specification, and a patentee will not be excused for shortcomings on account of ignorance. Specifications and drawings must be prepared so as to be intelligible and complete, and the Court will not study to piece together what it was the duty of the inventor to make plain. In *Allen v. Duckett* (10 P. O. R. 397), the Specification turned out to be so badly prepared that the Court was satisfied that the nature of the invention had not been properly ascertained. "Can anybody," said Hawkins, J., "reading this Specification, form any judgment as to what the object of the invention

is? . . . The more I look at it, the more satisfied I am that both the Provisional and the Complete Specifications are absolutely wanting in the essential features which ought to present themselves upon both Provisional and Complete Specifications, and I therefore hold that it is bad for that reason."

The Specification is addressed to persons who are competent to understand and carry out processes or manufactures akin to the subject-matter of the patent. Therefore, it is not necessary that technical terms and trade expressions should be explained, unless they are more than ordinarily obscure or uncommon. Thus, if the invention deals with electricity, the inventor may use the scientific and accepted terms common among electricians; if with chemistry, those terms which are common knowledge with chemists. So in an invention connected with a loom, for example, the patentee may safely presuppose an acquaintance on the part of his readers with the ordinary mechanism and operations of weaving. For it would be insufferable that a chance mention of a shuttle, reed, picking-stick, or weft fork, should be a signal for the writer to stop and carefully explain to the reader what these were.

As a development of this implied knowledge on the part of the reader, the Courts have in turn come to assess the sufficiency of a description by what is known as "the ordinary workman test."

This means that a Complete Specification will be held to be sufficient in law, if the directions are plainly enough given to enable a person of average intelligence, and conversant with that particular industry, to carry the invention into effect.

The reader is not to be called upon to exercise extraordinary intelligence or invention, or to fill in evident gaps left by the patentee. But he must duly exercise his trade knowledge and trained intelligence as a workman in interpreting the instructions of the patentee. In *Crossley v. Beverley* (3 C. & P. 513), the defendants asserted that the description of a gas-making apparatus was incomplete because no mention was made of the

Intelligibility of Specification subject to "the ordinary workman test."

condenser. Lord Tenterden, C.J., brushed this objection aside, saying that "a workman who was capable of making a gas apparatus would know that he must put in a condenser."

To go a little further than this, it may be said that where a patentee in his description makes an error which is on the face of it an error, and which could not possibly mislead anyone acquainted with the subject-matter, such error will not vitiate his patent.

Errors in
Specification:
how far excusable.

This was the opinion of Lord Westbury, L.C., in *Simpson v. Holliday* (12 L. T., N. S. 99). But his Lordship nevertheless went on to say that this was not a correct statement of the law when applied to errors which were only discoverable by experiment and further inquiry. In a Complete Specification, a patentee is not tied down to exact and definite proportion or detail, if the nature of the invention reasonably admits of variation. Thus, in the description of a new alloy, the proportions of metal to form the alloy should be stated specifically; but where variations might be made in these proportions without essentially affecting the nature or utility of the alloy, it is quite permissible for the patentee to say so and to indicate the limits within which such variations might be made (*Patent Type Founding Company v. Richards*, 1 Johns. 381). On the same grounds, a combination claim, consisting of several parts, would not be defeated by mere variation or substitutes, where the characteristics of the combination were preserved. In short, whether in mechanical or chemical combinations or processes, a reasonable latitude will always be allowed in construing the Specification. Wherever a Complete Specification can be made more easily understood by the addition of drawings, these should be incorporated.

Reasonable
latitude
allowed in
construing
Specification.

Drawings.

It was said by North, J., in *Laurence v. Perry* (2 P. O. R. 179), that drawings are not an absolute necessity even for the explanation of mechanical patents. But that was under the Act of 1852, and Sub-section 4 of Section 5 of the present Act says that a Complete Specification *must* be accompanied by drawings if required. There is little doubt, therefore, that it is an essential that drawings

should be used wherever possible. Language is at the best a very poor and misleading substitute for a representation of the thing itself, and, besides, a faithful and careful drawing is of use in explaining what might otherwise be an ambiguity in the description. Thus, if the descriptive part were to tell the reader something which is absurd, perhaps something so misleading that if it stood alone the very validity of the patent might be imperilled, if that misleading statement is coupled with a reference to the drawing, the error in the description can be explained and neutralised, so long as the drawing is so unmistakeably clear and correct that a competent person can at once see for himself that a mistake has been committed.

Drawings sometimes of value to correct and limit faulty description.

In making a drawing, the great object should be to clearly illustrate the subject-matter of the invention. This is sometimes so far lost sight of, that an inventor, in illustrating an improvement in locomotive furnace bars for example, is content with nothing less than giving several complete views of an entire locomotive engine and tender. The result is, that the illustrations of the improved bars are dwarfed, and the Specification encumbered by the presence of matter that has nothing to do with the invention.

Drawing should be confined to subject-matter of invention.

Perspective drawings or isometrical projections should be used where possible, as these appeal to the understanding of a much wider class than is the case with purely mechanical drawings.

As the drawings attached to the Specification are now reproduced by photo-lithography, and generally to a reduced scale, it is incumbent upon the patentee to see that his drawings are neat, black, clear, and distinct, and to as large a scale as the prescribed sizes of sheet will conveniently hold.

Mode of reproducing drawings for publication.

It should be mentioned that, under Sub-section 4 of Section 5 of the present Act, it is provided that when drawings have been filed with the Provisional Specifications, these drawings can be referred to in the Complete Specification without the necessity for filing fresh copies of the drawings.

Drawings filed with Provisional may be referred to as illustrations of the Complete.

Old matter
should be
differen-
tiated from
new.

In pursuance of the advice already given, as to the exercise of absolute good faith in preparing the Complete Specification, it might be useful also to point out the advantage of differentiating the old from the new in a Specification, especially where a combination is concerned. As Cresswell, J., says in *Gibson v. Braud* (1 Web. P. C. 627), "Every party is bound to tell the public clearly by his Specification what he claims, and what they may do or may not do without risk of an action for infringing his patent."

*Macfarlane
v. Price.*
No dis-
tinction
between old
and new.

In *Macfarlane v. Price* (1 Web. P. C. 74) certain improvements in umbrellas and parasols were described, no distinction being made as to which of the details were new and which were old. The patent was infringed by the use of a certain part shown in the drawings, and admittedly of the essence of the invention. But Lord Ellenborough, C.J., nonsuited the plaintiff on the ground that no one could be fairly expected to gather from the Specification what the novel parts really were.

So in *Forwell v. Bostock* (4 De G. J. & S. 298) certain improvements in a sewing machine were so described that Lord Westbury held that no one could properly distinguish between what was new and what was old, and on that account declared the Specification insufficient. This differentiating of the new from the old need not of course be carried out where common knowledge or the knowledge of the ordinary skilled workman is sufficient to point out the old parts.

But
differentia-
tion
between
old and
new not
always
necessary.

For example, if the invention refers to a new equilibrium valve for governing the passage of steam to the valve chest of a steam engine, and the Specification describes the valve in connection with an ordinary ball governor, it would not be necessary to disclaim the governor, for every one knows how old that is. But if the valve itself were partly old, it might be necessary to point out what parts of the valve were new and constituted the improvement. As regards an improvement upon a foregoing invention or existing patent, it will be sufficient, for the purposes of differentiation between old and new, to indicate the Specification of the first invention.

When two or three methods of carrying an invention into effect are described in the Specification, and one of them turns out to be useless, the patent is invalid (*Simpson v. Holliday*, 12 L. T., N. S. 99).

All claimed modes of carrying the invention into effect should have utility.

In construing Specifications of Letters Patent for Inventions, the practice of the Courts seems to have gone through a pendulum-like swing before settling down to the present rule of reasonable and fair construction. In former times, letters patent for inventions suffered from the vestiges of that odium which attached to the bad old monopolies. As a result, when a patent came into Court it was subjected to the most keen and searching scrutiny. The leaning of the Court was always dead against the patentee and in favour of the public. This might be termed the period of *malevolent* construction of Specifications. But early in the present century more liberal conceptions concerning the inventor and his mission began to prevail, and the practice of the Courts swung into what has been called the *benevolent* construction.

Construction of Specifications.

Former modes of construing Specifications.

That, in its turn, has been succeeded by a very evident determination on the part of the Court to allow itself to be influenced neither by the benevolent nor the malevolent theory of construction, but to give fair consideration to the meaning of the language employed and to decide accordingly.

Present practice in construing Specifications.

When confronted by counsel with examples of former practice, several eminent judges have expressed themselves upon the principles of construction.

In *Clopper v. Smith* (1 P. O. R. 89, 90) Bowen, L.J., gives an excellent exposition of the rules governing the Courts at this day. Chitty, J., in *Lister v. Norton* (3 P. O. R. 203), speaking of the construction of a Specification, says, "It ought to be construed, like any other legal document, as a whole. It certainly ought not to be construed malevolently; I will not say it ought to be construed benevolently; I do say it ought to be construed fairly. It must be read by a mind willing to understand, not by a mind desirous of misunderstanding."

Chitty, J., on construction.

CLAIMS.

Claims became essential to Specifications in 1883.

Next to a clear and comprehensive setting forth of the invention in the body of the Complete Specification, the most important task of the patentee is the framing of the Claims, by which he points out and fences off the real fruits of his brain. Prior to the present Act of 1883 it was not necessary to conclude the Specification with Claims, although, for their own sakes, patentees usually did so. Now, however, every Complete Specification must end with "a distinct statement of the invention claimed."

Simple as the requirement may seem, it is sometimes a matter of considerable difficulty to select and limit in clear and comprehensive language, not only the pith and gist of the invention, but also the subsidiary and collateral claims that may spring from the main trunk.

Power of Comptroller to require Claims in Complete.

The Comptroller-General of the Patent Office has power to require that something in the shape of a Claim shall be appended to the Complete; but as to the form and substance of the Claim, or its agreement with the invention described in the Specification, he has no power to interfere, and does not attempt to guide the applicant. It appears that there must be some attempt to indicate the scope of the invention in the Claim. Herschell, S.G., in *re Smith's Patent* (Griff. P. C. 268), expressed an opinion that to say "I claim the invention described in the Specification" would not be a Claim that should be accepted by the Comptroller. But he also said that if the Claim read, "I claim the improved bicycle substantially as described," such a phrase might be accepted, as it clearly pointed to a particular machine.

Claim must have specific reference to invention as described and shown.

The primary rule in drawing a Claim is to take care that the Claim shall not cover anything more than the actual invention. In the act of working out an invention, and preparing the Complete Specification, it is often the case that extensions of the uses of, and changes in, the apparatus, begin to suggest themselves more or less vaguely to the inventor, some of which he thinks might possibly lead to evasion if hit upon by other inventors. In this

state of mind, Claims are prepared, in which, not content with claiming the substance of the invention, the patentee endeavours also to secure some foothold in case of possible developments of his idea by others. With this object the Claim is drawn in vague terms, which the patentee flatters himself not only cover the design originated by himself, but would trip up anyone who might come within measurable distance of his domain.

Danger of
"fishing"
Claims.

This ambition has often proved fatal to his own patent, and in thus snatching at the shadow the patentee runs great risk of losing the substance.

In *Steven v. Keating* (2 W. P. C. 181) the patentee had described a mode of making a new cement by the use of sulphuric acid with limestone or chalk. The gist of the invention was the employment of the acid for the purpose. Not content with having proved the usefulness of sulphuric acid for his purpose, the patentee said, in the body of his Specification, that other acids might be used, and claimed the process in combination with the use of acids "as hereinbefore described." This was held to be a Claim for every acid, and, as it was proved that certain acids would not do, the Claim was upset as being too wide.

Claim must
not be too
wide.

Again, in *Minter v. Mower* (1 W. P. C. 142), the patentee of an automatically self-balancing chair, instead of claiming his own construction of the chair, which was both novel and useful, claimed "the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counter-balance to the pressure against the back of the chair, as above described." It was shown at the trial that a form of chair acting upon this claimed principle, but infinitely less cleverly constructed than the plaintiff's, had been made and sold before the date of his patent. It was held that Minter's Claim, instead of being confined to his own invention, was wide enough to cover the anticipatory chair also, and was therefore bad.

If an essential part of a combination, operation, or process, or an alternative arrangement or process, described and claimed, should turn out to be useless, the patent is bad. The first would put an entire stop to the useful function of

Modifica-
tions of
invention
claimed
must
possess
utility, or
the whole
will be
vitiated.

the machine or would nullify the process and is clearly a fatal defect (see Lord Denman's remarks in *Reg. v. Cutler*, 14 Q. B. 572). The second—viz., the failure of an *alternative* arrangement or process—is not so clearly a reason for upsetting a patent. The principle seems to be that the Court says, "Here you have two methods presented to you as equally useful. You are told that one is as good as the other. Having nothing to serve as a guide, you may choose the useless method. It fails. Practically, therefore, you are put to experiment to prove what is useful and what is useless, and that is distinct failure of a patent." In *Simpson v. Holliday* (12 L. T., N. S. 99) two methods of preparing dyes were described. The method first described was perfectly successful; the second (an alternative method) was a failure. The patent was held invalid on that account. Similarly, in *Pether v. Shaw* (10 P. O. R. 293), Kekewich, J., held the plaintiff's patent bad because, of two alternatives suggested in the Claim, one was of no use, although the other had proved highly successful. It must be remembered that the Claim is always read together with the Specification: therefore where a Claim is made, and direct qualifying reference is had to the Specification, the Claim is limited thereby, and the reader must go to the Specification to learn the extent of the limits. But, as this course is very apt to lead to doubt and uncertainty, it is unquestionably better to formulate in the Claim itself the feature which it is desired to secure.

The body
of the
Specifica-
tion may
limit and
explain the
Claim.

True
meaning of
Claims
sometimes
settled by
evidence
outside of
the Specifi-
cation.

Sometimes the interpretation of the true meaning of a Claim is a matter for settlement by evidence. That is to say, that, though a Claim may seem too wide to an outsider, it may have a more restricted meaning to a person well acquainted with the industry in question. Thus in *Gandy v. Reddaway* (2 P. O. R. 49) the Claim was for "constructing belts or bands for driving machinery, of cotton, canvas, or duck *woven hard*," &c. It was shown that at least ten classes of "hard woven" canvas were known in the market. Of these, numbers two, three, and four only were suitable for the purposes of the invention. The other classes were useless. The plaintiff endeavoured to show that a workman acquainted with

this class of manufacture would, without further instructions, have used number two, three, or four, and would never have thought of using any of the other numbers. It is to be gathered from the judgment that if this had been established on evidence, the Court might have upheld the patent. But no such evidence was forthcoming, and, consequently, the patent was held invalid.

“Substantially as hereinbefore described” is a phrase often appearing as the termination of a Claim. The words are used sometimes with the intention of giving increased breadth to a Claim, sometimes for the purpose of narrowing it. In *Young v. Rosenthal* (1 P. O. R. 33) Mr. Justice Grove gave it as his opinion that it was unnecessary to use any such word as “substantially” to qualify a Claim. The elasticity sought to be obtained in a Claim by such a qualification, either by increasing or limiting its ambit, was already given by the law. “The law says, if a man, although not literally infringing the letter of the patent, yet substantially infringes it, it is an infringement.” It is certainly reasonable to consider that all expressions which mean that anything practically or substantially the same will be deemed an infringement of the described invention are unnecessary and might as well be left out. They do no good, for of course it is always for the Court to decide what is and what is not an infringement, and no amount of fencing with such expressions as “mere mechanical equivalents,” or “substantially the same arrangement of parts,” &c., so commonly found in Specifications, will influence the Court in any way.

Grove, J.,
on the use
of the
word “sub-
stantially”
in Claims.

The subject of how far it is safe to claim anything savouring of a principle has already been referred to in the foregoing pages (see Chapter V., on “Subject-Matter”). It seems proper, however, at this point to repeat the rule already laid down, that although a bare principle *per se* cannot be patented, yet, if the principle is new, and a method of carrying it into effect exists or has also been devised, the principle, coupled with the mode of carrying it into effect, may be patented. If this is done, any other mode of carrying the principle into effect which another

Principles.

person might seek to use will be very narrowly scrutinised, and, if possible, held to be within the limits of the first patent.

The chief expressions of judicial opinion upon this point are to be found in *Neilson v. Harford* (1 Web. P. C. 370) and *Otto v. Linford* (46 L. T. 39).

Combina-
tion Claims.

Combinations, whether chemical or mechanical combinations of material, or combinations of parts or motions in machinery, or combinations of methods in industrial processes, are all fit subject-matter for Claims.

Products.

When the invention refers to a combination of materials mechanically mixed or combined so as to produce a new concrete or a new alloy or a waterproof fabric, or where the combination is chemically effected so as to produce a new dye or agent, the proper Claim to frame is for the special product made, from the materials and in the manner described.

In novel
combina-
tions the
novel
elements
should be
separately
claimed.

When the invention refers to combinations of machinery, not only should the combination as a whole be claimed, but those parts of the combination which are new should also be separately claimed. It has, however, been held that where a part of a combination which is undoubtedly new has not been so separately claimed, but figures only as an integer in the combination, such part cannot be taken and used for a similar purpose, even though wrapped up in a different combination.

This was a dictum of Lord Campbell in *Lister v. Leather* (8 E. & B. 1018), and a similar view was taken in *Procter v. Bennis* (4 P. O. R. 333). It is, however, much safer not to depend upon such rulings, but to make a positive Claim for the novel element, apart from the particular combination in which it figures.

The following rules may be useful as guides in the preparation of Claims:—

Rules for
the prepara-
tion of
Claims.

- (1) Everything which is not claimed is understood to be disclaimed.
- (2) The Claim should not embrace more than the actual invention.
- (3) A Claim should be expressed in the clearest and most concise language; should refer unmistakably

to the invention described in the Specification; and should not contain any vague and speculative phrases.

- (4) If the invention discloses a new principle, the Claim should be for the principle, coupled with the means for carrying it into effect.
- (5) If the invention relates to a new thing or product, the Claim should be for the product, and the method of producing it should also be claimed, if that also involves invention.
- (6) In Combination Claims, if the invention consists purely of the combination, the combination only should be claimed. If the combination contains new parts, or parts new as applied to the purposes of the invention, these parts also should be separately claimed.

When by inadvertence, or because of the incomplete nature of his experiments, or from any excusable cause, the applicant has failed or finds himself unable to file his Complete Specification before the expiry of nine months from the date of application, an extension of time for one month may be obtained, on payment of a fine of £2. No further enlargement of time can be had.

Extension
of time for
filing
Complete.

CHAPTER VIII.

OPPOSITION TO GRANT OF PATENT.

It HAS already been said that the Provisional Specification, during the period of provisional protection, is a secret document. Its tenor is unknown to the public, and opposition thereto is not contemplated by the Act. It has also been said that when the Complete Specification has been filed, examined, and accepted, the fact of acceptance is advertised

Provisional
Specifica-
tion a secret
document.

Advertisement of acceptance of Complete invites opposition.

in the Official Journal. This advertisement is accompanied by a notification that all persons interested in opposing the grant of a patent on the indicated application may, at any time within two months from the date of the Journal, give notice of opposition. At the same time, the Specification and drawings are thrown open to public inspection at the Patent Office, and the printing of the Specification is usually effected within about three weeks after acceptance.

In all cases the Specification is published and placed on sale in ample time to give an intending opponent, not resident near the Patent Office, every opportunity of examining it at his leisure, before filing his notice of opposition.

Persons entitled to oppose (before Comptroller).

The words of the Act (Section 11) are that "any person" may oppose, but the grounds of opposition are set forth as follows:—

Grounds of opposition.

- (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 patented in this country on an application of prior date.
- (3) 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-matter of an application made by the opponent in the interval between the leaving of the applicant's Provisional Specification and the filing of the Complete Specification.

Notice of opposition.

The notice of opposition (which bears a ten shilling stamp) must set forth the grounds upon which the opponent intends to rely. The Patent Rules provide that the notice must be signed by the opponent, be accompanied by an unstamped copy, and must give an address for service in the United Kingdom. If one of the grounds of opposition should be that the invention has been already patented in this country, the number, title, and date of the patent should be given. It may be noted that a person whose Complete Specification has

been accepted, but not yet sealed, is on the footing of a patentee in thus opposing. So long as the notice of opposition undeniably places the applicant in possession of the real grounds of opposition, quibbling objections to mere informalities in the notice will not affect its validity, and the Comptroller has power to amend either before or at the hearing (see *re Airey*, 5 P. O. R. 348; *re Lake*, Griff. A. P. C. 35; *re Fawcett*, Goodeve, P. P. 10).

On receiving the notice of opposition the Comptroller transmits the unstamped copy to the applicant. If the opponent intends to follow up his notice of opposition by declarations in support, which might or might not be necessary, he must do so within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the applicant's Complete Specification. On leaving these declarations at the Patent Office he must send a list of them to the applicant.

Declara-
tions by
opponent in
support of
opposition.

Within fourteen days from the date of receiving this list, the applicant may leave declarations in answer, delivering also a list to the opponent; and within a further period of fourteen days, the opponent may leave declarations in reply. These last declarations must be confined strictly to reply. In some cases, further declarations or rejoinders might be filed by the parties, but only by special leave of the Comptroller, and in most instances the declaratory evidence is closed by the opponent's reply.

Declara-
tions by
applicant
in reply.

Counter
declara-
tions by
opponent.

As to the advisability or non-advisability of filing declarations, it may be said that this depends greatly on the grounds of opposition. Where the grounds are simply a reference to a prior patent, declarations seem scarcely necessary, as the question will, after all, be decided from a comparison of the two Specifications. But where the grounds are that the applicant obtained the invention from the opponent, or wherever fraud is alleged, declarations are absolutely necessary as evidence in support, since no examination on oath can take place before the Comptroller, and mere oral *ex parte* statements would be of little avail.

Declara-
tions not
essential in
some cases.

But always
necessary
when fraud
or bad faith
is alleged.

To meet a reference to a prior Specification by an opponent, the applicant may produce any evidence of public

State of
public
knowledge
may be

shown in
declarations to
limit scope
of Claims
in Specification.

knowledge which will tend to limit the ambit of the opponent's Specification or reference.

Thus, in *re Jones* (Griff. A. P. C. 34) the applicant sought to minify the scope of the opponent's patent by citing several Specifications prior to the opponent's. The opponent objected, but the Law Officer intimated that it was material that he should be informed of the state of public knowledge.

Exhibits.

For this purpose exhibits may be filed with the declarations. Specimens of the inventions under consideration, or of matters imputed by the declarations, may be exhibited to the Comptroller or Law Officer, to assist him in understanding the drawings or explanations. Thus, in *re Lancaster* (Griff. P. C. 293) the applicant sought to demonstrate the action of his spring piston packing to the Law Officer by means of a specimen. The opponent asked that this should be barred, but the Solicitor-General (Gorst) said it assisted him very much to see the specimen, and he would look at it to better his understanding of the drawings.

Hearing
before
Comptroller.

When the evidence is complete, one of the parties may apply for a hearing, and the Comptroller appoints a time, at least ten days' notice of the hearing being given to the parties. A hearing fee of £1 is payable by each side. At the hearing, the parties themselves may appear, or their agents or solicitors, or they may be represented by counsel. As a rule the applicant begins, the opponent follows, and the applicant replies; but where the *onus probandi* lies on the opponent—as, for example, where the applicant is charged with fraud—the opponent begins. At the hearing the opponent must confine himself strictly to the grounds of opposition stated in his notice, and generally the hearing is little more than an oral urging of the chief points made in the declarations.

Decision.

The Comptroller, who is generally assisted by one or two of the chief examiners, seldom gives his decision at the hearing, but notifies the parties in writing. If either or both of the parties should be dissatisfied with the Comptroller's decision, appeal can be made to the Law Officer, notice of such appeal to be filed at the Patent

Appeal to
Law Officer.

Office within fourteen days from the date of the decision. In the event of an appeal being contemplated, or being probable, it is not advisable for the successful party in the meantime to bind himself to unqualified acceptance of the decision, as it is conceivable that such acceptance may trammel him in using his old evidence or producing new evidence to resist the appeal before the Law Officer.

Possible danger of unqualified acceptance of Comptroller's decision.

The proceedings before the Law Officer amount to a rehearing of the case, and if the successful party before the Comptroller has, by his premature unqualified acceptance of the decision, practically acceded to the exclusion or to a certain reading of parts of his evidence, he may be precluded from reproducing or giving effect to these before the Law Officer. At all events, he will have deprived himself of the power to file new evidence which may have come to his knowledge since the hearing before the Comptroller.

In *re Hampton and Facer* (Griff. P. C. 13) the successful applicants accepted the Comptroller's decision in their favour without qualification. The unsuccessful opponent appealed to the Law Officer. The applicants then applied under L. O., Rule 8, for leave to file evidence to show that the opponent's invention had been in use by others before the date of his patent; but, as they had accepted the Comptroller's decision *in toto*, Clarke, S.G., refused leave.

When notice of appeal has been given, the Comptroller transmits all the papers in the case to the Law Officer's clerk. When the date of the hearing has been appointed, seven days' notice is given to the parties and to the Comptroller.

The hearing before the Law Officer is limited to the points raised in the notice of appeal. The whole or a part only of the Comptroller's decision may be questioned, and if the party upon whom the appeal is served wishes to do so, he may question other parts of the Comptroller's decision by counter-appeal. The evidence before the Law Officer must be the same as that used before the Comptroller, and no further evidence will be admitted, save as to matters which have occurred or come to the knowledge of either party since the date of the decision

Proceedings before Law Officer.

Evidence.

appealed against, except with the leave of the Law Officer upon application for that purpose. In *re Bailey's Patent* (Griff. P. C. 269) Davey, S.G., decided that this rule related to evidence pure and simple, and refused to allow the Specification of a prior patent to be put in as proof of public knowledge. He said that such was not evidence, but an additional ground of opposition. But the practice seems unsettled, for in *re Jones* (Griff. A. P. C. 33) the same Law Officer admitted certain Specifications of prior date to the opponent's for the purpose of showing public knowledge.

Persons
entitled to
oppose
before Law
Officer.

It has been said that any person may oppose the grant of a patent before the Comptroller. But in appeals to the Law Officer, only such persons as are in his opinion entitled to be heard will be granted a hearing. Practice has established that those persons who are so entitled to be heard are as follows:—(1) The patentee of an existing prior patent; (2) the grantee of a prior expired patent; (3) a person from whom or from whose legal representative the invention has been wrongfully obtained; (4) a later applicant who alleges that the Complete Specification of the prior applicant contains matter not referred to in his Provisional Specification, but comprised in the after application of the opponent; (5) a licensee under a prior patent; (6) an assignee and manufacturer under a lapsed patent.

Applicant
or opponent
whose
Complete
has been
accepted,
considered
as "paten-
tee."

As has already been said, an applicant whose Complete Specification has been accepted is, for opposition purposes, in the position of a patentee, and the invention disclosed in his Complete Specification is for this purpose a patented invention.

Costs
(before Law
Officer).

Opposition cannot be founded upon mere description in a prior Specification. The invention must be claimed. The Comptroller-General has no power to award costs, but the Law Officer usually allows a sum for costs to the successful party. The average allowance is from five to ten guineas, but considerably larger sums have been awarded where costs have been heavy. An appellant who withdraws before the hearing is liable to pay costs.

The ground of opposition that the applicant obtained

the invention from the opponent or his legal representative only holds good in the case of communications passing in this country. If the information has been acquired abroad, the applicant, being the first importer, is in the shoes of the true and first inventor (*re Edmunds*, Griff. P. C. 281; *re Lake*, 5 P. O. R. 415).

In supporting an allegation that the applicant has obtained the invention from the opponent, the evidence requires to be very strong, especially if fraud is alleged.

Neither the Comptroller nor the Law Officer will stop a patent except upon evidence so conclusive that, in their estimation, no jury could fail to find for the opponent. There have been cases following the precedent laid down by Lord Cranworth in *re Russell* (2 De G. & J. 130), where the facts were such as to lead the Law Officer and Comptroller to issue the patent jointly to the applicant and opponent, as, for instance, in *re Lake* (Griff. P. C. 294) and *re Garthwaite* (Griff. P. C. 284).

As there is no provision for cross-examination of the declarants or other witnesses before the Comptroller, the latter will often, when the evidence is conflicting, take such a course as will cause the parties to go to the Law Officer, before whom cross-examination is permissible.

The relationship of master and servant does not give the master any rights in the servant's invention, even if the servant works out the invention in his master's time and with his master's tools. Thus in *re Heald* (8 P. O. R. 429) Clarke, Solicitor-General, said, "I am not aware of any authority which lays down that the invention of a servant, even made in the employer's time, and with the use of the employer's materials, and at the expense of the employer, thereby becomes the property of the employer, so as to prevent the person employed from taking out a patent for it." But where an inventor employs a workman to work out an invention, improvements in detail, invented or suggested by the workman, become the property of his employer, and the workman cannot afterwards take out a patent for these improvements. This was very plainly stated by Davey, Solicitor-General, in *re David & Woodley* (Griff. P. C. 26). Said the Solicitor-

Rule in evidence where fraud is alleged.

Case of patent being divided between applicant and opponent.

Witnesses or declarants may be cross-examined before Law Officer.

Master's rights in servant's invention.

Solicitor-General Clarke in *re Heald*.

David & Woodley.

General, "I am of opinion that if a workman is employed by an inventor to make a model for the purpose of carrying out his invention, and the workman suggests improvements in detail of the machine, which are adopted in the machine or model as completed, these suggestions are the property of his employer, and the workman cannot afterwards take out a patent for them."

Opponent's patent must be very similar to applicant's to prevent sealing.

When the opposition is based upon the ground of a prior patent, the similarity between the inventions must be very close to stop the patent. All the reported cases show that in most instances of refusal to seal a patent the inventions have been practically identical, so that it would serve no useful purpose to instance causes of refusal.

When the differences between the interfering inventions are at all appreciable, or if sufficient cause is shown to make it a matter of reasonable doubt, the patent is usually granted. The Comptroller and the Law Officer are guided in this lenity by the consideration that if the applicant's patent turns out to be really an infringement of the opponent's, the opponent has his remedy in a court of law, or by petition for revocation.

Apart from the refusal of a patent *in toto*, the Specification and Claims may be modified as the result of opposition. For example, it is frequently the practice to enforce the insertion of explanatory or disclaiming clauses referring to the existing state of knowledge, and sometimes to prior patents, so as clearly to show the limits of the applicant's Claim.

Reference to opponent's patent.

For example, an opponent, although he may be unsuccessful in stopping the patent, may compel a reference in the applicant's Specification to the opponent's prior patent, coupled with a disclaiming clause. This is a condition which is seldom pleasing to applicants; but its weight as an acknowledgment may be modified, if the applicant pleases, by adding references to other patents prior to the opponent's, which in their turn may seem to limit or affect the opponent's patent.

There is no doubt that references of this kind are obnoxious, and tend to affect the value of the patent in the eye of a possible purchaser.

In *re Guest v. Barrow* (5 P. O. R. 312) Webster, A.G., clearly showed his distaste for too indiscriminate references of this nature:—"I have never considered that a prior patentee has any right to be specially named, unless the applicants are willing to name him, and unless it is clear that there is no other publication except the one that is mentioned."

Guest v. Barrow.

The last of the three grounds of opposition—viz., 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-matter of an application made by the opponent in the interval between the leaving of the applicant's Provisional Specification and the leaving of his Complete Specification—was introduced by the Amending Act of 1888. The additional ground was intended to remedy a possible abuse, such as was disclosed in *re Green* (Griff. P. C. 286), where the applicant's patent was refused although the Specifications made it clear that the opponents had not originally in their Provisional Specification contemplated certain improvements for which the applicant had thereafter made provisional application. These improvements came to the knowledge of the opponents, and were included in their Complete Specification after the filing of the applicant's Provisional Specification. When the applicant filed his Complete Specification, the opponents stopped the patent by showing that his improvements were included in their Complete Specification. The Law Officer admitted the hardship, but was obliged to refuse the applicant's patent. However, by the Amending Act of 1888 such a miscarriage is now rendered impossible. It will be evident that but for this provision occasional injustice might have been done.

Opposition on ground of applicant having incorporated opponent's later improvement in his (applicant's) Complete.

Re Green.

For example, let us suppose that A on the 1st of January files a Provisional Specification of an automatic prepayment gas meter, in which no means are described for adjusting the delivery to the local or current price of gas. Suppose that B on the 1st of March files a Provisional, also describing a meter of that class, and containing a description of means for so adjusting the delivery. If B were

to publish a description of his invention, or put his meter into the market, so that A gained full knowledge of B's invention, A might formerly have included part of B's meter—say, for example, the adjustable delivery part—in his Specification, and B would have been powerless to stop A's patent, while A could have stopped B's.

Now, however, all this is remedied, and even if A were to describe part of B's invention without laying claim to it, B might oppose the patent and get such part of the description expunged. In *re Hetherington* (7 P. O. R. 419) the Complete Specification of the applicant described, but did not claim, a modified arrangement of flexible bend for carding engines not appearing in his Provisional Specification. The opponents had filed a subsequent application which contained a description of this arrangement of flexible bend. The applicant's patent was allowed to go forward only upon condition that the description of the opponents' flexible bend should be struck out.

CHAPTER IX.

SEALING OF THE PATENT.

Patent sealed as of date of application.

EVERY Patent is dated and sealed as of the day of application.

Letters Patent are sealed with the Seal of the Patent Office, having the same effect as if sealed with the Great Seal of the United Kingdom. The use of the Great Seal for this purpose was discontinued in 1878.

Period within which sealing must be effected.

The sealing must be effected within fifteen months from the date of application, unless under special circumstances, over which the patentee has no control—such, for example, as delay caused by opposition, in which case

the Law Officer may direct the sealing at any time. When an applicant dies before the expiry of the fifteen months, the patent may be granted to his legal representative and sealed within twelve months of death. If an extension of time of one month has been obtained for filing the Complete Specification, a patent may be sealed within nineteen months from the date of application.

Under the terms of the grant the patent privilege lasts for fourteen years, and is maintained in force by payment of the following annual renewal fees, which come into existence at the end of the fourth year:—

	£	s.	d.	Annual taxes.
Before the expiry of the fourth year, and in respect of the fifth year	5	0	0	
Before the expiry of the fifth year, and in respect of the sixth year	6	0	0	
Before the expiry of the sixth year, and in respect of the seventh year	7	0	0	
Before the expiry of the seventh year, and in respect of the eighth year	8	0	0	
Before the expiry of the eighth year, and in respect of the ninth year	9	0	0	
Before the expiry of the ninth year, and in respect of the tenth year	10	0	0	
Before the expiry of the tenth year, and in respect of the eleventh year	11	0	0	
Before the expiry of the eleventh year, and in respect of the twelfth year	12	0	0	
Before the expiry of the twelfth year, and in respect of the thirteenth year	13	0	0	
Before the expiry of the thirteenth year, and in respect of the fourteenth year	14	0	0	

When by accident the payment of the annual tax has been overlooked, an extension of time can be obtained on payment of the following fines:—

	£	s.	d.	Extension of time to pay annuities.
On extension of time for one month	1	0	0	
“ “ “ two months	3	0	0	
“ “ “ three months	5	0	0	

Nature of
patent
property.

A patent falls under the head of personal estate. As such it is transmissible by assignment, devolution, or by operation of law, as, for example, to a trustee in bankruptcy.

Co-
patentees.

When a patent has been granted to more than one person, the mutual rights and obligations of the co-patentees are worthy of a short consideration. Their position is in no degree that of an ordinary commercial partnership. As a matter of fact it is hardly possible at the present time to define exactly their respective positions. It has been said that their position must be deduced from the wording of the grant, but no decision is in existence based upon the actual wording of the present form of grant. The leading case on the subject is that of *Mathers v. Green* (L. R. 1 Ch. App. 29), which was decided in 1865 under the wording of the old grant, which differs to some extent from the present. The decision arrived at in that case was that each co-owner of a patent can assign his share and sue for an infringement independently of the other or others. He can work the patent himself and for his own benefit without accounting to his co-patentees, and can also grant licences under his own hand. This was the substance of Lord Cranworth's deliverance in the Court of Appeal. Lord Romilly, M.R., in the Court below, ruled that a co-patentee who granted a licence independently of his fellow-patentees was liable to account to them for their proper share of the royalties accruing under such a licence.

*Mathers v.
Green.*

*Steers v.
Rogers.*

The decision in *Mathers v. Green* was approved and followed in the House of Lords in the more recent case (1893) of *Steers v. Rogers* (10 P. O. R. 245). The defendant was part owner of a moiety of a patent by assignment, and was mortgagee of the other moiety. It was sought to make the defendant liable to account to the mortgagor for a share of the profits made by working the patent, but without success, the House of Lords approving and confirming the judgment of Romer, J., in the lower Court, that a part owner of a patent, even when only so by assignment, can work the patent, without accounting to his co-owner.

Rights of
assignee of
part of
patent.

Of course a mortgagee alone of a patent or share in a

patent would not be in the same position, but must pay out for profits as mortgagee in possession in the usual way.

It is therefore incumbent upon co-patentees clearly to define their relative positions and rights by means of a properly prepared agreement, which would prevent any co-owner from taking an unfair advantage of his fellows. For example, it might be provided that no one of the co-owners should use the invention without the consent of the others, or without accounting to them for the profits. Again, it might be mutually agreed that none of the owners should sell his share without the consent of the others, or that the patent should be sold only in its entirety. Provisions should be made also regarding the granting of licences, the payment of renewal fees, the prosecution of infringers, and other points likely to breed differences if unprovided for.

Desirable to define mutual rights of co-patentees by agreement.

A Register of Patents is kept at the Patent Office in accordance with Section 23 of the Patents Act. Every patent upon being sealed is entered upon this Register, and all dealings with the patent, whether by assignment, licence, amendment, or extension, and in short everything affecting the validity or proprietorship of the patent, should be entered on the Register by those concerned.

Register of Patents.

The patent is registered immediately upon being sealed, and, as the Comptroller recognises no property in the invention until after the grant, no documents affecting to deal with the patent will be registered until the patent has been sealed.

Documents affecting to deal with patent not registrable until after sealing.

No notice of any trust can be entered on the Register. An agreement made *before* the filing of an application, and referring to proposed dealings with the patent to be afterwards obtained, was refused entry on the Register even after the sealing of the patent.

Notices of trust not entered on Register.

Agreements made before filing of application should, if mis-takenly refer to invention afterwards protected.

This was decided in *Parnell's Patent* (5 P. O. R. 126), but North, J., in refusing the motion to compel entry on the Register, declined to lay down as an absolute rule that no document executed before the date of application could be entered on the Register after sealing. Probably an agreement made before the date of application, but having

attached to it, as an exhibit, a model or description and drawing of the invention, would be capable of registration, if the model or description or drawing corresponded clearly with the invention for which application was afterwards made.

Assignments and licences registrable by assignees and licensees.

An assignment, licence, or other deed affecting the ownership or use of the patent should be immediately registered by the person claiming to be entitled under the assignment, licence, &c. The fee for each entry in the Register is ten shillings.

Procedure in registering.

A request for entry should be left at or posted to the Patent Office, together with the original assignment, licence, or other document, and also a copy of the same. The Comptroller, having made the entry in the Register, returns the original, bearing his certificate of entry, but retains the copy. If the assignment, licence, or other document should refer to other documents of title, not being matters of record, an official or certified copy of these should accompany the request. A body corporate may be registered as proprietors, in its corporate name.

Register of Patents open to public inspection.

The Register of Patents is open to inspection by the public, and a certified copy of any entry may be had on payment of a small fee. The Register is *prima facie* evidence of any matters directed or authorised to be inserted therein. Written or printed copies or extracts, certified by the Comptroller, and bearing the seal of the Patent Office, of patents, specifications, or of registers, books, and other documents kept there, are admitted in evidence, without proof or production of the originals, in all courts of law.

Certified extracts from Register taken in evidence.

Rectifications of Register.

The Register may be rectified by an order of Court made on the application of any person aggrieved.

CHAPTER X.

AMENDMENT OF SPECIFICATION.

IT OFTEN happens that after the Complete Specification has been filed, or it might be after the patent has been obtained, the applicant or patentee finds that he has claimed too much, or that in some other respect his Specification requires amendment. Provision for this has been made in Section 18, Sub-section 1, of the Patents Act. The sub-section is as follows:---

Reasons for seeking amendment.

Section 18.

“An applicant or patentee may, from time to time, by request in writing left at the Patent Office, seek leave to amend his Specification, including drawings forming part thereof, by way of *disclaimer, correction, or explanation*, stating the nature of such amendment and his reasons for the same.”

Limits of amendment.

The words in italics show the limits within which amendments must be confined. The amendment may consist in striking out, correcting, or making more clear, but it must not in the smallest degree increase the scope of the patent. Even where terms, which are purely those of correction or explanation, are used in an amendment in such a manner as to give the faintest suspicion that their tendency might be to increase the ambit of the Specification, they are rigorously excluded.

The most usual cases of amendment are those in which the patentee has found that his claim is too wide; but there are also instances where the amendment may be only of the nature of correction or explanation.

In some cases a mistake in the drawing has been allowed to be amended without altering a word in the Specification.

Drawings.

There is practically no more difficulty in amending the Specification of a patent which has been sealed than there is in amending a Specification not yet sealed. In

the former case the official fee is £3, and in the latter case £1 10s.

Application to amend must be signed by applicant or patentee.

The request for leave to amend a Specification must be signed by the applicant or patentee. The amendment or amendments should be shown in red ink on an officially certified copy of the printed Specification. If accepted by the Comptroller, the request to amend is advertised in the Official Patent Journal, and generally in one or two newspapers. For example, if the patent relates to knitting machines, the Comptroller might require the proposed amendment to be advertised in a district devoted to such an industry, for instance in Leicester. If to cotton machinery, it might be required to be advertised in Manchester. The heading of the advertisement invites opposition from anyone interested.

Advertisement of application to amend.

Specification may be amended more than once.

The words "from time to time" in Section 18 would seem to show that a Specification may be amended and re-amended any number of times. Persons entitled to amend include assignees and mortgagees.

Persons entitled to amend.

Oppositions to amendments.

Although it is permissible for an applicant, on filing his Specification in the first instance, to refer to the defects or shortcomings of patented inventions of prior date, he will not be allowed to do so in an amendment (*re Hampton & Facer*, Griff. P. C. 13). The time within which opposition to an amendment will be entertained is one month from the date of the advertisement in the Official Journal. The notice of opposition bears a stamp of ten shillings. It must contain the full name and address of the opponent, and state the reasons of opposition. The applicant is advised of the opposition by the Comptroller, and thereafter declarations are filed by the opponent in support of his opposition within fourteen days of the expiry of one month from the date of the advertisement. The proceedings and rules as to declarations are identical with those already described with reference to the opposition to the grant of a patent.

Procedure on opposition.

Comptroller's decision subject to appeal.

The decision of the Comptroller is subject to an appeal to the Law Officer, whose decision is final.

Amendment on terms.

Section 20 of the Patents Act provides that, where an amendment by way of disclaimer, correction, or explanation

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

The concluding words of this section plainly show that the patentee will not be protected from the consequences of his own ignorance or want of skill, or of perfect honesty and straightforwardness in preparing his Specification. Good faith alone will not serve him if he has blundered in other ways, nor will the greatest skill and knowledge avail if he has not used these to make everything in his Specification as plain as he possibly could. These are axioms not only as regards the conditions of amendment, but in every case where the patent requires to be subjected to legal tests.

Specifica-
tion or
Claims
must in
first place
be framed
in good
faith and
with
reasonable
skill and
knowledge.

As Section 20 does not absolutely prohibit the bringing of an action for infringements committed before the amendment, it is within the province of the Comptroller or Law Officer to impose conditions, if good cause is shown by the opponent.

Comp-
troller may
impose
conditions
in granting
amend-
ment.

Where action for infringement has been taken on a patent, and the plaintiff discovers, from the defence or from some other cause, that his patent has been partly anticipated or is otherwise defective, he may apply to the Court for leave to amend his Specification *by way of disclaimer*; and the Court may direct that in the meantime the trial of the action shall be postponed. Permission to amend a Specification in such a case is usually coupled with the condition that the costs of the action up to the time of leave being given, and, generally speaking, all costs occasioned by the application for leave to amend, are to be paid by the applicant, whether the action succeeds or fails.

Patent
sub judice
may be
amended on
terms as to
costs &c.

CHAPTER XI.

ASSIGNMENTS OF PATENTS.

A patent or a share in a patent is an assignable property.

THE form of grant being to the patentee, his executors, administrators, and "assigns," it follows, from the terms, that a patent is assignable. And not only is it assignable as a whole, but any part or share of the patent may be dealt with, or the right to use a distinct and separate part of the invention may be bought and sold. Further, a patent may be assigned for any place in or part of the United Kingdom, and such district or divisional assignments are by no means uncommon.

Assignment should be by deed.

An assignment should be by deed (*per* Lindley and Bowen, L.JJ., in *Stewart v. Casey*, 9 P. O. R. 9); for the grant itself being under seal, it follows, as a rule of law, that things which are created by deed can only be assigned by deed.

If, however, an instrument not under seal purports to be an assignment of a patent, it is submitted that it would act as an agreement to assign, and specific performance could be enforced on this ground.

Contingent assignment.

An agreement to assign a patent upon the happening of a certain event would operate as an assignment without further assurance, upon the happening of the event.

Patent of bankrupt patentee passes to trustee.

If a patentee, or the proprietor of a patent, or of a share in a patent, should become bankrupt, his interest or share passes to the trustee in bankruptcy.

In drawing an assignment, any form of words which clearly transfers the proprietorship of the patent from the assignor to the assignee will serve.

Heads of assignment.

The usual course is first to indicate the patent grant, distinguishing it by number, date, and title. If the assignor is himself an assignee, the devolution of title should be set forth.

Next come the words purporting to assign the patent;

together with the rights and powers of the patentee, the consideration being here set forth.

The covenant for title is implied, in accordance with the Conveyancing Act, 1881, if the assignor describes himself as the "beneficial owner" or "trustee." Next should follow a covenant for the validity of the patent, as far as the acts of the assignor are concerned. In addition, it is sometimes considered prudent to insert an express covenant as to any improvements upon the patent that may thereafter be made by the assignor. If this were not done, a patentee or assignor might immediately afterwards produce an invention which might entirely supersede the invention he had sold.

Covenants.

Future improvements.

When the assignment deals with a share of a patent only, or is an assignment for a specified district, it is advisable to make provision for the payment of the annuities: otherwise an assignee might find himself compelled, for his own sake, to pay the annuities which would keep the patent in force, not for his benefit alone, but for the benefit of others upon whom he would have no claim for repayment.

Provision for payment of annuities.

In all cases where there are several co-owners of a patent, it is advisable to make specific arrangements as to the payment of their proportions of the annual renewal fees by the respective owners. The mutual rights and duties of the co-owners should also be laid down and limited.

Payment of annuities by co-proprietors.

It has already been said that a co-patentee or part owner might himself, and without the concurrence of the others, manufacture the invention or make profits without accounting to the others. This might fall hardly on the others, as a manufacturer capable of turning out large quantities of the patented goods might, so long as he was owner of a small share in the patent, do so with impunity, and without paying a farthing to his co-patentees. They, on the other hand, might be unable to get the manufacture taken up by others, so that the owner of, say, one-sixth of a patent might be making large profits, while the holders of the remaining five-sixths were making nothing.

Mutual rights of co-proprietors.

To prevent this, an agreement should be made binding

the present or future co-owners to account to each other for the profits made by them respectively, and to act in concert when granting licences. With regard to the latter, however, it should be said that in *Mathers v. Green* (L. R. 1 Ch. 29) an unreversed portion of the judgment of the lower Court held that where one of several joint patentees grants a licence, he is bound to account for the profits to his co-patentees.

Co-proprietorship might be resolved into trust.

In the event of the co-owners objecting to the quasi-partnership brought about by such an agreement as has been indicated, the patent could be assigned to trustees for the owners, the trustees being authorised to grant licences for the benefit of the owners, keep accounts of all profits, and distribute them in the proportions of ownership. The trustees would also be empowered to pay the renewal fees as they fall due, to provide for all current costs and expenses, and to institute or defend any proceedings at law in respect of the patent or trusteeship.

Corporations as proprietors.

A patent may be assigned to a body corporate in its corporate name, and such body corporate is entitled to be registered as the proprietors of the patent.

Persons other than patentee entitled to sue for infringement.

An action for infringement of a patent may be brought by the assignee, and the assignees of a bankrupt patentee may bring it. Where a distinct portion of a patent has been assigned, the assignee of that portion can act alone in bringing an action for infringement of this part of the invention. This was laid down by Erle, C.J., in *Dunnicliff v. Mallett* (7 C. B., N. S. 209, 227).

All assignments should be entered in the Register of Patents.

CHAPTER XII.

LICENCES.

By a Licence, the patentee relaxes the prohibition contained in the grant of Letters Patent against the public, in favour of a certain person—viz., the licensee—whereby the licensee is allowed to exercise the privilege originally granted exclusively to the patentee.

Nature of licence by patentee.

Licences may be classed as *Exclusive*, *General*, and *Restricted*.

Classes of licences.

An *Exclusive* Licence is a licence which is granted to one person or firm only. The patentee may reserve the continued use of the invention to himself personally, or he may exclude himself and his assigns. The exclusive licence may be for a fixed period, or it may be terminable by notice, or upon the happening of a contingency, or it may be for the full term of the patent and without power of revocation, in which case it amounts to, and for some purposes is treated as, an absolute assignment.

Exclusive.

A *General* Licence is a licence which is granted to several different licensees.

General.

A *Restricted* Licence may be described as a licence to use only a part of the invention, or to use it only for a certain purpose or within a certain district.

Restricted.

A licence to a manufacturer to make a patented article implies a licence to those who purchase the goods from him to re-sell to the public without direct authority from the licensor.

A licence is a personal right granted to the licensee, and cannot, therefore, be assigned or transferred by him, unless a power of assignment or transfer is specifically granted in the instrument. Neither can sub-licences be granted by a licensee, unless the power to do so is expressly conferred.

Licence a personal right not transferable.

Licences should be under hand and seal, but a licence of a less formal nature, even when granted by word of mouth, would be perfectly good as betwixt licensor and

Licences should be under hand and seal.

But less formal licences can be enforced as between the parties.

licensee, especially so if royalties have been paid and accepted. Such a licence could not, however, be registered in the Patent Office, nor could the licensee sue in the name of the licensor or otherwise for infringement by outsiders, as he might do if he were an exclusive licensee under deed.

Caution to be exercised in accepting licence.

The terms of a proposed licence should be very carefully scanned by the intending licensee: otherwise he may find himself for ever estopped from questioning the validity of the patent, although all the world besides may use it. Generally speaking, the mere relationship of licensor and licensee implies that the taker of the licence admits the validity of the patent, and is therefore estopped or hindered from denying a matter already stated or admitted by him. Consequently estoppel might take effect even where the licence was not under seal, or merely in the form of a letter, or even where the licence is verbal. As a rule such estoppel would exist only while the licence remained in force, or until the patent had been declared void in legal proceedings between the licensor and third parties (*Cheetham v. Nuthall*, 10 P. O. R. 321).

Estoppel.

But where more than the ordinary covenants have been imported into the instrument, or where the licence is for the full term of the patent, or where the taker of the licence agrees not to question the validity of the patent, the fettering of the licensee might be correspondingly severe, and complete estoppel set up.

In the absence of such restrictive terms in the licence, a licensee who wishes to discontinue should give immediate notice in writing to the licensor, and at the same time cease to use the invention (*Redges v. Mulliner*, 10 P. O. R. 21).

When the relationship of licensor and licensee has been thus properly determined, the licensee may afterwards dispute the validity of the patent—that is to say, if he again commences to manufacture under the patent, he will require to be dealt with as an ordinary infringer, and not as being estopped under his former licence.

Terms of licence should give

A rehearsal of the indicated possible difficulties points to the conclusion that, as it is to the interest of the licensor to bind the licensee as much as possible by the

terms of the instrument, on the other hand it is to the interest of the licensee to decline to accept anything that may too greatly hamper him in the future. Therefore the question of estoppel consequent upon recitals and statements in a licence, and actual or implied admissions on the part of the licensee, should be carefully considered before acceptance of the licence. If the licensor will make the concession, the most prudent course is to provide for discontinuance of the licence at once, on the patent being declared invalid, and expressly to bar admissions of the validity of the patent.

reasonable
freedom to
both
parties.

Again, from the point of view of the licensor it may be said that equal caution is required, lest, in seeming to guarantee more than can be substantiated, the question of failure of consideration should leave the licensee at liberty to dispute the licence. For example, the expressions "as beneficial owner" or "as trustee" would, under the Conveyancing Act of 1881, imply certain covenants for title which, as far as licensors are concerned, are best omitted from licences.

Risks of the
licensor.

Further, if the licence is exclusive, and no rent reserved, the licensor might well object to be too stringently bound by covenants for title and for validity, seeing that his only advantage from the licence will depend upon the enterprise of the licensee. At the same time he should have power of revocation for breaches of covenants, or in case the royalties do not reach a reasonable figure per annum within a given period. Otherwise an interested manufacturer might take an exclusive licence, for the express purpose of locking the patent up.

In the case of an exclusive licence, the payment of the renewal fees by one or other of the parties should be expressly provided for. In the absence of such provision, neither would be bound to pay these, and the responsibilities of the licensee might continue, although the patent had lapsed.

Exclusive
licence
should pro-
vide for
payment of
annuities
by one of
the parties.

An instance of this occurred in the case of *Mills v. Carson* (10 P. O. R. 9). Here an exclusive licence was granted to the defendants by the patentee for the then unexpired term of patent right for the con-

*Mills v.
Carson.*

sideration of £100 per annum. Nothing was said in the licence as to who should pay the renewal fees. Neither of the parties paid the next renewal fee, so that the patent lapsed. The licensee then declined to pay the next instalment of annuity to the plaintiff. On action being taken by the patentee's assignee, it was held by the Recorder, by the Divisional Court, and by the Court of Appeal, that nothing having been said in the deed about the payment of those fees, the licensee had no right to throw the onus of payment upon the patentee, and that he must pay and continue to pay the annuity prescribed in the deed for the term of years for which the patent would have lasted had it not been allowed to lapse. An ordinary licensee cannot sue alone in respect of infringements, but must join with the patentee. Even in the case of an *exclusive* licensee, his right to sue alone has never been expressly admitted by the Court, and the usual practice is to make the patentee co-plaintiff.

Right of licensee to sue when licence exclusive and irrecoverable.

When the licence, in addition to being exclusive, is irrevocable, and no payments are being made under it, the licence is virtually an assignment, and it seems reasonable to submit that the licensee may sue for infringements without making the licensor a party, although even this has never been directly decided.

Further covenants in licence.

The licensee usually covenants to pay the royalties and other sums agreed upon; to keep proper books of account; to allow inspection and the taking of extracts; and to make periodical returns, verified by statutory declaration, if required. He should also agree to stamp, number, or otherwise distinguish the goods where this is possible.

All questions as to mutual assistance in litigation, detection of infringements, the patenting of improvements, terms of revocation of licence, settlement of disputes by arbitration, &c., may be set forth in the instrument according to the arrangements of the parties.

Fraudulent licensor may be sued for recovery of moneys paid.

Where it is apparent that the licensor has acted fraudulently, all royalties and sums paid to him under the licence are recoverable.

Registration of licences.

Licences should be entered on the Register of Patents, and a registration fee of ten shillings is payable thereon.

When the licence is by deed, and no premium or fixed sum is payable on the making, the consideration being therefore uncertain, it must bear a stamp of ten shillings, under the Stamp Act of 1870: Where a fixed sum is paid, an *ad valorem* stamp is required, whether the licence is by deed or otherwise. Where the licence contains a provision for the payment of a minimum royalty, the revenue authorities require the payment of duty upon the gross minimum royalty reserved, although the licence may contain power for either of the parties to terminate the licence at any time.

Stamping.

COMPULSORY LICENCES.

Section 22 of the Patents Act provides for the grant of compulsory licences. The petitioner for such a licence must establish—

Compulsory licences.

1. Default of the patentee to grant licences on reasonable terms; also

Grounds for enforcing compulsory licences.

2. One of the three events mentioned in the section, viz.—

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

(b) That the reasonable requirements of the public cannot be supplied; or

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

It may be added that this section has proved almost inoperative since the beginning of the Act. Up to the time of writing, only three applications for compulsory licences have been made, and none of the three ever came to a hearing. It is, therefore, impossible to say upon what terms a compulsory licence would be granted.

An application for the compulsory grant of a licence is heard before the Board of Trade. An unsuccessful applicant has no appeal from the decision of the Board; but a patentee who may have been ordered to grant a licence might dispute the mandamus by which the order of the Board is enforced, so that practically he has a right of appeal.

Board of Trade decides on compulsory licences.

CHAPTER XIII.

AGREEMENTS.

AGREEMENTS also play an important part among documents affecting the working and proprietorship of patents and inventions.

Agreements before or after application.

Agreements may be made either before or after an application for the grant of a patent, and may be for divers objects. For example, if a poor inventor should make an application in conjunction with a person who has had no share in evolving the invention, but whose functions will be those of paying the expenses of obtaining the patent and of introducing the invention commercially, such an arrangement should form the subject-matter of agreement prior to the application being made; for if this is not done, the mere presence of the co-applicant's name would vest him with legal rights in one half share, which it might be difficult to disprove if he should afterwards refuse to enter into the intended agreement. Other reasons for agreement might arise in the case of a money loan from some one to pay the cost of the patent and afterwards to introduce it, the lender to acquire a share in the patent. Such pre-application agreement should distinctly identify the invention: otherwise the Comptroller might refuse to register it (if this should afterwards become necessary), on the ground that he had no means of verifying the representation that the invention mentioned in the agreement was the same as that afterwards protected.

Agreement before application should ascertain invention.

Agreements to ascertain mutual rights of co-patentees.

In the case of joint applicants or patentees, an agreement might be made either before or after the grant of the patent, limiting and defining the mutual rights of the parties, so that no one should have an undue advantage over his co-patentees.

Agreement to purchase.

A share in an invention and in the patent to be afterwards obtained may be purchased even before application

is made for a patent, and an agreement may be based upon this sale, in which the inventor binds himself to assign a share in the patent as soon as it shall have been issued.

Legally, until the Letters Patent are actually sealed and issued there is no vendible property existing: therefore an absolute assignment by deed of a patent for which application only has been made is not effectual. All that can be done is to make an agreement to assign when the patent is issued, and specific performance of such a contract will always be enforced.

Absolute assignment made only after grant of patent.

CHAPTER XIV.

THE REGISTER OF PATENTS.

WHEN A Patent is sealed, the Comptroller causes it to be entered by its date, number, and title, together with the name of the patentee, in the Register of Patents, which is a book kept at the Patent Office and containing particulars of everything affecting the existence and proprietorship of each patent so entered. Thus, the Register will contain entries of assignments, licences, amendments, extensions, payment of renewal fees, and other incidents in the life of a patent. The Register is *prima facie* evidence of any matters inscribed therein. No notice of any trust will be entered on the Register, but registration of an assignment containing trusts would not be refused. For example, it was held in *Stewart v. Casey* (9 P. O. R. 9) that the true construction of Sections 23, 85, and 87 of the Patents Act of 1885, and the Patents Rules, Section 85, only excludes from the Register simple notices of trust, and not documents affecting the proprietorship

Register.

Trusts not registrable.

of a patent, whether by creating trusts or otherwise; and that equitable assignments of a patent, or of a share in a patent, may be entered on the Register as documents affecting the proprietorship.

Documents dated before the actual sealing of Letters Patent, but after the date of application, will be accepted for entry on the Register, but only after the sealing of the patent.

Documents relating to dealings with invention before application, as a rule, not registrable.

In the majority of cases, documents referring to dealings with an invention before application has been made for a patent, are not capable of being entered on the Register at any time. The reason is, that the Comptroller would have great difficulty in satisfying himself that the invention referred to in the document sought to be registered was the same as that afterwards protected and patented. For example, suppose that the invention referred to in the document was "Improvements in Prime Motors," and that the application afterwards made had precisely the same title, it is conceivable that this title might serve for fifty different inventions, and that the invention contemplated in the document was for an improvement on the cut-off valve of a steam engine, while the application, although bearing the same title, might refer to an entirely different part of, and be applicable to, an entirely different class of motor.

Still it is evident, from the words of North, J., in *Parnell's Patent* (5 P. O. R. 126), that where the invention referred to in the document and the invention afterwards patented are *unquestionably* the same, registration will not be refused. Therefore, in such an agreement, a sketch and description of the invention should be attached, so as to identify it with the subject-matter of the application to be afterwards made.

Each volume of the Register is preserved for twenty-one years from the date of the latest patent recorded in it.

Persons entitled to register.

When a person becomes entitled to a patent, or to an interest therein, by agreement, or by transmission, or by operation of law, he should forward a request to the Comptroller for the entry of his name on the Register as complete or partial owner of the patent.

The request should be made according to Form "L."

and should be signed by the person requesting to be registered as proprietor.

A body corporate may be registered as proprietors in its corporate name, and in such a case the request should be signed by an authorised agent. Bodies corporate.

The request—on Form “L” in the case of an assignment, and on Form “M” in the case of a licence—should be accompanied by the original assignment, licence, or other document, and by an attested copy of the same, which is retained by the Comptroller.

If the assignment or other instrument should refer to a document or documents affecting the title and not in the possession of the Comptroller, the original or an official or attested copy must be left with the Comptroller. References to collateral documents.

Certified extracts from the Register are furnished by the Comptroller on payment of a small fee, and the Register is open to the inspection of the public every weekday. Thus a proposing purchaser or licensee can satisfy himself concerning all registered dealings with the patent. Certified extracts from Register obtainable.

Where rectification of the Register has been ordered by the Court, the order directs due notice of the rectification to be given to the Comptroller, who will thereupon amend the Register. Rectification by order of Court.

CHAPTER XV.

MISCELLANEOUS.

REVOCATION OF PATENTS.

The old action of *Scire facias* having been abolished by the Act of 1883, revocation of a patent is now obtained by petition to the Court. Abolition of *Scire facias*.

This petition is not presentable in the Court of the County Palatine of Lancaster, but it may be sent for trial at assizes before a judge without a jury. Petition for revocation.

The
"Court."

The "Court" means the High Court of Justice in England, the High Court of Justice in Ireland, and the Court of Session in Scotland.

A petition for revocation may be presented by—

Persons
entitled to
apply for
revocation.

- (1) The Attorney-General for England or Ireland, or the Lord Advocate in Scotland, or any person authorised by them.
- (2) Any person alleging that the patent is obtained in fraud of his rights, or of the rights of any person under or through whom he claims.
- (3) Any person alleging that he, or a person through whom he claims, was the true inventor of the subject-matter of the patent.
- (4) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

Advisable
always to
obtain fiat
of Law
Officer.

Under paragraphs 2, 3, and 4, a person may present his petition as of right; but upon other grounds he must obtain from the Attorney-General in England or Ireland, or the Lord Advocate in Scotland, his fiat or leave to present the petition. This fiat is not issued as a matter of course; but even where the applicant can present his petition under paragraphs 2, 3, and 4, it is sometimes better to fortify the petition with the fiat of the Attorney-General or Lord Advocate, so as to decrease the possibility of the petition failing, upon the ground of insufficient *locus standi*.

It must, however, be said that in *Morgan's Patent* (5 P. O. R. 186), Chitty, J., held that, granted the petitioner is qualified to present the petition himself, under paragraphs 2, 3, and 4, the patent may be attacked on any other ground.

Procedure
to obtain
fiat.

To obtain the fiat of the Attorney-General, the following papers should be sent to the patent clerk:—

- (a) A memorial to the Attorney-General asking his authority, and stating all the circumstances.

- (b) A statutory declaration verifying the statements in the memorial.
- (c) Two copies of the proposed petition and of the particulars proposed to be delivered with it.
- (d) The certificate of a barrister that the petition is proper to be authorised by the Attorney-General.
- (e) A certificate by a solicitor that the proposed petitioner is a proper person to be a petitioner, and that he is in a position to pay the costs of the petition if unsuccessful.

If the Attorney-General think fit, he may direct that the patentee shall have notice, and be allowed to appear before him and show cause why the fiat should not be issued.

The petitioner must deliver with his petition particulars of the objections upon which he means to rely. These may be amended from time to time with leave of the Court, but when complete, no evidence will be admitted in proof of any objection not included in the particulars, except by leave of the Court or a judge. If such leave is given, it will in most cases be on the usual terms—*i.e.* payment of costs by the petitioner up to the time of his making application to amend particulars.

Particulars of objections.

A petition for revocation is properly an action, and the issues are the same as in an action to try the validity of a patent.

When a patent is revoked on the ground of fraud, the successful petitioner, if he is the true inventor, can have a patent granted to him for the invention, as of the date of revocation, but expiring at the same time as the original revoked patent would have expired.

Patent revoked may in cases of fraud be transferred to petitioner.

PROLONGATION OF PATENTS.

Section 25 of the Act of 1883 refers to the extension of the term of a patent, and provides that a patentee may present a petition to Her Majesty in Council, praying that his patent may be extended for a further term; but such petition must now be presented at least *six months* before the time limited for the expiration of the patent.

Period within which petition for prolongation must be presented.

Grounds for granting petition.

Periods of extension.

Persons entitled to apply for prolongation.

Petitioner must present full accounts.

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

As the term "patentee" includes, under Section 46, any person who is for the time being entitled to the benefit of the patent, it follows that not only can the original patentee present a petition for extension, but also the executor or administrator of a deceased patentee, or an assignee of a patentee who has sold his interest.

In presenting a petition for extension, the applicant must state fully and fairly everything relating to the patent, and be prepared with complete sets of profit and loss accounts, so that approximately exact results of the working under the patent may be laid before the Committee. Anything savouring of suppression or designed confusion will most certainly result in the throwing out of the application.

It is much better plainly to state an even apparently damaging fact than to try to suppress it, for there is no tribunal more impatient of want of good faith than the Judicial Committee.

A petition for the extension of a patent dated after the 31st of December, 1883, will require to be presented within six months before its expiry.

But a petition for prolongation of a patent dated before that time may be presented any time before the expiry of the patent.

It must, however, be "prosecuted with effect"—*i.e.* some definite step must have been taken by the Judicial Committee before the patent expires. It is therefore better, even in the latter case, to present the petition within the six months.

Advertisement of notice of intention to petition.

Notice of the intention to petition for extension requires to be advertised in the *London Gazette*, and also in newspapers circulating in districts where the inhabitants are

likely to be interested in the subject-matter of the patent. The petition must actually be presented within one week from the last insertion of the advertisement in the *London Gazette*.

On or before the day fixed for the hearing of the petition, any person may enter at the Council Office a caveat, addressed to the Registrar, objecting to the extension. The opponent is not required to show such personal interest as in the case of opposition to the grant of a patent or amendment of a Specification before the Law Officer.

Opposition to petition.

Any person may oppose.

It is advisable to state fully all the particulars of objection to the extension in the caveat; but in *Stewart's Patent* (3 P. O. R. 7) evidence of prior user, not included in the particulars, was admitted, although this resulted in the loss of the costs by the opponents, who were successful.

Particulars of objection.

The Attorney-General may give evidence of objections on behalf of the Crown, irrespective of the particulars.

Objections by the Crown.

When an extension is opposed, four weeks' notice of the hearing must be given by the applicant to the opponent, and the applicant must also advertise the date of hearing in the *London Gazette* and such other newspapers as the order may name.

Procedure in opposition.

At least a week before the hearing, the petitioner must lodge at the Council Office six printed copies of the Specification and four copies of the balance sheet, showing the expenditure and receipts relating to the patent.

At the hearing, the petitioner and opponent may appear either personally or by counsel. The Attorney-General is always present to watch the case in the interests of the Crown, and may interpose, even although no caveat has been entered. The rules of evidence are the same as in courts of law.

Hearing of petition.

In examining the request for extension, the Judicial Committee will take into consideration the merits of the invention as regards the public, and the remuneration obtained from it by the patentee or his representative or assignee.

The three chief points to be proved by the petitioner are—

Points to be enlarged upon by petitioner.

- (1) The merit of the invention.

(2) That every possible effort has been used to make the invention commercially successful.

(3) That, without any fault of his own, the petitioner has been unable to reap a sufficient reward.

As far as merit is concerned, the chief thing to make plain is the great utility of the invention to the public.

Profits on foreign patents to be shown.

Where foreign patents have been obtained for the invention, this should be stated and the accounts should show the expenditure and receipts in connection with these.

Deductions from profits.

Where a certain profit has been made, deductions from this will be allowed for personal expenses of the petitioner, during the periods when he devoted himself exclusively to the pushing of the patent.

Law costs not allowed to be deducted.

It seems that law expenses incurred by the patentee in maintaining his patent rights are not allowed to be deducted from the profits.

Although it is scarcely the function of the Judicial Committee to try the validity of the patent for which extension is sought, still they will not grant extension where the patent is evidently bad. Therefore evidence of anticipation, by the opponent, will be received and given effect to.

Usual period of extension seven years.

As a rule no extension is granted for a longer period than seven years, but in rare instances ten and even fourteen years' extensions have been granted.

The new Letters Patent are sealed and dated as of the date of expiration of the original patent. No new Specification requires to be filed.

RESTRAINT OF THREATS.

Under former Acts threats not restrainable.

Before the Act of 1883, a patentee might almost with impunity send out circulars threatening legal proceedings on account of alleged infringements of his patent. He was then under no compulsion to bring any action in furtherance of his threats, and unless the party aggrieved could prove that these threats were injurious, untrue, and made maliciously and in bad faith, he had no remedy. So long as the patentee could make out any case that he had, or believed he had, reasonable ground for uttering such threats, he was safe.

Now, however, Section 32 of the Act of 1883 provides that "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 damages, if any, as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not, in fact, an infringement of any legal rights of the person making such threats: Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent."

Now Section 32 provides for restraint of threats for infringement.

Section does not apply if action is taken with due diligence.

The manner of conveying such threats is not very material, so long as it reaches the interested parties or their customers, and is calculated to have a restraining or injurious effect. For example, threats conveyed by circular or advertisement are not the only grounds of action: it has been held that threats made in a private letter, or in the course of correspondence (even when without prejudice), or at an interview, or when conveyed by a solicitor's letter, come within the meaning of the section.

What constitutes an actionable threat.

The threat must be in respect of something which has been done or is being carried on. As Bowen, L.J., expressed it in *Challender v. Royle* (4 P. O. R. 374), a merely general warning "to pirates not to pirate, and to infringers not to infringe," and that the patentee has a patent which he intends to enforce, is not in itself an actionable threat. But, even in the case of such a general statement the circumstances will be narrowly inquired into, and in the event of proof of damage an action would be maintainable.

Threat must relate to particular infringement.

General warning not a threat.

The remedies of an aggrieved person are, an action to recover such damages as may have been sustained, and an injunction against the continuance of the threats. These remedies are concurrent. Damages will be awarded only where actual injury has been sustained. Thus, in *Kurtz v.*

Remedies of threatened person.

Spence (5 P. O. R. 161), where the threats had been conveyed in a correspondence conducted "without prejudice," and where the plaintiffs had not gone to any expense for plant or machinery for the manufacture of the alleged infringing invention, a reference as to damages was refused.

Procedure where plaintiff questions validity of defendant's patent.

The plaintiff in such an action may question the validity of the defendant's patent, but in this case the action is conducted as if the defendant had brought an action against the plaintiff for infringement of his patent, the defendant having the first and last word.

"Reasonable time" within which party using threats should bring his action for infringement.

Three months after the utterance of the threats complained of has been considered a reasonable time within which to bring an action for infringement of the patent. The bringing of this action extinguishes the right of the person threatened to his remedy for the threats under Section 32.

OFFENCES AND PENALTIES.

Section 105.

Section 105 of the Act of 1883 provides that "Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, shall be liable for every offence, on summary conviction, to a fine not exceeding five pounds."

Penalty for falsely marking articles as "patented."

A person shall be deemed to represent that an article is patented if he sell the article with the word "Patent," "Patented," or any word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed, or otherwise applied to the article.

Expired patent.

It is not an offence under this section to continue to mark an article as "Patent" after the patent has expired.

How articles under provisional protection should be marked.

Where an invention has been provisionally protected only, it is an offence to mark or sell it as "Patented." In such a case the best course is to mark on the article, "Patent applied for, No. . . ."

Penalty for use of Royal Arms.

The succeeding section (106) forbids the use, except under authority, of the Royal Arms, or of arms deceptively similar thereto, in the carrying on of any business or calling, and so as to lead to the belief that the said business or calling is being carried on under royal or official

authority. The maximum fine on summary conviction is twenty pounds.

PATENT MEDICINES.

What are popularly known as "Patent Medicines" are distinct from patented inventions, and the term is a misnomer, which it will be no longer legal to use in the way of business. Under the Stamp Medicines Act of 1812, stamps, for application to any particular proprietary medicine, may be had from the Secretary of Stamps and Taxes, Inland Revenue, Somerset House, London. The applicant is required to pay for the preparation of the plate from which his stamps are to be printed, and this plate is kept in the custody of the Secretary, and used only for the purpose of printing the stamps which the owner may require. As has been said, such stamped proprietary medicines have hitherto been known and sold as "Patent Medicines," although not the subject of Letters Patent. Now, however, it is clear that anyone describing and selling medicines of this description as "Patent Medicines" will be liable to a penalty. In the *Pharmaceutical Society v. Piper* (L. R. 1893, 1 Q. B. 686) Collins, J., distinctly held that patent medicines meant "Medicines the subject of Letters Patent."

Patent medicines.

Patent medicines, so termed, must now be the subject of letters patent.

PATENT AGENTS.

Under the Supplementary Act of 1888 it was provided that after the 1st of July, 1889, no person shall be entitled to describe himself as a Patent Agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a Patent Agent. Any person contravening the section is liable on summary conviction to a fine not exceeding twenty pounds. The term "Patent Agent" means exclusively an agent for obtaining patents in the United Kingdom. The passing of this Act was a most necessary recognition of the importance to the public of the Patent Agent's profession. Up to the date of the Act there had been no means whatever of excluding incompetent persons from practising, much to the detriment of the public. In

Penalty for false description as "Patent Agent."

Roll of
Patent
Agents.

Training
and require-
ments now
necessary
to qualify
for admis-
sion to Roll
of Patent
Agents.

Chartered
Institute of
Patent
Agents.

forming the roll, it was of course impossible to shut out many of these incompetent practitioners, or to prevent the entry of others with very slender claims to admission. But, in spite of this drawback, it may fairly be said that the great body of the profession as it now exists approaches a respectable level, and will at the present rate of progress eventually attain a very high standard of efficiency. Admission to the roll is now only to be obtained after proof of proper professional training for at least seven years, as a pupil under a Registered Patent Agent, and after passing very searching qualifying examinations, which are held from time to time under the Register of Patent Agents Rules, 1889 to 1891.

The Institute of Patent Agents, which was intended to constitute a representative body of the chief Patent Agents of the United Kingdom, was formed in 1882, and was incorporated by Royal Charter in 1891. The Fellows of this Institute have alone the privilege of styling themselves Chartered Patent Agents. The transactions of the Institute are published annually in a volume edited by the Secretary.

PART II.—TRADE MARKS.

CHAPTER I.

INTRODUCTION.

THE custom of a maker of goods adopting a distinctive mark to affix to his merchandise is very ancient.

Antiquarians point to such distinctive makers' marks upon objects identified with various periods in the world's history, and there is no doubt that in the most remote times a workman whose goods had acquired fame by reason of his skill marked his products so as to show their origin.

Origin of
trade
marks.

Within our own historical purview, the Common Law soon began to take note of and punish fraudulent imitations, and to recognise and protect the right of the producer to have his distinctive mark reserved exclusively to himself. The first case which has been recorded, although in all probability not the first dealt with by the Courts, is that of *Southern v. How*, which occurred in the reign of Elizabeth, and in which damages were given to a clothmaker on proof of piracy of his distinctive mark. It is true that in after cases, the Courts, suspicious of creating anything that seemed to savour of monopoly, for some time hesitated to declare that there was any actual right of property in a trade mark; but early in the present century this ceased to be a matter of doubt. It became apparent that the exclusive possession of a distinctive trade mark was in no sense a monopoly likely to be injurious to the public, but was in reality a protection to them.

First
recognition
at common
law.

Trade mark
no
monopoly.

It was of advantage to the trader, because he was thereby enabled to reap with more certainty the custom to which his skill and enterprise entitled him. It was also a protection to the public, because in buying an article bearing

a well-known mark they were more certain of getting something which possessed acknowledged and approved qualities.

*Bacon, V.C.,
upon trade
marks, and
their owner-
ship.*

The accepted principles upon which the Courts now proceed in trade mark cases are best expressed in the following deliverance of Bacon, V.C., in *Ransome v. Graham* (51 L. J. Ch. 897) :—“A manufacturer who produces an article of merchandise which he announces as of public utility, and who places upon it a mark by which it is distinguished from all other articles of a similar kind, with the intention that it may be known to be of his manufacture, becomes the exclusive owner of that which is henceforth called his trade mark. By the law of this country (and the like law prevails in most other civilised countries) he obtains a property in the mark which he so affixes to his goods. The property thus acquired by the manufacturer, like all other property, is under the protection of the law, and for the invasion of the right of the owner of such property the law affords a remedy similar in all respects to that by which the possession and enjoyment of all property is secured to the owners.”

*Persons
entitled to
acquire
and use
trade
marks.*

It will be noted that the learned Vice-Chancellor, in the foregoing quotation, speaks only of a “manufacturer” adopting a trade mark for the goods he has made. It must, however, be said that, although this is perhaps the most common ownership of a trade mark, there are many instances where the mark is adopted and applied by those who are not actual makers of the goods to which the mark is attached. Thus one person may weave calico, and another may print or bleach or pack it, and a trade mark might be applied by the printer or bleacher or packer, and be registered by him and recognised as his alone. Or the mark might be applied by a mere middleman, who has no share whatever in the manufacture or treatment of the goods, such as an exporter or importer, who merely buys and sells; or by a person who has selected the goods. In all of these cases the mark belongs to the middleman, and the actual manufacturer, who supplies him with the goods to which the mark is affixed, has no claim to any share in it.

But, apart from manufactured goods, trade marks might be used to distinguish substances which are natural products, such as moulders' sand, coal, mineral waters or mineral oils, fruit and the like.

Trade marks applicable to natural products.

Previous to 1875 no means existed for acquiring and protecting trade marks by registration. It was occasionally the practice to enter a trade mark at Stationers' Hall, but this conferred no protection whatever. Therefore in bringing an action against an infringer it was necessary to depend entirely upon the Common Law right, and to prove user before the plaintiff's right to take action was admitted.

Trade marks not registrable before 1875.

The Merchandise Marks Act, 1862, had for its main object to subject infringers of trade marks to the operation of the Criminal Law, and the same is the case under The Merchandise Marks Act, 1887. But before the latter date, registration had been provided for by The Trade Marks Registration Acts, 1875 to 1877, and at the present time registration is governed by The Patents, Designs, and Trade Marks Acts, 1883 to 1888.

Merchandise Marks Act, 1862.

Merchandise Marks Act, 1887.

Trade Marks Registration Acts, 1875 to 1877.

Patents, Designs, and Trade Marks Acts, 1883 to 1888.

Registration of trade marks is granted to aliens, and the rights of aliens in their marks are protected in the English Courts as rigorously as if they belonged to British subjects.

CHAPTER II.

ON THE NATURE AND DEFINITION OF A TRADE MARK.

PASSING over in the meantime the definitions of trade marks as set out in the Merchandise Marks Acts of 1862 and 1887, and as declared in the Trade Marks Act, 1875, the present statutory definition of a trade mark is to be found in Section 64 of the Patents Act, 1888. The definition as it now stands is as follows:—

Definitions of trade marks.

“(1) For the purposes of this Act, a trade mark must

consist of, or contain at least one of, the following essential particulars :

Distinctive reproduction of name.

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

Signature.

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

Device &c.

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

Invented word.

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

Selected word.

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

Additions.

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

“(3) Provided as follows:

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

Old word, letter, and figure marks.

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

Definitions amplified.

The foregoing definitions are sufficiently clear to speak for themselves, but a short reference to each head may prove of advantage.

First.—A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

Secondly.—A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark.

The first and second heads are practically one and the same, and may be treated together.

By itself, and apart from any distinctive manner of printing or impressing, a name may constitute a trade mark—not a registrable trade mark, but still a species of property which can under the common law be made good against all the world, with the exception of *persons of the same name*. For it is clear that although a manufacturer of the name of Smith may have carried on business as a sewing machine maker for many years, and may have made his name famous in connection with sewing machines, he cannot on that account prevent another person of the same name from establishing a similar business, and selling machines under his own name. Smith would have his remedy if Jones were to manufacture sewing machines and sell them under the name of Smith, because it would be reasonable to imply that such a course showed fraudulent intent on the part of Jones to take improper advantage of the fame acquired by Smith. The rule, therefore, is that while as against persons bearing a different name a manufacturer's right in his "name trade mark" is absolute and exclusive, nevertheless as against persons bearing the same name no such exclusive right can be set up.

It must, however, be said that in some cases, even as against persons of the same name, a manufacturer would have his remedy, and a rival may be restrained from the free use of his own name if any fraudulent or unfair conduct in connection with such use can be brought home to him. Apart from the civil remedy, the criminal law will punish fraudulent use of a man's own name. In *Holloway v. Holloway* (13 Beav. 209) a brother of the plaintiff had to submit to an injunction, because it was held that he used his own name in such a manner as to imply a fraudulent intent to pass off his pills and ointment as of the plaintiff's manufacture.

Name *per se*
not a
registrable
trade mark.

Common-
law remedy
for
fraudulent
use of
name.

Holloway v.
Holloway.

Burgess v. Burgess.

Burgess v. Burgess (3 De G. M. & G. 896) was decided upon similar lines, although within more restricted limits, the defendant being restrained from using any sign or intimation capable of confusing the two establishments in the public mind. These and other cases may be submitted as showing that the mere name of an individual or firm, although not now registrable, is a perfectly valid trade mark, but subject to this disadvantage, that the owners cannot prevent others of the same name from using it also for the same class of business, so long as such others use it honestly.

Name only registrable when reproduced in distinctive manner.

Signature.

As has, however, been said, a mere trade name never was, and is not now, registrable in itself as a trade mark. It must, as the present Act says, be printed, impressed, woven, or otherwise produced in *some particular and distinctive manner*—that is to say, in some ornamental, fanciful, or peculiar fashion; and it is clear that a copy of a written signature comes under this description, since any one written signature is distinctive from another written signature. A trade name registered in this distinctive manner is then good against all the world—that is to say, *in its distinctive dress*. Except as regards the copy of a signature, the name registered in its distinctive dress need not be the actual name of the individual or firm applying for registration.

Thirdly.—A distinctive device, mark, brand, heading, label, or ticket.

Distinctiveness an essential in trade marks.

It will be noticed that each variety of mark set forth is subject to the qualification of distinctiveness. Applications for registration of marks under this heading are closely tested in respect of the essential feature of distinctiveness, and refusals are frequent on account of its absence. The mark must not only be distinctive, *i.e.* noteworthy in itself, but it must also be distinctive as compared with other existing marks.

Device.

The word “device” relates to a picture, such for example as a representation of some real or imaginary animal, or a geometrical or other figure, or crest, or in some cases a portrait.

It has been held that “marks” or lines on an article—

such, for example, as marking tobacco or edibles into squares or figures for the purpose of easy and exact subdivision—cannot be claimed as exclusive trade marks.

It was at one time possible to register pictorial representations of the goods as trade marks to be applied thereto: but the Comptroller will not now accept such pictorial representations as registrable trade marks. (See Official Order in *Trade Marks Journal*, No. 570, February 27th, 1889.)

Representations of goods not registrable.

It may be taken that initials printed in the ordinary non-distinctive manner are not registrable as trade marks, but initials arranged as a monogram of a sufficiently distinctive character, and especially when combined with some device, are usually accepted by the Comptroller.

Initials.

A “brand” is a mark for branding on corks, casks, butter-tubs, and the like.

Brand.

“Heading” is a technical name best known in the Manchester trade, and used to designate coloured or other stripes, or combinations of stripes, woven or printed, as headings or narrow borders upon the selvages or ends of piece goods. Registration of such “headings” is now possible only in the case of combination old marks, and even with old marks registration is extremely unlikely. It is certain that no new mark would now be registered which consists only of coloured stripes or arrangements of stripes as a “heading” to piece goods. An application for such a mark would be refused for lack of distinctiveness. “Heading” has also been interpreted as an additional and auxiliary label applied above the ordinary label upon which the chief mark is printed, but its recognised and usual meaning is that known in the Manchester trade.

Heading.

“Label” clearly refers to adhesive papers bearing the trade mark and capable of being stuck upon bottles, jars, cases, packets, and the like.

Label.

“Ticket” describes the case of a mark impressed upon a piece of material, such as pasteboard or metal, and loosely attached to the goods. The examples which most readily suggest themselves are the tickets pinned to the wares of a fancy goods dealer or a clothier.

Ticket.

Invented words.

Fourthly.—An invented word or invented words.

The Trade Marks Acts, 1875 to 1877, excluded fancy words from registration. The Patents Act, 1883, permitted the registration of fancy words not in common use. A fancy word has always been a favourite form of trade mark, since it is available not only to sight, but to speech and hearing. As a result of the Act of 1883 so many applications were received for the registration of fancy words, most of them both descriptive and laudatory of the goods, that the Courts were obliged to restrict and narrow the construction of the term "fancy word." In the leading case on the subject (*in re Van Duzer*, 34 Ch. D. 623) it was finally decided that a fancy word, to be capable of registration, must be a word having no meaning at all to the average Englishman, such for example as the word "Aeilyton," or, if it has any meaning at all, it must be obviously non-descriptive and non-deceptive.

Definition of "fancy word."

The amending Act of 1888 substituted "invented" words for "fancy" words. In devising an invented word as a trade mark, it should be the aim of the inventor to evolve a word not bearing upon the nature of the goods, and in no degree descriptive of the goods or of the effect produced. For example, "Glazo," as a mark for starch, would probably be refused as being somewhat indicative of the results of using such starch. "Satinine" as a mark for starch, blue, &c., was refused as being descriptive. "Emollio" for face cream, and "Granolithic" for artificial stone, have also been refused on the same grounds.

Examples of descriptive invented words.

Fifthly.—A word or words having no reference to the character or quality of the goods, and not being a geographical name.

Selected words.

Words or expressions registered under this clause need not be "invented" words or expressions.

But, on the other hand, the choice of such existing words or expressions is to some extent limited. Any word or expression savouring of advertisement, recommendation, or description is barred, and these are the very sort of words to which a manufacturer naturally turns. Therefore, an application for "Premier Ebony" as a trade mark for ink would be certain of refusal as being descriptive, and

as indicating quality. The term "United Service" has been accepted for soap; "Pharaoh's Serpents" for toys; "Charter Oak" for stoves. But applications of this nature are occasionally refused upon grounds which might sometimes be considered a little far-fetched. Thus, the word "Lady's" to be used in conjunction with the word "Blue" has been refused, because it was thought that to call a blue "Lady's Blue" was by inference a suggestion that this particular blue was of a higher quality than usual.

Examples
of meaning-
less selected
words.

Geographical words also are expressly excluded from the category of registrable trade marks, and this rule is very strictly adhered to. Geographical Dictionaries and General Gazetteers are ransacked by the trade mark authorities, with the result that many words which no one ever dreamt of as possessing a geographical signification have turned out to appear in such a list. For example, the word "Camel," which had been already registered before 1888 in connection with driving belts, was refused extension to another class by the Comptroller, after the Amending Act of 1888, because it was discovered that a very small and unimportant parish in Somersetshire bore that name. On appeal this refusal was upheld by the Board of Trade. This excluding clause is intended to prevent in the future the registration of such marks as "Glenfield Starch," "Eton Cigarettes," "Melrose Hair Restorer," "Strathmore Whisky," "Reading Biscuits," "Rugby Portland Cement," and the like.

Geographi-
cal words.

Examples
of terms
not now
registrable.

The reason is, that another manufacturer starting business in the same locality might be embarrassed in describing the place of origin of his goods, if the name of the place of origin had been registered as a trade mark by a rival manufacturer. Hence a possible discouragement to trade, which it is no part of the public policy to countenance.

As far as new marks are concerned, the foregoing rules furnish tests by which the registrable or non-registrable nature of a mark can be readily ascertained.

But at the date of the coming into force of the Act, many proprietors of existing and old marks saw themselves in danger of being shut out from registration altogether. As far as "word," "letter," and "figure" trade marks are concerned, it is evident that the new statutory definitions

Old marks.

of a trade mark narrowed the view which traders had been accustomed to take of the limits within which this class of trade marks might be adopted and maintained. Many words, letters, and figures, and combinations of these, not agreeing with the definitions for new marks, were in use before the passing of the Act, and had become so valuable to their owners that to shut them out from registration would have meant the infliction of considerable hardship. A side door was, therefore, opened by Section 64, Sub-section 3 (ii.), under which it is provided that “any *special and distinctive* word or words, letter, figure, or combination of letters or figures, or of letters and figures, used as a trade mark *before the Thirteenth day of August, One thousand eight hundred and seventy-five*, may be registered as a trade mark under this part of this Act.”

Section 64 allows registration of certain old marks not acceptable as new marks.

By means of this saving clause an old mark consisting of the particulars set forth, and which would probably be refused as a new mark, may be accepted for registration, provided it fulfils the conditions set forth.

Special and distinctive.

These are, that the word or words, or combination, forming the mark, must be “*special and distinctive*,” and that the mark was in use before the 13th August, 1875. As to the interpretation of the term “special and distinctive,” the practice of the Patent Office and the effect of a number of decisions tend to show that old marks are not by any means so severely criticised in respect of their special and distinctive nature as are new marks. Many labels and marks which have been in use since before the 13th of August, 1875, and which carry on their faces scarcely any features which can be called special and distinctive, are nevertheless accepted now by the Comptroller.

Conditions of registration as old mark.

Old mark must always have been used in same form.

To be effectual, the requisite prior user must undoubtedly have been as a *bonâ fide* trade mark applied directly to goods within the United Kingdom. The mark claimed must always have been used precisely in the form for which registration is sought. No material addition to or subtraction from the mark as used will be permitted. If the old mark has been altered in any way since the 13th of August, 1875, even although the alteration is but slight, the application to register is almost certain of refusal.

The amount of such prior user is not of much importance, granted that the use has actually taken place and in accordance with the required conditions.

Registration of an old mark, where such registration implies the enjoyment of privilege in respect of prior use as an old mark, is confined absolutely to the goods upon which the mark has been placed, and does not extend to registration as an old mark in respect of other goods, to which its use has been extended after the 13th of August, 1875. Foreign user is not taken into account, and where goods, whether of British or foreign origin, bearing a certain trade mark, have merely passed through this country on their way to another market, without being exposed here for sale, no privileges are acquired in respect of such prior user.

No privileged extension of old mark to new goods.

An incident to the registration of old marks was that, in many trades, different applicants sought to register the same or practically the same mark for the same class of goods. Sometimes the applicants were wholly unaware of the existence of the other marks, and cases arose in which several applicants applied in perfectly good faith to register, as their own, a mark which it turned out had been used by others for an equal or greater length of time in other parts of the country. This was especially the case in devices of a common type, such as anchors, crowns, tridents, &c. Clearly, where ten different manufacturers made ten different applications for the registration of the same mark for the same class of goods, and to which all seemed to have an equal right, it would have been ridiculous, even had it been possible in the face of Section 72, to recognise all of the claims, while to have registered one or two only would have been unjust to the others.

The Commissioners of Patents therefore formulated what is now known as **The Three Mark Rule**. This was to the effect that an old mark—that is to say, a mark used before the 13th August, 1875—might be registered by different persons in the same trade up to the number of three, and no more. This indulgence was, however, subject to the qualification that if the mark should prove to have

Three Mark Rule.

been used before the 13th August, 1875, by more than three persons, then it should be treated as a mark *common to the trade*, and not capable of registration by anyone, and if anyone had obtained registration before the Comptroller became aware of the facts, his registration might be cancelled (*re Shewlis & Blakey's Mark* and *Hughes & Young's Mark*, 10 P. O. R. 369). This Three Mark Rule was given effect to in Section 74 of the Patents Act, 1883, which expressly provides that any device which was, before the 13th August, 1875, publicly used by more than three persons, for the same or a similar description of goods, shall, for the purposes of this section, be deemed common to the trade in such goods.

Common marks.

Examples of common marks.

This does not mean that such a common mark is altogether incapable of registration. A common mark consisting, for example, of a word, such as the word "Selected" in the steel pen trade, or "Parchment" in the paper trade; or a combination of words, such as "Bank of England" in the sealing wax trade; or a device, such as a "syphon and glass" in the mineral water trade, or an "anchor" in the umbrella trade; or a combination of words and a device, such as a "crown" with the words "Best Best" in the iron trade, is still registrable, and many such marks have been registered, but only when accompanied by certain additions, whether of words, letters, figures, or devices, which latter are claimed as the distinctive characteristics, all proprietorship in the common mark *per se* being *expressly disclaimed*.

Rule 18 of the "Instructions" issued by the Comptroller runs as follows:—

"In the case of a trade mark used before the 13th August, 1875, common or open marks of any kind may be registered in connection with it; but in the case of a trade mark not so used (*i.e.* a new mark), common or open marks consisting of a word or combination of words only can be registered as a part of the mark.

"In each case the applicant for entry of such common particular or particulars must disclaim the right to the exclusive use of the same in a note at the foot of the

application form, such note to be signed by the applicant or his agent."

An owner of such a combination mark is bound to use the combination as registered, and in no other form.

By Section 1 of the Act of 1875, if the owner of a trade mark, whether old or new, failed to obtain registration, he was left powerless to restrain infringement or claim damages. But quickly recognising that there might be cases in which the owner of an old mark had an equitable claim to protection, although his mark might have been held incapable of registration, the Legislature cured this defect in the Amending Act of 1876. The effect of the alteration was, that if the proprietor of a trade mark, in use before the passing of the Principal Act, had applied for and had been refused registration, he might, nevertheless, institute proceedings either for the prevention of wrongful use, or damages for the infringement of such trade mark. Therefore, when an owner of an old mark had applied for registration and had been refused, his possession of the Comptroller's certificate of refusal placed him in a position to exercise whatever rights he might have had in the mark before and independently of the Acts.

Common-law rights of unsuccessful applicants for old marks under Act of 1876.

Certificate of refusal.

Section 77 of the Patents Act, 1883, preserves this arrangement, and is as follows:—

"A person shall not be entitled to institute proceedings to prevent or to recover damages for the infringement of a trade mark unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the 13th of August, 1875, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The Comptroller may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused."

Similar provisions under present Act.

The registration of a person as proprietor of a trade mark is *prima facie* evidence of his right to the exclusive use of the trade mark, and shall, after the expiry of five years from the date of registration, be conclusive evidence of his right to the exclusive use of the trade mark,

Registration *prima facie* evidence of right to mark.

After five years,

conclusive
evidence.

subject to the provisions of the Act (Section 76, Patents Act, 1883). The lapse of five years from registration is, however, no bar to proceedings brought for the purpose of rectifying the Register.

But mark
may be
expunged
even after
five years.

Therefore, if the registration of a mark is and has been wrongful from the first, from any cause, it is liable to be expunged from the Register, even after the lapse of five years (*Edwards v. Dennis*, 30 Ch. D. 454).

The registration of trade marks for cutlery and goods within the terms of the Cutlers' Company's Acts is governed by special rules.

Particulars
not regis-
trable as
marks or
parts of
marks.

In addition to pictorial representations of the goods, it may be noted that the following particulars are also restricted from registration either as trade marks or as parts of trade marks, viz.:—

- (a) Names of persons in the possessive case in combination with the names of goods.
- (b) The Royal Arms or Arms so nearly resembling them as to be calculated to deceive.
- (c) Representations of the reigning Sovereign or any member of the Royal family.
- (d) Representations of the Crown or the National Arms or Flags of Great Britain.
- (e) Such words as "Imperial," "Royal," and the like, either alone or as essential parts of a trade mark.

Foreigners'
rights
under Inter-
national
Convention.

It has been said that the subjects and citizens of foreign States are upon equal terms with British subjects in obtaining the registration of their trade marks in this country. Sections 103 and 104 of the Act of 1883 further enact that where a subject of a foreign State, which has become a party to the International Convention for the protection of Industrial Property (see Appendix), has made an application for the registration of a trade mark in his own country, he shall be entitled to the registration of his trade mark in this country in priority to other applicants (that is to say, applicants coming after the date of his foreign registration), provided he files his application in this country *within four months* of registration abroad.

These sections, if read literally, would point to the

possibility of the Comptroller being required by a foreign applicant to register a mark under those provisions, which could not be accepted by him if proffered as a new mark by a British subject. Many foreign countries will register almost any description of mark which is presented, and which would, as an original English mark, be certain of refusal here. It may, however, be assumed that the Comptroller would not accept and register as a new mark anything coming to him from a foreign source which did not satisfy the requirements of Section 64.

In *re The Carter Medicine Co.'s Trade Mark* (9 P. O. R. 401), North, J., makes it clear that, in his opinion at least, foreign trade marks, even when registered abroad, should, to insure registration here, conform to the requirements of the British Acts of 1883 to 1888.

It must, however, be confessed that the question is still in an unsettled state, because neither in the above case nor in the analogous instance of *The Californian Fig Syrup Co.'s Mark* (6 P. O. R. 126) were all of the essentials present to compel the Court boldly to confront the consequences of the unhappy wording of Sections 103 and 104.

In such States as have given their adhesion to the Convention, British subjects have, of course, corresponding advantages. Therefore it is to be feared that, if the actual wording of the sections of the British Acts were not given effect to here, British applicants might be differentiated against abroad, greatly to the injury of English commerce.

The probability is, that if the Comptroller were fairly confronted by a foreign applicant, with a mark properly registered in accordance with the rules of the country of origin, however at variance with British requirements, he would grant registration, rather than risk possible reprisals in respect of the registration of greatly more important British marks abroad.

Having thus passed in review the various definitions of trade marks and the qualifications and circumstances which govern registration, this chapter may be fitly closed by a few words of practical advice upon the choice of a trade mark.

Glancing at the list of essentials, as set forth in Section 64 of the Act of 1883, which must be carefully kept in view when deciding upon a trade mark, it is evident that the two most important divisions are—

- (1) A distinctive device.
- (2) An invented word, or a word arbitrarily chosen, not referring to the goods and not having a geographical significance.

An inspection of the applications advertised in the official *Trade Marks Journal* makes it apparent that, in nine cases out of ten, manufacturers prefer to adopt a distinctive device or picture as their trade mark.

Next in order of popularity appear to be invented and arbitrarily chosen words.

Trade
mark
should be
registered
before being
put to use.

It is a common indiscretion among manufacturers to design or choose a trade mark, apply it at once to the goods, and seek no protection from registration until the mark has, from its popularity, become a valuable trade property. It then occurs to the user, possibly only after attempts at infringement by others, that it would be advisable to register the mark, and application is made for that purpose. In many cases the response of the Comptroller is to the effect that the mark is not of a registrable nature, or is so similar to another registered mark that acceptance is impossible. Thus the applicant finds himself in this unsatisfactory position, that he must either choose a new mark and regard the time and money spent in advertising and popularising his first mark as thrown away; or he may elect to continue trading under the refused mark with the consciousness that if it should be infringed or fraudulently imitated by a rival, he has only the common-law remedy to depend upon, and can claim none of the advantages which the possession of a certificate of registration would have conferred upon him.

Therefore in designing and deciding upon a device or word as a trade mark, it is advisable that an intending user should first of all make himself certain as to its novelty and acceptability.

The Register of Marks is very jealously guarded against the inclusion of fresh marks which may seem in the

smallest degree to interfere with marks already registered. Even where the Comptroller is himself of opinion that the mark applied for is admissible, he will frequently ask the applicant to obtain consent to registration from the registered owner of an existing mark, which may in his estimation present some resemblance, however faint, to the proposed mark, and such permission is not easily obtained.

Consent
of owner of
prior mark.

The proper plan is, therefore, to make an application at once and without loss of time for the registration of the intended mark. Two or three weeks will enable the Comptroller to decide whether or not it is a mark which he can accept. If refused, another mark could then be substituted, and if this is accepted, the trader may then proceed to apply it to his goods with some assurance that he is safe in doing so.

In preparing a "device" trade mark, the design should be broad and simple, so as to be easily remembered when once seen. It should be striking, characteristic, and "distinctive" both in itself and as compared with other marks. Distinctive design must be apparent, and it may safely be said that simple geometric figures and the like, either alone or in combination, stand but little chance of acceptance. Carefully worked little pictures are not easily recognisable at a distance, or at a glance, and a device which is successful as a specimen of the fine arts is not usually the best type of trade mark. As a rule a device which sticks in the memory has something of the grotesque in it. No attempt should be made to introduce representations of the article to which the mark is to be applied. This would infallibly lead to refusal. Existing trade marks in which such representations occur have either been registered as old marks in existence before the 13th August, 1875, or they have been applied for and registered before the present rule against such representations took effect.

It has, however, been held, in the Court of Appeal, that where the shape in which the product is sold is not a necessary, but an arbitrarily given shape, as, for example, blacklead in the form of a dome, a representation of such arbitrarily given shape may be registered as a trade mark (see *in re James*, 33 Ch. D. 392).

Doubtful
exception to
rule that
representa-
tion of
goods not
registrable.

Further examples of invented words refused as descriptive.

When inventing or coining a word as a trade mark, no attempt should be made to refer, either directly or inferentially, to the goods themselves, or to their character, qualities, or effect. "Thermos," for example, has been refused as a trade mark for woollen underclothing, as being suggestive of warmth. In selected words, "Aquarius" has been refused as a trade mark for waterproofs; and many similar examples to the same effect might be given. All words having a geographical significance should also be avoided, and also all words having too close a similarity to known surnames.

The remaining forms a trade mark may assume are—

- (3) The name of an individual or firm, printed or reproduced in some particular and distinctive manner; and
- (4) The copy of a signature.

It is clear that neither of these types is so useful, nor so exclusive, as a "device" or "word" trade mark would be. As to the name, it is only the distinctive manner of printing or reproducing it, or, in other words, the device formed from the name, that constitutes the protected mark. The name itself cannot be confined to one individual. Another of the same name might commence manufacturing the same goods, and would have an equal right to register his distinctively printed name, or his signature, so long as neither imitated the distinctive features of that already registered.

The chief points to be avoided in designing or choosing a trade mark are as follows:—

Features to be avoided in designing trade mark.

- (1) A "device" trade mark should not include any pictorial representation of the goods, nor of the Royal Arms, nor representations of the reigning Sovereign, nor of any member of the Royal Family, nor of the Royal Crown, nor of the National Arms or Flags of Great Britain.

Word trade marks.

- (2) In a "word" trade mark, the word or words, whether invented or selected, should not refer to, nor be capable of being construed as referring to, the character, quality, or effect of the goods.

Neither must the word or words constitute a geographical name nor a surname.

(3) In a "name" trade mark, the name must not be used in the possessive case in conjunction with the names of goods. Thus, "Bunter's Bath Bricks" is unregistrable even when printed, stamped, or written in some particular and distinctive manner (see official order in *Trade Marks Journal* No. 570, February 27th, 1889). Name in possessive case.

(4) Generally. Even where the goods are patented specialities, it is advisable not to include the words "Patent" or "By Royal Letters Patent" in the registered mark unless accompanied by the number and date of the patent. "Patent."

The reason is this: Should the patent from any cause cease to exist, the trade mark then contains a statement which is not true and is deceptive, and in any proceedings by the owner this would be a most effectual weapon in the hand of a defendant (*Chearin v. Walker*, 5 Ch. D. 863). On the other hand, should the owner on the expiry of the patent cease to use the word "Patent" in his mark, he might be challenged for using his mark in a form different from that registered.

Such words or phrases as "Registered," "Entered at Stationers' Hall," "To counterfeit this is forgery," &c., must be struck out of all representations of trade marks sent up with applications to register.

CHAPTER III.

PROCEDURE IN REGISTERING A TRADE MARK.

The mere procedure in registering a trade mark is so simple that a short account will suffice to make it plain.

Any individual, firm, company, or corporation, capable of acquiring and holding property, may register a trade mark.

Persons who may register trade marks.

Foreigners have equal rights with British subjects, provided the mark is actually used on goods sold in this country.

Application forms.

The requisite forms for making application to register trade marks are on sale at all the chief post-offices in the United Kingdom. Form "F," which bears a stamp of five shillings, is the form of application for registration.

Representation of mark.

One of the representations of the mark should be mounted on this form, and the particulars inserted in accordance with the marginal notes which are printed on the sheet.

Classification of goods.

All goods, in respect of which trade marks may be registered, are divided into fifty classes, and the applicant must state the class under which he desires to claim the mark, and also particularise the goods to which the mark is to be applied. This classification will be found in the Trade Mark Rules in the Appendix.

Marks should be registered only for goods actually dealt with.

It is important to note here that an applicant should not claim the mark for goods in which he does not deal or intend to deal. By a recent regulation the Comptroller draws attention to the practice of applying for marks in Class 50 for miscellaneous goods, which he says "it is difficult to suppose would be generally dealt with by the same firm." He goes on to say that care should be taken not to include goods for which the mark is not intended, and that evidence may be asked to show that the goods specified are actually made or dealt in by the applicant. This restraint, which is really applicable to all classes, is directly in the interests of applicants, seeing that registration in respect of goods not traded in may afterwards be made the subject of a motion by some aggrieved person to rectify the Register by expunging or limiting the mark, and this notwithstanding that the mark has been five years on the Register. A case bearing directly upon this point is that of *Edwards v. Dennis* (30 Ch. D. 454). But there is practically no difficulty in getting the Court to expunge a trade mark registered in this improper manner. In a recent motion, heard on the 3rd April, 1894, by Mr. Justice Stirling, *Reddaway & Co.* applied to rectify the Register by expunging certain marks registered by *Peck & Co.* in respect of goods in which *Peck* did not deal. The motion was unopposed, and the order for rectification made accordingly.

The application form, "F," is signed by the applicant, or by his agent duly authorised. If the application is made by a firm, the form may be signed in the firm's name by a partner. If made by a company, the secretary or other officer or a director may sign his own name, adding his proper designation, and also the words "For the Company."

Two additional representations of the mark must accompany the application form "F," mounted on sheets of equal size with the form "F," and bearing the name and address of the applicant or his agent. In Classes 23 to 35 inclusive (textile goods and materials), four additional representations of the mark must be supplied.

Additional
representations.

Where the representations of the mark are too large to mount on forms "F" and "G," they may be mounted on linen, and folded and fixed to the forms. The papers, when completed, may be delivered or posted to "The Comptroller, Patent Office (Trade Marks Branch), 25 Southampton Buildings, London."

In the course of two or three weeks the applicant will be advised either of the acceptance of his mark, or that it has been objected to or refused by the Comptroller. When refusal takes place it is based either on resemblance of the mark to existing marks on the register, to which the applicant will be referred, or on the ground of non-conformance with the requirements set forth in the last chapter.

Dealings of
Comptroller
with
application.

Sometimes the objection of the Comptroller to register a mark on account of its resemblance to an existing mark may be got over by obtaining the consent of the owner of the prior mark. When so objected to, and the resemblance seems remote, it is advisable to sound the owner of the prior mark with the view of obtaining his consent to registration, even where this is not suggested by the Comptroller. If the prior owner gives his consent, the Comptroller will in many cases withdraw his objection.

When the mark is accepted by the Comptroller, the notice of acceptance calls upon the applicant to furnish a wood block or electrotype for the purpose of illustrating the advertisement of the mark in the official *Trade Marks Journal*. Such a block or electrotype should correspond exactly with the representations accompanying the application.

Notice of
acceptance.

Advertis-
ment.

and should not be more than two inches square. If larger, an additional charge of two shillings for each additional inch or part of an inch will be made. The largest space available is eight inches by six inches.

Nothing but the actual mark as applied for should appear on the face of the block or electrotype. The number of the application should be written or printed on the side of the block or foundation of the electrotype.

Trade
Marks
Journal.

The *Trade Marks Journal* (price sixpence) is published weekly, and contains a print of each mark advertised, with particulars of the class and applicant's name and address. When the mark is not illustrated, as for example in the Cotton Classes, the advertisement refers to a place or places where a representation of the mark can be seen.

Certificate
of registra-
tion.

If no opposition to registration is offered within one month from the date of advertisement in the Journal, the applicant is called upon to pay the final fee (£1), and the certificate of registration is at once issued. This is the short history of a trade mark application where nothing is done either by the Comptroller or by outsiders to trouble or arrest its progress. But any applicant should be prepared for such a possibility.

Comp-
troller's
objection or
refusal.

The Comptroller's objection to register a mark submitted to him, whether based on the ground of non-conformity to the rules, or because of resemblance to an existing mark, is frequently accompanied by an invitation to the applicant to appear before him personally or by representative, and state his case in support of the application. If the applicant does not accept this invitation, or if he fails at the hearing to convince the Comptroller that his mark should be accepted, the mark is absolutely refused. If dissatisfied with the decision of the Comptroller, the applicant may appeal to the Board of Trade, and the Board may either decide the matter, or may if they think fit refer the appeal to the Court.

Hearing in
support of
application.

Appeal to
Board of
Trade.

Opposition.

If, on the other hand, the mark should be opposed by a rival trader or by any other aggrieved person who thinks his interests would be imperilled by the registration of the mark, the notice of opposition should be given within one month from the date of the Journal containing the advertise-

ment. The time for opposition might, however, be extended by the Comptroller, on good cause being shown, for a period of not more than three months.

The notice of opposition must state the ground or grounds on which the opponent intends to oppose the registration, and be signed by himself or by his solicitor or agent, and must contain an address for service in the United Kingdom. The form "J" given in the Rules is to be adopted, with such variations as are called for by the circumstances. This form bears a one pound stamp.

Notice of
opposition.

When the opponent bases his opposition upon the existence on the Register of a trade mark similar to the mark opposed, the notice must state the date of registration and the number on the Register of such alleged anticipatory trade mark.

Within one month after receipt of this notice of opposition, or within such further time as the Comptroller may allow, the applicant may send to the Comptroller a counter-statement, in duplicate, of the grounds on which he relies to support his application. If he fails to send this counter-statement, he is considered to have abandoned his application.

Counter-
statement
by
applicant.

The next step is taken by the opponent, who must leave a declaration or declarations containing the evidence upon which he relies to support his opposition. Such declaration must be filed within two months, after the expiry of one month (or such further time, not exceeding three months, as the Comptroller may allow) from the date of the advertisement of the mark. The opponent must at the same time deliver a copy of the declaration to the applicant.

Declaration
by
opponent.

Within one month from the delivery of the said copy, the applicant should leave his declaration or declarations in support of his application, and in reply to the opponent's declarations, and should supply the opponent with a copy thereof. Within seven days from the receipt of such copy, the opponent may leave further declarations, which should be confined strictly to matters in reply to the statements in the opponent's declarations.

Counter-
declaration
by
applicant.

Reply by
opponent.

This completes the evidence, and no further declara-

Hearing.

tions can be filed by either party, except with the consent of the other or by special leave of the Comptroller. On completion of the evidence, the Comptroller, upon the application of either party, and on the payment of the prescribed fee (£1), appoints a time for hearing the case, and gives at least seven days' notice of the appointment to the applicant and opponent.

Decision.

At the hearing, the parties or their representatives attend and state their case fully; the declarations form the groundwork of all that is said, and no opposition is allowed which has not been set forth in, or does not directly spring from, the declarations filed. The decision of the Comptroller is usually signified to the parties in writing, within from one to two weeks from the hearing. Should either of the parties be dissatisfied with the decision, he may appeal to the Board of Trade. Notice of the intention to appeal should be left at the Patent Office within one month from the date of the Comptroller's decision. The notice of appeal must be accompanied by a written statement of the grounds of appeal and of the appellant's case in support. In addition to serving the Patent Office with these papers, a copy of the notice of appeal and of the appellant's case in support must be sent to the Secretary of the Board of Trade, Whitehall Gardens, London, and also to the other party in the matter.

Appeal to Board of Trade.

Board of Trade may hear appeal or may refer to Court.

The Board of Trade then decide whether they will hear the appeal or refer the matter to the Court. If they decide to hear the appeal, seven days' notice of the hearing is given to the appellant, and to the Comptroller, and to the respondent. The evidence used at the hearing before the Board of Trade is the same as that used before the Comptroller.

A reference to the Court is always more satisfactory where there are equitable reasons why registration should be granted, although a rigid reading of the Act and the Rules seems to bar registration. The Comptroller and the Board of Trade, however they may wish to help the applicant, always find themselves bound to adhere to the strict letter of the Act and Rules, whereas the Court may exercise such discretion as will prevent hardship.

Although not specified, the Chancery Division of the High Court of Justice is meant by "the Court," and in the case of applications at the Manchester Office "the Court" means also the Lancaster Palatine Chancery (Section 26 of the Act of 1888).

Opposition is usually encountered from the owner of another similar registered mark, but this is not always the case. The opponent might enter opposition upon other grounds.

If an applicant abandons his application immediately upon being notified of opposition, he may be called upon to pay to the opponent such costs of the opposition as the Comptroller may think reasonable. But this is the only stage in the proceedings at which the Comptroller has power to award costs. If the matter proceeds to a hearing, no costs are allowed to either party. Costs.

Even if the case is ultimately heard by the Court, and the opponent is successful, no costs are allowed to him in respect of the proceedings below—*i.e.* before the Comptroller and the Board of Trade.

SHEFFIELD MARKS.

The registration of trade marks in respect of goods within the Cutlers' Company's Acts is regulated by special rules. The privileges of the Cutlers' Company are recognised and the regulations mainly expressed in Section 81 of the Act of 1883. Sheffield Register.

The Cutlers' Company was authorised to establish at Sheffield a new Register of Trade Marks, to be called the Sheffield Register, and to this Register were transferred all trade marks for cutlery and kindred goods which had been registered or entered before the 1st of January, 1889, by persons carrying on business in Hallamshire, or within six miles thereof. The Company is also empowered to enter in the Sheffield Register all trade marks which have been assigned by the Cutlers' Company, and actually used before the 1st January, 1884, but which have not been entered in either of the other Registers.

Applications for registration of trade marks for metal goods, if made by persons carrying on business in Hallam-

Procedure
in register-
ing Sheffield
marks.

shire or within six miles thereof, are to be sent direct to the Cutlers' Company; if made by a person outside this area, the application is to be sent to the Comptroller, who communicates with the Cutlers' Company. When an application is made direct to the Company, they notify the Comptroller of the fact, and if the Comptroller has no objection to make, the application is proceeded with by the Company. As a matter of fact, the Comptroller acts in unison with the Company, and if both are of opinion that the mark may proceed, registration can be effected, and not otherwise.

Any person considering himself aggrieved by refusal of his application by the Company may appeal to the Court.

"Metal
goods."

The expression "metal goods" used in the Act is not confined to cutlery, but is explained to mean "all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal."

Duration of
registra-
tion.

When a trade mark has been registered, the period of protection lasts for fourteen years. At the end of that time the registration may be kept in force for another fourteen years upon payment of a renewal fee of one pound, and so on from time to time at the expiry of each successive period of fourteen years, so that the registration of a trade mark may be kept in force for an indefinite time. If this renewal fee is not paid, the Comptroller may remove the mark from the Register within three months from the termination of the fourteen years. If the renewal fee is paid before the termination of the three months, an additional fine of ten shillings is imposed. But even if the three months should pass without payment, and the mark has actually been expunged from the Register, the Comptroller will readily restore the mark if a sufficient explanation is forthcoming, and upon payment of an additional fine of one pound.

Renewal.

Lapse by
non-
payment of
renewal fee.

Rights lost
by abandon-
ment,
disuse, or
acqui-
escence.

The right to a registered trade mark might also be lost to the proprietor by abandonment, which might mean either total abandonment by prolonged disuse on his own part, or abandonment of his exclusive right by acquiescence

in the use of the mark by others, to such an extent as to create common and concurrent right in others. To constitute abandonment, the intention to abandon must, however, be shown. Mere non-user of a trade mark for a length of time does not *per se* show abandonment. The period of time during which a trade mark has been disused would, of course, be an element of importance. It has been said (*in re Grossmith*, 60 L. T., N. S. 612) that non-user for eleven years, during which the sale of the goods had ceased, and all labels had been destroyed, amounted to abandonment. It cannot, however, be said with certainty that the Court would look upon mere disuse of a trade mark, for four or five years for example, as abandonment, unless intention to abandon was clearly present.

Under Section 105 of the Act, any person who represents a trade mark applied to any article sold by him as "registered" which is not so, shall be liable for every offence, on summary conviction, to a fine not exceeding five pounds.

Penalty for falsely representing trade mark as registered.

CHAPTER IV.

RECTIFICATION OF REGISTER BY THE REMOVAL OR LIMITATION OF REGISTERED MARKS.

By Section 75 of the 1888 portion of the Act, it is provided that application for registration of a trade mark shall be equivalent to public use of the mark, and the date of the application shall be deemed to be the date of the registration. Thus, in instituting proceedings for infringement, the registered proprietor of a trade mark is no longer called upon, as he formerly was, to prove "lawful user" before he can obtain relief in a Court of law or equity for the infringement of his mark. Registration of the

Application to register equivalent to public use.

Mark to be of avail must be actually put to use.

mark is now notice to the world, and is equivalent to "lawful user" at common law. It must not, however, be inferred that the owner of a mark which has merely been registered, but not put to use at all, could obtain an injunction against someone afterwards using the mark. The essence of trade mark law is entirely against the assumption that anyone should be permitted to harass his neighbours by registering and shelving a mark, only asserting his proprietorship when another, wittingly or unwittingly, uses the mark for trade purposes.

Mark must be new and original.

Again, a mark to be good, even after registration, should in the first place have been original, or either the property or design of the applicant. A person cannot register as a new mark something which has already been used by another person in the same trade (see *Wragg's Trade Mark*, 29 Ch. D. 551). So much may be gathered from the remarks of Cotton, L.J., in *Hudson's Case* (32 Ch. D. 311), and from what was said by the President of the Court of Appeal in the same matter.

Registration *prima facie*, and after five years conclusive, evidence of owner's right.

When a person has been placed upon the Register as proprietor of a trade mark, this is *prima facie* evidence of his right to the exclusive use of the mark, and after the expiry of five years from the date of registration it is *conclusive* evidence of his right (Section 76). This, however, is upon the assumption that the registration was in the first place good: if not, it is clear that the title can be challenged, even after the expiry of five years. As Jessel, M.R., remarked in *re Palmer* (21 Ch. D. 53), "The Act only says that after five years the person who has registered a trade mark shall be entitled to the trade mark, but does not say that the mark, as registered, shall be deemed to be a trade mark." As a matter of fact, many trade marks have been expunged from the Register after having been registered for a much longer period than five years.

But title may be challenged even after five years.

Reasons for expunging trade mark.

The reasons for removing a trade mark from the Register are various. In many cases the reasons given by the Court have been practically a revision of the Comptroller's judgment in registering the marks at all, and have to do with inherent defects in the marks them-

selves, which should have prevented their registration in the first instance. Examples of these are to be found in "name marks," because of the name not being printed or reproduced in a distinctive manner; in "word" marks, because of the word not being distinctive, or being descriptive or deceptive, or common to the trade (*re Wragg's Trade Mark*, 29 Ch. D. 551; also *Hyde & Co.'s Mark*, 7 Ch. D. 724); or where a mark has been registered as an old mark in use before 1875 without being really so (*Baker v. Rawson*, 45 Ch. D. 519). To these may be added marks improperly registered for goods for which they were not used or intended to be used (*Edwards v. Dennis*, 30 Ch. D. 454; *Reddaway v. Peck*, page 110); marks, the registered proprietors of which carry on no business; marks, too similar to already registered marks; marks, improperly registered by a servant of the real owner; and marks, the registered owners of which have allowed others to use them so that they have lost their significance as being distinctive of one maker's goods (*re Wood's Trade Mark*, 32 Ch. D. 247).

Examples.

These are the principal grounds upon which a registered trade mark may be successfully challenged and removed from the Register, or restricted as to scope.

Any person who is aggrieved may take proceedings to rectify the Register, and, according to Fry, L.J., any person aggrieved means every person who will in reasonable probability suffer any injury or loss (using the words in a legal and not in a sentimental sense) from the other persons claiming to use the mark" (*in re Rivière*, 53 L. J., Ch. 455).

Definition of "aggrieved person."

In *re The Apollinaris Company's Marks* the same Judge, in reviewing the question whether the appellants, the *Vichy Water Company*, were or were not "persons aggrieved" within the Act, said, "We are of opinion that whenever one trader, by means of his wrongly registered trade mark, narrows the area of business open to his rivals, and thereby either immediately excludes or with reasonable probability will in the future exclude a rival firm from a portion of that trade into which he desires to enter, then that rival is an aggrieved person."

Trade rival.

Of course a person against whom proceedings have been

Defendant
in action.

brought by the owner of an improperly registered trade mark is an aggrieved person, and where the validity of the registration is capable of being attacked, the defendant should not only defend himself from the proceedings, but should also move to rectify the Register.

This is specially advisable if the mark has been on the Register for five years, as the defendant would then be fettered in meeting the charge of infringement by reason of the privileged position thereby acquired by the plaintiff.

Register
might be
amended.

Without going to the extent of removing the mark entirely from the Register, the entry might, on the application of an interested party, or of the proprietor, be purged of redundancy or mis-statement, or the entry might be varied so as to cure the mark of informalities or errors, or to vary the entry in accordance with a change of proprietorship. These variations in the entry may be made with the object of (a) restricting the goods to which the mark is stated to be applicable (*re Edwards's Trade Mark*, 30 Ch. D. 454); (b) striking out some part of the mark; (c) entering a partial disclaimer on the Register; or (d) altering the name of the registered proprietor.

As to the extent to which such alterations may be carried, the 92nd Section of the Act simply says that application may be made to the Court for leave to add to or alter a mark in any particular "not being an essential particular" within the meaning of the Act.

Alteration
of old
marks per-
missible
only in non-
essential
details.

This permission to alter has been held, but within extremely narrow limits, to apply to old as well as to new marks (see *Guinness, Son & Co.*, 5 P. O. R. 316; *Allsopp & Sons, Limited, &c.*, where leave was given to amend old marks by adding the word "Limited" to the names). As to what is an essential particular of a mark, Mr. Justice Kekewich, in *re Adams's Trade Mark* (9 P. O. R. 174), held that the word "Patent" in an old trade mark was so essential that he would not allow the alteration to be made. A new mark would not, however, be so stringently treated, and alterations are more readily allowed than in the case of old marks.

CHAPTER V.

TRANSFER OF TRADE MARKS.

TRADE MARKS can be assigned and transferred only in connection with the goodwill of the business in which the mark has been used. Therefore, the owner of a mark cannot legally dispose of it to another, without at the same time transferring to him at least so much of the business as relates to the goods for which the mark has been registered. Fry, L.J., in *Edwards v. Dennis* (30 Ch. D. 454), has said, "An assignee has no exclusive right to a trade mark, unless the assignment is of a business co-extensive with the trade mark as registered." Again, trade marks which have been registered as a series cannot be broken up and disposed of piecemeal. They must be assigned and transmitted as they were registered—viz., as a series (Section 66).

Trade marks transferable only when joined to goodwill of business.

Registration in series must be followed by transfer in series.

The reasons for this indissoluble union between a trade mark and the goods or business which have made the mark a readily accepted sign of certain qualities, are plain. The reputation of the mark has been made by the goods, and the mark must follow the business in those particular goods. Otherwise it might be made an instrument of fraud. This is so far the case that, in *Shipwright v. Clements* (19 W. R. 599), Vice-Chancellor Malins held that, if a business were sold without any word being said about the trade mark, the mark would be understood and held to pass to the purchaser. This is a rule which holds good in American practice as well as here.

When a trade mark has thus been assigned or transferred, the new proprietor should at once get his name put upon the Register in place of that of the former owner. This is done by sending to the Comptroller a formal request to alter the Register, showing the particulars of the transfer and that the mark has been

New owner placed on Register.

accompanied by the goodwill of the business, the whole of the several statements being verified by statutory declaration.

Trade mark
an asset in
bankruptcy.

On the bankruptcy of the owner of a trade mark, the mark, together with his other effects, passes to his representative in bankruptcy, who has the power to deal with it as with any other asset. When one of the members of a partnership, otherwise solvent, becomes bankrupt, his individual share or interest in the mark cannot be sold, but will pass to the solvent partner or partners. The reason of this is, that the undivided interest in the trade mark is valueless apart from the goodwill. If the owner of a trade mark, carrying on a business, assumes a partner or partners, the trade mark becomes part of the partnership assets, unless specially reserved by the original owner. The new partner or partners is or are entitled to registration as joint owner or owners with the original proprietor.

An asset in
partner-
ship.

Disposal of
trade mark
on dissolu-
tion of
partner-
ship.

On dissolution of partnership, the mark goes with the goodwill. If one of the partners carries on the old business, the trade mark passes to him with the goodwill, the value of the interest in the mark being accounted for to the retiring partner as one of the partnership assets. But if the partners agree to divide the partnership assets and carry on the same business separately, each is at liberty to use the mark (*Condy v. Mitchell*, 37 L. T., N. S. 268; C. A. 37 L. T., N. S. 766). But a former partner in a dissolved partnership was, in *Hanson v. Game Harrison* (9 P. O. R. 186), prevented from allowing a company carrying on business, with which he afterwards became associated, to use one of the marks of the former partnership. When a trade mark is designed and used in a joint adventure, neither of the parties has a right to the mark after the adventure is closed (*re Jones's Trade Mark*, 53 L. T. 1).

Joint
adventure.

Trade mark
personal
property.

On the death of the proprietor of a trade mark the mark passes to his personal representative with the rest of his personal property. The owner may bequeath his trade mark to whomsoever he pleases, but always in connection with the goodwill of the business.

CHAPTER VI.

LEGAL PROCEEDINGS IN CONNECTION WITH
TRADE MARKS.

THE foregoing chapters have dealt mainly with the definition, acquisition, and transfer of trade marks. But even so slight a sketch of the subject as this work professes to embody would be wholly incomplete if an indication were not given of the means by which trade mark property is defended and maintained.

When the registered owner of a trade mark finds that his rights are being infringed, there are three remedies which he may adopt:—

Three remedies for infringement of mark.

Chancery.

Common law.

Criminal.

(1) He may bring an action in the Chancery Division of the High Court for an injunction to restrain the infringer from using the mark, with a claim for damages or an account of profits.

(2) He may bring an action in the Queen's Bench Division of the High Court, claiming damages on the ground of false representation.

(3) He may institute a criminal prosecution under the Merchandise Marks Act, 1887, by summons before a magistrate or justice of the peace, or by indictment.

The first is the most usual proceeding; the second is scarcely ever employed, and will not be particularly referred to here; the third is made use of in aggravated cases, and possesses the virtue of being a swift, effective, and comparatively cheap remedy.

ACTION IN THE CHANCERY DIVISION.

The growth of the Chancery jurisdiction in trade marks has been of a gradual nature, but the beneficial description of the remedy by injunction and account, as compared with

Chancery Division.

the common-law remedy of damages, has resulted in making it at the present day almost the sole arena for the trial of the civil suit in trade mark cases.

Innocence
of infringer
not material
to issue.

The Court
protects the
public as
well as the
owner.

What was
originally
not
fraudulent
misrepre-
sentation
may after-
wards
become so.

The principles upon which the Courts of Equity act in the case of trade marks are, that the motives of the infringer are immaterial. He may have acted innocently and without the intention of defrauding anyone (see the remarks of Chitty, J., in *Upmann v. Forester*, 24 Ch. D. 231). He may even himself have designed the offending mark, and may have intended to use it as his own mark. He may have been absolutely ignorant of the existence of the mark which he has infringed. All of this matters nothing. The Court's duty is to protect the public, and it is undeniable that as soon as the goods leave the defendant, and pass from hand to hand, they may be made the instruments of fraud, and ultimate purchasers may believe that they were originally manufactured by the person entitled to the genuine mark.

Even when the maker, knowing that they are not the goods of the person entitled to use the trade mark, tells this to the immediate purchaser, thinking thereby to clear himself from the charge of fraud, still he is not absolved, because, as the goods pass on from hand to hand, this representation does not pass on with them, and thus the next purchaser or the public at large may be deceived. Consequently, all that has to be done is to show that the trade mark has been taken.

This is the gist of a deliverance by Sir G. Jessel, M.R., in *The Singer Manufacturing Co. v. Wilson* (2 Ch. D. 434), and summarises the principles of the Court of Chancery in such cases. So that it is not now necessary to show intentional fraud, as would be the case in common law. All that is necessary in equity is to show that the plaintiff has an exclusive right to use the mark, and that the mark has been taken by the defendant (Lord Westbury, C., in *The Leather Cloth Company's Case*, 4 De G. J. & S. 137).

Discovery
and
inspection.

Where full disclosure of facts is desirable, the Court will grant discovery and inspection, and upon establishment of the plaintiff's allegations will issue an injunction, and will also, if thought necessary, order the delivery

up and destruction of the labels or attachments bearing the infringing mark. Or the goods themselves may be ordered to be produced for the erasure of the marks which they bear; or, if this cannot be done without destroying the goods, their destruction might in some instances be ordered.

An innocent infringer will not, however, be so stringently dealt with as a wilful wrongdoer, especially if prompt submission is made. But it is unlikely that he will escape payment of the costs (see Justice Chitty in *Upmann v. Forester*); but note Stirling, J., in *American Tobacco Co. v. Guest* (9 P. O. R. 218), which was the case of an innocent infringer who had made a very small purchase of cigarettes bearing the false mark.

As a rule, trade mark cases are heard by a judge without a jury, and even where a defendant in such a case gave notice of trial before a judge and special jury, it was held that the case must be heard without a jury (*Spratt's Patent v. Ward & Co.*, 11 Ch. D. 240).

Trial of
trade
mark cases.

In applying for an interlocutory injunction, promptness in taking action is above all things to be recommended to the plaintiff. Delay is looked upon unfavourably by the Court, unless it can be conclusively shown that such delay was necessary to secure the requisite evidence to establish the plaintiff's case.

Application
for
injunction.

The injunction granted may assume various forms. It might be an absolute order to cease using the offending mark in any way, or the injunction might extend only to a certain feature or to certain features of the mark; or it might be limited by an undertaking on the defendant's part to add something which will make the mark more distinctive as compared with the plaintiff's mark.

Terms of
injunction.

If the defendant after issue of an injunction should continue to use the disputed mark or something so like it as to be practically the same thing, he is liable to committal for contempt. If, however, it is a question whether the defendant's action constitutes a *direct* breach of the injunction, so as to render him liable to committal, the terms of the injunction may be enlarged so as to include the new breach, and the defendant ordered to pay all costs (*Cartier v. May*, Dig. 200).

Breach of
injunction.

A trade mark being personal property, on the death of a plaintiff his representatives are entitled to continue the action.

Grounds of action.

As to the grounds upon which action may be taken, these are so multitudinous that it is impossible to give more than a few instances of cases brought upon diverse issues.

Imitation of a registered mark or of its essential features.

In the rare instances where a trade mark is boldly annexed *in toto*, and where the infringement is palpable, there is of course no difficulty in getting relief. But this is seldom the case, and as a rule the Court has rather to deal with colourable imitations or instances where important or essential features of a mark are taken, without an absolute infringement of the whole. It might even be that, without taking a single individual feature of a mark, a label or ticket or device might be produced by an infringer, which would, under a cursory inspection, deceive a purchaser into the belief that it really was the mark which it was intended to imitate (see James, L.J., in *Worthington's Trade Mark*, 14 Ch. D. 8). Sometimes, again, a representation of some animal or thing forming a trade mark, or an essential part of a trade mark, may become so well known by name alone that any other mark containing a representation of the same animal or thing, no matter how different in appearance or arrangement, would infallibly work injustice to the original owner.

Or of general appearance.

Device mark may be infringed by name mark.

Orr-Ewing v. Johnstone.

For example, in *Orr-Ewing v. Johnstone* (7 App. Cas. 219) the plaintiff had a mark which he applied to red yarn, an essential feature of the mark being the representation of two elephants. From this the goods had come to be known as the "Two Elephant" yarn. The defendants had also begun to use a ticket upon which two elephants figured. It was not contended that there was any deceptive resemblance between the tickets: nevertheless an injunction issued against the defendants, in terms which practically forbade them from representing or alluding to elephants at all in trade marks for this class of goods.

Lord Cranworth in *Seixo v. Provezende*.

Lord Cranworth, in his judgment in *Seixo v. Provezende* (L. R. 1 Ch. 192), says, "I do not consider the

actual physical resemblance of the two marks to be the sole question for consideration. If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular name, I think that the adoption by a rival trader of any mark which will cause his goods to bear the same name, may be as much a violation of the rights of that manufacturer as the actual copying of his device." The same principle was followed in *Read v. Richardson* (45 L. T., N. S. 54), where the beer of the plaintiffs having become well known in the market as "Dog's Head Beer," the defendants were restrained from using any representation of a dog's head on their bottle labels, no matter how unlike the plaintiffs'.

Dog's Head
Beer case.

A colourable imitation of a trade mark, whether consisting of a device or of a word, can generally be restrained, but it depends upon the extent of the resemblance. As far as words are concerned, "Tovril" has been restrained as an obvious imitation of "Bovril," and the use of the word "Steinberg" on pianos has been put down as being too similar to "Steinway." As regards a device, a beehive has been held to be a colourable imitation of a bell of a similar shape, similarly printed on a label. A church within a triangle on a beer label has been suppressed as being too like the triangular mark of Bass. A sprig of grape-vine has been held to infringe a sprig of hop-vine; and a unicorn's head has been considered too similar to a horse's head. But even with these examples it is impossible to do more than generalise. The Court will endeavour to look at the marks from the point of view of the general public, and where there is sufficient resemblance between the marks, relief will be granted.

Imitative
words
restrained.

Similar
devices
restrained.

The case of a mark, which is of any value to its owner, becoming public property (or *publici juris*, to use the accepted term) owing to the negligence of its originator, is not likely to occur under present conditions.

Trade mark
becoming
publici
juris.

All of the instances that can be quoted occurred before the Registration Act of 1875. "Harvey's Sauce" is a case in point of a designation which was at one time proper to one manufacturer only, but which by neglect or licence had

By neglect
or licence.

in time become the designation of an article capable of being made and sold by anyone, under the name of "Harvey's Sauce." The same thing occurred in the case of "Worcestershire Sauce." These, and other marks in a similar category, would have been now of enormous value, had their original owners sustained their rights in them; but, as has been said, similar cases are not now likely to occur.

Other instances where trade marks have become *publici juris* are to be found in the case of trade names given to patented articles. The sewing machine industry furnishes one or two examples, from which it may be drawn that it is permissible to use the name of the original patentees and manufacturers in describing an article the patent for which has expired, so long as the name is sufficiently qualified as to make it plain who are really the manufacturers. *The Wheeler and Wilson Sewing Machine Company*, after the expiry of their patent, tried to prevent other manufacturers from selling machines of their own make as "Wheeler and Wilson Machines," but failed. The same ill success attended suits on similar issues brought by *The Singer Manufacturing Company*, and in the end it was established that a manufacturer, affixing his own name to his machine, could not be restrained from using the name of the original patentees and makers as descriptive of the principle upon which the machines were made, granted that the said patentees are not also represented as the actual makers. In *The Singer Manufacturing Company v. Spence & Co.* (10 P. O. R. 297) the company succeeded in restraining the use of their name by the defendants in such a manner as to induce the belief that the machines sold by the defendants were the manufacture of the plaintiffs.

Similar instances of a name becoming *publici juris* are to be found in the cases of "Galloway Tubes" for boilers. "Worthington Pumps," &c.

A very curious, and to inventors especially a very interesting question, bearing in some degree upon the same subject, was raised during the consideration of the case of the *Linoleum Manufacturing Company v. Nairn* (7 Ch. D. 834). The question was this: Granted that a manu-

By operation of natural right.

facturer invents and patents an entirely new article, to describe which he invents an entirely new name, and then registers that name as a trade mark, can he preserve the right to be the sole user of the invented name which he has constituted his trade mark, after the expiry of his patent? Mr. Justice Fry, in the course of his judgment, distinctly puts it that he cannot. In the case mentioned linoleum floorcloth was a newly invented article of manufacture. The very name "Linoleum" was new, and had been invented to designate it.

Semble, an invented name applied to a newly invented and patented product, and registered as a trade mark, becomes *publici juris* on the expiry of the patent.

The plaintiff did not, however, register the word "Linoleum" alone as a trade mark. The mark consisted of the words "Linoleum Floor Cloth" printed on the border of a lozenge. In the centre of the lozenge were a *fleur-de-lys* and the words "F. Walton's Patent." Mr. Justice Fry considered the mark to consist of the combination as registered, and refused to allow the plaintiffs to pick out the word "Linoleum," and uphold that to be the really essential part of their trade mark. It must be confessed that, in coming to this decision, he was considerably supported by the acts of the plaintiffs themselves.

Although the Judge did not directly say so, it is not difficult to see, from the drift of his remarks, that, even had the plaintiffs registered the word "Linoleum" alone as their trade mark, he would have refused an injunction. Cotton, L.J., in *Slazenger v. Feltham* (6 P. O. R. 531), evidently adopted this reading of the judgment in the linoleum case.

Slazenger v. Feltham.

Had the word "Linoleum" alone been registered, and had the mark been upheld, the result would practically have been to extend the monopoly of the patent indefinitely, since no one but the patentee could have sold the floorcloth as "Linoleum," even after the expiry of the patent. This extension of the monopoly beyond the period of patent right would clearly be against public policy, and it is plain that in the case of a newly invented article for which a new name has to be found, such as "Dynamite," "Cordite," and "Roburite," and which obtains a world-wide fame under that name, and that name only, it would never do to vest the original makers and patentees with

a perpetual right to the only name by which the article is, or possibly can be, known to the public.

Claims when seeking injunction.

Account of profits.

Persons seeking an injunction should as a rule claim an account of profits in preference to damages, owing to the difficulty in proving the amount of damage flowing from the infringement. In the event of the plaintiff proving successful, the account of profits is made out under the direction of the chief clerk, in the chambers of the judge who has granted the injunction.

Owing to the number of questions that arise in making out such an account, it is advisable to place the inspection and examination of the defendant's books in the hands of a reliable accountant. Generally, however, the defendant compromises by the offer of a lump sum, which, in most cases, it is best to accept.

Costs.

As a rule costs follow the result of the action, unless the plaintiff, by delay in bringing his action, or unreasonable treatment of the defendant's offers of compromise, has placed himself in such a position that the Court, while granting the injunction, refuses the plaintiff his costs.

Advertisement of injunction.

The fact of an injunction having been obtained may be published by advertisement in a newspaper or by circular. The terms of such an advertisement should, however, be the subject of careful consideration and trustworthy advice before it is published.

CHAPTER VII.

THE CRIMINAL PROSECUTION.

Merchandise Marks Act, 1887.

"Forging" a trade mark.

FOLLOWING the Merchandise Marks Act of 1862, the new *Merchandise Marks Act of 1887* makes the forgery of trade marks a misdemeanour. To "forge" a trade mark means the making of a spurious trade mark so like an existing mark for the same goods as to be calculated to deceive. The term also means falsifying a genuine trade mark by alteration, addition, erasure, or other change. If these

acts are done without the assent of the proprietor of the genuine trade mark, they constitute offences under the Act, and the person charged must prove that he acted without intent to defraud. In this, the present Act differs from the former Act of 1862, which threw the onus of proving "intent to defraud" upon the prosecutor. It is also an offence to make any die, block, machine, or other instrument, for the purpose of forging or being used to forge a trade mark.

"Forging"
a block.

The following are the offences and punishments as set forth in the Act, so far as trade marks are concerned:—

OFFENCES.

Section 2 (1). Every person who—

- (a) Forges any trade mark; or
- (b) Falsely applies to goods any trade mark or any mark so nearly resembling a trade mark as to be calculated to deceive; or
- (c) Makes any die, block, machine, or other instrument for the purpose of forging or of being used for forging a trade mark; or
- (d) Applies any false trade description to goods; or
- (e) Disposes of or has in his possession any die, block, machine, or other instrument for the purpose of forging a trade mark; or
- (f) Causes any of the things above in this section mentioned to be done,

Offences.
Forging a trade mark.
Falsely applying.
Making printing block.
False description.
Selling or possessing printing block.
General.

shall, subject to the provisions of this Act, and unless he proves that he acted without intent to defraud, be guilty of an offence against this Act.

(2) Every person who sells, or exposes for, or has in his possession for, sale, or any purpose of trade or manufacture, any goods or things to which any forged trade mark or false trade description is applied, or to which any trade mark, or mark so nearly resembling a trade mark as to be

Persons committing offences should prove absence of guilty knowledge, and must assist

prosecutor
to discover
real
offenders.

calculated to deceive, is falsely applied, as the case may be, shall, unless he proves—

- (a) That, having taken all reasonable precautions against committing an offence against this Act, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the trade mark, mark, or trade description; and
- (b) That, on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or things; or
- (c) That otherwise he had acted innocently; be guilty of an offence against this Act.

PUNISHMENTS AND PENALTIES.

Punish-
ments and
penalties.

Section 2 (3). Every person guilty of an offence against this Act shall be liable—

- (i.) On conviction on indictment, to imprisonment, with or without hard labour, for a term not exceeding two years, or to fine, or to both imprisonment and fine; and
- (ii.) On summary conviction, to imprisonment, with or without hard labour, for a term not exceeding four months, or to a fine not exceeding twenty pounds, and in the case of a second, or subsequent, conviction, to imprisonment, with or without hard labour, for a term not exceeding six months, or to a fine not exceeding fifty pounds; and
- (iii.) In any case to forfeit to Her Majesty every chattel, article, instrument, or thing by means of or in relation to which the offence has been committed.

“Trade
mark”
means
registered
trade mark.

In Section 3 of the Act it is set forth that the expression “trade mark” used in the Act means a trade mark “registered in the Register of Trade Marks kept

under the Patents, Designs, and Trade Marks Act, 1883," and includes any mark protected by law (whether with or without registration) under international arrangements, such for example as the existing International Convention. The term also includes marks registered under the Trade Marks Act of 1875, and of course extends now to the Amending Act of 1888, following the Patents Act of 1883.

It will be seen that, unlike what has been said with reference to the civil remedy, a distinction is drawn between the case of a person who issues or causes to be issued the infringing trade mark, and of him who merely sells articles bearing the false mark. In the former case the circumstances all point to intentional fraud. In the latter case the seller or dealer might have acted quite innocently. In such a case the Act tells him how he must proceed to prove absence on his part of "intent to defraud." He must show where he got the goods, and from whom he obtained them. He must also show that he had no reason to doubt the genuine nature of the mark, and, in short, not only produce every possible proof of his own innocence, but also assist the prosecutor to discover the real offenders.

Innocent
retailer.

If a person should be convicted under this Act, he is not thereby relieved from further civil proceedings.

Where a tradesman shifts a genuine label from goods of superior quality to goods of an inferior quality, although by the same maker, such wrongful user of a trade mark would constitute an offence under the Act. Any person untruly representing that a trade mark is registered is liable on conviction to a penalty.

To mis-
apply a
genuine
label is an
offence.

Engravers or lithographers who execute instructions for a block, stamp, or die, well knowing it to be meant for fraudulent purposes, commit an offence under the Act. But an engraver who makes a die or block according to instructions without any such guilty knowledge, and who derives no advantage from the sale of the goods to which the forged mark is applied, can clear himself on proof of innocence in the same manner as the innocent seller. Such persons should give immediate notice that they intend to rely on this defence: otherwise they may have to pay the prosecutor's costs, although discharged from the prosecution

Offences by
engravers
and litho-
graphers.

Innocent
engraver.

Appeal. A defendant may appeal to the quarter sessions, and if charged before a court of summary jurisdiction he may select to be tried on indictment.

Evidence. In cases under the Merchandise Marks Act the defendant is allowed to give evidence upon oath, and his wife may in like manner be sworn and subjected to examination like any other witness.

Rules of evidence in criminal proceedings based upon those in the civil suit.

Among the reported cases under the Act there are very few indeed in which the head and front of the offending has been direct imitation of the prosecutor's trade mark. This is owing to the custom that has obtained of taking many cases which would be fitly the subject of criminal prosecution into the Court of Chancery. It may, however, be said that the rules which regulate comparison of the marks and the evidence which would point to intentional imitation and fraudulent intent are much the same as those obtaining in the higher Court. Therefore, the magistrate, or the justices on a summary proceeding, or the Court and a jury on indictment, would practically, in a question of fraudulent imitation, have to decide the same issues that would arise in the Court of Chancery. Such being the case, the evidence adduced by the prosecutor should be as full and based upon the same principles that would guide the plaintiff seeking an injunction in the High Court, as already explained in foregoing chapters.

Reg. v. Hughes et al.

An excellent example of a case of criminal prosecution under the Act, and founded upon the alleged fraudulent imitation and forgery of registered trade marks, was decided recently at the London Central Criminal Court before the Common Serjeant (Sir Forrest Fulton), both the traders who labelled and disposed of the goods and the printer of the labels being found guilty and sentenced. The prosecution was instituted by James Epps & Co., Limited, and the defendants (Hughes, Morris, and Fairweather) were indicted for conspiracy to defraud. The prisoners pleaded guilty. The evidence showed that Hughes and Morris had applied the forged labels (which were almost exact imitations of Messrs. Epps's registered labels) to packets of cocoa of an inferior quality; while Fairweather had printed the labels, knowing the fraudulent purpose for which they were

intended. Morris and Hughes were sentenced to twelve and five months' hard labour respectively, and Fairweather the printer to four months' (*London Daily Chronicle*, 24th October, 1893).

Another important case, of special interest to the Manchester trade, was decided in the City Police Court, Manchester, in July 1893. The prosecution originated with Messrs. G. & R. Dewhurst, merchants in Manchester, and the defendants, Messrs. Ellinger & Co., were shippers in the same city. Messrs. Dewhurst were the proprietors of a combination trade mark for piece goods, known to the trade as their "Rupree Combination." This combination consisted of—

*Reg. v.
Ellinger.*

- (1) A green ticket with a border enclosing a lion, and bearing the name of the firm;
- (2) The firm's signature in blue stamped upon the cloth;
- (3) A ticket in black and silver, the chief features being a rupee in obverse and reverse;
- (4) Figures in blue, stamped on the cloth, and showing the length; and
- (5) A coloured stripe "heading."

The goods were for export to India. The defendants, shipping to the same markets, had imitated the "Rupree Combination" by arrangements of green and black-and-silver tickets, signature and figures in blue, together with coloured "headings," which, although not identical with, were deceptively similar to the Dewhurst combination. It was pointed out that the items of the infringing combinations, when compared severally with the items of the Dewhurst combination, showed readily recognisable differences, nor was the actual relative arrangement of the items in all cases slavishly copied, while the name of the actual shipper or consignee was plainly printed on the tickets and on the cloth. Nevertheless, the unmistakable *general* resemblance, coupled with certain damaging evidence as to fraudulent intent, resulted in the conviction of the defendants. An interesting point in this case is that it is one of those which show that in adjudicating upon an alleged imitation or infringement of a trade mark, the nature of the market and the degree of

Example of
fraudulent
imitation of
combina-
tion trade
mark.

Susceptibility of ultimate purchaser to deception.

intelligence or civilisation of the ultimate purchasers—in other words, their susceptibility of being deceived—must be taken into consideration. The fact that in this instance the ultimate purchasers were natives of India, who were, according to the evidence, mostly ignorant of English, and incapable of easily distinguishing minor differences where a general resemblance to the genuine mark existed, had a powerful effect in influencing the judgment adversely to the defendants.

Query. Can defendant in criminal proceedings question validity of registration?

It has been a matter of discussion whether a defendant, prosecuted under the Merchandise Marks Act, can avail himself of the privilege, enjoyed by a defendant in the higher Courts, of questioning the validity of the registration of the mark which he has been charged with fraudulently imitating. *Primâ facie* one would think that the criminal charge should not deprive him of that advantage, but the writer is unable to point to any judicial solution of the question.

CHAPTER VIII.

COMMON-LAW TRADE MARKS AND TRADING OR FIRM NAMES.

THE foregoing chapters have dealt almost exclusively with trade marks which are in the privileged position of being registered, and which have thereby acquired a status and weight not inherent to unregistered marks.

But it must not be supposed that it is only the owners of registered marks who can obtain relief against infringers or imitators. The user or owner of a mark or of a trade name which is perhaps incapable of registration may nevertheless restrain piracy by the exercise of his common-law rights. This is a remedy which is alike open to the trader who never has registered his mark, to him whose mark has been refused, and to the proprietor whose mark has been expunged from the Register. The principle upon

which the Court goes is, that, whether the imitated mark or trade name is registered or unregistered, it will restrain the practice of fraud by one person at the expense of another. In an action pure and simple for the infringement of a registered trade mark, as touched upon in Chapter VI., there is usually a valid, tangible mark, and the issue is simply how and in what respect the infringer has invaded the property constituted by the mark. But, as Lord Blackburn said in *Singer Manufacturing Company v. Loog* (8 App. Cas. 15), after referring to frauds committed by the infringement of trade marks, "There is another way in which goods not the plaintiff's may be sold as and for the plaintiff's. A name may be so appropriated by user as to cause it to mean the goods of the plaintiff, although it is not and never was impressed on the goods so as to be a trade mark properly so called or within the recent statutes. Where it is established that such a trade mark bears that meaning, I think the use of the name, or one so nearly resembling it as to be likely to deceive, as applicable to goods not the plaintiff's, may be the means of passing off those goods as and for the plaintiff's." (See also the instructive remarks of Romer, J., in *Singer v. Spence*, 10 P. O. R. 297.)

Lord
Blackburn
in *Singer v.*
Loog.

An unregistered or unregistrable trade mark or trade name, such as is referred to by Lord Blackburn, was first termed a "Common-Law Trade Mark" by Lindley, L.J., in *Reddaway and Co. v. Bentham Hemp Spinning Co.* (9 P. O. R. 503), and the latest writers have adopted this name in alluding to such a trade mark. In the case just cited, the plaintiffs had been in the habit of using the terms "Camel," "Camel Brand," and "Camel Hair," as descriptive of their woven belting, so that, as they alleged, belting so distinguished was known all over the world as the plaintiffs' manufacture, and no other. The defendants, who had not been long in business, began to use the same terms as descriptive of their belting, justifying their action by alleging that their belting was woven from woollen yarns known in the market as "Camel Hair yarn." At the Manchester Assizes, in May 1892, Cave, J., directed a verdict for the defendants. The plaintiffs

Common-
law trade
mark.

Example of
common-
law mark.

Reddaway v.
Bentham.

moved for a new trial, and it was held in the Court of Appeal that there was evidence which ought to have been left to the jury. A new trial was therefore ordered, but before it took place the matter was arranged, the defendants submitting to an injunction. The result therefore was, that the plaintiffs established their right to the common-law trade mark constituted by the word "Camel," which was both an unregistered and an unregistrable word, seeing that the Comptroller had pointed out that it was not only a geographical name, but was also, strictly speaking, either descriptive or deceptive.

"Stone
Ale" case.
*Montgomery
v. Thompson.*

Another instance of a common-law trade mark is to be found in the "Stone Ale" case (*Montgomery v. Thompson*, 8 P. O. R. 361), which was finally decided in the House of Lords in May 1891. The respondents and their predecessors had for many years carried on business as brewers at the town of Stone. Their ale had become well known in the market as "Stone Ale." Together with other labels, they had registered the words "Stone Ale" as a trade mark. The infringer, Montgomery, built a brewery at Stone, and began to sell his liquor as "Stone Ale." On an action being brought by Thompson, Montgomery applied to rectify the Register by cancelling the registration of the word "Stone." Chitty, J., held that Montgomery should be restrained from using "Stone Ale," and refused the motion to rectify.

Geographi-
cal name
expunged
from
Register,
but upheld
as common-
law trade
mark.

On appeal it was held that the injunction against the defendant was properly granted, but that the registered mark "Stone Ale" must be removed from the Register (thus changing it from a registered into a common-law mark).

The defendant Montgomery appealed to the House of Lords, but without success, as the order of the Court of Appeal was affirmed. Thus it will be seen that even where a party has had the registration of his trade mark cancelled, as being at variance with the law which governs the registration of trade marks, he is not left defenceless, but may uphold his right to the exclusive use of the mark at common law.

Similar considerations weighed in deciding *Wotherspoon*

v. Currie (L. R. 5 H. L. 508), the "Glenfield Starch" case, and others which need not be referred to here.

Just as an imitation of a well-known trade mark or trade name, placed upon goods, becomes an instrument of fraud by leading the public to believe that they are buying the goods of one person, whereas the goods are really those of another person, so the trading name of an individual or company may be imitated, on a signboard for example, or in advertisements or circulars, in such a manner as to deceive the public into a belief that they are dealing with the individual or firm whose name has been imitated. Except under the terms of the Companies Act, 1862 (25 & 26 Vict., Cap. 89), there is no such thing as registration of a firm's name in the same sense as trade mark or design registration.

Trading and firm names.

25 & 26 Vict., cap. 89.

Suppose, therefore, a firm of cabinet makers consisting of less than seven members (this being the number entitling to registration under the Companies Act, 1862) were to launch a business under the title of "The London and Counties Furnishing Company," there are no means of registering such a name, and if another firm should assume the same or a deceptively similar name, the first company has only its common-law remedy. Where the name of the company is composed of words in ordinary use, the evidence as to deception or the probability of deception, through the assumption by another company of a similar name, requires to be very convincing, before a successful action can be maintained.

For example, where a bill was filed by *The London and Provincial Life Assurance Society* seeking to restrain *The London and Provincial Joint Stock Life Assurance Company* an injunction was refused. In the same manner injunctions were refused in the following suits: viz.—*The Colonial Life Assurance Company v. Home and Colonial Assurance Company, Limited*, and *The London Assurance Company v. London and Westminster Assurance Corporation, Limited*. *The Guinea Coal Company* was successful in restraining a rival concern which had taken the name of *The Pall Mall Guinea Coal Company*. *The India and China Tea Company*, however, failed to get an injunction against *The India and China Packet Tea Company*, the Court holding

Examples of conflicting firm and company names.

that the name assumed by the defendant company was truthfully descriptive of their business, and referred to the countries from which the goods were actually derived.

Registration under the Companies Act, 1862.

As to registration under the Companies Act of 1862, Section 20 of the Act provides that "No company shall be registered under a name identical with that by which a subsisting company is already registered, or so nearly resembling the same as to be calculated to deceive, except in a case where such subsisting company is in the course of being dissolved, and testifies its consent in such manner as the Registrar requires."

A company cannot, however, under the Companies Acts, legally register and maintain a name similar to the name of an earlier unregistered company (*Hendriks v. Montague*, 17 Ch. D. 643).

Fancy business title.

Where the trading name is the name of an individual, and this is assumed by a person of a different name, the intention of fraud is so evident that redress is quickly obtained. Even where the plaintiff's name is itself assumed or is a fancy title, such as *The Christy Minstrels*, *The Oldfield Lane Doctor*, or *Madame Elise*, an injunction to restrain the use of such an assumed name by others is readily obtained.

Use of own name in deceptive manner.

Holloway v. Holloway (13 Beav. 209).

It has been held that a person might use his own name in such a manner as to deceive (*Churton v. Douglas*, Johns. 174; *Burgess v. Burgess*, 3 De G. M. & G. 896; *Holloway v. Holloway*, 13 Beav. 209), but in such a case the plaintiff's evidence as to fraudulent intent must be very clear and convincing. Mere liability to confusion between the names of two firms where *mala fides* cannot be shown will not suffice to obtain an injunction (*Turton v. Turton*, 42 Ch. D. 128).

Fraudulent collusion to create firm name similar to existing firm.

A partnership got up between persons of the requisite names, and intended to take fraudulent advantage of the reputation attaching to an old-established business, will not be permitted to take the name of the older business, although the partners may be of the same names. Thus a clerk named Day and a shopkeeper named Martin were restrained from carrying on the business of blacking manufacturers as "Day and Martin" in imitation of the well-known firm of that name.

PART III.

COPYRIGHT IN DESIGNS.

CHAPTER I.

DEFINITION AND NATURE OF DESIGNS.

PRIOR to the Patents, Designs, and Trade Marks Acts of 1883 to 1888, there were two distinct forms of copyright in Designs—viz., “Ornamental” and “Useful.” Ornamental designs referred solely to such designs as are used to beautify articles of manufacture, such as designs for printed calicoes, wall-papers, carpeting, and the like, or raised or flat ornaments upon all sorts of goods, or ornamental shapes of manufactured objects. Useful designs, on the other hand, referred to objects whose novel shape or configuration enabled them to fulfil a useful purpose, such, for example, as an ink-bottle moulded with a recess to fulfil the additional function of a pen tray; or a tool whose shape or configuration enabled it to be used for more than one purpose; or a pavement light or prism of such a shape or configuration as to enable it to divert light into cellars.

Formerly designs separately classed as “Ornamental” and “Useful.”

Now, however, under the present Act, this distinction between Ornamental and Useful Designs is abolished, and a design is registered for the ornament or pattern, or for the shape or configuration, the latter not necessarily meaning a beautiful or artistic shape or configuration.

Now such distinction is abolished, and designs are registered for ornament or shape.

As to any *useful effect* that may be brought about by the shape or configuration of a design, registration gives no claim in respect of this. The shape or design must appeal to and be judged by the eye alone, and the Court will discard all reference to the useful effect, if any such exists.

Utility not considered.

Thus in *The Hecla Foundry Co. v. Walker, Hunter & Co.* (6 P. O. R. 554), the lower Courts, hampered probably by some reminiscences of the extinct Useful Designs registration, instanced the useful effect of the registered design of a kitchen range fire-door as one of the reasons for recognising and maintaining the validity of the registration. But the Judges in the House of Lords, while upholding the decision of the Courts below, expressly pointed out that the *utility* of the design must not be allowed to influence the question in any respect.

DEFINITION OF THE TERM "DESIGN."

"Design" defined.

The term "Design" is defined in Section 60 of the Act to mean any design applicable to any article of manufacture, or to any substance, artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, stamping, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for sculpture or other thing within the protection of the Sculpture Copyright Act of the year 1814 (54 Geo. III., Cap. 56).

Design may combine ornament, pattern, and shape.

Thus a design, within the Act, may be some ornament printed or produced on the flat, such as woven or printed designs on textile fabrics, paper-hangings, floorcloths, or the like; or patterns or designs etched, or stamped, or cast, or embossed, or cut, or otherwise produced on metal articles, or glass, or plastic material, or furniture, or tiles, or worked or woven, as in lace; or it may be for artistic or beautiful shape or configuration, as in a lamp stand, or lamp shade, or iron railing, or gate; or for shape, in which no appeal is made to the sense of beauty, as in a new shape or configuration of grate-door, or oil-can, or cravat, &c. Or, as the Act says, the design might contain two or all of the foregoing elements—*i.e.*, ornament, pattern, shape, and configuration.

It will be noted that the section does not make the

smallest allusion to utility. It is the design, and the design alone, that is protected. The Court will not look beneath the surface, but must find the reasons for registration apparent to the eye. If a useful object is attained, well and good; but this consideration will not be allowed to obtrude itself as an element to be taken into account.

In the case of *The Hecla Foundry Co. v. Walker, Hunter & Co.*, already referred to, the design was applied to a kitchen range fire-door, and consisted in casting an "ogee" moulding upon the upper edge of the door, which moulding filled in the gap across the top of the grate when the door was closed, and practically continued the moulding of the same description which already extended along the front of the grate on each side of the fireplace. Its practical advantages were, that it did away with the usual hinged fall-bar which had before been used to bridge the gap, and also helped to exclude cold air from the top of the grate. The new door was not registered as part of the range, but as an object by itself, the short specification on the application form being, "Range fire-door, with moulding on top: *Shape* to be registered." The defendants (the appellants in the House of Lords) had infringed by using a similar fire-door.

*Hecla
Foundry
Co. v.
Walker.*

The Lord Ordinary, in giving judgment for the plaintiffs, and confirming the validity of the registration, laid stress upon the elements of utility; and on appeal the Inner House, confirming the Lord Ordinary, made the same mistake. Finally, on appeal to the House of Lords, the decisions of the lower Scotch Courts were affirmed, but their error in allowing the question of utility to influence them was strongly insisted upon, and it was laid down that the eye alone must be the judge in dealing with a design. The defendants' fire-door had also a moulding along the top, and that being the plaintiffs' registered design, judgment was given accordingly. As Lord Fitzgerald said towards the conclusion of the case, "In the course of the discussion at the Bar, one of the learned counsel asked us to put the two things (*i.e.* the two fire-doors) side by side, and said that we should see by a look that the article produced

Utility not
a consider-
ation in
designs.

The eye to
be the
judge.

by the appellants was an obvious imitation of the registered design of the respondents. My Lords, I looked at the two things then, and I came to the conclusion that the door of the appellants was clearly an obvious imitation of the registered design of the respondents, and from that moment I thought that the argument was at an end.”

Walker v. Scott.

The case of *Walker v. Scott* (9 P. O. R. 482) is another instance in which a design, while conforming to the requirements of the section, yet had wrapped up in it an essentially useful purpose or result. The design was applicable to a cyclist's oil-can, and consisted in rounding the edges of the can, so that when carried on the person there was no danger of its catching or cutting the clothes or person. Although the validity of the registration was not questioned by the defendant, Chitty, J., in giving judgment for the plaintiff, did not seem to doubt its fitness as subject-matter. The design was practically a modified shape of oil-can. It was a change of shape apparent to the eye, and that satisfied the Court. The fact that the change did not mean any added beauty, and that it undoubtedly did enlarge the usefulness of the can, had nothing to do with the question.

Mere change of old shape may constitute design.

While thus showing that *utility* does not form a recognised element in a design, it may be advisable at this point to go a step further and glance at a possible confusion between patentable inventions and designs. It may well be that something which is perfectly fit subject-matter as a design might also be fit subject-matter for a patent. For example, the range-door already referred to, by virtue of its useful functions, and in combination with the range, would undoubtedly have constituted a patentable invention, and yet it has been seen that the registration of the door as a design was upheld by the highest authority.

Patentable inventions and designs.

Conception not capable of registration as design may be patentable as invention.

Nevertheless, such an instance is likely to be rare, and it may be instructive to notice an example where the registration of a design was held to fail on the ground that it was not properly a design, but trenched upon the domain of patentable inventions. In *Moody v. Tree* (9 P. O. R. 333) a design of basket was registered, the basket being woven in such a manner that the osiers were

worked in singly, the butt-ends showing outside; the whole, on being finished off, presenting a very pretty appearance. The jury in the County Court found that the basket was a novelty, but the judge, doubting whether it was fit subject-matter for registration as a design, granted an appeal to the Divisional Court. There it was held that the so-called design was really a method of manufacture, and should have been patented. Again, in *Cooper v. Symington* (10 P. O. R. 264) the plaintiff had registered as a design a corset, in which the busks in front, although really fastened together by eyes and studs, had yet, when secured upon the wearer, the appearance of having been laced together. This appearance was obtained by the arrangement and display of certain diagonal lacing which confined the busks in their sheaths. The general appearance was similar to the admittedly more becoming appearance of a laced-up corset. But then, to lace up a corset was a tedious operation, whereas in the plaintiff's corset the busks were secured at once by means of the eyes and studs. It was held by the Court that in a design the eye must be the judge, and although in the registered corset there was undoubtedly something new which might have been patented, nevertheless the *appearance* to the eye was not new, but was precisely the same as the old laced-up corset, which indeed it was designed and intended to imitate. Accordingly, Chitty, J., refused the plaintiff's motion for an injunction.

Moody v. Tree.

Cooper v. Symington.

A new combination of two or more old patterns or designs might form good subject-matter for registration as a new and original design. There is a case under the old Act of 5 & 6 Vict., Cap. 100, that of *Harrison v. Taylor* (4 H. & N. 815), decided on appeal from the Court of Exchequer, in which it was held that the plaintiff's design, which related to a species of double honeycomb fabric, was new and original and formed good subject-matter. The design was formed by combining a large honeycomb fabric with a small honeycomb fabric, the small honeycomb fabric serving as a ground upon which the large honeycomb was displayed. Both the large and the small honeycomb patterns were old, but their combination

Combina-
tion of old
patterns
may form
new design.
Harrison v. Taylor.

had not been carried out before. It is, however, certain that, under present practice, combination designs are narrowly scrutinised.

Hothersall v. Moore.
Obvious combination of old materials not design.

An example of the treatment usually accorded to designs which consist of combinations of old elements, too obvious to be upheld as novel and original, is to be found in the case of *Hothersall v. Moore* (9 P. O. R. 27). Here the plaintiff registered, as a design for dusters, the combination of an old and well-known border with an equally old and well-known fabric as centre-piece. Bristowe, V.C., held that this did not constitute a registrable design, and dismissed the action with costs.

Combination of separately old characteristics not a new design.

In *Le May v. Welch* (28 Ch. D. 24) a registered design of a collar contained three characteristics which it was admitted had *separately* appeared in collars prior to the date of the plaintiff's registration. The combination was considered too narrow or trifling to constitute a new design, and in the Court of Appeal, Lord Justice Bowen, in delivering his judgment, very properly drew attention to one of the reasons of the Court for declining to maintain the validity of such a registration. "We must not," said his Lordship, "allow industry to be oppressed. It is not every mere difference of cut, every change of outline, every change of length or breadth or configuration, in a simple and familiar article of dress like this, which constitutes novelty of design. To hold that, would be to paralyse industry, and make the Patents, Designs, and Trade Marks Acts a trap to catch honest traders."

Bowen, L.J., on limits of registration.

Design must display some substantial novelty.

In the last case quoted, not only the fitness or unfitness of a combination design as subject-matter for registration, but also the amount of invention or fancy displayed, was inferentially considered. As Lord Justice Bowen said, "there must be a substantial novelty in the design, having regard to the nature of the article." Thus in *Smith v. Hope Bros.* (6 P. O. R. 200) the plaintiff had registered a design for application to a scarf. At the hearing it became apparent that the sole advance upon what was acknowledged to be an old shape of scarf was the introduction of one or two folds or pleats in the body of the scarf. Mr. Justice Stirling dismissed the plaintiff's motion.

for injunction with costs, and directed that the design should be struck from the Register. The learned judge referred to the case of *Le May v. Welch*, and quoted with approval the remarks of Lord Justices Baggallay and Bowen. It should, however, be mentioned here that, just as the commercial success of an apparently obvious or simple invention has been considered an additional reason for maintaining a somewhat doubtful patent, so the commercial success of a registered design has been allowed to weigh with the Court in upholding the registration, even where the subject-matter has been somewhat narrow. In *Tyler v. Sharpe* (11 P. O. R. 35), Romer, J., in upholding the plaintiff's design of a watercloset basin, said that, although the design was somewhat slight, he could not help being favourably impressed by the immediate popularity and large sale of the article to which the design was applied.

Commercial success of design will influence Court.

The question of what constitutes good subject-matter for registration as a design would be incomplete without a reference to the adaptation of existing and well-known things, such as famous objects or buildings, to the purposes of design, as applied to manufactured objects. It seems only reasonable to suppose that if someone adapts a view or picture of some thing, or some personality, whether it be a flower or landscape, a building, or a statesman, and applies that representation or picture to some article of manufacture, he should be allowed to register it as a new design, and should be protected in such a specific adaptation. His right may perhaps be open to cavil if the representation he made use of was common and well known, such as a well-known photograph or engraving, although even this might not affect his right. But suppose the particular representation or view he uses is one produced or procured by himself, it might be asked why such adaptation should not be fit subject-matter for registration as a design for application to certain specified manufactured goods, according to the Act. It has been said, in text-books upon the subject of designs copyright, that the copy of a photograph of a well-known public character is not a new or original design within the meaning of the Act. The decision

Adaptation of pictures of well-known objects and persons as designs.

*Adams v.
Clementson.*

*Saunders v.
Wiel.*

upon which this assertion is based occurred in the case of *Adams v. Clementson* (12 Ch. D. 714). But this case turned on the old Act of 5 and 6 Vict., Cap. 100, Section 3, which is differently worded from the corresponding sections of the Act of 1883, and it has been thought by a high authority (Lindley, L.J., in *Saunders v. Wiel*, 10 P. O. R. 29) that the variation in the language of the Act of 1883 was influenced or caused by this very decision of *Adams v. Clementson*. In the latter case the dispute was between two earthenware manufacturers, the plaintiff, Adams, seeking to restrain the defendant by injunction from infringing the plaintiff's registered design which he applied to plates and other articles of earthenware. The design consisted of a portrait of General Martinez de Campos, copied from a photograph which had been sent to the plaintiff from Cuba. The defendant had received a similar photograph and was applying it to similar goods. In both cases the goods were produced almost entirely for export to Cuba.

Vice-Chancellor Malins decided that this was not fit subject-matter for a registrable design, because the plaintiff had simply taken the photograph and copied it, and the defendant had done the same thing. Accordingly the injunction was refused. It is, however, submitted that this decision has since been subjected to such destructive criticism that there is but little fear of its being repeated or having henceforth any weight as a precedent. A more correct interpretation of the law as it now stands is to be found in the case of *Saunders v. Wiel* (*supra*). Here the plaintiff, a silversmith, had registered, in Class 1, a design applicable to the handles of spoons and forks. The design consisted of a view of Westminster Abbey, modelled in relief on the spoon or fork handle. The nature of the design as stated in the application was for the "pattern and shape of spoon or fork handle in metal." The defendants had infringed, and, relying in their defence upon the decision in *Adams v. Clementson*, contended that the design was not one that could be registered. Cave, J., dissented from the judgment in *Adams v. Clementson*, and held that the design was proper subject-matter for registration, and that the defendants had infringed.

Held in *Saunders v. Wiel* that a modelled view of Westminster Abbey on spoon-handle good as design.

In the Court of Appeal the decision of the lower Court was upheld, and the adverse remarks of Cave, J., upon the decision in *Adams v. Clementson* were strongly endorsed by Lindley and Bowen, L.JJ.

Novelty is also essential to the valid registration of a design. The design must at the date of application be "a new or original design not previously published in the United Kingdom."

Design must be new or original.

Where a design has been freely exhibited, and sold prior to registration, of course novelty has been destroyed and cannot be revived. But there are many instances where a species of *quasi-disclosure* has taken place, in respect of which the question has to be debated whether or not such disclosure amounts to publication. Confidential disclosure to a partner, servant, agent, customer, or friend, for the purpose of obtaining an opinion on the merits of a design, is not publication, so long as it goes no further, and so long as actual business is not done in the goods bearing the design.

Limited disclosure not usually publication of design.

In *Heinrichs v. Bastendorff* (10 P. O. R. 160), the defendant pleaded that a sample of the writing-table which embodied the design had, before registration, been submitted by the plaintiff to a customer, who had altered and returned it. It was held by Day, J., that this did not constitute publication. But where, as in *Blank v. Footmann* (5 P. O. R. 653), the inventor of a new lace design had shown and handed a sample of the lace to his agent, and the agent had in turn shown the sample in a confidential manner to two selected customers, who gave orders and kept cuttings from the lace, it was held that publication had taken place. It would seem that the mere confidential exhibition of the lace to the three indicated persons would not of itself have constituted publication, but the concluding of an order, and the leaving of the cuttings or samples in the customers' hands, went beyond mere confidential disclosure. An examination of the report of the more recent and very similar case of *Winfield v. Snow* (8 P. O. R. 15), and a consideration of the remarks of Hawkins, J., will also help to show how far confidential communication of this description may go without con-

Heinrichs v. Bastendorff. Example of limited disclosure held not to be publication.

Blank v. Footmann. Example of limited disclosure held to be publication.

Winfield v. Snow.

Selling goods bearing design before date of registration is publication.

stituting publication. In *re Sherwood's Design* (9 P. O. R. 268) the proprietor of the design supplied a customer with two globes in accordance with the design, three days before registration was effected. There was a slight difference between the design of globe as registered and the globes as supplied; but it was held that publication had taken place, and the design was ordered to be expunged from the Register.

Substitution of one material for another (design remaining the same) not registrable.

It has also been laid down that the mere substitution of one material for another, where the object is the same and to be used for a similar purpose, does not constitute a registrable new design. Thus in *re Bach's Design* (6 P. O. R. 376) Bach registered, in Class 4, a fairy lamp-shade produced in the form of a rose and made of vitreous material. It was shown that lamp-shades of a similar design, but made of linen, had been manufactured and sold prior to the registration of Bach's design, and as a result the motion to expunge the design was successful.

Design published in one class, published in a similar class.

The same design may be registered in more than one class; but a design already registered in one class, and put on the market and made public, cannot afterwards be properly registered in another class as a new design. In *Hothersall v. Moore* (*supra*) the plaintiff had registered his design in Class 13 instead of in Class 14, which was the proper class. His after registration in Class 14 was held not to retrieve his error, and the registration in Class 14 was held invalid from publication, although such publication took place after registration in Class 13.

MARKING REGISTERED DESIGNS.

Goods must be marked.

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

In pursuance of this section, the Board of Trade Rules under the Act provide that all goods in Classes 1 to 12

shall during the period of copyright bear the abbreviation "R^D" and (except in the case of lace) the number appearing on the certificate of registration. All goods in Classes 13 and 14 (printed or woven designs on textile piece goods and on handkerchiefs and shawls) shall be marked "REG^D" without the number. Specified markings.

The object of the section being to protect the unwary by making it plain what goods are and what are not registered, a slight deviation from the strict letter of the Rules will not matter, so long as the goods are marked so as to make it plainly apparent that they are registered. In *Heinrichs v. Bastendorff* (*supra*) the plaintiff had marked his tables "REG^D" instead of "R^D". The defendant pleaded that registration was invalid on that account, but Day, J., brushed this contention aside, saying, "I am of opinion that does not vitiate registration at all" It is better, however, to adhere strictly to the Rules.

When it is impossible or inconvenient to place the mark actually on the goods, it may be placed on the case, or wrapping, or card. In *Blank v. Footman* (*supra*), Kekewich, J., decided that the plaintiff had complied sufficiently with the Act in marking his trimming, when made up in bundles, with the abbreviation "R^D" and the number printed on a paper band surrounding the goods. Made-up goods of certain nature may be marked in bulk.

But failure to mark the goods at all will undoubtedly vitiate registration, and the same may be said where the failure is only partial. For example, should a dozen dusters of a registered design be woven in a piece of, say, twelve dusters, it would not be sufficient to affix the mark "REG^D" to the piece alone, since that would be marking one only of the twelve dusters comprising the piece. When the piece is cut up, eleven dusters would go forth to the public, perhaps in different directions, without any indication of the design having been registered. This was held, *inter alia*, to vitiate registration in *Hother-sall v. Moore* (*supra*).

It will be noted that Section 51 concludes with a saving clause, giving relief in case of error if the proprietor can show that he took all proper steps to ensure the marking of the articles. Thus mere inadvertence or Relief in case of inadvertence.

blundering on the part of those over whom the proprietor of the design had no immediate control will not vitiate the registration of the design.

Wittmann v. Oppenheim.

In *Wittmann v. Oppenheim* (27 Ch. D. 260), a manufacturer employed by the proprietor of a design to make the articles for him, and to whom the proprietor had supplied a correct stamping die, used by mistake an old die, which related to an expired design of the same proprietor. Several articles were sold before the proprietor detected the blunder, but it was held that this did not vitiate his registration, it having been made apparent that he had done all in his power to ensure the correct marking of the articles. The question of what constitutes the taking of "all proper steps to ensure the marking" was also considered in the more recent case of *Johnson v. Bailey* (11 P. O. R. 21). Here a manufacturer who had registered the design of a teapot, and had prepared moulds and given his workmen injunctions to see that each pot was properly marked, lost his copyright because the workmen allowed the mould to become so worn that the registration mark on the goods was illegible. The Lord Ordinary (Low) decided that such general instructions as the plaintiff had given, when not followed up by personal supervision, did not constitute the taking of "all proper steps to ensure the marking."

Johnson v. Bailey.
Negligence in properly marking.

There is a penalty for marking designs as having been registered when such is not the case.

PENALTY FOR PIRACY.

Section 58

Section 58 of the Act provides that during the existence of copyright in any design—

"(a) It shall not be lawful for any person without the licence or written consent of the registered proprietor to apply or cause to be applied such design, or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale, to any article of manufacture, or to any substance, artificial or natural, or partly artificial and partly natural; and

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

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

Penalties for infringement of registration.

Under the old Act, the onus of proof that the offender knew that the design had been applied without the consent of the registered proprietor lay upon the plaintiff. This difficult provision was modified in 5 & 6 Vict., Cap. 100, by virtue of which the proprietor, by giving notice in writing, laid the onus of proving *bona fides* on the defendant.

Under the present Act it is not necessary to serve even an innocent infringer of a registered design with notice, except in the case of an innocent retailer of the infringing goods.

Innocent retailer only entitled to notice before action.

The cases that have already been cited, and the remarks upon what constitutes a design, will show how unprofitable it would be to enter into a discussion upon what would be considered a “fraudulent” or an “obvious” imitation of a registered design. As has already been said, the eye is in the main the judge as to what is and what is not an obvious imitation. It is conceivable that a design might be held to be an obvious imitation of a registered design, even although in arrangement and detail it is, when narrowly inspected, different, so long as the general effect, seen at a short distance, is the same. *A fortiori*, the defendant will not be allowed to shelter himself behind trifling distinctions and variations from the registered design.

“Obvious” or “fraudulent” imitation.

In *Sherwood v. Decorative Tile Co.* (4 P. O. R. 207), Manisty, J., says, “Upon the question of obvious imitation, you must to a great extent (I do not say entirely)

Manisty, J., compares an “obvious” with