

lices, which may be hold by leave of the king; if the Crown then grant a patent to an alien, it is presumed it would be valid as it is held by leave of the Crown.

We must also bear in mind that a patent is for something vendible, and in encouragement of commerce; little difference being made between subjects and aliens. Chapter 30 of Magna Charta grants safe pass to all merchants. By a statute passed in the ninth year of the reign of Edward III, "It is ordained and established that all merchants, aliens and denizens, and all other and every of them of what estate or condition soever they be, that will buy or sell corn, wine, goods, flesh, fish, and all other provisions and victuals, wools, cloths, wares, merchandises and all other things vendible, from whencesoever they come, by foreigners or by denizens at wheresoever it be, city, borough, town, port of the sea, fair, market, or elsewhere within the said realm within franchise or without, may freely and without interruption sell them to what persons it shall please them, as well to foreigners as to denizens, except the enemies of our Lord the King and of his realm." Further statutes of the fourteenth and twenty-fifth years of the same king confirm and emphasise the above: A statute in the second year of Richard I also recites the above statute of Edward III, and grievances of not conforming to it. "The Lord the King considering clearly the coming merchants, strangers within the realm, to be very profitable from many causes to all the said realm," it was permitted by this statute to all merchants alien to safely enter and abide . . . . sell all victuals, &c., in gross or by parcels, but only sell sweet wines in gross within franchised cities, &c., "other great wares" (piece goods) by the piece and not by retail; but the latter might be sold in markets and fairs in the country either in gross or in retail. Another statute in the eleventh year of the same reign again confirms the previous laws, reiteration being in those days considered necessary to emphasise the law. With the liberties thus seen to be granted to alien merchants, it is difficult to see that it is beyond the prerogative of the Crown to grant patents for vendible inventions to aliens.

It must be noticed in respect of the Statute of Monopolies, that, before this law was passed and for a considerable time afterwards, there were no inventions other than those brought from beyond the seas, and called inventions because they were previously unknown in England. The persons who brought the knowledge of these inventions into the realm were in most cases, though not in all, English subjects who, after having at

Some risk and trouble travelled abroad, returned to the realm to practise the new manufactures which they had learnt, and patents were granted them because of the good they brought to the commonwealth by the introduction of such new manufactures. In many cases it was obligatory on the patentee to work the invention and take apprentices so that the subjects might learn to practise the inventions. In the reign of Anne, when it was ordered "that a specification particularly describing and ascertaining the invention" should be enrolled in Chancery, that is to say, put on public record, it became no longer necessary to teach apprentices. It will thus be seen that the whole policy of the law was to take notice of the inventor only as a person introducing into England and diffusing there the knowledge of a manufacture, previously unknown there. Before the enrolment of a specification there would appear to have been no practical means by which a resident abroad could bring an invention into England, apart from personally entering the realm with his knowledge in his own head. Therefore foreigners resident and remaining abroad were *de facto* excluded from obtaining patents by reason of the absence of machinery whereby they could forward their inventions into the realm and diffuse the knowledge of them there, but it does not follow that *de jure* they were so excluded even before the reign of Anne. When applicants were allowed to deposit specifications on public record such proceeding became a means for introducing inventions into the realm, and parties resident abroad could by that means give the public full information of their inventions without coming personally into the realm to do so. Therefore this latter condition, "personal presence," which neither the Statute of Monopolies nor any other official or non-official statement of the law has ever laid down as essential, but which circumstances alone had up to that time rendered necessary, no longer existed as a necessary step for obtaining the patent.

In the case of *Darcy v. Allin*,<sup>1</sup> often referred to, a patent was granted for importing playing cards into England. There was no question of manufacturing in England, but the patentee was, by himself, his agents, or others, allowed to buy such cards abroad and import them into England. This patent was held void, not on account of the patentee going abroad out of the allegiance of the king; but because it sought to prevent others from manufacturing in England that which they had already the knowledge and right to manufacture.

<sup>1</sup>1 *Web. P.C.*, 1.

Whether an alien might, or might not, have held a valid patent here, has no direct bearing on the question at present, since, by the Naturalisation Act of 1870, any alien may hold real or other estate in the same manner as a British subject, that this extends to Letters Patent requires no further demonstration. An indirect proof lies in the fact that the Patent Act of 1883 specially states that "any person, whether a British subject or not," may apply for a patent, presuming therefore that foreign nationality is not a bar to the grant.<sup>1</sup>

The only remaining question, therefore, is whether the fact that an English resident has been held in the Courts to be rightly entitled the true and first inventor of a communicated invention, proves that a foreigner cannot claim the same title. This can only be answered in the affirmative, by presuming that a person may become qualified with the attributes of true and first inventor of some invention to the exclusion of any other person from also fulfilling the same rôle. We have seen that apart from disclosing the invention, this is not the case according to the precedents given. In Dollond's case, it was held that an independent inventor had a right to a patent, although the invention had been previously and separately discovered and used privately by another person, who, however, had not published his knowledge. The latter, therefore, had had all rights to receive a patent, but by reason of failure to ask for one, forfeited his priority. We see that the first and true inventor in law is not necessarily the man who first becomes possessed of an invention, but he who, having become possessed of the invention, first discloses it or applies for a patent. This doctrine is upheld in *Forsyth v. Riviere*,<sup>2</sup> and has not been disputed since.

We may therefore presume that when a communication is made to a resident in this country such person is not thereby made solely and to the exclusion of every other person the true and first inventor; but such person is merely placed in a position that he may apply for the patent as the true and first inventor; but if he does not so apply, there is no objection to any other person applying, if the latter is also possessed of the invention. The fact that some foreign inventions are patented by persons resident here, "as communications from abroad," does not of itself prevent other foreign inventions from being patented by other persons not resident in the realm.

<sup>1</sup> Patents Act, Sect. 4.

<sup>2</sup> 1 *Web. P.C.*, 97.

But it is further argued that the fact of the inventor being abroad precludes him from satisfying the requirement of bringing the invention into the realm, but as regards this point nothing in any law can be construed to necessitate this personal bringing of the invention into the realm. It is true that there are words in the deed of Letters Patent which at first sight show that the inventor should be personally in the realm, these are:—"Provided that it be made to appear to us . . . that the said invention is not a new invention as to the public use and exercise thereof within our kingdom of Great Britain, Ireland, and the Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid . . . these our Letters Patent shall forthwith determine and be void." It is more reasonable to read the above so that the words "within this realm" qualify the words "true and first" than to say that the inventor must be personally within this realm when, his foreign address being given in the same deed, the deed would thus involve an absurd contradiction on the face of it.

The Crown (having notice of the foreign domicile) continues to grant patents to residents abroad, and grants that such shall be construed in the most beneficial sense for the advantage of the patentees; so that until the Crown discontinues the practice it would appear that foreigners run no risk in applying in their own names. Even if in the last resort such grants are found to be based on no principle in law, they may be held valid on the grounds of expediency, and since the practice, in the words of Jessel, M.R., "has acquired by time and recognition the force of law."<sup>1</sup>

**Corporate Bodies as Applicants.**—We have seen that any person may apply for a patent who fulfils the requirements of true and first inventor, and that two or more persons may apply for a patent provided at least one of them is the true and first inventor. Under Sect. 117, sub-sect. 1, unless the context otherwise requires, a person includes a body corporate, so that not only persons individual, but bodies corporate can in certain cases apply for patent, that is to say, provided they fulfil the requirements of true and first inventors, or are associated with a person or other body corporate fulfilling the said requirements. It is obvious that a body corporate cannot be an inventor in the ordinary acceptance of the term, but it can apparently be the inventor in law of an invention communicated from abroad.

<sup>1</sup> Marsden v. Saville Street Foundry, *supra*.

A body corporate can in all cases be joint applicant with the inventor.

**Application under International Convention.**— For special arrangements and procedure *see* page 165.

It may, however, be mentioned here, that under Sect. 103 of the Act of 1883, any person who has applied in certain countries abroad may, within seven months of his application abroad, apply for patent here, and shall then be entitled to a valid patent in priority over previous applicants, during that period. Such applications here under convention are optional, but it must be observed that *the same applicant who has applied abroad must apply here*, the patent cannot be taken out as a communication. As any person importing an invention from abroad may be the true and first inventor so far as this realm is concerned, the question of inventorship does not arise in connection with these applications.

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## CHAPTER XII.

THE PATENT OFFICE: REGISTER OF PATENTS,  
OFFICIAL PUBLICATIONS.

**The Patent Office** is situated at 25, Southampton Buildings, London, W.C., and is under the control of an officer called the Comptroller-General of Patents, Designs, and Trade Marks, who acts under the superintendence and direction of the Board of Trade.<sup>1</sup> The appointment of the Comptroller, examiners, and other *employés* of the Patent Office is in the hands of the Board of Trade, subject to the approval of the Treasury.<sup>2</sup> The Patent Office is the only place at which applications for patents can be received, but same may be sent by post<sup>3</sup> if the documents are already provided with *impressed* stamps to the value of the government fees payable. The Patent Office is not empowered to impress these stamps; the stamped forms are, however, procurable at the principal post offices throughout the kingdom on prepayment of the value of the stamp. Documents sent by post in this manner are deemed to be filed at the time when the letter containing the same would be delivered in the ordinary course of post.<sup>4</sup>

In the Patent Office is also a valuable free library in which technical journals and books may be seen, and also copies of the specifications not only of British patents, but of United States, German, French and others sent by the respective foreign governments. The library is open free of charge to the public from 10 a.m. to 10 p.m.

**Rules.**—The Patent Rules, which govern minor points of proceeding relating to patents, are made by authority of the Board of Trade under Sect. 101, but the Board have no authority to levy fees.<sup>5</sup> Any rules so made must be laid before

<sup>1</sup> Patents Act, 1883, Sect. 82.

<sup>2</sup> Sect. 83.

<sup>3</sup> Sect. 97.

<sup>4</sup> Sect. 97.

<sup>5</sup> Chartered Institute v. Lockwood, X *R.P.C.*, 167.

both Houses of Parliament when in session, and must be advertised twice in the Official Journal of Patents.<sup>1</sup> Either House may within forty days signify disapproval of the rules.<sup>2</sup> The rules at present in force may be had from the Patent Office Sales Branch at cost of 9*d.*

**Powers of the Comptroller.**—When an examiner has reported against an application, the Comptroller may refuse to accept it, or may require it to be amended,<sup>3</sup> and in the latter case may, if he sees fit, direct that the application bear date as from the time when the requirement is complied with.<sup>4</sup> The Comptroller may also refuse to accept a complete specification if the examiner reports against it.<sup>5</sup>

If an amendment is filed, the Comptroller shall also refuse it, if in his opinion it enlarges the scope of the patent.<sup>6</sup> Inventions contrary to law or morality may also be refused.<sup>7</sup>

In all these cases where a discretionary power is given to the Comptroller he shall not exercise it adversely to the applicant without giving the latter an opportunity of being heard personally or by his agent.<sup>8</sup>

In case of opposition to a patent, the Comptroller shall hear the parties and determine the matter.<sup>9</sup>

From a refusal to accept an application, specification or amendment, and from a decision in a case of opposition, appeal may be made to the Law Officer of the Crown, who may examine witnesses on oath and give costs<sup>10</sup>; powers denied the Comptroller.

**Register of Patents.**—Sect. 23 provides for the keeping at the Patent Office of a book, called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and transmission of patents, of licenses under patents, and amendments, extensions and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed.

**Entry of Assignments and transmissions in Registers.**—Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to copyright in a registered design, or to a registered trade mark; the Comptroller shall on request, and on proof of title to his satisfaction,

<sup>1</sup> Sect. 101 (4).

<sup>2</sup> Sect. 101 (5).

<sup>3</sup> Sect. 7.

<sup>4</sup> Act 1888, Sect. 2.

<sup>5</sup> Act 1883, Sect. 9.

<sup>6</sup> Act 1883, Sect. 18 (8).

<sup>7</sup> Act 1883, Sect. 86.

<sup>8</sup> Act 1883, Sect. 94.

<sup>9</sup> Act 1883, Sect. 11.

<sup>10</sup> Act 1883, Sect. 33.

cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade mark; in the register of patents, designs, or trade marks, as the case may be. The person for the time being entered in the register of patents, designs, or trade marks as proprietor of a patent, copyright in a design, or trade mark as the case may be, shall, subject to the provisions of the Act and to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with the same, and to give effectual receipts for any consideration for such assignment, license, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property.<sup>1</sup>

The register of patents shall be *prima facie* evidence of any matters directed or authorised to be inserted therein.<sup>2</sup> Attested copies of deeds, licenses, or any other documents affecting the proprietorship in any Letters Patent, or in any license thereunder, must be supplied to the Comptroller in the prescribed manner for filing in the Patent Office.<sup>3</sup> The original documents must be forwarded but will be returned after verification with notification of the registration stamped on them, in about four clear days. A form of request for registration bearing a 10s. stamp must accompany the papers, which themselves must also be stamped with revenue stamps according to the Stamp Acts.

There shall not be entered in any register kept under the Act, or be receivable by the Comptroller, any notice of any trust expressed, implied, or constructive.<sup>4</sup> Only documents that confer a legal interest ought to be inserted in the register.<sup>5</sup> An incomplete agreement cannot be entered.<sup>6</sup>

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

<sup>1</sup> Act 1883, Sect. 87.

<sup>2</sup> Act 1883, Sect. 23 (2).

<sup>3</sup> Rule 72.

<sup>4</sup> Act 1883, Sect. 85.

<sup>5</sup> *Haslett v. Hutchinson*, 1891, VIII *R.P.C.*, 463.

<sup>6</sup> *Re Fletcher's Patent*, 1893, X *R.P.C.*, 255.



payment of the prescribed fee.<sup>1</sup> A fee of 1s. is charged for inspection.

**Certified Copies.**—Printed, or written copies, or extracts purporting to be certified by the Comptroller, and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals.<sup>2</sup>

**Rectification of Register.**—An alteration of the register can only be made by authority of the Court. By Sect. 90, sub-sect. 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 entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the Comptroller. The Court may order the whole entry to be expunged.<sup>3</sup>

**False Entry.**—If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces, or tenders, or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.<sup>4</sup>

**Correspondence.**—All communications with the Patent Office must be in writing, but personal interviews are permitted for explanation in certain cases with examiners and are sometimes necessary or advisable to elucidate a complex in-

<sup>1</sup> Act of 1883, Sect. 88.

<sup>2</sup> Act of 1883, Sect. 89.

<sup>3</sup> *Haslett v. Hutchinson, supra.*

<sup>4</sup> Act of 1883, Sect. 93.

vention or save time of correspondence. All documents for filing must be written or printed in an indelible ink upon paper 13 inches deep by 8 inches wide, and on one side only, leaving a 2-inch clear margin down the left-hand side. Official stamped forms may be used, or the documents after preparation may be presented for stamping at Somerset House or at the Royal Courts of Justice in London. The agent employed must be duly authorised to the satisfaction of the Comptroller. A suitable form is given in Appendix II (Form 2).

**Legal Assistance, &c., to Applicants.**—The British Patent Office disclaims all ability to reduce or remit any government fee, or to explain the law or assist applicants in the preparation of any documents. A similar neutral position is taken up by every other Government Patent Office. Rule 17 of the United States Patent Office further advises that: "As the value of patents depends largely upon the careful preparation of the specification and claims, the assistance of competent agents will in most cases be of advantage to the applicant, but the value of their services will be proportional to their skill and honesty, and too much care cannot be exercised in their selection. The Office cannot assume responsibility for the acts of attorneys, nor can it assist applicants in making selections. It will, however, be unsafe to trust those who pretend to the possession of any facilities except capacity and diligence for procuring patents in a shorter time or with broader claims than others." Also: "All solicitors, agents, or attorneys who in circulars, advertisements, or otherwise refer to the Commissioner of Patents or to any other official of the Patent Office, for evidence of their professional standing, do so without authority." Other Government Patent Offices adopt similar rules.

**Publications of the Patent Office.**—In the Illustrated Official Journal of the Patent Office, published weekly, price 6d., appears a list of applications for patents with names of inventors and titles of the inventions during the week, together with other lists of applications which have passed various stages; of patents on which renewal fees have been paid; and of those lapsed through non-payment. No details can be learnt respecting any invention until after the complete specification has been advertised in this journal as accepted. In this journal appear also in due course abstracts of all patented inventions in the order of their numbers and dates, but owing to the necessity of preserving the order of compilation, these abstracts are 17 months behind the nominal dates of the patents.

Various indices are published to these journals and specifications.

Full printed copies of each complete specification, with its drawings and previous provisional specification (if any), are usually placed on sale three weeks after the publication of the acceptance of the complete specification, at a uniform price of 8*d.* per copy.

Abstracts of the specifications of all patents are being gradually prepared in separate volumes, and divided into 140 convenient classes for publication. Some of these are illustrated. Of these the volumes containing the patents from 1617 to 1876, of which there may be more than one in each class, are priced at 2*s.* each. The later volumes, covering five to six years each, are issued at 1*s.* each.

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## CHAPTER XIII.

METHODS OF APPLICATION FOR PATENT OR  
"PROVISIONAL PROTECTION."

**Alternative Modes of Application.**—The form of application for patent (*see* Appendix II, Form No. 1), bearing 1*l.* stamp, must be accompanied by an authorisation of agent (Form 2) and either a provisional or a complete specification.<sup>1</sup> The specification must be in duplicate, signed by the applicant or his patent agent. Drawings, if any, must also be in duplicate (*see* page 166) and signed by applicant or agent.

A provisional specification bears no stamp; the complete specification a 3*l.* stamp on the original copy. Where applicant files a provisional specification with the application, he must file the complete specification within the period of nine calendar months next ensuing, or the application will be deemed to be abandoned. Nevertheless, the applicant, if he has omitted to file the complete specification within the nine months, may yet do so within a further month by filing a form of request for this extended time, bearing a 2*l.* stamp. This form may be filed at the same time as the complete specification, as the request is invariably allowed. No further extension than this one month can be had under any circumstances.

In respect of the conditions governing the choice between the alternative methods, the reader will do well to consult Part I, and more especially pages 35 to 56.

**Provisional Protection** is, in truth, only a form of protection given during the progress of an application, and its duration is from the day the application is filed until the Letters Patent are actually sealed and delivered; for further explanation, *see* Chapter IV. Nevertheless, in ordinarily speaking of provisional protection the inventor means the nine months' respite consequent on filing a provisional specification. Provisional protection, therefore, does not require a

<sup>1</sup> For forms and preparation of these documents *see* Chapters XIV and XV.

distinct form of application, but is obtained by applying for a patent and filing a provisional specification. It is entirely optional to the applicant whether he will afterwards "complete" the patent by filing the complete specification, or suffer the application to lapse.

**Deposit of Application.**—The aforesaid papers when stamped are deposited at the Patent Office in London, and an official receipt is given for them bearing a number equivalent to the number of the application, and showing the date of deposit. This number and date will eventually be those of the patent when granted. A new series of numbers is commenced on 1st January of each year.

**Progress of Application.**—The application is referred by the Comptroller of Patents to an examiner to ascertain and report 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.<sup>1</sup>

This examination must necessarily be very incomplete since the examiner can only judge of the invention as described in the specification, and has no certain means of knowing whether it is sufficient and correct or not. No examination is made as to novelty or patentable presentation of the invention and, whether the specification is a complete or a provisional one, the examiner has only to see whether its nature has been "fairly described." Applicants should, however, place no reliance in this examination, as it is made not in their interests but in the public interest.

After this examination, which may take from two to six weeks, or more or less according to the state of work in the examining division, the application is usually accepted, and a notification of acceptance sent to the applicant's agent, but if the application does not pass the examination, "the Comptroller may refuse to accept the application, or require that the application, specification, or drawings be amended before he proceeds with the application,"<sup>2</sup> and in the latter case the application shall, if the Comptroller so directs, bear date from the time when the requirement is complied with."<sup>3</sup> A badly prepared application is therefore liable to lose its original date, which will often present disastrous consequences for the validity of the patent.

<sup>1</sup> Patents Act, 1883, Sect. 6.

<sup>2</sup> Patents Act, Sect. 7.

<sup>3</sup> Patents Act, 1888, Sect. 2.

The applicant may, however, within 14 days,<sup>1</sup> appeal to the Law Officer, who may make an order determining whether, and subject to what conditions (if any), the application shall be accepted.<sup>2</sup>

Where a complete specification is filed after a provisional specification, it must be marked with the same number and date. Both specifications are then referred to an examiner to report whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that described in the provisional specification.<sup>3</sup> If not, it is returned for amendment, refusal being also subject to appeal to the Law Officer.<sup>4</sup>

**Appeals to Law Officer.—One Invention.**—On an appeal to the Law Officer against the Comptroller's decision requiring division of an application as containing more than one invention, Herschell, S.G., decided that various modifications of an invention could be inserted in the same application for patent so long as each was for carrying into effect the general object of the invention and the alternative devices for that purpose were of an analogous nature.<sup>5</sup> It has also been decided on appeal by Davey, S.G., in *re* Hearson's Patent,<sup>6</sup> that the application of part of an invention only to a further purpose constitutes a further invention which cannot be included in the same patent. Similarly if a party has invented a device such as a telegraphic apparatus, and claims and describes same as such, he cannot in the same patent lay claim to the broad use in electrical apparatus in general of the particular principle of utilising induced electrical currents, which he has employed in the telegraphic apparatus.<sup>7</sup>

**Appeal to Law Officer.—Title.**—The Comptroller refused an application until the title should be made wider to cover the invention, or latter narrowed to be within the title. Webster, A.G., while holding that there was some doubt as to the invention being entirely within the title, allowed the appeal, on the ground that the applicant might choose his own title so long as the rules and statute were not infringed, and that the

<sup>1</sup> Patent Rules, *Appeal to L.O.*, 1.

<sup>2</sup> Patents Act, 1883, Sect. 7 (30).

<sup>3</sup> Patents Act, 1883, Sect. 9.

<sup>4</sup> Patents Act, 1883, Sect. 9 (2).

<sup>5</sup> Jones' Patent, *Griff.*, 265.

<sup>6</sup> *Griff.*, 266.

<sup>7</sup> Robinson's Patent, *Griff.*, 267.

risk of his patent being limited by a narrower title solely concerned himself.

**Joint Application. — Signature of complete Specification.**—Where two joint applicants have filed their application for a patent it is not essential that both should sign the complete specification, for if the latter be filed signed by one of the applicants only it may be accepted.<sup>2</sup>

**Jurisdiction of Comptroller over Claims.**—The following judgment, which has a very important bearing for applicants for patents, was delivered by Herschell, S.G., in *re Smith's Patent*.<sup>3</sup>

“Provided the specification ends with a statement of the invention claimed distinct from the description of the invention contained in the specification, Sub-sect. 5 of Sect. 5 (*see* page 187) is complied with, and there is no power in the Patent Office to examine into the conformity of the claims put forward by the patentee with the description of the invention which he has given. I should only guard myself by saying this, that if the statement of the invention claimed were such as ‘I claim the invention described in the specification,’ that would be regarded as a mere colourable compliance with the terms of the statute, and not as a distinct statement of the invention claimed, because it would merely refer back to the previous description. Therefore, I think there must be a real statement of the invention claimed, but if there is such a statement I do not think it is competent to the Patent Office to enquire whether it goes beyond or is in conformity with the description of the invention. There is no doubt a claim of a particular machine in saying, ‘I claim the improved bicycle substantially as described,’ or ‘I claim the improved incandescent light,’ or anything which clearly points to what the invention is. But merely to say, ‘I claim the invention described in the previous specification,’ is a case in which, although it has the form of a distinct claim, I should think it was not a distinct statement of the invention claimed.”

**Acceptance of complete Specification.**—In any case, whether filed in the beginning or at any time within nine months, the complete specification must be accepted within 12 months of the date of the application<sup>4</sup> (save in event of an appeal having been filed against refusal to accept). The

<sup>1</sup> *Brown's Patent*, 1887, 2 *Griff.*, 1.

<sup>2</sup> *Grenfell and McEvoy's Patent*, VII *R.P.C.*, 151.

<sup>3</sup> 1 *Griff.*, 268.

<sup>4</sup> Sect. 9 (4).

Comptroller may, on request and payment of the prescribed fee, enlarge this time not longer than three months.<sup>1</sup> These fees have been recently reduced to 2*l.* for one month, 3*l.* for two months, and 6*l.* for three months; they are payable on again presenting the rejected and amended specification for acceptance during thirteenth, fourteenth, and fifteenth months respectively. For rights obtained on acceptance of complete specification, see Chapter IV.

**Publication for Opposition.**—Upon the acceptance of the complete specification the fact is advertised in the official journal, and during the two months next following the date of the advertisement anyone may oppose the grant on certain grounds (see Chapter XVII).

**Issue of Letters Patent.**—If no opposition is filed, the patent is sealed and issued in about seven days after the expiration of the period for opposition. It does not contain any copy of the specification or drawings. It is dated and numbered the same as the original application, and runs for 14 years from that date, subject to the payment of the renewal fees.

The grant of a patent on a later application shall not prevent grant of patent on an earlier application.<sup>2</sup>

**Application under International Convention.**—Persons who have made application in any of the countries mentioned below, if they desire, may have their application in Great Britain dated back to the date of their application in the said country or to the first of such applications if there be more than one, and so obtain in Great Britain the priority of that date, provided they apply in Great Britain within seven months of the date of application in said country or of the first of said applications respectively.

Such patents can be applied for *only in the name of the applicant for the foreign patent or patents* (i.e., cannot be taken as communications), the following additional documents being required:—

(a) The application form (known as Form A<sup>2</sup>) in place of the usual form (see Appendix II, Form 3).

(b) A certified copy of the specification and drawings filed with the said foreign application (or the first of them) as filed and stated to be such (not as allowed but as *applied for*).

(c) In case also this certified specification is in a foreign

<sup>1</sup> Act of 1885, Sect. 3.

<sup>2</sup> Act of 1883, Sect. 13.



language, a sworn translation must be added (this can be made by British patent agent).

(d) *A statutory declaration* (made, if abroad, before a notary or British consul) that the invention in respect of which the application in Great Britain is made is identical with that in respect of which the said foreign application was made. No particular form. (This can also be made by the British agent.)

These three requirements are in addition to the usual specification (which may differ in wording, or cover a smaller invention than the certified copy of the foreign specification), and necessary drawings for deposit and appointment of agent.

The use of the convention is optional, and is only likely to be required by foreigners when home patents are issued to them within five or six months of their application and it is desired to antedate patents in England to avoid the effect of publication or of previous applications which may have occurred there in the meantime. It should be noted that applications antedated can only be given the date of the day of application for the home patent, and no other date subsequent thereto, and that the term of seven months during which applicants may avail themselves of the privilege of antedating, commences to run from the day of *application* for the home patent, not from its grant or issue.<sup>1</sup>

The privilege is permitted by Sections 103 and 104 of the Act of 1883, and is extended by Great Britain not only in respect of applications made in the countries that have adhered to the Convention (for a list of which see page 360), but also by Order in Council from time to time it may be brought into force for any country with which Her Majesty is pleased to make similar arrangements, or any colony giving reciprocal privileges in this respect.

Orders in Council under these sections have been issued in respect of:—

Mexico	Tasmania	Western
Paraguay	Uruguay	Australia.
And for designs and Trade Marks only:—		
Equador	Greece	Roumania.

**Drawings for Specifications.**—Rule 28. The provisional or complete specification need not be accompanied by drawings

<sup>1</sup> Even where, as in the United States, the patent is not dated the day of application, it is the application date which governs the British patent and to which the latter will be antedated, if advantage be taken of the Convention.

if the specification sufficiently describes the invention without them, but, if furnished, they should accompany the provisional or complete specification to which they refer. No drawing or sketch such as requires a special engraving for letterpress should appear in the specification itself. If drawings are filed with the provisional specification and the complete specification does not necessitate any change in them, the applicant may adopt the drawings lodged with his provisional specifications as the drawings for his complete specification, but he should then refer to them in the latter document as those "left with the provisional specification." For sizes, &c., of drawings, *see* Appendix III.

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## CHAPTER XIV.

METHOD OF APPLICATION FOR PATENT, &c.:  
THE IMPORTANCE OF THE TITLE.

**Past Importance of Title.**—The Act of 1883, Sect. 5 (5), says “A specification, whether provisional or complete, must commence with the title.”

This title is intended to be a short and succinct *résumé* of the invention and has always been considered in the Courts of Law as a very important and material part of the patent. It is the link which connects the invention with the patent.

Why such importance should have been given to the title is easily understood when the former method of granting patents is considered. It was the fashion to grant a patent simply upon the title given by the inventor and without any previous disclosure of the invention. The Act of 1852 first required a provisional specification to accompany the application for patent, but up to 1884 it was the rule to grant the patent in such case before the complete specification was filed. The title was recited in the patent and a proviso added that if the patentee failed to file a complete specification of the invention within a certain time the grant should be void. If, therefore, the title described one thing and the complete specification something else the patentee was held to have obtained the patent by fraud on the Crown for representing his invention in the title to be something else than it really was.<sup>1</sup> The grant would also have been void for non-fulfilment of the proviso above-mentioned, since the patentee has not filed a complete specification of that invention which he had previously in the title represented himself as possessing.

These were the technical reasons for voiding patents given in a series of decisions of the Courts and universally upheld.

**The Practice under the Act of 1883** is, however, different; the patent is not now granted until after the com-

<sup>1</sup> *Brunton v. Hawkes, Morgan v. Steward*, 1 *Web. P.C.*, 196.

plete specification has been filed, but the patent still recites the title only, while declaring that the invention has been specified, &c., in the complete specification.

Some writers have deduced from this circumstance that there is no longer any importance in the title, there can be no deceit on the Crown when the patent is only granted after the specification has been filed and accepted; the former proviso also is naturally omitted and consequences of its non-performance fall with it.

The reasoning is correct, so far as it shows that the logical grounds mentioned in the older decisions are no longer available for judgment of the title. But the deduction is illusory, for grounds given for decisions are often only convenient pegs to hang the decisions on. The true reason is not that the Crown is deceived, but that the public are inconvenienced and the door opened to fraud, and that is equally the case at the present day, if the importance of a correct title be negatived.

**The Object of the Title** is, in reality, to afford a proper and convenient *resumé* for the purpose of indexing and for accurate summary of the contents; it is of the nature of a *précis* for the convenience of the public, so that they, by reading it, may see to what the invention relates, and it is thus intimately connected with the policy of the law, whose head and front are that the invention be properly disclosed for the public convenience. The title of the patent is intended to disclose the object of the invention.<sup>1</sup>

**Present Importance of Title.**—The argument that the title is still of importance is upheld by the Act of 1883 itself, and is the only view consistent with the sole decision reported in connection with the title since that Act came into force.<sup>2</sup>

It was clearly a ground of revocation before the Act of 1883 that the title was at variance with the specification,<sup>3</sup> whatever the reasons given for that ground. The Act of 1883, however, in Sect. 26 specially states that "Every ground on which a patent might, at the commencement of this Act, be repealed by *scire facias* shall be available by way of defence to an action of infringement, and shall also be a ground of revocation," so that the ground has equal force to-day.

In *Dowling v. Billington*<sup>2</sup> objection to the title was made and decided in favour of the patent on the merits, both in first instances by the Vice-Chancellor, and on appeal by the Lord

<sup>1</sup> *Househill Company v. Neilson*, 1 *Web. P.C.*, 678.

<sup>2</sup> *Dowling v. Billington*, High Court (Ireland), *Ch.*, VII *R.P.C.*, 191.

<sup>3</sup> *Cook v. Pearce*, 1844, *S.Q.B.*, 1064.

Chancellor, Lord Ashbourne, and Lord Chief Justice O'Brien, no reference being made to illegality of the objection.

From these it may be deduced that attention must equally now be given to the title as was the case before 1883.

**Variance between Title and Specification.**—The title must not describe or include what is not in the specification, or in fact more than the invention is capable of, so far as the specification shows.

An inventor, claiming to produce new notes by his invention in a flageolet, lost his patent when it only appeared that one *new* note was produced.<sup>1</sup>

Brushes stated to be tapering, when in truth only the bristles of each tuft were of different lengths, were held to be wrongly entitled.<sup>2</sup> A well known case is often cited,<sup>3</sup> "A new and improved method of drying and preparing malt," was the title given to an invention, the novelty of which consisted in submitting malt, made in the ordinary way, subsequently to high temperature, with the view of producing a material suitable for giving colour to beer. The patent was held void, for though in the ordinary way the purpose to which an invention is to be put need not be cited in the title, yet when it is necessary for a proper understanding of the title it should be stated. The title would more obviously have led people to suppose that the making of malt was intended. A title for "A machine for an expeditious and correct mode of giving a fine edge to knives, razors, scissors and other cutting instruments" was held to make the patent void when the invention was proved to be inapplicable to scissors.<sup>4</sup>

**Ambiguity of Title.**—Nevertheless a certain amount of ambiguity in the title is allowable. An inventor who entitled his invention "A new *or* improved method," &c., leaving it uncertain whether the invention claimed were altogether or only partly new, was held to be justified in so doing.<sup>5</sup> A patent was also upheld when the title described improvements, &c., while only one improvement was in fact produced.<sup>6</sup> A broadly worded title may also pass, such as "Improvements in steam engines," when it relates actually to a steam engine, no further description of the improvement being given in the title. Never-

<sup>1</sup> *Bainbridge v. Wigley*, 1 *Carp P.C.*, 270.

<sup>2</sup> *R. v. Metcalf*, 1 *Web. P.C.*, 141.

<sup>3</sup> *R. v. Wheeler*, 2 *B. and Ald.*, 345.

<sup>4</sup> *Felton v. Greaves*, 3 *C. and P.*, 611.

<sup>5</sup> *Beard v. Egerton*, 3 *C.B.*, 97.

<sup>6</sup> *Nickels v. Haslam*, 13 *L.J., C.P.*, 146.

theless such improvements must be in proper connection with a steam engine. An improved steam gauge or whistle would not come under that title. An improved street lamp described in the title as "a method or methods of more completely lighting cities and towns and villages" was held to be wrongly entitled.<sup>1</sup>

Space need not be occupied by further quotations from reported cases, since enough has been said to show that the title must accurately contain the invention and afford such guide to persons reading it that they may understand at least what kind of an invention is embodied in the specification. If the title does not afford such indications to a reader it is bad in law and the patent cannot be sustained.

**Too Narrow Title.**—The title must cover the whole invention, and every part of it, otherwise the patentee will not be able to sustain his monopoly for the part not covered by the title. An invention, entitled "Improvements in the doors and sashes of carriages," was stated in the specification to be applicable in any position where windows and doors were subject to jar and vibration. Nevertheless the patent was not held to include any windows and doors but those of carriages.<sup>2</sup> Compared with this may, however, be quoted a later decision (1870), where the title of "Improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein," was held sufficiently descriptive of an invention extended in the complete specification to the manufacture of frills and ruffles and trimmings, since the latter were all things *ejusdem generis*, *i.e.*, in the same category, and were, moreover, but products of the improved machinery.<sup>3</sup>

**Fancy Titles.**—The title in Patent Law is not in any way equivalent to a fancy name. Inventors may name their inventions as they please, such as the "Demon rat trap," "The pulsometer pump," "Excelsior wire netting," but such fancy names need not be mentioned in the application for the patent, and certainly not in the "title," with which the specification is to commence. Where a fancy name is novel and not descriptive of the article in any way, it may be protected as a trade mark, but it has nothing whatever to do with the patent.

**Examination.**—The examiner, to whom the application is referred at the Patent Office, is to ascertain if "the title

<sup>1</sup> *Cochrane v. Smethurst*, *Dar. P.C.*, 354.

<sup>2</sup> *Oxley v. Holden*, 8 *C.B.*, *N.S.*, 707.

<sup>3</sup> *Wright v. Hitchcock*, *L.R.*, 5 *Ex.*, 37.

sufficiently indicates the subject matter of the application,<sup>1</sup> but too much reliance must not be placed by inventors on such official examination.

**Amendment of Title.**—As the title forms in effect part of the specification, and is generally so regarded, it is probable that it may be amended in the same way as the specification itself under Sect. 18 of the Act of 1883, that is to say, by way of disclaimer, correction, or explanation; but it is the universal rule of these amendments that nothing shall make the patent wider or cover more, or a different invention in any way from what was included in its original scope. A narrow title can, therefore, under no circumstances be amended to make it broader, nor can a title at variance with the specification. As any amendment is open to opposition, and during an action can only be made by leave of a judge, it is best by care in first instance to avoid the necessity.

**Publication of the Title.**—Directly an application for patent is filed, the title with the inventor's name and address are published in the official journal of patents and this is all the information relating to the invention published by the Patent Office, until after the complete specification has been filed and accepted. As the public can thus learn nothing, beyond what the title informs them, as to the invention in which the applicant thus obtains priority, the importance of a true and accurate title may be reasonably inferred also from this fact.

<sup>1</sup> Patents Act, 1883, Sect. 6.

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## CHAPTER XV.

## METHOD OF APPLICATION FOR PATENT, &amp;c.: THE PROVISIONAL SPECIFICATION.

**Purpose of Provisional Specification.**—This specification; for the form of which *see* Appendix II, is intended to describe “the nature of the invention,”<sup>1</sup> and has no other purpose. It differs from the complete specification which will eventually replace it, in so far that the purpose of the latter is both “to particularly describe and ascertain the nature of the invention and in what manner the same is to be performed.”<sup>2</sup> The former has therefore only to fulfil a part of what the complete specification will eventually describe; but that part is not in the nature of a skeleton outline, but is a definite and separate part. The nature of the invention, and the manner of performing it, are two entirely distinct and separate things, and they differ not only in kind but in purpose. The first is intended to describe just what the “invention” itself is; to describe in fact its character and nature for the purpose of showing what the inventor wishes to retain for himself; the second is for the public benefit being in the nature of full directions for putting the invention into practice. Too much stress must also not be laid on the fact that the description in the complete must completely ascertain and describe the nature of the invention, while the provisional need only “describe” it, because whatever the description given, it must naturally be a full and proper one, and therefore complete and “particular” in its nature, otherwise it is in truth no description at all.

Wherever any person has made an invention, it must be presumed that a proper and sufficient description of its nature can be given; for the reason is obvious, that what cannot be described has not been invented. It may be politic to wait and allow the inventor to experiment to find out exactly the best way to carry the invention into practice, as there may be many ways of doing the same thing, and it is advisable that the

<sup>1</sup> Patents Act, 1883, Sect. 5 (3).

<sup>2</sup> Patents Act, 1883, Sect. 5 (4).



public shall be actually informed of the best; but as the inventor obtains priority over others from the date of his application, it is reasonable to be assured, that the invention itself has actually been made by him, of which of course the wording of the specification is the only proof.

- **The Nature of an Invention.**—It is not sufficient for any person to simply propose an object to be attained; that is not an invention, it may have been the aim of many. The invention lies in the way in which the proposed object is to be attained, and until the applicant can describe the nature of the way in which he proposes to effect the desired object, he has made no invention. But he does not need to wait until he can actually give every detail, it is sufficient if he be in possession of a definite principle on which to construct his machinery or carry out his intended process.

The nature of an invention is not then in its details, but in the principle which underlies it, and this is what is required to be described in the provisional specification, as well as also in the complete specification.

As an applicant for patent is presumed in law to be already in possession of an invention, and obviously therefore able to define its nature at the outset, the delay of nine months given him for filing the complete specification is only intended to afford time to experimentally determine the best practical mode of carrying the invention into effect, not to allow him to add to or alter his invention itself; that is to say, the definite principles which he has discovered, and to which he intends to give practical, in place of theoretical, shape.

**Importance of the Nature of the Invention.**—So far as the patentee is concerned, the nature of the invention is the most important part, because its description gives accurate limits to the scope of the invention, and therefore of the monopoly given by the patent. It defines what the public may not freely employ and consequently the *extent* of the patent rights depend wholly on it. The description of the way of performing the invention is more directly important to the public than to the patentee, since the latter description does not define how far the monopoly actually extends, but only gives directions for the use of the invention.

**Relative Importance of both Specifications.**—It has been customary to describe the complete specification as in every case the most important, and inasmuch as it is the more extensive and subject to direct attack in patent litigation it is perhaps so in various senses, but in a question of properly

patenting an invention, so as to secure its value for the patentee, I am more disposed to consider the provisional specification, where one is filed, as of the greater importance since the subject of which it particularly treats and to which it first gives shape in words is the more important part of the total information required from the inventor, and one in which mistakes can seldom, if at all, be rectified. Where the nature of the invention has been adequately described in the provisional specification, it is generally sufficient to simply copy it into the complete, previous to describing the mode of performing the invention.

**Origin of the Provisional Specification.**—Before 1850, patents were simply granted upon the titles of the inventions given by the applicants, and no further information was required of them until six months had elapsed and the complete specification had to be filed. This lax method of procedure caused great inconvenience and presented great opportunity for abuse, until in the above year the Attorney-General, whose warrant was necessary before a patent could be sealed, issued an order that a general outline of the invention should be furnished when the application was filed.

The requirement was embodied in the Act of 1852 and adopted also in 1853. Its object was stated in *Newall v. Elliott*,<sup>1</sup> to be in order “to ascertain the identity of the invention and make it certain that the patentee shall ultimately obtain his patent for that invention which he presented in the first instance.” It has also been clearly laid down that the provisional and complete specifications of a patent ought not so to differ that the nature of the invention as described in the one, shall be materially different from its nature as described in the other.<sup>2</sup> In the opinion of Lord Chancellor Chelmsford “the office of the provisional specification is to describe the nature of the invention, not with minute particularity, but with sufficient precision and accuracy to inform the Law Officer what is to be the subject matter of the patent. . . . It clearly appears that the complete specification is in a sense supplemental to the provisional specification not going beyond or varying from it, as to the nature of the invention, but conveying additional information which may have been acquired during the currency of the provisional specification as to the manner in which the invention is to be performed.”<sup>3</sup>

<sup>1</sup> 1864, 10 *Jur.*, N.S., 955.

<sup>2</sup> *Foxwell v. Bostock*, 1864, 10 *L.T. Rep.*, N.S., 144.

<sup>3</sup> 1866, *Penn v. Bibby*, *L.R.*, 2 *Ch.*, 132.

**Method of Performance unnecessary.**—The provisional specification was never intended to contain such a description as to enable a workman of ordinary skill to make the invention,<sup>1</sup> and so long as the nature of the invention is described, the inventor need not describe any way of carrying it out.<sup>2</sup> Nevertheless such a description of the method of performance, though unnecessary, will not, if inserted, necessarily harm the specification; and if the inventor discovers a better way of performing the invention before the complete specification is filed he not only *may*, but *ought* to describe it in the latter.<sup>3</sup> With due deference to the Court of Appeal, it is, however, generally inadvisable to insert in the provisional specification any method of carrying an invention into effect, since it is apt to be confused with the nature of the invention, and lead to allegations of variance if a different method be shown in the complete specification.

**Claims unnecessary.**—No claims should be added to the provisional specifications, for it is not the function of this specification to claim anything.<sup>4</sup> The specification is in itself a claim, as it should cover only the essentials of the invention.

**Permanent Nature of Provisional Specification.**—Although in a sense, this specification itself is of a “provisional” and temporary character, being afterwards replaced by the complete specification; its contents are the very reverse of temporary, they are in their essence of the greatest permanency. The nature of an invention cannot alter. An invention is entirely distinguished by its nature, and any change in its nature argues a change in the invention. If, therefore, an inventor describes the nature of his invention to be such and such in the provisional specification, it cannot be permitted, and is not permitted, by law to alter that nature, or describe it as otherwise in the complete specification. If there appears to be any material difference between the “nature” as described in, or ascertainable from, the complete specification, and that in the provisional specification, this is termed “variance,” and the patent is void. It is for this reason that the provisional is printed with the complete specification after the latter is filed and accepted, for purposes of comparison; and the permanent character of this specification as a record is thus apparent.

<sup>1</sup> *Stoner v. Todd*, 1876, 4 *Ch. D.*, 59.

<sup>2</sup> *Woodward v. Sansum*, *C.A.*, 1887, IV *R.P.C.*, 166.

<sup>3</sup> *Siddell v. Vickers*, *C.A.*, 39 *Ch. D.*, 92.

<sup>4</sup> *Lucas v. Miller*, 1885, II *R.P.C.*, 155.

## CHAPTER XVI.

## METHOD OF APPLICATION FOR PATENT: THE COMPLETE SPECIFICATION.

**Importance of Complete Specification.** — The complete specification<sup>1</sup> is by far the most important and difficult matter connected with the patent, it is in fact the very foundation of the patent. As a limiting factor it governs the whole extent of the patent rights. The latter may be broad and far-reaching or narrow and practically valueless, according simply to the wording of this specification.

On the wording of this document alone will depend whether the invention shall be fully covered and protected in all its extent, and its full value thus obtained and preserved; or whether only a part of this full value will be had; or whether the whole of the invention, so far as legal protection of it goes, shall be in effect utterly thrown away.

**Importance to Public.**—If we consider for a moment the function and object of a complete specification, the reason for its extreme importance will be at once manifest. It is important to the State, because it is the only equivalent which the latter receives for the patent right. The disclosure of the secret of the invention is the price which an inventor pays for his monopoly; it must be full and exact and put into the logical form, which legal experience has shown to be the best suited to the various ends and purposes in view.

**Importance to Inventor.**—It is important to the inventor, because in describing and setting forth his invention, he is limiting or showing the bounds and extent of the exclusive rights that he seeks, so that others shall not use what he claims as within his invention. A closer examination will show that in this the specification bears a somewhat different aspect to the inventor and to the State; for the State requires simply that the invention shall be fully described so that the stock of public knowledge may be increased, and trade thus benefited.

<sup>1</sup> For the form of this specification see Appendix II.

The disclosure of the invention is not necessarily synonymous with its protection, therefore the inventor should so disclose his invention that he retains the right of protection for it, that is to say by disclosing it in a particular way. Thus taking a simple example, an inventor of a machine may describe the machine as a whole with great minuteness and care, and thus produce a description from which any competent person can make such a machine, but he has not thereby disclosed an "invention." A Court can only presume that the machine as a whole is the matter set forth, giving but poor protection, since it is seldom necessary for an infringer to exactly copy a machine, he more frequently adapts and varies the original construction and design.

**Preparation for Complete Specification.**—Not only the actual drawing up of this specification but the preparation and arrangement of materials for it have to be carried out with care and skill. Patience and time are almost essential to the proper ascertaining and marshaling of facts bearing upon or tending to modify the scope of the invention and its practical embodiment. It is for this reason that the inventor, as a general rule, will find it best to protect his idea or crude invention by means of a Provisional Protection, so as to obtain time for the work necessary to develop the invention and present a complete specification in the best form.

**Distinction between "Nature" and "Performance."**—The difference between the disclosure of an invention for the purpose of the public obtaining information for the performance of it, and the disclosure necessary to protect the rights of the inventor is brought forward in the very opening of the specification itself. Thus in the words of the form<sup>1</sup> and of the Act of 1883,<sup>2</sup> the complete specification shall particularly describe and ascertain the nature of the invention and in what manner it is to be performed. The distinction is clearly put in the judgment given in *Philpot v. Hanbury*.<sup>3</sup> "The nature of the invention and the method of performing the same, are two different things. The object of requiring the nature of the invention to be stated in the specification is that persons reading it may know with reasonable clearness and facility what they are prohibited from using, the object of requiring the patentee to particularly describe and ascertain the means of

<sup>1</sup> For the form of this specification see Appendix II.

<sup>2</sup> Section 5 (4).

<sup>3</sup> 1885, II R.P.C., 38.

performing the same is to prevent him from extending his monopoly by keeping secret the mode in which he did it." Also in the Court of Appeal in *Edison and Swan v. Holland and others*:<sup>1</sup> "The two conditions in order to sustain a patent are distinct, and compliance with one is not necessarily compliance with the other. The first is that the patentee must state in clear and intelligible language what the invention really is, so that others may know what addition the patentee has made to what was known before, and what they are not at liberty to do without his consent. The second condition is that he must state in clear and intelligible language how the patented invention is to be performed, so that others may learn from it how practically to avail themselves of it."

**To whom Addressed.**—To be able to give what will prove to be a full and sufficient description of an invention to enable others to work it at the expiration of the term of the patent it is preferable to enquire at the outset as to what class of persons the specification may be presumed to be addressed. In *Newberry v. James*,<sup>2</sup> Lord Eldon held that "the specification should be so clear as to enable all the world to use the invention as soon as the term for which the patent had been granted was at an end." More exactly stated in *Galloway v. Bleaden*,<sup>3</sup> the specification must contain "such a fair and clear statement that a person with a competent degree of knowledge upon the subject-matter to which the patent relates would be able to make that which the plaintiff enjoys the exclusive privilege of"; and in *Bickford v. Skewes*,<sup>4</sup> the specification is addressed not to persons entirely ignorant of the subject-matter, but to artists of competent skill in that branch of manufacture to which it relates.

In *Plimpton v. Malcolmson*,<sup>5</sup> Jessel, M.R., said: "It is plain that the specification of a patent is not addressed to people who are ignorant of the subject-matter. It is addressed to people who know something about it. If it is a mechanical invention, as this is, you have first of all scientific mechanics of the first class, eminent engineers; then you have scientific mechanics of the second class, managers of great manufactories, great employers of labour, persons who have studied mechanics—not to the same extent as the first class, the scientific engineers, but

<sup>1</sup> 1839, VI *R.P.C.*, 243.

<sup>2</sup> 1817, 2 *Mer.*, 451.

<sup>3</sup> 1839, 1 *Web. P.C.*, 524.

<sup>4</sup> 1841, 1 *Q.B.*, 938.

<sup>5</sup> 1876, *L.R.*, 3 *Ch. D.*, 568.

still to a great extent—for the purpose of conducting manufactories of complicated and unusual machines, and who, therefore, must have made the subject a matter of considerable study; and in this class I should include foremen, being men of superior intelligence, who like their masters, would be capable of invention, and like the scientific engineers, would be able to find out what was meant even from slight hints; and still more from imperfect descriptions, and would be able to supplement so as to succeed even from a defective description, and even more than that, would be able to correct an erroneous description. That is what I would say of the two first classes, which I will call the scientific classes. The other class consists of the ordinary workman, using that amount of skill and intelligence which is fairly to be expected from him—not a careless man, but a careful man, though not possessing that great scientific knowledge or power of invention which would enable him by himself, unaided, to supplement a defective description or correct an erroneous description. Now, as I understand, to be a good specification, it must be intelligible to the third class I have mentioned, and that is the result of the law.”

The persons to whom a specification must be presumed to be addressed must more or less depend upon the nature of the invention, thus in *Badische Anilin and Soda Fabric v. Levinstein*,<sup>1</sup> a specification relating to the manufacture of dyes was held by the nature of the subject to be addressed to specialists in chemistry, such as are very generally employed in connection with dye works. In relation to a patent for manufacturing incandescent electric lamps, the subject being then entirely new, it was stated that the specification should be sufficient to enable an intelligent working man to make an incandescent lamp without having to try experiments.<sup>2</sup>

**Actual Sufficiency of Description.**—It should be borne in mind that it is always a question of fact, whether the invention has been so described, that the persons, workmen, mechanics, artists, &c., as they are variously termed in different decisions, will understand the invention sufficiently.<sup>3</sup> It will be well, therefore, to so explain the invention, that much expert assistance will not be perhaps required, to render the subject or gist of the invention intelligible to the jury, or to the judge

<sup>1</sup> 1887, *H.L.*, 12 *App. C.*, 710, *IV R.P.C.*, 449.

<sup>2</sup> 1889, *Edison and Swan Company v. Holland and others*, *L.T. Rep.*, *IV*, 386.

<sup>3</sup> *Hill v. Thompson*, 1887, *Walton v. Bateman*, 1842, *Wallington v. Dale*, 1852, *Parkes v. Stevens*, 1869.

sitting without a jury, it being often the result of the explanation of experts brought up by the plaintiff and defendant to contradict each other, that the matter is made more unintelligible than before to minds unacquainted with the practical side of the art.

“The construction (meaning) of the specification is for the Court to determine, like the construction of any other written instrument, the Court placing itself in the position of some person acquainted with the surrounding circumstances as to the state of art and manufacture at the time and making itself acquainted with the technical meaning in art or manufacture which any particular word or words may have. When the nature of the invention is thus ascertained by the Court as a matter of construction, the Court has then to inquire whether the manner in which the same is to be performed is sufficiently described in the specification to the comprehension of any workman of ordinary skill in the particular art or manufacture; and this the Court can best do by the evidence of workmen of that description, and by evidence of what workmen of that description have actually done under the patent.”<sup>1</sup>

If the specification is in point of fact sufficient to guide a competent workman, the specification must be held to be sufficient in point of law. It is for defendants to prove that the information given in the specification is not sufficient.<sup>2</sup>

**Bona Fides.**—It is incumbent on the inventor to reveal everything so that others may be able to use the invention in as ample and beneficial a way as the patentee himself uses it.<sup>3</sup>

A patentee who has invented a machine useful to the public, and can construct it in one way more extensive in its benefit than in another, and states in his specification only that mode which would be least beneficial, reserving to himself the more beneficial mode of practising it, although he will have so far answered the Patent Law as to describe in his specification a machine to which the patent extends; yet he will not have satisfied the law by communicating to the public the most beneficial mode he was then possessed of for exercising the privilege granted to him. . . . If at the time when he obtained his patent he was apprised of this more beneficial mode of working, and did not by his specification communicate this more beneficial mode of working to the public; that will

<sup>1</sup> *British Dynamite Company v. Krebs, H.L.*, per Lord Chancellor Cairns, 1 *Good. P.C.*, 91.

<sup>2</sup> *Edison v. Woodhouse, 2nd act, C.A.*, 1887, 1 *Web. P.C.*, 66.

<sup>3</sup> *R. v. Arkwright, 1785*, 1 *Web. P.C.*, 66.



have been a fraudulent concealment from the public, and will render his patent void."<sup>1</sup>

**Misleading Description.**—The specification must not be misleading. A patentee gave three recipes for preparing substances which when mixed were to produce seidlitz powder. These recipes were known and the materials made by them could be purchased.

Abbot, C.J., in delivering judgment,<sup>2</sup> said: "It is the duty of anyone to whom a patent is granted to point out in his specification the plainest and most easy way of producing that for which he claims a monopoly, and to make the public acquainted with the mode which he himself adopts. If a person, on reading the specification, would be led to suppose a laborious process necessary to the production of any one of the ingredients, when in fact he might go to a chemist's shop and buy the same thing as a separate simple part of the compound, the public are misled. If the results of the recipes, or any of them, may be bought in shops this specification, tending to make people believe an elaborate process essential to the invention, cannot be supported."

In *Sturtz v. De la Rue*,<sup>3</sup> patent was held void because sufficient information as to procuring a substance to be used, "the finest and purest chemical white lead," was not given. It appeared that the best procurable in London would not answer, that a particular quality procurable on the Continent was the only material suitable. "The patentee ought to have directed the attention of the public to that circumstance."

In a patent for drying and finishing paper the specification required the use of cloth "which cloth may be made of any suitable material, but I prefer it to be made of linen warp and woollen weft." As a fact the inventor had tried other cloths but only that "preferred" by him was found suitable, the patent was held invalid as the specification tended to mislead the public and to induce other persons to make experiments which the patentee knew must fail.<sup>4</sup>

**Intention Immaterial if Specification Misleading.**—It is not essential that the patentee should have intended to mislead, it is sufficient even if his specification would have that effect.<sup>5</sup>

<sup>1</sup> *Bovill v. Moore*, 1816, *Dav. P.C.*, 400.

<sup>2</sup> *Savory v. Price*, 1822, 1 *Ry. and Mo.*

<sup>3</sup> 1828, 1 *Web. P.C.*, 83.

<sup>4</sup> *Crompton v. Ibbotson*, 1828, 1 *Web. P.C.*, 83.

*Simpson v. Holiday*, 1864, 20 *Newt. Lond. Jour., N.S.*, 108.

If the statement made is obviously impossible to realise, and in fact does not deceive, it would appear to be insufficient to invalidate the patent. In *Thomson v. Batty*<sup>1</sup> a claim for the employment in compasses of a large bowl *filled or partially filled* with a viscous fluid was held not to invalidate the patent, although partial filling was necessary to secure complete effect, "filling" would answer only to a limited extent.

**Limits of Invention must be Defined.**—A person ought to be warned by the specification against the use of the particular invention. Therefore in the specification of a patent for an improved instrument it is essential to point out precisely what is new and what is old, and it is not sufficient to give a general description of the construction of the instrument without making such distinction.<sup>2</sup>

Where a patented machine or apparatus is entirely new, the patentee is not bound to describe and distinguish the different parts, but where the invention consists of a machine, which is only an improvement upon an old machine, he must distinguish and describe all the parts which he claims as new.<sup>3</sup> If this be not done it will be considered that the whole machine and also its different essential parts are claimed as new, in fact everything described.<sup>4</sup>

**"Combination" Patents.**—But if the invention is expressed as consisting of a combination or special arrangement of parts this will not constitute a claim to the parts individually.<sup>5</sup> When a claim is made for a combination of parts, the combination itself is therefore the invention, the novelty lies in that, and it is not necessary to specially disclaim the separate parts or state same to be old.<sup>6</sup> This case being decided in the House of Lords must be considered a leading case. The law as it governs the construction of a "Combination" Patent cannot be better stated than in the words of Lord Hatherley in *Clark v. Adie*:<sup>7</sup> "The case of *Foxwell v. Bostock* (4 De G.J. and S., 298) decides this, that where you take a well-known machine, an instrument which was well known before the date of the patent, you may, if you think

<sup>1</sup> 1888, VI R.P.C., 84.

<sup>2</sup> *Macfarlane v. Price*, 1886, 1 *Web. P.C.*, 74.

<sup>3</sup> *Dangerfield v. Jones*, 1865, 13 *L.T. Rep., N.S.*, 144.

<sup>4</sup> *Carpenter v. Smith*, 1841, 1 *Web. P.C.*, 532; *Tetley v. Enston*, 1853, *Macr. P.C.*, 82.

<sup>5</sup> *Lister v. Leather*, 1858, 27 *L.J., Q.B.*, 295.

<sup>6</sup> *Harrison v. Anderson Foundry Company*, 1876, *L.R.*, 1 *App. Cas.*, 577.

<sup>7</sup> *H.L.*, 1877, 2 *App. Cas.* 328.

fit, improve all the various parts of that machine by introducing into two or three of its definite parts, if there are so many, that which is now either by way of combination, or by way of discovery, and you may claim for each of those parts into which you have so introduced something new, the privilege of protection, just as if you had taken out Letters Patent for each of those new things separately—and you may claim for those parts A, B, and C, which, considered as separate things, are in themselves deserving of a patent—you may claim for them, when united, a beneficial result which may entitle you to a patent for the whole machine. But I apprehend, my lords, you must in some way or other inform those whom you are dealing with—by which I mean the general public—whom you wish to exclude for a certain number of years from using your invention; you must inform them, in some mode or other, whether you have subdivided, if I may use the term, your machine into those separate parts, and claim for each part the merit of novelty, or whether you are simply making a combination of things *per se* old, but which have never been used before in combination and which make up, as you say, your machine, for which you claim protection as a novel and useful machine, and which machine must not be made by anybody but yourself. If you claim protection also for a portion of the machine you must make it plain, I do not say necessarily by words or by any particular mode, but in some definite mode or other you must point out what is the combination of parts which you ask to have protected, and what are the subordinate parts which also you ask singly and respectively in themselves to have protected.”

**Complete after Provisional.**—A complete specification filed after a provisional in no way differs from one filed at the time of the application, but in drawing it up care must be taken not to exceed the terms of the provisional so far as to constitute legal variance which would render the patent invalid. The difficulty in judging variance lies more in the application of the principle of the law than in the principle itself.

According to Lord Blackburn, in *Baily v. Robertson*, H.L. :<sup>1</sup> “When the nature of an invention has been described in the provisional specification in the way which has been mentioned, if something were found out during the six months to make the invention work better, or with respect to the mode in which the operation may be performed—a thing which is very likely

<sup>1</sup> 1878, 3 *App. Cas.*, 1073.

to happen when in carrying out his invention, the inventor finds some particular bit will not work so smoothly as he expected, and it is necessary to add a little supplement to it. Still the nature of his invention remains the same, and it is no objection that in the complete specification, which comes afterwards, the invention or application is described more particularly and in more detail; or even if it be shown that there has been more discovery made, and so as to make the invention which he has described in the provisional specification really workable. If nothing more is done than that, I think it is good, but as soon as it comes to be more than that, and the patentee says, in the provisional specification, I describe my invention as A, and in the complete specification he says, I hereby describe A, and also B, then, as far as regards B, it is void, because the Letters Patent were granted for the invention that was described in the provisional specification, and do not cover the invention that is described in the other."

In this case the inventors had described in the provisional specification a mixture of bisulphide of lime, with a certain quantity of gelatine, as a preservative for fresh meat, &c., but in the complete specification had made a claim for bisulphide of lime alone. This was held to be a further invention involving a fatal variance.

In *Horrocks v. Stubbs*<sup>1</sup> the inventors had described means for arresting a machine for doubling, twisting, and winding threads in event of the breaking of any thread, adding in the complete a prop for holding up the oscillating frame which caused the arrest until the broken thread was again joined. This was held a further invention and fatal variance. A claim in the complete specification for something different from that which is contained in, or foreshadowed by, or fairly results from the provisional specification renders the patent void.<sup>2</sup>

Improvements in the arrangement of the mechanism, in the relative position and adaptation of the different parts with a view of producing the same results, the substitution of mechanical equivalents and modifications and developments within the scope of the invention set out in the provisional specification, cannot be held to invalidate a patent on the ground of disconformity between the provisional and complete specifications.<sup>3</sup>

It would appear also that where a combination of parts

<sup>1</sup> 1886, III *R.P.C.*, 232.

<sup>2</sup> 1886, III *R.P.C.*, 233.

<sup>3</sup> Per Lopes, L.J., in *Woodward v. Sansom*, IV *R.P.C.*, 166.

is visible in the provisional specification the complete may comprise more than the method of combining or arranging them.<sup>1</sup>

Nevertheless, if an improvement is made between the filing of the provisional and the complete specifications, and is within the terms of the provisional specification, it not only *may* but *ought* to be described. In *Woodward v. Sansum*,<sup>2</sup> a patentee in his provisional specification described a mode of carrying his invention into effect which was different from that which he stated in the complete specification:—*Held*, that as both modes were really within the same invention, which was described in general terms in the provisional specification, the patent was not bad.

This judgment was quoted with approval in *Siddoll v. Vickers*,<sup>3</sup> where, moreover, it was pointed out that the complete specification might also give a fuller and better description of the nature of the invention, and should do so if the provisional was in that respect at all defective. The provisional may be read in the light of the complete to ascertain if its meaning is doubtful.<sup>4</sup>

The determining factor in this question of the varying of methods described in a provisional, would appear to be whether the variation is still within the nature or principle of the invention.

**Omission of Part of Invention.**—If an applicant has included in his provisional specification more than can be sustained from want of novelty or otherwise, he may omit part in the complete specification, confining the latter to what can be validly held.

If the patentee were to introduce into his complete specification everything which was warranted by the terms of the provisional specification, and afterwards found that a part of that which he had claimed would invalidate his patent for want of novelty or for any other reason, he might afterwards cure the objection by a disclaimer. Now if he would be allowed to disclaim in such a case, which is matter of indulgence, he must have a right to waive his claim to any portion of the grant which the allowance of the provisional specification entitled him to demand.<sup>5</sup>

<sup>1</sup> *Watling v. Stevens*, III *R.P.C.*, 41.

<sup>2</sup> IV *R.P.C.*, 166.

<sup>3</sup> 39 *Ch. D.*, 92.

<sup>4</sup> V *R.P.C.*, 81.

<sup>5</sup> Lord Chancellor Chelmsford in *Penn v. Bibby*, *L.R.*, 2 *Ch.*, 134.

But the remainder must not be altered by the omission.<sup>1</sup>

Where an inventor had originally stated his invention to lie in the employment of wood in the construction of bearings for propeller shafts, &c., in his provisional specification; while describing the method of employment in the complete, his claim for the method "as therein described" was not held such variation as to invalidate the patent.<sup>2</sup> But where a provisional specification described a particular process for treating oils and fats, while the complete did not treat the process as an essential part of the invention, it was held a fatal variance.<sup>3</sup>

A patent for a tap that differed from certain others, only in the employment of a gauze strainer mentioned in the complete specification, was held invalid on account of disconformity, since this strainer was not mentioned in the provisional specification.<sup>4</sup>

According to the Court of Appeal in *Gadd v. Mayor, &c.*, of Manchester,<sup>5</sup> for deciding a question of variance, only two questions have to be considered, viz.: (1) What is the nature of the invention for which the patentee has obtained provisional protection? and (2) Is what is described in the complete specification an invention of a different nature from the former?

For further information applicable to the preparing of this specification see Chapter XIX on Construction of Specification.

**Claims.**—Each complete specification must end with a distinct statement of the invention claimed.<sup>6</sup> This has been interpreted by the Law Officer to mean that the statement referred to must be "distinct" from the specification,<sup>7</sup> though it may refer to the specification, and not that the statement must necessarily be distinct in itself in the sense of clear and unambiguous.

Nevertheless this statement, which is called the "claim," should naturally be in clear words so that there may be no mistake as to what the applicant wishes to reserve for himself.

Until the Act of 1883 was passed there was no statutory requirement that a claim should be inserted in the specification, though as a matter of convenience it was usual for those draughting specifications to sum up the heads of novelty which

<sup>1</sup> *Thomas v. Welch*, *L.R.*, 1 *C.P.*, 192.

<sup>2</sup> *Penn v. Bibby*, *L.R.*, 2 *Ch.*, 127.

<sup>3</sup> *Hutchinson v. Pattullo*, *V R.P.C.*, 351.

<sup>4</sup> *Nuttall v. Hargreaves*, *VIII R.P.C.*, 150.

<sup>5</sup> *IX R.P.C.*, 526.

<sup>6</sup> Patents Act, 1883, Sect. 5 (5).

<sup>7</sup> *Re Smith's Patent*, 1 *Griff.*, 268 (see page 164).

the patentee desired to hold for himself. Nor, under the present Act is a claim an absolute necessity, since it has been held by the House of Lords,<sup>1</sup> holding the same opinion as to the word "distinct," that *so long as the limits of the invention claimed are clearly discernible in the specification*, the absence of a clear claim at the end is not vital. As this means simply that the whole specification in such case should be the "claim," the inventor cannot, on the strength of that decision, avoid considering the meaning of claims.

The claim is in effect a disclaimer,<sup>2</sup> since, in pointing out exactly what the inventor wishes to reserve monopoly of; it, by inference, points out also what the patent does not cover. Where a claim is made, everything not claimed is held to be disclaimed; and everything described in a specification is held to be claimed unless disclaimed, either by a special disclaiming clause or by non-inclusion in the claiming clause; therefore the absence of a claim would, in ordinary cases, as a matter of fact, cause the loss of the patent owing to want of other distinction between what is new and what is old.

The value of a claim for a patentee, is that it enables him readily to fulfil the duty the law requires of distinguishing new from old. As the patentee is entitled to every point of novel and useful subject matter, that may be included in his specification; his claims should state, in the fewest possible words, what those points are. This must be done with due regard to Patent Law, so that it may not be said that what the patentee has claimed is not proper subject matter within the Patent Law; it must not be too wide, that want of novelty can be alleged against it, nor too narrow that the patentee should lose a part of his rights. It must, moreover, be certain and clear so that the patent may not be held void for ambiguity.

From the above it will be apparent that the claim is the most important part of the specification. Every word in it (or them, for more than one claim may be made) must be carefully weighed, for any one word will usually materially vary the scope of the claim, consequently the extent of the monopoly and the value of the patent. For further explanation on the latter head see Part I, especially pages 46 to 49.

Under the above decision,<sup>3</sup> that so long as the claim is distinct—apart—from the specification it fulfils the requirements of the Act; the examiners no longer see that the

<sup>1</sup> *Siddell v. Vickers*, VII R.P.C., 292.

<sup>2</sup> *Lucas v. Miller*, II R.P.C., 155.

<sup>3</sup> *Re Smith's Patent*, 1 Griff., 268.

claims cover the invention properly, for their duties (see pages 28 to 34, and 162) do not extend to that point. This throws the whole onus on the applicant or his patent agent, and in view of the great importance of logical accuracy in the claims too much care cannot be given to their consideration.

Claims are not intended to be made for the *advantages, &c.*, of the invention but for the subject matter of the invention itself.

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## CHAPTER XVII.

## OPPOSITION TO THE GRANT OF LETTERS PATENT.

**Time for Opposition.**—When the complete specification of the invention has been “accepted” by the Comptroller of Patents, this fact is notified to the public in the next weekly issue of the “Illustrated Official Journal of Patents.”

The notice of “acceptance” is not accompanied by any illustration or details of the invention, but the original specification and drawings may then be seen at the Patent Office on payment of 1s. fee; and about three weeks after the “acceptance,” the printed specifications with drawings are issued at the uniform price of 8d. per copy. Within two calendar months of the date of the official journal in which the fact of acceptance is notified, any person may file a form (see Appendix II) of opposition to the grant of the patent, on one of the three following grounds,<sup>1</sup> but no others:—

**Grounds for Opposition.**—The sole grounds for opposition are (a) that the applicant for patent has obtained the invention from the opponent, or from a person of whom he is the legal representative; (b) that the invention has been patented in this country on an application of prior date; and (c) that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification.

The above are the only grounds on which the grant of a patent may be opposed, although there are other grounds on which the patent might be revoked, or held inoperative, after the grant.<sup>2</sup>

**First Ground of Opposition: Fraud on Opponent.**—This ground, namely, that the invention was obtained from the

<sup>1</sup> Patents Act, 1883, Sect. 11, sub-sect. 1, as amended by the Act of 1888, Sect. 4.

<sup>2</sup> See Chapters XX and XXIII.

opponent, or from a person of whom the opponent is the legal representative, will usually be based more or less on an allegation of fraud, since the free communication of an invention from one to another for the purpose of taking a patent, in the name of that other, is not countenanced by the British Patent Law.

Thus, where an opposition was filed alleging that the invention had been obtained from the opponent, it was successful, though the opponent had accompanied the applicant to instruct the patent agent, and had himself suggested that it should be applied for in the name of the applicant.<sup>1</sup> Decision in a case of fraud always presents considerable difficulty, owing to the diversity usually found between the declarations of fact on the side of the applicant and opponent respectively. Since the Comptroller has no power of examining witnesses on oath, declarants cannot be subjected to cross-examination before him; so that, unless a very clear case is proved, it will usually be hopeless to stop the grant of the patent. Where the documentary evidence presented is of a very contradictory nature, instances are at hand in which the parties have agreed to accept judgment from the Comptroller, allowing the patent to proceed, in order that the case may be fought out on appeal before the Law Officer who can administer oaths.<sup>2</sup>

Usually, in oppositions of this kind, it is found that the invention as patented is somewhat different from that which the applicant is alleged to have obtained; thus, in *re Eadie's Patent*,<sup>3</sup> it was held proved that E. had received from B. the idea of a particular kind of traveller used in spinning machinery, with a straight part for the thread to take two or more turns. E.'s application for patent covered a traveller having two such straight parts. It was decided by the Comptroller to grant a joint patent to B. and E.

In *Evans and Otway's Patent*,<sup>4</sup> opposed by C., who had been jointly experimenting with Evans, and claimed to be the inventor, the evidence was so contradictory that the Law Officer decided to grant the patent, provided a half-share was assigned to C., the latter having also applied for a patent, to assign a half-share of that to E. Otway, however, a capitalist, added to the application, whose signature was necessary to the assignment, could not be found, so the order was varied to the

<sup>1</sup> *Re Marshall's Application*, 1888, V R.P.C., 661.

<sup>2</sup> *Re Luke's Patent, re Evans and Otway's Patent, infra.*

<sup>3</sup> *Griff.*, 279.

<sup>4</sup> *Griff.*, 279.

effect that E. and O.'s application be refused provided C. assigned half his application to E. A similar decision was given by the Comptroller in *re Garthwaite's Patent*,<sup>1</sup> opposed by K., who had also filed an application for patent for a similar invention.

In *re Luke's Patent*,<sup>2</sup> opposition was filed by T. on the ground that L. had obtained the invention from him whilst in his employ and confidence; the usual conflict of evidence arose, and the Comptroller, on the request of the parties, permitted the patent to proceed with a view of the rights of the parties being determined on appeal. The Law Officer held that L. had not obtained the whole of the invention from T., but that a part at least of the merits of the invention was due to T., and the parties were required to enter into an agreement to secure a half share of the patent to T. To secure the carrying out of this arrangement, refusal of T. to enter such agreement was to entail grant of patent, refusal of L. loss of patent.

In Paterson's patent,<sup>3</sup> the opponent D. sought to show that P. had seen and heard of an invention in the Cork Butter Market, for which he, D., had applied for a patent, and that P. had embodied the invention so learnt in the complete specification filed to complete a prior application of his own, previous to D.'s application. The opposition was successful in spite of a cross opposition of P. to grant D.'s patent. This case occurred before the third ground of opposition, as at present worded, was permitted to be put forward, and may be held to show that an invention may be proved to be obtained indirectly from the opponent.

The Law Officer will take a lawyer's view of the evidence, and be guided as much by the absence of direct evidence, as by the direct statement of the interested parties. Thus in a case where the applicant had declared and maintained that he had received the invention as a communication from a person resident in America, but produced no instructions of any kind or any papers, letters, &c., in support of his statement, the patent was refused on the opposition of the true inventor, who had from time to time communicated to a board of a limited company of which the applicant was a director, certain formulæ on which the specification appeared to have been founded, these formulæ having been entered by the opponent in a

<sup>1</sup> *Griff.*, 284.

<sup>2</sup> *Griff.*, 295.

<sup>3</sup> *Griff.*, 296.

memorandum book used by her and put in evidence in the case.<sup>1</sup>

**Fraud abroad.**—In respect of inventions acquired abroad it is held that neither the Comptroller nor the Law Officer has any jurisdiction to enquire into any circumstances under which an applicant may have acquired an invention out of this realm.

The words in the section of the Act referring to opposition made by a person, alleging that the invention has been obtained from him, are only intended to apply to communications in this country, and not to communications from abroad;<sup>2</sup> for it is settled law that the person importing the invention into the realm is the true and first inventor;<sup>3</sup> and for the purposes of the application it matters not under what circumstances he obtained the invention abroad. The “importer” may be liable to the person from whom he has obtained the invention abroad in respect of the breach of some contract or duty, but those are matters into which neither the Law Officer nor the Comptroller can inquire.<sup>4</sup> This decision was followed in *re Lake's Patent*.<sup>5</sup>

It would appear therefore from the cases above cited that in respect of foreign inventions fraud cannot be proved as a bar to the patent, especially when the application is made by a resident in Great Britain, by way of communication from abroad.

**Master and servant.**—It is settled law, that where an inventor employs others to work out the details of the invention, the modifications, &c., that they may suggest are the property of the employer. In *David and Woodley's Application*<sup>6</sup> this principle was applied to the refusal of a patent to the *employé* on the opposition of the employer.

In *Homan's Patent*,<sup>7</sup> the opposition of the *employé* to the grant of the patent to the applicant failed, although the *employé* had registered the invention as a “design,” it being held that it was the applicant, who alone could claim originality in the particular invention.

**Opponent as Legal Representative of Defrauded Person.**—In respect of obtaining an invention from a person

<sup>1</sup> VI R.P.C., 296.

<sup>2</sup> *Edmund's Patent, Griff.*, 284.

<sup>3</sup> *Edgeberry v. Stevens, see Chapter VII.*

<sup>4</sup> Per Webster, A.G., in *Edmund's Patent*.

<sup>5</sup> V R.P.C., 415.

<sup>6</sup> 2 *Griff.*, 26.

<sup>7</sup> VI R.P.C., 104.

of whom the opponent alleges that he is the legal representative, it has not been determined exactly who may or may not be considered the legal representative. In Edmund's Application it was supposed that this term meant the administrator of a deceased person, and not the holder of a power of attorney, but it was not necessary then to decide the point. In Macfarlane's Application,<sup>1</sup> under the old law, a company successfully opposed the grant of a patent, on the ground that the invention had been obtained from their engineer and chemist.

In the matter of Spiel's Application,<sup>2</sup> however, the opponents, as assignees of the patents and inventions of Johannes Spiel with all improvements thereon, failed to prevent grant of a patent to the applicant, Adolph Spiel, brother of the former; firstly, because the Comptroller held that he had no jurisdiction to enquire into the matter of fraud, the applicant and alleged communicator being resident abroad; and secondly, on appeal, because even if the fraud were proved, they had no *locus standi* to oppose, not being the legal representatives of Johannes Spiel.

**Application for Patent by Opponent.**—It would appear that to place himself in order, the opponent, who alleges that he is the first inventor and that the invention has been taken from him, should himself make an application for patent in the usual way, since the patent he opposes cannot be granted to himself in lieu of the applicant.

This application should be filed at the earliest possible moment, so as to antedate disclosure of the invention. Sect. 35 of the Act of 1883 provides that a patent to the true and first inventor shall not be invalidated by an application in fraud of him or by provisional protection obtained thereon, or by any use or publication of the invention *during the period of provisional protection*.

**Second Ground of Opposition: Prior Patent.**—No patent will be granted if the opponent proves that the invention was patented before *in this country*, even though the validity of the prior patent is disputed;<sup>3</sup> nor may the applicant attack the validity of former patents relied on by the opponent.<sup>4</sup> It is, however, allowable to the applicant to produce other prior patents, or otherwise prove the state of the art at the

<sup>1</sup> *John*, 168.

<sup>2</sup> 1888, V *R.P.C.*, 281.

<sup>3</sup> *Re Manceaux's Patent*, 1870, *L.R.*, 2 *Ch.*, 272.

<sup>4</sup> *Re Jones' Patent*, 11 *Griff.*, 34.

time of the opponent's patents for the purpose of showing the true extent of the patents brought up in opposition to the applicant's.<sup>1</sup> It is immaterial whether the prior patent relied on is still in force or has expired.<sup>2</sup> Before the passing of the Act of 1883, when patents were granted before the complete specification was filed, it was held to be questionable whether any objection could be made to the grant of patent on the ground of the invention having been previously patented, where no complete specification of the invention had been filed.<sup>3</sup> Subsequently, however, to the passing of the Act of 1883 it has been decided,<sup>4</sup> that the words "Patented in this country" do not include inventions which have received provisional protection only, so that uncompleted provisional protections, even when published (they are not published at the present time) cannot be quoted in opposition to the grant of a patent. Opposition can, however, be filed on the ground of a previous patent when the complete specification of that patent has been "accepted," although the Letters Patent have not yet been actually granted.<sup>5</sup> It has been held that, to be successful in opposition, the prior patent relied on must not only describe the invention but absolutely claim it, otherwise it is not considered "patented."<sup>6</sup>

But question cannot be raised whether the patents quoted by the opponent in opposition were really entitled to claim the invention in question, so long as it is found to be actually claimed, *i.e.*, patented therein. Thus the applicant cannot resist on the ground that in that respect the complete specification of the prior patent goes beyond the provisional.<sup>7</sup>

As respects matter described in the applicant's specification but not included in his claims, the applicant may be ordered either to omit the matter, or file disclaimer to show more clearly that he does not intend to claim such matter,<sup>8</sup> and where the applicant has described matter in his provisional specification, to which he has omitted all reference in the complete, he may be ordered to insert in the latter a specific disclaimer of

<sup>1</sup> *Re Jones' Patent*, 11 *Griff.*, 34.

<sup>2</sup> *Re Lancaster's Patent*, 1 *Griff.*, 293.

<sup>3</sup> *Re Scott and Young's Patent*, 1871, 18 *W.R.*, 425.

<sup>4</sup> *Re Bailey's Patent*, 1886, 1 *Griff.*, 270.

<sup>5</sup> *L'Oiseau and Pierrard's Application*, 1887, 2 *Griff.*, 38.

<sup>6</sup> *Re Von Buch's Patent*, 2 *Griff.*, 42.

<sup>7</sup> *Re Green's Patent*, 1 *Griff.*, 286 (see, however, third ground of opposition).

<sup>8</sup> *Re Teague's Patent*, 1 *Griff.*, 299.

such matter in case the provisional might be read to explain the complete.<sup>1</sup>

In order to refuse the grant of a patent there must be more than a slight difference; the alleged invention must be identical with the prior patent.<sup>2</sup>

It has always been considered preferable, where there is any doubt, to grant a patent rather than refuse one, for there is no remedy to the applicant if a patent be refused, while if it be granted it can at any time be revoked if sufficient cause be shown.<sup>3</sup> This is always upheld and acted upon, so that unless exact similarity is shown throughout between the invention sought to be patented, or some separately claimed part of it, and such previous inventions as are relied on, the patent will be sealed.

**Insertion of Reference to previous Patent.**—It is, however, usually ordered, where there is room for any doubt,<sup>4</sup> that the applicant should insert in his specification a disclaiming clause to the effect that he does not intend to cover the previous inventions referred to. It is supposed that this disclaimer is intended to protect the public so that the specification should not appear to claim more than the applicant is really entitled to;<sup>5</sup> and so far as this goes no applicant should object to entering a disclaiming clause if it is necessary for this purpose, as otherwise his patent would be bad by reason of false suggestion.

If a specification is properly drawn up, it should not need any disclaiming clause to make its meaning clearer; nevertheless, if a disclaiming clause is necessary, it is preferable from the applicant's point of view that it should be in general terms and avoid mention of any special previous patent by number and date, since dealings with the patent may be prejudiced, owing to a natural public belief that such a reference is evidence that the second patent is subsidiary to the first, and cannot be used without infringement. On opposition, questions of infringement cannot be in any way considered, so that the effect of these personal references to opponent's specification is to give, without just cause, a misleading idea which is much to the prejudice of the applicant's patent.

In *Anderson and McKinnell's application*<sup>6</sup> the Solicitor-

<sup>1</sup> *Re Hookham's Patent*, 2 *Griff.*, 32.

<sup>2</sup> *Re Stubbs' Patent*, 1 *Griff.*, 258; *Jones' Patent*, 2 *Griff.*, 31.

<sup>3</sup> *Re Russell's Patent*, 1857, 2 *De G. and J.*, 130.

<sup>4</sup> *Re Welch's Patent*, 1 *Griff.*, 302.

<sup>5</sup> *Re Lorrain's Application*, V *R.P.C.*, 142.

<sup>6</sup> 2 *Griff.*, 25.

General said: "Of all ways of protecting pre-existing arrangements in matters of this kind, the one I should be least willing to adopt, would be the mention in one specification of the fact of another patent being in existence." The question would naturally be whether the disclaimer inserted is sufficient to protect the rights of the opponent; it was held that a disclaiming clause naming the actual matter found to be embodied in the former patent was quite sufficient to protect the former patentee without naming his patent by number and date.<sup>1</sup>

In *re* Guest and Barrow's Patent<sup>2</sup> it was held that a prior patentee has no right to be specially named unless the applicants are willing to name him and unless it is clear that there is no other publication except the one that is mentioned. A general disclaimer as to state of knowledge was here held sufficient. The onus is on the opponent to show that a disclaimer is necessary to protect him.<sup>3</sup> The Attorney-General in *re* Sielaff's Patent<sup>4</sup> upheld a requirement for a general disclaimer, quoting, with approval, the decision above mentioned in *Anderson v. McKinnell's Patent*.

The matter cannot, however, be considered placed on a satisfactory footing until the case of *Stell's Patent*,<sup>5</sup> opposed by Farrar. In Attorney-General Sir Richard Webster's own words:—

"The principles upon which the Law Officers have acted now for some years in allowing disclaiming clauses are, first, if it appears clear that upon the invention claimed by the prior patentee there will be a repetition of the claim to the earlier invention in the later patent; and, secondly, if it is clear that the public would be misled by the later specification without disclaimer. . . . I am far from saying that that claim (Farrar's) cannot be infringed by the substitution of a mechanical equivalent. That is a matter which will have to be decided if ever the case comes to be tried, but the Law Officer has nothing to do with the question of infringement in deciding upon the propriety or impropriety of inserting a disclaimer. When, however, we see the combination which is the subject of *Stell's* claim in form it is different. It may be mechanically equivalent and it may be an infringement. But on what ground could Mr. Goodeve's client ask for a special disclaimer and reference? It seems to me it must be upon the ground that the matter is

<sup>1</sup> *Re* Cooper and Ford's Patent, 1 *Griff.*, 275.

<sup>2</sup> *V R.P.C.*, 312.

<sup>3</sup> *Re* Stell's Patent, VIII *R.P.C.*, 237.

<sup>4</sup> *V R.P.C.*, 484.

<sup>5</sup> *Supra.*



so clear that the Law Officer must decide that the reading of the claim of Stell's specification will be a repetition of Farrar's claim. I am not prepared to go as far as that. I repeat that I do not express any opinion whether it is an infringement or not, but I am not prepared to say that it can be nothing more than a repetition of Farrar's claim. There is another reason which I have had occasion lately several times to enunciate why I cannot allow a disclaiming clause in this case; I can well conceive that, assuming Stell's invention not to be an infringement of Farrar's invention, injury might be done to any owner of Stell's patent. The disclaimer asked for is a disclaimer with special reference to Farrar's specification, No. 16,752 of 1887. It is quite clear that the Law Officer is not in a position to be satisfied that he has the whole knowledge before him. I do not know whether, if this matter comes to be investigated, there may not be other specifications covering some part of the ground as near to Stell as Farrar's or, at any rate, indicating that a disclaimer should be in wider terms or should have reference to other existing arrangements besides those which are covered by Farrar's specification. It is obvious that a disclaimer which has reference solely to Farrar's specification might be construed as not being sufficiently wide to include a correct description of the antecedent state of knowledge. Therefore, I cannot see that any injury will be done to Farrar by the granting of a patent to Stell, and I cannot, in the face of the very particular claim properly so framed of Farrar in his specification No. 16,752 of 1887, construe the claim proposed to be put in Stell's specification as being a repetition of that claim, and that claim only, especially having regard to the alteration of the claim which is required by the Comptroller to limit the claim to the combination as distinguished from the subordinate parts of the combination. I think that the onus lies upon a prior patentee who asks for a disclaimer to show that it is necessary. Many years ago Lord Cairns pointed out that these rival disclaimers were of no value to the prior patentee except for the purpose of preventing the public being misled, or of preventing unfair dealing by means of patents which might be subsequently granted. I think that a prior patentee who asks for a disclaimer must satisfy the Comptroller, or the Law Officer on appeal, that it is necessary for his protection, and in this case, whether I regard the special language of Farrar's specification or whether I regard the state of knowledge which is before me, I am satisfied that there is no special injury to the owner

of Farrar's patent requiring that a disclaimer should be inserted."

An opponent may appeal to get a reference to his patent inserted, although he does not appeal against the allowance of the patent.<sup>1</sup>

The antedating of an application filed under International Convention does not give a right to oppose an application made in the meantime, although the patent on the latter may be invalidated by such antedated patent.<sup>2</sup>

It is, of course, within the competence of the Comptroller to require an amendment of the specification, or claims of the applicant, or the omission of any claim, if he is satisfied that that part covers an invention already patented, and he may allow the patent subject to such amendment. The Law Officers have also at times suggested that amendment is required, and have permitted the applicant to suggest and embody an amendment so long as it does not widen the invention.<sup>3</sup>

**The Third Ground of Opposition** was substituted by the amending Act of 1868 for a previous wording by which the report of an examiner that two pending applications were similar inventions was made a ground for opposition. These reports having been found of questionable utility were abandoned. In the only reported case since the amended Act in which this ground was relied on,<sup>4</sup> the opponents failed to prove that the applicants' complete specification, which admittedly included the opponents' invention, was in this respect at variance with, or went beyond, the provisional specification. If the opponents had been able to show that the applicants had in any way obtained the invention from them, then, according to the Attorney-General, there should be no hesitation in striking out the claims and description from the specification, but this not being proved, it is necessary to examine as to whether the invention particularly described in the complete specification is or is not substantially the same as that described in the provisional specification, and if there is not sufficient material to say that there is disconformity, then the patent should be allowed without any amendment of the complete specification.

This decision emphasises the fact that it is necessary to show all the invention sufficiently fully and accurately in the

<sup>1</sup> *Re Brownhill's Patent*, VI R.P.C., 105.

<sup>2</sup> *Re Everitt's Patent*, 2 *Griff.*, 29.

<sup>3</sup> *Re Fletcher's Patent*, 2 *Griff.*, 31.

<sup>4</sup> *Re Anderson and Anderson's Patent*, VII R.P.C., 323.

provisional specification, that this disconformity will not arise when the invention is fully described in the complete specification.

**Filing Opposition.**—The Form of Opposition (*see* Appendix II) must be signed by the opponent in person, and state his address for service in the United Kingdom.<sup>1</sup>

Where the ground of opposition is that the invention has been patented on an application or applications of previous date, each patent so relied on must be stated in above form by its number, date, and title.<sup>2</sup> Where an opponent had omitted to give the title of the patent, the Law Officer allowed the form to be amended at the hearing,<sup>3</sup> but where a patent which might have been relied on had been omitted amendment of form was refused,<sup>4</sup> thus excluding the omitted patent from consideration. The Comptroller has a general power to permit amendment of the opposition form.<sup>5</sup>

Where a patent agent had filled in his own name as opponent and signed the form with his own name, adding "Agent for opponent," the true opponent was permitted to substitute his own name.<sup>6</sup>

**Practice in Opposition: Evidence in Support.**—Where a notice of opposition is filed, a copy is sent by the Patent Office to the applicant or his agent.

Whatever may be the date when the form of opposition was filed, the opponent has 14 days after the expiration of the two months from the date of the advertisement in the journal of the acceptance of the complete specification, within which to file at the Patent Office sworn declarations by himself or others substantiating the grounds of his opposition, and to deliver a list of these declarations to the applicant or his agent.<sup>7</sup> Within 14 days from the receipt of this list, the applicant having meanwhile obtained, at his order and expense, copies of the declarations from the Patent Office, may answer these by sworn declarations, made by himself or others, stating the grounds on which he relies in support of his application, and must deliver a list thereof to the opponent.<sup>8</sup> The latter is

<sup>1</sup> Rule 32.

<sup>2</sup> Rule 34.

<sup>3</sup> *Re Airey's Patent*, V R.P.C., 348.

<sup>4</sup> *Re Bailey's Patent*, 1 Griff., 270.

<sup>5</sup> *Re Daniel's Patent*, V R.P.C., 413.

<sup>6</sup> *Re Lake's Patent*, 2 Griff., 35.

<sup>7</sup> Rule 35.

<sup>8</sup> Rule 36.

allowed a further seven days from receipt of this list to file further declarations in answer to the last, and deliver a list thereof to the applicant; but these declarations must be confined strictly to matters in reply.<sup>1</sup> No further evidence can afterwards be given by either party without special leave of the Comptroller of Patents.<sup>2</sup> In case of necessity, any of these times for filing declarations may be extended by order of the Comptroller on the special application of either party. It is customary to accompany the request for extension of time by the consent of the opposite party to such an extension, this consent being usually readily given.

**Hearing before Comptroller.**—The filing of declarations being completed, or the time for filing having passed, the Comptroller of Patents may fix a day for hearing the parties, or he may await the request of either party to be heard, made upon a form bearing a *l.* stamp. The other party, if also desirous of being heard, must send in a similar stamped form. The applicant and opponent, by themselves or their agents, are on payment by each of above fee entitled to be heard at the time and place<sup>3</sup> appointed for that purpose by the Comptroller, who, after argument before him, will usually reserve his judgment and communicate the same in writing to the applicant and opponent respectively.

**Appeal to Law Officer.**—If either party is dissatisfied with the judgment of the Comptroller or any part of it he may appeal to the Law Officer from the whole or part; but in such case he must within 14 days from the date of the decision of the Comptroller file in the Patent Office a notice of his intention to appeal, stating the nature of the decision appealed against, whether the appeal is from the whole or part only, and if so, what part of such decision.

The Comptroller may in special cases extend the period of 14 days for filing the appeal.

Where the Comptroller's decision requires an amendment of the specification, such as the introduction of a disclaiming clause, leaving to the applicant to suggest the exact words for such amendment as will answer the decision, the time during which appeal can be filed will run from the day the Comptroller notifies that he has accepted such and such amendment.<sup>4</sup>

<sup>1</sup> Rule 37.

<sup>2</sup> Rule 39.

<sup>3</sup> The Comptroller is now provided with a Court for this purpose at the Patent Office.

<sup>4</sup> *Re Chandler's Patent*, 1 *Griff.*, 273.

For the Form of Appeal, which must be signed by appellant in person, see Appendix II.

A copy must be sent to the Law Officer's clerk, and another to the other party.

**Procedure on Appeal.**—No further evidence can be filed, except as to matters which have come to the knowledge of either party, subsequent to the date of the Comptroller's decision, without special leave of the Law Officer given upon application for that purpose. The Law Officer will appoint a day for hearing, may examine witnesses on oath, which the Comptroller cannot do, and it is also within the power of the Law Officer to award costs to the successful party.<sup>1</sup>

**Who may Oppose.**—Under Sect. 11, sub-sect. 1 of the Act of 1883, "any person" may oppose the grant of a patent, but by sub-sect. 3 it is provided in the case of a notice being given of appeal from the decision of the Comptroller that "the Law Officer shall, if required, hear the applicant and any person so giving notice, and being in the opinion of the Law Officer entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made." Under this subsection the Law Officer has at different times refused to hear opponents, with the result in all cases that the opposition has failed; whether in direct consequence of the refusal to hear the opponent or not, does not appear. It would seem that if "any person" may oppose before the Comptroller he should be allowed to be heard on appeal, and that the words of the section "entitled to be heard in opposition to the grant" should rather be held to refer to the conduct of the opposition up to that point. The Law Officers have, however, in all cases decided that no person is entitled to be heard unless he was, or is, in their opinion sufficiently and properly a party interested in the refusal of the patent. The necessary corollary of this is that in such case the Law Officer, refusing to hear one side, is not in a position to determine that the grant of patent should not be made, and refusing to hear a person on the ground that such person was not entitled to oppose, is tantamount to refusing to consider the opposition as of any effect; for if it was intended to deprive the Law Officer of the advantage of hearing the opponent in event of his want of personal right to oppose, it was naturally intended that the opposition should be accounted null and of no effect in such a case, so the patent should proceed. Either, therefore, the concluding words of sub-sect. 3

<sup>1</sup> Patents Act, 1883, Sect. 33.

are in such cases rendered of no effect, or also the proceeding of judging of the propriety of the grant is to be needlessly prejudiced by the arbitrary and needless silencing of one of the parties.

**Persons Entitled to be Heard.**—A party is not entitled to be heard in opposition on appeal, so apparently not entitled to oppose, if he merely opposes as one of the public,<sup>1</sup> following the precedent established in *re Glossop's Patent*,<sup>2</sup> where the Solicitor-General, previous to considering the decision of the Comptroller allowing the patent, satisfied himself that the opponent was entitled to be heard, as being a manufacturer of the invention included in the previous patent as assignee thereof, although the patent had expired. A person who has no interest in prior patents except that he has manufactured under one of them is not entitled to be heard,<sup>3</sup> nor is a person intending to work inventions disclosed by previous patents entitled to be heard on the ground of such patents existing.<sup>4</sup> A patent agent cannot be heard on an opposition in his own name, though on behalf of a client,<sup>5</sup> but may represent and be heard on behalf of a client who has a right to oppose.

<sup>1</sup> *Hookham's Patent*, 2 *Griff.*, 32.

<sup>2</sup> 1 *Griff.*, 285.

<sup>3</sup> *McEvoy's Application*, V *R.P.C.*, 235.

<sup>4</sup> *Buristow's Application*, V *R.P.C.*, 286.

<sup>5</sup> *Heath and Frost's Patent*, 1 *Griff.*, 288.

## CHAPTER XVIII.

## ENFORCEMENT OF PATENT : THREATS.

**Enforcement by Civil Process.**—The State, in giving to an inventor an exclusive monopoly of his alleged invention under the form of a patent, does not directly guarantee him against infringement of his rights by others; that is to say, the patentee cannot proceed summarily to stop an infringement, but must apply to the High Court for an injunction against the continuance of the alleged infringement, and for such relief as the case merits, unless the infringer desists on request and affords satisfaction for any injury the patentee may have sustained.

Although the infringer acts in direct contravention of the Letters Patent, which forbid use of the invention by any others than the patentee and those sanctioned by him, this infraction is not a case for public prosecution, since the Crown has never guaranteed that the patent is one that can be upheld. As the patent is given solely at the risk of the applicant, it is for the latter to show that it is a monopoly which, in his particular case, satisfies the law and should be enforced.

Presumption is, of course, in favour of the grant of patent being valid, but is not carried so far as to permit the Court to impose any fine or penalty for non-observance of the patent, even if the result of a suit of infringement should be to show the validity of the patent beyond question; but after a patent has been once victorious in the Courts the patentee obtains the privilege, that he may receive a certificate to the effect that the validity of the patent came in question; and in any future suit of infringement that he may require to bring on that patent, and brings with success, this certificate will enable him to obtain his full costs as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same.<sup>1</sup>

Punishment may be inflicted upon an infringer who breaks

<sup>1</sup> Patents Act, 1883, Sect. 31.

an injunction delivered against him by the Court, because the breach is a contempt of the order of the Court; not because it is a contempt of the wording of the patent.

**Remedy for Infringement.**—The patentee may sue for an injunction (in Scotland, an interdict) against the infringement, and may also either obtain from the infringer damages equivalent to the loss caused to him by the infringement, or an account of the profits that the infringer himself has made by such infringement, and an order for those profits to be handed to the patentee. A patentee cannot have damages as well as an account of profits, he must choose which he will sue for.<sup>1</sup>

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

**Injunction.**—If a patentee has reasonable ground to apprehend that a man will infringe his right, he can come to the Court and obtain an injunction to restrain him from carrying out his intention.

According to Sir George Jessel in the case of *Frearson v. Loe*:<sup>2</sup> “The mischief done by the threatened infringement of a patent may be very great; and I see no reason why a patentee should not be entitled to the same protection as every other person is entitled to claim from the Court from threatened injury, where that threatened injury would be very serious. It seems to me that where there is a deliberate intention expressed and about to be carried into execution, to infringe certain Letters Patent under the claim of a right to use the invention patented, the plaintiff is entitled to come to this Court to restrain that threatened injury. Of course it must be plain that what is threatened to be done is an infringement.”<sup>3</sup>

An injunction will not be granted where the infringement has ceased for a considerable time and there is no evidence that the defendant has any intention of recommencing.<sup>4</sup> Where a person has done a wrongful act in infringing a patent, the probability will generally be that he will continue it, unless there is anything which prevents that probability from arising. The Court should consider all the circumstances of the case, so

<sup>1</sup> *De Vitre v. Betts*, 1873, *L.R.*, 6 *H.L.*, 319.

<sup>2</sup> *L.R.*, 9 *Ch. D.*, 48.

<sup>3</sup> Quoted and followed in *Dowling v. Billington*, VII *R.P.C.*, 201.

<sup>4</sup> *Proctor v. Bailey*, VI *R.P.C.*, 538.



as to draw an inference that there is a likelihood of the infringement.<sup>1</sup> The mere promise of the defendant not to continue infringement is not sufficient, if the Court infers from continuance of the infringement, that there is probability of its recurrence.<sup>2</sup>

**Interlocutory Injunction.**—Since a considerable time may often elapse before a case comes on for hearing, the Court will in some instances grant an injunction till the trial of the action, subject always, however, to the plaintiff entering into an undertaking in damages in case he should fail in the action. The question whether such an injunction should be granted or not depends upon the balance of convenience; thus where a defendant's company with small capital had just started a business and would probably not have the wherewithal to pay damages if the infringement continued, an injunction was granted.<sup>3</sup> As a rule, however, such an interim injunction is refused on the ground that if the patent is successful the measure of damage from the infringement continuing in the meantime is easily ascertained, while if the defendant be prevented from issuing the invention and the patent is afterwards found unsustainable, the measure of damage sustained by the defendant is most difficult to determine.<sup>4</sup> Interim injunctions are seldom granted unless the patent is of some age,<sup>4</sup> or unless there is some show that the use complained of is actually an infringement.<sup>5</sup> Wherever the injunction is refused the defendant will be required to keep an account for the purpose of ascertaining his profits in case the patent should be successful.<sup>6</sup> But where infringement is not made out an interim injunction will be refused though the defendant refuses to keep an account.<sup>7</sup>

**Account of Profits.**—The Court can only order an account of profit to be kept in such cases in which an injunction could be granted;<sup>8</sup> nevertheless the account can be ordered even when no injunction is asked for, if a *prima facie* case of infringement appears.<sup>9</sup> Such order should only go to sales about to be made; account of sales made before the action is

<sup>1</sup> Millington v. Fox, 3 Myl. and Cr., 338; Losh v. Huggins, 1 Web., 201.

<sup>2</sup> Bracher v. Bracher Dean and Company, VII R.P.C., 420.

<sup>3</sup> Thomson v. Hughes, VII R.P.C., 76.

<sup>4</sup> Briggs v. Lardeur, 1 R.P.C., 126.

<sup>5</sup> Frearson v. Loe, *supra* in text.

<sup>6</sup> Jackson v. Needle, 1 R.P.C., 174.

<sup>7</sup> British Tanning Company v. Groth, VII R.P.C., 1.

<sup>8</sup> Smith v. London and South Western Railway, 1854, Kay, 408.

<sup>9</sup> Vidi v. Smith, 1854, 28 L.J., Q.B., 342.

brought should only be delivered after final judgment.<sup>1</sup> An account of profits will not be ordered if it is clear that no profits have been made.

The amount of profits made by infringing a patent is recoverable by the patentee not as damages, but as money had and received to his use, and the patentee may therefore prove in the bankruptcy of the infringer for these profits.<sup>2</sup> Where an inquiry into profits is ordered the defendant cannot refuse to allow inspection of his books on the ground that he is about to appeal.<sup>3</sup> The inquiry may extend to the profits made by the defendants prior to their employment of the patented invention for the purposes of comparison.<sup>4</sup>

**Damages.**—The damages recoverable are according to the measure of the loss that the patentee can prove to have sustained through the wrongful acts of the infringers. It is the usual custom to refer an inquiry as to amount of damages to a referee or arbitrator. Where an infringing article has been made and sold to others, damages can be had from the users, even when an account of profits has been had from the manufacturer;<sup>5</sup> but where damages in full have been obtained from some of the users, the manufacturer cannot be called upon to pay damages also in respect of sales to those users;<sup>6</sup> and also if the manufacturer has paid a sum equivalent to damages in full no further damages are recoverable from users who have delivered up the infringing machines.<sup>7</sup> Damages are not measured by the profit made by the infringers, but by the profit lost to the patentee, a fair deduction may be made in respect of sales due to the particular exertions of the infringers;<sup>8</sup> and where the patentee himself has had to sell at a lower price to compete with the infringer the latter is also liable for the difference lost to the patentee on the latter's own sales;<sup>9</sup> except in cases where the reduction was necessary to meet other competitors and was not actually caused by the defendant's acts.<sup>10</sup>

<sup>1</sup> *Bergmann v. McMillan*, 1881, 17 *Ch. D.*, 423.

<sup>2</sup> *Watson v. Holliday*, 1882, 20 *Ch. D.*, 780.

<sup>3</sup> *Saxby v. Easterbrook*, 1872, *L.R.*, 7 *Ex.*, 207.

<sup>4</sup> *Siddell v. Vickers*, 1889, VI *R.P.C.*, 464.

<sup>5</sup> *Penn v. Bibby*, 1866, *L.R.*, 3 *Eq.*, 308.

<sup>6</sup> *Penn v. Jack*, 1867, *L.R.*, 5 *Eq.*, 81.

<sup>7</sup> *United Telephone Company v. Walker*, 1886, IV *R.P.C.*, 63.

<sup>8</sup> *United Horseshoe and Nail Company v. Stewart*, *H.L.*, 1888, 13 *App. C.*, 401.

<sup>9</sup> *American Braided Wire Company v. Thomson*, 1890, *C.A.*, 44 *Ch. D.*, 274.

<sup>10</sup> *United Horseshoe and Nail Company v. Stewart*, *supra*.

By Sect. 17, sub-sect. 4, of the Act of 1883, if any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

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

**Inspection.**—Where the plaintiff can make out a *prima facie* case of infringement, he has right to claim an order to permit him to inspect the alleged infringer's manufacture at his works. Thus, if the invention be for a machine, and it is alleged that the product sold by the defendant can only be produced by a similar machine, the conjecture may be set at rest by an order empowering the plaintiff to see the defendant's machine at work.<sup>1</sup> Not only may the plaintiff's witnesses inspect the defendant's machinery, but it is reasonable that the defendant's witnesses should inspect the plaintiff's machinery for purposes of comparison.<sup>2</sup> The allegation that defendant's is a secret process will not prevent order for inspection, the witnesses being warned that the knowledge so gained is not to be used otherwise than for purposes of evidence in the suit;<sup>3</sup> but an instance is to hand in which the plaintiff himself was excluded from inspection allowed to scientific men, on the ground that the plaintiff and defendant were competitors in trade.<sup>4</sup> And in another case the Court appointed an analyst to sample and report, and the perusal of the report was confined to the judge and leading counsel, the process being secret to the defendant.<sup>5</sup>

Inspection will not be allowed unless it is really required to prove the plaintiff's case.<sup>6</sup> The order may extend to taking

<sup>1</sup> *Bovill v. Moore*, 1815, 2 *Coop. C.C.*, 56.

<sup>2</sup> *Russell v. Cowley*, 1832, 1 *Web. P.C.*, 458; *Germ Milling Company v. Robinson*, 1885, III *R.P.C.*, 11.

<sup>3</sup> *Russell v. Crichton*, 1837, 15 *D. Ct. Sess.*, 1270.

<sup>4</sup> *Flower v. Lloyd*, 1876, *W.N.*, 1876, 169-230.

<sup>5</sup> *The Plating Company v. Farquharson*, 1879, 1 *Griff.*, 187.

<sup>6</sup> *Meadows v. Kirkman*, 1860, 19 *L.T. Rep., N.S.*, 46; *Piggott v. Anglo-American Telegraph Company*, 19 *L.T. Rep., N.S.*, 46.

samples.<sup>1</sup> Where the defendant uses more than one process inspection will only be allowed of that process as to which *prima facie* case of infringement is made out.<sup>2</sup>

When samples are given by the defendant the plaintiff will seldom be able to show that inspection is necessary.<sup>3</sup> The giving of an order for inspection is always subject to the discretion of the Court.<sup>4</sup>

**Intention of Infringer.**—It is no answer to say that the infringement was done through ignorance,<sup>5</sup> or without intention to injure the patentee,<sup>6</sup> so long as the latter suffers through the act of infringement he has his remedy against the infringer. Infringement depends on the acts, not on the intentions of the infringer.<sup>7</sup>

**Costs.**—As a rule the losing party to the case has to pay the costs, but on taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they shall not be allowed any costs in respect of any particular delivered by them, unless the same is certified by the Court or a judge to have been proven to have been reasonable and proper, without regard to the general costs of the case.<sup>8</sup> Where a patent has once been successfully upheld in a Court, the patentee may recover in any subsequent action full costs as between solicitor and client.<sup>9</sup>

**Threats.**—Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale, or purchase of the invention, any person or persons aggrieved thereby may bring an action against him and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats. This, however, does not apply where the person threatening “with due diligence

<sup>1</sup> *Davenport v. Jepson*, 1862, 1 *N.R.*, 307.

<sup>2</sup> *Cheetham v. Oldham*, 1888, V *R.P.C.*, 617.

<sup>3</sup> *Sidebottom v. Fielden*, VIII *R.P.C.*, 267.

<sup>4</sup> *McDougall v. Partington*, VII *R.P.C.*, 357.

<sup>5</sup> *Curtis v. Platt*, 1864, 11 *L.T. Rep.*, *N.S.*, 245.

<sup>6</sup> *Heath v. Unwin*, 1855, *H.L.*, 25 *L.J.*, *C.P.*, 19.

<sup>7</sup> *Stead v. Anderson*, 1847, 2 *Web. P.C.*, 156.

<sup>8</sup> Patents Act, 1883, Sect. 29 (6).

<sup>9</sup> Patents Act, 1883, Sect. 31.

commences and prosecutes an action for infringement of his patent." <sup>1</sup>

It is absolutely necessary for the plaintiff in such action to prove that he is not infringing; but even then the question is one of the balance of convenience and inconvenience, and the Court will use its discretion in deciding whether more harm will be done by granting or refusing the injunction.<sup>2</sup> Where the defendant ceases his threats and undertakes to begin a suit of infringement with due diligence an injunction will not issue.<sup>3</sup> A circular may be a threat though addressed to no one in particular.<sup>4</sup>

<sup>1</sup> Patents Act, 1883, Sect. 32.

<sup>2</sup> *Walker v. Clarke*, 1887, IV *R.P.C.*, 111.

<sup>3</sup> *Mackie v. Laundry Supply Company*, IX *R.P.C.*, 465.

<sup>4</sup> *Johnson v. Edge*, IX *R.P.C.*, 142.

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## CHAPTER XIX.

## CONSTRUCTION OF SPECIFICATION.

**Construction of the Specification.**—In a suit in which the patent is called in question, especially suits of revocation or infringement, the issue will often turn upon the exact extent of the patent with reference to the particular invention covered by it. To ascertain the exact nature and limits of the patented invention, the patent, that is to say, the title and the specification supporting the patent, must be construed together to find the true ambit of the patent.

This question is naturally very important for the patentee, since, on the legal meaning of his specification, the patent may or may not cover the whole of his actual invention. A review of the rules adopted for the construction of the patent of the specification may therefore not be out of place.

**Benevolent Construction.**—It has been often said that the specification must be construed benevolently for the patentee, and some confusion has arisen in the meaning to be given to the word benevolently. In a comparatively recent case Lord Justice Lindley said: "I do not like the expression 'benevolent' interpretation, I do not believe in it. The question is whether a given construction is the true construction; but of course, if any patent is capable of more constructions than one, the general rule would be applied that you would put upon it that construction which makes it a valid patent, rather than a construction which renders it invalid."<sup>1</sup> A former judgment of Chief Baron Pollock<sup>2</sup> clearly expresses the neutrality with which the specification is to be considered: "I take the rule to be, that, you are not to intend anything in favour of a specification or patent, and certainly not to intend anything against it; you are to deal with it just as you find it; you are to put the true and right and fair construction upon

<sup>1</sup> *Needham v. Johnson*, C.A., 1884, 1 R.P.C., 58; also *Automatic Weighing Machine Company v. Knight*, C.A., 1889, VI R.P.C., 307.

<sup>2</sup> *Stevens v. Keating*, 1848, 2 *Webb*, P.C., 187.

every allegation and every fact connected with it, and you are to find what is the true and fair and just result."

**Rules for Construction.**—Although the finding of the true meaning of the specification is a question of law, and consequently is left to the judge, when words or sentences of doubtful meaning occur it becomes a question of fact as to their intention and the sense to be put upon them.<sup>1</sup> Words in a specification should always be construed according to their ordinary meaning unless the context requires otherwise.<sup>2</sup> However, if a wrong word is used in the specification it is immaterial so long as there can be no doubt what the correct word should be.<sup>3</sup> The Court should consider to whom the specification is principally addressed, and endeavour to ascertain the meaning it would bear to such persons. In the House of Lords Lord Westbury, in giving judgment in *Simpson v. Holliday*,<sup>4</sup> said: "With respect to the rules that govern the construction of specifications, they are the ordinary rules for the interpretation of written instruments, having regard especially to the fact that the specification must clearly fulfil the obligation imposed on the patentee by the proviso contained in all Letters Patent, viz., that the grant shall be void if the patentee shall not particularly describe and ascertain the nature of the invention and in what manner the same is to be performed. It is, therefore, made a settled rule that the specification must be so expressed as to be perfectly intelligible to a workman of ordinary knowledge, and it must follow that if there be any obscurity or ambiguity in the specification which is likely to mislead, this defect ought not to be helped by any refined or secondary interpretation of the language. . . . When it is stated that an error in a specification which any workman of ordinary skill and experience would perceive and correct will not vitiate a patent, it must be understood of errors which appear on the face of the specification or the drawings it refers to, or which would be at once discovered and corrected in following out the instructions given for any process or manufacture, and the reason is because such errors cannot possibly mislead. But the proposition is not a correct statement of the law if applied to errors which are discoverable only by experiment and further inquiry. Neither is the proposition true of an erroneous statement in a specification amounting to

<sup>1</sup> *Derosne v. Fairie*, 1 *Web. P.C.*, 156; *Neilson v. Harford*, 1 *Web. P.C.*, 372.

<sup>2</sup> *Elliott v. Turner*, 2 *C.B.*, 446.

<sup>3</sup> *Derosne v. Fairie*, *supra*; and *Minton v. Mower*, 1 *Web. P.C.*, 141.

<sup>4</sup> 1868, 12 *L.T. Rep., N.S.*, 99.

a false suggestion, even though the error would be at once observed by a workman possessed of ordinary knowledge of the subject."

**Evidence of Meaning of Specification.**—There may be a question how far evidence may be allowed with a view of explaining the specification. Evidence may be called to explain technical words or to show the extent of public knowledge at the time the specification was written, and specifications of previous patents may also be referred to show this state of public knowledge,<sup>1</sup> but only if the specification is not clear so far that this prior knowledge may be required for properly ascertaining the meaning of words used in the specification.<sup>2</sup> Previous specifications or other evidence on behalf of the patentee cannot be considered if intended to show that the proper and natural reading of the specification must be avoided in favour of a less obvious reading which would prevent the patent being declared invalid;<sup>3</sup> that is to say, evidence of the prior state of the art is unnecessary and inadmissible for the construction of a *clear* specification.<sup>4</sup> If the specification is misleading, no evidence can be brought tending to show what the patentee had intended to claim as his invention.<sup>5</sup>

**Construction a Question of Law.**—It will be seen from these decisions that to the judge alone is left the duty of ascertaining the meaning of the specification, after the meaning of doubtful phrases, if any, has been explained in evidence, and the definite intention of the patentee in using those phrases has been ascertained. Evidence is only admissible to explain points on which the judge may be in legal doubt, and cannot be used by the patentee to explain away matters which on the usual meaning of words present no such doubt.

Apparent ambiguity of the specification is thus seen to be provocative of considerable expense in view of the testimony that must be produced to prove its clearness. There is also the further disadvantage that the judge may declare that the specification bears a meaning which perhaps the patentee did not actually intend, and which, consequently, may seriously jeopardise not only the chances of success when the question of actual infringement is considered but the validity of the patent itself.

<sup>1</sup> *Hocking v. Hocking, H.L., 1886, III R.P.C., 291.*

<sup>2</sup> *Hocking v. Hocking, H.L., 1886, III R.P.C., 291.*

<sup>3</sup> *Clark v. Adie, H.L., 1877, 2 App. Cas., 423.*

<sup>4</sup> *Clark v. Adie, H.L., 1877, 2 App. Cas., 430.*

<sup>5</sup> *Brooks v. Ripley, 1831, 2 Lond. Jour., C.S., 35.*



## CHAPTER XX.

## NATURE OF AND REMEDIES FOR INFRINGEMENT.

**Infringement dependent on Scope of Patent.**—The question as to whether any individual act is or is not an infringement falls naturally into one or other of two classes according as it concerns the extent of the particular invention or the extent of the rights given by patents generally.

For the first of these questions it is, of course, necessary, as pointed out in the last chapter, that the proper "construction" of the specification be first ascertained, for the result will be modified in a great measure according to the construction put upon the specification by the Court, and the greater or less breadth of the invention which the Court thus declares to be included in the scope of the patent. This question also deals with the particular subject matter of the infringement and rules might be laid down for ascertaining its subject matter just as for finding the subject matter of the patented invention, evidence being brought to bear for this end, so far as may be necessary. When the subject matter of the act of infringement has thus been discerned, it becomes merely a question of comparison whether it is the same or included within the subject matter of the patented invention.

**Infringement generally.**—Amongst decided cases it has been laid down that where there is a substantial resemblance to the patented invention in particulars covered by the exclusive rights given by the patent, infringement may be proved.<sup>1</sup>

"If a portion of a patent for a new arrangement of machinery is in itself new and useful, and another person for the purpose of producing the same effect, uses that portion of the arrangement and substitutes for the other matters combined with it another mechanical equivalent that would be an infringement of the patent."<sup>2</sup>

<sup>1</sup> *Stead v. Anderson*, 1847, 2 *Web. P.C.*, 155.

<sup>2</sup> Per Pollock, C.B., in *Sellers v. Dickinson*, 1850, 5 *Ex.*, 326.

“Where a patent is for a combination of two or more old inventions, a user of any of them would not be an infringement of the patent; but, where there is an invention consisting of several parts, the imitation or pirating of any part, of the invention is an infringement of the patent.”<sup>1</sup>

**Infringement of a Process.**—A use of a material part of a process is an infringement, even if all the parts of the process as specified are not used.<sup>2</sup> A valid patent for an entire combination for a process gives protection to each part thereof that is new and material for that process without any express claim of particular parts and notwithstanding that parts of the combination are old.<sup>3</sup> Nevertheless this decision must be confined to such cases where the patentee may be inferred to claim such parts separately from the whole; and the inference would only be likely to arise, when no specific claim is made in the specification; it will not apply when the specification is construed as claiming the general combination only.<sup>4</sup>

“The infringement of any part of a patent process is actionable, if that part of itself is new and useful so that it might be the subject of a patent, and is used by the infringer to affect the object or part of the object proposed by the patentee.”<sup>5</sup>

**Infringement of a Combination.**—“If it is clear that a patent is for a combination, and nothing but a combination, there is no infringement unless the whole combination is used, and it is in that way immaterial whether any, or which, of the parts are new.”<sup>6</sup> “There may, however, be cases in which, though the patent is for an entire combination of numerous parts, a collusive imitation of that invention may be effected though some detail of the combination is omitted or changed.”<sup>7</sup> The decision of the House of Lords in *Clark v. Adie* in 1877 is to the same effect. A subordinate part of a combination is only infringed if it is specially and separately claimed by the patentee.<sup>8</sup>

**Infringement by colourable Imitation.**—“Where a party

<sup>1</sup> Per Campbell, C.J., in *Smith v. London and North Western Railway*.  
<sup>2</sup> *Ell. and B.*, 76.

<sup>3</sup> *Bovill v. Keyworth*, 1857, 7 *Ell. and B.*, 737.

<sup>4</sup> *Lister v. Leather*, 1858, 8 *Ell. and B.*, 1004.

<sup>5</sup> *Harrison v. Anderston Foundry Company*, *H.L.*, 1876, 1 *App.*, 578.

<sup>6</sup> *Patent Bottle Envelope Company v. Seymour*, 1858, 5 *C.B.*, *N.S.*, 172.

<sup>7</sup> Per Lord Cairns in *Harrison v. Anderston Foundry Company*, *supra*.

<sup>8</sup> Per Lord Penzance in *Harrison v. Anderston Foundry Company*, *supra*.  
593.

<sup>8</sup> *L.R.*, 2 *App. Cas.*, 315.

has obtained a patent for a new invention, it is not in the power of any person simply by varying in form or in immaterial circumstances the nature or subject matter of that discovery to obtain either a patent for it for himself, or to use it without the leave of the patentee, because that would be in effect and in substance an invasion of the right."<sup>1</sup>

The use of the plaintiff's invention with slight immaterial variations to make a colourable difference is an infringement of the patent.<sup>2</sup>

The words "colourable imitation" are not happily chosen, but in effect their meaning is that where a defendant simply dresses up an invention so that it is "colourably" different, while underlying all there has been a taking of the invention of the plaintiff, it is an infringement.<sup>3</sup>

An alteration was held to be simply a colourable variation when an active part of a combination was made to act directly instead of indirectly.<sup>4</sup>

Substitution of a weight for a spring is a colourable alteration, the effect being the same.<sup>5</sup>

**Use of the Mechanical Equivalents.**—The question of mechanical equivalents is in effect the same as that of a colourable imitation. "The question would be simply whether the defendant's machine was only colourably different, that is whether it differed merely in the substitution of what are called mechanical equivalents for the contrivances which are resorted to by the patentee."<sup>6</sup>

If a defendant substitutes for a part of a plaintiff's invention some well-known equivalent, whether chemical or mechanical, he would probably be considered as only making a colourable variation.<sup>7</sup>

The substitution of mechanical equivalents is equally an infringement, even though the means employed might be better than those mentioned in the patent.<sup>8</sup>

Nevertheless it is not every mechanical equivalent which is necessarily an infringement, the question is whether the particular alteration is a mechanical equivalent in the sense in

<sup>1</sup> *Walton v. Potter*, 1841, 1 *Web. P.C.*, 586.

<sup>2</sup> *Stead v. Anderson*, 1847, 2 *Web. P.C.*, 156.

<sup>3</sup> *Dudgeon v. Thomson*, *H.L.*, 1877, 3 *App. Cas.*, 45.

<sup>4</sup> *Kaye v. Chubb*, *H.L.*, 1888, V *R.P.C.*, 641.

<sup>5</sup> *Winby v. Manchester Tramways*, 1889, VI *R.P.C.*, 359.

<sup>6</sup> *Morgan v. Seaward*, 1831, 1 *Web. P.C.*, 171.

<sup>7</sup> *Heath v. Unwin*, 1845, 2 *Web. P.C.*, 227.

<sup>8</sup> *Bateman v. Gray*, 1853, *Mac. P.C.*, 102.

which that expression is used in Patent Law, and this is a question for the judge to decide.<sup>1</sup>

**Use of Chemical Equivalents.**—The use of chemical equivalents introduces a question which with regard to mechanical equivalents has never arisen. The discovery of new chemical substances, and consequently of their actions, renders it necessary to clearly ascertain whether the use of a new substance not known at the date of the patent, and therefore not then possible to be considered a known equivalent is in fact an infringement. The question has been decided, though somewhat doubtfully, in the negative.

Thus, in the House of Lords, in *Unwin v. Heath*,<sup>2</sup> a patent was considered in which the invention was stated as the "use of carburet of manganese, in any process whereby iron is converted into cast iron," the method described consisted in adding carburet of manganese to the fused mass of metal. The infringement complained of consisted in adding oxide of manganese and carbonaceous matter, and it was proved in evidence that these two substances combined to form the carburet, producing the same effect but at a cheaper rate. A majority of the judges declared against infringement, though apparently on different grounds. Two being of opinion that this variation of the process being unknown could not be held to be included in the invention patented or claimed in the invention by the patentee. The patent, however, did not appear to claim any principle but only the use of the particular substance named.

The principle was followed in *Badische Anilin Fabrik, &c., v. Levinstein*, that the use of chemical equivalents not taken to be such at date of the patent is no infringement.<sup>3</sup>

**Infringement coupled with Improvement.**—Letters Patent may be infringed by a method which is an improvement upon the patentee's invention, provided the two methods are, in a material part, the same;<sup>4</sup> nor is the fact of making improvements any answer to the allegation of infringement.<sup>5</sup>

**Infringement of Part.**—Although it is necessary to show that all the improvements claimed are new, it is not necessary to show that they have been all infringed, it will be sufficient

<sup>1</sup> *Thorn v. Worthing Skating Rink Company*, 1876, *L.R.*, 6 *Ch. D.*, 417.

<sup>2</sup> 5 *H.L. Cas.*, 505.

<sup>3</sup> 11 *R.P.C.*, 90.

<sup>4</sup> *Russell v. Ledsam*, 14 *M. and W.*, 580.

<sup>5</sup> *Ehrlich v. Ihlee*, *C.A.*, 1888, 5 *R.P.C.*, 437.

to support an action if any one of them has been infringed.<sup>1</sup> The part, if only part is infringed, must, however, in any case be new in itself or in its effects not merely in its application, consequently a material improvement, otherwise there is no infringement,<sup>2</sup> and it must be a part clearly seen to be claimed by the patentee, otherwise it is not included in his monopoly.<sup>3</sup>

That there is no infringement of a combination by anything short of using the whole combination of the same elements or mechanical equivalents of them is also fully proved by several decisions, notably *Harrison v. Anderston Foundry Company*.<sup>4</sup>

**Infringement of Principle.**—Throughout all the decisions touching the principle of an invention a broad liberality is noticeable, and is probably the result of the sure ground on which judges have felt themselves to stand when dealing with the principle. It does not seem to have been recognised that every invention must rest upon a novel principle because it has not been the fashion to so describe the invention. It may be argued that if the inventor has not recognised the principle the Court is not called upon to give that broad effect to the patent which the inventor could equally not have contemplated. But where the inventor has made the principle on which his invention rests a salient and recognisable feature of his monopoly, the Court has generally seized upon the principle and supported it. Thus it has been decided that “the specification must tell the public for what it is the patentee claims protection. If it be for a principle, then if that be good, it will apply to every mode in which that principle can be carried into operation. If for a machine for a particular mode of carrying into effect an old principle, that does not go beyond the machine.”<sup>5</sup> It was also the opinion of Williams, J.,<sup>6</sup> that “If a patent is taken out for the application of a principle coupled with a mode of carrying the principle into effect, the patentee is entitled to protection from all other modes of doing so whether known or not known at the time of the specification. A more recent judgment<sup>7</sup> clearly shows that where the specifica-

<sup>1</sup> *Gillet v. Wilbey*, 1839, 9 *Car. and P.*, 336.

<sup>2</sup> *Lister v. Leather*, *Ex. Ch.*, 9 *Ell. and B.*, 1033.

<sup>3</sup> *Parkes v. Stevens*, *L.R.*, 8 *Eq.*, 366.

<sup>4</sup> *H.L.*, 1 *App. Cas.*, 581.

<sup>5</sup> *Neilson v. Thompson*, 1 *Web. P.C.*, 283.

<sup>6</sup> *Unwin v. Heath*, *H.L.*, *supra*.

<sup>7</sup> *Easterbrook v. Great Western Railway Company*, 1886, II *R.P.C.*, 201, III *R.P.C.*, 94.

tion disclosing a principle shows a method by which it may be carried out, and does not limit the claim of the patentee any apparatus which by different mechanical means carries out the same principle is an infringement, and this even though the purpose to which the principle is applied is different from those embodied in the specification.

**Manner of Infringement.**—Enough has been said on the matter of the infringement to show what form infringement generally takes; reference may now be made to the second question, namely, the manner in which a patent may be infringed and the nature of the personal acts of infringer. The patent expressly forbids anyone in any way using or putting in practice the invention or a part of it; but as the deed reserves the sole rights of making and vending also to the patentee, it may be presumed that the public are also forbidden to make or vend.

**Infringement by Making.**—The prohibition against making naturally only extends to the producing of an article included under the protection of the patent. It has been held that making is an infringement unless the article is made simply for amusement or as a model<sup>1</sup> or by way of experiment;<sup>2</sup> for “if a man makes things merely by way of *bonâ fide* experiment, and not with the intention of selling and making use of the thing so made for the purpose of which a patent has been granted, but with the view of improving upon the invention, or of seeing whether an improvement can be made or not, that is not an invasion of the exclusive rights granted by the patent.”<sup>3</sup> There is no infringement in making a part of a patented machine, where such part is not separately claimed,<sup>4</sup> nor in supplying or selling such a part alone or any ingredient to be used in the infringement of a patent,<sup>5</sup> though the purchaser may of course be guilty of an infringement in its use if such use is contrary to the patent.

**By Use or Exercise.**—These almost synonymous terms refer to the use of the invention (process or method) or of the article, machine, or thing patented. Use follows substantially the same rules as “making,” and consequently “experimental use,” as distinguished from commercial use, is not an infringement. Wherever the use is for the purpose of advantage it is

<sup>1</sup> Jones v. Pearce, 1832, 1 *Web. P.C.*, 125.

<sup>2</sup> Muntz v. Foster, 1844, 2 *Web. P.C.*, 101.

<sup>3</sup> Per Jessel, M.R., in *Frearson v. Loc*, 1879, *L.R.*, 3 *Ch. D.*, 66.

<sup>4</sup> McCormick v. Gray, 1861, 31 *L.J.*, *Ex.*, 42.

<sup>5</sup> Townsend v. Haworth, M.R. and C.A., 1875, *Higgins D.P.C.*, 166.

an infringement. The use in Great Britain for purposes of instruction of telephones bought abroad was held an infringement.<sup>1</sup> The use of an invention for a different purpose may still be an infringement.<sup>2</sup>

**By Vending.**—By vending is understood in this connection the sale of a vendible article or thing which is the result or product obtained by an act of putting the invention into practice. It has been noticed that, although the Statute of Monopolies reserves to the patentee the sole rights of making and working the invention, it does not specially mention "sale" as an act of infringement. This does not prove that an act of sale may not be an infringement, but only that it is not necessarily so. The question appears to be whether or not the particular act of sale is not in truth a putting in practice of the invention. Sale is an act of infringement whenever it is in effect a user of the invention to the detriment and without the permission of the patentee. That such sale is a user of the invention we have the authority of several decided cases.<sup>3</sup> But where the patentee himself is the maker of the invention and has sold the product, or where it has been made by his licensees, he cannot prevent subsequent sale or dealings with or use of that particular product.<sup>4</sup> Where the article sold has been imported from abroad, and thus has not been actually made within the country covered by the patent, the sale may be equally considered a user of the invention and consequently an infringement since the patentee is thus defrauded of the profit which it is the intention of the patent system to reserve to him;<sup>5</sup> and even where the patent is only for the process of manufacture, an importation and sale of the product, made by the same process abroad, is also an infringement;<sup>6</sup> but the onus of proof that the product has been made according to the patented process lies on the patentee.<sup>7</sup> It is questionable whether the mere exposure for sale without any sale actually being made is an infringement,<sup>8</sup> but manufacture for purpose of sale is an

<sup>1</sup> *United Telephone Company v. Sharples*, 1885, 29 *Ch. D.*, 164.

<sup>2</sup> *Edison and Swan Company v. Holland*, V *R.P.C.*, 483.

<sup>3</sup> *Gibson v. Brand*, 1841, 1 *Web. P.C.*, 630; *Walton v. Lavater*, 1860, 29 *L.J.*, *C.P.*, 279; *Wright v. Hitchcock*, 1870, 39 *L.J.*, *Ex.*, 103.

<sup>4</sup> *Thomas v. Hunt*, 1864, 17 *C.B.*, *N.S.*, 183; *Betts v. Wilmot*, 1871, *L.R.*, 6 *Ch. D.*, 239.

<sup>5</sup> *Walton v. Lavater*, *supra*.

<sup>6</sup> *Elmslie v. Boursier*, 1869, 39 *L.J.*, 328.

<sup>7</sup> *Cartsburn Company v. Sharpe*, 1884, 1 *R.P.C.*, 181.

<sup>8</sup> *Minter v. Williams*, 1 *Web. P.C.*, 135.

infringement though no sale is made<sup>1</sup> The sale of ingredients to another party, even with knowledge that the purchaser intends to use them in infringement of a patent, is in itself no infringement.<sup>2</sup> Manufacture here for sale abroad is also an infringement, since it is a making or putting in practice of the invention here.

**By Possession.**—There is no infringement in actual possession of an infringing article, but injunction may be obtained against its use or employment.<sup>3</sup> The Court will not at all times order the delivering up of infringing articles to the patentee, or their destruction, though in most cases such order may be had.

**By Importation.**—That there may be infringement by importation of the article, or a product of the process, is shown by the cases quoted on previous page (Footnotes<sup>5, 6, and 7</sup>); but it would appear that the importation must be connected with a purpose of trade, or else there must be some sort of user of the invention whether passive or active. Thus the temporary presence of certain capsuled bottles in a British port for transshipment was held a passive use of the invention here sufficient to constitute an infringement of that method of capsuling.<sup>4</sup> Sect. 43 of the Act of 1883, however, provides that inventions in use in foreign vessels temporarily within British waters are no infringement provided they are not used in connection with manufacture here, and that a similar treatment is accorded to British vessels by the respective foreign States.

<sup>1</sup> *Oxley v. Holden*, 8 *C.B.*, *N.S.*, 666.

<sup>2</sup> *Sykes v. Howarth*, 1879, *L.R.*, 12 *Ch. D.*, 833.

<sup>3</sup> *United Telephone Company v. London and Globe Telegraph Company*, 1 *R.P.C.*, 117.

<sup>4</sup> *Betts v. Neilson*, *H.L.*, 1865, 71, 3 *De G. J. and S.*, 87.



## CHAPTER XXI.

## NECESSITY AND METHODS OF AMENDMENT.

**Origin of Amendments.**—In former times, when once the specification had been filed, it was impossible to make any alteration in its wording, and as the patent is dependent for its validity upon the specification, great hardship arose, more especially when only a part of the specification was objectionable. This was especially the case, since the great expense of patents and the laxity of procedure led inventors to include several inventions in one patent, and consequently the risk of loss through one of the inventions proving disentitled to protection, was increased.

It was principally to remedy this hardship that, by the Act of 5 and 6 William IV, c. 83, patentees were allowed to disclaim from their specification such parts as were not sustainable under their patents. Special claims were then but seldom made, the Court being left to distinguish the nature or principles of the invention from the specification of its construction or working. Everything described was held to be claimed unless it were disclaimed, so that correction would usually take the form of excision of words or paragraphs.

Substantially the same procedure was followed under the Patent Law Amendment Act of 1852, only that the nature of an allowable amendment appears to have become widened with the gradually broadened notion of Patent Law which began to distinguish between the nature of the invention and its actual embodiment.

The Act of 1883, which first required a special claim or claims to be added to summarise exactly what the inventor desired to cover and include in the scope of the patent, has also further widened the possibility of amendment which may now consist of either a disclaimer, a correction, or an explanation,<sup>1</sup> always provided that "no amendment shall be allowed

<sup>1</sup> Patents Act, 1883, Sect. 18 (1).

that would make the specification as amended claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment." <sup>1</sup> The drawings may be amended in the same way so far as their nature admits.

**Possible Amendments.**—Bearing in mind that a patent may be invalid either by covering more than was new at the time, or something wanting in utility, or from ambiguity or insufficient explanation, it will be seen that this process of amendment provides for the remedying of these faults, but

**Impossible Amendments** are all such as would widen the patent. No amendment can be made where the inventor has claimed too little or has stated his invention to reside in this or that particular, whereas it should be in some other particular of his description, no amendment can also be made if the patentee was not actually the "true and first inventor," <sup>2</sup> or if there is *variance* between the provisional and complete specification other than mere addition in the latter. Naturally also if the *whole* invention be wanting in patentability amendment would be in any case useless.

**Nature of Amendment.**—It was formerly held that disclaimers could only be filed when they related to small and insignificant parts of the patent which nevertheless would invalidate the whole; <sup>3</sup> for if a material part of the patent was excised, it was held that a grant previously a nullity was converted into a valid right, and the public was entitled to be protected from such subsequent deprivation of the right of user. It was also decided that where the patentee had made a broad claim afterwards found unsustainable he could not limit it to a particular construction not specially claimed in the first instance. Thus a patentee who claimed broadly the employment of engraved rollers was not permitted to confine his claim to rollers with circular grooves when it was found that only these particular rollers would answer the purpose. <sup>4</sup> This decision has been followed since 1883, thus a patentee described a blasting cartridge, in which the explosive, preferably dynamite, was enclosed in an inner case within an outer case containing water, stating also that where dynamite was used the inner case might be omitted. An amendment intended to confine the patent to cartridges in which the inner case was omitted was

<sup>1</sup> Patents Act, 1883, Sect. 18 (8).

<sup>2</sup> See Chapters X and XI.

<sup>3</sup> *R. v. Wheeler*, 1850, 10 *C.B.*, 395; *R. v. Mill*, 1851, 14 *Beav.*, 315.

<sup>4</sup> *Ralston v. Smith*, *H.L.*, 1865, 11 *H.L. Cas.*, 223.

refused.<sup>1</sup> An application to insert the adjective "adjustable" to qualify a mechanism previously claimed broadly was refused.<sup>2</sup> It has been expressly stated that it is not the intention of the Act of 1883 to enable a patentee to strike out a broad claim and insert a new claim to a subordinate part.<sup>3</sup> From these cases it will be seen that the extent of relief offered by an amendment is very limited, and that in effect it consists in striking out without addition or substitution. Care should be taken that in patenting an invention, every patentable subordinate part or combination be separately claimed, in addition to the broad claims which may be made. The patentee is not limited to any particular number of claims, some specifications, notably from America, where patent law is better understood than it is here, contain as many as a hundred or more claims.

**Explanation and Correction.**—An explanation would appear to be allowable only when the specification is ambiguous. If it is capable of more than one construction, the applicant may explain so that it no longer remains doubtful what he intends to claim;<sup>4</sup> an explanation of the principles or reasons for an invention which more nearly touch its nature and consequently the scope of the patent will not be admitted;<sup>5</sup> and it has been distinctly stated that a specification originally insufficient cannot be cured by disclaimer or correction.<sup>6</sup>

**Procedure on Application for Amendment.**—The form of application (*see* Appendix II) must state the nature of the amendment and the reasons for making the same. It must be signed by the applicant or patentee personally. The stamp duty is 1*l.* 10*s.* if the application be made before the patent is sealed; 3*l.* if after the sealing. Among the reasons usually given are that "the patentee is advised that parts of the specification are wanting in novelty" or utility, or are ambiguous or misleading. This form is to be accompanied by a *certified* printed copy of the specification and drawings on which the amendments are shown written in red ink. The amendment is then advertised *in extenso* in the official journal, and notice is to be inserted in such newspapers as the Comptroller may direct (at applicant's expense). Papers usually chosen are the "Times," one or two local papers and one or two trade journals

<sup>1</sup> Heath and Frost's Patent, *Griff.*, 310.

<sup>2</sup> Walker's Patent, 2 *Griff.*, 22.

<sup>3</sup> Terrell's Patent, VI *R.P.C.*, 103.

<sup>4</sup> Ryland's Patent, 1888, V *R.P.C.*, 668.

<sup>5</sup> Nordenfeldt's Patent, 1887, 2 *Griff.*, 13.

<sup>6</sup> Johnson's Patent, 1896, XIII *R.P.C.*, 659.

with which the invention is connected. Opposition must be filed within one month of the first of these public notices. Where no notice of opposition is filed the Comptroller will determine whether, and subject to what conditions, if any, the amendment ought to be allowed. If any variation is made, or sought to be made, in the wording of the amendment the Comptroller may order the application to be advertised again, especially if the difference is substantial. The Comptroller's decision is subject to appeal to the Law Office, who may also impose such terms as he considers proper, or may refuse the amendment. Where any legal proceeding with regard to a patent is pending a request for amendment can only be applied for by leave of the Court or a judge,<sup>1</sup> a verified or official copy of the order being left at the Patent Office with the request.<sup>2</sup> The amendment when allowed shall be advertised in the official journal and such other papers as the Comptroller may direct.

**Opposition to Amendment.**—When a request for amendment is advertised it may be opposed within one month of the date of that advertisement. The form of opposition (see Appendix II), bearing a 10s. stamp, must be signed by the opponent in person, and must state the grounds of opposition. The subsequent proceedings by way of declarations in support of the opposition, and in reply follow exactly the same rules as in opposition to the grant of the patent (see Chapter XI). Appeal may also be made to the Law Office from the decision of the Comptroller of Patents in the same manner.

**Terms on which Amendments may be allowed.**—It should be noticed that both the Comptroller and the Law Officer (on appeal) can impose such terms as they may see fit in return for allowance of amendment. It has not been customary to impose any terms, unless an opposition has been filed, when the terms will naturally vary according to the nature and propriety of the opposition. Amongst the terms that have been imposed are that no action shall be brought in respect of any infringement that occurred before the date of the amendment,<sup>3</sup> or which would result in the future from the use of materials made before the amendment was allowed.<sup>4</sup> It has also been ordered that where certain manufacturers had commenced to work an invention on the strength of the invalidity of the patent, they should be permitted to continue

<sup>1</sup> Patents Act, 1883, Sect. 8; 1888, Sect. 5.

<sup>2</sup> Rule 58.

<sup>3</sup> *Re Harrison's Patent*, *Macr. P.C.*, 32.

<sup>4</sup> *Westinghouse's Patent*, *Griff.*, 315.

the manufacture.<sup>1</sup> A patentee may refuse to accept an amendment on the terms imposed, as the patentee did by way of protest in the last mentioned case. In a more recent case, reported since the Act of 1883 came into force, the Law Officer refused to impose terms because the Court being now competent to allow or refuse remedy for infringement occurring before an amendment under Sect. 20, he did not consider himself justified in forestalling any judgment that the Court might make under that section.

**Terms imposed by the Court.**—Whenever an action is pending in respect of a patent, amendment of the specification can only be made by leave of the Court upon such terms as the judge may impose. These terms are invariably that the costs of the action up to the amendment shall be borne by the patentee in any event, and in most cases that past infringement of the patent should be condoned.<sup>2</sup>

Even where an amendment has been made before any action is brought, or perhaps thought of, the Court may not give remedy for any infringement occurring before the date of the amendment unless satisfied that the original claims were drawn “in good faith and with reasonable knowledge and skill.”<sup>3</sup>

**Amendment of Provisional Specification** does not appear to be contemplated by the law. The provisional specification is not read in constructing the rights given by the patent, when the latter is granted, the complete specification alone does that; so it would be unnecessary to make any amendment in the provisional specification. The latter is kept on record as proof that the invention patented is substantially the same as that which the inventor had in his mind at the date of his application, and so it would be of course unadvisable to allow any amendment or alteration in it after the patent is once granted. Even before the complete specification is filed it appears impossible to amend the provisional specification. To add, would of course not be allowed, to strike out is unnecessary, since if this specification includes more than afterwards found to be justified, that part need not be included in the complete specification. Explanation might be allowed if it could be shown that the specification without it is unintelligible and should not have been accepted.

<sup>1</sup> Medlock's Patent, *Newton's L.J.*, N.S., 22, page 69.

<sup>2</sup> For examples of terms: *Singer v. Stassen and Company*, I R.P.C., 121; *Bray v. Gardiner*, 34 Ch. D., 668; *Haslem Foundry Company v. Goodfellow*, 37 Ch. D., 118; *Fusee Vesta Company v. Bryant and May*, V R.P.C., 189.

<sup>3</sup> Patents Act, 1883, Sect. 20.

**Amendment of Complete Specification.**—The whole of the first part of this chapter concerns only the complete specification, and the process of amendment is the same before or after the actual grant or sealing of the patent, though the stamp duties vary as before mentioned. Until the time the complete specification is “accepted,” amendments might be made without advertisement since the specification itself only becomes published on the acceptance. It is uncertain whether the sealing should be delayed until the amendment is disposed of; perhaps it is immaterial, but it is safer to ask that the sealing may be delayed until the specification is amended, to ensure formal correctness in grant of the patent on the perfected specification.

**Amendment of Application.**—Under the general rule that any paper, for amendment of which no special provisions are made, may be amended by leave of the Comptroller on such terms as he may allow, the form of application may be amended. This is often made available for adding the name of a co-applicant, and has even been used for substituting one applicant for another, where it appears that the first applicant was not entitled to apply. No amendment of this nature can be made after the patent is issued. Where incurable faults are found in the papers of the application, before the complete specification is filed, it is the usual practice for inventors to abandon the application and begin another. The original priority of date is of course lost. It is doubtful if disclosure of the invention between the dates of the first and second applications will invalidate the latter, looking to the decision in *Oxley v. Holden*, though it is probable that it would be held to do so, on the broad ground that the invention was known to others before the date of the patent.<sup>1</sup>

**Amendment of Documents generally.**—Any document for the amendment of which no special rules exist, may be amended during the progress of an application for patent, on such terms as the Comptroller of Patents may impose.

**Effect of Amendment.**—Until an invalid patent is amended it remains unenforceable, and consequently affords no remedy against infringement. Where an amendment has been allowed the Patent Act provides that the judge shall refuse to give damages for any infringement previous to such allowance, unless he is convinced that the inventor’s “original claim was framed in good faith and with reasonable skill and know-

<sup>1</sup> *Humpherson v. Syer*, IV *R.P.C.*, 407.

ledge."<sup>1</sup> As to what should be considered "reasonable skill and knowledge," there may be doubts; an inventor acting in ignorance of patent law cannot be said to possess them. Lord Lyndhurst once said that a man must be said to act with wilful ignorance, if he was ignorant of matters which he could have learnt if he made the inquiries which it was incumbent on him to make.<sup>2</sup> The public are presumed to be acquainted with the patent records, so that ignorance of pre-existing specifications on public view must be held a wilful ignorance.

**Enlargement by Amendment.**—If an amendment allowed is afterwards held to widen the patent, it is doubtful whether the patent becomes invalid or the amendment is simply void. In *re Goulard and Gibbs' Patent*,<sup>3</sup> it was held that the complete specification *as amended* went beyond the provisional, thus avoiding the patent. In the Court of Appeal,<sup>4</sup> it had been held that the amendment had widened the patent, and that this was also a ground for holding the patent void; but the House of Lords, holding that in fact the invention formerly set forth in the complete specification had not been widened by the amendment, gave on decision on this point of law.

In *Van Gelder's Patent*,<sup>5</sup> it was sought to prohibit the Law Officer from allowing a certain amendment on the ground that the invention would be widened. The Court of Appeal refused to issue a prohibition on the ground that the Law Officer was final judge in such matters, but were of opinion that if the amendment were afterwards held to widen the patent it would have no validity.<sup>6</sup> It has however since been declared in the House of Lords that an amendment once allowed by the Comptroller General or the Law Officer cannot be questioned in any court.<sup>7</sup>

**Clerical Errors** in the specification may be amended on permission of the Comptroller. Government fee, 5s.

<sup>1</sup> Patents Act, Sect. 20.

<sup>2</sup> *Re Honiball's Patent*, 2 *Web. P.C.*, 201.

<sup>3</sup> *H.L.*, VII *R.P.C.*, 388.

<sup>4</sup> *C.A.*, VI *R.P.C.*, 225.

<sup>5</sup> VI *R.P.C.*, 22.

<sup>6</sup> *Dudgeon v Thompson*, *L.R.*, 3 *App. C.*, 34; *re Moore's Patent*, *Mac. P.C.*, 116.

<sup>7</sup> *Moser v. Marsden*, *H.L.*, 1895, XIII *R.P.C.*, 24.

## CHAPTER XXII.

## EXTENSION OR PROLONGATION OF TERM OF PATENT.

**Petition for Extension.**—A patentee who alleges that he has not been sufficiently remunerated by his patent may petition Her Majesty in Council for an extension of the term.

**Repealed Acts.**—By the Statute of Monopolies it was declared illegal to grant patents for longer terms than 14 years, but owing to the hardship sometimes experienced by inventors of seeing the period of their protection nearly approaching its end just as the invention has become remunerative, power was given to the Crown in the year 1835 to extend the term of 14 years in meritorious cases. By the Act of 5 and 6 Will. IV, 1835, c. 83, Sect. 4, a patentee might, after advertising in the prescribed manner, petition His Majesty in Council for an extension of the term of his patent. The Privy Council, after hearing the petitioner and any opponents who had filed caveats and after “inquiring of the whole matter,” advised the Crown if and what extension, not exceeding seven years, should be granted. The procedure was amended by the Act of 2 and 3 Vict., c. 67 (1839), and again by 7 and 8 Vict., c. 69 (1844), the maximum term of extension was fixed at 14 years.

These three Acts were repealed by the Act of 1883, 46 and 47 Vict., c. 57, but Sect. 113 of the last Act was held to reserve the operation of the repealed Acts in respect of patents granted before 1884, so that in effect their operation extended to the end of 1897.

Under these Acts a considerable body of important decisions have been given, and inasmuch as the majority of these appear to be as applicable under the new practice as under the old, it is to be presumed that in effect the treatment of petitions for extension will remain the same.

**Legislation in Force.**—With the commencement of the



year 1898, Section 25 of the Patents, etc., Act of 1883 enters into active operation. This section is as follows:—

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

(2.) Any person may enter a caveat, addressed to the Registrar of the Council at the Council Office, against the extension.

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

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

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

(6.) It shall be lawful for Her Majesty in Council to make from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.

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

**The Rules** to be observed in proceedings before the Judicial Committee of the Privy Council under the Patents Designs and Trade Marks Act 1883, Section 25, are as follows:—

**RULE I.**— A party intending to apply by petition under Sect. 25 of the Act shall give public notice by advertising three times in the "London Gazette" and once at least in each of three London newspapers. If the applicant's principal place of business is situated in the United Kingdom at a distance of 15

miles or more from Charing Cross he shall also advertise once at least in some local newspaper published or circulating in the town or district where such place of business is situated. If the applicant has no place of business, then, if he carries on the manufacture of anything made under his specification at a distance of 15 miles or more from Charing Cross, he shall advertise once at least in some local newspaper published or circulating in the town or district where he carries on such manufacture. If he has no place of business and carries on no such manufacture, then, if he resides at a distance of 50 miles or more from Charing Cross, he shall advertise once at least in some newspaper published or circulating in the town or district where he resides. The applicant shall in his advertisements state the object of his petition and shall give notice of the day on which he intends to apply for a time to be fixed for hearing the matter thereof, which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the "London Gazette." He shall also give notice that caveats must be entered at the Council Office on or before such day so named in the said advertisements.

**RULE II.**—A petition under Sect. 25 of the Act must be presented within one week from the publication of the last of the advertisements required to be published in the "London Gazette." The petition must be accompanied with an affidavit or affidavits of advertisements having been published according to the requirements of the 1st of these Rules. The statements contained in such affidavit or affidavits may be disputed upon the hearing. The petitioner shall apply to the Lords of the Committee to fix a time for hearing the petition, and when such time is fixed the petitioner shall forthwith give public notice of the same by advertising once at least in the "London Gazette" and in two London newspapers.

**RULE III.**—A party presenting a petition under Sect. 25 of the Act must lodge at the Council Office eight printed copies of the specification: but if the specification has not been printed and if the expense of making eight copies of any drawing therein contained or referred to would be considerable the lodging of two copies only shall be deemed sufficient. The petitioner shall also lodge at the Council Office eight copies of the balance sheet of expenditure and receipts relating to the patent in question which accounts are to be proved on oath before the Lords of the Committee at the hearing. He shall also furnish three copies of the said balance sheet for the use of the Solicitor to the Treasury, and shall, upon receiving two days' notice, give

the Solicitor to the Treasury or any person deputed by him for the purpose reasonable facilities for inspecting and taking extracts from the books of account by reference to which he proposes to verify the said balance sheet at the hearing or from which the materials for making up the said balance sheet have been derived.

All copies mentioned in this Rule must be lodged and furnished not less than fourteen days before the day fixed for the hearing

**RULE IV.**—A party intending to oppose a petition under Section 25 of the Act must enter a caveat at the Council Office before the day on which the petitioner applies for a time to be fixed for hearing the matter thereof, and having entered such caveat shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing. The petitioner shall serve copies of his petition on all parties entering caveats in accordance with this Rule, and no application to fix a time for hearing shall be made without affidavit of such service. All parties intending to oppose a petition shall within three weeks after such copies are served on them respectively, lodge at the Council Office eight printed copies of the grounds of their objections to the granting of the prayer of the petition.

**RULE V.**—Parties shall be entitled to have copies of all papers lodged in respect of any petition under Sect. 25 of the Act at their own expense. All such petitions and all statements of grounds of objection shall be printed in the form prescribed by the rules which apply to proceedings before the Judicial Committee of the Privy Council. Balance sheets of expenditure and receipts shall be printed in a form convenient for binding along with such petitions.

**RULE VI.**—Costs incurred in the matter of any petition under Sect. 25 of the Act shall be taxed by the Registrar of the Privy Council, or other officer deputed by the Lords of the Judicial Committee of the Privy Council to tax the costs in the matter of any petition, and the Registrar or such other officer shall have authority to allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses.

**RULE VII.**—The Lords of the Committee may excuse petitioners and opponents from compliance with any of the requirements of these Rules, and may give such directions in matters of procedure and practice under Sect. 25 of the Act as they shall consider to be just and expedient.

**RULE VIII.**—The Lords of the Committee will hear the Attorney-General or other Counsel on behalf of the Crown on the question of granting the prayer of any petition under

Sect. 25 of the Act. The Attorney-General is not required to give notice of the grounds of any objection he may think fit to take or of any evidence which he may think fit to place before the Lords of the Committee.

**General Requirements.**—Even though there is no opposition, the petitioner will be required to fully show a good case for the exercise of the power of the Crown. The petitioner will require to be represented by Counsel at the hearing before the Judicial Committee of the Privy Council. The prayer of the petitioner is not granted unless due grounds for extension are shown, nor unless the merits of the invention are great, the accounts relating to it have been well kept, and the remuneration obtained under the patent has been inadequate.

The Attorney-General, or Counsel instructed on his behalf, usually appears on behalf of the Crown.

**Advertisements**—are stated in the Rules above given. The three insertions in the "London Gazette" should be in consecutive issues; the advertisements should of course be in the same words in the "Gazette" (three times), in three different London papers (once in each), and in the country papers where such are required. If manufacture is carried on in different towns this advertisement should appear in respect of each such town.

The advertisement must be signed by the petitioner's solicitor. When the patentee resides abroad and the manufacture is carried on under licenses, the advertisement should be inserted in the place or places where the manufacture is actually carried on.<sup>1</sup>

The cost of advertisement in the "London Gazette" (three times) and, say, in the "Times" "Telegraph" and "Standard" (once), and in a country paper, will usually amount to 15%.

The names of all parties petitioning must be given in the advertisements.<sup>2</sup>

**Petition.**—The petition must be in print, and be filed within one week of the insertion of the last advertisement in the "London Gazette."<sup>3</sup> An affidavit of insertion of advertisement must accompany the petition.

The petition should state every material fact relating to the patent. As the recommendation to the Crown to extend the patent is entirely a matter of discretion for the Judicial Committee, it is imperatively necessary that the petition should

<sup>1</sup> Derosne's Patent, 1844, 2 *Web. P.C.*, 2.

<sup>2</sup> Noble's Patent, 1850, 7 *Moo. P.C.*, 191.

<sup>3</sup> Rule II.

state fully and fairly everything relating to the patent, omission to do so is fatal to the petition.<sup>1</sup>

**The Petitioner.**—The petition may be presented by assignees of a patent and extension granted to them,<sup>2</sup> the grantee may, however, join in the petition,<sup>3</sup> but the new Letters Patent must be granted to the party or parties in whom the original patent is legally vested.<sup>4</sup> By the custom of granting extension to assignees it is considered that the original patentee is indirectly benefited, since otherwise his interest would be damnified by diminishing his chance of making an advantageous conveyance to the assignee.<sup>5</sup> So extension may be granted to an assignee, for instance a public company, when the patentee has ceased to have any connection with the working of the patent.<sup>6</sup> It must be understood that the assignee's title must be strictly proved,<sup>7</sup> even though the title be not disputed.<sup>8</sup> Extension may be granted to the executor of a surviving assignee.<sup>9</sup> An equitable assignee may appear in support of the petition, in company with the legal assignees, his name must, however, appear in the advertisements.<sup>10</sup> An "importer" of an invention may apply for extension, but the Judicial Committee will look with jealousy into the merits of the invention "imported."<sup>11</sup> A petitioner who has in truth obtained Letters Patent as agent and trustee for a foreign inventor may receive extension.<sup>12</sup> A mortgagee as legal owner should be a party to the petition,<sup>13</sup> but omission in this particular was not held fatal.<sup>14</sup> It is, however, not infrequently the case that hearings have been postponed to enable petitions to be amended in important particulars where the omission was not fatal.<sup>15</sup> The postponement of a hearing may, however, possibly prevent an application for extension from being "prosecuted with effect" before the patent expires, this consideration should be

<sup>1</sup> Pitman's Patent, 1871, 8 *Moo. P.C.C., N.S.*, 393.

<sup>2</sup> Russell v. Ledsam, 1845, 1 *H.L. Cas.*, 687.

<sup>3</sup> Pettit Smith's Patent, 1850, 7 *Moo. P.C.C.*, 133.

<sup>4</sup> Southworth's Patent, 1837, 1 *Web. P.C.*, 187.

<sup>5</sup> Morgan's Patent, 1843, 1 *Web. P.C.*, 737.

<sup>6</sup> Napier's Patent, 1861, 13 *Moo. P.C.C.*, 543.

<sup>7</sup> Galloway's Patent, 1843, 1 *Web. P.C.*, 725.

<sup>8</sup> Wright's Patent, 1837, 1 *Web. P.C.*, 561.

<sup>9</sup> Bodmer's Patent, 1849, 6 *Moo. P.C.C.*, 469.

<sup>10</sup> Noble's Patent, 1850, 7 *Moo. P.C.C.*, 191.

<sup>11</sup> Claridge's Patent, 1851.

<sup>12</sup> Newton's Patent, 1861, 14 *Moo. P.C.C.*, 156.

<sup>13</sup> Church's Patent, III *R.P.C.*, 95.

<sup>14</sup> Church's Patent, III *R.P.C.*, 95.

<sup>15</sup> Hutchinson's Patent, 1861, 14 *Moo. P.C.C.*, 364.

taken into account in timing the insertion of advertisements, the filing of the petition, and other matters connected with the case.

A petition was filed by the son of a deceased patentee who had acquired an interest in the patent from L., who had worked the patent under a verbal agreement with the patentee till his death. Held that the personal representative of the deceased patentee and L. ought to be made parties.<sup>1</sup>

**Grounds for Extension.**—It must be recognised that extension is not given as a matter of course, but that very special grounds must be shown for the exercise of the extraordinary jurisdiction conferred on the Judicial Comr<sup>of</sup>tee in this matter.<sup>2</sup> The novelty, merit, and utility of the invention must be proved, and it must be shown that all reasonable means have been used in order to make the invention productive, but that in spite of such exertions the remuneration obtained by the inventor has either failed, or has been quite disproportionate to his merits and to the benefit conferred upon the public.<sup>3</sup> Even when there is no opposition and the Attorney General, representing the Crown, does not object, extension will not be granted as a matter of course.<sup>4</sup> “The petitioner is bound to prove three points: first, the merits of the invention; secondly, that the party interested has done all in his power to bring out the invention and to turn it to advantage; and thirdly, that owing to circumstances beyond his control he has been unable to obtain an adequate remuneration.<sup>5</sup> Opposition of existing interests to the introduction of the invention will be considered in favour of extension.<sup>6</sup> Absence of remuneration due to litigation is favourably considered.<sup>7</sup> Where delay has occurred in introducing the invention, the delay must be justified, want of funds may, in some cases, be a good ground for delay.<sup>8</sup> Difficulty in introducing an invention owing to its nature (construction of captains’ bridges as life rafts), coupled

<sup>1</sup> Willacy’s Patent, 1888, V *R.P.C.*, 690.

<sup>2</sup> Jones’ Patent, 1840, 1 *Web. P.C.*, 579.

<sup>3</sup> Honiball’s Patent, 1855, *supra*.

<sup>4</sup> Perkin’s Patent, 1845, 2 *Web. P.C.*, 18; Cardwell’s Patent, 1856, 10 *Moo. P.C.C.*, 490.

<sup>5</sup> Markwick’s Patent, 1860, 13 *Moo. P.C.C.*, 313.

<sup>6</sup> Stafford’s Patent, 1838, 1 *Web. P.C.*, 563; Robert’s Patent, 1839, 1 *Web. P.C.*, 573.

<sup>7</sup> Pettit Smith’s Patent, *supra*; Heath’s Patent, 1853, 8 *Moo. P.C.C.*, 217.

<sup>8</sup> Norton’s Patent, 1863, 1 *Moo. P.C.C., N.S.*, 343.

with illness of patentee, has been held to justify extension for seven years.<sup>1</sup>

**Merit of Inventor.**—In considering the question of prolongation the merit of the inventor must be taken into account. The extension is, firstly, a reward to the inventor for the peculiar ability and industry he has exercised in making the discovery.<sup>2</sup> This may be a matter of degree “It may have been the successful result of long and patient labour and of great and unaided ingenuity without which for all that appears the public would never have had the benefit of the discovery; or it may have been but a happy accident or a fortunate guess; or it may have been very closely led up to by earlier, and in a true sense more meritorious but still incomplete experiments. Different degrees of merit must surely be attributed to an inventor under these circumstances.”<sup>3</sup>

A company buying a patent for a commercial purpose, although incidentally encouraging inventors, does not stand in as favourably a position as an inventor himself.<sup>4</sup> The merit of an “importer” is also less than that of an inventor.<sup>5</sup>

**Merit of Invention.**—The question of “merit” extends not only to the inventor but also to the invention itself as affecting the public. An invention of great benefit to the public may involve small merit in point of discovery.<sup>6</sup> Its simplicity may be an element of value.<sup>7</sup> Merit will principally lie in the utility in the practical working of the invention.<sup>8</sup>

“Utility,” as construed by the Privy Council on petitions for extension, is not necessarily utility required to support a patent, but is more nearly expressed by the word “merit.”<sup>9</sup> The sale of patent articles in large numbers at a high price is a strong evidence of utility;<sup>10</sup> while the non-user of the invention is presumptive proof of want of utility,<sup>11</sup> which requires to be rebutted by very strong evidence of utility to obtain prolongation.<sup>12</sup> The fact of an invention having a very limited market

<sup>1</sup> Roper's Patent, 1887, IV *R.P.C.*, 201.

<sup>2</sup> Norton's Patent, *supra*.

<sup>3</sup> Hill's Patent, 1 *Moo. P.C.C., N.S.*, 265.

<sup>4</sup> Electric Telegraph Company's Patent cited in Norton's Case, *supra*; Sillar's Patent, 1882, I *Good.*, 581.

<sup>5</sup> Soames' Patent, 1843, 1 *Web. P.C.*, 733.

<sup>6</sup> Derosne's Patent, *supra*.

<sup>7</sup> Muntz's Patent, 1846, 2 *Web. P.C.*, 119.

<sup>8</sup> Bett's Patent, 1862, 1 *Moo. P.C.C.*, 49.

<sup>9</sup> Saxby's Patent, 1870, 7 *Moo. P.C.C., N.S.*, 84.

<sup>10</sup> Downton's Patent, 1889, 1 *Web. P.C.*, 565.

<sup>11</sup> Wright's Patent, *supra*.

<sup>12</sup> Allan's Patent, 1857, 4 *Moo. P.C.C., N.S.*, 443; Jones' patent, *supra*.

may be considered in evidence of utility in spite of non-user.<sup>1</sup> Where utility is only apparent in a part of the invention, presumably a separable part, extension may be granted in respect of that part only.<sup>2</sup> The accounts, &c., should deal specifically with the useful part of such invention.<sup>3</sup>

**Remuneration.**—Money spent in experiments to perfect the invention,<sup>4</sup> also in taking out and defending the patent,<sup>5</sup> the expense of bringing the invention into use and manufacturers' fair profit,<sup>6</sup> apparently also a charge for loss of time in endeavouring to bring the invention into general use,<sup>7</sup> and commission paid for effecting sales,<sup>8</sup> may and should be deducted in estimating the profits. As to manufacturers' fair profit no rule can be given as to what deduction should be made on this score, but a deduction of two-thirds of the profit was considered unreasonable.<sup>9</sup> An estimated deduction of 400*l.* in respect of personal service and of a further sum as salesman's profits, neither of which amounts appeared in the accounts or in the petition, could not be taken into consideration.<sup>10</sup> It is also a question whether manufacturers' profits can be distinguished from patentees' profits when the patentee has obtained remuneration during the existence of the patent.<sup>11</sup>

Profits arising from exportation of patented articles must be added.<sup>12</sup> In *re Poole's Patent* it was held that a patentee residing in America need not state profits obtained in America, but only "what profits were made and what benefits were sustained by the introduction of the invention into this country;"<sup>13</sup> but in *re Johnson's Patent*, James, I.J., said, in reference to Poole's case: "Their Lordships desire it to be understood that that case is not to be considered as laying down any general rule of law. Where the question to be considered is whether an invention has been sufficiently remunerated or not, their Lordships

<sup>1</sup> Herbert's Patent, 1867, 4 *Moo. P.C.C., N.S.*, 300.

<sup>2</sup> Lee's Patent, 1856, 10 *Moo. P.C.C.*, 226; in *re Napier's Patent*, 1881, 6 *App. C.*, 174.

<sup>3</sup> Willacy's Patent, 1888, 5 *R.P.C.*, 690.

<sup>4</sup> Bates' Patent, 1836, 1 *Web. P.C.*, 739.

<sup>5</sup> Robert's Patent, 1839, 1 *Web. P.C.*, 575.

<sup>6</sup> Galloway's Patent, 1843, *supra*.

<sup>7</sup> Newton's Patent, *supra*; Carr's Patent, 1873, 9 *Moo. P.C.C.*, 379.

<sup>8</sup> Poole's Patent, 1867, 4 *Moo. P.C.C., N.S.*, 452.

<sup>9</sup> Hill's Patent, 1863, 1 *Moo. P.C.C., N.S.*, 258; Duncan and Wilson's Patent, 1884, 1 *R.P.C.*, 257.

<sup>10</sup> Bailey's Patent, 1884, 1 *R.P.C.*, 1.

<sup>11</sup> Muntz's Patent, 1846, 2 *Web. P.C.*, 121.

<sup>12</sup> Hardy's Patent, 1849, 6 *Moo. P.C.C.*, 411.

<sup>13</sup> 4 *Moo. P.C.C., N.S.*, 456.



must have regard to the remuneration which the invention has brought in to the patentee, or the person who claims the right of the patentee, whether it be in one country or another.<sup>1</sup> Thus, when the patentee has obtained foreign patents they should be stated with the profit made thereof.<sup>2</sup>

Insufficient remuneration is perhaps best shown when the patent only commences to be profitable during the last few years; an even and regular profit throughout the whole term is liable to tell against extension.<sup>3</sup> But where the remuneration has been sufficient, it is no ground for extension that the whole profit has been made in the last few years of the term.<sup>4</sup>

The remuneration must be taken upon the whole patent: where sufficient profit has been made on part of an invention, the unremunerated condition of other parts is not a ground for extension.<sup>5</sup> The profits obtained by licensees, just the same as of assignees, must be given, to estimate the total profit derived in respect of the invention.<sup>6</sup>

**Accounts.**—As the case mainly depends on the amount of remuneration the patentee has obtained, the accounts must be of the clearest and most unreserved nature,<sup>7</sup> and contain everything paid or received on account of the invention or patent.<sup>8</sup> It is not for the Committee to dissect the accounts or to re-cast them in a better form, they must be all ready to satisfy the Committee.<sup>9</sup> Especially must they be of the fullest when the profit made is very large.<sup>10</sup>

If the accounts are defective no prolongation will be granted,<sup>11</sup> nor will any adjournment be granted to enable accounts to be put in better shape.<sup>12</sup>

In accounts for presentation to the Committee the profits of the patent and general business should be kept quite distinct,<sup>13</sup> but the profits of general business should also be shown,

<sup>1</sup> 1871, 8 *Moo. P.C.C., N.S.*, 291.

<sup>2</sup> Adair's Patent, 1881, 6 *App. Cas.*, 176.

<sup>3</sup> Downton's Patent, 1839, 1 *Web. P.C.*, 565.

<sup>4</sup> Ryder's Patent, *John*, 213.

<sup>5</sup> Perkin's Patent, 1845, 2 *Web. P.C.*, 9.

<sup>6</sup> Johnson's Patent, 1871, 8 *Moo. P.C.C., N.S.*, 291.

<sup>7</sup> Hill's Patent, 1863, 1 *Moo. P.C.C., N.S.*, 258.

<sup>8</sup> Adair's Patent, 1881, 6 *App. Cas.*, 176.

<sup>9</sup> Saxby's Patent, 1870, 7 *Moo. P.C.C., N.S.*, 82.

<sup>10</sup> Thomas' Patent, 1892, 9 *R.P.C.*, 368.

<sup>11</sup> Clark's Patent, 1870, 7 *Moo. P.C.C., N.S.*, 255; Wield's Patent, 1871, 8 *Moo. P.C.C., N.S.*, 300.

<sup>12</sup> Yates and Kellett's Patent, 1887, 4 *R.P.C.*, 150.

<sup>13</sup> Betts' Patent, 1862, *supra*; Duncan and Wilson's Patent, 1884, 1 *R.P.C.*, 257.

more especially if the general business has benefited indirectly from the existence of the patent.<sup>1</sup> Assignees' profits must be shown as well as original inventor's profits,<sup>2</sup> and it appears also that licensee's profits must be stated as far as possible.<sup>3</sup>

Where books of account have been lost the Committee will accept a statement of the profits of the patentee to the best of his recollection,<sup>4</sup> but not unless thoroughly satisfied with the reason given for non-production of the books.<sup>5</sup>

<sup>1</sup> Johnson's Patent, 1871, 8 *Mo. P.C.C.*, N.S., 291.

<sup>2</sup> Deacon's Patent, 1887, IV *R.P.C.*, 122.

<sup>3</sup> Trotman's Patent, 1866.

<sup>4</sup> Hutchinson's Patent, 1861, 14, *Mo. P.C.C.*, 364.

<sup>5</sup> Lawrence's Patent, 1892, IX *R.P.C.*, 85.

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## CHAPTER XXIII.

SUNDRY PROVISIONS : REVOCATION. EXHIBITION OF INVENTION. MUNITIONS OF WAR. OFFENCES. PATENT AGENTS. JURISDICTION IN SCOTLAND, IRELAND, ISLE OF MAN. TIME FOR PAYING FEES, &c.

**Revocation.**—Where a patent is invalid from any cause it may be revoked on petition to the Court under Sect. 26 of the Act of 1883.

A petition for revocation of a patent may be presented by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland; any person authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland; any person alleging that the patent was obtained in fraud of his rights, or the rights of any person under or through whom he claims; any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee; or any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the Court or a Judge be admitted in proof of any objection of which particulars are not so delivered. Particulars delivered may be from time to time amended by leave of the Court or a judge. The defendant shall be entitled to begin and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent, the defendant shall be entitled to reply.

Where a patent has been revoked on the ground of fraud, the Comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to

him a patent in lieu of, and bearing the same date as, the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.<sup>1</sup>

So long as the person bringing the petition is qualified under any of the above headings he may rely on any legal ground for revocation.<sup>2</sup> In case the patent is revoked the costs will fall upon the patentee.<sup>3</sup>

As an invalid patent is not enforceable owing to the provision that every ground of invalidity is available by way of defence to an action of infringement, revocation suits need seldom be brought.

**Protection during Exhibition of Invention**, previous to applying for patent, is permitted in certain cases by the Act after previous formalities, but for various reasons applicants cannot be advised to avail themselves of the facility.

The permission referred to is contained in the following Sect. 39 of the Act of 1833: "The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely:—

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

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

The Patents, &c., Act, 1886, extended this provision to foreign exhibitions certified by Order in Council, the preliminary notice to the Comptroller being in such case not required.

It will be observed that the notice to the Comptroller must

<sup>1</sup> Sect. 26, sub-sects. 4-8.

<sup>2</sup> *Re Morgan's Patent*, 1888, V *R.P.C.*, 186.

<sup>3</sup> *Edmund's Patent*, VI *R.P.C.*, 358.

bear a 10s. stamp, and be accompanied by a specification of the invention. Its cost will thus be about equivalent to provisional protection. It will also be observed that the section quoted says nothing with regard to possible application for patent by another person in the meantime, and does not save the inventor at the exhibition from the consequences of such act of another inventor. Fraud would probably have to be proved, a matter of expense and uncertainty, even in the most obvious cases. On the whole, therefore, the inventor is advised to secure a provisional protection before exhibiting.

Such notices are seldom employed, their number fell to seven in 1891, and has since then been further reduced.

**Inventions for Munitions of War.**—Any inventor of instruments or munitions of war may assign the invention or patent, whether obtained or not, to the Secretary of State for War either for or without valuable consideration, and such assignment made with the consent of the Secretary of State shall be valid and effectual, and any covenants as to secrecy or otherwise may be enforced notwithstanding any want of valuable consideration.

The Secretary of State may, if he thinks fit, require the invention to be kept secret, in which case the specification is delivered sealed up to the Comptroller, possibly for safe custody, and remains sealed, and may not be opened without authority of the Secretary of State or of the Law Officers. No petition will lie to revoke such a patent, and even after expiry of the term of the patent the specification must be returned sealed to the Secretary of State.

The Secretary of State may at any time waive the benefit of these provisions, and in such case the specifications, &c., shall be kept and dealt with in the ordinary way.

It is specially provided that the communication of the invention to the Secretary of State, or to any person or persons authorised by him to investigate the merits, &c., and any use of the invention for purposes of such investigation, are not such publication or use as would invalidate a patent afterwards applied for.<sup>1</sup>

**Offences.**—Under Sect. 105 of the Act of 1883: “Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered, which is not so, shall be liable for every

<sup>1</sup> Patents Act, 1883, Sect. 44.

offence, on summary conviction, to a fine not exceeding five pounds.

“A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade mark is registered, if he sells the article with the word ‘patent,’ ‘patented,’ ‘registered,’ or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to the article.”

Fines have been imposed under this section when parties possessing only provisional protections have held out their inventions as patented.<sup>1</sup>

Under Sect. 106: “Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government department, assumes or uses in connection with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable, on summary conviction, to a fine not exceeding twenty pounds.”

**Patent Agents.**—The Act of 1888 imposed for the first time certain restrictions:—

By Sect. 1: “After the first day of July, one thousand eight hundred and eighty-nine, a person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act.

“The Board of Trade shall, as soon as may be after the passing of this Act, and may from time to time make such general rules as are in the opinion of the Board required for giving effect to this section, and the provisions of Section one hundred and one of the principal Act shall apply to all rules so made as if they were made in pursuance of that section.

“Provided that every person who proves to the satisfaction of the Board of Trade that prior to the passing of this Act he had been *bonâ fide* practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

“If any person knowingly describes himself as a patent

<sup>1</sup> R. v. Wallis, III R.P.C., 1; R. v. Crampton, III R.P.C., 367.

agent in contravention of this section he shall be liable, on summary conviction, to a fine not exceeding twenty pounds.

“In this section ‘patent agent’ means exclusively an agent for obtaining patents in the United Kingdom.”

It will be noted that no man is forbidden to *act* as a patent agent so long as he does not *describe* himself as one.<sup>1</sup>

**Jurisdiction in Scotland, Ireland, and the Isle of Man.**  
—By Sections 107 to 112: “In any action for infringement of a patent in Scotland the provisions of the Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts.

“For the purposes of this section ‘Court of Appeal’ shall mean any Court to which such action is appealed.

“In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

“Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

“Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of the Act.

“All parties shall, notwithstanding anything in the Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

“The provisions of the Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term ‘the Court’ shall mean any Lord Ordinary of the Court of Session, and the term ‘Court of Appeal’ shall mean either Division of the said Court; and with reference to any such proceedings in Ireland, the terms ‘the Court’ and ‘the Court of Appeal’ respectively mean the High Court of Justice in Ireland and Her Majesty’s Court of Appeal in Ireland.

<sup>1</sup> *Graham v. Fanta*, IX *R.P.C.*, 164.

“ If any rectification of a register under the Act is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification shall be served on the Comptroller, and he shall rectify the register accordingly.

“ The Act shall extend to the Isle of Man, and—

“ Nothing in the Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those Courts.

“ The punishment for a misdemeanor under the Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court.

“ Any offence under the Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.”

**Time for Paying Fees, Leaving Documents, &c.**—The Patent Office opens at 10 a.m. and closes at 4 p.m.

By Sect. 98: “ Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the Patent Office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day or days if two or more of them occur consecutively.”

**Loss of Patent.**—If the patent document is lost or destroyed, a duplicate can be obtained. Government stamp fee, 2*l.*

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## Part III.—Foreign Patents.

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### INTRODUCTORY EXPLANATION.

FOR convenience of reference the principal features of the various foreign Patent Laws have been arranged for each country under headings indicative of their contents. A short explanation of the contents of these headings may here be given to avoid reiteration.

The headings are as follows:—

**Date of Law.**—The date and name of the law are given for facilitating reference to the text, if needed, and as evidence of the source and time of the information. Full text of the laws may be seen for the most part in the Patent Office Library, and for reliable translations Carpmael's "Patent Laws of the World," and the Supplement thereto prepared by the Institute of Patent Agents in 1889 may be consulted. The Official Journal of the United States Patent Office from time to time contains the English text of foreign Patent Laws. The Author is indebted to all these sources, and to his correspondents and agents for more recent Acts. Very short intervals pass without some alteration occurring, especially in the British Colonies, where Patent Law appears to receive a considerable amount of legislative attention.

**Patentable Inventions**, as a rule, will require but little remark, since the general features by which the patentable nature of an invention are distinguished are much the same in every country. Subject matter is generally the same, also utility. Novelty is judged in much the same way, though there is variety in the particular limits within which novelty is required. The differences from the English practice where such occur are pointed out.

**Kinds of Patents.**—The privileges which inventors may obtain abroad are not always called Patents for Inventions, but

apart from mere name, they are not always exactly the same in effect.

Apart from mere translation of the word "Patent" (Patente, Brevet, Privilegio, &c.), the privileges are of three principal kinds:—

(a) Patents of Invention, synonymous with the same term as understood in England and America.

(b) Patents of Importation. This is practically the same in every respect as a Patent for Invention, but denotes that the particular invention, the subject of the patent, has been previously patented in some other country, and, usually, that the Patent of Importation will expire with that previous patent. It does not solely confer right to "import" an invention, as its name might imply; in all practical respects its legal force is the same as that of a Patent of Invention.

It is usually immaterial in law whether the inventor asks for a Patent of Invention or Importation when he has already a foreign patent. The cost is exactly the same, and it has been held in France and Belgium that, where a foreign patent exists, a Patent of Invention will expire with it exactly as if it were called a Patent of Importation.

(c) Patents of Addition or Improvement. These, when granted, are only obtainable by the patentee of a Patent of Invention or Importation, for an improvement or addition to the invention covered by the principal patent. It is usual that Patents of Addition are subject to no yearly or other taxes. They generally fall with the principal patent, and serve a great convenience in permitting a patentee from time to time to protect any minor improvement he may make at less expense than for a new patent.

No one can obtain a Patent of Addition without the "addition" is in proper connection with an invention previously patented to himself. No addition can be filed to another man's patent unless by his assignee properly possessed of the principal patent.

**Who may Apply:** that is, who is legally entitled to be an applicant for Patent of Invention according to statute or common practice of the country.

**Mode of Application** is intended to inform intending applicants of the work necessary, its nature and extent; of the method of prosecuting the application, and the official examination or requirements which will have to be met. As no application can be properly conducted otherwise than through an agent in the country, many laws containing a provision to that

effect, the full text of all those forms which the foreign agent can prepare and sign is omitted as superfluous. All those forms to which the signature of the applicant himself is necessary are given in Appendix II. The time and nature of opposition, if any, and any special features which may modify the result of the application or its cost are noted.

**Term of Patent.**—The length of term granted, its commencing date, date of priority, extension of term of patent, and like information concerning its duration, will be found under this heading, where not given under the heading “Kinds of Patents.”

**Renewal Fees.**—The exact amount of the renewal fees is given, and of the Government fees for extension of time where same can be had. Where fees are paid by patent agents for their clients, an additional charge is made for their services. Patent agents usually remind their own clients of the renewal fees shortly before they become due, thus obviating chance of irrevocable loss through patentee's forgetfulness. In firms of large practice this work is usually allotted to a special department in charge of the necessary registers.

**Working.**—Where the foreign law requires every patent to be worked within a stated time, particulars are given under this heading. Agents can generally effect a sufficient “working” to satisfy the law, if desired by patentees who have not had time or opportunity of selling or licensing their patent in the foreign country, or of working it there themselves. Working is more fully treated under “France,” “Belgium,” and “Germany.”

**Validity of Patent.**—Any specially noteworthy provisions affecting the validity or scope of a patent will be noted under this heading; silence inferring that the usual causes of invalidity, insufficiency of specification, want of novelty, &c., may be relied on.

**Infringement.**—The various remedies against infringement are noted. In many countries infringement knowingly committed is a penal offence.

**Amendment.**—Wherever the law affords means for amending a faulty patent the nature of the means is pointed out; absence of the heading implies that the law provides no remedy.

**Publications.**—The method of publishing copies of specifications in print or otherwise, registering same, cost of copies, and information of similar character, is included in this heading.

**Assignments and Licenses.**—Provisions respecting these documents, their preparation and registration.

**General Provisions** are such as are necessary to mention but do not come under any of above headings, such as marking goods, use of inventions on ships, use by Crown, &c.

**Average Cost of Foreign Patents.**—The cost is made up of several factors. These are principally the Government fees, and stamp duties, the foreign agency fee, and the cost of preparing and translating the documents, and of prosecuting the application. Of these, the first is fixed in amount although the stamp duties sometimes vary with the length of the specification, &c.; the second will vary somewhat with the standing of the foreign agent who must necessarily be employed and, with cost of prosecution, may range from 2*l.* to 10*l.* in most countries; the third should depend on the nature and complexity of the invention, and would differ according to the number of patents applied for. Allowance must be made for the great care required in every detail, consequently the following will be reasonable prices, where such care is properly taken. Drafting specifications 2*l.* 2*s.* per 1,000; translation 25*s.* or 30*s.*; engrossing copies, each 5*s.* per 1,000; powers, legalizing 15*s.* to 30*s.* In some cases the same specification and translation may serve for applications in different countries, and when suitable drawings are once prepared, copies will naturally cost comparatively little. The custom of giving a list of fixed inclusive prices for foreign patents intended to be adhered to, whatever the complexity of the invention or the number of patents taken, does not, therefore, lead in all cases to a just charge. The amount named in the following pages at the end of the description of the law of each country must, therefore, be taken for general guidance only, and certainly not as a fixed sum applicable in every case. To enable a proper estimate to be made of the total cost for any group of patent applications, details of the invention should always be furnished.

## ALGERIA.

A colony of France and covered by French patent.

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## ANTIGUA.

(See Leeward Islands.)

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## ARGENTINE REPUBLIC.

Date of Law—11th October, 1864; of Rules—9th November, 1866.

**Patentable Inventions.**—New inventions or discoveries in any branch of industry, whether made in the country or abroad, that is to say, new products of industry or new means or the new application of known means for obtaining an industrial result or product. An invention is not considered new if previous to the application for patent in Argentina it has already received sufficient publicity in works, pamphlets, or periodicals in Argentina or abroad to be worked. Pharmaceutical preparations, financial schemes, and inventions contrary to law or morality are not patentable.

**Kinds of Patents.**—Patents for new inventions are granted for 5, 10, or 15 years, at the option of the applicant, but where a previous foreign patent exists the Argentine patent, while limited to a maximum of 10 years, expires with the foreign patent.

Provisional patents or caveats (*patentes precaucionales*) are granted also for a term of one year, and are renewable yearly, their effect being that if during their term application for patent is made by any other party for a similar invention the holder of the provisional patent is notified of the fact and may oppose the grant within three months of the notification. Unless an agreement is made between the parties no patent will be granted to either party. Patents of addition are also granted for improvements on patented inventions, provided they do not

last for more than 10 years, or the life of the head patent if less than 10 years; but if the term of the head patent is half expired, or if the improvement lessens by one half the cost of production, time, risk, or danger, or for any like reason, the Commissioner may fix a longer term.

**Who may Apply.**—The inventor or his assigns.

**Application for Patent in Spanish** is directed to the Commissioner of Patents, and is accompanied by a specification and drawings in duplicate; these may be signed by the attorney. Where the invention is previously patented abroad a certified and legalised copy of the foreign patent, or any one of several foreign patents, must be sent. Where the invention is not already patented a declaration of the applicant (Form 73), authenticated by a notary and legalised by the Argentine Consul, must be substituted. The power of attorney (Form 20) must be legalised in the same way. The duration of term asked for must be mentioned in the petition, and half the government fees for that term must be paid at the time of filing. A receipt is given on request and cost of applicant. Where the term does not exceed 10 years the Commissioner will decide as to the patentability of the invention, subject to applicant's right to appeal to the Minister within 10 days. If the term exceeds 10 years the application is referred direct to the Minister of the Interior, from whom there is no appeal. The law permits the payment of the remaining half of the fees by equal annual instalments, but as the applicant is required to give security for the payment, it is practically necessary for a foreigner to pay the whole fee before the grant of the patent. If the patent is refused half the fee is returned. The fees are 80 pesos fuertes for 5 years, 200 for 10 years, or 350 for 15 years for a patent of invention; 50 pesos for a provisional patent or caveat of one year. For a patent of addition if taken by the holder of the original patent a fourth of the fee, if taken by any other party half of the fee. The duplicate of the description is affixed to the patent.

**Renewal Fees.**—None.

**Working** is to be done within two years of the date of issue of the patent, and not interrupted for longer than two years at a time, except owing to circumstances beyond control or accident, duly certified as such by the Patent Office.

**Infringement** is punishable by fine of from 50 to 500 pesos, or imprisonment of from one to six months, and forfeiture of infringing articles. For a second offence within five years, the penalty is doubled. Participation in infringement by selling,

exhibiting, importing, or communicating, knowingly committed, is subject to the same penalties. These penalties are without prejudice to the patentee's right to damages.

**Publication, Registration; &c.**—Quarterly lists of patents granted or refused are compiled for publication. Yearly volumes of patents granted with descriptions and drawings are also deposited for free public inspection at the Patent Office and chief provincial Post Offices. Written copies of the specifications filed (other than caveats) may be had on payment of stamp duty on the paper used.

**Assignments** must be by Notarial Act, properly legalised, if made outside Argentina by the Argentine Consul. Assignments must be registered at the Patent Office to acquire operative force against third parties.

The cost of obtaining patent is about 40*l.* for 5 years, 65*l.* for 10 years, 100*l.* for 15 years.

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## AUSTRALIA, &c.

Separate patents are necessary in Victoria, New South Wales, Queensland, South Australia, Western Australia, on the continent of Australia, and in Tasmania. New Zealand, Borneo, Fiji, Hawaii, among the adjacent and other islands of the Pacific Ocean.

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## AUSTRIA-HUNGARY.

**Patents in Austria and Hungary.**—The Patent Law of 15th August, 1852 (*see* Austria), covered the whole Empire. In 1867 Hungary obtained a separate government, but although thenceforward each country issued a separate Patent deed, the two patents were in effect considered one and indivisible. Neither could be obtained, prolonged, annulled, &c., without the other. The fees were increased 25 per cent. This dual system was abolished from 1st January, 1894, but patents issued or applied for before that date are still subject to its provisions and the raised fees. Thenceforth, as regards patents, the two countries became entirely distinct. Each country adopted separately the Act of 1852. The fees reverted to the original

scale. The dissociation Act of 1894, however, granted to an applicant in either country a delay of 90 days for retaining priority for his application in the other country. New laws have since been passed in each country (which *see*).

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## AUSTRIA.

(Including Bohemia, Cisleithania, Lichtenstein, Herzegowina, and Bosnia.)

Law of 15th August, 1852.\*

**Patentable Inventions.**—New discoveries, inventions or improvements, having for their object a new product or means or method of production. Preparations of food, beverage, or medicine, are not patentable. Novelty is not effected by previous user or publication outside the Austro-Hungarian Empire. Foreign Patent Office specifications invalidate when introduced into the empire. German specifications are not considered publications until three months have elapsed since their issue. When an invention is already patented abroad the Austrian patent lapses therewith, or if more than one with that which the applicant has indicated as the basis for the Austrian patent. Valid patent cannot be had if a foreign patent has previously lapsed

**Who may Apply.**—Any person, but if a foreign patent exists then only the patentee, his heirs or assigns.

**Application for Patent** is made by petition signed by the Attorney, who must be resident in Austria, and be appointed by legalized power (Form 16). The examination of the specification, on which the stamp duties vary according to the length, does not extend to question of novelty. A request may be made that the invention be kept secret. The patent dates from the day of issue. Longest term 15 years.

\* This law remains in force for present patents and applications until the new law, *see* page 256, comes into operation, the date of which is not yet fixed.



**Renewal Fees.**—On Austro-Hungarian patents granted or applied for before 1st January, 1894, with stamp duties:—

	Florins.		Florins.
1st year ..	26·25	9th year ..	59·06
2nd „ ..	26·25	10th „ ..	65·63
3rd „ ..	26·25	11th „ ..	78·75
4th „ ..	26·25	12th „ ..	91·98
5th „ ..	26·25	13th „ ..	105·00
6th „ ..	39·38	14th „ ..	118·13
7th „ ..	45·94	15th „ ..	131·25
8th „ ..	52·50		

On each separate patent, subsequent to 1st January, 1894, with stamp duties:—

	Florins.		Florins.
1st year ..	21·65	9th year ..	47·75
2nd „ ..	21·65	10th „ ..	55·00
3rd „ ..	21·65	11th „ ..	63·50
4th „ ..	21·65	12th „ ..	74·00
5th „ ..	21·65	13th „ ..	84·50
6th „ ..	32·00	14th „ ..	95·00
7th „ ..	37·25	15th „ ..	105·50
8th „ ..	42·50		

There is no extension of time for payment of renewal fees.

**Working** must be begun within one year of the grant of patent, and not interrupted for more than two years at a time. Proof of working must be afforded to the ministry.

**Importation** by the patentee is permitted.

**Infringement.**—Counterfeiting, selling, importing, offering or storing for sale, is an infringement punishable by fine of 25 fl. to 100 fl., or in default imprisonment 5 to 200 days. Where the specification has been kept secret by the desire of the patentee, fines are only inflicted on repetition of offence. Actions affecting the validity of patents are brought before the Ministry of Commerce; actions for infringements before the District Courts, with appeal to Higher District Courts, and further appeal to the Ministry of Commerce.

**Assignments** must be registered and accompanied by power of Attorney from the assignee to a resident agent to file the assignment and represent the assignee in the empire. Partial assignments, or for limited areas, cannot be registered under the law. The Letters Patent must be produced.

## Law of 11th January, 1897.\*

**Patentable Inventions.**—In addition to foods, beverages, and medicines; chemical products, means of disinfection, and inventions, the use of which would be contrary to State monopolies, are also declared not patentable. Processes for production of food, chemical products, &c., are, however, patentable.

**Novelty.**—The invention must not have been published *in print* anywhere, or used in Austria. Provision is made to enable the Authorities to declare certain foreign specifications not to be publications in the sense of this Act for a period not exceeding six months.

**Who may Apply.**—The actual inventor or his legal representatives.

**Application for Patent** is to be examined for novelty, somewhat as in Germany, to which practice that authorized by this Act is in nearly every respect exactly similar. The patent is to date from the day on which the application (after passing first examination) is published for opposition, which may be filed within two months. Application fee, 10 fl.

**Renewal Fees.**—On patents granted under Act of 1897 the renewal fees will be:—

	Florins.		Florins.
1st year .. ..	20	9th year .. ..	120
2nd „ .. ..	25	10th „ .. ..	140
3rd „ .. ..	30	11th „ .. ..	180
4th „ .. ..	40	12th „ .. ..	220
5th „ .. ..	50	13th „ .. ..	260
6th „ .. ..	60	14th „ .. ..	300
7th „ .. ..	80	15th „ .. ..	340
8th „ .. ..	100		

Three months' extension of time for tax payment, 5 fl.

**Working.**—A patent granted under Act of 1897 is liable to be revoked after three years from commencement of patent term if the patentee has not worked it in Austria, or done his best to do so, or if he works only to a small extent and satisfies the greater part of the demand by importation.

**Patents of Addition.**—The law of 1897 provides for grant of same, tax on application 10 fl., on grant 25 fl., no renewal fees.

**Sundry Provisions** of the law of 1897. This law provides for the establishment of a Patent Court to which appeals can be carried from the Patent Office in suits of nullity only.

\* See note to page 254.

There is no appeal from a final Patent Office decision to refuse a patent. Where the invention has been obtained from the papers, &c., of another, the latter may within three years obtain the revocation of the patent and its grant to himself. Provision is made for grant of compulsory licences to patentees of improvements.

It is also open to any person to ask for a declaration from the Patent Office as to whether any contemplated process or article is an infringement or not of any patent specified by him. The law of 1897 does not extend to any patent granted, or application made, before it comes into force; but any such application or patent granted may be converted into an application or patent under this law.

**Infringement** committed knowingly is subject to a fine of 500 fl. to 2,000 fl., or imprisonment of 3 to 12 months or to both, as well as damages, and destruction or delivery of the infringing articles or tools.

**Assignments** (*see* law of 1852).—Partial assignments, or for limited areas, are recognized by the law of 1897.

Cost of obtaining patent is usually 8*l.* to 20*l.* (*see* page 250).

## BAHAMA ISLANDS.

**Date of Law.**—52 Vict., cap. 23, An Act relating to the Law of Patents (assented to 23rd May, 1889).

**Patents** are granted for seven years, renewable for further period of seven years and again for a like period, or 21 years in all, for any art, process, or manner of producing, preparing, or making an article, and also any article prepared or produced by manufacture and any improvement thereon, not publicly known or used in the islands.

**Who may Apply.**—The true and first inventor or importer into the islands of an invention unknown there.

**Mode of Application.**—Every person, who desires to obtain exclusive privilege in respect to any invention, must file, by an attorney in the city of Nassau, a complete specification, with a copy of same, and in the case of persons residing abroad, a copy certified and stamped of any Letters Patent which may have been issued to such person with respect to the invention of which the specification is filed, fee 3*l.* Ten days after filing specification, a petition is presented to the Governor, accompanied by a copy of specification and a declaration praying for grant of Letters Patent. The Governor may refuse the patent

if he is of opinion that the alleged invention is not patentable in law or it appears to him that the invention is already in the possession of the public with the consent or allowance of the inventor, or that there is no novelty in the invention, or that the invention has been described in a book or other printed publication before the date of the application, or is otherwise in the possession of the public; or when it appears that the invention has already been patented in the colony. Form 26 may be used.

**Renewal Fees.**—For second period of seven years, 10%. ; for third period of seven years, 10%.

**Working.**—When the invention is not brought into operation within a period of three years after filing the specification, the exclusive right granted shall be forfeited and cease to exist.

**Infringement.**—Such remedy against any person who makes, uses, &c., without consent of the grantee, may be had in the Courts of the Islands, as the grantee of any Letters Patent would be entitled to in the like case by the law of England. Defendant can plead any such matter in defence as may be pleaded in any Court of High Court of Justice in England.

**Assignments, Registration.**—A Register of Proprietors is kept and copies of entries obtainable. Patents are assignable, and assignments must be registered in the Office of the Registrar of Records.

The cost of patent is usually 35%.

## BARBADOS.

**Territory covered.**—The Island of Barbados.

**Date of Law.**—Act of 12th December, 1883.

**Patent Rights or Exclusive Privileges** in respect of an invention are obtainable for a term of 7 years, renewable for a further 7 years, and again for a further 7 years, or 21 years in all, but cannot be validly held and maintained if at the time of filing the specification of the invention the latter is not a new invention as to the public use and exercise thereof within the Island of Barbados, or if the applicant is not the true and first inventor within the island, or if the invention was both well known elsewhere and also known to some persons or person

within the island other than the person filing the specification.

**Who may Apply.**—The “true and first inventor within the island,” which includes, as in British law, the true and first importer.

**Application for Patent** is made by filing in the office of the Colonial Secretary a complete specification of the invention with a copy thereof. A fee of 3*l.* 6*s.* 8*d.* is payable therewith. There is no examination, and by the act of deposit applicant acquires patent rights without further deed than the certificate of deposit. The term of the patent commences with the day of filing the specification. Form 26 may be used.

**Renewal Fees** are 10*l.* preliminary to first renewal of seven years; 20*l.* preliminary to second renewal for the same period.

**Working.**—Exclusive rights are forfeited and cease to exist if the invention is not brought into operation within three years.

**Infringement and Revocation.**—In either of these matters the law provides that remedies shall be had in exactly the same way as by British law.

**Publication.**—Specifications are not printed, but open to inspection. Notice of the filing of a specification is to be published three times in the Government Gazette.

The cost of obtaining patent is about 25*l.*

## BELGIUM.

**Date of Law.**—Principal Act, 24th May, 1854; Amending Act, 27th March, 1857; Act approving the International Convention of 1883, 5th July, 1884; Royal Decrees (Rules), 24th May, 1854, 12th September, 1861, 23rd June, 1877, and 21st October, 1884.

**General Remarks.**—The very full treatment given to the Jurisprudence under the heading of *France* will render it unnecessary to afford elaborate explanation of the provisions of the Belgian patent system which in all fundamentals is substantially the same; only a few leading references will, therefore, be given.

**Patents** are granted under three names, viz., patents of invention, of importation, and of improvement. The term of a

patent of invention is 20 years; a patent of importation is exactly the same as a patent of invention, only it is intended to be granted in lieu of the former, when a prior foreign patent for the same invention exists; it lapses with the foreign patent. Patents of improvement are the same as are usually called patents of addition; they are granted to original patentees for alterations, additions, or improvements on the principal invention, they expire with the head patent, and are not subject to renewal fees.

A decision<sup>1</sup> may be noticed from which it appears to be immaterial whether a foreign patentee asks for a patent of invention or of importation; a patent of invention is not invalidated if a prior foreign patent be found to have been taken, it however lapses with that foreign patent. It will be noticed that where more than one prior foreign patent exists the Belgium patent will lapse with that having the longest, not the shortest term.<sup>2</sup> Also that if the foreign patent prove to be unsustainable in law the Belgian does not fall for that reason.<sup>3</sup>

**Who may Apply.**—Inventor or his assignee, or administrator, executor, or heir of these.

**Application for Patent** is made by depositing in a sealed packet a duplicate specification and drawings to metric scale.<sup>4</sup> One set must be on stamped paper.<sup>5</sup> A receipt for payment of the first year's tax of 10 fr. must be presented. The deposit is made at the registry of one of the provincial governments or at the office of a district Commissary. A memorandum of the day and hour of deposit is made in the register, signed by applicant or his attorney, and a copy thereof given to applicant. The date so obtained is the commencement of the term of the patent which is granted in about a month's time without examination.<sup>6</sup> Power of attorney need not be legalised. Form 14 may be used.

**Validity of Patent.**—A patent may be declared void by the tribunals (a), if the invention had already been commercially worked in Belgium at the date of the patent; (b) if the invention is not fully or properly disclosed; (c) if the complete description and exact drawings of the patented article were

<sup>1</sup> Brussels, 31st December, 1857, E. Picard, "Traité des Brevets d'Invention," page 824.

<sup>2</sup> Art. 14.

<sup>3</sup> Antwerp, 22nd November, 1862, *B.J.* XXI, page 1162.

<sup>4</sup> Art. 17.

<sup>5</sup> Rule 1, 1861.

<sup>6</sup> Art. 2.

brought out in a printed<sup>1</sup> and published work or collection before the date of the patent, unless as regards a patent of importation that publication may be the result of a legal requirement.<sup>2</sup> Patents granted to others than the patentee of a prior foreign patent, or his assignees, are also void if the invention has been previously patented abroad.<sup>3</sup> It will be noticed that the publication above mentioned is not confined to Belgian territory,<sup>4</sup> but it must be full and complete enough to enable others to execute the invention.<sup>5</sup> Publication in foreign patent specifications falls under the exceptions given in condition (c) so long as it is done by imperative law, and does not depend only on the will of the patentee.<sup>6</sup> A judgment concerning British complete specifications filed after provisionals may be interesting, it being held that where the former goes beyond the limits of the latter (variance) the publication of the new matter inserted is not covered by this exception in the Belgian law.<sup>7</sup>

**Renewal Fees.**—These are 20 fr. for the second year, 30 for the third year, and so on, adding 10 fr. per year. They are payable before the anniversary of the date of deposit of the application, but a month's grace is given without extra payment, or six months' grace in all, on addition of a fine of 10 fr.

**Working.**—The Belgian law requires that the invention shall be worked in Belgium within one year of the commencement of working abroad,<sup>8</sup> and that it shall not cease for longer than a year at any time after that. Nevertheless, on petition, the Government *may* by Royal Decree stating reasons grant a delay of not longer than one year for the *commencement* of the working. Where working has not been performed, or has been abandoned, the Government may decree that the patent is revoked. A petition to this effect may be filed at the Ministry by any person interested, and the Government will call upon the patentee to produce proofs of the working within a certain time or otherwise oppose the petition before the issue of the decree. The Courts are not concerned with the working, the Ministry being sole judges of the sufficiency, &c., thereof.

**Infringement.**—The patentee has civil remedy for damages

<sup>1</sup> Or otherwise mechanically reproduced.

<sup>2</sup> Art. 24.

<sup>3</sup> Art. 25.

<sup>4</sup> Cass., 17th May, 1850, *B.J.* VIII, page 886.

<sup>5</sup> Picard and Olin, page 221.

<sup>6</sup> Picard and Olin, page 249.

<sup>7</sup> Brussels, 30th March, 1871, *B.J.* XXIX, page 981.

<sup>8</sup> Art. 23.

sustained, and may claim an injunction against the continuance of the infringement. Where the persons prosecuted have acted knowingly, confiscation of the infringing articles may be ordered, as well as of the tools, &c., for making same.

**Publication of Specifications.**—According to Act 19 the specifications of patents are not published until three months have elapsed from the grant of the patent, they are then published in print, either in full or by extract, as the Administration may judge desirable. The public are charged for copies at the rate of 75 cents the page of 25 lines, drawings 2 fr. the hour.

**Assignment** may be by simple deed under hand and seal, but to render it opposable to third parties there must be evidence of its date, it is advisable, therefore, to have it made before a notary and legalised before the Belgian Consul. Rule 19 of 24th May, 1854, requires an assignment or license, whether whole or partial, to be notified to the Ministry, for which purpose the assignee will have to appoint an agent in Belgium by power of attorney to make the notification. A certified duplicate of the assignment deed for filing must accompany the power of attorney. A tax of 14 fr. is imposed on registration.

The cost of obtaining patent, whether of invention, importation, or addition, is usually from 3*l.* to 12*l.* (*see page 250*).

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## BOLIVIA.

Date of Law.—8th May, 1858.

**Patents** may be granted for new inventions or improvements, other than for mere modifications of shape or ornament, or for medicinal remedies. The duration shall be not less than 10 or more than 15 years. Imported inventions already known abroad, but not previously known in Bolivia, may be patented for terms according to the estimated outlay necessary to set up the manufacture, namely, if 25,000 dols., 3 years; if 50,000 dols., 6 years; if 100,000 dols. or more, 10 years, and the patent is restricted to the locality in which the invention is worked, or to the territory necessary to secure its benefits.

**Term of Patent** commences from the date of decree granting the patent.

**Application** of two or more independent applicants—the first to apply for patent is preferred.

Applicant is to file a petition with description of the invention, drawings, or models, and samples of the product. The



application is referred to a special commission of experts and others sworn to secrecy, and within three months of the receipt of their report the patent shall issue. (Form 20 legalised may be used for the power of attorney.)

The specification, &c., is kept secret during the duration of the patent, and is published when the latter expires or lapses and deposited in the public library of the capital.

**Improvements, &c.,** necessitating amendments of the original documents before or after grant should be notified.

**Validity of Patent.**—Patents lapse if the specification is misleading or not fully descriptive of the invention, if the invention has been already described and published in print within or outside Bolivia, or if the patentee contravenes the obligations attached to the use of the privileges as to working or otherwise.

**Taxes.**—There are no renewal taxes.

**Working.**—The inventor must put his invention into complete practice within a year and a day, counting from the date of grant of the privilege, under penalty of the lapsing of the patent if he cannot justify his omission according to law.

**Infringement.**—A patentee on giving security for costs, may sue for confiscation of infringing articles and for damages. If the action fails the patentee is liable to damages for wrongful seizure, and to fine equivalent to the damages which had otherwise been recoverable had he succeeded.

**Registration.**—A register of patents granted is kept in the Office of the Secretary of the Interior, forming part of the collection of laws and decrees. Grants are published in the Official Journal and communicated officially to the heads of districts.

**Assignment** must be by public, or notarial, act, on pain of forfeiture of the patent.

The cost of obtaining patent is about 100*l*.

## BORNEO (BRITISH NORTH).

### Patents Proclamation, 1887.

The Ordinance XII of 1871 of the Legislative Council of the Straits Settlement (which see) was adopted *in toto*, with such substitution of names of places, &c., as might be necessary. Its operation in Borneo commenced 1st April, 1887.

Cost of patent 40*l*.

## BRAZIL.

Date of Law.—14th October, 1882.

**Patentable Inventions.**—New industrial products, new processes, new applications of known processes and improvements are patentable, if at the date of the application they have not been used either in Brazil or elsewhere, and have not been published so that they could be used. Inventions contrary to law, morality, public security, or health, and those which do not offer practical industrial results, are not patentable. Where an invention, however, is patented abroad, and application is filed in Brazil within seven months of the date of the foreign application, the former will not be invalidated by any publication, use, or petition by another in the meantime.

**Kinds of Patents.**—Of invention for 15 years, and of addition, the latter being granted to holders of the original patent and expiring therewith. The right of priority for an improvement on a patented invention is reserved to the holder of the latter during the first year. The law also provides that provisional patents may be granted where the inventor wishes to experiment in public or exhibit in an officially recognised exhibition; the term is not mentioned by law, and such protections are practically useless to foreigners. Patents lapse with previous foreign patents on the same invention.

**Who may Apply.**—The author or inventor, or co-inventors.

**Mode of Application.**—The petition in Portuguese (signed by agent) must be accompanied by a legalised power of attorney appointing an agent resident in Brazil (Form 21), and the specification in the same language in duplicate with the drawings or samples. No examination is made unless the invention refers to alimentary, chemical, or pharmaceutical products, in which case also samples must be deposited for Government analysis. This examination is at the expense of the applicant, and costs usually 4*l.* to 5*l.* The specification must also be advertised at patentee's cost *in extenso* in the *Diario Oficial* upon the grant of the patent.

**Renewal Fees.**—20 dols. for the first year, 30 dols. for the second, and so on yearly, adding 10 dols. each year. Tax for Patents of Addition is to be the same as the amount of the next annuity falling due on the principal patent, no other separate annuities being payable on the Patent of Addition.

**Working.**—The patent will lapse if the patentee does not

make effective use of the invention within three years, and if thereafter he suspends the use for more than one year except by reason of *force majeure*.

**Infringement** is punished by a fine of from 500 dols. to 50,000 dols. for the benefit of the Treasury, and for the benefit of the patentee from 10 to 50 per cent. of the damage caused, and delivery to him of all infringing instruments or products. The patentee may in addition recover damages by civil process.

**Assignments, &c.**, are ineffectual until registered in the Office of Agriculture, Commerce, and Public Works.

The cost of Brazilian patent is about 40*l.* when the specification does not exceed 1,000 words; for each 100 words additional the cost of translation, advertising, &c., amounts to 1*l.*

Patents of Addition 30*l.*, with same additional charges above 1,000 words, the amount of next annuity to be added.

## BRITISH GUIANA.

Date of Law.—Ordinance No. 13 of 1861.

**Patents for Inventions** are granted for 14 years, provided the invention is new within the colony and not previously published there. However, where a foreign patent already exists on the same invention the colonial patent will expire therewith; or if there are more than one such existing foreign patent, with the first which expires. A valid patent cannot be obtained if a foreign patent on the same invention has already expired.

**Who may Apply.**—The “true and first” inventor which, as in Great Britain, is interpreted to mean the true and first person to cause knowledge of the invention to come into the colony.

**Mode of Application** follows in its nature the proceedings formerly in vogue in Great Britain under the Act of 1852 but now abandoned. The petition (Form 69) must be accompanied by an affidavit of inventorship (Form 70), both these documents being signed by the applicant, and certified, for instance, by a British Consul. Either a provisional or complete specification (Form 71) must accompany the petition, the latter specification being also certified. The petition and specification are referred to the Attorney-General for report; and the Letters Patent must be applied for within three months of the

delivery of his report, and will issue in due course, but may not, except in certain special cases, be delayed for more than 12 months from the date of petition. If not previously done, the complete specification (certified) must be filed within six months of the delivery of the Letters Patent. The Letters Patent must be also registered within 10 days of grant at the Registrar's Office in Demerara and Essequibo. Among the Government fees are examination of provisional, 25 dols.; notice to proceed, 25 dols.; stamp duty thereon, 5 dols.; seating, 20 dols.; recording patent, 5 dols.; complete specification, 15 dols. The patent dates from the filing of the petition.

**Renewal Fees.**—Before end of seventh year 100 dols., which must be stamped on the original Letters Patent or duplicate thereof.

**Working.**—There is no official requirement as to working the invention in the colony. Importation does not invalidate the patent.

**Prolongation.**—The Governor, on proper proceedings commenced at least six months before expiry of patent (Sect. 23), may, if so advised, grant extension for a further period not exceeding seven years. Stamp duties, 150 dols.

**Amendments** may be made by way of disclaimer, provided they do not enlarge the scope of the patent.

**Registration, &c.**—A Register of Patents is kept containing specifications and all information. An inspection fee of 48 cents is charged. Copies at the rate of 25 cents per page, drawings by agreement. There are no printed copies of specifications.

**Infringement** is subject to usual remedies by way of injunction or claim for damages as in Great Britain. The cost of provisional patent in British Guiana is usually about 30%. Full patent 70%.

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## BRITISH HONDURAS.

**Date of Law.**—26 Vict., cap. 11, 10th September, 1862.

**Patents for Inventions** are granted for 14 years. They expire with any previously granted foreign patent, and cannot validly be taken after such foreign patent has expired. The invention must be new "within the colony."

**Who may Apply.**—The true and first inventor or importer. **Application** is substantially the same as for British

Guiana, except that the forms are slightly altered and the Letters Patent must issue within six months of the date of petition. Only the power (Form 26) and affidavit, or declaration (Form 72) need be signed by the inventor and legalised. The fees are—on petition 4 rls.; notice to proceed 2 rls.; filing specification 4 rls.; sealing 30 dols.; Attorney-General 10 dols.

**Renewal Fees.**—Before third year 52 dols., before seventh year 103 dols.

**Working.**—There is no legal requirement as to working the invention nor is importation forbidden.

**Infringement.**—Remedy is afforded as in Great Britain.

**Extension** may, in meritorious cases, be had for a further period not exceeding 14 years.

**Registers** of patents and of proprietors are kept in the Colonial Secretary's Office. Inspection fee 2 rls.; copies 2 rls. per 90 words. No printed copies.

The cost of patent in Honduras is about 55*l*.

## CANADA.

**Date of Law.**—The Patent Act, Rev. Statutes, 1886, cap. 61; as amended by 55–56 Vict., cap. 24 (1892).

**Patentable Inventions.**—Any invention, such as is usually considered patentable, may be patented in Canada, provided it was not known or used by others before the date of invention and has not been in use or on sale with the allowance of the inventor for more than one year previous to the application for patent in Canada. Up to 9th May, 1892, no person was entitled to a Canadian patent if a patent for the same invention had been in existence for more than 12 months in any other country; but under the amending Act of 1892 it may be considered questionable if this is now the case since the section was amended to read “Any inventor who elects to obtain a patent for his invention in a foreign country before obtaining a patent for the same invention in Canada, may obtain a patent in Canada, if the same be applied for within one year from the date of the issue of the first foreign patent for each invention.” As this permission would appear to be necessary solely to avoid the effect of public knowledge in the meantime, it appears likely that so long as the invention remains undisclosed in Canada

the patent may still be taken after the expiration of the 12 months referred to. Nevertheless, pending any judicial decision on the subject, inventors may be advised to apply within the 12 months.

“Under any circumstances, if a foreign patent exists, the Canadian patent shall expire at the earliest date on which any foreign patent for the same invention expires.”

**Patents; Duration.**—Patents granted prior to 9th July, 1892, were granted for 5, 10, or 15 years. Fees 20, 40, and 60 dols. Patents usually taken for the shortest term of 5 years are extended to 10 years and thence to 15 years on payment of fees of 20 dollars for each extension.

Patents granted since 9th July, 1892, are for terms of 6, 12, or 18 years respectively, fees and extensions (for six year periods) remaining the same.

Patents lapse with previously granted foreign patents.

**Who may Apply.**—The actual inventor or his assigns, or in case of death, any person to whom the inventor has bequeathed the right, or in default of such, the legal representatives of the deceased inventor.

**Mode of Application.**—The papers necessary for application are: (a) a petition stating the name and title of the invention, and stating a place of domicile in Canada (Form 55), signed by the applicant. (b) A power of attorney to the patent agent (Form 56), signed by the applicant before a witness. (c) A specification in duplicate, each copy being signed by the *inventor* (Form 58) before two witnesses. (d) An oath (Form 57), legalised in the proper way, by the *inventor*. (e) Where the applicant is an assignee of the inventor the assignment with a copy must also be forwarded for record; and (c) and (d) must be signed by the *inventor*, not by the applicant, unless the inventor is dead. Drawings may be signed by the attorney, but the other papers referred to cannot be signed by him. The Commissioner of Patents may require the applicant to furnish a model or samples of ingredients; the model must be less than twelve inches in any direction, and show properly every part of the invention claimed and its mode of working.

The Commissioner may refuse a patent, if the invention does not appear patentable or novel, or is already in the possession of the public through a printed publication or otherwise, or has been patented before in Canada or elsewhere, unless it is doubtful whether the patentee or the applicant was actually the first inventor. Applicant may file an answer

to any objection, and in event of refusal may appeal to the Governor in Council within six months of the date of the decision. Every application must be completed and perfected within two years of the filing of the petition.

Where conflicting applications are made arbitration is employed to ascertain the rights of the parties. Each party chooses an arbitrator and the Commissioner chooses a third. The parties pay the fees each of their own arbitrator, or by agreement.

**Renewal Fees.**—There are no renewal fees other than the fees for extension of 5 (6) or 10 (12) year patents to 10 (12) or 15 (18) years, for each 5 (6) years of extension 20 dols. is the Government fee. A special request for certificate of extension is to be forwarded, *together with the original Letters Patent*. No shorter extension than 5 (6) years can be obtained.

**Working.**—The patent rights cease if the invention is not worked in Canada within two years of the date of the patent, or such further time as the patentee may by petition obtain, and is thenceforth continuously worked in Canada, “in such a manner that any person desiring to use it may obtain it, or cause it to be made for him at a reasonable price at some manufactory or establishment for making or constructing it in Canada.”

**Importation.**—After twelve months have elapsed from the date of the patent the patentee, assignee, &c., may not import the invention under penalty of forfeiture so far as his personal interests in the patent are concerned. ‘Twelve months’ extension of this term may be granted on cause shown.

**Validity of the Patent.**—A patent is void if any material fact in the petition or declaration is untrue, or if the specification and drawings contain more or less than is necessary for purpose of misleading; but, contrary to English law, if the omission or addition was an involuntary error the Court *may* in any suit give effect to the patent so far as it is sustainable.

**Infringement** may be restrained by injunction, and damages may be recovered.

**Disclaimer and Re-issue.**—Provision is made for amendment of a specification by disclaimer of such parts as are not tenable; a copy of the disclaimer is attached to the Letters Patent. The disclaimer, in special form, signed by the patentee before two witnesses, must be forwarded in duplicate with the original Letters Patent and a fee of 2 dols. Where, however, the errors are such that disclaimer alone would be insufficient

to amend them, the patent can be *re-issued*; for instance, if the specification is defective or inoperative from insufficient description. The original patent is surrendered by writing under seal on the patent, and returned to the Patent Office with a new petition for re-issue, oath in support, specifications with drawings, and fee of 4 dols.

**Caveats** may be filed where the invention is not complete, and may be held somewhat analogous to provisional specifications, though drawings should be added. They are evidence of inventorship and operate for one year, to cause the inventor to receive notice of any similar application by another person, so that he may take steps to claim his prior rights by making his application for patent if so disposed. The fee is 5 dols. The caveat must be supported by a declaration of inventorship properly legalised.

**Assignments and Licenses** must be registered at the Patent Office in Canada (fee 2 dols.), including those between joint applicants for patents. An assignment is null and void against any subsequent assignment if the latter is registered first. Copies must be forwarded with the assignments, the latter being returned after record.

**Publications.**—Specifications are not at present printed for sale separately, but written copies can be had, expense varying with length and drawings.

**Marking Patented Goods.**—Every patentee must mark the goods with the word "Patent" followed by the year of the grant, as "Patent, 1892," under penalty of fine not exceeding 100 dols., or in default two months' imprisonment.

Persons other than the patentee or authorised by him marking goods with any such indication are liable to fine not exceeding 200 dols., or three months' imprisonment, or to both.

The cost of patent, including tax for six years, is about 15%.

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## CAPE OF GOOD HOPE.

(Including British Bechuanaland.)

Date of Law.—Act No. 17 of 1860.

**Patents for Inventions** are granted for 14 years for "inventions" considered to be such "under the British Act of 1852," that is to say, new within the realm, and probably meaning new within the colony of Good Hope. Where a prior



patent exists in "parts out of the Cape of Good Hope" the patent will lapse therewith, or with the first to expire if there be more than one. Patent cannot be validly obtained after expiry of any such foreign patent.

**Who may Apply.**—The true and first inventor, which term, under the meaning assigned to invention, would include the first "importer" of the knowledge of the invention into the colony.

**Mode of Application.**—The applicant must appoint an attorney (Form 26), to deposit a complete specification (see Form 94) at the Office of the Colonial Secretary, and in due time to give notice at the office of the Attorney-General that the application is to be proceeded with. The Attorney-General then issues a somewhat lengthy notice of appointment of a date for hearing, which the applicant is required to publish in certain newspapers as notice for opposition. At the hearing opponents, if any, who have entered opposition will be heard, or the Attorney-General may call in expert evidence (very rare) at the applicant's expense, and generally decide the question of whether a warrant for grant of patent shall issue. Upon issue of warrant, same must be deposited within three months at the Colonial Secretary's Office for issue of patent, provided that the latter must issue within six months of the date of filing the specification, which date the patent will bear. In case of accidental delay patent may be sealed within seven months; in case of death of applicant patent may be sealed to heirs within three months of death, notwithstanding expiration of the six months statutory term. Among the fees are depositing specification 2*l.* 10*s.*, Attorney-General's "Appointment" 2*l.* 4*s.* 6*d.*, Letters Patent 2*l.* 10*s.*

**Renewal Fees.**—Before expiration of the third year 10*l.*, seventh year 20*l.*

**Working.**—There are no legal conditions as to working the invention in the colony. Importation is not forbidden.

**Amendments** may be made by way of disclaimer, provided the scope of the patent is not extended.

**Infringement** is subject to the same remedies as in Great Britain.

**Extensions and Confirmation.**—Petitions for extension must be filed at least six months before expiry of patent, the Governor may refer the petition to Commissioners to advise as to term to which the patent may be further extended. In like manner if a patent be found legally invalid the Governor may on petition confirm the patent so that it may be upheld.

**Registers and Indexes** are kept and open to inspection (1s.). Copies may be had at the rate of 1s. per 72 words; there are at present no printed copies of patents. Assignments and licenses should be registered. Filing fee, 10s. Certificate of registration, 10s.

The cost of Cape patent is usually 25% to 35% (see page 250).

## CEYLON.

**Date of Law.**—Ordinance No. 16 of 1892, taking effect from 1st July, 1893.

This new law is precisely on the same lines as the Indian Act of 1888 (see India), with the exception that "the inventor of a new manufacture or two or more persons, some or one of whom only are or is the true and first inventors or inventor of a new manufacture, may petition the Governor for leave to file a specification thereof," and the fees and taxes charged by Government are of precisely the same amount and payable in the same order as under the Indian law. The working of patent is not compulsory. When applicant resides out of Ceylon all documents may be signed by agent under power of attorney (Form 26). The official referee's fee is R. 52.50 in every case.

The cost of patent is usually 25% to 30%.

## CHILI.

**Date of Law.**—9th September, 1840, amended 25th July, 1872.

**Patents for Invention**, that is to say, for novel arts, manufactures, machines or instruments, preparation of materials or any improvement thereof, may be had for a term not exceeding 10 years, and for the whole or part of the Republic. Novelty is not defined by the Act, but it is presumed that the invention should not have been previously published anywhere since the section allowing patents to the introducers of arts known elsewhere, but still unknown in Chili, was repealed in 1872.

**Who may Apply.**—The Act mentions only the "author or inventor."

**Mode of Application.**—Petition to the Minister of Interior must be accompanied by a full description with drawings,

samples or models, as the case may require, so that same may be referred to a commission of experts empowered to examine the novelty of the invention and sworn to secrecy and faithful judgment. A specification signed by the members of the commission, with a fee of 50 dols., must be entered in the National Museum, and receipt therefor obtained and presented before the patent will be issued. Arbitration shall decide claims of rival inventors. Form 20 legalised by Chilean Consul is sufficient to enable agent to apply for patent.

**Renewal Fees.**—There are none.

**Working.**—The Government may decide upon a term within which the invention must be worked, such term being mentioned in each patent. After that the working must not be abandoned at any time for longer than a year.

**Infringement** is punishable by fine of 100 dols. to 1,000 dols., and confiscation of infringing articles, the value of which is divided between the Government and the patentee, who has also civil action for damages.

**Assignments** must be registered and reasonable assurance given of the genuineness of the assignment.

**Registration and Publication.**—A register of patents is kept at the Ministry of Interior, but the specification deposited at the National Museum is kept under seal until the patent has expired.

The cost of patent in Chili is usually 70%.

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## COLUMBIA (BRITISH).

(See Canada, of which Dominion above forms a part.)

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## UNITED STATES OF COLUMBIA.

(Formerly Granadian Confederation.)

Date of Law.—No. 35, May 13th, 1869.

**Patents** are granted for any term, not less than 5 nor more than 20 years, at the option of the applicant, but expire with any prior foreign patent. New mechanical contrivances, combinations of materials, and processes useful to industry, arts,

or sciences, are considered patentable. If an invention has already been patented abroad, the patentee can hold a valid Columbian patent, provided the invention has not been already introduced into public use. Such patent expires with the foreign patent.

**Who may Apply.**—The inventor only, Columbian or foreign.

**Mode of Application.**—Power of attorney, Form 20, must be signed before Columbian Consul. The petition must be accompanied by a clear description of the invention, and if the patent is granted, drawings or models or samples must be furnished within 40 days or the patent will not issue. 10 dols. is payable on application, and is not refunded if the patent is refused; from 5 dols. to 10 dols. for each year of the term must be paid at the time of receiving the patent, the aforesaid 10 dols. being counted in part payment. No examination is made, but the application is open for opposition 30 days before grant.

**Renewal Fees.**—There are none, nor is extension obtainable.

**Working.**—If the invention is not practised for a whole year the patent will be void, unless special circumstances prevent the use.

The cost of patent for 5 years is usually 50l., 20 years 65l. to 80l.

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### CONGO FREE STATE.

**Date of Law.**—29th October, 1886; decree, 30th October, 1886.

**Patents** are granted in all respects as in Belgium, except that there are no renewal fees or legal obligation to work the invention within any stated time.

A Government tax of 100 francs is charged on each patent of invention or patent of importation. There is no tax on a patent of addition.

**Powers of Attorney** (Form 14) must be legalised by the Belgian Consul.

The cost of patent in the Congo Free State is usually 25l.

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## COSTA RICA.

The power of granting patents is confined to Congress by Article XX of the Constitution. Patents of invention must therefore be solicited from the Constitutional Congress.

## DENMARK.

Law.—13th April, 1894; entering into force 1st July, 1894.

**Patents** are granted for 15 years from their issue date, but having priority from date of filing application. They are independent of the life of prior foreign Patents, but cannot be validly obtained if the invention has been published in a generally accessible print (presumably anywhere), or used in Denmark. Patents of Addition are granted during the life of the Head Patent and expire therewith. Inventions for production of articles of food are not patentable.

**Who may Apply.**—Inventor or his assignee (proof of assignment being necessary).

**Mode of Application.**—Foreigners must appoint a resident attorney (Form 23, no legalizing required). Duplicate Danish Specifications and Drawings prepared as for Germany; fee 20 crowns. Examination as to novelty is made, and, if satisfactory, application is published; any person may lodge objection during the next two months, while the Patent Commission may also continue their examination. After expiration of the two months and within a further two months the Patent Commission will decide on the application. In case of refusal, applicant may apply within six weeks for reconsideration, and, if unsuccessful, may appeal within four weeks to a Special Commission, fee 100 crowns, returnable if successful. Issue fee on Patent 10 crowns; first year's fee 25 crowns.

**Renewal Fees.**—Payable yearly, 2nd and 3rd years, 25 crowns; 4th, 5th, and 6th years, 50 crowns; 7th, 8th, and 9th years, 100 crowns; 10th, 11th, and 12th years, 280 crowns; 13th, 14th, and 15th years, 300 crowns. For extension of three months, add  $\frac{1}{8}$ th of the renewal fee.

**Working.**—Within three years of issue of Patent, and thereafter yearly. The Patent Commission may, by favour, extend these times for good reasons.

**Infringement** punishable by damages, confiscation to patentee of infringing articles and, if knowingly committed, fine not exceeding 2,000 crowns, or on repetition 4,000 crowns. These are not recoverable unless action brought within three

years of the commission of the offence, and within one year of its coming to the knowledge of the patentee. Importation by others of articles, &c., made by a process patented in Denmark is an infringement.

The cost of Danish Patent is usually 7*l.* to 18*l.* (see page 250).

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### ECUADOR.

The law of 18th October, 1880, follows substantially that of 1858 in Bolivia, except that the Commission's Report is referred to Congress for approval, and foreigners must subscribe a declaration of submission to the laws of the country in all matters that may arise in respect of the patent and renounce all right to diplomatic intervention.

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### EGYPT.

Patents may be registered in the Courts at Cairo. It is advisable also to register at Alexandria and Mansourah. A certified copy of the patent is required, and a legalized power (Form 26 suitably varied), both certified by the Foreign Office of the Country or origin.

The cost varies and may be stated at about 30*l.*

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### FIJI.

Under Ordinance No. 3 of 1879 patents are granted for 14 years to the inventor, his heirs, administrators or assigns. A petition accompanied by specification in duplicate and declaration is referred to the Attorney General who may give a certificate of protection. Within two months notice must be given, and advertised in the "Royal Gazette" and another Fijian newspaper. Three months are allowed for opposition, and a further three months for sealing. Government Fees, 5*l.* 5*s.* on petition, 3*l.* 3*s.* on certificate, 10*l.* 10*s.* on patent, 5*s.* on registration of patent. Applicant should sign Form 26. There are no renewal fees or "working" conditions.

The cost of Fijian patent is usually 45*l.*

## FINLAND.

(Part of Russia, but not covered by the Russian patent.)

Date of Law.—Decree of 30th March, 1876.

**Patents** are granted for new inventions or improvements in manufacture or art, but not for medicines or inventions contrary to law or morality. The duration of the patent may be from 3 years to 12, according to the importance of the discovery. Patents lapse with prior foreign patents.

**Applicant.**—None but the inventor may apply for the patent.

**Application.**—A petition to the Finance Department of the Senate of Finland, with specification especially setting forth the novelties and stating if a foreign patent has been obtained thereon, and in such event, a certified copy is desired. Foreign residents must appoint an agent resident in Finland; the power (Form 14 may be used) should be legalised by Russian Consul. The specification, if not filed at the time of petition, must be sent in within 30 days. After examination and approval the patent will issue, and the whole specification and patent must be published by the applicant *in extenso* in the official Swedish and Finnish newspapers three times.

**Renewal Fees.**—None.

**Working** must be performed within two years in the country, and not be abandoned for more than one year at a time.

**Infringement** is punishable by fine, of which half goes to the patentee and half to the poor box in addition to damages.

The cost of Finnish patent varies according to the length of the specification, as the advertising constitutes a large item; with 1,000 words in the specification it will cost about 50*l.*, adding 2*l.* for each 100 words over 1,000.

## FRANCE.

Date of Law.—The law governing patents is dated 5th July, 1844, and as amended by the law of 31st May, 1856, in some minor particulars relating to the forfeiture of patent rights is now in force. A supplementary Act passed 23rd May, 1868, provides for the protection of inventions shown at exhibitions. The International Convention of 1883, to

which France is a party, has also the force of law, and where its provisions are contrary to the existing law appears to override the latter.

**Patentable Inventions** must be either the invention of new industrial products or the invention of new means or the new appliance of means already known for obtaining an industrial result or product.<sup>1</sup> Pharmaceutical compounds or remedies and financial plans and schemes are specially declared not patentable;<sup>2</sup> bare principles, &c., and inventions having no "industrial results," are also not patentable. An invention is not considered "new" if sufficient publicity has been given to the invention, either in France or abroad, to enable the invention to be worked, before the date of application for the French patent.

**Patents.**—The duration of a patent shall be 5, 10, or 15 years, as the applicant may elect; but inasmuch as the initial cost is the same and the yearly fees the same whatever the term of the patent, the patent for 15 years is invariably asked for. The term of a patent cannot be extended except by Act of Parliament.<sup>3</sup> The term commences from the date of the deposit of the documents constituting the application for the patent.<sup>4</sup>

**Foreign Patents.**—A patent may be obtained in France for an invention or discovery already patented (*breveté*) in any other country, but the duration of the French patent cannot exceed that of the previous foreign patent.<sup>5</sup> It will be noticed that the patent granted in this case is subject to exactly the same conditions as other patents so that it may be void for want of novelty. Thus, where a patent has been received in a foreign country in which the grant of patent is accompanied or preceded by a publication of the specification, no valid French patent can be had.<sup>6</sup> This has been confirmed in respect of a previous English patent,<sup>7</sup> and also of an United States patent<sup>8</sup> and of a German patent, the publication consisting in the placing of the specification on view for opposition.<sup>9</sup> There have been

<sup>1</sup> Art. 2.

<sup>2</sup> Art. 3.

<sup>3</sup> Art. 15.

<sup>4</sup> Art. 8.

<sup>5</sup> Art. 29.

<sup>6</sup> Paris, 1st August, 1861, Gougy, *Pataille*, 63, 263.

<sup>7</sup> Rej. 7th July, 1860, Lister, *Pataille*, 61, 41.

<sup>8</sup> Paris, 20th May, 1857, Journaux Leblond, *Pataille*, 59, 103.

<sup>9</sup> Rej. 9th March, Seltsam, *Pataille*, 83, 11.



qualifying decisions tending to show that the publication must have been an effective one, *i.e.*, actually known, but in view of above direct decisions on the point little reliance should be placed on the latter. The foreign publication must be a *sufficient* one to enable the invention to be worked. Foreign patent specifications are, of course, considered to be sufficient publications in this respect.

A valid French patent can, therefore, only be taken so long as, when previous foreign patents exist, no publication of the invention has been made by or under them, but the existence itself of a foreign patent is sufficient to make the duration of the French patent dependent thereon.

An uncompleted English provisional protection at a time when these were published has been held to be a "patent" in this connection.<sup>1</sup> This, however, was when the grant of Letters Patent preceded the filing of a complete specification in Great Britain; it is doubtful whether it would apply now under the procedure of the English Act of 1883. The determination of the date at which the foreign patent should be said to have been taken is to be determined by the French Court on their information of the respective foreign law,<sup>2</sup> and is determined to be the date of the term of the patent, although full patent rights may not have been obtained at that date.

The French patent falls with the previous foreign patent, from whatever cause the latter may cease to exist.<sup>3</sup> The right to obtain the French patent is personal to the patentee of the foreign patent or his legal personal representatives; the fact of a previous foreign patent existing need not be stated by the applicant for the French patent.<sup>4</sup>

**The Applicant** should be the "author of the invention, as by Art. 1" a new discovery or invention in any department of industry confers on its author under the conditions and for the periods hereinafter fixed the exclusive right of working the said discovery or invention for his own benefit. Art. 30 declares a patent to be void in certain cases, but the fact of the applicant not being the inventor is not amongst the grounds given; it is probable, therefore, that a patent applied for by an assignee will not be revoked. It is the opinion of French lawyers that an assignee may have a valid patent granted

<sup>1</sup> Paris 30th May, 1879. Rej. 28th June, 1881, Paterson, *Pataille*, 21, 209.

<sup>2</sup> Rej. 29th November, 1864, Bossi. *Gaz. Trib.*, 30th November, 1864.

<sup>3</sup> Cass., 14th January, Rebours (2), *Pataille*, 63, 81.

<sup>4</sup> Brunfaut *v.* Soc. Denain. Rej. 1860.

him.<sup>1</sup> Heirs may apply when the inventor is dead.<sup>2</sup> A limited company or corporation having a recognised civil status or legal separate existence may be considered an inventor.<sup>3</sup> A workman employed to carry out an invention cannot apply.<sup>4</sup>

**The Application.**—By Articles 5, 6, and 7 to constitute an application for patent there must be deposited in a sealed packet at the Office of the Secretary of the Prefecture of the Department in which the applicant (or his attorney) is domiciled, (a) an application for patent limited to a single principal object with the details constituting it and the application or purposes thereof, giving a title which shall be a precise summary or designation of the object of the invention, and mentioning the term (usually 15 years) of the patent desired; (b) a specification (in duplicate) in the French language without alterations or erasures, and drawings in ink or samples, also in duplicate, any suitable size and material, preferably tracing cloth being used for the drawings, and all measures and weights indicated, being according to the metric scale; (c) a list of the documents deposited; and (d) where the applicant proceeds through an agent (as he must do if absent from the country), a power of attorney in French, Form 14, signed by the applicant, which need not be legalised. In the latter case this is the only paper that the applicant need sign in person.

The documents will not be received unless the receipt for the payment of the first year's tax, 100 fr., is produced.<sup>5</sup>

A receipt for the sealed packet is given on request and payment of the stamp duty of 25 centimes.<sup>6</sup>

The patent is issued about four months after application, but the term of the patent commences from the day on which the application was filed.

**Examination.**—There is no examination as to novelty or patentability or as to the right of the applicant, nor is the Government empowered to refuse the application for patent for any cause except in event of the formalities of the application not being observed, or if more than one invention is sought to be protected by one patent. When a patent is refused in this manner half the government fee is returned to the applicant,

<sup>1</sup> V. Renouard, No. 83.

<sup>2</sup> Picard and Olin, No. 27.

<sup>3</sup> V. Renouard, No. 86.

<sup>4</sup> Huard and Pelletier, page 247.

<sup>5</sup> Art. 7.

<sup>6</sup> Art. 7 (3).

but the latter is at liberty to renew his application within three months from the date of the notice of rejection without forfeit of fee.<sup>1</sup> By Art. 11 patents applied for in due form shall be granted without previous examination at the applicant's own risk and without guarantee as to either the novelty or merit of the invention or the accuracy of the description. There is no way of amending a French patent after grant.

**Renewal Fees.**—The duration of the patent is dependent on the payment in due time of an annual fee of 100 fr. due and payable in each year before the anniversary of the date of application for the patent. If the last day for payment falls on a Sunday or public holiday payment must be made not later than the day previous. No extension of time can be had for the payment of renewal fees. It has been held that the payment is legally effective if made at any time on the day of anniversary of the date of the application,<sup>2</sup> but it is preferable<sup>3</sup> that the payment be made before the same hour on which the application was filed (the time of day being always noted on the filing receipt). A tax paid late will be received, but will only operate to keep up the patent if the applicants prove that by *force majeure* he was prevented from paying the tax in time. Sickness or insanity of patentee is no excuse.<sup>4</sup> Where an applicant had forwarded money to his resident agent to pay an annuity, and by reason of the absence of the agent the annuity was not paid in time, the patent was held not to have lapsed,<sup>5</sup> it being held that the intention of the law is to penalise only the negligence or bad faith of the patentee.<sup>6</sup>

**Working.**—The patent will lapse if the invention be not worked in France within two years of the date of the signature of the patent (found at the foot of the patent), or if it has ceased to be worked for two consecutive years unless in either case the patentee shows good cause for not so working it.<sup>7</sup>

It is necessary that the working should be real, and not simply formal, the object being that the invention should be commercially introduced or placed in such a form that it is capable of being commercially used.<sup>8</sup> It is sufficient if the patentee manufactures and puts on sale, whether an actual sale

<sup>1</sup> Art. 12.

<sup>2</sup> Cass., *Vimont v. Sykes et Collier*, 10th January, 1863.

<sup>3</sup> Cass., *Blondel et Cie. v. Antrailles*, 1st September, 1855.

<sup>4</sup> Cass., *Wild v. Parent and Schaken*, 16th March, 1864.

<sup>5</sup> Trib. Sanit., *Claude Michaud*, 1st July, 1854.

<sup>6</sup> Eug. Pouillet, page 473.

<sup>7</sup> Art. 32.

<sup>8</sup> Eug. Pouillet, page 492.

has been effected or not, provided the patentee has used his best endeavours to introduce his invention into commerce.<sup>1</sup> It is not necessary to take into consideration the duration of the patentee's efforts to introduce his invention.<sup>2</sup> As the law only requires the invention to be put into operation, in the question of a machine it is sufficient for the inventor to have worked same himself without selling or delivering machines to the public, it being presumed that the public obtain a benefit in the placing on sale of the products of the machine.<sup>3</sup> A public exhibition or experiment of the invention by or before parties having a possible interest in adopting the same has been held sufficient.<sup>4</sup> Placing a machine on view in a public exhibition, coupled with the sale of a single machine, was held sufficient.<sup>5</sup>

On the contrary, a single isolated act of manufacture has been held not sufficient;<sup>6</sup> nor is working proved by *procès verbaux* (certificates of a notary) drawn up every two years at the request of the inventor when the fact of manufacture was contradicted by the defective state and impractical installation of the machines.<sup>7</sup>

As to partial carrying out of the invention, it has generally been held that where a patent covers more than one process or modification it is not essential to work more than one.<sup>8</sup> Also where a patent of addition or improvement has been taken it is not necessary to work more than the latter only,<sup>9</sup> but not if the patent of addition is for a substantially distinct invention.<sup>10</sup> A patentee, however, having omitted to "work" a certain distinct part of his patent, in this case a particular tool, was held to have forfeited his patent right in that particular part only.<sup>11</sup> But where a patent for distilling apparatus claimed to be applicable to the treatment of various different matters (beet-root, wine, &c.) it was held unnecessary to work the machine in relation to all the matters mentioned in the patent.<sup>12</sup>

If the invention as "worked" be different from that as

<sup>1</sup> Trib. civ. Seine, 23rd July, 1846, *re* Porret.

<sup>2</sup> Trib. civ. Seine, 26th December, 1859, Thomas and Laurers.

<sup>3</sup> Colmar, 7th December, 1864, Klotz, *Pataille*, 65, 215.

<sup>4</sup> Paris, 10th August, 1876, Alexis, *Pataille*, 79, 133.

<sup>5</sup> Paris, 11th May, 1836. Rej. 13th June, 1837, Griollet.

<sup>6</sup> Paris, 23rd March, 1870, Wilcox, *Sirey*, 70, 248.

<sup>7</sup> Douai, 20th July, 1859, Lister, *Pataille*, 61, 44.

<sup>8</sup> Rej., 30th March, 1860, Lotz, *Dall.*, 61, 5, 48.

<sup>9</sup> Paris, 9th February, 1865, Poitevin, *Pataille*, 65, 190.

<sup>10</sup> Paris, 5th July, 1884, Fernand Martin, *Pataille*, 85, 289.

<sup>11</sup> Paris, 13th May, 1865, Chapellier, *Pataille*, 66, 88.

<sup>12</sup> Grenoble, 19th June, 1857, Villard (2), *Pataille*, 57, 448.

patented the question of the legal validity of the working will depend on whether the differences are essential or non-essential.

It is to be noted that the "working" is to be done in France, and that it may be done by a representative of the patentee or, presumably, by licensees; but in case of infringement the "working" of the patent by the infringer is not to be accounted a legal working.

From the above it will be seen that no fixed rule can be laid down as to what is a sufficient working to satisfy the law.

Patentees who have not been able to get their inventions taken up within the two years must be guided more or less by the commercial nature and value of their invention as to whether they shall have actual working performed, and to what extent, or whether they shall attempt to get working done by others so that if their attempts prove unsuccessful they may be able to prove justification for absence of actual working and so save their patent under the latter part of Art. 32.

What will be accepted as a sufficient justification may be best understood from actual cases which have occurred. Nevertheless, in applying these cases to the invention under consideration it must not be forgotten that decided cases have not such force with the Courts in France, or indeed anywhere in Europe, as they have in Great Britain. A French judge in no way considers himself bound to follow a precedent, cases are decided on their merits entirely.

Amongst accepted excuses for absence of working are the following:—Want of capital, natural result of the commercial crisis in France in 1848;<sup>1</sup> want of capital, especially when the invention concerns a small class (such as railways) who may desire to obstruct the patent so that it may lapse;<sup>2</sup> want of working due to the obstructive action of a infringer who afterwards sues the repeal of the patent;<sup>3</sup> want of means, coupled with the fact that the commercial working is restrained by State monopoly (telegraphic apparatus).<sup>4</sup>

Where a patent cannot be worked without infringement of a previous existing patent of other parties it has been held that the working of the second patent stands excused until the first patent has lapsed.<sup>5</sup> But it would appear that it is uncertain

<sup>1</sup> Paris, 30th March, 1855, Frezou and Meissonnier, *Pataille*, 55, 110.

<sup>2</sup> Rej. 23rd November, 1859, de Costa, *Soi*, 61, 1, 179.

<sup>3</sup> Amiens, 16th March, 1882, Abriany (1), *Pataille*, 83, 182.

<sup>4</sup> Amiens, 29th May, 1884, Mimault, *Pataille*, 85, 324.

<sup>5</sup> Cass., 6th March, 1858, Grassal, *Date*, 58, 1, 342.

whether this is so or not, if it be shown that the second patentee has taken no steps to obtain the permission of the previous patentee.<sup>1</sup>

It is difficult to apply any rule for patentees not residing in France, but the following may be suggested:—That where a patent concerns simple articles of commerce which may be made for sale without special machinery, that a number be made and placed on sale and proof of the facts obtained; where the invention, however, concerns manufacturing processes or requires special and costly machinery to produce it, that circulars be addressed to leading manufacturers in France, the more the better, offering licenses, same being *bonâ fide*, and that advertisements be inserted to the same effect in likely papers. These may have useful commercial result, but if not they may be shown as proof that the patentee has done all in his power to introduce the invention. The extent of the working or attempts should be somewhat commensurate with the value of the invention. Sworn proofs are advisable for the protection of the patentee in possible future suits. Absolute certainty cannot, of course, be assured by anything less than a full commercial working, but the above suggestions embody the opinions of the leading French patent agents and jurists.

**Validity of Patent** is destroyed under Art. 30 (a) if the invention was not new; (b) if same was not patentable under Art. 3 (medicines and financial schemes); (c) if same was for a bare principle, &c.; (d) if contrary to public order, safety, or morals; (e) if the title given fraudulently indicates any but the real object of the invention; (f) if the specification, &c., is not sufficient for the working of the invention or does not completely and fairly indicate the real means employed by the inventor; (g) if the patent was obtained contrary to Art. 18, by which, if any person files a patent application for an improvement on a previous patent during the first year of the term of the latter, except the said previous patentee himself or those entitled through him, the application is to be kept sealed up until the year has expired, and then be patented only if the previous patentee or a person entitled through him has not in the meantime made an application for patent for the like improvement, in which case the previous patentee would obtain the preference.

**Introduction of the Patented Article** from abroad by the patentee is forbidden (except so far as is allowed by the

<sup>1</sup> Douai, 20th July, 1859, Lister, *Pataille*, 61, 44.

Convention to citizens of the contracting States) under penalty of forfeiture of the patent.

The object being that French labour should be employed the bare fact of introduction of patented articles into France is not sufficient in itself to avoid the patent. Thus articles may be brought into France to be repaired or improved and again exported,<sup>1</sup> or may pass through France to their destination in other countries,<sup>2</sup> or may be brought in as patterns or samples not for actual use or sale.<sup>3</sup> The prohibition does not extend to articles necessary to be used in carrying out a patented process.<sup>4</sup> The patentee is not responsible for the introduction by others without his knowledge or consent.<sup>5</sup>

**Infringement** is punishable by fine of from 100 to 200 fr.,<sup>6</sup> enforceable by the Public Prosecutor at the public expense at the instance of the patentee,<sup>7</sup> but not of a licensee.<sup>8</sup> The fines are not cumulative.<sup>9</sup> A repetition of the offence, within 5 years of a condemnation, is punishable with imprisonment, from 1 to 6 months. The patentee may also bring an action for damages, and demand the confiscation of infringing articles, even when the defendant is acquitted.<sup>10</sup> Both actions are barred if no steps be taken within 3 years of the commission of the offence, or the last of such offences.<sup>11</sup> The applicant for an order of confiscation may be ordered to give security for costs, and if a foreigner, such security is obligatory.<sup>12</sup>

An infringer may successfully demur on the ground of nullity or forfeiture of the patent, or in connection with the ownership of the patent.<sup>13</sup>

**Scope of Patent.**—The French patent system gives a large scope to the patent independent of the wording of the specification; a patent for a product covers same even if made by different means to those specified.<sup>14</sup> The product need not be

<sup>1</sup> Paris, 12th June, 1870, *Hayemaine v. Voisin and Loncel*.

<sup>2</sup> Havre, 26th March, 1880, *Larmanjet v. Huet et autres*.

<sup>3</sup> Douai, 11th July, 1846, *Warlech v. Pecquet de Beurepaire*.

<sup>4</sup> Douai, 11th July, 1846, *Warlech v. Pecquet de Beurepaire*.

<sup>5</sup> Semie, 24th April, 1855, *Goodyear v. Aubert and Girard*.

<sup>6</sup> Art. 40.

<sup>7</sup> Art. 45.

<sup>8</sup> Cass., 27th April, 1869.

<sup>9</sup> Art. 42.

<sup>10</sup> Art. 49.

<sup>11</sup> Crim. Code, Art. 638.

<sup>12</sup> Art. 47.

<sup>13</sup> Art. 46.

<sup>14</sup> *Demar v. Montaguac*, C. Paris, 1856.

identical.<sup>1</sup> The question if the essential character of the product is reproduced decides.<sup>2</sup> A patent for a process is infringed by similar process giving same results but by different means.<sup>3</sup> In a chemical process there is infringement if the same substance is produced by analogous means;<sup>4</sup> and the substitution for producing a result of one chemical substance for another, even if not analogous is an infringement.<sup>5</sup> But where the product is old and the patent claims only use of certain substances to produce it, there is no infringement by use of a chemical equivalent of one of those substances, or other essential difference.<sup>6</sup> Unessential differences in a machine do not destroy character of infringement.<sup>7</sup> Fundamental analogy is proof of infringement.<sup>8</sup> Also reproduction of same principle by different means,<sup>9</sup> even where other essential differences are present.<sup>10</sup> A combination of known elements with a definite purpose is infringed where the same principle or purpose of that combination is obtained.<sup>11</sup> Reproduction of an essential part of the patented invention is an infringement.<sup>12</sup> A machine designed to make a new fabric may not be used without infringement for making a known material.<sup>13</sup> The making of known machine parts is an infringement, if same are intended to be put together to infringe a patented combination.<sup>14</sup> Where a combination is patented, use of one element thereof may be an infringement if used with same object.<sup>15</sup>

An infringing machine may be different, but must show the characteristics of the patented machine.<sup>16</sup> The combination of

<sup>1</sup> *Marchall v. Ch. de d'Orleans*, Cass., 1855.

<sup>2</sup> *Fournier v. Piet*, Tr. Seine, 1829.

<sup>3</sup> *Favier v. Massieux*, Tr. Seine, 1863; *Lawrence v. Ploncard*, C. Paris, 1878.

<sup>4</sup> *Dutertre Fr. v. divers*, C. Paris, 1859.

<sup>5</sup> *Renard v. Gerber Keller*, Tr. Seine, 1862.

<sup>6</sup> *Brossette v. Depron*, C. Paris, 1860; *Dhaisne v. Sarrebouse d'Audeville*, C. Paris, 1875.

<sup>7</sup> *Gache v. Gerin*, C. Lyon, 1856; *Delamelle v. Descoubert*, Cass., 1873.

<sup>8</sup> *Daubet v. Montagnat*, C. Lyon, 1859; *Mrs. Carret et autres*, C. Paris, 1873.

<sup>9</sup> *Porret-Blanchard v. Nicolo et autres*, Tr. Seine, 1846; *Meunier v. Senac*, Cass., 1878.

<sup>10</sup> *Brunfaut Fr. v. Ohagot et Cie.*, C. Paris, 1862.

<sup>11</sup> *Redier v. Redus*, C. Paris, 1862.

<sup>12</sup> *Godard, Desmaretz v. de l'Isle*, Cass., 1864; also Cass., 24th March, 1875.

<sup>13</sup> *Gevre v. Auclair*, C. Lyon, 1860.

<sup>14</sup> *Motte v. Lawrence et Cotel*, Cass., 1855.

<sup>15</sup> *Danois v. Balin*, Cass., 1879.

<sup>16</sup> *Boulogne v. Delamotte et Failli*, Cass., 1872.



the same elements is not an infringement where the form and arrangement are different.<sup>1</sup> A patent for means for producing a product is not infringed by use of other means for producing an identical product.<sup>2</sup> Those who knowingly receive, sell, or expose for sale, or introduce infringing articles are subject to the same penalties as infringers.<sup>3</sup> A purchaser with knowledge of infringement is an accomplice.<sup>4</sup> As to objects simply passing through France it has been held that they are not within the terms of Art. 41,<sup>5</sup> but there are other decisions to the contrary.<sup>6</sup> An action for damages will lie whether the infringement be knowingly committed or not.<sup>7</sup>

**Revocation.**—Actions of annulment or forfeiture may be brought by any person interested.<sup>8</sup> The Public Procurator may intervene,<sup>9</sup> and in such case all registered owners of the patent shall be cited.<sup>10</sup> The annulment of a patent renders it void *ab initio*. An action for damages may be brought by the patentee against a losing plaintiff in a suit of revocation.

**Patents of Addition** are granted to the holders of an original patent for any improvements, modifications, or alterations they may desire to make in their original inventions. Patents of addition lapse with the head patent, they are subject to no renewal fees, and their working is in effect covered by the working of the invention which is necessary to keep up the patent (*see Working*). The same documents are required as for a principal patent; except that usually no new power of attorney is necessary. The tax is 20 fr.

If a head patent is declared void for any cause the patent of addition falls with it,<sup>11</sup> even though the latter might have constituted a valid patent by itself.<sup>12</sup> Patents of addition have been upheld for extending the application of the head invention.<sup>13</sup> They may be validly held either for changes, improvements, or additions to the head invention.<sup>14</sup>

<sup>1</sup> Jeautet-David v. Raphanel, C. Besancon, 1870.

<sup>2</sup> Caly-Cazalet v. Soc. Acieries, Cass., 1869.

<sup>3</sup> Art. 41.

<sup>4</sup> Vachon v. Baroche, C. Dijon, 1851.

<sup>5</sup> Lepee v. Bolireller, Trib. Civ. Seine, 1860.

<sup>6</sup> Debain v. Fab. Musique, Trib. Corr. Seine, 1861.

<sup>7</sup> Guerineau, Aubry v. Dupuis, Trib. Civ. Seine, 1860.

<sup>8</sup> Art. 34.

<sup>9</sup> Art. 37.

<sup>10</sup> Art. 38.

<sup>11</sup> Art. 16.

<sup>12</sup> Raab and Cie. v. Neuvezel, C. Lyon, 1865.

<sup>13</sup> Lemaire-Daime v. Canonilli, Cass., 1867.

<sup>14</sup> Agnelle Fr. v. Murray, Makintosh et autres, C. Paris, 1870.

There is reserved to the principal patentee a priority of right to patent improvements on his patented invention during the first year.<sup>1</sup> This year dates from the day of signature of the patent.<sup>2</sup> The Courts are competent to decide as to whether such a priority can be sustained, *i.e.*, if the novelty is in truth an improvement on the original invention.<sup>3</sup> It would appear that a previous disclosure of the improvement before taking the patent of addition has no adverse effect thereon provided it did not occur before taking the principal patent.<sup>4</sup>

**Publications.**—A list of patents granted is published weekly in the "Bulletin Officiel"; there is no list of patents applied for. Separate printed copies of the specifications of patents are not published, but manuscript copies can be had on payment of cost at the Ministry of Agriculture and Commerce. The specifications of those patents on which the fee for the second year has been paid are printed and published in volumes. The original specifications are deposited at the Conservatoire des Arts et Metiers after the patents have expired.

**Marking Patented Articles.**—The law requires all articles made under patent to be marked "Breveté sans Garantie du Gouvernement," but in practice this is reduced to "Breveté S. G. D. G."

**Assignments and Licenses.**—To render an assignment valid the law requires (*a*) that it shall be made by notarial act, (*b*) that before it is made the taxes for the remainder of the term of the patent shall be paid up in full, (*c*) that the assignment shall be registered at the Secretary of the Prefecture of the Department in which it is made.

In respect of patentees resident out of France it has always been usual, though possibly it may not be essential, to operate the assignment by means of power of attorney on French soil. Thus the patentee and the proposed assignee give power to A and B respectively to appear together before a notary in France, there to effect the sale. It is necessary to produce the receipt for the remaining renewal fees on the patent. The assignment is afterwards registered. As the transfer itself must be by notarial act, the powers of attorney of the assignor and assignee must likewise be notarial, and properly legalised by the French Consul.

Where permissible the expense of transfer may be avoided

<sup>1</sup> Art. 18.

<sup>2</sup> *Clement v. Charbonnier*, Trib. Corr. d'Épernay, 1860.

<sup>3</sup> *Frezon v. Meissonnier*. Rej. 1855.

<sup>4</sup> *Storm v. Derival et autres*, C. Douai, 1864.

by foreigners by taking the patent in the name of the assignee instead of the inventor.

Recommendations have been made that to avoid expense of paying up the remainder of the renewal fees, an exclusive irrevocable license be given instead of an assignment. The idea is ingenious but not practicable, since it has been long ago decided that such a license is in truth an assignment.<sup>1</sup> Any *exclusive* license for a locality is a cession or assignment within the meaning of the Act.<sup>2</sup>

Ordinary *non-exclusive* licenses are not subject to above rules as to registration or payment of renewal fees. They may follow by simple agreement. Nevertheless they may be registered, if desired, without the previous payment of the renewal fees.<sup>3</sup>

The cost of obtaining a French patent may vary from 8*l.* to 20*l.* (see page 250).

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## GERMAN EMPIRE.

**Date of Law.**—The present law is dated 7th April, 1891, and came into force 1st October, 1891, in substitution for the previous Act of 1877, which in its main features it resembles very closely. Prior to 1877 there was no patent law for the whole of Germany, but separate patents could be had in Prussia, Saxony, Bavaria, Hanover, and Wurtemberg. An Act of 1st June, 1891, provides for the protection of "useful models."

**Kinds of Patents.**—Patents of Invention for 15 years, dating from the day next following the day of application; and Patents of Addition granted to the holders of Patents of Invention, for improvements in direct connection therewith, and expiring with the head patent if the latter is suffered to lapse. Nevertheless, if a Patent of Invention is revoked, the Patent of Addition does not necessarily fall with it, but becomes a principal patent, and can thenceforth be kept alive to the end of the term for which the head patent would have lived by payment of annuities; the *date* of payment being accounted from the date of the head patent, but the *amount* from the date

<sup>1</sup> *Re Pecquiriaux*. Rej. 8th March, 1852.

<sup>2</sup> *Re Carbonnier*, Trib. Corr. Rouen, 1866.

<sup>3</sup> Pouillet, "Traité des Br. d'Invention," page 271.

of application for the Patent of Addition.<sup>1</sup> Thus, if a patent be granted 1st January, 1893, an addition applied for 1st June, 1895, and the head patent revoked 1st December, 1898, an annuity becomes payable on the Patent of Addition before 1st January, 1899, and the amount is that of the fee for the fifth year. The Patent of Addition would expire 1st January, 1908.

“Useful models” are such inventions of a minor kind which have not required the exercise of that inventive talent which is necessary in Germany to uphold a Patent of Invention. Patents for useful models last six years.

**Patentable Invention.**—All new inventions which permit of industrial use are patentable unless incompatible with law or morality, and with the exception of articles of food, drinks, medicines, and chemical products, in so far as the invention does not relate to a distinct process for manufacturing such articles.<sup>2</sup> Nevertheless, it has been held that a patent for a process covers also the product when made by that process, and that importation of the product from abroad will be an infringement of the patent, if it can be proved to have been made by the patented process.<sup>3</sup> Principles are not patentable; but if a principle be known a patent may still be given for a particular mode of reducing the principle to practice.<sup>4</sup> It is no ground for refusal that the practical application of the principle is a matter of simplicity,<sup>5</sup> but no patent will be granted when the carrying out of the invention or solution of the problem is already within the ordinary capacity or skill in handicraft of a worker in the trade.<sup>6</sup> It is recognised that the problem which an inventor sets himself may be in itself new, and in such case there may be patentable invention even when the solution of the problem is easy.<sup>7</sup> A new combination,<sup>8</sup> or choice of new means,<sup>9</sup> for performing an old purpose, may be patentable. The patenting of one set of means for a purpose does not prevent patenting another set of means for the same purpose.<sup>10</sup> The use of known process or means for a new purpose is patentable if it brings

<sup>1</sup> Sect. 7 of Act of 1891.

<sup>2</sup> Sect. 1.

<sup>3</sup> Circular by Chancellor, *Gar.* VI, 23; R.G., 14th March, 1888, *Gar.* VI, 165.

<sup>4</sup> P.A., 15th April, 1880, *Gar.* II, 1.

<sup>5</sup> P.A., 15th November, 1888, *Gar.* VI, 2.

<sup>6</sup> R.G., 23rd October, 1880, *Gar.* II, 97.

<sup>7</sup> R.G., 15th May, 1889, *Gar.* VII, 4.

<sup>8</sup> R.G., 24th June, 1881, *Gar.* III, 26; Hartig P.B., 13, 1882.

<sup>9</sup> R.G., 5th April, 1881, *Gar.* II, 141.

<sup>10</sup> R.G., 4th May, 1889, *Gar.* VII, 17.

with it a new technical effect,<sup>1</sup> or if its use entails great difficulties which the inventor has overcome.<sup>2</sup> The same remarks apply to the use of elements of a combination.<sup>3</sup> The Patent Law requires that the invention shall be capable of industrial use,<sup>4</sup> but it is not necessary to prove actual use or commercial advantage, or that it attains its purpose, but only possibility of its use.<sup>5</sup>

**Novelty.**—The Patent Law states that an invention shall not be considered new if at the date of the application it has already been described in a public print *anywhere*, provided that the publication has occurred within the last century; or if it has been so publicly employed in the country that its use by other persons skilled in the art appears possible.<sup>6</sup> As to publication in print abroad, it should be observed that it is not necessary that it should have reached Germany, though it should be of such a nature that it can eventually come to the knowledge of the German public.<sup>7</sup> Foreign patent specifications must, from the nature of the subject, be considered sufficient,<sup>8</sup> and are equally bars to applications by the foreign patentees themselves;<sup>9</sup> but the mere exposure of specification for opposition is not a publication in the eye of the law, since the latter speaks of publications *in print* only.<sup>10</sup> The sending out of circulars to a small circle of people is not a publication,<sup>11</sup> nor the sending of drawings to a few persons in a private way;<sup>12</sup> but sending out full descriptive circulars broadcast is a publication.<sup>13</sup> As to the amount of publication, it must be sufficient to enable those who understand the art to work the invention without further invention,<sup>14</sup> but such information may be contained in a drawing alone.<sup>15</sup> Public use to defeat a patent must be sufficiently open that persons conversant with the art are able to operate the

<sup>1</sup> R.G., 11th March, 1889, *Gar.* VII, 47.

<sup>2</sup> R.G., 8th January, 1890, *Gar.* VII, 65.

<sup>3</sup> R.G., 22nd May, 1880, *Gar.* II, 40.

<sup>4</sup> Sect. 1.

<sup>5</sup> P.A., 30th September, 1880, *Gar.* II, 6.

<sup>6</sup> Sect. 2.

<sup>7</sup> P.A., 12th January, 1882, *Gar.* III, 138.

<sup>8</sup> R.G., 22nd May, 1880, *Gar.* II, 40.

<sup>9</sup> P.A., 15th April, 1880, *P. Bl.*, 43, 1880.

<sup>10</sup> R.G., 20th May, 1881, *Gar.* III, 90.

<sup>11</sup> P.A., 13th October, 1881, *Gar.* III, 99.

<sup>12</sup> P.A., 15th April, 1880, *Gar.* II, 1.

<sup>13</sup> P.A., 2nd November, 1882, *Gar.* IV, 21.

<sup>14</sup> R.G., 3rd July, 1880, *Gar.* II, 85.

<sup>15</sup> R.G., 5th April, 1881, *Gar.* II, 141.

invention.<sup>1</sup> If the knowledge is confined to a small circle of persons it is insufficient.<sup>2</sup> Trials and experiments for the production of a machine are not equivalent to public use,<sup>3</sup> but an exhibition of working before experts and interested persons may be.<sup>4</sup> Exhibition abroad is not a publication.<sup>5</sup> Under the Law of 1891 the Chancellor may, by a notice in the "Reichsanzeiger" (Gazette), declare that the officially-published specifications of those foreign States which grant reciprocity in this respect to Germany shall not be considered publications according to German law until three months have elapsed from the actual date of their public appearance. At present this provision has only been applied to Austria-Hungary, but there appears to be no reason why it should not be extended to the United States. Claim cannot be made, however, to the benefits of the section until the notice appears.

**Who may Apply.**—Whoever first applies for a patent is entitled to the grant,<sup>6</sup> but the patent will be void if it is shown that the invention was taken without permission from the papers or apparatus of another person.<sup>7</sup> It does not matter whether that other person is the inventor or not.<sup>8</sup> The writers on German Law generally recognise a right of application inherent in the inventor;<sup>9</sup> this right will pass to assignees or heirs of the inventor.<sup>10</sup> If an application is refused, abandoned, or not prosecuted, the priority of date is lost.<sup>11</sup>

**Mode of Application.**—Where the applicant does not reside in Germany, a resident agent must be appointed to represent the inventor and receive notices on his behalf as long as the patent remains in force. The power (Form 16), which need not be legalised, must accompany the application, and a duplicate specification of the invention in the German language with drawings, if any, these latter papers being signed by the resident agent.

The application is submitted to one of the four subdivisions of the Application Department of the Patent Office, where the

<sup>1</sup> R.G., 1st February, 1881, *Gar.* II, 235.

<sup>2</sup> R.G., 27th October, 1880, *Gar.* II, 151.

<sup>3</sup> P.A., 19th August, 1880, *P. Bl.*, 1831, 3.

<sup>4</sup> R.G., 23rd October, 1880, *Gar.* II, 97.

<sup>5</sup> P.A., 9th June, 1881, *Gar.* III, 130.

<sup>6</sup> Sect. 3.

<sup>7</sup> Sect. 10.

<sup>8</sup> R.G., 23rd October, 1880, *Gar.* II, 97.

<sup>9</sup> *Gareis. Kommentar.*

<sup>10</sup> Sect. 6.

<sup>11</sup> P.A., 13th October, 1881, *Gar.* III, 99.

novelty and patentability of the invention are examined. If informality is found, or if novelty or patentable subject matter is wanting, or if the invention is not sufficiently distinguished from prior patents or other published descriptions, a "*Vorbescheid*" (preliminary decision) calling attention to the defects and prior matter referred to, is forwarded to the applicant or his agent, requiring him to amend or answer within a stated time, usually two months. The time will be extended on request being filed to that effect. If no answer be returned to the Patent Office within the time, or extended time, allowed, the application shall be deemed to be withdrawn.<sup>1</sup> If answer is duly filed the Department will decide upon the application, or may issue further *Vorbescheide* until satisfied that the material is sufficient for judgment. When the application is brought into due form decision will issue; if in favour of the grant the papers will be laid open for opposition; if against the grant the applicant has one month to appeal to the Appeal Department (see 20 M.); this time cannot be extended, but where the appeal is entered, a further time may be had to file the argument by which the appeal is supported. The appeal is taken by one or other of the two divisions of the Appeal Department, whose members are distinct from those of the Application Department. The judgment of the Appeal Department is final in matters affecting applications for patents.

When the application is allowed and ready for publication the fact is notified to the applicant, and an advertisement is inserted in the "*Reichsanzeiger*." The invention acquires provisional protection, and is open for opposition for two months. Within this time the first year's tax, 30 M., must be paid. When the two months are expired the application is again examined and passed and an allowance sent to the inventor. The patent is next inserted in the Register and receives its distinctive number; and lastly, in about two to three months the document containing a printed copy of the specification and drawings is issued.

If opposition is filed, it must be supported by an argument, and copies are forwarded to the applicant or his agent, who will be invited to answer. Decision will be given by the Patent Office, and is subject to appeal as above. Witnesses may be heard and costs awarded.

Amendments in the application or specification can be made at any time up to the publication for opposition.

<sup>1</sup> Sect. 21.

The publication can also be delayed, on the request of applicant, for a period not exceeding six months, the Patent Office being not empowered to refuse less than three months' delay in such case.<sup>1</sup>

**Application for Useful Model** is not subject to examination as to novelty or patentability. Since the German Patent Office is very strict in requiring that the matter sought to be patented shall show exercise of inventive talent, and patents are refused if the invention differs only slightly from known constructions, or in such a way only that the differences made are held to be within the competence of those conversant with the art; applicants whose inventions do not present any distinctly novel principle may be well advised to file with the application for patent an application for model patent. If the former is refused they can then still obtain patent rights, though for the shorter term of six years. Form 17 and a second set of papers similar to those for application for patent are required. The applications should be simultaneous to avoid the consequences of either antedating the other.

**Renewal Fees.**—For the second year 50 M.; third year 100 M., and so on, adding 50 M. yearly. These taxes are due before the anniversary of the date of the patent, but may be paid within the ensuing six weeks without fine, or within a further six weeks on adding a fine of 10 M. Power is reserved to the Chancellor to reduce these fees under the new Act of 1891. This power is not exercised in individual cases. A patentee in necessitous circumstances, on proof of that fact, can be granted a respite for payment of the first and second years' taxes until the third year, being exempted from payment if the patent lapses in the third year.

The only renewal fee on a useful model patent is 60 M. before end of third year.

**Working.**—A patent can be revoked after the lapse of three years, counting from the day on which the patent is advertised as granted,<sup>2</sup> (a) if the patentee neglects to work his invention in the German empire to an adequate extent, or to do all that was required for securing the said working; (b) if the grant of licenses would be to the public interest, and the patentee refuses such license when suitable compensation and good security are offered.

<sup>1</sup> Sect. 23.

<sup>2</sup> Act of 1891, Sect. 11. For Patents before the Act the three years is computed in the same way under decision of the *Patentamt* of 23rd July, 1885, *Gar.* V, 210.



In respect of working; it has been held that the provision of the law is intended for the benefit of German trade and manufacturers generally; so that importation will not serve instead.<sup>1</sup> Even when articles are made in the country, but the majority sold there are imported, the working will not be held sufficient;<sup>2</sup> but it is open to the patentee to prove that the importation is without harm to the interests of home industries.<sup>3</sup> Thus, if it is the *use* of an invented matter (machine), rather than its manufacture which is of value to the trade, importation of the machine appears to be no ground for revocation of patent.<sup>4</sup> If the manufacture is not within the competence of German factories (a special kind of Bohemian glass reflector) the patentee was held justified in manufacturing solely abroad (Bohemia).<sup>5</sup> The grant of licenses is not necessarily a sufficient working,<sup>6</sup> though *genuine* offers of license which nobody has accepted may amount to a sufficient attempt to get the invention worked.<sup>7</sup> When working is done, it need not be identical with the patent so long as it contains the essentials of the patented invention.<sup>8</sup> Where a patent of addition has been filed, the invention added becomes one with the invention covered by the head patent,<sup>9</sup> consequently a working of the improvement covered by the patent of addition, which is presumed so far to supersede the head patent, will answer the requirements of the law without working the details of the head patent.<sup>10</sup> Useful models do not need to be worked.

**Scope and Effect of the Patent.**—The patent forbids others than the patentee or those authorised by him to employ the invention professionally, or in the way of commerce (*gewerbmässig*);<sup>11</sup> or to trade in or offer the invented matter for sale. Where a patent is granted for a process it extends to the direct products of the process.<sup>11</sup> A patent has no effect against any person who, at the date of application for the patent, has already employed the invention in Germany, or made the necessary arrangements for doing so;<sup>12</sup> such person

<sup>1</sup> P.A., 11th October, 1888, *Gar.* VI, 288.

<sup>2</sup> R.G., 8th June, 1889, *Gar.* VII, 232.

<sup>3</sup> R.G., 11th December, 1886, *Gar.* VI, 247.

<sup>4</sup> P.A., 15th May, 1884, *Gar.* V, 219.

<sup>5</sup> R.G., 11th May, 1889, *Gar.* VII, 258.

<sup>6</sup> P.A., 20th January, 1881, *Gar.* III, 200.

<sup>7</sup> P.A., 19th October, 1882, *Gar.* IV, 165.

<sup>8</sup> R.G., 12th November, 1883, *Gar.* IV, 193.

<sup>9</sup> R.G., 10th May, 1881, *Gar.* III, 213.

<sup>10</sup> P.A., 4th October, 1888, *Gar.* VI, 294.

<sup>11</sup> Sect. 4.

<sup>12</sup> Sect. 5.

may continue to use the invention in his own or other workshops according to the requirements of his business, and this exemption will pass with the respective business.<sup>1</sup> Patents also do not apply to vehicles or ships, other than German ships,<sup>2</sup> temporarily within jurisdiction.<sup>1</sup>

The Government may also appropriate inventions for use in the army or navy, or for the public welfare, but subject to compensation to the patentee; which, in event of dispute as to amount, will be settled by the Courts of Law.<sup>1</sup>

The logical basis of the German patent system, though it limits the number of patents which can be granted, makes those which are granted more valuable, as it gives to them a very extended scope. Recognising, as the Germans do, the principle or spirit of the invention as more important than any form of words, the Courts do not scruple to go beyond the logical wording of the claim, and consider the invention itself, as set forth in the specification, with a view of finding the general idea or meaning of the invention.<sup>3</sup> The Patent Office will not permit claims to be drawn for separate combinations within the whole invention, since the inventor is only required to point out and describe what is new and of his invention, and this must constitute an integral whole, or else there is more than one invention comprised in his demand and division will be necessary. Though the claims may thus appear narrow, it is for the Courts to give full effect to the invention, and the inquiry therefore usually turns, not on the claim, but on the meaning of the specification as a whole and the general conditions of the art at the time the invention was made.<sup>3</sup> It has been repeatedly held that where an invention consists in a combination of parts, it must be considered not according to the separate parts but according to the way they co-act, and the claim should consequently show the relative action of the parts rather than their construction.<sup>4</sup> A new combination to be patentable must rest on a new idea.<sup>5</sup>

**Annulment and Revocation.**—A patent may be annulled on any one of three grounds,<sup>6</sup> viz.: (a) that the invention was not patentable or not new, but under the new Act this ground

<sup>1</sup> Sect. 5.

<sup>2</sup> R.G., 20th October, 1887, *Gar.* VI, 205.

<sup>3</sup> R.G., 15th May, 1889, *Gar.* VII, 9.

<sup>4</sup> P.A., 25th November, 1880, *Gar.* III, 52; R.G., 24th June, 1881, *Gar.* III, 26.

<sup>5</sup> R.G., 4th May, 1889, *Gar.* VII, 41.

<sup>6</sup> Sect. 10.

will no longer be accepted after five years have elapsed since the grant of patent was published;<sup>1</sup> (b) that the invention had been patented to a prior applicant, a ground which remains always open and may be brought forward by any person; and (c) if the essential contents of the application were abstracted from the specification, process, &c., of another person, in which case annulment will only be given on petition of that person.<sup>2</sup> A patent may, however, be revoked, (a) if at the end of three years "working" has not been done as above said, or (b) if after the same time it appears conducive to the public interest that permission to use the invention be granted to others, and the patentee refuses to grant such permission on reasonable terms and good security.

Suits of revocation or annulment are brought, in the first instance, before the Annulment Department of the Patent Office. Appeal against decision of the Annulment Department lies to the Appeal Department, and thence, within six weeks, further appeal may be made to the *Reichsgericht* (Supreme Court) at Leipzig. Revocation or annulment can be pronounced in respect of a part of the patent.<sup>3</sup>

**Infringement**, knowingly committed, is punishable by fine up to 5,000 M., or imprisonment not exceeding one year, and the judgment may be advertised at the expense of the condemned party.<sup>4</sup> The patentee may also demand damages or a fine in lieu of damages not exceeding 10,000 M., and where the fine is ordered no further suit for damages can be brought.<sup>5</sup> A suit of infringement cannot be brought except in respect of acts occurred during the previous three years.<sup>6</sup>

**Improper Use of word Patent.**—Marking packages, articles, &c., with false indications leading to belief that they are protected under Patent Law; or use of such words or marks on any advertisement or otherwise is liable to a fine not exceeding 1,000 M.

**Publication of Specifications.**—These are printed separately and placed on sale shortly after the patent is allowed, at the price of 1 M. each. Applicants may order in advance within fourteen days of the allowance of patent not less than 20 copies at cost of  $\frac{1}{2}$  M. each, or may deposit a sum not less

<sup>1</sup> Sect. 27.

<sup>2</sup> P.A., 12th January, 1882, *Gar.* III, 138.

<sup>3</sup> Sect. 35.

<sup>4</sup> Sect. 36.

<sup>5</sup> Sect. 37.

<sup>6</sup> Sect. 38.

than 20 M., or a multiple thereof, and be supplied with all subsequent specifications appearing in that class at the rate of  $\frac{1}{2}$  M. apiece, until the deposit is exhausted.

**Assignments, &c.**—Any alteration made in the ownership or representative of owner of the patent must be recorded at the Patent Office and published in the "Reichsanzeiger." With the assignment, the new owner, if resident out of Germany, must give a new appointment of agent, so that the legal representation in Germany may not cease. Assignment should be in duplicate.

Cost of German patent is usually from 8*l.* to 20*l.* (see page 250).

Cost of German model patent is usually from 6*l.* to 18*l.* (see page 250).

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## GUATEMALA.

Date of Law.—21st May, 1886.

**Patents** are granted for inventions or improvements for terms varying from 5 to 15 years. The invention, if foreign, must not previously have been published in Guatemala. Where a previous foreign patent exists, the patent expires therewith, provided the maximum term of 15 years shall not be exceeded.

**Application for Patent** shall be accompanied by a clear description of the invention and within 40 days of the grant of the patent, full drawings, &c., shall be filed, together with samples, to be preserved as proofs in case of litigation. Patents are granted without examination, at the risk of the applicant. They are subject to an annual tax of from \$5 to \$50. Form 20, legalised by the Guatemalan Consul, is sufficient to enable an agent to make application for patent.

**Working.**—The invention must be put in practice within a year of the grant, and not abandoned at any time for longer than a year.

**Infringement** is a penal offence.

**Publication.**—Each application is published four times, and grant of patent twice, in the "Official Gazette." Specifications are only visible after lapsing of the patent.

**Grants in Favour of Enterprises**, either of money or by loan of buildings or land, remission of customs or other duties, and other exemptions, may be made in favour of applicants

who obtain concessions promising great advantage to the State.

The cost of application for patent is usually 80%.

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## HAWAII.

**Date of Law.**—Civil Code, Secs. 255, 256, Act of Aug. 29th, 1884.

**Patents** are granted for 10 years for inventions not previously known in the country, or described in any printed publication. Also for the unexpired term (not exceeding 10 years) of any previous foreign patent, provided the invention has not been in use for more than one year in Hawaii.

**Who may Apply.**—The inventor only.

**Application** (Form 66) is directed to the Minister of the Interior, and contains a petition, oath, description, and drawings; if for a composition of matter samples of ingredients must be added. Models to be furnished if asked for. The application is referred to the Commissioner of Patents for examination and report, and if in favour of the grant the patent is issued by the Minister of the Interior, a copy of the specification and drawings being attached to it.

**Caveats** operative for one year may be filed by any person desiring further time to mature an invention.

The government fees are:—On application for patent 5 dols; for examination 20 dols; issue 5 dols., each caveat 5 dols.

**Record** of patents and specifications is kept in the Office of the Interior Department.

The cost of application for Hawaiian patent is usually 15%.

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## HONG KONG.

**Date of Law.**—Ord. No. 2 of 1892, effective from 1st Apr., 1892.

**Kinds of Patent.**—Letters patent are granted for inventions already patented in Great Britain, but not otherwise. They expire with the British Patent.

**Applicant.**—The inventor, or assignee.

**Application.**—The petition, specification, and declaration signed by agent under power (Form 26) are filed at the Colonial Secretary's Office. Notice is given twice in the Hong Kong Govt. Gazette of the date on which the petition will be considered by the Executive Council and such other advertisement made as the Governor may direct.

**Renewal Fees.**—None.

**Working.**—There is no legal necessity to work the invention. The cost of Letters Patent is usually 30%.

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## HUNGARY.

Date of Law.—7th July, 1895. In force 1st Jan., 1896.

**Patents** for 15 years from date of application are granted for inventions other than articles of nourishment and chemical products. Inventions for war purposes are subject to refusal if opposed by the Minister of Commerce. The Law as to novelty is the same as in Germany. Patents of Addition can be had and prior right to an improvement on a patented invention is reserved to the patentee for one year from date of original application.

**Who may apply.**—The inventor or his successors (the latter having to exhibit proof of title).

**Mode of Application.**—Foreigners must appoint a local agent by legalized power (Form 19). The mode of application is subject to Ordinance of the Minister of Commerce, and is modelled on that prevailing in Germany (which see) except that no examination is made as to novelty. Fees on application 20 Kr. 1st year's tax 40 Kr.

**Renewal Fees** for 2nd year 50 Kr.; 3rd, 60 Kr.; 4th, 70 Kr.; 5th, 80 Kr.; 6th, 100 Kr.; 7th, 120 Kr.; 8th, 140 Kr.; 9th, 160 Kr.; 10th, 200 Kr.; 11th, 250 Kr.; 12th, 300 Kr.; 13th, 350 Kr.; 14th, 400 Kr.; and 15th, 500 Kr. Extension of time 30 days free; further 30 days, 20 Kr. (*see below*).

**Working.**—Within three years and should not be abandoned without justification (*see below*).

**Patents dated before 1896** are subject to the provisions of the old law as to taxes, working, etc. (*see Austria*).

The cost of Patent of invention or addition is usually 7% to 18%.

## INDIA.

**Date and Title of Law.**—The Inventions and Designs Act, 1888, in force from 1st July, 1888; Acts of 1859 and of 1883 repealed, saving past operation of, and rights, &c., acquired under these Acts.

**Patents** are validly granted only in respect of useful inventions possessing the character of novelty under the Act, but where the same invention has already been patented in any country other than the United Kingdom or India, a valid patent can only be had in any case if application is made in India within one year from the date of the acquisition of such foreign patent.

An invention is not considered new if it has already been known or published in India, or in the United Kingdom, with the following exceptions:—(a) Public use or knowledge obtained in fraud of the inventor and not acquiesced in by him, will not be considered to invalidate the patent if the application be made within six months of the commencement of such use; (b) public use by the inventor or his servant or agent, or by any person with his authority for not exceeding one year previous to application is permitted; (c) where the inventor has obtained a British patent, any previous use or publication in British India between the date of the application for the British patent and the application for like privileges in India will not be held to invalidate the Indian patent if the latter is applied for within one year from the date of the actual sealing of the British patent; (d) where an invention has been exhibited at an industrial or international exhibition certified as such by the Governor-General in Council it does not lose its character of patentable novelty thereby, if the application be made within six months of the date of admission into the exhibition. Patents in India expire with previously granted patents abroad.

**Who may Apply.**—The actual inventor, or his executors, administrators, or assignees. The term "inventor" does not include the importer into British India unless he is the actual inventor. Where two or more inventors apply on the same day each may obtain a privilege or patent; where the applications are made on different days the first to file the application is preferred.

**Application for Patent.**—The patent rights are obtained by the act of filing specifications of the invention after leave to do so has been obtained by petition to the Governor-General in Council. The application in proper form must be signed by the applicant or his agent duly appointed by legalised power of attorney (Form 26). "It must state the name, occupation, and address of the applicant, and where a patent has been obtained in the United Kingdom the date of this patent, and the date of the actual sealing thereof; and must describe with reasonable precision and detail the nature of the invention, and of the particular novelty whereof it consists, and be supplemented by such further particulars relating to the invention, and by such drawings or photographs illustrative thereof as the Governor-General in Council may see fit to require from the applicant." A model must be furnished if asked for. The Government fee on petition is R. 10.

The application may be referred to an expert for inquiries and report after deposit of a stated fee previously required of the applicant, but this is very unusual; or the Governor-General may make such further enquiry as he may think fit before granting leave to file the specification.

The specifications (at present seven copies are required, including one incorporated with the petition) (Government fee R. 30) must be filed within six months of the date of the order giving permission to file. Three months' extension may be had (Government fee R. 20). Upon the filing of the specifications, for which a receipt is given, the applicant obtains by law, without special deed being given, patent rights for 14 years counting from the day of filing the specification subject to the payment of renewal fees.

**Renewal Fees.**—Each year, before the expiration of the 4th, 5th, 6th, 7th, and 8th year, R. 50. Before the 9th, 10th, 11th, 12th, and 13th years, R. 100. Extension of time can be had for any of these payments, Government fees for one month, R. 10; two months, R. 25; three months, R. 50.

**Working.**—None.

**Publication.**—Registers are kept of all inventions patented and of the addresses, &c., of the patentees, assignees, &c., open to inspection; the specifications filed are also open to inspection (fee R. 1), but are not printed.

**Extension of Patents.**—Provision is made for extension of patent where the inventor has been inadequately remunerated. The petition must be filed not more than one year or less than six months before the expiration of the patent. The Governor-



General may refer the petition to the High Court. Extended patents are subject to renewal fees of R. 100 yearly, the limit of extension is 7 years, or in exceptional cases 14 years.

**Amendments** may be made to specifications filed, in an analogous manner to the practice in Great Britain. The Government tax on amendment is R. 20.

**Infringement.**—Invalidity of the patent cannot be set up in answer to a suit of infringement; if the patent is invalid, it can only be declared void on special application to the High Court, security for costs being given. If the patent is revoked on the ground of fraud the true inventor may receive a patent in lieu thereof, and the fraudulent patentee may be condemned to pay to the rightful inventor the whole or a portion of the profits, as determined by the Court, on consideration of the diligence of the true inventor and general merits of the case.

**Compulsory Licenses** may be granted, as in Great Britain, on petition to the Governor-General in Council.

The cost of Indian patent varies with the rate of exchange, at present it is usually 16% to 20%.

## ITALY.

**Date of Law.**—31st January, 1864, extending and amending the Sardinian Law of 30th October, 1859.

**Patents** are granted for inventions, as usually understood, other than medicines, provided the invention be new, or not formerly known in sufficient detail to enable it to be put in practice. As in France, publication abroad is held to invalidate a subsequent Italian patent;<sup>1</sup> but any publication made in pursuance of foreign Patent Laws is not a bar to obtaining a valid Italian patent, provided the latter be applied for during the currency of the foreign patent and before others have imported the invention or worked it in Italy.<sup>2</sup> Patents taken under this latter clause are called patents of importation, but a recent decision<sup>3</sup> of the Court of Appeal of Milan, in opposition to a prior decision<sup>4</sup> to the contrary effect, has affirmed that it is

<sup>1</sup> *Loc. Tel. Lombarde v. Soc. Tel. Zurich*, Turin Cass., 20th January, 1890.

<sup>2</sup> Art. 4.

<sup>3</sup> 26th March, 1890.

<sup>4</sup> 14th December, 1888.

immaterial whether the applicant asks for and receives a patent of importation or a patent of invention, the effect of each being exactly the same. Where the original patentee or his assignee make improvements and modifications in the patented invention, these may be protected by patents of addition, expiring with the original patent and not subject to renewal fees. Six months of priority are reserved to the original patentee at the beginning of the term of the patent for filing any patents of addition he may make within that time. If the invention is connected with beverages or eatables, patents will only be granted on advice of the Board of Health.

**Who may Apply.**—The law reserves the right to the author of the invention but it is customary to consider that an assignee may apply. Patents of addition can only be applied for by the grantees of the head patents to which they respectively refer.

**Application** must be accompanied by a specification in Italian or French, and drawings in triplicate, if any, a certified and legalised copy of the original foreign patent, if there is one, a certified and legalised power of attorney (Form 14 may be used), a receipt for the tax, and a memorandum of the documents deposited. The application must state the number of years (not above 15) for which the patent is desired. The papers must be upon officially-stamped paper, and, with exception of the Power, all may be signed by the agent. The tax varies with the duration of the patent applied for and is called the proportional tax. It amounts to 10 lire for each year of the patent. The first annuity (40 lire) is also payable at the time of application.

**Prolongation.**—A patent granted for any term less than the maximum may be prolonged for any further period up to the maximum, and this as often as necessary till the maximum is reached. The cost of prolongation is, however, an extra charge, to be added to the proportional tax for the extended period and the annuity then due at the time of applying for prolongation. No prolongation can be made unless applied for before the term originally expires. The original letters patent and the last certificate of prolongation must be produced.

**Annuities.**—Each patent, whatever its length of term, prolonged or otherwise, is subject to the following scale of annuities during its life, default in payment entailing forfeiture of the patent:—Each year for the first three years, 40 lire; 4th, 5th, and 6th years, 65 lire; 7th, 8th, and 9th years, 90 lire; 10th, 11th, and 12th years, 115 lire; and 13th, 14th, and 15th

years, 140 lire each year. The patent need not be produced for payment of annuities alone, but only if prolongation is sought. There are no annuities on patents of addition.

**Examination.**—Other than the report of the Board of Health on beverages, &c., mentioned before, there is no examination of patents before grant.

**Duration of Patents.**—The patent is operative against third parties from the day it is applied for; but its nominal term commences with the last day of March, June, September, or December next following the day on which it was applied for. Its maximum term is 15 years and minimum term one year. The minimum of prolongation is also one year. Prolongation of a patent includes patents of addition thereto. Where a prior foreign patent exists the Italian patent expires therewith, but if more than one prior foreign patent exists on the same invention it expires with that having the *longest* term, and not the shortest as is usual in such cases.

**Working.**—Where a patent is originally granted for five years or less, working must be performed within the first year and not interrupted for more than a year at a time. Where, however, the patent was originally granted for more than five years the working must be begun within two years and not interrupted for more than two years.

**Amendment** may only be made within the first six months of the term of the patent, and is effected by filing a specification of the amendment in triplicate, with drawings also if needed. A tax of 40 lire is charged thereon. A certificate of reduction is given, and is in the nature of a disclaimer; it is thus the converse of a patent of addition which latter may be had at any time.

**Assignments** must be registered at the Ministry, and published in the Official Gazette at the cost of the applicant. The assignment must be notarial. Art. 49 provides that in case of a partial assignment, the deed cannot be registered until the annuities due throughout the term of the patent have been all paid up.

**Infringement**, fraudulently committed, is subject to fine not exceeding 500 lire, and in a civil action to damages and confiscation of infringing objects, tools, &c.

**Publication.**—No person is allowed to inspect the specifications and drawings filed until three months have elapsed from the delivery of the patent. Copies may then be taken. Extracts of registers must, however, be on stamped paper and in pursuance of stamped request. Quarterly lists of patents granted, and