

said: "It ought not to be assumed in every case whenever you see the words 'trade mark' on a label that it must be intended solely to refer to the particular part of the label on which it is placed."

Rectifica-
tion pro-
ceedings
usually
taken in
Chancery.

Jurisdiction
of Irish and
Scotch
Courts.

Methods of
hearing the
application.

Discovery.

Appeal.

Proceedings to rectify the Register are usually taken in the Chancery Division. "The Court" in England is His Majesty's High Court of Justice, or where the mark was applied for in the Manchester Branch Office for Trade Marks "the Court" includes the Palatine Court of Chancery. The Irish Court has held that it has no jurisdiction to order any alteration or rectification of the Register of Trade Marks (*Bayer v. Connell*, [1897] 14 R. P. C. 275); but a Scotch Court has jurisdiction to entertain a petition for rectification of the Register (*Cowie v. Herbert*, [1897] 14 R. P. C. 436).

Evidence is ordinarily given by affidavit, and the deponents may, in the discretion of the Court, be subjected to cross-examination. But frequently the case is taken as an ordinary witness action. Declarations filed by the respondent, the registered proprietor, in matters appertaining to the registration, transfer, or alteration of the mark may be put in as evidence by the applicant (*Thewlis and Blakey's Mark*, [1893] 10 R. P. C. 369). Discovery of documents relating to the grounds of the motion may in some cases be ordered (see *Wills's Trade Mark*, [1892] 9 R. P. C. 346).

Appeal from the decision of the Court may be made to the Court of Appeal and to the House of Lords.

CHAPTER V.

TRANSFER AND DEVOLUTION OF TRADE MARKS.

SECTION 70 of the Act of 1883 provides that a trade mark when registered may be assigned and transmitted in connection with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill.

Registered trade mark wedded to goodwill of business.

The owner of a trade mark cannot therefore legally dispose of the mark to another without at the same time transferring to him the goodwill of so much at least of the business as relates to the goods in respect of which the mark has been registered. As was said by Fry, L. J., in *Edwards v. Dennis* ([1885] 30 Ch. D. 454), "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." 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).

Mark cannot be transferred except with goodwill.

Marks in series cannot be broken up.

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* ([1871] 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 America, practice as well as here.

Reasons for tie between trade mark and goodwill.

Mark must indicate in hands of assignee what it indicated in hands of assignor.

When the mark is indicative of origin, it must, in the hands of the assignee, indicate what it indicated in the hands of the assignor. Thus, as was said by Fry, L. J., in *Pinto v. Badman* ([1891] 8 R. P. C. 181), "it may be assigned if it is indicative of origin, when the origin is assigned with it. It cannot be assigned when it is divorced from its place of origin, or when in the hands of a transferee it would indicate something different from what it indicated in the hands of the transferor."

But although a trade mark may contain the name or initials of the former owner, if the business and goodwill of the former owner has in fact been transferred to the new proprietor, his continued use of the mark with the old name or initials on it is not a deception (*Hall v. Barrows*, [1863] 4 De G. J. & S. 150).

Portion of business with corresponding marks.

A portion of a business may be sold with the trade marks referring to these goods which are dealt with in that part of the business, and the use of the marks will be restricted to these generally.

On bankruptcy, mark passes to trustee.

On the bankruptcy of the owner of a trade mark the mark, together with his other effects, passes to the trustee in bankruptcy as being goods and chattels within Section 15, Sub-section 5, of The Bankruptcy Act, 1869, and the trustee 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.

In partnership is part of assets.

Right of remaining partner to trade marks.

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*, [1877] C. A. 37; L. T. N. S. 767).

But a former partner in a dissolved partnership was, in *Hanson v. Game Harrison* ([1892] 9 R. P. C. 186), prevented from allowing a limited 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*, [1885] 53 L. T. N. S. 1; *Robinson v. Finlay*, [1878] 9 Ch. D. 487).

But former partners in dissolved partnership may each carry on and use marks.

Trade mark in joint adventure.

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.

Devolves as personal property.

When a trade mark has thus been assigned or transferred, the new proprietor should at once, in accordance with Section 87 of the Act, 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 accompanied by the goodwill of the business, the whole of the several statements being verified by statutory declaration.

New proprietor should register as owner.

Form of request.

In the event of the Comptroller refusing to enter an assignment upon the Register the assignee may make an application to the Court for an Order directing registration. In such a case the assignee would be a person aggrieved under Section 90. The facts entitling him to be held a *bonâ fide* owner of the mark, and the whole nature of the transaction by virtue of which he acquired it, must be embodied in his affidavits supporting the notice of motion.

Where Comptroller refuses to register.

There is no such thing as licensing another to use a trade mark. If the owner of the trade mark permits it to be used in connection with other people's goods he loses his claim to it (see the "*Edon Cigarettes*" Case, *Wood v. Lombard & Butler*, [1883] 32 Ch. D. 247).

Owner cannot license another to use his trade mark.

CHAPTER VI.

ACTION FOR INFRINGEMENT.

Remedies
for infringe-
ment.

Action to
restrain in-
fringement.

Action for
passing off.

Criminal
proceed-
ings.

County
Court no
jurisdic-
tion.

Chancery
Court

Person
that the
mark
should be
registered

WHEN the owner of a trade mark finds that his mark is being infringed the question as to how he will seek his remedy depends upon the nature of the infringement and also upon his own position. If his trade mark has been registered and the infringement is simply a copy or substantially a copy of the mark he may bring an action in the Chancery Division for an injunction to restrain the infringement, with a claim for damages or an account of profits. With this claim he may, if he is so advised, and particularly if his mark has been not exactly copied but colourably imitated, claim an injunction and damages in respect of the passing off of the goods by the defendant as and for the goods of the plaintiff. Or he may bring an action for "passing off" and for false representation on the King's Bench side, claiming damages, or in an aggravated case he may institute criminal proceedings under The Merchandise Marks Act, 1887, by summons before a Magistrate or Justice of the Peace or by indictment.

A registered trade mark not being a franchise, some authorities have contended that an action for infringement could properly be tried in a County Court where the damages claimed did not exceed £50. But in *Row v. Hart* ([1905] 22 R. P. C. 222), the Court of Appeal held that although a registered trade mark was not a franchise within Section 53 of The County Courts Act, 1888, the County Court had no jurisdiction, either under that Act or under The Judicature Act, 1873, to entertain an action for infringement of a trade mark.

The Chancery Division is the Court in which an action is usually brought when the plaintiff is the proprietor of a properly registered mark which has been infringed. The plaintiff's right to sue is derived from the Statute, Section 77 of which provides that "a person shall not be entitled to

initiate any proceeding to prevent or to secure damages for the infringement of a trade mark unless in the case of a trade mark capable of being registered under the Act it has been registered in pursuance of this Act or of an enactment repealed by the 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 Act 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." Or refused.

So far as the statutory right to sue is concerned, the plaintiff must therefore possess either a certificate of registration or, in the case of an old mark which has been refused, a certificate of refusal to register. This particular type of action will be considered first, and incidentally the "passing off" element in such actions, since it is difficult to separate one from the other. Statutory right.
Certificate of registration or of refusal.

The first thing for the plaintiff to establish is the fact of infringement. The infringement must imitate the mark as registered or the essential particulars of the mark, and must imitate it sufficiently closely to be calculated to deceive, so that the infringing mark may be easily mistaken for the registered mark. But the first essential is that the registered mark should have been imitated. As was said by Jessel, M. R.: "If you come for trade mark and not for actual fraud you can only sue in respect of what you have registered as a trade mark." Features of infringement.

The infringement may be an exact copy of the plaintiff's mark as registered, or it may consist only of the most salient characteristics of the registered mark, or it may, without being a copy, imitate the general appearance of the plaintiff's mark so as to resemble it. "Resemblance is a circumstance which is of primary importance for the Court to consider, because if the Court finds that there is no reason for the resemblance, except for the purpose of misleading, it will infer that the resemblance is adopted for the purpose of misleading," *per* Wood, V.C., in *Taylor v. Taylor* (1864) 23 L. J. Ch. 255. The studied resemblance may be brought about in labels by appropriating the general lines of the printing, colouring, and other general Resemblance need not be exact in detail.

Instances of general resemblance.	effects in such a manner that, without actually copying a single word or line of the plaintiff's label, the two marks may be almost indistinguishable at a short distance: as, for example, where a pelican on a green ground was substituted for a crane on a similar backing (<i>Balfour v. Kilburn</i> , 1 Hyde 270); "Rottgen" with two crosses for "Rodgers" with a star and a cross (<i>Rodgers v. Rottgen</i> , 5 T. L. R. 678). A mustard-tin label, with grouping, colours, and arms similar to that of the plaintiff's, was held to infringe in <i>Colman v. Farrow</i> ([1897] 15 R. P. C. 198).
Labels.	
Words.	In words a deceptive similarity may also be created: as, for example, "Condisanitas" for "Sanitas" (<i>Sanitas Co. v. Condly</i> , [1887] 4 R. P. C. 195, 530); "Steinberg" for "Steinway" (<i>Steinway v. Henshaw</i> , [1887] 5 R. P. C. 77); "Apollinis" for "Apollinaris" (<i>Apollinaris Co. v. Herrfeldt</i> , [1887] 4 R. P. C. 478). But there was held to be sufficient difference between "Wincarnis" and "Vincalis" (<i>Coleman v. Brown</i> , [1899] 16 R. P. C. 619). In device marks similarity was held to exist between a bell and a beehive (<i>Bell and Black v. Bell</i> , Seb. Dig. 514); a diamond containing a "K" and a diamond without a "K" (<i>Curtis v. Pape</i> , [1888] 5 R. P. C. 146). But, even if every case adjudicated upon by the Courts were given, it would help but little in assisting the reader to come to a decision on some fresh case brought to his notice. As Lord Watson asked in <i>Orr-Ewing v. Johnston</i> ([1882] 7 App. Cas. 219): "How can observations of Judges upon other and quite different facts bear upon the present case, in which the only question is, What is the result of the evidence?" The plain rule is, that in each case the Court will institute a common-sense comparison of the marks in dispute, guided always by the evidence and by the behaviour of the parties.
Inutility of precedents in deciding cases of resemblance. <i>Orr-Ewing v. Johnston</i> .	
Mere physical resemblance not the only guide.	But, although the eye is so powerful a factor in settling trade mark disputes as to colourable imitation or general mutual resemblance, mere physical resemblance of the marks is not always the true guide.
<i>Seico v. Prozeende</i> .	Lord Cranworth, in his judgment in <i>Seico v. Prozeende</i> ([1866] 1 L. R. 1 Ch. 102), 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." In other words, even if marks placed side by side are easily distinguishable, the one might yet, apart from the other, be an infringement. This principle was followed in *Read v. Richardson* ([1881] 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 describing their beer as such and from using any representation of a dog's head on their bottle labels, no matter how unlike the plaintiffs'.

Name echo
of device.

"Dog's Head
Beer" Case.

Another example is to be found in *Orr-Ewing v. Johnston* ([1882] 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. This mark was chiefly current in the Indian market.

*Orr-Ewing
v. Johnston.*
"Two
Elephant"
Yarn label.

The infringing use of the mark must be in respect of goods for which the plaintiff has registered and uses his mark, and must of course be used in selling goods not of the plaintiff's manufacture. Therefore, if the goods made by the plaintiff are in the lawful possession of the defendant, and all that the latter has done is to place the plaintiff's mark on the goods, he is within his rights in doing so, even if he prints the labels himself (*Parina v. Silverlock*, [1858] 1 K. & J. 509; 24 L. J. Ch. 632). The particular mode of applying the infringing mark to the spurious goods is not of importance so long as the goods are sent out in such a manner as to show that they are intended to be sold under the mark. Thus, placing the mark on a case or wrapper, or placing

The in-
fringement
must be on
goods
similar to
plaintiff's.

Modes of
applying
infringing
mark.

Advertise-
ment is in-
fringement.

Jay v. Ladler.

a slip among the goods, or even printing the mark on a circular or catalogue offering the goods for sale, will amount to wrongful use of the mark (*Jay v. Ladler*, [1889] 6 R. P. C. 136; *Bourne v. Swan & Edgar*, [1902] 20 R. P. C. 105; or on posters (*Price's Candle Co. v. Jeye*, [1901] 19 R. P. C. 17).

Old bottles refilled.

Old cases or bottles or casks bearing the genuine mark must not be used to convey and cover spurious goods (*Barnett v. Leuchars*, [1865] 13 L. T. N. S. 495). In one instance where the plaintiff's old bottles bearing his mark moulded thereon were sent out containing other manufacturer's goods, the defendant having pasted his own labels on the bottles, it was held that the use of the bottles constituted an infringement (*Rose v. Loftus*, [1878] 47 L. J. Ch. 576; *Allen v. Richards*, [1882] 26 Sol. Jo. 658), and an offence against the Merchandise Marks Act (*Thwaites v. McErilly*, [1904] 21 R. P. C. 397).

Proof of actual deception not necessary.

Nor of fraudulent intent.

Innocent infringer.

Ultimate deception.

In the case of a registered trade mark, to obtain an injunction the plaintiff need not prove that actual deception of customers has taken place (*Paine v. Daniels*, 10 R. P. C. 217; [1893] 2 Ch. 567). Neither is there any necessity to prove fraudulent intent on the part of the defendant, for 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*, [1883] 24 Ch. D. 231). He may even himself have designed the offending mark, and may have intended to use it as his own mark in absolute ignorance of the existence of the mark which he has infringed. All 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 by middlemen, 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 (*Sykes v. Sykes*, [1824] 3 B. & C. 541). Consequently all that has to be done is to show that the trade mark has been taken.

*Sykes v.
Sykes.*

This is the gist of a deliverance by Sir G. Jessel, M. R., in *Singer Manufacturing Co. v. Wilson* ([1875-7] 2 Ch. D. 434; 3 App. Cas. 376), and summarises the principles of the Court of Chancery in such cases. So that it is not now necessary to show actual deception or intentional fraud. 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 (*Westbury, L. C.*, in *Leather Cloth Co.'s Case*, [1863-5] 4 De G. J. & S. 137).

*Jessel, M.R.,
in Singer
Manufacturing Co.
v. Wilson.*

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 Mr. Justice Chitty in *Upmann v. Forester*, [1883] 24 Ch. D. 231); but note Stirling, J., in *American Tobacco Co. v. Guest*, [1892] 9 R. P. C. 218, which was the case of an innocent retailer who had made a very small purchase of cigarettes bearing the false mark. In this case the defendants were relieved from the payment of costs. The Court might even in certain circumstances refuse an injunction where the infringement is of a trivial nature committed without the knowledge of the defendants, and especially in cases where the defendants have immediately offered to apologise and pay costs (*Clarke v. Hudson's Executors*, [1901] 18 R. P. C. 310).

*Practice in
the case of
innocent
infringers.*

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.*, [1879] 11 Ch. D. 240).

*Usually
tried with-
out jury.*

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

*Inter-
locutory
injunction
should be
promptly
applied for.*

was necessary to secure the requisite evidence to establish the plaintiff's case (*Isaacson v. Thompson*, [1871] 41 L. J. Ch. 101).

Usually
advisable
to warn
infringer.

It is advisable, although not necessary, that the plaintiff, before beginning proceedings, should give the infringer notice of his intention to take action, so as to give an opportunity of explanation and submission.

Endorse-
ment of
writ.

The writ should be endorsed with a claim for an injunction to restrain the defendant, his servants and agents, &c., from applying the plaintiff's registered mark of [----] to any [goods] manufactured or sold by the defendant, and from issuing any boxes or cases or the like to which the mark is applied, or from affixing or using any label, ticket, or card containing or bearing the said mark &c. Or the claim might be for damages for the wrongful use or imitation of the plaintiff's trade mark, and for an injunction and an order for delivery up and destruction of all goods, documents, articles, or things held to be an infringement of the plaintiff's rights &c. The endorsement must of course be modified to suit circumstances.

Statement
of claim.

In the statement of claim the plaintiff, claiming as proprietor, should, if the nature of the infringement renders it desirable, describe the mark, and should

Particulars.

preferably give particulars of registration. He should then allege infringement by the defendant, giving some instances of breaches, plead damage sustained by the wrongful acts of the defendant, and claim an injunction on the lines suggested in the endorsement on the writ, together with damages or an account of profits, with delivery up of the goods or materials upon which the infringing mark had been placed.

Colourable
imitation.

The statement of claim might be confined to the points indicated where the mark has been absolutely copied, but where the infringement may also be construed as a colourable imitation of the mark or get-up, paragraphs should be introduced into both writ and statement of claim complaining of such wrongful imitation or get-up, and setting forth that by reason of the alleged unlawful acts the

Passing off.

defendant has sold and passed off goods not of the plaintiff's manufacture as and for the plaintiff's goods. In such a case the claim for injunction should refer to such wrongful passing off.

The plaintiff might, as soon as his writ is issued, apply for an interlocutory injunction. Formerly this ~~was~~ not readily granted except in cases where the clearest proof of the plaintiff's right and the defendant's wrongdoing was forthcoming. But under present practice, and especially where there is strong suspicion of intentional deception on the part of the defendant, the Court is more ready to grant such relief.

Interlocutory injunction.

Theoretically, the position of an innocent infringer of a registered mark is no better than that of an intentional wrongdoer, but practically the Courts will distinguish, especially where the defendant, as soon as the mistake is brought home to him, makes prompt submission, giving an undertaking and offering to pay such costs as the plaintiff may have incurred. If after such an offer the plaintiff still goes on, the Court will not support him in any merely vindictive proceedings, although it may find itself compelled technically to issue an injunction. In *Millington v. Fox* ([1834] 3 M. & Cr. 338) the defendants, having inadvertently made use of the plaintiff's trade mark, themselves informed the plaintiffs of the fact, offering an undertaking, payment of costs, and compensation. The plaintiffs applied for an injunction, which was granted, but without costs. In *Colburn v. Simms* ([1843] 2 Hare 543), which concerned an infringement of copyright, the defendants, after the filing of the bill, offered to submit to an order in the terms of the bill. The plaintiffs refused and pressed for an injunction, which was granted, but without costs. In the course of his judgment Wigram, V.-C., said: "If a plaintiff immediately after the suit is commenced is offered and may obtain all he seeks, and still thinks proper to go on with his suit, the Court may give him his decree, but will not give him the costs." In *Upmann v. Elkan* ([1871] L. R. 12 Eq. 140), where an innocent infringer made full submission before issue of writ, the injunction was granted, but without costs; and in *Caruncho v. Highmoor* ([1883] 27 Sol. Jo. 199), where the defendant offered an absolute undertaking in the terms of the endorsement of the writ, on plaintiff pressing for an injunction Chitty, J., granted it, but so far from giving the plaintiff his costs he ordered him to pay five guineas towards the

The position of an innocent infringer.

Examples of practice in the case of innocent infringers.

Millington v. Fox.

Colburn v. Simms.

Plaintiff must act reasonably.

Upmann v. Elkan.

Caruncho v. Highmoor.

Jenkins
v. Hope.

Rutter
v. Smith.

Clarke
v. Hudson's
Executors.

costs of the defendant. In some cases even the injunction has been refused. Thus, in *Jenkins v. Hope* ([1895] 13 R. P. C. 57), the innocent infringers of a patent offered, after the issue of a writ, to account for profits, to give a perpetual undertaking, and to pay all costs. The plaintiff, notwithstanding, proceeded with his action. The injunction was refused, but the plaintiff was held entitled to his costs down to the date of the offer, and the costs of the hearing. North, J., said the offer of the defendants should have been accepted. See also *Leahy v. Glover* ([1893] 10 R. P. C. 141), and *Rutter v. Smith* ([1900] 18 R. R. C. 49), where an application for an injunction, in respect of an isolated sale of an ounce of tobacco under plaintiff's trade mark, was refused with costs. In *Clarke v. Hudson's Executors* ([1901] 18 R. P. C. 310), where the offence consisted in advertising the mark of the plaintiffs in an unauthorised manner (although this appeared to have been done by the printers without authority from the defendants), the offer of the defendants to apologise and give an undertaking and pay costs was disregarded by the plaintiffs, who wished additional terms. Farwell, J., refused an injunction, and only gave the plaintiffs the costs down to and including the writ.

But submission by defendant must be full and such as plaintiff has a right to expect.

But if the offer made by the defendant under such circumstances falls short of the terms of the writ, or appreciably short of such terms as the plaintiff is entitled to obtain, an injunction will be granted with costs (*McAndrew v. Bassett*, [1864] 10 L. T. 65; *Fennessy v. Day & Martin*, [1886] 55 L. T. 161). In *Slazenger v. Pigott* ([1895] 12 R. P. C. 439), in which case an apology and an offer to consent to an order in the terms of the writ were made, North, J., when granting the injunction directed that the costs to be paid to the plaintiff should not exceed those of a consent order in chambers.

Practice and a consideration of the cases makes it plain that where the defendant has made reasonable submission, although he may not have granted every whit claimed by the plaintiff, or indeed every tittle to which the plaintiff is legally entitled, the plaintiff may find himself saddled

with the increased or unnecessary costs incurred by his pressing matters to extremes.

An interlocutory injunction is not usually granted where the plaintiff has unduly delayed (*Isaacson v. Thompson*, [1871] 41 L. J. Ch. 101), and in any case an interlocutory injunction, if granted at all, should be subject to an undertaking by the plaintiff to make good any damages suffered by the defendant in the event of the injunction not being sustained.

Delay in
applying for
injunction.

In considering his defence the defendant must first ascertain the title of the plaintiff and his conclusive or non-conclusive right to the sole use of the mark. It will be remembered that according to Section 76 of the Act, mere registration of the mark is *prima facie* evidence of the proprietor's right to the exclusive use of it, while at the expiry of five years such *prima facie* right becomes conclusive as to his right to the exclusive use of the mark, but subject to the provisions of the Act. Evidently, then, a mere denial of infringement, with allegations that the trade mark is not the plaintiff's and that the alleged trade mark is not a trade mark as set out in the form in the Rules of Court of 1883, is very seldom of sufficient breadth, and in the case of a mark registered for more than five years would apparently plead something which it is incompetent to plead.

Defence.

Conclusive
or non-con-
clusive
right of
plaintiff.

Form of
defence.

If the plaintiff's mark has not been five years on the Register then the defendant may plead against the validity of the registration all the objections to the mark which might be imported into an application to expunge or vary the entry on the Register (*Finto v. Badman*, [1891] 8 R. P. C. 181). But this case also decides that a claim to rectify the Register should not be put forward by counter-claim. Thus he might contend that the mark was improperly registered in that it did not comply with the requirements of registration under Sections 64 and 74 of the Act, in addition to the defences permissible even when the mark has been five years registered, as for example that the trade mark has become severed from the goodwill or has been abandoned, or that the plaintiff has been guilty of laches

Where
plaintiff's
mark has
not been
five years
on Register.

Examples
of pleas in
defence.

such as delay or acquiescence, or because of estoppel, or that the defendant has a concurrent right of user, or that the plaintiff does not use his mark as registered, or that it is fraudulent or deceptive or contains a misrepresentation, such, for instance, as the word "patent" when there is no patent.

Where plaintiff's mark more than five years on Register.

Limitations of defence.

Application to expunge cannot be by counter-claim.

But if the plaintiff's registration is more than five years old the defendant cannot attack the plaintiff's title generally. He cannot, for example, show that the plaintiff's mark is not a trade mark or that it was not competent to be registered as a trade mark under Section 64 (*Apollinaris Co. v. Herrfeldt*, [1887] 4 R. P. C. 478, 483). To do this he must move the Court to expunge the mark from the Register or to vary it in such a manner as to defeat the action. This must be a separate application, and a motion to expunge or vary cannot be added to the defence by way of counterclaim (*Pinto v. Badman*, *supra*). The motion to rectify is heard with the action, or on the application for interlocutory injunction, if such is made. In a proper case facilities are given for the introduction of such a motion to rectify. For example, in *Edwards v. Elkan* ([1888] 3 R. P. C. 70) Stirling, J., adjourned a motion for interlocutory injunction to enable the defendant to prosecute a counter application to register his own mark and to move to rectify the Register by expunging the plaintiff's.

Registration in Stationers' Hall.

Mere copyright registration of a trade mark in the Stationers' Hall gives birth to no trade mark rights, and is no defence if the copyrighted mark infringes another trader's mark (*Reinhardt v. Spalding*, [1879] 49 L. J. Ch. 57).

Discovery.

Discovery is granted in trade mark actions as in other causes. But such discovery will not be ordered where it is likely to be oppressive (*re Wills's Trade Marks*, 10 R. P. C. 269; [1892] 3 Ch. 201), nor where names of customers or correspondents referring to the matters in issue were concerned (*Carrer v. Pinto Leite*, [1871] L. R. 7 Ch. 90). Discovery concerning sales, where the defendant denies infringement, is not usually ordered, and is scarcely material until infringement has been decided. But when an account of profits has been directed, discovery of

Names of customers.

Discovery of sales.

customers and all goods sold is usually enforced (*Leather Cloth Co. v. Hirschfeld*, [1863] 1 H. & M. 295).

The Court may in its discretion, and if thought desirable for the purpose of obtaining such information or evidence as will assist the course of justice, order inspection. If, therefore, a plaintiff can show reasonable grounds, he may obtain an order to inspect goods which he has strong reasons for believing are marked with the infringing mark. Inspection.

Applications for an inspection order are made in the Chancery Division by motion or summons, and in the King's Bench Division by summons.

Should the plaintiff succeed in his action, he may obtain all or a part of the relief he asked—viz. an injunction to restrain further infringement; delivery up of the goods bearing the infringing mark for destruction if need be, or for erasure of the mark if that can be done; damages, or an account of profits made by the defendant through his wrongful use of the mark. Relief granted by the Court.

It is for the successful plaintiff to elect whether he will have damages or an account of profits. He cannot have both. Damages or an account.

Costs usually follow the event, unless the successful plaintiff has been guilty of laches, or sometimes where the defendant is an innocent infringer or has been guilty of some technical offence only, as in *Upmann v. Elkan* ([1871] L. R. 12 Eq. 140), the defendants being merely carriers. In this case the plaintiffs, though successful in obtaining an injunction, obtained no costs. Again, in *Rutter v. Smith* ([1900] 18 R. P. C. 49), where only one sale of an ounce of tobacco passed off as the plaintiff's was proved, Mr. Justice Kekewich, characterising the action as trivial, gave judgment for the defendant with costs. Costs.

On the other hand, a defendant, even when successful, may be refused his costs if his conduct should not commend itself to the Court. Thus in *Warsop v. Warsop* ([1904] 21 R. P. C. 481) the defendant was refused costs because of his misrepresentation that the mark he used was "registered." In *King v. Gillard* ([1904] 21 R. P. C. 589) the successful defendants were refused their costs because of untrue statements made upon the Costs governed by circumstances.

label complained of, but this was reversed on appeal ([1905] 22 R. P. C.).

Costs on higher scale.

Where the case is of great importance and the issues complicated, costs on the higher scale may be given (*Great Tower Street Tea Co. v. Smith*, [1889] 6 R. P. C. 165).

Certificate of validity of plaintiff's claim to trade mark.

If the right of the successful plaintiff to the exclusive use of his registered trade mark came in question at the trial, he should ask the Court or the Judge to certify to that effect (see Section 77A of the Act as consolidated, or Section 18 of the Act of 1888). The result of obtaining this certificate is that in any subsequent action for infringement of the registered mark, the plaintiff, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or Judge trying the subsequent action certifies that he ought not to have the same.

Costs as between solicitor and client in subsequent action.

Certificate should be pleaded in subsequent action.

Presumably, following patent practice, to get the benefit of such a certificate in a subsequent action the plaintiff must plead it (*Pneumatic Tyre Co. v. Chisholm*, [1895] 13 R. P. C. 488); and following the same practice the second action must have been begun subsequent to the giving of the certificate, otherwise Section 77A would not apply (*Automatic Weighing Machine Co. v. Hygienic Society*, [1889] 6 R. P. C. 475).

Appeal.

Appeal may be made both in interlocutory proceedings and from the final judgment of the Court of First Instance to the Court of Appeal, and from the latter to the House of Lords. In a case of urgency an appeal on an interim injunction has been advanced in the list on the ground that the defendant's business would be irretrievably prejudiced by the continuance of the injunction (*Lazenby v. White*, L. R. 6 Ch. 89).

Advancement of appeal.

It seems that a refusal to grant an interlocutory injunction should not be appealed against, even where the defendant refuses to submit to an injunction or to give an undertaking, if he at the same time removes the cause of complaint (*Dale v. Smith*, [1882] W. N. 145).

No statutory action for threats by proprietor of trade mark.

The section in the Patent Act of 1883 which makes a patentee liable to an action for threats against alleged infringers, does not extend to trade marks. Therefore the

proprietor of a trade mark may give notice that his mark is being infringed, and that he intends to take proceedings without rendering himself liable under the Statute to an action for threats, and he cannot be restrained by injunction from so doing (*Colley v. Hart*, 44 Ch. D. 179; [1888] 6 R. P. C. 17). But statements not made in good faith and calculated to injure the trade of another, or amounting to trade libel or slander of title, may be restrained (*Thorley's Cattle Food Co. v. Massam*, [1880] 14 Ch. D. 763; *Coulson v. Coulson*, [1887] 3 T. L. R. 740; *Nähmaschinen Fabrik v. Singer*, [1893] 10 R. P. C. 310; *Royal Baking Powder Co. v. Wright, Crossley & Co.*, [1900] 18 R. P. C. 95). It appears from the latter case that even when the statements complained of are untrue and made maliciously the plaintiff must prove special damage. But mere puffing of one's own goods, in however extravagant terms, is not a libel on the goods of rival traders (*Mellin v. White*, [1895] App. Cas. 154).

But action
might be
taken as for
trade libel
or slander.

CHAPTER VII.

COMMON LAW TRADE MARKS, TRADE NAMES,
AND THE ACTION FOR "PASSING OFF."

Owners of
non-
registered
and non-
registrable
marks may
restrain in-
fringement.

THE last Chapter referred mainly to actions taken in respect of registered trade marks, which, on that account, occupy a privileged position under the Statute.

But it must not be supposed that it is only the owners of registered marks who can obtain relief against infringers or imitators. The 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 or unfair trading by one person at the expense of another. In an action for the infringement of a registered trade mark, as touched upon in Chapter VI., there is usually an ascertained 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 Co. v. Looy* ([1882] 18 Ch. D. 395; 8 App. Cas. 15), after referring to frauds committed by the infringement of registered trade marks, "There is another way in which goods not the plaintiffs' may be sold as and for the plaintiffs. A name may be so appropriated by user as to cause it to mean the goods of the plaintiffs, 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

Name
trade mark.

as to be likely to deceive, as applicable to goods not the plaintiffs', may be the means of passing off those goods as and for the plaintiffs." (See also the instructive remarks of Romer, J., in *Singer v. Spence*, [1893] 10 R. P. C. 297.)

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 & Co. v. Bentham Hemp Spinning Co.* ([1892] 9 R. P. C. 503), and the latest writers have adopted this term 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," and in some instances having an admixture of camel's hair in the yarn. At the Manchester Assizes, in May, 1892, Cave, J., directed a verdict for the defendants. The plaintiffs 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.

This result was so far unsatisfactory, in that the point involved had not been the subject-matter of a direct pronouncement by the Courts. But the question was not to rest here. Another firm of rival manufacturers began to use the name "Camel Hair" in connection with their woven belting, and proceedings were taken by Messrs. Reddaway to restrain them. The case went to the House of Lords (*Reddaway v. Banham*, 13 R. P. C. 218; [1896] A. C. 199), and is so important and so often quoted that a full history of the proceedings may not be out of place. The defendants contended that as the words "Camel Hair Belting" truly described their goods, which were composed substantially of camel hair, they could not

Common
Law trade
marks.

*Reddaway
and Co.
v. Bentham
Hemp
Spinning Co.*

*Reddaway
v. Banham.*

When a
certain
name has
become
identified
with the
goods of a

particular
maker its
use by
others will
be
restrained.

be restrained from using these words, even without the addition of their name as manufacturers. But the House of Lords were of a different opinion, and held that when words which although properly descriptive of an article have come to have the secondary meaning of denoting the goods of a particular manufacturer, he is entitled to restrain others from using them *so as to deceive purchasers*, notwithstanding that the words are descriptive of the goods.

Terms of
order in
Reddaway
v. Banham.

The order was in the form approved by the House in *Johnstone v. Orr-Ewing* (7 App. Cas. 219), and restrained the defendants from using the words "Camel Hair" on belting, *without clearly distinguishing such belting from the belting of the plaintiffs*. Of course, as was pointed out by Herschell, L. C., it was not proposed to prohibit the use of the words "Camel Hair" altogether. The meaning of the order was that the words "Camel Hair," alone and without qualification, meant Reddaway's manufacture and no other. But it left it open to other makers to use the term so long as they made it clear that the belting was not as a matter of fact of Reddaway's make. Thus, "Camel Hair Belting, manufactured by Banham and Co.," or "Banham's Camel Hair Belting" would not have been within the terms of the injunction (*Reddaway v. Ahlers*, [1901] 19 R. P. C. 12; *Reddaway v. Frictionless Packing Co.*, [1902] 19 R. P. C. 505; *Reddaway v. Stevenson*, [1902] 20 R. P. C. 276). In *Reddaway v. Stevenson* (*supra*) it was held to be within the terms of the injunction to sell belting as "Camel Hair" even when the words were prefixed by the special brand or fancy name trade mark of the vendor—*e.g.* "Phoenix Camel Hair Belting." In the same case the learned V.-C. went so far as to restrain the use of the words "Stevenson's Camel Hair Belting." But he founded this part of his decision on the fact that the defendants had made certain untrue statements in their circulars, describing themselves as manufacturers and the proprietors of works, whereas they were merely agents or dealers in mill furnishings. Otherwise it must have been difficult to reconcile his decision with his own remarks in the earlier case of *Reddaway v. Frictionless Packing Co.* (*supra*), where he declined to draw a distinction between a

manufacturer and a mere agent or dealer. Apparently the Court has discretion to make either party suffer where untrue statements and lack of good faith are brought home to him. Thus, Kekewich, J., in *King v. Gillard* ([1904] 21 R. P. C. 589) deprived a successful defendant of his costs because of untrue statements as to medals and awards made upon the labels complained of (see also *Warsop v. Warsop*, [1904] 21 R. P. C. 481). But this part of the decision in *King v. Gillard* was reversed in the Court of Appeal ([1905] 22 R. P. C.).

The case of *Reddaway v. Banham* has been thus fully referred to, partly because although so often quoted its full import is sometimes missed, and partly because it constitutes a salient example of the building up of a right of property in a Common Law trade mark which was both unregistered and unregistrable, seeing that it was not only a geographical name but was also either descriptive or deceptive.

"Camel" mark both descriptive and geographical.

Another instance of a Common Law trade mark is to be found in the "Stone Ale" Case (*Montgomery v. Thompson*, [1891] 8 R. P. C. 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.

"Stone Ale" Case.

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.

Geographical name removed from Register, but defendant restrained from infringing.

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.

"*Glenfield Starch*"
Case.

Similar considerations weighed in deciding *Wotherspoon v. Currie* ([1872] L. R. 5 H. L. 508), the "*Glenfield Starch*" Case, in which, as Lord Westbury said, it was evident "that long antecedently to the operations of the respondent the word 'Glenfield' had acquired a secondary signification or meaning in connection with a particular manufacture—in short, it had become the trade denomination of the starch made by the plaintiffs. . . . The word 'Glenfield,' therefore, as a denomination of starch, had become the property of the plaintiffs."

Yorkshire Relish"
Case.

The case of *Powell v. Birmingham Vinegar Brewery Co.* (14 R. P. C. 720; [1897] App. Cas. 710; 66 L. J. Ch. 763) is also an instance of a trade name becoming a Common Law trade mark by right of long user. The plaintiff had for thirty-four years designated his sauce, which was made according to a secret recipe, as "*Yorkshire Relish*." The defendants began to make and sell a similar but not identical sauce of their own manufacture under the same designation, but with their own name and address on the label. The plaintiff obtained an interlocutory injunction to restrain, and thereupon the defendants issued new labels with the name "*Holbrook's*" in large letters and "*Yorkshire Relish*" in smaller letters. The House of Lords, to whom the case was carried, held that "*Yorkshire Relish*" meant the manufacture of a particular person—viz. the plaintiff. That so long as the plaintiff succeeded in keeping the secret of the sauce, he remained in fact the sole manufacturer of "*Yorkshire Relish*," and that the defendants in selling their goods as "*Yorkshire Relish*," when they were not so in fact, committed a fraud upon the public and represented that the goods were the goods of which the plaintiff only was the manufacturer. The same principle held good in the earlier "*Angostura Bitters*" Case, where the defendant was restrained from calling his bitters "*Angostura*" until he should find out how to make the real "*Angostura Bitters*."

Secret
recipe.

A person
making his
goods from
a secret
recipe has
a right to
the sole use
of the name
so long as
he preserves
his secret.

"*Angostura Bitters*"
Case.

the composition of which was a secret (*Siebert v. Findlater*, [1878] 7 C. D. 801). It should be noted at this point that when a person who has a trade secret employs workmen under an express or implied contract not to divulge the secret, such employes cannot in breach of trust make use of their knowledge and set it up against their employer; neither can such knowledge be acquired and used by another by such breach of trust (*Williams v. Williams*, [1817] 3 Mer. 157; *Escourt v. Escourt Hop Essence Co.*, [1875] L. R. 10 Ch. 276). But this holds good only where a positive breach of trust has occurred.

Improper
use of trade
secret.

The "Camel Hair" Case is thus representative of that class of Common Law mark which by original and continued user becomes, *per se* and in its unqualified form, even although descriptive, the sole property of a particular manufacturer in respect of goods open to all the world to make but not to sell under that particular designation, except with the addition of some qualification which will clearly point out its source of origin and distinguish it from the goods of the owner of the unqualified mark. The "Yorkshire Relish" Case is an example of a Common Law trade mark becoming appropriated to a manufacturer of certain goods made according to a secret recipe which other people cannot make because they have not the secret, and the appropriated name of which they cannot use either with or without distinguishing qualifications. But the acquirement of such Common Law rights, and the stamping of a term, especially when descriptive, with the secondary meaning which connects it in the mind of the public with the goods of a particular manufacturer, is generally a matter of time and undisturbed possession. In *Weingarten v. Bayer* ([1903] 20 R. P. C. 649) the unregistered term "Erect Form" as applied to corsets was held descriptive, and not to have been so long identified with the plaintiffs' goods as to have acquired the secondary meaning entitling them to hold it in its unqualified form against others. The plaintiffs had only begun the use of the name in the U.S. in 1900. In the beginning of 1901 they had imported quantities of the corsets into England and these were extensively sold and advertised as "Erect Form Corsets." About the end of 1901 the defendants began to

Comparison
of typical
cases of
Common
Law marks.

"Erect
Form"
Corset Case.

use the name, avowedly with the intention of preventing the plaintiffs from acquiring a prescriptive monopoly. The plaintiffs' action to restrain them was unsuccessful. The adoption by the defendants of a specially printed scroll label carrying the words "Erect Form" was characterised by the Court of Appeal as injudicious, but as the defendants had ceased to use it after issue of the writ, an injunction in respect of this also was refused. On appeal by the plaintiffs to the House of Lords the gist of the judgment of the Court of Appeal was left untouched, but an injunction and inquiry in respect of the scroll was granted ([1905] 22 R. P. C.; see also report in *Times*, 12th April, 1905).

New trade names applied to newly invented products.

The monopoly under a patent cannot be prolonged under a trade mark.

And the monopoly in the new name of a new product which is not patented cannot be retained by the author.

There remains a third class of trade mark or name which is especially interesting to inventors. Suppose, for example, that a man invents an entirely new article or product, to describe which he invents an entirely new name, and then (whether the name is registered as a trade mark or not) proceeds to manufacture and sell the new product or article under that name, the question arises—Can he preserve the right to the sole and exclusive use of that invented name which he has constituted his trade mark after the expiry of his patent? The answer is, Generally speaking, he cannot. As was said by Lord Davey in the *Cellular Clothing Co. v. Marton and Murray* ([1899] 16 R. P. C. 397): "If a man invents a new article and protects it by a patent, then during the term of the patent he has of course a legal monopoly; but when the patent expires all the world may make the article, and if they may make the article they may say that they are making the article, and for that purpose use the name which the patentee has attached to it during the time when he had the legal monopoly of the manufacture. But, my Lords, the same thing in principle must apply where a man has not taken out a patent, as in the present case, but has a virtual monopoly, because other manufacturers, although they are entitled to do so, have not in fact commenced to make the article. He brings the article before the world; he gives it a name descriptive of the article—all the world may make the article, and all the world may tell the public what article it is they make, and for that purpose they may *prima facie* use the name by which the article is known in the market."

So, then, if a man invents an absolutely new description of floorcloth, composed of boiled oil and finely ground cork and other ingredients, and patents it, and then invents a new name for it—say “Linoleum”—and sells it in the market under that name, during the fourteen years of his patent monopoly no one else can make “Linoleum” or sell a floorcloth as “Linoleum.” Thus the public only know the article as Linoleum and by no other name, so that to give the inventor a monopoly in the name after the patent had expired would be virtually to give him and his successors a monopoly for ever, and this would be against public policy (*Linoleum Co. v. Nairn*, [1878] 7 Ch. D. 834). And, as Lord Davey says, the same principle must hold good in a thing which is unpatented, and which, when the secret of manufacture is out, is open to any one to make. So that, apparently, the man who attaches a distinctive name to an article already known and open to all the world to make is in a more favourable position with respect to his trade name than if he had been the first discoverer or patentee of the new article. This was illustrated in the “Vaseline” Case (*Chesebrough Manufacturing Co.’s Marks*, [1902] 19 R. P. C. 342), where the Court of Appeal held that the petroleum jelly to which the name “Vaseline” had been applied was at the date of its baptism a known product open to all the world to make, and that the name “Vaseline” was an invented word applied to an existing and known product, and therefore not within the principle of the “Linoleum” and “Cellular” decisions.

“*Linoleum*”
Case.

“*Vaseline*”
Case.

The principle is sound, for in the latter case there is no question of monopoly in the goods, 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 or patentees with a perpetual right to the only name by which the article is, or possibly can be, known to the public.

Decisions
directed
against the
principle
of perpetual
monopoly.

When a new name is given to a new article of manufacture—such, for example, as “Gramophone” to designate a new type of talking machine, or “Neostyle” to designate

Accessories
of patented
apparatus
sold under
new name.

a new type of duplicating machine—it is sometimes asked whether unpatented accessories for such machines (such, for instance, as “Gramophone Needles” or “Neostyle Ink”) can be sold by others than the owners and sole producers of the new machine or article. The balance of opinion seems to be that they can, especially when the get-up is distinctive (*Neostyle Co. v. Ellams*, [1904] 21 R. P. C. 569); *a fortiori* if the name of the actual maker of the accessories is shown on the goods or packets thus—“Horlock’s Gramophone Needles” or “Neostyle Ink, made by Ellams & Co.”—the right of anyone to make and sell such accessories is unquestionable.

Common
Law trade
mark: name
of locality.

Where a person uses the name of a district as his Common Law mark, the extent of his remedy is usually that he can restrain anyone else from using the same name, except upon goods which actually are produced in that district. In *Bewlay v. Hughes* ([1898] 15 R. P. C. 290) the plaintiff had for some years sold his cigars under the name “Dindigul.” The defendant began to sell his cigars also as “Dindigul,” and alleged that the tobacco actually came from Dindigul. The plaintiff obtained an injunction restraining him from using the name except upon cigars actually made of Dindigul tobacco. But compare this with the decision in *Wotherspoon v. Currie* ([1872] L. R. 5 H. L. 508), where it was held that from long user and notoriety the plaintiff’s starch had become so widely known as “Glenfield” starch that the defendant, although making his starch at Glenfield, must not sell his goods as “Glenfield” starch. However, this must be looked upon as an exceptional case.

“*Glenfield
Starch*” Case
must be
regarded as
exceptional.

Where the goods are a natural product and derive their name from the locality where they are found, the mere name of the locality cannot be appropriated to one vendor.

“*Whitstable
Oyster*”
Case.

The plaintiffs in the “Whitstable Oyster” Case failed to establish any exclusive right to the name “Whitstable” as meaning oysters from their beds, the defendants showing that their beds were also in Whitstable (*Whitstable Oyster Co. v. Hayling Oyster Co.*, [1901] 18 R. P. C. 434); see also *Grand Hotel of Caledonia Springs v. Wilson*, [1904] 21 R. P. C. 117).

The use of
words too
similar
to the

Apart from the absolute copying of the mark of another, a rival trader might adopt a word or mark so nearly resembling that of another as to be calculated to

deceive. Thus, in *Smith v. Carron Co.* ([1896] 13 R. P. C. 108) the defendants were restrained from using the word "Stafford" to designate their stoves, as being too near the plaintiff's mark "Trafford"; the use of "Savoline" was held to infringe "Savonol" for soap (*Field v. Wagel*, [1900] 17 R. P. C. 266); and "Securine" was restrained as a colourable imitation of "Seccotine" (*McCaw v. Nickols*, [1903] 21 R. P. C. 15).

plaintiff's
mark will be
restrained.

But a much more common attempt at deception is where the general appearance of a trader's goods is imitated in such a manner that they can be easily mistaken for the goods of the person who originated that particular get-up. Mr. Justice Kekewich said, in *Jones v. Hallworth* ([1897] 14 R. P. C. 225), that in this class of case "the eye is the ultimate judge, guided, of course, or assisted rather, by the various facts which are available." Mr. Justice Byrne, in *Clark v. Sharp* ([1898] 15 R. P. C. at p. 146), also said that in cases depending upon what is called "get-up" or "dressing" of the goods the actual issue is not so much whether the Judge or members of the jury might be personally deceived, but whether (all of the collateral points having been considered) the true conclusion is that the ordinary customer of the retail dealer is likely to be deceived. Merely originating a certain unregistered get-up does not, however, create a monopoly, particularly if it is imitated shortly after its appearance, as in the "Red, Blue, and Green Coffee Tin" Case (*Payton v. Snelling*, [1899] 17 R. P. C. 48, 628). But even when the plaintiff's "get-up" is comparatively recent he may succeed in getting an injunction where intention to imitate is proved and intent to deceive can be inferred from the circumstances, such, for example, as the instructions of the defendant to a designer to make a get-up "exactly like" the plaintiff's (*County Chemical Co. v. Frankenburg*, [1904] 21 R. P. C. 722). In this case the plaintiffs began in 1902 to pack repair outfits for tyres in boxes of a certain shape, size, colour, and design. In 1903 the defendant imitated the get-up nearly exactly, though with some slight difference in the lettering. No case of actual deception was proved, but Alverstone, L.C.J., said that the question was: "Is this selection of such similarity as there is, a mere accident

General
"get-up."

Deceptive
imitative
"get-up"
will be
restrained.

The test is,
will the
ordinary
customer be
deceived?

"Red, Blue,
and Green
Coffee Tin"
Case.

Relief
against
imitation of
recent
"get-up"
may be
obtained.

A "get-up" may deceive though details are not copied.

Per contra details may be copied without creating deceptive general appearance.

or an innocent act done without any intention of passing off; or is it done in order to imitate the plaintiffs' goods?" As a result an injunction was granted. In *Rowland v. Mitchell* ([1896] 14 R. P. C. 37) the plaintiff's wrapper, containing certain printed matter and a portrait of himself, had been imitated by a wrapper of the defendant with different matter similarly arranged and also bearing a portrait, but not of the plaintiff. The Court held that the defendant's wrapper was calculated to deceive, and granted an injunction to restrain passing off, with costs. In *Liebig's Extract Co. v. Chemists' Co-operative Society* ([1896] 13 R. P. C. 736) the same liability to confound the plaintiffs' with the defendants' tins caused the Court of Appeal to confirm an injunction against passing off which had been granted in the Court below. In *Lerer v. Goodwin* ([1887] 4 R. P. C. 492) the plaintiffs succeeded entirely on the issue of get-up. Their soap tablets were put upon the market wrapped in imitation parchment printed with instructions in broken or spaced letterpress. The defendants used the same parchment wrapper material printed with instructions of their own composition, but arranged in the same broken or spaced manner as the plaintiffs'. This was held to be a fraudulent imitation. But in another action by the same plaintiffs (*Lerer v. Bedingfield*, [1898] 16 R. P. C. 3), although the Court of Appeal recognised that some parts of the plaintiffs' wrapper had been taken, yet the general resemblance between the wrappers was not sufficiently close to constitute passing off, and an injunction was refused. The same result was arrived at in *King v. Gillard* ([1904] 21 R. P. C. 589), being an action taken by the proprietors of "Edwards' Desiccated Soup" against the defendants for copying their "get-up." Here the resemblance was sufficiently close to cause Joyce, J., in the plaintiffs' motion for interlocutory injunction to give an opinion that the defendants had "distinctly and obviously copied the plaintiffs' labels in certain respects," and to express his surprise that "respectable people should do this sort of thing." Nevertheless, at the trial it was held that the plaintiffs' get-up was not distinctive of their goods only; that the points of

resemblance between their get-up and that of the defendants were common to the trade; that the defendants' get-up was not calculated to deceive; and that no case of actual deception had been proved. To mark his disapproval of certain untrue statements on the defendants' labels, Kekewich, J., deprived them of their costs, but the Court of Appeal dissented from this ([1905] 22 R. P. C.). In *Schreppes v. Gibbens* ([1904] 22 R. P. C. 113) the plaintiffs attempted to restrain the defendant from using a narrow chocolate and white bottle label with red centre piece, which they alleged imitated their own well-known label. Here, again, chocolate and white bottle labels proved to be common property, and no fraudulent imitation of the plaintiffs' details was shown.

In the *Imperial Tobacco Co. v. Parnell* ([1904] 21 R. P. C. 598) the plaintiffs had been accustomed to get up their cigars with a very narrow red band in contradistinction to the wider bands of other makers. At the trial it was proved that other makers had simultaneously used such narrow red bands, and the Court of Appeal held that the plaintiffs had no exclusive right to such narrow bands as distinguishing their cigars from those of other manufacturers.

*Narrow Red
Band Cigar
Case.*

In *Colley's Patents, Limited v. British Paper Co.* ([1904] 21 R. P. C. 689) the defendants were able to prove that the label, which the plaintiffs contended was an imitation of their get-up, had been used by them and their predecessors in business at a date prior to that when the plaintiffs first used their label, and the action was dismissed.

*Prior user
of get-up.*

A further feature in attempts to pass off goods as and for the goods of another is to be found in those cases where a trader's name has been taken or imitated. We have seen that a man's own name or that of a firm may be registered as a trade mark, but only in a distinctive dress, and it is this distinctive dress only which he can claim.

*Trader's
name.*

It is also common knowledge that a man may use his own name in his own business, so long as there is no fraud or misrepresentation, and so long as he uses it in such a manner as to avoid confusion between his goods and

*A man's
right to
use his
own name.*

Qualifica-
tion by
Byrne, J.,
in *Jamieson*
v. Jamieson.

A man not
bound to
use extra
precautions
to avoid
confusion.

But where
trader's
name and
his goods
are in-
dissolubly
connected
in public
mind defen-
dant's acts
narrowly
scrutinised.

"*Valentine*
Meat Juice"
Case.

Dewar
v. Dewar.

those of a rival, no matter how long that rival may have been established in business (*Burgess v. Burgess*, [1853] 3 De G. M. & G. 896; *Turton v. Turton*, L. R. 42 C. D. 128; and *Jamieson v. Jamieson*, [1898] 15 R. P. C. 169). But, as was said by Byrne, J., in the latter case, a man entering a trade in which another person of a like name has established a reputation, has a burden cast on him to distinguish his goods from those of that other person. It was also said in the Court of Appeal in the same case that a man is not bound to use extra precautions to avoid confusion between his goods and those of other persons in the trade, if such confusion arises solely from similarity of name and from the use of features common to the trade. But such a case must be distinguished from the case where the name of a particular trader has in the market come to denote his goods. An example of this latter case is to be found in *Valentine Meat Juice Co. v. Valentine Extract Co.* ([1900] 17 R. P. C. 673), where the defendant company were restrained by the Court of Appeal from carrying on business in meat extracts under the name of "Valentine," and from selling goods of this nature under any name including the word "Valentine." The evidence enabled the Court to come to the conclusion that the plaintiffs, who had traded under the name "Valentine" for nearly thirty years, were entitled to say that the name when used on goods of this nature denoted that the goods were of their manufacture. The co-defendant Valentine was restrained from using his own name in any such business *without clearly distinguishing his goods from the plaintiffs'*, but the injunction against the company to which Valentine had given his name was, as pointed out, of a more sweeping nature. In *Dewar v. Dewar* ([1900] 17 R. P. C. 341) the plaintiffs failed to convince the Court that the term "Dewar's Whisky" denoted only the whisky sold by them, and an injunction was refused, but the circumstances in this case were incomparably less favourable to the plaintiffs than in the "Valentine Meat Juice" Case, as the defendants' firm had also been a long time in existence and the plaintiffs' assumption of the particular words complained of had been of comparatively recent origin. The principle of restraining

a man from carrying on business in certain goods under his own name was discussed by the Court of Appeal in *Cash v. Cash* ([1902] 19 R. P. C. 181), and there the defendant was restrained from vending certain goods, such as frillings and woven initials, as "Cash's Frillings" &c., but the Court declined to say that under any circumstances, apart from fraud or restraint of another description, a man could be absolutely enjoined from carrying on business in his own name. *Cash v. Cash.*

In *Chivers v. Chivers & Co.* ([1900] 17 R. P. C. 420) an attempt on the part of the plaintiff to show that "Chivers," as applied to table jelly, meant his manufacture only, failed, it being proved that the defendants had been for a long time in business as jam makers and that the plaintiff had only begun his trade in table jelly ten years before the defendants did so. It may be said with regard to all cases of individual name trade marks at Common Law that the plaintiff can only succeed by proving long exclusive use of the name in connection with certain goods, and in addition to such prescriptive right that the name has acquired a secondary meaning which would cause all such goods sold under that name to be mistaken for the goods of the plaintiff. "Chivers' Table Jelly."

Plaintiff must always prove long exclusive user.

At this point it seems not out of place to refer to individual name trade marks which by general use have become *publici juris* and open to anyone to use. Many of these are the names of what were once patented articles which have become so associated with the name of the original patentee as to be known generally and to all the world by that name only, such for example as "Corliss Valves" for steam engines, "Galloway Tubes" for boilers, "Worthington Pumps," and many other instances which will recur to the reader. These names are now lost to the original users so far as exclusive right is concerned, so that any boilermaker may make and sell "Galloway Tubes," or any engineer may similarly make and sell "Worthington Pumps" or "Corliss Valves." In other branches of trade "Harvey's Sauce" was, in *Lazenby v. White* ([1871] 41 L. J. Ch. 354), admitted to be common to the trade, and "Worcestershire Sauce" is in the same Names which have become public property.

Instances of names which have become *publici juris*.

But where the owners of the name still carry on business it must appear clearly that they are not the manufacturers of the goods.

category. These and other name marks similarly situated would have been of enormous value had their original owners maintained their rights in them. The sewing machine industry furnishes other examples of the individual trade name of a patented article which has become wedded to the article itself, becoming in a measure public property. In *Wheeler & Wilson Co. v. Shakespeare* ([1869] 39 L. J. Ch. 36), and in *Singer Manufacturing Co. v. Wilson* (2 Ch. D. 434; 3 App. Cas. 376), the Courts declined to continue a patent monopoly by a claim to the exclusive use by way of trade mark of a name which had become descriptive of the principle of construction (see also *Daimler Motor Car Co., Limited v. British Motor Traction Co., Limited*, [1901] 18 R. P. C. 465, concerning the use of the name "Daimler" as descriptive of a system). But although the term "Singer" as descriptive of a principle was thus thrown open to the public, nevertheless it was decided in *Singer Manufacturing Co. v. Spence* ([1893] 10 R. P. C. 297) that the name must not be so used as to be calculated to deceive the public and cause them to buy the machines as and for the manufacture of the Singer Company.

The name of a registered design may also become *publici juris*.

The principle as to patented articles applies also to articles registered as a design. In *Winser v. Armstrong* ([1899] 16 R. P. C. 167) the plaintiffs in 1885 registered the design of a sewer trap and sold them during the period of registration and afterwards as "Winser Interceptors." The traps became well known as "Winser Interceptors." In 1898—viz. eight years after the expiry of registration—the plaintiffs took action against the defendants, who had begun to make and sell traps of the same design as "Winser Interceptors." Byrne, J., held that the name had become significant of that particular design of trap and did not necessarily mean that the goods were of the plaintiff's manufacture. The action was therefore dismissed.

No statutory right in action for "passing off."

As compared with the action for infringement of a registered trade mark the action for "passing off" does not greatly differ, except in this respect, that the statutory privilege acquired by registration forms no part of it, and the plaintiff must prove that the conduct of the defendant is such as to deceive or to lead to deception, or

in other words that the defendant is trying to pass off his goods as and for the goods of the plaintiff. The plaintiff must therefore either show that the defendant actually represented his goods to be those of the plaintiff, or by the use of a trade mark or a trade name or by get-up led buyers to believe, or was likely to lead them to believe, that the goods he sold were those of the plaintiff. Seeing, therefore, that a registered proprietor of a trade mark can only proceed upon his registered trade mark substantially as registered, it follows that he might fail in showing infringement of his registered mark, and yet, in the opinion of the Court, be entitled to succeed against the defendant upon the score of passing off. Such being the case, a claim in respect of passing off is generally added in actions for infringement of registered trade marks, so that if the action under registration breaks down the case in regard of passing-off may succeed. Proof of actual damage done to the plaintiff is not in all cases necessary, but it is advisable if possible to adduce evidence of actual deception. One instance only of passing off without any intention to continue doing so, or any proof of damage to the plaintiff, has been held not to constitute a ground of action (*Knight v. Crisp*, [1904] 21 R. P. C. 670). Actual comparison of a plaintiff's and defendant's goods is a potent factor in deciding the question, but in certain classes of alleged deceptive get-up, a view and comparison by the Judge does not entitle him to dispense with evidence of such alleged deception (*London Omnibus Co. v. Larell*, [1900] 18 R. P. C. 74).

Plaintiff must prove deception or extreme probability of deception.

In action on registered trade mark it is desirable to add claim for passing off.

In delivering his defence the defendant, in addition to a general denial of the acts imputed, should attack the position assumed by the plaintiff, and deny that the mark or name or get-up in question has any exclusive reference to the plaintiff's goods; that the mark or name or get-up used by the defendant is different from the plaintiff's, and is not used in such a manner as to pass off other goods as and for the goods of the plaintiff; that the defendant has an independent or concurrent right of user; that the plaintiff is barred from relief by some agreement or acquiescence, or delay, or deceptive or fraudulent use, or

Further points in defence.

abandonment, or for any other reason the defendant may be able to allege. Of course, if the defendant can show he has used the get-up complained of prior to or concurrently with the plaintiff the action must fail (*Colley's Patents, Limited v. British Paper Co.*, [1904] 21 R. P. C. 689).

Relief in
action for
passing off.

If a plaintiff in a passing-off action is successful, the relief granted is usually an injunction restraining the defendant from passing off or doing anything calculated to pass off his goods as and for those of the plaintiff; delivery up of all goods bearing the deceptive mark or name or get-up for destruction or erasure; destruction of all blocks, papers, documents, &c., furthering such deception; and damages or an account of profits.

The terms of relief and the form of the injunction are of course varied according to the circumstances and merits of the case.

Relief in
action
against
person of
same name.

Where the defendant's name and the plaintiff's name are the same, and the action is taken in respect of deceptive use of the name, so as to cause confusion between the goods of the parties, the injunction as a rule never goes beyond restraining the defendant from using his name in such a manner as to deceive.

Trading or
firm name
on sign-
board &c.

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 the 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. c. 89), there is no such thing as registration of a firm's name in the same sense as trade mark or design registration.

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.

It is not enough to say that the defendant's business is represented as being *similar* to the plaintiff's: it must be clear that it is represented as *actually* the business of the plaintiff, or at least the representations must be of such a nature as to convince the Court that the public will be deceived to that extent (*Churton v. Douglas*, [1859] Johns. 174; *Holloway v. Holloway*, [1850] 13 Beav. 209). As James, L.J., said in *Hendriks v. Montague* ([1880] 17 Ch. D. 638): "All the Court requires is to be satisfied that the names are so similar as to be calculated to produce confusion between the two—so calculated to do it that, when it is drawn to the attention of those adopting the name complained of . . . it is not honest of them to persevere in their intention, though originally the intention might not have been otherwise than honest." An injunction may also be granted where the name is such as to suggest an amalgamation with the plaintiff firm (*Manchester Brewery Co. v. North Cheshire and Manchester Brewery Co.*, [1899] App. Cas. 83). Where direct fraud is ascertained, as in *Pinet v. Pinet* ([1897] 15 R. P. C. 65)—where the defendant had assumed the plaintiff's name with the intention to trade in the same or a similar business—the Courts are always ready to assist the plaintiff.

Court must be convinced of the probability of deception.

Where an amalgamation is suggested.

Direct fraud.

"Get-up" of shop front or sign, or using a deceptive name or title thereon, where evidently intended to imitate the plaintiff's, will also be restrained (*Burgess v. Burgess*, [1853] 3 De G. M. & G. 896; 22 L. J. 675; and *Foot v. Lee*, 13 Ir. Eq. 484). Just as a shop front may be got up so as to prove deceptive, and thereby cause the public to enter and buy, so a public vehicle may be got up so as to deceptively imitate another's property, and thus cause the

"Get-up" of business premises.

Public vehicles.

public to use it under the belief that they are riding in the vehicle the get-up of which has been imitated. But to succeed in such a case the plaintiff should produce evidence to show that members of the public were actually deceived, and, except where the vehicles are absolutely identical, the Judge ought not to substitute a view under Order L., Rule 4, for evidence that the get-up of the defendant's goods is calculated to deceive (*London General Omnibus Co. v. Lavell*, [1900] 18 R. P. C. 74).

Dis-
tinguishing
names for
business
premises.

A peculiar or unusual name distinguishing a shop or place of business is usually protected from imitation. Thus "Uncle Tom's Cabin" as a name for a curiosity shop would probably be maintainable against the imitator. But this would not hold good if the title were simply descriptive, such as "The Antiquarian Stores" (see *Hudson v. Osborne*, [1870] 39 L. J. Ch. 79; *Boulnois v. Peake*, [1868] 13 Ch. D. 513, note; *Bodega Co., Limited v. Owens*, [1889] 7 R. P. C. 31).

The right to use the trade name of certain premises may co-exist in different parties in the same trade (*Cooper v. MacLachlan*, [1901] 19 R. P. C. 27); and where the proprietor of the "Black Swan Distillery," where gin was made, sold the goodwill and trade mark (a Black Swan) to the plaintiff and the freehold of the premises to the defendant, the defendant was held entitled to carry on the business of a *whisky* distiller at the premises he had bought, and to continue to use the old title and sign of a "Black Swan," and to advertise it as the "Black Swan Distillery" (*Nicholson v. Buchanan*, [1900] 19 R. P. C. 321).

Fraudulent
assumption
of name.

Fancy name
assumed by
plaintiff.

Where the trading name is the actual name of an individual or of the members of a firm, and this is assumed by a person or association of a different name or names (as in *Pinet v. Pinet*, *supra*), the fraudulent intention is obvious. But even when the plaintiff's name is itself assumed, or is a fancy title, relief may be obtained as in "The Christy Minstrels" (*Christy v. Murphy*, 12 How. Pr. 77; *Montague v. Moore*, "Seton," 5th ed., p. 539); "The Oldfield Lane Doctor" (*Milner v. Reed*, [1870] Sebas. Dig. 328);

or "Madame Louise" (*Isaacson v. Thompson*, [1871] 41 L. J. Ch. 101), where the plaintiff only missed getting an injunction by her own delay.

As to registration under the Companies Act of 1862, Section 20 of that 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."

Registration of company names, Companies Act, 1862.

In *Aerators, Limited v. Tollit et al.* ([1902] 19 R. P. C. 418) the plaintiffs sought to restrain the registration of a company as "The Automatic Aerator Patents Limited," but on proof that there was no similarity in the goods dealt in by the defendants with those of the plaintiffs the action was dismissed. Farwell, J., characterised the action of the plaintiffs as an attempt to monopolise generally an ordinary English word.

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*, [1880] 17 Ch. D. 638).

Un-registered firm name.

But in any action brought to restrain the registration of a company with a name so nearly resembling that of an existing company as to cause confusion, evidence is admissible for the purpose of ascertaining how the existing company has used its name and what by reason of its connecting that name with its goods the public have come to attribute to that name. Thus, in *Daimler Motor Car Co. v. British Motor Co.* ([1901] 18 R. P. C. 465) the Daimler Motor Car Co. brought an action to restrain the defendants from registering a company under the name of "The Daimler Wagon Co., Limited," the plaintiffs relying on Section 20 of The Companies Act, 1862, and also on their Common Law right. The Court held that the word "Daimler" meant a particular system, and was used by all persons who manufactured under the "Daimler" Patents, and that the plaintiffs had failed to establish that the word

Right of plaintiff company must be established by evidence.

"Daimler" was so identified with their goods as to cause confusion if used in the name of another company.

Promoting
company of
similar
name
without
goodwill.

From *Tussaud v. Tussaud* ([1890] 44 Ch. D. 678), and also from the "Valentine Meat Juice" Case ([1900] 17 R. P. C. 673), it seems that although a defendant may commence and carry on a business similar to that of the plaintiff in his own name, albeit that name is the same as the plaintiff's, he cannot, nevertheless, start a limited company under his name unless he has a reasonably long-established business and goodwill to assign to the company. According to Stirling, J., in *Tussaud v. Tussaud* (*supra*), if it be granted that a private business properly assigned becomes the property of a joint stock company, there seems no reason why "that company might not be registered under the same name as had previously been used in connection with the business."

Examples
of relief
granted.

Injunctions have been granted in *Hoby (The Grosvenor Library) v. Grosvenor Library, Limited* (28 W. R. 386); *Accident Insurance Co., Limited v. Accident, Disease, and General Insurance Co., Limited* ([1884] 54 L. J. Ch. 104); *Manchester Brewery Co. v. North Cheshire and Manchester Brewery Co.* ([1899] A. C. 83); *Guinea Coal Co. v. Pall Mall Guinea Coal Co.* ([1869] L. R. 5 Ch. 155, *Lee v. Haley*).

Examples
of relief
refused.

But relief was refused in *Army and Navy Co-operative Society, Limited v. Junior Army and Navy Stores, Limited* ([1879] Sebas. Dig. 393); *Australian Mortgage, Land, and Finance Co. v. Australian and New Zealand Mortgage Co.* (W. N., [1880] 6 C. A.); *Merchant Banking Co. of London v. Merchants' Joint Stock Bank* ([1878] 9 Ch. D. 560); *London Assurance v. London and Westminster Assurance Corporation* ([1863] 32 L. J. Ch. 664); *Daimler Motor Car Co., Limited v. Daimler Wagon Co., Limited* ([1901] 18 R. P. C. 465), and in several other cases. The *ratio decidendi* in these cases is that no one can obtain a monopoly in a name which merely describes the nature of the business, the locality of its operations, or a system of construction.

A proposal by the defendants to modify the style complained of will be entertained at the hearing, as in

Army and Navy Co-operative Society, Limited v. Army, Navy, and Civil Service Co-operative Society of South Africa ([1902] 19 R. P. C. 574). Here the defendants on appeal undertook to change their name to "Naval, Military, and Civil Service Co-operative Society of South Africa, Limited," and submitted to their appeal being dismissed.

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 in *Croft v. Day* ([1843] 7 Beav. 84) an injunction was obtained against a man of the name of Day who had associated himself with a person named Martin, and begun to sell blacking under the firm name of "Day & Martin."

Fraudulent
partner-
ship.

The Court has jurisdiction to protect foreign trading firms from improper assumption of their firm name in this country, even when the foreign plaintiff firm has no agency here. In *Panhard et Levassor v. Panhard Levassor Motor Co.* ([1901] W. N. 153) the defendants, an English registered company, were restrained from using the names of *Panhard and Levassor*, who were well-known motor car manufacturers in Paris.

Foreign
firms.

CHAPTER VIII.

THE CRIMINAL PROSECUTION.

THE MERCHANDISE MARKS ACTS, 1887, 1891, AND 1894.

Offences
under The
Merchan-
dise Marks
Act, 1897.

Block for
forging a
trade mark.

Offences.

FOLLOWING the Merchandise Marks Act of 1862, *The Merchandise Marks Act, 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.

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

OFFENCES.

2. (1) Every person who—

Forging a
trade mark.
Falsely
applying.

Making
block or die.

False
description.

- (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 | Selling or possessing printing block. |
| (f) Causes any of the things above in this section mentioned to be done. | 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 calculated to deceive, is falsely applied, as the case may be, shall, unless he proves—

Vendors offending must prove absence of guilty knowledge, and must assist prosecutor to discover real offenders.

(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;

he guilty of an offence against this Act.

PUNISHMENTS AND PENALTIES.

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

Punishments and penalties.

(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 His Majesty every chattel, article, instrument, or thing by means of or in relation to which the offence has been committed.

Definition
of "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 1901, following the Patents Acts of 1883 and 1888.

Innocent
retailer.

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.

Meaning of
"innocently."

But although he may have had no intent to defraud, a defendant is not on that account held to have acted "innocently." As Lord Coleridge said in *Wood v. Burgess* (L. R. 24 Q. B. D. 162), "An intent to defraud the purchaser is not a necessary ingredient of the offence charged." Thus a mineral water manufacturer who fills bottles bearing another manufacturer's name moulded thereon is not held to have acted "innocently," although he may have no intention to pass off the contents of the bottles as other than his own manufacture, or although he places his own label on the bottles. The cases dealing with the interpretation of the term "innocently" under the Statute are discussed by Porter, M. R., in the Irish case of *Thwaites v. McErilly* ([1903] 20 R. P. C. 663).

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.

Misapplying a genuine label.

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. A defendant may appeal to the Quarter Sessions, and if charged before a Court of summary jurisdiction he may elect to be tried on indictment.

Offences by engravers and lithographers.

Innocent engraver.

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.

Evidence.

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 High 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

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

decide the same issues that would arise in the Higher Courts. Such being the case, the evidence adduced by the prosecutor should be as full and based upon the same principles as would guide the plaintiff seeking an injunction in the High Court, as already explained in foregoing chapters.

Cases under
the Act.

An excellent example of a case of criminal prosecution under Section 2 of the Act, and founded upon the alleged fraudulent imitation and forgery of registered trade marks, was decided in 1893 at the London Central Criminal Court before the then Common Sergeant (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 cocoon 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).

*Reg. v.
Hughes.*

*Reg. v.
Ellinger.*

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 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 "Rupee Combination." This combination consisted of—

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 "Rupee 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 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.

Example of fraudulent imitation of combination trade mark.

Susceptibility of ultimate purchaser to deception.

The innocent retailer is usually tenderly dealt with if he can show that he has taken reasonable precautions or that otherwise he had acted innocently. In *Christie v. Cooper* (Div. Ct., [1900] 2 Q. B. 522) it was held that

Reasons for exonerating innocent retailer.

a person, albeit he had reason to suspect the genuineness of the trade mark, might, nevertheless, have acted innocently in selling the goods, and might therefore be exonerated under Section 2, Sub-section 2, of the Act.

Applying
false trade
description.

"Hand-
made
cigarette"
Case.

Although not strictly connected with trade marks it might be of use to notice one or two instances of applying a false trade description to goods. For example, in *Kirshenboim v. Salmon & Gluckstein* (Div. Ct., [1898] 2 Q. B. 19) cigarettes in fact machine made were represented as "hand made." It was held to be no defence that the machine made goods were of as good quality as the hand made, and the defendants were convicted. Apparently "false trade description" might be read "incorrect" trade description. But it has been held that to describe children's toy books as being made of "untearable linen" when in fact made of cotton did not constitute a trade description, which was false "in a material respect" (*Rea v. Stoneham*, "Daily Telegraph," 19th January, 1905).

False
description
need not be
actually
applied to
goods.

The false description need not be actually applied to goods. A false description in an invoice referring to the goods is within the Statute (*Budd v. Lucas*, Div. Ct., [1891] 1 Q. B. 408; *Coppen v. Moore*, Div. Ct., [1898] 2 Q. B. 300; *Cameron v. Wiggins*, Div. Ct., [1900] W. N. 253; [1901] 1 Q. B. 1). But the mere handing over of two half-pound packets of tea by a salesman in response to a demand by a purchaser, which packets contained less than the full weight, was held not to constitute an "application" to the goods of a false trade description of their weight within the Statute (*Langley v. Bombay Tea Co.*, Div. Ct., [1900] W. N. 141; [1900] 2 Q. B. 460).

Right of
defendant
to question
validity of
registra-
tion.

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. *Prima 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.

One of the amendments, made the 14th December, 1900, upon the terms of the International Convention of 1883, was to the following effect:—

Article X bis.—The subjects or citizens of the States parties to the Convention (Articles II. and III.) shall enjoy in all of the States of the Union the protection accorded to native subjects or citizens against dishonest competition, forging, and dishonest use of trade marks abroad.

Amend-
ment on
Inter-
national
Convention
limited by
Merchan-
dise Marks
Act, 1887.

This Article when adopted was accepted by the British Delegates subject to the following declaration:—

It is to be clearly understood that Great Britain will not be bound to give protection beyond that established by The Merchandise Marks Act, 1887, which is most stringent and complete.

The text of the Convention, with the new amendments (consolidated), will be found in Appendix A. The additional Article X. *bis.* ought to prove a useful weapon in the hands of those British manufacturers who have hitherto seen their trade marks forged and fraudulently applied in foreign countries, almost with impunity.

TRADE MARKS RULES, 1890, 1897, AND 1898

(CONSOLIDATED).

NOTE.—THE RULES REPEALED ARE PRINTED IN ITALICS. THE SUBSTITUTED RULES OF 1897 AND 1898 ARE IN HEAVIER TYPE.

BY VIRTUE of the provisions of The Patents, Designs, and Trade Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following Rules:—

PRELIMINARY.

Citation of Rules.

1. These Rules may be cited as “The Trade Marks Rules, 1890,” and shall come into operation from and immediately after the 31st day of December, 1889.

Note.—The Rules of 1897 and 1898 came into operation respectively on the 31st of December, 1897, and the 15th September, 1898.

INTERPRETATION.

Interpretation.

2. In the construction of these Rules any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively.

FEES.

Fees.

3. The fees to be paid in pursuance of the said Acts, so far as they relate to trade marks, shall be the fees specified in the First Schedule hereto.

FORMS.

Forms.

4. The Form F in the First Schedule to The Patents, Designs, and Trade Marks Act, 1883, shall be altered or amended by the substitution therefor of the Form F in the Second Schedule to these Rules.

5. (1) An application for registration of a trade mark shall be made in the Form F of the Second Schedule to these Rules. (2) The remaining forms in such Schedule may be used in all cases to which they are applicable.

CLASSIFICATION OF GOODS.

6. For the purposes of trade marks registration and of these Rules goods are classified in the manner appearing in the Third Schedule hereto. Classifica-
tion of
goods.

If any doubt arises as to what class any particular description of goods belongs, the doubt shall be determined by the Comptroller.

APPLICATION FOR REGISTRATION.

7. An application for registration of a trade mark, if made by any firm or partnership, may be signed by some one or more members of such firm or partnership, as the case may be. Application
by firm.

If the application be made by a body corporate, it may be signed by the Secretary or other principal officer of such body corporate.

8. Where a trade mark for registration of which application is made is in Classes 23, 24, or 25 of the Third Schedule to these Rules, the applicant shall address and send his application to the Manchester Trades Marks Branch, 48 Royal Exchange, Manchester. Other applications (except applications which under Section 81 of the said Acts should be made to the Cutlers' Company) shall be addressed and sent to the Patent Office, Trade Marks Branch, 25 Southampton Buildings, Chancery Lane, London, W.C. Address of
application.

9. *An application for registration and all other communications between the applicant and the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller.* Agency.

9. An application for registration and all other communications between the applicant and the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller, but the Comptroller shall not be bound to recognise as such agent, or to receive further communications from, any person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been Trade
Marks
Rules, 1898.

erased from the Register of Patent Agents kept under the provisions of The Patents, Designs, and Trade Marks Act, 1888, relating to the registration of Patent Agents, and not since restored.

Acknowledgment of application.

10. On receipt of the application the Comptroller shall furnish the applicant with an acknowledgment thereof.

Contents of form of application.

11. Where application is made to register a trade mark which was used by the applicant or his predecessors in business before the 13th of August, 1875, the application shall contain a statement of the time during which and of the person by whom it has been so used in respect of the goods mentioned in the application.

Size &c. of documents.

12. Subject to any other directions that may be given by the Comptroller, all applications, notices, counter-statements, representations of marks, papers having representations affixed, or other documents required by the said Acts or by these Rules to be left with or sent to the Comptroller or to the Cutlers' Company shall be upon foolscap paper of a size of 13 inches by 8 inches, and shall have on the left-hand part thereof a margin of not less than one inch and a half.

Representations of trade mark.
Repealed.

13. *Subject to any other directions that may be given by the Comptroller, three representations of each trade mark, except in the case of marks applied for in Classes 23 to 35 inclusive, must be supplied upon paper of the size aforesaid, and must be of a durable nature. One of such representations must be made upon or affixed to the form of application, the others upon separate half-sheets. In the case of trade marks exceeding the limits of the foolscap paper of the size aforesaid, such marks may be pasted and folded upon the sheets of foolscap.*

In the case of marks applied for in Classes 23 to 35 inclusive, the applicant shall supply four representations of each mark for each class.

Where a drawing or other representation or specimen cannot be given in manner aforesaid, a specimen or copy

of the trade mark may be sent either of full size or on a reduced scale, and in such form as the Comptroller may think most convenient.

The Comptroller may, if dissatisfied with the representation of a trade mark, require a fresh representation, either before he proceeds with the application or before he registers the trade mark.

The Comptroller may also, in exceptional cases, deposit in the Patent Office a specimen or copy of any trade mark which cannot conveniently be shown by a representation, and may refer thereto in the Register in such manner as he may think fit.

13. Every application for registration of a Trade Mark shall contain a representation of the mark affixed to it in the square which the Form F contains for that purpose.

Representations of Trade Marks.

Where the representation exceeds such square in size the representation shall be mounted upon linen, tracing cloth, or other material that the Comptroller may consider suitable. Part of the mounting shall be affixed in the space aforesaid and the rest may be folded over.

Trade Marks Rules, 1897.

With every application for registration sent to the Manchester Trade Marks Branch there shall be supplied four additional representations of each mark on the Form G, exactly corresponding with that on the Application Form F, and noted with all such particulars as may from time to time be required by the Comptroller or by the Keeper of Cotton Marks at Manchester. Such particulars shall, if required, be signed by the applicant or his agent.

In the case of marks applied for in any of the Classes 5, 6, 7, 11, 12, 13, 14, 22, 26, 27, 28, 29, 30, 31, 32, 33, 34, and 35 there shall be sent with the application four additional representations of each mark on the Form G, exactly corresponding with that affixed to the application in Form F, and noted with all such particulars as may from time to time be required by the Comptroller. Such particulars shall, if required, be signed by the applicant or his agent.

In the case of marks applied for in any other class there shall be sent with the application three additional representations of each mark on the Form G, exactly corresponding

to that affixed to the Application Form F, and noted with all such particulars as may from time to time be required by the Comptroller. Such particulars shall, if required, be signed by the applicant or his agent.

All representations of marks must be of a durable nature, but the applicant may in case of need supply in place of representations on the Form G half sheets of strong foolscap of the size aforesaid with the representations affixed thereon and noted as aforesaid.

Applications for the registration of the same mark in different classes shall be treated as separate and distinct applications.

The Comptroller, if dissatisfied with any representation of a mark, may at any time require another representation satisfactory to him to be substituted before proceeding with the application.

Where a drawing or other representation or specimen cannot be given in manner aforesaid, a specimen or copy of the trade mark may be sent either of full size or on a reduced scale, and in such form as the Comptroller may think most convenient.

The Comptroller may also, in exceptional cases, deposit in the Patent Office a specimen or copy of any trade mark which cannot conveniently be shown by a representation, and may refer thereto in the Register in such manner as he may think fit.

*Representa-
tion of a
series of
trade marks.*

Repeated.

14. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in Section 66 of the said Acts, a representation of each trade mark of the series shall be made or affixed upon the form of application, and also upon each of the separate half-sheets of paper aforesaid.

**Trade
Marks
Rules, 1907.**

14. When application is made for the registration of a series of trade marks under Section 66 of The Patents, Designs, and Trade Marks Act, 1883, a representation of each trade mark of the series shall be affixed, as aforesaid, to the application upon Form F, and to each of the accompanying Forms G.

15. *Whenever a mark consist of or includes words printed in other than Roman character, there shall be given at the foot or on the back of each representation a translation of such words signed by the applicant or his agent.* *Translation of foreign characters.
Repeated.*

15. When a trade mark contains a word or words in other than Roman characters, there shall be endorsed on the application in Form F, and on each of the accompanying representations in Form G, a sufficient transliteration and translation to the satisfaction of the Comptroller of each of such words, and every such endorsement shall be signed by the applicant or his agent. **Trade
Marks
Rules, 1897.**

Where a trade mark contains a word or words in a language other than English, the Comptroller may ask for an exact translation thereof, and if he so requires such translation shall be endorsed and signed as aforesaid.

16. Any application, statement, notice, or other document authorised or required to be left, made, or given at the Patent Office, or to the Comptroller, or to any other person under these Rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post. *Mode of
sending
notices &c.*

In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

EXERCISE OF DISCRETIONARY POWERS.

17. Before exercising any discretionary power given to the Comptroller by the said Acts adversely to the applicant for registration of a trade mark, the Comptroller shall (if so required by the applicant within one month from the date of the Comptroller's objection) give the applicant an opportunity of being heard personally or by his agent by sending the applicant ten days' notice of a time when he may be so heard. *Hearing by
Comp-
troller.*

Notice of
wish to be
heard
before
Comp-
troller.

18. Within five days from the date when such notice would be delivered in the ordinary course of post the applicant shall notify to the Comptroller whether or not he intends to be heard upon the matter.

Notification
of decision.

19. The decision of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified to the applicant.

APPEAL TO THE BOARD OF TRADE.

Notice of
appeal.

20. When any person intends to appeal to the Board of Trade from a decision of the Comptroller in any case in which an appeal is given by the said Acts, he shall, within one month from the date of the decision appealed against, leave at the Patent Office, Trade Marks Branch, a notice of such his intention.

Grounds of
appeal to
be stated.

21. Such notice shall be accompanied by a statement in writing of the grounds of appeal, and of the appellant's case in support thereof.

Trans-
mission of
notice.

22. A copy of the notice of intention to appeal, accompanied by a statement of the case, shall also be forthwith sent to the Secretary of the Board of Trade, No. 7 Whitehall Gardens, London; and where there has been an opposition before the Comptroller, to the opponent or applicant as the case may be.

Directions
by Board.

23. The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to evidence, or otherwise, for the purpose of the hearing of the appeal by the Board of Trade, or for the purpose of their referring the appeal to the Court to hear and determine the same.

Hearing of
appeal.

24. Where the Board of Trade intend to hear the appeal, seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing, shall be given to the Comptroller and to the appellant, and where there has been an opposition before the Comptroller to the opponent or applicant as the case may be.

No appeal
unless
notice duly
given.

25. No appeal shall be entertained of which notice has not been given within one month from the date of the

decision appealed against, or such further time as the Comptroller may allow, except by special leave of the Board of Trade.

26. Subject to the directions and leave of the Board of Trade, the evidence to be used on an appeal to the Board of Trade in the matter of an opposition shall be the same as that used at the hearing before the Comptroller.

Evidence
on appeal.

ADVERTISEMENT OF APPLICATION.

27. Every application shall be advertised by the Comptroller in the official paper during such times and in such manner as the Comptroller may direct, unless he refuse to entertain the application.

Advertise-
ment of
application.

If no representation of the trade mark be inserted in the official paper in connection with the advertisement of an application the Comptroller shall refer in such advertisement to the place or places where a specimen or representation of the trade mark is deposited for exhibition.

28. The official paper for the purposes of these Rules shall be some paper published under the direction of the Board of Trade, or such other paper as such Board may from time to time direct.

Definition
of official
paper.

29. For the purposes of such advertisement the applicant may be required to furnish a wood block or electrotpe (or more than one, if necessary) of the trade mark, of such dimensions as may from time to time be directed by the Comptroller, or with such other information or means of advertising the trade mark as may be required by the Comptroller; and the Comptroller, if dissatisfied with the block or electrotpe furnished by the applicant or his agent, may require a fresh block or electrotpe before proceeding with the advertisement.

Means of
advertising
trade mark
to be sup-
plied to
official
paper.

30. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in Section 66 of the said Acts, the applicant may be required to furnish a wood block or electrotpe (or more than one, if necessary) of any or of each of the trade marks constituting the series; and the Comptroller may, if he thinks fit, insert with

Advertise-
ment of
series.

the advertisement of the application a statement of the manner in respect of which the several trade marks differ from one another.

OPPOSITION TO REGISTRATION.

Notice of
opposition.

31. (1) A notice of opposition to the registration of a trade mark shall state the ground or grounds on which the opponent intends to oppose the registration, and be signed by him or by his solicitor, and shall also contain an address for service in the United Kingdom, and shall be in the Form J in the Second Schedule to these Rules, with such variations as circumstances may require.

Opposition
on the
ground of
trade mark
already
on the
Register.

(2) Where the ground or one of the grounds of opposition is that the applicant is applying for the registration of a trade mark identical with one already on the Register with respect to the same goods or description of goods, or having such resemblance to a trade mark already on the Register with respect to such goods or description of goods as to be calculated to deceive, the notice shall state the date of registration, and the number on the Register of such trade mark already on the Register.

Opponent's
evidence.

(3) Within two months after the expiration of one month or such further time not exceeding three months as the Comptroller may allow from the date of the advertisement of the application the opponent shall leave at the Patent Office, Trade Marks Branch, his evidence by way of statutory declaration as he may desire to adduce in support of his opposition, and deliver to the applicant copies thereof.

Applicant's
evidence.

(4) ¹ Within one month from the delivery of the opponent's copies of his statutory declarations the applicant shall leave at the Patent Office, Trade Marks Branch, his evidence by way of statutory declaration in answer, and deliver to the opponent copies thereof, and within seven days from such delivery, the opponent shall

Evidence in
reply.

¹ The counter-statement required by the Acts must also be delivered by the applicant within one month from the date of the receipt of the opponent's notice of opposition (Section 69, Subsection 2).

leave at the Patent Office, Trade Marks Branch, his evidence by way of statutory declaration in reply, and deliver to the applicant copies thereof. Such last-mentioned evidence shall be confined to matters strictly in reply.

(5) No further evidence shall be left on either side except by leave of the Comptroller upon the written consent of the parties duly notified to him, or by special leave of the Comptroller given on an application made to him.

Closing of evidence.

(6) Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

Applications for leave to adduce further evidence.

(7) On the completion of the evidence the Comptroller shall, upon application by either party, upon Form E in the Second Schedule to these Rules, and upon payment of the prescribed fee, appoint a time for the hearing of the case, and shall give the parties at least seven days' notice of such appointment.

Appointment of time for hearing.

(8) On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition, and where the ground or one of the grounds of opposition is that registration is being applied for in respect of a trade mark identical with one already on the Register with respect to the same goods or description of goods, or having such resemblance to a trade mark already on the Register with respect to such goods or description of goods as to be calculated to deceive, the opposition shall not be allowed upon such ground, unless the date of registration and the number on the Register of the said trade mark already on the Register have been duly specified in the notice of opposition.

Disallowance of opposition in certain cases.

(9) The decision of the Comptroller in the case shall be notified to the parties.

Decision to be notified to parties.

REGISTER OF TRADE MARKS.

32. As soon as may be after the expiration of one month from the date of the advertisement of the application, the Comptroller shall, subject to opposition to the application

Time of registration of trade marks.

and the determination thereof, if he is satisfied that the applicant is entitled to registration, and on payment of the prescribed fee, enter the name, address, and description of the applicant in the Register of Trade Marks as the registered proprietor of the trade mark in respect of the particular goods or classes of goods described in his application.

Where applicant dies before registration, the trade mark may be registered for successor to goodwill of business.

33. In case of the death of any applicant for a trade mark after the date of his application, and before the trade mark applied for has been entered on the Register, the Comptroller, after the expiration of the prescribed period of advertisement, may, on being satisfied of the applicant's death, enter on the Register, in place of the name of such deceased applicant, the name, address, and description of the person owning the goodwill of the business, if such ownership be proved to the satisfaction of the Comptroller.

Entries to be made in Register.

34. Upon registering any trade mark the Comptroller shall enter in the Register the date on which the application for registration was received by the Comptroller, and such other particulars as he may think necessary.

Notice of registration.

35. The Comptroller shall send notice to the applicant of the registration of his trade mark, together with a reference to the advertisement of such trade mark in the official paper.

Request by subsequent proprietor.

36. Where a person becomes entitled to a registered trade mark by assignment, transmission, or other operation of law, a request for the entry of his name in the Register as proprietor of the trade mark shall be addressed to the Comptroller, and left at the Patent Office, Trade Marks Branch.

Signature of request.

37. Such request shall in the case of an individual be made and signed by the person requiring to be registered as proprietor, and in the case of a firm or partnership by some one or more members of such firm or partnership, or in either case by his or their agent respectively, duly authorised to the satisfaction of the Comptroller, and in the case of a body corporate by their agent, authorised in like manner.

38. Every such request shall state the name, address, and description of the person claiming to be entitled to the trade mark (hereinafter called "the claimant"), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the Register as proprietor, so as to show the manner in which, and the person or persons to whom, the trade mark has been assigned or transmitted, and so as to show further that it has been so assigned or transmitted in connection with the goodwill of the business concerned in the particular goods or classes of goods for which the trade mark has been registered. Contents of request.
39. Every such request shall be accompanied by a statutory declaration, to be thereunder written, verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the trade mark as claimed by such request. Declaration to accompany request.
40. The claimant shall furnish to the Comptroller such other proof of title and the existence and ownership of such goodwill as aforesaid as he may require for his satisfaction. Further proof of title if required.
41. A body corporate may be registered as proprietor by its corporate name. Body corporate.
42. The term "applicant" in Rules 17, 18, and 19 shall include each of several persons claiming to be registered as proprietor of the same trade mark. Definition of "applicant."
43. Whether all such persons so claiming require to be heard before the Comptroller or not, he may, before exercising the discretion vested in him by Section 71 of the said Acts, require such persons, or any or either of them, to submit a statement in writing within a time to be notified by him, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require. Comptroller may require statement from rival claimants.
44. Where each of several persons claims to be registered as proprietor of the same trade mark, and the Comptroller refuses to register any of them until their rights have been determined according to law, the manner in which the rights of such claimants may be submitted to Submission to Court of conflicting claims.

the Court by the Comptroller, or, if the Comptroller so require, by the claimants, shall, unless the Court otherwise order, be by a special case; and such special case shall be filed and proceeded with in like manner as any other special case submitted to the Court, or in such other manner as the Court may direct.

Settlement
of special
case.

45. Where the special case is to be submitted by the parties it may be agreed to by them, or, if they differ, may be settled by the Comptroller on payment of the prescribed fees.

Order of
Court.

46. Where an order has been made by the Court in either of the following cases: viz.—

- (a) Allowing an appeal under Section 62 of the said Acts;
- (b) Disallowing an opposition to registration under Section 69; or
- (c) Under the provisions of Sections 72, 90, or 92 of the said Acts,

the person in whose favour such order has been made, or such one of them, if more than one, as the Comptroller may direct, shall forthwith leave at the Patent Office, Trade Marks Branch, an office copy of such order. The Register shall thereupon be rectified or altered, or the purport of such order shall otherwise be duly entered in the Register, as the case may be.

Removal of
mark from
Register.

47. Where a trade mark has been removed from the Register for nonpayment of the prescribed fee or otherwise, under the provision of Section 79 of the said Acts, the Comptroller shall cause to be entered in the Register a record of such removal and the cause thereof.

Alteration
of address
in Register.

48. If the registered proprietor of a trade mark send to the Comptroller, together with the prescribed fee, notice of an alteration in his address, the Comptroller shall alter the Register accordingly.

Notice to
Comptroller of
applications
to rectify
Register.

49. Four clear days' notice of every application to the Court under Section 90 of the said Acts, for rectification of the Register, shall be given to the Comptroller.

50. Whenever an order is made by the Court for making, expunging, or varying an entry from or in the Register, the Comptroller shall, if he thinks that such rectification or variation should be made public, and at the expense of the person applying for the same, publish, by advertisement or otherwise, and in such manner as he thinks just, the circumstances attending the rectification or variation in the Register.

Publication
of rectifica-
tion or
variation of
Register.

51. Whenever the registered proprietor of any trade mark intends to apply for the leave of the Court to add to or to alter such trade mark, under Section 92 of the said Acts, the notice to be given to the Comptroller shall be given fourteen days at least before such application. If leave be granted on such application, the applicant shall forthwith supply to the Comptroller such a number of representations of the trade mark, as altered, as he may deem sufficient.

Notice
to Comp-
troller of
Order of
Court for
alteration
of trade
mark under
Section 92
of Acts.

INSPECTION OF REGISTER.

52. The Register of Trade Marks shall be open to the inspection of the public, on payment of the prescribed fee, on every week-day, between the hours of ten and four, except on the days and at the times following:—

Hours of
inspection.

- (a) Christmas Day, Good Friday, the day observed as Her Majesty's birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England; or
- (b) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office;
- (c) Times when the Register is required for any purpose of official use.

POWER TO DISPENSE WITH EVIDENCE.

53. Where under these Rules any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Comptroller, or at the Patent Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to

Dispensing
with
evidence.

do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence.

AMENDMENTS.

Amendment of documents.

54. Any document or drawing or other representation of a trade mark for the amending of which no special provision is made by the said Acts may be amended, and any irregularity in procedure which in the opinion of the Comptroller may be obviated without detriment to the interests of any person may be corrected, if the Comptroller think fit, and on such terms as he may direct.

ENLARGEMENT OF TIME.

Comptroller may enlarge time.

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

CUTLERS' COMPANY.

Sheffield applications in duplicate.

56. All applications to the Cutlers' Company for registration of a trade mark, under Section 81 of the said Acts, shall be in duplicate, accompanied by the prescribed fees and representations.

Notice to Comptroller.

57. The Cutlers' Company shall, within seven days of the receipt by them of an application to register a trade mark, send the Comptroller one copy of such application, by way of notice thereof, together with two representations of the mark for each class for which the applicant seeks registration.

Time within which Comptroller may object to application made at Sheffield.

58. (1) The time within which the Comptroller shall give notice to the Cutlers' Company of any objection he may have to the acceptance of an application for registration made to the said Company shall be one month from the date of the receipt by the Comptroller of the notice from the said Company of the making of the application.

(2) If no such objection is made by the Comptroller, the Cutlers' Company shall require the applicant to send the Comptroller a wood block or electrotpe as the Comptroller may direct, and the Comptroller shall, if satisfied with such wood block or electrotpe, advertise the application in the same manner as an application made to him at the Patent Office.

Advertise-
ment of
application
made at
Sheffield.

(3) The manner in which the Comptroller shall notify to the Cutlers' Company an application and proceedings thereon made as mentioned in Sub-section 8 of Section 81 of the said Acts shall be by sending to the Cutlers' Company a copy of the official paper containing the application of which notice is required to be given, with a note distinguishing such application.

Manner of
notifying to
Cutlers'
Company
application
received by
Comp-
troller.

59. The provisions of these Rules as to forms, representations, the proceedings on opposition to registration, registration, and all subsequent proceedings shall, as, far as the circumstances allow, apply to all applications to register made to the Cutlers' Company, and to all proceedings consequent thereon.

Similarity
of pro-
ceedings at
London and
Sheffield.

CERTIFICATES.

60. The Comptroller, when required to give a certificate as to any entry, matter, or thing which he is authorised by the said Acts or any of these Rules to make or do, may, on receipt of a request in writing and on payment of the prescribed fee, give such certificate, but every certificate of registration shall have specified on the face thereof whether the same is to be used in legal proceedings, or for the purpose of obtaining registration in a foreign country, or for purposes other than use in legal proceedings or obtaining registration in a foreign country.

Certificate
by Comp-
troller.

DECLARATIONS.

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

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

(a) In the United Kingdom before any justice of the peace or any commissioner, or other officer

authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding.

- (b) In any other part of Her Majesty's dominions before any Court, Judge, Justice of the Peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and
- (c) If made out of Her Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or a Notary Public, or before a Judge or Magistrate.

Notice of
seal of
officer
taking
declaration
to prove
itself.

62. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorised to take such declaration in testimony of such declaration having been made and subscribed before him, may be admitted by the Comptroller without proof of the genuineness of any such seal or signature, or of the official character of such person or his authority to take such declaration.

REPEAL.

Previous
Rules
repealed.

63. All general Rules as to the registration of trade marks heretofore made by the Board of Trade under The Patents, Designs, and Trade Marks Acts, 1883 to 1888, and in force on the 31st day of December, 1889, shall be, and they are hereby repealed, as from that date, without prejudice, nevertheless, to anything done under such Rules, or to any application pending at the said date.

M. E. HICKS-BEACH,

President of the Board of Trade.

FIRST SCHEDULE.

F E E S.

1. On application to register a trade mark for one or more articles included in one class	(Form F)	£	s.	d.
		0	5	0
2. For registration of a trade mark for one or more articles in one class	(Form I)	1	0	0
3. For registering a series of trade marks, for every additional representation after the first in each class		0	5	0
4. On appeal from Comptroller to Board of Trade—by appellant	(Form H)	1	0	0
5. On notice of opposition for each application opposed—by opponent	(Form J)	1	0	0
6. On hearing by Comptroller—by applicant and by opponent respectively	(Form E)	1	0	0
7. On application to register a subsequent proprietor in cases of assignment or transmission, the first mark	(Form K)	1	0	0
8. For every additional mark assigned or transmitted at the same time		0	2	0
9. For continuance of mark at expiration of 14 years	(Form X)	1	0	0
10. Additional fee where fee is paid within three months after expiration of 14 years ...	(Form Y)	0	10	0
11. Additional fee for registration of trade mark where removed for nonpayment of fee ...	(Form Z)	1	0	0
12. For altering address on the Register, for every mark	(Form M)	0	5	0

	£	s.	d.
13. For every entry in the Register of a rectification thereof or an alteration therein, not otherwise charged (Form N)	0	10	0
14. For cancelling the entry or part of the entry of a trade mark upon the Register, on the application of the owner of such trade mark ... (Form O)	0	5	0
15. On request to Comptroller to correct a clerical error, or permit amendment of application under Section 91 (Form Q)	0	5	0
16. For certificate of refusal to register a trade mark under Section 77 (Form L)	1	0	0
17. For certificate of refusal at the same time for more than one trade mark, for each additional trade mark after the first (Form I)	0	10	0
18. For certificate of registration to be used in legal proceedings (Form S)	1	0	0
19. For certificate of registration to be used for the purpose of obtaining registration in foreign countries (Form R)	0	5	0
20. For certificate of Comptroller under Section 96, other than certificate of registration to be used in legal proceedings, or for the purpose of obtaining registration in a foreign country ... (Form T ⁿ)	0	5	0
21. For copy of notification of registration	0	2	0
22. Settling a special case by Comptroller ... (Form T)	2	0	0
23. For inspecting Register, for every quarter of an hour	0	1	0
24. For making a search amongst the classified representations of trade marks, for every quarter of an hour... ..	0	1	0
25. For office copy of documents, for every 100 words (but never less than one shilling)	0	0	4
26. For certifying office copies, MS. or printed ...	0	1	0

27. In cases where the wood block or electrotpe of	£	s.	d.
the trade mark exceeds two inches in breadth or			
depth, or in breadth and depth—For every inch			
or part of an inch over two inches in breadth	...	0	2 0
For every inch or part of an inch over two inches			
in depth	...	0	2 0
28. Manchester Trade Marks Office	...	0	2 0
29. Sheffield Marks	...	0	2 0
30. On appeal from Cutlers' Company, Sheffield, to			
Comptroller	...	1	0 0

M. E. HICKS-BEACH,

President of the Board of Trade.

Approved: FRANK MOWAT,

*Assistant Secretary for the Lords Commissioners of
Her Majesty's Treasury.*

SECOND SCHEDULE.

FORMS.

This Schedule contains the various Forms under the Rules. Printed and stamped copies of the Forms are on sale at most Post Offices and Law Stationers. To save space the Forms are not set out here, but, as a guide, the identifying letters of the principal Forms have been annexed to the corresponding fees in the foregoing First Schedule.

THIRD SCHEDULE.

GENERAL NOTE.—Any Wares made of mixed materials (for example, of both Cotton and Silk) shall be included in such one of the classes appropriated to those materials as the Comptroller may desire.

CLASSIFICATION OF GOODS.

NOTE.—The goods referred to in the following classes are mentioned by way of illustration, and not as an exhaustive list of the contents of the class.

CLASS 1.—Chemical Substances used in Manufactures, Photography, or Philosophical Research, and Anti-corrosives. Such as Acids, including vegetable acids; Alkalies; Artists' Colours; Pigments; Mineral Dyes.

CLASS 2.—Chemical Substances used for Agricultural, Horticultural, Veterinary, and Sanitary purposes. Such as Artificial Manure; Cattle Medicines; Deodorisers; Vermin Destroyers.

CLASS 3.—Chemical Substances prepared for use in Medicine and Pharmacy. Such as Cod Liver Oil; Medicated Articles; Patent Medicines; Plasters; Rhubarb.

CLASS 4.—Raw or partly prepared Vegetable, Animal, and Mineral Substances used in Manufactures not included in other classes. Such as Resins; Oils used in Manufactures and not included in other classes; Dyes, other than Mineral; Tanning Substances; Fibrous Substances (*e.g.* Cotton, Hemp, Flax, Jute); Wool; Silk; Bristles; Hair; Feathers; Cork; Seeds; Coal; Coke; Bone; Sponge.

CLASS 5.—Unwrought and partly wrought Metals used in manufacture. Such as Iron and Steel—pig or cast. Iron—Rough; Bar and Rail, including rails for railways; Bolt and Rod; Sheet, and Boiler and Armour Plates; Hoop. Lead—Pig; Rolled; Sheet. Wire; Copper; Zinc; Gold, in ingots.

CLASS 6.—Machinery of all kinds, and parts of Machinery, except Agricultural and Horticultural Machines included in Class 7. Such as Steam Engines; Boilers; Pneumatic Machines; Hydraulic Machines; Locomotives; Sewing Machines; Weighing Machines; Machine Tools; Mining Machinery; Fire Engines.

CLASS 7.—Agricultural and Horticultural Machinery, and parts of such Machinery. Such as Ploughs; Drilling Machines; Reaping Machines; Thrashing Machines; Churns; Cyder Presses; Chaff Cutters.

CLASS 8.—Philosophical Instruments, Scientific Instruments, and Apparatus for useful purposes; and Instruments and Apparatus for Teaching. Such as Mathematical Instruments; Gauges; Logs; Spectacles; Educational Appliances.

CLASS 9.—Musical Instruments.

CLASS 10.—Horological Instruments.

CLASS 11.—Instruments, Apparatus, and Contrivances, not Medicated, for Surgical or Curative purposes, or in relation to the Health of Men or Animals. Such as Bandages; Friction Gloves; Lancets; Fleams; Enemas.

CLASS 12.—Cutlery and Edge Tools. Such as Knives; Forks; Scissors; Shears; Files; Saws.

CLASS 13.—Metal Goods not included in other classes. Such as Anvils; Keys; Basins (metal); Needles; Hoes; Shovels; Corkscrews.

CLASS 14.—Goods of Precious Metals (including Aluminium, Nickel, Britannia Metal, &c.) and Jewellery, and Imitations of such Goods and Jewellery. Such as Plate; Clock Cases and Pencil Cases of such metals; Sheffield and other Plated Goods; Gilt and Ormolu Work.

CLASS 15.—Glass. Such as Window and Plate Glass; Painted Glass; Glass Mosaic; Glass Beads.

CLASS 16.—Porcelain and Earthenware. Such as China; Stoneware; Terra Cotta; Statuary Porcelain; Tiles; Bricks.

CLASS 17.—Manufactures from Mineral and other Substances for Building or Decoration. Such as Cement; Plaster; Imitation Marble; Asphalt.

CLASS 18.—Engineering, Architectural, and Building Contrivances. Such as Diving Apparatus; Warming Apparatus; Ventilating Apparatus; Filtering Apparatus; Lighting Contrivances; Drainage Contrivances; Electric and Pneumatic Bells.

CLASS 19.—Arms, Ammunition, and Stores not included in Class 20. Such as Cannon; Small-arms; Fowling-pieces; Swords; Shot and other Projectiles; Camp Equipage; Equipments.

CLASS 20.—Explosive Substances. Such as Gunpowder; Gun-cotton; Dynamite; Fog Signals; Percussion Caps; Fireworks; Cartridges.

CLASS 21.—Naval Architectural Contrivances and Naval Equipments not included in Classes 19 and 20. Such as Boats; Anchors; Chain Cables; Rigging.

CLASS 22.—Carriages. Such as Railway Carriages; Waggons; Railway Trucks; Bicycles; Bath Chairs.

CLASS 23.—(a) Cotton Yarn, and Sewing Cotton not on spools or reels. (b) Sewing cotton on spools or reels.

CLASS 24.—Cotton Piece Goods of all kinds. Such as Cotton Shirtings; Long Cloth.

CLASS 25.—Cotton Goods not included in Classes 23, 24, or 26. Such as Cotton Lace; Cotton Braids; Cotton Tapes.

CLASS 26.—Linen and Hemp Yarn and Thread.

CLASS 27.—Linen and Hemp Piece Goods.

CLASS 28.—Linen and Hemp Goods not included in Classes 26, 27, and 50.

CLASS 29.—Jute Yarns and Tissues, and other Articles made of Jute not included in Class 50.

CLASS 30.—Silk, spun, thrown, or sewing.

CLASS 31.—Silk Piece Goods.

CLASS 32.—Other Silk Goods not included in Classes 30 and 31.

CLASS 33.—Yarns of Wool, Worsted, or Hair.

CLASS 34.—Cloths and Stuffs of Wool, Worsted, or Hair.

CLASS 35.—Woollen and Worsted and Hair Goods not included in Classes 33 and 34.

CLASS 36.—Carpets, Floorcloth, and Oilcloth. Such as Drugget; Mats and Matting; Rugs.

CLASS 37.—Leather, Skins unwrought and wrought, and Articles made of Leather not included in other classes. Such as Saddlery; Harness; Whips; Portmanteaus; Furs.

CLASS 38.—Articles of Clothing. Such as Hats of all kinds; Caps and Bonnets; Hosiery; Gloves; Boots and Shoes; other Ready-made Clothing.

CLASS 39.—Paper (except Paper-hangings), Stationery, and Book-binding. Such as Envelopes, Sealing Wax, Pens (except gold pens), Ink, Playing Cards, Blotting Cases, Copying Presses.

CLASS 40.—Goods manufactured from India-rubber and Gutta-percha not included in other classes.

CLASS 41.—Furniture and Upholstery. Such as Paper-hangings; Papier-mâché; Mirrors; Mattresses.

CLASS 42.—Substances used as Food or as ingredients in Food. Such as Cereals, Pulses, Olive Oil, Hops, Malt, Dried Fruits, Tea, Sago; Salt, Sugar, Preserved Meats, Confectionery, Oil-cakes, Pickles, Vinegar, Beer Clarifiers.

CLASS 43.—Fermented Liquors and Spirits. Such as Beer; Cider; Wine; Whisky; Liqueurs.

CLASS 44.—Mineral and Aërated Waters, natural and artificial, including Ginger-beer.

CLASS 45.—Tobacco, whether manufactured or unmanufactured.

CLASS 46.—Seeds for Agricultural and Horticultural purposes.

CLASS 47.—Candles, Common Soap, Detergents; illuminating, heating, or lubricating Oils; Matches, and Starch, Blue, and other Preparations for Laundry purposes. Such as Washing Powder; Benzine Collas.

CLASS 48.—Perfumery (including Toilet Articles, Preparations for the Teeth and Hair, and Perfumed Soap).

CLASS 49.—Games of all kinds and Sporting Articles not included in other classes. Such as Billiard Tables; Roller Skates; Fishing Nets and Lines; Toys.

CLASS 50.—Miscellaneous.—(1) Goods manufactured from Ivory, Bone, or Wood not included in other classes. (2) Goods manufactured from Straw or Grass not included in other classes. (3) Goods manufactured from Animal and Vegetable substances not included in other classes. (4) Tobacco Pipes. (5) Umbrellas, Walking-sticks, Brushes, and Combs. (6) Furniture Cream, Plate Powder. (7) Tarpaulins, Tents, Rickcloths. Rope, Twine. (8) Buttons of all kinds, other than of precious metal or imitations thereof. (9) Packing and Hose of all kinds. (10) Goods not included in the foregoing classes.

(Signed) M. E. HICKS-BEACH,

President of the Board of Trade.

PART III.

COPYRIGHT IN DESIGNS.

CHAPTER I.

INTRODUCTION.

THE protection of Designs applicable to manufactured articles is by no means a thing of absolutely modern creation. It is true that prior to 1787 no such thing as legal proprietorship in a design existed; but when at that date the Legislature awoke to the desirability of creating such proprietorship, it never ceased from time to time to improve and enlarge upon the original measure, the immediately beneficial effects of which were no doubt at once apparent. The proofs of its interest are to be found in the fact that between 1787 and the date of the present Statute not less than twelve enactments were passed relating to the protection of designs, the bulk of these Acts being indicated in the Third Schedule of the present Act of 1883.

Originally
no pro-
prietorship
in designs.

The first in 1787 (27 Geo. III. c. 38) seems to have been of a tentative nature, seeing that it was limited to expire at the end of the succeeding parliamentary session. By its terms, designs applicable to printed linens, cottons, calicoes, and muslins were copyrightable by their proprietors for two months from the date of first publication.

First
Designs
Act, 1787.

In 1794, by an amending Act (34 Geo. III. c. 23), the former Act was made perpetual, and the term of two months was extended to three. By a further Act passed in 1839 (2 Vict. c. 13) the provisions of the original Act were made to include textile fabrics of wool, silk, and hair,

Amending
Acts, 1794
and 1839.

Extension to Ireland.	or mixtures of linen, cotton, wool, silk, and hair, the operation of the Act being at the same time extended to Ireland in addition to England and Scotland. An Act of the same year closely following the latter Act created a Register of Proprietors, and gave protection for twelve months from the date of registration. The Act at the same time extended the field of articles to which designs were applicable, and provided that designs in metal work were to be protected for three years instead of for twelve months.
Creation of Register of Proprietors.	
Metal work designs.	
Act of 1842.	Then followed the consolidating and amending Act of 1842 (5 & 6 Vict. c. 100), whereby the definition of designs and the methods of application, whether to the ornamentation or to the moulding or shaping of the article, were particularised. The different goods susceptible of treatment were classified, and, in addition to the recovery of penalties for piracy, the proprietor was given a right of action for damages.
Action for damages.	
Act of 1843.	The Act of 1843 (6 & 7 Vict. c. 65) introduced the feature of "useful designs" in articles of manufacture, the Registrar (whose office had been created by the preceding Act) being empowered to exercise his discretion as to what were "ornamental" and what were "useful" designs.
Useful designs.	
Act of 1850.	In 1850 an Act (13 & 14 Vict. c. 104) was passed providing for the registration of designs within the Sculpture Copyright Act, but the chief feature in this Act was the introduction of "provisional registration" of designs.
Provisional registration.	
Acts of 1858 to 1875.	Minor Acts followed in 1858, 1861, and 1865, extending and modifying in detail the previous Acts, and by the Act of 1875 (38 & 39 Vict. c. 93) the ministerial powers and duties of the Board of Trade and the custody of the Register were transferred to the Commissioners of Patents, who from the date of that Act administered the Designs Office.
Register entrusted to Commissioners of Patents.	
Patents, Designs, and Trade Marks Acts, 1883 to 1901.	Lastly, the whole of these prior Acts then surviving were repealed by the Patents, Designs, and Trade Marks Acts of 1883 to 1901, which, together with the Designs Rules, now regulate and govern the registration of designs.
Formerly two types of design:	The reader will thus note that, prior to the now subsisting Acts of 1883 to 1901, 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.

“orna-
mental”
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.

Distinction
now
abolished.

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 disregard all reference to the useful effect, if any such exists.

Utility not
considered.

Thus, in *Hecla Foundry Co. v. Walker, Hunter & Co.* ([1889] 6 R. P. C. 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.

*Hecla
Foundry
v. Walker.*

The propriety of this view has never since been doubted, and in *re Morton's Design* ([1900] 17 R. P. C. 117) Mr. Justice Farwell, when the question of utility was raised, said: “What you have to see is whether, tested by the eye, the design is novel or original within the meaning of the

The only
test is that
of novelty
and origi-
nality.

Act. 'That it may be useful seems to me to be immaterial, because I think it must be admitted that however useless a novel design may be, it would still be within the meaning of the Act if it were novel or original.'

This goes a long way towards clearing the decks for a proper comprehension of the present Act, and makes plain the fundamental principle that under the present Statute the old and familiar differences between ornamental and useful designs, with all the considerations that flowed from these differences, are abolished and done away with.

There must be a recognisable difference from something done before.

Practically speaking, in the eye of the Act a novel and original design simply means something in the decoration, shape, or appearance of an article different to a sufficiently appreciable extent from anything publicly done before in the same article or class of article. Those of the succeeding pages which are devoted to the consideration of actual examples will show how small a difference may constitute a valid and registrable design. By means of these examples it is hoped the significance of the word "design" within the Act may become apparent. To discuss the larger and more abstract meaning of the term is not within the province of these pages.

Following the convenient arrangement of the two preceding divisions of this work, the remaining chapters will deal successively with the Procedure in Registering Designs, including a reference to the Register; the Persons Qualified to Register; the Subject-Matter of Designs; Novelty; Marking; the Action for Infringement, and the Rectification of the Register.

CHAPTER II.

PROCEDURE IN REGISTERING DESIGNS.

THE procedure in registering designs is simplicity itself, and the scope of this chapter will be limited to bringing together, condensing, and classifying the information scattered throughout the Act, the Board of Trade Rules, and the Comptroller's instructions.

Procedure
in
registering.

Stamped forms of application to register, price 10s. in Classes 1 to 12 (except for lace), and 1s. in Classes 13 and 14, and also for lace designs, can be obtained at the chief post-offices of most important towns. It has not been considered necessary to print the forms in this work. By following the marginal instructions on the application form "E," no mistake need be made by the applicant in filling in the particulars. The only part of the form that calls for the exercise of judgment is that where the applicant is directed to state the nature of the design, and "whether it is applicable for the pattern or for the shape." The latest instructions issued by the Patent Office require that the statement of the nature of the design shall particularise whether it is applicable for "the pattern" or for "the shape or configuration" or for "the ornament," these more extended terms being drawn from Section 60 of the Act. It may be taken that the terms "pattern" and "ornament" are, in many cases, practically synonymous. If any difference is to be recognised, "pattern" may be taken to refer to repeat designs, such as checks, stripes, or combinations of that description, or floral or other repeat devices which are usually employed to decorate window-curtains, calicoes, carpets, wall-papers, and the like; while "ornament" would more fitly apply to ornamental tracery or designs upon metal articles or picture frames, or furniture, or goods, or utensils such as cutlery or china. Lace designs (in Class 9) are classified as "patterns," and the lace design application forms, E¹ and O¹, which appear in the set of Rules which came

Application
forms.

Statement
of nature of
design.

Pattern,
shape or
configura-
tion, or
ornament.

Pattern.

Ornament.

Shape or
configura-
tion.

Short
description
of object
might be
added.

Copies of
design.

Signature
of
applicant
or agent.

into operation on the 30th of November, 1893, contain a statement that "the nature of the design is the pattern." It may be noted that these latest application forms for lace request the Comptroller to register the accompanying design "without search." "Shape or configuration" evidently refers more particularly to manufactured objects and articles in the round, and relates to general outline rather than to surface decoration. The term would properly describe a design for a tombstone, or a chair, or a lamp-stand, and each of these might combine ornament with it, as set forth in Section 60.

When thought to be necessary, a short technical description of the article may be added, with the part or parts which are claimed as new or original specifically defined. The form is signed by the applicant or his authorised agent and dated, and is then ready for filing. The application form should be accompanied by three exactly similar drawings, photographs, or specimens of the design. The drawings, photographs, tracings, or specimens should be mounted on foolscap sheets of paper of the same size as Form E (13 in. by 8 in.). Rough sketches or unfixed pencil drawings will not be accepted. When the design refers to the shape or configuration, two or more views of the object may be given, if such should be necessary, to convey a correct impression of the design. Both views should be on the same half-sheet of foolscap. Each drawing or specimen of a design in Classes 13 and 14 should show the complete pattern and a portion of the repeat, and ought not to be of less size than 7 in. by 3 in. When specimen cuttings of the design are furnished instead of drawings, they must be of a nature that will permit of their being pasted into books. The drawings or mounted specimens should be signed by the applicant or his agent.

When the papers have been thus completed they should be delivered or sent by post to—

The Comptroller,

Patent Office (Designs Branch),

25 Southampton Buildings,

Chancery Lane,

London, W.C.

The goods to which designs are applicable are divided into fourteen classes. The following is a list of the classes:—

Classifica-
tion of
goods.

1. Articles composed wholly or chiefly of metal not included in Class 2.
2. Jewellery.
3. Articles composed wholly or chiefly of wood, bone, ivory, *papier mâché*, or other solid substances not included in other classes.
4. Articles composed wholly or chiefly of glass, earthenware or porcelain, bricks, tiles, or cement.
5. Articles composed wholly or chiefly of paper (except hangings).
6. Articles composed wholly or chiefly of leather, including bookbinding of all materials.
7. Paper-hangings.
8. Carpets and rugs in all materials, floorcloths, and oilcloths.
9. Lace, hosiery.
10. Millinery and wearing apparel, including boots and shoes.
11. Ornamental needlework in muslin or other textile fabrics.
12. Goods not included in other classes.
13. Printed or woven designs on textile piece-goods.
14. Printed or woven designs on handkerchiefs and shawls.

By Section 58 of the Act the protection afforded to a registered design is restricted to the particular class or classes of goods in which the design is registered.

The same design may be registered in more than one class, but for each class a separate application, each with its annexed three representations, will be required.

Same
design may
be regis-
tered in
more than
one class.

When the design is to be applied to a set, each of the drawings accompanying the application should show

Registra-
tion in sets.

all the various arrangements in which it is proposed to apply the design to the articles included in the set.

Lace
designs.

There is a special form, "O," for applications of this nature, and the stamp is £1. For sets of lace designs in Class 9 a special form, O¹, is provided.

Careful ap-
plications.

Should an applicant be desirous of losing no time in making his application, he may send up the application forms, accompanied by a single sketch, instead of the three careful drawings or photographs required. This fixes the date of the application, and the finished drawings may then be made at greater leisure, and afterwards filed. The sketch and the drawings must, however, agree in showing the nature of the design.

Certificate
of registra-
tion.

On receipt of an application the Comptroller considers the design, and if he decides to register it he sends a certificate of registration to the applicant, sealed with the seal of the Patent Office.

Objection to
register.

The Comptroller might, however, decline to register, and in that case, before exercising the discretionary power given to him by the Acts adversely to the applicant, the Comptroller shall, if so required by the applicant, within one month from the date of the Comptroller's objection, give the applicant an opportunity of being heard personally or by his agent, by sending the applicant ten days' notice of a time when he may be so heard. Within five days from the receipt of this notice the applicant must notify the Comptroller whether or not he intends to be heard.

Hearing.

Appeal
from
refusal to
Board of
Trade.

The decision of the Comptroller consequent upon the hearing is then notified to the applicant.

If this decision is a refusal to register, the applicant may still appeal to the Board of Trade. If he intends to do so, he should, within one month from the adverse decision, leave at the Patent Office a notice on Form F of his intention to appeal. The notice is to be accompanied by a statement of the grounds of appeal and of the applicant's case in support thereof. A copy of the notice should at the same time be sent to the Secretary of the Board of Trade, 7 Whitehall Gardens, London. The Board of Trade will then appoint a hearing, and a notice of the time and place of hearing is sent to the Comptroller

and to the applicant. After the hearing the Board of Trade gives its decision, and this is final. The Board might in some cases refer the matter to the Court. There is no provision as to costs.

Final decision.

Reference to Court.

When registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered. During the existence of the copyright in a design, the design shall not be open to inspection except by the proprietor, or by a person authorised by him, or by the Comptroller, or by the Court, and then only in presence of the Comptroller or his representative, and upon payment of the prescribed fee. The person making the inspection is not allowed to make any copy of the design.

Inspection of registered designs.

When the copyright in the design has ceased, the design is open to inspection by anyone paying the prescribed fee, and copies may be freely made.

Inspection of expired designs.

SEARCHES.

Any person wishing to know whether the registration of a particular design marked as "registered" is still in force, and when and by whom it was registered, may obtain the information he requires by producing or sending the design, with its mark and number, to the Comptroller, and paying the prescribed fee. The request for search should be made on Form "N," stamped with five shillings.

Searches by Comptroller.

A still more valuable provision in the Rules empowers the Comptroller, on payment of the same fee, to make a search among the registered designs for the purpose of finding whether a design produced by the person requesting the search is identical with, or an obvious imitation of, any registered design still in force.

This is a precautionary measure that might be recommended to manufacturers who contemplate the production of a design concerning which they may have any doubt. It must, however, be said that if, even after receiving the Comptroller's certificate that it is *not* an obvious

Comptroller's certificate not evidence.

imitation, the owner of a registered design should take action on the ground that it is an obvious imitation, the Comptroller's certificate is not admitted as evidence on the defendant's behalf, and has no weight with the Court.

REGISTER OF DESIGNS.

Proprietor
entered on
Register.

Upon the issue of the certificate of registration, the name, address, and description of the proprietor of the design, together with the date and number of registration, are entered in the Register of Designs by the Comptroller.

Assignee or
licensee
entered on
Register.

When a person becomes entitled to the copyright in a registered design, or to any share or interest therein, by assignment, transmission, or other operation of law, or where a person acquires any right to apply the design, either exclusively or otherwise, a request for the entry of his name in the Register as such proprietor, or as having acquired such right, should be addressed to the Comptroller, and left at the Patent Office, Designs Branch. This request, which is made on Form "K," is stamped with ten shillings in the case of designs in Classes 1 to 12, and with one shilling in the case of designs in Classes 13 and 14. The assignment or licence must be in writing.

Request for
entry.

The request should state the name, address, and description of the claimant, and give particulars, with dates and names of the assignment, transmission, or licence by virtue of which the request is made.

Verification
by declara-
tion.

The request concludes with a statutory declaration, signed by the claimant, verifying and declaring the truth of the several statements made and particulars given in the request. The Comptroller will then alter the Register in accordance with the request.

Body
corporate
may be
registered.

When the request is made on behalf of a firm or partnership, it should be signed by some one or more members of the firm or partnership, or by his or their duly authorised agent. A body corporate can be registered as proprietors in its corporate name, and the request may be signed by a director or by the secretary, or by the duly authorised agent of the body corporate.

When an order has been made by the Court to rectify the Register, the person in whose favour the order has been made should forthwith leave at the Patent Office an office copy of such order, whereupon the Register will be rectified or the purport of the order duly entered in the Register as the case may be. Four clear days' notice of every application to the Court for rectification of the Register should be given to the Comptroller.

Duty of person in whose favour order of Court has been made.

The Register of Designs shall be *prima facie* evidence of any matters directed or ordered by the Act to be entered therein.

Register of Designs *prima facie* evidence.

A certificate of any entry on the Register of Designs, for use in legal proceedings, may be had from the Comptroller by making a request on form "I," which is stamped with five shillings.

Certificate of entry.

INDUSTRIAL AND INTERNATIONAL EXHIBITIONS.

Any person desirous of exhibiting an unregistered design at an industrial or international exhibition, certified so to be by the Board of Trade or by an Order in Council made in pursuance of Section 57 of the Act, should, in the former case, give the Comptroller seven days' notice of his intention to exhibit, and such notice must be given upon Form "L," stamped with five shillings. This notice preserves his prior right to make application for registration of the design during six months from the opening of the exhibition. The notice to the Comptroller should include a brief description of the design, and be accompanied by a sketch or specimen. Application for registration should be made within six months of the opening of the exhibition. In the case of an international exhibition held out of the United Kingdom and certified by an Order in Council (see Section 57) notice to the Comptroller is excused.

Exhibition of unregistered designs.

DURATION OF COPYRIGHT.

The *Duration of Copyright* is limited to five years from the date of registration, and there is no provision for extension of this time. An unusual clause for the fostering of native industry occurs in Section 54 of the Act, which

Duration of copyright.

Working clause.

provides that if a registered design is used in manufacture in any foreign country, and is not used in this country within six months of its registration here, the copyright in the design shall cease. This clause is akin to the condition of "working" attached to the grant of many foreign patents.

Copyright
extends
only to
United
Kingdom.

It might be thought needless to say that the protection accorded to designs by The Patents, Designs, and Trade Marks Acts, 1883 to 1901, does not extend beyond the limits of the United Kingdom.

Reference, however, may be made to a case (*Potter & Co. v. Braco de Prata Co.*, [1891] 8 R. P. C. 218) in which the plaintiffs, who were a British firm, sought to make the defendants (also British subjects) liable for the infringement of certain calico-printers' designs. It was admitted that the designs of the plaintiffs were being copied and sold, but the defendants pleaded that the goods bearing the designs were manufactured and sold in Portugal and Brazil—countries which were not subject to the operations of the Act. The judgment of the Lord President was to the effect that an infringement of a design registered under the Act consists in the production and sale of goods in this country, where they are protected, and nowhere else. No right is secured to a registered design in a foreign country by registration here, except the right under the International Convention (see Appendix A).

A tort
created by
a British
Statute
must, to be
actionable,
have been
committed
in this
country.

The Acts of 1883 to 1901 extend to the Isle of Man, but nothing in the Acts is to affect the jurisdiction of the Courts in the Isle in proceedings for infringement or in any action or proceeding respecting a design, competent in those Courts (see Section 112 of the Act, Appendix C). Copyright in a registered design does not cover the Channel Islands.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

Persons who have applied for registration of a design in any country or colony under the Convention, and who apply for registration in another country within four months thereof, will obtain the date of their original application (see Section 103, and Appendix A, page 450).

CHAPTER III.

PERSONS QUALIFIED TO REGISTER AND TO BE REGISTERED AS PROPRIETORS.

A PERSON qualified to register a design is the author or inventor of the design unless he produced it on behalf of another person for a good or valuable consideration.

Who may register.

To be precise, the words of Section 61 of the Act which purport to define the proprietor of a design are as follows:—

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

The author or purchaser or person having the right to apply the design.

Section 5 of the old Act of 1842 was much to the same purport, and under that measure it was held, in *Lazarus v. Charles* ([1873] L. R. 16 Eq. 117, 122), that where a person has a workman in his employ, and the workman in the course of his business and employment makes a design which is new and original, the master may register the design as his property; but that persons not the original designers nor the employers of the designer, but merely customers who made a contract with the foreign designer that he should supply them with articles in this country according to the design, were not entitled to register themselves as proprietors here, since they were neither authors of the design nor had they purchased it for a valuable consideration. As Malins, V.-C., said in this case:—“The plaintiffs were not entitled to any merit of invention; they only did as anyone else might do: that

Master and servant.

Exclusive licensees to sell cannot register as proprietors. *Lazarus v. Charles.*

is, they purchased the articles, but they gave no consideration to entitle them to be the proprietors of the design under the terms of the Act; for the agreement to purchase the articles from the manufacturer can form no consideration within the meaning of the Statute. Therefore they are not the designers of the article, nor are they entitled to be the proprietors by virtue of having purchased a design for valuable consideration. That is, in my opinion, a fatal objection to the plaintiff's title."

*Jewitt
v. Eckhardt.*

Even where an exclusive right to sell was of the essence of a contract between the designer and the customer, the customer was held not entitled to register. In *Jewitt v. Eckhardt* ([1878] 8 Ch. D. 404) an American manufacturer purported to sell to the plaintiff the sole right to deal in an article of a new design which was about to be put upon the market, it being stipulated that the plaintiff should obtain the goods exclusively from the manufacturer. Here it was held that the plaintiff, not having under the contract the right to manufacture, had not acquired the right to apply the design and could not be registered as proprietor.

*Agent for
foreign
principals.*

The agent of a foreign firm selling goods of a particular design in this country for his foreign principals has no claim to be registered as proprietor of the design (*Guiterman's Design*, [1886] 55 L. J. Ch. 309).

*Bond fide
mistaken
and non-
fraudulent
registration
may be
cured by
substitution
of true
author's
name.*

*Grocott's
Design.*

Where a design was mistakenly registered by an agent of the designer in his own name instead of that of his principal, but without any fraudulent intent, the Court ordered the principal's name to be substituted for the agent's (*Grocott's Design*, [1899] 17 R. P. C. 139). But if the registration were originally fraudulent it seems that in motions to rectify the Register the practice in trade marks would be followed—viz. to strike the design off the Register and let the true designer re-apply in his own name. But how if in the meantime the design had been published? Re-registration by the true author would be futile in such a case, unless the Court were to order that the new registration should be of the same date as the original wrongful entry. Failing this, apparently the best course would be for the Court to declare the wrongful proprietor trustee for the rightful owner.

Although in patent practice the first importer of an invention from abroad is considered the true and first inventor, there seems no reason to suppose that a mere first importer of a design from abroad, although not in any fiduciary relationship to the foreign author, could claim to be legally registered as proprietor (*Lazarus v. Charles*, [1873] L. R. 16 Eq. 117).

First importer.

An assignee of a registered design steps into the shoes of the registered owner, and may on application to the Comptroller, on Form "K," be registered as proprietor. Holders of licences may also enter a notice of the licence, but neither assignment nor licence can be entered until the original proprietorship has been placed on the Register (*Jewitt v. Eckhardt*, *supra*). A bare licensee cannot sue for infringement (*Woolley v. Broud*, [1892] 9 R. P. C. 208). In the latter case, where unregistered verbal licensees joined with the proprietor in an action for infringement, judgment for the defendants was given so far as the licensees were concerned.

Assignee.

Licensee.

Licensee for sale cannot sue for infringement.

Where the proprietorship is disputed, the onus of proof lies on the party claiming the proprietorship (*Heinrich's Design*, [1891] 9 R. P. C. 73).

In disputed proprietorship onus of proof on claimant.

A design is personal property, and on the death or bankruptcy of the proprietor goes to his personal representatives or to the trustee in bankruptcy.

Design is personal property.

To conclude, the persons qualified to be placed on the Register as proprietors may be classified as follows:—

List of persons qualified to register as proprietors.

1. The designer or author of the design.
2. A person on behalf of whom the designer or author has executed the design for a good or valuable consideration.
3. A person who has acquired the design or a share therein for a good or valuable consideration (*i.e.* an assignee of the whole or a part); or has acquired the right, either exclusively or otherwise, to apply the design to manufactured articles.
4. Any person upon whom may devolve the foregoing property or rights in the design.

CHAPTER IV.

SUBJECT-MATTER OF DESIGNS.

Defini-
tion of
"Design."

Must be
capable of
application
to some
article of
manufac-
ture.

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 by 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. c. 56).

Ornament.

Thus a design, within the Act, may be some pattern or 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 metal on 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 or motor-cycle frame; or, as the Act says, the design may contain two or all of the foregoing elements—*i.e.* ornament, pattern, shape, and configuration.

Shape.

Design may
combine
ornament,
pattern, and
shape.

No utility
necessary.

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 *Hecla Foundry Co. v. Walker, Hunter & Co.* ([1889] 6 R. P. C. 554), 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 grate. 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
v. Walker,
Hunter
& Co.*

Range
fire-door.

"Shape"
in design.

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 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

Utility must
not be con-
sidered.

The eye to
be the
judge.

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."

Moody v. Tree:
Woven Basket Case.
Cooper v. Symington:
Corset Case.
Farwell, J., on utility in *Morton's Design:*
Cuff-link.

The judgment in the above case was resorted to for guidance in *Moody v. Tree* ([1892] 9 R. P. C. 333) by the Divisional Court; and in *Cooper v. Symington* ([1893] 10 R. P. C. 264) Mr. Justice Chitty decided that the utility of the registered corset could not make up for its shortcomings as a design. In the more recent deliverance of Farwell, J., in *Morton's Design* ([1900] 17 R. P. C. 117) the necessity of disregarding utility in designs was again insisted upon. Said the learned Judge: "That it (the design) may be useful seems to me to be immaterial, because I think it must be admitted that however useless a novel design may be, it would still be within the meaning of the Act if it were novel or original."

Instance of very slight subject-matter.
Walker v. Scott.

The case of *Walker v. Scott* ([1892] 9 R. P. C. 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. The validity of the registration was not questioned by the defendant, and 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.

A design might be for something also patentable.

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. The judgment of Lord Shand in *Walker v. Falkirk Iron Co.* ([1887] 4 R. P. C. 390) is an authority for saying that 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 referred to in that case, by virtue of its useful functions, and in combination with the range, would undoubtedly have constituted a patentable invention, and yet the registration of the door as a design was upheld by the Court. In *Werner Motors, Limited v. Gamage* ([1904] 21 R. P. C. 621), it was expressly held that rights under a patent and in a design may co-exist in respect of the same article. The subject-matter in the latter case was a motor-bicycle frame.

Patent
right and
design
copyright
may
co-exist.

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 a patentable invention. In *Moody v. Tree* ([1892] 9 R. P. C. 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* ([1893] 10 R. P. C. 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

But a
patentable
invention
might be
bad subject-
matter for
design.

*Moody v.
Tree.*

*Cooper v.
Symington.*

A design
must be
judged
from its
appearance,
not its uses.

same as the old laced-up corset, which indeed it was designed and intended to imitate. Accordingly, Chitty, J., ordered the design to be expunged.

Combina-
tion
designs.

*Harrison v.
Taylor.*

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. c. 100—that of *Harrison v. Taylor* ([1859] 29 L. J. Ex. 3; 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 had not been carried out before.

But the
combina-
tion must
show some
ingenuity.

*Hothersall
v. Moore.*

It is probable that when the combination of old elements to produce a new effect involves the exercise of taste and invention, it would not upset the design to analyse it and show where the different combined elements were obtained. But where the combination is a mere mechanical adding of one old thing to another, not betraying ingenuity in the combination, the result is not so likely to be upheld as novel and original. For example, in the case of *Hothersall v. Moore* ([1891] 9 R. P. C. 27) the plaintiff had 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.

Small
change in
combina-
tion design.

In *Rollason's Design* ([1898] 15 R. P. C. 441) the finding of the House of Lords was practically, from the nature of the evidence and the anticipatory matter, a finding that the result of a combination of old features, even although the combination itself is not strikingly new, may be a novel design; and in *Rivett v. Grimshaw* ([1894] 11 R. P. C. 351) a combination of a bassinette and mailcart was held to be a good registrable design.

In *Le May v. Welch* ([1884] 28 Ch. D. 24; 54 L. J. Ch. 279) 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 and 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."

Mere slight changes in style and shape of common article not subject-matter.

Le May v. Welch.

In *Gillard v. Worrall* ([1904] 22 R. P. C. 76) the design consisted in merely bending the moveable feed gas tube of a stand jet for a baker's oven so as to lie close to the wall of the oven mouth and carry the light round the corner. As Hall, V.-C., said: "Nothing more than a twist of the tube to carry the gas round a corner." The registration was held invalid.

Example of bad subject-matter.

In the case of *Le May v. Welch* (*supra*), 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.* ([1889] 6 R. P. C. 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* (*supra*), and quoted with approval the remarks

Some invention must be apparent.

Smith v. Hope Bros.

Commercial
success may
help to
sustain
design.

of Lords 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* ([1893] 11 R. P. C. 35) Romer, J., in upholding the plaintiff's design of a water-closet 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.

Adaptation
of well-
known
objects and
personages
as subject-
matter for
designs.

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 goods. It seems only reasonable to suppose that if someone adapts a view or picture or 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 used to be said, in text-books upon the subject of Designs Copyright, that the copy of a photograph of a well-known public character applied to manufactured objects is not a new or original design within the meaning of the Act. The decision upon which this assertion is based occurred in the case of *Adams v. Clementson* ([1879] 12 Ch. D. 714). But this case turned on the old Act of 5 & 6 Vict. c. 100,

*Adams v.
Clementson.*

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*, [1892] 10 R. P. C. 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.

Portrait on earthenware.

Saunders v. Wiel.

Westminster Abbey spoon handles.

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.

A modelled view of Westminster Abbey on spoon handle held good subject-matter.

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

Lindley,
L. J., on
new and
original
designs.

endorsed by Lindley and Bowen, L. JJ. As was said by Lindley, L. J.: "What we have to consider is this: whether this registered design—for a design of some sort of course it is—is a design applicable for the pattern and for the shape to things in Class 1, and in particular forks and spoons, and whether it is a new or original design not previously published in the United Kingdom. Now why is it not? Has such a design applicable to metals ever been seen before? If you ask that question you are told this—'Yes, if you mean by design, public buildings, or if you mean cathedrals and churches, they are common enough'; therefore there is no novelty in the idea. But if you ask a little closer whether anybody has previously taken this particular aspect of Westminster Abbey and used it as a design applicable to things in Class 1 or to any things like it, the answer is, 'No, that is new and never has been published before.' That answer seems to me to bring the plaintiff's case within the Act of Parliament."

Mere substitution of one material for another in the same article does not make it a new design.

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* ([1889] 6 R. P. C. 376), Bach registered, in Class 4, a fairy lampshade produced in the form of a rose and made of vitreous material. It was shown that lampshades 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.

Analogous application of old thing bad.

In *Clarke's Design* ([1896] 13 R. P. C. 351) it was held that a design applicable for shape, consisting of two parts, which in conjunction with another part were old, for the purpose of an oil or gas lamp, was not a novel or original design for an electric lamp.

But a new design incorporating an old one may be good.

According to Lord Herschell, in *Harper & Co. v. Wright & Butler* ([1895] 12 R. P. C., at p. 491), a design founded upon and even incorporating the whole or part of a previous design may be good in its totality.

Slightness of change

How slight a change may constitute a well-known subject-matter for a registrable design might be instanced

in *Walker v. Scott* ([1892] 9 R. P. C. 482), where the mere rounding of the edges of an oil-can of well-known shape constituted the subject-matter of the design. In *Rollason's Design* ([1898] 15 R. P. C. 441), the coffin plates in respect of which registration had been effected were exceedingly similar to alleged anticipations both in shape and in ornament. The alleged distinctive features of Rollason's plates—viz., the sunk central flat portions, could not be said to appear in the drawings as sunk. But the House of Lords, having satisfied themselves of the proprietor's intentions, held that there was subject-matter, and sustained the registration. It seems, therefore, that very little difference of appearance will suffice to uphold a registered design. As was said by Lord Herschell in *Rollason's Case*: "Very often a very successful design may be one in which the difference from previous designs can, on analysis, be shown to be very slight, where, nevertheless, the result is to make the one so much more pleasing than the other that it is a successful design. Whilst on the one hand we certainly ought not to give protection to a design in which the variations are trivial and unimportant so that it is substantially the same design as one already registered, on the other hand we ought not to refuse it where the design is practically a different one, which may be more attractive."

to constitute subject-matter.

Drawing not conclusive as to form of design.

Another case, in which the filed drawing did not seem a fair guide to the section of presser-bar actually claimed by the proprietor, occurred in *Varley v. Keighley Iron Works, Limited* ([1896] 14 R. P. C. 169); but here also the plaintiff succeeded. It seems advisable in cases such as those of *Rollason* and of *Varley* that details should be given in the drawing of any point left in doubt by the main illustration.

CHAPTER V.

NOVELTY.

Design
must be
new or
original.

Must be
new with
reference
to the
goods to
which it is
applied.

Distinction
between
"new" and
"original."

Novelty
considered
with refer-
ence to
state of
prior
knowledge.

ACCORDING to Section 47 of the Act, a design to be capable of registration must be "a new or original design not previously published in the United Kingdom." The words "new or original" mean, according to Fry, L. J., in *Le May v. Welch* ([1884] 28 Ch. D. 24), that "the design must either be substantially novel or substantially original, having regard to the nature and character of the subject-matter to which it is to be applied." Or as was said by Lindley, L. J., in *Clarke's Design* ([1896] 13 R. P. C. 351): "The design must be new or original with reference to the kind of article for which it is registered. . . . A design may be new for a coal-scuttle but not for a bonnet. On the other hand a design for a shade of a gas-lamp can hardly be new if it was old for an oil-lamp." *Per* Chitty, L. J., in *Rollason's Design* ([1897] 14 R. P. C. 909): "There is a distinction between the words 'new' and 'original.' Every design which is original is new, but every design which is new is not necessarily original." Mr. Justice Manisty, in *Sherwood v. Decorative Tile Co.* ([1887] 4 R. P. C. 207), speaks of a new arrangement of well-known parts as constituting a "new" design, but not what the Act of Parliament means by an "original" design. It is questionable, however, whether the Legislature meant as much as they are credited with by the learned Judges mentioned, since in Section 61 the words used are "new *and* original."

Novelty in a design must always be considered with relation to the state of knowledge at the date of registration. Thus, in *Morton's Design* ([1900] 17 R. P. C. 117), where the registered design related to the shank of a cuff-link, the state of knowledge as evidenced by prior examples of shanks, and by similar shanks appearing in prior patent specifications, caused the Court to decide that the design was not new or original.

A registered design cannot be maintained as new and original if a similar design has previously been registered in a different class for substantially the same purpose (*Read & Gresswell's Design*, [1889] 6 R. P. C. 471), and the same was held in *Bach's Design* ([1889] 6 R. P. C. 376) and in *Plackett's Design* ([1892] 9 R. P. C. 436). But this is, generally speaking, only the case where the registrations although in different classes are for application to the same or substantially the same articles. Thus although it was shown that the moulding on the registered design of fire-door in *Walker v. Falkirk Iron Co.* ([1887] 4 R. P. C. 390) was old in furniture and doors for other purposes, that was held not to destroy the validity and novelty of the registered design. In other words a design may be old in fire-irons and yet new in scarf-pins, or old in cathedrals but new in spoons (see *Saunders v. Wiel* in last chapter). But a design old in an oil-lamp cannot be new simply because it is applied to a gas-lamp (*Clarke's Design, supra*).

Not generally new if registered in other class.

Design old in furniture may be new in a kitchen range.

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.

Novelty destroyed by prior exhibition.

Confidential disclosure.

In *Heinrichs v. Bastendorff* ([1893] 10 R. P. C. 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* ([1888] 5 R. P. C. 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 an alleged 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

Disclosure for the purpose of doing business destroys novelty.

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. Almost the same circumstances caused the registered design to be upset in the older case of *Hunt v. Sterens* ([1878] W. N. 79). An examination of the report of the more recent and very similar case of *Winfield v. Snow* ([1890] 8 R. P. C. 15), and a consideration of the remarks of Hawkins, J., will also help to show how far confidential communications of this description may go without constituting publication. In *re Sherwood's Design* ([1892] 9 R. P. C. 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 globe as supplied; but it was held that publication had taken place, and the design was ordered to be expunged from the Register.

Premature
sale of
articles in
accordance
with design
destroys
novelty.

Public
exhibition.

In *Smout v. Slaymaker* ([1890] 7 R. P. C. 90) a registered design of a fire-screen was ordered to be expunged from the Register upon proof that fire-screens identical in design had been publicly exhibited and sold prior to registration.

Publication
by book or
specifica-
tion.

In addition to anticipation by prior user, or sale, or exhibition, or prior registration, a design might be anticipated by prior publication in the United Kingdom by means of a book, or specification, or pamphlet, or newspaper. The principle is precisely the same as that which holds good with reference to prior publication of patented inventions by such means, and the reader is referred to the division of this book on Patents and to the chapter which deals with prior publication. It may, however, be said that in the rare case where a patent and a design co-exist for the same article a patent provisionally applied for and not completed before the registration of the design does not anticipate the design if no publication has taken place (*Werner Motors, Limited v. Gamage*, [1904] 21 R. P. C. 621).

Substitu-
tion of one
material
for another.

It has already 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* ([1889] 6 R. P. C. 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.

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 kindred 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.

Publication
in one class
will destroy
novelty in
another
class.

It has not been decided whether registration *per se* without publication would constitute anticipation. The point was raised but not decided in *Read and Gresswell's Design* ([1889] 6 R. P. C. 471). In the writer's opinion registration alone, and without publication, would not constitute anticipation.

Query
whether
registration
per se is
anticipa-
tion.

CHAPTER VI.

MARKING THE GOODS.

Goods must
be marked.

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

Specified
markings.

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.

Object of
marking.

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* ([1893] 10 R. P. C. 160) 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.

Made-up
goods may
be marked
in bulk.

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. Footmann* ([1888] 5 R. P. C. 653) Kekewich, J., decided that the plaintiff had complied

sufficiently with the Act in marking his trimming, when made up in bundles, with the abbreviation "RD" and the number printed on a paper band surrounding the goods.

But failure to mark the goods at all will undoubtedly (unless the proprietor can show a very strong case) 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 "REGD" 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 *Hothersall v. Moore* ([1891] 9 R. P. C. 27).

Consequences of failure to mark.

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 blundering, on the part of those over whom the proprietor of the design had no immediate control, will not necessarily vitiate the registration of the design.

Relief in case of inadvertence.

As was said by Lord Herschell in *Rollason's Design* ([1898] 15 R. P. C. 441): "The section, by its concluding words, leaves an opening to prevent the operation of the section in full stringency, because it provides that the copyright shall not cease if all proper steps have been taken by the proprietor to ensure the marking of the article. In interpreting these concluding words, I think it is necessary to bear in mind the object of the section and to take into account too what the nature of the omission is. The object of the section, as stated in plain terms, is to 'denote that the design is registered': that is to say, to give warning to the public that they are not entitled to copy it by reason of registration. Of course, if there is nothing to give that notice to the public, the proprietor would need to make out a very strong case to excuse himself under the concluding words of the section, because he has failed to do that which was essential to the very purpose of the provision contained

Per Lord Herschell—
if the public is properly warned of registration that is the main thing.

in the section: namely—to denote to the public that the design was a registered one. Even in that case he might escape the loss of his design by making out a case which would show that it was not due to any fault of his.”

Wrong
number
excused.

In the case of *Rollason's Design* the registered number had been wrongly stamped on certain of the coffin plates as No. 252,908 instead of No. 232,908, the mistake having originated in the stamping die, which had been examined and approved in error by the plaintiff. Nevertheless he was held excused, and the registration sustained.

In *Harper v. Wright* ([1895] 12 R. P. C. 483) the owner put the wrong registered numbers on the articles in addition to the right numbers, but this was held not to vitiate his registration.

Old number
used by
mistake.

In *Wittmann v. Oppenheim* ([1884] 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* ([1893] 11 R. P. C. 21), in which 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.”

Proprietor
must take
all proper
steps to
ensure
marking.

Marking
the wrong
part in an
article.

In the still more recent case of *Morton's Design* ([1900] 17 R. P. C. 117) the registered design applied to the shank of a cuff-link. Instead of marking the shank, the

proprietor marked the plate of the link. As Farwell, J., pointed out, there was a double misleading in such marking. Not only were the public not informed of what was registered, but they were invited to believe that something was protected which really was not. On these grounds, *inter alia*, registration was cancelled. Almost exactly the same remissness in marking destroyed the copyright in *Lea v. Price* ([1904] 22 R. P. C. 122). Here the thing registered was a lamp head separable and distinct from the other parts. But instead of marking the head the plaintiffs had marked a binding ring situated at the foot of the globe. The ring was not registered, and was no part of the design. On the other hand, in *Ingram v. Edwards* ([1904] 21 R. P. C. 463) a registered gas bracket was marked not on the body of the bracket itself but on a detachable cup. Nevertheless, it was held that as the cup was an integral part, without which the bracket would not have been complete, the marking was sufficient.

The articles are to be marked "before delivery on sale" by the proprietor or, as was decided in *Wedekind v. General Electric Co., Limited* ([1897] 14 R. P. C. 190), by his lawfully authorised agents. In the case referred to, the sale of at least one unmarked telephone transmitter was proved and the action dismissed. The sale of one unmarked article only destroyed the copyright in the older case of *Hunt v. Stevens* ([1878] W. N. 79).

Sale of goods unmarked destroys copyright.

In *Woolley v. Broad* ([1892] 9 R. P. C. 429) the sale of lace protected by design registration—when the lace was in the brown or unfinished state—without any registration mark, was held to destroy the copyright, although it was shown that the further treatment of the lace by the "finishing" firm to whom it was sold must have destroyed the registration mark.

Sale of goods unmarked in unfinished state.

In a case under the old Act (*Fielding v. Hawley*, [1883] 48 L. T. N. S. 639) where the design related to a butter-dish consisting of dish and cover, the dish only was marked, but it was held that this satisfied the Act, the dish and cover together being one article.

Marking separable parts of article.

Samples.

Mere patterns of the registered goods if not sold need not be marked.

Penalty for describing an article as "registered."

It is an offence under the Act (Section 105) to describe an article as "registered" where no registration has been effected. A person is deemed to represent a design as registered if he sells the article bearing any word or mark expressing or implying that registration has been obtained. The penalty for such misrepresentation is that the offender is liable for each offence on summary conviction to a fine not exceeding £5.

Exported goods.

Even if sold outside of the limits of the United Kingdom, goods to which a registered design is applied must be marked (*Sarazin v. Hamell*, [1863] 7 L. T. N. S. 660), otherwise the copyright will be lost.

CHAPTER VII.

ACTION FOR INFRINGEMENT.

THERE is no Common Law right in designs such as may exist in unregistered Common Law trade marks or trade names. The right to sue for the infringement of a design rests only in the registered proprietor of the copyright. Legal proceedings in respect of designs are governed chiefly by Sections 58 and 59 of the Act.

No
Common
Law right
in designs.

Section 58 of the Act provides that during the existence of copyright in any design—

Section 58.

(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

Unlawful
for any
unlicensed
person to
apply
design.

(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.

Unlawful to
sell articles
having
design
wrongfully
applied.

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.

This section is a repetition substantially of Section 7 of the Act of 1842.

Clause (a) is evidently aimed at the manufacturer or producer of the goods, while Clause (b) seems to deal with the seller. It is not under Clause (a) necessary to bring home to the manufacturer knowledge of the existence or registration of the design. It is enough that he applies it or causes it to be applied. But under Clause (b) the seller or retailer is only liable if he sells

Differences
between
Clauses (a)
and (b).

articles bearing the design, knowing that it has been applied without the proprietor's consent.

What constitutes an infringement.

Test of the eye.

As to what constitutes an infringement, it was said by Lord Westbury, in *Holdsworth v. McCrea* ([1867] L. R. 2 H. L. 380), that "the appeal is to the eye, and the eye alone is the judge of the identity of the two things"; and by Lord Herschell, in *Hecla Foundry Co. v. Walker* ([1889] 6 R. P. C. 554), that the eye is the test, and that the question should be determined by placing the designs side by side and asking whether they were the same, or the one an obvious imitation of the other, taking into account the state of knowledge at the time, and in what respects the registered design was new and original, when considering whether variations from the registered design were substantial or not. The same test was proposed to be applied in *Hothersall v. Moore* ([1891] 9 R. P. C. 27), and it may safely be said that this test furnishes the means for deciding nine-tenths of all design actions brought into Court.

Need not be an exact copy.

General resemblance may constitute infringement.

In *McCrea v. Holdsworth* ([1870] L. R. 6 Ch. 418), and in *Oliver v. Thornley* ([1896] 13 R. P. C. 490) it was held that to establish infringement it was not necessary that an exact copy should have been made by the defendant. If the appearance is strikingly similar to that of the registered goods that is enough. In *Harper v. Wright* ([1895] 12 R. P. C. 433) the design of a stove, the ornament of which was Gothic in style, had been registered. The defendant's stove, although different in detail and even in style, was nevertheless so similar in general appearance to the plaintiff's that it was held to be an "obvious imitation." But it is of course not competent to register any particular *style* of ornament, and, as Lord Herschell said in *Harper v. Wright* (*supra*), if the whole point of the design consists merely of a cathedral window of a particular kind, a design consisting of a cathedral window of another kind would not infringe. This is equivalent to saying that no one can register a general appearance. The question of detail and the judgment of the eye must decide whether infringement has arisen. Thus in *Holden v. Hodgkinson* ([1904] 22 R. P. C. 102) the tombstone design of the plaintiff, consisting of a slab with rounded top and flanked by black

porcelain pillars, was held not to be infringed by a slab with a pinnacle and ogle top, and also flanked by black porcelain pillars. The minor details also differed.

An obvious and fraudulent imitation might be created, and the inference that it was so would be largely augmented, where the defendant had instructed his designer to work as closely to the plaintiff's design as possible, and so as to produce the general effect without imitating the details (*Grafton v. Watson*, [1884] 51 L. T. N. S. 141; see also *Harper v. Wright*, *supra*). But it would scarcely be a profitable digression to enter upon a general discussion as to what would constitute 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, and the circumstances of each case might be examined to determine whether it was also a "fraudulent" 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 is the same. *A fortiori*, the defendant will not be allowed to shelter himself behind trifling distinctions and variations from the registered design.

In *Sherwood v. Decorative Tile Co.* ([1887] 4 R. P. C. 207), Manisty, J., says: "Upon the question of *obvious* imitation, you must to a great extent (I do not say entirely) be guided by the eye." And again the same learned Judge remarks: "It may not be easy—I do not say it is impossible—to define in words exactly what is meant by a *fraudulent* imitation. I think the word was introduced for the very purpose of meeting the case of an imitation, not an *obvious* imitation, but an imitation varied for the purpose really of perpetrating what is a legal fraud. For instance, having before your mind and before your eye the design of another, and introducing into your design some differences, in order if possible to avoid coming within the Act of Parliament."

In the case last quoted the same Judge came to the conclusion that the defendant's design, although not an "obvious," was on the other hand a "fraudulent," imitation.

As has already been pointed out, the mere fact of applying or causing to be applied the registered design,

Obvious and
fraudulent
imitation.

Grafton v.
Watson.
Harper v.
Wright.

Manisty, J.,
on
"obvious"
and
"fraudulent"
imitations.

Sherwood v.
Decorative
Tile Co.

If manu-
facturer has
applied the
design he
liable.

without the consent of the proprietor, renders the manufacturer of the goods liable to an action.

But
Section 58
provides a
refuge for
innocent
retailer.

The case is, however, different with the retailer of the goods, and to succeed the plaintiff must show that the defendant knew that the design had been applied without the consent of the registered proprietor. To apprise him of this knowledge the proper course is to serve him with a notice which should show the defendant distinctly and intelligibly that the design had been applied without the plaintiff's consent (*Norton v. Nicholls*, [1859] 1 E. & E. 765, 28 D. J. Q. B. 225; *Smith v. Roberts*, [1888] 5 R. P. C. 611).

Sufficiency
of notice to
retailer.

A mere general notice that the retailer is selling goods with a registered design applied, but giving no details, is not a sufficient notice (*Smith v. Roberts*, *supra*). In the latter case, where the defendants after insufficient notice stopped the sale of goods of the class complained of and immediately upon an inspection of the plaintiff's design returned all goods to the manufacturer, it was held there was no cause of action, and the case was dismissed with costs. In the course of his judgment, in *Smith v. Roberts*, Bristowe, V.-C., said: "I think that the intention of the Act, Section 58, Sub-section (b), is to protect a retail dealer, or dealer selling goods and not being himself the manufacturer of them, from pains and penalties in respect of that which he does not himself know; and if the retail dealer is selling goods as to which he has no knowledge that there is any registration, he is doing that which is no wrong; the wrong is in doing it after having knowledge brought home to him that protection by registration has been given to the goods which he is seeking to sell." In this action it was held that the defendants had not sold with knowledge that the designs were registered, and that there was no intention to sell after acquiring such knowledge. The action was accordingly dismissed, with costs against the plaintiff.

Intention
of the
section is to
protect
innocent
retailer.

Smith
v. Roberts.

Penalties
now limited
in amount
(Act of
1888).

In the case of *Sherwood v. Decorative Tile Co.* ([1887] 4 R. P. C. 207), where the sale of one hundred infringing tiles was proved, a penalty of £50 was imposed, although under the Act as it then stood a penalty of £5000 might have been adjudged. In view of this and similar cases,

to prevent the possibility of ruinous penalties being imposed, in the amending Act of 1888 the total amount of penalties to be forfeited in respect of any one design was limited to a maximum of £100.

In *Jan v. Grossman* ([1895] 12 R. P. C. 537), the defendant purchased and resold one or two powder puffs the design of which had been registered by the plaintiff. The first knowledge he had of the registration of the design was imparted to him over the counter by the plaintiff, whereupon he withdrew the puff which remained in his shop window. He also promised to sell no more, but declined to give a formal undertaking to that effect. On summons for judgment under Order 32, Rule 6, the action was dismissed with costs. Kekewich, J., called it a useless and trumpery action.

Trumpery
actions not
encouraged.

Goods having the design applied during the currency of registration, and stored up to await the expiry of registration before being put on the market, may be made the subject of an injunction, and delivery up, and destruction may be ordered (*McCrea v. Holdsworth*, [1848] 2 De G. & Sm. 496).

Manufac-
ture without
sale before
expiry of
registra-
tion.

Under the old Act of 1842 the penalty for piracy of a registered design was recoverable by action or by summary proceeding before a magistrate or justice of the peace. But by Section 58 of the present Act the penalty is recoverable as a simple contract debt in any Court of competent jurisdiction. Thus the plaintiff might sue in the High Court, or if his claim does not exceed £50 in the County Court. Where an injunction is sought, or where there is a question of applying to rectify the Register by expunging a design, the Chancery Division would be the most convenient. If trial by jury is desired, or the action is for damages, as under Section 59, the King's Bench Division is more suitable.

Penalty re-
coverable as
simple con-
tract debt.

Injunction.

Jury.

The registered proprietor is the person entitled to sue: that is to say, any person properly on the Register within the classification set forth in Section 61—viz. the author; the person on behalf of whom the design was made for a consideration; the assignee of the whole or a part; the holder of a licence, either exclusive or non-exclusive, to

Persons
entitled to
sue for in-
fringement.

apply the design and on the Register of Proprietors; or the personal representative of the deceased or bankrupt proprietor.

Licensee to
apply the
design.

Therefore although a licensee alone under a patent cannot sue in respect of infringements, although notice of his licence is on the Register, a licensee to apply the design (but not merely to sell articles under the design) has a right to be put on the Register as "proprietor" within the meaning of Section 61, and can therefore, alone or together with his co-proprietors, sue for infringement. But the licence must be in writing (*Jewitt v. Eckhardt*, [1878] L. R. 8 Ch. D. 404) and the licensee on the Register; otherwise he has no cause of action (*Woolley v. Broad*, [1892] 9 R. P. C. 208).

Licence to
apply
design must
be in
writing.

Practice in
designs
actions
similar to
practice in
patent
actions.

In *Morris Wilson v. Coventry Machinists' Co.* ([1891] 8 R. P. C. 353), North. J., held that it was "a convenient rule that the course of proceedings adopted for patent actions should be followed as regards actions for infringement of registered designs." That rule is now generally followed, and in respect of certain points that will be noted, the procedure in a Design action is the same as that in a Patent action.

The
defendant.

The defendant must be (a) the person who has applied or caused to be applied the design to goods in the class for which the design was registered, for purposes of sale; or (b) the person who exposes such goods for sale, knowing that the design has been applied without the proprietor's consent. The preceding portion of this chapter deals with the notice to be given to anyone who is or may be an innocent infringer.

Endorse-
ment of
writ.

The writ alleging infringement should be endorsed with a claim for—

Penalty.

(a) The penalties against the defendant for infringement of the plaintiff's registered design;

Injunction.

(b) An injunction to restrain the defendant, his servants and agents, from infringing the design; and

Delivery
up.

(c) Delivery up or destruction of all articles in the possession or under the control of the defendant.

In the event of the plaintiff electing not to proceed for penalties, he may, in lieu of the penalties, claim damages for the infringement of his design under Section 59. But he must not claim both damages and penalties (*Saunders v. Wiel*, [1892] 9 R. P. C. 459). It should be noted that the same case decides that when penalties are claimed, interrogatories tending to show that the defendant was liable to such penalties cannot be administered.

Damages in lieu of penalties (Section 59).

Interrogatories in penalty action.

The statement of claim should recite—

Statement of claim.

(a) That the plaintiff is the registered legal proprietor of a design No. , registered on the day of , 19 , in Class , for application to [*specify goods*];

Title of plaintiff.

(b) That the defendant has since the said date of registration wrongfully and without the licence or written consent of the plaintiff applied or caused to be applied for the purposes of sale the said design, or an obvious or fraudulent imitation of the same, to goods similar to those in respect of which the design was registered.

Infringement by defendant.

The statement of claim should then conclude with substantially a repetition of the claims endorsed on the writ (*supra*).

If the action is taken against a retailer, the statement under Clause (b) should be to the effect that the defendant has, since the date of registration, wrongfully sold and exposed for sale goods to which the said design, or an obvious or fraudulent imitation thereof, has been applied, the defendant knowing that the same has been applied without the consent of the plaintiff.

In the case of a seller of the goods.

Mr. Justice North having given it as his opinion in *Morris Wilson v. Coventry Machinists' Co.* ([1891] 8 R. P. C. 353), that proceedings in Patent actions should be regarded as the model upon which to regulate Designs actions, it is advisable that the statement of claim should be accompanied by particulars of breaches giving, if possible, all known or ascertained instances of infringement, with names, places, and dates. There is no specific obligation under the

Procedure similar to that in patent actions.

Particulars of breaches.

Statute to give such particulars, but under Order XIX., Rule 7, of the Rules of the Supreme Court, they may be ordered, and as a rule they are given.

Defence.

In his defence the defendant should state everything that will assist him to rebut the plaintiff's claim, as for instance—

- (a) That the defendant does not admit that the plaintiff is the registered proprietor of the design set forth by number and date in the statement of claim, or that the design was ever so registered; or, in the alternative, if such registration has been effected, the defendant denies that the plaintiff was entitled to register the said design in such class or at all.
- (b) That the said design was not fit subject-matter for registration, and was not new or original, and that any copyright, registration, or protection alleged to have been obtained for the same is invalid and of no force and effect.
- (c) That the design was published prior to the date of registration.
- (d) That since the date of the alleged registration the plaintiff has sold or delivered on sale articles to which the alleged registered design was applied, without being marked, in accordance with Section 51 of The Patents, Designs, and Trade Marks Act, 1883, with the prescribed mark, words, or figures, denoting that the design was registered, or wrongly or insufficiently so marked, whereby any copyright that may at any time have subsisted in the said design has ceased.
- (e) If the plaintiff possesses any copyright in the said design (which is denied) the defendant has not infringed.

Defence by
retailer.

If the defendant is a retailer, a further paragraph should be to the effect that the defendant has not wrongfully sold and exposed for sale any goods to which the plaintiff's alleged registered design has been applied; or, in the alternative, if

the defendant has done so, he did it without knowing that the design had been so applied without the consent of the plaintiff.

The defence is preferably to be accompanied by the defendant's particulars of objections. As in the case of the plaintiff's particulars of breaches, particulars of objections are not obligatory under the Statute, but it is better that they should be given. They should set forth in paragraphs any facts or information upon which the defendant may intend to rely, showing for instance—

Defendant's
particulars
of objec-
tions.

- (a) That the plaintiff, or the original registered proprietor, was not the author of the design or had not duly acquired it or the right to enter himself as registered proprietor in any of the manners set forth in Section 61. (If the defendant can state who was the author let him do so.)
- (b) That the design was not fit subject-matter for registration, and was not new, or original, but was similar to, or a copy or substantially a copy of, a design or designs published prior to the date of registration by &c. (*here set forth all prior publications of similar designs with full particulars*).
- (c) That prior to the date of registration the design had been publicly used within the realm by &c. (*here set forth all instances of prior user with names, addresses, and dates*). If it is alleged that the design is of common knowledge, particular instances of prior publication or user need not be given (*Holliday v. Heppenstall*, [1889] 6 R. C. P. 320).
- (d) Any instances of sales of unmarked or insufficiently marked goods made by the plaintiff since registration, if such sales have taken place.

Pages or sheets of drawings in books or publications should be given, and full circumstances of prior user, with dates, names, and addresses.

Summons
for further
and better
particulars.

If the defendant's particulars of objections are thought by the plaintiff to be insufficient, he may apply by summons in chambers for further and better particulars, and if thought fit, following the analogous practice in Patent cases, such further and better particulars will be ordered.

Particulars
may be
amended
from time
to time on
terms.

In the event of the defendant desiring to amend his particulars of objections so as to include, for example, some anticipatory matters not cited in the original particulars, he may by summons obtain leave to do so, but the usual terms founded upon similar applications in Patent actions will be imposed—viz. that the plaintiff shall have leave to elect to discontinue, and if he elects so to do that he shall have the costs from the date of the first delivery of the defendant's particulars to the delivery of the amended particulars. This was held in the Designs action of *Morris Wilson v. Corentry Machinists' Co.* ([1891] 8 R. P. C. 353), following the order made in the Patent case of *Edison Telephone Co. v. India Rubber Co.* ([1881] L. R. 17 Ch. D. 137). But the Judge has absolute discretion and may make such an order unconditionally, and his discretion will not be interfered with by the Court of Appeal (*Woolley v. Broad*, [1892] 9 R. P. C. 429; *Wilson v. Wilson*, [1899] 16 R. P. C. 315).

Judge has
absolute
discretion.

Anticipa-
tions to be
relied on
must be
pleaded.
But this
rule might
be relaxed.

No alleged anticipation of a registered design can be relied on at the trial unless pleaded (*Walker v. Hecla Foundry Co.*, [1887] 5 R. P. C. 71). In *Rivett v. Grimshaw* ([1894] 11 R. P. C. 351) the defendants were allowed to give in evidence particulars of an alleged anticipation of which the plaintiffs only had notice a short time before the trial. Day, J., held that sufficient notice had been given, and admitted the evidence, but it would be extremely unsafe to consider this as a precedent.

Order for
inspection.

Application for inspection may be made at any time during the course of an action, and in the case of the plaintiff even before delivery of the statement of claim (*Drake v. Muntz Metal Co.*, [1886] 3 R. P. C. 43). A defendant may apply at any time after entering appearance (Order L. of the Rules of the Supreme Court, Rule 6). In both cases, as a rule, notice must be given to the opposite party. Applications for such Orders are made

in the Chancery Division by motion in Court or summons at chambers; in the King's Bench Division by summons at chambers (Order LIV. of the Rules of the Supreme Court, Rule 12; Order LV., Rule 15). To obtain an order for inspection the plaintiff must show by affidavit that he has a case to be tried and that inspection is necessary to place the case properly before the Court; otherwise inspection will be refused (*Batley v. Kynoch*, [1874-5] L. R. 20 Eq. 632). Mere suspicion will not justify inspection (*Germ Co. v. Robinson*, [1884] 1 R. P. C. 217), nor will the Court order a roving inspection (*Cheetham v. Oldham*, [1888] 5 R. P. C. 617). As Lord Halsbury, L. C., said in *MacDougall v. Partington* ([1890] 7 R. P. C. 472): "The Court is always reluctant to grant inspection where it may be injurious to one side, and where the right depends on a question which has yet to be determined in the cause." Where the party upon whom the Order is sought to be imposed avers that inspection may disclose trade secrets, although this will not prevent the Court from making the Order, precautions may be taken by having the inspection made by some independent person, who will report to the Court, and whose report is private and confidential (*Plating Co. v. Farquharson*, [1883] Griff. P. C. 187). Where an Order for inspection has been made the inspectors are usually specified by name, and the notice to be given to the opposite party is also indicated.

Mere suspicion not enough to justify inspection order.

No order made that may prejudice business of other party.

Order XXXI. of the Rules of the Supreme Court deals with the practice in discovery and inspection. As it is the rule that in actions for statutory penalties interrogatories by the plaintiff tending to show that the defendant is liable to such penalties are disallowed, in an action for infringement of a design brought for penalties under Section 58 of the Act, interrogatories administered to the defendant need not be answered (*Saunders v. Wiel*, [1892] 9 R. P. C. 459). It seems, from the remarks of Lord Esher, M. R., in the latter case, that the remedies under Section 58 and 59 are distinct, and the plaintiff must elect under which he is going. In an action for damages under Section 59, apparently interrogatories may be administered.

Where penalties are claimed interrogatories not allowed.

Practice in administering interrogatories.

Leave must be obtained from the Court or a Judge before interrogatories can be delivered by either party, and the party interrogating must pay at least £5 into Court before delivery. Application may be made by summons at chambers. As a rule, in the Chancery Division leave is only given to the plaintiff to interrogate after he has delivered his statement of claim, and to the defendant after delivery of his defence.

Limits of interrogatories.

The plaintiff must not seek discovery of the defendant's case, but the defendant may ask anything tending to destroy the plaintiff's claim (*Hoffmann v. Postill*, [1869] L. R. 4 Ch. 673). A secretary or other officer answering on behalf of a corporate body need only answer as to information acquired in the course of his employment in the company, and not as to information acquired apart from his function (*Welsbach Incandescent Gas Light Co. v. New Sunlight Incandescent Lamp Co.*, [1900] 17 R. P. C. 401).

Answers to interrogatories.

When interrogatories are answered, they must be answered by affidavit filed within ten days or such other time as the Judge may allow. They must be answered fully, and everything tending to show the fact of infringement must be set out in the answers.

Interlocutory injunctions.

An interlocutory injunction to restrain infringement may be applied for immediately upon issue or service of the writ. If the evidence of infringement is sufficient to convince the Court, and it is apparent that the plaintiff would suffer seriously from a continuance of the wrong, an interlocutory injunction will be granted, or at all events the defendant will be ordered to keep an account. If the injunction is granted, the plaintiff must give the usual undertaking as to damages. But if the title of the plaintiff is questioned, or the defendant is able to show that he has on any ground a good *prima facie* defence, or if the plaintiff has been guilty of undue delay or other laches, no interlocutory injunction will issue.

Costs.

In accordance with the ordinary rule, costs in Designs actions will usually follow the event. But, as in Patent cases, this rule may be and often is modified by circumstances. Thus, in *Sherwood v. Decorative Tile Co.* ([1887] 4 R. P. C. 207), where the Court was of opinion that a

Judge's discretion as to costs.

good deal of the successful plaintiff's evidence was unnecessary and improper, the defendants were ordered to pay two thirds only of the plaintiff's costs. And where, as in *Blank v. Footmann* ([1888] 5 R. P. C. 653), the plaintiffs failed in their action, but succeeded on one issue, they got the costs of that issue. In *Winfield v. Snow* ([1890] 8 R. P. C. 15) only one issue was tried, and the defendants were successful on that, with the result that they got the general costs of the action and of the issue upon which they had succeeded, the costs of the untried issues being reserved. In *Birkin v. Pratt* ([1895] 12 R. P. C. 371) an unsuccessful plaintiff got the costs of the issue of want of novelty, the defendant succeeding on the issue of non-infringement.

The innocent retailer pushed into an action against his will, and after he had done all he could to avert it, usually escapes costs. Thus, in *Smith v. Lewis Roberts & Co.* ([1888] 5 R. P. C. 611) it was held that an innocent retailer who had sold in ignorance of the registered design, but who has neither sold nor threatened to sell after notice given, is entitled to have any action brought against him dismissed with costs; and this was also held in *Jan v. Grossman* ([1895] 12 R. P. C. 537), although the defendant (an innocent retailer), while promising to sell no more of the goods, declined to give a formal undertaking to that effect.

Costs in the case of an innocent retailer.

Smith v. Lewis Roberts & Co.

Jan v. Grossman.

There is no provision in the Designs portion of the Act giving a remedy in the case of threats of legal proceedings issued by the proprietor of a registered design, such as exists in the Patents portion relative to threats emanating from the proprietor of Letters Patent.

No statutory provision as to threats.

If the threats in respect of a registered design constitute a trade libel or wrongfully interfere with or prejudice a man in his business he has a remedy at Common Law, but not under the Statute.

Trade libel.

Either party may appeal to the Court of Appeal and thence to the House of Lords.

Appeal.

CHAPTER VIII.

RECTIFICATION OF THE REGISTER.

The
Register
of Designs.

SUB-SECTIONS 1 and 2 of Section 55 of The Patents, Designs, and Trade Marks Act, 1883, provides as follows:—

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

(2) The Register of Designs shall be *prima facie* evidence of any matters by this Act directed or authorised to be entered therein.

Section 90.
Provisions
for rectify-
ing the
Register.

Again, by Section 90, Sub-section 1, it is provided that—

90. (1) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person, or of any other particulars from any Register kept under this Act, or by any entry made without sufficient cause in any such Register, make such order for making, expunging, or varying the entry as the Court thinks fit, or the Court may refuse the application, and in either case may make such order with respect to the cost of the proceedings as the Court thinks fit.

The Court.

“The Court” means the High Court of Justice in England, or the Chancery Court of the County Palatine of Lancaster when the registered proprietor is within its jurisdiction. In *Bayer v. Connell & Co.* ([1897] 14 R. P. C. 275) the Irish Court held that it had no jurisdiction to interfere with the Register; but in *Cowie v. Herbert* ([1897] 14 R. P. C. 436) the Court of Session in Scotland (Inner House) did not doubt that it possessed such jurisdiction.

Applica-
tions to
rectify.

Applications to rectify the Register are usually made by motion, and sometimes, but more rarely, by summons, and are generally made on the Chancery side.

The question as to who may be rightly considered a "person aggrieved" within the Statute has already been considered in Chapter IV. of the portion of this work devoted to Trade Marks; and practically as concerns Designs the issues are the same. In general terms when a person is hampered in his business, or prevented from engaging in it to the fullest legitimate extent, or when his customers are or may be intimidated or hindered from dealing with him by the existence of a design improperly on the Register, then he is a person aggrieved. He is also a person aggrieved if he is the registered proprietor of a similar design for the same or substantially the same goods, and standing on the Register in priority to the design he complains of. Again, he is a "person aggrieved" if he has been sued for infringement of the design. It is therefore no uncommon incident in an action for infringement for the defendant to move to expunge the design from the Register. Once he has attained the *locus standi* of a person aggrieved, he may in his application to rectify the Register use all of the grounds upon which the registration of a design may be cancelled, or in respect of which the original registration might have been refused. For instance, he might contend that the person registered as proprietor is not and never was properly so; *e.g.* that he is neither the author, nor purchaser, nor licensee to apply the design to the manufactured articles. Or he may show that the registration of the design is invalid for want of novelty or from prior user or publication or from want of subject-matter, or that goods to which the registered design has been applied have been sold unmarked or improperly marked, or that being a design manufactured and applied abroad it had not been used in this country within six months of its registration here (Section 54). With regard to this section it might be asked whether mere importation of the goods from abroad would constitute "use" within the section?

It will be remembered that in the Trade Marks portion of this work it was shown that an applicant to expunge an entry in the Trade Marks Registry, even when he has proved to the satisfaction of the Court that the mark is

Persons entitled to make application to rectify.
"Persons aggrieved."

Prior registered proprietor.

Defendant in an action.

Grounds of rectification.

No home user of design.

Substitution of rightful for wrongful owner on the Register.

really his own, cannot successfully include in the terms of his motion a request to have his name substituted for that of the originally wrongfully registered proprietor. The mark must be expunged and the proper owner may then make an application for re-registration on his own behalf. This practice may be defended on the ground that mere prior publication and prior user, especially when wrongful, does not injure the validity of a trade mark at all. Besides, the owner has his Common Law rights to fall back upon, which are non-existent in the case of a design. In a design the prior user and publication by the original wrongful proprietor would be fatal to validity if the design were re-registered by the true owner after ousting the wrongful holder. An assignment from the wrongful proprietor to the true owner would not do, because the title of the assignor would be bad. The only equitable alternative is that the name of the applicant who has proved his right should be substituted for that of the wrongful holder, as specially provided for in the case of patents (see Section 26, Sub-section 8), so as to preserve the validity in the hands of the new owner. This was done in the case of *Grocott's Design* ([1899] 17 R. P. C. 139), the first of its kind. Kekewich, J., and counsel representing the Comptroller, seemed both to be under the impression that had the original registration been fraudulent instead of being inadvertent (as it was in the case cited) it would have been altogether bad, and nothing could have been done but to strike it off. But surely it is a hard saying that the true author is to be placed in a worse position by the fraud of his supplanter than by his inadvertence. However, the writer may be mistaken in this view of the meaning of the Court, and it is but just to point out that in *Heinrich's Design* ([1891] 9 R. P. C. 73) the motion was to rectify the Register by striking out Heinrich's name and substituting that of the applicant. The applicant failed to convince the Court that he was the true author of the design, but there seems at no time to have been any question of the admissibility or propriety of the terms of the motion, though fraud was necessarily alleged.

Grocott's Design.
Fraudulent as compared with inadvertent registration.

Heinrich's Design.

When a change occurs in the name of a registered proprietor, the Register will be correspondingly altered on application to the Comptroller. Formerly it was the practice to apply to the Court for an order directing the Comptroller to make the alteration. But in *re New Ormonde Cycle Co.'s Mark* ([1896] 13 R. P. C. 475), which was the case of a limited company having changed its name, North, J., held that it was not competent for the Court to make any such order under Section 92, but that the Comptroller had power to make the alteration under Section 87. It would therefore seem that no application to the Court is necessary.

Power of
Comp-
troller
to alter
changed
name of
proprietor
on Register.

Following the practice in Trade Marks, an application to rectify the Register of Designs cannot be made the subject-matter of a counter claim in an action for infringement. It must be separately made by motion or summons. When the Comptroller is made a party to the proceedings, as is usually the case, he must have four clear days' notice of the application. The registered proprietor should also be made a respondent to the motion if within the jurisdiction. If without the jurisdiction the registered proprietor should be served by letter with a copy of the notice of motion informing him of the day fixed for hearing. For notice to be given in this manner, under such circumstances, the sanction of the Court is not necessary.

Application
to rectify
Register
cannot be
made by
counter-
claim in
action.

Service of
respondent
without the
juris-
diction.

If rectification is ordered, the person in whose favour it is made should leave an office copy of the order with the Comptroller, who will make the necessary alteration in the Register.

An appeal lies from any decision of the Court of First Instance to the Court of Appeal and to the House of Lords.

Appeal.

DESIGNS RULES, 1890, 1893, & 1898

(CONSOLIDATED).

NOTE.—*The Rules repealed are printed in italics. The substituted matter from the Rules of 1893 and 1898 is in heavier type.*

BY VIRTUE of the provisions of The Patents, Designs, and Trade Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following Rules:—

PRELIMINARY.

Citation of Rules.

1. These Rules may be cited as The Designs Rules, 1890, and shall come into operation from and immediately after the 31st day of March, 1890.

Note.—The Designs Rules of 1893 are cited as such, and came into operation from the 30th November, 1893; those of 1898 came into operation on the 15th September, 1898.

INTERPRETATION.

Interpretation.

2. In the construction of these Rules any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively.

FEEES.

Fees.

3. The fees to be paid under the said Act, so far as it relates to applications for and registration of designs, shall be the fees specified in the First Schedule hereto.

FORMS.

Repealed.

[4. *An application for the registration of a design shall be made in the Form E or Form O in the Second Schedule hereto. The remaining Forms in such Schedule may be used in all cases to which they are applicable.*]

4. An application for the registration of a design for articles not being lace shall be made in the Form E or Form O in the Second Schedule hereto. An application for one design to be applied to lace shall be made in the Form E1 in the Second Schedule hereto, and for one design to be applied to a set of lace articles shall be made in the Form O1 in the Second Schedule hereto. A request for registration of the name of any subsequent proprietor of a lace design or set of lace designs shall be made in the Form K1 in the Second Schedule hereto. The remaining Forms in such Schedule may be used in all cases to which they are applicable.

Forms.
Designs
Rules,
1898.

CLASSIFICATION OF GOODS.

5. For the purposes of the registration of designs and of these Rules, goods are classified in the manner appearing in the Third Schedule hereto.

Classifi-
cation of
goods.

APPLICATION FOR REGISTRATION.

[6. All communications between an applicant for the registration of a design and the Comptroller or the Board of Trade, as the case may be, may be made by or through an agent duly authorised to the satisfaction of the Comptroller.]

Agents.

6. All communications between an applicant for the registration of a design and the Comptroller or the Board of Trade, as the case may be, may be made by or through an agent duly authorised to the satisfaction of the Comptroller, but the Comptroller shall not be bound to recognise as such agent, or to receive further communication from any person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the Register of Patent Agents kept under the provisions of The Patents, Designs, and Trade Marks Act, 1888, relating to the registration of Patent Agents, and not since restored.

Designs
Rules,
1898.

7. An application for the registration of a design shall, with the prescribed fee, be left at the Patent Office (Designs Branch), or be sent prepaid by post, addressed to the Comptroller at the Patent Office (Designs Branch), 25 Southampton Buildings, Chancery Lane, London.

Address of
Comp-
troller.

Size of
papers.

8. An application for the registration of a design, and all drawings, sketches, photographs, or tracings of a design, and all other documents sent to or left at the Patent Office (Designs Branch), or otherwise furnished to the Comptroller or to the Board of Trade, shall be written, printed, copied, or drawn upon strong wide-ruled foolscap paper (on one side only), of the size of 13 inches by 8 inches, leaving a margin of not less than one inch and a half on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand.

The Comptroller may in any particular case vary the requirements of this Rule as he may think fit.

Sketches
and
drawings.

9. An application for the registration of a design shall be accompanied by a sketch or drawing, or by three exactly similar drawings, photographs, or tracings of the design, or by three specimens of the design, and shall, in describing the nature of the design, state whether it is applicable for the pattern or for the shape or configuration of the design, and the means by which it is applicable.

Nature of
design.

When sketches, drawings, or tracings are furnished they must be fixed.

When the articles to which designs are applied are not of a kind which can be pasted into books, drawings, photographs, or tracings of such designs shall be furnished.

Certificate
of registra-
tion.

10. If the Comptroller determines to register a design, he shall as soon as may be send to the applicant a certificate of such registration in the prescribed form, sealed with the seal of the Patent Office.

Applica-
tions may
be sent by
post.

11. Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the Comptroller or to any other person under these Rules may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

EXERCISE OF DISCRETIONARY POWERS.

12. Before exercising any discretionary power given to the Comptroller by the said Acts adversely to the applicant for registration of a design the Comptroller shall (if so required by the applicant within one month from the date of the Comptroller's objection) give the applicant an opportunity of being heard personally or by his agent by sending the applicant ten days' notice of a time when he may be so heard.

Hearing
by Comp-
troller.

13. Within five days from the date when such notice would be delivered in the ordinary course of post, the applicant shall notify to the Comptroller whether or not he intends to be heard upon the matter.

Hearing
by Comp-
troller.

14. The decision or determination of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified to the applicant.

Notification
of Comp-
troller's
decision.

APPEAL TO THE BOARD OF TRADE.

15. Where the Comptroller refuses to register a design, and the applicant intends to appeal to the Board of Trade from such refusal, he shall, within one month from the date of the decision appealed against, leave at the Patent Office (Designs Branch) a notice of such his intention.

Notice of
appeal to
Board of
Trade.

16. Such notice shall be accompanied by a statement of the grounds of appeal, and of the applicant's case in support thereof.

Statement
on appeal.

17. The applicant shall forthwith, on leaving such notice, send a copy thereof to the Secretary of the Board of Trade, No. 7 Whitehall Gardens, London.

Notice to
Secretary
of Board
of Trade.

18. The Board of Trade may thereupon give such directions (if any) as they may think fit for the purpose of the hearing of the appeal for the Board of Trade.

Directions
by Board of
Trade.

19. Seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing of the appeal, shall be given to the Comptroller and the applicant.

Notice of
time of
hearing.

REGISTER OF DESIGNS.

Registering
design.

20. Upon the sealing of a certificate of registration the Comptroller shall cause to be entered in the Register of Designs the name, address, and description of the registered proprietor, and the date upon which the application for registration was received by the Comptroller, which day shall be deemed to be the date of the registration.

Subsequent
proprietors.

21. Where a person becomes entitled to the copyright in a registered design, or to any share or interest therein, by assignment, transmission, or other operation of law, or where a person acquires any right to apply the design either exclusively or otherwise, a request for the entry of his name in the Register as such proprietor of the design, or as having acquired such right, as the case may be (hereinafter called "the claimant"), shall be addressed to the Comptroller, and left at the Patent Office (Designs Branch).

Signature
to request.

22. Every such request shall, in the case of an individual, be made and signed by the person requiring to be registered as proprietor; and in the case of a firm or partnership, by some one or more members of such firm or partnership, or, in either case, by his or their agent respectively, duly authorised to the satisfaction of the Comptroller; and in the case of a body corporate, by their agent, authorised in like manner.

Particulars
in request.

23. Every such request shall state the name, address, and description of the claimant, and the particulars of the assignment, transmission, or other operation of law by virtue of which the request is made, so as to show the manner in which and the person or persons to whom the design has been assigned or transmitted, or the person or persons who has or have acquired such right as aforesaid, as the case may be.

Statutory
declaration
with
request.

24. Every such request shall be accompanied by a statutory declaration, to be thereunder written, verifying the several statements therein, and declaring that the

particulars above described comprise every material fact and document affecting the proprietorship of the design or the right to apply the same, as the case may be, as claimed by such request.

25. The claimant shall furnish to the Comptroller such other proof of title as he may require for his satisfaction. Proof of title if required.

26. A body corporate may be registered as proprietor by its corporate name. Corporate name.

27. Four clear days' notice of every application to the Court under Section 90 of The Patents, Designs, and Trade Marks Acts, 1883 to 1888, for rectification of the Register of Designs, shall be given to the Comptroller. Notice to Comptroller of application to rectify Register.

28. Where an order has been made by the Court, under Section 90 of the said Acts, the person in whose favour such order has been made shall forthwith leave at the Patent Office an office copy of such order. The Register shall thereupon be rectified, or the purport of such order shall otherwise be duly entered in the Register, as the case may be. Notice of order of Court.

POWER TO DISPENSE WITH EVIDENCE.

29. Where under these Rules any person is required to do any act or thing, or to sign any document, or make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Comptroller or at the Patent Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence. Comptroller's discretion as to evidence.

AMENDMENTS.

Amend-
ments.

30. Any document, drawings, sketches, or tracings for the amending of which no special provision is made by the said Act may be amended, and any irregularity in procedure which, in the opinion of the Comptroller, may be obviated without detriment to the interests of any person may be corrected, if the Comptroller think fit, and upon such terms as he may direct.

ENLARGEMENT OF TIME.

Enlarge-
ment of
time.

31. The time prescribed by these Rules for doing any act or taking any proceeding thereunder may be enlarged by the Comptroller, if he think fit, and upon such terms as he may direct.

MARKING GOODS.

Registration
mark.

[32. *Before the delivery on sale of any article to which a registered design has been applied, the proprietor of such design shall, if such article is included in any of the classes one to twelve in the Third Schedule hereto, cause each such article to be marked with the abbreviation "RD" and the number appearing on the certificate of registration, and shall, if such article is included in the classes thirteen or fourteen in the Third Schedule hereto, cause each such article to be marked with the abbreviation "REGD."*

Registra-
tion mark.Designs
Rules,
1893.

32. Before delivery on sale of any article to which a registered design has been applied, the proprietor of such design shall, if such article is included in Class 13 or Class 14 in the Third Schedule hereto, cause each such article to be marked with the abbreviation "Regd.," and shall, if such article is included in any of the Classes 1 to 12 in the Third Schedule hereto, cause each such article to be marked with the abbreviation "Rd.," and also, in the case of articles other than lace, with the number appearing on the certificate of registration.

INSPECTION.

33. On such days and during such hours as the Comptroller shall from time to time determine and notify by a placard posted at the Patent Office any person paying the prescribed fee may, on production of the number of any design of which the copyright has ceased, inspect such design, and any person paying the prescribed fee may take a copy or copies of such design.

Office hours.

CERTIFICATE BY COMPTROLLER.

34. Where a certificate is required for the purpose of any legal proceeding or other special purpose as to any entry, matter, or thing which the Comptroller is authorised by the said Act or these Rules to make or do, the Comptroller may, on a request in writing and on payment of the prescribed fee, give such certificate, which shall also specify on the face of it the purpose for which it has been requested as aforesaid.

Certificate in legal proceeding.

SEARCHES ON PRODUCTION OF SKETCH OF DESIGN.

35. The Comptroller may, on receipt of the prescribed fee, make searches among the designs registered at the Patent Office, and inform any person requesting him so to do whether a particular design produced by such person, and to be applied to goods in any particular class, is or is not identical with or an obvious imitation of any registered design applied to such goods of which the copyright is still existing.

Search.

INDUSTRIAL AND INTERNATIONAL EXHIBITIONS.

36. Any person desirous of exhibiting a design, or any article to which a design has been applied, at an Industrial or International Exhibition, or of publishing a description of a design during the period of the holding of the Exhibition, shall, after having obtained from the Board of Trade

Notice of exhibition.

a certificate that the Exhibition is an industrial or international one, give to the Comptroller seven days' notice in writing of his intention to exhibit the design or article, or to publish a description of the design, as the case may be.

For the purpose of identifying the design in the event of an application to register the same being subsequently made, the applicant shall furnish to the Comptroller a brief description of the nature of the design, accompanied by a sketch or drawing thereof, and such other information as the Comptroller may in each case require.

REPEAL.

Repeal of
previous
Rules.

37. All general Rules as to the registration of designs heretofore made by the Board of Trade under The Patents, Designs, and Trade Marks Acts, 1883 to 1888, and in force on the 31st day of March, 1890, shall be, and they are hereby, repealed, as from that date, without prejudice, nevertheless, to any proceeding which may have been taken under such Rules.

M. E. HICKS-BEACH,
President of the Board of Trade.

31st March, 1890.

FIRST SCHEDULE

(Amended in conformity with The Designs Rules, 1893.)

FEES.

	£	s.	d.
1. On application to register one design to be applied to single articles in each class, not being lace, and except articles in Classes 13 and 14 ... (<i>Form E</i>)	0	10	0
2. On application to register one design to be applied to lace or to single articles in Classes 13 and 14 ... (<i>Form E1 or E</i>)	0	1	0
3. On application to register one design to be applied to a set of articles, not being lace, for each class of registration ... (<i>Form O</i>)	1	0	0
3a. On application to register one design to be applied to a set of lace articles ... (<i>Form O1</i>)	0	2	0
4. On notice of appeal to Board of Trade against refusal of Comptroller to register ... (<i>Form F</i>)	1	0	0
5. Copy of certificate of registration, each copy (<i>Form H</i>)	0	1	0
6. On request for Certificate of Comptroller for legal proceedings or other special purpose (<i>Form I</i>)	0	5	0
7. On request to enter name of subsequent proprietor (<i>Form K</i>)	{ Same as registration fee.		
8. On notice to Comptroller of intended exhibition of an unregistered design ... (<i>Form L</i>)	0	5	0
9. Inspection of design in any case in which inspection is permitted by The Patents, Designs, and Trade Marks Acts, 1883 to 1888, and the Designs Rules thereunder, for each quarter of an hour ...	0	1	0
10. Copy of one such design ...	{ Cost according to agreement.		

		£	s.	d.
11. On request to correct clerical error ...	(Form M)	0	5	0
12. On request for search under Section 53	(Form N)	0	5	0
13. On request to enter new address ...	...	0	5	0
14. For office copy, every 100 words (but never less than 1s.)		0	0	4
15. For certifying office copies, MSS. or printed...	...	0	1	0

NOTE.—The term “set” to include any number of articles ordinarily on sale together, irrespective of the varieties of size and arrangement in which the particular design may be shown on each separate article.

M. E. HICKS-BEACH,

President of the Board of Trade.

*Approved:—*R. E. WELBY,

For the Lords Commissioners of Her Majesty's Treasury.

31st March, 1890.

SECOND SCHEDULE.

FORMS.

In this Schedule the different Forms are set out *in extenso*; but as these are printed, stamped, and on sale at most post-offices and law stationers it has been considered unnecessary to set them out here. In the foregoing First Schedule the identifying letters of the chief Forms are annexed to the corresponding fees.

THIRD SCHEDULE.

CLASSIFICATION OF ARTICLES OF MANUFACTURE AND SUBSTANCES.

Classes.

1. Articles composed wholly or chiefly of metal, not included in Class 2.
2. Jewellery.
3. Articles composed wholly or chiefly of wood, bone, ivory, papier mâché, or other solid substances not included in other classes.
4. Articles composed wholly or chiefly of glass, earthenware, or porcelain, bricks, tiles, or cement.
5. Articles composed wholly or chiefly of paper (except hangings).
6. Articles composed wholly or chiefly of leather, including book-binding, of all materials.
7. Paper-hangings.
8. Carpets and rugs in all materials, floorcloths, and oilcloths.
9. Lace, hosiery.
10. Millinery and wearing apparel, including boots and shoes.
11. Ornamental needlework on muslin or other textile fabrics.
12. Goods not included in other classes.
13. Printed or woven designs on textile piece goods.
14. Printed or woven designs on handkerchiefs and shawls.

M. E. HICKS-BEACH,
President of the Board of Trade.

31st March, 1890.

APPENDIX A.

INTERNATIONAL CONVENTION

FOR THE

Protection of Industrial Property (1883)

AS AMENDED 14TH DECEMBER, 1900.

CONSOLIDATED.

THE International Convention was initiated and concluded by the several assenting Powers for the purpose of affording mutual protection to their respective subjects and citizens in sustaining their rights, chiefly, to the abstract species of industrial property constituted by Patents for Inventions, Copyright in Designs, Trade Marks, and Trade Names. The original text of the Convention is in the French language, and the following excerpt is from the authorised translation.

The opening paragraphs rehearse the names and titles of the subscribing potentates and plenipotentiaries, and are of but slight interest to the general reader. Since the signature several changes have taken place, and it will serve a more useful purpose to give the complete list of the Governments which are now parties to the Convention. These are as follows:—America (U.S.), Belgium, Brazil, Cuba, Denmark with the Farøe Islands, France and her Colonies, Germany, Great Britain, Holland with East Indian Colonies, Italy, Japan, Mexico, New Zealand, Norway, Portugal with the Azores and the Madeiras, Queensland, Servia, Spain, Sweden, Switzerland, and Tunis.

The countries which are not members of the Convention but which have concluded mutual arrangements with Great Britain under Section 103 of the Patent Act of 1883 in terms akin to those of the Convention are as follows:—Paraguay and Uruguay, Roumania, Ecuador, Greece (Trade Marks and Designs only), the Republic of Honduras, Tasmania, and Western Australia.

The text of the Convention consists of nineteen Articles, and is followed by a Final Protocol explaining and qualifying the terms of these Articles. In the following copy the additional matter and amendments agreed to at the Conference of the 14th December, 1900, are introduced and consolidated with the original text at their proper places. The new additions and alterations are printed in heavier type.

ARTICLE I. contains a list of the original subscribing Powers, which may now be replaced by the list given in the foregoing introduction.

ARTICLE II.—The subjects or citizens of each of the Contracting States shall, in all the other States of the Union, as regards patents, industrial designs or models, trade marks and trade names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each State.

ARTICLE III.—Subjects or citizens of States not parties to the Union who are domiciled or have **effective and genuine** industrial or commercial establishments in the territory of any of the States of the Union shall be assimilated to the subjects or citizens of the Contracting States.

ARTICLE IV.—Any person who has duly applied for a patent, industrial design or model, or trade mark in one of the Contracting States shall enjoy, as regards registration in the other States, and reserving the rights of third parties, a right of priority during the periods hereinafter stated. Consequently, subsequent registration in any of the other States of the Union before expiry of these

periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another registration, by publication of the invention or by the working of it, by the sale of copies of the design or model, or by use of the trade mark. The above-mentioned terms of priority shall be twelve months for patents, and four months for industrial designs and models and trade marks.

Article IV. bis.—Patents applied for in the various Contracting States by persons admitted to the benefits of the Convention under the terms of Articles II. and III. shall be independent of patents obtained for the same invention in other States, whether parties to the Union or not. This provision shall apply to patents in existence at the time of its being put in force. The same thing shall apply, in the event of the accession of other States, to patents in existence on either side at the time of accession.

ARTICLE V.—The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the States of the Union shall not entail forfeiture. Nevertheless, the patentee shall remain bound to work his patent in conformity with the laws of the country into which he introduces the patented objects.

ARTICLE VI.—Every trade mark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the Union. That country shall be deemed the country of origin where the applicant has his chief seat of business. If this chief seat of business is not situated in one of the countries of the Union, the country to which the applicant belongs shall be deemed the country of origin. Registration may be refused if the objects for which it is solicited is considered contrary to morality or public order.

ARTICLE VII.—The nature of the goods on which the trade mark is to be used can in no case be an obstacle to the registration of the trade mark.

ARTICLE VIII.—A trade name shall be protected in all the countries of the Union, without necessity of registration, whether it form part or not of a trade mark.

ARTICLE IX.—All goods illegally bearing a trade mark or trade name may be seized on importation into those States of the Union

where this mark or name has a right to legal protection. The seizure shall be effected at the request of either the proper Public Department or of the interested party, pursuant to the internal legislation of each country. In States whose legislation does not allow seizure on importation this seizure may be replaced by prohibition of importation. The authorities shall not be bound to effect seizure in the case of goods in transit.

ARTICLE X.—The provisions of the preceding Article shall apply to all goods falsely bearing the name of any locality as indication of the place of origin, when such indication is associated with a trade name of a fictitious character or assumed with a fraudulent intention. Any producer, manufacturer, or trader who produces, manufactures, or trades in such goods, and who is established either in the locality falsely indicated as the place of origin or in the region in which this locality is situated, shall be deemed an interested party.

Article X. bis.—The subjects or citizens of the States parties to the Convention (Articles II. and III.) shall enjoy in all the States of the Union the protection accorded to native subjects or citizens against dishonest competition.

ARTICLE XI.—The High Contracting Parties shall, in conformity with the legislation of each country, grant temporary protection to patentable inventions, to industrial designs or models, and trade marks, for articles exhibited at official or officially recognised International Exhibitions which have been organised in the territory of one of them.

ARTICLE XII.—Each of the High Contracting Parties agrees to establish a special Government Department for Industrial Property, and a central office for communication to the public of patents, industrial designs or models, and trade marks.

ARTICLE XIII.—An International Office shall be organised under the name of “Bureau International de l’Union pour la Protection de la Propriété Industrielle” (International Office of the Union for the Protection of Industrial Property). This office, the expense of which shall be defrayed by the Governments of all the Contracting States, shall be placed under the high authority of the Central

Administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the Union.

ARTICLE XIV.—The present Convention shall be submitted to periodical revisions with a view to introducing improvements calculated to perfect the system of the Union. To this end conferences shall be successively held in one of the Contracting States by Delegates of the said States.

ARTICLE XV.—It is agreed that the High Contracting Parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of industrial property, in so far as such arrangements do not contravene the provisions of the present Convention.

ARTICLE XVI.—States which have not taken part in the present Convention shall be permitted to adhere to it at their request. Such adhesion shall be notified officially through the diplomatic channel to the Government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses and admission to all the advantages stipulated by the present Convention, and shall take effect one month after the despatch of the notification made by the Swiss Government to the other States of the Union, unless a later date has been indicated by the adhering State.

ARTICLE XVII.—The execution of the reciprocal engagements contained in the present Convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the constitutional laws of those of the High Contracting Parties, who are bound to procure the application of the same, which they engage to do with as little delay as possible.

ARTICLE XVIII.—The present Convention shall come into operation one month after the exchange of ratifications, and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the Government commissioned to receive adhesions. It shall only affect the denouncing State, the Convention remaining in operation as regards the other Contracting Parties.

ARTICLE XIX.—The present Convention shall be ratified, and the ratifications exchanged in Paris, within one year at the latest.

In witness whereof the respective plenipotentiaries have signed the same, and have affixed thereto their seals.

Done at Paris the 20th March, 1883.

[Here follow the signatures of the respective plenipotentiaries.]

The present additional Act shall have the same validity and duration as the Convention of the 20th March. 1883.

It shall be ratified and the ratifications deposited at Brussels at the Ministry of Foreign Affairs as soon as may be possible, and within eighteen months from the day of signature at latest.

It will come into force three months after the closing of the procès-verbal of deposit.

IN WITNESS whereof &c.

Done at Brussels in single copy the 14th December, 1900.

FINAL PROTOCOL.

[TRANSLATION.]

ON proceeding to the signature of the Convention concluded this day between the Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia, and Switzerland, for the Protection of Industrial Property, the undersigned plenipotentiaries have agreed as follows:—

1. The words “Industrial Property” are to be understood in their broadest sense; they are not to apply simply to industrial products properly so called, but also to agricultural products (wines, corn, fruits, cattle, &c.), and to mineral products employed in commerce (mineral waters &c.).

2. Under the word “Patents” are comprised the various kinds of industrial patents recognised by the legislation of each of the Contracting States, such as importation patents, improvement patents, &c.

3. The last paragraph of Article II. does not affect the legislation of each of the Contracting States as regards the procedure to be followed before the tribunals, and the competence of those tribunals.

3 bis. The patentee in each country shall not incur forfeiture for non-working until the expiration of a minimum period of three years commencing from the date of the deposit of his application in the country in question, and in case the patentee fail to give satisfactory reasons for his inaction.

4. Paragraph 1 of Article VI. is to be understood as meaning that no trade mark shall be excluded from protection in any State of the Union from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of that State: provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in the said country of origin. With this exception, which relates only to the form of the mark, and under reserve of the provisions of the other Articles of the Convention, the internal legislation of each State remains in force.

To avoid misconception it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order in the sense of the last paragraph of Article VI.

5. The organisation of the special Department for Industrial Property mentioned in Article XII. shall comprise, so far as possible, the publication in each State of a periodical official paper.

6. (*Relates to the expenses and ministerial conduct of the International Office, and is otherwise of no interest*).

7. The present Final Protocol, which shall be ratified together with the Convention concluded this day, shall be considered as forming an integral part of, and shall have the same force, validity, and duration as, the said Convention.

In witness whereof the undersigned plenipotentiaries have drawn up the present Protocol.

[Here follow the signatures of the respective plenipotentiaries.]

NOTE.—Before signing this Protocol the British Delegates put on record a declaration that the registration of Foreign Marks in the United Kingdom under the Convention was to be governed by the Statute and practice in force in this country.

APPENDIX B.

TWELVE SHORT PRECEDENTS OF AGREEMENTS, ASSIGNMENTS, LICENCES, MORTGAGES, &c., RELATING TO THE WORKING AND DISPOSAL OF LETTERS PATENT FOR INVENTION.

THE following short examples of Agreements, Assignments, Licences, and Mortgages may usefully serve as guides to persons engaged in preparing such documents.

Modern practice is all in favour of abridging and simplifying the prolixity which many draftsmen still affect. The Author has therefore, in drawing these Precedents, endeavoured to make them as concise as possible.

One notable new feature will be apparent in the examples of Agreements made prior to application: viz. the inclusion of a short description and sketch of the invention spoken of in the Agreement, so that the subject-matter of the Agreement may be identified with the subject-matter of the after application. This course is in all such cases advisable, lest it should be necessary afterwards to seek registration of the document, as such registration would inevitably be refused by the Comptroller if he should be unable to identify the invention referred to in the Agreement with the invention afterwards patented (*re Parnell's Patent*, [1888] 5 R. P. C. 126).

Form 1.

AGREEMENT between an Inventor who has been unable from want of means to develop or protect his Invention and a second party who proposes to furnish the necessary funds in consideration of receiving a share in the Patent to be applied for.

An Agreement made the day of , 19 ,
BETWEEN ANDREW BELL, of No. 15 Leaf Street, in the City of

Birmingham, Metal Worker, of the one part, and CHARLES DENDY, of No. 56 Horne Square, Birmingham aforesaid, Stockbroker, of the other part.

WHEREAS the said Andrew Bell claims to be the true and first inventor of certain "Improvements in Apparatus for directly recording and transcribing Speech and Sounds," which invention he has not been able, from want of means and opportunity, properly to develop and patent: AND WHEREAS the said Charles Dendy has agreed with the said Andrew Bell to provide and pay a sum of money not exceeding Five Hundred Pounds for the further development and patenting of the said invention, but subject to the conditions and for the consideration hereinafter expressed:

NOW THESE PRESENTS WITNESS and it is hereby agreed between the parties as follows:—

1. The said Charles Dendy shall, upon the signing of this Agreement, advance the sum of £100 for the purpose of purchasing materials, tools, and all necessary adjuncts to enable the said Andrew Bell to proceed with his experiments and trials for the further development of the said invention, and if necessary additional sums will be advanced by the said Charles Dendy from time to time to continue the said experiments and trials, it being hereby agreed that the total sum so advanced shall not exceed £250.

2. If when the said sum of £250 shall have been expended the invention is still not sufficiently developed or advanced to warrant an application for Letters Patent, the said Charles Dendy shall be at liberty to give notice to the said Andrew Bell of his intention to withdraw from this Agreement, and thereupon, within one week after such notice has been given, and when all liabilities incurred in connection with the development of the invention since the signing of this Agreement, and with the knowledge and consent of the said Charles Dendy, have been discharged by the said Charles Dendy, this Agreement shall cease and determine, and the invention will remain the sole property of the said Andrew Bell, who shall not be liable in respect of any sums expended by the said Charles Dendy in pursuance of this Agreement.

3. If the aforesaid experiments and trials should result in the proper and successful development of the invention, the said Andrew Bell shall forthwith make application for Letters Patent,

and shall thereafter and in due course file the Complete Specification and take all necessary steps to obtain the Letters Patent, but all at the expense of the said Charles Dendy.

4. As soon as the Letters Patent shall have been issued and obtained, the said Andrew Bell shall execute a proper assignment conveying one half share in the said Letters Patent and invention, and in all further improvements upon the same devised by him, to the said Charles Dendy, as consideration for the moneys expended and to be paid by him; and if after provision for all outstanding amounts and charges the full sum of £500 shall not have been already expended, then the undisbursed balance shall be paid on the execution of the said assignment by the said Charles Dendy to the said Andrew Bell.

5. The said assignment shall contain conditions limiting the mutual rights and liabilities of the co-owners of the Letters Patent, and shall provide that the invention and patent, however worked or disposed of, shall operate for the mutual benefit of the co-owners, and neither of the co-owners shall be at liberty to work or license the invention and patent rights for his own benefit alone, but shall account for his share of the profits to his co-owner, the patent or patents being held equally between them as tenants in common, and in like manner the annual taxes which fall due at or before the expiry of the fourth year of the patent or patents shall be paid by the parties hereto in equal shares.

6. In order to identify the invention forming the subject-matter of this Agreement with the invention forming the subject-matter of the patent or patents to be hereafter applied for under the conditions of this Agreement, and so to provide for the entry of this Agreement upon the Register at the Patent Office, if such entry should hereafter prove to be necessary or desirable in the interests of either of the parties, the following is a short description and sketch of the invention in its present condition:—*[Here insert a brief description and sketch of the invention.]*

7. It is to be understood that this Agreement shall have no effect as regards the obtaining, ownership, or working of any foreign patents for the invention, and that these may be obtained and dealt with by the said Andrew Bell at his own expense, and without reference to the said Charles Dendy.

8. The duties, liabilities, and benefits undertaken by and accruing to the parties to this Agreement shall extend and apply as far as possible to the executors, administrators, and assigns of either party.

IN WITNESS WHEREOF the within-named parties have hereunto set their hands the day and year first above written.

ANDREW BELL.

CHARLES DENDY.

NOTE.—*This document would not be capable of registration until after the patent had been applied for and issued, and then only if the invention indicated in the Agreement was, in the opinion of the Comptroller, the same as that covered by the patent. Registration would, however, only require to be sought in the event of the inventor refusing or failing to execute the assignment provided for in Paragraph 4.*

Form 2.

AGREEMENT between an Inventor whose Invention has not yet been protected, and a second party, not a co-Inventor, who is to join with him in applying for a Patent, and acquire one half share in consideration of his defraying the costs of applying for the Patent and paying the Inventor an additional sum of money upon the issue of the Patent.

An Agreement made the day of , 19 ,
BETWEEN EDWARD FISHER, of No. 13 Thacker's Row, Preston, in the
County of Lancashire, Hairdresser's Assistant, of the one part, and
GEORGE HARDY, of No. 35 Thacker's Row aforesaid, Grocer, of the
other part.

WHEREAS the said Edward Fisher claims to be the inventor of "An Improved Apparatus for Heating Curling Tongs by Electricity," of which the following is a brief description and sketch, inserted for the purpose of identifying the subject-matter of this Agreement with the subject-matter of the patent to be

hereafter applied for, that is to say [*here insert short description and sketch of the invention*]: AND WHEREAS the said George Hardy is desirous of acquiring one half interest in the said invention and in the patent to be hereafter obtained for the same, and the said Edward Fisher has agreed to sell one half share and interest as aforesaid for the sum and upon the conditions hereinafter set forth:

NOW IT IS HEREBY AGREED BETWEEN THE PARTIES AS FOLLOWS:—

1. Immediately upon the signing of this Agreement the said George Hardy will instruct a Patent Agent to make a search to ascertain the novelty of the said invention, and if no anticipatory publication is found, then the parties hereto will make application for a patent in their joint names, and will thereafter and in due course file the Complete Specification, and obtain issue of the Letters Patent. The costs of the search and all the charges incurred in applying for and obtaining the patent will be borne and paid by the said George Hardy as part consideration in respect of this Agreement, and no demand in respect thereof is to be made upon the said Edward Fisher, except that if the search discloses that the invention is not novel, and the matter proceeds no further, then the said Edward Fisher agrees to pay one half of the agent's charges incurred for making the search.

2. Immediately upon the issue of the Letters Patent and not later than one week thereafter, the said George Hardy will pay to the said Edward Fisher the sum of £100, which, together with the aforesaid search and patent fees, shall constitute the consideration paid by him for the half share in the patent, and the agent who obtains the Patent will be instructed to keep the Letters Patent in his hands until payment of this latter sum of £100 has been made.

3. The patent and every extension thereof shall be held and enjoyed by the parties hereto in equal shares as tenants in common, and all renewal fees and expenses connected with the maintenance of the patent when granted shall be borne equally by the parties. Neither of the parties shall be entitled to work the invention for his exclusive benefit nor to grant licences without accounting to his co-patentee or his representatives or assigns for one half share of all

net profits derived from such working or licensing. Either of the parties shall be at liberty to sell his share of the patent, and his assignee shall be subject to and be bound by the conditions and restrictions herein set forth.

4. Any further improvements in the invention which may be devised by either of the parties shall be disclosed to the other, and if considered advisable the same shall be patented in their joint names and at their joint expense.

5. Except where the context requires a different interpretation, or where from other causes such interpretation is not reasonable, any expression referring to either or both of the said parties to this Agreement shall extend and be construed to apply also as far as possible to the assigns of the person or persons so designated.

IN WITNESS &c.

NOTE.—*This Agreement would not require registration unless difficulties were to arise in respect of the Partition Clause in Paragraph 3.*

Form 3.

AGREEMENT between Joint Inventors and intending Co-applicants for the purpose of defining their respective interests, rights, and powers in, to, and under the Patent to be applied for.

Memorandum of Agreement made this day of , 19 , BETWEEN ISAAC JENKINS, of No. 17 Tuer Street, in the City of Manchester, Cotton Spinner, of the one part, and KENNETH LATHAM, of The Hawthorns, Palatine Road, Didsbury, near Manchester aforesaid, Engineer, of the other part.

WHEREAS the said parties have jointly invented certain "Improvements in Carding Engines," a sketch and description of which is contained in the Schedule attached thereto and in respect of which it is intended by the parties to make joint application for a patent: AND WHEREAS the said Isaac Jenkins has invented the chief portion of the said improvements, while the parts of the invention attributable to the said Kenneth Latham refer to less important details, it has been thought desirable before applying for a patent to define the respective shares and the terms and

conditions in and under which the said invention and any Letters Patent obtained for the same shall be possessed and worked by the parties:

NOW THESE PRESENTS WITNESS AND IT IS HEREBY AGREED AS FOLLOWS:—

1. The property constituted by the invention and Letters Patent to be hereafter applied for shall be considered as divided into three equal parts, of which two parts or thirds shall be the share of the said Isaac Jenkins, and the remaining one third the share of the said Kenneth Latham.

2. All expenses connected with ascertaining the novelty of the invention and obtaining Letters Patent therefor, and all renewal fees and charges connected with maintaining the patent in force when granted, shall be borne and paid by the parties hereto in the proportion of their respective interests: namely, two thirds by the said Isaac Jenkins and one third by the said Kenneth Latham.

3. In the same manner all net profits obtained as royalties or otherwise from the manufacture, sale, use, or licensing of the said invention and Letters Patent shall be shared by the parties hereto in the same proportions: that is to say, two thirds to the said Isaac Jenkins and one third to the said Kenneth Latham.

4. If either of the parties hereto should manufacture carding engines made in accordance with the said invention, a fixed royalty, to be mutually agreed upon, shall be chargeable upon each machine, and this royalty shall be shared between the parties in the indicated proportions.

5. Neither of the parties shall be entitled to grant licences without the consent in writing of the other, but either of the parties may sell his share of the invention and Letters Patent without the concurrence of the other, and the purchaser of the share so assigned shall be subject to the same conditions and restrictions and entitled to the same benefits as are imposed upon and secured to each of the original co-patentees under this Agreement.

6. The conditions of this Agreement shall apply, not only to the parties hereto, but also, as far as possible, to their assigns.

IN WITNESS &c.

SCHEDULE.

[To contain description and sketch of invention.]

Form 4.

AGREEMENT for sale of Patent, between Inventor who has obtained Provisional Protection and Purchaser who arranges to pay the purchase money in the following instalments; viz., One-third on signing Agreement; one-third on acceptance of Complete Specification; and the remainder on the issue of the Letters Patent.

An Agreement made the day of , 19 ,
 BETWEEN MATTHEW NASH, of No. 12 Prior's Court, in the City of London, Clerk, of the one part, and OLIVER PALEY, of Gracechurch Street, London aforesaid, Advertising Agent, of the other part.

WHEREAS the said Matthew Nash claims to be the inventor of, and has obtained Provisional Protection for, an invention entitled "Improvements in Means for Displaying Advertisements," No. 3698, dated 15th March, 1905, which invention and the patent to be obtained therefor he has agreed to sell to the said Oliver Paley :

NOW THESE PRESENTS WITNESS that in consideration of the sum of £150 paid by the said Oliver Paley to the said Matthew Nash as hereinafter set forth, he the said Matthew Nash DOTH HEREBY AGREE to sell and assign the said invention and Letters Patent to the said Oliver Paley, the purchase money aforesaid to be paid in the following instalments: that is to say, £50 upon the signing of these presents; £50 upon the acceptance of the Complete Specification (which the said Matthew Nash agrees forthwith, and at his own cost, to prepare and file); and £50 upon the sealing and issue of the Letters Patent.

PROVIDED that if the said Matthew Nash shall fail to file the Complete Specification in due course, the said sum of £50 paid upon the signing of this Agreement shall be returned by him to the said Oliver Paley, or if the said Complete Specification should be endorsed by the Comptroller with such references to prior patents as would, in the opinion of the said Oliver Paley, render any patent thereunder valueless, or should after acceptance be successfully opposed, then the said sum of £50 paid at the signing of this Agreement, and also the sum of £50 paid on the acceptance of the Complete Specification, shall be repaid by the said Matthew Nash to the said Oliver Paley, and these sums shall be recoverable as a simple contract debt. PROVIDED FURTHER that upon the sealing and issue of the Letters Patent

the said Matthew Nash shall forthwith execute a proper deed of assignment conveying the said invention and Letters Patent to the said Oliver Paley, or otherwise shall execute such further deeds or instruments as may be considered necessary to more fully vest and secure the said invention and Letters Patent in and to the said Oliver Paley, but at the cost of the said Oliver Paley. Any improvements upon the said invention which the said Matthew Nash may devise during the five years following the signing of this Agreement shall be disclosed and submitted to the said Oliver Paley or his assigns, and shall become his property, with the option of protecting the same by a patent if he or they should think fit, but at the cost of the said Oliver Paley or his assigns.

IN WITNESS &c.

NOTE.—*This document need not be registered. The Agreement should be replaced by the deed of assignment provided for, and that deed could be registered.*

Form 5.

AGREEMENT for Sale of Patent to Company, made between Patentee and Trustee for Syndicate about to form a Company; agreed consideration, partly cash, partly shares in Company; Patentee to be a Director in Company; Agreement to become void in the event of capital not being subscribed.

Memorandum of Agreement made this day of , 19 , BETWEEN WILLIAM SCOTT, of Brierfield Hall, Northwich, in the County of Chester (hereinafter called "the Vendor"), of the one part, and GEORGE SCATTERGOOD, of No. 3 Capstan Street, in the City of Liverpool, Solicitor (hereinafter called "the Trustee"), of the other part.

WHEREAS the said Vendor claims to be the true and first inventor of certain "Improvements in Pneumatic Wheel Tyres," for which he has obtained His Majesty's Letters Patent No. 14,036, under date the 12th February, 1902, and also certain foreign and colonial patents as set forth in the Schedule A hereto: AND WHEREAS the parties whose names appear in the Schedule B hereto, together with the amounts of their respective holdings or interests, and who are hereinafter referred to as "the Syndicate,"

have duly empowered and appointed the said Trustee to agree to purchase the said invention and Letters Patent (home, foreign, and colonial) from the Vendor, in trust for and on their behalf, for the consideration of £10,000 in cash, together with certain fully paid-up shares, but subject to the conditions hereinafter expressed:

NOW THESE PRESENTS WITNESS that, in pursuance of the said agreement and authorisation, and for the considerations and subject to the conditions herein expressed, IT IS HEREBY AGREED between the said Vendor and the said Trustee as follows:—

1. The Trustee shall upon the signing of these presents pay to the Vendor the sum of £250, being part payment of the aforesaid sum of £10,000, receipt of which sum of £250 is hereby acknowledged by the Vendor, and the Trustee shall thereupon inform the Syndicate of the execution of this Agreement.

2. The Syndicate or their agents shall then take the necessary steps to promote and form a limited company, to be entitled "The Scott Patent Tyre Company, Limited," and shall register the said company in terms of The Companies Acts, 1862 to 1900, the registered office to be in Liverpool as aforesaid.

3. The capital of the said company shall be £50,000, divided into 5000 shares of £10 each, and out of the said 5000 shares 1000 fully paid-up shares shall be allotted to the Vendor, in addition to the sum of £10,000 already referred to, and the Vendor shall be placed upon the board of directors.

4. Immediately upon the registration of the company prospectuses and advertisements will be issued and the subscription of capital invited. If the required amount of capital is subscribed the Vendor shall thereupon execute a proper assignment or assignments duly conveying and transferring the said invention and patents, both in this country and elsewhere, and also the benefits of any future improvements devised by him upon or in addition to the said inventions and Letters Patent, as beneficial owner, to the said company or their duly appointed trustee, and the Vendor shall upon the execution of the assignment receive the sum of £9750, being the amount of purchase money hereinbefore set forth, less the sum of £250 paid at the signing of this Agreement, and shall in addition have delivered to him the certificates representing 1000 fully paid-up shares of £10 each.

5. If sufficient capital should not be subscribed to pay the said purchase money and justify proceeding to allotment, then within three months after the date of the first issued prospectuses or advertisements inviting subscriptions of capital to the company this Agreement shall become null and void, and the Trustee shall forfeit and the Vendor shall retain the sum of £250 paid at the signing of this Agreement.

IN WITNESS &c.

SCHEDULE A.

[Numbers, dates, and titles of Home and Foreign Patents.]

SCHEDULE B.

[Names of Members of Syndicate, with amounts of holding or interest.]

NOTE.—*This Agreement, together with any subsequent instrument, should be referred to in any prospectus issued, and should also be filed with the Registrar of Joint Stock Companies, pursuant to Section 7 of The Companies Act, 1900.*

Form 6.

ASSIGNMENT (Absolute) of Invention and Letters Patent by the Patentee to a Purchaser.

An Indenture made the day of , 19 ,
BETWEEN ROBERT SHEDDON, of No. 29 New Smithhills, Paisley, in the County of Renfrew, North Britain, Iron Turner (hereinafter called “the Assignor”), of the one part, and THEODORE UNDERWOOD, of the Clydebank Shipbuilding Yard, Stobcross, Glasgow, in the County of Lanark, N.B., Marine Engineer (hereinafter called “the Assignee”), of the other part.

WHEREAS the Assignor claims to be the inventor of certain “Improvements in Feathering Paddlewheel Floats,” for which he has obtained Letters Patent No. 12,342, dated 23rd July, 1903: AND WHEREAS the Assignor has agreed with the Assignee for the sale to him, the Assignee, of the said invention and Letters Patent for the sum hereinafter expressed:

NOW THIS INDENTURE WITNESSETH that, in pursuance of the said Agreement and in consideration of the sum of £1000

paid by the Assignee to the Assignor upon the signing of these presents (the receipt of which sum is hereby acknowledged), he the Assignor, as beneficial owner, doth hereby assign unto the Assignee and his assigns absolutely all those the said invention and Letters Patent and the sole and exclusive benefit thereof, and all rights, powers, emoluments, and advantages whatsoever under or in respect of the said Letters Patent, the Assignor hereby covenanting with the Assignee and his assigns that, notwithstanding anything by him the Assignor done, omitted, or knowingly suffered, the said Letters Patent are now valid and subsisting.

IN WITNESS &c.

NOTE.—*This Assignment should be under seal, and should be registered.*

Form 7.

ASSIGNMENT of Half Share of Patent; Co-owners to work the Invention under the Patent independently of each other, but all Licences to be granted under the hands and seals of both.

An Indenture made the day of , 19 ,
BETWEEN RICHARD MASON, of The Phoenix Boiler Works, Pendleton, Manchester, in the County of Lancaster, Boiler Maker (hereinafter called "the Assignor"), of the one part, and THOMAS JOHNSON, of No. 40 MacDonald Street, Belfast, in the County of Antrim, Ireland, Engineer (hereinafter called "the Assignee"), of the other part.

WHEREAS the Assignor has obtained Letters Patent No. 7326, dated the 12th of July, 1900, for "Improvements in the Construction of Steam Generators," of which he claims to be the true and first inventor: AND WHEREAS the Assignor has agreed to sell one half share of the said invention and Letters Patent to the Assignee for the sum of £600, but subject to the conditions hereinafter set forth:

NOW THIS INDENTURE WITNESSETH that, in consideration of the said sum of £600 paid by the Assignee to the Assignor at the signing of these presents, and the receipt of which is hereby acknowledged, he the Assignor, as beneficial owner, doth

hereby assign and convey one half share of the said invention and Letters Patent absolutely to the Assignee and his assigns, the said assignment being coupled with the following conditions:—

1. Either of the parties may, in carrying out his own business, manufacture and sell boilers made in accordance with the said invention, and under the said Letters Patent, without accounting to the other for profits and royalties derived therefrom.

2. Neither of the parties alone shall be at liberty to grant any licences to third parties to manufacture and sell under the said Letters Patent, but any such licence shall be granted only with the full consent of both parties, and under their respective hands and seals, and all royalties and profits whatsoever accruing under such licence or licences shall be divided equally between the parties hereto, share and share alike.

3. All renewal fees for maintaining the patent in force and the agency or other charges connected with the payment of such renewal fees shall be borne and paid by the parties hereto in equal proportions, and if either of the parties or his assigns should omit or refuse to pay his or their share of such renewal fees and expenses, the same shall remain a charge upon his or their share of the patent, or otherwise shall be recoverable from the party or his assigns by the other party by action at law as a simple contract debt.

4. Either of the parties shall be at liberty at any time to sell his share of the said invention and Letters Patent to a third party, but only after the other party has had the first refusal of the said share at the price for which the said half share is actually and ultimately sold.

5. The terms "Assignor" and "Assignee," and any other terms herein used to describe the parties to this Agreement, shall be understood to include, as far as possible, their assigns, except where such an interpretation is specifically barred.

IN WITNESS &c.

NOTE.—*This Agreement should be under seal and registered.*

Form 8.

ASSIGNMENT of a Patent to Trustees in Trust for Purchasers having unequal shares, the Trustees to exploit the Patent, sell the goods, grant licences, draw royalties, distribute profits, call for contributions, and otherwise act generally for the beneficial owners.

An Indenture made the day of , 19 ,
 BETWEEN HIRAM POTTER, of Newark, New Jersey, in the United States of America, Engineer (hereinafter called "the Vendor"), of the first part; JAMES STEEL, of No. 12 Victoria Street, in the City of London, Civil Engineer, ALFRED MOTTERSHEAD, of the "Black Bull" Hotel, in the City of Chester, Wine Merchant, and PHILIP STAPLETON, of Burnley, in the County of Lancaster, Cotton Spinner (hereinafter called "the Purchasers"), of the second part; and GEORGE KINGHORN and FREDERICK WILSON, both of No. 133 King William Street, in the City of London, Chartered Accountants (hereinafter called "the Trustees"), of the third part.

WHEREAS the Vendor has obtained His Majesty's Letters Patent in the United Kingdom for "An Improved Telephonic Transmitter," No. 328, dated 14th January, 1903: AND WHEREAS he has agreed to sell and the Purchasers have agreed to purchase the said invention and Letters Patent for the sum of £5000 in the following shares and proportions: namely—As to the said James Steel, one half share, for which his contribution to the purchase money is £2500, and as to the said Alfred Mottershead and Philip Stapleton, one fourth share each, for which their contributions to the purchase money are respectively £1250 each: AND WHEREAS the Purchasers have requested the Vendors to assign the said invention and Letters Patent to the aforesaid Trustees, in trust for the Purchasers, subject to the payment of the purchase money and to the conditions herein expressed:

NOW THIS INDENTURE WITNESSETH that, in pursuance of the said Agreement and request, and in consideration of the said sum of £5000 paid at the signing of these presents, and the receipt of which the Vendor hereby acknowledges, he the Vendor, as beneficial owner, doth hereby assign and convey to the Trustees the aforesaid invention and Letters Patent, upon trust for the Purchasers as tenants

in common in the shares already set forth: namely one half share to the said James Steel, and one fourth share each to the said Alfred Mottershead and Philip Stapleton. AND THE VENDOR doth hereby covenant with the said Trustees jointly, and also with each of the Purchasers separately, that, notwithstanding anything by the Vendor done, or omitted, or knowingly suffered, the said Letters Patent are now valid and subsisting and not void or voidable. PROVIDED FURTHER and it is hereby agreed and declared as follows:—

1. Except under licence granted by the Trustees, none of the Purchasers or their assigns shall be entitled to make, use, exercise, or vend the said invention and Letters Patent within the United Kingdom.

2. The Trustees shall work and exploit the patent and premises to the best advantage of the Purchasers, and shall, subject to the direction and advice of the Purchasers, or a majority of the Purchasers representing three fourths of the value, manufacture the patented apparatus and grant licences for the manufacture, use, and sale of the invention at royalties to be fixed by the Purchasers or a majority as aforesaid, and all net profits, royalties, and emoluments accruing to the Trustees from and by such manufacture, licensing, and exploiting of the invention and Letters Patent shall form part of the trust estate, and, subject to the payment of all costs and expenses, shall be held by the Trustees in trust for the Purchasers and paid to them in accordance with their respective shares as hereinbefore set forth.

3. The Trustees may, and shall at any time during the continuance hereof, at the request in writing of the Purchasers or their assigns, or such of them as hold a majority in value of not less than three fourths of the entire value of the patent and premises, sell the said Letters Patent, and the purchase money so obtained, after deducting all necessary costs and expenses, shall be divided among the Purchasers or their assigns in accordance with the amounts of their respective holdings.

4. The Trustees shall, out of the trust estate, pay the renewal fees necessary to maintain the said patent in force, or to obtain and maintain any further patents which may be applied for or bought by or under the direction of the Purchasers or for any extension or

extensions of the said patent or patents, and, generally, the Trustees shall pay out of the trust moneys all costs, expenses, and liabilities strictly chargeable against the estate.

5. Any proceedings at law or otherwise necessary for the protection and maintenance of any Letters Patent aforesaid, or for the protection and maintenance of the rights of the owners therein, and for the prosecution of infringers pirating the invention or inventions, or slandering the title or titles of such Letters Patent or Patents, shall be taken and prosecuted by the Trustees when required so to do by the Purchasers or by a three fourths value majority of the Purchasers, the costs of such proceedings to be borne by the trust estate, and any moneys recovered in the form of damages or otherwise, or sums paid to compromise actions, shall be paid and accrue to the said trust estate, less costs and charges paid in recovering or obtaining the same or judgments to that effect.

6. The Trustees shall present accounts as between themselves and the respective Purchasers half-yearly, such accounts to be made out as extending from the 1st day of January in each year to the 30th day of June in each year, and from that day to the 31st day of December in each year, such accounts to be presented and a proper balance struck, audited by independent auditors appointed by the Purchasers, and settled not less than fourteen days after the termination of the respective periods over which the accounts extend. If on the presentation of accounts it should be found that there is an adverse balance against the trust estate or the respective Purchasers, then the Trustees shall apportion the sum to be paid by each Purchaser, having regard to his (the Purchaser's) share, and shall require him in writing to pay such sum within fourteen days, and if default in payment is made the said sum due shall bear interest at five per cent. per annum, and shall until paid remain a charge upon the defaulting owner's share in the estate.

7. For each half-year or portion thereof, each Trustee shall during the continuance of his trusteeship receive the sum of £100, such payment to come out of the moneys of the trust estate generally and not to be chargeable as a debt against any of the Purchasers particularly.

8. The Trustees or either of them may be removed by the Purchasers, but such power of removal shall be exercised only by a majority representing two thirds in value of the entire ownership.

9. If any difference shall arise between the parties—that is to say, between the Vendor and the Trustees, or between the Trustees, or between the Purchasers, or between the Trustees and the Purchasers—in respect of the construction of this instrument, or of the respective rights, duties, or liabilities of the parties, the same shall, if competent and desirable, be referred to two arbitrators, one to be appointed by each of the parties, and such arbitrators, or their umpire, may accordingly make an award in respect of the said difference, and the costs of or incidental to such reference and award respectively, and the person or persons by whom and in what manner the same shall be paid; and the submission may be made an order of the High Court of Justice upon the application of either party, who may consent or instruct counsel to consent thereto for the other of them, the death of any party not to operate as a revocation of the submission or otherwise be a bar to proceedings in respect thereof.

IN WITNESS &c.

NOTE.—*Although dealing with a trust, this deed can and should be registered as an Assignment. Registration will not, however, refer to the trusts therein set forth (see Section 85 of the Patent Acts).*

Form 9.

LICENCE (Non-Exclusive) in consideration of Royalties to be paid Half-yearly.

An Indenture made the day of , 19 ,
BETWEEN HENRY DICKENSON, of No. 4 Saxby Street, Salford, in the County of Lancaster, Mill Mechanic (hereinafter called “the Licensor”), of the one part, and JOHN BOOTH (trading as “Jacob Booth and Co.”), of The Penelope Works, Burnley, in the same county, Manufacturer (hereinafter called “the Licensee”), of the other part.

WHEREAS the Licensor has obtained Letters Patent No. 393 of the 8th day of January, 1900, for a certain invention entitled “Improvements in Shuttle Tongues”: AND WHEREAS the

Licensee has applied to obtain and the Licensor has agreed to grant the Licensee a licence to use the said invention in consideration of the royalties and upon the terms hereinafter set forth :

NOW THIS INDENTURE WITNESSETH that, in pursuance of the said Agreement, and in consideration of the royalties hereinafter reserved and the covenants on the part of the Licensee hereinafter contained, the Licensor doth hereby grant unto the Licensee full liberty, licence, power, and authority to make, use, exercise, and vend the said invention within the United Kingdom and the Isle of Man: TO HAVE, HOLD, EXERCISE, and ENJOY the said licence and premises unto and by the Licensee and his successors in business for and during all the residue now to come and unexpired of the term of fourteen years for which the said Letters Patent were granted: YIELDING AND PAYING unto the Licensor half-yearly, on the 30th day of June and the 31st day of December in each year, for every gross of shuttle tongues manufactured and sold by the Licensee in accordance with the said invention and Letters Patent, the sum of ten shillings as royalty: PROVIDED ALSO that the Licensee shall keep at his usual place of business all proper books of account, and will enter therein all particulars relating to the manufacture and sale by him of the said patent shuttle tongues, and will produce the said books to the Licensor or his authorised agent at all reasonable times for inspection and the taking of copies or extracts therefrom, and will at the end of each half-year aforesaid deliver or send to the Licensor a statement in writing of all essential particulars of the manufacture and sale during such half-year of the said patent shuttle tongues, together with a statement showing the amount of royalties payable to the Licensor, and shall, if required so to do, verify the said statement and particulars by statutory declaration. AND IT IS FURTHER PROVIDED that if the amount of royalties payable under this licence should for any continuous two years fall beneath the aggregate sum of £100, then the Licensor may terminate and withdraw this licence by giving three months' notice to that effect. FURTHER, if, as the result of proceedings at law or otherwise, the aforesaid Letters Patent should in the High Court or in any Court of Appeal be declared null and void, either wholly or in respect of their essential features, this licence shall therefrom cease and determine, and the Licensee shall be at liberty

to manufacture the said shuttle tongues without the payment of royalty to the Licensor, notwithstanding that this licence is expressed to be for the full term of patent right. In the event of the Licensee wishing to terminate and withdraw from this licence, he may do so by giving the Licensor three months' notice to that effect, and nothing in the licence mentioned shall operate as estoppel to prevent the Licensee, after his licence has determined, from challenging the validity of the patent, either as plaintiff or defendant, in any action at law commenced and prosecuted after the termination of this licence.

THE LICENSEE shall stamp all shuttle tongues manufactured by him in accordance with the said invention and Letters Patent or otherwise. The shuttles to which the tongues are applied shall be stamped with the words "Dickenson's Patent," and also with the number of the patent.

LASTLY, the Licensor shall, during the continuance of this licence, pay the renewal fees necessary to keep the patent in force, and shall, if required, produce the certificate of payment fourteen days before the last day for such payment, or otherwise shall allow the Licensee to pay the said renewal fees, the amount thereof to be deducted from the royalties then or thereafter due to the Licensor.

IF THE LICENSEE should at any time fail to pay the royalties due to the Licensor within three weeks from the end of the half-year in respect of which such royalties are payable, the Licensor may thereupon by notice in writing revoke this licence without prejudice to his right of recovery of any moneys then due to him or to any right of action in respect of breaches of this licence.

IN WITNESS &c.

Form 10.

LICENCE (Exclusive, save in respect of Licensor) for a Single County at Rent and Royalties.

An Indenture made the day of , 19 ,
BETWEEN GEORGE CHAMPION, of the Tubal Brass Works, Tubal Lane, in the City of Manchester, Brass and Tin Worker (hereinafter called "the Licensor"), of the first part, and FREDERICK

PERKINS, of No. 12 Grove Street, Bury, in the same county, Tinsmith (hereinafter called "the Licensee"), of the second part.

WHEREAS the Licensor claims to be the true and first inventor of and has obtained Letters Patent No. 12,333 of 12th October, 1899, for an invention of "Improvements in Humidifying and Ventilating Apparatus": AND WHEREAS the Licensee has agreed to take, and the Licensor has agreed to grant, an exclusive but (except as hereinafter limited) non-assignable licence to the Licensee to make, use, exercise, and vend the said invention in accordance with the said patent at the rent and royalties and under the conditions hereinafter specified:

NOW THIS INDENTURE WITNESSETH that, in pursuance of the said agreement and conditions, and in consideration of the said rent and royalties reserved, the Licensor, as beneficial owner, hereby grants, and the Licensor agrees to accept, an exclusive licence upon the following terms:—

1. The licence hereby granted shall continue to the full term now to come and unexpired of the aforesaid patent rights, subject to the hereinafter contained conditions as to terminating the licence.

2. For each year during which the licence shall continue, dating from the date of this Indenture, the Licensee shall pay to the Licensor an annual rent of £50, payable in advance, the first payment of £50 being made at the signing of these presents and acknowledged by the Licensor to be so paid.

3. In addition to the said annual payment of £50, the Licensee shall pay to the Licensor for each humidifier manufactured by him during the continuance of this licence the sum of £1 as royalty, such payments to be made half-yearly. The first payment of royalties, if any should be due, shall be made fourteen days after the expiry of six months from the date of this Indenture, and thereafter half-yearly as provided.

4. The Licensee shall keep proper books of account at his usual place of business, and shall enter therein all particulars of humidifying and ventilating apparatus manufactured by him in accordance with the invention and patent, and shall allow the same to be inspected, and copies and extracts made thereof and therefrom,

by the Licensor or his authorised agent at all reasonable times, and shall allow the Licensor or his authorised agent at all reasonable times to inspect his works if the Licensor should desire so to do. The Licensee shall at the end of each half-year furnish true statements showing the number of humidifiers manufactured by him during the half-year then expired, and shall accompany the said statement by an account showing the amount of royalties due to be paid to the Licensor, and shall verify the said statements and accounts by statutory declaration if required so to do by the Licensor. All sums due as royalties from the Licensee to the Licensor shall be paid to the Licensor not less than fourteen days after the expiry of each half-year.

5. Although this Indenture is set forth as an exclusive licence, the Licensor reserves to himself the right to manufacture and sell humidifying apparatus in Lancashire under his patent as aforesaid, but at prices which shall not be lower than those quoted by the Licensee; and all humidifiers sold by the Licensor shall be strictly those of his own manufacture, made at his works in Tubal Lane as aforesaid, or in any other workshop to which he may hereafter remove, or in which he may carry on his business.

6. The Licensee will not during the continuance of this licence manufacture any humidifying apparatus except in accordance with the said invention, and will not, while the licence is in force, dispute the validity of the said Letters Patent, and will do all in his power to detect infringers and assist the Licensor in any proceedings at law or otherwise which the Licensor may institute to protect his patent rights and interests.

7. Each humidifier and ventilating apparatus manufactured and sold by the Licensee shall bear upon the casing, or upon some prominent part of the apparatus, a stamped brass plate, not less than two inches in length by an inch and a quarter in breadth, bearing the words "Champion's Patent" and the numerals "No. 12,333⁰⁰"; but to this the Licensee may add his name and address as maker. These brass plates will be consecutively numbered, and will be supplied at cost price by the Licensor to the Licensee, the latter binding himself to use only such brass plates as are supplied to him by the Licensor, and no others, and all humidifiers in accordance with the patent identified as having issued from the hands of the Licensee and not bearing a brass plate so supplied

shall be chargeable with triple royalty, hereby agreed to represent liquidated damages suffered by the Licensor, unless a reasonable explanation is forthcoming.

8. The Licensor binds himself to maintain the patent in force during the continuance of this licence by the payment of the annual renewal fees, the certificate of each payment of the said renewal fees to be shown by the Licensor to the Licensee not less than fourteen days before the payment shall have become due; and if from any cause the Licensor shall omit or fail to pay any such renewal fee, the Licensee shall be at liberty to pay the same, together with any fine, if such should have been incurred, and shall charge the same against the Licensor, and deduct it from any moneys due to the Licensor at that time or thereafter in the hands of the Licensee.

9. If any rent, royalties, or other sums due from the Licensee to the Licensor should remain unpaid for one month after the time when they shall have become due, or if a breach of any of the conditions herein contained should be committed by the Licensee, the Licensor shall be at liberty to terminate this licence by giving two months' notice, and at the expiry of that time this licence shall cease and determine.

10. If the Letters Patent in respect of which this licence is granted shall, as the result of proceedings at law between the Licensor and third parties, or by revocation or otherwise, be finally declared void, either wholly or as to a material part thereof, then this licence shall forthwith cease and determine, and the Licensee shall be at liberty to manufacture and sell the invention without accounting to the Licensor for rent and royalties; and in any case if at any time after the expiry of three years from the date hereof the Licensee should wish to terminate this licence, he may do so by giving six months' notice to that effect, whereupon this licence shall cease and determine.

11. The Licensee shall not be at liberty to sell or assign this licence, during its continuance, to another or to others; but in the event of the death or withdrawal from business of the Licensee, this licence shall continue to his representatives and successors in business upon the terms and under the conditions hereinbefore set forth as enjoyed by and binding upon the Licensee himself.

IN WITNESS &c.

NOTE.—*This Licence should be entered in the Register of Patents.*

Form 11.*Notice by Licensor to Terminate Licence.**(Address and date.)*

IN ACCORDANCE with the power given me under Clause of the Licence dated the day of , 19 , granted by me to you in respect of Letters Patent No. 15,342 of 18th December, 1898, for "Improvements in Skates," I hereby give you notice that the said Licence shall, as and from the day of next, absolutely cease and determine.

(Signature)

To A. B., of .

NOTE.—*An intimation of this withdrawal should be sent to the Comptroller-General of Patents.*

Form 12.*Mortgage of a Patent.*

An Indenture made the day of , 19 , BETWEEN SIDNEY SMITH, of The Hollies, Cleworth Street, Barnstaple, in the County of Devon, Hat Manufacturer (hereinafter called "the Mortgagor"), of the one part, and WALTER PYM, of Newport, Barnstaple aforesaid, Gentleman (hereinafter called "the Mortgagee"), of the other part.

WHEREAS the Mortgagor has obtained His Majesty's Letters Patent No. 1236, dated 24th February, 1901, for an invention entitled "An Improved Filter": AND WHEREAS the Mortgagor has applied to the Mortgagee for a loan of £500, to be secured together with interest thereon, by a mortgage of the said invention and Letters Patent as hereinafter expressed:

NOW THIS INDENTURE WITNESSETH that, in consideration of the said sum of £500 this day paid by the Mortgagee to the Mortgagor (the receipt whereof is hereby acknowledged), the Mortgagor doth hereby covenant with the Mortgagee that he

(the Mortgagor) will pay to the Mortgagee, on the day of next, the sum of £500, together with interest thereon at the rate of six per cent. per annum.

AND THIS INDENTURE ALSO WITNESSETH that, for the consideration aforesaid, the Mortgagor, as beneficial owner, doth hereby assign unto the Mortgagee all those the said invention and Letters Patent, and the sole and exclusive benefit thereof, to hold the said invention, Letters Patent, and premises unto the Mortgagee and his assigns, subject to the proviso for redemption hereinafter contained. PROVIDED ALWAYS that if the Mortgagor shall pay to the Mortgagee the sum of £500, with interest on the same in the meantime at the rate of six per cent. per annum, on the said day of next, then the Mortgagee will at any time thereafter, at the request and cost of the Mortgagor, re-assign to him the said Letters Patent and premises; but otherwise if the said sum of £500 or any part thereof shall remain unpaid after the said day of next, he the Mortgagor shall pay to the Mortgagee, so long as the said sum or any part thereof shall remain unpaid, interest on the said sum or unpaid part thereof at the rate of six per cent. per annum by equal half-yearly payments on the day of and the day of . PROVIDED ALSO that if the said Mortgagor shall at the said period, or within fourteen days thereafter, make payment to the Mortgagee of the said interest, and shall perform and observe all the covenants and conditions herein contained and on his part to be performed and observed, then the Mortgagee will not call in the said sum of £500 or any unpaid portion thereof until the day of , 19 . PROVIDED ALSO that in such case provided, the Mortgagor shall not before the said day of , 19 , compel the Mortgagee to receive the said sum of £500 or the unpaid portion thereof.

AND THE MORTGAGOR doth hereby covenant with the Mortgagee that the said Letters Patent are now valid and subsisting and not void or voidable, and that the Mortgagor will during the continuance of this security pay all fees necessary for the renewal and maintenance of the said Letters Patent at least one month before the day when such renewal fees shall become due, and shall forthwith send or deliver to the Mortgagee the receipt for

every such payment; and if the Mortgagor should fail to pay such renewal fee, then the Mortgagee may, if he think fit, himself make payment of the fee, and the amount, together with the expenses, fine, or other charges, will remain on the security hereof as further moneys advanced. PROVIDED ALSO that until the Mortgagee shall become entitled to exercise the power of sale to be implied herein, the Mortgagor shall be at liberty to use and work the said invention without interference from the Mortgagee, and may also, in the joint names of himself and the Mortgagee, grant licences to make, use, exercise, and vend the same.

LASTLY, it is hereby declared that, except when the context requires a different interpretation, each of the expressions "Mortgagor" and "Mortgagee" shall, wherever used herein, be also applicable, as far as possible, to the assigns of the parties thereby designated.

IN WITNESS &c.

NOTE.—*This Mortgage should be registered.*

APPENDIX C.

THE PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 to 1902 (Consolidated).

The Acts contain 118 Sections with Schedules, and the respective Sections are to the following effect:—

PART I.—PRELIMINARY.

Section.

1. Short title.
2. Division of Acts into parts. Preliminary; Patents; Designs; Trade Marks; General.
3. Commencement of Act.

PART II.—PATENTS.

Application for and Grant of Patent.

4. Persons entitled to apply for patent. Joint Patentees; Statutory Declarations.
5. Application and specification. Drawings.
6. Reference of application to Examiner.
7. Power of Comptroller to refuse application or require amendment.
8. Time for leaving Complete Specification.
9. Comparison of Provisional and Complete Specifications.
10. Advertisement on acceptance of Complete Specification.
11. Opposition to grant of patent.
12. Sealing of patent. Extension of time.
13. Date of patent. Publication of specification.

Provisional Protection.

14. Provisional protection. Invention may be used during provisional term.

Protection by Complete Specification.

15. Effect of acceptance of Complete Specification.

Patent.

16. Extent of patent.
17. Term of patent.

Amendment of Specification.

18. Amendment of specification.
19. Power to disclaim part of invention during action &c.
20. Restriction on recovery of damages.
21. Advertisement of amendment.

PART II.—PATENTS (*continued*).*Compulsory Licences.*

Section.

22. Power of Board of Trade to consider and of Judicial Committee to order grant of licences.

Registry of Patents.

23. Register of Patents.

Fees.

24. Fees in schedule.

Extension of Term of Patent.

25. Extension of term of patent on petition to King in Council.

Revocation.

26. Revocation of patent.

Crown.

27. Patent to bind Crown.

Legal Proceedings.

28. Hearing with assessor.
29. Delivery of particulars.
30. Order of inspection &c. in action.
31. Certificate of validity questioned, and costs thereon.
32. Remedy in case of groundless threats of legal proceedings.

Miscellaneous.

33. Patent for one invention only.
34. Patent on application of representative of deceased inventor.
35. Patent to first inventor not invalidated by application in fraud of him.
36. Assignment for particular places.
37. Loss or destruction of patent.
38. Proceedings and costs before Law Officer.
39. Exhibition at Industrial or International Exhibition not to prejudice patent rights afterwards acquired.
40. Publication of illustrated journal, indexes, &c.
41. Patent museum.
42. Power to require models on payment.
43. Foreign vessels in British waters.
44. Assignment to Secretary for War of certain inventions.

Existing Patents.

45. Provisions respecting existing patents.

Definitions.

46. Definitions of "patent," "patentee," and "invention."

PART III.—DESIGNS.

Registration of Designs.

Section.

- 47. Application for registration of designs.
- 48. Drawings &c. to be furnished on application.
- 49. Certificate of registration.

Copyright in Registered Designs.

- 50. Copyright on registration.
- 51. Marking registered designs.
- 52. Inspection of registered designs.
- 53. Information as to existence of copyright.
- 54. Cesser of copyright in certain events.

Register of Designs.

- 55. Register of Designs.

Fees.

- 56. Fees on registration &c.

Industrial and International Exhibitions.

- 57. Exhibition at Industrial or International Exhibition not to prevent or invalidate registration.

Legal Proceedings.

- 58. Penalty on piracy of registered design.
- 59. Action for damages.

Definitions.

- 60. Definition of "design," "copyright."
- 61. Definition of "proprietor."

PART IV.—TRADE MARKS.

Registration of Trade Marks.

- 62. Application for registration.
- 63. Limit of time for proceeding with application.
- 64. Conditions of registration of trade mark. Essential features of trade marks.
- 65. Connection of trade mark with goods.
- 66. Registration of a series of marks.
- 67. Trade marks may be registered in any colour.
- 68. Advertisement of application.
- 69. Opposition to registration.

PART IV.—TRADE MARKS (*continued*).

Section.

- 70. Assignment and transmission of trade mark.
- 71. Conflicting claims to registration.
- 72. Restrictions on registration.
- 73. Further restriction on registration.
- 74. Saving for power to provide for entry on Register of common marks as additions to trade marks.

Effect of Registration.

- 75. Registration equivalent to public use.
- 76. Right of first proprietor to exclusive use of trade mark.
- 77. Restrictions on actions for infringement, and in defence to action in certain cases.
- 77A. Certificate as to exclusive use and costs thereon.

Register of Trade Marks.

- 78. Register of Trade Marks.
- 79. Removal of trade mark after fourteen years unless fee paid.

Fees.

- 80. Fees for registration &c.

Sheffield Marks.

- 81. Registration by Cutlers' Company of Sheffield marks.
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PART V.—GENERAL.

Patent Office and Proceedings thereat.

- 82. Patent Office.
- 83. Officers and clerks.
- 84. Seal of Patent Office.
- 85. Trusts not to be entered in Registers.
- 86. Refusal to grant patent &c. in certain cases.
- 87. Entry of assignments and transmissions in Registers.
- 88. Inspection of and extracts from Registers.
- 89. Sealed and certified copies to be received in evidence.
- 90. Rectification of Registers by Court.
- 91. Power for Comptroller to correct clerical errors.
- 92. Alteration of registered mark.
- 93. Falsification of entries in Registers.
- 94. Exercise of discretionary power by Comptroller.
- 95. Power of Comptroller to take directions of Law Officers.
- 96. Certificate of Comptroller to be evidence.
- 97. Applications and notices by post.
- 98. Provision as to days for leaving documents.

PART V.—GENERAL (*continued*).

Section.

- 99. Declaration by infant, lunatic, &c.
- 100. Transmission of certified printed copies of specifications &c.
- 101. Power for Board of Trade to make general rules for classifying goods and regulating business of Patent Office.
- 102. Annual reports of Comptroller.
- 102A. Proceedings of Board of Trade.

International and Colonial Arrangements.

- 103. International arrangements for protection of inventions, designs, and trade marks.
- 104. Provisions for Colonies and India.

Offences.

- 105. Penalty on falsely representing articles to be patented &c.
- 106. Penalty on unauthorised assumption of Royal Arms.

Scotland, Ireland, &c.

- 107. Saving for Courts in Scotland.
- 108. Summary proceedings in Scotland.
- 109. Proceedings for revocation of patent in Scotland (action of reduction).
- 110. Reservation of remedies in Ireland.
- 111. General saving for jurisdiction of Courts.
- 112. Isle of Man.
- 112A. Jurisdiction of Lancaster Palatine Court.

Repeal; Transitional Provisions; Savings.

- 113. Repeal and saving for past operation of repealed enactments &c.
- 114. Former Registers to be deemed continued.
- 115. Saving for existing rules.
- 116. Saving of Crown prerogative.

General Definitions.

- 117. General Definitions.

Register of Patent Agents.

- 117A. Register of Patent Agents.

THE FIRST SCHEDULE.—Forms of Application &c.

THE SECOND SCHEDULE.—Fees on instruments for obtaining patents, and renewal.

THE THIRD SCHEDULE.—Enactments repealed.

THE PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 to 1902 (Consolidated).

THE REPEALED PORTIONS OF THE ACT OF 1883 ARE OMITTED EXCEPT IN THE CASE OF THE TRADE MARKS DIVISION. THE AMENDMENTS EFFECTED BY THE SUCCEEDING ACTS ARE INTRODUCED AT THE APPROPRIATE PLACES AND ARE IN **heavy type**. THE CORRESPONDING AMENDING ACT AND SECTIONS ARE CITED IN THE MARGIN, WHERE THE INTERPOLATED MATTER OCCURS.

(46 & 47 VICTORIA, CHAPTER 57.)

An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks.

[25th August, 1883.]

48 & 49 Vict. c. 63.—An Act to amend The Patents, Designs, and Trade Marks Act, 1883. [14th August, 1885.]

49 & 50 Vict. c. 37.—An Act to remove certain doubts respecting the construction of The Patents, Designs, and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions. [25th June, 1886.]

51 & 52 Vict. c. 50.—An Act to amend The Patents, Designs, and Trade Marks Act, 1883. [24th December, 1888.]

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

[17th August, 1901.]

2 Edw. VII. c. 34.—An Act to amend the Law with reference to Applications for Patents and Compulsory Licences, and other matters connected therewith.

[18th December, 1902.]

BE IT ENACTED by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

PART I.

PRELIMINARY.

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

The Act of 1902 may be cited as "The Patents Act, 1902," and may be cited and shall be construed as one with The Patents, Designs, and Trade Marks Acts, 1883 to 1901. Act 1902, s. 5.

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

PART I.—PRELIMINARY.

II.—PATENTS.

III.—DESIGNS.

IV.—TRADE MARKS.

V.—GENERAL.

Division of
Act into
parts.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the Thirty-first day of December, One thousand eight hundred and eighty-three. Commence-
ment of Act.

The Act of 1888 shall, except so far as is thereby otherwise specially provided, commence and come into operation on the First day of January, One thousand eight hundred and eighty-nine. Act 1888,
s. 28.

NOTE.—The Acts of 1885 and 1886 commenced respectively on the 14th August, 1885, and 25th June, 1886. The Act of 1901 commenced on the 1st January, 1902. The Patents Act, 1902, came into operation as regards Sections 3, 4, and 5 on the 18th December, 1902. By an Order of the Board of Trade, Sections 1 and 2 became operative as from the 1st of January, 1905.

PART II.

PATENTS.

Application for and Grant of Patent.

4. (1) Any person, whether a British subject or not, may make an application for a patent. Persons
entitled to
apply for
Patent.

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

**Act 1885.
s. 5.
Power to
grant
Patents to
several
persons
jointly.**

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

**Application
and specifi-
cation.**

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

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

**Act 1885.
s. 2.
5 & 6
Will. IV.
s. 62.**

The declaration may be either a statutory declaration under The Statutory Declarations Act, 1835, or not, as may be from time to time prescribed.

(3) A Provisional Specification must describe the nature of the invention, and be accompanied by drawings, if required.

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

**Act 1886.
s. 2.
The same
drawings
may accom-
pany both
specifica-
tions.**

The requirement of this sub-section as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the Complete Specification refers to the drawings which accompanied the Provisional Specification. And no patent heretofore sealed shall be invalid by reason only that the Complete Specification was not accompanied by drawings, but referred to those which accompanied the Provisional Specification.

(5) A specification, whether Provisional or Complete, must commence with the title, and in case of a Complete Specification must end with a distinct statement of the invention claimed.

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

Reference
of applica-
tion to
Examiner.

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

Act 1888,
s. 2.
Power of
Comp.
troller to
refuse
application
or require
amend-
ment.

(2) Where the Comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the Law Officer.

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

7a (1)¹ Where an application for a patent has been made and a Complete Specification has been deposited by the applicant, the Examiner shall forthwith, in addition to the inquiries which he is directed to make by The Patents, Designs, and Trade Marks Act, 1883 (in this Act referred to as "the Principal Act"), make a further investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed or described in any specification (other than a Provisional Specification not followed by a

Act 1902,
s. 1.
Examina-
tion of
previous
Specifica-
tions in
United
Kingdom
on appli-
cations for

¹ By Order of the Board of Trade this Section of the Act of 1902 came into operation on the 1st January, 1905.

patents.
46 & 47
Vict. c. 57.

Complete Specification) published before the date of the application, and deposited pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application.

(2) If on investigation it appears that the invention has been wholly or in part claimed or described in any such specification, the applicant shall be informed thereof, and the applicant may, within such time as may be prescribed, amend his specification, and the amended specification shall be investigated in like manner as the original specification.

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

(4) The provisions of Sub-section 5 of Section 9 of the Principal Act, as amended by any subsequent enactment, shall apply to reports under this section.

(5) If the Comptroller is satisfied that no objection exists to the specification on the ground that the invention claimed thereby has been wholly or in part claimed or described in a previous specification as before mentioned, he shall, in the absence of any other lawful ground of objection, accept the specification.

(6) If the Comptroller is not so satisfied, he shall, after hearing the applicant, and unless the objection be removed by amending the specification to the satisfaction of the Comptroller, determine whether a reference to any, and, if so, what, prior specifications ought to be made in the specification by way of notice to the public.

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

48 & 49
Vict. c. 63.

(8) Section 8 of the Principal Act and Section 3 of The Patents, Designs, and Trade Marks (Amendment) Act, 1885 (which regulate the time for depositing a Complete Specification), shall have effect as if references therein to the period of nine months were references to the period of six months.

(9) The investigations and reports required by this section shall not be held in any way to guarantee the validity of any patent, and no liability shall be incurred by the Board of

Trade or any officer thereof by reason of, or in connection with, any such investigation or report, or any proceeding consequent thereon.

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

(11) This section shall come into operation at such date as the Board of Trade may by order direct, and shall apply only to applications made after that date, and the Order shall be laid before both Houses of Parliament.

(4) The Comptroller shall, when an application has been accepted, give notice thereof to the applicant. Act 1888,
s. 2, s.s. 4.

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

8. (1) If the applicant does not leave a Complete Specification with his application, he may leave it at any consequent time within ~~SIX~~ months from the date of application. Time for
leaving
Complete
Specifica-
tion.
Act 1902,
s. 1, s.s. 8.

A Complete Specification may be left within such extended time, not exceeding one month after the said ~~six~~ months, as the Comptroller may on payment of the prescribed fee allow. Act 1885,
s. 3.
Act 1902,
s. 1, s.s. 8.

(2) Unless a Complete Specification is left within that time, the application shall be deemed to be abandoned.

9. (1) Where a Complete Specification is left after a Provisional Specification, the Comptroller shall refer both specifications to an Examiner for the purpose of ascertaining whether the Complete Specification has been prepared in the prescribed manner, and whether the invention particularly Comparison
of Pro-
visional and
Complete
Specifica-
tions.