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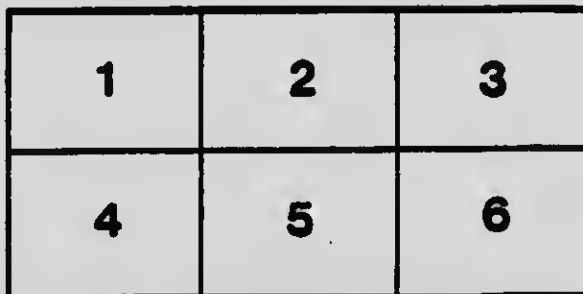
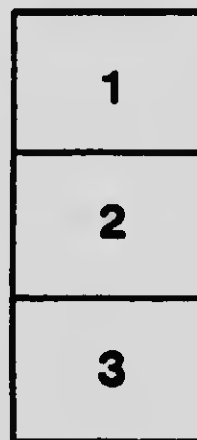
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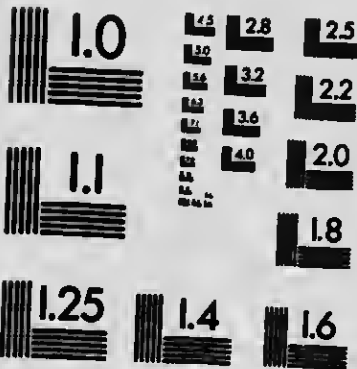
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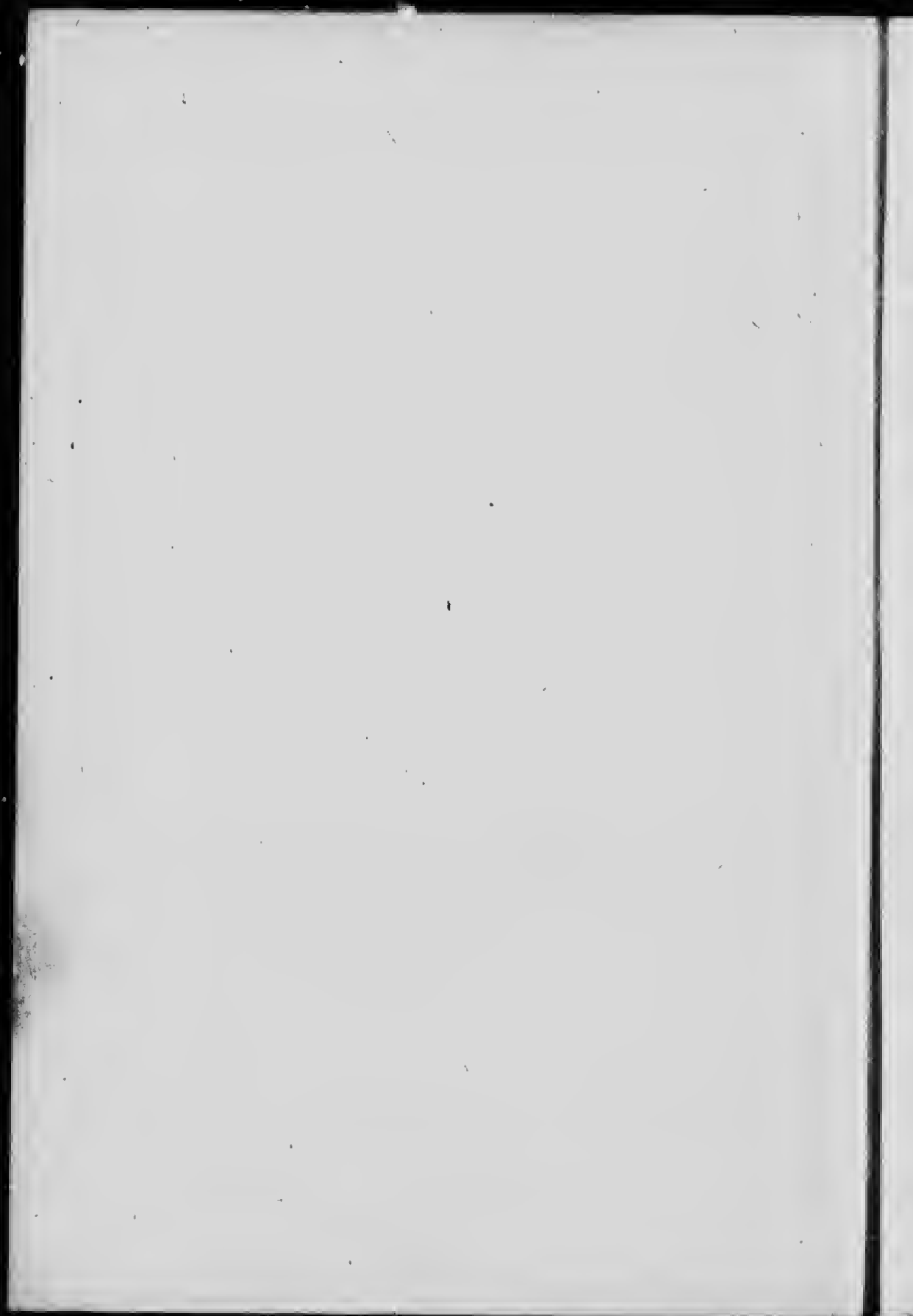
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CANADIAN PATENT LAW AND PRACTICE

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APPENDIX

ON

CANADIAN PATENT OFFICE PRACTICE

BY

W. J. LYNCH, I.S.O.
CHIEF OF CANADIAN PATENT OFFICE

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TABLE OF CONTENTS.

	PAGE
LIST OF ABBREVIATIONS	vii
TABLE OF CASES.....	ix to xxxii

CHAPTER I.

LEGISLATION.....	1-6
------------------	-----

CHAPTER II.

SUBJECT MATTER—Invention and discovery—Application of new principle—New application of old principle—Combinations—Mechanical skill—Evidence of invention—Classification of inventions—Art—Machine—Manufacture—Composition of matter—Business systems—Patent medicines — Improvements — The inventor — Master and servant—Joint inventors—Importer.....	6-29
--	------

CHAPTER III.

NOVELTY—Applicant must be first inventor anywhere — Anticipation — Unsuccessful experiments—Prior knowledge at any time may defeat patent—cf. United States principles— — Invention perfectly conceived probably anticipates— Evidence to prove prior knowledge.....	30-49
--	-------

CHAPTER IV.

UTILITY—English definition—Meaning of useful in Canada—Useful for what?—Misleading statements as to utility—inventions having illicit objects—inoperative inventions.....	50-54
---	-------

CHAPTER V.

ABANDONMENT—PUBLIC USE OR SALE—Actual or constructive dedication—Conduct from which inferred—General rule anything not claimed presumed abandoned — Exceptions—Abandonment by withdrawal or failure to prosecute application — Public use or on sale — Consent or allowance of inventor—Surreptitious use..	55-66
---	-------

CHAPTER VI.

	PAGE
EFFECT OF FOREIGN PATENTS ON RIGHTS IN CANADA, SECTION 8—History—Effect of Section . . .	67-71

CHAPTER VII.

APPLICATION FOR PATENT—Formal requirements—Petition—Power of Attorney—Oath—Inventor dead—Title or name—Specification—Claims—Sufficiency of specification—Purpose of claims—Construction—Drawings—Models—Examination—Amendments—Withdrawal of application—Conflicting or interfering applications—Arbitration Board—Evidence—Division of application	72-90
---	-------

CHAPTER VIII.

REFUSAL TO GRANT PATENT—Practice of Patent Office—Appeal from Commissioner to Exchequer Court—Grounds of objection	91-97
--	-------

CHAPTER IX.

REISSUE AND DISCLAIMER—Reissue—Statute similar to American—Effect of word "deemed"—Meaning of "same invention"—Effect of delay—Broadened reissues—Procedure—Disclaimer—Must not change character of invention—Procedure	98-112
---	--------

CHAPTER X.

DEVOLUTION, ASSIGNMENT AND LICENSE—Right to patent where inventor dead—Joint ownership—Assignment defined—Registration necessary—Effect of notice of prior equities—Agreement to assign—Effect of notice of previous licenses—Mortgage—Warranty—Assignments of improvements—License distinguished from assignment—Licenses—General, limited and exclusive—Implied license—Right to repair—Employer and employee	113-130
---	---------

TABLE OF CONTENTS.

v

CHAPTER XI.

	PAGE
CONDITIONS AS TO WORKING AND IMPORTATION— COMPELSORY LICENSES—History of sections— Patentee must manufacture—Power v. Griffin— Invention must be wholly manufactured in Can- ada—Must sell without restrictions—Extension of restrictions to third parties—Reasonable price—Importation—Earlier cases probably bad law—Ingredients or parts—Extensions—Com- pulsory Licenses.....	131-157

CHAPTER XII.

CAVEATS.....	158-160
--------------	---------

CHAPTER XIII.

ARTICLES MADE OR USED PRIOR TO THE ISSUING OF A PATENT.....	161-162
--	---------

CHAPTER XIV.

MARKING PATENTED ARTICLES.....	163-165
--------------------------------	---------

CHAPTER XV.

INFRINGEMENT — Statute — Question of law and fact—Substance of invention must be taken— Class of invention—Application of new prin- ciple—Proctor v. Bennis—New application of old principle—Curtis v. Platt—Colourable in- fringement—Doctrine of equivalents—Alteration of combinations—Effect of not marking—What constitutes infringement—Contributory infringe- ment—Repair—Rights of Crown.....	166-190
---	---------

CHAPTER XVI.

ACTION TO RESTRAIN THREATS OF LEGAL PROCEED- INGS.....	191-192
---	---------

CHAPTER XVII.

IMPEACHMENT—Jurisdiction—Causes for—Procedure in Exchequer Court—Security— <i>Scire facias</i>	193-202
---	---------

CHAPTER XVIII.

	PAGE
PRACTICE IN INFRINGEMENT CASES—Jurisdiction— Venue—Particulars of breaches—Interlocutory injunctions — Balance of convenience — Disco- very — Inspection — Jury — Onus of proof—Ex- perts — Defences — Final injunction — Onus of committal or attachment—Sequestration—Dam- ages or account—Delivery up or destruction— Delay in bringing action—Costs.....	203-235

CHAPTER XIX.

BILLS OR NOTES GIVEN FOR PATENT RIGHTS	236-238
--	---------

CHAPTER XX.

FOREIGN PATENT LAW—International Convention— Date of publication in Canada—United States— Great Britain—Short digest of laws in other countries—When foreign applications must be filed—Provisional protection—Patents of addi- tion—Marking patented articles.....	239-248
EXCHEQUER COURT FORMS	249-269
FORMS FOR PATENT CONVEYANCING	270-301
THE PATENT ACT.....	302-326
RULES OF CANADIAN PATENT OFFICE.....	327-334

APPENDIX.

CANADIAN PATENT OFFICE PRACTICE, BY W. J. LYNCH, I.S.O.....	335-448
FORMS OF CANADIAN PATENT OFFICE.....	404-432
INDEX	449-478

LIST OF ABBREVIATIONS (CANADIAN).

() A.C.		} Law Reports, Appeal Cases.
App. Cas.		
A.L.R.		Alberta Law Reports.
B.C.R.		British Columbia Reports.
Ch. Ch.		Grant's Chancery Chambers Reports.
C.L.J.		Canada Law Journal.
C.L.T.		Canadian Law Times, Occasional Notes.
C.P.		Upper Canada Common Pleas Reports.
E. & A.		Error and Appeal Reports, Ont.
E.L.R.		Eastern Law Reports.
Ex. C.R.		} Exchequer Court of Canada Reports.
E.C.R.		
Gr.		Grant's Chancery Reports, Ont.
L.C.		Lower Canada Jurist.
L.C.L.J.		Lower Canada Law Journal.
L.C.R.		Lower Canada Reports.
L.N.		Legal News, Que.
L.R.P.C.		Law Reports, Privy Council.
Man. R.		Manitoba Reports.
M.L.R.Q.B.		Metropolitan Law Reports, Queen's Bench.
M.L.R.S.C.		Metropolitan Law Reports, Superior Court.
N.B. Eq.		New Brunswick Equity Reports.
N.B. Eq. Cas.		New Brunswick Equity Cases.
N.B.R.		New Brunswick Reports.
N.S.R.		Nova Scotia Reports.
N.W.T. Rep.		North-west Territories Reports.
O.A.R.		} Ontario Appeal Reports.
A.R.		
O.L.R.		Ontario Law Reports.
O.P.R.		} Ontario Practice Reports.
P.R.		
O.R.		Ontario Reports.
O.W.N.		Ontario Weekly Notes.
O.W.R.		Ontario Weekly Reporter.
Q.L.R.		Quebec Law Reports.
Q.P.R.		Quebec Practice Reports.
Q.R.K.B.		Quebec Official Reports, King's Bench.
Q.R.Q.B.		Quebec Official Reports, Queen's Bench.
Q.R.S.C.		Quebec Official Reports, Superior Court.
S.C.R.		Supreme Court of Canada.
S.L.R.		Saskatchewan Law Reports.
Tay.		Taylor's King's Bench Reports, Upper Canada.
Terr. L.R.		North-west Territories Law Reports.
U.C.C.P.		Upper Canada Common Pleas Reports.
U.C.L.J.		Upper Canada Law Journal.
U.C.Q.B.		Upper Canada Queen's Bench Reports.
W.L.R.		Western Law Reporter.

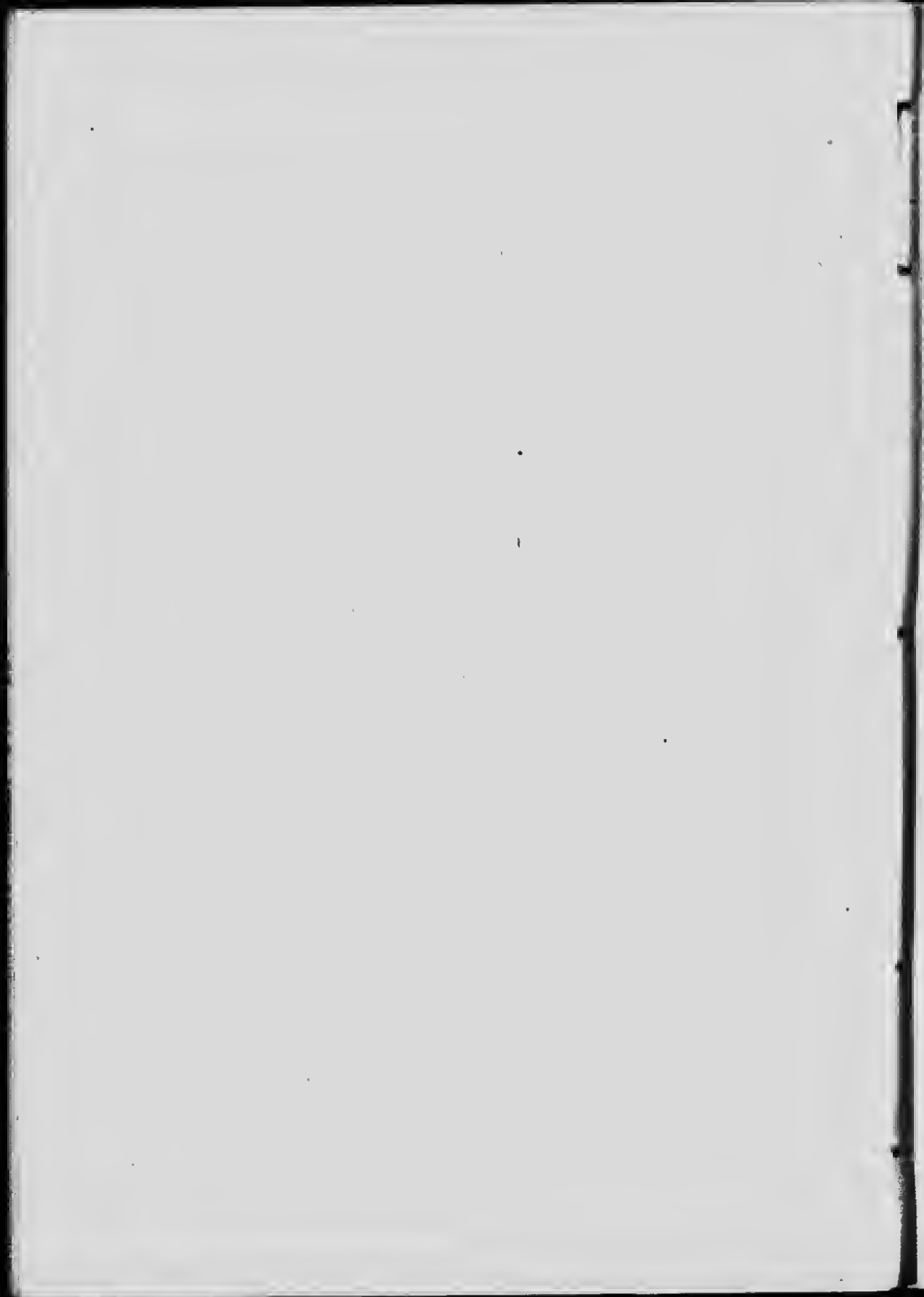


TABLE OF CASES.

	Page
Abell v. McPherson, (1870) 17 Grant 23; (1871) 18 Grant 437.....	12
Acetylene Illuminating Co. Ltd. v. United Alkali Co. Ltd. (1903) 20 R.P.C. 161; 22 R.P.C. 145.....	8, 10
Adair v. Young, (1879) L.R. 12 Ch.D. 13.....	189
Adam v. Folger, 120 Fed. 260; 56 C.C.A. 540.....	216
Adams v. Bell, (1850) 1 L.C.R. 136.....	2
Adams v. Burke, 84 U.S. 453.....	128
" v. Edwards, (1848) 1 Fish 1.....	37
African Gold Recovering Co. v. Sheba Gold Mining Co. (1897) 14 R.P.C. 660.....	124
Agawan Co. v. Jordan, (1868) 7 Wall 583.....	28, 116
Aitcheson v. Mann, (1883) 9 P.R. 253.....	204
Aktiebolaget Separator v. Dairy Outfit Co. (1897) 14 R.P.C. 473; 15 R.P.C. 327.....	178
Albany Steam Trap Co. v. Worthington, 79; F. 966.....	110
Alexander v. Henry, (1895) 12 R.P.C. 360.....	231
Allen v. Hunter, (1885) 6 McLean 303.....	159
Allen v. Rawson, (1845) 1 C.B. 551.....	28
Allen v. Reid, (1888) 14 Q.L.R. S.C. 126.....	17
Alliance Pure White Lead Syndicate Ltd. v. MacIvor's Patents (1891) 39 W.R. 487.....	219
Alsop's Patent (1907) 24 R.P.C. 733.....	52
Aluminium Co. v. Domeiere (1897) 15 R.P.C. 32.....	216, 234
American v. Helmstetter 142 Fed. 978; 74 C.C.A. 240.....	14, 16
American v. Wagner, 151 Fed. 576; 81 C.C.A. 120.....	45
American v. Weston, 59 Fed. 147; 8 C.C.A. 56.....	49
American v. Pennock, 164 U.S. 26; 41 L. Ed. 337; 17 S. Ct. 1.....	59
American Bell Telephone Co. v. Kitsell (1888) 35 F. 521.....	233
American Braided Wire Co. v. Thompson, (1888-90) 5 R.P.C. 113, 7 R.P.C. 47; 152.....	19, 228, 230, 231, 232
American Cotton Tie Co. v. Simmons, (1878) 106 U.S. 89; 3 Bann. & Ard. 320.....	128
American Dunlop Tire Co. v. Anderson Tire Co. (1896) 5 Ex. C.R. 194	175
American Dunlop v. Gould Bicycle Co. (1899) 6 Ex. C.R. 223.....	27, 175
American Stoker Co. v. General Engineering Company of Ontario Ltd. (1898) Q.R. 14, S.C. 479; 6 Ex. C.R. 328.....	18
Amory v. Brown, (1869) L.R. 8 Eq. 663.....	224

Anderson v. Leibig's Extract of Meat Co. (1882) 45 L.T. 757.....	192
Anderson v. Patent Oxonite Co. (1886) 3 R.P.C. 279.....	216
Anderson Tyre Company of Toronto v. American Dunlop Tyre Company (1896) 5 Ex. C.R. 82.....	147
Andrews v. Hovey, 124 U.S. 694.....	161
Ansonia v. Electrical, 144 U.S. 11.....	12, 17
Anti-Vibration Incandescent Lighting Co. v. Crossley, (1905) 22 R.P.C. 441.....	13, 15
Arnold v. Bradbury, (1871) 6 Ch. App. 706.....	81
Ashworth v. English Card Clothing Co. (1903) 20 R.P.C. 790; 21 R.P.C. 553.....	174, 221
Ashworth v. Law, (1890) 7 R.P.C. 231.....	124
Asbworth v. Roberts (1890) 45 Ch.D. 623.....	219
Aspinwall v. Gill, 32 Fed. 697.....	114
Atlantic Works v. Brady, (1882) 107 U.S. 192.....	16
Attorney-General v. Bate, (1883) 27 L.C.J. 153; 6 L.N. 227.....	86, 201
Auer Incandescent Light Mfg. Co. v. Dreschel & Melick, (1898) 6 Ex. C.R. 55; 5 E.C.R. 384; 28 S.C.R. 608.....	233
Auer Incandescent v. O'Brien, (1897) 5 Ex. C.R. 243.....	58, 101, 105, 142, 152, 173, 185, 209
Automatic Weighing Machine Company v. Combined Weighing Machine Co. (1889), 6 R.P.C. 367.....	177
Automatic Weighing Machine Co. v. Knight, (1889) 6 R.P.C. 297, 81, 179, 211	
Automatic Weighing Machine Co. v. Fearby, (1893) 10 R.P.C. 442.....	233
Bacon v. Spottiswoode, (1839) 1 Beav. 382.....	228
Badische Anilin Und Soda Fabrik v. Hickson, (1906) A.C. 419; 23 R.P.C. 433.....	189
Badische Anilin Und Soda Fabrik v. Isler, (1906) 1 Ch. 605, 126, 128, 143, 144	
Badische Anilin Und Soda Fabrik v. Levinstein, (1885) 2 R.P.C. 73 4 R.P.C. 462.....	14, 77, 179, 219, 238
Bailey v. Airey, (1905) 22 R.P.C. 461; 23 R.P.C. 277.....	174
Ball v. Crompton Corset Co., (1887) 9 O. R. 228; 12 O.A.R. 738; 13 S.C.R. 469.....	17
Ballard v. Pittsburg, 12 Fed. 784.....	56
Bank of Toronto v. Insurance Co. of N.A. (1897) 18 P.R. 27.....	298
Barber v. National, (1904) 129 Fed. 370.....	130
Barclay v. McAvity, (1894) 1 N.B. Eq. R. 1, 146.....	125
Baril v. Masterman, (1881) 4 L.N. 181.....	17
Barnet-McQueen v. Canadian Stewart, (1910) 13 Ex. C.R. 186.....	14, 31, 57, 60, 62, 63, 80, 82, 159, 168, 179, 182, 206
Barter v. Howland, (1878) 26 Grant 135.....	57
Barter v. Smith, (1876) 2 Ex.C.R. 455.....	139, 140, 147
Bartholomew v. Sawyer, (1859) 4 Blatch. 347.....	94
Bateman v. Gray, (1853) Macr. P.C. 93; 116; 22 L.J. Ex. 290.....	177
Bates v. Coe, 98 U.S. 31; 256 L.Ed. 68.....	61

Battin v. Taggart, 17 How. 74.....	58
Batley v. Kynock, (1874) L.R. 19 Eq. 90.....	220, 221
Beam v. Merner, (1886) 14 O.R. 412.....	120, 124
Beard v. Turner, (1866) 13 L.T.N.S. 746.....	234
Bell v. Daniels, (1858) 1 Fisher 372.....	51, 159
Bell v. Peoples Tel. 22 Fed. 309.....	39
Bell Telephone Case, (1885) 9 Ont. R. 339.....	89, 93
Bell Telephone Company v. The Telephone Manufacturing Company, and The Minister of Agriculture, (1884) 7 O.R. 605.....	93, 139
Bennett v. Wortman, (1901) 2 O.L.R. 292.....	184
Benno Jaffé Und Darmstaedter Lanolin Fabrik v. Richardson, (John) & Co. Ltd., (1893) 10 R.P.C. 136; 11 R.P.C. 93; 261; 68 L.T. 404 18, 219	
Bergman v. MacMillan, (1881) L.R. 17 Ch. D. 423.....	114
Betts v. Willmot, (1871) L.R. 6 Ch. 239.....	128, 223
Betts v. Nielson and Betts v. De Vitre, (1864-73) L.R. 3 Ch. 429, 442; 6 H.L. 319; 34 L.J. Ch. 289, 291.....	184
Betts v. Gallais, (1870) L.R. 10 Eq. 392.....	225
Betts v. Neilson, (1868) 3 Ch. App. 429.....	48, 62
Bickford v. Skewes, (1841) 1 Q.B. 938.....	84
Bicknell v. Peterson, (1897) 24 O.A.R. 427.....	12
Birch v. Harrap, (1896) 13 R.P.C. 615.....	174
Birdsell v. Shalhiol, (1884) 112 U.S. 485.....	233
Black v. Huhhard, (1877) 12 O.G. 842; 3 Bann. v. Ard. 39.....	128
Black v. Munson, (1877) 14 Blatch. 268; Fed. Cas. 1463.....	230
Blackett v. Dickson & Mann Ltd., (1909) 26 R.P.C. 73.....	11
Blakey (C.A.) & Co. v. Latham & Co., (1889) 6 R.P.C. 184.....	19
Blauvelt v. Interior Conduit and Insulation Co., (1897) 80 F. 906.....	130
Blackledge v. Weir, 108 Fed. 71, 47 C.C.A. 76.....	114
Blount v. Société, 53 Fed. 98; 3 C.C.A. 455.....	215, 216, 225
Bloxam v. Elsee, (1825) 1 C. & P. 558; 6 B. & C. 169.....	27, 52, 86
Boak v. Merchants' Marine Insurance Co., Cassel's Digest, 2nd Ed. 677, 234	
Bossé v. Paradis, (1892) 21 S.C.R. 419.....	235
Bonathon v. Bowmanville Furniture Manufacturing Co., (1870) 31 U.C. Q.B. 413.....	60, 62, 130, 216
Boulton v. Bull, (1795) 2 Hy. Bl. 463; Davies 162.....	16, 23, 26, 50
Bovill v. Cowan, (1867) 15 W.R. 608.....	219
Bovill v. Crate, (1865) L.R. 1 Eq. 388.....	216, 234
Bovill v. Keyworth, (1857) 7 E. & B. 725.....	13, 15
Bovill v. Moore, (1815) 2 Coop. Ch. Ca. 56.....	26, 221
Bovill v. Pimm, (1856) 11 Ex. Ch. 718.....	174
Bovill v. Smith, (1867) L.R. 2 Eq. 459.....	216
Bower v. Hodges, (1853) 13 C.B. 765.....	122
Boyd v. Horrocks, (1886-92) 3 R.P.C. 285; 5 R.P.C. 557; 6 R.P.C. 152 9 R.P.C. 77.....	174, 177
Boyd v. McAlpin, 3 McLean 427.....	117

Boyd v. Tootal, Broadhurst, Lee Co., (1894) 11 R.P.C. 175.....	228
Bracher v. Bracher Dean & Co., (1890) 7 R.P.C. 420.....	217
Bradford Dyers v. Bury, (1902) 19 R.P.C. 1.....	77, 109
Brickhill v. New York, (1879) 18 Blatch. 273; 5 Bann. & Ard. 547.....	130
Briggs and Co. v. Lardeur et al., (1884) 1 R.P.C. 126.....	216
Britain v. Hirsch, (1888) 5 R.P.C. 226.....	8, 10
British Dynamite Co. v. Krehs, (1896) 13 R.P.C. 190.....	77, 78, 168, 199
British Liquid Air Co. Ltd. v. British Oxygen Co. Ltd., (1909) 26 R.P.C. 511, H.L.....	11
British Motor Syndicate v. John Taylor & Sons, (1901) 1 Ch. 122 (1900) 17 R.P.C. 723.....	189, 230
British Ore Concentration Ltd. v. Minerals Separation Ltd., (1907) 24 R.P.C. 790.....	213
British Tanning Co. v. Groth, (1891) 8 R.P.C. 113.....	174, 215
British United Shoe Machinery v. Fussell, (1908-1910) 25 R.P.C. 631; 27 R.P.C. 205.....	13, 15, 16, 80, 189, 230
British United Shoe Co. v. Thompson, (1905) 22 R.P.C. 177... 8, 82, 178	
British United Machinery Co. Ltd. v. Sirhon Collier Ltd., (1909) 26 R.P.C. 534; 27 R.P.C. 567.....	188
British Westinghouse Electric and Mfg. Co. Ltd. v. Electrical Co. Ltd., (1911) 28 R.P.C. 517.....	233
British Westinghouse Electric and Mfg. Co. Ltd. v. Braulik, (1910) 27 R.P.C. 209 C.A.....	13, 16
Brook v. Broadhead, (1889) 2 E. C.R. 562.....	140
Brooks v. Byam, (1843) 2 Story 525.....	117, 118, 120
Brooks v. Lamplugh, (1898) 15 R.P.C. 33.....	10, 174, 178
Brooks v. Lycett's Saddle Co., (1903) 20 R.P.C. 575.....	217
Brooks v. Sacks, 81 Fed. 403.....	41
Brooks v. Steele & Currie, (1897) 14 R.P.C. 46.....	168, 223
Brown v. Guild, 90 U.S. 181.....	39
Brown v. Hastie & Co. Ltd., (1902-4) 21 R.P.C. 445.....	178
Brush v. Condit, 132 U.S. 39; 33 L. Ed. 251.....	40, 41, 62
Bunge v. Higginbottom & Co. Ltd., (1902) 19 R.P.C. 187.....	169
Burdell v. Denig, 92 U.S. 716.....	231
Burnett v. Tak, (1882) 45 L.T. 743.....	192
Burns v. Meyer, 100 U.S. 671.....	80
Burr v. Duryee, 1 Wall 577.....	9, 22
Buser v. Novelty, 151 Fed. 478; 81 C.C.A. 16.....	40
Bush v. California, 52 Fed. 945; 3 C.C. 368.....	126
Bush v. Fox, (1856) 5 H.L.C. 707.....	10
Byerly v. Cleveland, (1887) 31 Fed. 73.....	231
Cahoon v. Ring, 1 Cliff. 592.....	37
Caldwell v. Van Vlissingen, (1851) 9 Hare, 415.....	215
Campbell v. Bate, (1886) 15 R.L. 467 S.C.....	86
Campion v. Benyon, (1821) 3 Brod. & Bing. 5.....	74

TABLE OF CASES CITED.

xiii

Cannington v. Nuttall, (1871) L.R. 5 H.L. 205.....	16
Cantrell v. Wallick, 117 U.S. 689.....	39
Carnegie Steel Co. v. Cambria Iron Co. 185 U.S. 403.....	22
Carpenter v. Smith, (1842) 1 Weh. P.C. 530.....	48, 62
Carter & Co. v. Hamilton, (1894) 3 Ex. C.R. 351; 23 S.C.R. 172.....	175
Cartshurn Sugar Refining Co. v. Sharp, (1884) 1 R.P.C. 181.....	185
Case v. Cressey, (1900) 17 R.P.C. 255.....	8, 10
Case v. Redfield, 4 McLean 526.....	117
Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate, (1895) 12 R.P.C. 232.....	9, 10, 235
Celluloid Manufacturing Co. v. Crofut, 24 Fed. 796.....	56
Celluloid Manufacturing Co. v. Tower, 26 Fed. 451.....	18
Centerwood v. Gerber, 149 U.S. 224.....	57
Central v. Coughlin, 141 Fed. 91; 72 C.C.A. 93.....	178
Challender v. Royle, (1887) 4 R.P.C. 363.....	216
Chamberlain & Hookham Ltd. v. Mayor, etc., of Bradford, (1903) 20 R.P.C. 673.....	174
Chamberlain Metal Weatherstrip of Detroit Co. v. Peace Metal Weatherstrip Co., (1905) 9 Ex. C.R. 399; 37 S.C.R. 530.....	175
Chambers v. Crichley, (1864) 33 Beav. 574.....	120
Chambers v. Smith, 5 Fisher 12; 5 Fed. Cas. 2582.....	118, 119, 122, 127
Chanter v. Leese, (1838) 4 M. & W. 595.....	120, 124
Cheetham v. Oldham, (1888) 22 L.J.N.S. Ex. 26; 5 R.P.C. 621; 7 R.P. C. 116.....	221
Chicago Sugar Refining Co. v. Pope Glucose Co., 84 F. 981.....	22
Clark v. Adie, (1877) 2 App. Cas. 315, 423.....	86, 120, 124, 125, 181
Clark v. Griffiths, (1885) 24 N.B.R. 567.....	...
Clark v. Williamantic, 140 U.S. 481; 35 L. Ed. 521; 11 S. Ct. 846.....	49
Cleaver v. Wallwork, (1896) 13 R.P.C. 277.....	174
Clement Talbot Ltd. v. Wilson, (1907) 26 R.P.C. 467.....	229
Clinton Wire Cloth Co. v. Dominion Fence Co., (1907) 11 Ex. C.R. 103; 39 S.C.R. 535.....	175, 223
Clishy v. Reese, 88 Fed. 645; 32 C.C.A. 80.....	41
Clum v. Brewer, 2 Curt. 506.....	114
Cochrane v. Deuer, 94 U.S. 780; 24 L. Ed. 139.....	21
Cochrain (J.P.) & Co. Martins (Birmingham) Ltd., (1911) 28 R.P.C.....	127
Cochrane v. Smethurst, (1816) 2 Coop. Ch. Cas. 57.....	74
Cochrane v. Waterman, (1844) 1 McArthur's Patent Cases 59.....	160
Coffin v. Ogden, 18 Wall 120.....	34, 37, 39
Collar Co. v. Van Deusen, (1874) 23 Wall 530.....	28
Collette v. Lasnier, (1886) 13 S.C.R. 563.....	109, 168, 222, 227, 228, 231
Colgate v. Manufacturing Co., (1886) 28 Fed. 147.....	230
Computing v. Automatic, 204 U.S. 609; 51 L. Ed. 645; 27 S. Ct. 307....	59
Consolidated Car Heating Co. v. Came, (1903) Q.R. 18 S.C. 44 Q.R. 11 K.B. 103; 1903 A.C. 509; 20 R.P.C. 745.....	147, 168, 170, 171

Consolidated Fruit Jar Co. v. Wright, 94 U.S. 92; 24 L. Ed. 68.....	49, 56, 61, 62, 63
Consolidated v. Crosley, 113 U.S. 157.....	175
Conway v. Ottawa Electric Railway Co., (1904) 8 Ex. C.R. 432... 62, 63	
Coon v. Wilson, (1884) 113 U.S. 277.....	104
Coppin v. Lloyd, (1898) 15 R.P.C. 373.....	123
Copeland v. Webb, (1862) 11 W.R. 134.....	217
Copeland, Chatterson Co. v. Business Systems Ltd., (1906) 7 O.W.R. 274, 348; 9 O.W.R. 610.....	208, 227
Copeland, Chatterson Co. v. Hatton, (1906) 10 Ex. C.R. 224; 37 S.C.R. 651.....	126, 142, 187, 207
Copeland, Chatterson Co. v. Lyman Brothers, (1907) 9 O.W.R. 908... 11 O.W.R. 70.....	16, 69, 120, 124, 142, 208, 215, 225
Copeland, Chatterson Co. v. Paquette et al, (1906) 10 E.C.R. 410. 19, 111	
Corhin Cahinet Lock Co. v. Eagle Lock Co., (1893) 150 U.S. 42... 58, 103	
Corning v. Burden, 15 How. 252.....	20, 22
Cornish v. Keene, (1835) 1 W.P.C. 501.....	27, 224
Cortelyou v. Johnon, 145 Fed. 933; 76 C.C.A. 455.....	185
Craig v. Samuels Benjamin & Co., (1894) 24 S.C.R. 278; 21 Ont. App. R. 412.....	237
Crane v. Price, (1842) 1 W.P.C. 377.....	11, 13, 15, 18, 26
Craver v. Weyhrich, 31 Fed. 607.....	58
Crompton v. Anglo-American Brush Electric Corporation, (1887) 4 R.P.C. 197.....	213
Crompton v. Belknap, (1869) 3 Fisher 536.....	51
Crompton v. Ibbotson, (1828) 1 W.P.C. 83.....	78, 199
Crossley v. Beverley, (1829) 1 W.P.C. 112; 3 Car. & P. 513; 1 Ruee. & M. 166.....	78, 225
Crossley v. Derby Gas Light Co., (1829) 1 W.P.C. 119.....	227, 234
Crossley v. Dixon, (1863) 10 H.L.C. 293.....	120, 123, 124, 125
Croesley v. Potter, (1853) Macr. P.C. 240.....	9
Crouch v. Speer, (1874) 1 Ban. & Ard. 145; 6 O.G. 187.....	52
Crown v. Aluminium, 108 Fed. 845.....	52, 54, 56
Curran v. Burdall, (1883) 20 Fed. 835.....	130
Curtie v. Platt, (1863) 3 Ch. D. 135.....	10, 173
Cutlan v. Dawson, (1896-7) 13 R.P.C. 710; 14 R.P.C. 249.....	123, 124
Daimler v. Conklin, (1909) 170 Fed. 70.....	128
Dalgleish v. Conboy, (1876) 26 U.C.C.P. 254.....	116, 117, 118, 122, 127
Dalzell v. Dueber, etc., Mfg. Co., 149 U.S. 315; 37 L. Ed. 749.....	118
Dangerfield v. Jones, (1865) 13 L.T. 142.....	125
Dansereau v. Bellmare, (1889) 16 S.C.R. 180.....	14
Darcy v. Allin, (1602) Noy R. 178.....	50
Davenport v. Rylande, (1866) L.R. 1 Eq. 302; 35 L.J. Ch. 204.....	225
Davey Pegging Machine Co. v. Duplessie Pegging Machine Co., Oct. 4th (1899) Audette Practice in Exchequer Court, 2nd Ed. P. 420....	208

TABLE OF CASES CITED.

XV

Davies v. Curtis & Harvey Ltd., (1903) 20 R.P.C. 561.....	125
Davis v. Edison, 60 Fed. 27; 68 C.C.A. 615.....	198
Daw v. Eley, (1867) L.R. 3 Eq. 496.....	226
Dawes v. Harness, (1875) L.R. 10 C.P. 166.....	120
De Beauvoir v. Welch, (1827) 7 B. & C. 266.....	101
Deering v. Winona, 155 U.S. 286; 39 L. Ed. 153; 15 S. Ct. 118.....	39, 41, 57
Dege's Patent (1895) 12 R.P.C. 448.....	213
Delap v. Robinson, (1898) 18 P.R. 231.....	218
De La Rue v. Dickenson, (1857) 7 E. & B. 738.....	168
De La Vergne, etc., Machine Co. v. Featherstone, 147 U.S. 209, 37 L. Ed. 138.....	117
Dent v. Turpin, (1861) 2 J. & H. 139; 30 L.R. Ch. 495.....	114
Dental Vulcanite Co. v. Van Antwerp, (1876) 2 Bann. & Ard. 255.....	230
Detweiler v. Voegel, (1881) 8 Fed. 600.....	128
De Vitre v. Betts, (1873) L.R. 6 H.L. 319.....	227
Dick v. Ellams Duplicator Co., (1900) 17 R.P.C. 196.....	81
Dickerson v. Radcliffe (1897) 17 O.P.R. 586.....	219
Dicks v. Brooks, (1880) L.R. 15 Ch. D. 22.....	229
Dircks v. Mellor, (1845) 26 Lon. Journ. 268.....	215
Dittgen v. Racine Paper Goods Co., 181 Fed. 394.....	63
Doe dem Manton v. Austin, (1832) 9 Bing. 41.....	125
Dominion Cotton Mills Company v. General Engineering Company of Ontario, (1902) A.C. 570; 31 S.C.R. 75; 6 Ex.C.R. 357.....	70, 71
Dompierre v. Barile, (1889) 18 R.L. 597 Q.B.....	16
Dowling v. Billington, (1890) 7 R.P.C. 191.....	183, 216
Dredge v. Parnell, (1898) 16 R.P.C. 625.....	17
Ducketts Ltd. v. Whitehead, (1895) 12 R.P.C. 187.....	226
Dudgeon v. Thompson, (1873) 3 App. Cas. 34. 10, 84, 169, 171, 176, 215, 226	
Dunbar v. Myers, 94 U.S. 187.....	15, 16, 17, 111
Dunlop Pneumatic Tyre Co. v. British & Colonial Motor Co. (1901) 18 R.P.C. 313.....	189
Dunlop Pneumatic Tyre Co. v. Excelsior Tyre Cement & Rubber Co., (1901) 18 R.P.C. 209.....	128, 188
Dunlop Pneumatic Tyre Co. v. Green, (1900) 17 R.P.C. 234.....	231
Dunlop Pneumatic Tyre Co. v. Holborn Tyre Co., (1901) 18 R.P.C. 222 128, 188	
Dunlop Pneumatic Tyre Co. v. Neal, (1899) 16 R.P.C. 247.....	128, 226
Dunlop Pneumatic Tyre Co. v. Mosely, (1904) 21 R.P.C. 274..... 149, 150, 186, 187	
Dunlop Pneumatic Tyre Co. v. Stone & Corser, (1897) 14 R.P.C. 263 216	
Dunlop Pneumatic Tyre Co. v. Wapshare Tube Co., (1900) 17 R.P.C. 433 235	
Dunlop Pneumatic Tyre Co. v. Wilson, (1890) 17 R.P.C. 332.....	128
Dunnicliff v. Mallett, (1859) 7 C.B.N.S. 209.....	114
Durand v. Green, (1894) 60 Fed. 392.....	79
Duryea v. Kauffman, (1910) 21 O.L.R. 182; 17 O.W.R. 626 1055; 2 O.W.N. 336; 476.....	120, 122, 124, 125, 207, 211, 212, 213

Eastern Hat and Cap Co. v. Walmsley, (1908) 5 E.L.R. 538.....	16, 78
Edison v. Holland, (1889) 6 R.P.C. 243.....	76, 77, 224
Edison & Swan United Electric Light Co. v. Woodhouse & Rawson, 4 R.P.C. 79.....	81
Edison v. U.S. 52 Fed. 300.....	18
Edison Bell v. Smith, (1894) 11 R.P.C. 389.....	233
Edison Bell Phonograph Corporation Ltd. v. Hough, (1894) 11 R.P.C. 594.....	217
Edison Bell Phonograph Corporation Ltd. v. Smith & Young, (1894) 11 R.P.C. 148.....	81
Edison Telephone Co. v. Indian Rubber Co., (1881) L.R. 17 Ch. D. 137	211
Edisonia Ltd. v. Forse, (1908) 25 R.P.C. 546.....	28, 129
Egbert v. Lippman, 104 U.S. 333.....	40, 60, 62, 63
Electric v. Hall, 114 U.S. 87.....	14, 16
Electric v. Boston, 139 U.S. 481; 35 L. Ed. 253; 11 S. Ct. 586.....	57
Electric v. Edison, 61 Fed. 834; 10 C.C.A. 106.....	216
Electric Boot & Shoe Finishing Co. v. Little, 75 Fed. 276; 138 Fed. 732..	199
Electric Construction Co. v. Imperial Tramways Co., (1900) 17 R.P.C. 537.....	48
Electric Fireproofing Co. of Canada v. Electric Fireproofing Co., (1910) 43 S.C.R. 182; Q.R., 31 S.C. 34.....	2, 20, 24, 120, 168, 215, 225
Electrical Accumulator Co. v. Julien Electric Co., (1889) 38 Fed. 131..	111
Electrolyte Plating Apparatus Co. v. Holland, (1901) 18 R.P.C. 521....	40
Eliot v. Mayor, etc., of Bristol, (1894) 71 L.T. 659.....	125
Elizabeth v. Pavement Co., 97 U.S. 126; 24 L. Ed. 1000.....	60, 62, 63
Ellwood v. Christy, (1865) 18 C.B.N.S. 494.....	228
Ellington v. Clark, (1888) 5 R.P.C. 135, 319; 58 L.T. 818.....	176
Elmslie v. Boursier, (1869) L.R. 9 Eq. 217.....	152, 185
Emery v. Hodge, (1861) 11 U.C.C.P. 196.....	16
Emery v. Iredale, (1860) 11 U.C.C.P. 196.....	81
Emerson v. Simm, (1873) 6 Fisher. 281.....	230
English & American Machinery Corporation v. Union Boot & Shoe Co. (1894) 11 R.P.C. 367.....	211, 230
Erlich v. Ihlee, (1888) 5 R.P.C. 198, 437.....	176
Expanded Metal Co. v. Bradford, 214 U.S. 336.....	21
Ex Parte Blythe, 30 O.G. 1321.....	20
Ex Parte Crippen, U.S. Commissioner's Decisions Manuscript, May 24th 1890.....	25
Ex Parte Meinhardt, (1907) 129 O.G. 3503.....	25
Ex Parte Stevens, (1876) 3 Ch. D. 659, 590, 299.....	69
Evans v. Eaton, 3 Wheat. 454; 7 Wheat. 357.....	26
Faller v. Aylen, (1904) 8 O.L.R. 70.....	89
Farbenfabriken Vormals F. Bayer v. Bowker, (1891) 8 R.P.C. 389..	213
Fawcett v. Homan, (1896) 13 R.P.C. 398.....	19
Federation Brand Salmon Canning Co. v. Shortt, 39 S.C.R. 375; 7 B.C. Rep. 197.....	81, 175, 204

TABLE OF CASES CITED.

xvii

Fenner v. Wilson, (1893) 10 R.P.C. 283, 287.....	217
Fisher v. American, 71 Fed. 523.....	12
Flower v. Detroit, (1887) 127 U.S. 571.....	58, 103
Flower v. Lloyd, (1876) W.N. 169, 230; 45 L.T. 746.....	221
Ford v. Foster, (1872) L.R. 7 Ch. App. Cas. 611.....	234
Foden v. Wallis & Stevens Ltd., (1908) 25 R.P.C. 501.....	235
Forncrook v. Root, 127 U.S. 176; 32 L.Ed. 97.....	40
Fowell v. Chown, (1894) 25 O.R. 71; Affd. 22 O.A.R. 268.....	70, 162
Fox v. Astrachans Ltd. (1910) 27 R.P.C. 377.....	78
Foxwell v. Bostock, (1864) 10 L.T. 144; 12 W.R. 723.....	110, 182
Franklin Hocking v. Franklin Hocking, (1889) 6 R.P.C. 69.....	10, 120, 121
Frearson v. Loe, (1898) L.R. 9, Ch. D. 48.....	183, 184, 216
Freeman v. Asmus, (1895) 145 U.S. 240.....	58, 103
Frost (Geo.) Co. v. Lamstag, (1910) 180 Fed 739.....	18
Fuller v. Berger et al, 120 F. 274.....	53
Fuller & Johnston v. Partlett, (1887) 68 Wis. 73.....	130
Gadd v. The Mayor, etc., of Manchester, (1892) 9 R.P.C. 516.....	10
Galloway v. Bleadon, (1839) 1 W.P.C. 521.....	234
Gamhle v. Kurtz, (1846) 3 C.B.N.S. 425.....	176
Gammons v. Battershy, (1901) 21 R.P.C. 322.....	19
Gardner v. Broadbent, (1856) 2 Jur. N.S. 1041.....	215, 217
Garrard v. Edge, (1889) 6 R.P.C. 372.....	177
Gayler v. Wilder, 10 How. 477; 13 L. Ed. 504.....	34, 39, 116, 122, 127
General Engineering Company of Ontario v. The Dominion Cotton Mills and Stoker Co., (1902) A.C. 570 (1899) 6 Ex.C.R. 309; 31 S.C.R. 75... 18, 19, 209, 210, 212, 213	
Germ Milling Co. v. Robinson, (1886) 3 R.P.C. 11; 55 L.J. Ch. 287; 1 R.P.C. 217.....	221
Gihson and Campbell v. Brand, (1841) 4 M. & G. 1791; W.P.C. 627... 184, 189, 210	
Gillett v. Wiltby (1839) 9 C. & P. 334; 1 Weh. P.C. 270.....	150, 187
Gill v. Coutts & Sons (1895) 13 R.P.C. 125.....	48
Gill v. United States, (1896) 160 U.S. 426.....	130
Gill v. Wells, 89 U.S. 1.....	14, 16, 178
Gillette v. Rea, (1909) 1 O.W.N. 448.....	126, 143
Gillette Safety Razor Co. v. Anglo-American Trading Co. Ltd., (1912) 29 R.P.C. 577.....	81
Gillette Safety Razor Co. v. Gamage (1907) 24 R.P.C. 1.....	217
Gillies v. Colton, (1875) 22 Gr. 123.....	120, 124
Girvin v. Burke, (1889) 19 O.R. 204.....	237
Goddard v. Lyon, (1894) 11 R.P.C. 354.....	13
Godfrey v. Eames, 68 U.S. 317; 17 L. Ed. 684.....	58
Goodyear v. Jackson, (1901) 112 F. 146.....	128, 185
Goodyear v. Van Antwerp, (1876) 9 O.G. 497.....	230
Goodyear Dental Vulcanite Co. v. Smith, 5 O.G. 585; Holmes 354....	51

Gottfeid v. Phillips Best Brewing Co., (1879) 17 O.G. 675	128
Gottfreid v. Miller, 104 U.S. 521.....	116
Gosnell v. Bishop, (1888) 5 R.P.C. 41, 151.....	19, 174
Gorville v. Hay, (1903) 21 R.P.C. 49.....	120
Gormully & Jeffry Mfg. Co. v. North British Rubber Co. (1894-8) 12 R.P.C. 17; 13 R.P.C. 691; 14 R.P.C. 283; 15 R.P.C. 245.....	177
Graham v. Geneva, (1880) 11 Fed. 138.....	57, 64
Graham v. McCormack Mfg. Co., 11 Fed. 859.....	57
Gramophone & Typewriter Coy. Ltd. v. Ullman, (1906) 23 R.P.C. 782 C.A.....	13
Green v. American, 78 Fed. 119; 24 C.C.A. 41.....	15
Green v. Watson, (1884) 10 A.C. 113; 2 O.R. 627.....	119, 122, 127
Griffin v. Toronto Railway, (1902) 7 Ex. C.R. 411.....	14, 16
Guelph J. Company v. Whitehead, (1883) 9 P.R. 509.....	220
Guyot v. Thompson, (1894) 11 R.P.C. 541.....	123, 124, 126, 127
Haffke v. Clark, (1891) 46 F. 772.....	7
Hailes v. Albany Stove Co., (1887) 123 U.S. 582.....	110
Haltes v. Van Wormer, (1873) 20 Wall. 353.....	15, 16
Haines v. McLaughlin, 135 U.S. 584; 34 L. Ed. 290.....	61
Hall v. Condor, (1857) 2 C.B.N.S. 22.....	120, 124
Hall v. Macneale, 107 U.S. 90; 27 L. Ed. 367.....	62
Halsey v. Brotherhood, (1880) L.R. 15 Ch. D. 514.....	192
Hambly v. Allbright & Wilson, (1902) 7 Ex. C.R. 363.....	145, 152
Hammond v. Mason, 92 U.S. 724; 23 L. Ed. 767.....	122
Hancock v. Bewley, (1860) Johns. 601.....	114
Hancock v. Moulton, John's Pat. Mans. 5th Ed. p. 254.....	177
Haggood v. Hewit, (1886) 119 U.S. 226.....	130
Harmer v. Playne, (1809) 11 East 101.....	76
Harris v. Rothwell, (1886) 3 R.P.C. 243.....	212, 224
Harrison v. Taylor, (1865) 11 Jur. N.S. 408.....	234
Harwood v. Great Northern Railway Co., (1865) 11 H.L.C. 654.....	8, 10
Haskell Golf Ball Co. v. Hutchison, (1906) 23 R.P.C. 125.....	235
Haslam & Co. v. Hall, (1887) 4 R.P.C. 203.....	208
Hassell v. Wright, (1870) L.R. 10 Eq. 509.....	118
Hattersley & Sons v. Hodson (1906) 21 R.P.C. 517, 23 R.P.C. 192 H.L. 84, 86	84, 86
Haworth v. Harcastle, (1834) Bing. N.C. 190; 1 W.P.C. 480.....	53
Hayes Young v. St. Louis, 137 Fed. 80; 70 C.C.A. 1.....	58
Hayne v. Maltby, (1789) 3 T. R. 438.....	124
Hayward v. Pavement Light Co., (1884) 1 R.P.C. 207.....	176, 215
Heald's Patent, (1891) 8 R.P.C. 429, 430.....	28
Heap v. Hartley, (1889) 6 R.P.C. 495.....	119, 122, 127, 128
Heath v. Smith, (1853) 2 W.P.C. 258.....	61
Heath v. Unwin, (1852-5) 1 W.P.C. 551; 2 W.P.C. 225; 25 L.J. 8; 5 H.L.C. 505.....	78

TABLE OF CASES CITED.

xix

Heathfield v. Greenway, (1894) 11 R.P.C. 17.....	213
Herrburger Schwander et Cie v. Squire, (1880) 6 R.P.C. 194.....	48
Henderson v. Sheld, (1907) 24 R.P.C. 108.....	120
Herscher v. Hertz & Collingwood, (1895) 11 T.L.A. 466; 99 L.T. Journal 213.....	192
Hessin v. Coppin, (1874) 19 G.R. 629; 21 Gr. 253.....	61, 162, 218
Hicks v. Kelsey, 95 U.S. 620.....	18
Hickton's Patent Syndicate v. Patent Machine Improvement Co., (1909) 26 R.P.C. 339.....	26
Hildreth v. McCormick, (1907) 10 Ex. C.R. 378; 39 S.C.R. 499.....	126, 142, 143
Hills v. London Gas Light Co., (1858) 5 H. & N. 312.....	35
Hinks v. Safety Lighting Co., (1876) L.R. 4 Ch. D. 607.....	57, 80, 84, 86
Hiltcheock v. Tremain, 9 Blatchf. 550.....	39
Hohhle v. Jennison, (1892) 149 U.S. 355.....	128
Hocking v. Hocking, (1885) 6 R.P.C. 69 H.L.....	10, 120, 121
Hoffhelms v. Brandt, 3 Fish. 218.....	52
Hoffman v. Young, 2 Fed. 74.....	14
Hogg v. Emerson, (1845) 6 Howard 437.....	222
Holliday v. Heppenstall, (1889) 6 R.P.C. 320.....	211, 212
Holophane Ltd. v. Berend & Co., (1898) 15 R.P.C. 18.....	215
Hornhlower v. Boulton, (1795) 8 T.R. 95.....	22
Horne v. McKernan (1862) 30 Beav. 547.....	219
Horton v. Mabon, (1862) 12 C.B.N.S. 437.....	8, 10
Hoskins v. Fisher, (1887) 125 U.S. 217.....	58, 102
Hotchkiss v. Greenwood, 11 How. 248.....	18
Househill Co. v. Neilson, (1843) 1 W.P.C. 679.....	8, 9, 35, 40, 209
Household v. Fairburn, (1884) 51 L.T. 498, S.C. (1885) 2 R.P.C. 130.....	192
Hotel Security Checking Co. v. Lorraine Co., (1908) 160 F. 467.....	25
Houston Ray Co. v. Stern, (1896) 74 Fed. 626.....	230
Huddart v. Grimshaw, (1803) 1 Weh. P.C. 86.....	15
Hunter v. Carrick, (1884) 10 O.G.R. 449, 11 S.C.R. 300; 28 Gr. 489.....	16, 100
Hull v. Bollard, (1856) 25 L.J. Ex. 304.....	207
Ide v. Trorlicht, 115 Fed. 137; 53 C.C.A. 341.....	55
Imperial Supply Co. Ltd. v. G.T.R. Co., (1912) 14 Ex. C.R. 88.....	28, 124, 130
Incandescent Gas Light Co. v. Cantelo, (1895) 12 R.P.C. 262.....	128, 143, 144
Incandescent Gas Light Co. v. Brogden, (1899) 13 R.P.C. 179.....	126, 144
Incandescent Gas Light Co. v. New Incandescent Gas Mantle Co., (1897) 15 R.P.C. 81.....	151
Incandescent Gas Light Co. v. The De Mare Incandescent Light System, (1896) 13 R.P.C. 301.....	163, 169, 170

Indiana Manufacturing Co. v. Smith, (1904) 9 Ex. C. R. 154	121
Ingersoll Sergeant Drill Co. v. Consolidated Pneumatic Tool Co. Ltd., (1907) 25 R.P.C. 61.....	81
Innes v. Shortt, (1898) 15 R.P.C. 450.....	188
International Harvester Co. of America v. Peacock, (1908) 25 R.P.C. 765	13
International Tooth Crown Co. v. Gaylord, 140 U.S. 55; 35 L. Ed. 347.	62, 63
Jackson v. Needle, (1884) 2 R.P.C. 191.....	215, 217
Jahncke v. Bell, (1892) 9 R.P.C. 94.....	174
Jandus Arc Lamp and Electric Co. Ltd. v. Arc Lamp Co., (1905) 22 R.P.C. 277.....	10, 226
Jandus Arc Lamp and Electric Co. Ltd. v. Johnston, (1900) 17 R.P.C. 361	117
Jardine v. King, Mendham & Co., (1896) 18 R.P.C. 411.....	174
Johnston v. Martin, (1892) 19 O.A.R. 592.....	237
Johnston v. Johnston, 60 F. 618.....	24
Johnston v. Root, (1858) 2 Fish. 291; 2 Clifford. 106.....	56, 159
Johnston's Application, (1902) 19 R.P.C. 56.....	25
Johnston's Patent, (1896) 13 R.P.C. 659.....	111
Jones v. Barker, 11 Fed. 597.....	49
Jones v. Berge, (1893) 58 Fed. 1008.....	118, 122
Jones v. Berger, (1843) 1 Web. P.C. 544.....	48
Jones v. Galbrath, (1901) 22 C.L.J. 76.....	179, 218
Jones v. Pearce, (1832) 1 W.P.C. 122.....	40, 184
Jones v. Russell, (1896) 1 N.B. Eq. R. 232.....	121
Jones v. Wetherell, (1855) McArthur's Patent Cases 413.....	159
Judson v. Bradford, (1878) 3 Bann. & Ard. 549.....	230
Kane v. J. Boyle & Co., (1901) 18 R.P.C. 325.....	225
Kay v. Marshall, (1841) 2 W.P.C. 71; 8 C. & Fin. 245.....	10, 11, 80
Kaye v. Chubb & Sons, (1886) 4 R.P.C. 23.....	226, 235
Kreeland v. Sheriff, 18 O.G. 242.....	49
Kelvin v. Whyte, Thompson & Co., (1907) 25 R.P.C. 177.....	51, 224
Kemper, McArthur's Patent Cases 4.....	7
Kendall v. Windsor, (1858) 62 U.S. 322; 16 L. Ed. 165.....	56, 66
Kenny's Patent Button-Holeing Company (Ltd.) v. Somervell, (1878) 38 L.T. 778; 26 W.R. 786.....	129
Keystone Bridge v. Phoenix Iron Co., 95 U.S. 274.....	80
Kidder v. Smart, (1885) 8 O.R. 362.....	58, 106, 165
King Brown & Co. v. Anglo-American Brush Corporation, (1892) 9 R.P.C. 313.....	48
Klein v. Russell, 19 Wall. 433.....	53
Kleinert Rubber Co. v. Eisman Rubber Co., (1908) 12 O.W.R. 60.....	208
Knight v. Argyles Ltd. (1912) 29 R.P.C. 593.....	85
Kynock Ltd. v. Webb, (1900) 17 R.P.C. 160.....	26, 81

TABLE OF CASES CITED.

xxi

Lamb Knit Goods Co. v. Lamb Glove & Mitten Co., 120 F. 267.....	82
Lane v. Locke, 150 U.S. 193; 37 L. Ed. 10.....	122, 120
Lane Fox v. Kensington and Knightsbridge Electric Lighting Co., (1902) 9 R.P.C. 413.....	8, 11, 52, 77, 78
Lans v. McAllister, 1 O.W.R. 455; 2 O.W.R. 148.....	185
Lawson v. Hillman, 123 Fed. 416; 59 C.C.A. 510.....	41
Larose v. MacPherson & Co., (1897) 14 R.P.C. 696.....	122
Lean v. Huston, (1884) 8 O.R. 521.....	162
Leeds & Catlin v. Vletor Talking Machine Co., 213 U.S. 301.....	22
Leeds Forge Co. Ltd. v. Delighton's Patent Flue and Tube Company Ltd. (1901) 18 R.P.C. 233.....	226
Lefevre v. Titmore, (1899) Q.R. 16 S.C. 248.....	235
Lehigh v. Kearney, 158 U.S. 461; 39 L. Ed. 1055; 15 S. Ct. 871.....	59
Lehnbeuter v. Holthaus, 105 U.S. 74.....	216, 225
Leggett v. Standard Oil Co., (1897) 149 U.S. 287.....	104
Leonard, re, (1913) 14 Ex. C.R. 351.....	57, 58, 104
Le Neve v. Le Neve (1748) 3 Atk., 646.....	117
Leonhardt v. Kalle, (1894) 11 R.P.C. 534.....	216
Leslie v. Calvin et al, 9 O.R. 207.....	
Lewis v. Marling, (1829) 10 B. & C. 22, 1 W.P.C. 496.....	53, 78
Liardet v. Hammond Electric Light and Power Co., (1883) 31 W.R. 710	120, 124
Lines v. Usher, (1897) 14 R.P.C. 276.....	123
Linotype & Machinery Ltd. v. Hopkins, (1908) 25 R.P.C. 665; 27 R.P.C. 109.....	121
Lister v. Leather, (1858) 8 E. & B. 1004.....	10, 13, 16, 26
Lister v. Norton, (1886) 3 R.P.C. 207.....	77, 215, 216, 217
Lomhard v. Alexander Dunhar & Sons Co., (1910) 8 Eastern Law Reports 281.....	60, 69, 140
London & Leicester Co. v. Griswold, (1886) 3 R.P.C. 251.....	212
Longbottom v. Shaw, (1891) 8 R.P.C. 333.....	19
Loom Co. v. Higgins, 105 U.S. 580.....	12, 17, 49, 76
Losh v. Hague, (1838) 1 W.P.C. 200.....	10, 11
Lovell v. Hicks, (1836-7) 2 Y. & C. Ex. 46.....	120, 124
Lyon v. Goddard, (1893) 11 R.P.C. 354.....	53
Lyon v. Newcastle-on-Tyne Corporation, (1894) 11 R.P.C. 218.....	225
Macfarland v. Price, (1816) 1 W.P.C. 74; 1 Stark. 199.....	86
MacLaughlin v. Lake Erie R.W. Co., (1902) 3 O.L.R. 706.....	122, 123
Machine Co. v. Murphy, 97 U.S. 120; 24 L. Ed. 935.....	116, 177
Magic v. Economy, 97 Fed. 87; 38 C.C.A. 430.....	178
Magin v. Karle, 150 U.S. 387, 37 L. Ed. 1119.....	40
Mahn v. Harwood, (1884) 112 U.S. 354.....	105
Main v. Ashby & Co., (1911) 28 R.P.C. 492.....	11
Mander v. Falcke, (1891) 3 Ch. 488.....	226

Mandleberg v. Morley, (1893) 10 R.P.C. 256.....	209
Many v. Sizer, (1849) 1 Fish. 14.....	37, 231
Manton v. Parker, (1815) Davies P.C. 350.....	224
Marconi v. British Radio Telegraph and Telephone Co., (1911) 28 R.P.C. 181.....	11, 13, 16, 179
Mattice v. Brandon Machine Works Co., 17 Man. 105; 5 W.L.R. 410.....	16
Mason v. Vancamp, (1891) 14 P.R. 296.....	207
Mast v. Dempster, 82 Fed. 327; 27 C.C.A. 191.....	55
Mathers v. Green, (1865) L.R. 1 Ch. 29.....	114
Mathews v. Parmenter, (1896) 13 R.P.C. 519.....	86
Mattice v. Brandon Machine Works, (1907) 17 Man. 105.....	14
Maw v. Massey Harris Co., (1902) 14 Man. 252.....	204
McClain v. Ortmyer, 141 U.S. 419.....	8, 17, 57
McCoy v. Nelson, 121 U.S. 484; 30 L. Ed. 1017.....	216
McClurg v. Kingsland, 1 Howard 202.....	9, 130
McCormack Harvesting Machine Co. v. C. Aultman Co., 169 U.S. 607.	102, 175
McCormick v. Talcott, 61 U.S. 402.....	15, 16
McCormick v. Gray, (1861) 7 H. & N. 25; 31 L. J. Ex. 42.....	184
McDonald v. The King, (1906) 10 Ex. C.R. 338.....	189
McDougall v. Partington, (1890) 7 R.P.C. 216.....	124
M'Kenzie v. M'Glaughlin, (1884) 8 O.R. 111.....	123
McNeely v. Williams, 96 Fed. 973; 37 C.C.A. 641.....	56
Meadows v. Kirkman, (1860) 29 L.J.N.S. Ex. 205.....	221
Meldrum v. Wilson et al, (1901) 7 E.C.R. 198.....	12
Meters Ltd. v. Metropolitan Gas Meter Co. Ltd., (1910) 27 R.P.C. 721	232
Mica Insulator Co. v. Bruce Peebles & Co. Ltd., (1905) 22 R.P.C. 527..	207
Milburn v. Newton Colling Ltd., (1908) 52 Sol. Jo. 317.....	227
Miller v. Brass Co., 104 U.S. 350; 26 L. Ed. 783.....	57, 104, 105
Miller's Patent, 15 R.P.C. 205.....	61
Miller v. Searle Barker & Co., (1893) 10 R.P.C. 106.....	85
Mills in re, 117 O.G. 904.....	63, 64
Mills v. Carson, (1892) 9 R.P.C. 338, (1893) 10 R.P.C. 9.....	123, 124
Mills v. Scott, (1849) 5 U.C.Q.B. 360.....	206
Milner v. Kay, (1902) 1 O.W.R. 200.....	69, 70
Minter v. Wells, (1834) 1 C.M. & R. 505.....	15, 27
Mirror v. Shoemaker, 59 Fed. 120.....	49
Mitchell v. Hancock Inspirator Company, (1886) 2 Ex. C.R. 539. .14, 16, 148	
Mitchell v. Hawley, (1872) 16 Wall. 544.....	128
Moffatt v. Leonard, (1905) 5 O.W.R. 26.....	169, 208, 210, 212
Moneyweight Scale Co. v. Toledo Computing Scale Co., (1911) 187 F. 826.....	102
Monnet v. Beck, 14 R.P.C. 777.....	80
Moore v. Marsh, 74 U.S. 515.....	116
Moore v. Thompson, (1890) 7 R.P.C. 325.....	174

TABLE OF CASES CITED.

xxiii

Morgan v. Seward, (1837) 1 W.P.C. 170.....	177, 217
Morgan & Co. v. Windover & Co. (1888-1890) 5 R.P.C. 295; 7 R.P.C. 131.....	19, 40
Morley v. Lancaster, 129 U.S. 263; 32 L. Ed. 715; 9 S. Ch. 249.....	175
Morris v. Bransom, (1776) 1 W.P.C. 51.....	14
Morris v. Young, (1895) 12 R.P.C. 455.....	174
Morrison v. Moat, 9 Hare 241.....	162
Morton v. Middleton, (1863) 1 Macph. (Ct. of Sess.) 718.....	16
Mosely v. Victoria Rubber Co., (1886) 3 R.P.C. 351; 4 R.P.C. 241.....	220
Moser v. Marsden, (1893) 10 R.P.C. 350.....	26
Moser v. Sewell, (1893) 10 R.P.C. 365.....	217
Mueller v. Mueller, (1899) 95 F. 155.....	129
Muntz v. Foster, (1843) 2 W.P.C. 95.....	176, 215
Muntz v. Grenfell, (1842) 2 Web. P.C. 88.....	214
Murray v. Clayton, (1872) L.R. 7 Ch. App. 570.....	13
National v. Aiken, 163 Fed. 254.....	14, 16
National v. American, 53 Fed. 361.....	15
National v. Interchangeable, 106 Fed. 693.....	12, 18
National Cash Register Co. v. American Cash Register Co., 178 Fed. 79.....	63, 61
National Co. for the Distribution of Electricity by Secondary Generators v. Gibbs, (1899) 16 R.P.C. 339; 17 R.P.C. 302.....	113
National Opalite Glazed Brick & Tile Syndicate Ltd. v. The Ceralite Syndicate Ltd., (1896) 13 R.P.C. 649.....	226
National Phonograph Co. of Australia v. Menck, (1911) 28 R.P.C. 229.....	123, 144
Needham v. Oxley, (1878) 8 L.T.N.S. 604; 11 W.R. 745.....	233
Neil v. McDonald, (1902) 20 R.P.C. 213.....	125
Neilson v. Betts, (1871) L.R. 5 H.L. 1.....	185, 188, 227
Neilson v. Harford, (1841) 1 W.P.C. 295.....	77, 81
Nelson v. Thompson, (1841) 1 W.P.C. 275.....	216, 217
Nettlefolds v. Reynolds, (1892) 9 R.P.C. 270.....	174
New England v. Sturtevant, 150 Fed. 131; 80 C.C.A. 85.....	49
New Process Fermentation Co. v. Kock, 21 Fed. 580.....	96
New Ixion Tyre & Cycle Co. v. Spilsbury, (1898) 2 Cb. 484.....	117, 118
New York Herald Co. v. Ottawa Citizen Co., (1909) 41 S.C.R. 229 80, 93, 101	
Newall v. Elliot, (1863) 10 Jur. N.S. 954; 10 L.T. 792.....	190
Newton v. Grand Junction R. Co., (1846) 5 Ex. C.R. 331.....	16
Nobel's Explosives Co. v. Anderson, (1894) 11 R.P.C. 519.....	84,
168, 169, 172, 179	
Nobel's Explosives Co. v. Jones Scott & Co., (1881) 17 Ch. D. 721.....	189
Nordenfelt v. Gardner, (1884) 1 R.P.C. 61 C. A.....	10, 176, 180
North v. Williams, (1870) 17 Grant 179.....	16, 80
North British Rubber Co. v. Gormully & Jeffrey Manufacturing Co., (1894) 12 R.P.C. 17.....	216, 217

North British Rubber Co. v. Macintosh, (1894) 11 R.P.C. 477.....	226
North Jersey v. Brill, 134 Fed. 180.....	18
Noxon v. Noxon, (1894) 24 O.R. 401.....	123, 124
Noxon v. Patterson & Brother Co. 16 P.R. 40.....	207
Odell v. Stout, 22 Fed. 159.....	49
Oldham v. Longmead, (1789) Davies P.C. 157.....	120
Onduras v. Hovey, 124 U.S. 694.....	49
O'Reilly v. Morse, 15 Howard 621.....	222
Osram Lamp Works Ltd. v. Z. Electric Lamp Manufacturing Co. Ltd., (1912) 29 R.P.C. 421.....	10, 226
Ottawa and Hull Power Manufacturing Co. Ltd. v. Murphy, (1906) Q.R. 15 K.B. 230.....	216
Otto v. Linford, (1885) 46 L.T.N.S. 35.....	8, 84, 85
Overend v. Burrow, Stewart & Milne Co., (1909) 19 O.L.R. 642.....	18, 183, 215, 225
Owens v. Taylor, (1881) 29 Gr. 216.....	120, 124
Parkham v. American, 4 F.P.C. 468.....	39
Paradie (Ex Parte), 7 L.C.J. 130.....	201
Parker v. Ferguson, (1849) 1 Blatch. 407.....	47
Parker v. Hulme, 1 Fish. 45.....	47
Parker and Whipple Co. v. The Yale Lock Co., (1887) 123 U.S. 87.....	58, 102
Parkinson v. Simon, (1894) 11 R.P.C. 238, 493.....	174, 223
Parkinson's Patent, (1896) 13 R.P.C. 509.....	110
Parke v. Booth, 102 U.S. 96; 26 L. Ed. 54.....	61
Parkes v. Stevens, (1869) L.R. 8 Eq. 358.....	18
Parramore v. Boston Mfg. Co., (1902) 4 O.L.R. 627.....	220
Parrott v. Palmer, (1834) 3 M. & K. 632.....	234
Pashley v. Linotype Co. Ltd., (1903) 20 R.P.C. 633.....	28
Patent Type Foundry Co. v. Walter, (1860) 1 Johns 727.....	221
Pattee Plough Co. v. Kingman & Co., (1889) 129 U.S. 294.....	58, 102
Patterson v. Gas Light and Coke Co., (1876-8) L.R. 2 Ch. D. 812; 3 A.C. 239.....	36, 48
Patterson v. U.S., 181 F. 920.....	73
Patric v. Sylveeter, (1876) 23 Gr. 573.....	64, 102
Paulus v. Buck, 129 Fed. 594; 64 C.C.A. 162.....	116, 127
Peckover v. Rowland, (1893) 10 R.P.C. 118.....	174, 211
Penn v. Bihby, (1866) L.R. 3 Eq. 308; 2 Ch. App. 127.....	228
Penn v. Jack, (1868) L.R. 5. Eq. 81.....	228
Pennock v. Dialogue, (1829) 2 Pet. 1; 7 L. Ed. 327.....	56, 66
Pennsylvania v. Locomotive, 110 U.S. 480.....	12
Phelps v. Brown, (1859) 17 Howard 7.....	159
Philip v. Nock, 17 Wall. 460.....	231
Philips v. Ivel Cycle Co., (1890) 7 R.P.C. 77.....	235
Philpott v. Hanbury, (1885) 2 R.P.C. 38.....	25, 48, 76

TABLE OF CASES CITED.

XXV

Pickard v. Prescott, (1892) 9 R.P.C. 195.....	38
Piggott v. The Anglo-American Telegraph Co., (1868) 19 L.T.N.S. 46	220, 221
Piper v. Piper, (1904) 3 O.W.R. 451.....	28
Pitts v. Whittman, 2 Story 609.....	117
Pittsburg Reduction Co. v. Cowles Electric Co., 55 Fed. 301.....	57, 59
Planing Machine Co. v. Keith, 101 U.S. 479; 25 L. Ed. 939.....	40, 56, 59
Plating Co. v. Farquharson, (1891) Griff. P.C. 187.....	221, 227
Plimpton v. Malcolmson, (1876) L.R. 3 Ch. D. 531.....	77, 224
Plimpton v. Spiller, (1876) 6 Ch. D. 412.....	80, 84, 217, 228
Plimpton v. Winslow, 14 Fed. 921.....	63
Pneumatic Tyre Co. v. Puncture Proof Pneumatic Tyre Co., (1899) 16 R.P.C. 209.....	229
Pneumatic Tyre Co. v. Tubeless Tyre Co. et al, (1898) 15 R.P.C. 74	14, 177
Pontiac Knit Boot Co. v. Merino Shoe Co., 31 Fed. 280.....	117
Pope v. Gormully, 144 U.S. 248; 36 L.Ed. 420; 12 S. Ch. 637.....	116, 122
Poppenhusen v. New York Gutta Percha Comb Company, (1858) 2 Fish 62.....	223
Potts v. Creager, 155 U.S. 597.....	11, 18
Powell v. Begley, (1867) 13 Grant. 381.....	18
Power v. Griffin, (1902) 33 S.C.R. 39.....	139, 140, 147, 153
Pratt v. Wilcox Mfg. Co., (1893) 64 Fed. 592.....	118, 122
Presto Coat Collar Co. v. Levy Brothers, (1911) 28 R.P.C. 363 C.A.....	51
Presto Gear Case & Components Co. v. Orme, Evans & Co., (1900) 17 R.P.C. 218; 18 R.P.C. 17.....	174
Presto Gear Case & Components Co. v. Simplex Gear Case Co., (1898) 15 R.P.C. 635.....	174
Printing and Numerical Machinery Co. v. Sampson, (1875) L.R. 19 Eq. 462.....	121
Proctor v. Bayley, (1889) 6 R.P.C. 106, 538.....	184, 189, 225
Proctor v. Bennis, (1887) 36 Ch. D. 740 C.A.; 4 R.P.C. 333.....	10, 13, 130, 173, 176, 182, 234
Prouty v. Ruggles, 41 U.S. 336; 16 Pett. 336.....	15, 16
Queen v. La Force, (1894) 4 Ex. C.R. 14.....	30, 33, 86, 202, 222, 235
Queen v. Pattee, (1871) 7 L.J. 124.....	201
Queen v. The General Engineering Company of Ontario, (1900) 6 Ex. C.R. 328.....	196, 200
R. v. County Court Judge of Halifax, (1891) 1 Q.B. 793 (1891) 2 Q.B. 263	203
R. v. Wheeler, (1819) 2 B. & Ald. 349.....	23
Railway and Electric Appliances Co. In re, (1888) 38 Ch. D. 597.....	123
Railway Register Mfg. Co. v. Broadway & Seventh Avenue P.R. Co. (1886) 26 Fed. 522.....	58
Ralston v. Smith, (1865) 11 H.L. Cas. 223.....	11

Ransome v, The Mayor of New York, (1856) 1 Fisher. 242.....	39
Rat Portage Lumber Co. v. Equity Fire Insurance Co., (1907) 17 Man. L.R. 33	208
Read v. Andrew, (1885) 2 R.P.C. 119.....	217
Reckendorfer v. Faber, (1875) 92 U.S. 347	14, 16
Redges v. Mullinar, (1893) 10 R.P.C. 21.....	123, 124
Reed v. Cutter, 1 Storey, 590; Fed. Cas. No. 11645	87, 43
Reeves v. Keystone Bridge Co., 5 Fish. 546; Fed. Cas. No. 11660	49
Regina v. Smith, (1885) 7 O.R. 440	86, 201, 202
Reynolds v. Smith, Herbert & Co. (1902) 20 R.P.C. 123, 410.....	8, 10
Renard v. Levinstein, (1864-5) 2 H. & M. 828; 10 L.T. 94.....	119, 127, 215 219
Riley v. Easton (1852) Mac. P.C. 48.....	199
Rich v. Baldwin, 133 Fed. 920.....	18
Richard v. Duhon, 103 F. 868.....	3
Richardson v. Castrey, (1887) 4 R.P.C. 265.....	176
Richmond & Co. Ltd. v. Wrightson, (1904) 22 R.P.C. 25.....	129
Rickman v. Thierry, (1896) 14 R.P.C. 105.....	19
Rifle and Cartridge Co. v. Arms Co., (1885) 118 U.S. 24.....	56
Robert Mitchell v. The Hancock Inspirator Co., (1886) 2 Ex. C.R. 530	14, 16, 148
Rogere v. Fitch, 81 Fed. 959; 27 C.C.A. 23.....	49
Rollard v. Fournier, (1912) 4 D.L.R. 756	12, 225
Root v. Third Avenue R. Co., 146 U.S. 210; 36 L. Ed. 958	62, 63
Rothwell v. King, (1886) 3 R.P.C. 379.....	215
Rowcliffe v. Morris, (1886) 3 R.P.C. 17.....	81
Royal Electric Company of Canada v. The Edison Electric Light Co., (1889) 2 Ex. C.R. 576.....	141, 142, 147, 148
Rucker v. London Electric Supply Corp., (1900) 17 R.P.C. 279	48
Rude v. Westcott, (1889) 130 U.S. 152.....	230
Rushton v. Crawley, (1870) L.R. 10 Eq. 522.....	15
Russell v. Cowley, (1835) 1 W.P.C. 459.....	14, 26, 221
Russell v. Hatfield, (1885) 2 R.P.C. 144.....	268
Saccharin Corporation Ltd. v. Anglo-Continental Works Ltd., (1900) 17 R.P.C. 307 (1901) 1 Ch. 414.....	185
Saccharin Corporation Ltd. v. Chemicals and Drugs Co., (1900) 15 R.P.C. 53; 17 R.P.C. 28, 612; 743; 2 Ch. 656	219, 232
Saccharin Corporation Ltd. v. Dawson, (1902) 19 R.P.C. 169.....	185
Saccharin Corporation Ltd. v. Jackson, (1903) 20 R.P.C. 611.....	185
Saccharin Corporation Ltd. v. Mack, (1906) 23 R.P.C. 611.....	185
Saccharin Corporation Ltd. v. Quincey, (1900) 17 R.P.C. 337; 2 Ch. 246	225
Saccharin Corporation Ltd. v. Reitmeyer & Co., (1900) 2 Ch. 659; 17 R.P.C. 606.....	189
San Francisco v. Keating, 68 Fed. 357; 15 C.C.A. 476.....	14, 16
Samuel v. Fairgrieve, (1893) 24 O.R. 486, 490.....	238

TABLE OF CASES CITED.

xxvii

Sargent v. Hall, 114 U.S. 63; 29 L. Ed. 67; 5 St. 1021.....	59
Savage v. C.P.R., (1906) 16 Man. L.R. 378.....	208
Savage v. Harris, (1896) 13 R.P.C. 364.....	48, 84
Saxby v. Clunes, (1874) 43 L.T. Ex. 228.....	10
Saxby v. Easterbrook, (1872) L.R. 7 Ex. 207.....	228, 232
Saxby v. Gloucester Wagon Co., (1880) L.R. 7 Q.B.D. 305.....	8, 10, 28
Sayers v. Collyer, (1885) L.R. 28 Ch. D. 103.....	234
Schroeder v. Donatt, (1909) 14 O.W.R. 103.....	208
Schwarzwalder v. N.Y., 66 F. 152.....	111
Scott v. Hamling, (1897) 14 R.P.C. 123.....	174
Scott v. Hull Steam Fishing & Ice Co., (1897) 14 R.P.C. 143.....	174, 225
Seahury v. Am Ende, (1894) 152 U.S. 561.....	76
Seed v. Higgins, (1860) 8 H.L.C. 550.....	223
Seymour v. McCormick, 16 Howard. 480.....	231
Seymour v. Osborne, 78 U.S. 516; 11 Wall. 516.....	26, 52, 56
Sharples et al v. National Mfg. Co. Ltd., (1905) 9 Ex. C.R. 460; Audette's Practice of the Exchequer Court, 2nd Ed. p. 508.....	192, 227
Shaw v. Colwell Lead Co., (1882) 11 F. 711.....	51
Shaw v. Cooper, 7 Peters. 292; 8 L. Ed. 689.....	63, 66
Shaw v. Jones, (1889) 6 R.P.C. 328.....	177
Shaw v. The Bank of England, (1852) 22 L.J.N.S. Ex. 26.....	220, 221
Sheehan v. Great Western Railway, (1881) L.R. 16 Ch. D. 59.....	114
Shepard v. Carrigan, 116 U.S. 593; 29 L. Ed. 723; 6 S. Ct. 493.....	59
Shillito v. Larmuth Co. (1885) 2 R.P.C. 1.....	216
Shoe Machinery Co. v. Cutlan, (1896) 13 R.P.C. 141.....	174, 217
Shortt v. Federation Brand, (1899) 7 B.C.R. 197; 31 S.C.R. 378.....	81, 175, 204
Siddell v. Vickers Sons & Co., (1888-1892) 5 R.P.C. 416 C.A.; 9 R.P.C. 152.....	10, 228, 229
Sidebottom v. Fielden, (1891) 8 R.P.C. 266.....	212
Sims v. Slater, (1896) 10 C.L.T. 227.....	208
Simpson v. Holliday, (1886) L.R. 1 H.L. 315.....	52, 77, 78
Singer v. Walmsley, (1860) 1 Fisher 559.....	78
Singer Sewing Machine Co. v. Wilson, (1865) 12 L.T.N.S. 140.....	220
Sirdar Rubber Co. Ltd. v. Wallington Wills & Co., (1907) 24 R.P.C. 539.....	128, 188
Sisson v. Gilbert, 9 Blatch. 185.....	66
Smith v. Ball, (1861) 21 U.C.Q.B. 122.....	222
Smith v. Boyd, (1895) 17 P.R. 463; 18 P.R. 296.....	207
Smith v. Buckingham, (1870) 21 L.T.N.S. 819.....	120
Smith v. Goldie, (1883) 9 S.C.R. 46.....	13, 16, 19, 30, 60, 93, 139, 159, 168
Smith v. Goldie, (1885) 11 P.R. 24.....	13
Smith v. Goodyear, 93 U.S. 486; 23 L. Ed. 952.....	56, 216, 225
Smith v. Greey, (1885) 11 P.R. 169; 10 P.R. 482.....	58, 206, 210, 212, 218, 219
Smith v. London and North Western Railway Co., (1853) 2 E. & B. 69	114
Smith v. London and South Western Railway Co., (1854) Kay. 408; 23 L.J. 1 Ch. S. 62.....	227

Smith v. Mitchmore, (1849) 10 U.C.C.P. 391.....	122, 165
Smith v. Nichols, 21 Wallace. 119.....	18
Smith v. O'Connor, 4 O.G. 633; 2 Sawyer. 461; 6 Fish. 460.....	61
Smith and Davles v. Mellon, 58 Fed. 705; 7 C.C.A. 439.....	63
Smith, etc., Manufacturing Co. v. Sprague, 123 U.S. 249; 31 L. Ed. 141.....	62, 63, 64
Societe Anonyme de Manufactures de C'aces v. Tilghmans Patent Sand Blast Co., (1883) L.R. 25 Ch. D. 1.....	128, 192
Societe Fabrique v. Franco-American, (1897) 82 F. 439.....	130
Solomons v. United States, (1890) 137 U.S. 342.....	130
Solvo Laundry Co. v. Mackie, (1893) 10 R.P.C. 68.....	211
Spedding v. Fitzpatrick, (1887) 38 Ch. D. 410.....	207
Spencer v. Ancoats Vale Rubber Co. Ltd., (1889) 6 R.P.C. 46.....	227
Spencer v. Holt, (1902) 20 R.P.C. 142.....	215
Standard v. Peters, 77 Fed. 630; 23 C.C.A. 367.....	49
Stead v. Anderson, (1847) 2 W.P.C. 134.....	183
Stead v. Williams, (1844) 2 W.P.C. 126.....	40, 48
Steers v. Rogers, (1893) 10 R.P.C. 245.....	114
Stepney Spare Motor Wheel Co. Ltd. v. Hall, (1911) 28 R.P.C. 381.....	11
Stevens v. Keating, (1848) 2 W.P.C. 175, 2 Ex. 772.....	84, 179, 217
Stewart v. Casey, (1891) 8 R.P.C. 259; 9 R.P.C. 9.....	118
Sturtz v. De La Rue, (1828) 1 W.P.C. 83.....	78
Stiles v. Ecclestone, (1903) 1 K.B. 544.....	204
Sugg v. Bray, (1885) 2 R.P.C. 223.....	176
Summers v. Abell, (1869) 15 Grant. 532.....	16, 34, 62
Sunlight Incandescent Gas Light Co. v. Incandescent Gas Light Co., (1897) 14 R.P.C. 757.....	235
Swain v. Edlin-Sinclair Tyre Co., (1903) 20 R.P.C. 435.....	221
Swain v. Holyoke, 109 Fed. 154; 48 C.C.A. 265.....	63
Sykes v. Howarth, (1879) L.R. 12 Ch. D. 826.....	151, 184, 207
Taylor v. Archer, (1871) 8 Blatch. 318.....	111
Taylor v. Brandon, (1894) 21 O.A.R. 361.....	17, 78
Taylor's Patent, (1896) 13 R.P.C. 482.....	62
Tennant's Case, (1802) 1 W.P.C. 125.....	27
Tetley v. Easton, (1852) 2 C.B.N.S. 706.....	81, 219
Thermos Ltd. v. Isola Ltd., (1910) 27 R.P.C. 388.....	10, 11
The Telephone Cases, 126 U.S. 1.....	8, 9, 22, 40
Thompson v. Hughes, (1890) 7 R.P.C. 71.....	217, 227
Thompson v. James, (1863) 32 Beav. 570.....	15, 17
Thompson v. Moore, (1889-90) 6 R.P.C. 426; 7 R.P.C. 325.....	177, 179
Thompson-Houston v. Elmira, 71 Fed. 396; 18 C.C.A. 145.....	57
Thorn v. Worthing Skating Rink Co., (1876) L.R. 6 Ch. D. 415.....	177
Ticket Punch Register Co. v. Colley's Patents, (1894) 12 R.P.C. 171.....	174, 223

TABLE OF CASES CITED.

xxix

Tilgman v. Proctor, 102 U.F. 707.....	22, 39
Tilghman Patent Sand Blast Co. Ltd. v. Wright & Butler Ltd., (1884) 1 R.P.C. 16	208
Topliffe v. Topliffe, (1892) 145 U.S. 156.....	12, 58, 104
Toronto Auer Light Co. v. Colling, (1898) 31 O.R. 18.....	79, 83, 185, 193, 203, 205, 227, 233
Toronto Gravel Road Co. v. Taylor, (1875) 6 R.P. 227.....	220
Toronto Telephone Mfg. Co. v. Bell Telephone Co. of Canada, (1885) 2 Ex. C.R. 495, 524.....	14, 16, 152
Tubes Ltd. v. Perfecta Seamless Steel Tube Co. Ltd., (1900) 17 R.P.C. 569 (1903) 20 R.P.C. 77.....	77, 81, 84
Tuck v. Bramhill, (1868) 6 Blach. 95.....	111
Turner v. Winter, (1787) 1 W.P.C. 77.....	52, 78, 199
Tweedale v. Ashworth, (1890) 7 R.P.C. 426.....	184
Union v. U.S., 112 U.S., 624.....	110
United v. Greenman, 153 Fed. 283; 82 C.C.A. 591.....	41
United Horseshoe & Nail Co. v. Stewart, (1888) L.R. 13 App. Cas. 401.....	229, 230, 231
United Horseshoe & Nail Co. v. Swedish Horsenail Co., (1889) 6 R.P.C. 1.....	52
United Nickel Co. v. Railroad Co., (1888) 36 Fed. 186.....	230
United States, etc., Cartridge Co. v. Whitney Arms Co., 118 U.S. 22; 30 L. Ed. 53.....	56
United Telephone Co. v. Bassano, (1886) 3 R.P.C. 295.....	177
United Telephone Co. v. Dale, (1884) 25 Ch. D. 778	149, 187
United Telephone Co. v. Equitable Telephone Co., (1888) 5 R.P.C. 235.....	216
United Telephone Co. v. Harrison Cox-Walker, (1882) L.R. 21 Ch. D. 720.....	177
United Telephone Co. v. London & Globe Telephone & Maintenance Co. (1884) L.R. 26 Ch. D. 766; 1 R.P.C. 117.....	189, 233
United Telephone Co. v. Neilson, (1887) W.N. 192.....	188
United Telephone Co. v. Sharples, (1885) L.R. 29 Ch. D. 164; 2 R.P.C. 28	184
United Telephone Co. v. St. George, (1886) 3 R.P.C. 321.....	176, 177
United Telephone Co. v. Tasker, (1888) 5 R.P.C. 628.....	214
United Telephone Co. v. Walker, (1886) 4 R.P.C. 6.....	228, 229, 230
Universities of Oxford & Cambridge v. Richardson, (1802) 6 Ves. 689..	215
Upman v. Elkan, (1860) L.R. 7 Ch. 130.....	189
U.S. v. Berdan, 156 U.S. 552; 38 L. Ed. 530; 15 S. Ch. 420.....	181
U.S. v. Whitney, 118 U.S. 22; 30 L. Ed. 53; 6 S. Ch. 950.....	59
U.S. Credit System v. American Indemnity, 59 F. 139.....	24, 25
Untermeyer v. Freund, 58 Fed. 205; 7 C.C.A. 183.....	49
Unwin v. Heath, (1855) 5 H.L. Cases. 505.....	14, 179, 183, 199
Valveless Gas Engine Syndicate v. Day, (1899) 16 R.P.C. 97.....	121
Vance v. Campbell, Fed. Cas. No. 16337, 1 Black 427.....	15, 16

Van Gelder Co. v. Sowerhy, etc., Ltd., (1890) 7 R.P.C. 41.....	114, 119
Vanorman v. Leonard, (1845) 2 U.C.Q.B. 72.....	2, 29
Vavasseur v. Krupp, (1878) 9 Ch. D. 351.....	232
Vermilea v. Canniff, (1886) 12 O.R. 164.....	120, 124
Vermilyea v. Guthrie, 9 P.R. 269.....	221
Vickers v. Siddell, (1887-92) L.R. 15 App. Cas. 496; 5 R.P.C. 81, 416; 6 R.P.C. 464; 7 R.P.C. 292; 9 R.P.C. 152.....	14, 74, 79
Victor v. American, 145 Fed. 350; 78 C.C.A. 180; 143 U.S. 275.....	57
Victor v. H. A. Wilson Co., (1904) 7 O.L.R. 576.....	70, 161, 162, 163
Vidal Dye Syndicate Ltd. v. Levinstein Ltd., (1912) 29 R.P.C. 265 C.A.....	76, 77, 233
Vidi v. Smith, (1854) 23 L.J.N.S. 342.....	220
Voightman v. Perkinson, 138 Fed. 56.....	9
Von Heyden v. Neustadt, (1880) 14 Ch. D. 230.....	185
Von Schmidt v. Bowers, 80 Fed. 140; 25 C.C.A. 323.....	14
Wade v. Metcalf, 129 U.S. 202.....	129
Walker v. Hydrocarbon Syndicate, (1865) 2 R.P.C. 8.....	176
Wall v. Leck, 66 Fed. 552.....	10
Wallington v. Dale, (1852) 7 Ex. Ch. 888.....	14
Walmsley v. Eastern Hat & Cap Manufacturing Co., (1909) 43 N.S.R. 432.....	16, 78
Walsh v. Lonsdale, 21 Ch. D. 9.....	123
Walton v. Lavater, (1860) 8 C.B.N.S. 162.....	114
Walten C. Church Engineering Co. v. Wilson, (1886) 3 R.P.C. 123..	208
Walton v. Potter, (1841) 1 W.P.C. 585.....	168, 176, 209
Wapshare Tube Co. Ltd. v. Hyde Imperial Rubber Co., (1901) 18 R.P.C. 374.....	113, 215
Ward v. Hill, (1901-3) 18 R.P.C. 481; 20 R.P.C. 189.....	52, 294
Ward v. Livesey, (1888) 5 R.P.C. 102.....	123
Washburn v. Beat. Em. All, 143 U.S. 275; 36 L. Ed. 154; 12 Ct. 443 ..	89, 49
Washburn & Moen Mfg. Co. v. Cunard Steamship Co., (1889) 6 R.P.C. 398.....	189
Washburn & Moen Mfg. Co. v. Haish, 19 O.G. 73, 4 Fed. 900.....	103
Waterman v. Mackensie, 138 U.S. 252; 34 L. Ed. 923; 11 S. Ch. 334..	115, 116, 119, 122, 127
Waterman v. Shipman, 55 Fed. 982; 5 C.C.A. 371.....	119
Waterous v. Bishop, (1870) 20 U.C.C.P. 29.....	17
Watson v. Green, (1883) 2 O.R. 627; 10 O.A.R. 113.....	120, 124
Watson v. Harris, (1899) 31 O.R. 134.....	121
Watson Laidlaw & Co. Ltd. v. Potts, Cassel & Williamson, (1910) 27 R.P.C. 541; 28 R.P.C. 56,	77
Webb Lamp Co. v. Atkinson, (1902) 19 R.P.C. 599.....	229
Wegman v. Corcoran, (1879) 27 W.R. 331; 13 Ch. D. 65.....	235
Weighing Machine Co. v. Pneumatic Scale Corporation, 166 F.R. 288	42

TABLE OF CASES CITED.

XXXI

Wellman, Seaver & Head Ltd. v. Burstinghaus & Co. Ltd., (1911) 28 R.P.C. 326.....	232
Welshach Co. v. New Incandescent, etc., Co., (1900) 17 R.P.C. 237..	50
Welshach Incandeeent Gas Light Co. Ltd. v. Daylight Incandescent Mantle Co., (1899) 17 R.P.C. 141, 148.....	10
Welshach Incandeeent Light Co. v. Sheubein, Mar. 15, (1897) Audette Prac. of Ex. Ct. 2nd Ed. p. 509.....	8, 214
Wenham v. May, (1887) 4 R.P.C. 303.....	176
Werderman v. Societe Generale D'Electricete, (1881) 19Ch. D. 24 6..	118
Weetern v. Standard, 84 Fed. 654.....	18
Weethead v. Keene, (1838) 1 Beav. 287.....	114
Westinghouse v. Boyden, 170 U.S. 535.....	22
Westinghouse v. Stanley, 133 Fed. 174.....	41
Westinghouse Air Brake Co. v. Chicago Brake & Mfg. Co., 85 Fed. R. 786, p. 790.....	121
Westinghouse Electric & Mfg. Co. v. Wagner Electric & Mfg. Co., (1912) 32 U.S. Supreme. 691; 180 O.G. 323.....	229
Westlake v. Cartter, (1873) 6 Ficher 519.....	223
Weetley Richards v. Perkee, (1893) 10 R.P.C. 181.....	224
Westmoreland Specialty Co. v. Hogan, (1909) 167 F. 327; 163 F. 289...	18
Whiting v. Tuttle, (1870) 17 Gr. 454.....	120
Whitney v. Burr, 115 Ill. 289; 3 N.E. 434.....	117
Wickersham v. Singer, (1859) McArthur's Patent Cases. 689.....	56
Wilke, In Re (1891) 3 Ch. 59.....	113
Williams v. Hensman, 1 John H. 546.....	113
Williame v. Nye, (1890) 7 R.P.C. 62.....	13, 15, 16
Wills v. Dawson, (.863) 1 New Rep. 234.....	11
Wilson v. Coon, 18 Hatch. 535.....	104
Wilson v. Union Oil Mills, (1892) 9 R.P.C. 57.....	124
Wilson v. Wilson Brothers Bohhin Co. Ltd., (1911) 20 R.P.C. 733; 739 C.A.....	51
Winans v. Denmead, 15 How. 330.....	18
Winhy v. Manchester, etc., Steam Tramway Co., (1890) 8 R.P.C. 61.....	18, 48, 177
Wisner v. Coulthard, (1893) 22 S.C.R. 178.....	16, 80
Withington Cooley Manufacturing Co. v. Kenney, (1895) 68 F. 500....	130
Withrow v. Malcolm, (1884) 6 C.R. 12.....	58, 101, 103, 106
Wood v. Leadhitter, 9 Jur. 187.....	123
Wood v. Raphael, (1896) 13 R.P.C. 730.....	13
Wood v. Zimmer, (1815) 1 W.P.C. 82;.....	78, 198
Woodcock v. Parker, (1813) Fed. Cas. No. 17, 971; 1 Rohh. 37.....	44
Woodruff v. Eclipse Office Furniture Co. (1904) 4 O.W.R. 165....	123, 124
Woodruff v. Moeely, (1873) 17 L.C.J. 306.....	29
Woods v. Zimmer, (1815) 1 W.P.C. 44, 82.....	61, 78
Woodward v. Oke, (1906) 7 O.W.R. 881.....	12, 16
Woolensack v. Reiher, (1884) 115 U.S. 101.....	104
Worley v. Tobacco Co., 104 U.S. 340; 26 L. Ed. 821.....	62

Worthington Pumping Engine Company v. Moore, (1903) 20 R.P.C. 41	28, 129
Wren v. Wield, (1869) L.R. 4 Q.B. 213	192
Wright v. Hitchcock, (1870) L.R. 5 Ex. 37	183, 185
Wright v. Postell, 44 Fed. 352	56
Wveth v. Stone, (1850) 1 Story 291	111
Yale Lock Co. v. Berkshire Bank, (1890) 135 U.S. 342; 34 L. Ed. 168; 10 S. Ct. 884	56, 59
Yates v. Great Western, (1877) 2 O.A.R. 226; 24 Grant. 495	16, 18
Young v. Erie and H. Ry. Co., 17 P.R. 4	207
Young v. Foerster, (1889) 37 Fed. 203	128
Young v. Hermand Oil Co., (1892) 9 R.P.C. 373	125
Young v. Rosenthal, 1 R.P.C. 29	50
Z Electric Lamp Mfg. Co. v. Marples Leach & Co., (1909-10) 26 R.P.C. 677; 27 R.P.C. 305, 737	76, 213

CHAPTER I.

LEGISLATION.

There is by common law no property in an invention. An inventor can only acquire the right to the exclusive use of his invention by virtue of a special grant.

From early times the Sovereigns of England claimed and exercised the right of granting monopolies on certain trades, or producing articles within the realm, or importing them from other countries. Royal Prerogative.

The abuse of the power of granting monopolies led in the reign of James I. to the passing of the Statute of Monopolies (21 Jac. 1 C. 3). Section 1 of this statute declared all monopolies and all grants, licenses, charters and letters patent made or granted to any person for the sole buying, selling, making, working or using of anything within the realm should be utterly void and of none effect, and in nowise to be put in use or execution. Statute of Monopolies.

Section 6, however, read as follows:

“Provided also. and he it declared and enacted, That any Declaration before mentioned shall not extend to any Letters Patent and Grants of Privilege for the Term of fourteen Years or under, hereafter to be made of the sole Working or Making of any Manner of new Manufactures within this Realm to the true and first Inventor and Inventors of such Manufactures, which others at the Time of Making such Letters Patent and Grants shall not use, so as also they be not contrary to the Law, nor mischievous to the State, by raising Prices of Commodities at home, or Hurt of Trade, or generally inconvenient;”

This Act is said to have been merely declaratory of the common law. It defines the limits within which

letters patent may be granted. It does not change the basis of grant. This was left and still remains in England in the exercise of the royal prerogative.

**Basis of
Canadian
grant
statutory.**

All questions as to the prerogative right of the Crown to grant patents in Canada are merely of academic interest. From the time of the earliest local statutes dealing with patents the basis of the grant has been statutory and has not been the royal prerogative. The Statute of Monopolies has therefore had no application (*Adams v. Bell* [1850] 1 L.C.R. 136; *Vanorman v. Leonard* [1845] 2 U.C. Q.B. 72).

As has been pointed out, the different foundations for grants of patents in England and Canada have produced widely different results (*Electric Fireproofing Co. of Canada v. Electric Fireproofing Co.* [1910] 43 S.C.R. 182, per *Idington J.*, p. 186).

**Earliest
Canadian
statute.**

The earliest statute in Canada is 4 Geo. IV. (1823), c. 25, of Lower Canada. The object set forth in the preamble is the encouragement of Genius and of Arts in the Province.

This Act was apparently modeled after the United States Act of 1793 and provided for the grant to an inventor being an inhabitant of the province and a British subject of the "exclusive right and liberty of making, constructing, using and vending to others to be used" the "art, machine, manufacture or composition of matter" which he had invented. The Act required the filing of oath, specification, drawing and model, made provision for infringement and impeachment proceedings and for fees to be paid on application for patent.

A similar Act (7 Geo. IV., c. 5 U.C.) was passed in Upper Canada in 1826.

Slight amendments were made in the Act of Lower Canada by 9 Geo. IV., c. 47 L.C. (1829); 1 Wm. IV., c. 24 L.C. (1831) and 6 Wm. IV., c. 34 L.C. (1836). After the Union a consolidating Act (1849), 12 Vic., c. 24, was passed containing new provisions with respect to disclaimer, reissue, and the marking of patented articles.

Slight modifications of this Act appear in 14 and 15 Vic., c. 79 (1851) Can.; 16 Vic., c. 11 (1852) Can.; 20 Vic., c. 33 (1857) Can.; C.S.C., U.C. c. 21 (1859) Can., and C.S.C., c. 34 (1859) Can. and 29 Vic., c. 19 (1866) Can.

The Patent Acts in force in Nova Scotia, New Brunswick and Prince Edward Island were of similar form to those in Upper and Lower Canada. (See R.S.N.B. [1854] c. 118; R.S.N.S. [1864] c. 117.)

By the British North America Act "Patents of Invention and discovery" was one of the subjects assigned to the exclusive legislative authority of the Parliament of Canada. (See Sec. 91, '2.)

Following Confederation in the year 1869 a new and extensive Patent Act was passed (32-33 Vic., c. 11). This Act, which forms the groundwork of all subsequent Canadian legislation, was largely a copy of the United States Act of 1836. The immediate original of our patent law is therefore American rather than English.

First Act
after Con-
federation.
1869.

This Act repealed the Provincial Acts in New Brunswick and Nova Scotia as well as in Upper and Lower Canada, but continued existing patents in force for the territory covered by their original grant.

Section 6 of the Act of 1869 provided:

"Any person having been a resident of Canada for at least one year next before his application, and having invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement on any art, machine, manufacture or composition of matter not known or used by others before his invention or discovery thereof or not being at the time of his application for a patent in public use or on sale in any of the Provinces of the Dominion, with the consent or allowance of the inventor, or discoverer thereof may on a petition to that effect presented to the Commissioner . . . etc."

It will be noted that the Act required residence in Canada but not British nationality.

This Act was followed by a second general Act in Act of 1872. 1872, 35 Vic., c. 26.

In this Act the principal section, now 7, appeared in its present form as section 6. The requirement as to residence was removed, and public use permitted to con-

tinue for one year prior to application. The words "or discoverer" were omitted after the word "inventor."

Section 6 read:

"Any person having invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement in any art, machine, manufacture or composition of matter not known or used by others before his invention thereof, and not being in public use or on sale for more than one year previous to his application, in Canada with the consent or allowance of the inventor thereof, may, on a petition to that effect presented to the Commissioner, and on compliance with the other requirements of this Act, obtain a patent granting to such person an exclusive property therein."

Amendments to the Act of 1872 were made by 36 Vic., c. 44 (1873); 37 Vic., c. 44 (1874); 38 Vic., c. 14 (1875); 45 Vic., c. 22 (1882); 46 Vic., c. 19 (1883); 47 Vic., c. 38 (1884); 49 Vic., c. 25 (1886).

The Patent Act appeared in the revised statutes of 1886 as chapter 61. In the revision the comma in front of the words "in Canada" in section 6 was omitted.

Slight amendments relative to the office of the Deputy Commissioner of Patents and to procedure were made by 51 Vic., c. 18 (1886) and 53 Vic., c. 14 (1890).

Other amendments of a minor character were made to the Patent Act by 54 and 55 Vic., c. 26 (1891); 54 and 55 Vic., c. 33 (1891); 55 and 56 Vic., c. 24 (1892) and 56 Vic., c. 34 (1893).

Compulsory
license in-
troduced.

The Compulsory License System as a substitute for working with respect to certain inventions was introduced by 3 Ed. VII., c. 46 (1903).

The Patent Act as it appears to-day is chapter 69 of the Revised Statutes of Canada, 1906.

Combines
Investiga-
tion Act.

The Combines Investigation Act, 9-10 Edward VII. (1910), chap. 9, sec. 22, provides that a patent may be revoked if the owner so uses the same as "unduly to limit the facilities for transporting, producing, manu-

favouring, supplying, storing or dealing in any article which may be a subject of trade or commerce, or so as to restrain or injure trade or commerce in relation to any such article, or unduly to prevent, limit or lessen the manufacture or production of any article or unreasonably to enhance the price thereof, or unduly to prevent or lessen competition in the production, manufacture, purchase, barter, sale, transportation, storage or supply of any article."

The Bills of Exchange Act, R.S.C. 1906, c. 119, provides that every bill or note the consideration for which consists in whole or in part of the purchase money of an interest in a patent right shall bear across the face the words "Given for a patent right" and provides penalties for non-compliance with this requirement.

Bills of Exchange Act.

CHAPTER II.

SUBJECT MATTER.

The basis of most of the Canadian Patent Law is Section 7 of the Patent Act (R.S.C. 1906, c. 69). This section reads as follows:

"7. Any person who has invented any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement in any art, machine, manufacture or composition of matter, which was not known or used by any other person before his invention thereof, and which has not been in public use or sale with the consent or allowance of the inventor thereof, for more than one year previously to his application therefor in Canada, may, on a petition to that effect, presented to the Commissioner, and on compliance with the other requirements of this Act, obtain a patent granting to such person an exclusive property in such invention.

"2. No patent shall issue for an invention which has an illicit object in view, or for any more scientific principle or abstract theorem."

In order to obtain a patent the applicant must bring himself within the terms of this section.

1. He must have invented something.
2. That which he has invented must be an "art, machine, manufacture or composition of matter" or an "improvement in any art, machine, manufacture or composition of matter."
3. It must be new—not known or used by any other person before his invention thereof.
4. It must be useful.
5. It must not have been in public use or on sale with the consent or allowance of the inventor for more than

one year previously to his application for patent in Canada.

Each of these requirements will be treated separately.

We shall first consider what must have been done in order that the applicant can be held to have invented something, that is, what is meant by the word "invented" as used in the section.

Section 7 was undoubtedly copied from the United States Act of 1836 (5 Statutes at Large 119). Section 6 of this Act read in part as follows: History of section 7.

"And he it further enacted, that any person or persons having discovered or invented any new and useful art, machine, or manufacture or composition of matter, or any new and useful improvement on any art, machine, manufacture or composition of matter not known or used by others before his or their discovery or invention thereof, and not at the time of his application for a patent, in public use or on sale, with his consent or allowance, as the inventor or discoverer, and shall desire to obtain an exclusive property therein may make application in writing to the Commissioner of Patents, expressing such desire, and the Commissioner on due proceedings had, may grant a patent therefor."

In the Canadian Act of 1869 the words "invented or discovered" were used as in the United States enactment. In the Act of 1872, however, the word "discovered" was dropped. This change in wording probably made no change in the effect of the statute. The word "discovered" still remains in the United States Statutes, but it has been read as synonymous with "invented." (In re Kemper, McArthur's Patent Cases 4; Haffcke v. Clark [1891] 46 F. 772).

Invention has been described as the contriving or constructing of that which had not existed before, or as the finding out, contriving, devising or creating something new and useful, which did not exist before, by the operation of the intellect. In truth, however, no general definition has been given that affords any practical help in Definition of invention.

determining whether a given thing has involved invention or not. There must have been an exercise of the inventive faculty, but whether this has been present or not cannot be determined by applying the test of any general definition. (*McClain v. Ortmyer*, 141 U.S. 419 at p. 426.) The only help that can be obtained is from a consideration of the particular cases where the courts have held that invention has been present or absent.

Invention
and discov-
ery.

Every discovery is not necessarily an invention as the word is understood in patent law. A discovery may add to human knowledge and be of great benefit to mankind but fall short of being an invention. To constitute an invention it is not enough to disclose something which has before been unseen, or seen but dimly. There must not only be an addition to knowledge but there must be produced as the result of ingenuity a new and useful thing or result or a new method of producing an old thing or result. As expressed by the Canadian statute there must be a new "art, machine, manufacture or composition of matter" or a new improvement in an art, machine, manufacture or composition of matter. (*Lane-Fox v. Kensington and Knightsbridge Electric Lighting Co.* [1892] 9 R.P.C. 413; *Reynolds v. Smith (Herbert) & Co., Ltd.* [1902] 20 R.P.C. 123, 410; *Britain v. Hirsch* [1888] 5 R.P.C. 226 at p. 232; *Harwood v. Great Northern Railway Co.* [1865] 11 H.L.C. 654; *Horton v. Mahon* [1862] 12 C.B.N.S. 437; *Saxby v. Gloucester Waggon Co.* [1880] L.R. 7, Q.B.D. 305; *Welsbach Incandescent Gas Light Co., Ltd. v. Daylight Incandescent Mantle Co.* [1899] 17 R.P.C. 141, 148; *Case v. Cressey* [1900] 17 R.P.C. 255; *Acetylene Illuminating Co., Ltd. v. United Alkali Co., Ltd.* [1903] 20 R.P.C. 161, 173, 22 R.P.C. 145, 156.)

Application
of new prin-
ciples.

This distinction is especially important where the discovery is of some principle capable of practical application. The abstract principle is itself not an invention, but where the principle is applied in a practical way, as where a mechanical principle is used in a machine then we have an invention, and an invention which is regarded with great favor by the Courts. (*Otto v. Linford* [1881] 46 L.T.N.S. 35; *The Househill Co. v. Neilson* [1843] 1 W.P.C. 679, 685; *The Telephone Cases* 126 U.S. 1;

McClurg v. Kingsland, 1 Howard 202; Burr v. Duryee 68 U.S. 531; Voightman v. Perkinson 138 Fed. 56; Crossley v. Potter [1853] Macr. P.C. 240; Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate [1895] 12 R.P.C. 232, 256.)

In *Househill Co. v. Neilson* (1843) 1 W.P.C. 679, 685, the patent in question was for the so called "hot blast" invention. The inventor had discovered the principle that heated air supplied to a fire produced a more perfect combustion. He applied the principle practically by heating the blast of a furnace in a separate vessel before injecting into the furnace. Lord Justice Clerk Hope in addressing the jury said:

"The main merit, the most important part of the invention, may consist in the conception of the original idea, in the discovery of the principle in science, or of the law of nature, stated in the patent—and little or no pains may have been taken in working out the best manner and mode of the application of the principle to the purpose set forth in the patent. But still if the principle is stated to be applicable to any special purpose, so as to produce any result previously unknown, in the way, and for the objects described, the patent is good. It is no longer an abstract principle. It comes to be a principle turned to account to a practical object and applied to a special result. It becomes, then, not an abstract principle, which means a principle considered apart from any special purpose or practical operation, but the discovery and statement of a principle for a special purpose, that is, a practical invention, a mode of carrying a principle into effect."

The matter is thus put in an American case (*Telephone Case* 126 U.S. 1 at p. 533):

"In doing this (applying the undulatory theory of sound to practice) both discovery and invention in the popular sense of these terms, were involved, discovery in finding the art, and invention in devising the means for making it useful. For such discoveries, and such inventions the law has given the discoverer and inventor the right to a patent as discoverer for the useful art, process, method of doing a thing he has found, and as inventor

for the means he has devised, to make his discovery one of actual value."

(For other cases see *Reynolds v. Herbert Smith & Co.*, Ltd. [1902] 20 R.P.C. 123, 410; *Jandus Arc Lamp and Electric Co., Ltd. v. Arc Lamp Co.* [1905] 22 R.P.C. 277; *Britain v. Hirsch* [1888] 5 R.P.C. 226; *Harwood v. Great Northern Railway Co.* [1865] 11 H.L.C. 654; *Horton v. Mahon* [1862] 12 C.B.N.S. 437; *Saxby v. Gloucester Waggon Co.* [1880] L.R., 7 Q.B.D. 305; *Welschach Incandescent Gas Light Mantle Co. v. Daylight Incandescent Mantle Co., Ltd.* [1899] 17 R.P.C. 141; *Case v. Cressey* [1900] 17 R.P.C. 255, 261; *Acetylene Illuminating Co., Ltd. v. United Alkali Co., Ltd.* [1903] 20 R.P.C. 161, 173, 22 R.P.C. 156; *Wall v. Leck* 65 Fed. 552.)

The mere application of an old contrivance to an analogous use without novelty in mode of application is not invention (*Losh v. Hague* [1838] 1 W.P.C. 200; *Kay v. Marshal* [1841] 2 W.P.C. 71, 8 Cl. and Fin. 245), and this may be so even if the commercial success is met with (*Thermos, Ltd. v. Isola, Ltd.* [1910] 27 R.P.C. 388).

New application of old principle.

An old principle applied in a new way, however, or by new means may involve invention. (*Proctor v. Bennis* [1887] 36 Ch.D. 740, C.A.; *Gadd v. The Mayor, etc., of Manchester* [1892] 9 R.P.C. 516; *Brooks v. Lampugh* [1898] 15 R.P.C. 33; *Cassel Gold Extracting Co. v. The Cyanide Gold Recovery Syndicate* [1895] 12 R.P.C. 232; *Bush v. Fox* [1856] Macr. P.C. 152, 166, 178; *Harwood v. G.N.R.* [1865] 11 H.L.C. 654, 35 L.T.Q.B. 27; *Siddell v. Vickers, Sons & Co.* [1888] 5 R.P.C. 416, C.A.; *Curtis v. Platt* [1863] 3 Ch.D. 135; *Lister v. Leather* [1858] 8 E. & B. 1004; *Saxby v. Clunes* [1874] 43 L.T. Ex. 228; *Dudgeon Thomson* [1873] 3 App. Cas. 34; *Nordenfelt v. Gardner* [1884] 1 R.P.C. 61, C.A.; *Hocking v. Hocking* [1888] 6 R.P.C. 69, H.L.; *Osram Lamp Works v. Z-Electric Lamp Co.* [1912] 29 R.P.C. 421.)

Lord Justice Lindley in *Gadd v. The Mayor, etc., of Manchester* (1892) 9 R.P.C. 516, at p. 524, thus states the law:

"1. A patent for the mere new use of a known contrivance, without any additional ingenuity in overcoming fresh

difficulties, is had, and cannot be supported. If the new use involves no ingenuity, but is in manner and purpose analogous to the old use, although not quite the same, there is no invention: no manner of new manufacture within the meaning of the statute of James. 2. On the other hand, a patent for a new use of a known contrivance is good, and can be supported if the new use involves practical difficulties which the patentee has been the first to see and overcome by some ingenuity of his own. An improved thing produced by a new and ingenious application of a known contrivance to an old thing, is a manner of new manufacture within the meaning of the statute."

For other cases see *Lane-Fox v. Kensington & Knights-bridge Electric Lighting Co.* (1892) 9 R.P.C. 416; *Losh v. Hague* (1838) 1 W.P.C. 200; *Kay v. Marshall* (1841) 8 Cl. & Fin. 245; *Ralston v. Smith* (1865) 11 H.L. Cas. 223; *Wills v. Dawson* (1863) 1 New Rep. 234; *Main v. Ashley & Co.* (1911) 28 R.P.C. 492; *Thermos Ltd. v. Isola Ltd.* (1910) 27 R.P.C. 388; *Crane v. Price* (1842) 1 W.P.C. 393; *Stepney Spare Motor Wheel Co., Ltd. v. Hall* (1911) 28 R.P.C. 381; *British Liquid Air Co., Ltd. v. British Oxygen Co., Ltd.* (1909) 26 R.P.C. 509, H.L.; *Blackett v. Dickson & Mann, Ltd.* (1909) 26 R.P.C. 120; *Marconi v. British Radio Telegraph Co., Ltd.* (1911) 28 R.P.C. 181.

The leading American case of *Potts v. Creager* 155 American U.S. 597, deals with the transfer of a device from one cases. branch of industry to another as follows:

"But where the alleged novelty consists in transferring a device from one branch of industry to another, the answer depends upon a variety of considerations. In such cases we are bound to enquire into the remoteness of relationship of the two industries; what alterations were necessary to adapt the device to its new use, and what the value of such adaptation has been to the new industry. If the new use be analogous to the former one the court will undoubtedly be disposed to construe the patent more strictly and to require clearer proof of the exercise of the inventive faculty in adapting it to the new use particularly if the device be one of minor import-

ance in its new field of usefulness. On the other hand, if the transfer be to a branch of industry but remotely allied to the other, and the effect of such transfer has been to supersede other methods of doing the same work, the court will look with a less critical eye upon the means employed in making the transfer. Doubtless the patentee is entitled to every use of which his invention is susceptible, whether such use be known or unknown to him, but the person who has taken his device and by improvements thereon has adapted it to a different industry, may also draw to himself the quality of inventor." (See also *Pennsylvania v. Locomotive* 110 U.S. 480; *Ansonia v. Electrical* 144 U.S. 11; *Fisher v. American* 71 Fed. 523; *Loom Co. v. Higgins* 105 U.S. 580; *Topliff v. Topliff* 145 U.S. 156; *National v. Interchangeable* 106 Fed. 693.)

Canadian cases.

In *Bicknell v. Peterson* (1897) 24 O.A.R. 427, it was held that the application to a new purpose of an old mechanical device out of the track of its former use and not in nature naturally likely to suggest itself to one skilled in the art was patentable. The case related to the application of rolling contact to an oil pump. Rolling contact was old but its use in a pump for the purpose of avoiding friction was held to be new.

This case was followed in *Ward v. Oke* (1906) 7 O.W.R. 881. In the judgment it was stated, "No doubt the swivel is an old mechanical device, but the application to a new purpose of an old mechanical device is patentable when the new application lies so much out of the track of its former use as not naturally to suggest itself to a person turning his mind to the subject, but requires thought and study." *Abell v. McPherson* (1870) 17 Grant 23, (1871) 18 Grant 437 is to the same effect. In this case it was held that if the patentee's invention had never before been applied to the same class of machines, but had been applied to other machines he can claim invention. (For Canadian authorities see also *Meldrum v. Wilson et al.* [1901] 7 Ex. C.R. 198; *Rolland v. Fournier* [1912] 4 D.L.R. 756.)

Combinations.

An important class of inventions is that known as combinations. Frequently the word combination is used, especially in the specification of a patent to describe any invention made up of parts more or less complex. Tech-

nically, however, the word is used to refer to cases where there is some interaction or functional co-operation of the parts, producing a separate entity having a result and characteristics different from the sum of the individual results and characteristics of its elements. Buckley, L.J., in *British United Shoe Machinery v. Fussell* (1908) 25 R.P.C. 631, 657, defined a combination as meaning "a collocation of intercommunicating parts with a view to arrive at a simple result." (*Proctor v. Bennis* [1887] 36 Ch.D. 740; *Wood v. Raphael* [1896] 13 R.P.C. 730; *Crane v. Price* [1842] 1 W.P.C. 383, 409; *Murray v. Clayton* [1872] L.R. 7 Ch. App. 570.)

Combinations when they produce a new result or a known result in a new way are considered to be patentable inventions. (*British United Shoe Machinery Co. v. Fussell* [1908] 25 R.P.C. 651; *Williams v. Nye* [1890] 7 R.P.C. 62; *Wood v. Raphael* [1896] 13 R.P.C. 730; *Anti-Vibration Incandescent Lighting Co. v. Crossley* [1905] 22 R.P.C. 441; *Goddard v. Lyon* [1894] 11 R.P.C. 354; *Marconi v. British Radio Telegraph & Telephone Co.* [1911] 28 R.P.C. 181; *British Westinghouse Electric and Mfg. Co. v. Braulik* [1910] 27 R.P.C. 209, C.A.; *International Harvester Co. of America v. Peacock* [1908] 25 R.P.C. 777; *Gramophone and Typewriter Co., Ltd. v. Ullman* [1906] 23 R.P.C. 752, C.A.)

All of the elements of a combination may be old, but the combination may itself constitute an invention. (*Lister v. Leather* [1857] 8 E. & B. 1004; *Bovil v. Keyworth* [1857] 7 E. & B. 725; *Crane v. Price* [1842] 1 W.P.C. 383.)

All the elements may be old.

The leading Canadian case of *Smith v. Goldie* [1883] 9 S.C.R. 46, deals with this point. The headnote reads:

"An invention consisted of the combination in a machine of three parts, or elements, A, B and C, each of which was old, and of which A had been previously combined with B in one machine, and B and C in another machine, but the united action of which in the patented machine, produced new and useful results. Held (Strong, C.J., dissenting) to be a patentable invention."

In the judgment Ritchie, J., said:

"Where the patent is for a combination, the combination itself is the novelty and also the merit."

And Henry, J.:

"The result in this case is produced by the combined and simultaneous action of the draft upwards created by the fan, and the continuous operation of the brush or brushes worked by the machinery as described in the specification. It was the simultaneous action which produced the result. . . . By the co-operation of the constituents, a new machine of a distinct character and function was formed, and a beneficial result produced by the co-operating action of the constituents, and not the mere adding together of the separate contributions."

For other Canadian authorities on combinations see Toronto Telephone Mfg. Co. v. Bell Telephone Co. of Canada (1885) 2 Ex. C.R. 495; Robert Mitchell v. The Handcock Inspirator Co. (1886) 2 Ex. C.R. 539; Griffin v. Toronto Railway (1902) 7 Ex. C.R. 411; Mattice v. Brandon Machine Works (1907) 17 M.L.R. 105; Dansereau v. Bellmare (1889) 16 S.C.R. 180; Barnet McQueen v. Canadian Stewart (1910) 13 Ex. C.R. 186.

If any of the elements of a combination are new, they may themselves be claimed as subordinate integers. (Barnet McQueen v. Canadian Stewart [1910] 13 Ex. C.R. 186.)

Omission or addition of an element from a combination.

A new combination may be formed by the omission of an element from, or by the addition of an element to the elements of an old combination, provided there is a new result produced by a different interaction of the elements. (Pneumatic Tyre Co. v. Tubeless Tyre Co. et al. [1898] 15 R.P.C. 74; Wallington v. Dale [1852] 7 Exch. 888; Russell v. Cowley [1835] 1 W.P.C. 459; Morris v. Bransom [1776] 1 W.P.C. 51; Vickers v. Siddell [1890] L.R. 15, App. Cas. 496.) The substitution of a new element in an old combination, if the element substituted is not obviously and demonstrably an equivalent of the one for which it was substituted may involve invention. (Unwin v. Heath [1855] 5 H.L. Cases, 508, 522, 1 W.P.C. 551; Badische Anilin und Soda Fabrik v. Levinstein [1885] 2 R.P.C. 73.)

For American cases on combination see San Francisco v. Keating 68 Fed. 357, 15 C.C.A. 476; Von Schmidt v. Bowers 80 Fed. 140, 25 C.C.A. 323; American v. Helmstetter 142 Fed. 978, 74 C.C.A. 240; National v. Aiken 163 Fed. 254; Hoffman v. Young 2 Fed. 74; Na-

tional v. American 53 Fed. 369; Green v. American 78 Fed. 119, 24 C.C.A. 41; Gill v. Wells 89 U.S. 1; Electric v. Hall 114 U.S. 87; Prouty v. Ruggles 41 U.S. 336; McCormick v. Talecott, 61 U.S. 402; Vance v. Campbell 16,837 Fed. Cas.; Dunbar v. Myers 94 U.S. 187.

It is necessary to distinguish combinations from mere aggregations. Aggregation is not invention either in processes, machines, or manufactures. (*Hailes v. Van Wormer* [1873] 20 Wall 353.) The elements which are collocated in an aggregation may themselves, if new, amount to separate inventions, but assembling these elements, unless there is interaction, can produce no new result, and there can therefore be no invention. For example, in *Reekendorfer v. Faber* (1875) 92 U.S. 347, a rubber eraser was placed on the end of a pencil and a patent claimed for the alleged combination. The Supreme Court of the United States held that the pencil and eraser each continued to perform its own duty and nothing else. No effect was produced; no result followed from the use of the two and consequently the union was an aggregation and not invention. (See also *Williams v. Nye* [1890] 7 R.P.C. 62; *Thompson v. James* [1863] 32 Beav. 570; *Rushton v. Crawley* [1870] L.R. 10, Eq. 522.)

Combinations distinguished from aggregations.

The test of a combination is the presence of a result different from the individual results of its elements. *Buckley, L.J.*, in *The British United Shoe Machinery Co. v. Fussell* (1908) 25 R.P.C. at p. 657, thus states the rule: "For this purpose a combination, I think, means not every collocation of parts, but a collocation of intercommunicating parts so as to arrive at a desired result, and to this, I think, must be added that the result must be what, for the moment, I will call a simple and not a complex result. . . . It is not every combination of parts which is for this purpose a combination."

For other English authorities see *Crane v. Price* (1842) 1 Web. P.C. 377; *Cannington v. Nuttall* (1871) L.R., 5, H.L. 205; *Huddart v. Grimshaw* (1803) 1 Web. P.C. 86; *Bovill v. Keyworth* (1857) 7 E. & B. 725; *Minter v. Wells* (1834) 1 Cr. M. & R. 505; *Anti-Vibration Incandescent Lighting Co. v. Crossley* (1905) 22 R.P.C. 445;

British United Shoe Machinery Co., Ltd. v Fussell (A. & Sons) (1908) 25 R.P.C. 257; Williams v. Nye (1890) 7 R.P.C. 62; Newton v. Grand Junction R. Co. (1846) 5 Exch. 331, 334; Boulton v. Bull (1795) 2 H. Bl. 463; Lister v. Leather (1895) 8 E. & B. 1004; Morton v. Middleton (1863) 1 Macph. (Ct. of Sess.) 718; Marconi v. British Radio Telegraph & Telephone Co. (1911) 28 R.P.C. 181; British Westinghouse v. Braulik (1910) 27 R.P.C. 209.

The same distinction was drawn in Hunter v. Carrick (1884) 11 S.C.R. 300, where it was held that a mere aggregation of parts not in themselves patentable and producing no new result due to the combination itself, was not invention, and consequently it could not form the subject of a patent.

For Canadian cases see North v. Williams (1870) 17 Grant 179; Walmsley v. Eastern Hat & Cap Mfg. Co. (1909) 43 N.S.R. 432; Smith v. Goldie (1883) 9 S.C.R. 46; Dompierre v. Barile (1889) 18 R.L. 597, Q.B.; Wisner v. Coulthard (1893) 22 S.C.R. 178; Copeland-Chatterson v. Lyman Bros. (1907) 9 O.W.R. 908, 912; Yates v. Great Western (1877) 2 O.A.R. 226; Woodward v. Oke (1906) 17 O.W.R. 881; Toronto Telephone Mfg. Co. v. Bell Telephone Co. of Canada (1885) 2 Ex. C.R. 495; Robert Mitchell v. The Handcock Inspirator Co. (1886) 2 Ex. C.R. 539; Griffin v. Toronto Railway (1902) 7 Ex. C.R. 411; Mattice v. Brandon Machine Works Co., 17 M.L.R. 105; Emery v. Hodge (1861) 11 U.C.C.P. 196; Summers v. Ahell (1869) 15 Grant 532.

For United States Authorities see Gill v. Wells 89 U.S. 1; Electric v. Hall 114 U.S. 87; Prouty v. Ruggles 16 Pett. 336; McCormick v. Talecott 61 U.S. 402; Vance v. Campbell 1 Black 427; Dunhar v. Myers 94 U.S. 187; San Francisco v. Keating 68 Fed. 351; Hailes v. Van Wormer 20 Wall 353; Reckendorfer v. Faher 192 U.S. 347; American v. He...stetter 142 Fed. 978; National v. Aiken 163 Fed. 254, C.C.A.

Mechanical
skill.

It is not invention to produce something which any skillful mechanic, electrician, chemist or other expert would produce whenever required. In Atlantic Works v. Brady (1882) 107 U.S. 199, Mr. Justice Bradley gave a

statement of the law which has been referred to in many cases in the United States:

"The process of development in manufactures creates a constant demand for new appliances, which the skill of ordinary head workmen and engineers is generally adequate to devise, and which, indeed, are the natural and proper outgrowth of such development. Each step forward prepares the way for the next, and each is usually taken by spontaneous trials, and attempts in a hundred different places. To grant to a single party a monopoly of every slight advance made, except where the exercise of invention somewhat above ordinary mechanical or engineering skill is distinctly shown, is unjust in principle and injurious in its consequences. The design of the patent laws is to reward those who make some substantial discovery or invention which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufacture." (Allen v. Reid [1888] 14 O.L.R. 126; Dredge v. Parnell [1898] 16 R.P.C. 625.)

The substitution of one known material for another known material to produce the same result even though there may be increased efficiency resulting from the substitution is generally within the range of expert skill, and therefore does not constitute invention. In a leading Canadian case, *Ball v. Crompton Corset Co.* (1887) 13 S.C.R. 469, a metal spring substituted for india-rubber in a corset was held to be a mere mechanical equivalent. (See also *Ansonia v. Electrical* 144 U.S. 11; *McClain v. Ortmyer* 141 U.S. 419, 12 S.Ct. 76; *Loom Co. v. Higgins* 105 U.S. 580; *Dunbar v. Myers* 94 U.S. 187; *Baril v. Masterman* (1881) 4 L.N. 181; *Waterous v. Bishop* (1870) 20 U.C.C.P. 29; *Taylor v. Brandon* (1894) 21 A.R. 361; *Thompson v. James* (1863) 32 Beav. 570.

Substitution of material.

Where, however, the substituted material is one which to the skilled person would not be an obvious equivalent for that for which it is substituted, and the substitution results in new properties or uses in the product, there may be invention. For example, it has been held that the use of

celluloid for the top of a salt-cellar instead of metal, having the advantage that moisture was not collected and imparted to the salt was a good invention. (*Westmoreland Specialty Co. v. Hogan* [1909] 167 F. 327, 163 F. 289.)

See also *Edison & Swan, etc., v. Woodhead* (1887) 4 R.P.C.; *Parkes v. Stevens* (1869) L.R. 8, Eq. 358; *Winhy v. Man; chester, etc., Steam Tramways Co.* (1890) 8 R.P.C. 61, 67-*Crane v. Price* (1840) 1 Web. P.C. 375; *Potts v. Creager* (1894) 155 U.S. 597 at p. 608; *Edison v. U.S.* 52 Fed. 308; *Smith v. Nichols* 21 Wallace 119; *Geo. Frost Co. v. Lamstag* (1910) 180 Fed. 739; *Celluloid v. Tower* 26 Fed. 451; *Rich v. Baldwin* 133 Fed. 920; *North Jersey v. Brill* 134 Fed. 180; *Hotchkiss v. Greenwood* 11 How. 248; *Hicks v. Kelsey* 95 U.S. 620.

Change of form or shape may be invention.

Changes of form or shape are not always to be regarded as the result of mechanical skill. There may be sufficiently important, beneficial and new results in some cases to warrant a claim for invention. In the case of the *General Engineering Company of Ontario v. The Dominion Cotton Mills & American Stoker Co.* 1902 A.C. p. 570, 31 S.C.R. 75, 6 Ex. C.R. 306, the invention resided in a slight change in the shape of the hawl of the fuel chamber. (See also *Winans v. Denmead* 15 How. 330; *Western v. Standard* 84 Fed. 654; *National v. Interchangeable* 106 Fed. 696.)

In *Overend v. Burrow, Stewart & Milne Co.* (1909) 19 O.L.R. 642, a new setting and inclination of the teeth of curry-combs was held to involve invention in view of the superior results produced.

Evidence of invention simplicity.

Simplicity is no evidence of want of invention. As expressed by Spragge, V.C., in *Yates v. The Great Western Railway Co.* (1877) 24 Grant 495, 2 O.A.R. 226 "The great simplicity of an invention is not a ground of objection to a patent therefor, it is rather a recommendation in favour of it." (See also *Powell v. Begley* [1867] 13 Grant 381) and *Benno Jaffé und Darmstaedter Lanolin Fabrik v. Richardson (John) & Co., Ltd.* [1904] 21 R.P.C. 303.)

Commercial success.

Commercial success and extended use will tip the scales when the issue is in doubt but not otherwise.

(Riekman v. Thierry [1896] 14 R.P.C. 105; Fawcett v. Homan [1896] 13 R.P.C. 398; Longhottom v. Shaw [1891] 8 R.P.C. 333; Morgan & Co. v. Windover & Co. [1890] 7 R.P.C. 139.) Due consideration will always be given to the fact that a large and profitable business has been established on the patent (Copeland-Chatterton v. Paquette et al. [1906] 10 E.C.R. 410). But as stated in the American case of *Kremetz v. Cottle* (148 U.S. 556): "The argument drawn from commercial success is not always to be relied on. Other causes, such as the enterprise of the vendors and the lavish expenditures in advertising may co-operate to promote a large demand. But when the other facts in the case leave the question of invention in doubt, the fact that the device has gone into general use and has displaced other devices which have previously been employed for analogous use is sufficient to turn the scale in favour of the existence of invention."

The success of a device in performing a certain purpose where the use of other similar devices have proved a failure, shows invention, even if the actual change made in construction is slight. (General Engineering Company of Ontario v. Dominion Cotton Mills & American Stoker Co. [1902] A.C. 570, 6 Ex. C.R. 306; Gosnell v. Bishop [1888] 5 R.P.C. 188; American Braided Wire Co. v. Thomson [1890] 5 R.P.C. 125, C.A.; Blakey & Co. v. Latham, Ltd. [1889] 6 R.P.C. 187; Gammons v. Battershy [1901] 21 R.P.C. 322.)

Success in practice.

Whether or not the invention is the result of study and experiment or is an accidental discovery is immaterial. As stated by Henry, J., in *Smith v. Goldie* (1883) 9 S.C.R. 48, "There have been some most important inventions made by mere accidental discovery, and after being discovered, the great wonder has been, that what appears after discovery so palpable, had never been discovered before. Such may be said, to some extent of the discovery in this case, but that is no reason why the inventor should not get the benefit of his discovery through its protection as provided by law."

Invention may be result of accident.

The Canadian Statute following the American, adopts the classification of inventions into "art, machine, manufacture or composition of matter." It is not seen that anything is included which is not covered by the term

Canadian classification.

Cf. English. "manufacture" as used in the English Statutes. It is, however, not certain that the field in Canada is co-extensive with that in England. Iddington, J., in *Electric Fireproofing Co. of Canada v. Electric Fireproofing Co.* (1909) 43 S.C.R. 182, said at p. 185: "Our statute defines what is patentable. I am not clear that the ground it covers is identical with that portion of the Royal Prerogative reserved and preserved by statute as the foundation in England for grants of the like kind of rights. Invaluable as is the long line of authority moulding the limits of the latter basis for a grant, we must not forget that the basis here rests upon an express statutory limitation, not by any means quite identical with the other."

Cf. American. The language of the section is the same as that of the United States enactment. With regard to the American section, Commissioner Butterworth in *Ex Parte Blythe* 30, O.G. 1321, said: "It is evident that the words 'art,' 'machine,' 'manufacture,' and 'composition of matter' were carefully chosen to cover what were regarded as four great and distinct classes of invention. It is undoubtedly the intention of the law to distinguish as separate inventions 'a new art,' 'a new machine,' 'a new manufacture,' 'a new composition of matter.'"

Each of the terms has received a separate interpretation in the United States.

"Process" defined. The term "art" as used has been held to be practically synonymous with "process." An early and comprehensive definition of a process appears in *Corning v. Burden* 15 How. 252, 267, by Grier, J.:

"A process, *eo nomine*, is not made the subject of a patent in our Act of Congress. It is included under the general term 'useful art.' An art may require one or more processes or machines in order to produce a certain result or manufacture. The term 'machine' includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result. But where the result or effect is produced by chemical action by the operation or application of some element or power of nature, or of one substance to another, such modes, methods or operations are called processes. A new process is usually the result of discovery, a machine of invention. The art of tanning,

dyeing, making water-proof cloth, vulcanizing india-rubber, smelting ores, and numerous others, are usually carried on by processes as distinguished from machines. One may discover a new and useful improvement in the process of tanning, dyeing, etc., irrespective of any particular form of machinery or mechanical device, and another may invent a labour-saving machine by which this operation or process may be performed, and each may be entitled to his patent. . . . It is when the term 'process' is used to represent the means or method of producing a result that it is patentable, and it will include all methods or means which are not effected by mechanism or mechanical combinations."

A question much discussed in the United States cases was whether a mechanical process, as such and apart from the mechanism employed for carrying it out was patentable subject matter. Mechanical processes.

The question was finally settled, and mechanical processes sustained by the Supreme Court of the United States in *Expanded Metal Co. v. Bradford* 214 U.S. 366. Mr. Justice Day, who rendered the opinion of the court, said:

"The word 'process' is not used in the statute. The inventor of a new and useful art is distinctly entitled to the benefit of the statute as well as he who invents a machine, manufacture or composition of matter."

"It is undoubtedly true, and all the cases agree, that the mere function or effect of the operation of a machine cannot be the subject matter of a lawful patent. But it does not follow that a method of doing a thing, so clearly indicated that those skilled in the art can avail themselves of mechanism to carry it into operation, is not the subject matter of a valid patent. The contrary has been declared in decisions of this court. A leading case is *Cochrane v. Deener*, 94 U.S. 780, in which this court sustained a process patent involving mechanical operations, and in which the subject was discussed by Mr. Justice Bradley, speaking for the court. On page 787 that learned Justice said: 'That a process may be patentable, irrespective of the particular form of the instrumentalities used, cannot be disputed. . . . Either may be pointed out; but, if the patent is not confined to that particular tool or machine, the use of the others would be an infringement,

the general process being the same. A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing. If new and useful, it is just as patentable as is a piece of machinery. In the language of the patent law, it is an art. The machinery pointed out as suitable to perform the process may or may not be new or patentable, whilst the process itself may be altogether new and produce an entirely new result. The process requires that certain things should be done with certain substances and in a certain order; but the tools to be used in doing this may be of secondary consequence."

The judgment then pointed out that the statement of the rule had been recognized and applied (*Tilghman v. Proctor* 102 U.S. 707) and that subsequent cases showed that the Supreme Court had not intended to limit process patents to those showing chemical action or similar elemental changes. In support of this, quotations were made from the judgments in *Westinghouse v. Boyden* 170 U.S. 535; *Carnegie Steel Co. v. Cambria Iron Co.* 187 U.S. 403; *The Telephone Cases* 126 U.S. 1; *Leeds & Catlin v. Victor Talking Machine Co.* 213 U.S. 301. The conclusion of the court was given in these words:

"We therefore reach the conclusion that an invention or discovery of a process or method involving mechanical operations, and producing a new and useful result, may be within the protection of the Federal Statute, and entitle the inventor to a patent for his discovery."

Machine.

The term machine as stated in *Corning v. Burden* (15 Howard 252) "includes every mechanical device or combination of mechanical powers and devices to produce some function and to produce a certain effect or result." Further definitions are found in *Chicago Sugar Refining Co. v. Pope Glucose Co.* 84 Fed. 981; *Burr v. Juryee* 68 U.S. 531.

English meaning of term "manufacture."

The words "any manner of new manufacture" used in the Statute of Monopolies have by construction been given a very comprehensive meaning, to include anything made by the hand of man, or the practice of making a thing or producing a result. (*Hornblower v. Boulton* [1795] 8 T.R. 99.)

The extended significance of the term is noted by Eyer, C.J., in *Boulton v. Bull* (1795) 2 H. Bl. 463 at p. 493. "It was admitted in the argument at the bar, that the word 'manufacture' in the statute was of extended signification; that it applied not only to things made, but to the *practice of making*, to principles carried into practice in a new manner, and to new results of principles carried into practice. Let us pursue this admission. Under things made, we may class in the first place, new compositions of things, such as manufactures in the most ordinary sense of the word; secondly, all mechanical inventions, whether made to produce old or new effects, for a new piece of mechanism is certainly a thing made. Under the practice of making we may class all new artificial manners of operating with the hand, or with instruments in common use, new process in any art producing effects useful to the public."

A further definition is given by Ahhot, C.J., in *R. v. Wheeler* (1819) 2 B. & Ald. 349: "Now the word 'manufactures' has been generally understood to denote either a thing made, which is useful for its own sake, and vendible as such, as a medicine, a stove, a telescope, and many others, or to mean an engine or instrument, or some part of an engine or instrument to be employed, either in the making of some previously known article, or in some other useful purpose, as a stocking frame, or a steam engine for raising water from mines. Or it may perhaps extend also to a new process to be carried on by known implements or elements, acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or of a better and more useful kind. But no merely philosophical or abstract principle can answer to the word 'manufactures.' Something of a corporeal and substantial nature, something that can be made by man from the matters subjected to his art and skill, or at the least some new mode of employing practically his art or skill, is requisite to satisfy this word."

Since our statute following that of the United States has made an enumeration of the different classes of subjects which in England are held patentable, it is to be presumed that the term "manufacture" must be restricted

in meaning so as to exclude the other classes. It may be taken to cover anything made by the art or industry of man, not being an "art," "machine" or "composition of matter." (Curtis's Law of Patents, p. 827; Walker on Patents, sec. 17.)

In *Johnston v. Johnston* (60 F. 618) it is stated: "The term 'manufacture' as used in patent law, has a very comprehensive sense, embracing whatever is made by the art or industry of man, not being a machine, a composition of matter or a design." An "art" is obviously excluded by the wording of this definition.

Composition
of matter.

The last class, "composition of matter," does not require much discussion. Archihald, J., in *Electric Fireproofing Co. of Canada v. Electric Fireproofing Co.* (1909) Q.R. 34 S.C. 388, held that the words "composition of matter" included all composite matter whether it was the result of chemical reaction, or of mechanical mixture, and that the latter might, therefore, be the subject of a patent.

To classify an invention under one of the heads given in the Act is often very difficult. However, as stated by Mr. Walker, sec. 19: "If an inventor is certain that his invention belongs to one or another of the three classes of things, but is uncertain as to which, no evil need result from the doubt. No inventor needs to state or to know whether the thing he had produced is a machine, a manufacture or a composition of matter, provided he knows that it is one or the other of these."

Business
systems.

While the patent field is wide, it is not so wide as sometimes supposed. Unsuccessful attempts have been made from time to time to obtain patents for certain classes of business systems.

In considering such systems, it has not been necessary in most instances to determine whether they fell within the classification of matter or not, for the reason that it has appeared that even if they did fall within such classification there was not sufficient ingenuity to involve invention. (*U.S. Credit System v. American Indemnity* 59 F. 139.) In some instances, however, it has been specifically held that systems of this kind do not fall within the limits of the field of patentable inventions.

In *Ex Parte Meinhardt* (1907) 129 O.G. 3503, an attempt was made to obtain a patent for a system of lettering which consisted in the adoption of a certain scale for the height of the letters and then determining in terms of this scale the proper width of the letters. It was held that although the system was apparently new and useful it was not an "art, machine, manufacture, or composition of matter," and therefore not patentable. System of lettering.

In *Hotel Security Checking Co. v. Lorraine Co.* (1908) 160 F. 467, the headnote reads:

"A system of transacting business, disconnected from the means for carrying out the system is not, within the most liberal interpretation of the term, an 'art,' and unless the means used are novel and disclose invention, such system is not patentable."

For similar reasons, patents for various forms of contracts for insurance and other purposes have been refused, whenever the novelty consisted in the arrangement of the writing or printing embodying the contract or in the manner of ruling. If the novelty rests on the physical structure of the document such as a peculiar shape or method of folding, the patent may be supported. (*U.S. Credit v. American* 59 F. 139.) Where such patents have been supported, it has generally appeared that the invention resided in some particular article of manufacture used in the system, and not in the system itself. Forms of contracts.

The English authorities exclude business systems because there is not a "new manner of manufacture" within the Statute of Monopolies. (In the matter of *Johnston's Application* [1902] 19 R.P.C. 56; *Philpot v. Hanbury* [1885] 2 R.P.C. 153.)

The term "patent medicines" with which the public have become familiar is a misnomer. Very few, if any, of such medicines are patented. The names under which they are sold are usually protected by trade mark registration and the formula of the medicine kept secret. It would be very difficult to get a patent on any medicine or physician's prescription for the reason that the Patent Office holds that if the ingredients thereof are well known and included in Standard Pharmacopœias, there is nothing more than the exercise of the skill of a physician in combining them in any desired manner. (*Ex Parte Crippen*, Patent medicines.

United States Commissioner's Decisions Manuscript, May 24th, 1890.)

Improve-
ments under
English law.

In the early cases in England, there was some doubt whether a patent could be taken out for an improvement on a patented invention, but such doubts have long been removed, and improvement patents are rather the rule than the exception. (See *Lister v. Leather* [1857] 8 E. & B. 1017; *Russell v. Cowley* [1843] 1 W.P.C. 463; *Bovill v. Moore* [1815] 2 Coop. Ch.Ca. 56; *Moser v. Marsden* [1893] 10 R.P.C. 361; *Hickton's Patent Syndicate v. Patents Machine Improvements Co.* [1909] 26 R.P.C. 339.)

The improver, however, cannot make use of his invention without the license of the original patentee. *Halshury, L.C., in Kynock Ltd. v. Webb* (1900) 17 R.P.C. 107, said: "Now it is true, that any machine protected by a patent is susceptible of improvements, and such improvements, if in other respects conforming to the patent law, may be protected themselves, but they can only be made use of by the license of the proprietor who is in command of the master patent."

Under
Canadian
law.

Improvements, by section 7 of our Act, are made a distinct patentable class of inventions. In one sense every invention is an improvement on the existing knowledge of the art, and it is not seen that anything is gained by a separate classification. The improvement to be patentable must involve invention, and having determined that invention is present it is immaterial from a patentable standpoint whether we regard it as an improvement or not. The term has, however, acquired some standing as denoting an advance in a known machine, but in all cases it must answer the tests of novelty, ingenuity and utility already referred to. (*Crane v. Price* [1842] 1 W.P.C. 410; *Boulton v. Bull* [1795] 2 H. Bl. 589; *Seymour v. Oshorne* 78 U.S. 516; *Evans v. Eaton* 3 Wheat. 454, 7 Wheat 357; *Smith v. Nichols* 88 U.S. 112.)

The question of the use of improvements on a patented invention is specifically dealt with in section 9: "Any person who has invented any improvement on any patented invention, may obtain a patent for such improvement; but he shall not thereby obtain the right of vending or

using the original invention, nor shall the patent for the original invention confer the right of vending or using the patented improvement. R.S. c. 61, s. 9."

This section is unnecessary as the grant of a patent on an improvement could not in any sense be construed to give the right to make or use the original invention on which it is an improvement. A patent grants hut the right to restrain others from manufacturing, using and selling the particular patented invention defined by the claims of the patent.

Apart from the question of what constitutes invention, there is to be considered the question of who is to be considered the inventor under different circumstances. The inventor.

An invention may follow from the suggestion of another person to the patentee. Whether or not the patentee is to be considered an inventor will depend on the materialty of the suggestion, and as to whether or not it is merely an inchoate idea which could not be embodied in a practical machine or manufacture without such development as would amount to invention under the rules already stated. (Tennant's case, 1802, 1 W.P.C. 125; Cornish v. Keene [1835] 1 W.P.C. 501, 507.)

If one person has had an opportunity to steal the invention from another, the circumstances will be carefully examined. In *American Dunlop v. Gould Bicycle Co.* (1899) 6 Ex. C.R. 223, it was held that where one who invents anything has had an opportunity to hear of it from other sources, and especially where delay has occurred on his part in patenting his invention, the claim that he is the true inventor ought to be carefully weighed.

One person may employ another, as he would use a mere tool, to construct or work out his invention in practical form. In this case the invention is that of the master who has suggested the principle, and not of the servant. Master and servant. (*Minter v. Wells* [1834] 1 W.P.C. 132; *Bloxam v. Elsee* [1825] 1 C. & P. 558, 567.)

If in the course of experiments the servant makes valuable discoveries accessory to the main principle, and to carry that out in a better way, such improvements are the property of the inventor of the original principle and Master suggests principle.

may be embodied in his patent. (Allen v. Rawson [1845] 1 C.B. 551.)

Servant makes substantive invention.

If, however, the servant as a matter of fact makes a substantive invention, he is the first and true inventor thereof. (Collar Co. v. Van Deusen [1874] 23 Wall. 530; Agawan Co. v. Jordan [1868] 7 Wall. 583.)

As was said by Byrne, J., in Worthington Pumping Engine Company v. Moore (1903) 20 R.P.C. 41 at p. 48, cited by Moss, C.J.O., in Piper v. Piper (1904) 3 O.W.R. 451, "The mere existence of a contract of service does not *per se* disqualify a servant from taking out a patent for an invention made by him during his term of service, even though the invention may relate to a subject matter germane to and useful for his employers in their business, and that even though the servant may have made use of his employer's time, and servants and materials in bringing his invention to completion, and may have allowed his employers to use the invention while in their employment." (See also in *re* Heald's Patent [1891] 8 R.P.C. 429, 430, and the Imperial Supply Company, Ltd. v. G.T.R. Co. [1912] 14 Ex. C.R. 88; Saxhy v. Gloucester Wagon Co. [1883] L.R. 7, Q.B. 305.)

Servant may be trustee.

The question of the right of ownership of inventions made by a servant while in his master's employ is distinct from the question as to who has made the invention. Only the person making the invention can be entitled to a patent. The relations between the master and servant whatever they may be cannot alter this fact. They may, however, effect the title to the patent when issued. The circumstances of employment may be such that the servant will be considered the trustee of the inventions made by him for the benefit of the master. (Edisonia, Ltd. v. Forse [1908] 25 R.P.C. 546; Pashley v. Linotype Co., Ltd. [1903] 20 R.P.C. 633.)

Joint inventors.

It is possible for an invention to be a product of a number of minds, and especially in the case of machines containing a multiplicity of parts, or where two or more persons have worked together on a given invention and it is impossible to divide the invention into separate entities belonging to each. (Piper v. Piper [1904] 3 O.W.R. 451.)

The importer or introducer of an invention is not to be considered the inventor under the statute in Canada, the law differing from that in England in this respect. This point was early settled in Canadian jurisprudence. (See *Woodruff v. Mosely* [1874] 17 L.C.J. 306, and *Vanorman v. Leonard* [1845] 2 U.C.Q.B. 72.)

CHAPTER III.

NOVELTY.

To give a right to a Patent the applicant must be an original inventor. It is not sufficient, however, that he has invented something. His invention must fulfill other requirements of the Act. Section 7 requires that it shall be "new," "not known or used by any other person before his invention thereof," and that it shall be an art, machine, etc., which "has not been in public use or on sale with the consent or allowance of the inventor thereof, for more than one year previously to his application therefor in Canada." It is also evident from the use of the words in sections 17, 25 and 33 that the applicant must be "the first inventor."

Applicant
must be first
inventor
anywhere.

It is now decided beyond doubt that the invention must be "new" and that the applicant must be "the first inventor" throughout the world and not merely in Canada. The head-note in *Smith v. Goldie* (1883) 9 S.C.R. 46, reads in part as follows:

"1. To be entitled to a patent in Canada, the patentee must be the first inventor in Canada or elsewhere. A prior patent to a person who is not the true inventor is no defence against an action by the true inventor under a patent issued to him subsequently, and does not require to be cancelled or repealed by *scire facias*, whether it is vested in the defendant or in a person not a party to the suit:

"2. The words in the 6th section of the Patent Act, 1872, 'not being in public use or on sale for more than one year previous to his application in Canada,' are to be read as meaning 'not being in public use or on sale in Canada for more than one year previous to his application.'"

In the *Queen v. La Force* (1894) 4 Ex. C.R. 14, a patent was granted to a Canadian. It was shown that

prior to the invention by the Canadian, an American citizen had made in the United States the same invention. He had not, however, communicated his invention to the public. Burbidge, J., distinguished *Smith v. Goldie*, being apparently of the opinion that the head-note was not a correct statement of the law found in the judgments of the court and held that the patent granted to the Canadian was good. His views were summed up as follows, p. 61:

"In the result, I am of opinion that under the patent law of Canada a prior foreign invention, of which the public had no knowledge or means of knowledge, is not sufficient to defeat a patent issued to an independent Canadian inventor. Whether the same rule should be followed in cases of conflicting applications for patents, is another question. In the present case the patent having been issued, the Crown's power or authority in respect thereof is exhausted. If the patent be good, if there be no ground of impeachment, it must stand, and the second patent is waste paper. In the case of conflicting applications, the Crown has not parted with its power to make a grant, and there is provision for the appointment of arbitrators to decide between the applicants. In such a controversy, it seems to me that the first applicant, if he be a true inventor and the first to make known his invention to the public, should be preferred. If there is any doubt as to that being the law at present, or if it is not the law, I venture to hope that the doubt may be removed or the law changed, for not only is the rule a just one, as it gives the reward to the person who first communicates a knowledge of the invention to the public, but it is a convenient one in respect of the proof by which under it any question of priority may be determined. On the other hand, it appears to me that the doctrine that he who first conceives an invention is to be preferred to him who first reduces it to practice and gives it to the public, leads of necessity to an inquiry as to what men may have done in secret, and opens wide and dangerously a door to perjury and the fabrication of evidence."

In a recent case *The Barnett-McQueen Co. v. The Canadian Stewart Co.* (1910) 13 Ex. C.R. 186, this question was considered by Cassels, the present Judge of the Exchequer Court. After quoting the head-note of

Smith v. Goldie given above, the judgment proceeds, p. 227:

"A perusal of the written opinions of the Judges who composed the Supreme Court at the time of this decision would fail to disclose the fact that these two important points stated in the head-note had been passed upon by the court. None of the Judges who then composed the Supreme Court are now members of the court.

"As I was counsel in the case, and very familiar with the facts, I think it well to clear up the question.

"Both the propositions of law stated in the head-note were in fact decided in the manner stated. They had to be so decided, otherwise the plaintiff Smith could not have succeeded. A careful consideration of the facts shows this.

"The case was originally tried by the late Chancellor Spragge, who dismissed the suit on the ground that contrary to the terms of the statute the patentee had imported the patented invention into Canada.

"The Court of Appeal dismissed the appeal on the ground that under the evidence adduced there was no invention. They were of opinion that the question of importation was not open as a defence. Apparently both in the Court of Appeal and in the Supreme Court the conclusion was that the decision of Dr. Tache was one *in rem* and not open to revision. See *Power v. Griffin*. [33 S.C.R. 39.] While the appeal to the Court of Appeal was dismissed on the ground stated, the Judges of that court, especially Mr. Justice Patterson, discussed fully and passed upon the questions reported to have been decided by the headnote referred to.

"The Supreme Court of Canada reversed the decision of the Court of Appeal and pronounced judgment in favour of the plaintiff.

"As I have stated, the court could not have decided in favour of the plaintiff unless they adopted the views of Mr. Justice Patterson on the two questions now under consideration. I extract the dates from the judgment of the Court of Appeal.

"Smith's application for a patent in Canada was dated 11th January, 1873. His Canadian patent bears date 18th April, 1873 [See p. 629 of 7 Ont. A.R.]

"Sherman and Lacroix each had Canadian patents issued in 1872 (see page 635). The machine in question, the invention of Smith, was in complete working order in the United States in April, 1871 (see page 633). His application in the United States was in July, 1871 (see page 633). On page 641, Mr. Justice Patterson points out that had the law not being changed 'the patentees of the rival machines who obtained their patents at Ottawa in 1872 must as against the plaintiff Smith have been held to be the first inventors.'

"At pages 640, 641 Mr. Justice Patterson reviews the changes in the Canadian law. Referring to the Consolidated Statutes of Canada, chapter 34, section 3, it is pointed out that under that law no one was entitled to a patent except a subject of Her Majesty. This Act authorized the granting of a patent, etc., 'the same not being known or used in this Province by others before his discovery or invention thereof.'

"In 1869, by 32-33 Vic., cap. 11, the privilege was extended to any person who had been a resident of Canada for one year before his application. See section 6 of this statute.

"In 1872 (not 1875, as erroneously printed on page 641 of the Appeal Court report) by 35 Vic., cap. 26, the restriction as to residence was removed, and quoting Mr. Justice Patterson, page 641, 'thus in all respects placing foreigners on the same footing with subjects, but at the same time, and as a compliment of this extension of the privilege, required absolute novelty—not merely novelty within the Dominion, in the invention.'

"This decision in *Smith v. Goldie* (*supra*) has been followed in all the cases subsequently decided, with the exception of one case, in which the learned Judge drew a distinction in favour of a Canadian inventor who had obtained a patent in Canada earlier in point of date than an American inventor who was held to be a prior inventor to the Canadian inventor, but who obtained his patent in Canada on a date subsequent to that of the Canadian inventor [*The Queen v. Laforce* 4 Ex C.R. 14.] There is no justification for such a decision when the law as adjudged in *Smith v. Goldie* is understood. The case referred to was

settled prior to the hearing of an appeal taken to the Supreme Court.

"In considering the Canadian statutes, care must be exercised in reviewing the English and American authorities on this question to note the differences that exist between the English and the American statutes and the Canadian law.

"In *Summers v. Ahell* [15 Gr. 532, 536, 537] the language of *VanKoughnet, C.*, and *Spragge, V.C.*, may be referred to.

"On this question of invention the Canadian statute is very similar to that of the United States prior to 1836. The statute of 1790 of the United States reads as follows:

" 'Any person setting forth that he, she or they hath or have invented or discovered any useful art, manufacture, engine, machine or device, etc., not before known or used.'

"This Act of 1790 was amended in 1793, which latter Act provided that the invention must have been one 'not known or used before the application.'

"Under the Act of 1790 there was no limit to the time or place of user. Under the Act of 1793 there was no limit of place. Under these two statutes the court held that the inventor must be the first inventor as to all the world in order to be entitled to a patent. This is practically what the present Canadian law requires. It was thought in the United States that this pressed hardly on inventors, and a change was made in 1836 providing that the Commissioner might grant a patent 'if it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant.'

"Cases in which the American courts dealt with the question of prior invention under the Acts prior to 1836 may be considered. *Gayler v. Wilder* (10 How. 477); *Coffin v. Ogden* (18 Wall. 120)."

In view of this explanation of *Smith v. Goldie* there can be little doubt that there can be no limit as to place but that the invention must be new and the inventor must be the first inventor as to all the world.

The question then follows as to what is meant by "new," "not known or used by any other person before his invention thereof," "first inventor." In other words, what novelty is required by the Act.

What novelty is required.

In the *Queen v. LaForce* the decision was finally rested on the fact that the prior invention was made in a foreign country. It was, however, the view of Burbidge, J., that the law is that the first person who makes known his invention to the public is entitled to a patent and that novelty is not negated by a prior invention not communicated to the public. It is not clear that this view is opposed to the decision in *Smith v. Goldie*. It would seem, however, that this is not the opinion of the present Judge of the Exchequer Court and that his condemnation of *Queen v. La Force* carries with it dissent from this view.

We are without authority on this question except that given above. The writers are, however, of the opinion that an invention is anticipated by a perfected prior invention even though such invention is known only to the inventor. They think that the applicant must be absolutely the world over the person who has first invented that for which he seeks a patent.

Prior invention known only to inventor probably defeats patent.

In Great Britain a patent is not void for want of novelty merely because of a prior invention of the same thing unless there has been public user of the prior invention or something amounting to communication to the public. In *Hills v. London Gas Light Co.* (1858) 5 H. & N. 312, 336, Lord Bramwell stated the law as follows:

Law in England.

"If a person has invented anything which is the subject of a patent and has kept it to himself, or communicated it privately to one or two, in fact, has not made it public knowledge, if anyone else discovers that invention it is new, that is to say, new in the sense that the first invention has not been published."

In the *Househill Co. v. Neilson* 1 Web. P.C. 679, 719. Lord Chancellor Lyndhurst said:

"If the invention is in use at the time that the grant is granted, the man cannot have a patent, although he is the original inventor; if it is not in use, he cannot obtain a patent if he is not the original inventor. He is not called the inventor who has in his closet invented it, but who does not communicate it: the first person who dis-

closes that invention to the public is considered as the inventor. The party must be an inventor, you need not say the inventor, because another may have invented it and concealed it; but in addition to his being an inventor, others must not use the invention at the time of the patent."

This law is based on the principle that the consideration which the patentee gives for the monopoly granted by a patent is the knowledge of the invention. If the invention is public property at the date of the patent, the patent is void for want of consideration. In *Patterson v. Gas Light and Coke Co.* (1875) L.R., 3 A.C. 239, 244, Lord Blackburn said quoting Hindmarch on Patents: "If the public once becomes possessed of an invention by any means whatever, no subsequent patent can be granted for it, either to the true and first inventor himself, or to any other person, for the public cannot be deprived of the right to use the invention, and a patentee of the invention could not give any consideration to the public for the grant, the public already possessing everything that he could give." For the same reason in Great Britain even in the case of a grant to the first inventor, the patent will be void, except in the case of a fraudulent disclosure against which the patentee is protected by the statute, if the invention has been previously published.

Law of
United
States.

The law of the United States as to whether an invention is anticipated by a prior invention not made known to the public in any way is perhaps not very certain. Merwin, *Patentability of Inventions*, deals with the question as follows, p. 634:

"The question is, whether a thing or a process which has once been known as used in this country, by persons other than a subsequent original inventor of it, can be the subject of a patent.

"It is plain that it cannot be, according to the literal meaning of the statute, which requires that the patentee shall be the first as well as the original inventor. Now, if an invention has formerly been known and used, though by one person only, and though he has kept such knowledge and use to himself, and though he has forgotten the invention and cannot reproduce it, still it is clear that he is the first inventor; and the subsequent inventor cannot

he so considered, as it is obviously impossible that there should be two first inventors.

"The other words of limitation in regard to prior knowledge and use can be gotten over a little more easily; thus a person may be held to have invented something 'new,' if he invent something new to the public of his time, although it was formerly known. So, also, the words, 'not known or used by *others* in this country . . . before his (the inventor's) invention or discovery thereof,' might possibly be construed to imply knowledge or use by a considerable number of persons—at least by more than one person.

"The statute, however, has not been construed strictly in this regard. The principle, of which we reminded the reader at the beginning of this chapter, that a benefit conferred upon the public is the consideration for a patent, has been brought into play; and the Supreme Court have held that the intention of Congress was to confer a patent upon him who first not only invents or discovers, but also reveals to the public, a patentable improvement. The meaning of the Act, they said, must be gathered from a consideration of the whole thereof; and when the Act is so treated it appears that the section (the fifteenth) which in one case, namely, that of a previous knowledge or use in a foreign country, provides for the granting of a patent to one who is not the first inventor, qualifies the whole Act, and shows that its intentment was that the patentee should not be literally the first inventor, but the first to make an invention known to the public."

This view seems to be supported by authorities cited by the author (*Adams v. Edwards*, 1834, 1 Fish. 1; *Many v. Sizer*, 1 Fish 17; *Cahoon v. Ring*, 1 Cliff. 592). It is, however, opposed to the language used in several decisions. In *Coffin v. Ogden*, 18 Wall. 120, it was said: "The prior knowledge and use by a single person is sufficient." In *Reed v. Cutter*, 1 Story 590, Story, J., said: "If the invention is perfected and put into actual use by the first and original inventor, it is of no consequence whether the invention is extensively known or used, or whether the knowledge or use thereof is limited to a few persons, or even to the first inventor himself."

Whether the principle of the law of Great Britain that a patent is a contract between the Crown, on behalf of the public, and the patentee, by which a monopoly is given in exchange for disclosure of a new invention has any application in the Canadian law is very doubtful. In England the basis of the grant is still the royal prerogative. The Statute of Monopolies only defined the limits of this prerogative. In Canada the right to a patent depends entirely on statute. There seems to be no good reason why there should be imported into the Canadian Patent Law a principle which the legislature has not incorporated in the Act unless there is some doubt as to the interpretation of the words of the statute.

Interpreta-
tion of
Canadian
Statute.

On the question under discussion there does not seem to be room for any doubt. The language of the Canadian Act is different from that used in the Statute of Monopolies and also from the American Act. In Canada and in neither of the other countries we have the limitation of a grant to a person who has made an invention "not known or used by *any other person* before his invention thereof." In Great Britain the only corresponding provision in the Statute of Monopolies is "which *others* at the time of making of such letters patents and grants shall not use." In the United States the words are "not known or used by *others* in this country." In the Canadian Statute the phrase "*any other person*" is singular. In the British and American enactments the word "*others*" is used in the plural. It is therefore submitted that no matter what might be read into the Canadian Act to limit or extend the meaning of the terms "new" and "first inventor" it is impossible to read out of the Act the words "*any other person*." It is therefore submitted that an invention is anticipated by knowledge or use by one person.

Anticipation
a question of
fact.

The question whether the invention is new or was previously known or used is one of fact and depends upon the circumstances in every case (*Pickard v. Prescott* [1892], 9 R.P.C. 195 at p. 200). In order to negative novelty it must be shown that something substantially identical with the invention was previously known or used.

Something produced by accident without knowledge of what has been done or how it was done and conse-

quently without the power to reproduce it is not an invention and can therefore not be an anticipation (*Ransom v. the Mayor of New York* [1856], 1 Fisher 242; *Tilghman v. Proctor*, 102 U.S. 707, 26 L. Ed. 279).

Something which cannot be reproduced no anticipation.

In order that there may be an anticipation the idea in which the exercise of the creative faculties results must be complete and capable of practical application. To recognize a public want, to entertain vague notions of some mode in which that want may be supplied, to put forth efforts which approach, however nearly to the solution of the problem and yet leave it unsolved, are not enough. There is no invention unless there is reached the perfect, practical, operative idea, which when embodied in tangible materials, will accomplish the desired result. (*Robinson on Patents*, p. 122, sec. 80.)

Idea must have been capable of practical application.

For this reason, mere experiments if unsuccessful however nearly they approach the complete invention, and even although patented, do not anticipate. In *Coffin v. Ogden* 85 U.S. 120, 21 L. Ed. 821, this was put as follows: "The invention or discovery relied upon as a defence, must have been complete, and capable of producing the result sought to be accomplished, and this must be shown by the defendant. The burden of proof rests upon him, and every reasonable doubt must be resolved against him. If the thing were embryonic or inchoate; if it rested in speculation or experiment; if the process pursued for its development had failed to reach the point of consummation, it cannot avail to defeat a patent founded upon a discovery or invention which was completed while in the other case there was only progress, however near that progress may have approximated to the end in view. The law requires, not conjecture, but certainty."

Unsuccessful experiments do not anticipate.

The following decisions in the United States are in point: *Gayler v. Wilder*, 10 How. 477, 13 L. Ed. 504; *Washburn v. Beat-em-all*, 143 U.S. 275, 36 L. Ed. 154, 12 S.Ct. 443; *Cantrell v. Wallick*, 117 U.S. 689; *Hitchcock v. Tremain*, 9 Blatchf. 550; *Parham v. American*, 4 Fisher 482; *Bell v. Peoples*, 22 F. 313; *Deering v. Winona*, 155 U.S. 286, 39 L. Ed. 153, 15 S.Ct. 118; *Brown v. Guild*, 90 U.S. 181.

The following English cases may be consulted, hearing in mind, however, that in Great Britain the anticipa-

tion must not only have been an invention, but also have been published: *Jones v. Pearce* (1832) 1 W.P.C. 122; *Househill Co. v. Neilson* (1843) 1 W.P.C. 673; *Stead v. Williams* (1843) 2 W.P.C. 126; *Electrolyte Plating Apparatus Co. v. Holland* (1901) 18 R.P.C. 521.

Idea in practical form though imperfect anticipates.

If, however, experiment has resulted in an invention of a practical character embodying the same idea as a subsequent invention, there will be anticipation, even though the prior invention may not be mechanically perfect, or may not have reached the highest degree of perfection. (*Fornecrook v. Root*, 127 U.S. 176, 32 L. Ed. 97; *Magin v. Karle*, 150 U.S. 387, 37 L. Ed. 1118; *The Telephone Cases*, 126 U.S. 1, 31 L. Ed. 863; *Brush v. Condit*, 132 U.S. 39, 33 L. Ed. 251; *Planing Machine Co. v. Keith*, 101 U.S. 479, 25 L. Ed. 939.)

Prior knowledge at any time defeats patent.

The prior knowledge or use need not have been continuous to the time of the later invention. Remoteness or abandonment are only of importance as furnishing grounds for the inference that that which is set up as an anticipation was not in fact identical with the later invention. The matter is put by *Cotton, L.J.*, in *Morgan v. Windover* (1889) 5 R.P.C. at p. 302, as follows: "If in truth, we were satisfied that a carriage, in accordance with that which is claimed by Mr. Morgan as his invention, was then made, and made in a practical working shape, it would not be material that it had never been used from that time to this, because there would have been a prior use of that which is claimed by Mr. Morgan as his invention, but, as was pointed out by Lord Brougham in *The Househill Co. v. Neilson* (1843) 1 W.P.C. 679, although, if there is a complete anticipation by prior use, the abandonment of it is nothing, yet, when it is a question of whether, really, there was a carriage perfected in accordance with the plans of Mr. Morgan, the fact that it had never been used for thirty-six years, or something of that sort, before he took out his patent, is most material, as leading to the conclusion that that which was made in the year 1848 was not a perfect carriage in accordance with the invention of Mr. Morgan."

In *Bueer v. Novelty*, 151 Fed. 478, 81 C.C.A. 16, is found a statement of the law which has been criticized

in the United States. It is believed, however, to be a correct statement of the Canadian law. It was there said: "If, then, an alleged invention is in fact an invention, no subsequent abandonment of it can be said to be an abandoned experiment. At most it is an abandoned invention, but an invention that has been abandoned is as much an anticipation, and to as great an extent negatives novelty, as an invention that has not been abandoned. . . ."

See also *Clishy v. Reese*, 88 Fed. 645, 32 C.C.A. 80; *Lawson v. Hillman*, 123 Fed. 416, 59 C.C.A. 510; *United v. Greenman*, 153 Fed. 283, 82 C.C.A. 581; *Brush v. Condit*, 132 U.S. 39; *Deering v. Winona*, 155 U.S. 286; *Brooks v. Sacks*, 81 Fed. 403; *Westinghouse v. Stanley*, 133 Fed. 174.

In the United States the principles as to when an invention is perfected so as to amount to an anticipation have been well established. In view of the similarity of the Canadian Statute to the American Statute it is of interest to consider these principles. The following portions of the Revised Statutes of the United States are of importance in this connection:

United States principles as to when an invention has been perfected so as to amount to anticipation.

"SECTION 4886. Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor." [See prior patent statutes, section 24, 1870; sections 6 and 7, 1836; section 1, 1800; section 1, 1793.]

"SECTION 4923. Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or dis-

coverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication." [See prior patent statutes, section 62, 1870; section 15, 1836.]

"SECTION 4920. In an action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney, thirty days before, may prove on trial any one or more of the following special matters:

* * * * *

"Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or

"Third. That it had been patented or described in some printed publication prior to his supposed invention or discovery thereof; or

"Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or

"Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public."

The principles referred to have been the result of innumerable decisions. Those which seem of importance are to be found in an elaborate judgment in *Automatic Weighing Machine Co. v. Pneumatic Scale Corporation*, 166 Fed. 288, where many of the decisions are reviewed. They are as follows:

1. A statutory invention is a completed invention; that is, an invention which is perfected and adapted to use, and an inventor has not made an invention in the legal sense, until he has reduced his invention to practice.

2. An invention need not be perfected and adapted to use, or reduced to practice, in order to obtain a valid patent, since no such condition is contained in the statutes. Filing a complete and allowable application is constructive reduction to practice, and the courts have adopted the rule that such an application is conclusive evidence that the patentee made his invention, that is, reduced his invention to practice, at least as early as the date of filing.

3. A conception evidenced by disclosure, drawings, and even a model confers no rights upon an inventor, unless followed by some other act, such as actual reduction to practice, or filing an application for a patent. A conception of this character is not a complete invention under the patent laws. It may constitute an invention in a popular sense, but it does not make the inventor the "original and first inventor" under the statutes.

4. A patentee who has used "reasonable diligence in adapting and perfecting" his invention can carry the date of his invention back to the time of his drawings and disclosure.

This rule, which is treated as an exception to the general principle, was first introduced into the Patent Law in 1836. By section 15 of the Act of 1836, c. 357, 5 Stat. 123, it was provided that the defendant in an action upon a patent may set up in defence that the plaintiff had "surreptitiously and unjustly obtained his patent for that which was in fact invented by another who was using reasonable diligence in adapting and perfecting the same." This provision is now contained in section 4920 of the Revised Statutes quoted above.

The effect of this last proposition was considered in *Reed v. Cutter*, 1 Story 590, Fed. Cas. No. 11645, where Mr. Justice Story said:

"The Patent Act of July 4, 1836, c. 357, ss. 7, 8, 13, 15, 16, 5 Stat. 322, expressly declares that the applicant for a patent must be the first, as well as an original inventor. The passage cited from Mr. Phillips' work on Patents (page 395), in the sense in which I understand it, is perfectly accurate. He there expressly states that the party claiming the patent must be the original and first inventor, and that his right to a patent will not be defeated by proof, that another person had anticipated him in

making the invention, unless such person 'was using reasonable diligence in adapting and perfecting the same.' These latter words are copied from the fifteenth section of the Act of 1836 (chapter 357) and constitute a qualification of the preceding language of that section, so that an inventor who has first actually perfected his invention will not be deemed to have surreptitiously or unjustly obtained a patent for that which was in fact first invented by another, unless the latter was at that time using reasonable diligence in adapting and perfecting the same. And this I take to be clearly law; for he is the first inventor in the sense of the Act, and entitled to a patent for his invention, who has first perfected and adapted the same to use; and until the invention is so perfected and adapted to use it is not patentable. An imperfect and incomplete invention, resting in mere theory or in intellectual notion, or in uncertain experiments, and not actually reduced to practice, and embodied in some distinct machinery, apparatus, manufacture or composition of matter, is not, and indeed cannot be, patentable under our Patent Acts, since it is utterly impossible, under such circumstances, to comply with the fundamental requisites of those Acts. In a race of diligence between two independent inventors, he who first reduces his invention to a fixed, positive and practical form, would seem to be entitled to a priority of right to a patent therefor. *Woodcock v. Parker*, Fed. Cas. No. 17, 971. The clause of the fifteenth section, now under consideration, seems to qualify that right, by providing that, in such cases, he who invents first shall have the prior right, if he is using reasonable diligence in adapting and perfecting the same, although the second inventor has, in fact, first perfected the same and reduced the same to practice in a positive form. It thus gives full effect to the well-known maxim that he has the better right who is prior in point of time, namely, in making the discovery or invention."

The basis for the general principles given is suggested in *Walker on Patents*, 4th Ed., p. 57, s. 61:

"Novelty of a machine or manufacture is not negatived by any prior unpublished drawings, no matter how completely they may exhibit the patented invention, nor by any prior model, no matter how fully it may coincide

with the thing covered by the patent. The reason of this rule is not stated with fulness in either of the cases which support it, but that reason is deducible from the statute and from the nature of drawings and of models. The statute provides, relevant to the newness of patentable machines and manufactures, that they shall not have been previously known or used by others in this country. Now, it is clear that to use a model or a drawing is not to use the machine or manufacture which it represents; and it is equally obvious that to know a drawing or a model is not the same thing as knowing the article which that drawing or model more or less imperfectly pictures to the eye. It follows that neither of those things can negative the newness required by the statute. Nor is the statutory provision on this point lacking in good reasons to support it. Private drawings may be mislaid or hidden so as to preclude all probability of the public ever deriving any benefit therefrom; and even if they are seen by several or by many, they are apt to be understood by few or by none. Models also are liable to be secluded from view and to suffer change, and thus to fail of propagation. Moreover, if a patent could be defeated by producing a model or a drawing to correspond therewith, and by testifying that it was made at some sufficiently remote point of time in the past, a strong temptation would be offered to perjury. Several considerations of public policy and of private right combine, therefore, to justify the rule of this section."

This statement of Walker has been approved in a number of cases. It must, however, as regards models, be read in the light of the language used by Judge Coxe in *American v. Wagner*, 151 Fed. 576, 81 C.C.A. 120:

"These are all the authorities cited by Mr. Walker, and we are convinced that they do not sustain the broad contention of the complainant. The law, section 4886 of the Revised Statutes, provides that any person may obtain a patent, *inter alia*, for a machine invented by him 'not known or used by others in this country before his invention or discovery thereof.' It is clear, as pointed out by Mr. Walker, that knowledge of a model of a machine is not knowledge of the machine itself any more than knowledge of a model of Brooklyn Bridge is knowledge of

that structure. But we think the rule should be restricted to a model pure and simple as the word is understood in common parlance, viz., a pattern, a copy, a representation usually upon a reduced scale. The word 'model' should not be construed to mean the identical device which is covered by the patent. If this were otherwise a defendant who produces the exact structure of the claims and proves that it was known prior to the date of the alleged invention is completely answered if the complainant can show that the anticipating structure was filed as a model. In other words, the question is not one of nomenclature but of fact. In the case of a complicated machine a small model incapable of actual use may be filed for the purpose of explaining and illustrating the drawing; that such a model alone would not anticipate is, of course, perfectly clear. On the other hand, it frequently happens that the applicant files as his model not a pattern or reproduction of the thing invented by him, but the thing itself. Take, for illustration, an application for a patent for a horse-shoe nail when one of the nails made by the inventor is filed as a model, can it be that a subsequent applicant can hold a patent for that nail or any feature thereof after proof of its prior existence and the knowledge thereof by the public? During the pendency of an application a model filed in the Patent Office is supposed to be inaccessible to the public and therefore proof of its filing date is not alone proof of public knowledge at that time but, on the other hand, such knowledge having been shown by extrinsic evidence, the model is not open to the suspicion that it has been altered, and until proof to the contrary is adduced, must be presumed to be in the condition it was at the date of filing. As before stated, we think the Yost model was something more than a mere model, for the reason that it is a full operative embodiment of the tabulating mechanism, and for the further reason that its existence and purpose is established by evidence independent of its connection with the Patent Office."

Question-
able how far
United
States
principles
will be
followed.

How far these rules will be adopted in Canada it is impossible to surmise. The last rule is based on the provision of the Statute with which there is no corresponding section in the Canadian Act. If the others are, as suggested by Walker, based on the wording of section 4886 of

the Revised Statutes, there is no reason why they should not apply in Canada, as section 7 of the Canadian Act is in practically the same words. It would seem, however, that they are the result of an effort to evolve a satisfactory patent law rather than to interpret the language of any particular section or sections. While the principles laid down are convenient they are somewhat arbitrary and it would be very rash to assume that they will be adopted by Canadian courts.

The wording of the Canadian Statute, which is like that of the United States in this respect, does not require that the prior invention shall have been *used* but only *known*. The statute does not say "known and used," but "known or used." (Parker v. Ferguson [1849] 1 Blatch. 407; Parker v. Hulme, 1 Fish. 45.) To hold, as has been done in the United States, that an art, machine, manufacture or composition of matter is not known unless it has been actually made or reduced to practice, seems to be a very narrow and unwarranted interpretation of the Act. Some inventions may be of such a complicated nature that no one can be sure of them until they are actually made or operated. With most inventions, however, once they have been worked out in the mind of the inventor they are quite as well known as they are after being reduced to practice as required in the United States. A skilled mechanic, for example, will understand most machines as completely from a drawing or model as from the actual machine. We therefore see no reason, except the ground of convenience, why the Canadian courts should adopt the principles laid down by the American courts.

The writers are therefore of the opinion that the question as to whether an invention has been previously known or used must come down to a question of evidence and that the kind or amount of evidence necessary to show anticipation cannot be limited except by the ordinary rules of evidence and proof. Evidence sufficient to show that the invention has been perfectly conceived will be sufficient. It need not have been actually reduced to practice provided only ordinary mechanical skill is required to carry the conception to success.

Invention perfectly conceived probably anticipates under Canadian law.

English cases must be used with care.

In Great Britain, as has been stated, the question is whether the invention has before the patent been used or published in such a way that it must be said to be in the possession of the public. In England the invention is not new if it has been used in public (*Carpenter v. Smith* [1842] 1 Weh. P.C. 543; *Gill v. Coutts & Sons* [1895] 13 R.P.C. 125, 136), or if it has been described in a book (*Stead v. Williams* [1844] 2 Weh. P.C. 126, 142) or specification (*Jones v. Berger* [1843] 1 Weh. P.C. 544, 550; *Rucker v. London Electric Supply Corporation* [1900] 17 R.P.C. 279) or an official report (*Patterson v. Gas Light and Coke Co.* [1877] 3 App. Cas. 239), or if shown in a published drawing (*Herrhurger Schwander et Cie v. Squire* [1889] 6 R.P.C. 194; *Electric Construction Co. v. Imperial Tramways Co.* [1900] 17 R.P.C. 537, 550), or if a model has been exhibited in public (*Winby v. Manchester, etc., Steam Tramways Co.* [1890] 8 R.P.C. 61, 66), provided there has been a sufficient description or disclosure to enable a highly skilled person, without the exercise of invention, to carry out the alleged new discovery. (*Savage v. Harris* [1896] 13 R.P.C. 364, 368; *Betts v. Neilson* [1868] 3 Ch. App. 429; *Philpott v. Hanbury* [1885] 2 R.P.C. 43; *King, Brown & Co. v. Anglo-American British Corporation* [1892] 9 R.P.C. 313, 320.)

In Canada an invention is not new if at the date of invention it had already been known or used by any person. The prior user need not have been in public. Publication of a prior invention is not necessary. Publication of the invention except as evidence of abandonment is immaterial. The English cases must therefore be used with great care.

Evidence necessary to prove prior knowledge.

As to the evidence which will be required to prove prior knowledge of an invention not communicated to the public, we can get very little light from the authorities. There are no Canadian cases of any value. The English cases are not in point. The only cases from which any help can be gained are the American decisions arising under section 4920 of the Revised Statutes where a patent has been obtained for what was in fact invented by another who was using reasonable diligence in adopting and perfecting the same. It is submitted that evidence sufficient to show a prior invention made but not adapted and

perfected under the United States law will be sufficient to show anticipation in Canada. Proof may be made by drawings or models. (*Loom Co. v. Higgins*, 105 U.S. 58, 26 L. Ed. 1177; *Odell v. Stout*, 22 Fed. 159; *Kreeland v. Sheriff*, 18 O.G. 242; *Reeves v. Keystone Bridge Co.*, 5 Fish. 546, Fed. Cas. No. 11660; *Mirrow v. Shoemaker*, 59 Fed. 120), or by oral testimony (*Standard v. Peters*, 77 Fed. 630, 23 C.C.A. 367.)

A prior invention may be established by parol evidence alone. (*American v. Weston*, 59 Fed. 147, 8 C.C.A. 56; *Washburn v. Beat-em-All*, 143 U.S. 275; *Consolidated Fruit Jar Co. v. Wright*, 94 U.S. 92; *Egbert v. Lippman*, 104 U.S. 333; *Onduras v. Hovey*, 124 U.S. 694; *Jones v. Barker*, 11 Fed. 597.)

The rule as to burden of proof established in the United States courts is as follows:

Where anticipation is set up by a defendant in an infringement action the burden of proof rests upon him. Where, however, anticipation prior to the date of the patent is proved the burden is shifted to the plaintiff to prove that his invention was made anterior to the alleged anticipation. (*Clark v. Williamanter*, 140 U.S. 481, 35 L. Ed. 521, 11 S. Ct. 846; *Untermeyer v. Freund*, 58 Fed. 205, 7 C.C.A. 183; *Rogers v. Fitch*, 81 Fed. 959, 27 C.C.A. 23; *New England v. Sturtevant*, 150 Fed. 131, 80 C.C.A. 85.)

United States rule as to burden of proof where anticipation set up.

CHAPTER IV.

UTILITY.

Whether English decisions are exactly in point in determining what is meant by the word "useful" as used in the Canadian Statute is a matter of some doubt.

No
statutory
require-
ment of
utility in
England.

The sixth section of the Statute of Monopolies does not refer to the necessity of utility in the invention, but saving, as it does, the common law prerogative of the Crown, it refers us back to what had previously been held to be the necessary elements of an invention. One of these elements was that it should tend to the furtherance of trade and be for the good of the realm. (*Darcy v. Allin* [1602] Noy. R. 178.) The public had a right to receive a meritorious consideration in return for the protection granted (*Boulton v. Bull* [1795] 2 H. Bl. 463). On this foundation the requirement of utility rested.

Utility de-
fined in
England.

A late definition of utility as the term is understood in England was given by Buckley, J., in *Welshach Co. v. New Incandescent, etc., Co.* (1900) 17 R.P.C. 237, at p. 252:

"Utility, in Patent law, does not, as I understand it, mean either abstract utility, or comparative or competitive utility, or commercial utility. It was described by Mr. Justice Grove in *Young v. Rosenthal*, 1 R.P.C. 34, as meaning an invention better than the preceding knowledge of the trade as to a particular fabric. I adopt this definition if the word 'better' be understood as meaning better in some respects and not necessarily better in every respect, so that, for instance, an article which is good, though not so good as that previously known, but which can be produced more cheaply by another process, is better, in that it is better in point of cost, although not so good in point of quality. . . .

"Again I may take another test of utility, namely, that an invention is useful for the purposes of the Patent

Law, when the public are thereby enabled to do something which they could not do before, or to do in a more advantageous manner, something which they could do before, or to express it in another way, that an invention is patentable which offers the public a useful choice. "

The test of utility stated by Buckley, J., is adopted though it would seem with a possible modification by Lord Salvesen in *Kelvin v. Whyte, Thompson & Co.* (1907) 25 R.P.C. 177, at p. 192: "In my opinion, it is not necessary that I should decide, even if I were competent to do so whether the grummet ring suspension or the compainer's latest is the most satisfactory. It is enough if the new suspension affords a useful choice to persons who require compasses." (See also *Wilson v. Wilson Brothers Bobbin Co., Ltd.* [1911] 28 R.P.C. 733, 739, C.A. *Presto Coat Collar Co. v. Levy Brothers* [1911] 28 R.P.C. 363, C.A.)

The result of the English decisions seems to be that an invention must possess advantages of some kind over what already exists. It is not thought that the word "useful" in the Canadian Act must be read in this sense. As pointed out, the requirement of utility arises in England from the necessity of consideration for the grant. In Canada there seems no reason why the idea of consideration should enter into the question. We are simply called upon to interpret the words of the statute. It is submitted that the word "useful" does not imply any comparison with what already exists but only requires that the invention shall be serviceable or capable of use. If a thing is useful (in the sense of being serviceable) in itself, and is new, there can be no question as to whether it is better than what has previously existed.

This view is that adopted by the United States courts on the statute from which our section is copied. In *Crompton v. Belknap* (1869) 3 Fisher 536, the word "useful" was held to mean "capable of some beneficial use," in contradistinction to what is pernicious or frivolous or worthless. In *Shaw v. Colwell Lead Co.* (1882) 11 F. 711, it was said at p. 715: "The statutes do not require inventions to be superior to or better than all other things known to be patentable. It is sufficient if they are useful in themselves, if they are also new." (*Bell v.*

Meaning of
"useful" in
Canadian
Act.

United
States
views.

Daniels [1858] 1 Fisher 375; Seymour v. Oshorne [1876] 11 Wallace 516; Crouch v. Speer [1874] 6 O G. 187; Hoffheims v. Brandt, 3 Fish. 218; Crown v. Aluminum, 108 F. 845; Lamb Knit Goods Co. v. Lamb Glove & Mitten Co., 120 F. 267.)

Useful for
what?

The English cases raise the question "useful for what?" and give the answer: "for the purposes set forth in the patent." (Lane-Fox v. Kensington & Knightsbridge Electric Lighting Co. [1892] 9 R.P.C. 413, 417.) If it is not useful for such purposes the patent is void. (Simpson v. Holliday [1886] L.R., 1 H.L. 315; Turner v. Winter [1787] 1 W.P.C. 77; Bloxam v. Elsee [1827] 1 C. & P. 558; United Horseshoe and Nail Co. v. Swedish Horsenail Co. [1889] 6 R.P.C. 1, 8.) If the patentee has set forth a number of purposes for which the invention is alleged to be useful, and it turns out that the invention is not useful for them all, it will nevertheless be valid unless the purposes for which it is useless were the principal ones, and it can be said that the statements of the patentee are substantially misleading and false in suggestion.

Stirling, L.J., in Ward Bros. v. James Hill & Sons (1903) 20 R.P.C. 189, at p. 202, said: "But then it is said that the specification contained a representation that the invention which is the subject of claim 2, would be useful if it was worked automatically, and consequently on the authority of the case of Bloxam v. Elsee (6 B. & C. 169) that inasmuch as it was not useful when worked automatically the patent was invalid. It does seem to me that if the specification contained such a representation, the consequence which is contended for would follow, but I cannot find any such representation in the specification."

Mr. Justice Parker in *In the Matter of Alsop's Patent* (1907) 24 R.P.C. 733, referring to utility for purpose specified at p. 753, said: "Want of utility in this sense, must however, in my opinion, be distinguished from want of utility in the sense of the invention being useless for any purpose whatever. . . . Further there may be cases in which the result which the patentee claims to have produced, can in fact be produced, but the patentee has gone on to detail the useful purposes to which such result can be applied and that in fact the result produced cannot be applied to one or more of such purposes. In such a case

I do not think the patent is necessarily void, provided there are purposes for which the result is useful. If it be avoided it can only be because it contains a misrepresentation so material that it can be said the Crown has been deceived." (See also *Lyon v. Goddard* [1893] 11 R.P.C. 354; *Lewis v. Marling* [1829] 10 B. & C. 22; *Haworth v. Hardcastle* [1834] 1 Bing. N.C. 190.)

Though we are without decisions it is thought the Canadian law on this point is the same as the English. An untrue statement of purposes for which the invention is useful wilfully made for the purpose of misleading probably falls within the terms of sec. 29 of the Patent Act and renders the patent void. It is not thought that sec. 33 has any direct application to the statement of the purposes for which the invention is useful made in the patent. Sec. 33 refers to the subject matter of the invention as claimed which must be the same whether all the uses claimed exist or not. It may, however, perhaps furnish an argument from analogy in favour of the view of the English courts.

Misleading statement as to utility.

In the United States it has been held that utility is absent if the invention is immoral or its use pernicious. (*Klein v. Russell*, 19 Wall. 433; *Richard v. Duhon*, 103 F. 868.) In Canada, inventions having an "illicit" object are specifically excluded by subsection 2 of sec. 7 of the Act, and it is therefore not necessary under it, to construe the term "useful" to exclude such inventions.

Inventions having "illicit" objects.

"Illicit" appears to be a term of much wider scope than "immoral," and under it the Canadian Patent Office has refused to grant patents for inventions, such as those on oleomargarine compounds, which in other countries would be good subject matter. The refusal to grant patent on oleomargarine compounds is based on the Criminal Code which prohibits the manufacture or sale of oleomargarine compounds, and it would appear that a similar objection would exist to the granting of any patent, the sole purpose of which was to provide a means for evading or contravening the prohibition of some statute. The courts as yet in Canada have not considered any patents of an illicit or immoral character.

In *Fuller v. Berger et al.* (120 F. 274), an invention was held to be useful, "if it is used or is designed and

adapted to be used, to accomplish a good result, though in fact it is oftener used, or as well or even better adapted to be used, to accomplish a bad result."

Inoperative inventions.

A patent for an invention which is inoperative or unworkable may be attacked on two grounds. First: It is not an invention. Second: It is not useful. The first ground is really the proper one. It has been held in the United States that to sustain a defence of lack of utility against a patent on the ground that it is inoperative or unworkable, it is necessary for the defendant to show either that it is theoretically impossible for such a device to operate or demonstrate by clear proof that persons skilled in the art to which the invention appertains have endeavoured in good faith to make the patent work and have been unable to do so. (Crown v. Aluminum, 108 F. 845.)

CHAPTER V.

ABANDONMENT—PUBLIC USE OR SALE.

Sec. 4886 of the Revised Statutes of the United States contains the provision that "any person who has invented . . . unless the same is proved to have been abandoned may . . . obtain a patent therefor." In the Canadian Statute the word "abandonment" does not appear. It is believed, however, that the law as to abandonment is substantially the same in Canada as in the United States.

Any person who has invented something new has an inchoate right, which by compliance with the statute, may be converted into a property in his invention. The patent secures to the inventor an exclusive right. It prevents others from making or using the invention. Prior to the granting of a patent the inventor may extinguish his inchoate right by surrendering or dedicating his invention to the public. Once the invention passes into the public domain the inventor cannot resume his right.

Abandonment may rest upon the actual intention of the inventor to dedicate his invention to the public. Such a dedication like any other dedication must be clearly proved. (*Mast v. Dempster*, 82 Fed. 327, 27 C.C.A. 191; *Ide v. Trorlicht*, 115 Fed. 137, 53 C.C.A. 341.) It may, however, be constructive where it results from a statute which may be considered as operating regardless of the intention of the inventor or as raising an irrebuttable presumption of an intention to abandon. Under the Canadian Statute an invention must be regarded as abandoned under sec. 7 where it has "been in public use or on sale with the consent or allowance of the inventor thereof, for more than one year previously to his application for patent therefor in Canada."

Abandonment may result from actual or constructive dedication.

An invention may be abandoned to the public either before, at the time, or after application for a patent.

Abandonment before patent applied for.

Before making application the inventor may in words expressly disclaim any exclusive right in his invention or dedicate it to the public. Or his conduct may be such as to be inconsistent with an intention to retain the right to claim a patent (*Kendall v. Windsor*, 62 U.S. 322, 16 L. Ed. 165; *United States, etc., Cartridge Co. v. Whitney Arms Co.*, 118 U.S. 22, 30 L. Ed. 53; *Crown v. Aluminum*, 108 Fed. 845, 48 C.C.A. 72). In either case his inchoate right to a patent is extinguished and cannot be resumed. (*Pennock v. Dialogue* [1829] 2 Pet. 1, 7 L. Ed. 327; *Kendall v. Windsor* [1858] 62 U.S. 322, 16 L. Ed. 165; *Crown v. Aluminum*, 108 Fed. 845, 48 C.C.A. 72; *Planing Machine Co. v. Keith* [1879] 101 U.S. 479, 484.)

Conduct from which abandonment may be inferred.

No precise test can be applied as to the conduct from which abandonment may be inferred. It is a question of evidence. Desertion or destruction of a device without any definite intention of resuming experiments in connection with it may show abandonment of the invention. (*Seymour v. Osborne* [1870] 78 U.S. 516, 20 L. Ed. 33; *Johnston v. Root*, 2 Fish. 291, 2 Clifford 108.) In the United States it has been held that long delay, constituting laches in applying for a patent, may also prove abandonment. (*Consolidated Fruit Jar Co. v. Wright*, 94 U.S. 92, 24 L. Ed. 68; *Craver v. Weyhrich*, 31 Fed. 607; *Wright v. Postel*, 44 Fed. 352.) Delay will, however, not amount to abandonment where it is accounted for in such a way as to be consistent with an expectation to finally secure a patent. Delay may be explained by illness or insanity (*McNeely v. Williams* 96 Fed. 978, 37 C.C.A. 641; *Ballard v. Pittsburg*, 12 Fed. 784), or by poverty (*Smith v. Goodyear*, 93 U.S. 491; *Celluloid Mfg. Co. v. Crofut*, 24 Fed. 796). The poverty must be extreme and disabling. (*Rifle & Cartridge Co. v. Arms Co.* [1885] 118 U.S. 24; *Wickersham v. Singer* [1859] 1 *McArthur's Patent Cases*, 689; *Craver v. Weyhrich* [1887] 31 Fed. 607.) The question whether an inventor who keeps the invention secret so that he may enjoy the exclusive benefit of its use loses his right to a patent is considered later.

Abandonment at time of application.

An invention may also be abandoned at the time of application for a patent. The inventor will be held to abandon an invention when he formally disclaims it in an application for a patent for some other invention. (*Yale*

Lock Co. v. Berksbire Bank [1890] 135 U.S. 342, 34 L. Ed. 168, 10 S. Ct. 884; Pittshugg v. Cowles Electric Co., 55 Fed. 301.)

The general rule is that anything described in a specification, if not claimed, is presumed to be given to the public. (Barnett-McQueen v. Canadian Stewart Co., Ltd. [1910] 13 Ex. C.R. 186 at p. 221; Barter v. Howland [1878] 26 Gr. 135; Terrell on Patents, 5th Ed., p. 131; Hincks v. Safety Lighting Co. [1876] L.R. 4 Cb.D. 607; Miller v. Brass Co., 104 U.S. 350, 26 L. Ed. 783; Electric v. Boston, 139 U.S. 481, 35 L. Ed. 250, 11 S. Ct. 586; McClain v. Ortmyer, 141 U.S. 419, 35 L. Ed. 800, 12 S. Ct. 76; Centerwood v. Gerher, 149 U.S. 224, 37 L. Ed. 710, 13 S. Ct. 856; Decring v. Winona, 155 U.S. 286, 39 L. Ed. 153, 15 S. Ct. 118; Re Leonard (1913) 14 Ex.C.R. 351).

General rule, anything not claimed presumed to be abandoned.

This general rule is, however, subject to qualifications. As it is based upon the presumed intention of the inventor to dedicate what he does not claim, to the public, this presumption may be rebutted if there be something to show that he has no such intention. The absence of any intention to dedicate to the public may be evidenced by filing another application covering the matter described, but not claimed before the issue of the first patent (Thompson-Houston v. Elmira, 71 Fed. 396, 18 C.C.A. 145; Graham v. Geneva [1880] 11 Fed. 138; Graham v. McCormack, 11 Fed. 859; Victor v. American, 145 Fed. 350, 78 C.C.A. 180, 143 U.S. 275), or by reserving in the first patent a right to secure the matter disclosed by a future patent. It may possibly also be shown by applying for a subsequent patent covering such matter within a reasonable time after the issue of the first patent, and before the public have acted on the apparent abandonment created by the failure to claim in the first patent. (Robinson on Patents, Vol. I, p. 483.)

General rule may be rebutted.

The presumption of abandonment will also be rebutted by an amendment properly made, claiming what had not been claimed, before the patent issues.

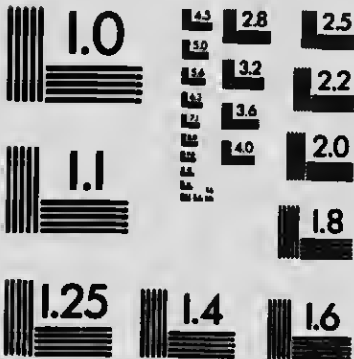
There is also another qualification of the general rule. Sec. 24 of the Patent Act provides for a re-issue where a patent is defective or inoperative by reason of insufficient specification where the error arose from inadvertence, accident or mistake. Failure to claim will be presumed to have

Abandonment not presumed from failure to claim which can be cured on re-issue.



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been intentional, but under circumstances covered by sec. 24, it is not intentional and does not indicate abandonment. Whether such failure to claim is abandonment or not, therefore, depends upon the right of the inventor, under all the circumstances to correct the omission by re-issue. (*Railway Register Mfg. Co. v. Broadway & Seventh Avenue R.R. Co.* [1886] 26 Fed. 522; *Batlin v. Taggart*, 58 U.S. 77, 15 L. Ed. 3; *Topliff v. Topliff*, 145 U.S. 156, 36 L. Ed. 658, 12 S. Ct. 825; *Re Leonard* (1913) 14 Ex. C.R. 351).

The only case which we have had in Canada held that what could have been claimed as part of the invention under the specifications and description accompanying the original patent, but was not by reason of error, mistake or inadvertence, may be claimed on a re-issue. (*Withrow v. Malcolm* [1884] 6 O.R. 12.) It is, however, perhaps open to doubt as to whether this law will stand. The Supreme Court of the United States has held that a re-issue cannot be granted to cover any matter disclosed with respect to which an intention to claim was not shown in the original patent. (*Parker & Whipple Co. v. The Yale Lock Co.* [1887] 123 U.S. 87, 99; *Hoskins v. Fisher* [1887] 125 U.S. 217, 223; *Flower v. Detroit* [1887] 127 U.S. 571; *Pattee Plough Co. v. Kingman & Co.* [1889] 129 U.S. 294; *Freeman v. Asmus* [1895] 145 U.S. 240; *Corbin Cabinet Lock Co. v. Eagle Lock Co.* [1893] 150 U.S. 42.) This view appears to have been anticipated in the dissenting opinion of Proudfoot, J., in *Withrow v. Malcolm*.

Unless there has been laches in applying for a re-issue.

Where, however, something has been disclosed, but not claimed, and unreasonable delay occurs in applying for a re-issue, the right to a re-issue may be lost, and that which has not been claimed held to be abandoned to the public (*Kidder v. Smart* [1884] 8 O.R. 362; *Withrow v. Malcolm* [1882] 6 O.R. 12). For a contrary view, see *Auer Incandescent v. O'Brien* (1897) 5 Ex. C.R. 243.

Abandonment by withdrawal or failure to prosecute an application.

Abandonment of an application, either by withdrawal or failure to prosecute, may be evidence of the abandonment of the invention. The presumption of abandonment raised may, however, be rebutted by a new application. (*Hayes Young v. St. Louis*, 137 Fed. 80, 70 C.C.A. 1; *Godfrey v. Eames*, 68 U.S. 317, 17 L. Ed. 684; *Smith v. Goodyear*, 93 U.S. 486, 23 L. Ed. 952.) Where an application has been rejected and the inventor for a considerable

time takes no step to reinstate or renew it, he must be held to have acquiesced in its rejection, and to have abandoned any intention of further presenting his claim. (U.S. v. Whitney, 118 U.S. 22, 30 L. Ed. 53, 6 S. Ct. 950; Planing v. Kelth, 101 U.S. 479.) Where the inventor cancels a claim from an application or acquiesces in its rejection by amendment, the claim will be held to be disclaimed or abandoned (Yale Lock Co. v. Berkshire Bank, 135 U.S. 403; Pittsburg Reduction Co. v. Cowles Electric Co., 55 Fed. 320; Sargent v. Hall, 114 U.S. 63, 29 L. Ed. 67, 5 S. Ct. 1021; Shepard v. Carrigan, 116 U.S. 593, 29 L. Ed. 723, 6 S. Ct. 493; American v. Pennock, 164 U.S. 26, 41 L. Ed. 337, 17 S. Ct. 1; Lehigh v. Kearney, 158 U.S. 461, 39 L. Ed. 1055, 15 S. Ct. 871; Computing v. Automatic, 204 U.S. 609, 51 L. Ed. 645, 27 S. Ct. 307. See also Macomber, The Fixed Law of Patents, sec. 207.)

Sec. 7 of the Canadian Act provides that "any person who has invented any new and useful article . . . which has not been in public use or on sale with the consent or allowance of the inventor thereof, for more than one year previously to his application for patent therefor in Canada, may . . . obtain a patent." Public use
or on sale.

Under sec. 17 "The Commissioner may object to grant a patent in any of the following cases:

(b) When it appears to him that the invention is already in the possession of the public, with the consent or allowance of the inventor.

Sec. 54 provides that a patent shall not be invalid by reason of purchase, construction or acquisition or use of the invention prior to the issuing of a patent "unless the same was purchased, constructed, acquired or used, with the consent or allowance of the inventor thereof, for a longer period than one year before the application for a patent therefor, thereby making the invention one which has become public and in public use."

The United States Patent Act of 1836, sections 6 and 7, authorized the Commissioner of Patents to grant a patent only where the invention had not been in public use or on sale with the applicant's consent or allowance prior to the application. Sec. 7 of the United States Patent Act of 1839 provided that no patent should be held to be in-

valid by reason of purchase, sale or use of the thing covered thereby prior to the application for a patent except on proof of abandonment of such invention to the public, or on proof that such purchase, sale or use had been for more than two years prior to such application for a patent. The provision of sec. 4886 of the Revised Statutes is, "and not in public use or on sale for more than two years prior to the application."

The Canadian Patent Act of 1869 required that the invention should not be in public use or on sale at the time of the application. (*Bonathon v. Bowmanville Furniture Mfg. Co.*, 31 U.C.Q.B. 413.) In the Act of 1872, the Act was amended and in sec. 5 a clause only slightly different from that quoted above from sec. 7 of the present Act appeared.

The effect of the provisions of sec. 7 is that there will be a constructive or statutory abandonment of the invention if it has been in public use or on sale with the consent or allowance of the inventor for more than one year prior to his application in Canada.

Invention must not have been in use or on sale for longer than the fixed period anywhere.

In *Smith v. Goldie* (1882) 9 S.C.R. 46, it was held that the words used in the sixth section of the Patent Act, 1872, "not being in public use or on sale for more than one year previous to his application, in Canada," were to be read as meaning "not being in public use or on sale in Canada for more than one year previous to his application." In the revision of the Statutes in 1886, however, the wording of the section was changed, and in *The Barnett-McQueen Co. v. The Canadian Stewart Co.* (1910) 13 Ex. C.R. 186, it was held that the words "in Canada" in the section as it now stands do not refer to "public use or on sale," but to the application for the patent, and therefore that the inventor is disentitled to a patent if the invention has been in use or on sale anywhere for more than a year previous to the application for a patent in Canada. (See also *Lomhard v. Alexander Dunbar & Sons Co.* [1910] 8 E.L.R. 261.)

No abandonment by use or sale within the year.

An invention may be abandoned by express declaration or by conduct of the inventor within one year prior to his application, but the evidence must be clear. (*Elizabeth v. Pavement Co.*, 97 U.S. 126, 24 L. Ed. 1000; *Egbert Lippmann*, 104 U.S. 333, 26 L. Ed. 755.) Public use or

sale of the invention either by the inventor or others within one year before his application is no evidence of abandonment. (*Park v. Booth*, 102 U.S. 96, 26 L. Ed. 54; *Haines v. McLaughlin*, 135 U.S. 584, 34 L. Ed. 290; *Bates v. Coe*, 98 U.S. 31, 25 L. Ed. 68; *Consolidated Fruit Jar Co. v. Wright*, 94 U.S. 92, 24 L. Ed. 68.) Public use or sale pending an application cannot evidence an abandonment. (*Goodyear Dental Vulcanite Co. v. Smith*, 5 O.G. 585, *Holmes* 354; *Smith v. O'Connor*, 4 O.G. 633, 2 *Sawyer* 461, 6 *Fish*. 469.)

The use referred to in the statute must be public.

In *Hessin v. Coppin* (1873) 19 Gr. 629, it was held that the words quoted above, now found in sec. 54, amount to a definition of public use. They were said to declare an invention to be "in public use" if for a longer period than one year before the application for a patent therefor, it has been purchased, constructed, acquired or used. The decision in this case cannot be questioned. The language is, however, too broad unless read as applied only to the facts before the court. Section 54 deals only with the rights of intervening parties, and the public use therein referred to is confined to use by others than the inventor. Even confined to such use the language used in this case can amount to little more than a general rule, subject to explanation and qualification. About all that can be got out of sec. 54 is a suggestion that "construction" by someone other than the inventor may amount to use within the meaning of the Act.

It was suggested in *Hessin v. Coppin* (1873) 15 Gr. 629, that the Patent Act contemplates an immediate disclosure of the invention and that the right to a patent may be prejudiced by failure to disclose and secret use for a considerable length of time. The same suggestion was made by Lord Campbell, C.J., in *Heath v. Smith*, 2 W.P.C. 278. The point has not been decided in Great Britain or Canada. It is submitted, however, that an inventor may, if he can, keep his invention secret and that secret use will not prejudice his right to a patent. (*Bates v. Coe*, 98 U.S. 31, 25 L. Ed. 68; *Parks v. Booth*, 102 U.S. 96, 26 L. Ed. 54; *Miller Patent* 15 R.P.C. 213; *Wood v. Zimmer*, 1 W.P.C. 44, 82; *Frost*, Patent Law and Practice, 4th Ed., Vol. I., p. 129.)

Use referred to in statute must be public.

Secret use probably does not prejudice right to patent.

Public use is use in public manner not use by public.

Whether a use is public or private does not depend upon the number of persons to whom its use is known. "Public use does not mean a use or exercise by the public, but a use or exercise in a public manner" (per Ahinger, C.B.), *Carpenter v. Smith* [1842] 1 W.P.C. 530, 9 M. & W. 304). A single use may be sufficient. If an inventor having made his device, gives it or sells it to another, to be used by the donee or vendee without limitation or restriction, or injunction of secrecy, and it is used, such use is public, within the meaning of the statute, even though the use and knowledge of the use may be confined to one person. (*Eghert v. Lippman*, 104 U.S. 333, 26 L. Ed. 755; *Root v. Third Avenue R. Co.*, 146 U.S. 210, 36 L. Ed. 946; *International Tooth Crown Co. v. Gaylerd*, 140 U.S. 55, 35 L. Ed. 347; *Consolidated Fruit Jar Co. v. Wright*, 94 U.S. 92, 24 L. Ed. 68; *Worley v. Tohacco Co.*, 104 U.S. 340, 26 L. Ed. 821; *Taylor's Patent* [1896] 13, R.P.C. 481; *Betts v Neilson* [1868] L.R. 3 Ch. 429.)

Use in hidden place may be public.

Some inventions are by their very character only capable of being used where they cannot be seen or observed by the public eye. Nevertheless, if an inventor sells a machine of which his invention forms a part and allows it to be used without restriction of any kind, the use is public. The fact that after the construction of a mechanical device, the mechanism is hidden from view, does not make a use of the device a private one. (*Eghert v. Lippman*, 104 U.S. 333, 26 L. Ed. 755; *Hall v. MacNeale*, 107 U.S. 90, 27 L. Ed. 367; *Root v. Third Avenue R. Co.*, 146 U.S. 210, 36 L. Ed. 946; *Brush v. Condit*, 132 U.S. 39, 33 L. Ed. 251; *Smith, etc., Mfg. Co. v. Sprague*, 123 U.S. 249, 31 L. Ed. 141.)

Use in public for experimental purposes may not be public use within the Act.

The use of an invention by way of experiment in testing and working the invention and for no other purpose not incidental thereto is not public use within the Act. (*Conway v. Ottawa Electric Ry. Co.* [1904] 8 Ex. C.R. 432; *Barnett McQueen Co. v. Canadian Stewart Co.* [1910] 13 Ex. C.R. 186; *Summers v. Ahell* [1869] 15 Gr. 532; *Elizabeth v. Pavement Co.*, 97 U.S. 126, 24 L. Ed. 1000.) The experiment must, however, be clearly experimental (*Bonathan v. Bowmanville* [1871] 31 U.C.Q.B. 413; *Smith, etc., Mfg. Co. v. Sprague*, 123 U.S. 249, 31 L. Ed. 141) and must be an inventor's experiment for the

purpose of discovering defects and perfecting the invention, and not a trader's experiment to test the market. (Smith & Davis v. Millon, 58 Fed. 705, 7 C.C.A. 439). The use if experimental is not public within the statute, though made in public. (Conway v. Ottawa Electric Ry. Co. [1904] 8 Ex. C.R. 432; Elizabeth v. Pavement Co., 97 U.S. 126, 24 L. Ed. 1000; Egbert v. Lippmann, 104 U.S. 333, 26 L. Ed. 755; Shaw v. Cooper, 7 Peters 292, 8 L. Ed. 689) The fact that the inventor derived a profit from the use so long as the profit is incidental, does not prevent the use from being experimental. (Smith, etc., Mfg. Co. v. Sprague, 123 U.S. 249, 30 L. Ed. 141; International Tooth Crown Co. v. Gaylord, 140 U.S. 55, 35 L. Ed. 347; Root v. Third Ave. Ry. Co., 146 U.S. 210, 36 L. Ed. 946.) Nor is the nature of the use effected by the fact that the public derives a benefit. (Elizabeth v. Pavement Co., 97 U.S. 126, 24 L. Ed. 1000.)

An invention will also be constructively abandoned if it has been "on sale" with the consent or allowance of the inventor for more than one year prior to the application. On sale.

An invention is "on sale" if it is offered for sale whether any specimen of it is actually sold or not, and it may be on sale even though no specimen has been actually made if orders are solicited from models, drawings, or otherwise. (Barnett-McQueen Co. v. The Canadian Stewart Co. [1910] 13 Ex. C.R. 186; Plimpton v. Winslow, 14 Fed. 921; Dittgen v. Racine Paper Goods Co., 181 Fed. 394.) Actual sale not necessary.

A single sale of a single specimen of the thing invented is enough to constitute putting the invention on sale. (Smith, etc., Mfg. Co. v. Sprague, 123 U.S. 249, 31 L. Ed. 141; Consolidated Fruit Jar. Co. v. Wright, 94 U.S. 92, 24 L. Ed. 68; National Cash Register Co. v. American Cash Register Co., 178 Fed. 79; in re Mills, 117 O.G. 904; Swain v. Holyoke, 109 Fed. 154, 48 C.C.A. 265.) A single sale places invention on sale.

It has been held in the United States that the disposition by an inventor for a pecuniary consideration of the article invented amounts to a "sale" within the meaning of the Patent Act, whether such disposition is made in accordance with a contract to manufacture such article, which would not be within the Statute of Frauds, or to Disposition not within the Statute of Frauds may be sale within Act.

sell it after manufactured. (*National Cash Register Co. v. American Cash Register Co.*, 178 Fed. 79.)

Sale for experimental purposes only may not be sale within section.

A sale of the invention by the inventor for experimental purposes where he is unable otherwise to make proper tests, does not put the invention on sale. (*In re Mills*, 117 O.G. 904; *Smith v. Sprague*, 123 U.S. 249, 31 L. Ed. 141; *Graham v. Geneva Mfg. Co.*, 11 Fed. 138.) Where, however, there has been a case of "on sale" made, the onus is on the inventor to prove the same was for experimental purposes. (*In re Mills*, 117 O.G. 904; *Smith v. Sprague*, 123 U.S. 249, 31 L. Ed. 141.)

Consent or allowance of inventor.

Under the Canadian Statute, the public use or sale of an invention by third persons more than one year before the application for a patent does not defeat the right to a patent unless the use or sale was with the consent or allowance of the inventor. Under the American Act consent or allowance of the inventor to the sale or use has not been required since 1839.

In *Patric v. Sylvester* (1876) 23 Gr. 573, the head-note reads in part as follows:

Patric v. Sylvester doubtful law.

"To invalidate a patent of invention on the ground that the subject thereof was in public use in any of the Provinces of the Dominion for more than a year prior to the application of the inventor for a patent, such use need not be shown to have been with the consent of the inventor; but to invalidate a patent on the ground that the subject-matter was on sale in any of such Provinces for that time, it must be shown to have been on sale with the consent or allowance of the inventor; in this respect sec. 6, now sec. 7, and sub-sec. 32 of the Act of 1872 (35 Vic., c. 26) correspond in their provisions."

Whether the head-note correctly states the law laid down in the judgment in this case is doubtful. In any event it is submitted that it is not good law. The language of *Proudfoot, V.C.*, was as follows:

"The defendant contends, however, that the plaintiff's patent is void on the ground of prior user, in other Provinces of the Dominion than New Brunswick, before the date of the patent of September, 1874; and a distinction was attempted to be made between the language of the Patent Act of 1872, sec. 6, relating to the grant of original patents, and of sec. 32, sub-sec. 2, as to the extension of

Provincial patents; that to invalidate the former it must have been used with the consent of the inventor in Canada; while in the latter all that was required was *knowledge* of the invention, and that the *consent* of the inventor in sec. 32 referred only to the *sale* with his consent.

"I think no such distinction exists. Sec. 6 says: 'Any person having invented any new . . . machine . . . not known or used by others before his invention thereof, and not being in public use or on sale for more than one year previous to his application, in Canada, with the consent or allowance of the inventor . . . may obtain a patent.' Sec. 32 says: 'It shall be lawful for the Commissioner, upon the application of the patentee . . . being the inventor . . . if the subject matter of the patent has not been known or used, nor with the consent of the patentee on sale in any of the other Provinces of the Dominion, to issue . . . a patent for the remainder of the term.' In neither case need the knowledge or use be with the consent of the inventor, and in both the consent is limited to the sale. The sixth section, indeed, says *not being in public use*, with consent, etc., but public use must be comprehended under the more general phrase *used by others* which does not require consent. I agree in the construction contended for of sec. 32, but do not think the Legislature intended to alter the laws as to priority of user by the construction insisted on of sec. 6."

This language may, perhaps, be said to be *obiter*, as it was decided that the patented invention had not been in use "during the period." What the language of the Vice-Chancellor amounted to is difficult to arrive at from the judgment. He does not distinguish between user (1) before the invention; (2) after the invention and before the application, and (3) user after the application and before the date of the patent. The language seems to refer in a confused way to all user "before the date of the patent," failing to note that user after the application and before the patent is not referred to in the Act, and that the clauses dealing with user before the invention and user after the invention, and before the application, refer to two entirely distinct things. The clause "not known or used by others before his invention" deals with

the question of novelty and no question of consent can arise as the use is not a use of "his invention," but "before his invention." The other clause, "and not being in public use or on sale for more than one year previous to his application," presupposes novelty—that is, the absence of knowledge or use before the invention—and deals with use of the invention prior to the application. In this clause the words "with the consent or allowance of the inventor" refer to the words "in public use," as well as to the words "on sale." The Vice-Chancellor was certainly wrong in stating that the public use referred to in the latter clause must be comprehended under the more general phrase "used by others," which does not require consent. The public use referred to in the second clause is after the invention. What he describes as the more general phrase refers only to use before the invention.

Surreptitious use of invention for more than year has no effect.

Since consent or allowance of the inventor is essential, surreptitious use of the invention can have no effect. Knowledge or at least failure to use accessible means of knowledge is necessary to consent, and a use or sale successfully concealed from the inventor will not effect his right to a patent. (*Kendall v. Windsor*, 62 U.S. 322, 16 L. Ed. 165; *Pennock v. Dialogue*, 2 Pet. 1, 7 L. Ed. 327.) But no matter by what means an invention has been communicated to the public, if the inventor knows of use by others abandonment will result, if he does not at once prohibit such use or does not make application for a patent within the year. (*Kendall v. Windsor*, 62 U.S. 322, 16 L. Ed. 135; *Sissons v. Gilbert*, 9 Blatch. 185; *Shaw v. Cooper*, 7 Pet. 292, 8 L. Ed. 689.)

CHAPTER VI.

EFFECT OF FOREIGN PATENTS ON RIGHTS IN CANADA.

SECTION 8.

Section 8 of the Patent Act reads: "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 patent is applied for within one year from the date of the issue of the first foreign patent for such invention.

As to inventions for which foreign patents have been taken out.

"2. If within three months after the date of the issue of a foreign patent, the inventor gives notice to the Commissioner of his intention to apply for a patent in Canada for such invention, then no other person having commenced to manufacture the same device in Canada during such period of one year, shall he entitled to continue the manufacture of the same after the inventor has obtained a patent therefor in Canada, without the consent or allowance of the inventor.

Manufacture in Canada.

"3. No Canadian patent issued previous to the thirtieth day of August, one thousand nine hundred and three, shall he deemed to have expired before the end of the term for which it was granted merely because of the expiry of a foreign patent for the same invention. (55-56 Vic., c. 24, s. 1; 3 Edw. VII., c. 46, s. 2.)

Expiry of Canadian patent.

The Act of 1869 (32-33 Vic., cap. 1157) provided that the inventor should not be deprived of his right to a patent by reason of a foreign patent granted within six months prior to application in Canada.

History of section.

The Act of 1872 (35 Vic., cap. 26, sec. 7) contained the following provisions:

"But an inventor shall not be entitled to a patent for his invention, if a patent therefor in any other country shall have been in existence in such country for more than twelve months prior to the application for such patent in Canada; and if during such twelve months, any person shall have commenced to manufacture in Canada the article for which such patent is afterwards obtained, such person shall continue to have the right to manufacture and sell such article, notwithstanding such patent; and under any circumstances where a foreign patent exists, the Canadian patent shall expire at the earliest date at which any foreign patent for the same invention expires."

The Revised Statutes of 1886 continued this provision changing only the first few words to read "No inventor shall be entitled to a patent, etc."

In 1892 (55-56 Vic., cap. 24, sec. 1) the section was repealed. Sub-sections 1 and 2 as they now appear were then enacted. The provision as to expiration of a Canadian patent at the earliest date at which any foreign patent for the same invention expires was continued.

In 1903 (3 Edw. VII., cap. 46 sec. 2) repealed the provision as to expiry of a Canadian patent with a foreign patent.

Sub-section
1 is unsatis-
factory.

The present section is very unsatisfactory. The meaning of the earlier enactments was clear. The effect of the present section is far from clear. In place of the present sub-sec. 1, we had formerly a provision, negative in terms, that no inventor should obtain a patent for what had been patented elsewhere for more than a year. If this provision had any meaning its effect was to limit the rights which would in its absence have arisen from the rest of the Act. Necessarily, inasmuch as it was entirely negative and gave no rights, the right to obtain a patent in Canada within the year after the foreign patent must have depended upon other sections of the Act and could not have been elsewhere negated. Inferentially, in the absence of this provision, a patent could also have been obtained after

the expiration of the year. The other sections of the Act have not been changed in anything material to his discussion. It might therefore be argued that if the former provision had any meaning and was in effect restrictive, the present sub-section has no meaning and no effect, and consequently, that a patent will be good though applied for after one year from the issue of a foreign patent.

While this might be a logical view from a literal reading of the sub-section, it will probably not prevail. It seems likely that the courts will hold, if the question ever arises, that the law is now the same as before the change made in the section, and that a valid patent cannot be obtained unless applied for within a year from the granting of a foreign patent. In two recent cases it seems to have been assumed, though not decided, that this is the law. (*Milner v. Kay* [1902] 1 O.W.R. 200; *Copeland-Chatterton Co. v. Lyman Bros. Co.* [1907] 9 O.W.R. 908, 11 O.W.R. 70.) It is probably a case for the application of the principle that where there is a special affirmative power given which would not be required because there is a general power, it must be read as importing a negative and that nothing else can be done (*ex parte Stephens* [1876] 3 Ch.D. 659).

The present practice of the Patent Office is to refuse a patent where a foreign patent is known to have existed for more than a year.

It cannot be contended that an inventor acquires any greater rights by reason of obtaining a foreign patent. He must still comply with sec. 7. In *Lombard v. Alexander Dunbar & Sons Co.* (1911) 8 E.L.R. 261, Barker, C.J., said, referring to sec. 8: "As I read that section it only keeps the field open as against other applicants for a year within which the foreign patentee may apply. It in no way gives him any right to obtain a patent in Canada merely because he has one in a foreign country. In order to do that he must comply with the provisions of sec. 7." (See also *Milner v. Kay* [1902] 1 O.W.R. 200.) Even where there has been a foreign patent a Canadian patent will be void if the invention has been in public use or on sale with the consent of the inventor for more than one year.

Law is probably the same as before change in section.

Existence of foreign patent does not relieve inventor from fulfilment of terms of section 7.

Section refers to date when patent actually issued.

Sub-section 2 is probably meaningless.

Certain foreign patents are issued as of the date of filing. It is thought, however, that the section refers to the date on which the patent is actually issued, and not to the date given in the patent.

Sub-sec. 2 of sec. 8 is even more unsatisfactory than sub-sec. 7. Until a patent issues any person may manufacture the invention. (*Victor v. H. A. Wilson Co.* [1904] 7 O.L.R. 576.) When the Canadian patent issues it gives the exclusive right to manufacture to the patentee, and in the absence of any statutory provision the rights of all other persons to manufacture cease. The provision repealed in 1892 gave any person who commenced to manufacture within twelve months after a foreign patent the right to continue to manufacture and sell. The prior foreign patent therefore in effect curtailed the rights of the patentee. The present sub-section, unless by implication, gives the intervening manufacturer no rights; nor does any other section of this Act. Sec. 54 gives the right to use and sell specific articles manufactured prior to the patent, but does not authorize one who has, with or without the consent of the patentee, manufactured the patented article for less than a year before the issue of the patent, to continue to manufacture after the issue thereof (*Fowell v. Chown*, 25 O.R. 71, *Affd.* 22 O.A.R. 268). It is open to argument that by implication the effect of the sub-section is that where a foreign patent has been taken out and no notice is given of intention to apply for a Canadian patent within three months, anyone commencing to manufacture before the Canadian patent issues may continue to manufacture after the Canadian patent issues. This argument, however, carries legislation by implication a long way. While it is impossible to be certain, the writers incline to the view that the sub-section lacks application and is meaningless.

British patent is a foreign patent.

It was held in *Dominion Cotton Mills Company v. General Engineering Company of Ontario* (1902) A.C. 570, that a British patent is a foreign patent within the meaning of this section.

In *Milner v. Kay* (1902) 1 O.W.R. 200, a foreign patent was obtained on September 8th, 1896, and the Canadian application was made on September 8th, 1897. It was held the application was within the year.

Previous to 1903 a Canadian patent expired at the earliest date at which any foreign patent for the same invention existing at any time during the term of the Canadian patent expired. (Dominion Cotton Mills Co. v. General Engineering Co. of Ontario 1902 A.C. 570.) This provision was repealed in 1903, and it was provided that no patent then existing should expire merely because of the expiring of a foreign patent.

Expiry of foreign patent does not now affect Canadian patent.

CHAPTER VII.

APPLICATION FOR PATENT.

Formal requirements. The formal documents and drawings required for a patent application are:

(1) Petition. Where the application is to be made through a solicitor or agent, a power of attorney should be incorporated with it or executed separately.

(2) Oath.

(3) Specifications in duplicate, signed in the presence of two witnesses.

(4) Extra or third copy of claims.

(5) Drawings on cardboard 8" x 13", with tracings in duplicate hearing certificate signed by applicant or his attorney in the presence of two witnesses.

The petition. The petition practically amounts to a declaration that sec. 7 of the Patent Act has been complied with, that is to say, that the applicant "has invented new and useful . . . not known or used by any other person before his invention thereof, and which has not been in public use or on sale with the consent or allowance of the inventor thereof, for more than one year previously to his application for patent therefor in Canada."

Under sec. 29 the patent is void if any material allegation in the petition is untrue.

The petitioner in his petition, elects a domicile in Canada, the only purpose of which is apparently to settle the venue in the case of an impeachment of the patent under sec. 35.

Power of attorney. A power of attorney is not referred to in the Act or rules, but the forms authorized by the rules make provision for it, and indicate that it should be witnessed. The ordinary power of attorney in view of rulings under sec.

16 of the Act, is not considered sufficient authority to withdraw the application, although special authority to do this may be incorporated in it.

In addition to verifying the allegations of the petition, the oath, to comply with the prescribed form, must set forth any prior foreign patents obtained and the dates of issue for such patents. Oath.

Some foreign patents are granted as of the day on which they are filed, such as those of Great Britain, France or Germany. It is the actual issue or sealing date which should be referred to in the oath. Where more than one foreign patent exists, the Canadian application should be filed within one year from the first issued or sealed foreign patent. Pending foreign applications should not be referred to.

An oath executed more than three months previous to the filing of the application for patent, will not usually be accepted by the Patent Office.

In the United States a false oath leaves the applicant open to the charge of perjury. (Patterson v. U.S. 181, F. 970.) False oath.

In Canada such an oath would appear to bring the juror within sec. 175 of the Criminal Code, which reads; "Every one is guilty of an indictable offence and liable to seven years' imprisonment who, being required or authorized by law to make any statement on oath, affirmation or solemn declaration thereupon makes a statement which would amount to perjury if made in a judicial proceeding."

Where the invention has been assigned, the oath must nevertheless be executed by the inventor. If the inventor is dead, the administrator or executor may take the oath, which must be changed in wording to correspond.

If the inventor has died before application for patent has been made, it may be made by the person to whom the right to obtain a patent has been bequeathed or by the legal representatives of the deceased, upon a certified copy of the probate of the will, or letters of administration being filed. If an assignment has been Inventor dead.

made before death, the assignee may apply, and no probate or letters of administration are required.

Title or
name.

If an inventor dies during the prosecution of his application, probate or letters of administration should be filed before issue, and the patent will be withheld until such document is filed, if the Patent Office has knowledge of the death.

The inventor is required by sec. 12 of the Patent Act to insert the title or name of his invention in the petition. Sec. 29 provides that a patent shall be void "if any material allegation in the petition . . . is untrue," and it may be that a misleading or deceptive title would fall under this section.

In the early days in England the title performed the functions of a provisional specification and was of the utmost importance. Disconformity between the title and specification was fatal to the validity of the grant as being a fraud on the Crown. (*Cochrane v. Smethurst* [1816] 2 Coop. Ch. Cas. 57; *Campion v. Benyon* [1821] 3 Brod. & Bing. 5.) Since the Patent Act of 1883, which gave the Comptroller authority to examine the title proposed by the applicant, no patent has been held void for disconformity between the title and the specification, but no doubt such an objection could still be taken (see *Vickers v. Siddell* [1890] 7 R.P.C. at p. 303). Sec. 29 of the Canadian Act would appear to leave the law substantially the same here as in England. A title which in England would render the patent void through disconformity with the specification, might here be considered an untrue and material allegation in the petition.

Under the practice in the Patent Office no fancy or trade names are permitted in the title.

Sec. 13 of the Patent Act reads:

The speci-
fication.

"13. The specification shall correctly and fully describe the mode or modes of operating the invention, as contemplated by the inventor; and shall state clearly and distinctly the contrivances and things which he claims as new for the use of which he claims an exclusive property and privilege.

"Such specification shall bear the name of the place where, and the date when it is made, and shall be signed by the inventor, if he is alive, and if not, by the applicant, and by two witnesses to such signature of the inventor or applicant.

"In the case of a machine the specification shall fully explain the principle and the several modes in which it is intended to apply and work out the same.

"In the case of a machine, or in any other case in which the invention admits of illustration by means of drawings, the applicant shall also, with his application, send in drawings in duplicate, showing clearly all parts of the invention; and each drawing shall bear the signature of the inventor, if he is alive, and, if not, of the applicant, or of the attorney of such inventor or applicant, and shall have written references corresponding with the specification; but the Commissioner may require further drawings or dispense with any of them, as he sees fit.

"One duplicate of the specification and of the drawings if there are drawings, shall be annexed to the patent, of which it shall form an essential part, and the other duplicate shall remain deposited in the Patent Office.

"The Commissioner may in his discretion, dispense with the duplicate specification and drawing, and in lieu thereof cause copies of the specification and drawing, in print or otherwise, to be attached to the patent of which they shall form an essential part. R.S. c. 61, s. 13."

As appears from the section, the specification has two functions to perform: that of correctly and fully describing the mode or modes of operating the invention as contemplated by the inventor, and that of stating clearly and distinctly the contrivances and things claimed as new and for the use of which an exclusive property and privilege is claimed.

Functions of
specifi-
cation.

The requirement is in substance the same as in England and the United States, although differing somewhat in terms.

Cf. English Statute.

The English Statute (46 and 47 Vic., c. 57, s. 4) requires the inventor to "particularly describe and ascertain the nature of the invention and in what manner it is to be performed," and further requires that the specification shall "end with a distinct statement of the invention claimed."

Cf. American Statute.

The American Statute (R.S. 4888) calls for a written description of the invention, "and of the manner and process of making, constructing, compounding, using it, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery."

The specification should clearly disclose the invention. If the invention is not disclosed there is nothing patented. The nature of the disclosure must vary with the character of the invention and the state of the art at the time the invention is made.

Sufficiency.

The specification is sufficient if it makes the nature of the invention plain to persons having a reasonably competent knowledge of the subject. (*Edison v. Holland* [1889] 6 R.P.C. 243, 279, 280; *Philpott v. Hanbury* [1885] 2 R.P.C. at p. 38; *Loom Co. v. Higgins* [1881] 105 U.S. 580; *Seahury v. Am Ende* [1894] 152 U.S. 561; *Z-Electric Lamp Co. v. Marples* [1910] 27 R.P.C. 737; *Vidal Dye Syndicate, Ltd. v. Levinstein* [1912] 29 R.P.C. 245, C.A.)

To whom addressed.

To determine the question of sufficiency it is necessary to consider to whom the specification is addressed. "No sort of a specification would probably enable a ploughman, utterly ignorant of the whole art, to make a watch" (per Lord Ellenborough, C.J., in *Harmer v. Plaync* [1809] 11 East 108). The specification is to be taken to be addressed to artisans of ordinary skill in the particular art

or manufacture to which the invention relates. (*British Dynamite Co. v. Krehs* [1896] 13 R.P.C. at p. 192; *Tubes v. Perfecta Co.* [1903] 20 R.P.C. at p. 96; *Lister v. Norton* [1886] 3 R.P.C. at p. 203; *Plimpton v. Malcolmson* [1876] 3 Ch.D. at p. 568.)

The test of whether the specification is intelligible, and sufficient to artisans of ordinary skill, should not be extended to include the most eminent and highly skilled persons, "because generally those persons are men of great science and philosophical knowledge, and they would, upon a mere hint in the specification, probably invent a machine which should answer the purpose extremely well" (per Parke, B., in *Neilson v. Harford* [1841] 1 W.P.C. 314).

While the specification may call upon a workman to exercise all the actual existing knowledge common to the trade (*Lane-Fox v. Kensington Electric Co.* [1892] 9 R.P.C. at p. 417) it must not be so ambiguous that fresh experiment or research is necessary before the results set forth in the specification can be obtained (*Badische v. Levinstein* [1887] 4 R.P.C. at p. 462; *Bradford Dyers v. Bury* [1902] 19 R.P.C. at p. 7; *Simpson v. Holliday* [1866] L.R. 1 H.L. 315, 320; *Vidal v. Levinstein* [1912] 29 R.P.C. 245). "You must not give people mechanical problems and call them specifications" (per Jessel, M.R., in *Plimpton v. Malcolmson* [1876] L.R. 3 Ch.D. 576). The ambiguity will not, however, avoid the patent if it could be cleared up by a workman of ordinary ability and information in his trade.

May call upon common knowledge.

Lindley, L.J., in *Edison v. Holt* [1889] 6 R.P.C. 282, said: "I feel the great difficulty of describing in words the distinction between an amount of practice, without which failure is probable, but the necessity for which does not destroy a patent, and an amount of experiment and invention without which failure is certain, and the necessity for which destroys a patent. The test, however, by which to decide such a question is, I think, to be found by asking whether anything new has to be found out by a person of reasonably competent skill, in order to succeed, if he follows the directions contained in the specification. If yes, the patent is bad; if no, it is good so far as this point is concerned." (See also *Watson, Laidlaw & Co., Ltd. v. Potts, Cassel & Williamson* [1910] 27 R.P.C. 541

and 28 R.P.C. 565; *Fox v. Astrachans, Ltd.* [1910] 27 R.P.C. 377.)

Technical error.

A technical error will not vitiate a specification if it be such that an ordinary skilled workman would at once observe and be in a position to correct (per Lord Westbury, *Simpson v. Holliday* [1866] L.R. 1 H.L. 321; see also *Singer v. Walmsley* [1860] 1 Fisher 559).

Details which can be supplied by workmen unnecessary.

It is unnecessary to give details commonly supplied or known by workmen in the trade or to describe old or well-known apparatus. (*Lane-Fox v. Kensington & Knight-bridge Electric Lighting Co.* [1892] 9 R.P.C. 413.) "Every specification is to be read as if by persons acquainted with the general facts of the mechanical or chemical sciences involved in such invention" (per Baron Alderson in *Heath v. Unwin* [1852] 2 W.P.C. 245; and see *Crossley v. Beverley* [1829] 1 W.P.C. 112).

Material details must be given.

Where, however, shape, size or arrangement is the material part of the invention, full specific details must be given. In *Taylor v. Brandon* (1874) 21 O.A.R. 361, it was held that a specification providing merely that a protector is to be arranged "at an angle" is void for uncertainty, and in *Walmsley v. Eastern Hat & Cap Mfg. Co.*, 43 N.S.R. 432, the failure to specify the peculiar shape, which appeared to be patentable, was fatal.

Good faith necessary.

The specification must be drawn in the utmost good faith (*Sturtz v. De La Rue* [1828] 1 W.P.C. 83), and if it contains more or less than is necessary for obtaining the end for which it purports to be made, when such omission or addition is wilfully made for the purpose of misleading, the patent is void under sec. 29. By the English law any unnecessary ambiguity affectively introduced into the specification renders the patent void. (*Turner v. Winter* [1787] 1 W.P.C. 80; *Crompton v. Ibbotson* [1828] 1 W.P.C. 83.) It is incumbent upon the patentee to communicate all he knows and to disclose the best form of his invention. (*Wood v. Zimmer* [1815] 1 W.P.C. 82; *The British Dynamite Co. v. Krebs* [1896] 13 R.P.C. 190 at p. 195.)

It is only suppression of things material for the public to know which is fatal. If the patentee makes a full and fair disclosure so far as his knowledge at the time extends, he has done all that is required (per Bayley, J., in *Lewis v. Marling* [1829] 1 W.P.C. 496).

The specification in addition to describing the mode of operation of the invention must state clearly and distinctly the contrivances and things which are claimed as new. This duty is according to modern practice relegated to the separate claiming classes. Purpose of claims.

The Canadian Act requires the inventor to "state clearly and distinctly the contrivances and things which he claims as new and for the use of which he claims an exclusive property and privilege."

The United States Act requires the inventor to "particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery."

A distinction between the requirements of the two statutes was drawn by Chancellor Boyd in Toronto *Auer Light Co. v. Colling* (1898) 31 O.R. 18: Cf. American Practice.

"As to the American cases, there is a distinct cleavage in the decision before and after the Patent Act of 1870. The effect of that legislation is explained in *Durand v. Green* (1894) 60 Fed. R. 392. The earlier law of 1836 was very much the same as the Dominion Patent Act. The Act of 1870 provided for the specifications and claims as two distinct things and requires an inventor not merely to specify and point out, but to particularly point out and distinctly claim his invention.

"By the earlier Act he was instructed to specify what he alleged to be his invention; by the later Act, he is told, the invention for which he seeks a patent he must distinctly claim. Under the old law, the all important thing is the scope of the invention, but under the stricter modern rule (necessitated by the competition of inventors and the developments of modern science) the matter for determination is the subject matter of the patent, as defined and limited by the claim. This restrictive policy does not obtain in England, nor has it been adopted in Canada. We stand on the old footing, and the earlier decisions in the States are in conformity with the English cases (*Vickers v. Siddell* [1890] 15 App. Cas. 496)."

It is doubtful whether the distinction between the statutes pointed out by Boyd, C., really exists. The Canadian Act requires that the specification shall describe the invention but also and apparently as something separ-

ate from the description that it shall "state clearly and distinctly, the contrivances and things claimed as new." Moreover, sec. 12 calls specifically for an additional or third copy of "the claim or claims."

Whether called for by the Act or not, it is the settled practice of the Patent Office to demand separate claims.

Claim de-
limits the
invention.

The purpose of the claim is to delimit the scope of the invention. Mr. Justice Cassels in *Barnet-McQueen v. Canadian Stewart Co.* (1910) 13 Ex. C.R. 186 at p. 221, says:

"The purpose of the claim is (according to the late Sir George Jessel) to disclaim all that is not claimed. (See *Hinks v. Safety Lighting Co.*, L.R. 4 Ch.D. 612; *Plimpton v. Spiller*, L.R. 6 Ch.D. 412.) This definition of Sir George Jessel has been found fault with by later Judges. The present view seems to be that the purpose of the claim is to delimit the scope of the patentee's invention. (See *British United Shoe Machinery Co., Ltd. v. Fussell & Sons, Ltd.*, 25 R.P.C. 631.)

"It is not of much consequence which language is used; the result is the same."

In *North v. Williams* (1870) 17 Grant 179, at p. 181 it is stated: "The proper mode of claim is for the applicant to state what part of that for which he asks a patent he claims to have invented; and what part he does not claim to have invented. . . . If this is left altogether ambiguous the patent is void."

In *J. O. Wisner Sons Co. v. Coulthard, Scott & Co. et al.* (1893) 22 S.C.R. 178, Sedgewick, J., at p. 186, remarks:

"In my judgment the wording of the claim as put forward in the patent conveys little or no meaning, and certainly does not in terms describe the combination now contended for, and upon authority of *Keystone Bridge v. Phoenix Iron Co.*, 95 U.S. 274; *Burns v. Meyer*, 100 U.S. 671; *Hinks v. Safety Lighting Co.*, 4 Ch.D. 607, I am inclined to think the appellants would have to fail on this ground."

Construe
with speci-
fications.

The language employed in the claim should correspond with that of the description as it is to be read therewith; nothing can be claimed which has not previously been fully set forth and described. (*Monnet v. Beck*, (1877) 14 R.P.C. 777, 847; *Kay v. Marshall*, (1836) 2 W.P.C. 39.)

The claim is to be read and construed with reference to the body of the specification, and not as if it were an isolated sentence having no connection with or reference to that which precedes it (*Neilson v. Harford* [1841] 1 W.P.C. 295; *Edison & Swan United Electric Light Co. v. Woodhouse & Rawson*, 4 R.P.C. 79; *Edison Bell Phonograph Corporation, Ltd. v. Smith & Young* [1894] 11 R.P.C. 389; *Ingersoll Sergeant Drill Co. v. Consolidated Pneumatic Tool Co., Ltd.* [1907] 25 R.P.C. 61). The proper way to read a specification is not to read the claim first, but, looking at the whole instrument, to read the specification first to see what the patentee says he has invented, and then to read the claim fairly to see whether he has claimed what he desires to patent. (*Arnold v. Bradbury* [1871] 6 Ch. App. 706; *Tubes, Ltd. v. Perfecta Seamless Steel Tube Co., Ltd.* [1900] 17 R.P.C. 569.)

If the claim is too wide in language it is bad as covering that which is old (*Dick v. Ellams Duplicator Co.*, (1900) 17 R.P.C. 196, 202), or as covering more than the patentee has invented or described in his specification. (*Tetley v. Easton* [1852] 2 C.B.N.S. 706.)

Too wide a claim is bad.

In some cases, however, a claim which is broader than the specification or invention as described, may be restricted by interpretation. (*Gillette Safety Razor Co. v. Anglo-American Trading Co., Ltd.* [1912] 29 R.P.C. 577.)

The claim is bad if it claims a principle apart from the means for carrying it out, and a claim to every mode of carrying a principle into effect amounts to a claim to the principle itself. (*Neilson v. Harford* [1841] 1 W.P.C. 355; *Automatic Weighing Machine Co. v. Knight* [1889] 6 R.P.C. 308.)

Claim to principle bad.

Where the patent is for a combination, provided it is clear that the invention resides in the combination, it is not necessary to state which elements of it, if any, are new (*Rowcliffe v. Morris* [1886] 3 R.P.C. 17, 24; *Kynoch v. Webb* [1900] 17 R.P.C. 100; *Shortt v. Federation Brand* [1899] 7 B.C.R. 197, 31 S.C.R. 378; and see *Emery v. Iredale* [1860] 11 U.C.C.P. 196).

Combination claims

A combination may contain elements which are new in themselves. If it is desired to protect such new elements it is necessary to claim them separately (The

British United Shoe Co. v. Thompson [1905] 22 R.P.C. 198.)

Mr. Justice Cassels in *Barnet-McQueen v. Canadian Stewart* (1910) 13 E.C.R. 186, at p. 221, deals with this point and with combination claims in general at p. 22 as follows.

"The claim in the case before me is a claim for a combination of old elements; although being for a combination it is not of materiality so far as the construction of the claim is concerned, whether one element is new or not. If an element is new, and the patentee is entitled to a patent for the novel element or elements, he should claim this separately. Any new invention which the patentee sets out in his specification, if not claimed, is given to the public. It is the fault of the inventor in not claiming it, and he must suffer. The combination of old elements is the invention, provided it is the subject matter of a patent, and the court finds invention.

"In construing the claim for a combination reference must, of course, be had to the preceding specification and the state of the art, and the patentee is entitled to a fair and liberal construction. If, however, the patentee has chosen in unambiguous terms to incorporate an element as a part of his combination, then the mere fact that subsequently he may find out that he might have omitted this element does not help him.

"I venture to think that a careful consideration of the English authorities show that in reality there is no distinction between the law as regards combination claims and the infringement thereof as decided in England from the law as decided in the United States. The first question to ascertain is what is the combination claimed as the invention. If, on a proper construction of the specification and claim, having regard to the state of the art, it be determined that an element forms part of the combination, the patentee cannot get rid of this element as being an immaterial or non-essential element. No such thing as an immaterial or non-essential element in a combination is recognized in the patent law. Having regard to the essentials of a combination, the admission that an element is not material is an admission that the combination claimed is an invalid combination, and

the claim is bad. It follows that if the alleged infringer omits one element of the combination, he does not infringe the combination. Of course if instead of omitting an element he substitutes a well-known equivalent, he in fact uses the combination. I will deal later on with this latter aspect in considering the defendant's construction."

There is a considerable difference in practice in the method of drafting claims prevailing in the United States and Great Britain. In Great Britain reference is permitted from one claim to another to avoid repetition of the preceding claim, and expressions such as "The device according to claim 1 having, etc.," "The use of the device of the preceding claim with, etc.," are frequently used. It is also common to find a general reference to the drawings in place of a specific claim, such for example as "The device constructed and arranged as shown in detail in Fig. 1 of the drawings."

Contrast
English and
American
form of
claims.

Expressions such as the foregoing are objected to in the United States as being indefinite and so not within the statutory requirements. In place of referring from one claim to another, it is the practice to repeat if necessary all the elements of the preceding claim, resulting very often in a series of claims after what has been termed the "house-that-jack-built" type. Such claims have been barred in Great Britain by the statutory requirement that the claims should be "succinct" as well as separate and distinct from the body of the specification.

In the Canadian Patent Office it was the practice for many years to call for claims after the American form. Recently, however, an appeal was taken from an examiner's requirement to this effect, and the Deputy Commissioner held that if an applicant insisted, claims after the British form would be allowed to him at his own risk. It is believed that the British form of claims is quite proper, in Canada, and will be favourably regarded by Canadian Courts. (See *Toronto Auer Light Co. v. Colling* [1898] 31 O.R. 18.)

The general rules of construction applicable to all written instruments apply equally to patent specifications. The language used is to be given its ordinary meaning,

Construc-
tion of
specifi-
cation.

and technical words the special meanings they have in the arts in which they are employed. The specification is to be construed as of the date of issue of the patent, and with regard to the state of knowledge at that time (*Nobel's Explosives Co. v. Anderson* [1894] 11 R.P.C. 523).

Impartial interpretation.

The specification is not to be interpreted benevolently, or malevolently, but impartially, and the court will not be astute to find flaws to upset the patent. (*Stevens v. Keating* [1848] 2 Ex. 772; *Bickford v. Skewes* [1841] 1 Q.B. 938; *Hinks v. Safety Lighting Co.* [1876] L.R. 4 Cb.D. 612; *Dudgeon v. Thompson* [1877] 3 App. Cas. 34; *Plimpton v. Spiller* [1877] 6 Cb.D. 286.)

Where there is a doubt that interpretation is to be placed upon it which will make the patent of some effect (*Otto v. Linford* [1881] 46 L.T.N.S. 39; *Hattersley & Sons v. Hodgson* [1906] 23 R.P.C. 192, H.L.) and this must necessarily be an interpretation favourable to the patentee.

Read whole document together.

The whole document is to be read together including the drawings and an interpretation adopted, which is the most consistent with each part. (*Tubes, Ltd. v. Perfecta Seamless Tube Co., Ltd.* [1903] 20 R.P.C. 77.)

Drawings.

The drawings should be full and clear. They need not be working drawings, but should be of a character to be readily intelligible to the average person skilled in the art. The rules require that they should be executed in India ink, on sheets 8 x 13 inches, and that tracings in duplicate signed by the inventor or his attorney should be furnished. No drawings are necessary if the invention can be carried into effect without them. (*Savage v. Harris & Son* [1896] 13 R.P.C. 364.)

The rules with regard to drawings are:

Rules.

"13. Drawings in duplicate, to be attached to the duplicate specification, must be made in India ink or carbon ink, on sheets of tracing cloth other than Linaura or similar fabric, eight by thirteen inches, neatly executed and without colours.

"Each sheet of tracing linen shall contain the following certificate at the bottom: 'Certified to be the drawings

referred to in the specification hereunto annexed,' and signed by the inventor or his attorney; place, date and signature of two witnesses.

"All drawings must be clear, sharp, well-defined, not too fine, and *perfectly black*.

"Lines that are pale, ashy, very fine, ragged or broken, give bad results when photo-lithographed.

"Brush-shading, tinting and imitation surface graining should never be used; and in fine shading the result should be attained with as few lines as possible.

"Section lines also should be as open in their spacing as the case will admit of, and these, as well as all right lines, in order to insure clearness should be made with a ruling pen. The shading of convex and concave surfaces may be dispensed with when the invention is otherwise well illustrated.

"Shade lines may sometimes be used with good effect, but heavy shadows where they would obscure lines or letters of reference, should be avoided.

"With each application an extra full set of drawings must be supplied on double Bristol board, 8 x 13 inches, without writing on its face, merely the usual reference letters; no title, certificate nor signatures; on the back of the sheet the name of the inventor and the title of the invention must be written in pencil.

"The card-board drawing should be rolled on a roller for transmission to the office, as folding will prevent its usefulness for photo-lithographing."

The drawings should not be misleading or represent an inoperative machine. In *Knight v. Argylls, Ltd.* (1912) 29 R.P.C. 593, it was held that a mistake in the drawing by which a mechanical problem of some complexity is presented if the machine is to be made operative, may invalidate the patent. Misleading drawings.

An obvious error, however, will not vitiate the patent Obvious error.
(*Otto v. Linford* [1882] 46 L.T. (N.S.) 351; *Miller v.*

Searle, Barker & Co. [1893] 10 R.P.C. 106; Hinks v. Safety Co. [1876] 4 Ch.D. 607).

The drawings are part of and are to be read with the specification (Bloxam v. Elsee [1825] 1 Car. & P. 558; MacFarland v. Price, 1 W.P.C. 74; Hattersley v. Hodgson [1904] 21 R.P.C. 517). They may be called in aid of it. (Mathews v. Parmenter [1896] 13 R.P.C. 519; Queen v. La Force [1894] 4 Ex. C.R. 14). A patent cannot be supported to cover a material feature which is shown in the drawings alone (Clark v. Adie [1877] L.R. 2 App. Cas. 315), unless there be some indication given in the written specification that what is shown in the drawings is claimed as part of the invention. (Hattersley v. Hodgson [1904] 21 R.P.C. 517.)

Models.

Models need only be furnished when required by the Commissioner; and this is only in exceptional cases. Models are invariably required, however, when the invention is of the "perpetual motion" class. Formerly models were required in each case, and there was some difference of opinion as to the effect of failing to file a model. (Regina v. Smith [1885] 7 O.R. 440; Atty.-General v. Bate [1883] 6 L.N., 227 S.C.; Campbell v. Bate [1886] 15 R.L., 467 S.C.)

Examination.

As required by sec. 15 of the Act each application for a patent is sent to an Examiner who searches as to novelty, and generally examines the application for objections or informalities which would form a bar to the grant of the patent. The facilities for examination as to novelty are comparatively limited, as the Patent Office only possesses an incomplete set of classified United States Patents, and at present the volume of work is out of proportion to the number of Examiners employed.

The applicant is advised by letter of any objections raised by the Examiner, and he may overcome them if he can. Rule 24 reads:

Amendments.

"Amendments must not be made by erasures or insertions in the original papers, but must be made on fresh sheets of paper, so that the sheets containing the matter to be amended may be removed from the application and replaced by sheets containing the amendments.

"Amendments to the specifications must be made in duplicate, and those to the claims in triplicate."

Communications from the Examiner must be replied to within one year, or the application will be held to be abandoned under Rule 9.

To withdraw an application a specific authorization is required, although this may be incorporated in the original power of attorney. If there are assignees, their consent in writing will be necessary under sec. 16.

Withdrawal
of applica-
tion.

The procedure with respect to conflicting applications is set forth in sec. 20, which reads:

"20. In case of conflicting applications for any patent, the same shall be submitted to the arbitration of three skilled persons, two of whom shall be chosen by the applicants, one by each, and the third of whom shall be chosen by the Commissioner; and the decision or award of such arbitrators, or of any two of them, delivered to the Commissioner in writing, and subscribed by them or any two of them, shall be final, as far as concerns the granting of the patent.

Conflicting
or interfer-
ing applica-
tion.

"2. If either of the applicants refuses or fails to choose an arbitrator, when required so to do by the Commissioner, and if there are only two such applicants, the patent shall issue to the other applicant.

"3. If there are more than two conflicting applications, and if the persons applying do not all unite in appointing three arbitrators, the Commissioner may appoint the three arbitrators for the purposes aforesaid.

"4. The arbitrators so named shall subscribe and take before a judge of any court of record in Canada, an oath, in the form following, that is to say:

"I, the undersigned (A.B.), being duly appointed an arbitrator under the authority of the Patent Act, do hereby solemnly swear or affirm (as the case may be), that I will well and truly perform the duty of such ar-

bitrator on the conflicting applications of (C.D. and E.F.) submitted to me.

"5. The arbitrators, or any one of them, when so sworn, may summon before them any applicant or other person, and may require him to give evidence on oath, orally or in writing (or on solemn affirmation if such applicant or person is entitled to affirm in civil cases), and to produce such documents and things as such arbitrators deem requisite to the full investigation of the matters into which they are appointed to examine, and they shall have the same power to enforce the attendance of such applicants and other persons, and to compel them to give evidence, as is vested in any court of justice in civil cases in the province in which the arbitration is held.

"6. The fees for the services of such arbitrators shall be a matter of agreement between the arbitrators and the applicants, and shall be paid by the applicants who name them, respectively, except those of the arbitrator or arbitrators named by the Commissioner which shall be paid by the applicants jointly. R.S. c. 61, s. 19."

**History of
section.**

This section is of long standing in Canadian patent law, being present in substantially the same form in the Ontario Provincial Statutes of 1826 (7 Geo. IV. c. 5, s. 7). The Federal Act of 1872 included the section in its present form. A similar section existed in the United States Statute of 1793 (see sec. 9) but this was repealed in 1836, and the modern practice established providing for a tribunal within the Patent Office itself for hearing and deciding cases of conflicting applications.

It cannot be said at the present time that the practice under the section is very satisfactory. Poor results arise from the fact that each arbitration board is free to adopt its own procedure, and there is no appeal whatever from its decision.

It is the practice of the Commissioner when two applications are reported to be in conflict by an Examiner, to send a formal notice to each of the applicants, notifying him of the interference and requiring the appointment of

his arbitrator. If no arbitrator is appointed by any applicant within a year, the application is held abandoned under Rule 9. When one of the applicants appoints his arbitrator the Commissioner by virtue of his authority under Rule 9 calls upon the other applicant to appoint his arbitrator within a certain limited time, and upon this being done, the Commissioner appoints the third arbitrator. If the other applicant fails to appoint his arbitrator within the time required, the patent is issued to the applicant who has appointed his arbitrator.

Where there are more than two applicants they all must agree on the three arbitrators or the Commissioner will appoint them all. The arbitrators themselves meet and arrange to conduct their own proceedings according to such rules as they see fit to adopt.

In *Faller v. Ayles* (1904) 8 O.L.R. 70, it was held that the discretion of the Commissioner in appointing arbitrators was not open for review. (See also the dissenting opinion of Judge Duff in *New York Herald Co. v. Ottawa Citizen Co.* (1907) 41 S.C.R. 229.) In *Faller v. Ayles* an injunction to prevent the arbitrators performing their functions was served on them after the award was completed and published. The court held them to be *functi officio*.

Each applicant must pay his own arbitrator and half the fees of the Government Arbitrator. The arbitrators need not be residents of Canada but must hold their sittings in Canada.

The nature of the evidence which will be accepted is a matter for the Arbitration Board to decide. In some instances affidavits as well as a *viva voce* testimony are accepted, and in others printed testimony taken in similar proceedings in the United States has been received. Evidence.

The decision of the arbitrators is final as regards granting the patent. There is no review of their decision by any court. (*Bell Telephone Case* [1885] 9 O. R. 343; *Faller v. Ayles* [1904] 8 O.L.R. 70.)

While sec. 23, paragraph "a" of the Exchequer Court Act, gives the court jurisdiction in the case of conflicting applications, there is no machinery provided in the Patent Act whereby the question may be brought before the court for adjudication.

First conception.

In Canada there is no elaborate set of rules as to priority between rival inventors for guidance as in the United States. The distinction between "conception" and "reduction to practice" and the necessity for diligence between these two steps does not arise here. The question to determine is who actually was the first inventor, that is to say, the first person the world over to conceive of the invention in practical form. This will always be a matter of evidence to which general rules are applicable.

Abandonment.

If one of the applicants has been dilatory in coming to the Patent Office, the question of whether he has abandoned his invention may be raised. Such a question would be determined by the general rules as to abandonment given previously. A decision that the invention has been abandoned would not help the subsequent inventor, because it would then be public property. There is nothing in the Canadian law which permits one who is not actually the first inventor to succeed by showing greater diligence. For reasons which have been stated at length under the heading of "Novelty," it is believed that the person who actually conceives the invention first in practical form is the *only* one entitled to a patent.

The section of the Act apparently only contemplates whole applications being in conflict with each other, and no provision is made for the formation of "counts" after the American plan. The Patent Office has, to some extent at least, adopted the American practice of suggesting claims from one applicant to another, thus causing the interfering part of the invention to be claimed in the same language by each applicant, but there is no method of forcing an applicant to adopt claims which are suggested to him.

Division of applications

An application should contain only one invention. If the Examiner finds it to comprise a plurality of inventions he may require division. The application should then be restricted to one invention, and independent "divisional" applications filed for any other inventions. The divisional applications are given the benefit of the filing date of the original case. Rule 10 of the Rules of Practice gives an applicant the right to have a single patent issued for several inventions, "so dependent on and connected with each other as to be necessarily taken together to obtain the end sought for by the inventor."

CHAPTER VIII

REFUSAL TO GRANT PATENT.

Secs. 17 and 18 of the Patent Act read as follows:

"17. The Commissioner may object to grant a patent in any of the following cases:

"(a) When he is of opinion that the alleged invention is not patentable in law;

"(b) When it appears to him that the invention is already in the possession of the public, with the consent or allowance of the inventor;

"(c) When it appears to him that there is no novelty in the invention;

"(d) When it appears to him 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;

"(e) When it appears to him that the invention has already been patented in Canada, unless the Commissioner has doubts as to whether the patentee or the applicant is the first inventor;

"(f) When it appears to him that the invention has already been patented in a foreign country, and the year has not expired within which the foreign patentee may apply for a patent in Canada, unless the Commissioner has doubts as to whether the foreign patentee or the applicant is the first inventor. R.S. c. 61, s. 16.

"18. Whenever the Commissioner objects to grant a patent as aforesaid, he shall notify the applicant to that effect and shall state the ground or reason therefor, with sufficient detail to enable the applicant to answer if he can, the objection of the Commissioner." R.S. c. 61, s. 17.

Commissioner may object to grant a patent in certain cases.

Applicant to be notified.

Practice of
Patent
Office.

The practice of the Patent Office is to refer the application to an Examiner. Any objection to the patent made by the Examiner is forwarded to the applicant. To this the applicant replies. Correspondence in connection with the objections of the Examiner may last until the application or some of the claims are finally rejected by the Examiner. It is, however, a rule of the Patent Office (Rule 9) that the applicant must reply to each official action within one year, or if required to do so by the Commissioner, within a shorter period set by the Commissioner.

The objections of the Examiner are forwarded to the applicant by letter signed by the Deputy Commissioner. The letter enclosing a final rejection by the Examiner therefore serves as the notice of objection required by sec. 18.

A practice has grown up in the Patent Office of allowing an appeal to the Deputy Commissioner in person from the final rejection of all or some of the claims of the application. This practice is not based on any rule, and, doubtless, the Patent Office could refuse to follow it at any time. It is required that the appeal to the Deputy Commissioner shall be within six months of the Examiner's final rejection. The appeal should be in the form of a petition headed "Appeal to the Deputy Commissioner of Patents in person from the decision of the Examiner," and should set out the reasons why the ruling of the Examiner should be reversed. The Deputy Commissioner also frequently hears oral arguments. If the Deputy Commissioner refuses to allow the appeal, his letter is to be considered as the notice required by sec. 18.

Section 19
of Patent
Act.

Sec. 19 of the Patent Act reads: "Every applicant who has failed to obtain a patent by reason of the objection of the Commissioner, as aforesaid, may at any time within six months after notice thereof has been mailed, addressed to him or his agent, appeal from the decision of the Commissioner to the Governor-in-Council."

In effect re-
pealed by
amendment
to Exche-
quer Court
Act of 1913.

At the last session of Parliament (1913) this section was in effect repealed by an amendment to the Exchequer Court Act, which reads as follows:

"1. The Exchequer Court Act, chap. 140 of the Revised

Statutes, 1906, is amended by adding the following section immediately after sec. 23:

"23A. Every applicant for a patent under The Patent Act who has failed to obtain a patent by reason of the objection of the Commissioner of Patents as in the said Act provided may, at any time within six months after notice thereof has been mailed, by registered letter, addressed to him or his agent, appeal from the decision of the said Commissioner to the Exchequer Court.

Appeal from decision of Commissioner of Patents.

"2. The Exchequer Court shall have exclusive jurisdiction to hear and determine any such appeal.

Jurisdiction on appeal.

"3. The Exchequer Court shall have exclusive jurisdiction to hear and determine any now pending appeals to the Governor-in-Council under sec. 19 of The Patent Act, and the Governor-in-Council shall transfer the said appeals and all documents and proceedings relating thereto to the Exchequer Court."

Appeals pending under R.S., c. 69, s. 19.

Rules regulating the practice in the Exchequer Court under this section are to be found on page 354a.

The functions of the Commissioner under sec. 17 were formerly thought to be ministerial rather than judicial. In any case the courts would not interfere and there was no remedy open to the person whose application was objected to by the Commissioner, except the appeal to the Governor-in-Council (*Smith v. Goldie* [1882] 9 S.C.R. 46. *In re The Bell Telephone Company and The Telephone Manufacturing Co. and The Minister of Agriculture* [1884] 7 O.R. 605; *re The Bell Telephone Company* [1885] 9 O.R. 339 at p. 342; *New York Herald Co. v Ottawa Citizen* [1909] 41 S.C.R. 229 at p. 241).

Discretion of Commissioner now subject to review by Exchequer Court.

The result of the recent enactment has been to do away with the appeal to the Governor-in-Council. The substitution of an appeal to a court of law is likely to have consequences not contemplated perhaps by those who framed the enactment. Sec. 17 in its wording was obviously intended to confer a very wide discretion upon the Commissioner. How far this will be effected by subjecting his ruling to review by a court it is impossible

to say. The somewhat personal discretion heretofore exercised by the Commissioner and probably contemplated by the Patent Act will possibly give place to a discretion of a more judicial character based upon rulings as to the interpretation of sec. 17 by the Exchequer Court.

Sec. 17 is very badly drawn and does not present any logical classification of the cases where the Commissioner may object to grant a patent. However, except in connection with paragraph (d), no serious difficulty arises.

Paragraph
(a), "Patent-
able in law."

What is meant by "patentable in law" in paragraph (a) no one can say. The term is not defined. Inasmuch as the right to a patent must depend on the Patent Act it can probably mean nothing except "patentable under this Act."

Paragraph
(b), In pos-
session of
public with
allowance of
inventor.

Paragraph (b) must be read in the light of sec. 7. Sec. 7 in effect permits public use or sale for one year prior to the application. Public use or sale within this period can, therefore, not place the invention "in the possession of the public." As pointed out under "abandonment," however, the inventor may otherwise abandon or dedicate his invention even within one year within which the invention may be in public use or on sale.

Paragraph
(c) Want of
novelty.

Paragraph (c) relates to novelty and is in harmony with the other sections of the Act.

(d), Described
in book
or other
printed pub-
lication, or
otherwise in
the posses-
sion of the
public.

Paragraph (d) presents difficulty. It was undoubtedly derived from the American Act of 1836. Sec. 7 of this Act provided that if on examination of the alleged invention "it shall not appear to the Commissioner . . . that it had been patented or described in any printed publication in this or any foreign country . . . it shall be his duty to issue a patent therefor." There may perhaps have been some doubt as to whether the time referred to by this provision was the time when the invention was made or the time when the application was made for patent. It was held, however, in *Bartholomew v. Sawyer* (1859) 4 Blatch. 347, 1 Fish 516 that when the section was considered in connection with other sections and with the whole scope of the Act there was no doubt that the time referred to was the time of invention. If the Canadian draftsman had followed the American decision as to the time to which the corresponding provision applied, no difficulty would have

arisen. Unfortunately he inserted in the paragraph the words "before the date of the application." The result is a provision which is anomalous and on its face inconsistent with the rest of the Act.

It may be argued that this paragraph amounts to a declaration that publication of the invention of the applicant in a book or printed publication prior to the application disentitles the applicant to a patent. This view receives no support from the other sections of the Act. Sec. 7 is a statement of the conditions, the fulfillment of which entitled a person to a patent. That there shall have been no publication in a book or other printed publication prior to the application is not one of the conditions there set out. Moreover, sec. 7 gives a right to a patent notwithstanding the fact that the invention may have been in public use or on sale for a year before application, and it would seem absurd that the printing of a description of the invention should disentitle the inventor to a patent while public use and therefore public knowledge within the year would not. Nor does publication in a book or other printed publication render a patent void under sec. 29 or any other section. Further, inasmuch as no jurisdiction is conferred on the courts to review the action of the Commissioner under sec. 17 except where he refuses the grant it would seem that if there has been publication as specified and the Commissioner is ignorant of it or disregards it, the patent granted is good.

In terms sec. 17 is a little more than a statement of rules for the guidance of the Commissioner. While it is impossible to be certain of the effect of paragraph (d) it is suggested that the most reasonable view is that the Commissioner should treat publication as *prima facie* evidence merely that the invention is in the possession of the public and not necessarily in itself placing the invention in the possession of the public. If the Commissioner finds the invention described in a book or other printed publication he may assume it is in the possession of the public and object to the grant. If, however, the applicant answers this objection under sec. 18 by showing that notwithstanding such publication the invention has not become public property the Commissioner should withdraw the objection and grant the patent.

Printed publication does not cover private communications.

It would seem that "publication" in this section means something similar to a book such as a magazine or newspaper which places the contents in the possession of the public, and does not include private communications even though printed. It probably does not include business circulars or similar communications. (New Process Fermentation Co. v. Kock, 21 Fed. 580.)

"Printed publication" probably does not include foreign patents.

Foreign patents are dealt with in a special manner under sec. 8. It would, therefore, seem that the term "printed publication" does not include a printed foreign patent of the applicant.

Printed copies of foreign patents of applicant and description in Official Gazettes.

In many countries copies of all patents are printed and distributed to libraries and elsewhere, and are sold to the general public for a small price. Most countries have also an Official Gazette or Record in which descriptions of all patents are given. The printed copies would probably, and the Official Gazette would, we think, almost certainly come within the term "printed publication." If the view of the writers be correct, however, these are publications so far as they relate to patents of the applicant, of which the Examiner need take no account as they can afford no evidence of the invention being in the possession of the public.

Paragraph (e), Canadian Patents

Where an application is made for an invention previously patented in Canada, the prior patent may under (e) be a ground for objection. In practice the prior patent is cited by the Examiner. The applicant may then furnish evidence of invention anterior to the prior patent. This may be done by declaration or affidavits. Sometimes a foreign patent to the applicant may show that it was obtained or applied for prior to the Canadian patent cited. If the Commissioner is of the opinion that there is doubt as to who was the first inventor he will grant the second patent. Two patents for the same invention cannot both be good though they may both be had. Once they are issued the question of validity is for the courts to decide.

Paragraph (f) Foreign Patents.

Paragraph (f) must be read in connection with sec. 8. It does not seem of much value. The Commissioner must where there is a foreign patent for the same invention withhold the grant to another for one year unless he thinks there is doubt as to whether the applicant or the

foreign patentee is the first inventor. It may be remarked that without this section the Commissioner should object to a grant for want of novelty where there is a foreign patent unless he has reason to believe the applicant the first inventor. The only use the section seems to serve is to afford an opportunity for an interference so that only one patent may be issued.

CHAPTER IX.

RE-ISSUE AND DISCLAIMER.

The Patent Act provides two remedies for a defective specification: disclaimer and re-issue. The former remedy is designed only to correct specifications too broad in scope or which have claimed too much, while the latter covers a wider field and may cure as well an insufficient description or claims either too broad or too narrow.

Section 24. Sec. 24 of the Patent Act, applying to re-issue, reads:

"24. Whenever any patent is deemed defective or inoperative by reason of insufficient description or specification, or by reason of the patentee claiming more than he had a right to claim as new, but at the same time it appears that the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention, the Commissioner may, upon the surrender of such patent and the payment of the further fee hereinafter provided, cause a new patent, in accordance with an amended description and specification made by such patentee, to be issued to him for the same invention, for any part or for the whole of the then unexpired residue of the term for which the original patent was, or might have been, granted.

"2. In the event of the death of the original patentee or of his having assigned the patent, a like right shall vest in his assignee or his legal representatives.

"3. Such new patent, and the amended description and specification, shall have the same effect in law, on the trial of any action thereafter commenced for any

cause subsequently accruing, as if the same had been originally filed in such corrected form before the issue of the original patent.

"1. The Commissioner may entertain separate applications, and cause patents to be issued for distinct and separate parts of the invention patented, upon payment of the fee for a re-issue for each of such re-issued patents." (R.S. c. 61, s. 23.)

The above section practically in its present form was introduced into our law by 38 Vic., c. 14 (1875) and was a copy with slight changes of sec. 13 of the United States Act of 1836.

The present United States Statute (R.S. 4916) reads:

"Whenever any patent is inoperative or invalid by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident or mistake, and without fraudulent or deceptive intention, the Commissioner shall on the surrender of such patent, and the payment of the duty required by law, cause a new patent for the same invention and in accordance with the corrected specification to be issued to the patentee, or in case of his death, or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The Commissioner may in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a re-issue for each of such re-issued letters patent. The specification and claim in every such case shall be subject to revision and restriction in the same manner as original

Cf. U.S. R.S.
4917.

applications are. Every patent so re-issued, together with the corrected specification, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent, shall the model or drawings be amended except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident or mistake as aforesaid."

Similarity of
American
and Canadian
Statutes.

The general similarity between the Canadian and American Statutes has been noted by the Court of Appeal in Ontario. Patterson, J., in *Hunter v. Carrick* (1881) 10 O.A.R. 449, 468, says: "Cases may arise for adjudication in which it will be important to keep in view the differences between the two statutes, but as far as they touch the immediate subject before us, viz.: the effect of the re-issue of a patent upon *corrected* specifications, as they are styled in the United States statute, or *amended* or *corrected* ones as they are indifferently styled in ours, we may for our present purpose regard them as covering the same ground; and I agree with the learned Judge, whose decision we are considering, that we should treat the judgments in the United States Courts, in which the effect of the Statutes has been declared, as laying down the rule which we should follow. . . . I do not care to form an opinion till it becomes necessary, as to how far the action of the Commissioner of Patents under our law may be analogous to that of the Commissioner of Patents under the United States system."

Differences.

An important difference in the two statutes is the use of the word "deemed" in the beginning of the Canadian section. The effect of the inclusion of this word would appear to be that the question of deciding whether the original specification was "defective or insufficient"

is left to the Commissioner, and his decision being an exercise of discretionary power, will not be open to review by a court before which the patent comes.

This was noted by Burhidge, J., in *Auer Incandescent v. William P. O'Brien* (1897) 5 Ex. C.R. 243, 285:

"The use of the word 'deemed' imports that a discretion, a judgment is to be exercised. (*De Beauvoir v. Welch*, 7 B. & C. 278.) But by whom? In the first place perhaps by the applicant, but in the end and as a foundation for his jurisdiction by the Commissioner. His jurisdiction does not depend upon the patent being in fact defective or inoperative for the reasons specified, but upon the patent being deemed for such reasons to be defective or inoperative. How is the court in an action for the infringement of the new patent to try out the question as to whether or not the Commissioner deemed the surrendered patent to be defective or inoperative by reason of insufficient description or specification, or by reason of the patentee claiming more than he had a right to claim as new. The patent might be neither defective nor inoperative and yet the applicant and the Commissioner might be honestly mistaken and might in good faith deem it to be defective or inoperative. Must not the question in such a case be concluded by the action of the Commissioner? It seems to me that it must at least in an action for infringement of the re-issued patent."

Patent
"deemed"
defective or
inoperative.

The view that the exercise of the discretionary power conferred by a statute on an official such as the Commissioner will not be reviewed, is supported by the language of Duff, J., in a dissenting opinion in the case of the *New York Herald Co. v. Ottawa Citizen Co.* (1909) 41 S.C.R. 229.

Other differences between the Canadian and American statutes are not material. The Canadian statute refers to a patent deemed "defective or inoperative," the American to one which is "inoperative or invalid." In the Canadian section the words "amended description" are used; in the United States enactment the words are "corrected specification." The American statute provides that no new matter shall be introduced into the specification. There is no express provision in the Canadian as to this. These differences were noted in *Withrow v. Malcolm* (1882)

6 O.R. 12, in which an extended discussion of the law of re-issue is found.

Intermediate period when invention unprotected.

The Canadian Patent Office refuses to consider an application for re-issue until a surrender of the old patent has been made. There is therefore a period between the surrender and the re-issue when the invention is not protected. (*Patric v. Sylvester* [1876] 23 Grant 573.) The United States Statute provides that the surrender shall only take effect upon issue of the new patent.

Question of validity of old patent not reopened.

The object of a patentee applying for a re-issue is not to reopen the question of the validity of the original patent, but to rectify any error which may have been found to have arisen from his inadvertency or mistake. (*McCormack Harvesting Machine Co. v. C. Aultman Co.*, 169 U.S. 607, at p. 610.)

"Inadvertence or mistake" does not include erroneous judgment.

"Inadvertence or mistake" does not include erroneous judgment. Where a patentee has in his original application submitted to the rejection of claims he is estopped from presenting any of such rejected claims in an application for re-issue. (*Moneyweight Scale Co. v. Toledo Computing Scale Co.* [1911] 187 F. 826.)

Meaning of "Same invention."

The Act requires that the re-issue should be made "*for the same invention.*" These words may mean either whatever invention was described in the original patent, or whatever invention was described and appeared therein to have been intended to be secured. If the words be given the first interpretation, then anything disclosed in the original specification or drawing may be claimed in the re-issue. Under the second interpretation a re-issue cannot be granted to cover any matter disclosed with respect to which an intention to claim was not shown in the patent.

The United States Supreme Court in the case of *Parker & Whipple Co. v. The Yale Lock Co.* (1887) 123 U.S. 99, decided that the words "the same invention" meant whatever invention was described in the original letters patent and appeared therein to have been intended to be secured thereby. This rule has been re-affirmed in many cases by the Supreme Court. (*Hoskins v. Fisher* [1887] 125 U.S. 223; *Flower v. Detroit* [1887] 127 U.S. 571; *Pattee Plough Co. v. Kingman & Co.* [1889] 129 U.S. 294;

Freeman v. Asmus [1895] 145 U.S. 240; Corhin Cabinet Lock Co. v. Eagle Lock Co. [1893] 150 U.S. 42.)

In Canada we have only one case, that of *Withrow v. Malcolm* (1882) 6 O.R. 12. The trial Judge, Ferguson, J., said at p. 22:

"I think it is clear from what is there stated (Curtis on Patents, Sec's 279 to 285) and from a large number of cases to which I was referred by counsel that a re-issued patent must be for the *same invention* as was the patent surrendered upon re-issue taking place, and that the re-issue can include no new invention, that is, no invention not comprehended in the surrendered patent whose place it takes. It was argued in this case that the claim cannot upon the re-issue of a patent, be enlarged, and I apprehend this is correct, if the meaning is that by enlarging the claim or extending it the invention is enlarged so to speak, that is, something new is imported into the re-issued patent, some invention not contained or comprehended in the surrendered one, but this is not or is not always the meaning of enlarging the claim."

The judgment of Ferguson, J., came before a Divisional Court composed of two Judges. The judgment of Boyd, C., was in favour of affirming the judgment. Proudfoot, J., dissented. In his reasons for judgment, Boyd, C., said at p. 41.

"What could have been claimed as part of the invention under the specifications and descriptions accompanying the original patent, but was not by reason of error, mistake or inadvertence may be claimed in a re-issue if there has been no *laches*. Washburn & Moen Manufacturing Co. v. Haish 19 U.S. Off. Gaz. 173; S.C.; Dec. Com. Patents 1881, p. 77. Not what the patentee claims as his invention but what is for the first time disclosed to the public on his application, is the measure of his right on a re-issue."

Proudfoot, J., in his dissenting opinion, said at p. 51:

"I do not assent to this construction of the statute, that it authorizes a re-issue with broader and more comprehensive claims, if by that he meant that it authorizes a re-issue with a claim not in the original patent at all. . . . This, in my judgment, does not authorize a re-issue for a new claim. That a re-issue may be had if the claim be

so imperfectly described through error or mistake as not to cover the invention may be conceded . . . The decisions in this connection have not been so numerous as in the United States, and they have not reached the point of justifying a misapplication of the law. I think we should give effect to what appears to me to be the plain language of the statute and not allow ourselves to be drawn in the wake of decisions that misconstrue it and misapply it."

In a recent case re Leonard (1913), 14 Ex. C.R. 351, Cassels, J., expressed an opinion substantially the same as that of Boyd, C. In this case Mr. Justice Cassels, in support of his views, refers to *Wilson v. Coon*, 19 O.G. 482, which is authority for amendment of claims by re-issue. The general conclusions to be drawn from *Wilson v. Coon* must, it is believed, be considerably modified in view of the more recent United States cases referred to above.

It would appear, therefore that the law in Canada at present is that whatever is disclosed to the public in the original patent may be claimed on re-issue. Whether this law will stand is open to doubt. It may be that a higher court will adopt the view of the Supreme Court of the United States, which appear to be substantially that of Proudfoot, J.

Effect of
delay.

There is no statement in the Canadian or United States Statutes as to the time within which an application for re-issue may be made. The American courts, however, have placed a limit on the time within which an application to broaden a claim by re-issue may be made.

The position is taken in the United States that if certain matter is disclosed but not claimed in a patent, the right to cover it by re-issue may become abandoned, just as the right to secure a patent in the first instance may become abandoned through public use, sale or publication beyond the determined period. (*Miller v. Brass Co.* [1887] 104 U.S. 350.) The length of time which may occur without losing the right to a broadened re-issue cannot be settled as a fixed rule for all cases. The nature of the invention and the conduct of the patentee or existence of interfering rights must be taken into account. (*Leggett v. Standard Oil Co.* [1897] 149 U.S. 292; *Coon v. Wilson* [1884] 113 U.S. 277.) The general rule is that a delay of

two years or more invalidates a broadened re-issue unless that delay is accounted for and excused by special circumstances which show it to have not been unreasonable. (Toppliff v. Toppliff [1892] 145 U.S. 171, and Wollensack v. Reiber [1884] 115 U.S. 101.)

This two-year rule in the United States is drawn by analogy from the law with respect to original patents (R.S. 4886), which makes public use for more than two years prior to the application a bar to the grant of the patent. The American law is thus stated in Mahn v. Harwood (1884) 112 U.S. 354:

Two-year
rule in
U.S.A.

"A patent cannot lawfully be re-issued for the mere purpose of enlarging the claim unless there has been a clear mistake inadvertently committed in the wording of the claim and the application for a re-issue is made within a reasonably short time period after the original patent was granted. The granting of such reissues after the lapse of long periods of time is an abuse of the power and is founded on a total misconception of the law. . . . The rights of the public here intervene, which are totally inconsistent with such tardy re-issues; and the great opportunity and temptation to commit fraud after any considerable lapse of time, when the circumstances of the original application have passed out of mind, and the monopoly has proved to be of great value, make it imperative on the courts, as a dictate of justice and public policy, to hold the patentees strictly to the rule of reasonable diligence in making applications for this kind of re-issues."

"No precise limit of time can be fixed and laid down for all cases. The courts will always exercise a proper liberality in favour of the patentee. But in any case, by such delay as the court may deem unnecessary and unreasonable, the right to a re-issue will be regarded as having been abandoned and lost. . . . In Miller v. Brass Co., 104 U.S. 350, by analogy to the law of public use before an application for a patent, we suggested that a delay of two years should be construed equally favourable to the public. But this was a mere suggestion by the way and was not intended to lay down any general rule."

The Canadian law with respect to loss of right to broaden by re-issue through constructive abandonment by

Broadened
re-issues in
Canada.

delay in application is not clear. A lengthy but *obiter* statement is made by Burbidge, J., in *Auer Incandescent v. O'Brien* (1897) 5 Ex. C.R. 243, part of which reads as follows:

"The doctrine that the right of a patentee to a re-issue is lost in certain cases by lapse of some time after the date of the expiry of the original patent and before the application for the re-issue, has been established in the courts of the United States, and recognized in Canada. The doctrine itself has no statutory support. The legislature has not either in the United States or in Canada required that an applicant for a re-issue should come to the Commissioner within any definite or specified time. It is a doctrine that rests wholly upon the authority of decided cases. The object aimed at by the rule is good, but the rule is, I think, open to some objection when enforced by a court."

After this statement the Judge considers by means of an example, the grave injustice which would be wrought if an applicant surrendered a good patent to secure a re-issued patent, which would be held bad, because applied for too late. He then says: "That is a rule I should not care to adopt or follow unless compelled to do so by clearest authority. If the re-issue gives the patentee something that he was not entitled to, then he should be held not entitled, no matter how promptly the application was made, but if nothing more is granted to him than that to which he was entitled when the original patent issued, and the only effect of the re-issue is to correct some error in the specification that arose from inadvertence, accident or mistake, I do not see why, after the issue of the new patent by the Commissioner, he should be prejudiced by any delay in making the application."

The view of Judge Burbidge is contrary to the judgment in *Kidder et al. v. Smart et al.* (1884) 8 O.R. 362, where after considering *Witbrow v. Malcolm* (1882) 6 O.R. 12, and the United States cases, Ferguson, J., says: "The conclusion at which I have arrived after the best consideration I have been able to give the case is that the delay (without any excuse whatever) of the patentee for a period of nearly two years after full notice and knowledge

of the alleged inadvertence or mistake in his original patent and after professional advice on the subject, and after a re-issue of the same patent in the United States, founded upon the same inadvertence or mistake (during which period manufacture was carried on in the United States under the re-issue there) before the application for re-issue in this country is fatal to the validity of the re-issued patent in Canada."

In view of this conflicting opinion the Canadian law cannot be said to be settled. The American two-year rule has no foundation in the Canadian Statute. Whether the one-year period fixed by the Canadian Act, after which an invention on sale or in use with the consent of the inventor becomes public property, can form the basis of a similar rule in Canada is open to doubt.

The procedure in an application for re-issue is the same as for an original application and the same documents and drawings must be presented together with a surrender deed of the original patent written on a separate sheet of paper. If the original patent be lost a certified copy may be filed instead. The petition may be made by the patentee, or the assignee of the entire interest or the legal representative of either in case of death. It would appear that if any aliquot part has been assigned, the assignee must necessarily join the re-issue application in order to make the surrender of the original patent effective. Procedure.

The fees payable on an application for re-issue, namely, four dollars for each unexpired year of the original patent, are, in addition to the renewal taxes on the original patent due at the end of the sixth and twelfth years, and these will continue to be payable dating from the issue of the original patent. The two years within which to manufacture and the year within which to import run likewise from the date of the original patent. If the re-issue is not granted a return of fees less ten dollars will be made. Fees.

Disclaimers are designed to meet the case in which the claims of the patent are too broad. The provisions as to disclaimers are contained in sec. 25 of the Patent Act, which reads Disclaimers.

Section 25.

"25. Whenever by any mistake, accident or inadvertence, and without any wilful intent to defraud or mislead the public, a patentee has:

"(a) Made his specification too broad, claiming more than that of which he or the person through whom he claims was the first inventor; or,

"(b) In the specification, claimed that he or the person through whom he claims was the first inventor of any material or substantial part of the invention patented, of which he was not the first inventor, and to which he had no lawful right:

"The patentee may, on payment of the fee hereinafter provided, make disclaimer of such parts as he does not claim to hold by virtue of the patent or the assignment thereof.

"2. Such disclaimer shall be in writing and in duplicate, and shall be attested in the manner hereinbefore prescribed, in respect of an application for a patent; one copy thereof shall be filed and recorded in the office of the Commissioner, and the other copy thereof shall be attached to the patent and made a part thereof by reference, and such disclaimer shall thereafter be taken and considered as part of the original specification.

"3. Such disclaimer shall not affect any action pending at the time of its being made, except in so far as relates to the question of unreasonable neglect or delay in making it.

"4. In the case of the death of the original patentee, or of his having assigned the patent, a like right shall vest in his legal representatives, any of whom may make disclaimer.

"5. The patent shall thereafter be deemed good and valid for so much of the invention as is truly the invention of the disclaimant, and is not disclaimed if it

is a material and substantial part of the invention, and is definitely distinguished from other parts claimed without right and the disclaimant shall be entitled to maintain an action or suit in respect of such part accordingly. R.S. c. 61, s. 24."

In view of the form of sec. 33 of the Act, the provisions as to disclaimer are perhaps not of great importance. Sec. 33 reads: Cl. Section 33.

"33. Whenever the plaintiff, in any action fails to sustain the same, because his specification and claim embrace more than that of which he was the first inventor, and it appears that the defendant used or infringed any part of the invention justly and truly specified and claimed as new, the court may discriminate, and the judgment may be rendered accordingly." R.S. c. 61, s. 32. In most cases this section affords all the relief which can be secured by formal disclaimer.

Sec. 4922 of the United States Revised Statutes, which corresponds to sec. 33 of the Canadian Act, includes the following provisions: Cl. U.S. Statute R.S. 4922.

"But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer."

These provisions are not contained in the Canadian section, and it would seem that in an action for infringement the presence in the patent of something which should have been disclaimed cannot affect the question of costs unless the patentee set up the invalid claim as having been infringed.

The effect of sec. 33 has in several decided cases apparently been overlooked. Thus in *Collette v. Lasnier* (1886) 13 S.C.R. 563, Henry, J., in a dissenting

opinion, stated: "If it appears by the patent or specification that anything is claimed by the patentee as part of his invention which is not new, the grant of the privilege will be wholly void."

Sec. 25 follows the American Statute (R.S. 4917) in its language, and the rules developed in the United States will generally be found to apply here.

Cf. English Statute.

In England the disclaimer may be made by amendment as provided by 7 Ed. VII., c. 29, s. 21.

Cf. United States rule as to changing character of invention by disclaimer.

The English Statute (sub-section 6, sec. 21, of the Act of 1907) expressly states: "No amendment shall be allowed that would make the specification as amended, claim an invention substantially different from the invention claimed by the specification as it stood before amendment." This is only a statement of the rule applied in the earlier decisions. Thus in *Foxwell v. Bosstock* (1864 10 L.T. 144, 12 W.R. 723, Lord Westbury said: "Possibly they mean that the patent must not, by operation of the disclaimer, be made to include or comprehend something which was not originally contained in the patent. The invention claimed may be reduced or diminished, but it must not be extended or enlarged.")

The rule is the same in the United States. Mr. Justice Bradley, in *Hailes v. Albany Stove Co.* (1887) 123 U.S. 582 at p. 587, said: "A disclaimer is usually and properly employed for the surrender of a separate claim in a patent, or some other distinct or separable matter which can be excised without mutilating or changing what is left standing. Perhaps it may be used to limit a claim to a particular class of objects, or even to change the form of a claim which is too broad in its terms, but certainly it cannot be used to change the character of the invention. And if it requires an amended specification or supplemental description to make an altered claim intelligent or relevant, whilst it may possibly present a case for a surrender and re-issue, it is clearly not adapted to a disclaimer. A man cannot by merely filing a paper drawn up by his solicitor make to himself a new patent or one for a different invention from that which he had described in his specification." (See also *Union*

v. U.S., 112 U.S. 624, and Albany Steam Trap Co. v. Worthington, 79 F. 966.)

It is clear that where the claim is to a combination, the alteration of it by addition or subtraction of an element would in effect be claiming a different invention, and therefore cannot be accomplished by disclaimer. *Alteration of combination not permissible.*

In *re* Parkinson's Patent (1896) 13 R.P.C. 509, a proposed amendment to a claim which added to the combination claimed other portions of the apparatus, was held to be for a different invention, and not allowable.

Disclaimer is not to be used for the purpose of turning an insufficient description into a sufficient one. (Johnson's Patent [1896] 13 R.P.C. 659.)

The Canadian Statute, unlike the American, says nothing about the effect of delay in filing a disclaimer. *Question of delay does not arise.* As a disclaimer does not seek to enlarge the patent, there is nothing to be abandoned by failure to disclaim. The question of the effect of delay can therefore not arise except possibly as affecting costs.

The effect of the disclaimer is to cause the matter properly disclaimed to cease to be a part of the invention, and the patent is to be considered as if it had never been included. (*Dunbar v. Myers*, 94 U.S. 187; *Schwarzwalder v. N.Y.*, 66 F. 152.) *Effect of disclaimer.*

A disclaimer may go too far and defeat the patent. The subject matter left after the disclaimer must possess patentable novelty. In *Copeland-Chatterson v. Paquette* (1906) 10 E.C.R. 410, 38 S.C.R. 451, the claim sued on was held invalid as possessing no novelty over one which had been disclaimed.

The portion of the specification disclaimed must be readily distinguishable from the remaining portion, so that there may be no ambiguity as to what is actually disclaimed and what is still left. (*Tuck v. Brambill* [1868] 6 Blatch. 95; *Electrical Accumulator Co. v. Julien Electric Co.* [1889] 38 Fed. 134; *Taylor v. Archer* [1871] 8 Blatch. 318.) *Portion disclaimed must be distinguishable.*

By reason of sec. 2, sub-section (d), "Legal representatives" in sub-section 4 includes assigns. The position of an assignee of a part interest is, however, not clear. Apparently a disclaimer might be filed by an assignee of a part interest, which would have effect in any action *Disclaimer by assignee.*

brought by him. In the United States, if one of several joint owners files a disclaimer, no other owner may avail himself of the benefits thereof, nor would it affect a suit brought by the owners jointly. (Wyeth v. Stone [1840] 1 Story 294.)

Procedure. The procedure to make a disclaimer is simple. The disclaimer is executed in the presence of two witnesses, and filed in the Patent Office with the statutory fee of two dollars.

CHAPTER X.

DEVOLUTION, ASSIGNMENT AND LICENSE.

The Patent Act contains the following sections relating to assignments:

"26. The patent may be granted to any person to whom the inventor, entitled under this Act to obtain a patent, has assigned or bequeathed the right of obtaining the same, or in default of such assignment or bequest, to the legal representatives of the deceased inventor. R.S. c. 61, s. 25.

When representatives may obtain the patent.

"27. Every patent issued for an invention shall be assignable in law, either as to the whole interest or as to any part thereof, by any instrument in writing; but such assignment, and every grant and conveyance of any exclusive right to make and use and to grant to others the right to make and use the invention patented, within and throughout Canada or any part thereof, shall be registered in the Patent Office in the manner, from time to time, prescribed by the Commissioner for such registration; and every assignment affecting a patent for invention shall be null and void against any subsequent assignee, unless such instrument is registered as hereinbefore prescribed, before the registration of the instrument under which such subsequent assignee claims. R.S., c. 61, s. 26.

Patents to be assignable.

Registration.

Assignment null if not registered.

"28. In cases of joint application for grants, every assignment from one or more of the applicants or patentees to the other or others, or to any other person, shall be registered in like manner as other assignments. R.S., c. 61, s. 27."

Assignment in cases of joint applications.

An inventor may assign his right to obtain a patent, or he may assign an interest in the invention and in the right to obtain a patent. If an assignment be filed with

Assignment of right to a patent.

the application the grant will be made to the assignee, or where the assignment is of partial interest, to the inventor and the assignee. Where the assignment is made during the lifetime of the inventor, the inventor must make the affidavit. If the inventor be dead, the assignee may make the affidavit, as provided by sec. 10, sub-sec. 2.

Right to a patent where inventor dies.

If the inventor die before application without having assigned his right to the patent, the right to obtain the patent passes to the person to whom the inventor has bequeathed the right to obtain the patent, or if he has not bequeathed the right to a patent, or dies intestate, to his executors or administrators. Apparently the bequest referred to by the section is a specific bequest. It would seem that where there is a bequest of the right to the patent, the right passes direct to the legatee, and forms no part of his estate. On these points, however, we are without authority.

Grant under Canadian patent to two or more creates joint tenancy.

The form of grant to two or more persons used by the Canadian Patent Office being to the grantees "their heirs and assigns" creates a joint tenancy or interest which survives to the remaining grantees or grantee on the death of one or more of the original grantees unless there has been a severance of the joint tenancy or interest. (*National Company for the Distribution of Electricity by Secondary Generators v. Gihhs* [1899] 16 R.P.C. 339, 17 R.P.C. 302.)

Assignment to two or more creates joint tenancy.

An estate or interest in joint tenancy is also created by an assignment or bequest to two or more persons without any words showing an intention to sever the respective interests, as to two persons and their heirs.

Joint tenancy may be severed and tenancy in common created.

It is open to joint owners at any time, to sever their joint interest and to create a tenancy in common. (*National Co. for the Distribution of Electricity by Secondary Generators v. Gihhs* [1899] 16 R.P.C. 339, 17 R.P.C. 302.)

It would seem that this can be done simply by agreement between the owners that the owners are to hold as tenants in common. (*In re Wilks* [1891] 3 Ch. 59; *Williams v. Hensman*, 1 Johns & H. 546, 7 Jur. N.S. 771, 30 L.J., Ch. 878.) Another method that has been suggested is an assignment by the joint owners to a third person and a separate re-assignment to each owner of an undivided interest, thereby destroying the unity

of title. Joint tenancy may be avoided in a transfer to two or more persons by separate grants of individual interests to each or by stating that the grantees are to hold as tenants in common.

Except as to survivorship the rights of joint tenants and tenants in common *inter se* are practically the same. Rights of co-owners.

Each co-owner of a patent can work the patent himself and is under no obligation to account to the others for any profits made from the working (Mathers v. Green [1865] L.R. 1 Ch. 29; Steers v. Rogers [1893] 10 R.P.C. 245). Each co-owner may work patent.

It also seems certain that under the Canadian form of patent each co-owner may grant licenses. It is, however, perhaps open to doubt whether he is not liable to account to his co-owner for what he receives in respect to the licenses. (Dunnicliff v. Mallett [1859] 7 C.B.N.S. 269; Walter v. Lavater [1860] 8 C.B.N.S. 167; Mathers v. Green [1855] L.R. 1 Ch. 29; Hancock v. Bewley [1860] Johns 601.) Each co-owner may grant licenses, but may be liable to account.

See American cases: Blackledge v. Weir, 108 Fed. 71, 27 C.C.A. 76; Clum v. Brewer, 2 Curt. 506; Aspinwall v. Gill, 32 Fed. 697.

Each co-owner can, it is believed, sue without making his co-owners parties to the action where there is infringement either for an injunction or an account. Apparently, however, he can only recover that portion of the damages to which his interest in the patent entitles him having regard to the proportion of the patent owned by others. (Smith v. London and North Western Railway Co. [1853] 2 E. & B. 69; Dunncliffe v. Mallett [1850] 7 C.B.N.S. 209; Deut v. Turpin [1861] 2 J. & H. 139, 30 L.R., Ch. 495; Sheehan v. Great Western Railway [1881] L.R. 16, Ch. D. 59.) Each co-owner may sue, but can recover only proportionate share of damages.

In actions for infringement, however, the better practice seems to be to join all parties interested as defendants if they do not join as co-plaintiffs. (Westhead v. Keene [1838] 1 Beav. 287; Bergman v. Macmillan [1881] L.R. 17, Ch.D. 423; Van Gelder Co. v. Sowerby, Ltd. [1890] 7 R.P.C. 41.) Better practice to join all parties.

In England the rights of co-patentees *inter se* were somewhat modified by the Act of 1907. By sec. 37 it was provided: English law changed by Act of 1907.

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

We have in Canada no corresponding legislation.

Section 27
copied from
United
States Act.

Sec. 27 of the Canadian Act is almost in the same words as sec. 22 of the Act of 1869. The section appears to have been copied in part from sec. 11 of the American Act of 1836. The American legislation relating to patents is now contained in The Revised Statutes, sec. 4898:

"Every patent or interest therein shall be assignable in law, or by instrument in writing, and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under his patent, to the whole or any specified part of the United States. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof."

Right to
assign recog-
nized by
patent.

The right of the Canadian patentee to assign the exclusive right which has been granted to him, is recognized by the patent itself, the grant being to the grantee, "his executors, administrators, legal representatives and assigns."

No exclusive
right to
make or use
exists after
two years.

The language used in sec. 27, "exclusive right to make and use, and to grant to others the right to make and use" is not accurate. By reason of sec. 38 there is no exclusive right to use after two years.

What is an
assignment.

Whether a transfer of a particular right or interest under a patent is an assignment or license does not depend upon the name by which it calls itself, but upon the legal effect of its provisions. (*Waterman v. Mackenzie*, 138 U.S. 252, 34 L. Ed. 923, 11 S.C. 334.)

By virtue of sec. 27 the owner of a patent may by instrument in writing, assign, grant or convey, either:

(1) The whole patent comprising the exclusive right to make, use and vend the invention throughout Canada; or

(2) An undivided part or share of that exclusive right; or

(3) The exclusive right under the patent within and throughout a specified part of Canada.

A transfer of either of these three kinds of interests is an assignment properly speaking, and vests in the assignee a title in so much of the patent itself. Any assignment or transfer short of one of these is a mere license, giving the licensee no title in the patent and no right to sue at law in his own name for infringement. (*Dalglish v. Conboy* [1876] 26 U.C.C.P. 254; *Waterman v. Mackenzie*, 138 U.S. 252, 34 L. Ed. 923, 11 S. Ct. 334; *Paulus v. Buck*, 129 Fed. 594, 64 C.C.A. 162; *Pope v. Gormully*, 144 U.S. 248, 36 L. Ed. 420, 12 S. Ct. 637; *Gayler v. Wilder*, 10 How. 477, 13 L. Ed. 504; *Moore v. Marsh*, 74 U.S. 515.)

A legal assignment of English letters patent can only be made by deed. (*Stewart v. Casey* [1891] 9 R.P.C. 9.) The Canadian Act does not require that the assignment shall be under seal. (*Dalglish v. Conboy* [1876] 26 U.C.C.P. 254; *Gottfreid v. Miller*, 104 U.S. 521, 26 L. Ed. 851.)

An assignment in Canada need not be under seal.

To pass a legal interest an assignment must be in writing. (*Machine Co. v. Murphy*, 97 U.S. 120, 24 L. Ed. 935; *Agawam Co. v. Jordan* [1868] 7 Wall. 583; *Moore v. Marsh*, 74 U.S. 515.)

But must be in writing.

The practice of the Canadian Patent Office is to register almost any document referring to a patent. The Act, however, provides only for the registration of the following instruments:

Provision as to registration.

(1) An assignment of the whole interest in a patent throughout Canada.

(2) An assignment of the individual part of a patent throughout Canada.

(3) The grant or conveyance of right to make, and use the thing patented in some specified part of Canada, to the exclusion of the patentee.

As between the parties registration is not necessary to the validity of the assignment. An unregistered assignment is only void as against a subsequent registered

Registration not necessary as between

parties to assignee. (*Dalgleish v. Conhoy* [1876] 26 U.C.C.P. 254; *De La Vergne, etc., Machine Co. v. Featherstone*, 147 U.S. 209, 225, 37 L. Ed. 138.) Nor is registration necessary as against an infringer. (*Brooks v. Byam*, 2 Story 525; *Pitts v. Whittman*, 2 Story 609; *Boyd v. McAlpin*, 3 McLean 427; *Case v. Redfield*, 4 McLean 526.)

Effect of notice in United States. Under the United States enactment an unregistered assignment is void as against a subsequent purchaser or mortgagor for a *valuable consideration, without notice*, unless it is recorded in the Patent Offices within *three months from the date thereof*, but a purchaser with notice of a prior unrecorded assignment will be deemed to hold in trust for the prior assignee. (*Whitney v. Burr*, 115 Ill. 289, 3 N.E. 434; *Pontiac Knit Boot Co. v. Merino Shoe Co.*, 31 Fed. 286.)

Effect of notice in England. The English Act, sec. 71, provides that notwithstanding registration "any equities in respect of such patent or design may be enforced in like manner, as in respect of any other personal property."

Effect of notice in Canada. The Canadian Act says nothing about valuable consideration or notice, and it is impossible to say whether any equities will prevail as against the terms of the section. This would seem to be a place for the application of the doctrine of *Le Neve v. Le Neve* (1748) 3 Atk. 646, that the person who purchases an estate, although for valuable consideration, after notice, of a prior equitable right, makes himself a *mala fide* purchaser, and will not be enabled by getting in the legal estate, to defeat such prior equitable interest but will be held a trustee for the benefit of the person whose right he sought to defeat. (See *New Ixion Tyre & Cycle Co. v. Spilshury* [1898] 2 Ch. 484, *Chitty, L.J.*, 489.) In view, however, of the criticism which has been offered as to the accepted application of the doctrine in England it is doubtful whether it will be adopted by the Canadian courts in this instance. (See *White & Tudor's Leading Cases in Equity*, 7th Ed., Vol. II., p. 175.)

Except as against section 27 equities probably enforced. Except as against the provisions of sec. 27 there would seem to be no reason why the equities in a patent should not be enforceable in the same way as in respect of other personal property, or why the doctrine of notice with its equitable consequences should not be applicable. The

English Act makes special provision on this point (S. 71) but in the absence of anything to the contrary in the Act this would seem to follow.

An agreement to assign operates as an equitable assignment (Stewart v. Casey [1891] 8 R.P.C. 259, 9 R.P.C. 9) and may be specifically enforced (Jandus Arc Lamp and Electric Co. v. Johnson [1900] 17 R.P.C. 376). The usual conditions of an equitable assignment will apply, however, and a legal assign without notice may claim priority. (Wapshare Tube Co., Ltd. v. Hyde Imperial Rubber Co. [1901] 18 R.P.C. 374.) Moreover, inasmuch as an equitable assignee can scarcely have greater rights than a legal assignee, it is possible that by reason of sec. 27 a legal assignment when registered may prevail even where the assignee has had notice.

Equitable assignments.

While an assignment to pass the legal estate must be in writing, sec. 27 does not refer to an agreement to assign and a parol agreement is enforceable. (Dagleish v. Conhoy [1876] 26 U.C.C.P. 254; Dalzell v. Dueber, etc., Mfg. Co., 149 U.S. 315, 37 L. Ed. 759.)

Agreement to assign need not be in writing.

Under the English law it has been decided that an assignee with notice of previous licenses takes subject to these licenses (Hassell v. Wright [1870] L.R. 10 Eq. 509; Werdermann v. Societe Generale D'Electricite [1881] 19 Ch.D. 246; The New Ixion Tyre and Cycle Co. v. Spilsburg [1898] 2 Cb. 484). It also seems to be the general view that an assignee who takes without notice of prior licenses is not bound by them. (Terrell on Patents, 5th Ed. 194; Frost Patent Law and Practice, 3rd Ed., Vol. II., p. 122.) In the United States the law is that a purchaser of a patent takes it subject to all outstanding licenses whether he has or has not notice of them. (Walker on Patents, p. 304; Pratt v. Wilcox Mfg. Co. [1893] 64 Fed. 592; Jones v. Berger [1893] 58 Fed. 1008; Brooks v. Byam [1843] 2 Story 525; Chambers v. Smith, 5 Fisher 12, 5 Fed. Cas. No. 2582.) There can be no reason why the law in England and Canada should differ, and while there does not seem to be any direct authority in England it is probable the law is as stated and that in Canada also an assignee is not bound by licenses of which he had no notice.

Assignee probably takes subject only to licenses of which he has notice.

Rights of assignee of whole or part of patent.

The assignee of the whole interest in a patent acquires all the rights of the patentee. He may sue infringers alone. The assignee of an undivided part of a patent has the rights of any co-owner which have already been discussed. The assignee of the patent rights in some limited area would seem to be vested with the sole right to sue for infringement within his limited territory. (*Green v. Watson* [1884] 10 A.C. 113; *Waterman v. Mackenzie*, 138 U.S. 252, 34 L. Ed. 923, 11 S. Ct. 334; *Chambers v. Smith*, 5 Fed. Cas. No. 2582; see also *Heap v. Hartley* [1888] 6 R.P.C. 495; *Renard v. Levinstein* [1864-5] 2 H. & M. 628.)

Position of assignee who holds by way of mortgage in United States.

In the United States it has been held that a mortgage vests the whole title to the patent in the mortgagee subject only to be defeated by performance of the condition or by redemption within a reasonable time, and that a patent right being incorporeal property, nor susceptible of actual delivery and possession, the recording of the mortgage in the Patent Office is equivalent to delivery of possession and makes the title of the mortgage complete towards all other persons, as well as against the mortgager. The mortgagee may grant licenses and sue for injunction or damages against an infringer. (*Waterman v. Mackenzie*, 138 U.S. 252, 34 L. Ed. 923, 11 S. Ct. 334; *Waterman v. Shipman*, 55 Fed. 982, 5 C.C.A. 371.)

Position of assignee who holds by way of mortgage in England.

In England the mortgagee is entered in the register as "mortgagee" and not as "assignee." The mortgager remains the person entitled to the patent and therefore the "patentee" within the meaning of the Act. The mortgagor may sue without joining the mortgagee in an action for infringement. The mortgagee cannot sue infringers. (*Van Gelder v. Sowerhy Bridge Flour Co.* [1890] 7 R.P.C. 41.)

Position of assignee who holds by way of mortgage in Canada.

In Canada we are without authority as to the position of a mortgagee. The American views would seem to be more applicable to condition created by our Patent Act but how far American decisions will be followed, it is impossible to say.

Assignor sued for infringement can not set up invalidity of patent.

The patentee having assigned his patent cannot manufacture the patented article. Should he do so and an action of infringement be brought against him by his assignee, he is not allowed to set up as a defence the invalidity of the patent. This is sometimes put on the

ground of estoppel but under the Canadian law is perhaps better put on the ground that he cannot derogate from his own grant. (*Duryea v. Kauffman* [1910] 21 O.L.R. 161, 175; *Whiting v. Tuttle* [1870] 17 Gr. 454; *Gillies v. Colton* [1875] 22 Gr. 123; *Franklin Hocking v. Franklin Hocking* [1889] 6 R.P.C. 69; *Oldham v. Longmead* [1789] Davies P.C. 157, referred to in *Hayne v. Malthy* [1789] 3 T.R. 438 at pp. 439, 441; *Chambers v. Crichley* [1864] 33 Beav. 574; *Gonville v. Hay* [1903] 21 R.P.C. 49.)

In the ordinary case of the sale or license of a patent there is no implied warranty as to the validity of the patent, and the purchaser cannot therefore set up the invalidity of the patent as a defence in an action for the purchase price. (*Electric Fireproofing Co. of Canada v. Electric Fireproofing Co.* [1910] 43 S.C.R. 182; *Duryea v. Kauffman* [1910] 21 O.L.R. 161; *Vermilyea v. Canniff* [1886] 12 O.R. 164; *Owens v. Taylor* [1881] 29 Gr. 216; *Beam v. Merner*, 14 O.R. 412; *Watson v. Green* [1883] 2 O.R. 627, 10 O.A.R. 113; *Copeland-Chatterson v. Lyman Bros. Co.* [1907] 9 O.W.R. 908, 912; *Hall v. Condor* [1857] 2 C.B.N.S. 22; *Smith v. Buckingham* [1870] 21 L.T.N.S. 819; *Liardet v. Hammond Electric Light and Power Co.*, 31 W.R. 710, *Crossley v. Dixon* [1863] 10 H.L.C. 293; *Clark v. Adie* [1877] 2 App. Cas. 423.)

No implied warranty arises from ordinary assignment.

Where, however, the patentee purports to assign the exclusive right to manufacture, use and sell the patented article an implied warranty arises that the patent is valid, otherwise he could not assign such exclusive right. (*Chanter v. Leese* [1838] 4 M. & W. 295, 5 M. & W. 698; *Hall Condor* [1857] 2 C.B.N.S. 22.)

Assignment of exclusive right implies warranty.

Where there has been fraud, the purchaser may plead it, and repudiate the contract, and may prove the invalidity of the patent where it is necessary to do so to prove fraud. (*Duryea v. Kauffman* [1910] 21 O.L.R. 161; *Dawes v. Harness* [1875] L.R. 10 C.P. 166; *Lovell v. Hicks* [1836-7] 2 Y. & C. Ex. 46; *Hayne v. Malthy* [1789] 3 T.R. 438; *Chanter v. Leese* [1838] 4 M. & W. 295, 5 M. & W. 698.)

Invalidity of patent may be proven where fraud has existed.

The invalidity of the patent may also be brought in issue where there is an express warranty or covenant. (*Henderson v. Shield* [1907] 24 R.P.C. 108.)

Invalidity may be issued where express warranty given.

Assignor may show ambit of patent.

While an assignor sued by his assignee may be estopped from denying the validity of the patent, he is at liberty to show that the claims of the patent are not as wide as or what the assignee contends. That is, he may show what the patent is good for (*Hocking v. Hocking* [1888] 6 R.P.C. 69; *Indiana Manufacturing Co. v. Smlth* [1904] 9 Ex. C.R. 154).

Assignment of improvements.

In assignments there is frequently inserted a covenant to assign all improvements of the invention which the inventor shall make. Such a covenant is not contrary to public policy (*Printing and Numerical Machinery Co. v. Sampson* [1875] L.R. 19 Eq. 462). The word "improvements" may have a different meaning in different instruments. It usually has no technical meaning, but is to be interpreted in the sense in which it is popularly used. The test as to whether the subsequent invention is or is not an infringement of the earlier patent is therefore not a proper one. In *Westinghouse Air-Brake Co. v. Chicago Brake & Mfg. Co.*, 85 Fed. 786, at p. 790, it was said: "Identity of purpose and function of the two mechanisms controls the question whether the one stands in the relation of an improvement to the other." In *Linotype and Machinery, Ltd. v. Hopkins* (1908) 25 R.P.C. 665, 27 R.P.C. 109) it was said by Buckley, L.J., in the Court of Appeal, p. 670: "In the case of a machine, an improvement of the machine includes, I think, any machine which, while retaining the essential or characteristic parts, or some of the essential or characteristic parts of the machine (being parts in the use of a patented machine which are subject to the monopoly claims) yet, by addition to or omission of, or alteration made in these parts, or some of them, achieves more quickly or more cheaply, or in some better way, the same result as, or achieves a better result than is achieved by the patented machine in the purpose for which it was contrived." In *Watson v. Harris* (1899) 31 O.R. 134, the word was held to include any development of the central idea which underlay the earlier invention. (See also *Valveless Gas Engine Syndicate v. Day* [1899] 16 R.P.C. 100; *Jones v. Russell* [1896] N.B. Eq. R. 232.)

License distinguished from assignment.

Licenses differ from assignments, in that the patentee granting a license does not part with his whole interest,

but grants merely a right to use the invention for the whole term or any portion of the whole term, that is merely a right to do that which without a license could not be done except by violating the monopoly granted to and still vested in the licensor. (Terrell on Patents, 5th Ed., p. 202; *Heap v. Hartley* [1889] 6 R.P.C. 499.)

A document is a license only and not an assignment unless it conveys the entire monopoly or an undivided interest therein throughout the whole of Canada, or some particular part thereof (*Green v. Watson* [1884] 10 A.C. 113; *Dalgleish v. Conhoy* [1876] 26 U.C.C.P. 254; *Waterman v. Mackenzie*, 138 U.S. 252, 34 L. Ed. 923, 11 S. Ct. 334; *Gayler v. Wilder*, 10 How. 477, 13 L. Ed. 504; *Pope v. Gormully*, 144 U.S. 236, 36 L. Ed. 420, 12 S. Ct. 637).

An agreement for a license, upon the principle established in *Walsh v. Lonsdale*, 21 Ch.D. 9, may be equivalent to a license (*Duryea v. Kauffman* [1912] 3 O.W.N. 651, 21 O.W.R. 141).

Agreement to license is equivalent to a license.

By reason of sec. 30 it would seem that in Canada a license must be in writing. (*Smith v. Mitchmore* [1849] 10 U.C.C.P. 391.) There is, however, no requirement that it shall be under seal.

Apparently license must be in writing.

Sec. 27 as to registration does not apply to a mere license. (*Dalgleish v. Conhoy* [1876] 26 U.C.C.P. 254; *MacLaughlin v. Lake Erie R.W. Co.* [1902] 3 O.L.R. 706; *Pratt v. Wilcox Mfg. Co.* [1893] 64 Fed. 592; *Jones v. Berg* 1893] 58 Fed. 1006; *Brooks v. Byam* [1843] 2 Story 525, 4 Fed. Cas. No. 1948; *Chambers v. Smith*, 5 Fisher 12, 5 Fed. Cas. No. 2582.)

Section 27 does not cover licenses.

A licensee may not sub-license or assign unless the intention to allow him to do so is expressed or implied, as for example, where the license is granted to the licensee "and his assigns" (*Bower v. Hodges* [1853] 13 C.B. 765; *Lawson v. Macpherson & Co.* [1897] 14 R.P.C. 696; *Lane v. Locke*, 150 U.S. 193, 196, 37 L. Ed. 10, 49). But although not expressly or impliedly assignable, the licensor can not impeach the assignment if he has acquiesced, *ex. gr.*, has accepted royalties from the assignee (*Lawson v. Macpherson & Co.* [1897] 14 R.P.C. 69; *Lane v. Locke*, 150 U.S. 193, 196, 37 L. Ed. 1049; *Hammond v. Mason*, 92 U.S. 724, 23 L. Ed. 767).

Licensee can not grant sub-licenses unless intention to allow him to do so expressed.

A person licensed to use a patented invention in the absence of an agreement to the contrary, may alter or change it for his own use as he sees fit. (MacLaughlin v. Lake Erie R.W. Co. [1901] 2 O.L.R. 190, 3 O.L.R. 706.)

No covenant implied to pay renewal fees.

In the absence of a covenant, neither the licensor nor the licensee is bound to pay renewal fees (The Railway and Electric Appliances Co. [1888] 38 Ch.D. 597; Mills v. Carson [1892] 9 R.P.C. 338, [1893] 10 R.P.C. 9).

A covenant to pay renewal fees cannot be implied from a covenant for quiet enjoyment (Re Railway and Electric Appliance Co. [1888] 38 Ch.D. 597). Where, however, the licensor undertook to "protect and defend" the patent from all infringements, it was held he must pay renewal fees (Lines v. Usber [1897] 14 R.P.C. 206).

Or to manufacture.

No covenant can be implied binding the licensee to fulfil the requirement of sec. 38 as to manufacture.

General rule that mere license may be terminated at will.

Whether a license is revocable or irrevocable depends upon the terms of the instrument. The general rule is that a mere license in the absence of provisions to the contrary, may be terminated at will by either party. (Wood v. Leadhitter, 9 Jur. 187; Crossley v. Dixon [1863] 10 H.L.C. 291; Coppin v. Lloyd [1898] 15 R.P.C. 373; Redges v. Mullinar [1893] 10 R.P.C. 21; Woodruff v. Eclipse Office Furniture Co. [1904] 4 O.W.R. 165; Noxon v. Noxon [1894] 24 O.R. 401.)

Even if under seal.

A license under seal is as much revocable as a license by parol. (M'Kenzie v. M'Glaughlin [1884] 8 O.R. 111, 115; Noxon v. Noxon [1894] 24 O.R. 401.)

License coupled with an interest is not revocable.

If the license be "coupled with an interest" or coupled with obligations on both parties, it is not revocable. (Ward v. Livesey [1888] 5 R.P.C. 102; Guyot v. Thompson [1894] 11 R.P.C. 541; Cutlan v. Dawson [1897] 14 R.P.C. 249; MacLaughlin v. Lake Erie R.W. Co. [1901] 3 O.L.R. 706 at p. 194.)

Principles only apply where license is silent.

These principles, however, only apply where the license is silent as to the power of the parties to terminate it. If the instrument provides for revocation the license will be revocable though involving mutual obligations. (Ward v. Livesey [1888] 5 R.P.C. 102.)

Right to one party to

Where an agreement provides that one party may determine the license but says nothing as to the right of

the other to do so, it will generally be inferred that the other party has no right to put an end to it. (Cutlan v. Dawson [1897] 14 R.P.C. 249, 13 R.P.C. 710; Guyot v. Thompson [1894] 11 R.P.C. 541.)

terminate
may imply
that other
party can
not do so.

In the absence of express agreement, a licensee during the term of the license, may not dispute the validity of the patent. This is generally put on the ground of estoppel. It may usually be rested simply on contract. There being no warranty expressed, and no warranty being implied, the validity of the patent is immaterial. The licensee has promised to pay, and the action is on the promise. (Duryea v. Kauffman [1910] 21 O.L.R. 182; Copeland-Cbatterson Co. v. Lyman Bros. Co. [1907] 9 O.W.R. 908, at p. 912; Gillies v. Colton [1875] 22 Gr. 123; Vermilyea v. Canniff [1886] 12 O.R. 164; Owens v. Taylor [1881] 29 Gr. 210; Beam v. Merner, 14 O.R. 412; Crossley v. Dixon [1863] 16 H.L.C. 293, 32 L.J., Cb. 617; Hall v. Condor [1857] 2 C.B.N.S. 22, 53, 26 L.J.C.P. 138, 288; Clark v. Adie [1877] L.R. 2 App. Cas. 423; Liardet v. Electric Lighting Co. [1883] W.N. 96; Ashworth v. Law [1890] 7 R.P.C. 231; Wilson v. Union Oil Mills [1892] 9 R.P.C. 63.) Even a license under an implied license may be estopped (Imperial Supply Co. v. G.T.R. [1912] 14 Ex. C.R. 88).

Licensee
may not set
up invalidity
of patent.

It follows that a licensee must pay royalties reserved, though the patent be declared void. (African Gold Recovering Co. v. Sheba Gold Mining Co. [1897] 14 R.P.C. 663.)

Royalties
must be paid
though
patent in-
valid.

If there is an express warranty the case is different and the validity of the patent may then be brought in question (Wilson v. Union Oil Mills Co., Ltd. [1892] 9 R.P.C. 59; Mills v. Carson [1892] 9 R.P.C. 338, [1893] 10 R.P.C. 9; Watson v. Green [1883] 10 O.R. 627, 10 O.A.R. 113).

Where ex-
press war-
ranty exists
invalidity of
patent may
be set up.

Fraud, which in effect asserts the non-existence of an agreement, may be pleaded, and in proving fraud the validity of the patent may be an issue. (Lovell v. Hicks [1836-1837] 2 Y. & C. 46, 472; Hayne v. Maltby [1789] 3 T. R. 438; Chanter v. Leese [1838] 4 M. & W. 595; McDougall v. Partington [1890] 7 R.P.C. 216, at p. 223; Ashworth v. Law [1890] 7 R.P.C. 231 at p. 234.)

In proving
fraud
validity
may be an
issue.

While a licensee may not deny the validity of the patent he may show, that acts done by him in respect of which it is sought to hold him liable for royalties, are not cov-

Licensee
may show
that acts
are not

covered by patent. ered by the patent and may refer to the state of public knowledge at the date of the patent to show the true ambit of the claims. (Barclay v. McAvity [1894] 1 N.B. Eq. R. 1, 146; Clark v. Adie [1877] 2 App. Cas. 423; Neil v. McDonald [1902] 20 R.P.C. 213; Davies v. Curtis & Harvey, Ltd. [1903] 20 R.P.C. 561; Young v. Hermand Oil Co. [1892] 9 R.P.C. 373.)

Licensee may dispute validity of patent after termination of license. "Not all the incidents of a tenancy follow the granting of a license, *e.g.*, while a tenant is not allowed to deny his landlord's title, even after the termination of a lease, unless and until he gives up possession of the premises (Doe dem Manton v. Austin [1832] 9 Bing. 41; Eliot v. Mayor, etc., of Bristol [1894] 71 L.T. 659 at p. 663) the licensee is at liberty in any case after the termination of the license to dispute the validity of the patent." (Duryea v. Kauffman [1910] 21 O.L.R., 161 at p. 182. See also Dangerfield v. Jones [1865] 13 L.T. 142.) Where the licensee may determine the license, he may do so and then dispute the validity of the license. (Crossley v. Dixon [1863] 10 H.L.C. 293; Redges v. Mullinar [1893] 10 R.P.C. 21; Noxon v. Noxon [1894] 24 O.R. 401; Woodruff v. Eclipse Office Furniture Co. [1904] 4 O.W.R. 165.)

General, limited, and exclusive licenses.

Licenses may be:

- (1) General.
- (2) Limited.
- (3) Exclusive.

"General licenses are those which include the right to use every part of the invention, in any manner and to any extent, and apply to the whole of the geographical area for which the patent was granted."

"Limited licenses may be limited in the sense that they apply to a part of the invention, or to the construction or use of a patented article, but not to both; or to the use of the invention in a particular manner, or in a particular district, or for a specified portion of the term for which the patent was granted."

"Exclusive licenses are those under the terms of which the patentee is prevented from making a like grant to any one other than the licensee during the continuance of the license." Frost, Patent Law and Practice, 3rd Ed., Vol. II., pp. 141, 142.

The English Act of 1907, sec. 38, has placed certain restrictions on the power of the patentee to impose terms of limitation. In Canada the patentee must comply with sec. 38. With the possible exception in the case of process patents, he must sell the patented invention at a reasonable price to any one desiring to obtain it. (*Hildreth v. McCormack* [1906] 10 Ex. C.R. 378, 39 S.C.R. 499.) There is, however, no prohibition against restrictive agreements. One of the public has the right to insist on an absolute sale. If, however, he submits to a restrictive agreement or license, the agreement is good. (*Copeland-Chatterson Co. v. Hatton* [1906] 10 Ex. C.R. 224, 37 S.C.R. 651.)

Patentee must comply with section 38 by selling where demand made but may enter into restrictive agreements.

It was held in the *Incandescent Gas Light Co., Ltd. v. Brogden* (1899) 16 R.P.C. 179, that a "patentee had a right, not merely by sale without reserve to give an unlimited right to the purchaser to use, and thereby to make in effect a grant from which he could not derogate, but might attach to it conditions, and if those conditions were broken, then there was no license, because the license was hound up with the observance of the conditions." Therefore the patentee might license the user of his patented invention with the condition attached that it was to be used only in connection with some other article sold by him.

A purchaser from one having only a limited license is bound by limitations in the license of which he has notice. Where a purchaser is without notice the law is not so clear. *Wills, J.*, in the *Incandescent Gas Light Company, Ltd. v. Cantelo* (1895), 12 R.P.C. 262, expressed the opinion that under any circumstances "the sale of a patented article carries with it the right to use it in any way that the purchaser chooses to use it unless he knows of restrictions." In the case of *Badische Anilin und Soda Fabrik v. Isler* (1906), 1 Ch. 605, however, *Buckley, J.*, expressed the opinion that there is no such general rule of law, and that upon principle "nothing (so far as license as distinguished from estoppel is concerned) can turn on the question whether the purchaser from the licensee knew of the conditions or not." He thought that a third person could only be freed from the condition by the patentee being estopped from setting up his rights.

Purchaser from holder of limited license.

Estoppel is probably the gist of the matter. In some cases a purchaser may be bound by terms of a license of which he has no notice; in others he will not be bound. Where a patentee sells to a dealer for resale he cannot set up as against a purchaser without knowledge the restrictions of a license. (*Incandescent Gas Light Co., Ltd. v. Cantelo* (1895), 12 R.P.C. 262, Wills, J.; *Incandescent Gas Light Co., Ltd. v. Brogden* (1899), 16 R.P.C. 179; *Badische Anilin und Soda Fabrik v. Isler* (1906), 1 Ch. 605; *National Phonograph Company of Australia, Ltd. v. Menck* (1911), 28 R.P.C. 229).

Exclusive license excludes the patentee.

An exclusive license may be for the whole of Canada or of some limited portion only. Unless there is some reservation in the license, an exclusive license will exclude the owner. (*Guyot v. Thompson* [1894] 11 R.P.C. 541; *Bush v. California*, 52 Fed. 945, 3 C.C. 368.)

Exclusive irrevocable license is an assignment.

An exclusive irrevocable license reserving no interest in the patentee is an assignment if it covers the whole area of the patent. (*Guyot v. Thompson* [1894] 11 R.P.C. 541 at p. 554; *Heap v. Hartley* [1889] 6 R.P.C. 495 at p. 500.) It would also under the Canadian Act seem to amount to an assignment if it covers only a limited area. (*Green v. Watson* [1884] 10 A.C. 113 at p. 118; *Dagleish v. Conhoy* [1876] 26 U.C.C.P. 254; *Waterman v. Mackenzie*, 138 U.S. 252, 34 L. Ed. 923, 11 S. Ct. 334; *Gaylor v. Wilder*, 10 How. 477, 13 L. Ed. 504; *Paulus v. Buck*, 129 Fed. 594, 64 C.C.A. 162.)

Licensee, except possibly exclusive licensee, can not sue.

Where a license amounts to an assignment, the licensee or assignee may sue without joining the licensor. This has already been discussed in connection with assignments. Possibly an exclusive licensee under a license which does not amount to an assignment may also sue (*Renard v. Levinstein* [1864-5] 2 H. & M. 628; *Cochrain (J. P.) & Co. v. Martins (Birmingham) Ltd.* [1911] 28 R.P.C. 284) though it is doubtful if he can do so without joining the assignor as a defendant where he is not a plaintiff. In any other case a licensee is not entitled to sue without joining the patentee. The reason for this is that the license gives no title in the patent but merely enables the licensee to do something which would be unlawful but for the license. (*Heap v. Hart-*

ley [1889] 6 R.P.C. 495; *Waterman v. Mackenzie*, 138 U.S. 252, 34 L. Ed. 923, 11 S. Ct. 334.)

It is the practice of the Canadian Patent Office to record licenses. The Act, however, does not require that licenses shall be recorded, and it is doubtful if it even authorizes it. It would seem, therefore, that recording a license can have no effect except as against a person who can be shown to have acquired actual knowledge of the license. There can be no obligation to search in the Patent Office for something that is not required to be filed. (*Chambers v. Smith*, 5 Fed. Cas. 2582.)

Recording a license can have no effect except against person acquiring actual knowledge.

The right to deal with a patented invention freed from the patent frequently arises apart from any expressed agreement. It is usually said to result from an implied license.

Implied license.

The unconditional and lawful sale of a patented article carries with it an implied license to deal with the article as the purchaser sees fit. The license is apparently based on estoppel, the patentee by his conduct in selling the article being prevented from setting up any patent rights in respect to it. (*National Phonograph Co. of Australia v. Menck* [1911] 28 R.P.C. 229; *Incandescent Gas Light Co., Ltd. v. Cantelo* [1895] 12 R.P.C. 262; *Badische Anilin und Soda Fabrik v. Isler* 1906 1 Ch. 605; *Betts v. Willmet* [1871] L.R. 6, Ch. 239; *Detweiler v. Voegelé* [1881] 8 Fed. 600; *Black v. Hubbard* [1877] 12 O.G. 842, 3 B. & A. 39; *American Cotton Tie Co. v. Simmons* [1878] 106 U.S. 89.)

License on sale.

The implied license on a sale includes the right to repair, but not to make a new article under cover of repair. (*Young v. Foerster* [1889] 37 Fed. 203; *Goodyear v. Jackson* [1901] 112 Fed. 146 at p. 149; *Dunlop Pneumatic Tyre Co. v. Neal* [1899] 16 R.P.C. 247; *Dunlop Pneumatic Tyre Co. v. Holborn Tyre Co.* [1901] 18 R.P.C. 222; *Dunlop Pneumatic Tyre Co. v. Wilson* [1890] 17 R.P.C. 332; *Dunlop Pneumatic Tyre Co. v. Excelsior Tyre, Cement and Rubber Co.* [1901] 18 R.P.C. 209; *Sirdar Rubber Co., Ltd. v. Wallington, Wills & Co.* [1907] 24 R.P.C. 539 at p. 543; *Gottfried v. Philips Best Brewing Co.* [1879] 17 O.G. 675; *Mitchell v. Hawley* [1872] 16 Wall. 544.)

Right to repair.

The implied license on sale applies not only where

the sale takes place within this country, but also as against the vendor in another country who holds a patent in Canada. (*Betts v. Willmot* [1871] L.R. 6, Ch. 239; *Heap v. Hartley* [1889] 6 R.P.C. 495.) In this respect it differs from an express license to manufacture and sell under a patent of one country which apparently does not authorize sale or use in another country where a patent exists. (*Société Anonyme de Manufactures de Glaces v. Tilghman's Patent Sand Blast Co.* [1883] L.R. 25, Ch.D 1.)

License extends as against vendor to all countries.

The implied license on sale probably applies only where the vendor in the foreign country holds the patent in this country, and not as against another holding the title to the patent. (*Daimler v. Conklin* [1909] 170 F. 70.)

Within the country, however, a purchaser from one having a right to sell has a right to use and probably to re-sell everywhere even in a territory assigned to some one other than the vendor. (*Adams v. Burke*, 84 U.S. 453; *Hohbie v. Jennison* [1892] 149 U.S. 355.)

Partner allowing partnership to use invention gives implied license continuing after partnership.

Where a patentee works a patent in partnership with another the patent becomes an asset of the partnership, and unless disposed of as partnership assets, each partner has an equal right on dissolution to use the invention. The other partner is taken to have acquired an irrevocable license to work the invention. (*Kenny's Patent Button-holeing Co., Ltd. v. Somervell* [1878] 38 L.T. 878, 26 W.R. 786; *Mueller v. Mueller* [1899] 95 F. 155; *Wade v. Metcalf*, 129 U.S. 202.)

Employee has right to his own invention except where contract is such that what he does is done for employer when he is merely a trustee of patent obtained by him.

The relation of employer and employee may be such as to create an implied license in favour of the employer. As was said by Byrne, J., in *Worthington Pumping Engine Co. v. Moore* (1903) 20 R.P.C. 41 at p. 48, "The mere existence of a contract of service does not *per se* disqualify a servant from taking out a patent for an invention made by him during his term of service, even though the invention may relate to subject matter germane to and useful for his employers in their business, and, that, even though the servant may have made use of his employer's time and servants and materials in bringing his invention to completion and may have allowed his employers to use the invention while in their employment." It may be, however, that any patent taken out by the

employee can only be held by him as trustee for the employer. This will be the case where the contract of service provides in express terms that any invention shall belong to the employer. This may also result where in the circumstances of a particular case, it is inconsistent with the good faith which ought properly to be inferred or implied as an obligation arising from the contract of service that the employee should hold the patent otherwise than as trustee for his employer. (Worthington Pumping Engine Company v. Moore [1902] 20 R.P.C. 41; Richmond & Co., Ltd. v. Wrightson [1904] 22 R.P.C. 25; Edisona, Ltd. v. Forse [1908] 25 R.P.C. 546.)

It would seem that there may be an intermediate position between that where the employee is the absolute owner of the patent even as against the employer, and that where the employee holds merely as trustee for the employer. It has been held in the United States and Canada that "when one is in the employ of another in a certain line of work, and devises an improved method or instrument for doing that work, and uses the property of his employer and the services of other employees to develop and put in practicable form his invention, and explicitly assents to the use by his employer of such invention, a jury, or a court trying the facts, is warranted in finding that he has so far recognized the obligation of service flowing from his employment and the benefits resulting from his use of the property, and the assistance of the co-employees of his employer, as to have given to such employer an irrevocable license to use such invention (per Mr. Justice Brewer in *Solomons v. United States* [1890] 137 U.S. 342 at p. 346; *McClurg v. Kingsland*, 1 How. 202; *Imperial Supply Co., Ltd. v. G.T.R.* [1912] 14 Ex. C.R. 88; *Bonathan v. Bowmanville* [1871] 31 U.C.Q.B. 413; *Gill v. United States* [1896] 160 U.S. 426; *Blauvelt v. Interior Conduit & Insulation Co.* [1897] 80 F. 906).

The extent and nature of the license to be implied must depend on the circumstances of each particular case. It being no part of the business of a railway company to manufacture the invention for sale, the license was held to extend only to the use of the company. (*The Imperial Supply Co. v. G.T.R.* [1912] 14 Ex. C.R. 88. See also *Fuller & Johnston v. Bartlett* [1887] 68 Wis. 73; *Brickill*

Employer may from circumstances have license to use employee's invention.

Extent of such license depends on particular facts in case.

v. New York [1879] 18 Blatch. 273; 5 Bann. & Ard. 547; Withington Cooley Mfg. Co. v. Kenney [1895] 68 F. 500.)

Such license
can not be
assigned.

An implied license of this character cannot be assigned (Hapgood v. Hewitt [1886] 119 U.S. 226; Lane & Bodley Co. v. Locke [1893] 150 U.S. 193, L. Ed. 10, 49).

Person in-
ducing or
allowing an-
other to use
patented in-
vention is
estopped
from setting
up his
rights.

Estoppel may bar a suit for infringement by a person who has induced another to construct or sell the patented article while concealing the existence of the patent or acquiescing in the sale or construction. (Société Fabrique v. Franco-American [1897] 82 F. 439; Barber v. National [1904] 129 F. 370; Proctor v. Bennis [1887] 36 Ch.D. 740, 4 R.P.C. 333.) A person selling a patented article before acquiring title to the patent will be similarly estopped when title is subsequently obtained. (Curran v. Burdsall [1883] 20 F. 835.)

CHAPTER XI.

CONDITIONS AS TO WORKING AND IMPORTATION.

COMPULSORY LICENSES.

The Patent Act contains the following important sections as to manufacturing or working under the patent and importation of the patented invention:

"38. Every patent shall, unless otherwise ordered by the Commissioner as hereinafter provided, be subject, and expressed to be subject, to the following conditions: Patent conditional.

"(a) Such patent and all the rights and privileges thereby granted shall cease and determine, and the patent shall be null and void at the end of two years from the date thereof, unless the patentee or his legal representatives within that period or an authorized extension thereof, commence, and after such commencement, continuously carry on in Canada, the construction or manufacture of the invention patented, 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; Manufacture in Canada within two years.

"(b) If, after the expiration of twelve months from the granting of a patent, or an authorized extension of such period, the patentee or patentees, or any of them, or his or their or any of their legal representatives, for the whole or a part of his or their or any of their interest in the patent, import or cause to be imported into Canada, the invention for which the patent is granted, such patent shall be void as to the interest of the person or persons so importing or causing to be imported. Importation prohibited. 3 E. VII., c. 46, s. 4.

Term for
manufacture
in Canada
may be ex-
tended.

"39. Whenever a patentee is unable to commence or carry on the construction or manufacture of his invention within the two years hereinbefore provided, the Commissioner may, at any time not more than three months before the expiration of that term, grant to the patentee or his legal representatives an extension of the term of two years, on his proving to the satisfaction of the Commissioner that his failure to commence or carry on such construction or manufacture is due to reasons beyond his control. 3 E. VII., c. 46, s. 5.

Term for
importation
may be ex-
tended.

"40. The Commissioner may grant to the patentee or his legal representatives, for the whole or any part of the patent, an extension for a further term not exceeding one year, during which he may import or cause to be imported into Canada the invention for which the patent is granted, if he or they show cause, satisfactory to the Commissioner, to warrant the granting of such extension; but no extension shall be granted unless application is made to the Commissioner at some time within three months before the expiry of the twelve months aforesaid. 3 E. VII., c. 46, s. 6.

Proviso.

Conditions
which may
be substi-
tuted.

"44. On the application of the applicant for a patent, previous to the issue thereof, or on the application within six months after the issue of a patent of the patentee or his legal representatives, the Commissioner, having regard to the nature of the invention, may order that such patent, instead of being subject to the condition with respect to the construction and manufacture of the patented invention hereinbefore provided, shall be subject to the following conditions, that is to say:

Application
by any per-
son to use
patent.

"(a) Any person, at any time while the patent continues in force, may apply to the Commissioner by petition for a license to make, construct, use and sell the patented invention, and the Commissioner shall, subject to general rules which may be made for carrying out this section, hear the person applying and the owner of the patent, and,

if he is satisfied that the reasonable requirements of the public in reference to the invention have not been satisfied by reason of the neglect or refusal of the patentee or his legal representatives to make, construct, use or sell the invention, or to grant licenses to others on reasonable terms to make, construct, use or sell the same, may make an order under his hand and the seal of the Patent Office requiring the owner of the patent to grant a license to the person applying therefor, in such form, and upon such terms as to the duration of the license, the amount of the royalties, security for payment, and otherwise, as the Commissioner, having regard to the nature of the invention and the circumstances of the case, deems just;

Order of
Commis-
sioner.

“(b) The Commissioner may, if he thinks fit, and shall on the request of either of the parties to the proceedings, call in the aid of an assessor, specially qualified, and hear the case wholly or partially with his assistance;

Assessors.

“(c) The existence of one or more licenses shall not be a bar to an order by the Commissioner for, or to the granting of a license on any application, under this section; and,

More than
one license
may be
granted.

“(d) The patent and all rights and privileges thereby granted shall cease and determine, and the patent shall be null and void, if the Commissioner makes an order requiring the owner of the patent to grant any license, and the owner of the patent refuses or neglects to comply with such order within three calendar months next after a copy of it is addressed to him or to his duly authorized agent. 3 E. VII., c. 46, s. 7.”

Forfeiture of
patent for
refusal to
grant
license.

A history of these sections may be useful for purposes of reference.

Sec. 28 of the Patent Act, 1869 (32-33 Vic., cap. 11), read as follows: Patent Act
1869, sec. 28.

“28. Every patent granted under this Act shall be subject to the condition that such patent and all the

rights and privileges thereby granted shall cease and determine and the patent shall be null and void, at the end of three years from the date thereof, unless the patentee shall, within that period, have commenced and shall, after such commencement carry on in Canada the construction or manufacture of the invention or discovery patented, in such 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, and that such patent shall be void if after the expiration of eighteen months from the granting thereof, the patentee or his assignee or assignees for the whole or a part of his interest in the patent imports or causes to be imported into Canada, the invention or discovery for which the patent is granted."

Sub-sec. 1, sec. 28 of the Patent Act of 1872 (35 Vic., cap. 26), continued sec. 28 of the Act of 1869 but cut down the time within which manufacture must be commenced from three years to two years, and the period for importation to twelve months.

Act of 1872,
sec. 28.

Sub-sec. 1 also provided, "that in case disputes should arise as to whether a patent has or has not become null and void under the provisions of this section, such disputes shall be settled by the Minister of Agriculture or his deputy, whose decision shall be final."

Sub-sec. 2 read:

"(s) Whenever a patentee has been unable to carry on the construction or manufacture of his invention within the two years hereinbefore mentioned, the Commissioner may grant to the patentee a further delay on his adducing proof to the satisfaction of the Commissioner that he was, for reasons beyond his control, prevented from complying with the same; but no such further delay shall thus be granted in any case in advance of the time hereinbefore prescribed."

By 38 Vic., cap. 14, sec. 2 (1875), sub-sec. 2 of sec. 28 Act 1875,
of the Act of 1872 was repealed and the following sub- c. 14, s. 2.
section substituted:

"2. Whenever a patentee has been unable to carry on the construction or manufacture of his invention within the two years hereinbefore mentioned, the Commissioner may at any time not more than three months before the expiration of that period, grant to the patentee a further delay on his adducing proof to the satisfaction of the Commissioner that he was, for reasons beyond his control, prevented from complying with the above-mentioned condition."

It will be observed that the new sub-section omitted the clause "but no such further delay shall be thus granted in any case in advance of the time hereinbefore prescribed."

By 45 Vic., cap. 22, sec. 1 (1882), sec. 28 of the Patent Act 1882,
Act of 1872 was amended by adding the following sub- c. 22, s. 1.
section:

"3. The Commissioner may grant to the patentee or his assignees for the whole or any part of the patent, an extension for a further period of time, not exceeding one year beyond the twelve months limited by the first paragraph of this section, during which he may import or cause to be imported into Canada the invention for which the patent is granted: Provided, that the patentee or his assignee or assignees for the whole or any part of the patent, shall show cause satisfactory to the Commissioner to warrant the granting of such extension; but no extension shall be granted unless application be made to the Commissioner at some time within three months before the expiry of the twelve months aforesaid or any extension thereof."

By this Act the Commissioner was for the first time authorized to extend the time for importation.

Revised
Statutes
1886, c. 61,
s. 37.

The Revised Statutes of 1886, cap. 61, consolidated sec. 28 of the Act of 1872, and the amendments in sec. 37. For the words "assignee or assignees" the words "legal representatives" were substituted. The words "or discovery" were struck out, leaving only the word "invention." Other changes were in wording merely and of no consequence.

Act 1890,
c. 13, s. 2.

By 53 Vic., cap. 13, sec. 2 (1890), sub-sec. 1 of sec. 37 was repealed. In the sub-section substituted, the words "or his assignee" were restored after the words "legal representatives" and the words "or any authorized extension of such period" were added after the words "twelve months from the granting of a patent" in the clause providing for forfeiture for importation.

The new sub-section omitted the clause giving exclusive jurisdiction to the Minister or the Deputy Minister to decide disputes as to avoidance for importation or non-manufacture, and substituted the following provision:

"and any difference which arises as to whether a patent has or has not become null and void under the provisions of this section may be adjudicated upon by the Exchequer Court of Canada, which court shall have jurisdiction, upon information in the name of the Attorney-General of Canada, and at the relation of any person interested, to decide any such question: Provided that this section shall not be held to take away or affect the jurisdiction which any court, other than the Exchequer Court of Canada, possesses."

Act 1891,
54, 55 Vic.,
c. 33, s. 1.

By 54-55 Vic., cap. 33, sec. 1 (1891), the sub-section substituted by 53 Vic., cap. 13, sec. 2, was amended by striking out the words "and at the relation of any person interested," and substituting therefor the words "or at the suit of any person interested."

Act of 1892,
55, 56 Vic.,
c. 24, s. 6.

By 55-56 Vic., cap. 24, sec. 6 (1892), sub-sec. 1 of sec. 37 as amended was repealed and a new sub-section substituted. A new arrangement of the section was made. The first section was with a few verbal differences, the same as the present sec. 38.

In paragraph (b) relating to importation, the words "or patentees, or any of them" were added after the word "patent" and the words "or his or their representatives, or his or their assignee" substituted for the words "or his legal representatives or his assignee" after the word "patentee."

The following clause appeared for the first time at the end of paragraph (b):

"as to the interest of the person or persons importing or causing to be imported as aforesaid."

In sub-sec. 2 of the new section, conferring jurisdiction on the Exchequer Court which is contained in sec. 45 of the present Act the word "question" was substituted for the word "difference," the words "or any interest therein" were added after the word "patent," the words "null and" were omitted before the word "void," and the words "to decide any such question" were inserted before the words "upon information in the name of the Attorney-General of Canada."

3 Edw. VII., cap. 46 (1903), was passed in consequence of the Supreme Court of Canada in *Power v. Griffin* (1902) 33 S.C.R. 39. This Act repealed sec. 37 as amended. What are now secs. 38, 39, 40, 41 and 45 appeared as secs. 4, 5, 6, 7 and 8 respectively. The provisions of what is now sec. 44 were entirely new with the Act.

Act 1903,
3 Edw. VII.,
c. 46.

Sec. 1 of this Act authorized the Deputy Commissioner, or in his absence, the Acting Deputy Minister of Agriculture to do any act which the Commissioner was authorized to do.

In consequence of the fact that the prevailing view as to the law on many points was decided to be wrong by *Power v. Griffin*, a number of sections were passed to preserve patents which had become void owing to this wrong interpretation of the Act. The present secs. 41, 42 and 43 were amongst these sections.

Sections
preserving
existing
patents.

In the United Kingdom, prior to the Patents Act, 1883, the patentee was under no obligation to work his patent and could import at will. Sec. 22 of that Act gave power to the Board of Trade under certain circumstances to grant licenses.

Provisions
as to work-
ing in Great
Britain.

Sec. 3 of the Patents Act, 1892, repealed sec. 22 of the Act of 1883, and extended the rights of the public in the matter of compulsory licenses.

The Patents and Designs Act, 1907, repealed the former Act, and still further extended the rights of the public. Under sec. 24 of the latter Act, any person may apply to the Board of Trade for a compulsory license, or in the alternative for the revocation of the patent on the ground that the reasonable requirements of the public have been satisfied. The Board of Trade, if a *prima facie* case has been made out, may refer the petition to the court, and the court may order that licenses be granted or if satisfied that the reasonable requirements of the public will not be satisfied by the grant of licenses may revoke the patent.

No order of revocation can be made before the expiration of three years from the date of the patent.

Under sec. 27 of this Act, the Comptroller may after four years from its date revoke any patent on the application of any person on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom, and not "to an adequate extent within the United Kingdom."

Subject to these provisions for compulsory licenses and revocation, there is no compulsion to work a patent as a condition of the grant. There is no restriction on importation.

No provisions as to working or importation in United States.

In the United States there are now no statutory provisions relative to working or importation. The Act of 1832 provided that patents might be granted to aliens on condition that they should cease and determine in case of failure to introduce the invention into public use in the United States within one year from the issue of the patent. This provision was, however, repealed by the Act of 1836.

Provisions as to working and importation in other countries.

In France there exist provisions very similar to those in the Canadian Act, both as to manufacture and importation. Obligations as to working are imposed in most other countries, amongst others in Argentine Republic, Austria, Belgium, Brazil, Denmark, Germany, Italy, Japan, Portugal, Russia, Spain, Sweden, Turkey, Uruguay, Venezuela. In India, where the requirements of the pub-

lic are not supplied, licences may be ordered. The Australian Statute is similar to the English.

Between 1872 and 1890, exclusive and final jurisdiction to decide whether a patent had become void for non-manufacture or importation, was placed in the Commissioner of Patents or his Deputy. Judicial opinion differs as to whether the functions discharged by the Commissioner were ministerial or judicial. (Smith v. Goldie [1883] 9 S.C.R. 40 at p. 46, Henry, J., p. 68. In re the Bell Telephone Company and the Telephone Manufacturing Company and the Minister of Agriculture [1885] 7 O.R. 339.)

Jurisdiction as to whether patent had become void for non-manufacture or importation, formerly in Commissioner of Patents.

The Commissioners and Deputies, however, seem for the most part to have acted on the view that their functions were ministerial, and that they were vested with a large discretion. In the case of Barter v. Smith (1877) 2 Ex. C.R. 455 at p. 481, Deputy Minister Tasche said: "The legislature has, certainly not without intention, provided for a kind of paternal tribunal, formed by the Commissioner of Patents, the natural proprietor of patentees, which intention can be no other than that every case should be adjudicated upon in a liberal manner."

Commissioners acted on belief that they had large discretion.

A number of the decisions rendered by the Commissioner or Deputy are reported in the second volume of the Canadian Exchequer Court Reports.

Decisions of Commissioner of doubtful value.

These decisions of the Patent Office are not binding on the courts. Nevertheless, after the change of jurisdiction, the courts followed them very closely for some years. In 1902, however, the case of Power v. Griffin (33 S.C.R. 39) reached the Supreme Court of Canada, and the decision rudely shattered prevailing views as to the interpretation of the sections we are now discussing. In this case, the Supreme Court intimated very clearly that it is the business of the courts to decide what the law is as expressed in the statutes, and not to speculate as to the probable intention of the legislature except so far as it can be found in the words of the Act. Since Power v. Griffin, the older cases must be used with great care.

Sec. 38 presents special difficulties in connection with patents for arts or processes, which will be dealt with

later. As to other patents some things are clear and others very uncertain.

Patentee must manufacture whether demand exists or not.

Power v. Griffin (1902) 33 S.C.R. 39, makes it quite clear that the patentee must manufacture his invention whether there is any demand for it or not. It was formerly thought and so decided that unless someone could show that he was unable to obtain the invention, the patent did not lapse. (*Barter v. Smith* [1877] 2 Ex. C.R. 455 at p. 481.)

It is now quite certain that unless the invention is manufactured, even if no one has wanted it, the patent becomes void.

Patentee need not manufacture personally and need do nothing to create demand.

The Patent Act does not require the patentee to manufacture personally (*Brook v. Broadhead* [1889] 2 Ex. C.R. 562). Neither is the patentee hound to do anything to create a demand or a market for the invention.

Patentee need not continue to manufacture provided he supplies facilities for supplying demand.

The requirement is that the patentee shall continue to manufacture so that anyone desiring to use the invention 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. The meaning of this requirement is far from clear. The result seems to be that the patentee is hound under *Power v. Griffin* (1902) 33 S.C.R. 39, to manufacture or cause to be manufactured the patented invention to some extent, but having actually manufactured it, is not hound to continue to manufacture. Apparently what is required is that the patentee shall furnish facilities for manufacturing. What these facilities shall be must depend on the nature of the invention. Where necessary a factory must be provided, but obviously, in many instances, a factory will not be necessary. It would seem that what is meant is that there must be somebody ready and able to supply the invention. It must be supplied at a reasonable price and we should think necessarily with a reasonable time. On these points, however, we have no decisions which can be relied upon.

The manufacture to satisfy the statute must be of that which is patented. It goes without saying that the statute is not complied with by the manufacture of something which so differs from the patented article that it is not an infringement of it (*Lomhard v. Alexander Dunhar & Sons Co.* [1910] 8 E. L.R. 261).

Nice questions arise as to what ingredients or parts of a patented article the patentee may import and still satisfy the requirements as to manufacture. There can be no doubt that if an article imported to be used by a patentee in the construction of his invention is a common commercial article which it is open to every person to manufacture, import, sell and use without infringing the patent it may be imported without rendering the patent void under paragraph (b) of sec. 38.

Patented invention must be wholly manufactured in Canada.

In the case of *Royal Electric Company of Canada v. The Edison Electric Light Co.* (1889) 2 Ex. C.R. 576, dealing with forfeiture for importation, Sir John Thompson, Minister of Justice, said:

"There is no express provision in the statute imposing the penalty of forfeiture for importing into Canada the various parts of the invention in respect of which the patent was granted, much less of importing one of its parts. The words of the statute are 'the invention for which the patent is granted' and they ought not to be extended beyond their plain meaning."

There is much doubt as to whether this view of Sir John Thompson is correct. But whether it is or not it does not follow that in satisfying paragraph (a) as to manufacture the patentee may use and import parts the importation of which will not cause forfeiture under paragraph (b). The object of paragraph (a) is to provide for the satisfying of the public demands by manufacture in Canada. It is submitted that the patented article must be wholly manufactured in Canada. It is suggested that nothing can be used which in the state it is imported is a part of the patented article. The test can not be whether that which has been imported would be an infringement. The test is whether there has been such work done on that which has been imported that it has ceased to be an article of general commerce, having no necessary relation to the patented invention, and has become something specially adapted for use in the patented invention so as to be identified as a part of it.

The patentee is not only bound to manufacture, he must also sell. This is now decided. He must transfer the absolute property in the patented article. He does not satisfy the requirements by being willing to lease. (Hil-

Patentee must sell.

dreth v. McCormick [1907] 10 Ex. C.R. 378, 39 S.C.R. 499.)

Sale must be without restrictions as to use.

It has been suggested that while the patentee is bound to sell and transfer the absolute property in the patented article, he may insist on imposing restrictions as to use at least as against parties other than the immediate purchaser. The point has perhaps not been actually decided except in the Exchequer Court, but it is the opinion of the writers that any person has a right to obtain the patented article for a price in money free from any condition or restriction as to use. (Royal Electric Co. v. Edison Electric Light Co. [1889] 2 Ex. C.R. 576; Copeland-Chatterson Co. v. Hatton [1906] 10 Ex. C.R. 224, 37 S.C.R. 651; Copeland-Chatterson Co. v. Lyman Bros. Co. [1907] 9 O.W.R. 908 at p. 912; Hildreth v. McCormick [1907] 10 Ex. C.R. 378, 39 S.C.R. 499.)

Onus on party attacking patent to show refusal to sell.

The onus is, however, on the person attacking a patent to show that there has been a refusal to sell at a reasonable price. It is doubtful whether it is sufficient to show that the patentee has asked an unreasonable price or attempted to impose conditions. (Auer Incandescent Light Mfg. Co. v. O'Brien [1897] 5 Ex. C.R. 243.)

Obligation to sell does not prevent agreement imposing conditions.

While the patentee must sell to any one who insists on obtaining an absolute title to the invention, it is nevertheless open to a patentee to enter into any agreement imposing conditions as to the use of the patented invention.

In the Copeland-Chatterson Co. v. Hatton (1906) 10 Ex. C.R. 224, 37 S.C.R. 651, a loose leaf hinder was sold on the condition that it was to be used only with sheets sold by the patentees. The purchaser used the hinder with sheets sold by other parties. It was held that the purchaser not only broke his contract but infringed the patent. It was also held that the parties who supplied the sheets knowing that they were to be used in connection with the patented invention, and induced the licensees to use them, also infringed. (See also Copeland-Chatterson Co. v. Lyman Bros. Co. [1907] 9 O.W.R. 908 at p. 912.)

Any restrictions must arise from agreement at time of sale.

Any such restrictions must be imposed at the time of sale, otherwise the law implies from a sale a license given, to sell or deal with the goods purchased as the purchaser pleases. The patentee can not impose a condition subsequent to the sale by delivery of the goods with a condition

endorsed upon them or upon the package upon which they are contained. (*Badische Anilin und Soda Fabrik v. Isler* [1906] 1 Ch. 605, Buckley, J., p. 611; *Gillette v. Rea* [1909] 1 O.W.R. 448; *National Phonograph Co. v. Menck* [1911] 28 R.P.C. 229.)

In *Gillette v. Rea* (1909) 1 O.W.N. 448, Boyd, C., expressed the opinion that *Hildreth v. McCormick* (1907) 10 Ex. C.R. 378, 39 S.C.R. 499, is fatal to any attempt to impose conditions as to price extending beyond the first purchaser. A condition as to price does not seem in any way different from any other condition in this regard, and it is submitted that it does not follow from *Hildreth v. McCormick* that conditions are not binding on third parties. *Hildreth v. McCormick* decided only that the patentee must sell and transfer the absolute property in the invention to any one who insists on such a sale. In this case *Idington, J.*, suggested that the patentee might on a sale of the article patented to comply with sec. 38 have the right to reserve in the event of re-sale of the article the use of the invention and "that a sale may not mean more than a property in the article plus the right to use it as long as the vendee from the patentee might retain it, absolutely, as to the material, qualified perhaps as to the quality of usefulness derived from the invention." This is a refinement that can not perhaps be relied upon. But there can be no doubt that if a purchaser from the patentee submits to conditions his rights are limited by his agreement and that the rights of such a purchaser and third parties dealing with him are not in any way affected by sec. 38. It was decided by the Chancellor in *Gillette v. Rea* that third parties purchasing the patented article are not bound by restrictions of which they do not know at the time of purchase. It was apparently the view of *Wills, J.*, in the *Incandescent Gas Light Company, Ltd. v. Cantelo* (1895) 12 R.P.C. 262, that under any circumstances "the sale of a patented article carries with it the right to use it in any way that the purchaser chooses to use it, unless he knows of restrictions." In the case of *Badische Anilin und Soda Fabrik v. Isler* (1906) 1 Ch. 605, however, Buckley, J., expressed the opinion that there is no such general rule of law and that upon principle "nothing (so far as license as distinguished

Restrictions probably extend to third parties.

from estoppel is concerned) can turn on the question whether the purchaser from the licensee knew of the condition or not." He thought that a third person could only be freed from the condition by the patentee being estopped from setting up his rights. In any event it is submitted that there is no doubt that if third parties know of the restrictions they are bound by them. The patentee cannot then be estopped, and the third parties can get no rights to the use of the patented article except those which the person from whom they purchase can give. (*Incandescent Gas Light Co, Ltd. v. Cantelo* [1895] 12 R.P.C. 262, *Wills, J.*; *Incandescent Gas Light Co., Ltd. v. Brogden* [1899] 16 R.P.C. 179; *Badische Anilin und Soda Fabrik v. Isler* [1906] 1 Ch. 605; *National Phonograph Company of Australia, Ltd. v. Menck* [1911] 28 R.P.C. 229.)

Reasonable price undefined.

There are no Canadian decisions as to what is meant by a "reasonable price." The price must depend on the nature of the invention and it is almost impossible to suggest any general rules.

Three views as to application of working clause to patents for processes.

Does paragraph (a) of sec. 38 apply to patents on an art or process? This is a question which has not yet been decided.

Three views have been advanced as to process patents:

1. That the section has no application.
2. That the patentee is obliged to work the patent so that anyone may obtain the product resulting from the operation of the process for a reasonable price.
3. That the patentee must allow the process to be used by anyone for a reasonable price—in other words, that he must grant licenses.

The section says that "every patent" shall be subject to the condition. It would seem therefore that the intention may have been to include process patents within its operation. One object of the section is to encourage and protect Canadian labour and industry. It has therefore been argued that inasmuch as a process is an intangible thing which can not be manufactured, no question of Canadian labour or industry can arise and the legislature never intended that a process patent should be subject to the condition. It must be observed, however, that another object of the Act is to limit the monopoly of the

patentee so that he may obtain a revenue from his invention, but shall not prevent the public from obtaining the use of it. To hold that a process patent is not subject to the section is to give the patentee an absolute monopoly in his invention with the right to work it or not as he sees fit, and the right to prevent any other person from using it upon any terms.

In *Hamhly v. Wilson* (1902) 7 Ex. C.R. 363 at p. 386, Burhidge, J., used the following language: "Now this provision presents the difficulty that the language used is not apt or appropriate where the invention is an art or process, as it may be. One does not construct or manufacture a process and no one can obtain a process or cause it to be made for him at a manufactory or establishment. In the present case the phosphorus made by the process for which the patent issued is the same as that made chemically. The invention is useful because phosphorus may be made more cheaply in the way discovered by the patentee. The only advantage that can possibly accrue to the people of Canada, for the grant given is that during its existence they may get phosphorus cheaper than they otherwise would, and that after the grant has terminated the invention may be free to all. The only way that advantage could be secured in the present case without allowing the importation of phosphorus made in accordance with the process protected by the patent, would be to impose upon the patentee or his assignees, the obligation to make it, or cause it to be made in Canada, according to that process, so that anyone desiring to do so could obtain it at a reasonable price. But as stated there is the difficulty, and it is a real one, that Parliament has not so provided in apt and clear terms."

This is the only case in which the question is discussed at any length. This case can scarcely be said to decide that the section applies to a process, but only that if it does then there is no forfeiture unless it is shown that someone has been refused the use of the process for a reasonable price. Moreover the cases cited by the learned Judge held that no patentee is bound to manufacture unless there is a demand, and the fact that the Supreme Court in *Power v. Griffin* overruled these cases,

notwithstanding a further re-enactment of this section, detracts greatly from any value there might otherwise be in the decision.

The view that the patentee is obliged to furnish the product of a process does not seem tenable. The Act speaks only of the invention and the product is not the invention. To read the Act in this way would be to read something into it which is not there.

The third suggested interpretation that licenses must be granted, obtains some support from the words of MacLennan, J., in *Hildreth v. McCormick* (1907) 39 S.C.R. 499, (10 E.C.R. 378,) at p. 505, where he said:

"Mr. Cassels asked how the sections could upon that construction be made to apply to a patent for a process. I see no difficulty even in that case, for even there the person desiring to use the invention is entitled to acquire it absolutely, and not merely to take a lease of it."

The section can, however, not be applied to process patents without straining the language used, and the opinion of the writers is that the courts will not feel called upon to hold that the section applies where the language used is entirely inapt, no matter what may have been the intention of the legislature.

Failure to manufacture on part of exclusive licensees or assignees for districts may imperil the patent.

Paragraph (b), relating to importation, provides that importation shall render the patent void only as to the interest of the person or persons so importing or causing to be imported. The patentee is therefore protected against the acts of his licensees or assignees for districts. Paragraph (a) does not protect the patentee against failure of others holding under him to manufacture. The patentee must bear this in mind when granting exclusive licenses or assignments for districts.

Importation.

Importation of the patented invention is permitted for one year from the date of the grant. If there is importation of the invention after one year the patent becomes void as to the interest of the person importing or causing to be imported.

There are more decisions on the question of importation than on manufacture, but they are equally unsatisfactory and unreliable.

Whether importation displaces

As has been stated, in many cases the object of the legislature in prohibiting importation after a given time

was to protect the industrial interest of Canada. In many of the decisions it has therefore been considered of importance whether the result of the importation has been to displace or injure Canadian labour or industry. In Canadian labour probably probably immaterial.

While the case of *Power v. Griffin* (1902) 33 S.C.R. 39, did not deal with importation, the attitude of the Supreme Court in that decision does not lend any support to decisions based on this consideration. The Act does not say anything about Canadian labour or industry, and anyone reading the judgments of the Supreme Court in *Power v. Griffin* must come to the conclusion that this court would not enter very far into the intention of the statute. The question for decision is what the statute says. It says in terms that are unqualified that importation renders the patent void.

If our view of the inferences which must be drawn from *Power v. Griffin* and the few later cases which have been decided is correct, most of the early cases are very unreliable. Nevertheless, those which have been decided by courts are binding till overruled by a higher court, and it is of some interest to know what the law is, even if it is bad law.

In *Barter v. Smith* (1877) 2 Ex. C.R. 455, it was decided by Tasché, Deputy Minister of Agriculture, that where the importation was inconsiderable and inflicted no injury of any account on Canadian manufacture, the patent was not rendered void. This decision was followed by Burhidge, J., in the *Anderson Tire Company of Toronto v. American Dunlop Tire Company* (1896) 5 Ex. C.R. 82. A similar view was also expressed by Pagnuelo, J., in *Consolidated Car Heating Company v. Came*, (1900) Q. R. 18 S.C. 44. The latter case went to the Privy Council, but this point was not discussed in any of the higher courts. Cases holding that importation which does not inflict injury on Canadian manufacture does not render a patent void are probably bad law.

It was also decided in *The Royal Electric Company of Canada v. The Edison Electric Light Co.* (1889) 2 Ex. C.R. 576, by Sir John Carling, Minister of Agriculture, in accordance with an opinion delivered by Sir John Thompson, that the importation of several lamps covered by a patent which "were never sold in Canada, nor offered for sale, nor intended to be sold, but were merely intended to be used as samples or models of the article

which it was intended should be manufactured in Canada" did not avoid the patent.

It is thought that these decisions can not be relied on. It is submitted that they can not be sustained on the ground that the importations were not within the Act because no injury was done to Canadian labour. The section provides for no exceptions.

What ingredients of invention may be imported.

The most important question in connection with the section is what ingredients of an invention may be imported.

In the case of the Royal Electric Co. of Canada v. The Edison Electric Light Co. (1889) 2 Ex. C.R. 576, referred to above, Sir John Thompson expressed the opinion that if an article imported to be used by the patentee in the construction of his invention is a common commercial article which it is open to every person to manufacture, import, sell or use without infringing the patent in question, it may be imported.

In Mitchell v. Hancock Inspirator Company (1886) 2 Ex. C.R. 539, the invention was for a new combination of known elements. Tasché, Deputy Minister of Agriculture, decided that the importation of the elements made use of in the mechanism in question as constituents of the combination secured by the patent and to be used as such was importation of the patented article.

This case was considered by Sir John Thompson in Royal Electric Company of Canada v. The Edison Electric Light Co. of Canada (1889) 2 Ex. C.R. 576, and he there stated that he would have great difficulty in advising that it was correctly decided, or that it should be followed. Both the decision and the language of Sir John Thompson go very far. He there said, p. 597:

"I do not find anywhere that the statute expressly imposes the penalty of forfeiture for importing into Canada the various parts of the invention for which the patent was granted, much less for importing one of the parts. The words of the statute are, 'the invention for which the patent is granted' and it does not seem that the Minister or his Deputy in administering the law, can enlarge the statute or add any words to it, even in trying to prevent an invasion of the statute. In considering and administering such a statute

the Minister or his Deputy can only apply the penalty to the offence which the statute forbids. He cannot apply it to an attempt to evade the statute." One of the articles imported was a filament apparatus apparently made for the sole purpose of going into the patented lamp, but it was decided that there was no importation within the meaning of the section.

The decision of Sir John Thompson, Minister of Justice, is entitled to the greatest consideration. It is however not binding on a court of law, and the question is therefore open. Sir John Thompson was of the opinion that "a fair test of the patentee's ability to freely import any article required in the construction of his invention, is to ascertain if it is open to every person in Canada to manufacture, import, sell and use the same without thereby infringing the patent in question. If the article is thus part of the public domain the patentee is at liberty to import it or to purchase it in Canada for the purpose of such construction."

Test suggested by Sir John Thompson.

Even if this test be accepted, it must be applied with great care.

In *United Telephone Company v. Dale* (1884) 25 Ch. D. 778 at p. 782, Mr. Justice Pearson made the following observation in the course of the argument: "If there was a patent for a knife of a particular construction and an injunction was granted restraining a defendant from selling knives according to the patent, and he was to sell the component parts, so that any school-boy could put them together and construct the knife, surely that sale would be a breach of the injunction." This statement was discussed in *Dunlop Pneumatic Tyre Company v. Moseley* (1904) 21 R.P.C. 274. Vaughan Williams, L.J., at p. 280 said, "I have not to determine whether that observation is right or not. I only wish to say that, as far as I am concerned, I see no reasons for saying that it is wrong, and there is nothing in my judgment to-day which is intended to be inconsistent with it. If you are in substance selling the whole of the patented machine, I do not think you save yourself from infringement because you sell it in parts which are so manufactured as to be adapted to put together."



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It would seem therefore that all the parts of an invention can not be imported according to this test if these parts can be put together without difficulty or considerable labour.

It must also be borne in mind that a patent may contain a number of claims, some of which may be on separate parts. The patent may be infringed by infringing any one claim (*Gillett v. Wilky* [1839] 9 C. & P. 336, 1 Weh. P.C. 270 at p. 276). According to the proposed test a patent will be void if any part is imported on which there is a separate claim.

Test of Sir
John
Thompson
open to
question.

But whether the test is satisfactory in regard to importation of parts which are not covered by a separate claim or of the whole invention in a partially manufactured state is perhaps open to some doubt. Infringement by manufacture and sale of parts was discussed by the Court of Appeal in England in *Dunlop Pneumatic Tyre Company Ltd. et al. v. Moseley* (1904) 21 R.P.C. 274, and the authorities fully reviewed. The defendants in this case made covers with a lining suitable for the insertion of wires adapted for use in the manner employed by the patentee but not necessarily for use in that manner. It was alleged that the sales were made to persons who the defendants must have known intended to infringe the patent. It was held by the Court of Appeal confirming the judgment of Swinfen-Eady, J., that the defendants did not infringe. Vaughan Williams, L.J., further said, "I wish to say that, in my judgment this case would fail even though the plaintiffs were able to substantiate the proposition which the learned Judge finds against them, that these covers, as manufactured and sold by these defendants could not be used for any other purpose than fitting them into the plaintiff's tyres under one or other of the patents." This opinion, however, goes beyond the actual decision and is therefore not binding.

The reasons for this decision were stated by Vaughan Williams, L.J., as follows, p. 280: "Then Lord Justice Mellish said: 'I am of the same opinion. I think it is quite clear that at law the defendant would be entitled to a verdict on a plea of not guilty. Selling materials for the purpose of infringing a patent to the man who is to infringe it, even although the party who sells it knows that he is

going to infringe it, and indemnifies him, does not by itself make the person who so sells an infringer. He must be a party with the man who so infringes, and actually infringe.' Now I put that view to Mr. Terrell and to Mr. Russell in the course of the argument. I say that in form, what they are complaining of here is an infringement; but when they come to the proof of that of which they are complaining, infringement, they do not prove that the defendants are parties with anyone who has infringed, and they do not prove that the defendants have actually infringed. Of course if the defendants were parties to an infringement, in such sense as that they would be principals, if infringement were an offence which would be indictable as a criminal offence, they would be equally responsible in this civil action."

It follows from this reasoning that where parts are made as an agent for the person who uses them in making something which is an infringement the agent infringes. (Sykes v. Howarth [1879] L.R. 12 Ch.D. 826.) So too if there be an agreement between two parties that each will make parts and these parts together form the invention each being a party to the acts of the other will infringe. (Incandescent Gas Light Co. v. New Incandescent Gas Mantle Co. [1897] 15 R.P.C. 83.)

The whole point as to infringement according to the English law is that nothing infringes except what is substantially the patented invention. The manufacturer of a part does not make the invention. What he makes is not even a part of the invention but something which has no relation to it except where he is a party with the person who assembles the parts and produces the whole invention. His intention in itself makes no difference.

The infringement test as applied to importation rests on the assumption that the patentee may do what anyone else may do. This seems a reasonable assumption but it must be borne in mind that the prohibition against importation is directed only against the patentee and those claiming through him. Undoubtedly the question must be whether that which is imported is the invention. Our doubts as to the sufficiency of the infringement test arise, however, from the fact that the patentee importing must

always be a party with himself in assembling and producing the finished invention. He can not get away from the fact that if what he imports is something made for use in his invention, more especially where it is not in a form capable of use in any other way, it is part of the invention. We doubt very much if it will be sufficient to show that what is imported is not the whole invention but only a fractional part of the whole in a condition of only partial completion.

The writers are therefore of the opinion that until we have a decision by the courts a patentee should not import anything on which labour has been done to peculiarly adapt it to use in the invention.

Question whether importation of product made under patented process is importation of invention.

It has been held by Burhidge, J., in two cases that importation of an article made in accordance with a patented process renders the patent void (*Auer Light Manufacturing Company v. O'Brien* [1897] 5 Ex. C.R. 243; *Hamhly v. Wilson* [1902] 7 Ex. C.R. 363). This opinion is based on *Elmslie v. Boursier* (1869) L.R. 9, Eq. 217, and similar cases where it has been held that a person who sells an imported product is indirectly making, using and putting in practice the patented invention. It is difficult to see how these cases have any application. How can there be any indirect importation of the patented invention?

Importation renders patent void only as to interest of person importing.

Importation only renders the patent void as to the interest of the person or persons so importing or causing to be imported. Where there are joint owners it would therefore seem that importation by one does not enlarge the rights of the public. The person importing can not restrain others from infringing because he has no longer any exclusive right. But the co-owner still has all the rights he formerly had as against the public.

Importation by a licensee does not render the patent void as to the interest of the owner. (*Hamhly v. Wilson* [1902] 7 Ex. 363.)

But where there is connivance on the part of a person owning an interest in a patent, this will be equivalent to importation by the person conniving (*Toronto Telephone Manufacturing Co. v. Bell Telephone Co.* [1885] 2 Ex. C.R. 495 at p. 524).

Under sec. 39 the Commissioner may grant an extension of time to manufacture beyond the two years. Under sec. 40 an extension may be made of the time for importation.

Extension of time to manufacture or import.

The application for an extension of time must be made by petition presented within three months before the expiry of the time limited, setting out the grounds for the application. The petition must be verified by declaration under the Canada Evidence Act where the proof is made in Canada or by affidavit if made elsewhere.

Petition must be presented within three months before expiry of time.

Under sec. 39 the Commissioner has power to grant an extension before the expiration of the two years only. Under sec. 40 the grant may be made after the expiration of the year allowed for importation, provided the application has been made before the year allowed for importation expires.

Extension of time to manufacture must be granted before time limited, extension to import may be made afterwards.

Extensions for manufacture are only warranted where failure has arisen from reasons beyond the control of the patentee. Prolonged illness has been held a ground for an extension. Extensions have also been granted where efforts have been made to manufacture by erecting a plant or in some other way, and there has been an honest failure.

Grounds for extension.

Importation beyond the period is only allowed in very exceptional cases, usually for the purpose only of demonstrating the utility of the invention.

Power v. Griffin (1902) 33 S.C.R. 39, decided that the Commissioner is *functus officio* after one extension, and can not grant any further extensions. This also cast some doubt on the power of the Deputy Commissioner to grant extensions. Sec. 5, sub-sec. 2, reads:

"2. The Deputy Commissioner may do any act or thing, whether judicial or ministerial, which the Commissioner of Patents is authorized or empowered to do by any provision of this Act; and in the absence of the Deputy Commissioner, any person performing the duties of the Deputy Minister of Agriculture under the authority of the Civil Service Act may, as acting Deputy Commissioner, do any such act or thing."

Sections 41, 42 and 43. Secs. 41, 42 and 43 were passed in 1903 after Power v. Griffin, to protect patentees against results of the erroneous view of the law prevailing prior to that decision.

COMPULSORY LICENSES.

Section 44. Sec. 44 was passed in 1903 after Power v. Griffin had decided that every patented invention must be manufactured whether there is any demand for it or not.

There is no reason why every patent which can be placed under this section should not be brought under it.

An invention subject to this section does not become void for failure to satisfy the requirements of the public. Licenses may be ordered. Compulsory licenses, however, may only be ordered under circumstances which would render void the patent if it were not under this section, and the patentee is therefore never any worse off than if subject to sec. 38, paragraph (a).

Patents which may be placed under section 44.

The Department will place the following inventions under sec. 44:

Patents for an art or process; improvements on a patented invention where both patents are not held by the same person; appliances or apparatus used in connection with railways, telegraph, telephone and lighting systems, and other works usually under the control of public or large private corporations and which can not be installed without the consent of such corporations, and inventions which are manufactured or constructed only to order and are not according to custom, carried in stock.

Petition to place patent under section 44.

Application to have a patent placed under sec. 44 should be made by petition signed by the applicant, setting out the grounds on which the application is based. The petition may accompany the application for patent but must be presented within six months after the date of the patent.

Up to the present time no compulsory licenses have been granted.

The following rules in respect to petitions for compulsory licenses were approved by the Governor-General in Council on February 23rd, 1904:

PETITION FOR GRANT OF COMPULSORY LICENSE.

"25. A petition to the Commissioner for an order for a license under sec. 44, paragraph (a), of the Act, shall show clearly the ground or grounds upon which the petitioner claims to be entitled to a license, and shall state in detail the circumstances of the case, the terms upon which he asks that an order may be made, the purpose of such order, and the name and address of the patentee and of any other person who is alleged in the petition to have made default."

TO BE LEFT WITH EVIDENCE AT A PATENT OFFICE.

"26. The petition and an examined copy thereof shall be left at the Patent Office, accompanied by affidavits or statutory declarations in proof of the allegations contained in the petition, together with any other documentary evidence in support; and petitioner shall, within ten days after the leaving of such petition, deliver to the patentee and any other person who is alleged in the petition to have made default, copies of the petition and of such affidavits or statutory declarations and other documentary evidence in support."

OPPOSANTS' OPPOSITIONS AND EVIDENCE.

"27. The persons to whom such copies are delivered by the petitioner may, within ten days after being invited to do so by the Commissioner, leave at the Patent Office their oppositions to such petition, together with their affidavits or statutory declarations or other documentary evidence in support, in answer, and if they do so, shall deliver copies thereof to the petitioner within ten days, and the petitioner may within ten days from such last mentioned delivery leave at the Patent Office his affidavits or statutory declarations and other documentary evidence in reply; and if he does so, shall deliver copies thereof to the patentee or any other person alleged in the petition to have made default within ten days, such last mentioned affidavits or statutory declarations being confined to matters strictly in reply."

CLOSING OF EVIDENCE.

"28. No further evidence than as aforesaid may be left by either side at the Patent Office, except by leave or on requisition of the Commissioner, and upon such terms, if any, as he may think fit."

OTHER PARTIES INTERESTED MAY BE ALLOWED TO INTERVENE.

"29. The Commissioner may at any stage of the proceedings before granting his order, give notice of the proceedings, and furnish copies thereof to any person not a party thereto who may be interested in the patent and whose rights may be affected by his order, and may allow such person to intervene in the proceedings. After such person has been allowed to intervene, he shall be governed by these rules as though the petitioner had alleged in his petition that such person was in default."

HEARING OF THE PETITION.

"30. On completion of the evidence, or after the expiration of the time for completing the same, the Commissioner, on the request of the petitioner, shall fix a time for hearing the petition, and shall give notice to the petitioner, the patentee, and all other parties to the proceedings, that it is his intention to hear the petition on a specified day, which day shall not be less than two weeks from the date when the notice is served."

DOCUMENTS TO BE TYPEWRITTEN OR PRINTED.

"31. All petitions lodged at the Patent Office shall (unless the Commissioner otherwise direct) be typewritten or printed, and the parties shall furnish as many copies of the documents lodged by them as shall be required by the Commissioner."

COPIES OF PAPERS AND ADDRESSES OF PARTIES.

"32. Parties shall be entitled to have copies of all the papers lodged in respect to the petition, at their own expense. The petitioner and each of the other parties shall specify an address for service in Canada, and may be heard in person or by counsel or by a duly authorized agent."

COUNSEL ON BEHALF OF CROWN.

"33. The Commissioner shall, if so requested, hear counsel on behalf of the Crown on the question of granting the prayer of any petition. Counsel on behalf of the Crown shall not be 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 Commissioner."

SERVICE OF NOTICE.

"34. Any notice required to be served or given by the rules relating to compulsory license may be served or given by posting the same to the party to be notified in a registered envelope, and documents required to be delivered may be delivered in the same way."

ALTERATIONS OR ENLARGEMENTS OF TIMES PRESCRIBED
BY RULES.

"35. The times prescribed by these rules may be altered or enlarged by the Commissioner if he thinks fit, upon such notice to parties interested and upon such terms, if any, as he may direct."

CHAPTER XII.

CAVEATS.

Sec. 46 of the Patent Act reads:

Section 46 of
the Patent
Act.

"46. Any intending applicant for a patent who has not yet perfected his invention and is in fear of being despoiled of his idea, may file, in the Patent Office, a description of his invention so far as it has proceeded, with or without plans, at his own will; and the Commissioner, on payment of the fee in this Act prescribed, shall cause the said document, which shall be called a Caveat, to be preserved in secrecy, with the exception of delivering copies of the same whenever required by the said applicant or by any judicial tribunal, but the secrecy of the document shall cease when the applicant obtains a patent for his invention.

"2. If application is made by any other person for a patent for any invention with which such Caveat may, in any respect, interfere, the Commissioner shall forthwith give notice by mail, of such application, to the person who has filed such Caveat, and such person shall, within three months after the date of mailing the notice, if he wishes to avail himself of the Caveat, file his petition and take the other steps necessary on an application for a patent, and if, in the opinion of the Commissioner, the applications are conflicting, like proceedings may be had in all respects as are by this Act provided in the case of conflicting applications.

"(3) Unless the person filing a Caveat makes application within one year from the filing thereof for a patent, the Commissioner shall be relieved from the obliga-

tion of giving notice, and the Caveat shall then remain as a simple matter of proof as to novelty or priority of invention, if required."

The provisions as to caveats follow in a general way, Cf. U.S.A. sec. 27 the United States Act of 1836. Caveats were Act of 1836. abolished in the United States in 1910.

When a caveat has been filed, notice of any subsequent application covering the same subject matter is sent to the caveator, and action is suspended on such application for three months to give the caveator an opportunity to file an application for what he has covered by his caveat. If the caveator files an application and it is decided that it conflicts with that of the other applicant, the question as to who is entitled to the patent is referred to three arbitrators as provided by sec. 20 of the Patent Act. Proceedings when conflicting application filed.

A caveat serves two purposes. Its first use is to prevent the issue of a patent to another inventor for a similar invention without the caveator having an opportunity to establish that he was the first inventor. (Phelps v. Brown [1859] 17 Ho. 7; Allen v. Hunter [1855] 6 McLean 303; Bell v. Daniels [1858] 1 Fisher 372 at p. 375.) Secondly, it constitutes evidence of the state of development of the invention at the date of filing and may afford evidence of invention at least as early as the filing of the caveat. (Johnson v. Root [1858] 2 Fisher 291; Jones v. Wetherell [1855] McArthur's Patent Cases 4.) Purposes served by a caveat.

The value of a caveat must not, however, be over-estimated. It does not in any way effect the right to the patent. The only person who can obtain a valid patent is the person who the world over is the first inventor. (Smith v. Goldie [1883] 9 S.C.R. 46; Barnet McQueen v. Canadian Stewart [1910] 13 Ex. C.R. 186.)

A caveat is not entitled to notice of an application already pending in the Patent Office at the time he files his patent.

A caveat cannot be renewed. A second caveat is, Renewal. however, frequently filed for the same invention on the expiration of the first.

Omission to consider a caveat does not invalidate a patent granted to another as the result of the oversight. (Cochrane v. Waterman [1844] 1 McArthur's Patent Cases 59).

Formal documents required.

The formal documents for filing a caveat comprise a specification signed by the inventor, and an affidavit to the effect that he is the inventor of the invention described. The government fee is five dollars.

An assignment of the invention set out in a caveat will not be accepted by the Patent Office. The Patent Office refuses to file assignments of inventions until there has been an application made for a patent.

CHAPTER XIII.

SEC. 54— ARTICLES MADE OR USED PRIOR TO THE ISSUING OF A PATENT.

Sec. 54 of the Patent Act reads:

"Every person who, before the issuing of a patent, has purchased, constructed or acquired any invention for which a patent is afterwards obtained under this Act, shall have the right of using and vending to others the specific article, machine, manufacture or composition of matter patented and so purchased, constructed or acquired before the issue of the patent therefor, without being liable to the patentee or his legal representatives for so doing; but the patent shall not, as regards other persons, be held invalid by reason of such purchase, construction or acquisition or use of the invention by the person first aforesaid or by those to whom he has sold the same, unless the same was purchased, constructed, acquired or used, with the consent or allowance of the inventor thereof, for a longer period than one year before the application for a patent therefor, thereby making the invention one which has become public and in public use."

This section comes to us through the Patent Act, 12 Vic., chap. 24, sec. 12 (1849) and is founded upon sec. 7 of the American Patent Act of 1839.

Osler, J.A., points out in *Victor v. H. A. Wilson Co.* (1904) 7 O.L.R. 570 at p. 577, that "The two clauses of the section are, however, entirely distinct and the questions involved therein quite different, as Blatchford, J., points out in *Andrews v. Hovey*, 124 U.S. 694 at p. 702, 'The first clause relates to the particular right of a particular person to use a particular machine, manufacture or composition of matter after the grant of the patent, and notwithstanding its grant, and in no manner relates to the

Two clauses relate to different questions.

validity or invalidity of the patent. The second clause relates wholly to the validity of the patent.'"

No right given to continue manufacture after the patent, unless by implication under section 8.

Anyone has the right up to the date of a Canadian patent, notwithstanding the existence of a foreign patent, notice of intention to apply, or of actual application for a Canadian patent, to manufacture the invention afterwards patented. This right is recognized by sec. 8. Sec. 54 gives no right to continue manufacture after the patent issues. The right given by sec. 54 merely relates to the use and sale of the specific articles in existence at the date of the patent (*Victor v. H. A. Wilson Co.* [1904] 7 O.L.R. 570 at p. 576; *Fowell v. Chown* [1894] 25 O.R. 71 Aff'd., 22 O.A.R. 268). Where a foreign patent is taken out and no notice of intention to apply for a Canadian patent is given within three months, it is open to argument that by implication sub-sec. 2 of sec. 8 gives to anyone who commences to manufacture after the foreign patent issues, and before the Canadian patent is applied for, the right to continue to manufacture after the Canadian patent issues. Whether the courts will hold this to follow from the sub-section is however very doubtful.

Right to sell or use article made prior to patent does not depend on making having been with consent of patentee.

The right of the person who has constructed the invention prior to the issue of the patent, to use and vend the specific article or machine so constructed without being liable to the patentee for so doing, does not depend upon his having so constructed it with the consent or license of the inventor.

Section 54 does not relate to processes.

Sec. 54 does not mention an art. It, therefore, gives no right to continue the use of a process after the patent issues.

Breach of faith or confidence.

The courts have in certain cases restrained persons from using or selling an invention where the use or sale amounts to a violation of a stipulation as to secrecy, or a breach of faith or confidence. (*Lean v. Huston* [1884] 8 O.R. 521; *Hessing v. Coppin* [1874] 21 Gr. 253; *Morrison v. Moat*, 9 Hare 241.) Sec. 54 does not protect a wrongdoer. Where a case of this kind can not be made out, although his conduct may be dishonourable, anyone making an invention prior to the issue of the patent, may use and sell it (*Victor v. H. A. Wilson Co.* [1904] 7 O.L.R. 570 at p. 576).

CHAPTER XIV.

MARKING PATENTED ARTICLES.

Section 55 of the Patent Act reads:

"55. Every patentee under this Act shall stamp or engrave on each patented article sold or offered for sale by him the year of the date of the patent applying to such article, thus: 'PATENTED, 1906,' or as the case may be; or when, from the nature of the article, this cannot be done, then by affixing to it, or to every package wherein one or more of such articles is or are enclosed, a label marked with a like notice." Section 55 of Patent Act.

This section appeared in the Act of 1869, and is similar in form to sec. 4900, U.S. Revised Statutes. The purpose is to notify the public that the invention is patented.

The words "patent applied for" or "patent pending" frequently seen on articles for which patent applications have been made but not granted have no legal significance or effect. (Victor v. H. A. Wilson Co. [1904] 7 O.L.R. 570 at p. 576.) "Patent applied for."

Secs. 64 and 65 of the Patent Act, providing a penalty for failure to mark or for falsely marking, read: Sections 64-65 of Patent Act.

"64. Any patentee under this Act who sells or offers for sale any article patented under this Act not stamped or engraved with the year of the patent, applying to such article, or when from the nature of the article this cannot be done, not having affixed to it or every package wherein one or more of such articles is or are enclosed, a label marked with the year of the date of the

patent applying to such article in manner and form provided by this Act, shall be liable to a penalty not exceeding one hundred dollars, and, in default of the payment of such penalty, to imprisonment for a term not exceeding two months.

"65. Every person who:

"(a) writes, paints, prints, moulds, casts, carves, engraves, stamps or otherwise marks upon anything made or sold by him, and for the sole making or selling of which he is not the patentee, the name or any imitation of the name of any patentee for the sole making or selling of such thing, without the consent of such patentee; or,

"(b) without the consent of the patentee, writes, paints, prints, moulds, casts, carves, engraves, stamps or otherwise marks upon anything not purchased from the patentee, the words, *Patent*, *Letters Patent*, *King's*, or, *Queen's Patent*, *Patented*, or any word or words of like import, with the intent of counterfeiting or imitating the stamp, mark, or device of the patentee, or of deceiving the public and inducing them to believe that the thing in question was made or sold by or with the consent of the patentee or his legal representatives; or,

"(c) offers for sale as patented any article not patented in Canada, for the purpose of deceiving the public;

"is guilty of an indictable offence, and liable to a fine not exceeding two hundred dollars, or to imprisonment for a term not exceeding three months, or to both."

Does not
affect right
to recover
damages.

It will be seen that the failure to mark does not affect the right to recover damages for infringement as it does in the United States, but instead leaves the patentee liable to the penalty of a fine not exceeding one hundred dollars, or to imprisonment for two months in default of payment of the fine.

It is not illegal to manufacture and sell an article in this country which has been patented in the United States, and put upon it a statement that it is so patented, as a recommendation of it, so long as there is no infringement of a valid existing patent in this country. (Kidder et al. v. Smart et al. [1885] 8 O.R. 362.)

The stamping of the date of the patent on articles sold or offered for sale does not amount *per se* to a license to use the invention. (Smith v. Mitchmore [1849] 10 U.C.C.P. 391.)

CHAPTER XV.

INFRINGEMENT.

Sec. 21 of the Patent Act reads:

Section 21 provides for grant of exclusive right.

"21. Every patent granted under this Act shall contain the title or name of the invention, with a reference to the specification, and shall grant to the patentee and his legal representatives, for the term therein mentioned, from the granting of the same, the exclusive right, privilege and liberty of making, constructing and using, and vending to others to be used, the said invention, subject to adjudication in respect thereof before any court of competent jurisdiction.

"2. In cases of joint applications, the patents shall be granted in the names of all the applicants."

The operative part of the Canadian patent form reads:

Patent grants exclusive right.

"Now therefore the present patent grants to the said. . . his executors, administrators, legal representatives and assigns for the period of eighteen years from the date of these presents the exclusive right, privilege and liberty of making, constructing and using, and vending to others to be used, in the Dominion of Canada, the said invention, subject nevertheless to adjudication before any court of competent jurisdiction."

British patent contains prohibition.

The British patent in addition to giving the patentee the exclusive right to "make, use, exercise and vend" his invention, commands all persons that they do not "make use of or put in practice the invention" nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom whereby to pretend themselves the inventors thereof" without the license of the patentee.

The Canadian patent contains no similar prohibition. The rights of the Canadian patentee depend on the *exclusive* grant to him and on the provisions of the Act.

The following sections of the Patent Act deal with infringement and actions for infringement:

"31. Any action for the infringement of a patent may be brought in the court of record having jurisdiction, to the amount of the damages claimed, in the province in which the infringement is alleged to have taken place, which holds its sittings nearest to the place of residence or of business of the defendant; and such court shall decide the case and determine as to costs.

Canadian patent contains no similar provision.

"32. In any action for the infringement of a patent, the court, or any judge thereof, may, on the application of the plaintiff, or defendant, respectively, make such order as the court or judge sees fit,

Sections dealing with infringement.

"(a) restraining or for an injunction restraining the opposite party from further use, manufacture or sale of the subject-matter of the patent, and for his punishment in the event of disobedience of such order; or,

"(b) for and respecting inspection or account; and,

"(c) generally respecting the proceedings in the action.

"2. An appeal shall lie from any such order under the same circumstances, and to the same court, as from other judgments or orders of the court in which the order is made.

"33. Whenever the plaintiff, in any such action, fails to sustain the same, because his specification and claim embrace more than that of which he was the first inventor, and it appears that the defendant used or infringed any part of the invention justly and truly specified and claimed as new, the court may discriminate, and the judgment may be rendered accordingly.

"34. The defendant, in any such action, may plead as matter of defence, any fact or default which, by this Act, or by law, renders the patent void; and the court shall

take cognizance of such pleading and of the facts connected therewith, and shall decide the case accordingly."

Law as to infringement same in Canada as in England.

It is believed that the law as to infringement is substantially the same in Canada as in England. (*Electric Fireproofing Co. of Canada v. Electric Fireproofing Co.* [1910] 43 S.C.R. 182 at p. 193, Q.R. 31 S.C. 34; *The Barnett McQueen Co. v. The Canadian Stewart Co.* [1910] 13 Ex. C.R. 186 at p. 221; *Consolidated Car Heating Company v. Came* [1903] Q.R. 18 S.C. 44, Q.R. 11 K.B. 103, 1903 A.C. 509.)

An invalid patent creates no rights.

There can be no infringement of an invalid patent. Such a patent has no legal existence and there is therefore no monopoly. Nor is an invalid patent any protection to an infringer. Where there are two patents for the same invention, one of them must be invalid and an invalid patent gives no rights. (*Collette v. Lasnier* [1886] 13 S.C.R. 563 at p. 568; *Smith v. Goldie* [1883] 9 S.C.R. 46.)

Infringement a mixed question of law and fact.

The question of infringement is a mixed one of law and fact. As a matter of law it is the function of the court to construe the specification and claims to determine what is the patented invention. (*The British Dynamite Co. v. Krebs* [1896] 13 R.P.C. 190 at p. 192; *Brooks v. Steele and Currie* [1897] 14 R.P.C. at p. 73.) The court having determined what the patented invention is, the question of whether there has been an infringement is one of fact, and is for the jury where there is one. (*Walton v. Potter* [1841] 1 W.P.C. at p. 586; *De La Rue v. Dickenson* [1857] 7 E. & B. at p. 738; *The Incandescent Gas Light Co. v. The De Mare Incandescent Gas Light System* [1896] 13 R.P.C. 301.)

Patent construed as any other document.

The construction of the claims and specifications will be determined by the court 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 the art and manufacture at the time, and making itself acquainted with the technical meaning in art or manufactures which any particular word or words may have. (*The British Dynamite Co. v. Krebs* [1879] 13 R.P.C. 190 at p. 192; *Nobel's Explosives Co. v. Anderson* [1894] 11 R.P.C. 519.)

The patented invention, that is the invention which is protected by the patent, is what is claimed and nothing more. In *Nobel's Explosives Co. v. Anderson* (1894) 11 R.P.C. 119, Romer, L.J., said at p. 128: "In order to make out infringement it must be established to the satisfaction of the court that the alleged infringer, dealing with what he is doing as a matter of substance, is taking the invention claimed by the patent, not the invention which the patentee might have claimed, if he had been well advised or holder, but that which he has in fact and substance claimed on a fair construction of the specification." (*Bradford Dyers' Association v. Bury* [1902] 19 R.P.C. 1; *Bunge v. Higginbottom Co., Ltd.* [1902] 19 R.P.C. 187.)

A patent protects only what is claimed.

There is therefore no such thing as an infringement of the equity of a patent. In *Dudgeon v. Thompson* (1873) 3 App. Cas. 34, Lord Cairns said at p. 44: "There used to be a theory in this country that persons might infringe upon the equity of a statute, if it could not be shown that they had infringed the words of the statute; it was said that they had infringed the equity of the statute, and I know there is, by some confusion of ideas, a notion sometimes entertained, that there may be something like an infringement of the equity of a patent. My Lords, I cannot think that there is any sound principle of that kind in our law; that which is protected is that which is specified, and that which is held to be an infringement must be an infringement of that which is specified."

No such thing as infringement of the equity of a patent.

In *Moffatt v. Leonard* (1905) 5 O.W.R. 259 at p. 261, Meredith, C.J., said: "That they have not adopted exactly the same form as that used by the plaintiffs is immaterial, if they have, as I think they have, taken substantially the substance and pith of his invention." The way the matter is generally put, is that infringement consists in taking the "substance of the invention." Often instead of "substance" the words "pith and marrow" are used. The use of these words has, however, been criticized as being misleading; (*Incandescent Gas Light Co. v. De Mare Incandescent Gas Light Co.* [1896] 13 R.P.C. 301, per Wills, J.).

Infringer must take substance of invention.

While the subject matter of the patent must be determined by the court as a matter of law by construing the

The substance of invention.

vention can not be determined without knowledge of step taken in the art.

specification and claims, it is not sufficient to consider merely the specification and claims to decide whether there has been infringement or not. Infringement involves the question of fact as to whether the substance of the invention has been taken, and this necessitates an examination as to what is the essence or substance of the invention. The substance of the invention must be got at by ascertaining what the step is which has actually been taken by the inventor, and this can only be done by considering not only what has been claimed, but the state of existing knowledge on the subject, what is generally described as the state of the art, at the date of the patent, and by obtaining an understanding of the invention itself.

In *Consolidated Car Heating Co. v. Came* (1903) A.C. 509 (a Canadian case), Lord Davey said at p. 516: "Their Lordships cannot adopt the view apparently taken by the learned Chief Justice that the matter is to be determined simply on reading the specification. They think that, according to established authority, the court is bound to decide as a fact whether the alleged infringer has taken the substance of the invention, and in forming an opinion on that question to have regard to the evidence as to the existing state of knowledge on the subject at the date of the patent and as to the operation of the machine."

Relative importance of parts is a matter of evidence.

The relative importance of the parts is a question to be settled by evidence. In *The Incandescent Gas Light Co. v. The De Mare Incandescent Gas Light System* (1896) 13 R.P.C. 301, this question is discussed at length. At page 330, Wills, J., said: "In dealing with the question of construction, I have carefully avoided any reference to the relative importance of different parts of the invention. In dealing with the question of infringement it is impossible not to consider them. Infringement is a question of fact for the jury, if there be one; and the question is not whether the substantial part of the process, said to be an infringement, has been taken from the specification; but the very different one, whether what is done, or proposed to be done, takes from the patentee the substance of his invention. . . . What the thing invented is must be gathered from the specification

alone, and the patentee cannot escape from the thing he has claimed as the standard, and the only standard with which to compare the alleged infringement, so as to see if it constitutes substantially the appropriation of the thing claimed. When, however, you come to make that comparison, how can you escape from considering the relative magnitude and value of the things taken and of those left or varied? It is seldom that the infringer does the thing, the whole thing, and nothing but the thing claimed by the specification. He always varies, adds, omits; and the only protection the patentee has in such a case lies, as has often been pointed out by every court, from the House of Lords downwards, in the good sense of the tribunal which has to decide whether the substance of the invention has been pirated. It is contended by the defendants that what is important, and what is of subsidiary consequence, can only be gathered from the specification itself. . . . I am satisfied that that neither is nor can be the law. Certainly *Dudgeon v. Thompson* L.R. 3 App. Cas, (34) which was cited as an authority to that effect says nothing of the kind. 'Additions or subtractions' says Lord Cairns 'may exist and yet the thing protected by the specifications may be taken notwithstanding.' There are no means of ascertaining whether, notwithstanding additions or subtractions, the invention has been taken, except by seeing what they are worth as compared with the things which have been taken bodily from the invention." (See also *Consolidated Car Heating Co. v. Came* [1903] 20 R.P.C. 745, 1903 A. C. 509.)

Looked at as to "substance" inventions have been divided into two classes.

First. The invention may consist in a method of application of a new principle. Patents covering such an invention are variously described as "pioneer," "master," "generic," "primary." These inventions are often said to be of the *Proctor v. Bennis* type. Method of application of new principle.

The following kinds of invention are said to fall within this class:

- (1) A method of application of a new principle.
- (2) A new machine, material or process for a new purpose.

New appli-
cation of old
principle

Second. The invention may consist in a new method of applying an old principle. Such an invention is often referred to as of the Curtis v. Platt type.

The following kinds of invention are said to fall within this class:

(1) The novel application of an old principle.

(2) A new machine, material or process for an old purpose.

(3) An old machine for a new purpose.

(See Terrell on Patents, 5th Ed., 290.)

Same prin-
ciple in-
volved with
both kinds
of patents,
but the ap-
plication is
different.

Whether an invention fall within one class or the other, the question of infringement is governed by the same principle (Nobel's Explosives Co. v. Anderson [1894] 11 R.P.C. 119). The only matter to be decided is: Has the substance of the invention been taken? Obviously, however, the substance of the invention is of quite different character in the two cases, and the courts have held that the governing principle must have a different application to the two classes of cases. The different application to the two classes is admirably put by Mr. Terrell (Terrell on Patents, 5th Ed., p. 288) as follows:

"It is submitted that a claim cannot be sustained for a hare principle or for every method of applying a principle, whether that principle be new or old, but when the principle is new the court will give a wide construction to the claim. The court in every case will inquire in what the essence of the invention as claimed consists, and will hold the defendant to have infringed if he has taken the pith and marrow of the invention as claimed, and when the invention is merely for an improved mode of attaining an old object, the pith of his invention is that particular method, and only by making use of that particular method will a man be held to have infringed; but when the invention is for a new method of attaining a new result, the novelty of the result itself is part of the merit of the invention and of the consideration given by the patentee in return for the grant; and consequently, a man will be held to have infringed if he should have arrived at the same result by means of a process substantially the same as, or only colourably different from, that disclosed in the specification of the original invention."

In the leading case of *Curtis v. Platt* (1863) 3 Ch.D. 135, Wood, V.C., said at page 136: Rule in *Curtis v. Platt*.

"Where the thing is wholly novel, and one which has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machine for effecting the same object, to see whether or not they are merely colourable contrivances for evading that which has been before done. When the object itself is one which is not new, but the means only are new, one is not inclined to say that a person who invents a particular means of doing something that has been known to all the world long before, has a right to extend very largely the interpretation of those means which he has adopted for carrying it into effect. Because, otherwise, that would be to say that the whole world is to be precluded from achieving some desirable and well-known object which everybody has had in view for years. In such a case it may be said that the means taken are simply mechanical equivalents for the means previously adopted for arriving at the same object."

In the leading case dealing with the other type of invention (*Proctor v. Bennis* [1887] 36 Ch.D. 740, 4 R.P.C. 333 at p. 355) Cotton, L.J., referring to the patent sued on in *Curtis v. Platt*, said: Rule in *Proctor v. Bennis*.

"It was specially to introduce improvements into the mechanical means and arrangements which a previous patentee had used to obtain a well-known object in a well-known machine. Therefore in that case, in applying those words used by the judges, we must deal with the case before them and come to the conclusion, as I do, that what they meant was this, that where there is no novelty in the result, where neither the machine or the result is new, there you must tie down the patentee, who claims an improvement in the machinery for producing in a known machine that result, strictly to the invention which he claims, and the mode of effecting the improvement which he says is his invention. But here the throwing coal on to the furnace by the intermittent radial action of a flap or door was new, and nothing of the kind had been done before. It is true there had been

previous though imperfect machines for feeding furnaces automatically, but that had not been done previous to this machine by any intermittent radial action of a flap or door, as was done by the plaintiff, and apparently successfully done by him. In my opinion, therefore, these opinions expressed by the judges with reference to mere improvements in an old machine for an old purpose cannot lay down any law for a case like this, where the result of throwing coal on to the furnace by the intermittent radial action of the flap is first applied in a machine invented by the plaintiff. There was not only novelty in the machine, but there was novelty in the effect, and in the result to be produced by that machine."

The following list of cases where the rule in *Curtis v. Platt* was applied is given in *Frost Patent Law and Practice*, p. 358: *Boyd v. Horrocks* (1892) 9 R.P.C. 77, 6 R.P.C. 152, 528; *Morris v. Young* (1895) 12 R.P.C. 455; *Chamherlain & Hookham, Ltd. v. Mayor, etc.*, *Bradford* (1903) 20 R.P.C. 673 at p. 684; *Ashworth v. English Card Clothing Co.* (1903) 20 R.P.C. 790; *Bovill v. Pimm* (1856) 11 Exch. 718; *British Tanning Co. v. Groth* (1891) 8 R.P.C. 113; *Jahneke v. Bell* (1892) 9 R.P.C. 94; *Nettlefolds v. Reynolds* (1892) 9 R.P.C. 270; *Parkinson v. Simon* (1894) 11 R.P.C. 238, 493; *Ticket Punch Register Co. v. Colley's Patents* (1894) 12 R.P.C. 1, 171; *Sboe Machinery Co. v. Cutlan* (1896) 13 R.P.C. 141; *Cleaver v. Wallwork* (1896) 13 R.P.C. 277; *Birch v. Harrap* (1896) 13 R.P.C. 615; *Scott v. Hamling* (1897) 14 R.P.C. 123; *Scott v. Hull Steam Fishing and Ice Co.* (1897) 14 R.P.C. 143; *Brooks v. Lamplugh* (1898) 15 R.P.C. 33 at p. 41; *Bailey v. Airey* (1905) 22 R.P.C. 461, 23 R.P.C. 277.

Mr. Frost states that the rule in *Proctor v. Bennis* was approved by the House of Lords in *Moore v. Thompson* (1890) 7 R.P.C. 325 and held to apply in *Gosnell v. Bishop* (1888) 5 R.P.C. 41 151; *Peckover v. Rowland* (1893) 10 R.P.C. 118, 234; *Jardine v. King, Mendham & Co.* (1896) 13 R.P.C. 411; *Presto Gearcase and Components Co. v. Simplex Gear Case Co.* (1898) 15 R.P.C. 635; *Presto Gear Case and Components Co. v. Orme, Evans & Co.* (1900) 17 R.P.C. 218, 18 R.P.C. 17.

The following Canadian cases may be consulted: Short v. Federation Brand Salmon Canning Co. (1899) 7 B.C.R. 197, 31 S.C.R. 378; Clinton Wire Cloth Co. v. The Dominion Wire Fence Co. (1907) 11 Ex. C.R. 103, 39 S.C.R. 535; Chamberlin Metal Weather Strip Co. of Detroit v. Peace Metal Weather Strip Co. (1905) 9 Ex. C.R. 399, 37 S.C.R. 530; Carter & Company v. Hamilton (1893) 3 Ex. C.R. 351, 23 S.C.R. 172; American Dunlop Tire Co. v. Anderson Tire Co. (1896) 5 Ex. C.R. 194; The American Dunlop Tire Co. v. Gould (1899) 6 Ex. C.R. 223.

A similar rule to that laid down in Proctor v. Bennis is followed in the United States. In McCormack v. Aultman, 169 U.S. 607, it was said:

Similar rule to that of Proctor v. Bennis in United States.

"Where an invention is of a primary character and the mechanical functions performed by the machine as a whole are entirely new, all subsequent machines which employ substantially the same means to accomplish the same result are infringements, although the subsequent machine may contain improvements in the separate mechanisms which go to make up the machine."

The rule is explained in Morley v. Lancaster, 129 U.S. 263, 32 L. Ed. 715, 9 S. Ct. 299.

"These claims are not for a result or effect, irrespective of the means by which the effect is accomplished. It is open to a subsequent inventor to accomplish the same result, if he can, by substantially different means. The effect of the rule before laid down is merely to require that, in determining whether the means employed in the defendant's machine, are substantially the same means as those employed in complainant's machine, the complainant's patent is to receive a liberal construction, in view of the fact that he was a pioneer in the construction of an automatic hutton-sewing machine, and that his patent, especially in view of the character and terms of the four claims in question, is not to be limited to the particular devices or instrumentalities described by him, used in the three main elements of his machine, which combined together make it up. This is the principle applied by this court in Consolidated v. Crosby, 113 U.S. 157."

The words "colourable" or "colourably" are often used in connection with infringement, but their use has been objected to as tending to convey the idea that a

Colourable infringement.

patent may be infringed by something that is not identically or substantially the same as the patented invention. The gist of the matter is contained in the words of Lord Cairns in *Dudgeon v. Thompson* (1873) 3 App. Cas. 34:

"If there is a patented invention, and if you, the defendant, are found to have taken that invention, it will not save you from the punishment or from the restraint of the court, that you have, at the same time that you have taken the invention, dressed it up colourably, added something to it; taken, it may be, something away from it, so that of the whole of it may be said, as is said in this injunction: Here is a machine, which is either the plaintiff's machine or differs from it only colourably. But underlying all that, there must be a taking of the invention of the plaintiff. There used to be a theory in this country that persons might infringe upon the equity of a statute if it could not be shown that they had infringed the words of the statute; it was said that they had infringed the equity of the statute, and I know there is, by some confusion of ideas, a notion sometimes entertained that there may be something like an infringement of the equity of a patent. My Lords, I cannot think that there is any sound principle of that kind in our law; that which is protected is that which is specified, and what which is held to be an infringement must be an infringement of that which is specified. But I agree it will not be the less an infringement because it has been coloured or disguised by additions or subtractions, which additions or subtractions may exist, and yet the thing protected by the specification be taken notwithstanding."

See also *Dudgeon v. Thompson* (1873) 3 App. Cas. 34; *Muntz v. Foster* (1843) 2 W.P.C. 95; *Walton v. Potter* (1841) 1 W.P.C. 585; *Gamble v. Kurtz* (1846) 3 C.B.N.S. 425 at p. 479; *Hayward v. Pavement Light Co.* (1884) 1 R.P.C. 207; *Nordenfelt v. Gardner* (1884) 1 R.P.C. 61; *Walker v. Hydrocarbon Syndicate* (1885) 2 R.P.C. 8; *Sugg v. Bray* (1885) 2 R.P.C. 223; *United Telephone Co. v. St. George* (1886) 3 R.P.C. 321; *Richardson v. Castrey* (1887) 4 R.P.C. 265; *Ellington v. Clark* (1888) 5 R.P.C. 135, 319; *Wenham v. May* (1887) 4 R.P.C. 303; *Proctor v. Bennis* (1887) 36 Ch.D. 740; 4 R.P.C. 333; *Ehrlich v. Ihlee* (1888) 5 R.P.C. 198,

437; *Garrard v. Edge* (1889) 6 R.P.C. 372, 563; *Boyd v. Horrocks* (1889-92) 3 R.P.C. 285, 5 R.P.C. 557, 6 R.P.C. 152; *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.* (1889) 6 R.P.C. 121 at p. 367; *Shaw v. Jones* (1889) 6 R.P.C. 328; *Winhy v. Manchester, etc., Steam Tramways Co.* (1890) 8 R.P.C. 61, 7 R.P.C. 30, 6 R.P.C. 359.

The substantial equivalent of a thing is, in the sense of the patent law, the same as the thing itself (*Machine Co. v. Murphy*, 97 U.S. 120, 24 L. Ed. 935). This in short is what is known generally as the doctrine of equivalents, or when confined to mechanical devices, the doctrine of mechanical equivalents. This doctrine involves little more than has already been stated. Something which is merely an equivalent of a part described by the patentee may not be used for effecting the same end. The difficulty is to determine whether what has been used is or is not an equivalent. This will depend upon the character of the invention. If the step taken by the patentee is a long one and his invention involves the utilization of a new principle, he is not limited to the details he has employed but any details which utilize the principle in substantially the same way will be held to be the equivalents of those used by the patentee. If, however, the invention be one of detail merely, a substantially different detail will not be an equivalent of the patented invention though accomplishing the same result. For this reason it is sometimes said that the doctrine of mechanical equivalents has no application to inventions of the type of *Curtis v. Platt*. It is more correct to say it has only a limited application.

See *Bateman v. Gray* (1853) Macr. P.C. 93 at p. 116, 22 L.J. Ex. 290; *Morgan v. Seaward* (1837) 1 W.P.C. 171; *Thorn v. Worthing Skating Rink Co.* (1876) L.R. 6 Ch.D. 415; *United Telephone Co. v. Harrison Cox-Walker* (1882) L.R. 21 Ch.D. 720; *United Telephone Co. v. Bassano* (1886) 3 R.P.C. 295; *United Telephone Co. v. St George* (1886) 3 R.P.C. 321; *Hancock v. Moulton, Johns Pat. Man.*, 5th Ed., p. 254; *Thompson v. Moore* (1889-90) 6 R.P.C. 426, 7 R.P.C. 325; *Pneumatic Tyre Co. v. Tubeless Tyre and Capon Neaton, Ltd.* (1897-8) 15 R.P.C. 74, 236; *Gormully and Jeffry Manufacturing*

Doctrine of equivalents.

Co. v. North British Rubber Co. (1894-8) 12 R.P.C. 17, 14 R.P.C. 283; Aktiebolaget Separator v. Dairy Outfit Co. (1897) 14 R.P.C. 473, 15 R.P.C. 327, 334, 335, 338; Brooks v. Lamplugh (1898) 15 R.P.C. 33; Brown v. Hastie & Co., Ltd. (1902-4) 21 R.P.C. 445; British United Shoe Machinery Co. v. Thompson (1905) 22 R.P.C. 177; The Auer Incandescent Light Manufacturing Co. v. O'Brien (1897) 5 Ex. C.R. 243 at p. 288.

The doctrine of equivalents and its application is stated as follows in the American case, *Central v. Coughlin*, 141 Fed. 91, 72 C.C.A. 93:

American
statement of
doctrine of
equivalents.

"An equivalent is defined as a thing which performs the same function and performs that function in substantially the same manner as the thing of which it is alleged to be an equivalent. But in the application of rules on the subject, we must have in view the patent alleged to be infringed. If it is for a primary invention—one which performs a function never performed by an earlier invention—the patentee will have the right to treat as infringers those who make or use machines operating on the same principle and performing the same functions by analogous or equivalent combinations, even though the infringing machine may be an improvement of the original. But if the invention is a secondary invention, that is, one which performs a function previously performed by earlier inventions, but which performs that function in a substantially different way from any which preceded it; an improvement on a known machine by a mere change of form or a new combination of parts, the patentee cannot treat another as an infringer who has improved the original machine by the use of a different form or combination performing the same functions. The first inventor of improvements cannot invoke the doctrine of equivalents and suppress all other improvements."

Patent
covers only
known
equivalents.

In the United States it has been held that a "patent covers only known equivalents" (*Magie v. Economy*, 97 Fed. 87, 38 C.C.A. 430). In *Gill v. Wells*, 89 U.S. 1, it was said:

"Repeated decisions of this court have settled the rule in such cases that if the ingredient substituted by the defendant's machine was a newly discovered one, or

even an old one performing some new function, and was not known at the date of the plaintiff's patent as a proper substitute for the ingredient left out, the charge of infringement cannot be maintained."

In England a similar rule was suggested in *Unwin v. Heath* (1855) 5 H.L.C. 505. It has been doubted, however, whether this is the law in England. (Terrell on Patents, 5th Ed., 299.) Mr. Frost suggests (Frost on Patents, 4th Ed., p. 256) that the real point for determination is whether or not the newly invented or discovered equivalent is, where judged by the light of public knowledge at the date of the patent alone, clearly and obviously an equivalent *qua* the function of the part for which it is substituted. (*Stevens v. Keating* [1848] 2 W.P.C. 175, 181, 5 R.P.C. 259; *Nobel's Explosives Co. v. Anderson* [1894] 11 R.P.C. 119; *Badische Anilin und Soda Fabrik v. Levinstein* [1885] 2 R.P.C. 73; *Automatic Weighing Machine Co. v. Knight* [1889] 6 R.P.C. 297; *Thompson v. Moore* [1889] 6 R.P.C. 426, 7 R.P.C. 329; *Marconi v. British Radio Telegraph and Telephone Co.* [1911] 28 R.P.C. 181.)

It has been thought by some that the law as to infringement of patents for combinations is different in Canada from that of England (*Jones v. Galbraith & Sons* [1902] 9 B.C.R. 521, *Drake, J.*, at p. 527).

In the recent case of *Barnet McQueen Co. v. Canadian Stewart Co.* (1910) 13 Ex. C.R. 186, *Cassels, J.*, expressed the opinion that the law is the same in England, the United States and Canada.

A patent for a combination is not infringed by taking separately the integers which are comprised in that combination. The separate integers may be claimed apart from the combination, but are not protected unless claimed. (*The British United Shoe Machinery Co., Ltd. v. A. Fussell & Sons, Ltd.* [1908] 25 R.P.C., p. 631; *Barnet McQueen v. Canadian Stewart Co.* [1910] 13 Ex. C.R. 186.)

As stated by American authorities a combination to be patentable, must possess the qualities of interaction which effect a new or different result from that of any element or the summation of the separate results of

Law as to infringement of combination patents probably same in England, United States and Canada.

Taking an integer does not infringe the combination patent.

Variations which do not infringe.

all the elements, else it is a mere aggregation. It therefore follows that infringement is only avoided when

(1) something is added which changes the action and function of the combination, or

(2) when something is omitted which changes the action and function of the combination, or

(3) when some element is substituted which cannot be held an equivalent of that which was omitted.

Statement
of Lord
Esher in
Nordenfelt
v. Gardner.

In *Nordenfelt v. Gardner* (1884) 1 R.P.C. 61 C.A. at p. 65, Lord Esher, M.R., said:

"That seems to me to claim the feeding apparatus as a combination, and to claim the combination, and the combination alone. If that be so, how can such a combination be infringed? The machine which is challenged may have that combination actually without any variance at all. If so, it is obvious that the challenged machine is an infringement. Or it may have that combination with some alteration. The alteration of a combination, as it seems to me, may be by addition, or subtraction, or substitution of parts. Any one of these alters the combination. If the alteration whether it be by addition, or subtraction, or substitution, be merely colourable, then the two machines are substantially the same; although not mathematically exactly the same, they are substantially the same, and in any case, notwithstanding such colourable alteration, there may be an infringement. An alteration by addition may be an improvement, but then that will leave the whole of the original combination, and add something to it. If such an alteration of the combination be made it seems to me that no good patent can be made with regard to the new machine, except by claiming the invention as an improvement, and by showing distinctly what the addition is, so as to show what the improvement is. An alteration by subtraction, if it were more than a colourable subtraction would, as it seems to me, alter the combination. It would not be a combination of the same things; it would be a combination of different things, and, if the combination were altered by a material subtraction, I should think that it was a new combination. But an alteration by substitution, that is, by substitution of one of the material elements of the original combination, must to my mind be a new combination. The second

combination, then, is a combination of different things from the first. There is a taking away of one of the elements and a material element of the old combination, and the putting in of a new material element which is different from any of the elements of the former. Somebody tried to express these things by A, B, and C, but if the original combination is of A, B, and C, and you take away C and make a combination of A, B, and D it seems to me as clear as possible that the new combination is a different combination from the old."

In connection with the statement of Lord Esher it is only necessary to make one observation. It is doubtless true that an alteration by addition which leaves the original combination and merely adds something to it is an infringement. Such an alteration would result only in an aggregation composed of the old combination and one or more new elements. If, however, the addition should result in a change of action or function then the old combination is not left, but a new combination is formed which is not an infringement of the original invention. In *U.S. v. Berdan*, 156 U.S. 552, 38 L. Ed. 530, 15 S. Ct. 420, it was said "when several elements, no one of which is novel, are united in a combination which is the subject of a patent, and these several elements are thereafter united with another element into a new combination, and this new combination performs a work which the patented combination could not, there is no infringement." It is believed this is also the law in Canada.

Suggested qualification of statement of Lord Esher.

In England language has been used in some of the cases that might seem to indicate that a combination of several elements might be infringed by a use of a certain number of them less than those covered by the patent. In *Clark v. Adie* (1875) 10 Ch. at p. 675, James, L.J., said:

Combination probably can not be infringed by combination of less elements than patented invention.

"And it might well be, that if the instrument patented consists of twelve different steps, producing in the result the improved clipper, an infringer who took eight or nine or ten of these steps, might be held by the tribunal judging of the patent to have taken in substance the pith and marrow of the invention, although there were one,

two, three, four or five steps which he might not actually have taken and represented upon his machine."

It is believed that the determining question is whether the elements omitted are material elements or not, that is, whether they are elements at all or not. Cassels, J., deals with this matter in the *Barnett McQueen Co. v. The Canadian Stewart Co.* (1910) 13 Ex. C.R. 186 at p. 222, as follows:

"The first question to ascertain is what is the combination claimed as the invention. If on a proper construction of the claim and specification, having regard to the state of the art, it be determined that an element forms part of the combination the patentee cannot get rid of this element as being an immaterial or non-essential element. No such thing as an immaterial or non-essential element in a combination is recognized in the patent law. Having regard to the essentials of a combination, the admission that an element is not material is an admission that the combination is an invalid combination, and the claim is bad. It follows that if the alleged infringer omits one element of the combination, he does not infringe the combination. Of course, if instead of omitting an element he substitutes a well-known equivalent, he in fact uses the combination."

The reason for the language which raises the apparent difficulty is indicated by Cassels, J. He points out that in England, prior to 1883, a claim was not requisite to the specification, and therefore in cases such as *Foxwell v. Bostock* (1864) 10 L.J. 144, 12 W.R. 723, there being no specific claim, the patentee has set out in his specification his invention, and it is a question of fact what his invention is. Under the Canadian practice a claim is required, and an element claimed can not be held to be non-essential or not a material element. At p. 221, Cassels, J., said: "If, however, the patentee has chosen in unambiguous terms to incorporate an element as a part of his combination, then the mere fact that subsequently he may find out that he might have omitted this element does not help him."

No duty on patentee to warn infringers.

There is no duty cast upon a patentee to warn persons that they are infringing. (*Proctor v Bennis* [1887] 36 Ch.D. 740, 4 R.P.C. 333.)

A patent may be infringed by one who is ignorant of the patent (*Unwin v. Heath* 1855] 5 H.L.C. 505). Every one is taken to have notice of a patent (*Wright v. Hitchcock* [1870 L.R. 5 Ex. 37; *Young v. Rosenthal* [1884] 1 R.P.C. 29.) "The question of infringement depends not on what the defendant intends, but on what he does." (*Stead v. Anderson* [1846] 2 W.P.C. 147.)

Patent may be infringed by one who has no knowledge of patent.

In England it is provided by sec. 33 of Patent Act, 1907, that damages can not be recovered from a defendant who proves he was not aware, nor had reasonable means of making himself aware, of the existence of the patent. There is no similar provision in the Canadian Act.

Sec. 55 of the Canadian Act reads as follows:

"55. Every patentee under this Act shall stamp or engrave on each patented article sold or offered for sale by him the year of the date of the patent applying to such article, thus,—PATENTED, 1906, or as the case may be; or when, from the nature of the article, this cannot be done, then by affixing to it, or to every package wherein one or more of such articles is or are inclosed, a label marked with a like notice."

Patentee who does not mark patented article is liable to penalty, but failure to mark does not affect his right to recover for infringement.

The only consequence to the patentee of a breach of sec. 55 is, that he is liable to the penalty imposed by sec. 61. There is no provision similar to that in the United States (Revised Statutes, sec. 665), that in any suit for infringement by the party failing to mark his invention no damages shall be recovered by the plaintiff except on proof that the defendant was duly notified of the infringement, and continued after such notice, to make, use or vend the article patented. (*Overend v. Burrow, Stewart Milne Co.* [1909] 19 O.L.R. 642 at p. 651.)

Proof of intention to infringe will justify an injunction. In *Frearson v. Loe* (1878) L.R. 9 Ch.D. 48, *Jessel, M.R.*, held that 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. (See also *Dowling v. Billington* [1890] 7 R.P.C. 191.)

Proof of intention to infringe justifies an injunction.

Any infringement will be evidence of intention to continue the infringement. In *Proctor v. Bayley* (1889) 6 R.P.C. 538, Cotton, L.J., said: "When a patent is infringed, the patentee has a *prima facie* case for an injunction, for it is to be presumed that an infringer intends to go on infringing, and that the patentee has a right to an injunction to prevent his doing so."

Taking out a patent for invention already patented or granting licenses under subsequent patent does not infringe.

One who "puts in practice" the invention infringes.

Both employer and workmen are liable for infringement.

Making the patented article does not infringe unless there is profit or advantage.

Taking out a patent for something that infringes does not amount to infringement. (*Tweedale v. Ashworth* [1890] 7 R.P.C. 431.) Nor does granting a license under a subsequent patent for an invention which would infringe amount to infringement. (*Gibson and Campbell v. Brand* [1842] 1 W.P.C. 631; *McCormick v. Gray* [1861] 7 H. & N. 25, 31 L.J. Ex. 46.)

Reading the patent together with sec. 21 of the Act, it will be seen that the patent may be infringed by making, constructing and using, and by vending to others to be used, the patented invention. Sec. 30 would seem to add that infringement takes place where anyone "puts in practice" the patented invention. In *Bennett v. Wortman* (1901) 2 O.L.R. 292, Meredith, J., decided, that reading the sections which are now 30 and 32, the proper conclusion is that the words "puts in practice" in sec. 30 would include selling the "subject matter of the patent" authority to restrain which is given by sec. 32. There are no other Canadian cases defining what is meant by "puts in practice."

A person is liable if his agent or workman infringes. The agent and workmen are also liable. (*Sykes v. Hawthorn* [1879] L.R. 12 Ch.D. 826; *Betts v. de Vitre* [1864-73] L.R. 3 Ch. 429, 442, 6 H.L. 319, 34 L.J. Ch. 289, 291.)

In England it has been held that where there is no use or sale for profit or advantage, a patented invention may be made by way of experiment. (*Jones v. Pearce* [1832] 1 W.P.C., p. 125; *Frearson v. Loe* [1878] L.R. 9 Ch.D. 48.) But slight use of an invention constitutes infringement. Use of an article for the purpose of instructing pupils amounts to infringement. (*United Telephone Co. v. Sharples* [1885] L.R. 29 Ch.D. 164, 2 R.P.C. 28.)

A process patent protects not only the process, but

the thing produced by the process, and an action will therefore lie against any person purchasing and using or selling articles made in derogation of the patent, no matter whether they are made in Canada or elsewhere. (Wright v. Hitchcock [1870] L.R. 5 Ex. 37; Elmslie v. Boursier [1869] L.R. 9 Eq. 217; Von Heyden v. Neustadt [1880] 14 Ch.D. 230; Auer Incandescent Light Co. v. O'Brien [1897] 5 Ex. C.R. 243; Saccharin Corporation, Limited v. Anglo-Continental Works, Limited [1900] 17 R.P.C. 307, [1901] 1 Ch. 414.)

Using or selling product of process patent amounts to infringement.

The onus is on the patentee of proving that the articles said to infringe were in fact made by the patented process. Where, however, the articles were made in another country, a *prima facie* case made by the patentee will throw the onus on the defendant to show that the articles were not made according to the process. Where it is shown that the process patented is the only known method of making the product, such a *prima facie* case is made out. (Neilson v. Betts [1871] L.R. 5 H.L. 1; Carlsburn Sugar Refining Co. v. Sharp [1884] 1 R.P.C. 181; Saccharin Corporation v. Dawson [1902] 19 R.P.C. 169; Saccharin Corporation v. Jackson [1903] 20 R.P.C. 611; Saccharin Corporation v. Mack [1906] 23 R.P.C. 611; Toronto Auer Light Co. v. Colling [1898] 31 O.P. 18; Lanz v. McAllister, 1 O.W.R. 455, 2 O.W.R. 148.)

Onus on patentee to show articles made by patented process.

In the patent law of the United States the doctrine of what is known as contributory infringement has a recognized place. Contributory infringement is defined in Goodyear v. Jackson (1901) 112 Fed. 146:

Doctrine of contributory infringement recognized in United States.

"Infringement is the unlawful making or selling or using of a patented invention. Contributory infringement is 'the intentional aiding of one person by another in the unlawful making or selling or using the patented invention,' and this is usually done by making or selling a part of the patented invention with the intent or purpose of so aiding. The essence of contributory infringement lies in concerting or planning with others in an unlawful invasion of the patentee's rights."

The limitation of this doctrine is indicated in Cortelyou v. Johnson, 145 Fed. 933, 76 C.C.A. 455:

"The majority of the court (Coxe and Townsend, JJ.) is of the opinion that the decree at bar pushes the doc-

trine of contributory infringement to its extreme limits. The doctrine originated in a desire to secure to a patentee complete protection in all the rights granted to him by the patent, but it was confined to those rights; it went no farther. One who sold an element of a patented combination which could not be used except in an infringing combination or device, was not permitted to reap the benefits of such sale. He did not directly infringe, but he promoted the infringement of others by putting in their hands a device which could only be used in violation of the patent. When confined to articles, whether covered by the patent or not, which are made for the express purpose of inducing infringement and are not intended for any legitimate use, the doctrine of contributory infringement is logical, just and salutary, but we doubt the wisdom of extending it to the ordinary commodities of life, used in connection with a patented machine, because the patentee sells or licenses the machine upon the conditions that he alone is to furnish these commodities. Care should be taken that the courts, in their effort to protect the rights of patentees, do not invade the just rights of others, engaged in legitimate occupations, by creating new monopolies not covered by patents and by placing unwarrantable restrictions upon trade. . . . We incline to the opinion that the line should be drawn to include those articles which are either parts of a patented combination or device or which are produced for the sole purpose of being so used and to exclude the staple articles of commerce."

Contributory infringement finds no place in law in England.

The doctrine of contributory infringement as such finds no place in English or Canadian law. Indeed the law of England seems to be quite contrary to that laid down in the United States.

The English cases are reviewed in *Dunlop Pneumatic Tyre Company, Ltd. v. Mosely* (1904) 21 R.P.C. 274. The defendants in this case made covers with a lining suitable for the insertion of wires adapted for use in the manner employed by the patentee but not necessarily for use in that manner. It was alleged that the sales were made to a person who, the defendants must have known, intended to infringe the patent. It was held by the Court of Appeal, confirming the judgment of Swin-

fern Eady, J., that the defendants did not infringe. Vaughan Williams, L.J., further said:

"I wish to say that in my judgment, this case would fail even though the plaintiffs were able to substantiate the proposition which the learned judge finds against them, that these covers, as manufactured and sold by these defendants, could not be used for any other purpose, than fitting them into the plaintiffs' tyres under one or other of the patents."

This opinion, while going beyond the decision, must in the meantime at least be taken as possibly the law of England and Canada.

Where, however, all the parts are sold, adapted to be put together this amounts to a sale of the whole invention and is an infringement. (United Telephone Co. v. Dale [1884] 25 Ch.D. 782; Dunlop Pneumatic Tyre Co. v. Mosley, 21 R.P.C. 274 at p. 280.)

Sale of all-parts in condition to be readily put together infringes.

It must also be borne in mind, that a patent may contain a number of claims, some of which may be on separate parts. The patent may be infringed by infringing any one claim. (Gillett v. Wilthy [1839] 9 C. & P. 336, 1 Web P.C. 270.)

Patent infringed by infringing one claim.

There is one Canadian case which seems to lean away from the English view. In Copeland-Chatterton v. Hatton (1906) 10 Ex. C.R. 224, 37 S.C.R. 651, a loose leaf hinder was sold on the condition that it should be used only with sheets sold by the patentees. Other manufacturers who were joined as defendants furnished the licensees with sheets prepared and adapted for use in the patented hinder, and to induce him to buy such sheets from them undertook to indemnify him against any action the patentees might bring against him. It was held that the other manufacturers infringed. Burhidge, J., in the Exchequer Court repudiated the idea of contributory infringement, indicating that so far as the Exchequer Court was concerned at least what was done was either infringement or nothing. He, however, laid down the proposition (p. 247) that one who knowingly and for his own ends and benefit and to the damage of the patentee induces or procures another to infringe a patent, himself infringes the patent.

Copeland-Chatterton v. Hatton.

From the point of view of the English law this case

seems to be open to the criticism which Mr. Terrell makes of the decision in *Innes v. Short* (1898) 15 R.P.C. 450, that there is no such thing as "aiding and abetting" infringement, for the defendant manufacturers did nothing more.

Copeland-Chatterton Co. v. Hatton was confirmed by the Supreme Court of Canada which is not bound by the Court of Appeal in England but the question of infringement by the defendant manufacturers was not discussed. Possibly the decision in this case may not be in conflict with the actual decisions in the English cases but it certainly is not in harmony with language used in several English cases, and it may be that the law of Canada to the extent involved in this decision is different from that of England.

Purchaser
may repair
without
infringing
but must not
rebuild.

As was said in *Davis v. Edison*, 60 Fed. 27, 68 C.C.A. 615:

"The right to repair a patented device is a right which goes with the device when it is sold, but that right does not include a right to rebuild the device in the sense of making it a new device."

In the *Sirdar Rubber Co., Ltd. v. Wallington Wills & Co.* (1907) 24 R.P.C. at p. 543, Lord Halsbury said:

"The principle is quite clear, although its application is sometimes difficult: you may prolong the life of a licensed article but you must not make a new one under cover of repair. (See also *The Dunlop Pneumatic Tyre Co. v. Holhorn Tyre Co.* [1901] 18 R.P.C. 222; *The United Telephone Co. v. Neilson* [1887] W.N. 192; *Dunlop Pneumatic Tyre Co., Ltd. v. Excelsior Tyre Co.* [1901] 18 R.P.C. 209.)

Purchase,
possession
or transport
do not in-
fringe unless
presumption
of intention
to use arises.

The general rule is that mere purchase, possession or transport does not amount to infringement where the circumstances are such that no presumption arises of intention to use the patented invention. (*British United Shoe Machinery Co., Ltd. v. Simon Collier, Ltd.* [1909] 26 R.P.C. 534, 27 R.P.C. 567.) In certain cases, however the mere possession of the patented invention involves the user. For example, in *Neilson v. Betts* (1871) L.R. 5 H.L. 1, the invention was a capsule used on hotted beer to preserve it, and it was held that there was user of the patented invention while in shipment and therefore

Infringement. (See also *Adair v. Young* [1879] L.R. 12 Ch.D. 13; *Proctor v. Bayley* [1889] 6 R.P.C. 538; *United Telephone Co. v. London and Globe Telephone and Maintenance Co.* [1884] 26 Ch.D. 766, 1 R.P.C. 117; *British Motor Syndicate v. John Taylor & Sons* [1901] 17 R.P.C. 732, [1900] 1 Ch. 122; *Dunlop Pneumatic Tyre Co. v. British and Colonial Motor Co* [1901] 18 R.P.C. 315; *Nohel's Explosives Co. v. Jones, Scott & Co.* [1881] 17 Ch.D. 721.)

Innocent carriers may be restrained from dealing with infringing articles. (*Washburn and Moen Manufacturing Co. v. Cunard Steamship Co.* [1889] 6 R.P.C. at p. 403; *Upman v. Elkan* [1869] L.R. 7 Ch. 130.)

Innocent carriers may be restrained.

Giving an order for the making of goods in the country according to a patented process amounts to infringement. (*Gihson v. Brand* [1842] 4 M. & G. 196, 1 W.P.C. 627.)

Giving order to make infringes.

In order that there may be infringement the invention must be made, used, vended or put in practice within the territory covered by the patent. Apparently "vending" within the meaning of the Act must be confined to selling goods made or brought into the country. Therefore entering into agreements in connection with patented inventions where manufacture and delivery takes place out of the country does not constitute an infringement. (*The Saccharin Corporation v. Reitmeyer & Co.* [1900] 2 Ch. 659, 17 R.P.C. 606; *The Badische Anilin und Soda Fabrik v. Hickson* [1906] A.C. 419, 23 R.P.C. 433.)

To constitute infringement the article must be made, used, vended or put in practice within Canada.

Sec. 52 of the Patent Act reads:

"52. The Government of Canada may, at any time use any patented invention, paying to the patentee such sum as the Commissioner reports to be a reasonable compensation for the use thereof."

Crown has right to use patented invention.

Apart from statute, the Crown has the power if it sees fit to do so, to use a patented invention without the assent of the patentee, and without making any compensation to him. The right granted to the patentee is not exclusive of the Crown, but of its subjects and others. The report of the Commissioner provided for by the section is a condition precedent to the right to recover

Report of Commissioner a condition precedent to right to recover.

compensation. (McDonald v. The King [1906] 10 Ex. C.R. 338.)

Sec. 53 of the Act reads:

Use in
foreign ship
does not
infringe.

"53. No patent shall extend to prevent the use of any invention in any foreign ship or vessel, if such invention is not so used for the manufacture of any goods to be vended within or exported from Canada."

It has been held that a British patent is not infringed by the use of the invention on board an English vessel abroad. (Newall v. Elliot [1863] 10 Jur. N.S. 954, 10 L.T. 792.)

The Canadian patent grants rights only "in the Dominion of Canada." The Dominion Parliament could in any event have no jurisdiction beyond the boundaries of Canada.

Questions relating to licenses, expressed or implied, and infringement by licensees are dealt with under licenses.

CHAPTER XVI.

ACTION TO RESTRAIN THREATS OF LEGAL PROCEEDINGS.

Sec. 36 of the British Patents and Designs Act, 1907, enacts that:

"Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as he has sustained thereby, if the alleged infringement to which the threats related was not in fact an infringement of any legal rights of the person making such threats; Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent."

British
Statute.

This section is a re-enactment with verbal variations of sec. 32 of the Patent Designs and Trade Marks Act, 1883. Prior to 1883 there was in England no legislation on this subject.

In Canada the law is the same as in England prior to 1883. A patentee is not liable for issuing threats of legal proceedings providing he does so *bona fide*. He is only liable where he makes statements as to the existence of a patent, or as to infringement, which are untrue, and where the statement is made *mala fide* for the purpose of injuring the plaintiff, and not in *bona fide* defence of his own rights. Where statements are proved to be false in a judicial proceeding, any repetition will be *mala fide*, and if there is evidence of an intention to

Law in
Canada
same as in
England
prior to 1883.

continue issuing them, then an injunction will be granted. (Wren v. Weild 1869] L.R. 4 Q.B. 213; Halsey v. Brotherhood [1880] L.R. 15 Ch.D. 514; Burnett v. Tak [1882] 45 L.T. 743; Anderson v. Leihig's Extract of Meat Co. [1882] 45 L.T. 757; Societe Anonyme des Manufactures de Glaces v. Tilghman's Patent Sand Blast Co. [1883] 25 Ch.D. 1; Household v. Fairhurn [1884] 51 L.T. 498 S.C., [1885] 2 R.P.C. 140; Herschher v. Hertz and Collingwood [1895] 11 T.L.A. 466, 99 L.T. Journal 213.)

Exchequer Court has no jurisdiction to restrain issuing threats.

In Sharples et al. v. National Mfg. Co., Ltd., Jan. 23rd, 1905, (Audette's Practice of the Exchequer Court, 2nd Ed., p. 508) on motion for an order restraining the plaintiffs from interfering with the defendant's business, and from issuing, or circulating statements or writings or articles in any way reflecting upon the right of the defendant to make and sell the cream separators alleged to infringe, or warning possible purchasers from buying the defendant's machines, it was held that the Exchequer Court had no jurisdiction to restrain the plaintiffs in the manner asked for, and that sec. 32 of the English Act (46-47 Vic., chap. 57) was not in force in Canada. The court, however, thought it had power to take the defendant's application into account in as much as it would offer the plaintiffs to grant their application for an undertaking by the defendants to keep an account, made at the same time, provided they would also undertake to discontinue interfering with the defendant's business and issuing warnings in the manner above specified.

CHAPTER XVII.

IMPEACHMENT.

The Exchequer Court of Canada, a Federal Court established by Act of the Dominion Parliament, has jurisdiction in all civil actions arising from infringement of patents or brought to annul or impeach patents. The Provincial Courts have also a limited jurisdiction in certain matters relating to patents conferred by the Patent Act. In cases of any importance an appeal may be taken to a common tribunal, the Supreme Court of Canada. From the Exchequer Court the appeal is direct to the Supreme Court. From the Provincial Courts the appeal from the trial court reaches the Supreme Court through one or more appellate Provincial Courts. The decisions of the Supreme Court are binding on both the Exchequer and the Provincial Courts, but the decisions of the Exchequer Court are not binding on the Provincial Courts, nor are the decisions of the Provincial Courts binding upon the Exchequer Court. Moreover, the decisions of the courts of one Province are not binding on those of another.

Courts having jurisdiction in patent cases.

Great confusion is only avoided by the respectful attitude assumed by the judges of the different courts towards the decisions of other courts. This attitude is shown by the language used in Court of Appeal for Ontario in *The Welsbach Incandescent Light Co., Limited, v. Stannard*, found in *Toronto Auer Light Co., Limited, v. Collins* (1898) 31 O.R. 18. Osler, J.A., referring to a decision of the Exchequer Court of Canada, said at p. 20: "But even if I entertained more doubt than I do of the soundness of that judgment I should hesitate before giving effect to a different opinion. The case at all events would have to be a very plain one—one, that is, in which I thought the judgment of the Exchequer Court plainly wrong—in which I would do so. No doubt we are not bound in any way by the decision of that

Respectful attitude of Courts towards decisions of other courts.

Court. It seems neither convenient nor desirable that the Patent Law in one Province should be different from that prevailing at the same time throughout the other Provinces of the Dominion, which would be the result were we to differ from the Exchequer Court, the decision of which, as a Federal Court, prevails throughout the Dominion unless differed from in some particular Province or overruled by the Supreme Court."

Jurisdiction
to impeach
under sec-
tion 35.

Jurisdiction to impeach a patent for certain causes is conferred on the Exchequer Court and on named Provincial Courts by sec. 35 of the Patent Act. This section reads:

"Any person who desires to impeach any patent issued under this Act may obtain a sealed and certified copy of the patent and of the petition, affidavit, specification and drawings thereunto relating, and may have the same filed in the office of the prothonotary or clerk of any of the divisions of the High Court of Justice in Ontario, or of the Superior Court of Quebec, or of the Supreme Court of Nova Scotia, New Brunswick, British Columbia or Prince Edward Island, respectively, or of the Court of King's Bench in Manitoba, or of the Supreme Court of the North-West Territories in the Province of Saskatchewan, and Alberta respectively, pending the disestablishment of that Court by the legislature of those Provinces respectively, and thereafter of such superior court of justice as, in respect of civil jurisdiction, is established by the said legislatures respectively in lieu thereof, or of the Territorial Court in the Yukon Territory, according to the domicile elected by the patentee as aforesaid, or in the office of the registrar of the Exchequer Court of Canada, and such courts, respectively, shall adjudicate on the matter and decide as to costs; and if the domicile elected by the patentee is in that part of Canada formerly known as the district of Keewatin, the Court of King's Bench of Manitoba shall

have jurisdiction until there is a superior court therein, after which, such superior court shall have jurisdiction.

"2. The patent and documents aforesaid shall then be held as of record in such courts respectively, so that a writ of *scire facias*, under the seal of the court, grounded upon such record, may issue for the repeal of the patent, for cause as aforesaid, if, upon proceedings had upon the writ in accordance with the meaning of this Act, the patent is adjudged to be void. R.S. chap. 61, sec. 34; 53 Vic., chap. 13, sec. 1."

Provincial Courts are limited to the jurisdiction to impeach conferred by this section. The Exchequer Court has a wider jurisdiction. Sec. 23 of the Exchequer Court Act, R.S.C. 1906, c. 140, reads:

Exchequer Court has also jurisdiction under Exchequer Court Act, R.S.C. 1906, cap. 140, sec. 23.

"The Exchequer Court shall have jurisdiction as well between subject and subject as otherwise . . ."

"(b) In all cases in which it is sought to impeach or annul any patent of invention . . ."

Sec. 31 of the same Act provides:

"The Exchequer Court shall have and possess concurrent original jurisdiction in Canada.

"(b) In all cases in which it is sought at the instance of the Attorney-General of Canada, to impeach or annul any patent of invention . . ."

Jurisdiction is also given to the Exchequer Court by sec. 45 of the Patent Act to decide whether a patent has become void by reason of importation or non-manufacture under sec. 38 of the Patent Act. Sec. 45 reads:

Jurisdiction to decide whether patent void under section 38 of Patent Act given by section 45, Patent Act.

"Any question which arises as to whether a patent or any interest therein, has or has not become void under any of the provisions of the seven last preceding sections of this Act, may be adjudicated upon by the Exchequer Court of Canada, which court shall have jurisdiction to decide any such questions upon information in the name of the Attorney-General of Canada, or at the suit of any

person interested; but this section shall not be held to take away or affect the jurisdiction which any court other than the Exchequer Court of Canada possesses."

Provincial Court can only impeach "for cause as aforesaid" under section 35, Patent Act.

In the Provincial Courts patents can be impeached only in the manner prescribed by sec. 35, by proceedings instituted by a writ of *scire facias*. Impeachment can only be "for cause as aforesaid" as provided by sub-sec. 2 of this section. The meaning of these words "for cause as aforesaid" was considered by Burhidge, Judge of the Exchequer Court, in the *Queen v. The General Engineering Company of Ontario* (1900) 6 Ex. C.R. 328. It was held that the section did not provide for impeachment where a patent was alleged to have expired on account of the expiry of a foreign patent by reason of sec. 8 of the Patent Act as it then stood, and the view was expressed that it is doubtful whether the words "for cause as aforesaid" should be extended beyond the grounds for which patents are declared void by what is now sec. 29. It is not seen how these words can apply to anything else. Certainly they can confer no jurisdiction to impeach for non-manufacture or importation, as these are not "causes as aforesaid" but causes arising under a subsequent section—38.

Exchequer Court is not confined to section 35 but under 35 can only impeach by *sci. fa.* procedure.

So far as the Exchequer Court is concerned the extent of application of sec. 35 is a question of procedure only. The Exchequer Court Act gives the Exchequer Court jurisdiction to impeach for any ground. Proceedings can only be instituted by *scire facias*, however, where authorized by sec. 35.

Sub-sec. 1 of sec. 29 reads:

Causes for impeachment under sec. 29.

"A patent shall be void, if any material allegation in the petition or declaration of the applicant hereinbefore mentioned in respect of such patent is untrue, or if the specifications and drawings contain more or less than is necessary for obtaining the end for which they purport to be made, when such omission or addition is wilfully made for the purpose of misleading: Provided that if it appears to the court that such omission or addition was an involuntary error, and if it is proved that the

patentee is entitled to the remainder of his patent *pro tanto*, the court shall render a judgment in accordance with the facts, and shall determine as to costs, and the patent shall be held valid for such part of the invention described as the patentee is so found entitled to."

The petition referred to is the petition required by sec. 7. The word "declaration" is not elsewhere used in the Act. At the time this section was first passed the practice in England was to present a petition verified by statutory declaration (Agneau on the Law and Practice of Patents for Invention), and it seems probable that the word "declaration" in the Canadian Act was used as referring to the oath or affirmation required to accompany the petition (sec. 10). The form of petition called for by the Patent Office follows substantially the wording of sec. 7 and sets forth that the petitioner or his assignor has invented

Declaration in section 7 probably refers to oath accompanying petition.

"new and useful improvements in . . . not known or used by others before his invention thereof, and not being in public use or on sale, with his consent or allowance, as such invention, for more than one year previous to his application for a patent in Canada." The oath reads: "That I verily believe that I am the inventor of the new and useful improvements in . . . described and claimed in the specifications relating thereto . . . ; that the same has not been patented to me, or to others, with my knowledge or consent except in the following countries . . . ; that the several allegations contained in the said petition are respectively true and correct."

Contents of petition.

It will be noted that the oath requires that patents for the invention in other countries shall be stated. This is not required by sec. 10. Under the section of the former Act, for which sec. 8 has been substituted, it was provided that an inventor should not be entitled to a patent if a patent for the same invention had existed in any other country for more than a year. The wording of the oath

Oath must set out foreign patents.

was doubtless to cover this provision. Sec. 8 as it now stands does not expressly provide that a patent shall not be granted, or if granted shall be void where a foreign patent had been in existence for more than a year, but it is thought it does so inferentially.

Specification containing more or less than necessary for obtaining the end for which they purport to be made.

Sec. 29 further provides that a patent shall be void "if the specifications and drawings contain more or less than is necessary for obtaining the end for which they purport to be made," but only "when such omission or addition is wilfully made for the purpose of misleading."

In "An Act respecting Patents of Inventions, Consolidated Statutes of Canada, 1859, chap. 34," a section dealing with actions for infringement reads in part as follows:

Early provisions.

Sec. 27, sub-sec. 2: "And if at the trial in any such action, it is made apparent to the satisfaction of the Court (the defendant having pleaded the same), that the specification filed by the Patentee does not contain the whole truth relative to the invention or discovery to which it refers, or that it contains more than is necessary to produce the desired effect, (such concealment or addition fully appearing to have been made for the purpose of deceiving the public) . . . judgment shall be rendered for the defendant, with costs, and the patent shall be declared void." This sub-section was copied from sec. 15 of the United States Act of 1836.

In the Act of 1869 the earlier section disappears and a section substantially the same as 29 of the present Act appeared.

Common law.

The United States section and the section found in the Consolidated Statutes of Canada, 1869, followed the English common law. Under the English law a patent is void if the patentee does not communicate all he knows. He must disclose the best form of his invention. If anything that gives an advantageous operation to the thing invented he concealed, the specification is void. In *Wood v. Zimmer* (1815) 1 W.P.C. 44, 82, the patent was for a method of making verdigris. The method described in the specification was sufficient to make verdigris,

but the inventor was accustomed, clandestinely, to use aquafortis with some advantage. It was said by Gibbs, L.J. "Now, though the specifications should enable a person to make verdigris substantially as good without the aquafortis as with it, still, inasmuch as it would be made with more labour by the omission of aquafortis, it is prejudicial concealment and a breach of the terms which the patentee makes with the public." The patent was held void. (See also *Retley v. Easton* [1852] Mac. P.C. 48; *Unwin v. Heath* [1855] 5 H.L. Cases 505; *The British Dynamite Co. v. Krebs* [1896] 13 R.P.C. 190 at p. 195; *Electric Boot & Shoe Finishing Co. v. Little*, 75 Fed. 276, 138 Fed. 732.)

It is open to argument that the present clause does not require full disclosure and that the specifications and drawings contain all that is "necessary for obtaining the end for which they purport to be made" if they describe a useful invention. We are of the opinion, however, that this section when read with sec. 13, requires a full description of the invention made and not merely of a useful invention.

Canadian section probably requires full disclosure.

In England it has also been the law that ambiguity or any unnecessary details introduced into the specifications for the purpose of misleading the public as to the nature and operation of the invention rendered the patent void. (*Turner v. Winter* [1787] 1 W.P.C. 80; *Crompton v. Ithotson* [1828] 1 W.P.C. 83.)

Ambiguity or unnecessary and misleading detail in England.

In fact the application of this clause both as to omissions and additions under the Canadian practice regarding claims must be very limited. The specifications and drawings must describe a useful invention, otherwise there is nothing to protect by the patent. It can be but seldom that a specification is sufficient to protect the invention and yet deceives or misleads.

Actual application in Canada limited.

Sec. 29 provides that where an omission or addition is made in the specifications or drawings through involuntary error and the patentee is entitled to the remainder of the patent, the patent may be held good for such part of the invention described as the patentee is found to be entitled to. The meaning of this provision is far from clear. It is not seen how in the case of an omission there can be any remainder to be held valid. Nor is it thought

Where omission or addition arises from involuntary error the patent is good for the remainder.

that the court can eliminate an unnecessary addition claimed to be a necessary part of the patent. (*Barnett-McQueen v. Canadian Stewart Company, Limited* [1910] 13 Ex. C.R. 186.) The only application apparently is where a patent contains a number of claims, some of which are good and some bad.

Section 29 as applied to claims.

The claims are part of the specifications and it would seem that a claim which can not be supported falls within the section. Where, however, some claims of the patent are good, a bad claim can render the patent void only where it has been made for the purpose of deceiving. Otherwise, in impeachment proceedings relief will be given as provided in the latter part of sub-sec. 1 of sec. 29, and in an infringement action as provided by sec 33. The fact that the applicant inserted certain claims in a Canadian application which were cancelled during the prosecution of the corresponding United States case was held not necessarily to have been done for the purpose of misleading, as he might have thought the United States Examiner wrong in objecting to them (*Copeland-Chatterson v. Hatton* [1906] 10 Ex. C.R. 224, 37 S.C.R. 651).

Provision as to furnishing copy of judgment to Patent Office applies only where patent void in part and good in part.

Sub-sec. 2 of sec. 29, providing for furnishing a copy of the judgment to the Patent Office, only applies to a judgment holding a patent void in part and good as to the remainder.

Grounds for declaring patent void under sec. 29 summarised.

The grounds upon which patents are declared void under sec. 29 were summarized by Burbidge, J., in *The Queen v. General Engineering Co.* (1900) 6 Ex. C.R. 328 at p. 343, as follows:

"(1) That the grantee had not invented the art, machine, manufacture or composition of matter, or the improvement therein, for which the patent had been granted.

"(2) That the alleged invention was not the proper subject matter for an invention;

"(3) That it was not new, but had been known and used by other persons before his invention;

"(4) That it had been in public use or on sale with the consent or allowance of the inventor for more than

one year previously to his application for a patent therefor in Canada;

"(5) That it was not useful; and

"(6) That the specifications were insufficient and misleading."

Exchequer Court Rule 16 reads:

"Any action or proceeding to impeach or annul any patent of invention may be instituted:

Procedure to impeach in Exchequer Court.

"(a) By information in the name of the Attorney-General of Canada; or

"(b) By a statement of claim filed by any person interested; or

"(c) By a writ of *scire facias* as provided in the 35th section of the Patent Act."

Under the rule a patent may be impeached in the Exchequer Court on any ground by proceedings commenced by Statement of Claim and unquestionably this is the simplest means of having a patent declared invalid. There seems to be no good reason why anyone should now use the more complicated *scire facias* proceedings in the Exchequer Court. Any advantage or convenience there might be in using the Provincial Courts is more than offset by the fact that the Provincial Courts can only impeach by *scire facias* proceedings and these are so uncertain and have become to such an extent obsolete, that it is almost impossible to define the practice.

Proceedings in the Provincial Courts under sec. 35 must be brought in the province or territory wherein the patentee has elected his domicile as required by sec. 11.

Proceedings in Provincial Courts under sec. 35 must be brought in province where patentee has elected his domicile. Consent of Attorney-General necessary in *sci. fa.* proceedings.

The consent of the Attorney-General to the issue of the writ of *scire facias* is necessary. (*Queen v. Pattee* [1871] 7 L.J. 124; *Ex Parte Paradis* [1854] 7 L.C.J. 130; *Attorney-General v. Bate* [1883] 27 L.C.J. 153, 6 L.N. 277.) In *Queen v. Pattee*, the Master in Chambers (Mr. Dalton) expressed the view that the Attorney-General of the Province was the proper officer to grant the fiat. The Court of Review in *Quebec* held in *Attorney-General v. Bate* that the proper official was the Attorney-General for the Dominion. In *Regina v. Smith* (1885) 7

O.R. 440, the fiat was that of the Attorney-General of Canada. In the Exchequer Court the fiat is that of the Attorney-General of Canada.

Mr. Justice Audette, in his book on Practice, states:

Procedure
to obtain
consent of
Attorney-
General.

"When a draft of the writ of *sci. fa.* has been prepared, a fair copy of it is laid before the Attorney-General of Canada, together with a short statement of the facts containing the date of the patent sought to be cancelled, the title of the inventor, the prosecutor's name and address, and mentioning whether the validity of the patent has already been tried and the result of any proceedings which may have been taken. A certified copy of the patent in question should also be produced. The permission to sue out the writ is usually granted as a matter of course, but as it means suing in the name of the King, the fiat is only granted upon the condition that the prosecutor give security.

"The reason for requiring the security is, that patentees may not be vexatiously harassed by action of *scire facias*, in which they could not recover costs against the prosecutor, and the condition of the bond is that if the defendant obtains a judgment in his favour, the prosecutor shall pay him the amount of his costs after taxation thereof."

Security to
be given.

The security required to be given by the Attorney-General of Canada is one thousand dollars, which is the amount of security required by Exchequer Court Rule 18 in a proceeding by Statement of Claim to impeach or annul a patent.

The practice in the Provincial Courts must be similar to that described by Mr. Justice Audette. In *Regina v. Smith* (1885) 7 O.R. 440, the security demanded was two thousand dollars.

Form of
writ of *sci.*
fa. in Ex-
chequer
Court.

In the Exchequer Court the form of writ of *scire facias* is given in Schedule "E" to the Rules of the Exchequer Court (see Rule 19). The pleadings used in *The Queen v. La Force* (1894) 4 Ex. C.R. 14, are set out in full in the report of the case. Forms of pleadings are also given in Audette's Practice of the Exchequer Court, second edition, p. 415.

CHAPTER XVIII.

PRACTICE IN INFRINGEMENT CASES.

In actions for the infringement of a patent the Provincial Courts and the Exchequer Courts have concurrent original jurisdiction.

Sec. 31 of the Patent Act reads:

"Any action for the infringement of a patent may be brought in the court of record having jurisdiction, to the amount of the damages claimed, in the Province in which the infringement is alleged to have taken place, which holds its sittings nearest to the place of residence or of business of the defendant; and such court shall decide the case and determine as to costs. R.S. c. 61, s. 30."

Exchequer Court and Provincial Courts have concurrent jurisdiction.

This section evidently does not include the Exchequer Court of Canada, but relates only to Provincial Courts. This question is, however, of no importance because the Exchequer Court Act, R.S.C. 1906, chap. 140, sec. 23, provides that "the Exchequer Court shall have jurisdiction as well between subject and subject as otherwise . . . (c) in all other cases in which a remedy is sought respecting the infringement of any patent of invention . . ."

Which provincial court of record has jurisdiction in infringement suits depends where damages are sought on the amount claimed. In England the County Courts have no jurisdiction to try an action of infringement where the validity of the patent is in dispute (*R. v. County Court Judge of Halifax* 1891, 1 Q.B. 793, 1891, 2 Q.B. 263). It would seem, however, that in Canada, a County Court being a court of record, would where there is a claim for damages for an amount within its jurisdiction in other matters, have jurisdiction under sec. 31 of the Patent Act (*Toronto Auer Light v. Colling* [1898] 31 O.R. 18). If, however, damages are not claimed,

Jurisdiction as between Provincial Courts depends on amount claimed as damages.

but only an injunction, the jurisdiction of the County Court is doubtful (*Stiles v. Ecclestone* 1903 1 K.B. 544).

Venue in
Provincial
Courts.

It was held in *Aitcheson v. Mann* (1883) 9 O.P.R. 253, 473, that sec. 31 was not *ultra vires* of the Dominion Parliament; that the word "may" was obligatory and not merely permissive; and that the reasonable construction of the Act was that the venue must be laid at the place of sittings of the court in which the action is brought, nearest to the residence or place of business of the defendant. In a court having jurisdiction throughout a Province the writ may be issued anywhere (*Shortt v. Federation Brand Salmon Canning Co.* [1899] 7 B.C.R. 197, 31 S.C.R. 378). In *Shortt v. Federation Brand Salmon Canning Co.* (1899) 6 B.C.R. 436, it was held that the place of business of the Company was at its head office where the pecuniary arrangements connected with the work and sale or export of the fish were made, and not a place where a cannery closed seven or eight months in the year was located. The question is probably one of fact in each case. It is not thought, however, that a company could object where the venue is laid at its head office as fixed in compliance with the act under which it is incorporated.

Extent to
which judgment in
favor of defendant
binding in
other
actions.

Sec. 34 of the Patent Act reads:

"The defendant in any such action may plead as matter of defence, any fact or default which by this Act, or by law, renders the patent void; and the court shall take cognizance of such pleading and of the facts connected therewith, and shall decide the case accordingly." R.S. c. 61, s. 33.

In *Maw v. Massey Harris Co.* (1902) 14 Man. 252 at p. 257, Bain, J., is reported to have said:

"Under sec. 33 [now 34] of the Patent Act, in an action for the infringement of a patent the defendant is empowered to plead as a defence to the action any fact which would render the patent void, and I suppose the effect of this enactment is that if such a plea is sustained the patent would be held to be void as against the defendant, though it would still *prima facie* be valid as against

anyone else." This would seem to be the correct view of the effect of this section.

The provisions of sec. 36 as to issue and filing of a certificate of judgment avoiding a patent would seem to apply only to proceedings taken to impeach the patent. The judgment in an infringement action would only be binding in other cases on points of law to the extent that any decision is binding on courts of co-ordinate jurisdiction or on lower courts. If, however, the facts were the same any but a higher court would probably defer to a previous decision. (Toronto Auer Light Co. v. Colling, 31 O.R. 18.)

The practice in actions for infringement does not differ in many points from that in other actions in the court where it is brought and does not require lengthy treatment. One of the few questions that can be discussed with any advantage is that relating to particulars.

The following rules of the Exchequer Court deal with particulars in infringement cases: Particulars.

"25. In an action for infringement of a patent the plaintiff must deliver with his statement of claim particulars of the breaches complained of. Exchequer Court rules.

"26. The defendant must deliver with his statement in defence particulars of any objections on which he relies in support thereof.

"27. If the defendant disputes the validity of the patent, the particulars delivered by him must state on what ground he disputes it, and if one of those grounds is want of novelty, he must state the time and place of the previous publication or user alleged by him.

"28. Further and better particulars may be ordered to be delivered as the court or a judge may see fit.

"29. Particulars delivered may be from time to time amended by leave of the court or a judge.

"30. At the hearing, no evidence shall, except by leave of the court or a judge, be admitted in proof of any allegations of which particulars are not so delivered.

"31. The court or a judge may disallow any costs of, or connected with, the particulars delivered, by either party if it appears that such particulars were unnecessary or have not been proven; and the court or judge may, notwithstanding the result of the action, order either the

plaintiff or the defendant, whether or not successful in the action, to pay to the opposite party any costs occasioned thereby."

Particulars
in Pro-
vincial
Courts.

In *Smith v. Greay* (1885) 11 P.R. 169, the power of the Ontario Courts to order particulars was discussed. The Chancery Division held that the delivery of particulars was a proceeding within the meaning of sec. 32 of the Patent Act providing that the court, or any judge thereof, might make orders "generally respecting the proceedings in the action." Boyd, C., dissenting, was of the opinion that this section went no further than to justify such general order for particulars as is usual in other cases. The other judges thought that the section gave power to make an order for particulars such as would have been made under the enactments and the practice under them in England. The judgment in *Mills v. Scott* (1849) 5 U.C.Q.B. 360, was distinguished as having been delivered at a time before there was any provision such as that contained in sec. 32.

A separate
statement of
particulars
not neces-
sary in
Provincial
Courts.

Smith v. Greay has been generally followed by Provincial Courts, but how far the judgment goes is far from certain. Since this judgment the practice in England as to particulars has been changed very considerably, but it can scarcely be contended that the Canadian practice should follow all the changes in the English rules. Probably the furthest the case can go is to make the practice in England at the time of the passing of this section a standard as to particulars required. It is not thought that this practice is very different from that prevailing in actions other than those relating to patents.

Smith v. Greay was a case where an application was made for further particulars and does not decide that a separate statement of particulars is required in the Provincial Courts. The rules of the Exchequer Court would seem to require particulars delivered separately from the pleadings. Frequently, however, particulars have been given in the Statements of Claim or Defence, and Audette, J., has intimated that where this is done further particulars need not be given. In the Provincial Courts particulars substantially the same as those required in the Exchequer Court should be set out in the pleadings. In this respect the practice in the Provincial Courts

would seem to be similar to that in Scotland (*Mica Insulator Co. v. Bruce, Peebles & Co., Ltd.* [1905] 22 R.P.C. 527). If the pleadings do not contain allegations of facts sufficiently full and definite to prevent surprise or embarrassment at the trial further particulars will be ordered. Quite apart from sec. 32 or any rules there is a general jurisdiction in the courts to make such an order (*Mason v. Vancamp* [1891] 14 P.R. 296; *Spedding v. Fitzpatrick* [1887] 38 Ch.D. 410). In most Provinces rules exist providing for orders for further particulars. (In Ontario, see Consolidated Rule 299.)

It may be questionable whether particulars delivered separately under the Exchequer Court rule or pursuant to an order in any court are technically part of the pleadings. Substantially, however, they have the same effect as the pleadings, and in the discussion which follows the word "particulars" will be used in a general sense covering particularity or detail required whether in pleadings or separate statement.

The general rule is that a party will at the trial be limited to the particulars given without an order being made for that purpose (*Young v. Erie & H. Ry. Co.*, 17 P.R. 4). It should be borne in mind that where evidence tendered comes within the terms of the particulars it will be admitted though they may be so general that further particulars would have been ordered (*Hull v. Bollard* [1856] 25 L.J. Ex. 304; *Sykes v. Howarth* [1879] L.R. 12 Ch.D. 826). It is therefore advisable to apply for an order for further particulars where it is considered that those delivered are too general. Where an order is made for further particulars a provision is frequently made for the exclusion of evidence if no further or insufficient particulars are delivered (*Noxon Brothers Manufacturing Company v. Patterson & Brother Company* [1894] 16 P.R. 40; *Duryea v. Kauffman* [1910] 17 O.W.R. 626, 1055, 2 O.W.N. 336, 476).

Application for further particulars should be made before the applicant pleads over. The rule in actions other than those relating to patents is that after pleadings are closed it will only be in exceptional circumstances that further particulars will be ordered, where it is shown that they are necessary for trial. (*Smith v. Boyd* [1895] 17

Evidence coming within terms of particulars admitted even though further particulars would have been ordered.

Particulars ordered in patent cases at any stage of action.

P.R. 463, 18 P.R. 296; *Bank of Toronto v. Insurance Co. of N.A.* [1897] 18 P.R. 27; *Savage v. C.P.R.* [1906] 16 Man. L.R. 376; *Rat Portage Lumher Co. v. Equity Fire Insurance Co.* [1907] 17 Man. L.R. 33.) In patent cases, however, it would seem that this general rule is not followed. (*Copeland-Chatterson Co. v. Lyman Brothers* [1907] 9 O.W.R. 900, at p. 912; *Moffatt v. Leonard* [1904] 3 O.W.R. 633.) In the Exchequer Court in *Davey Pegging Machine Co. v. Duplessis Pegging Machine Co.*, Oct. 4th, 1899, an order was made on the application of a plaintiff after he had filed his reply and issues had been joined (*Audette, Practice in the Exchequer Court*, 2nd Ed., p. 420). Where the details of the facts pleaded or set out in particulars die in the knowledge of the party asking particulars, further particulars may be postponed until after discovery (*Russell v. Hatfield* [1885] 2 R.P.C. 144; *Sims v. Slater* [1896] 10 C.L.T. 227).

Particulars
of breaches
—claims in-
fringed,
manner in
which they
are infringed

A plaintiff must give particulars of the breaches complained of (*Exchequer Court Rule 25*; *Copeland-Chatterson v. Business Systems, Limited* [1906] 7 O.W.R. 274, 348; *Kleinert Ruhher Co. v. Eisman Ruhler Co.* [1908] 12 O.W.R. 60; *Schroeder v. Donatt* [1909] 14 O.W.R. 103). He must specify what claims of his patent he alleges to be infringed. He may, however, state that he relies on all the claims. If this course is unreasonable it becomes a question of costs at the trial (*Haslam & Co. v. Hall* [1887] 4 R.P.C. 203). He must also state in what way the defendants have infringed. As to how far a plaintiff must go in this respect no principle can be deduced from the Canadian cases. The English cases would seem to show that less particularity is required from a plaintiff than a defendant (*Terrell on Patents*, 5th Ed., p. 325). The English rule recently adopted requires one specific instance of each type of infringement alleged. Before this rule was made it was apparently sufficient to indicate the type of infringement complained of. Instances were given only for purposes of identification. Even yet it is evident the plaintiff is not limited to damages to the instances given (*Haslam & Co. v. Hall* [1887] 4 R.P.C. 203; *Tilghman's Patent Sand Blast Co., Ltd. v. Wright & Butler, Ltd.* [1884] 1 R.P.C. 103; *Walter C. Church Engineering Co. v. Wilson* [1886] 3 R.P.C.

123). In the Exchequer Court the practice has been to require very full particulars from plaintiffs (see *Auer Incandescent Light Mfg. Co. v. O'Brien*, May 22, 1895; Audette, *Practice of the Exchequer Court*, 2nd Ed., p. 420).

Where a vendor is sued for infringement, greater particularity is required of the plaintiff than where the defendant is the manufacturer of the article said to infringe (*Mandleberg v. Morley* [1893] 10 R.P.C. 260).

A defendant must give particulars of all objections which he wishes to raise to the validity of a patent. The Canadian Courts have not laid down any very satisfactory rules as to how far statements of objections should go. Moreover our courts do not seem to have always borne in mind that the grounds of objection to the validity of a patent are not the same in Canada as in England. Some suggestions may be made as to the principal objections.

Want of subject matter—that is, that what has been patented did not amount to invention or does not come within any of the classes named in sec. 7, not being an “art, machine, manufacture or composition of matter”—must be pleaded or set out in the particulars (*Frost, Patent Law and Practice*, 4th Ed., p. 411; *Walton v. Potter* [1841] 1 W.P.C. 597; *Househill Co. v. Neilson* [1843] 1 W.P.C. 679). Further particulars of this objection were refused in *General Engineering Co. of Canada, Ltd. v. The Dominion Cotton Mills Co., Ltd.*, Dec. 28, 1898, Audette, *Practice of the Exchequer Court*, 2nd Ed., 421).

It may be objected that the subject matter of the patent was not invented by the patentee. This is substantially the objection raised in England that the patentee was not “the true and first inventor” and frequently in Canada the English wording is used with the evident intention of taking the same objection as would be taken by the same language in England. The use of the English plea is, however, misleading. In England “first inventor” does not necessarily mean the first person to invent, but only an actual inventor who first publishes. In Canada the first inventor the world over is the person who has first invented. He alone, it is submitted, can sustain a patent. The words “true and first inven-

Greater particularity required where defendant a vendor, than where he is a manufacturer.

Particulars of objections.

Want of subject matter—that which has been done does not amount to invention or is not an “art, machine, manufacture or composition of matter.”

Subject matter not invented by the patentee.

tor" therefore mean more in Canada than as used in England. In Canada when used in an objection they set up want of novelty. In England they are used not to set up want of novelty, but only that the thing patented, even though new in the sense that it had not been previously given to the public, was not the invention of the patentee, but of someone else (Terrell on Patents, 5th Ed., p. 20; Gibson and Campbell v. Brand [1841] 4 M. & G. 179, 1 W.P.C. at p. 627). If therefore the substance of the English objection that the patentee was not the true and first inventor is to be retained as a distinct objection in Canada, the language should be different.

It is submitted that the substance of the English objection should be preserved, and that the reasoning of the English cases requires that when it is desired to set up that the patentee did not invent what was patented, but got it from someone else, that this should be a distinct objection. The Canadian cases require that full particulars should be given as to the person whom the defendant claims was the first inventor (Terrell on Patents, 5th Ed., 337; Smith v. Greay [1885] 11 P.R. 169; Moffat v. Leonard [1904] 3 O.W.R. 633; Duryea v. Kaufman [1910] 17 O.W.R. 626, 1055; The General Engineering Co. of Canada, Ltd. v. The Dominion Cotton Mills Co., Ltd., Dec. 29, 1898, Audette, Practice in the Exchequer Court, 2nd Ed., 421).

Subject
matter not
new.

Following the language of sec. 7 of the Patent Act, the general objection may be taken that the subject matter of the patent was not new, but was known or used by some other person prior to the patentee's invention thereof. This objection is distinct from that just dealt with. The previous objection is that the patentee did not invent what is covered by the patent. This objection is that he was not the first inventor even though he may have actually invented the thing quite independently from anyone else.

This objection is want of novelty, but is not the same as the objection of want of novelty in England. Substantially, in England the objection of want of novelty means that the subject matter has been in the possession of the public prior to the patent. In England there may be novelty even though the invention had actually been

made prior to its invention by the patentee so long as there was no publication or public use. In Canada this is not the case. There is no novelty if the invention was known to any other person prior to its invention by the patentee. The patentee must be the first inventor in the literal sense, and not as this term is understood in England. As already pointed out, therefore, the common pleas "not first inventor" and "want of novelty" are in Canada not distinct. Novelty is necessary so that the patentee may be the first inventor.

The objection that the subject matter is not new, but was known or used by some other person prior to the patentee's invention, may rest in general public knowledge or on specific anticipations.

From one aspect general public knowledge goes to the question of subject matter and might be considered as an objection to want of subject matter. However it is looked at, objection should be clearly taken. Common public knowledge may be proved by ordinary evidence, with reference to well-known books, if necessary, but not by reference to single prior specifications or rare books, or by evidence of particular knowledge or user not of a general character. It is submitted that further particulars of the objection of common public knowledge should not be ordered and that Exchequer Court Rule 27 requiring statement of time and place of previous publication or user alleged does not apply to the objection of want of novelty on the ground of common public knowledge, but only to specific anticipations. (Frost Patent Law and Practice, 4th Ed., p. 419; Holliday v. Heppenstall [1889] 6 R.P.C. 320; Automatic Weigbing Machine Co. v. Knight [1889] 6 R.P.C. 297 at p. 302; Edison Telephone Co. v. Indian Rubber Co. [1881] L.R. 17 Cb.D. 137; Peckover v. Rowland [1893] 10 R.P.C. 118; 234; Solvo Laundry Supply Co. v. Mackie [1893] 10 R.P.C. 68; English and American Machinery Corporation v. Union Boot and Shoe Co. [1894] 11 R.P.C. 367.) In Duryea v. Kaufman [1910] 17 O.W.R. 626, 1055, 2 O.W.N. 336, 476, however, it would seem that further particulars of something very similar to this objection were ordered.

Want of novelty may be based on general public knowledge of which particulars need not be given.

Or specific anticipations of which full particulars must be given.

Where it is intended to give evidence of knowledge or user by some particular persons full particulars must be given with names and places. Specifications to be used at the trial should be clearly identified and the parts relied upon indicated. (Smith v. Greay [1885] 11 P.R. 169; Moffat v. Leonard [1905] 5 O.W.R. 259; Duryea v. Kaufman [1910] 17 O.W.R. 626, 1055, 2 O.W.N. 336, 476; The General Engineering Co. of Canada, Ltd. v. The Dominion Cotton Mills Co., Ltd., Dec. 29, 1898, Audette Practice in the Exchequer Court, 2nd Ed., 421; Terrell on Patents, 4th Ed., 339.)

The defendant should also point out the claims of the patent affected by anticipatory matter. (London & Leicester Co. v. Griswold [1886] 3 R.P.C. 251; Harris v. Rothwell [1886] 3 R.P.C. 243 at p. 383; Holliday v. Heppenstall [1889] 6 R.P.C. 320; Sidehottc.n v. Fielden [1891] 8 R.P.C. 266.)

Subject matter not useful.

A patent may be objected to on the ground that the invention is not useful. In England further particulars of the objection are not required (Terrell on Patents, 5th Ed., p. 341), and there seems to be no good reason why they should be ordered in Canada. However, in the case of Duryea v. Kaufman (1910) 17 O.W.R. 626, 1055, 2 O.W.N. 336, 476, further particulars were ordered "in which respect the patent was not useful at the time of the alleged invention or at any other time as stated."

Invention abandoned.

Abandonment of the invention is an objection on which we can obtain little help from the English or Canadian cases. It is thought that full particulars as to the manner, time, and place of abandonment should be given.

Subject matter in public use or on sale for more than one year.

The objection arising under sec. 7, that the invention was in public use or on sale with the allowance of the inventor for more than one year prior to the application for the patent is a form of constructive abandonment. It is believed that this objection should be set out very fully with particulars of time and place of user or being on sale.

Where it is intended to attack the patent on the ground that the specifications are defective full particulars should be given. In England the objection that the specification does not define the limits of the invention claimed is

sufficient and does not require to be further particularized (Terrell on Patents, 5 Ed., p. 342; *British Ore Concentration, Ltd. v. Minerals Separation, Ltd.* [1907] 24 R.P.C. 723).

The objection that the specification is insufficient should be set forth fully, indicating the defect and where a workman would meet with difficulty in carrying out the directions given. (Terrell on Patents, 5th Ed., p. 341; *Crompton v. Anglo-American Brush Electric Corpn.* [1887] 4 R.P.C. 197; *Heathfield v. Greenway* [1894] 11 R.P.C. 17; *Dege's Patent* [1895] 12 R.P.C. 448; *Jones v. Galbraith* [1901] 22 C.L.T. 76; *Duryea v. Kaufman*, 17 O.W.R. 626, 1055, 2 O.W.N. 336, 476.) There is, however, a limit to the particulars which can be demanded. ("*Z*" *Electric Lamp Manufacturing Co., Ltd. v. Marples, Leach & Co., Ltd.* [1909-10] 26 R.P.C. 677, 27 R.P.C. 305; 737.)

Sec. 29 of the Patent Act provides that a patent shall be void if the specifications or drawings contain more or less than is necessary for the end for which they purport to be made, when such omission or addition is wilfully made for the purpose of misleading. This objection should be taken separately and full particulars should be given in which the specifications contain more or less than is necessary for the end for which they purport to be made and in which respect they are misleading. (*Farhenfabriken vorm F. Bayer v. Bowker* [1891] 8 R.P.C. 389 at p. 391; *Heathfield v. Greenway* [1894] 11 R.P.C. 17; *The General Engineering Co. of Canada, Ltd. v. The Dominion Cotton Mills Co., Ltd.*, Dec. 28, 1898, *Audette Practice in the Exchequer Court*, 2nd Ed., 420.)

Patents which have not been placed under the compulsory license clauses of sec. 44 may be attacked for failure to comply with the terms of sec. 38 for failure to manufacture within two years from the date of issue or failure to continue to manufacture after two years so as to supply the demand. No further particulars can be given of the objection of failure to manufacture within two years, but where there has been manufacture to some extent and the attack is on the ground of failure to supply the demand, full particulars should be given as to demand made and refused for the patented article and probably of tender of a reasonable price.

Specifications or drawings contain more or less than is necessary for the end for which they purport to be made.

Patent void under section 38 for failure to manufacture

Patent void under section 38 for importation.

Patent void by reason of existence of a foreign patent for more than one year prior to application in Canada.

Prior publication probably not ground for objection

Prior user not a ground except where it has occurred for more than a year with consent of inventor.

Interlocutory injunctions.

Evidence required.

Under sec. 38 it may be objected that there has been importation after one year. Particulars should be given of the time and place of such importation.

Formerly the existence of a foreign patent for more than one year prior to the application in Canada rendered the patent void. While there may be some doubt as to the law it is thought that this is still a ground of objection. If it is, then the foreign patent should be referred to so as to identify it.

It is thought that prior publication of the patented invention is not a ground for attacking a patent in Canada. It is submitted that prior publication is at most evidence of abandonment and not evidence of any real weight. Publication of the invention of another who first invented is not necessary to invalidate the patent of the subsequent inventor. It is sufficient if the other has actually invented.

Prior user of the patentee's invention is only a defence where it has occurred more than a year prior to the application with the consent of the inventor as provided in sec. 7. Prior user of the invention of another is not of importance except as evidence. If the invention actually existed prior to the invention by the patentee, his patent is had whether there was user or not.

In patent cases the practice as to interlocutory injunctions is similar to that in other cases. An application may be made at any time after commencement of the action, and in cases of urgency the order may be made *ex parte*. (Muntz v. Grenfell [1842] 2 Weh. P.C. 88, 91; United Telephone Co. v. Tasker [1888] 5 R.P.C. 628.) The application must be supported by affidavit. In England, the plaintiff, if he is the first inventor, must swear to the fact, as also to the novelty and utility of the invention, and to the due filing of a sufficient application. If the plaintiff is an assignee, he must swear to the best of his belief and must state the sources of his information. (Terrell on Patents, 5th Ed., p. 352.) In Canada the patent is *prima facie* evidence of novelty and utility. Possibly the affidavit need not cover these points. In the Welshach Incandescent Light Co. v. Shenhein, March 15, 1897 (Audette Practice of the Exchequer Court, 2nd Ed., p. 509), an application for an injunction was

refused with leave reserved to apply on further material because the affidavits did not show (1) the rights the several plaintiffs had in the patent, (2) where the alleged acts of infringement occurred, (the patent running through only a given territory), (3) where the defendant had his place of business at the time of the alleged acts of infringement.

In England an interim injunction will ordinarily not be granted in the case of a new patent. (Caldwell v. Van Vlissingen [1851] 9 Harc 415, 424; Renard v. Levinstein [1864-5] 2 H. & M. 628; Lister v. Norton [1886] 3 R.P.C. 202; Jackson v. Needle [1884] 2 R.P.C. 191; British Tanning Co. v. Groth [1891] 8 R.P.C. 113; Holophane Ltd. v. Brend & Co. [1898] 15 R.P.C. 18 at p. 19; Jackson v. Needle [1884] 2 R.P.C. 191; Wapshare Tube Co. v. Hyde Imperial Rubber Co. [1901] 18 R.P.C. 374; Spencer v. Holt [1902] 20 R.P.C. 142.) The circumstances must usually be such as to create a presumption of validity of the patent. Such a presumption will arise where there has been a long continued working, user and enjoyment of the patent rights, or where there has been a trial as to the validity of the patent which has terminated in favour of the patentee. (Universities of Oxford and Cambridge v. Richardson [1802] 6 Ves. 706; Gardner v. Broadbent [1856] 2 Jur. N.S. 1041; Dudgeon v. Thompson [1873] 3 App. Cas. 34; Muntz v. Foster [1843] 2 W.P.C. at p. 95; Rothwell v. King [1886] 3 R.P.C. 379; Hayward v. Pavement Lg. Co. [1884] 1 R.P.C. 207.) An order may be made also where the defendant has admitted the validity of the patent (Dircks v. Mellor [1845] 26 Lon. Journ. 268), or where the defendant is unable to set up want of validity by reason of estoppel or otherwise.

Circumstances must create a presumption of validity of patent.

In Canada it seems to be accepted that there is a *prima facie* presumption of the novelty and utility of the invention and that the patentee is the first and true inventor, which arises from the grant of the letters patent (Overend v. Burrow, Stewart & Milne Co. [1909] 19 O.L.R. 642; The Electric Fire Proofing Company v. The Electric Fire Proofing Company of Canada [1910] 43 S.C.R. 182, (Q.R. 31, S.C. 34); Copeland-Chatterson Co. v. Lymann Bros. Co. [1907] 9 O.W.R. 908 at p. 912; Blount v. Societe, 53 Fed. 98, 3 C.C.A. 455; Smith v.

English law followed in Canada notwithstanding presumption arising in Canada from patent.

Goodyear [^]Dental Vulcanite Co., 93 U.S. 486; Lehnheuter v. Holthaus, 105 U.S. 94.) Notwithstanding this presumption the English law requiring other circumstances creating a presumption of validity to warrant granting an interim injunction has been followed in at least two cases. (Bonathan v. Bowmanville Furniture Manufacturing Company [1870] 5 P.R. 195; Ottawa and Hull Power and Manufacturing Company, Limited v. Murphy [1906] Q.R. 15 K.B. 230.) This practice is supported by the practice in United States Courts, which requires something such as adjudication against others or acquiescence by the public to aid the presumption which the patent raises. (Adam v. Folger, 120 Fed. 260, 56 C.C.A. 540; Blount v. Societe, 53 Fed. 98, 3 C.C.A. 455; Electric v. Edison, 61 Fed. 834, 10 C.C.A. 106; McCoy v. Nelson, 121 U.S. 484, 30 L. Ed. 1017; High on Injunctions, 4th Ed., 961.)

Interim injunction refused where there has been acquiescence or delay.

An interim injunction will be refused where there has been anything amounting to acquiescence on the part of the plaintiff (Neilson v. Thompson [1841] 1 W.P.C. 275), or where there has been unexplained delay in making the motion. (Bovill v. Crate [1865] L.R. 1 Eq. 388; Lister v. Norton [1886] 3 R.P.C. 202; United Telephone Co. v. Equitable Telephone Co. [1888] 5 R.P.C. 235; Leonhardt v. Kalle [1894] 11 R.P.C. 534; Dunlop Pneumatic Tyre Co. v. Stone & Corser [1897] 14 R.P.C. 263; Aluminum Co. v. Domeiere [1897] 15 R.P.C. 32; North British Rubber Co. v. Gormully & Jeffrey Manufacturing Co. [1894] 12 R.P.C. 17.) Delay may in some cases be satisfactorily explained. (United Telephone Co. v. Equitable Telephone Co. [1888] 5 R.P.C. 235; Bovill v. Smith [1867] L.R. 2 Eq. 459; United Telephone Co. v. Equitable Telephone Co. [1888] 5 R.P.C. 233.)

Prima facie case of infringement or threatened infringement.

The applicant for an interim injunction must satisfy the court that there is a *prima facie* case of actual infringement which will be proved at the trial when the case is tried out (Shillito v. Larmoth & Co. [1885] 2 R.P.C. 1; Challender v. Royle [1887] 4 R.P.C. 363 at p. 372; Briggs & Co. v. Lardeur et al. [1884] 1 R.P.C. 126; Anderson v. Patent Oxonite Co. [1886] 3 R.P.C. 279), or a deliberate intention to infringe, and that what is threatened would amount to infringement (Frearson v. Loe [1878] L.R. 9 Ch.D. at p. 65; Dowling v. Billington

[1890] 7 R.P.C. at p. 191; *Shoe Co. v. Cutlan* [1896] 13 R.P.C. at p. 141).

Given a *prima facie* case as to validity and infringement the court will be governed by the balance of convenience. It will consider the probability of grave injury to one side or the other arising from the grant, or of the refusal to grant the order. Where an interim injunction would cause serious injury to the defendant, and no direct benefit to the plaintiff, it will be refused (*Neilson v. Thompson* [1841] 1 W.P.C. 275 at p. 286; *Morgan v. Seaward* [1837] 1 W.P.C. 167 at p. 170; *Thompson v. Hughes* [1890] 7 R.P.C. 71; *Moser v. Sewell* [1893] 10 R.P.C. 365 at p. 367). Where the plaintiff has had long enjoyment and an established trade, and the defendant's trade is a new one, and his sales are likely to be large, the balance of convenience will usually be in favour of an injunction (*Plimpton v. Spiller* [1876] 4 Ch.D. 286 at p. 292; *Bracher v. Bracher, Dean & Co.* [1890] 7 R.P.C. 420 at p. 422; *Brooks v. Lycett's Saddle Co.* [1903] 20 R.P.C. 575 at p. 577; *Stevens v. Keating* [1848] 2 W.P.C. 175, 8 R.P.C. 259).

Balance of convenience.

It is no answer to a motion for an interlocutory injunction that the defendant has volunteered to keep an account (*Read v. Andrews* [1885] 2 R.P.C. 119 at p. 122). As a matter of discretion, however, an interim injunction is frequently refused when the defendant undertakes to keep an account and the court is satisfied that the defendant is financially able to pay any award made against him (*Gardner v. Broadbent* [1856] 2 Jur. N.S. 1041; *Copeland v. Webb* [1862] 11 W.R. 134; *Jackson v. Needle* [1884] 2 R.P.C. 191; *Lister v. Norton* [1886] 3 R.P.C. 202), or where the defendant offers to discontinue the use of the alleged infringement until trial (*Gillette Safety Razor Co. v. Gamage* [1907] 24 R.P.C. 1). Injunctions have also been refused upon the defendants paying a sum of money into court as security (*Edison-Bell Phonograph Corporation, Ltd. v. Hough* [1894] 11 R.P.C. 594; *North British Co. v. Gormully & Jeffrey Mfg. Co.* [1894] 12 R.P.C. 17).

Undertaking to keep an account.

Where an interlocutory injunction is granted in a patent case, the ordinary undertaking as to damages is required (*Fenner v. Wilson* [1893] 10 R.P.C. 283, 287; Undertaking as to damages.

Delap v. Robinson [1898] 18 P.R. 231). The usual form of undertaking is as follows: "And the plaintiff, by his counsel, undertaking to abide by any order which this court may make as to damages, in case the court shall hereafter be of opinion that the defendant (or defendants, or any or either of them) shall have sustained any by reason of this order, which the plaintiff ought to pay." Notwithstanding the fact that the injunction may be afterwards dissolved, it is still, however, in the discretion of the court to refuse a reference as to damages (*Hessin v. Coppin* [1874] 21 Gr. 253).

Guarantee to secure undertaking where plaintiff out of jurisdiction.

Discovery.

Where the plaintiff is out of the jurisdiction he must give the guarantee of a responsible person within the jurisdiction (*Delap v. Robinson* [1898] 18 P.R. 231). A bond is the usual method of supplying this guarantee.

The rules as to discovery in actions for infringement of patents are the same as in other actions, notwithstanding that under the rules of procedure governing these actions ample particulars must be given both by the plaintiff and defendant. (*Ross on Discovery*, p. 282.) In some of the Provinces the English practice of delivering interrogatories obtains. In the Exchequer Court, and in the Ontario and Manitoba Courts, we have instead of this practice examination for discovery. The practice as to production of documents is substantially the same in all Canadian courts.

Rule that parties not bound to disclose evidence does not apply where disclosure necessary to put other party in possession of case to be met.

It is a general rule that a party will not be allowed to put questions which extend to the evidence wherewith the party interrogated or examined for discovery intends to support his case at the trial, or to the names of his witnesses. It is submitted that this rule does not apply in patent cases when it is necessary to disclose the names of witnesses in order to put the other side in possession of the case he has to meet. In *Smith v. Greedy* (1884) 10 P.R. 482, *Boyd, C.*, held that in a patent case a defendant might be interrogated as to the grounds of his attacking the validity of the plaintiff's patent, and that there must be a fair and full disclosure of the particular line of attack which was contemplated, but no such individualizing of the persons who are alleged to be prior users as would enable the plaintiff to fix upon the defendant's witnesses. It is thought that this decision was in

effect overruled by the judgment delivered on an application for particulars in the same case (*Smith v. Greycy* [1885] 11 P.R. 169) where it was decided that names of prior users might be ordered to be given. In England, where prior user is set up, the defendant may be compelled to answer interrogations asking the names and addresses of the persons using the invention as alleged, as well as the places where the prior user has taken place. (*Alliance Pure White Lead Syndicate, Ltd. v. MacIvor's Patents* [1891] 39 W.R. 487.) It is thought that the rule is similar in Canada, where anticipation or use for more than a year with the consent of the inventor is set up.

The fact that the particular discovery sought will lead to the disclosure of the private affairs of the opposite party will not be a sufficient ground to refuse it if necessary to enable the party to establish his case. Names of customers may be relevant and necessary, for example, as between licensor and licensee to prove user, the question of user being material as to whether an account shall be given (*Ashworth v. Roberts* [1890] 45 Ch.D. 623), or on an enquiry as to damages, or an accounting as to profits (*Saccbarin Corporation v. Chemicals and Drugs Co.* [1900] 2 Ch. 656). Discovery is not prevented by the fact that the answers may expose the customers to actions (*Tetley v. Easton* [1852] 2 C.B.N.S. 706; *Horne v. McKernan* [1862] 30 Beav. 547; *Bovill v. Cowan* [1867] 15 W.R. 608). Discovery is not refused because it is alleged that if given, a trade secret or secret process will be disclosed.

The court will, however, as far as possible, protect against such disclosure. (*Renard v. Levinstein* [1864] 10 L.T. 94; *Benno Jaffé und Darmstaedter Lanolin Fabrik v. Richardson* [1893] 68 L.T. 404; *Ashworth v. Roberts* [1890] 45 Ch.D. 623; *Badische Anilin, etc., Fabrik v. Levinstein* [1883] 24 Ch.D. 156, [1885] 29 Ch.D. 366, 394.) In *Dickerson v. Radcliffe* (1897) 17 O.P.R. 586, the action was brought to restrain defendants from selling a certain drug in violation of rights of the plaintiff under a patent, and of the terms under which the drug was sold to the defendants. There was a contest as to the patent. The court refused as a matter of discretion to compel the defendants before the trial to disclose their

Private affairs must be disclosed where disclosure necessary to enable other party to make his case.

transactions as to the buying and selling the drug, even though this course might mean a double trial.

In *Parramore v. Boston Mfg. Co.* (1902) 4 O.L.R. 627, the defendants objected to answer certain questions as they were put for the purpose of declaring the plaintiff's patent forfeited under the statute. It was held that the action was not one for forfeiture, but an action in which the defendants had a right to contend that the rights of the plaintiff had been extinguished on non-performance of the conditions on which he obtained his patent, and that the plaintiff was entitled to the fullest discovery, including information as to agreements and transactions made and carried on between them and certain agents employed by him for the manufacture and sale of the patented invention.

Privileged communications.

Communications between a patentee and his patent agent relative to the preparation of the specification are not privileged (*Moseley v. Victoria Rubber Co.* [1886] 3 R.P.C. 351). Opinions of experts are not privileged unless obtained for use in the litigation in question (*Toronto Gravel Road Co. v. Taylor* [1875] 6 P.R. 227). Copies of foreign patents, obtained by solicitors for purposes of use in the case, are privileged (*Guelph C. Company v. Whitehead* [1883] 9 P.R. 509).

Inspection.

Sec. 32 of the Patent Act provides that the court or judge may make such order as the court or judge sees fit for and respecting inspection. The "inspection" mentioned is inspection of machinery or processes with a view to evidence of infringement, and not of books. (*Vidi v. Smith* [1854] 23 L.J.N.S. 342.) In the Exchequer Court, rule 32 provides that the court or judge may make such order for inspection and impose such terms and give such descriptions respecting the same and the proceedings thereon as the court or judge may see fit. In some of the Provincial Courts rules dealing specially with inspection exist (see Ontario Consolidated Rule 1096).

Inspection a matter of discretion.

Inspection has not been considered a matter of right (*Piggott v. The Anglo-American Telegraph Co.* [1868] 19 L.T.N.S. 46). It is only granted where a *prima facie* case is made out of infringement (*The Singer Sewing Machine Co. v. Wilson* [1865] 12 L.T.N.S. 140; *Shaw v. The Bank of England* [1852] 22 L.J. Ex. 26; *Batley v. Kynock*

[1874] L.R. 19 Eq. 90; *Germ Milling Co. v. Robinson* [1884] 55 L.J. Ch. 287, 1 R.P.C. 217; *Cheetham v. Oldham* [1888] 5 R.P.C. 621) and where the court is satisfied that the inspection sought is necessary to the case of the party seeking it (*Piggott v. Anglo-American Telegraph Co.* [1868] 19 L.T.N.S. 46; *Batley v. Kynock* [1874] L.R. 19 Eq. 90; *Cheetham v. Oldham* [1888] 5 R.P.C. 617; *Shaw v. Bank of England* [1852] 22 L.J.N.S. Ex. 26; *Meadows v. Kirkman* [1860] 29 L.J.N.S. Ex. 205) or that the inspection is the only method of determining which of conflicting statements made by the parties is true. (*Swain v. Edlin-Sinclair Tyre Co.* [1903] 20 R.P.C. 435.)

The court will not allow inspection to be oppressive or to be carried beyond what is necessary in the interest of justice. (*Frost, Patent Law and Practice*, 4th Ed., 460; *Bovill v. Moore* [1815] 2 Coop. Ch. Cas. 56; *Russell v. Cowley* [1835] 1 W.P.C. 459; *Piggott v. Anglo-American Telegraph Co.* [1868] 19 L.T.N.S. 46.) In *Flower v. Lloyd* (1876) W.N. 169, 230, and *Swain v. Edlin-Sinclair Tyre Co.* (1903) 20 R.P.C. 435, the inspection was limited to scientific men, even the plaintiff being excluded. (See also *Plating Co. v. Farquharson* [1881] Griff. P.C. 187.)

Inspection not allowed to be oppressive.

The court in England has ordered samples to be given (*The Patent Type Foundry Co. v. Walter* [1860] 1 Johns 727; *Germ Milling Co. v. Robinson* [1886] 3 R.P.C. 11). Where the parties agree on inspection without order, the costs of such inspection may be allowed. (*Ashworth v. English Card Clothing Co., Ltd.* [1903] 20 R.P.C. 790, 21 R.P.C. 553.)

Samples may be ordered to be furnished. Costs of inspection agreed upon.

In England it is provided by the Patents and Design Act (1907) Sec. 31 (1) that patent actions are to be tried without a jury unless the court otherwise directs. Trials by jury in patent cases have been very rare since 1883. It seems to be the general view that a jury will only be allowed where there is an allegation of fraud. (*Frost Patent Law and Practice*, 4th Ed., 486.)

Jury in England only where fraud alleged.

In Canada the Patent Act says nothing as to how a patent case is to be tried. In *Vermilyea v. Guthrie* 9 P.R. 269, *Boyd, C.*, expressed the view that an action for the infringement of a patent should not ordinarily be

In Canada jury in patent cases not generally allowed.

tried by a jury. In recent years trial by jury is practically unknown in patent cases. In the Exchequer Court there is no provision for trial by jury.

Questions as to onus of proof at the trial are difficult. Some discussion will be attempted.

Patentee must prove his patent.

On the trial, unless it is admitted, the patentee must prove his patent. The patent may be proved by the production of the patent itself or of a copy certified under the seal of the Patent Office. (Patent Act, sec. 60.)

Title proved by patent where grant made to assignee.

Where the patent was originally granted to the assignee of the inventor, it is *prima facie* evidence of title of the assignee. (Walker on Patents, 494.)

Title acquired after grant must be proved.

Where, however, the plaintiff obtained his title after the patent issued, he must prove his title. The documents through which the title has been acquired may be proved as any other documents are proved. Where the documents have been deposited in the Patent Office, they may be proven by copies certified under the seal of the Patent Office. (Patent Act, sec. 60.)

Plaintiff has right to begin and reply.

In an action for infringement the plaintiff has the right of beginning and of replying, notwithstanding that the burden of proof may really be on the defendant. (Terrell on Patents, 4 Ed., 368.)

In *scire facias* proceedings prosecutor has right to begin in Provincial Courts, but practice reversed by rules in Exchequer Court.

In an action of *scire facias* in the Provincial Courts the burden of proof is on the prosecutor as to the greater number of issues and usually he has the right to begin. (Hindmarsh on Patent Privileges, 499.) In the Exchequer Court the practice has been changed. Exchequer Court rule 23 reads: "On the trial of any action to impeach or annul a patent of invention 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." The rule follows the practice prescribed by the Imperial Statute of 1883, sec. 26, sub-sec. 7.

Specification is proven as part of patent.

Under the Canadian law the specifications form part of the patent and are therefore proven when the patent is proven. (Patent Act, sec. 13; Collette v. Lasnier [1886] 13 S.C.R. 563; Smith v. Ball [1861] 21 U.C.Q.B. 126; Queen v. LaForce [1894] 4 Ex. C.R. 14; Hogg v. Emerson [1845] 6 Howard 437; O'Reilly v. Morse, 15 Howard 621.)

What the patented invention is, is ascertained from the patent as a matter of construction and can be proven in no other way. The court may, however, be assisted in interpretation by experts in several ways. Experts may explain technical terms, give evidence as to the state of knowledge at the date of the alleged invention, so as to enable the court to decide between possible constructions, explain the practical working of that which is described, or point out the relative importance of the different parts of the described invention. The burden of proving infringement is on the plaintiff. Where the infringement complained of is the sale or use of the patented invention, the plaintiff must prove that the article sold or used was not made by himself or his agents. (*Betts v. Willmot* [1871] L.R. 6 Ch. 239.)

Subject matter ascertained construction of patent with assistance of experts as to technical terms, state of art, etc.

Onus on plaintiff to prove infringement.

Experts cannot be asked to give an opinion as to whether or not there has been infringement. (*Seed v. Higgins* [1860] 8 H.L.C. 550; *Parkinson v. Simon* [1894] 11 R.P.C. 238 at p. 493.) Expert evidence may, however, be called to show the particulars in which an alleged invention has been used by an alleged infringer, and the real importance of whatever differences there may be between the plaintiff's invention and whatever is done by the defendant. (*Brooks v. Steele and Currie* [1897] 14 R.P.C. 46 per Lindley, L.J.) Experts may also be asked whether the defendant's variations are not mechanical equivalents. (*Ticket Punch Co. v. Colley's Patents* [1894] 12 R.P.C. at p. 186.)

Experts can not be asked whether there has been infringement.

American cases have held that under the United States Statute the patent is *prima facie* evidence that in the specification there is contained a description in such full, clear and exact terms as will enable anyone in the art to which it appertains to put it in practice. (*Poppenbusen v. New York Gutta Percha Comb Company* [1858] 2 Fish. 62; *Westlake v. Cartter* [1873] 6 Fish. 519; *Robertson on Patents*, Vol. III., p. 242.) In England where the defendant alleges that there is a defect or insufficiency in the specification, the burden of proving that there is no such defect is on the plaintiff. (*Terrell on Patents*, 4 Ed., p. 370.) In Canada we are without authority. The examination in the Patent Office must cover sufficiency as well as novelty, and the Canadian cases which

Onus where defect in specifications alleged is probably on defendant in Canada.

have held that there is a presumption of novelty, may, perhaps, support the view that the Canadian law is the same in Canada as in the United States.

Sufficiency depends on whether intelligible to ordinary workman in art.

In proving sufficiency or insufficiency the question is whether the specification is intelligible to the ordinary workman in the particular art. (*Plimpton v. Malcolmson* [1876] L.R. 3 C.D. 531; *Edison v. Holland* [1889] 6 R.P.C. 243.) Experts may give evidence as to whether the specification would or would not be intelligible to ordinary workmen, or ordinary workmen may be called.

Where wilful omission or addition alleged onus on defendant

Where it is alleged that the patent is void by reason of an omission or addition wilfully made for the purpose of misleading (Patent Act, sec. 29) it is thought the onus must be on the person attacking the patent.

Want of novelty and not "true and first inventor" in England and Canada.

The plea that the patentee was not "the true and first inventor" and want of novelty are in England distinct defences. In Canada the invention is not patentable if it was known by any other person at the date of the invention. The invention is therefore not new unless the applicant for a patent was in the literal sense the first inventor.

In England the onus is on the defendant to prove if he so alleges that the patentee was not "the true and first inventor." (*Ward v. Hill* [1901-3] 18 R.P.C. 481 at p. 490, 20 R.P.C. 189; *Kelvin v. Whyte, Thompson & Co.* [1907] 25 R.P.C. 177, p. 189.) Where the defence of want of novelty is raised, the onus is on the patentee to make a *prima facie* case of novelty. When this has been done the onus is on the defendant (*Cornish v. Keene* [1835] 1 W.P.C. 501 at p. 509; *Manton v. Parker* [1815] Davies P.C. 350; *Galloway v. Bleadon* [1839] 1 W.P.C. 526; *Amory v. Brown* [1869] L.R. 8 Eq. 663; *Harris v. Rothwell* [1886] 3 R.P.C. 243; *Westley Richards v. Perkes* [1893] 10 R.P.C. 181).

In Canada if separate defence to effect that invention was not made by plaintiff but by someone else, onus on defendant.

If the English defence that the patentee was not "the first and true inventor" is to be used as a separate defence in Canada, different language must be used. In one phase the substance of the English defence is applicable, where it is alleged that the invention was not invented by the patentee, but was stolen by him from someone else. When this defence is set up, the onus is undoubtedly on the defendant.

As to the onus where want of novelty is pleaded, the Canadian cases have followed the United States law rather than the English, and it seems to be very well established that a presumption of novelty arises from the patent, and that the onus is on the defendant to show want of novelty. The basis for this appears to be the examination by the Patent Office (Patent Act, sec. 15; *Overend v. Burrows, Stewart, & Milne Co.* [1909] 19 O.L.R. 643; *The Electric Fire Proofing Co. v. The Electric Fire Proofing Company of Canada* [1910] Q.R. 31 S.C. 34; 43 S.C.R. 182; *Copeland-Chatterson Co. v. Lyman Bros. Co.* [1907] 9 O.W.R. 908; *Rolland v. Fournier* [1912] 4 D.L.R. 756; *Blount v. Societe*, 53 Fed. 98, 3 C.C.A. 455; *Smith v. Goodyear*, 93 U.S. 486; *Lehnbeuber v. Holt-haus*, 105 U.S. 94).

In Canada onus on defendant where want of novelty set up.

In England, where the defence of want of utility is raised, the onus is apparently on the patentee to give *prima facie* evidence to show that the patent was useful. (*Frost, Patent Law and Practice*, 4th Ed., p. 476.) In Canada utility is presumed from the patent. (*Overend v. Burrows, Stewart & Milne Co.* [1909] 19 O.L.R. 643; and cases above.)

Want of utility, onus on patentee in England but on defendant in Canada.

At the trial, where actual or threatened infringement is shown, a perpetual injunction will usually be granted. Generally an injunction will be refused where the patent has expired before the commencement or during the course of an action (*Frost, Patent Law and Practice*, 4th Ed., Vol. I., p. 500; *Davenport v. Rylands* [1866] L.R. 1 Eq. 302, 35 L.J. Ch. 204; *Betts v. Gallais* [1870] L.R. 10 Eq. 392, *Saccharin Corporation, Ltd. v. Quincey* [1900] 17 R.P.C. 337, 2 Ch. 246, 249; *Kane v. J. Boyle & Co.* [1901] 18 R.P.C. 325). Where, however, goods had been made before the expiry of the patent and were stored ready to throw on the market, an injunction was granted restraining the sale of these goods after as well as before the expiration of the patent. (*Crossley v. Beverly* [1829] 1 W.P.C. 112, 3 Car. & P. 513, 1 Russ. & M. 166.) An injunction may also be refused if the court is satisfied that the defendant though he had infringed, had no intention of repeating the infringement (*Scott v. Hull Steam Fishing and Ice Co.* [1897] 14 R.P.C. 143; *Proctor v. Bayley* [1889] 6 R.P.C. 106, 538; *Lyon v.*

Injunction where actual or threatened infringement shown.

Newcastle-upon-Tyne Corporation [1894] 11 R.P.C. 218). Where, however, there has been an infringement even though by one act only, if the infringer asserts in an action brought that he had a right to do what he did, it is presumed that he intended to continue infringing. (Dunlop Pneumatic Tyre Co. v. Neal [1899] 16 R.P.C. 247.)

Stay of injunction pending appeal.

Usually an injunction will not be stayed pending an appeal. Where, however, if the appeal succeed, the injury to the defendants will be exceedingly great without any corresponding advantage to the plaintiff, the injunction may be suspended. Where the injunction is stayed the defendants should be required to keep an account, and if circumstances warrant it, to give security (Kaye v. Chuhh & Sons [1886] 4 R.P.C. 23; North British Rubber Co. v. Macintosh [1894] 11 R.P.C. 489; Ducketts, Ltd. v. Whitehead [1895] 12 R.P.C. 187, 191; National Opalite Glazed Brick and Tile Syndicate, Ltd. v. The Ceralite Syndicate, Ltd. [1896] 13 R.P.C. 649; Leeds Forge Company, Ltd. v. Deighton's Patent Flue and Tube Company, Ltd. [1901] 18 R.P.C. 240; Osram Lamp Works, Ltd. v. Electric Lamp Manufacturing Co., Ltd. [1912] 29 R.P.C. 401). In Jandus Arc Lamp and Electric Co., Ltd. v. Arc Lamp Co. (1905) 22 R.P.C. 277 at p. 298, the defendants were allowed to continue their business on their accepting a license from the patentees, the patentees to return royalties paid if the defendants succeeded on appeal.

Injunction lasts only as long as patent.

An injunction lasts as long as the patent lasts and no longer. It will not be enforced after the patent has expired or become void. (Daw v. Eley [1867] L.R. 3 Eq. 496.) It will probably not be enforced where there has been a surrender and re-issue. (Dudgeon v. Thompson [1873] 3 App. Cas. 34.)

Remedy for breach of injunction, committal or attachment.

Where there is a breach of the injunction the remedy is committal or attachment. Apparently there is now practically no distinction between committal and attachment, though committal is more appropriate. (Mander v. Falcke 1891 3 Ch. 488; Holmsted & Langton, Ontario Judicature Act, 3rd Ed., p. 1105.)

Where the party committing a breach of an injunction is a limited company or other corporation, or is out

of jurisdiction, the proper course is to move for a writ of sequestration. (Halsbury, Laws of England, Vol. XVII., p. 292; *Spencer v. Ancoats Vale Rubber Company, Limited* [1889] 6 R.P.C. 46; *Sharples v. National* [1905] 9 Ex. C.R. 460; *Copeland-Chatterson Co. v. Business Systems, Ltd.* [1907] 9 O.W.R. 610.)

In some cases costs may be awarded as between solicitor and client. (*Plating Co. v. Farquharson* [1881] Griff. P.C. 187; *Copeland-Chatterson Co. v. Business Systems, Ltd.* [1907] 7 O.W.R. 60.)

An undertaking entered into or given to the court is equivalent to an injunction so far as an application to the court to punish its breach is concerned. (Halsbury's Laws of England, Vol. XVII., p. 293; *Thompson v. Hughes* [1890] 7 R.P.C. 71-76; *Milburn v. Newton Colling, Ltd.* [1908] 52 Sol. Jo. 317.)

Sec. 30 of our Act specifically gives the remedy of damages to the patentee against an infringer.

As an alternative to this remedy it is the practice of the courts to grant an account of profits where such is demanded. As an order for account has long been considered as ancillary to the right to an injunction (*Smith v. London & South Western Railway Co.* [1854] Kay 408, 23 L.J. 1 Ch. 562; *Crossley v. Derby Gas Light Co.* [1838] 4 My. & Cr. at p. 37) no special statutory authority seems necessary.

Sub-sec. (b) of sec. 32 of the Patent Act, in any event, supplies such authority.

While the successful plaintiff in an action for infringement is entitled to an order for an account of profits made by the infringer, or damages against him, he is not entitled to both remedies. The reason for this is that if an account be taken of profits, the infringement is thereby condoned. (*Collette v. Lasnier* [1886] 13 S.C.R. 563; *Toronto Auer Light Co. v. Colling* [1898] 31 O.R. 18; *Neilson v. Betts* [1871] L.R. 5 H.L. 1, 22; *De Vitre v. Betts* [1873] L.R. 6 H.L. 319.)

The plaintiff may, however, have both remedies as against different persons either in the same or different actions,—for instance he may have an order to account for profits against the manufacturer and seller and damages against the user (*Toronto Auer Light Co. v. Colling*

Sequestration.

Costs sometimes as between solicitor and client.

Undertaking equivalent to injunction so far as punishment for breach concerned.

Damages.

Account of profits.

Damages and account of profits alternative remedies.

Plaintiff may have both remedies against different persons.

[1898] 31 O.R. 18; Penn v. Bibby [1866] L.R. 3 Eq. 308, 2 Ch. App. 127; Penn v. Jack [1868] L.R. 5 Eq. 81; United Telephone Co. v. Walker [1886] 4 R.P.C. 2 at p. 67; Boyd v. Tootal, Broadhurst, Lee Co. [1894] 11 R.P.C. 175.) The order for account against the manufacturer or seller does not license the use of the inventions to those who have purchased from them. So long as the article is used there is continuing damage. (Plimpton v. Spiller [1876] 4 Ch.D. 286 at p. 292; Penn v. Bibby [1866] L.R. 3 Eq. 308, 2 Ch. App. 127.)

The circumstances of each case must determine which remedy is preferable. An account of profits generally involves a most extended inquiry of an involved and complicated character, with results not often satisfactory to either party.

Plaintiff
only entitled
to an ac-
count of
actual
profits.

An account of profits means the determination of the actual profits made by the infringer from the manufacture, use or sale of the invention. In electing to take such profits the plaintiff condones the infringement, and adopts what was done by the defendant, who may in the enquiry be regarded as the agent or trustee of the plaintiff. (American Braided Wire Co. v. Thompson [1890] 7 R.P.C. 138.) If the defendant has made no profits an amount will not be granted though damages may be allowed. (Bacon v. Spottiswoode [1839] 1 Beav. 382.) The plaintiff is only entitled to the profits actually made, not to those which might have been made had the infringer used the invention differently, or pursued a different line of business policy. (Ellwood v. Christy [1865] 18 C.B.N.S. 494.) Where the defendant who has used or sold the invention might have made a profit otherwise by the use or sale of something not covered by the patent, it is necessary to compare the profits actually made with those which would have been made had the defendant used that thing and not the patented invention. (Siddell v. Vickers [1888] 5 R.P.C. 416 Collette v. Lasnier [1886] 13 S.C.R. 563.) The defendant must give all the necessary information and submit to such examination of his books as may be necessary to determine the profit made, even although this involves a disclosure of the profits of his business, before as well as after the infringement. (Saxby v. Easterbrook

[1872] L.R. 7 Ex. 207; Siddell v. Vickers [1892] 9 R.P.C. 152.)

Where the infringing article consists of both patented and unpatented parts, it is necessary to discriminate and determine what proportion of the net profits was attributable to the use of the plaintiff's invention. (United Horseshoe and Nail Co. v. Stewart [1888] L.R. 13 App. Cas. 412.) That an exact division of such profits is impossible is evident, and even an approximate division is difficult. The case is peculiarly difficult where the defendant has added meritorious improvements.

Plaintiff only entitled to profits attributable to patented invention.

In the United States the rule has recently been settled by the Supreme Court in Westinghouse Electric and Manufacturing Co. v. Wagner Electric and Manufacturing Co. (1912) 180 O.G. 323, 32 U.S. Supreme 691, that a patentee suing to recover profits from an infringer who has added non-infringing and valuable improvements discharges the burden resting upon him by proving the existence of profits attributable in part to the use of his invention and the impossibility of accurately or approximately separating them from those arising out of the defendant's additions. The defendant must then carry the burden of such separation if he is to escape liability for the entire profits.

Burden on defendant to separate profits not attributable to invention from profits made by whole article.

To entitle the plaintiff to an order for an enquiry as to damages he must show actual, not merely nominal damage. (Dicks v. Brooks [1880] L.R. 15 Ch.D. 39; Wehh Lamp Co. v. Atkinson [1902] 19 R.P.C. 599.)

Damages—Plaintiff must show actual damages.

The measure of damages which the plaintiff is entitled to recover is the actual loss which is the direct and natural result of the wrongful acts of the defendants. (United Telephone Co. v. Walker [1886] 4 R.P.C. 62 at p. 67; Pneumatic Tyre Co. v. Puncture Proof Pneumatic Tyre Co. [1899] 16 R.P.C. 209 at p. 212; United Horseshoe and Nail Co. v. Stewart & Co. [1888] L.R. 13 App. Cas. 401 at p. 412; Clement Talbot, Ltd. v. Wilson [1907] 26 R.P.C. 467.) The object of the enquiry is to compensate the plaintiff, not to punish the defendant.

Measure of damages is actual loss to plaintiff.

Where the plaintiff has been in the practice of granting licenses under his patent the determination of the damages is comparatively simple, as they will generally be represented by the royalty that would have been

Where plaintiff ordinarily grants licenses, measure is

usually royalty which would have been paid by infringer.

payable by the defendant had he been a licensee. (United Telephone Co. v. Walker [1886] 4 R.P.C. 62; English and American Machinery Co. v. Union Boot and Shoe Machine Co. [1894] 13 R.P.C. 64; British Motor Syndicate v. Taylor (John) & Sons [1900] 17 R.P.C. 723, [1901] 1 Cb. 122; American Braided Wire Co. v. Thompson Co. [1888] 5 R.P.C. 113, 7 R.P.C. 113.)

Royalty must, however, be established and conditions must be similar.

In measuring damages by royalties, it is necessary to consider all the facts surrounding the licenses taken as a basis for the calculation. The royalty must have been actually paid, and by a sufficient number of persons to show that it is reasonable and such as the patented article can stand and the licensees afford to pay. (Rude v. Westcott [1889] 130 U.S. 152; Houston Ray Co. v. Stern [1896] 74 Fed. 636.) A single license is not sufficient (Judson v. Bradford [1878] 3 Bann. & Ard. 549). Any evidence tending to show abnormal conditions with respect to any license may be introduced, and such conditions must be borne in mind in determining the normal royalty (Black v. Munson [1877] 14 Blatch. 268, Fed. Cas. 1463; United Nickel Co. v. Railroad Co. [1888] 36 Fed. 186). A royalty for making and using is no measure of damages for making and selling. (Colgate v. Mfg. Co. [1886] 28 Fed. 147.)

Where royalty measure not applicable measure is loss to plaintiff.

Where the plaintiff has not granted licenses, and no established royalty is applicable, a determination must be made of what the plaintiff has lost through the defendant's interference and competition. (British United Shoe Machinery Co., Ltd. v. Fussell & Sons, Ltd. [1910] 27 R.P.C. 205.) Even if the defendant has lost money by manufacturing or selling the infringing article, he may still be liable in damages. (Emerson v. Simm [1873] 6 Fisher 281; Dental Vulcanite Co. v. Van Antwerp [1876] 2 Bann. & Ard. 255.)

No presumption that plaintiff's loss is equal to defendant's gain.

There is no presumption that the plaintiff's loss equals the defendant's gain, and so the profits made by the defendant are not a proper measure of damages. (United Horseshoe Nail Co. v. Stewart [1888] 3 R.P.C. 143, 5 R.P.C. 267.) Profits refer to what the defendant has gained and damages to what the plaintiff has lost. (Good-year v. Van Antwerp [1876] 9 O.G. 497.) The defendant's profits may, however, afford some indication of the loss

sustained by the plaintiff (*Many v. Sizer* [1849] 1 Fisher 14; *Byerly v. Cleveland* [1887] 31 Fed. 73). It is only rarely that they will be referred to for this purpose. As stated by Gwynne, J., in *Collette v. Lasnler* (1886) 13 S.C.R. 563: "It is only where, from the peculiar circumstances of the case, no other rule can be found that the defendant's profits become the criterion of the plaintiff's loss." (See also *Seymour v. McCormick*, 16 Howard 480; *Philip v. Nock*, 17 Wall. 460; *Burdell v. Denig*, 92 U.S. 716.)

The defendant generally inflicts a loss on the plaintiff by reducing his sales, and sometimes by forcing a reduction of price.

In estimating the loss due to reduction of sales, it is necessary to take the nature of the invention into account. If the patented article is a new and special one, which is not subject to general competition with other similar unpatented articles, it may be concluded that the plaintiff would have made all the sales made by the defendant. (*The American Braided Wire Co. v. Thompson & Co.* [1888] 7 R.P.C. 110; *Lane v. Pick* [1882] 13 Fed. 475.) Where the article is subject to general competition, as in the case of a horseshoe nail produced by a patented machine, some part of the profits the plaintiff would have had on the defendant's sales may be struck off as representing sales due to increased activity in the trade produced through the rivalry of competition. (*The United Horseshoe and Nail Company, Limited v. Stewart & Co.* [1888] 5 R.P.C. 260; *Alexander v. Henry* [1895] 12 R.P.C. 360.)

It is also necessary to discriminate where the defendant sells a cheaper and lower grade article than that usually manufactured and sold by the plaintiff. It is not to be assumed that the plaintiff would have made the same number of sales of the higher class articles. The court in such cases is obliged to form the best conclusion it can from the facts of the case. (*Dunlop Pneumatic Tyre Co. v. Green* [1900] 17 R.P.C. 234.)

To recover damages for reduction of price, it is necessary to show that the reduction is a natural and direct result of the defendant's acts (*United Horseshoe and Nail Co. v. Stewart* [1888] L.R. 13 App. Cas. 401; *American*

Damage
through
reduction
in sales.

Allowance
must be
made for
difference in
price owing
to difference
in quality.

Damages
through
reduction
in price.

Braided Wire Co. v. Thompson & Co. [1890] 7 R.P.C. 47.) Where the plaintiff has been obliged to reduce his price to effect a sale in view of the defendant's competing price, his damages will be the difference between the usual price and the price at which he was forced to sell. (Wellman, Seaver & Head, Ltd. v. Burstinghaus & Co., Ltd. [1911] 28 R.P.C. 326.) The defendant, however, may be entitled to an allowance by reason of increase of sales through diminution of price. (Meters, Ltd. v. Metropolitan Gas Meter Co., Ltd. [1910] 27 R.P.C. 721.)

Bearing of
require-
ment to sell
at a reason-
able price.

This question may be affected somewhat in Canada by sec. 38 of the Patent Act, which requires the patentee unless the patent has been placed under sec. 44, to sell at a "reasonable price." The damages allowable to the plaintiff under the above rule would possibly be the difference between the price at which he was forced to sell, and a "reasonable" price.

Full partic-
ulars must
be given on
enquiry as
to damages
or profits.

In an enquiry as to damages or profits, the defendant must give full particulars as to the amount sold, and the names and addresses of the purchasers (American Braided Wire Co. v. Thompson & Co. [1888] 5 R.P.C. 113; Saccharin Corporation v. Chemicals and Drugs Co. [1900] 17 R.P.C. 612). The defendant may also be interrogated or examined and required to produce his books. (Saxby v. Easterbrook [1872] L.R. 7 Ex. 207.)

Delivery
up—Destruction.

The successful plaintiff in an infringement action is entitled to an order for delivery up of the infringing article to be destroyed, the nature of which is given by Cotton, C.J., in Vavasseur v. Krupp (1878) 9 Ch.D. 351: "The court in a suit to restrain the infringement of a patent does not proceed on the footing that the defendant proved to have infringed has no property in the articles, but assuming the property to be in him, it prevents the use of those articles, either by removing that which constitutes the infringement, or by ordering, if necessary, a destruction of the articles so as to prevent them from being used in derogation of the plaintiff's rights, and does this as the most effectual mode of protecting the plaintiff's rights—not on the footing that there is no property in defendant. The court cannot proceed to give that relief and interfere with the articles in question, and has as against this

person power to adjudicate that the articles are made or used in infringement of the plaintiff's rights."

The court may refrain from making such an order by reason of the circumstances or nature of the invention, as where the invention is a new combination of old parts which may be used for other purposes (*Needham v. Oxley* [1878] 8 L.T.N.S. 604, 11 W.R. 745) or is only a part of a complicated machine, and the infringers undertake to remove the infringing parts. (*The Automatic Weighing Company v. Fearhy* [1893] 10 R.P.C. 442; *United Telephone Co. v. London & Glohe Telephone and Maintenance Co.* [1884] L.R. 26 Ch.D. 766, 1 R.P.C. 117.) It is possible that the defendant may have the option of delivering up or destroying in the presence of the plaintiff. (*British Westinghouse Electric and Manufacturing Co., Ltd. v. Electrical Co., Ltd.* [1911] 28 R.P.C. 517, 532.)

Court may refuse to order delivery up.

The order for delivery up will usually be limited to the infringing parts. (*Edison Bell v. Smith* [1894] 11 R.P.C. 389; *Automatic Weighing Co. v. Fearhy* [1893] 10 R.P.C. 442.)

Order limited to infringing parts.

An order for delivery up was made in the Exchequer Court in *Auer Incandescent Light Manufacturing Co. v. Dreschel & Melick* [1898] 6 Ex. C.R. 55, affirmed on appeal to the Supreme Court, 28 S.C.R. 608. The decision was followed by the Divisional Court in Ontario, in *Toronto Auer Light v. Colling* (1898) 31 O.R. 18 at p. 24. An order was also made in *Clinton Wire Cloth Co. v. Dominion Fence Co.* (1907) 11 Ex. C.R. 103, 39 S.C.R. 535.

Order made in Canada.

The United States courts have seldom granted this remedy, but they have stated their power to give it. (*American Bell Telephone Co. v. Kitsell* [1888] 35 F. 521, following *Birdsell v. Shalliol* [1884] 112 U.S. 485.)

Subject to any statutory bar mere delay in bringing an action is not sufficient to deprive a plaintiff of his rights. (*Halshury's Laws of England*, Vol. XVII., Tit. Injunctions, p. 210; *Vidal Dyes Syndicate, Ltd. v. Levinstein, Ltd.* [1912] 29 R.P.C. 245.) Acquiescence may, however, disentitle a plaintiff to relief. Delay or acquiescence which would prevent a plaintiff from succeeding on an interlocutory application, may be no bar to his right to a perpetual injunction or to damages, or an

Delay in bringing action.

account at the trial. (Proctor v. Bennis [1887] L.R. 36 Ch.D. 740, C.A. 4 R.P.C. 333; Aluminum Co. v. Domeiere [1897] 15 R.P.C. 32; Bovill v. Crate [1865] L.R. 1 Eq. 388.) Where, however, there has been such standing by or acquiescence that it would amount to a fraud to afterwards insist on legal rights an injunction may be refused (Halsbury's Laws of England, Vol. XVII., Tit. Injunctions, p. 210; Sayers v. Collyer [1885] L.R. 28 Ch.D. 103), and damages or an account may not be allowed (Crossley v. Derby Gas Co. [1829] 1 W.P.C. 120; Harrison v. Taylor [1865] 11 Jur. N.S. 408; Parrott v. Palmer [1834] 3 M. & K. 632, 640), or may be limited to damages or profits since the commencement of the action. (Sayers v. Collyer [1885] L.R. 28 Ch.D. 103; Ford v. Foster [1872] L.R. 7 Ch. App. Cas. 611, 627; Beard v. Turner [1866] 13 L.T.N.S. 746.)

Costs.

Under the Canadian practice the question of costs in infringement actions presents few peculiar points. In England no costs are allowed in respect of any particulars unless a certificate is obtained at the trial that they were reasonable and proper. (S.S.C. Ord. 53 A.T. 22.) We have no provision for such a certificate in Canada. In the Exchequer Court, rule 31 reads:

Costs of particulars.

Exchequer Court rule.

"The Court or a Judge may disallow any costs of, or connected with, the particulars delivered by either party if it appears that such particulars were unnecessary or have not been proven, and the Court or Judge may, notwithstanding the result of the action, order either the plaintiff or the defendant, whether or not successful in the action, to pay to the opposite party any costs occasioned thereby." In the Provincial Courts there is no rule dealing specially with particulars in patent cases.

No rule in Canada allowing costs as between solicitor and client where plaintiff has certificate of validity in previous action.

In England a plaintiff who succeeds in an action in which he has been able to plead the possession of a certificate that the validity of the patent in suit had been called in question in a previous action for infringement, is entitled to have his full costs as between solicitor and client, unless the court otherwise directs. (Patents and Designs Act, 1907, [7 Edw. VII., c. 29 s. 35].) We have no similar provision in Canada. In the Exchequer Court there is no provision for taxation of costs as between solicitor and client. (Boak v. Merchants Marine In-

insurance Co., Cassel's Digest, 2nd Ed., 677; *Bosse v. Paradis* [1892] 21 S.C.R. 419; *Queen v. La Force* [1894] *Audette Practice of the Exchequer Court*, 2nd Ed., 415.)

Where a plaintiff succeeds on the issue of validity, but fails to prove infringement, the courts in England have established a general rule which will doubtless be followed in Canada that the costs will be apportioned. (*Phillips v. Ivel Cycle Co.* [1890] 7 R.P.C. 77, 85; *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate* [1895] 12 R.P.C. 232 at p. 258; *Sunlight Incandescent Gas Light Co. v. Incandescent Gas Light Co.* [1897] 14 R.P.C. 757; *Dunlop Pneumatic Tyre v. Wapshare Tube Co.* [1900] 17 R.P.C. 433; *Kaye v. Chubb & Sons* [1886] 4 R.P.C. 23; *Haskell Golf Ball Co. v. Hutchison* [1906] 23 R.P.C. 125; *Foden v. Wallis & Stevens, Ltd.* [1908] 25 R.P.C. 501.)

English rule that cases will be apportioned where plaintiff succeeds as to validity but fails to prove infringement.

There is no general rule as to the apportionment of costs where the plaintiff fails to uphold his patent, but is successful on the issue of infringement. (*Frost Patent Law and Practice*, 4th Ed., Vol. I., p. 535.) In some cases, however, plaintiffs have been awarded costs of unsuccessful issues raised by the defendants. (*Wegman v. Corcoran* [1879] 27 W.R. 331, 13 Ch.D. 65; *Badische Anilin und Soda Fabrik v. Levinstein* [1885] 2 R.P.C. 73, L.R. 29 Ch.D. 366, 420.)

No general rule as to apportionment where plaintiff fails as to validity and shows infringement.

CHAPTER XIX.

BILLS OR NOTES GIVEN FOR PATENT RIGHTS.

Sections
14, 15, 16 of
Bills of
Exchange
Act.

Sections 14, 15 and 16 of the Bills of Exchange Act (R.S. 1906, c. 119) read:

"14. Every bill or note the consideration of which consists, in whole or in part, of the purchase money of a patent right, or of a partial interest, limited geographically or otherwise, in a patent right, shall have written or printed prominently and legibly across the face thereof, before the same is issued, the words *given for a Patent Right*,

"(2) Without such words thereon, such instrument and any renewal thereof shall be void, except in the hands of a holder in due course without notice of such consideration.

"15. The endorsee or other transferee of any such instrument having the words aforesaid so printed or written thereon, shall take the same subject to any defence or set-off in respect of the whole or any part thereof which would have existed between the original parties.

"16. Every one who issues, sells or transfers by endorsement or delivery, any such instrument not having the words *Given for a Patent Right* printed or written in manner aforesaid across the face thereof, knowing the consideration of such instrument to have consisted, in whole or part, of the purchase money of a patent right, or of a partial interest, limited geographically or otherwise in a patent right, is guilty of an indictable offence and liable to imprisonment for any term not exceeding one year, or to such fine, not exceeding two hundred dollars, as the court thinks fit."

The first statute containing similar provisions to the foregoing was passed in 1884, 47 Vic., chap. 38, entitled: "An Act for the better prevention of fraud in connection with the sale of Patent Rights." 47 Vic., ch. 38.

This Act provided that every bill or note (for the sale of patent rights) should have written legibly across its face the words "Given for a patent right," and that any endorsee or transferee of a note with these words on it took it subject to any defence or set-off existing between the original parties. The Act provided a penalty of a year's imprisonment or a fine up to two hundred dollars for issuing, selling or transferring such a note without these words.

Under this statute, in *Girvin v. Burke* (1889) 19 O.R. 204, it was held by a Divisional Court in Ontario, affirming *Rose, J.*, that the words "given for a patent right" were not required as between maker and payee, and that the object of the Act was to give the endorsee or transferee of the note the same defence as would have existed between the original parties.

The Bills of Exchange Act of 1890, 53 Vic., chap. 33 sec. 30, sub-sec. 4, added to the section requiring printing, etc., across the notes "and without such words thereon, such instrument and any renewal thereof shall be void except in the hands of a holder in due course without notice of such consideration." 53 Vic., ch. 33.

The case of *Johnson v. Martin* (1892) 19 O.A.R. 592, was commenced before the Bills of Exchange Act of 1890 though it did not reach the Court of Appeal until after that Act had been passed. The Court of Appeal in effect overruled *Girvin v. Burke* (1889) 19 O.R. 204, holding that a note, the consideration for which was the purchase money of a patent right, without the words "given for a patent right" across its face was void in the hands of an endorsee for value, with notice of the consideration.

The Act of 1890 made the law upon this point clear.

In *Craig v. Samuels, Benjamin & Co.* (1894) 24 S.C.R. 278 (*sub nom.* *Samuel v. Fairgrieve* [1893] 24 O.R. 486) the Supreme Court held that a joint and several note made by two persons in partnership was invalid under the foregoing sections, although one of the makers was already indebted to the payee for a personal account to

more than the amount of the note, and the consideration of the note was the purchase of a patent right only as regards the other maker.

"The Act is aimed at bills and notes where the consideration therefor is wholly or partially for an interest in a patent right. . . . The endeavour in this case has been by indirect means to render legal that which it was the aim and very object of the statute to prevent." (Samuel v. Fairgrieve [1893] 24 O.R. 486, 490.)

In *Lefebvre v. Titmore* (1899) Q.R. 16 S.C. 248, the Court of Review held that a note which does not bear the words "given for a patent right" when issued is void and that it can not be made good by the payee writing the words across it before suit.

CHAPTER XX.

FOREIGN PATENT LAW.

The Canadian patentee or inventor is usually interested in the patent laws of foreign countries to the extent of learning when he must apply to avoid loss of his rights, and what formalities and taxes are necessary to be observed or paid in order to maintain his patent in force, and it is from these standpoints that the subject will be briefly treated here.

Scope of chapter.

Canada stands in a somewhat peculiar position for the reason that while part of the British Empire, it is not a member of the International Convention, although Canadian laws confer benefits on foreigners which are substantially equal to those afforded by the Convention.

Relation of Canada to the International Convention.

The International Convention is an agreement entered into between the principal countries of the world, whereby reciprocal protection is extended with respect to inventions made by subjects or citizens of the contracting states. By Article 4 of this Convention an application filed in any one of the Convention States within twelve months after the filing of the first application in a Convention country has the same force and effect as if filed simultaneously therewith, and intermediate publication is of no effect. The members of this Convention on January 1st, 1912, were:

Austria, Hungary, Bosnia and Herzegovina, Belgium, Brazil, Cuba, Denmark and Faeroe Islands, Dominican Republic, France, Algeria, and all French Colonies, Germany, Great Britain, Australian Commonwealth, Japan, Mexico, Norway, Dutch Indies, Surinam, Curacas, Portugal with the Azores and Madeira, Servia, Spain, Sweden, Switzerland, Tunis and United States.

Members of International Convention.

It has been suggested that a Canadian, who for example, files an application in the United States, may in such application claim the priority of the Convention in other countries as a subject of the King of Great Britain.

The wording of Article 4 is sufficiently loose to allow this contention. This article reads in part as follows:

"Any person who has duly applied for a patent, industrial design or model, or trademark in one of the contracting states, shall enjoy, as regards registration in the other states, and reserving the rights of third parties, a right of priority during the periods hereinafter stated."

It may be argued that "any person" is sufficiently wide in scope to include residents of non-convention states. Most of the Patent Offices will accept applications filed under such conditions, but it is believed that such meaning would be against the context, and the whole tenor of the agreement and not be sustained in court.

Generally foreign applications should be filed before publication of the invention.

Most of the foreign countries, except the United States require that an application, except one filed under the International Convention, should be made before the invention has been published in a printed publication, or otherwise received sufficient publicity within the country to enable the invention to be put in practice by those skilled in the art. The meaning attached to publication is not uniform in all countries; in some a printed publication alone is considered, while in others laying of the patent specification open to the public is sufficient.

Date of publication of Canadian patents.

The date at which an issued Canadian patent is to be considered "published" is not easy to settle. It is the practice to issue patents on Tuesdays of each week, and the manuscript copies of the specification and drawings of the patents issued are accessible to the public on the day of issue. No printed publication of the entire specification and drawings takes place. The Canadian Patent Office Record, however, is issued some three or four months after the issue of the patent and contains a reduced reproduction of one sheet only of the drawings and a copy of the claims of the patent. In the case of simple inventions this would form a complete disclosure, but for a complicated invention it would be quite insufficient to enable the invention to be understood. To avoid possible doubt, it is advisable for a Canadian patentee to apply for such foreign patents as he desires to obtain prior to issue of his Canadian patent, and cer.

tainly before the Canadian Patent Office Record containing the abstract from his patent issues.

UNITED STATES.

Application by a foreigner for patent in the United States should be made within one year from the date of filing of his first foreign application, and within two years of any printed publication, public use or sale of his invention in the United States. It is important to file as early as possible in the United States, for the reason that in the event of any conflict between a domestic and foreign inventor as to priority, the foreign inventor is limited to proving the date on which he introduced the invention into the United States, while the domestic inventor may introduce proof as to the earliest date of conception and reduction to practice. The foreign inventor will not be allowed to offer such proof unless the conception or reduction to practice took place in the United States.

The law generally is similar to that in Canada. A more rigid examination as to novelty is made in the Patent Office, and provision is made for an appeal from the Examiner's decision to the Board of Examiners in Chief, and from this Board to the Commissioner. Interference proceedings between two or more applicants who claim the same invention, or between an applicant and a patentee, are expensive and tedious. Such proceedings are conducted before an Examiner of Interferences, the evidence being taken before notary publics, and extended before argument.

Law similar to Canadian.

Interference.

The filing fee is fifteen dollars, and when an application has been examined and allowed, a further or final fee of twenty dollars is called for, which must be paid within six months or the application will become forfeited, and may only be renewed within eighteen months upon payment of a second filing fee. The renewed application will be subject to re-examination.

After issue, printed copies of the patent may be obtained from the Commissioner of Patents, Washington, D.C., at a cost of five cents each. Re-issue of defective patents is provided for as in Canada.

Printed copies.

There are at present no requirements as to working or compulsory manufacturing in the United States, no prohibition against importation, and no taxes to pay.

Formal papers required.

The formal papers for an application in the United States comprise a petition, a specification, a drawing if necessary, and an oath sworn to before a notary public or United States consular agent who must impress his seal through the papers, or through a wafer which binds a ribbon passed through all the papers. If the oath be taken before a notary public in a foreign country, it is necessary to supply a consular certificate of his official character.

Official letters of objection from the Patent Office must be responded to within one year or the application will be held to be abandoned.

GREAT BRITAIN.

A British application must be filed before the invention is published within the realm. An importer or one who introduces the invention into the country from abroad is held under the statute to be an inventor and entitled to a patent. Consequently, applications instead of being filed in the name of the true inventor may, when he resides abroad, be filed in the name of a resident of Great Britain, as a communication from abroad. An examination as to novelty is made which is limited to British patents issued during fifty years prior to application. Provisional protection may be obtained for six months prior to filing of the complete specification by filing what is known as a provisional specification, which may be more concise and contain less detail than the complete. The patent when issued dates and runs for fourteen years from the date of first application. Taxes must be paid before the end of the fourth year of the patent, and annually thereafter.

If at the end of four years, the patented article is manufactured, or the process carried on exclusively or mainly outside the United Kingdom, the patent, upon application to the Comptroller may be revoked, unless the patentee can give satisfactory reasons for his inaction.

Compulsory licenses may be granted after three years if the reasonable demands on the part of the public for the invention are not complied with.

FRANCE.

The application should be filed before the invention has received sufficient publicity either in France or abroad

to enable it to be worked. No examination as to novelty is made. Yearly taxes are due and the invention must under penalty of forfeiture of the patent, be worked or practiced in France within two years of the date of issue of the patent and the working must not be discontinued for two consecutive years. Importation of the patented article from abroad is prohibited. No assignment may be recorded until the taxes for the full term (fifteen years) of the patent have been paid.

GERMANY.

Application should be made before printed publication of the invention anywhere and before public use within the Empire. A very rigid examination as to novelty is made. Annual taxes must be paid, and the invention worked to an adequate extent in Germany within three years. The term of the patent is fifteen years. A "Gebrauchsmuster" or Utility Design Patent may be obtained for many small articles. Such patents are granted for three years, renewable for a further period of three years.

AUSTRIA.

Application must be made before the invention has been so described in a printed publication or so publicly used or exhibited that the use of the same by persons skilled in the art is possible. Annual taxes are payable, and working of the invention must be effected within three years, or sooner if the native demand for the invention is being satisfied by importation.

HUNGARY.

Application should be made before the invention has been so made known by publication or working that it could be used by persons skilled in the art. Annual taxes must be paid, and the invention worked in Hungary within three years, or earlier if the invention is being worked abroad, and the circumstances warrant it.

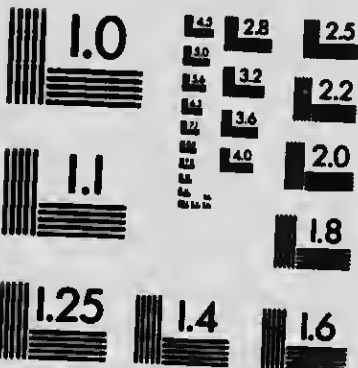
BELGIUM.

Two kinds of patents are granted: Patents of Invention and Patents of Importation. The former should be applied for before public use of the invention in Belgium or patenting elsewhere, and the latter during the term



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of a prior foreign patent, provided that the invention is not already in commercial use in Belgium. Annual taxes must be paid, and working effected in Belgium within one year of first commercial working elsewhere, and such working must not be discontinued for any twelve consecutive months.

DENMARK.

Application should be made before the invention has been described in detail in generally accessible prints or openly used in Denmark. Annual taxes are payable and working due within three years from the issue.

ITALY.

Patents of invention and of importation are granted. The former should be applied for before publication in Italy and the latter before free importation into and use of the invention in Italy. Yearly taxes are due and working in Italy within two years of the patent if granted for six years in the first instance, and within one year if the grant is for a lesser term. The term is from one to fifteen years at the election of the applicant. Prolongations of the shorter term patents up to fifteen years may be obtained. The disadvantage of a term less than six years is that working is due within one year from issue.

NORWAY.

Application should be made before the invention has been published anywhere, but patent specifications laid open for public inspection in other countries are not a bar. Yearly taxes are due, and compulsory licenses may be granted if the invention is not sufficiently worked within three years from issue. The term is fifteen years.

SWEDEN.

Application should be made before publication or public use in any country. If patented abroad, however, it may be patented in Sweden if application be made within six months. Yearly taxes are payable, and Compulsory License provisions prevail after three years. The term is fifteen years.

PORTUGAL.

Application should be made before public use or publication in Portugal or her colonies. Yearly taxes must

be paid and the invention worked within two years. The working must not cease for two consecutive years.

RUSSIA.

Application may be made even after the issue of patents for the same invention in other countries, provided that the invention is new as to Russia, and has not been published or described there in printed books or newspapers. A very dilatory examination as to novelty is made during which time provisional protection is granted. Taxes are payable annually after issue, and working must be effected within five years from the grant.

SPAIN.

Patents of invention having a term of twenty-one years must be applied for before publication or public use in any country. Patents of introduction having a term of five years may be obtained for any invention not already exploited in Spain. Working must be effected within two years and a certificate obtained; annual taxes are payable.

SWITZERLAND.

Application should be made before publication in Switzerland. Annual taxes are payable and working due within three years.

TURKEY.

Application for patents of invention should be made before publication anywhere. Patents of importation may be obtained any time during the life of the foreign patent. Certain inventions, such as medicines and those relating to munitions of war, are excluded. Yearly taxes must be paid and the invention worked within two years. The working must not cease for two consecutive years.

MEXICO.

Application must be filed within three months from date of issue and within twelve months of date of filing of first foreign application or before publication of the invention. There are no taxes or requirements as to working. Compulsory Licenses may be granted after three years. The term is twenty years.

ARGENTINE REPUBLIC

Application should be made before publication anywhere, but where foreign patents have been obtained, an application may be made any time during its life and a grant made limited to the life of the foreign patent. Annual taxes are due, and working must be commenced within two years and not interrupted thereafter for two years at a time.

BRAZIL.

Foreign patents may be "confirmed" in Brazil for the term of the foreign patent, not exceeding fifteen years. Patents of invention must be applied for before publication or public use. An inventor who obtains a foreign patent before application in Brazil, will not have his patent invalidated by publication or use within seven months from the issue of the foreign patent. Taxes are payable annually, and working must be effected within three years and not discontinued for a period over one year.

INDIA.

Application should be filed before public use or knowledge in India. Taxes are due before the end of the fourth year and annually thereafter. Working provisions similar to Great Britain.

JAPAN.

Application should be filed before public use or knowledge in Japan. Only citizens of States having a Convention or Treaty with Japan may obtain patents. Canada is included. Annual taxes are payable and working to an adequate extent is due within three years and should not be discontinued for any three consecutive years thereafter.

UNION OF SOUTH AFRICA.

At present patents must be taken out separately in each of the Provinces. It is expected that a single Union Act will be passed shortly, covering all the Provinces. In Cape Colony and Natal, a valid patent may be obtained even after publication if the invention is new within the Province. In Transvaal, application should be filed within one year of the date of grant of the first foreign patent. In Orange River Colony, application should be made be-

fore publication of public use in the Province. The term is fourteen years in each Province. In Cape Colony, Natal and Orange River Colony, taxes are due before the end of the third and seventh years. In Transvaal they are due before the end of the third year, and annually thereafter. There are no working requirements, but Compulsory Licenses may be granted in Transvaal.

AUSTRALIA.

Application should be made before the invention has been described in a book or other printed publication in Australia. Taxes are payable within the seventh year, and working requirements similar to those in Great Britain are in force. Provisional protection may be obtained for nine months.

NEW ZEALAND.

Application should be made before the invention has been publicly manufactured, used or sold in New Zealand and before publication, unless such publication is made without the knowledge or consent of the inventor. Taxes are payable before the end of the fourth and seventh years and working requirements similar to those in Great Britain are in force.

CUBA.

Two kinds of patents are granted: Independent Cuban or "Nacional" patents on application made before public use anywhere or publication in Cuba, and patents for inventions previously patented abroad. The foreign patent is "Revalidated" in Cuba, and this may take place even after publication. There are no taxes. Working of a "Nacional" patent must take place within one year. No working is required when the patent is a "Revalidation" of a United States patent.

WHEN FOREIGN APPLICATIONS MUST BE FILED.

The following statement indicates briefly when application should be made in the principal foreign countries:

Before Publication or Public Use of the Invention Anywhere.—France, Hungary, Holland, Spain (if twenty-year patent applied for), Sweden, Turkey and Tunis.

Before Printed Publication Anywhere, and Before Public Use in the Country.—Austria, Belgium, Denmark, Finland, Germany, Luxemburg, Norway, Portugal, Russia. In Belgium and Russia official publication by the Patent Office of the applicant's own country does not bar.

Before Publication or Public Use in the Country.—Great Britain, Switzerland, Chili, Japan, Cape Colony, Natal, Orange River Colony, Australia, New Zealand.

During the Life of a Foreign Patent Provided No Prior Use in the Country.—Italy, Spain (five-year patent), Newfoundland, Jamaica and Costa Rica.

PROVISIONAL PROTECTION.

In Great Britain and most of her colonies, an application may be filed with provisional specifications with or without drawings, and a complete specification filed at a later date.

PATENT OF ADDITION.

In most of the European countries, patents of addition may be obtained for improvements upon a patented invention. The patent of addition usually lapses with the main patent, and there are no taxes payable on it.

MARKING PATENTED ARTICLES.

Requirements as to marking patented articles exist in Switzerland, Mexico, Japan, France, Germany, Great Britain, Australia, New Zealand, Salvador, Nicaragua.

EXCHEQUER COURT FORMS.

STATEMENT OF CLAIM.

IN THE EXCHEQUER COURT OF CANADA.

BETWEEN
MONTREAL GRAMOPHONE COMPANY, LIMITED,
Plaintiffs;
AND
JOHN SMITH,
Defendant.

Filed the day of 19 .

STATEMENT OF CLAIM.

1. THE Plaintiffs are a duly incorporated Company having their head office at the City of Montreal, in the Province of Quebec. The Defendant carries on business as a dealer in musical instruments at the City of Calgary, in the Province of Alberta:
2. By Patent numbered 65079 and bearing date the 24th day of February, 1907, under the hand of Sydney Fisher, Commissioner of Patents, and the Seal of the Patent Office of the Dominion of Canada, there was granted to Thomas Brown, of the City of Ottawa, in the Province of Ontario, his executors, administrators, legal representatives and assigns, for the period of 18 years from the date of the said Patent, the exclusive right, privilege and liberty of making, constituting and using and vending to others to be used in the Dominion of Canada the invention consisting of certain new and useful improvements in gramophones:
3. For greater certainty as to the description of said invention the Plaintiffs crave leave to refer to the original patent, specification and drawings when produced to this Honourable Court:

4. By instrument in writing bearing date the 24th day of June, 1908, which instrument is duly recorded in the Patent Office for the Dominion of Canada as Number 46014, and to which for greater certainty the Plaintiffs crave leave to refer when produced to this Honourable Court, the said Thomas Brown sold and assigned unto the Plaintiffs the said Patent numbered 65079, and all the rights and privileges thereunder to be fully and entirely held by the plaintiffs to the full end of the term for which the said patent was granted:

5. THE Defendant has for some time past infringed the said Patent numbered 65079 by making, using and vending to others to be used gramophones embodying the invention described in the said Patent as appears in the particulars of the said Patent delivered herewith and threatens to continue to infringe the said Patent by making, using and vending to others to be used such gramophones:

The Plaintiffs Therefore Claim:—

1. AN injunction to restrain the Defendant, his servants and agents, from making, using and vending to others to be used gramophones or portions thereof made in infringement of the Plaintiffs' said Patent, or made so as to be a mere colourable imitation of the invention herein described.

2. AN account of profits, or, at the option of the Plaintiffs, an enquiry as to damages.

3. Destruction of or delivery up by the Defendant to the Plaintiffs of all gramophones or portions of gramophones made in infringement of the Plaintiffs' rights.

4. THEIR costs of this action.

5. SUCH further and other relief as the nature of the case may require or to this Honourable Court may seem just.

(Sd.)

Counsel for the Plaintiffs.

PARTICULARS OF BREACHES.
 IN THE EXCHEQUER COURT OF CANADA.

BETWEEN
 MONTREAL GRAMOPHONE COMPANY, LIMITED,
Plaintiffs;
 AND
 JOHN SMITH,
Defendant.

PARTICULARS OF BREACHES.

1. THE Plaintiffe claim that the Defendant has infringed the following claims of the patent referred to in the Statement of Claim numbered 65079:—1, 2, 5, 7, 8.
2. THE following are the breaches complained of in the Statement of Claim:—
 - (1) THE Defendant between the First day of July, 1912, and the present time has manufactured at his factory in the City of Calgary gramophones which were infringements of the claims of the Plaintiffe' patent set out above.
 - (2) THE Defendant in his music shop in the City of Calgary, by himself, his servants or agents, used a gramophone during the period from the First day of November, 1912, to the First day of June, 1913, which was an infringement of the claims of the Plaintiffe' patent above set out.
 - (3) THE Defendant sold gramophones at Calgary which were infringements of the claims of the Plaintiffe' patent set out above as follows:—On the Fifth day of November, 1912, to William Brown; on the Twentieth day of December, 1912, to James Murphy.
 - (4) THE Defendant also in the period between the First day of July, 1912, and the First day of June, 1913, sold many other gramophones which infringed the claims of the Plaintiffs' patent above set out at times and to persons not at present known to the Plaintiffe. The Plaintiffe are unable to give particulars of such sales until they have had discovery from the Defendant, but the Plaintiffe will claim to recover from the Defendant compensation in respect of such infringements.

DELIVERED together with the Statement of Claim herein
 this day of 1913, by

Plaintiffs' Solicitor.

STATEMENT OF DEFENCE.

IN THE EXCHEQUER COURT OF CANADA.

BETWEEN

MONTREAL GRAMOPHONE COMPANY, LIMITED,
Plaintiffs;

AND

JOHN SMITH,

Defendant.

Filed the day of 19 .

STATEMENT OF DEFENCE.

1. THE Defendant admits the allegations made in paragraph 1, but denies all other allegations contained in the Statement of Claim:

2. THE Defendant denies that the Plaintiffs are the owners of the Canadian Patent 65079:

3. THE Defendant denies that the said Patent was assigned to the Plaintiffs:

4. THE Defendant denies that he infringed the Plaintiffs' alleged patent. He denies that he has made, used or vended to others to be used gramophones embodying the invention described in the said alleged patent as set out in the Statement of Claim and particulars of breaches delivered therewith:

5. THE patent sued upon is and always has been void and of no effect for the reasons stated in the particulars of objections delivered herewith:

6. THE Defendant says that the owners of the patent sued upon did not within the period of two years from the date thereof commence, and after such commencement, continuously carry on in Canada the construction or manufacture of the alleged invention patented, in such a manner that any person desiring to use it might 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, and that the said patent therefore ceased and

determined and became null and void under the conditions therein contained and the provisions of Section 38 of the Patent Act.

7. THE Defendant says that the Plaintiffs, after the expiration of twelve months from the granting of the patent sued upon, imported into Canada the alleged invention for which the patent was granted and that the said patent thereupon ceased and determined and became null and void under the conditions therein contained and the provisions of 38 of the Patent Act.

DATED this day of 19 .

Counsel for Defendants.

PARTICULARS OF OBJECTIONS.

IN THE EXCHEQUER COURT OF CANADA.

BETWEEN
MONTREAL GRAMOPHONE COMPANY, LIMITED,
Plaintiffs;
AND
JOHN SMITH,
Defendant.

PARTICULARS OF OBJECTIONS.

THE following are the particulars upon which the Defendant disputes the validity of the patent number 65979 mentioned in the Statement of Claim, in addition to *al.*, on which he may be entitled to rely without delivering any further particulars than those given in the Statement of Claim:—

1. THE alleged improvements in gramophones, the subject matter of the said patent, was not an invention within the meaning of the Patent Act. The alleged invention consists only of a mechanical variation in the well-known sound box mechanism of the cylinder phonograph involving no invention:

2. THE subject matter of the said patent was not invented by Thomas Brown who claimed to be the inventor thereof and applied for the said patent, but if the said subject matter was an invention within the meaning of the Patent Act, it was invented by John McLaughlin of the City of Ottawa.

3. THE subject matter of the said patent was not new. The alleged invention claimed by the specification was a matter of general common knowledge for many years before the date of the application for the said patent.

The invention described in the said patent, and covered by the claims set out in the Particulars of breaches delivered, was prior to the alleged invention by the said Thomas Brown described in the following Patents:—

U.S. Patent to Thompson No. 780, 745 dated April 1, 1902.

U.S. Patent to Smith No. 870, 695 dated December 2, 1903.

The alleged invention was prior to the alleged invention by the said Thomas Brown known and used by Peter Glavey at Ottawa during the year 1902.

4. THE alleged invention was not useful.

5. THE alleged invention was abandoned to the public prior to the application for patent in Canada. The alleged invention was described but not claimed in patent number 54365 dated May 3, 1901, granted to the said Thomas Brown.

6. THE alleged invention was in public use or on sale with the consent or allowance of the alleged inventor thereof for more than one year previously to the application for patent in Canada. Gramophones containing the alleged invention were sold by Thomas Clavey, an agent of the alleged inventor at his shop in the City of Montreal, in the month of October, 1905.

7. Thomas Brown, the original patentee, obtained a patent for the alleged invention in a foreign country, namely, in the United States of America, on the 23rd day of January, 1906, the said patent being numbered 654321, and the application on which the patent sued upon was granted was not made within one year from the date of the issue of the said patent of the United States of America, not having been made until the 30th day of January, 1907.

8. THE specification forming part of the said patent does not correctly and fully describe the mode or modes of operating the said alleged invention as contemplated by the alleged inventor, and does not state clearly and distinctly the contrivances and things which he claimed as new and for the use of which he claimed an exclusive property and privilege, and it would not be possible for anyone skilled in the art to which the alleged invention appertains to apply or work out the same from the information afforded by the specification. No sufficient directions are given as to the manner in which the needle must be adjusted on the record in order that it may be vibrated and propelled thereby, as set out in lines 10 to 20 on page 4 of the patent. It is not stated whether the whole apparatus described is claimed as new or only parts thereof. The specification forming part of the said patent

is too broad, claiming more than that of which the said Thomas Brown was the inventor.

9. The specifications and drawings forming part of the Plaintiffs' alleged patent contain more than is necessary for obtaining the end for which they purport to be made and such addition was wilfully made for the purpose of misleading. The support of the swinging arm is described as useful and necessary whereas the same is not of any utility and is not necessary.

DELIVERED together with the Statement of Defence herein this day of 1913, by

Defendant's Solicitor.

SUMMONS FOR INTERIM INJUNCTION.

(Copy of Summons issued in case.)

IN THE EXCHEQUER COURT OF CANADA.

BETWEEN

THE AUER INCANDESCENT LIGHT MANUFACTURING COMPANY, (LTD.)

Plaintiff;

AND

HERMAN DRESCHER ET AL.,

Defendants.

Let the Defendants, their Attorneys or agents attend before the presiding Judge at Chambers in the City of Ottawa, on Wednesday the 7th day of April next, A.D. 1897, at 2.30 o'clock in the afternoon or as soon thereafter as Chambers may be held, to show cause why an interim injunction should not be granted to restrain them, the said Defendants, their agents, workmen and employees during the pendency of the present action from importing, manufacturing, using, offering for sale and selling to others for use, Incandescent lights or devices manufactured according to the invention set forth and claimed by the Letters Patent of the Dominion of Canada Numbered 46946 or in any manner only colourably differing therefrom, and upon this application will be read the Statement of Claim and affidavits of William R. Granger, Waldron Shapleigh, Charles Storey Taggart and Charles A. Duclos filed herein, copies of which affidavits are to be served with this summons.

Dated at Chambers this 1st day of April, A.D. 1897.

(Sgd.) G. W. BURBIDGE,
J.E.C.

ORDER GRANTING INTERIM INJUNCTION.
(Order made in case.)

IN THE EXCHEQUER COURT OF CANADA.
TUESDAY THE 13TH DAY OF APRIL, A.D. 1897.

PRESENT:
THE HONOURABLE MR. JUSTICE BURBIDGE.

BETWEEN
THE AUER INCANDESCENT LIGHT MANUFACTURING COMPANY (LTD.)
Plaintiff;

AND
HERMAN DRESCHER AND MARY VAIL MELICK,
Defendants.

Upon the application of the Plaintiff made on the seventh day of April, A.D. 1897, upon hearing read the summons, the affidavits of service thereof, and the affidavits of William R. Granger, Waldron Shapleigh, Charles Storey Taggart and Charles A. Duclos filed in support thereof, the exhibits therein referred to, the affidavit of Herman Dreschel filed in answer, and upon hearing Counsel for all parties.

This Court was pleased to direct that the said application should stand over for judgment and the same coming on this day for judgment. This Court doth order that upon the Plaintiff giving an undertaking to abide by any order which this Court or the Judge thereof may hereafter make as to damages occasioned to the Defendants by the granting of an interim injunction as hereafter set forth, the said Defendants, their servants, workmen, agents and employees be and they are hereby restrained until after the trial of this action, or until further order of this Court or the Judge thereof from importing into this Country, manufacturing, using, offering for sale and selling to others for use Incandescent lights or devices

manufactured according to the invention set forth and claimed by the said Letters Patent of the Dominion of Canada Number 46946 or in a manner only colourably differing therefrom.

AND THIS COURT DOETH FURTHER ORDER that the costs of this application be costs in this cause to the successful party.

By the Court,

(Sgd.) L. A. AUDETTE,

Registrar.

SUMMONS FOR FURTHER PARTICULARS

(Copy actual Order made in case.)

IN THE EXCHEQUER COURT OF CANADA.

BEFORE THE
HONOURABLE MR. JUSTICE CASSELS, In Chambers.

BETWEEN

CANADIAN MACHINE TELEPHONE COMPANY,
LIMITED,*Plaintiffs;*

AND

AUTOMATIC ELECTRIC COMPANY AND
JOHN WILEY,*Defendants.*

Let the Plaintiffs, their Attorneys or Agents attend before the Judge of this Court in Chambers in the City of Toronto, on Friday the eighth day of May, A.D. 1908, at the hour of eleven o'clock in the forenoon, or so soon thereafter as Chambers may be held, to show cause why an order should not issue from this Court directing the Plaintiffs to furnish further and better particulars of the allegation of infringement of their alleged Letters Patent set out in the Statement of Claim herein, and in the meantime let all further proceedings be stayed.

And take notice that in support of this application will be read the Statement of Claim of the Plaintiffs, the Particulars furnished by the Plaintiffs under the order of the twenty-seventh of March, A.D. 1908, and the affidavit of William Donald Hogg filed on this application.

Dated at Ottawa, this second day of May, A.D. 1908.

(Sgd.) W. G. P. CASSELS,
J.E.C.

ORDER FOR FURTHER PARTICULARS.

(Copy Order made in case.)

IN THE EXCHEQUER COURT OF CANADA.

MONDAY THE NINTH DAY OF DECEMBER, A.D. 1907.

PRESENT:

THE HONOURABLE MR. JUSTICE BURBIDGE.

BETWEEN

TORONTO TYPE FOUNDRY COMPANY, LIMITED,
Plaintiffs;

AND

JAMES T. REID *ET AL.*,
Defendants.

Upon motion made unto this Court this day on behalf of the Plaintiffs upon hearing the Pleadings herein and the Notice of Motion, and upon hearing Counsel for the Plaintiffs and for the Defendants respectively.

1. It is ordered that the Defendants within fifteen days after the service on them or their Solicitors of a copy of this order do deliver:—

(a) Particulars in writing setting forth specifically the acts of abandonment referred to in paragraph eleven of the Defendants' plea herein, and the respective dates thereof and by whom the same were made respectively.

(b) Particulars in writing of the alleged importation thereof into Canada referred to in paragraph sixteen of the Defendants' plea herein showing the respective dates of the said importation into Canada referred to and the respective names of the persons so importing into Canada as alleged.

(c) Particulars in writing of the foreign patents referred to in paragraph seventeen of the Defendants' plea herein, showing the dates of the said foreign patents, by

whom the same were granted respectively and the respective numbers thereof.

(d) Particulars in writing of the books and other publications referred to in paragraph eighteen of the Defendants' plea herein, stating the nature of the anticipations on which the Defendants' rely and showing the names of the books and other publications referred to and the respective pages thereof where the said invention is so described as alleged.

(e) Particulars in writing of the claims in other prior patents referred to in paragraph nineteen of the Defendant's plea herein, showing the respective dates of the said prior Patents, by whom the same were granted respectively, the respective numbers thereof, the respective places, pages and lines where the said prior claims have been made as alleged, also the grounds on which it is alleged that the Plaintiffs were not the first grantee of the patent in question herein and also whether all or some and if only some, which of the Plaintiffs' claims are alleged to be included in the said prior patents.

(f) Particulars in writing of the use of the said invention prior to the application for the said patent referred to in paragraph twenty-one of the Defendants' plea herein, showing the place where the said prior use took place, and the names and the respective present addresses of the prior users, the respective dates when the said use took place and the manner in which the said prior user anticipates the said invention.

2. And it is further ordered that within fifteen days after the examination for discovery of the Plaintiffs by the said Defendants, the said Defendants shall be at liberty to add to the particulars delivered by them, under paragraph 1 hereof.

3. And it is further ordered that the time within which the Plaintiffs shall be required to deliver their Answer to the Defendants' plea herein be extended until twenty days after the delivery of such particulars by the Defendants as required by paragraph 1 hereof, and in the event of the Defendants adding to the said particulars to be delivered by them under paragraph 1 hereof by virtue of the leave

in their behalf reserved to them by paragraph 2 hereof, the Plaintiffs shall be at liberty to deliver a further Answer to the Defendants' said plea if they so desire within twenty days after the delivery of such additional particulars by the Defendants as aforesaid.

4. And it is further ordered that the costs of this application be costs in the cause.

By the Court,

(Sgd.) CHARLES MORSE,
Deputy Registrar.

ORDER FOR INSPECTION AND PARTICULARS.
(Copy actual Order made in case.)

IN THE EXCHEQUER COURT OF CANADA.

BEFORE THE
HONOURABLE MR. JUSTICE BURBIDGE,
In Chambers.

BETWEEN
THE SYDENHAM GLASS COMPANY, LIMITED,
Plaintiffs;

AND
HENRY D. HERDT AND THE CANADIAN GLASS
MANUFACTURING COMPANY, LIMITED,
Defendants.

Upon reading the Summons herein, upon the twenty-second day of December, A.D. 1906, upon hearing read the Statement of Claim herein, and the affidavits of Allan R. Oughtred and James Whittmore, filed, and upon hearing what was alleged by Counsel for both parties.

I do order that the Plaintiffs be at liberty along with their Solicitors and Scientific witnesses at any time within twenty days from the service of this order to inspect the machine or machines of the Defendants which are alleged by the Plaintiffs to infringe the patent mentioned in the Statement of Claim, upon giving three days' notice to the Defendants of their intention so to do by serving due notice of the time and place of such inspection upon the agents of the Defendants' Solicitors at Ottawa and that upon such inspection said machine or machines be put in motion.

And I do further order that within thirty days from the service of this order the Plaintiffs do deliver to the Defendants particulars of the breaches complained of in this action specifying particularly the time or times when and the place or places where the Plaintiffs alleged that the breaches complained of took place, and specifying

also whether it is alleged that such breaches consisted in the manufacture or in the use or in the sale of any machine or machines or part or parts of any machine or machines and specifying the machine or machines or the part or parts of any machine or machines which it is alleged by the Plaintiffs the Defendants have made or used or sold in infringement of the Plaintiffs' patent, and specifying which of the claims of the patent sued upon it is alleged by the Plaintiffs have been infringed by the Defendants and specifying as to each claim alleged to have been infringed by what machine or machines or part or parts of any machine or machines, it is alleged that the same has been infringed.

And I do further order that the time allowed for filing the Statement of Defence herein be extended until forty days from the delivery by the Plaintiffs of the particulars hereinbefore directed.

And I do further order that the costs of this application be costs in the cause.

Dated at Ottawa this fourth day of February, A.D. 1907.

(Sgd.) GEO. W. BURBIDGE,
J.E.C.

JUDGMENT FOR INJUNCTION, DELIVERY UP,
ACCOUNT, ETC.

(Copy Judgment in case.)

IN THE EXCHEQUER COURT OF CANADA.

MONDAY THE TWENTY-FOURTH DAY OF JANUARY, A.D. 1898.

PRESENT:
THE HONOURABLE MR. JUSTICE BURBIDGE.

BETWEEN
THE AUER INCANDESCENT LIGHT MANUFACTURING COMPANY, LIMITED
Plaintiff;

AND
HERMAN DRESCHER AND MARY VAIL MELICK,
Defendants.

THIS ACTION coming on for trial at the City of Ottawa, in the County of Carleton on the 19th day of October A.D. 1897 before this Court in the presence of Counsel for the plaintiffs and defendants, upon hearing read the pleadings herein and upon hearing what was alleged by Counsel on both sides.

THIS COURT was pleased to direct that this action should stand over for judgment, and the same coming on this day for judgment.

THIS COURT DOETH ORDER, ADJUDGE AND DECLARE that the Letters Patent of invention of the Dominion of Canada Number 46946, bearing date of the 1st day of September, A.D. 1894, and issued to the Welsbach Incandescent Gas Light Company, Limited, is a good, valid and subsisting patent, and did not lapse on the 10th day of August, 1896, by reason of the expiry on that date of a patent obtained in Spain for the same invention on the 10th day of August 1886.

AND THIS COURT BOTH FURTHER ORDER AND ANJUROE, that the said defendants have infringed the said Letters Patent Numbersd 46946.

AND THIS COURT BOTH FURTHER ORDER AND ANJUROE that the said defendants, their servants, workmen, agents and employees be, and they are hereby restrained and ordered to desist, during the continuance of the said Letters Patent, from importing into this country, manufacturing, using, leasing, offering for sale and selling to others for use, incandescent devices manufactured according to or in the manner prescribed by the said Letters Patent, or according to or in any manner only colourably differing therefrom, and generally from infringing the rights of the plaintiff in respect to which the said Letters Patent were granted.

AND THIS COURT BOTH FURTHER ORDER AND ANJUROE that the said Defendants do forthwith deliver up to the said plaintiff all such lights or incandescent devices as aforesaid as are now in the possession of the said Defendants.

AND THIS COURT BOTH FURTHER ORDER AND ANJUDGE that an account be taken of all gains and profits made by the defendants by the manufacture, sale, letting or hire, supply or user of such lights or devices for lights by the defendants, or by any person or persons by the order or for the use of the said defendants, and that the matter be referred to the Registrar of this Court to take such account and ascertain the amount of such gains and profits.

AND THIS COURT BOTH FURTHER ORDER AND ANJUDGE that the defendants do pay to the plaintiff the amount of gains and profits so ascertained.

AND THIS COURT BOTH FURTHER ORDER AND ANJUROE that the defendants do pay to the plaintiff the costs of this action after taxation thereof.

By the Court,

(Sgd.) L. A. AUDETTE,
Registrar.

JUDGMENT DISMISSING ACTION AND DECLAR-
ING PATENT INVALID.

(Order made in case.)

IN THE EXCHEQUER COURT OF CANADA.

FRIDAY THE TENTH DAY OF NOVEMBER, A.D. 1910.

PRESENT:

THE HONOURABLE MR. JUSTICE CASSELS.

BETWEEN

THE BARNET McQUEEN COMPANY, LIMITED,
Plaintiff;

AND

CANADIAN STEWART COMPANY, LIMITED,
Defendants.

(1) THIS ACTION having come on for trial at the City of Ottawa on the twenty-fifth, twenty-sixth and twenty-seventh days of May, A.D. 1910, and the City of Toronto on the twentieth, twenty-first, twenty-second, twenty-third, twenty-fourth and twenty-fifth days of June, A.D. 1910, and at the said City of Ottawa on the third, fourth, fifth, sixth, seventh and eighth days of October, A.D. 1910, before this Court in the presence of Counsel, both for the Plaintiff and for the Defendant, upon hearing read the Pleadings, and other proceeding in the said action and upon hearing the evidence adduced and what was alleged by Counsel aforesaid; this Court was pleased to direct that said action should stand over for judgment and the same coming on this day for judgment.

(2) THIS COURT doth order and adjudge that the said Action be and the same is hereby dismissed.

(3) ANN THIS Court doth declare that the Letters Patent of the Dominion of Canada, numbered 111315 and 113624 in question in this action are and each of them is

invalid, and null and void, and doth order and adjudge the same accordingly.

(4) Ann it is further ordered and adjudged that the Plaintiff do pay to the Defendant its costs of this Action after taxation thereof.

By the Court,

(Signed) L. A. AUDETTE,
Registrar.

FORMS FOR PATENT CONVEYANCING.

ASSIGNMENT OF A PATENT with benefit of IMPROVEMENTS, &c.

THIS INDENTURE made the _____ day of _____ 19____, BETWEEN A.B. of &c. (hereinafter called "the assignor") of the one part, and C.D. of &c. (hereinafter called "the assignee") of the other part.

WHEREAS the assignor claims to be the inventor of a certain new and useful improvement in _____

for which he has obtained a patent of the Dominion of Canada, No. _____ dated _____

AND WHEREAS the assignor has agreed with the assignee for the sale to him of the said invention and patent and of any improvements which may hereafter he made by him in the said invention and all inventions connected with improvements in _____

NOW THIS INDENTURE WITNESSETH as follows:

1. In pursuance of the said agreement in this behalf and in consideration of the sum of...dollars now paid to the assignor by the assignee (the receipt whereof is hereby acknowledged) the assignor hereby assigns, sells or sets over unto the assignee ALL THOSE the said invention and patent and the full and exclusive benefit thereof and all rights, privileges and advantages appertaining thereto

2. The assignor hereby covenants with the assignee as follows:—

(a) That the said patent is subsisting and is not void or voidable.

[or where as is usually the case, it is desired to covenant against the acts or omissions of the assignor only]

(a) That notwithstanding anything by him the assignor done, omitted or knowingly suffered the said patent is now valid and subsisting and not void or voidable.)

(b) That notwithstanding anything by the assignor done or omitted or knowingly suffered, the assignor has

good right to assign the said patent in manner aforesaid and that the assignee and the persons deriving title under him may at all times hereafter during the continuance of the said patent enjoy the full benefit thereof without any interruption or disturbance from or by the assignor or any person rightfully claiming under him and that the assignor and every person rightfully claiming under him will at the request and cost of the assignee or the person deriving title under him execute and do such further assurances and things for more effectually vesting the said patent in him or them as he or they shall reasonably require.

(c) That he has granted no licenses for the use, manufacture or sale of the patented invention.

(d) That he will forthwith from time to time after making or discovering any improvement upon the said invention or any further invention relating to

disclose the improvement or invention to the assignee, who shall be entitled to the sole and exclusive benefit thereof, and if and whenever required by the assignee, but at the cost of the assignee, will give the assignee all particulars as to the mode of operating the same, and will at the expense of the assignee, execute and do all instruments, acts and things necessary for obtaining a patent in respect of such improvement or further invention and vesting the same in the assignee.

(e) That he will, whenever the solicitor of the assignee shall advise that a reissue of any of the patents vested in the assignee is desirable, sign all papers, take all oaths and do all acts necessary to the procurement of such reissue without charge to the assignee but at his expense.

3. In the construction of these presents the expression "the assignor" shall whenever the context so admits, be deemed to include the said assignor and his personal representatives, and the expression "the assignee" shall whenever the context so admits, be deemed to include the said assignee, his personal representatives and assigns.

IN WITNESS WHEREOF the parties have hereto set their hands and seals.

WITNESS:

**ASSIGNMENT OF HALF SHARE OF A PATENT
WITH PROVISIONS FOR DIVISION OF PROFITS, ETC.**

THIS INDENTURE made the _____ day of _____ 19____,
BETWEEN A.B. of &c. (hereinafter called "the assignor")
of the one part, and C.D. of &c. (hereinafter called "the
assignee") of the other part.

WHEREAS the assignor claims to be the inventor of a
certain new and useful improvement in _____
_____ for which he has ob-
tained a patent of the Dominion of Canada, No.
_____ dated _____

AND WHEREAS the assignor has agreed with the as-
signee for the sale to him of one half share of the said
invention and patent.

NOW THIS INDENTURE WITNESSETH as follows:—

1. In pursuance of the said agreement in this behalf
and in consideration of the sum of _____ dollars now paid
to the assignor by the assignee (the receipt whereof is
hereby acknowledged) the assignor hereby assigns, sells and
set over unto the assignee one half share of ALL THOSE
the said invention and patent and the full and exclusive
benefit thereof and all rights, privileges and advantages ap-
pertaining thereto.

2. The assignor hereby covenants with the assignee that
notwithstanding anything by the assignor done or omitted
or knowingly suffered the said patent is subsisting and is
not void or voidable and the assignor has good right to as-
sign the said one half share in the said patent in manner
aforesaid and that the assignee and the persons deriving
title under him may at all times hereafter during the con-
tinuance of the said patent enjoy the full benefit thereof
without any interruption or disturbance from or by the
assignor or any person rightfully claiming under him and
that the assignor and every person rightfully claiming under
him will at the request and cost of the assignee or the
person deriving title under him execute and do such further
assurances and things for more effectually vesting the said
one half share in the said patent in him or them as he or
they shall reasonably require.

3. Either of the said parties may himself manufacture
and sell under the said patent but neither party shall

grant any license to manufacture or sell patented articles under the said patent, nor shall he sell or assign his share in the said patent without the previous consent in writing of the other. All profits or royalties derived by either of the said parties from working or granting licenses under said patent shall be divided equally between the parties but neither party shall be liable to the other for, or share in any loss made by the other.

4. All fees connected with keeping on foot the said patent shall be paid by the parties hereto in equal shares. Either may, if he thinks advisable pay such fee and shall on paying the same have the right to recover from the other party one half of the amount so paid together with interest at the rate of _____ per cent per annum.

5. Each of the said parties shall keep true and particular accounts of all matters connected with the manufacture and sale by him of all articles manufactured by him under the said patent and all monies received by him in respect of royalties or otherwise from licenses under said patent and will on the _____ day of _____ and the _____ day of _____ in each year deliver a statement of account in respect of such manufacture and sale and the profits derived therefrom and such monies received from royalties or otherwise from licenses under said patent and shall if required verify or procure some fitting person in his employ to verify the said statement by statutory declaration, and shall, as soon as statement of account shall have been delivered by him as aforesaid, and the balance (where any) due from him to the other party shall be ascertained, pay the same to him forthwith, but if the said balance or any part thereof shall remain unpaid for one month from the date on which the said account should have been rendered as hereinbefore set out, it shall bear interest from the end of said month at the rate of _____ per cent per annum, and together with such interest be a charge on the share of the said patent of the party liable to pay the same in favour of the other party. Each party shall permit the other party, his accountant, solicitor or agent, at all reasonable times, to enter any factory or place of business or any office of the other party to ascertain the state and extent of the manufacture or sale under the said patent, and to inspect and take copies of or extracts

from any books, accounts, receipts, papers and documents in the possession or under control of such party and relating in whole or in part to the manufacture and sale under the said patent or to monies received for royalties or otherwise in respect of licenses under the said patent.

6. In the event of any infringement of the said patent being committed or threatened either of the parties may, if the other shall be unwilling to join with him in taking action, commence and prosecute in the joint names of himself and the other party, but at his own cost, all proceedings or actions necessary to restrain or prevent such infringement.

7. If either party shall at any time make any improvement in or relating to upon the said invention or make or discover any further invention relating to he shall forthwith disclose the same to the other and if and when required by the other shall give to him full details as to the nature of and mode of working the same and will execute and, do all instruments, acts and things necessary for obtaining a patent in respect of such improvement or further invention and vesting a one half share in such patent in the other party and any patent so obtained shall be held by the parties hereto upon the same terms as herein set forth and the expenses of patenting any invention shall be borne by the parties equally.

8. In the construction of these presents, whenever the context so admits the expression "the assignor" shall be deemed to include the said assignor and his personal representatives, and the expression "the assignee" shall be deemed to include the said assignee, his personal representatives and assigns.

IN WITNESS WHEREOF the parties have hereto set their hands and affixed their seals.

WITNESSES:

ASSIGNMENT OF HALF SHARE OF A PATENT
WITH PROVISIONS FOR WORKING
INDEPENDENTLY.

THIS INDENTURE made the _____ day of _____ 19____,
BETWEEN A.B. of &c. (hereinafter called "the assignor")
of the one part, and C.D. of &c. (hereinafter called "the
assignee") of the other part.

WHEREAS the assignor claims to be the inventor of a
certain new and useful improvement in _____
for which he has
obtained a patent of the Dominion of Canada, numbered
dated _____

AND WHEREAS the assignor has agreed with the as-
signee for the sale to him of one half share of the said in-
vention and patent.

NOW THIS INDENTURE WITNESSETH as follows:—

1. In pursuance of the said agreement in this behalf
and in consideration of the sum of _____
dollars now paid to the assignor by the assignee (the
receipt whereof is hereby acknowledged) the assignor here-
by assigns, sells and sets over unto the assignee one half
share of ALL THOSE the said invention and patent and the
full and exclusive benefit thereof and all rights, privileges
and advantages appertaining thereto.
2. The assignor hereby covenants with the assignee
that notwithstanding anything by the assignor done or
omitted or knowingly suffered, the said patent is subsisting
and is not void or voidable and the assignor has good right
to assign the said one half share in the said patent in man-
ner aforesaid and that the assignee and the person deriving
title under him may at all times hereafter during the con-
tinuance of the said patent enjoy the full benefit thereof
without any interruption or disturbance from or by the
assignor or any person rightfully claiming under him and
that the assignor and every person rightfully claiming under
him will at the request and cost of the assignee or the
person deriving title under him execute and do such further
assurances and things for more effectually vesting the said
one half share in the said patent in him or them as he or
they shall reasonably require.

3. Either of the parties hereto may manufacture and sell patented articles under the said patent without accounting to the other for any profits derived therefrom.

4. Either party shall be at liberty to sell and assign his share or interest of and in the said invention and patent to any third party.

5. Neither party shall grant any license to manufacture or sell patented articles under the said patent without the previous written consent of the other.

6. All fees connected with keeping on foot the said patent shall be paid by the parties hereto in equal shares. Either may if he thinks advisable pay such fee and shall on paying the same have the right to recover from the other party one half of the amount so paid together with interest at the rate of per cent per annum.

7. In the construction of these presents whenever the context so admits the expression "the assignor" shall be deemed to include the said assignor and his personal representatives and the expression "the assignee" shall be deemed to include the said assignee, his personal representatives and assigns.

IN WITNESS WHEREOF the parties have hereto set their hands and affixed their seals.

WITNESS:

ASSIGNMENT OF DISTRICT.

THIS INDENTURE made the _____ day of _____,
 BETWEEN
 A.B. of &c. (hereinafter called "the assignor")
 of the one part
 AND
 C.D. of &c. (hereinafter called "the assignee")
 of the other part:

WHEREAS E.F. of _____ did obtain a patent
 of the Dominion of Canada, dated _____
 numbered _____ for an invention entitled improve-
 ments in _____ and whereas by indenture dated
 _____ the said E.F. did assign to the assignor
 the said patent and the said improvements in _____
 AND WHEREAS the said assignor has agreed to assign
 to the said assignee for the sum of _____ dollars, the said
 patent and the full benefit thereof and of any improve-
 ments which may hereafter be made by him in the
 patented invention and all inventions connected with im-
 provements in _____ for the Province of _____

NOW THIS INDENTURE WITNESSETH as follows:

1. In pursuance of the said agreement and in consider-
 ation of the sum of _____ dollars, now paid by the said
 assignee to the said assignor, the receipt whereof is hereby
 acknowledged the said assignor hereby assigns, sells and
 sets over unto the said assignee the said invention and
 patent and the full benefit and advantage thereof for the
 Province of _____ but not elsewhere, to HOLD the same
 unto the said assignee and his assigns absolutely.
2. The assignor hereby covenants with the assignee that
 notwithstanding anything by the assignor done or omitted
 or knowingly suffered, the assignor has good right to assign
 the said patent in manner aforesaid and that the assignee
 and the person deriving title under him may at all times
 hereafter during the continuance of the said patent enjoy
 the full benefit thereof within the said Province without
 any interruption or disturbance from or by the assignor or
 any person rightfully claiming under him and that the as-
 signor and every person rightfully claiming under him will

at the request and cost of the assignee or the person deriving title under him execute and do such further assurances and things for more effectually vesting the said patent within the said Province in him or them as he or they shall reasonably require.

3. The said assignor hereby further covenants with the said assignee as follows:

(a) That notwithstanding anything by him the assignor done, omitted or knowingly suffered the said patent is now subsisting and is valid.

(b) That he has not granted any assignment of the said patent or any license for the manufacture, sale or use of the said invention with respect to the said Province of .

(c) That he will pay all fees and do all things necessary for maintaining and keeping on foot the said patent during the term for which the same was granted.

(d) That he will forthwith from time to time after making or discovering any improvement upon the said invention or any further invention relating to disclose the improvement or invention to the assignee, who shall be entitled to the sole and exclusive benefit thereof within the said Province of , and if and whenever required by the assignee but at the cost of the assignee, will give the assignee all particulars as to the mode of operating the same, and will at the expense of the assignee, execute and do all instruments, acts and things necessary for obtaining a patent in respect of such improvement or further invention and vesting the same in the assignee for the said Province of .

4. The said assignee hereby covenants with the assignor that he will within the aforesaid Province of supply all demands on the part of the public for the patented invention at a reasonable price in accordance with Section 38 of the Patent Act. (Or if Patent is under Section 44 insert the following:—4. The assignee within the said Province of will do all such acts and things as may be necessary for satisfying the reasonable requirements of the public within the meaning of Section 44 of the Patent Act in respect of the invention and will not do or suffer and will not abstain from doing any act

or thing whereby a license may be ordered by the Commissioner under the provisions of that section.)

5. The said assignee further covenants that he will not sell the patented invention outside of the said Province, or knowingly sell the said invention to anyone who intends to remove the same outside of the said Province.

IN WITNESS, ETC.

(b) If the royalties payable in any one year ending on the day of shall not have amounted in the aggregate to the sum of dollars, then the licensee will pay to the licensor such further sum as with the amount of royalties payable in such year together amounts to the sum of dollars.

(c) The licensee will stamp or engrave on each patented article sold or offered for sale by him the words "PATENTED 19 "

(d) The licensee will keep true and particular accounts of all matters connected with the manufacture under this license and will on the day of and the day of in each year deliver particulars in writing of the number of manufactured and sold respectively by or on behalf of the licensee during the preceding half year.

(e) The licensee will permit the licensor or his accountant, solicitor or agent at all reasonable times to inspect and take copies of or extracts from any books, accounts, receipts, papers and documents in the possession or under the control of the licensee and relating in whole or in part to the manufacture, use or sale of under this license and to inspect and take an account of all the said for the time being, in stock or on hand.

(f) The licensee will not raise or cause to be raised any question concerning or any objection to the validity of the said patent on any ground whatsoever.

(g) The licensee will give notice in writing to the patentee of any infringement or threatened infringement of the said patent which shall at any time and from time to time come to his knowledge.

(h) The licensee will not import or cause to be imported into Canada the patented invention.

(i) The licensee will forthwith communicate to the licensor any improvement he may make on and any further invention he may discover with respect to the invention (whether such improvement or further invention shall be patented or not) and will fully disclose to the licensor the nature and mode of operating the same and will permit the licensor to make, use and sell the same throughout the Dominion of Canada, and during the continuance of the license.

2. The licensor hereby covenants with the licensee:—

(a) That the licensee, paying the royalties hereby reserved and observing and performing the covenants by the licensee herein contained, shall and may at all times during the continuance of this license enjoy and exercise the same without any interruption or disturbance by the licensor or any person claiming under him.

(b) That notwithstanding anything by the licensor done, or omitted or knowingly suffered, the said patent is now valid and subsisting.

3. The licensor for himself and the persons deriving title under him hereby further covenants with the licensee that the licensor will during the continuance of the license hereby granted observe and perform the covenants and provisions following, that is to say:—

(a) The licensor will pay all renewal fees and do all such acts and things as may be necessary to maintain and keep on foot the said patent.

(b) The licensor will forthwith communicate to the licensee any improvement he may make on and any further invention he may discover with respect to (whether such improvement or further invention shall be patented or not) and will fully disclose to the licensee the nature and mode of operating the same and will permit the licensee to make, use, exercise and vend the same during the subsistence of this license without payment of any further royalty, premium, or compensation than such as is hereinbefore mentioned.

(c) The licensee will at the request and cost of the licensee commence all necessary legal or other proceedings in respect of any infringement or suspected infringement of the said patent for effectually protecting and defending the same and take all such steps and do all such things as may be necessary for prosecuting any such proceedings to a successful conclusion or permit the licensee at the like cost so to do in the name of the licensor and if the licensor shall fail for the period of _____ months after his attention has been called to the matter by notice in writing by the licensee to institute any proceedings or actions necessary to prevent any infringement of the said patent, the licensee shall be relieved from further obligations to pay any royalties under this license.

4. If said patent shall in any action for infringement or impeachment thereof be held invalid on any ground whatsoever all royalties payable hereunder shall forthwith cease to be payable, but if the decision of the Court so holding or declaring shall be reversed on appeal, the royalties shall forthwith again become payable together with all royalties which would have been payable but for the adverse decision.

5. If any royalties hereinbefore covenanted to be paid shall be in arrears and unpaid for a period of months after the same shall have become payable or if the licensee shall commit or allow to be committed a breach of any of the other covenants hereinbefore contained and on his part to be performed or observed and shall not remedy such breach within days after notice is given to him by the licensor requiring such remedy or if the licensee shall become insolvent or make an assignment for the benefit of his creditors or compound or make any arrangement with his creditors the licensor shall be at liberty in every such case by notice in writing to determine this license, and thereupon the license hereby granted and all rights of the licensee hereunder shall forthwith cease and determine but without prejudice to the remedy of the licensor to sue for and recover any royalties then due and to the remedy of either party in respect of any previous breach of any of the covenants or agreements herein contained.

6. Any notice required or authorised to be given by either party hereunder to the other may be served by prepaid letter sent through the post to the last known place of business of the other party and it shall operate and be deemed to have been served at the expiration of ten days from the time of being put into the post office at the
of and proof that the letter was properly addressed and posted shall be sufficient evidence of service.

IN WITNESS, ETC.

respect of each _____ manufactured by or on behalf
of the licensee during the preceding _____ months.

(b) If the royalties payable in any one year ending on
the _____ day of _____ shall not have amount-
ed in the aggregate to the sum of _____ dollars,
then the licensee will pay to the licensor such further sum
as with the amount of royalties payable in such year to-
gether amounts to the sum of _____ dollars.

(c) The licensee will stamp or engrave on each patented
article sold or offered for sale by him the words "PATENTED
19 _____"

(d) The licensee will keep true and particular accounts
of all matters connected with the manufacture under this
license and will on the _____ day of _____ and the
day of _____ in each year deliver particulars in writing
of the number of _____ manufactured and sold
respectively by or on behalf of the licensee during the pre-
ceding half year.

(e) The licensee will permit the licensor or his account-
ant, solicitor or agent at all reasonable times to inspect and
take copies of or extracts from any books, accounts, receipts,
papers and documents in the possession or under the control
of the licensee and relating in whole or in part to the
manufacture, use or sale of _____
under this license and to inspect and take an account of all
the said _____ for the time being in stock or in
hand.

(f) The licensee will not raise or cause to be raised
any question concerning or any objection to the validity
of the said patent on any ground whatsoever.

(g) The licensee will give notice in writing to the
patentee of any infringement or threatened infringement of
the said patent within the Counties of _____
which shall at any time and from time to time come to his
knowledge.

(h) The licensee will within the aforesaid Counties of _____
supply all demands on the part of the pub-
lic for the patented invention at a reasonable price in ac-
cordance with Section 38 of the Patent Act.

(Or, where the patent is under Section 44 of the Patent
Act.)

(h) The licensee within the said Counties of will do all such acts and things as may be necessary for satisfying the reasonable requirements of the public within the meaning of Section 44 of the Patent Act in respect of the invention and will not do or suffer and will not abstain from doing any act or thing whereby a license may be ordered by the Commissioner under the provisions of that Section.

(j) The licensee will not import or cause to be imported into Canada the patented invention.

(k) The licensee will forthwith communicate to the licensor any improvement he may make on and any further invention he may discover with respect to the invention (whether such improvement or further invention shall be patented or not) and will fully disclose to the licensor the nature and mode of operating the same and will permit the licensor to make, use and sell the same throughout the Dominion of Canada, except in the territory covered by this license, and during the continuance of the license.

(l) The licensee will not sell the patented invention outside of the said Counties of or knowingly sell the said invention to anyone who intends to remove the same outside of the said Counties.

2. The licensor hereby covenants with the licensee:—

(a) That the licensee, paying the royalties hereby reserved and observing and performing the covenants by the licensee herein contained, shall and may at all times during the continuance of this license enjoy and exercise the same without any interruption or disturbance by the licensor or any person claiming under him.

(b) That notwithstanding anything by the licensor done, or omitted or knowingly suffered, the said patent is now valid and subsisting.

3. The licensor for himself and the persons deriving title under him hereby further covenants with the licensee that the licensor will during the continuance of the license hereby granted observe and perform the covenants and provisions following, that is to say:—

(a) The licensor will pay all renewal fees and do all such acts and things as may be necessary to maintain and keep on foot the said patent.

(b) The licensor will forthwith communicate to the licensee any improvement he may make on and any further invention he may discover with respect to (whether such improvement or further invention shall be patented or not) and will fully disclose to the licensee the nature and mode of operating the same and will permit the licensee to make, use, and sell the same within the Counties of _____ during the subsistence of this license without payment of any further royalty, premium or compensation than such as is hereinbefore mentioned.

(c) The licensor will at the request and cost of the licensee commence all necessary legal or other proceedings in respect of any infringement or suspected infringement of the said patent for effectually protecting and defending the same within said Counties of _____ and take all such steps and do all such things as may be necessary for prosecuting any such proceedings to a successful conclusion or permit the licensee at the like cost so to do in the name of the licensor and if the licensor shall fail for the period of _____ months after his attention has been called to the matter by notice in writing by the licensee to institute any proceedings or actions necessary to prevent any infringement of the said patent within said Counties of _____ the licensee shall be relieved from further obligations to pay any royalties under this license.

4. If said patent shall in any action for infringement or impeachment thereof be held invalid on any ground whatsoever all royalties payable hereunder shall forthwith cease to be payable, but if the decision of the court so holding or declaring shall be reversed on appeal, the royalties shall forthwith again become payable together with all royalties which would have been payable but for the adverse decision.

5. If any royalties hereinbefore covenanted to be paid shall be in arrears and unpaid for a period of _____ months after the same shall have become payable or if the licensee shall commit or allow to be committed a breach of any of the other covenants hereinbefore contained and on his part to be performed or observed and shall not remedy such breach within _____ days after notice is given to him by the licensor requiring such remedy or if

the licensee shall become insolvent or make an assignment for the benefit of his creditors or compound or make any arrangement with his creditors the licensor shall be at liberty in every such case by notice in writing to determine this license, and thereupon the license hereby granted and all rights of the licensee hereunder shall forthwith cease and determine but without prejudice to the remedy of the licensor to sue for and recover any royalties then due and to the remedy of either party in respect of any previous breach of any of the covenants or agreements herein contained.

6. Any notice required or authorised to be given by either party hereunder to the other may be served by prepaid letter sent through the post to the last known place of business of the other party and it shall operate and be deemed to have been served at the expiration of ten days from the time of being put into the post office at the of and proof that the letter was properly addressed and posted shall be sufficient evidence of service.

IN WITNESS, ETC.

MORTGAGE OF A PATENT.

THIS INDENTURE made the _____ day of _____ 19____, between A.B. of _____, hereinafter called "the mortgagor" of the one part, and C.D. of _____, hereinafter called "the mortgagee" of the other part.

WHEREAS the mortgagor is the owner of a patent of the Dominion of Canada, dated _____ and numbered _____, for improvements in _____

AND WHEREAS the mortgagee has agreed to lend to the mortgagor the sum of _____ dollars to be secured together with interest thereon by mortgage of the said patent as hereinafter expressed.

NOW THIS INDENTURE WITNESSETH as follows:

1. In consideration of the sum of _____ dollars, this day paid by the mortgagee to the mortgagor (the receipt whereof is hereby acknowledged) the mortgagor doth covenant with the mortgagee that he the mortgagor will pay to the mortgagee on the _____ day of _____ the sum of _____ dollars, together with interest thereon, as well after as before maturity, both before and after default, at the rate of _____ per cent per annum payable _____ yearly on the _____ days of _____ and _____ in each and every year until the principal sum shall have been fully paid and satisfied, the first of said instalments of interest to become payable on the _____ day of _____

AND IT IS HEREBY AGREED that in case default shall be made in payment of any sum to become due for interest, at any time appointed for payment thereof as aforesaid, compound interest shall be payable and the sum in arrears for interest from time to time, as well after as before maturity, shall bear interest at the rate aforesaid and in case the interest and compound interest are not paid in six months from the time of default a rest shall be made, and compound interest at the rate aforesaid shall be payable on the aggregate amount then due, as well after as before maturity, and so on from time to time, and all such interest and compound interest shall be a charge on the premises hereby assigned.

2. For the consideration aforesaid the mortgagor doth hereby assign to the mortgagee the said patent and the sole and exclusive benefit thereof, to have and to hold the same to the mortgagee subject to the proviso for redemption hereinafter contained.

3. The mortgagor hereby covenants with the mortgagee that notwithstanding anything by the mortgagor done or omitted or knowingly suffered the mortgagor has good right to assign the said patent in manner aforesaid, and that the mortgagee and the persons deriving title under him may from and after default in payment of the principal sum or interest as hereinbefore provided at all times thereafter during the continuance of the said patent enjoy the full benefit thereof without any interruption or disturbance from or by the mortgagor or any person rightfully claiming under him, and that the mortgagor, and every person rightfully claiming under him will, at the request and cost of the mortgagee, or the persons deriving title under him, execute and do such further assurances and things for more effectually vesting the said patent in him or them as he or they shall reasonably require.

4. If the mortgagor shall pay to the mortgagee the sum of _____ dollars with interest as hereinbefore set out then that the mortgagee will at any time thereafter at the request and cost of the mortgagor re-assign to him the said patent and the sole and exclusive benefit thereof.

5. Upon default in payment of the principal sum or interest for (one) month the mortgagee may, on giving notice to the mortgagor assign and sell the said patent either by public auction or private contract, and out of the proceeds of such sale in the first place pay all costs incurred by him in or about the sale and in the next place apply the same in or towards satisfaction of the monies owing to this security and then pay the surplus (if any) to the mortgagee.

Provided that on default of payment for (two) months the above powers may be exercised without notice.

6. The mortgagor will do all acts and things necessary to maintain said patent and will pay all fees required by law for keeping the said patent on foot and deliver a

receipt for such payment to the mortgagee one calendar month at least before the latest time allowed by law for payment of the same respectively, and in case the mortgagee shall fail to deliver such receipt within the said time it shall be lawful for the mortgagee to make such payment. The mortgagor will from time to time so long as any money shall remain on the security of these presents, use his best endeavours to discover any infringement now or hereafter to be made of the said letters patent, and communicate to the mortgagee every suspected or ascertained infringement aforesaid, and if, and when, required in writing by the mortgagee so to do, will either himself commence or take and prosecute or defend all legal or other proceedings necessary or suitable for the protection of the said letters patent, or the recovery of damages for, or restraining, the infringement thereof, or permit the mortgagee to take such proceedings, and, in the event of the mortgagor taking such proceedings will do everything in his power for the purpose of making such proceedings successful.

7. All monies paid by the mortgagee for or in respect of any fees or other charges or any proceedings whatever the event of such proceedings, including costs of the mortgagee as between solicitor and client, together with interest on the same at the rate of _____ per cent per annum from the respective times of payment shall be repaid by the mortgagor to the mortgagee on demand, and shall in the meantime and until payment thereof be charged on the premises hereby assigned.

8. The mortgagor shall not import the patented invention beyond the period allowed by the Patent Act, and shall manufacture the invention so that the patent shall not become null and void under the conditions of Section 38 of the said Act. At any time that the mortgagee shall be of the opinion that the patent is likely to be endangered by failure to manufacture the invention he may himself manufacture or cause to be manufactured the invention so that all demands therefor shall be satisfied and all losses incurred in so manufacturing or causing the invention to be manufactured together with interest on the same at the rate of _____ per cent per annum

shall be repaid by the mortgagor on demand and shall until repayment thereof be charged on the premises hereby assigned.

9. Until the mortgagee shall become entitled to exercise the power of sale vested in him by virtue of these presents, the mortgagor shall be at liberty to make, use and sell the said invention without interruption from the mortgagee but shall not grant any licenses to make, use or sell said invention, except such as shall be joined in by the mortgagee.

10. From and after the time when the mortgagee shall first become entitled to exercise the power of sale vested in him by virtue of these presents it shall be lawful for him alone to work the said invention and to grant licenses in respect thereof or to assign the said patent and invention for districts or otherwise to deal with the same in any manner that he shall think fit.

11. The mortgagor doth hereby covenant with the mortgagee that he will communicate to the mortgagee during the continuance of this security all improvements which he may discover or make in connection with the said invention and also all improvements which during the said time he shall have control of or acquire by purchase or otherwise and whether patented or not and such improvements and patents if any, shall be deemed to be comprised within this security and the mortgagor will execute all documents and do all things necessary to extend the operation of this security to all such improvements or patents.

12. It is hereby declared that except where the context requires a different interpretation, each of the expressions "the mortgagor" and "the mortgagee" shall whenever used herein be also applicable as far as possible to the executors, administrators and assigns of the person designated thereby.

IN WITNESS WHEREOF we have hereunto set our hands and seals at the place and date above mentioned.

WITNESS, ETC.

5. The said patented machine shall be and remain the property of the licensor and may be removed from the premises of the licensee upon breach of any of the covenants of this agreement.

6. The licensee shall not at any time hereafter question or dispute the validity of the said patent and his obligation to pay rent or royalties hereunder shall continue, notwithstanding that the said patent is declared void.

7. The licensee shall not remove the patented machine or suffer the same to be removed from his premises without the previous written consent of the licensor.

8. This agreement may be determined by the licensor any time after day of upon giving to the licensee months notice in writing and on the expiration of such notice the patented machine shall be removed from the licensee's premises at the expense of the licensor.

9. The licensee shall give notice to the licensor when and so soon as any part of the said machine becomes worn out or needs repair, and thereupon the licensor shall replace such parts as may be necessary and place the machine in good repair at the cost of the licensee.

10. The licensor shall keep the said machine insured against fire in his favour in the sum of in an Insurance Company approved by him, and the cost of such insurance shall be paid by the licensee.

11. In the construction of these presents whenever the context so admits the expression "the licensor" shall be deemed to include the said licensor and his personal representatives, and the expression "the licensee" shall be deemed to include the said licensee and his personal representatives.

IN WITNESS, ETC.

ASSIGNMENT OF LICENSE.

THIS INDENTURE made the _____ day of _____
 BETWEEN
 A.B. of &c. (hereinafter called "the licensee")
 _____ of the first part,
 AND
 C.D. of &c. (hereinafter called "the assignee")
 _____ of the second part:

WHEREAS _____ the owner of a certain patent of
 the Dominion of Canada, numbered _____ dated _____
 for improvements in _____ did by indenture
 dated the _____ day of _____ grant a license to
 said licensee and his assigns to manufacture, use and sell
 the invention covered by said patent, for the residue of
 the term comprised in the said patent, in consideration of
 the royalties therein reserved and subject to the coven-
 ants and agreements therein contained.

AND WHEREAS the said licensee has agreed to sell and
 assign to the said assignee the said license for the sum
 of _____

NOW THIS INDENTURE WITNESSETH as follows:

1. In pursuance of the said agreement and in consider-
 ation of the sum of _____ dollars now paid by the said
 assignee to the said licensee the receipt whereof is hereby
 acknowledged the said licensee hereby assigns and conveys
 unto the said assignee ALL THAT the said license and the
 full and exclusive benefit thereof. To Hold the same unto
 the said assignee and his assigns subject to the covenants,
 agreements and conditions therein contained and on the
 licensee's part to be performed and observed.

2. The said licensee hereby covenants with the said as-
 signee that the said license is now subsisting and is not
 void or voidable and that all royalties reserved thereunder
 up to the _____ day of _____ have been paid and all
 the covenants and agreements therein contained and on
 the licensee's part to be observed and performed have been
 duly observed and performed up to and including the date
 of these presents.

3. The said assignee hereby covenants with the said licensee that he will henceforth pay the royalty reserved hereby and will perform and observe all the covenants, agreements and conditions on the licensee's part contained in the said license and that he will indemnify and keep indemnified the said licensee from and against all actions, proceedings, claims and demands in respect of the said royalties, covenants, agreements and conditions respectively.

IN WITNESS ETC.

AGREEMENT WITH WORKMAN TO PERFECT
INVENTION.

AN AGREEMENT made the _____ day of _____
BETWEEN

A.B. of &c. (hereinafter called "the employer")
_____ of the one part,

AND

C.D. of &c. (hereinafter called "the employee")
_____ of the other part:

WHEREBY IT IS AGREED as follows:

1. The said employee shall forthwith use his utmost endeavours to invent a _____ which will (insert result desired).

2. The said employer shall at his own cost provide the said workman with all tools, appliances, machinery and things necessary for the purpose aforesaid.

3. In consideration of the premises the said employer shall pay to the said employee for a period of _____ months from the date hereof the sum of _____ per week.

4. If at any time hereafter or if within the period of _____ months from the date hereof the said employee shall invent a _____ which will (insert result desired) he shall forthwith disclose to the said employer or any patent agent or solicitor appointed by him a full and complete description of the nature of the said invention and the mode of operating the same.

5. The said invention and all improvements thereon at any time discovered or invented by the said employee shall be the sole and absolute property of the said employer and the said employee if and wherever required by the said employer shall at the expense of the said employer apply for a patent for the said invention or any such improvement thereon and shall on request by and at the cost of the said employer execute and do all instruments and things necessary to assign and vest the said invention and improvements and any patent that may be obtained in respect thereof in the said employer or any person or persons or company appointed by him.

In WITNESS, ETC.

AGREEMENT BETWEEN JOINT INVENTORS.

AN AGREEMENT made the _____ day of _____
BETWEEN _____ of the one part,
AND _____ of the other part:

WHEREAS the said parties hereto have jointly invented certain improvements in

AND WHEREAS the said parties hereto are desirous heretofore making application for patent for the said invention of defining their respective rights and interests in the said invention and in any patent that may be obtained for the same.

NOW IT IS HEREBY AGREED AS FOLLOWS:

1. The said invention and any patent obtained in respect thereof shall, subject as hereinafter mentioned, be held by the said inventors equally and as tenants in common.
2. All fees, costs, charges and expenses connected with obtaining, maintaining, protecting and extending or prolonging the said patent shall be borne and paid by the said parties hereto in equal shares and proportions.
3. All profits or royalties derived by either of the said parties under the said patent shall be divided equally between them.
4. No license shall be granted by either of the said parties without the previous consent in writing of the other and neither party shall sell or assign his share or interest in the said patent without the like consent.

AS WITNESS:

FORMS.

PETITION FOR PLACING A PATENT UNDER THE COMPULSORY LICENCE CLAUSE.

THE PETITION OF _____ of _____ showeth:

(a) That he is the owner of Canadian Patent No. _____
for _____ granted to him on the _____
day of _____

(b) That he is desirous of having his patent placed under
the Compulsory Licence Clause for the following
reasons:

(Here insert reasons.)

Your petitioner hereby prays that his patent may be
made subject to Section 44 of the Patent Act Revised
Statutes 1906.

Signed at _____ this _____ day of _____ 19 .

PETITION FOR EXTENSION OF TIME WITHIN
WHICH TO IMPORT.

THE PETITION OF _____ of _____ showeth:

(a) That he is the owner of Canadian Patent No. _____
for _____ granted to him on the
day of _____

(b) That he is desirous of obtaining an extension of time
within which to import for the following reasons:

(Here insert reasons.)

Your petitioner therefore prays that an extension of
may be granted to him within which to import.

Signed at _____ this _____ day of _____ 19 .

AFFIDAVIT.

I, A.B., the above named petitioner being sworn, make oath
and say: that the several allegations set forth in the fore-
going petition are respectively true and correct.

Sworn to and subscribed before me this _____ day of
19 .

PETITION FOR EXTENSION OF TIME WITHIN
WHICH TO MANUFACTURE.

THE PETITION OF _____ of _____ showeth:

(a) That he is the owner of Canadian Patent No. _____
for _____ granted to him on the
day of _____

(b) That he is desirous of obtaining an extension of
time within which to manufacture for the following rea-
sons:

(Here insert reasons.)

Your petitioner therefore prays that an extension of
_____ may be granted to him within which to
manufacture.

Signed at _____ this _____ day of _____ .

AFFIDAVIT.

I, A.B., the above named petitioner make oath
and say: that the several allegations set forth in the
foregoing petition are respectively true and correct.

Sworn to and subscribed before me this _____ day of _____
19 .

THE PATENT ACT.

REVISED STATUTES OF CANADA, 1906.

CHAPTER 69.

An Act respecting Patents of Invention.

SHORT TITLE.

Short title. 1. This Act may be cited as the Patent Act. R.S., c. 61, s. 1.

INTERPRETATION.

Definitions. 2. In this Act, unless the context otherwise requires,—

- (a) 'Minister' means the Minister of Agriculture;
- (b) 'Commissioner' means the Commissioner of Patents, and 'Deputy Commissioner' means the Deputy Commissioner of Patents;
- (c) 'invention' means any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement in any art, machine, manufacture or composition of matter;
- (d) 'legal representatives' includes heirs, executors, administrators and assigns or other legal representatives. R.S., c. 61, s. 2.

PATENT OFFICE AND APPOINTMENT OF OFFICERS.

Patent office constituted. 3. There shall be attached to the Department of Agriculture, as a branch thereof, an office which shall be called the Patent Office; and the Minister of Agriculture for the time being shall be the Commissioner of Patents. R.S., c. 61, s. 3.

Duties of Commissioner. 4. The Commissioner shall receive all applications, fees, papers, documents and models for patents, and shall perform and do all acts and things requisite for the granting and issuing of patents of invention; and he shall have the charge and custody of the books, records, papers, models, machines and other things belonging to the Patent Office. R.S., c. 61, s. 4.

Deputy and officers. 5. The Deputy Minister of Agriculture shall be the Deputy Commissioner, and the Governor in Council may,

from time to time, appoint such officers and clerks under the Deputy Commissioner as are necessary for the purposes of this Act, and such officers and clerks shall hold office during pleasure.

2. The Deputy Commissioner may do any act or thing, whether judicial or ministerial, which the Commissioner of Patents is authorized or empowered to do by any provision of this Act; and, in the absence of the Deputy Commissioner, any person performing the duties of the Deputy Minister of Agriculture under the authority of the Civil Service Act may, as acting deputy commissioner, do any such act or thing. 60-61 V., c. 25, s. 1; 3 E. VII., c. 46, s. 1.

Powers and
duties of
Deputy.

6. The Commissioner shall cause a seal to be made for the purposes of this Act, and may cause to be sealed therewith every patent and other instrument and copy thereof issuing from the Patent Office. R.S., c. 61, s. 6.

Seal.

APPLICATIONS FOR PATENTS.

7. Any person who has invented any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement in any art, machine, manufacture or composition of matter, which was not known or used by any other person before his invention thereof, and which has not been in public use or on sale with the consent or allowance of the inventor thereof, for more than one year previously to his application for patent therefor in Canada, may, on a petition to that effect, presented to the Commissioner, and on compliance with the other requirements of this Act, obtain a patent granting to such person an exclusive property in such invention.

Who may
obtain
patents.

2. No patent shall issue for an invention which has an illicit object in view, or for any mere scientific principle or abstract theorem. R.S., c. 61, s. 7.

What may
not be
patented.

8. 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 patent is applied for within one year

As to inven-
tions for
which for-
eign patents
have been
taken out.

from the date of the issue of the first foreign patent for such invention.

Manufacture
in Canada.

2. If within three months after the date of the issue of a foreign patent, the inventor gives notice to the Commissioner of his intention to apply for a patent in Canada for such invention, then no other person having commenced to manufacture the same device in Canada during such period of one year, shall be entitled to continue the manufacture of the same after the inventor has obtained a patent therefor in Canada, without the consent or allowance of the inventor.

Expiry of
Canadian
patent.

3. No Canadian patent issued previous to the thirteenth day of August, one thousand nine hundred and three, shall be deemed to have expired before the end of the term for which it was granted merely because of the expiry of a foreign patent for the same invention. 55-56 V., c. 24, s. 1; 3 E. VII., c. 46, s. 2.

Improvements may
be patented.

9. Any person who has invented any improvement on any patented invention, may obtain a patent for such improvement; but he shall not thereby obtain the right of vending or using the original invention, nor shall the patent for the original invention confer the right of vending or using the patented improvement. R.S., c. 61, s. 9.

Oath of
inventor to
be made
before
obtaining
patent.

10. Every inventor shall, before a patent can be obtained, make oath, or, when entitled by law to make an affirmation instead of an oath, shall make an affirmation, that he verily believes that he is the inventor of the invention for which the patent is asked, and that the several allegations in the petition contained are respectively true and correct.

Or of the
applicant if
the inventor
is dead.

2. In the event of the inventor being dead, such oath or affirmation shall be made by the applicant, and shall state that he verily believes that the person whose assignee or legal representative he is, was the inventor of the invention for which the patent is solicited, and that the several allegations in the petition contained are respectively true and correct.

Before
whom oath
may be
made.

3. Such oath or affirmation may be made before a minister plenipotentiary, *chargé d'affaires*, consul, vice-consul or consular agent, a judge of any court, a notary

public, a justice of the peace, or the mayor of any city, borough or town, or a commissioner for taking affidavits having authority or jurisdiction within the place where the oath may be administered. R.S., c. 61, s. 10; 55-56 V., c. 24, s. 2.

11. The applicant for a patent shall, for the purposes of this Act, elect his domicile at some known and specified place in Canada, and shall mention the same in his petition for a patent. R.S., c. 61, s. 11. Election of domicile.

12. The applicant shall, in his petition for a patent, insert the title or name of the invention, and shall, with the petition, send in a specification in duplicate of the invention and an additional or third copy of the claim or claims. 56 V., c. 34, s. 1. Particulars required on application.

13. The specification shall correctly and fully describe the mode or modes of operating the invention, as contemplated by the inventor; and shall state clearly and distinctly the contrivances and things which he claims as new, and for the use of which he claims an exclusive property and privilege. What the specification shall show.

2. Such specification shall bear the name of the place where, and the date when it is made, and shall be signed by the inventor, if he is alive, and if not, by the applicant, and by two witnesses to such signature of the inventor or applicant. Place and date.

3. In the case of a machine the specification shall fully explain the principle and the several modes in which it is intended to apply and work out the same. In the case of a machine

4. In the case of a machine, or in any other case in which the invention admits of illustration by means of drawings, the applicant shall also, with his application, send in drawings in duplicate, showing clearly all parts of the invention; and each drawing shall bear the signature of the inventor, if he is alive, and, if not, of the applicant, or of the attorney of such inventor or applicant, and shall have written references corresponding with the specification; but the Commissioner may require further drawings or dispense with any of them, as he sees fit. Drawings to be furnished in certain cases.

Drawings
how dis-
posed of.

5. One duplicate of the specification and of the drawings, if there are drawings, shall be annexed to the patent, of which it shall form an essential part, and the other duplicate shall remain deposited in the Patent Office.

Certain
matters may
be dispensed
with.

6. The Commissioner may, in his discretion, dispense with the duplicate specification and drawing, and in lieu thereof cause copies of the specification and drawing, in print or otherwise, to be attached to the patent, of which they shall form an essential part. R.S., c. 61, s. 13.

Model to be
furnished
when re-
quired, or
specimens.

14. In all cases in which the invention admits of representation by model, the applicant, if required by the Commissioner, shall furnish a model of convenient size exhibiting its several parts in due proportion; and when the invention is a composition of matter, the applicant, if required by the Commissioner, shall furnish specimens of the ingredients, and of the composition, sufficient in quantity for the purpose of experiment.

Precautions
in cases of
dangerous
substances.

2. If such ingredients or composition be of an explosive or dangerous character, they shall be furnished with such precautions as are prescribed in the requisition therefor. 55-56 V., c. 24, s. 3.

Examin-
ation of
applications
for patents.

15. On each application for a patent, a thorough and reliable examination shall be made by competent examiners to be employed in the Patent Office for that purpose. 55-56 V., c. 24, s. 8.

Withdrawal
of applica-
tions for
patents.

16. No application for a patent shall be withdrawn without the consent in writing of each and every registered assignee of such patent or any part thereof. 55-56 V., c. 24, s. 4.

REFUSAL TO GRANT PATENTS.

Commis-
sioner may
object to
grant a
patent in
certain
cases.

17. The Commissioner may object to grant a patent in any of the following cases:—

- (a) When he is of opinion that the alleged invention is not patentable in law;
- (b) When it appears to him that the invention is already in the possession of the public, with the consent or allowance of the inventor;
- (c) When it appears to him that there is no novelty in the invention;

- (d) When it appears to him 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;
- (e) When it appears to him that the invention has already been patented in Canada, unless the Commissioner has doubts as to whether the patentee or the applicant is the first inventor;
- (f) When it appears to him that the invention has already been patented in a foreign country, and the year has not expired within which the foreign patentee may apply for a patent in Canada, unless the Commissioner has doubts as to whether the foreign patentee or the applicant is the first inventor. R.S., c. 61, s. 16.

18. Whenever the Commissioner objects to grant a patent as aforesaid, he shall notify the applicant to that effect and shall state the ground or reason therefor, with sufficient detail to enable the applicant to answer, if he can, the objection of the Commissioner. R.S., c. 61, s. 17.

Applicant to be notified.

19. Every applicant who has failed to obtain a patent by reason of the objection of the Commissioner, as aforesaid, may, at any time within six months after notice thereof has been mailed, addressed to him or his agent, appeal from the decision of the Commissioner to the Governor in Council. R.S., c. 61, s. 18.

Appeal to Governor in Council.

CONFLICTING APPLICATIONS.

20. In case of conflicting applications for any patent, the same shall be submitted to the arbitration of three skilled persons, two of whom shall be chosen by the applicants, one by each, and the third of whom shall be chosen by the Commissioner; and the decision or award of such arbitrators, or of any two of them, delivered to the Commissioner in writing, and subscribed by them or any two of them, shall be final, as far as concerns the granting of the patent.

Arbitration in case of conflicting applications.

2. If either of the applicants refuses or fails to choose an arbitrator, when required so to do by the Commissioner, and if there are only two such applicants, the patent shall issue to the other applicant.

Failure to appoint arbitrator.

In certain cases, commissioner may appoint.

3. If there are more than two conflicting applications, and if the persons applying do not all unite in appointing three arbitrators, the Commissioner may appoint the three arbitrators for the purposes aforesaid.

Arbitrators to be sworn.

4. The arbitrators so named shall subscribe and take before a judge of any court or record in Canada, an oath in the form following, that is to say:—

Form of oath.

'I, the undersigned (A.B.), being duly appointed an arbitrator under the authority of the Patent Act, do hereby solemnly swear or (affirm, *as the case may be*), that I will well and truly perform the duty of such arbitrator on the conflicting applications of (C.D. and E.F.) submitted to me.'

Powers of arbitrators.

5. The arbitrators, or any one of them, when so sworn, may summon before them any applicant or other person, and may require him to give evidence on oath, orally or in writing (*or on solemn affirmation, if such applicant or person is entitled to affirm in civil cases*), and to produce such documents and things as such arbitrators deem requisite to the full investigation of the matters into which they are appointed to examine, and they shall have the same power to enforce the attendance of such applicants and other persons, and to compel them to give evidence, as is vested in any court of justice in civil cases, in the province in which the arbitration is held.

Their remuneration.

6. The fees for the services of such arbitrators shall be a matter of agreement between the arbitrators and the applicants, and shall be paid by the applicants who name them, respectively, except those of the arbitrator or arbitrators named by the Commissioner, which shall be paid by the applicants jointly. R.S., c. 61, s. 19.

GRANT AND DURATION OF PATENTS.

What the patent shall contain and confer.

21. Every patent granted under this Act shall contain the title or name of the invention, with a reference to the specification, and shall grant to the patentee and his legal representatives, for the term therein mentioned, from the granting of the same, the exclusive right, privilege and liberty of making, constructing and using, and vending to others to be used, the said invention, subject to adjudication in respect thereof before any court of competent jurisdiction.

2. In cases of joint applications, the patents shall be granted in the names of all the applicants. R.S., c. 61, s. 20. Joint applications.

22. Every patent shall be issued under the seal of the Patent Office and the signature of the Commissioner or of the Deputy Commissioner, and, when duly registered, shall be good, and shall avail the grantee and his legal representatives for the term mentioned in the patent. Form of issue.

2. The Commissioner may require that any patent, before it is signed by the Commissioner or by any other member of the King's Privy Council for Canada, acting for him, and before the seal hereinbefore mentioned is affixed to it, shall be examined by the Minister of Justice; and, if such examination is so required, the Minister of Justice shall, accordingly, examine it, and if he finds it conformable to law, he shall certify accordingly, and such patent may then be signed, and the seal affixed thereto. R.S., c. 61, s. 21; 56 V., c. 34, s. 2. Patent may be referred to Minister of Justice.

23. The term limited for the duration of every patent of invention issued by the Patent Office shall be eighteen years; but, at the time of the application therefor, it shall be at the option of the applicant to pay the full fee required for the term of eighteen years, or the partial fee required for the term of six years, or the partial fee required for the term of twelve years. Duration of patent.

2. If a partial fee only is paid, the proportion of the fee shall be stated in the patent, and the patent shall, notwithstanding anything therein or in this Act contained, cease at the end of the term for which the partial fee has been paid, unless before the expiration of the said term the holder of the patent pays the fee required for the further term of six or twelve years, and obtains from the Patent Office a certificate of such payment in the form which is, from time to time, adopted, which certificate shall be attached to and refer to the patent, and shall be under the signature of the Commissioner or of the Deputy Commissioner. If partial fee only is paid.

3. If such second payment, together with the first payment, makes up only the fee required for twelve years, then the patent shall, notwithstanding anything therein Effect of second and of further payment.

or in this Act contained, cease at the end of the term of twelve years, unless at or before the expiration of such term the holder thereof pays the further fee required for the remaining six years, making up the full term of eighteen years, and obtains a like certificate in respect thereof. 55-56 V., c. 24, s. 5.; 56 V., c. 34, s. 3.

RE-ISSUE OF PATENTS.

In certain cases new patent or amended specification may be issued.

24. Whenever any patent is deemed defective or inoperative by reason of insufficient description or specification, or by reason of the patentee claiming more than he had a right to claim as new, but at the same time it appears that the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention, the Commissioner may, upon the surrender of such patent and the payment of the further fee hereinafter provided, cause a new patent, in accordance with an amended description and specification made by such patentee, to be issued to him for the same invention, for any part or for the whole of the then unexpired residue of the term for which the original patent was, or might have been granted.

Death or assignment.

2. In the event of the death of the original patentee or of his having assigned the patent, a like right shall vest in his assignee or his legal representatives.

Effect of new patent.

3. Such new patent, and the amended description and specification, shall have the same effect in law, on the trial of any action thereafter commenced for any cause subsequently accruing, as if the same had been originally filed in such corrected form before the issue of the original patent.

Separate patents for separate parts of invention.

4. The Commissioner may entertain separate applications, and cause patents to be issued for distinct and separate parts of the invention patented, upon payment of the fee for a re-issue for each of such re-issued patents. R.S., c. 61, s. 23.

DISCLAIMERS.

25. Whenever, by any mistake, accident or inadvertence, and without any wilful intent to defraud or mislead the public, a patentee has,—

- (a) made his specification too broad, claiming more than that of which he or the person through whom he claims was the first inventor; or,
- (b) in the specification, claimed that he or the person through whom he claims was the first inventor of any material or substantial part of the invention patented, of which he was not the first inventor, and to which he had no lawful right;

Patentee may disclaim any thing included in patent by mistake.

the patentee may, on payment of the fee hereinafter provided, make disclaimer of such parts as he does not claim to hold by virtue of the patent or the assignment thereof.

2. Such disclaimer shall be in writing, and in duplicate, and shall be attested in the manner hereinbefore prescribed, in respect of an application for a patent; one copy thereof shall be filed and recorded in the office of the Commissioner, and the other copy thereof shall be attached to the patent and made a part thereof by reference, and such disclaimer shall thereafter be taken and considered as part of the original specification.

Form and attestation of disclaimer.

3. Such disclaimer shall not affect any action pending at the time of its being made, except in so far as relates to the question of unreasonable neglect or delay in making it.

Not to affect pending suits.

4. In case of the death of the original patentee, or of his having assigned the patent, a like right shall vest in his legal representatives, any of whom may make disclaimer.

In case of death of patentee.

5. The patent shall thereafter be deemed good and valid for so much of the invention as is truly the invention of the disclaimant, and is not disclaimed, if it is a material and substantial part of the invention, and is definitely distinguished from other parts claimed without right; and the disclaimant shall be entitled to maintain an action or suit in respect of such part accordingly. R.S., c. 61, s. 24.

Effect of disclaimer.

ASSIGNMENTS.

26. The patent may be granted to any person to whom the inventor, entitled under this Act to obtain a patent, has assigned or bequeathed the right of obtaining the same, or in default of such assignment or bequest, to the

When representatives may obtain the patent.

legal representatives of the deceased inventor. R.S., c. 61, s. 25.

Patents to be assignable.

Registration

Assignment null if not registered.

Assignment in cases of joint applications.

27. Every patent issued for an invention shall be assignable in law, either as to the whole interest or as to any part thereof, by any instrument in writing; but such assignment, and every grant and conveyance of any exclusive right to make and use and to grant to others the right to make and use the invention patented, within and throughout Canada or any part thereof, shall be registered in the Patent Office in the manner, from time to time, prescribed by the Commissioner for such registration; and every assignment affecting a patent for invention shall be null and void against any subsequent assignee, unless such instrument is registered as hereinbefore prescribed, before the registration of the instrument under which such subsequent assignee claims. R.S., c. 61, s. 26.

28. In cases of joint applications or grants, every assignment from one or more of the applicants or patentees to the other or others, or to any other person, shall be registered in like manner as other assignments. R.S., c. 61, s. 27.

IMPEACHMENT AND OTHER LEGAL PROCEEDINGS IN RESPECT OF PATENTS.

Patent to be void in certain cases, or valid only for parts.

Proviso.

Copies of judgment to be sent to patent office.

29. A patent shall be void, if any material allegation in the petition or declaration of the applicant hereinbefore mentioned in respect of such patent is untrue, or if the specifications and drawings contain more or less than is necessary for obtaining the end for which they purport to be made, when such omission or addition is wilfully made for the purpose of misleading: Provided that if it appears to the court that such omission or addition was an involuntary error, and if it is proved that the patentee is entitled to the remainder of his patent *pro tanto*, the court shall render a judgment in accordance with the facts, and shall determine as to costs, and the patent shall be held valid for such part of the invention described, as the patentee is so found entitled to.

2. Two office copies of such judgment shall be furnished to the Patent Office by the patentee, one of which shall be registered and remain of record in the office, and

the other of which shall be attached to the patent, and made a part of it by a reference thereto. R.S., c. 61, s. 28.

30. Every person who, without the consent in writing of the patentee, makes, constructs or puts in practice any invention for which a patent has been obtained under this Act or any previous Act, or who procures such invention from any person not authorized by the patentee or his legal representatives to make or use it, and who uses it, shall be liable to the patentee or his legal representatives in an action of damages for so doing; and the judgment shall be enforced, and the damages and costs that are adjudged shall be recoverable, in like manner as in other cases in the court in which the action is brought. R.S., c. 61, s. 29.

Remedy for infringement of patent.

31. Any action for the infringement of a patent may be brought in the court of record having jurisdiction, to the amount of the damages claimed, in the province in which the infringement is alleged to have taken place, which holds its sittings nearest to the place of residence or of business of the defendant; and such court shall decide the case and determine as to costs. R.S., c. 61, s. 30.

Action for infringement of patent.

32. In any action for the infringement of a patent, the court, or any judge thereof, may, on the application of the plaintiff, or defendant respectively, make such order as the court or judge sees fit,—

Injunction may issue.

- (1) restraining or for an injunction restraining the opposite party from further use, manufacture or sale of the subject-matter of the patent, and for his punishment in the event of disobedience of such order; or,
- (b) for and respecting inspection or account; and,
- (c) generally respecting the proceedings in the action.

2. An appeal shall lie from any such order under the same circumstances, and to the same court, as from other judgments or orders of the court in which the order is made. R.S., c. 61, s. 31.

Appeal.

33. Whenever the plaintiff, in any such action, fails to sustain the same, because his specification and claim embrace more than that of which he was the first in- Court may discriminate in certain cases.

ventor, and it appears that the defendant used or infringed any part of the invention justly and truly specified and claimed as new, the court may discriminate, and the judgment may be rendered accordingly. R.S., c. 61, s. 32.

Defence in
action for
infringe-
ment.

34. The defendant, in any such action, may plead as matter of defence, any fact or default which, by this Act, or by law, renders the patent void; and the court shall take cognizance of such pleading and of the facts connected therewith, and shall decide the case accordingly. R.S., c. 61, s. 33.

Proceedings
for impeach-
ment of
patent.

35. Any person who desires to impeach any patent issued under this Act, may obtain a sealed and certified copy of the patent and of the petition, affidavit, specification and drawings thereunto relating, and may have the same filed in the office of the prothonotary or clerk of any of the divisions of the High Court of Justice in Ontario, or of the Superior Court of Quebec, or of the Supreme Court in Nova Scotia, New Brunswick, British Columbia or Prince Edward Island, respectively, or of the Court of King's Bench in Manitoba, or of the Supreme Court of the Northwest Territories in the provinces of Saskatchewan and Alberta respectively, pending the disestablishment of that Court by the legislature of those provinces respectively, and thereafter of such superior court of justice as, in respect of civil jurisdiction, is established by the said legislatures respectively in lieu thereof, or of the Territorial Court in the Yukon Territory, according to the domicile elected by the patentee, as aforesaid, or in the office of the registrar of the Exchequer Court of Canada, and such courts, respectively, shall adjudicate on the matter and decide as to costs; and if the domicile elected by the patentee is in that part of Canada formerly known as the district of Keewatin, the Court of King's Bench of Manitoba shall have jurisdiction until there is a superior court therein, after which, such superior court shall have jurisdiction.

Scire facias
may issue.

2. The patent and documents aforesaid shall then be held as of record in such courts respectively, so that a writ of *scire facias*, under the seal of the court, grounded upon such record, may issue for the repeal of the patent, for cause as aforesaid, if, upon proceedings had upon the writ

in accordance with the meaning of this Act, the patent is adjudged to be void. R.S., c. 61, s. 34; 53 V., c. 13, s. 1.

36. A certificate of the judgment avoiding any patent shall, at the request of any person filing it to make it of record in the Patent Office, be entered on the margin of the enrolment of the patent in the Patent Office, and the patent shall thereupon be and be held to have been void and of no effect, unless the judgment is reversed on appeal as hereinafter provided. R.S., c. 61, s. 35.

Judgment
voiding
patent to be
filed in
Patent
Office.

37. The judgment declaring or refusing to declare any patent void shall be subject to appeal to any court having appellate jurisdiction in other cases decided by the court by which such judgment was rendered. R.S., c. 61, s. 36.

Appeal.

CONDITIONS AND EXTENSION.

38. Every patent shall, unless otherwise ordered by the Commissioner as hereinafter provided, be subject, and expressed to be subject, to the following conditions:—

Patent con-
ditional.

(a) Such patent and all the rights and privileges thereby granted shall cease and determine, and the patent shall be null and void at the end of two years from the date thereof, unless the patentee or his legal representatives, within that period or an authorized extension thereof, commence, and after such commencement, continuously carry on in Canada, the construction or manufacture of the invention patented, 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;

Manufacture
in Canada
within two
years.

(b) If, after the expiration of twelve months from the granting of a patent, or an authorized extension of such period, the patentee or patentees, or any of them, or his or their or any of their legal representatives, for the whole or a part of his or their or any of their interest in the patent, import or cause to be imported into Canada, the invention for which the patent is granted, such patent shall be void as to the interest of the person or persons so importing or causing to be imported. 3 E. VII., c. 46, s. 4.

Importation
prohibited.

Term for
manufacture
in Canada
may be
extended.

39. Whenever a patentee is unable to commence or carry on the construction or manufacture of his invention within the two years hereinbefore provided, the Commissioner may, at any time not more than three months before the expiration of that term, grant to the patentee or his legal representatives an extension of the term of two years, on his proving to the satisfaction of the Commissioner that his failure to commence or carry on such construction or manufacture is due to reasons beyond his control. 3 E. VII., c. 46, s. 5.

Term for
importation
may be
extended.

40. The Commissioner may grant to the patentee or his legal representatives, for the whole or any part of the patent, an extension for a further term not exceeding one year, during which he may import or cause to be imported into Canada the invention for which the patent is granted, if he or they show cause, satisfactory to the Commissioner, to warrant the granting of such extension; but no extension shall be granted unless application is made to the Commissioner at some time within three months before the expiry of the twelve months aforesaid. 3 E. VII., c. 46, s. 6.

Proviso.

Validity of
any exten-
sions al-
ready
granted.

41. The validity of any extension granted or assumed to be granted before the thirteenth day of August, one thousand nine hundred and three, of the period of two years theretofore limited by statute in that behalf for the commencement of the construction or manufacture of a patented invention, or of the period of twelve months theretofore so limited for the importation of a patented invention, shall not be open to impeachment, nor shall the patent for any invention in respect of which any such extension had been so granted be deemed to have lapsed or expired, because,—

(a) such extension, instead of being granted by the Commissioner, was so granted or assumed to be granted by the Deputy Commissioner, or, as acting deputy commissioner, by a person performing the duties of the Deputy Minister of Agriculture under the provisions of the Civil Service Act in that behalf, instead of by the Commissioner; or,

(b) in the case of the invention to which such extension relates, there had been granted or assumed to be granted a previous extension or previous extensions of such period of two years, or such period of twelve months, as the case may be. 3 E. VII., c. 46, s. 9.

42. The validity of any patent granted before the thirteenth day of August, one thousand nine hundred and three, shall not be impeached, nor shall such patent be deemed to have lapsed or expired, by reason of the failure of the patentee to construct or manufacture the patented invention, if the patentee within the period of two years from the date of the patent allowed for such construction or manufacture, or within an authorized extension of that period, became, and at all times thereafter continued to be, ready either to furnish the patented invention himself or to license the right of using it, on reasonable terms, to any person desiring to use it, and if the patentee, or his legal representatives, within six months from the thirteenth day of August, one thousand nine hundred and three, had,—

Conditional validity of certain patents granted before August 13th, 1903.

- (a) commenced, and after such commencement, continuously carried on in Canada, the construction or manufacture of the patented invention in such manner as to enable any person desiring to use it to 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, or,
- (b) applied for and thereupon obtained an order of the Commissioner making the patent subject to the condition hereinafter provided for authorizing application for the issue of licenses to make, construct, use and sell the patented invention. 3 E. VII., c. 46, s. 10.

43. In the case of any patent which before the thirteenth day of August, one thousand nine hundred and three, had become void or the validity of which might have been impeached, and which was revived or protected from impeachment by any provision of the Act, passed in the third year of His Majesty's reign, chapter forty-six, intituled *An Act to amend the Patent Act*, or which,

Rights of third persons saved.

by reason of any such provision, is to be deemed not to have elapsed or expired, any person who had, between the time when such patent became void or the ground for such impeachment arose, and the thirteenth day of August, one thousand nine hundred and three, aforesaid, commence to manufacture, use or sell in Canada the invention covered by such patent, may continue to manufacture, use or sell it in as full and ample a measure as if such revival or protection from impeachment had not been effected; and, in case any person had, before the thirteenth day of August aforesaid, contracted with the owner of the patent for the right to manufacture, use or sell such invention in Canada, the contract shall be deemed to have remained in full force and effect notwithstanding that the patent had become void as aforesaid, unless the person who had so contracted with such owner can show that in the meantime, by reason or on the faith of such invalidity or lapsing, he has materially altered his position with respect to such invention, and that the revival of such contract would cause him damage. 3 E. VII., c. 46, s. 14.

Conditions which may be substituted.

44. On the application of the applicant for a patent, previous to the issue thereof, or on the application within six months after the issue of a patent of the patentee or his legal representatives, the Commissioner, having regard to the nature of the invention, may order that such patent, instead of being subject to the condition with respect to the construction and manufacture of the patented invention hereinbefore provided, shall be subject to the following conditions, that is to say:—

Application by any person to use patent.

(a) Any person, at any time while the patent continues in force, may apply to the Commissioner by petition for a license to make, construct, use and sell the patented invention, and the Commissioner shall, subject to general rules which may be made for carrying out this section, hear the person applying and the owner of the patent, and, if he is satisfied that the reasonable requirements of the public in reference to the invention have not been satisfied by reason of the neglect or refusal of the patentee or his legal representatives to make, construct, use

or sell the invention, or to grant licenses to others on reasonable terms to make, construct, use or sell the same, may make an order under his hand and the seal of the Patent Office requiring the owner of the patent to grant a license to the person applying therefor, in such form, and upon such terms as to the duration of the license, the amount of the royalties, security for payment, and otherwise, as the Commissioner, having regard to the nature of the invention and the circumstances of the case, deems just;

Order of
Commissioner.

(b) The Commissioner may, if he thinks fit, and shall on the request of either of the parties to the proceedings, call in the aid of an assessor, specially qualified, and hear the case wholly or partially with his assistance;

Assessors.

(c) The existence of one or more licenses shall not be a bar to an order by the Commissioner for, or to the granting of a license on any application, under this section; and,

More than
one license
may be
granted.

(d) The patent and all rights and privileges thereby granted shall cease and determine, and the patent shall be null and void, if the Commissioner makes an order requiring the owner of the patent to grant any license, and the owner of the patent refuses or neglects to comply with such order within three calendar months next after a copy of it is addressed to him or to his duly authorized agent. 3 E. VII., c. 46, s. 7.

Forfeiture
of patent
for refusal
to grant
license.

45. Any question which arises as to whether a patent, or any interest therein, has or has not become void under any of the provisions of the seven last preceding sections of this Act, may be adjudicated upon by the Exchequer Court of Canada, which court shall have jurisdiction to decide any such questions upon information in the name of the Attorney General of Canada, or at the suit of any person interested; but this section shall not be held to take away or affect the jurisdiction which any court other than the Exchequer Court of Canada possesses.

References
to the
Exchequer
Court.

Jurisdiction
of other
courts.

3 E. VII., c. 46, s. 8.

CAVEATS.

Intending applicant for patent may file a *caveat*.

46. Any intending applicant for a patent who has not yet perfected his invention and is in fear of being despoiled of his idea, may file, in the Patent Office, a description of his invention so far as it has proceeded, with or without plans, at his own will; and the Commissioner, on payment of the fee in this Act prescribed, shall cause the said document, which shall be called a *caveat*, to be preserved in secrecy, with the exception of delivering copies of the same whenever required by the said applicant or by any judicial tribunal, but the secrecy of the document shall cease when the applicant obtains a patent for his invention.

Notice of application by another to be sent to person filing *caveat*.

2. If application is made by any other person for a patent for any invention with which such *caveat* may, in any respect, interfere, the Commissioner shall forthwith give notice by mail, of such application, to the person who has filed such *caveat*, and such person shall, within three months after the date of mailing the notice, if he wishes to avail himself of the *caveat*, file his petition and take the other steps necessary on an application for a patent, and if, in the opinion of the Commissioner, the applications are conflicting, like proceedings may be had in all respects as are by this Act provided in the case of conflicting applications.

Duration of *caveat*.

3. Unless the person filing a *caveat* makes application within one year from the filing thereof for a patent, the Commissioner shall be relieved from the obligation of giving notice, and the *caveat* shall then remain as a simple matter of proof as to novelty or priority of invention, if required. R.S., c. 61, s. 38.

PATENT FEES.

Tariff of fees.

47. The following fees shall be payable before an application for any of the purposes herein mentioned shall be received by the Commissioner, that is to say:—

Full fee for 18 years.....	\$60.00
Partial fee for 12 years.....	40.00
Partial fee for 6 years.....	20.00
Fee for further term of 12 years.....	40.00
Fee for further term of 6 years.....	20.00

On lodging a <i>caveat</i>	\$5.00
On asking to register a judgment <i>pro tanto</i>	4.00
On asking to register an assignment, or any other document affecting or relating to a patent.....	2.00
For each and every patent mentioned in any notice given to the Commissioner by the inventor after the issue of a foreign patent of his intention to apply for a patent in Canada for such invention.....	2.00
On asking to attach a disclaimer to a patent.....	2.00
On asking for a copy of patent with specification.....	4.00
On petition to re-issue a patent after surrender, in addition to the fees on the original patent which shall, notwithstanding such surrender, continue to be payable as aforesaid, for every unexpired year of the duration of the original patent.....	4.00
On office copies of documents, not above mentioned. the following charges shall be made:—	
For every single or first folio of one hundred words certified copy.....	\$0.25
For every such subsequent folio, fractions of or under one-half not being counted, and of one-half or more being counted as a folio.....	0.10

55-56 V., c. 24, s. 7; 56 V., c. 34, s. 4; 3 E. VII., c. 46, s. 11.

48. For every copy of drawings, the person applying shall pay such sum as the Commissioner considers a fair remuneration for the time and labour expended thereon by any officer of the Patent Office, or of the Department, or person employed to perform such service. R.S., c. 61, s. 40. Copies of drawings.

Fees to be in full for all services. 49. The said fees shall be in full of all services performed under this Act, in any such case, by the Commissioner or any person employed in the Patent Office. R.S., c. 61, s. 41.

Application of fees. 50. All fees received under this Act shall be paid over to the Minister of Finance, and shall form part of the Consolidated Revenue Fund of Canada, except such sums as are paid for copies of drawings when made by persons not receiving salaries in the Patent Office. R.S., c. 61, s. 42.

Exception. Return of fees in certain cases only. 51. No person shall be exempt from the payment of any fee or charge payable in respect of any services performed for such person under this Act; and no fee, when paid, shall be returned to the person who paid it, except,—

(a) when the invention is not susceptible of being patented; or,

(b) when the petition for a patent is withdrawn.

2. In every such case the Commissioner may return the fee paid less the sum of ten dollars. R.S., c. 61, s. 43.

GENERAL.

Government may use patented invention 52. The Government of Canada may, at any time, use any patented invention, paying to the patentee such sum as the Commissioner reports to be a reasonable compensation for the use thereof. R.S., c. 61, s. 44.

As to use of patented invention in foreign vessels. 53. No patent shall extend to prevent the use of any invention in any foreign ship or vessel, if such invention is not so used for the manufacture of any goods to be vended within or exported from Canada. R.S., c. 61, s. 45.

Patent not to affect a previous purchaser. 54. Every person who, before the issuing of a patent, has purchased, constructed or acquired any invention for which a patent is afterwards obtained under this Act, shall have the right of using and vending to others the specific article, machine, manufacture or composition of matter patented and so purchased, constructed or acquired before the issue of the patent therefor, without being liable to the patentee or his legal representatives for

so doing; but the patent shall not, as regards other persons, be held invalid by reason of such purchase, construction or acquisition or use of the invention, by the person first aforesaid or by those to whom he has sold the same, unless the same was purchased, constructed, acquired or used, with the consent or allowance of the inventor thereof, for a longer period than one year before the application for a patent therefor, thereby making the invention one which has become public and in public use. R.S., c. 61, s. 46.

Proviso as to other persons.

53. Every patentee under this Act shall stamp or engrave on each patented article sold or offered for sale by him the year of the date of the patent applying to such article, thus,—*Patented, 1906*, or as the case may be; or when, from the nature of the article, this cannot be done, then by affixing to it, or to every package wherein one or more of such articles is or are enclosed, a label marked with a like notice. R.S., c. 61, s. 54.

Patented article to be stamped or marked.

56. All specifications, drawings, models, disclaimers, judgments and other papers, except *caveats*, and except those filed in connection with applications for patents which are still pending, shall be open to the inspection of the public at the Patent Office, under such regulations as are adopted in that behalf. R.S., c. 61, s. 47; 3 E. VII., c. 46, s. 12.

Inspection by the public.

57. The Commissioner may destroy, sell or otherwise dispose of, in such manner as he deems best in the public interest, all models and specimens of composition of matter and of ingredients thereof filed in connection with applications for patents of invention after they have served their immediate purpose.

Sale or destruction of models and specimens of composition.

2. All money arising from the sale or disposal of such models or specimens shall be paid into the Consolidated Revenue Fund of Canada. 3 E. VII., c. 46, s. 15.

Money arising therefrom.

58. Clerical errors which occur in the framing or copying of any instrument in the Patent Office shall not be construed as invalidating the same, but, when discovered, they may be corrected under the authority of the Commissioner. R.S., c. 61, s. 48.

Clerical errors.

Certified copy of destroyed or lost patent.

59. If any patent is destroyed or lost, a certified copy thereof may be issued in lieu thereof upon the person who applies therefor paying the fees hereinbefore prescribed for office copies of documents. R.S., c. 61, s. 49; 53 V., c. 13, s. 4.

Seal of Patent Office to be evidence.

60. Every court, judge and person whosoever shall take notice of the seal of the Patent Office and shall receive the impressions thereof in evidence, in like manner as the impressions of the Great Seal are received in evidence, and shall also take notice of and receive in evidence, without further proof and without production of the originals, all copies or extracts certified under the seal of the Patent Office to be copies of or extracts from documents deposited in such office. R.S., c. 61, s. 50.

Officers of Patent Office not to deal in patents.

61. No officer or employee of the Patent Office shall buy, sell or acquire or traffic in any invention or patent, or in any right to a patent; and every such purchase and sale, and every assignment or transfer thereof by or to any officer or employee, as aforesaid, shall be null and void, but this provision shall not apply to any original inventor, or to any acquisition by bequest. R.S., c. 61, s. 51.

Regulations may be made and forms prescribed.

62. The Commissioner may, from time to time, subject to the approval of the Governor in Council, make such rules and regulations, and prescribe such forms, as appear to him necessary and expedient for the purposes of this Act, and notice thereof shall be given in the *Canada Gazette*; and all documents, executed in conformity with the same and accepted by the Commissioner, shall be held valid, so far as relates to proceedings in the Patent Office. R.S., c. 61, s. 52.

Annual report for Parliament.

63. The Commissioner shall cause a report to be prepared annually and laid before Parliament of the proceedings under this Act, and shall, from time to time, and at least once in each year, publish a list of all patents granted, and may with the approval of the Governor in Council, cause such specifications and drawings as are deemed of interest, or essential parts thereof, to be printed, from time to time, for distribution or sale. R.S., c. 61, s. 53.

OFFENCES AND PENALTIES.

64. Any patentee under this Act who sells or offers for sale any article patented under this Act not stamped or engraved with the year of the patent, applying to such article, or when from the nature of the article this cannot be done, not having affixed to it or every package wherein one or more of such articles is or are inclosed a label marked with the year of the date of the patent applying to such article in manner and form provided by this Act, shall be liable to a penalty not exceeding one hundred dollars, and, in default of the payment of such penalty, to imprisonment for a term not exceeding two months. R.S., c. 61, s. 54.

Patented articles to be stamped or marked.

Penalty for default.

65. Every person who,—

(a) writes, paints, prints, moulds, casts, carves, engraves, stamps or otherwise marks upon anything made or sold by him, and for the sole making or selling of which he is not the patentee, the name or any imitation of the name of any patentee for the sole making or selling of such thing, without the consent of such patentee; or,

Falsely marking an article as patented.

(b) without the consent of the patentee, writes, paints, prints, moulds, casts, carves, engraves, stamps or otherwise marks upon anything not purchased from the patentee, the words, *Patent*, *Letters Patent*, *King's* or *Queen's Patent*, *Patented*, or any word or words of like import, with the intent of counterfeiting or imitating the stamp, mark or device of the patentee, or of deceiving the public and inducing them to believe that the thing in question was made or sold by or with the consent of the patentee or his legal representatives; or,

(c) offers for sale as patented any article not patented in Canada, for the purpose of deceiving the public;

is guilty of an indictable offence, and liable to a fine not exceeding two hundred dollars, or to imprisonment for a term not exceeding three months, or to both. R.S., c. 61, s. 55.

An indictable offence.

Making
certain false
entries on
copies an
indictable
offence.

66. Every person who wilfully makes or causes to be made any false entry in any register or book, or any false or altered copy of any document relating to the purposes of this Act, or who produces or tenders any such false or altered document in evidence, knowing the same to be such, is guilty of an indictable offence, and shall be liable to be punished by fine and imprisonment accordingly. R.S., c. 61, s. 56.

RULES
OF THE
CANADIAN PATENT OFFICE.

BY ORDER IN COUNCIL, DATED 23RD FEBRUARY, 1904.

1. A personal appearance of the applicant, or his representative, at the Patent Office is not required, unless specially called for by the Commissioner. Personal appearance not required.
2. In all cases the applicant or depositor of any paper is responsible for the merits of his allegations, and the validity of the instruments furnished by him or his agent. Responsibility of applicant.
3. Correspondence may be carried on either with the applicant, or his agent, but only with one person, and will be conveyed through the Canadian mails free of charge. Correspondence.
4. All documents must be legibly and neatly written, or printed, on foolscap paper, 13 inches long and 8 wide, with an inner margin of one inch and a half wide. Documents, how to be prepared.
5. All communications are to be addressed—"The Commissioner of Patents, Ottawa, Canada." Papers forwarded to the Office should be accompanied by a letter, and a separate letter should be written on every subject. How to be addressed.
6. As regards proceedings not specially provided for in the accompanying forms, any other form being conformable to the letter and spirit of the law may be accepted, and if not conformable therewith will be returned for correction. Forms of proceedings.
7. Models need only be furnished when required by the Commissioner, and must be neat and substantial working ones, not exceeding 12 inches on the longest side, unless otherwise allowed by special permission; models must be so constructed as to show exactly every part of the in- Models to be furnished only when required by Commissioner.

Samples. vention claimed and its mode of working. In cases where samples of ingredients are required by law, they must be contained in glass hottles properly arranged; hut dangerous or explosive substances must not be sent. Both models and hottles must bear the name of the inventor, the title of the invention and date of the application; they must be furnished to the Patent Office free of charge and in good order.

Fees, how to be transmitted. 8. All fees should be transmitted with the application for any action by the office. Remittances must be in current bankable funds, bank drafts, money orders, or certified cheques payable at par at Ottawa. Money sent by mail should be in registered letters and is at the risk of the sender. Drafts, money orders and cheques should be made payable to the Commissioner of Patents, Ottawa.

Applications to be proceeded with within one year. 9. An applicant for an original patent, or for the re-issue of a patent, shall proceed with his application with due diligence; and upon his failure to prosecute the same within a period of one year after the date of the acknowledgment of the filing of his application, or other subsequent official action of which notice have been duly given, the same shall be held to be abandoned, and any fees paid thereon forfeited, unless the Commissioner is satisfied that the cause of the delay was not the fault of the applicant.

Commissioner may order action within shorter period. In any case, however, in which it is established to the satisfaction of the Commissioner that there is unnecessary delay on the part of the applicant in the prosecution of his application, and that such delay may injure the right of other parties, the Commissioner may require the applicant to proceed with the prosecution of his application within such period less than one year as to the Commissioner may seem reasonable; and upon the failure of the applicant so to do, his application shall be held to be abandoned, with forfeiture of fees, as aforesaid.

Proper action. Prosecution of an application, to save it from abandonment, must include such proper action as the condition of the case may require.

10. Two or more separate inventions cannot be claimed in one application, nor included in one Patent. But if separate matters are represented to be so dependent on, and connected with, each other as to be necessarily taken together, to obtain the end sought for by the inventor, the Commissioner of Patents shall be the judge whether or not the pretensions of the applicant in such respect can be entertained. Separate inventions.

11. The filing of a protest against the issuing of a Patent shall not be taken in itself as sufficient reason to withhold the granting of such Patent to an applicant. Protest, effect of.

12. A *Caveat* can only be filed by an inventor, and shall be composed of a specification (*and drawings*), certified on oath [Form No. 17] and the applicant may, while it is pending, lodge additional papers, provided they relate exclusively to the same invention. The person filing a *Caveat* will not be entitled to notice of any application pending at the time of filing his *Caveat*. A *Caveat* must be limited to a single invention. Caveat. Single invention.

The specification of a *Caveat* should be sufficiently precise to enable the Office to judge whether there is a probable interference when a subsequent application is filed. Caveat specification.

13. Drawings in duplicate, to be attached to the duplicate specification, must be made in India or carbon ink, on sheets of tracing cloth other than Linaura or similar fabric, eight by thirteen inches, neatly executed and without colours. Drawings.

Each sheet of tracing linen shall contain the following certificate at the bottom: "Certified to be the drawings referred to in the specification hereunto annexed," and signed by the inventor or his attorney; place, date, and signature of two witnesses. Certificate.

All drawings must be clear, sharp, well-defined, not too fine and perfectly black.

Lines that are pale, ashy, very fine, ragged or broken, give bad results when photo-lithographed.

Brush-shading, tinting and imitation surface graining should never be used; and in fine-shading the result should be attained with as few lines as possible.

- Section lines.** Section lines also should be as open in their spacing as the case will admit of, and these, as well as all right lines, in order to insure clearness, should be made with a ruling pen. The shading of convex and concave surfaces may be dispensed with when the invention is otherwise well illustrated.
- Shade lines.** Shade lines may sometimes be used with good effect, but heavy shadows where they would obscure lines or letters of reference, should be avoided.
- Bristol, card board, size of, &c.** With each application an extra full set of drawings must be supplied on double Bristol Board, 8 by 13 inches, without writing on its face, merely the usual reference letters; no title, certificate, nor signatures; on the back of the sheet the name of the inventor and the title of the invention must be written in pencil.
- Transmission of card board drawings.** The card board drawing should be rolled on a roller for transmission to the office, as folding will prevent its usefulness for photo-lithographing.
- Re-issue of patents.** 14. In the matter of a re-issue, under Section 24 of the Act, whatever is really embraced in the original application and so described or shown in the same, that it might have been embraced in the original Patent, may be ground for a re-issue. No new matter can be introduced into the specifications, nor shall the models or drawings be amended except each by the other. In the absence of model or drawing, the re-issue may contain amendments, upon satisfactory proof to the Commissioner that such amendments were part of the invention, although omitted in the original application. Separate patents may be issued for each separate and distinct part of the invention, comprehended in the original patent.
- Separate patents.**
- Pending applications.** 15. Information in relation to pending applications will be furnished only to applicants, or to such persons as may be duly authorized in writing by them to obtain the same.
- Office cannot respond to certain inquiries.** 16. The Office can not respond to inquiries as to the probability of an alleged invention being patented in advance of an application for a Patent; nor to inquiries founded on brief or imperfect descriptions, propounded with a view of ascertaining whether alleged improve-

ments have been patented, nor unless the name of the patentee, and, as nearly as possible, the date of the Patent, be given; nor can it act as an expounder of the Patent Law, nor as counsellor for individuals, except as to questions within the office.

Nor act as counsellor.

In order to avoid unnecessary explanations and useless loss of time and labour, it is particularly recommended that reference be made to the law before writing on any subject to the Patent Office.

A copy of the Rules with a particular section marked, sent to any person making an inquiry, will be deemed a respectful answer by the Office.

Marked Rules and Forms.

17. It is desirable, both in the interests of the applicant and of the public service, that the papers and drawings should be prepared by competent persons. Therefore, the applicant is advised, unless himself competent to draw up papers, in connection with the application, to employ a skilled attorney, as the value of patents is largely based upon the ability with which the specification and claims have been prepared. The Office will always decline to advise the selection of an attorney.

Proceedings, how facilitated.

18. All business with this Office should be transacted in writing. The action of the Office will be based exclusively on the written record. No attention will be paid to any alleged verbal promise or understanding in relation to which there is any disagreement or doubt.

Transactions to be in writing.

19. An assignment is to be accompanied by a copy thereof; the original will be kept in the Patent Office, and the copy will be returned to the person sending it, with certificate of registration thereon.

Assignments.

20. All cases connected with the intricate and multifarious proceedings arising from the working of the Patent Office, which are not specially defined and provided for in these Rules will be decided in accordance with the merits of each case under the authority of the Commissioner; and such decision will be communicated to the interested parties in writing.

Miscellaneous cases, how to be decided.

21. Applications for patents sent to this Office, unaccompanied by the fee provided by law, will receive no

Fee must accompany application.

official recognition, nor he filed nor numbered; they will merely be pigeon-holed, and only marked filed the day on which the fee shall have been received.

Right to amend application.

22. The applicant has a right to amend before or after the first rejection or action; and he may amend as often as the examiner presents new reference or reasons for rejection. In so amending the applicant must clearly point out by letter accompanying his amendments and not therein, all the patentable novelty which he thinks the case presents in view of the state of the art disclosed by the references cited or the objections made. He must also show how the amendments avoid such references or objections.

Amendment of drawing and specification.

23. The specifications and drawings must be amended and revised when required, to correct inaccuracies of description or unnecessary prolixity, and to secure correspondence between the claim, the specification and the drawing. But no change in the drawing may be made except by written permission of the office.

How amendments are to be made.

24. Amendments must not be made by erasures or insertions in the original papers, but must be made on fresh sheets of paper, so that the sheets containing the matter to be amended may be removed from the application and replaced by sheets containing the amendments.

Amendments to the specifications must be made in duplicate, and those to the claims in triplicate.

COMPULSORY LICENSES.

Petition for grant of compulsory license or revocation of patent.

25. A petition to the Commissioner for an order for a license under Section 44, paragraph (a), of the Act, shall show clearly the ground or grounds upon which the petitioner claims to be entitled to a license, and shall state in detail the circumstances of the case, the terms upon which he asks that an order be made, the purpose of such order, and the name and address of the patentee and of any other person who is alleged in the petition to have made default.

26. The petition and an examined copy thereof shall be left at the Patent Office, accompanied by affidavits or statutory declarations in proof of the allegations contained in the petition, together with any other documentary evidence in support; and petitioner shall within ten days after the leaving of such petition deliver to the patentee and any other person who is alleged in the petition to have made default, copies of the petition and of such affidavits or statutory declarations and other documentary evidence in support.

To be left with evidence at Patent Office.

27. The person to whom such copies are delivered by the petitioner may, within ten days after being invited to do so by the Commissioner, leave at the Patent Office their oppositions to such petition, together with their affidavits or statutory declarations or other documentary evidence in support, in answer, and if they do so, shall deliver copies thereof to the petitioner within ten days, and the petitioner may, within ten days from such last mentioned delivery, leave at the Patent Office his affidavit or statutory declarations and other documentary evidence in reply; and if he does so, shall deliver copies thereof to the patentee or any other person alleged in the petition to have made default within ten days, such last mentioned affidavits or statutory declarations being confined to matters strictly in reply.

Opposants' oppositions and evidence

Evidence in reply.

28. No further evidence than as aforesaid may be left by either side at the Patent Office, except for leave or on requisition of the Commissioner, and upon such terms, if any, as he may think fit.

Closing of evidence.

29. The Commissioner may at any stage of the proceedings before granting his order, give notice of the proceedings, and furnish copies thereof to any person not a party thereto who may be interested in the patent and whose rights may be affected by his order, and may allow such person to intervene in the proceedings. After such person has been allowed to intervene, he shall be governed by these rules as though the petitioner had alleged in his petition that such person was in default.

Other parties interested may be allowed to intervene.

30. On completion of the evidence, or after the expiration of the time for completing the same, the Com-

Hearing of the petition.

missioner, on the request of the petitioner, shall fix a time for hearing the petition, and shall give notice to the petitioner, the patentee, and all other parties to the proceedings, that it is his intention to hear the petition on a specified day, which day shall not be less than two weeks from the date when the notice is served.

Documents to be typewritten or printed.

31. All petitions and other documents lodged at the Patent Office shall (unless the Commissioner otherwise direct), be typewritten or printed, and the parties shall furnish as many copies of the documents lodged by them as shall be required by the Commissioner.

Copies of papers.

Addresses of parties.

32. Parties shall be entitled to have copies of all papers lodged in respect to the petition, at their own expense. The petitioner and each of the other parties shall specify an address for service in Canada, and may be heard in person or by counsel or by a duly authorized agent.

Counsel on behalf of Crown.

33. The Commissioner shall, if so requested, hear counsel on behalf of the Crown on the question of granting the prayer of any petition. Counsel on behalf of the Crown shall not be 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 Commissioner.

Service of notice.

34. Any notice required to be served or given by the rules relating to compulsory licence may be served or given by posting the same to the party to be notified in a registered envelope, and documents required to be delivered may be delivered in the same way.

Alterations or enlargements of times prescribed by rules.

35. The times prescribed by these rules may be altered or enlarged by the Commissioner if he thinks fit, upon such notice to parties interested and upon such terms, if any, as he may direct.

NOTE:—Appendix of forms issued by Patent Office, with annotations, are to be found in Appendix to this book written by Mr. Lynch.

PATENT ACT.

IN THE EXCHEQUER COURT OF CANADA.

GENERAL RULES AND ORDERS.

In pursuance of Section 87 of "The Exchequer Court Act" (R.S. 1906, C. 140) it is hereby ordered that the following General Rules and Orders shall be in force to regulate the practice and procedure in any appeal to the Exchequer Court from the decision of the Commissioner of Patents, as provided in 3-4 George V., chapter 17, intituled "An Act to amend the Exchequer Court Act."

328. Any appeal to the Exchequer Court from a decision of the Commissioner of Patents objecting to grant a patent of invention shall be by way of rehearing, and shall be brought by notice of motion in a summary way, and no petition, case, or other formal proceeding except such notice of motion shall be necessary. The appellant may by notice of motion appeal from the whole or any part of any decision of the Commissioner, and the notice of motion shall state whether the whole or part only of such decision is complained of, and in the latter case shall specify such part. Such notice of motion on appeal may be in the form given in Schedule "A" to these Rules.

329. When any person intends to appeal from any decision of the Commissioner of Patents objecting to grant a patent of invention he shall within six months after he has received notice of such decision, as provided by 3-4 George V., C. 17, sec. 1, file a notice of motion in the office of the Registrar of the Court. A copy of the notice of motion shall also be served upon the Commissioner of Patents, and upon any party who may be affected by such appeal. The Exchequer Court or a Judge thereof, may direct service of the notice of motion upon any person who before the hearing of the appeal may appear to

have an interest therein, and in the meantime may postpone or adjourn the hearing of the appeal upon such terms as may be thought fit, and may give such judgment and make such order as might have been given or made if the persons served with such notice had been originally parties thereto. Any notice of appeal may be amended at any time as the Exchequer Court, or a Judge, may think fit.

330. Where the appeal cannot be heard at the place and time mentioned in the notice of motion, at least seven days' notice of the time and place subsequently fixed for such hearing shall be given to the Commissioner of Patents, and to any party who may be affected by such appeal.

331. The Commissioner of Patents shall forthwith after the service upon him of the notice of motion by way of appeal, transmit to the Registrar of the Exchequer Court all papers, proceedings and evidence before him relating to the application for the patent in question.

332. On any such appeal the Exchequer Court shall consider and determine the same upon the documents and evidence before the Commissioner of Patents at the date of the decision complained of, and upon such additional evidence relating to the questions in controversy as it may in its discretion direct to be given.

333. The General Rules and Orders regulating the practice and procedure in suits before the Court shall, so far as applicable, prevail in proceedings on appeal from the Commissioner of Patents.

334. The costs of and incidental to all proceedings on such appeals shall be in the discretion of the Court or a Judge. The Court, or a Judge, may order a lump sum in lieu of taxed costs.

335. All appeals from the Commissioner of Patents pending before the Governor in Council at the time of the coming into force of 3-4 George V., C. 17, intituled "An Act to amend the Exchequer Court Act," in which the documents and proceedings relating thereto have been

transferred to the Court by the Governor in Council, shall be heard *de novo*, and notice of motion shall be filed and served by the appellant in every such appeal in the same manner as if the appeal had been taken to the Court in the first instance.

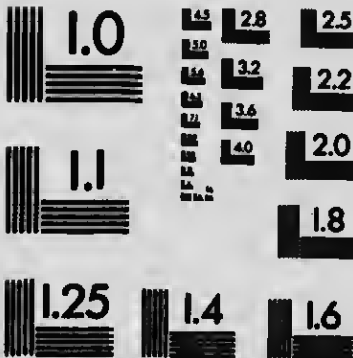
Dated at Ottawa, this 24th day of September, 1913.

(Signed) W. G. P. CASSELS,
J.E.C.



MICROCOPY RESOLUTION TEST CHART

(ANSI and ISO TEST CHART No. 2)



APPLIED IMAGE Inc

1853 East Main Street
Rochester, New York 14609 USA
(716) 482 - 0300 - Phone
(716) 286 - 5989 - Fax

APPENDIX

CANADIAN PATENT OFFICE PRACTICE

DEFINITIONS FOR GUIDANCE IN PREPARING AND
PROSECUTING APPLICATIONS AND OTHER
PROCEEDINGS RELATING TO PATENTS

BY

W. J. LYNCH, I.S.O.,

CHIEF OF THE CANADIAN PATENT OFFICE

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(REVISED)

1913

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INTRODUCTION.

It may be in the first place explained, that the object of this compilation is intended for the use of those interested in taking out patents for inventions in Canada; and particularly to furnish definitions to facilitate the work of inventors, patentees, attorneys and others interested; and also at the same time to simplify the work in the Patent Office itself by lessening the complications arising from defective applications.

The text of the Patent Act itself is given in full, with annotations by paragraphs, in order to make clear those points, on which it has been found, in practice, that misconceptions and consequent errors have arisen, causing trouble, delay; and oftentimes resulting in failure.

The official forms issued by the Patent Office, are given with marginal notes, in relation to the insertion of details applicable to special cases.

The definitions which are given to various sections of the Patent Act, are only those which have been established by practice in the Patent Office, and no attempt has been made to interpret the Act. It may be added that no comment has been made on those sections of the Act which refer to questions which do not come within the province of the Office. The sole object of the compilation has been, to facilitate the preparation and prosecution of applications for patents and other actions before the Patent Office.

CHAPTER 69.

An Act respecting Patents of Invention.

SHORT TITLE.

1. This Act may be cited as the Patent Act. R.S., c. 61, s. 1.

INTERPRETATION.

2. In this Act, unless the context otherwise requires,—
- (a) 'Minister' means the Minister of Agriculture;
 - (b) 'Commissioner' means the Commissioner of Patents, and 'Deputy Commissioner' means the Deputy Commissioner of Patents;
 - (c) 'invention' means any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement in any art, machine, manufacture or composition of matter;
 - (d) 'legal representatives' includes heirs, executors, administrators and assigns or other legal representatives.
- R.S., c. 61, s. 2.

PATENT OFFICE AND APPOINTMENT OF OFFICERS.

PATENT OFFICE CONSTITUTED.

3. There shall be attached to the Department of Agriculture, as a branch thereof, an office which shall be called the Patent Office; and the Minister of Agriculture for the time being shall be the Commissioner of Patents. R.S., c. 61, s. 3.

DUTIES OF COMMISSIONER.

4. The Commissioner shall receive all applications, fees, papers, documents and models for patents, and shall per-

form and do all acts and things requisite for the granting and issuing of patents of invention; and he shall have the charge and custody of the books, records, papers, models, machines and other things belonging to the Patent Office. R.S., c. 61, s. 4.

DEPUTY AND OFFICERS.

5. The Deputy Minister of Agriculture shall be the Deputy Commissioner, and the Governor in Council may, from time to time, appoint such officers and clerks under the Deputy Commissioner as are necessary for the purposes of this Act, and such officers and clerks shall hold office during pleasure.

2. The Deputy Commissioner may do any act or thing, whether judicial or ministerial, which the Commissioner of Patents is authorized or empowered to do by any provision of this Act; and, in the absence of the Deputy Commissioner, any person performing the duties of the Deputy Minister of Agriculture under the authority of the Civil Service Act, may, as acting deputy commissioner, do any such act or thing. 60-61 V., c. 25, s. 1; 3 E. VII., c. 46, s. 1.

CORRESPONDENCE.

All business with the Patent Office should be transacted in writing and communications should be addressed to the "Commissioner of Patents, Ottawa, Canada," and, if posted at any Post Office within the limits of Canadian territory, will be conveyed through the mails free of charge.

Correspondence with the Patent Office may be carried on either with the inventor, his assignee or his attorney, but only with one person; and in all cases the depositor of any paper is responsible for the merits of his allegations, and the validity or sufficiency of the instruments furnished by him.

All communications from the Patent Office bear a serial number. This number should be quoted in all subsequent actions or correspondence with the office, when relating to the same subject.

PRELIMINARY SEARCHES AND INQUIRIES AS TO PATENTED INVENTIONS.

The Patent Office always declines to respond to inquiries as to the patentability of an alleged invention in advance of a regularly filed application for patent accompanied by the required fee (for tariff of fees see page 391); also to inquiries founded on brief or imperfect descriptions with a view of ascertaining whether alleged inventions or improvements have been patented, unless the name of the inventor be given.

PATENT OFFICE REFUSES ACTING AS EXPOUNDER OF LAW OR IN RECOMMENDING ATTORNEYS.

The Patent Office further declines to act as an expounder of the Patent Law, or as counsellor for individuals, except as to questions within the office, or to advise inventors or others in the selection of an attorney. Unless an inventor is competent to prepare his papers and drawings for an application for patent, he should employ a skilled attorney, as the value of a patent is largely based upon the ability and clearness with which the specification and claims have been prepared. Speaking generally, it is greatly in the interest of the inventor, and the Patent Office, to seek the services of an attorney possessed of technical knowledge and experienced in practice, in order that an applicant for a patent may obtain the fullest protection to which he is entitled. The Patent Office cannot advise or assist an applicant in the preparation of his application for patent, or, the framing of other documents.

A personal appearance of the applicant, or his representative, at the Patent Office is not required, unless specially called by the Commissioner.

NO REGISTRATION OF PATENT ATTORNEYS.

There is no provision in the Patent Act or Rules of Practice for the registration of patent attorneys; therefore any person qualified to act in such capacity may do so without the intervention of an attorney resident in Canada. When an attorney prepares and presents an application for a patent afterwards assigned, the assignee may appoint a

new attorney. A power of attorney may at any time while the application is pending, be revoked, and the applicant may prosecute the same, or appoint a new attorney.

POWERS OF ATTORNEY.

After a patent has been granted the powers given to an attorney cease and determine for any subsequent action by the office, such as in the cases of presenting a petition under Sections 39, 40 or 44 of the Patent Act; therefore petitions under the Sections named must be signed by the patentee or owner of the patent unless a new power of attorney is filed authorizing the same attorney or another person to do so. An exception, however, is made in presenting a petition to have a patent brought under Section 44 (Compulsory License Clause). If the application is made by any person on behalf of the owner of the patent, instead of by the owner himself, it must be accompanied by an authorization from such owner to that effect; or production of the original patent will be considered by the Patent Office sufficient evidence of authorization.

MISCELLANEOUS CASES, HOW TO BE DECIDED.

All cases connected with the intricate and multifarious proceedings arising from the working of the Patent Office, which are not specially defined and provided for in the Rules of the Patent Office, will be decided in accordance with the merits of each case under the authority of the Commissioner; and such decision will be communicated to the interested parties in writing.

SEAL.

6. The Commissioner shall cause a seal to be made for the purposes of this Act, and may cause to be sealed therewith every patent and other instrument and copy thereof issuing from the Patent Office. R.S., c. 61, s. 6.

(See also Sections 22, 35 and 60, pages 364, 374-398.)

APPLICATIONS FOR PATENTS.

7. Any person who has invented any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement in any art, machine, manu-

facture or composition of matter, which was not known or used by any other person before his invention thereof, and which has not been in public use or on sale with the consent or allowance of the inventor thereof, for more than one year previously to his application for patent therefor in Canada, may, on a petition to that effect, presented to the Commissioner, and on compliance with the other requirements of this Act, obtain a patent granting to such person an exclusive property in such invention.

2. No patent shall issue for an invention which has an illicit object in view, or for any mere scientific principle or abstract theorem. R.S., c. 61, s. 7.

An application for patent may be made by the inventor, joint inventors, assignee, or, in the event of the inventor being dead, his legal representative, and shall be composed of the following documents:—

(1) Petition to the Commissioner of Patents. Form (1), (2), (3), (4) or (5), pages 404, 405, 406, 407 and 408.

(2) Oath. Form (12), (13), (14) or (15), pages 423, 424, 426, 427.

(3) Power of attorney (if an attorney is employed). Form (7), page 410.

(4) Specification and Claims in duplicate). Form (9), (10) or (11), pages 412, 416 and 421. Instructions on page 351.

(5) Drawings on tracing linen (in duplicate). See instructions on pages 353, 354 and 355.

(6) Drawings on double bristol board. See instructions on pages 353 and 354.

(7) Third copy of claim or claims. See page 350.

(8) A covering letter enclosing the statutory fee and enumerating the enclosures.

(9) Assignment with copy and recording fee \$2.00 (if a part or the whole of the invention is assigned).

DOCUMENTS.

All documents must be legibly and neatly written; typewritten or printed in either the English or French language on but one side of foolscap paper (8 x 13 inches), with margin of one inch and a half wide upon the left hand

side of the page. When a specification is typewritten the ribbon copy must be attached to the petition, oath and power of attorney to remain of record in the Patent Office; the carbon copy to be attached to the patent.

WHAT MAY NOT BE PATENTED.

No patent may be granted for an invention, the use of which is contrary to law or morality, or for a mere scientific principle.

INSANITY OF INVENTOR.

In case an inventor becomes insane, the application may be made by, and the patent issued to, his legally appointed guardian or representative, who will make the oath.

CORPORATIONS OR COMPANIES.

Corporations or Companies may apply for a patent, as assignee, but the oath must be taken by the inventor and the specification and assignment signed by him, the latter to contain the usual authorization to the Commissioner to issue the patent to the assignee.

DEATH OF INVENTOR.

In the case of the death of the inventor during the time intervening between the filing of the application and the granting of a patent thereon, the patent will issue to the executor or administrator upon the filing of a certified copy of the letters of administration or letters testamentary.

If an inventor dies without making an application for a patent for an invention, his legal representative may apply for a patent for such invention.

MEDICAL COMPOUNDS.

The Patent Office refuses to grant patents for medical compounds, on the ground that they do not involve invention, and are no more than prescriptions a physician might make.

The Patent Office usually advises applicants, or persons enquiring before making application, who have medical compounds to protect, to adopt a trade mark, and register the same under which the particular preparation may be sold. When making application for the registration of a trade mark, it does not become necessary to disclose the formula.

On application to "The Minister of Agriculture (Trade Mark and Copyright Branch), Ottawa, Canada," the Act governing trade marks and the rules and forms appertaining thereto will be gratuitously furnished.

APPLICATION RESTRICTED TO ONE INVENTION UNLESS CONNECTED.

An application for a patent must be restricted to one invention, unless separate matters are represented to be so dependent on, and connected with, each other, as to be necessarily taken together to obtain the end sought for by the inventor. The Commissioner of Patents is to be the judge whether or not the pretensions of the applicant in such respect may be entertained.

IF APPLICATION CONTAINS MORE THAN ONE INVENTION.

If an application is found to contain two or more separate inventions the Patent Office will so advise the applicant and he will be requested to divide it, retaining in the pending application whichever invention he may elect. The other invention or inventions may be made the subject matter of separate applications, which must conform to the rules and forms applicable to original applications and be accompanied by the usual statutory fees. The divisional application or applications will be entered and considered as of the same date of filing as the original application; and thus come within the provisions of Section Eight of the Patent Act, should the invention have been patented elsewhere, more than one year. The specifications should contain a reference to the original application by giving its date of filing and serial number.

Divisional application or applications must be filed within twelve months from the date of the call to divide.

NOVELTY OF INVENTION.

Under the foregoing section of the Patent Act, an invention, to be susceptible of being patented, must possess novelty elsewhere, as well as in Canada.

INCOMPLETE APPLICATION.

An informal or incomplete application will not be referred to the examiner until it is made to conform with

the requirements of the Patent Act and the Rules and Forms; therefore, no protection is afforded the applicant as regards what may have subsequently been filed of a similar nature and receiving the consideration of the examiner. Applicants to whom papers have been returned as informal should not delay too long in returning them to the Patent Office.

STOP ORDERS.

When an applicant desires to delay action, after his application has been referred to the examiner, he or his attorney may request in writing a "stop-order" placed thereon; and all action will be suspended until the order is removed; unless the delay may injure the rights of another applicant having filed an application for a similar invention, in which case the Commissioner may request the immediate removal of the "stop-order."

When a "stop-order" has been entered on an application it should not be allowed to remain for more than twelve months from the date of the acknowledgment of the filing of the application for patent, or the date of the examiner's last report, if there be one in the case; otherwise the application will be considered abandoned with forfeiture of all fees paid.

APPLICATIONS WITHOUT FEES.

Applications for patents sent to the Patent Office, unaccompanied by the fee provided by law, will receive no official recognition; nor will they be filed or numbered. They will merely be pigeon-holed; and only marked filed the day on which the fee has been received.

FILING DATE CONDITIONS.

Under the present practice of the Patent Office, the filing of the Petition, Oath, and Power of Attorney (if an attorney is employed), together with the statutory fee, payable at par, at Ottawa, will ensure for the applicant a filing date as of the day they are received at the Patent Office. The specification and drawings to follow with as little delay as possible. But no reference to the Examiner will be made until the application is complete in every particular.

ABANDONED APPLICATION.

When an application for a patent has become abandoned by failure to complete or prosecute the same, the Commissioner may, under the power given to him by the ninth rule of the Rules and Forms of the Patent Office, reinstate the application and order it, if otherwise in condition, to be referred to the Examiner. Before, however, exercising this discretionary power, the Commissioner must be satisfied, after sufficient proof has been filed in writing, that the cause of the delay was not the fault of the applicant. In some cases the Commissioner may exact that the statement of facts or proof be supported by an affidavit; or, in the case where the delay has occurred through prolonged illness of the applicant, that a medical certificate be adduced. No fee is exacted for the reinstatement of an application.

AS TO INVENTIONS FOR WHICH FOREIGN PATENTS HAVE BEEN TAKEN OUT.

8. 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 patent is applied for within one year from the date of the issue of the first foreign patent for such invention.

2. If within three months after the date of the issue of a foreign patent, the inventor gives notice to the Commissioner of his intention to apply for a patent in Canada for such invention, then no other person having commenced to manufacture the same device in Canada during such period of one year, shall be entitled to continue the manufacture of the same after the inventor has obtained a patent therefor in Canada, without the consent or allowance of the inventor.

3. No Canadian patent issued previous to the thirteenth day of August, one thousand nine hundred and three, shall be deemed to have expired before the end of the term for which it was granted merely because of the expiry of a

foreign patent for the same invention. 55-56 V., c. 24, s. 1; 3. E. VII., c. 46, s. 2.

WHEN A FOREIGN PATENT HAS BEEN ISSUED.

An application for a Canadian patent, corresponding with a foreign patent, must be filed within one year from the date of *issue* or *sealing* of the first issued foreign patent; and will be received up to and including the anniversary date, providing that the application is accompanied by the statutory fee, payable at par in Ottawa.

APPLICANT RESPONSIBLE FOR DELAY IN TRANSMISSION.

An application for patent or payment of fee takes effect only when it is actually received at the Patent Office, although it may have been delayed in transmission through the fault of the postal service. The applicant must take upon himself the risk of the mode of transmission; consequently, it is unwise to delay mailing the application and fee until a day or two before the expiry of the year mentioned in the preceding section of the Patent Act.

NOTICE OF INTENTION TO APPLY FOR PATENT.

The notice as above and as defined in sub-section 2 of the Act, may be filed at the Patent Office any time within three months after the issue of the earliest corresponding foreign patent; and must be accompanied by the prescribed fee of \$2.00.

In a case of a foreign patent dated, as of the date of the filing of the application the aforesaid three months period commences to run from the date of the issue or sealing of such patent.

The filing of an application for patent in Canada for an invention covered by a foreign patent, not issued more than three months previous, does not take from the inventor the right of also filing the notice, above defined.

Frequent demands are made on the Patent Office, to extend the time of a "Notice", or grant a delay longer than twelve months, to file the application for patent, but it is obvious that the Commissioner has not this discretionary power, in view of the terms of Section Eight of the Patent Act, requiring that the Canadian application

should be filed within twelve months from the date of the issue of the corresponding foreign patent.

The Patent Office does not prescribe any specific form for giving notice of intention to apply for a patent; the notice, however, should cite the first issued foreign patent, by giving the number, date, name of patentee and title of invention.

EXPIRY OF FOREIGN PATENT.

The expiry of a foreign patent for the same invention does not affect the life of the Canadian patent.

IMPROVEMENTS MAY BE PATENTED.

9. Any person who has invented any improvement on any patented invention, may obtain a patent for such improvement; but he shall not thereby obtain the right of vending or using the original invention, nor shall the patent for the original invention confer the right of vending or using the patented improvement. R.S., c. 61, s. 9.

OATH OF INVENTOR TO BE MADE BEFORE OBTAINING PATENT.

OR OF THE APPLICANT IF THE INVENTOR IS DEAD.

BEFORE WHOM OATH MAY BE MADE.

10. Every inventor shall, before a patent can be obtained, make oath, or, when entitled by law to make an affirmation instead of an oath, shall make an affirmation, that he verily believes that he is the inventor of the invention for which the patent is asked, and that the several allegations in the petition contained are respectively true and correct.

2. In the event of the inventor being dead, such oath or affirmation shall be made by the applicant, and shall state that he verily believes that the person whose assignee or legal representative he is, was the inventor of the invention for which the patent is solicited, and that the several allegations in the petition contained are respectively true and correct.

3. Such oath or affirmation may be made before a minister plenipotentiary, *chargé d'affaires*, consul, vice-consul or consular agent, a judge of any court, a notary public, a justice of the peace, or the mayor of any city, borough or town, or a commissioner for taking affidavits having authority or jurisdiction within the place where the oath may be administered. R.S., c. 61, s. 10; 55-56 V., c. 24, s. 2.

When the invention has been assigned before the issue of patent, the oath must be made by the inventor and not by the assignee. If the inventor is dead, the administrator or executor will take the oath that the person named as inventor was the inventor. If the application be made by the guardian or representative of an insane person, the form of oath will be correspondingly changed. If one or more patents are granted for the same invention in foreign countries the oath should cite each of such patents, by giving the number and date of issue or sealing, but no reference should be made therein to pending applications in foreign countries at the time the oath is made. An oath executed more than three months previous to the filing of the application for patent will not be accepted by the Patent Office; and will be returned for a new oath.

In a case where joint inventors are not residing in the same place, and that it is not convenient for them to take the oath before the same officer, they may each be sworn at their respective places of residence before different officers, but both executions should appear on the same document.

The oath may be taken before a notary public, who is also acting as the attorney in the case.

It is defined in Sub-Section 3 of Section 10, above quoted, before whom the oath or affirmation should be taken. For forms of Oaths see pages 423, 424, 426 and 427.

ELECTION OF DOMICILE.

11. The applicant for a patent shall, for the purposes of this Act, elect his domicile at some known and specified place in Canada, and shall mention the same in his petition for a patent. R.S., c. 61, s. 11.

See Section 35, page 374 of the Patent Act for particulars respecting the above requirement.

PARTICULARS REQUIRED ON APPLICATION.

12. The applicant shall, in his petition for a patent, insert the title or name of the invention, and shall, with the petition, send in a specification in duplicate of the invention and an additional or third copy of the claim or claims. 56 V., c. 34, s. 1.

The title of the invention must be the same wherever it appears in the papers, constituting the application for patent. Titles with fancy or trade names are not allowable. The practice of including the power of attorney in the petition is not encouraged by the Patent Office; it should form a separate document. See form 7 on page 410.

An additional or third copy of claim or claims, free from the title of the invention, names or date, must be furnished with the petition for patent; and such claims should be commenced about five inches from the top of the first page, to permit the insertion by the Patent Office of other matter required for the printer.

WHAT THE SPECIFICATIONS AND DRAWINGS SHALL SHOW.

13. The specification shall correctly and fully describe the mode or modes of operating the invention, as contemplated by the inventor; and shall state clearly and distinctly the contrivances and things which he claims as new and for the use of which he claims an exclusive property and privilege.

2. Such specification shall bear the name of the place where, and the date when it is made, and shall be signed by the inventor, if he is alive, and if not, by the applicant, and by two witnesses to such signature of the inventor or applicant.

3. In the case of a machine the specification shall fully explain the principle and the several modes in which it is intended to apply and work out the same.

4. In the case of a machine, or in any other case in which the invention admits of illustration by means of

drawings, the applicant shall also, with his application, send in drawings in duplicate, showing clearly all parts of the invention; and each drawing shall bear the signature of the inventor, if he is alive, and, if not, of the applicant, or of the attorney of such inventor or applicant, and shall have written references corresponding with the specification; but the Commissioner may require further drawings or dispense with any of them, as he sees fit.

5. One duplicate of the specification and of the drawings, if there are drawings, shall be annexed to the patent, of which it shall form an essential part, and the other duplicate shall remain deposited in the Patent Office.

6. The Commissioner may, in his discretion, dispense with the duplicate specification and drawing, and in lieu thereof cause copies of the specification and drawing, in print or otherwise, to be attached to the patent, of which they shall form an essential part. R.S., c. 61, s. 13.

SPECIFICATION.

The specification, as all other documents, must be legibly written, printed or typewritten, with permanent ink, on one side only of sheets of strong white paper, 8 inches by 13 inches. At the top of the first page of the specification, a space of at least four inches should be left blank. In the preamble, after stating the name and residence of the applicant and the title of the invention, the numbers and dates of any corresponding foreign patents and the name of the country should be inserted; followed by a statement of the object of the invention. The specification must correctly and fully describe the mode or modes of operating the invention; concluding with a specific and distinct claim or claims of the part or parts, improvement, or combination, which the applicant regards as his invention or discovery. The specification is required to be in such full, clear and exact terms as to enable any person skilled in the art to which the invention appertains, to make, construct, compound or use the same without needing to make additional invention.

CLAIMS.

The claims should not be made for the efficiency or advantages of the invention, nor should there be any reference from one claim to another. Each claim should set forth a combination of elements which is complete and operative, either for the whole operation or for some necessary part of such operation. If the state of the art allows, the claims may be sufficiently general to cover the preferred and modified constructions, but only one form may be claimed specifically. If an applicant wishes to claim the modified forms specifically, he must set them forth in separate applications. At the end of the claims must appear the execution, consisting of the place where executed, and the date, the signatures of the inventor and two witnesses; and such might preferably appear at the top of a separate sheet of paper from that containing the last claim.

MODIFICATIONS.

Modifications in the sense of specific variations of the preferred form of invention are permitted to be described and shown in the specification and drawings of an application. If such modifications are shown in the drawings they must be described, and conversely, if described in detail in the specification, they must be shown in the drawing. Modifications not shown or described in either the drawing or specification as originally filed cannot be introduced into the case.

An applicant is allowed to present generic claims covering all of the modifications shown and described, and generic claims covering two or more of the modifications, but it is not allowed in one application to claim specifically more than one species.

AMENDMENTS.

Amendments must be made on new sheets of paper containing the amended matter, and ready for insertion, and not on the sheets containing the matter to be amended. These new sheets must be supplied in duplicate for the specification, and in triplicate for the claims, and accompanied by a covering letter pointing out what amendments have been made, and the patentable novelty which

the applicant believes the case presents in view of the state of the art disclosed by the references cited, or the objections made by the Patent Office. He must also show how the amendments avoid such reference or objections. The applicant has right to amend before or after the first rejection or action, and he may amend as often as the Examiner presents new reference or reasons for rejection. The specification must be amended and revised when required by the Patent Office to correct inaccuracies of description or unnecessary prolixity.

The specification including the claims must be in duplicate, and in addition, a third copy of the claims alone must be furnished. (See page 350.)

As amendments to applications for Patents are, in most cases, confined to the claims, necessitating the preparation of new sheets to be substituted for those containing cancelled or amended matter, it is suggested that the claims headed by such an expression as "*What I Claim is,*" be commenced on a separate sheet from that containing the specification proper.

Erasures, additions, insertions or mutilations of the papers and records must not be made by the applicant after the papers have become a part of the official files.

Prosecution of an application, to save it from abandonment, must include such proper action as the correction of the case may require.

When amendments are required to the specification or claims, after an application has been referred to the examiner, no new execution by the inventor or applicant is exacted by the Patent Office, the original execution remaining of record is sufficient, but the duplicate specification and claims as amended, should bear the original execution, typewritten. The Patent Office will not, however, refuse a new execution.

DRAWINGS.

Drawings must be furnished in triplicate, two on tracing linen and one on double Bristol board, all eight by thirteen inches. Each sheet of tracing linen shall contain the following certificate at the bottom: "Certified to be the drawing referred to in the specification hereunto an-

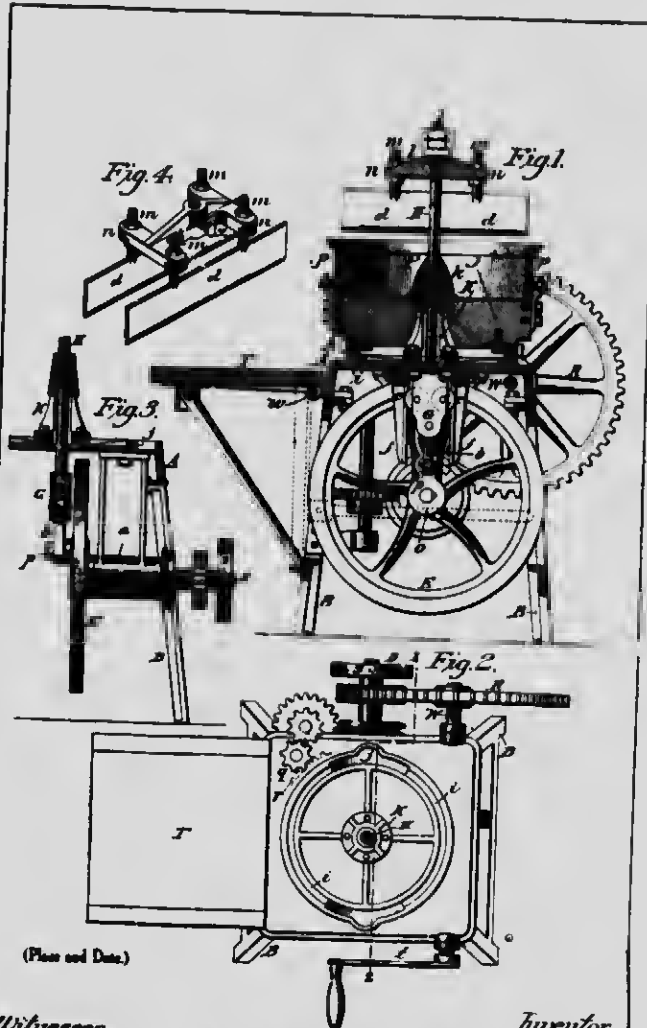
nexed;" and signed by the inventor or his attorney, in the presence of two witnesses to which must be added the place and date. The drawing on Bristol board should contain no execution or certificate on its face, but merely the usual reference letters; yet on the back of each sheet the name of the inventor and the title of the invention must be written in pencil.

All drawings must be clear, sharp, well defined, not too fine, and perfectly black. Sections and shading should not be represented by solid black or washes. Reference letters or figures must be clear and distinct. The same letters should be used in different views of the same parts. Where the reference letters are shown outside the figure, they must be connected with the parts referred to by faint indicating lines. The drawings must show every feature of the invention covered by the claims. If there are more figures than can be conveniently shown on the regulation size (8 x 13) (leaving a margin of one inch on the four sides) two or more sheets may be used bearing the prescribed certificate and execution as on the first sheet. The figures should be numbered consecutively throughout and without regard to the number of sheets. There is no limit to the number of sheets that may be filed, but no more sheets should be employed than is absolutely necessary. No change in the drawing may be made except by written permission of the Patent Office.

When an attorney is employed he may sign the name of the inventor on the drawing, adding his own signature as attorney in fact.

The drawing on Bristol board should be rolled on a roller, or enclosed in a mailing tube, or flat, protected with mill-board for transmission to the Patent Office, as folding will prevent its usefulness for photo-lithographing.

The above section of the Patent Act, Sub-Section 6, gives the Commissioner of Patents power to dispense with the duplicate specification and drawing, or the drawings on tracing linen and exacts only the drawing on Bristol board; but this power is not at present exercised as the Patent Office has not yet undertaken to print the specifications and drawings of patents.



(Place and Date.)

Witnesses:

E.....F.....
 G.....H.....

Certified to be the Drawings referred
 to in the specification herewith annexed.

Inventor:

A.....B.....

per C.D.....

Attorney.

**MODELS OR SPECIMENS TO BE FURNISHED WHEN
REQUIRED.**

14. In all cases in which the invention admits of representation by model, the applicant, if required by the Commissioner, shall furnish a model of convenient size exhibiting its several parts in due proportion; and when the invention is a composition of matter, the applicant, if required by the Commissioner, shall furnish specimens of the ingredients, and of the composition, sufficient in quantity for the purpose of experiment.

2. If such ingredients or composition be of an explosive or dangerous character, they shall be furnished with such precautions as are prescribed in the requisition therefor. 55-56 V., c. 24, s. 3.

Models or specimens of ingredients are rarely called for, and should not be sent to the Patent Office unless required by the Commissioner; but when models are exacted they must be neat and substantial working ones, of a convenient size; and must bear the name of the inventor and serial number of the application. All charges for the carriage of models to the Patent Office must be prepaid; and after such models have served their purpose they will be returned to the sender on request at his expense.

EXAMINATION OF APPLICATIONS FOR PATENTS.

15. On each application for a patent, a thorough and reliable examination shall be made by competent examiners to be employed in the Patent Office for that purpose. 55-56 V., c. 24, s. 8.

When an examiner has made his final rejection of one or more, or all of the claims in an application for patent, and after stating the ground or reason therefor, the applicant has, under the present practice of the Patent Office, the right to appeal to the Deputy Commissioner of Patents from such decision.

The appeal should be in the form of a petition headed "Appeal to the Deputy Commissioner of Patents in person from the decision of the Examiner," and should clearly

and specifically set out the reasons why the contention of the Examiner should be reversed. The limit of time for presenting this appeal is within six months from the date of the Examiner's final rejection. No fee is exacted for the appeal.

Forfeited and abandoned applications will not be cited as references.

Personal interviews with Examiners are permitted between the hours of 11 and 12 in the forenoon, and 2 and 3 in the afternoon, but appointments must be made with the chief officer of the Patent Office at a reasonable time beforehand.

WITHDRAWAL OF APPLICATIONS FOR PATENTS.

16. No application for a patent shall be withdrawn without the consent in writing of each and every registered assignee of such patent or any part thereof. 55-56 V., c. 24, s. 4.

When an inventor makes an assignment of a part interest in his invention to one or more persons, and the assignment accompanies the application for patent, or is filed subsequently, the Patent Office will exact that both the inventor and assignee, or assignees, shall consent over their own signatures to the withdrawal of the application; and if this action is taken within a period of one year after the date of the acknowledgment of the filing of the application, or of the examiners' report, the fee paid will be returned, less ten dollars.

In cases where the inventor has assigned all his interest in his invention it will not be necessary for him to join with the assignee, or assignees, in withdrawing the application.

REFUSAL TO GRANT PATENTS.

17. The Commissioner may object to grant a patent in any of the following cases:—

(a) When he is of opinion that the alleged invention is not patentable in law;

(b) When it appears to him that the invention is already in the possession of the public, with the consent or allowance of the inventor;

- (c) When it appears to him that there is no novelty in the invention;
- (d) When it appears to him 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;
- (e) When it appears to him that the invention has already been patented in Canada, unless the Commissioner has doubts as to whether the patentee or the applicant is the first inventor;
- (f) When it appears to him that the invention has already been patented in a foreign country, and the year has not expired within which the foreign patentee may apply for a patent in Canada, unless the Commissioner has doubts as to whether the foreign patentee or the applicant is the first inventor. R.S., c. 61, s. 16.

It may be stated that under sub-section "e" of the above section, the Commissioner may grant a second patent for the same invention, on the applicant clearly establishing to the satisfaction of the Commissioner, that he is the first inventor notwithstanding that a patent had been previously granted to another person or persons.

In such a case, after both patents have been granted, it will be a matter for the Courts to decide which patent shall be valid.

Under sub-section "f" of the same section, when an application for a patent is made for an invention patented in a foreign country by another person, and the year mentioned in section 8 has not expired within which the foreign patentee may apply for a patent in Canada, the Commissioner may refuse to grant the patent, unless he has doubts as to whether the foreign patentee or the applicant is the first inventor.

It may be remarked that the Patent Act does not provide for interferences with applications for patents and patents already granted.

APPLICANT TO BE NOTIFIED.

18. Whenever the Commissioner objects to grant a patent as aforesaid, he shall notify the applicant to that effect and shall state the ground or reason therefor, with sufficient detail to enable the applicant to answer, if he can, the objection of the Commissioner. R.S., c. 61, s. 17.

APPEAL TO THE GOVERNOR IN COUNCIL.

19. Every applicant who has failed to obtain a patent by reason of the objection of the Commissioner, as aforesaid, may, at any time within six months after notice thereof has been mailed, addressed to him or his agent, appeal from the decision of the Commissioner to the Governor in Council. R.S., c. 61, s. 18.

The above section of the Patent Act provides for an appeal to the Governor-General in Council by any applicant who has failed to obtain a patent, by reason of the objection of the Commissioner on any of the grounds mentioned in Section 17. Such appeal should be made in the form of a petition setting out such reasons and arguments that the applicant may have to adduce in support of his contention. The period within which this appeal may be made is six months from the date of the Commissioner's refusal to grant the patent. No fee is exacted.

APPEAL TRANSFERRED TO EXCHEQUER COURT.

By an Act passed at the Session of 1912-13 to amend the Exchequer Court Act, the jurisdiction given the Governor-General in Council by the above section was transferred exclusively to the Exchequer Court.

The terms of the amending Act are as follows:—

An Act to amend the Exchequer Court Act.

His Majesty, by and with the advice and consent of the Senate and House of Commons of Canada, enacts as follows:—

1. *The Exchequer Court Act*, chapter 140 of the Revised Statutes, 1906, is amended by adding the following section immediately after section 23:—

"23A. Every applicant for a patent under *The Patent Act* who has failed to obtain a patent by reason of the objection of the Commissioner of Patents as in the said Act provided may, at any time within six months after notice thereof has been mailed, addressed to him or his agent, appeal from the decision of the said commissioner to the Exchequer Court.

"2. The Exchequer Court shall have exclusive jurisdiction to hear and determine any such appeal.

"3. The Exchequer Court shall have exclusive jurisdiction to hear and determine any now pending appeals to the Governor in Council under section 19 of *The Patent Act*."

CONFLICTING APPLICATIONS.

20. In case of conflicting applications for any patent, the same shall be submitted to the arbitration of three skilled persons, two of whom shall be chosen by the applicants, one by each, and the third of whom shall be chosen by the Commissioner; and the decision or award of such arbitrators, or of any two of them, delivered to the Commissioner in writing, and subscribed by them or any two of them, shall be final, as far as concerns the granting of the patent.

2. If either of the applicants refuses or fails to choose an arbitrator, when required so to do by the Commissioner, and if there are only two such applicants, the patent shall issue to the other applicant.

3. If there are more than two conflicting applications, and if the persons applying do not all unite in appointing three arbitrators, the Commissioner may appoint the three arbitrators for the purposes aforesaid.

4. The arbitrators so named shall subscribe and take before a judge of any court of record in Canada, an oath in the form following, that is to say:—

"I, the undersigned (A.B.), being duly appointed an arbitrator under the authority of the Patent Act, do hereby solemnly swear *or* (affirm, *as the case may be*), that I will well and truly perform the duty of such arbitrator on the conflicting applications of (*C.D. and E.F.*) submitted to me."

5. The arbitrators, or any one of them, when so sworn, may summon before them any applicant or other person, and may require him to give evidence on oath, orally or in writing (*or on solemn affirmation, if such applicant or person is entitled to affirm in civil cases*), and to produce such documents and things as such arbitrators deem requisite to the full investigation of the matters into which they are appointed to examine, and they shall have the same power to enforce the attendance of such applicants and other persons, and to compel them to give evidence, as is vested in any court of justice in civil cases, in the province in which the arbitration is held.

6. The fees for the services of such arbitrators shall be a matter of agreement between the arbitrators and the applicants, and shall be paid by the applicants who name them, respectively, except those of the arbitrator or arbitrators named by the Commissioner, which shall be paid by the applicants jointly. R.S., c. 61, s. 19.

When an examiner reports a conflict in part or in whole with two applications for patents the Commissioner directs that the applicants be so advised and calls upon each to appoint an arbitrator, such appointment to be made over their respective signatures. In this notice of conflict the applicants or their attorneys of record are given the names and addresses of the respective opposing parties, thus affording them an opportunity of coming to some agreement, if they can, rather than undertake the proceedings and consequent expense of an arbitration.

Under the present practice the applicants are allowed one year from the date of call to appoint their arbitrators and notify the Commissioner, unless one of the applicants at an earlier date appoints his arbitrator, in which

case the opposite party is advised of this and given from thirty to sixty days within which to appoint his arbitrator. Failure in this respect will bring his case under clause 2 of the above section of the Patent Act. For good reasons, however, the Commissioner may extend either period. The action of the Commissioner in fixing a shorter time than the year above mentioned is, by virtue of the discretionary power given him in the following rule:—

“In any case, however, in which it is established to the satisfaction of the Commissioner that there is unnecessary delay on the part of the applicant in the prosecution of his application, and that such delay may injure the rights of other parties, the Commissioner may require the applicant to proceed with the prosecution of his application within such period less than one year as to the Commissioner may seem reasonable; and upon failure of the applicant so to do, his application shall be held to be abandoned, with forfeiture of fees.”

When both parties have selected their arbitrators, and have submitted the names to the Commissioner, and have agreed upon the locality (which must be within the limits of the Dominion) where they shall meet, the Commissioner will forthwith appoint the third or Government arbitrator who, upon acceptance, will receive from the Patent Office the duplicate specifications and drawings last accepted by the examiner and upon which the conflict was declared. It will then be his duty to confer with the interested parties and arrange for the date of sitting, etc.

It is customary for the Commissioner to appoint the Government arbitrator in, or nearby, the locality chosen by the applicants for holding the arbitration; but in no case does the Commissioner interfere or take any part in regard to the fees for the services of the arbitrator appointed by him; the Patent Act providing that he shall be paid by the applicants jointly. The remuneration to be paid to the three arbitrators is entirely a matter of agreement between them and the applicants.

The above section of the Patent Act contains the form of oath to be taken by the arbitrators before a judge of any court of record in Canada; and sub-section 5 clearly defines their powers.

The Patent Act or practice does not preclude non-residents of Canada acting as arbitrators.

In a conflict where there are more than two applications involved, if the applicants, after being served with notice, do not all unite in appointing three arbitrators, the Commissioner may appoint the three arbitrators, whose remuneration for their services must also be borne equally by the applicants.

If the applicants in an arbitration case have not appointed their arbitrators within a year from the date of the official notice, or any extension of that time granted by the Commissioner, the cases will be held to be abandoned, unless the Commissioner is satisfied that the cause of the delay was not the fault of such applicants.

In no case shall any portion of the fees paid be returned by the Patent Office to the applicants, where no arbitrators have been appointed, unless the applications are withdrawn within a year from the date of the call for the appointment of arbitrators. The unsuccessful applicant, or applicants, in an arbitration case will, upon application at any time, be entitled to a refund of all fees paid less ten dollars.

Copies of papers in conflicting applications are not furnished by the Patent Office to the opposing applicants unless authorized in writing by the opposite applicant and after the usual fee has been paid as provided for in Section 47 of the Patent Act. (Office copies of documents, page 391.)

Section 23, paragraph *a* of the Exchequer Court Act provides that the Court shall have jurisdiction in cases of conflicting applications for patents. The records of the Patent Office do not show, however, that advantage has ever been taken of this provision of the law. All cases of conflict appear to have been dealt with under the provisions of the Patent Act.

WHAT A PATENT SHALL CONTAIN AND CONFER.

21. Every patent granted under this Act shall contain the title or name of the invention, with a reference to the specification, and shall grant to the patentee and his legal representatives, for the term therein mentioned, from the

granting of the same, the exclusive right, privilege and liberty of making, constructing and using, and vending to others to be used, the said invention, subject to adjudication in respect thereof before any court of competent jurisdiction.

2. In cases of joint applications, the patents shall be granted in the names of all the applicants. R.S., c. 61, s. 20.

FORM OF ISSUE OF PATENT.

22. Every patent shall be issued under the seal of the Patent Office and the signature of the Commissioner or of the Deputy Commissioner, and, when duly registered, shall be good, and shall avail the grantee and his legal representatives for the term mentioned in the patent.

2. The Commissioner may require that any patent, before it is signed by the Commissioner or by any other member of the King's Privy Council for Canada, acting for him, and before the seal hereinbefore mentioned is affixed to it, shall be examined by the Minister of Justice; and, if such examination is so required, the Minister of Justice shall, accordingly, examine it, and if he finds it conformable to law, he shall certify accordingly, and such patent may then be signed, and the seal affixed thereto. R.S., c. 61, s. 21; 56 V., c. 34, s. 2.

In the absence of the Commissioner or the Deputy Commissioner, the Acting Deputy Commissioner may sign the patent or any other document or instrument issued by the Patent Office (see section 5, sub-section 2 of the Patent Act, page 339.)

DURATION OF PATENT.

23. The term limited for the duration of every patent of invention issued by the Patent Office shall be eighteen years; but, at the time of the application therefor, it shall be at the option of the applicant to pay the full fee required for the term of eighteen years, or the partial fee

required for the term of six years, or the partial fee required for the term of twelve years.

2. If a partial fee only is paid, the proportion of the fee shall be stated in the patent, and the patent shall, notwithstanding anything therein or in this Act contained, cease at the end of the term for which the partial fee has been paid, unless before the expiration of the said term the holder of the patent pays the fee required for the further term of six or twelve years, and obtains from the Patent Office a certificate of such payment in the form which is, from time to time, adopted, which certificate shall be attached to and refer to the patent, and shall be under the signature of the Commissioner or of the Deputy Commissioner.

3. If such second payment, together with the first payment, makes up only the fee required for twelve years, then the patent shall, notwithstanding anything therein or in this Act contained, cease at the end of the term of twelve years, unless at or before the expiration of such term the holder thereof pays the further fee required for the remaining six years, making up the full term of eighteen years, and obtains a like certificate in respect thereof. 55-56 V., c. 24, s. 5; 56 V., c. 34, s. 3.

All patents are granted for the full term of eighteen years whether the applicant elects to pay the entire fee of sixty dollars at the time of making his application for patent, or to pay this fee by instalment of three equal payments; that is to say, twenty dollars with the petition for patent and twenty dollars at any time before the expiry of the sixth and twelfth years. It is also optional with the applicant to pay the fees for the first and second terms at the time of making the application for patent, or, after the patent has been granted, to pay the fees for the second and third terms in one payment at any time before the expiry of the first six years.

When remitting a partial fee to the Patent Office the instructions on page 347 should be observed, and a cover-

ing letter should accompany such fee stating the purpose of the enclosure, and, at the same time, identifying the patent by giving the number, date, and to whom granted. If the original patent is available it should also accompany the fee, in order that the certificate of payment may be stamped thereon; but if, for any reason, it cannot then be produced, the Patent Office will acknowledge the payment by letter and enclose therewith the usual official receipt. The original patent may be stamped at any time afterwards when forwarded to the Patent Office for that purpose.

Patentees and their solicitors should not delay until the last day in remitting these partial fees, for if they are received after the expiry of the sixth and twelfth years' terms, the patents will cease and determine, the Commissioner not being vested with the discretionary power, under any circumstances, to revive them. A revival can only be secured by a private Act of Parliament, the obtaining of which entails considerable expense to the patentee. It may further be added that the Committee on Private Bills usually discourages applications of this kind, on the ground that no person should be denied the right of manufacturing, using or vending an invention which has become the property of the public; exceptional cases may arise, however, in which the patentee or the holder of the patent may be justly entitled to relief from Parliament.

The form of petition and instructions as to the necessary procedure in presenting an application for a Private Bill may be obtained on written application to the Clerk of the House of Commons, Ottawa.

RE-ISSUE OF PATENTS.

24. Whenever any patent is deemed defective or inoperative by reason of insufficient description or specification, or by reason of the patentee claiming more than he had a right to claim as new, but at the same time it appears that the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention, the Commissioner may, upon the surrender of such patent and the payment of the further fee hereinafter provided,

cause a new patent, in accordance with an amended description and specification made by such patentee, to be issued to him for the same invention, for any part or for the whole of the then unexpired residue of the term for which the original patent was, or might have been granted.

2. In the event of the death of the original patentee or of his having assigned the patent, a like right shall vest in his assignee or his legal representatives.

3. Such new patent, and the amended description and specification, shall have the same effect in law, on the trial of any action thereafter commenced for any cause subsequently accruing, as if the same had been originally filed in such corrected form before the issue of the original patent.

4. The Commissioner may entertain separate applications, and cause patents to be issued for distinct and separate parts of the invention patented, upon payment of the fee for a re-issue for each of such re-issued patents. R.S., c. 61, s. 23.

In the matter of a re-issue, whatever is really embraced in the original application and so described or shown in the same, that it might have been embraced in the original patent, may be ground for a re-issue. No new matter may be introduced into the specification, nor shall the model or drawings be amended except each by the other. In the absence of model or drawing, the re-issue may contain amendments, upon satisfactory proof to the Commissioner that such amendments were part of the invention, although omitted in the original application. Separate patents may be issued for each separate and distinct part of the invention, comprehended in the original patent and the fees shall be the same in each case.

The petition for a re-issue may be made by the original patentee or the assignee of the entire interest, or if the patentee is dead his legal representative.

The papers forming an application for a re-issue should be of the same number and kind as an ordinary application for patent and must be accompanied by the original

patent, together with the surrender of the same, written on a separate sheet of paper. If the original patent be lost a copy certified by the Patent Office must be filed in lieu thereof, and application may be made therefor, if not already procured, on payment of the usual fee, according to the tariff of fees on page 392.

The fee payable on a re-issue application is four dollars for each and every unexpired year of the duration of the original patent; that is to say, eighteen years from the date thereof, whether the partial fees were paid for the second or third terms. See section 23 of the Patent Act, herein, page 364.

After the re-issue patent has been granted, the partial fees on the original patent shall, notwithstanding the surrender, continue to be payable as they become due; that is to say, dating from the issue of the original patent.

The two years mentioned in section 38 of the Patent Act as to manufacture commences to run from the date of the original patent and not from the date of any re-issue thereof. If the original patent has been brought under section 44 of the Patent Act (Compulsory License System) it will likewise apply to the re-issue patent and the order stamped thereon, but not otherwise unless the latter was issued before six months elapsed following the date of the original patent and application made therefor before the expiry of that period.

If a re-issue be refused the original patent, or certified copy thereof, will be returned to the applicant and upon his request a refund will be made of all fees paid less ten dollars.

DISCLAIMERS.

25. Whenever, by any mistake, accident or inadvertence, and without any wilful intent to defraud or mislead the public, a patentee has,—

- (a) made his specification too broad, claiming more than that of which he or the person through whom he claims was the first inventor; or,
- (b) in the specification, claimed that he or the person through whom he claims was the first inventor of any

material or substantial part of the invention patented, of which he was not the first inventor, and to which he had no lawful right;

the patentee may, on payment of the fee hereinafter provided, make disclaimer of such parts as he does not claim to hold by virtue of the patent or the assignment thereof.

2. Such disclaimer shall be in writing, and in duplicate, and shall be attested in the manner hereinbefore prescribed, in respect of an application for a patent; one copy thereof shall be filed and recorded in the office of the Commissioner, and the other copy thereof shall be attached to the patent and made a part thereof by reference, and such disclaimer shall thereafter be taken and considered as part of the original specification.

3. Such disclaimer shall not affect any action pending at the time of its being made, except in so far as relates to the question of unreasonable neglect or delay in making it.

4. In case of the death of the original patentee, or of his having assigned the patent, a like right shall vest in his legal representatives, any of whom may make disclaimer.

5. The patent shall thereafter be deemed good and valid for so much of the invention as is truly the invention of the disclaimant, and is not disclaimed, if it is a material and substantial part of the invention, and is definitely distinguished from other parts claimed without right; and the disclaimant shall be entitled to maintain an action or suit in respect of such part accordingly. R.S., c. 61, s. 24.

On asking to attach a disclaimer to a patent, the statutory fee is \$2.00, and the disclaimer must be furnished in duplicate. Sub-section 4 of the above section defines who may file a disclaimer. (For form, see page 432.)

ASSIGNMENTS.

26. The patent may be granted to any person to whom the inventor, entitled under this Act to obtain a patent,

has assigned or bequeathed the right of obtaining the same, or in default of such assignment or bequest, to the legal representatives of the deceased inventor. R.S., c. 61, s. 25.

27. Every patent issued for an invention shall be assignable in law, either as to the whole interest or as to any part thereof, by any instrument in writing; but such assignment, and every grant and conveyance of any exclusive right to make and use and to grant to others the right to make and use the invention patented, within and throughout Canada or any part thereof, shall be registered in the Patent Office in the manner, from time to time, prescribed by the Commissioner for such registration; and every assignment affecting a patent for invention shall be null and void against any subsequent assignee, unless such instrument is registered as hereinbefore prescribed, before the registration of the instrument under which such subsequent assignee claims. R.S., c. 61, s. 26.

28. In cases of joint applications or grants, every assignment from one or more of the applicants or patentees to the other or others, or to any other person, shall be registered in like manner as other assignments. R.S., c. 61, s. 27.

An assignment made before the issue of a patent, when presented with the application, will be recorded immediately upon its receipt, provided that it contains the title of the invention and is accompanied by a plain unexecuted copy thereof, or duplicate executed copies, and the statutory fee of two dollars. The assignment will be returned to the person forwarding the same after registration. Such assignment by the inventor must contain a request to the Commissioner authorizing the issue of the patent to the assignee, or jointly to himself and the assignee, if only a portion of the interest in the invention is assigned. The residence or place of business of an assignee, whether an individual or a company, should be given in the assignment. (See form 18, page 430.)

On the presentation of an assignment or any other instrument in writing affecting a patent after issue, it should

contain the title of the invention, number and date of the patent, and may be executed in duplicate, or if not, the original should be accompanied by a plain unexecuted copy. In the latter case the original is retained by the Patent Office, and the copy is returned to the sender bearing evidence of registration. (See form 19, page 431.)

If for any reason the assignee of the whole or a part interest in a patent desires the return of the original assignment or instrument, the Patent Office will return it after being recorded, provided that the copy is acknowledged before a notary and his certificate and seal thereto affixed. The same practice applies to agreements and other instruments affecting a patent. When more than one patent or application for patent is included in a single instrument, a recording fee of two dollars is exacted by the Patent Office for each and everyone mentioned.

Should an assignment be presented for registration relating to a patent which has been allowed to expire through the non-payment of either of the partial fees, registration will be deferred until the Patent Office shall have advised the sender of this circumstance, and if, after such notice, registration is insisted upon, the assignment will be recorded for what it is worth, and an entry made thereon that the partial fee for the second or third term of the patent, as the case may be, was not paid.

If an assignment, after it has been recorded at the Patent Office, is found to contain an error in any respect it may be remedied only by the filing of an amending assignment presented for registration in the ordinary manner and on payment of the usual fee of two dollars for each and every patent mentioned therein.

An assignment without date of execution may be registered after the sender has been previously advised of the omission and fails to have it rectified, but who insists upon its registration as previously filed.

Assignments and other like instruments may be presented for registration in either the English or French language, and should be legibly written, printed or type-written on paper eight by thirteen inches, and on but one side of the paper. This latter requirement of the Rules of the Patent Office may in some cases be waived by the Commissioner.

The person presenting an assignment, or any other instrument affecting the proprietorship of a patent, for registration, must assume all responsibility as to its validity and sufficiency.

The Patent Office will furnish, on application, an abstract from the Register of Assignments showing the registered owner of any particular patent.

The usual fee is fifty cents.

IMPEACHMENT AND OTHER LEGAL PROCEEDINGS IN RESPECT OF PATENTS.

29. A patent shall be void, if any material allegation in the petition or declaration of the applicant hereinbefore mentioned in respect of such patent is untrue, or if the specifications and drawings contain more or less than is necessary for obtaining the end for which they purport to be made, when such omission or addition is wilfully made for the purpose of misleading: Provided that if it appears to the court that such omission or addition was an involuntary error, and if it is proved that the patentee is entitled to the remainder of his patent *pro tanto*, the court shall render a judgment in accordance with the facts, and shall determine as to costs, and the patent shall be held valid for such part of the invention described, as the patentee is so found entitled to.

2. Two office copies of such judgment shall be furnished to the Patent Office by the patentee, one of which shall be registered and remain of record in the office, and the other of which shall be attached to the patent, and made a part of it by a reference thereto. R.S., c. 61, s. 28.

The statutory fee payable to the Patent Office for the registration referred to in the above section is four dollars, and the judgment should be furnished in duplicate.

REMEDY FOR INFRINGEMENT OF PATENT.

30. Every person who, without the consent in writing of the patentee, makes, constructs or puts in practice any in-

vention for which a patent has been obtained under this Act or any previous Act, or who procures such invention from any person not authorized by the patentee or his legal representatives to make or use it, and who uses it, shall be liable to the patentee or his legal representatives in an action of damages for so doing; and the judgment shall be enforced, and the damages and costs that are adjudged shall be recoverable, in like manner as in other cases in the court in which the action is brought. R.S., c. 61, s. 29.

ACTION FOR INFRINGEMENT.

31. Any action for the infringement of a patent may be brought in the court of record having jurisdiction, to the amount of the damages claimed, in the province in which the infringement is alleged to have taken place, which holds its sittings nearest to the place of residence or of business of the defendant; and such court shall decide the case and determine as to costs. R.S., c. 61, s. 30.

INJUNCTION AND APPEAL.

32. In any action for the infringement of a patent, the court, or any judge thereof, may, on the application of the plaintiff, or defendant respectively, make such order as the court or judge sees fit,—

- (a) restraining or for an injunction restraining the opposite party from further use, manufacture or sale of the subject matter of the patent, and for his punishment in the event of disobedience of such order; or,
- (b) for and respecting inspection or account; and,
- (c) generally respecting the proceedings in the action.

2. An appeal shall lie from any such order under the same circumstances, and to the same court, as from other judgments or orders of the court in which the order is made. R.S., c. 61, s. 31.

COURT MAY DISCRIMINATE IN CERTAIN CASES.

33. Whenever the plaintiff, in any such action, fails to sustain the same, because his specification and claim embrace more than that of which he was the first inventor, and it appears that the defendant used or infringed any part of the invention justly and truly specified and claimed as new, the court may discriminate, and the judgment may be rendered accordingly. R.S., c. 61, s. 32.

DEFENCE IN ACTION FOR INFRINGEMENT.

34. The defendant, in any such action, may plead as matter of defence, any fact or default which, by this Act, or by law, renders the patent void; and the court shall take cognizance of such pleading and of the facts connected therewith, and shall decide the case accordingly. R.S., c. 61, s. 33.

PROCEEDINGS FOR IMPEACHMENT OF PATENT.

35. Any person who desires to impeach any patent issued under this Act, may obtain a sealed and certified copy of the patent and of the petition, affidavit, specification and drawings thereunto relating, and may have the same filed in the office of the prothonotary or clerk of any of the divisions of the High Court of Justice in Ontario, or of the Superior Court of Quebec, or of the Supreme Court in Nova Scotia, New Brunswick, British Columbia or Prince Edward Island, respectively, or of the Court of King's Bench in Manitoba, or of the Supreme Court of the Northwest Territories in the Provinces of Saskatchewan and Alberta respectively, pending the disestablishment of that Court by the legislature of those provinces respectively, and thereafter of such superior court of justice, as, in respect of civil jurisdiction, is established by the said legislatures respectively in lieu thereof, or of the Territorial Court in the Yukon Territory, according to the domicile elected by the patentee, as aforesaid, or in the

office of the registrar of the Exchequer Court of Canada, and such courts, respectively, shall adjudicate on the matter and decide as to costs; and if the domicile elected by the patentee is in that part of Canada formerly known as the district of Keewatin, the Court of King's Bench of Manitoba shall have jurisdiction until there is a superior court therein, after which such superior court shall have jurisdiction.

2. The patent and documents aforesaid shall then be held as of record in such courts respectively, so that a writ of *scire facias*, under the seal of the court, grounded upon such record, may issue for the repeal of the patent, for cause as aforesaid, if, upon proceedings had upon the writ in accordance with the meaning of this Act, the patent is adjudged to be void. R.S., c. 61, s. 34; 53 V., c. 13, s.1.

NOTE.—Attention is directed to the Act entitled "An Act to Provide for the Investigation of Combines, Monopolies, Trusts and Mergers." 9-10 Edward VII., Chap. 9, Section 22 whereof provides as follows:—

REVOCATION OF PATENT IN CERTAIN CASES.

22. In case the owner or holder of any patent issued under *The Patent Act* has made use of the exclusive rights and privileges which, as such owner or holder he controls, so as unduly to limit the facilities for transporting, producing, manufacturing, supplying, storing or dealing in any article which may be a subject of trade or commerce, or so as to restrain or injure trade or commerce in relation to any such article, or unduly to prevent, limit or lessen the manufacture or production of any article or unreasonably to enhance the price thereof, or unduly to prevent or lessen competition in the production, manufacture, purchase, barter, sale, transportation, storage or supply of any article, such patent shall be liable to be revoked. And, if a Board reports that a patent has been so made use of, the Minister of Justice may exhibit an information in the Exchequer

Court of Canada praying for a judgment revoking such patent, and the court shall thereupon have jurisdiction to hear and decide the matter and to give judgment revoking the patent or otherwise as the evidence before the court may require.

JUDGMENT VOIDING PATENT TO BE FILED IN THE PATENT OFFICE.

36. A certificate of the judgment avoiding any patent shall, at the request of any person filing it to make it of record in the Patent Office, be entered on the margin of the enrolment of the patent in the Patent Office, and the patent shall thereupon be and be held to have been void and of no effect, unless the judgment is reversed on appeal as hereinafter provided. R.S., c. 61, s. 35.

APPEAL.

37. The judgment declaring or refusing to declare any patent void shall be subject to appeal to any court having appellate jurisdiction in other cases decided by the court by which such judgment was rendered. R.S., c. 61, s. 36.

MANUFACTURE AND IMPORTATION.

CONDITIONS AND EXTENSION.

38. Every patent shall, unless otherwise ordered by the Commissioner as hereinafter provided, be subject, and expressed to be subject, to the following conditions:—

- (a) Such patent and all the rights and privileges thereby granted shall cease and determine, and the patent shall be null and void at the end of two years from the date thereof, unless the patentee or his legal representatives, within that period or an authorized extension thereof, commence, and after such commencement, continuously carry on in Canada, the construction or manufacture of the invention patented, 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;

- (b) If, after the expiration of twelve months from the granting of a patent, or an authorized extension of such period, the patentee or patentees, or any of them, or his or their or any of their legal representatives, for the whole or a part of his or their or any of their interest in the patent, import or cause to be imported into Canada, the invention for which the patent is granted, such patent shall be void as to the interest of the person or persons so importing or causing to be imported. 3 E. VII., c. 46, s. 4.

TERM FOR MANUFACTURE IN CANADA MAY BE EXTENDED.

39. Whenever a patentee is unable to commence or carry on the construction or manufacture of his invention within the two years hereinbefore provided, the Commissioner may, at any time not more than three months before the expiration of that term, grant to the patentee or his legal representatives an extension of the term of two years, on his proving to the satisfaction of the Commissioner that his failure to commence or carry on such construction or manufacture is due to reasons beyond his control. 3 E. VII., c. 46, s. 5.

Under the above section of the Patent Act the Commissioner of Patents is given power to grant an extension of the two years mentioned in section 38 in which to commence the manufacture of the patented invention in Canada.

The petition must be supported by proof in the form of a solemn declaration, according to the provisions of the "Canada Evidence Act," if such proof be made in Canada; and if made elsewhere, by an affidavit before an officer authorized to administer an oath in the place where the same is made. Absence of a demand for the patented in-

vention is not considered a sufficient reason for granting the extension of time to manufacture.

Each case is considered on its merits; and the various special circumstances that attend it; and once the Commissioner has exercised his power in granting an extension of time to manufacture under a patent, he cannot grant any further delay.

In considering applications for extensions of time to manufacture, the law is applied according to its strict and literal meaning; and the applications are granted only when the applicant has clearly established to the satisfaction of the Commissioner, that the failure to manufacture is due to no fault of his, but to reasons beyond his control. Although these applications are quite numerous, it is seldom that such a case is made out, which warrants the granting of the desired extension. There are circumstances, however, which may be favourably entertained by the Commissioner, such as prolonged illness of the patentee or holder of the patent during the greater part of the two years following the date of the patent, when this fact has been clearly established by a medical certificate supported by affidavit. Also when it is shown that actual steps have been taken towards the erection of a plant or workshop in Canada; which, for good reasons, cannot be completed before the termination of the two years for manufacture. In such cases a short extension may be granted to enable the holder of the patent to complete the undertaking. It should also be stated in the petition in what locality the operations are being carried on.

The period for presenting petitions for such extensions, is within the three months preceding the expiry of the two years from the date of the patent, and without the payment of any fee.

If a petition is denied for insufficient reasons, as may appear to the Commissioner, and there is yet time before the expiry of the aforesaid three months, the applicant may file a supplementary petition, if he has new ground to adduce why the extension should be granted. It must be shown that honest effort has been made to commence manufacture in Canada.

The practice of inserting notices in newspapers by patentees, whose patents are not under the Compulsory

License System, and who are not manufacturing in Canada, that they are willing to grant licenses, is foreign to the law, and it is not seen what purpose is to be served thereby.

The Patent Act or Rules of Practice does not require of a patentee, or the holder of a patent, to notify the Commissioner, when manufacture has been commenced in Canada. When such notice is sent to the Patent Office, it is merely filed for what it may be worth, but the Patent Office will not undertake to answer enquiries as to whether or not, a patentee or holder of a patent has given such notice.

The Patent Office does not prescribe any specific form of petition for an extension of time to manufacture.

TERM FOR IMPORTATION MAY BE EXTENDED.

40. The Commissioner may grant to the patentee or his legal representatives, for the whole or any part of the patent, an extension for a further term not exceeding one year, during which he may import or cause to be imported into Canada the invention for which the patent is granted, if he or they show cause, satisfactory to the Commissioner, to warrant the granting of such extension; but no extension shall be granted unless application is made to the Commissioner at some time within three months before the expiry of the twelve months aforesaid. 3 E. VII., c. 46, s. 6.

The extension of time to import, which the Commissioner of Patents is empowered to grant, under the preceding section, must be applied for by petition, at some time within three months before the expiry of the twelve months from the date of the patent. The petitioner must be the holder of the patent, and in his petition set forth clearly and specially, in such a manner as to enable the Commissioner to determine their sufficiency, the reasons to warrant the granting of such extension.

The petition must be supported by proof in the form of a solemn declaration, according to the provision of the "Canada Evidence Act," if such proof is made in Canada; and if made elsewhere, by an affidavit before an officer authorized to administer an oath in the place where the same is made.

An extension of time to import is not given to create a demand, but only to enable the owner of the patent to start the manufacture in Canada, by the importation of a machine or device, for the purpose of demonstrating its utility, provided that there has been no importation of the patented invention during the year in which he had the privilege of doing so. Therefore, extensions of time for general importation of the invention to fill orders or supply the trade, will meet with refusal.

When the owner of a patent desires to import the article patented, for the purpose above mentioned, he will be required to include in his petition an undertaking to the effect that he will restrict himself to the importation of the one specimen or full sized working machine, as the case may be, and it will be further necessary for him to state, in his petition, the shortest period required for such importation.

Contrary to the requirements under section 39 of the Patent Act the Commissioner may consider a supplementary petition for an extension of time to import presented after the three months, provided always that the original petition, although refused, was received at the Patent Office at some time within the last three months of the year following the date of the patent.

As in the case of an extension of time to manufacture, the Commissioner has not the power to grant a second extension of time to import.

The Patent Office does not prescribe any specific form of petition, or fee, for extension of time to import.

VALIDITY OF AN EXTENSION ALREADY GRANTED.

41. The validity of any extension granted or assumed to be granted before the thirteenth day of August, one thousand nine hundred and three, of the period of two years theretofore limited by statute in that behalf for the commencement of the construction or manufacture of a patented invention, or of the period of twelve months theretofore so limited for the importation of a patented invention, shall not be open to impeachment, nor shall the patent for any invention in respect of which any such

extension had been so granted be deemed to have lapsed or expired because,—

- (a) such extension, instead of being granted by the Commissioner, was so granted or assumed to be granted by the Deputy Commissioner, or, as acting deputy commissioner, by a person performing the duties of the Deputy Minister of Agriculture under the provisions of the Civil Service Act in that behalf, instead of by the Commissioner; or,
- (b) in the case of the invention to which such extension relates, there had been granted or assumed to be granted a previous extension or previous extensions of such period of two years, or such period of twelve months, as the case may be. 3 E. VII., c. 46, s. 9.

CONDITIONAL VALIDITY OF CERTAIN PATENTS GRANTED
BEFORE AUGUST 13TH, 1903.

42. The validity of any patent granted before the thirteenth day of August, one thousand nine hundred and three, shall not be impeached, nor shall such patent be deemed to have lapsed or expired, by reason of the failure of the patentee to construct or manufacture the patented invention, if the patentee within the period of two years from the date of the patent allowed for such construction or manufacture, or within an authorized extension of that period, became, and at all times thereafter continued to be, ready either to furnish the patented invention himself or to license the right of using it, on reasonable terms, to any person desiring to use it, and if the patentee, or his legal representatives, within six months from the thirteenth day of August, one thousand nine hundred and three, had,—

- (a) commenced, and after such commencement continuously carried on in Canada, the construction or manufacture of the patented invention in such man-

ner as to enable any person desiring to use it to 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; or,

- (b) applied for and thereupon obtained an order of the Commissioner making the patent subject to the condition hereinafter provided for authorizing applications for the issue of licenses to make, construct, use and sell the patented invention. 3 E. VII., c. 46, s. 10.

RIGHTS OF THIRD PERSONS SAVED.

43. In the case of any patent which before the thirteenth day of August, one thousand nine hundred and three, had become void or the validity of which might have been impeached, and which was revived or protected from impeachment by any provision of the Act, passed in the third year of His Majesty's reign, chapter forty-six, intituled *An Act to amend the Patent Act*, or which, by reason of any such provision, is to be deemed not to have elapsed or expired; any person who, between the time when such patent became void or the ground for such impeachment arose, and the thirteenth day of August, one thousand nine hundred and three, aforesaid, commenced to manufacture, use or sell in Canada the invention covered by such patent, may continue to manufacture, use or sell it in as full and ample a measure as if such revival or protection from impeachment had not been effected; and in case any person had, before the thirteenth day of August aforesaid, contracted with the owner of the patent for the right to manufacture, use or sell such invention in Canada, the contract shall be deemed to have remained in full force and effect notwithstanding that the patent had become void as aforesaid, unless the person who had so contracted with such owner can show that in the mean-

time, by reason or on the faith of such invalidity or lapsing, he has materially altered his position with respect to such invention, and that the revival of such contract would cause him damage. 3 E. VII., c. 46, s. 14.

COMPULSORY LICENSE SYSTEM.

44. On the application of the applicant for a patent, previous to the issue thereof, or on the application within six months after the issue of a patent of the patentee or his legal representatives, the Commissioner, having regard to the nature of the invention, may order that such patent, instead of being subject to the condition with respect to the construction and manufacture of the patented invention hereinbefore provided, shall be subject to the following conditions, that is to say:—

(a) Any person, at any time while the patent continues in force, may apply to the Commissioner by petition for a license to make, construct, use and sell the patented invention, and the Commissioner shall, subject to general rules which may be made for carrying out this section, hear the person applying and the owner of the patent, and, if he is satisfied that the reasonable requirements of the public in reference to the invention have not been satisfied by reason of the neglect or refusal of the patentee or his legal representatives to make, construct, use or sell the invention, or to grant licenses to others on reasonable terms to make, construct, use or sell the same, may make an order under his hand and the seal of the Patent Office requiring the owner of the patent to grant a license to the person applying therefor, in such form, and upon such terms as to the duration of the license, the amount of the royalties, security for payment, and otherwise, as the Commissioner, having regard to the nature of the invention and the circumstances of the case, deems just;

- (b) The Commissioner may, if he thinks fit, and shall on the request of either of the parties to the proceedings, call in the aid of an assessor, specially qualified, and hear the case wholly or partially with his assistance;
- (c) The existence of one or more licenses shall not be a bar to an order by the Commissioner for, or to the granting of a license on any application, under this section; and,
- (d) The patent and all rights and privileges thereby granted shall cease and determine, and the patent shall be null and void, if the Commissioner makes an order requiring the owner of the patent to grant any license, and the owner of the patent refuses or neglects to comply with such order within three calendar months next after a copy of it is addressed to him or to his duly authorized agent. 3 E. VII., c. 46, s. 7.

When the Patent Office is considering petitions under this section of the Patent Act, the requirements of the law in regard to manufacture are kept in mind. Ordinary patents are governed by paragraph (a) of Section 38, but such patents as the following may be placed under the Compulsory License System, when the Commissioner is satisfied of the propriety of this being done, namely, patents for an art or process; improvements on a patented invention when both patents are not held by the same person; appliances or apparatus used in connection with railways, telegraph, telephone and lighting systems; and other works usually under the control of public or large private corporations; and which appliances or apparatus cannot be installed or constructed without the consent of such corporations; and certain inventions which are manufactured or constructed only to order, and are not, according to custom, carried in stock.

When a patent covers an invention which is an improvement upon a previously granted patent, not held by the same person, the number and date of the latter patent should also be mentioned in the petition. Applicants for

patents, patentees, or their attorneys should not petition the Commissioner for an order to place a patent under the compulsory license system, when the invention does not fall under any of the several headings enumerated above, as otherwise, the Patent Office is put to the trouble of making unnecessary entries and of sending a formal refusal.

The petition must be presented by the owner of the patent within six months from its date, or may accompany the application for patent or at any time while it is pending. It must be signed by the applicant, and in either case should contain the grounds upon which the application is based. If the original patent is available, it should accompany the petition in order that it may be stamped by the Patent Office, if the order is granted.

When a patent has been brought under this section of the Act it still remains subject to the terms and provisions of Section 38, paragraph (b), as to importation.

As previously stated on page 341, the power of attorney filed with an application for a patent, subsequently issued, does not apply to a petition under section 44; therefore, it must be signed by the owner of the patent or his agent under a new power of attorney. The production of the original patent, however, will be considered sufficient evidence of authorization if it accompanies the petition made by any person on behalf of the owner of the patent. No fee is exacted by the Patent Office under this section of the Act.

Attorneys are advised to acquaint their clients, either before or after the issue of a patent, of the provisions of the Compulsory License System (section 44, quoted on the fly leaf of each patent); when their inventions are such as come under any of the several headings hereinbefore mentioned. Experience in the Patent Office suggests offering this advice, as it not unfrequently occurs that patentees file petitions for extensions of time to manufacture, pleading ignorance of the existence of that provision of the law, *at the time*, when such an application could have been made.

The following rules for the guidance of the Patent Office, Patentees and others in respect of petitions to the Commissioner, for an order for a license, were approved by the Governor-General in Council, on the 23rd February, 1904, and are in force.

PETITION FOR GRANT OF COMPULSORY LICENSE.

25. A petition to the Commissioner for an order for a license under Section 44, paragraph (a), of the Act, shall show clearly the ground or grounds upon which the petitioner claims to be entitled to a license, and shall state in detail the circumstances of the case, the terms upon which he asks that an order may be made, the purpose of such order, and the name and address of the patentee and of any other person who is alleged in the petition to have made default.

TO BE LEFT WITH EVIDENCE AT PATENT OFFICE.

26. The petition and an examined copy thereof shall be left at the Patent Office, accompanied by affidavits or statutory declarations in proof of the allegations contained in the petition, together with any other documentary evidence in support; and petitioner shall, within ten days after the leaving of such petition, deliver to the patentee and any other person who is alleged in the petition to have made default, copies of the petition and of such affidavits or statutory declarations and other documentary evidence in support.

OPPOSANTS' OPPOSITIONS AND EVIDENCE.

27. The persons to whom such copies are delivered by the petitioner may, within ten days after being invited to do so by the Commissioner, leave at the Patent Office their oppositions to such petition, together with their affidavits or statutory declarations or other documentary evidence in support, in answer, and if they do so, shall deliver copies thereof to the petitioner within ten days, and the petitioner may within ten days from such last mentioned delivery leave at the Patent Office his affidavits or statutory declarations and other documentary evidence in reply; and if he does so, shall deliver copies thereof to the patentee or any other person alleged in the petition to

have made default within ten days, such last mentioned affidavits or statutory declarations being confined to matters strictly in reply.

CLOSING OF EVIDENCE.

28. No further evidence than as aforesaid may be left by either side at the Patent Office, except by leave or on requisition of the Commissioner, and upon such terms, if any, as he may think fit.

OTHER PARTIES INTERESTED MAY BE ALLOWED TO INTERVENE.

29. The Commissioner may at any stage of the proceedings before granting his order, give notice of the proceedings, and furnish copies thereof to any person not a party thereto who may be interested in the patent and whose rights may be affected by his order, and may allow such person to intervene in the proceedings. After such person has been allowed to intervene, he shall be governed by these rules as though the petitioner had alleged in his petition that such person was in default.

HEARING OF THE PETITION.

30. On completion of the evidence, or after the expiration of the time for completing the same, the Commissioner, on the request of the petitioner, shall fix a time for bearing the petition, and shall give notice to the petitioner, the patentee, and all other parties to the proceedings, that it is his intention to hear the petition on a specified day, which day shall not be less than two weeks from the date when the notice is served.

DOCUMENTS TO BE TYPEWRITTEN OR PRINTED.

31. All petitions and other documents lodged at the Patent Office shall (unless the Commissioner otherwise direct), be typewritten or printed, and the parties shall furnish as many copies of the documents lodged by them as shall be required by the Commissioner.

COPIES OF PAPERS AND ADDRESSES OF PARTIES.

32. Parties shall be entitled to have copies of all papers lodged in respect to the petition, at their own expense. The petitioner and each of the other parties shall specify an address for service in Canada, and may be heard in person or by counsel or by a duly authorized agent.

COUNSEL ON BEHALF OF CROWN.

33. The Commissioner shall, if so requested, hear counsel on behalf of the Crown on the question of granting the prayer of any petition. Counsel on behalf of the Crown shall not be 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 Commissioner.

SERVICE OF NOTICE.

34. Any notice required to be served or given by the rules relating to compulsory license may be served or given by posting the same to the party to be notified in a registered envelope, and documents required to be delivered may be delivered in the same way.

ALTERATIONS OR ENLARGEMENTS OF TIMES PRESCRIBED BY RULES.

35. The times prescribed by these rules may be altered or enlarged by the Commissioner if he thinks fit, upon such notice to parties interested and upon such terms, if any, as he may direct.

REFERENCES TO THE EXCHEQUER COURT.

45. Any question which arises as to whether a patent, or any interest therein, has or has not become void under any of the provisions of the seven last preceding sections of this Act, may be adjudicated upon by the Exchequer Court of Canada, which court shall have jurisdiction to decide any such questions upon information in the name of

the Attorney General of Canada, or at the suit of any person interested; but this section shall not be held to take away or affect the jurisdiction which any court other than the Exchequer Court of Canada possesses. 3 E. VII., c. 46, s. 8.

CAVEATS.

46. Any intending applicant for a patent who has not yet perfected his invention and is in fear of being despoiled of his idea, may file, in the Patent Office, a description of his invention so far as it has proceeded, with or without plans, at his own will; and the Commissioner, on payment of the fee in this Act prescribed, shall cause the said document, which shall be called a *caveat*, to be preserved in secrecy, with the exception of delivering copies of the same whenever required by the said applicant or by any judicial tribunal, but the secrecy of the document shall cease when the applicant obtains a patent for his invention.

2. If application is made by any other person for a patent for any invention with which such *caveat* may, in any respect, interfere, the Commissioner shall forthwith give notice by mail, of such application, to the person who has filed such *caveat*, and such person shall, within three months after the date of mailing the notice, if he wishes to avail himself of the *caveat*, file his petition and take the other steps necessary on an application for a patent, and if, in the opinion of the Commissioner, the applications are conflicting, like proceedings may be had in all respects as are by this Act provided in the case of conflicting applications.

3. Unless the person filing a *caveat* makes application within one year from the filing thereof for a patent, the Commissioner shall be relieved from the obligation of giving notice, and the *caveat* shall then remain as a simple matter of proof as to novelty or priority of invention, if required. R.S., c. 61, s. 38.

The filing of a caveat is not confined to a resident of Canada, but may be filed by any intending applicant for a patent, who desires further time to mature his invention. Such caveat shall be filed in the confidential archives of the Patent Office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof; and if application is made within the year, by any other person, for a patent, with which such caveat would in any manner conflict, the Commissioner shall give notice thereof, by registered letter, to the person by whom the caveat was filed. If such person desires to avail himself of his caveat, he shall file his application for patent within three months from the date of the official notice.

If a conflicting caveat is in force when an application for patent is filed, though the examination of the application is delayed or the application is rejected, and the rejection is not set aside until after the caveat has expired, the caveator is still entitled to be notified.

A caveat is simply an official expression of an inventor's intention to take out a patent at some time on the invention therein described, provided that the same is patentable in law; the Patent Office filing it without any examination as to the patentability of the subject matter.

The papers prescribed for the filing of a caveat are: (1) a petition form (16), page 428; (2) an oath, form (17), page 429; (3) a specification, form (9), page 412; and (4) a drawing on tracing linen or paper that may be folded. The application must be restricted to a single invention. Only the inventor and his properly authorized attorney may have access to a caveat, with the exception of delivering copies of the same whenever required by any judicial tribunal; but the secrecy of the document shall cease when the applicant obtains a patent for his invention.

The Patent Office Rules do not exact a formal claim to the specification, but the latter should be sufficiently precise to enable the Examiner to judge whether there is a probable conflict, when a subsequent application for patent is filed. The law governing caveats leaves it optional with the inventor to file or not to file drawings with his application; but the Patent Office always strongly urges, in the interest of the applicant, that some illustration should be filed with his specification.

A caveator may, while his caveat is pending, lodge additional papers without the payment of a further fee, provided that they relate exclusively to the same invention.

The person filing a caveat will not be entitled to notice of any application for a patent pending, at the time of filing his caveat.

There is no provision in the law making a caveat assignable, and if an assignment is presented for registration the Patent Office will return it to the sender.

Caveat papers cannot be withdrawn after they are filed, but copies may be obtained by the caveator or any person duly authorized by him, for the usual fee. See tariff of fees, page 391.

The statutory fee on filing a caveat is \$5.00; and once a caveat fee has been paid, it may not be refunded or transferred to an application for patent.

Although the Patent Act makes no provision for the renewal of caveats beyond the year mentioned, the Patent Office does not refuse to accept and file a second caveat for the same invention on presentation of a new application covering new papers and payment of the statutory fee of \$5.00, as if no previous caveat had been filed; but no reference should be made in the new application to the former caveat.

PATENT FEES.

47. The following fees shall be payable before an application for any of the purposes herein mentioned shall be received by the Commissioner, that is to say:—

Full fee for 18 years.....	\$60.00
Partial fee for 12 years.....	40.00
Partial fee for 6 years.....	20.00
Fee for further term of 12 years.....	40.00
Fee for further term of 6 years.....	20.00
On lodging a <i>caveat</i>	5.00
On asking to register a judgment <i>pro tanto</i>	4.00
On asking to register an assignment, or any other document affecting or relating to a patent.....	2.00

For each and every patent mentioned in any notice given to the Commissioner by the inventor after the issue of a foreign patent of his intention to apply for a patent in Canada for such invention.....	\$ 2.00
On asking to attach a disclaimer to a patent.....	2.00
On asking for a copy of patent with specification.....	4.00
On petition to re-issu a patent after surrender, in addition to the fees on the original patent which shall, notwithstanding such surrender, continue to be payable as aforesaid, for every unexpired year of the duration of the original patent.....	4.00
On office copies of documents, not above mentioned, the following charges shall be made:—	
For every single or first folio of one hundred words certified copy.....	\$0.25
For every such subsequent folio, fractions of or under one-half not being counted, and of one-half or more being counted as a folio.....	0.10

55-56 V., c. 24, s. 7; 56 V., c. 34, s. 4; 3 E. VII., c. 46, s. 11.

All fees should be transmitted with the application for any action by the Office, and must be made in current bankable funds: Bank drafts, post office or express money orders, or certified cheques, payable to the Commissioner of Patents, Ottawa. Bank drafts on New York or Chicago are taken at par, but all others for amounts not exceeding \$200.00 must have a collection fee of 10c. added thereto, but drafts made for a larger sum must have $\frac{1}{8}\%$ added. Postage stamps in payment of fees will not be accepted by the Patent Office, and money sent by mail should be in registered letters, at the risk of the sender.

Personal cheques and drafts, when not drawn as above indicated, are returned to the sender, thereby causing delay, that may result in not obtaining the desired filing date, when the application has been sent to the Patent Office within a few days of the expiry of the period within which legal filing should be made.

FEES FOR OFFICE COPIES.

Unless a copy of the patent is required as an exhibit in an action at court, or, to replace a lost or destroyed patent, it is usual to order only, a copy of the specification and drawings, or either. In many cases, copies are required by inventors and attorneys to examine the references cited by the examiners, anticipating in part, or whole the claims in a pending application for patent. This information would thus be obtained in the majority of cases at a much less cost, than if a copy of the full patent is ordered. The copy of the specification and drawings only, may be equally as useful for other purposes.

The tariff above quoted from the Patent Act, prescribes a charge of twenty-five cents for the first folio of one hundred words of any document, and ten cents for every subsequent folio, fractions of or under one half not being counted.

For a blue-print of each sheet of drawing attached to a patent, the fee is twenty-five cents.

All copies of specifications and drawings are certified by the Patent Office, and the certificate thereto attached, gives the name of the patentee, the title of the invention, the number and date of the patent, and the date the application was filed.

It may be added that Canadian patents are not printed, therefore, all copies of documents are typewritten, and are prepared as promptly as possible, in the order of the date of the filing of the requisition therefor.

On application, the Patent Office will quote, beforehand, the cost of a copy of the specification and drawing of any particular patent, properly identified.

COPIES OF DRAWINGS.

48. For every copy of drawings, the person applying shall pay such sum as the Commissioner considers a fair

remuneration for the time and labour expended thereon by any officer of the Patent Office, or of the Department, or person employed to perform such service. R.S., c. 61, s. 40.

Copies of drawings are made by the blue-print or Vandyke process at twenty-five cents for each sheet, except in the case of a caveat. When the drawing is not made on tracing linen or thin paper, a pen-tracing will be made and charged for according to the time and labour expended thereon.

When three or more blue-print copies of the same sheet of drawing are ordered the fee is fifteen cents per sheet.

FEEs TO BE IN FULL FOR ALL SERVICES.

49. The said fees shall be in full of all services performed under this Act, in any such case, by the Commissioner or any person employed in the Patent Office. R.S., c. 61, s. 41.

APPLICATION OF FEES.

50. All fees received under this Act shall be paid over to the Minister of Finance, and shall form part of the Consolidated Revenue Fund of Canada, except such sums as are paid for copies of drawings when made by persons not receiving salaries in the Patent Office. R.S., c. 61, s. 42.

REFUND OF FEES.

51. No person shall be exempt from the payment of any fee or charge payable in respect of any services performed for such person under this Act; and no fee, when paid, shall be returned to the person who paid it, except,—

(a) when the invention is not susceptible of being patented; or

(b) when the petition for a patent is withdrawn.

2. In every such case the Commissioner may return the fee paid less the sum of ten dollars. R.S., c. 61, s. 43.

The refund mentioned in clause (2) of this section may be made to the applicant, or to his attorney, on a written

application at any time after the patent has been refused (clause *a*); but under clause (*b*), when the petition for a patent is withdrawn, the refund is made provided only that the application has not fallen under the operation of Rule 9, which provides that:—

“An applicant for an original patent, or for the re-issue of a patent, shall proceed with his application with due diligence; and upon his failure to prosecute the same within a period of one year after the date of the acknowledgment of the filing of his application, or other subsequent official action of which notice has been duly given, the same shall be held to be abandoned, and any fees paid thereon forfeited.”

If, however, an application has not become so abandoned, the refund may be made to the applicant or to his attorney, but the latter must first file an authorization signed in person by the applicant, consenting to the abandonment of the application; and in the case of a part interest in the invention having been assigned, the authorization must also bear the signature of the assignee.

GOVERNMENT MAY USE PATENTED INVENTION.

52. The Government of Canada may, at any time, use any patented invention, paying to the patentee such sum as the Commissioner reports to be a reasonable compensation for the use thereof. R.S., c. 61, s. 44.

When application is made by any Department of the Government of Canada to fix compensation under this section, the Department applying, and the patentee, will be given full opportunity of submitting evidence, both urging their respective pretensions.

The question of what is a reasonable price is absolutely within the discretion of the Commissioner of Patents, and from his decision no appeal can be taken.

USE OF PATENTED INVENTION IN FOREIGN VESSELS.

53. No patent shall extend to prevent the use of any invention in any foreign ship or vessel, if such invention is not so used for the manufacture of any goods to be vend- ed within or exported from Canada. R.S., c. 61, s. 45.

PATENT NOT TO AFFECT A PREVIOUS PURCHASER.

54. Every person who, before the issuing of a patent, has purchased, constructed or acquired any invention for which a patent is afterwards obtained under this Act, shall have the right of using and vending to others the specific article, machine, manufacture or composition of matter patented and so purchased, constructed or acquired before the issue of the patent therefor, without being liable to the patentee or his legal representatives for so doing; but the patent shall not, as regards other persons, be held invalid by reason of such purchase, construction or acquisition or use of the invention, by the person first aforesaid or by those to whom he has sold the same, unless the same was purchased, constructed, acquired or used, with the consent or allowance of the inventor thereof, for a longer period than one year before the application for a patent therefor, thereby making the invention one which has become public and in public use. R.S., c. 61, s. 46.

PATENTED ARTICLE TO BE STAMPED OR MARKED.

55. Every patentee under this Act shall stamp or engrave on each patented article sold or offered for sale by him the year of the date of the patent applying to such article, thus,—*Patented, 1906*, or as the case may be; or when, from the nature of the article, this cannot be done, then by affixing to it, or to every package wherein one or more of such articles is or are enclosed, a label marked with a like notice. R.S., c. 61, s. 54.

INSPECTION BY THE PUBLIC.

56. All specifications, drawings, models, disclaimers, judgments and other papers, except *caveats*, and except those filed in connection with applications for patents which are still pending, shall be open to the inspection of the public at the Patent Office, under such regulations as are adopted in that behalf. R.S., c. 61, s. 47; 3 E. VII., c. 46, s. 12.

The Patent Office does not, however, withhold from the public the information as to whether or not an application has been filed, provided that the name of the supposed applicant and title of invention are given; but no information will be offered beyond giving the date of the filing of the application.

The books and records of the office, except those relating to pending applications for patents and caveats, are open to public inspection daily, except on Sundays and statutory holidays, from 9 a.m. to 5 p.m.; on Saturdays until 1 p.m.

The public is permitted to take extracts from patents or registered assignments, but the making of complete copies of specifications and drawings is not allowed by the Patent Office.

SALE OR DESTRUCTION OF MODELS OR SPECIMEN OF INGREDIENTS.

57. The Commissioner may destroy, sell or otherwise dispose of, in such manner as he deems best in the public interest, all models and specimens of composition of matter and of ingredients thereof filed in connection with applications for patents of invention after they have served their immediate purpose.

2. All money arising from the sale or disposal of such models or specimens shall be paid into the Consolidated Revenue Fund of Canada. 3 E. VII., c. 46, s. 15.

Under the authority of the above section the accumulated models were sold (*en bloc*) on the 3rd of March, 1904.

CLERICAL ERRORS.

58. Clerical errors which occur in the framing or copying of any instrument in the Patent Office shall not be construed as invalidating the same, but, when discovered, they may be corrected under the authority of the Commissioner. R.S., c. 61, s. 48.

A mistake incurred through the fault of the Patent Office, in framing or copying any instrument as clearly

disclosed by the records or files may, when discovered, be corrected, under authority of the Commissioner; but clerical errors arising from inadvertence, accident or mistake, on the part of the applicant or his attorney, and only discovered after the patent has been granted may not be corrected.

CERTIFIED COPY OF DESTROYED OR LOST PATENT.

59. If any patent is destroyed or lost, a certified copy thereof may be issued in lieu thereof upon the person who applies therefor paying the fees hereinbefore prescribed for office copies of documents. R.S., c. 61, s. 49; 53 V., c. 13, s. 4.

A certified copy to take the place of a destroyed or lost patent, should be composed of a copy of the deed or grant, covering a copy of the original specification (and drawings if there be any in the case) for which the Patent Office charges, under the tariff, a fee of \$4.00, plus 25c. for each sheet of drawing forming part of the original patent.

This certified copy of patent will bear the seal of the Patent Office, as provided for in the next following section of the Patent Act.

SEAL OF THE PATENT OFFICE TO BE EVIDENCE.

60. Every court, judge and person whosoever shall take notice of the seal of the Patent Office and shall receive the impressions thereof in evidence, in like manner as the impressions of the Great Seal are received in evidence, and shall also take notice of and receive in evidence, without further proof and without production of the originals, all copies or extracts certified under the seal of the Patent Office to be copies of or extracts from documents deposited in such office. R.S., c. 61, s. 50.

When a certified copy of a patent is required for any action at court, it is usual to order a complete copy of the patent, as issued. (See also preceding clause.)

**OFFICERS OF THE PATENT OFFICE NOT TO DEAL IN
PATENTS.**

61. No officer or employee of the Patent Office shall buy, sell or acquire or traffic in any invention or patent, or in any right to a patent; and every such purchase and sale, and every assignment or transfer thereof by or to any officer or employee, as aforesaid, shall be null and void, but this provision shall not apply to any original inventor, or to any acquisition by bequest. R.S., c. 61, s. 51.

RULES AND FORMS.

62. The Commissioner may, from time to time, subject to the approval of the Governor in Council, make such rules and regulations, and prescribe such forms, as appear to him necessary and expedient for the purposes of this Act, and notice thereof shall be given in the *Canada Gazette*; and all documents, executed in conformity with the same and accepted by the Commissioner, shall be held valid, so far as relates to proceedings in the Patent Office. R.S., c. 61, s. 52.

The revised and amended Rules and Forms of the Patent Office, approved by the Governor-General in Council, on the 23rd February 1904, are at present in force, and copies may be had gratuitously on application, by addressing the "Commissioner of Patents, Ottawa, Canada."

As regards proceedings not specially provided for in the Rules and Forms above mentioned, any other form being conformable to the letter and spirit of the law may be accepted, under authority of the Commissioner and if not conformable therewith will be returned for correction.

A copy of the Rules, with a particular paragraph marked, sent to any person making an inquiry, will be deemed a respectful answer, by the Patent Office.

**ANNUAL REPORT FOR PARLIAMENT AND THE CANADIAN
PATENT OFFICE RECORD.**

63. The Commissioner shall cause a report to be prepared annually and laid before Parliament of the Pro-

ceedings under this Act, and shall, from time to time, and at least once in each year, publish a list of all patents granted, and may with the approval of the Governor in Council, cause such specifications and drawings as are deemed of interest, or essential parts thereof, to be printed, from time to time, for distribution or sale. R.S., c. 61, s. 53.

Apart from the Commissioner's annual report to Parliament, the Patent Office publishes monthly "The Canadian Patent Office Record" containing the number, name of patentee, date of filing of the application, date of issue and the full claims of each patent, in addition to a print of at least one figure of the drawings. This publication may be obtained from the Patent Office at an annual subscription fee of \$2.00, payable in advance; or single monthly copies may be purchased at 20c. each.

This publication, with its annual indices, is to be found on the shelves of many of the Public Libraries of Great Britain, United States, Canada and other countries, where it may be consulted by inventors and others interested in inventions, and thus, in many cases, dispense with the necessity of applying to the Patent Office for information disclosed in that publication. A list of Public Libraries receiving this publication will be found on pages 433 to 440.

The Patent Record bears the date of the last day of each calendar month, and contains all patents granted in that month; but it usually takes from thirty to thirty-five days for printing and preparation for distribution; thus, for example, the January number would not be ready for mailing from the Patent Office until about the fifth of March following, and the same for each succeeding monthly number.

This information is offered to enable patentees and attorneys to arrive at a probable date when the Patent Record will reach certain foreign countries, where previous actual publication is a bar to the valid filing of an application for a corresponding patent.

OFFENCES AND PENALTIES.

PATENTED ARTICLES TO BE STAMPED OR MARKED.

PENALTY FOR DEFAULT.

64. Any patentee under this Act who sells or offers for sale any article patented under this Act not stamped or engraved with the year of the patent, applying to such article, or when from the nature of the article this cannot be done, not having affixed to it or every package wherein one or more of such articles is or are inclosed a label marked with the year of the date of the patent applying to such article in manner and form provided by this Act, shall be liable to a penalty not exceeding one hundred dollars, and, in default of the payment of such penalty, to imprisonment for a term not exceeding two months. R.S., c. 61, s. 54.

FALSELY MARKING AN ARTICLE AS PATENTED.

AN INDICTABLE OFFENCE.

65. Every person who,—

- (a) writes, paints, prints, moulds, casts, carves, engraves, stamps or otherwise marks upon anything made or sold by him, and for the sole making or selling of which he is not the patentee, the name or any imitation of the name of any patentee for the sole making or selling of such thing, without the consent of such patentee; or,
- (b) without the consent of the patentee, writes, paints, prints, moulds, casts, carves, engraves, stamps or otherwise marks upon anything not purchased from the patentee, the words, *Patent*, *Letters Patent*, *King's* or *Queen's Patent*, *Patented*, or any word or words of like import, with the intent of counterfeiting or imitating the stamp, mark, or device of the patentee, or of deceiving the public and inducing them to believe that the thing in question was made or sold by

or with the consent of the patentee or his legal representatives; or,

(c) offers for sale as patented any article not patented in Canada, for the purpose of deceiving the public; is guilty of an indictable offence, and liable to a fine not exceeding two hundred dollars, or to imprisonment for a term not exceeding three months, or to both. R.S., c. 61, s. 55.

MAKING CERTAIN FALSE ENTRIES ON COPIES AN INDICTABLE OFFENCE.

66. Every person who wilfully makes or causes to be made any false entry in any register or book, or any false or altered copy of any document relating to the purposes of this Act, or who produces or tenders any such false or altered document in evidence, knowing the same to be such, is guilty of an indictable offence and shall be liable to be punished by fine and imprisonment accordingly. R.S., c. 61, s. 56.

GENERAL.

OFFICE HOURS.

The Patent Office is open to the public every weekday, except on Saturday, between the hours of nine and five, and on Saturday between the hours of nine and one, except on legal holidays.

WHEN LEGAL HOLIDAYS INTERVENE.

Whenever the last day fixed by the Patent Act, or the Rules, for taking any action shall fall on a day when the Patent Office is not open, it is deemed to be lawful to do any such thing on the day following such excluded day, or days, if two or more of them occur consecutively.

MONEY PAID THROUGH ERROR.

Money paid into the Patent Office by actual mistake, such as a payment in excess, or when not required by law, will be refunded; but a mere change of purpose after the payment of money will not entitle the person who paid it to demand such a return.

PROTESTS.

The filing of a protest against the issuing of a patent shall not be taken in itself as sufficient reason to withhold the granting of such patent to an applicant. Under the present practice of the Patent Office, however, a protest, if it contains substantial grounds, is referred to the Examiner in charge of the class to which the invention appertains, and the same will receive consideration when the application involved is taken up for examination.

TELEGRAMS.

Telegrams involving searches, if not received before 4 o'clock p.m. at the Patent Office, may not ordinarily be answered until the following day. On Saturdays, not later than 12 o'clock.

All telegrams to the Patent Office must be prepaid by the sender, and if an answer is required, the message will be sent marked "Collect." To insure a reply, however, in all cases a person making an enquiry should add to his message the words "Answer paid."

ISSUE DAY.

Patents are dated and issued by the Patent Office on the Tuesdays of each week.

THE INTERNATIONAL CONVENTION.

The Dominion of Canada is not a member of the International Convention for the Protection of Industrial Property.

APPENDIX OF FORMS.

PETITIONS.

PETITION BY A SOLE INVENTOR.

(FORM 1)

To the Commissioner of Patents, Ottawa:

(a) Name, full address and calling of applicant.

The petition of (a).....

.....showeth: that he has invented new and useful improvements in

(b) Title of the invention.

(b).....

not known or used by others before his invention thereof, and not being in public use, or on sale, with his consent or allowance as such inventor for more than one year previous to his application for a patent therefor in Canada.

Your petitioner, therefore, prays that a patent may be granted to him for the said invention, as set forth in the specification in duplicate relating thereto, and for the purposes of the Patent Act, your petitioner elects his domicile

(c) Name of place and province in Canada.

in the (c).....

Place.....

Dated the.....day of.....19.....

(d) To be signed by the applicant.

(d).....

NOTE.—See instructions on pages 342, 349 and 350.

PETITION BY JOINT INVENTORS.

(FORM 2)

To the Commissioner of Patents, Ottawa:

The petition of (a)..... (a) Names, full addresses and calling of applicants.

..... showeth: that they have jointly invented a new and useful improvement in (b)..... (b) Title of invention.

not known or used by others before their invention thereof, and not being in public use, or on sale, with their consent or allowance as such inventors, for more than one year previous to their application for a patent therefor in Canada.

Your petitioners, therefore, pray that a patent may be granted to them jointly for the said invention, as set forth in the specification in duplicate relating thereto and for the purposes of the Patent Act, your petitioners elect their domicile in the (c)..... (c) Name of place and Province in Canada.

Place..... Dated the..... day of..... 19.....

(d)..... (d) To be signed by the applicants.

PETITION FOR A RE-ISSUE BY THE INVENTOR.
(FORM 4)

To the Commissioner of Patents, Ottawa:

The petition of (a)..... (a) Name,
full address
and calling
of applicant.

..... showeth:
that your petitioner obtained a patent hearing date the.....
day of..... A.D. 19..... for a new and useful improve-
ment in (b).....

(b) Title of
invention.

That the petitioner is advised that the said patent is
deemed defective, or inoperative, by reason of insufficient
description or specification, and that the errors arose from
inadvertence, accident or mistake, without any fraudulent
or deceptive intention.

Your petitioner, being desirous of obtaining a new patent
in accordance with the amended description and specifica-
tion in duplicate, therefore prays that he may be allowed
to surrender the aforesaid patent, and a new patent be
granted to him, in accordance with the amended descrip-
tion and specification of the said invention, for the unex-
pired period for which the original patent was granted.

Place.....

Dated this..... day of..... 19..... (c) To be
signed by
the paten-
tee.
(c).....

PETITION FOR A RE-ISSUE BY ASSIGNEE.

(FORM 5)

To the Commissioner of Patents, Ottawa:

(a) Name, full address and calling of assignee. The petition of (a).....

 showeth:

that your petitioner, by assignment bearing date the.....
 day of.....19.....obtained the

(b) Name, full address and calling of patentee. exclusive right to a patent granted to (b).....

 on the.....day of.....19.....

(c) Title of invention. for new and useful improvements in (c).....

That your petitioner is advised that the said patent is deemed defective or inoperative by reason of insufficient description or specification, and that the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention.

Your petitioner, being desirous of obtaining a new patent in accordance with an amended description and specification in duplicate, therefore prays that he may be allowed to surrender the aforesaid patent, and that a new patent be granted to him as assignee of the said (d).....

(d) Name of patentee.

in accordance with the amended description and specification of the said invention, for the unexpired period for which the original patent was granted.

Place.....

Dated this.....day of.....19.....

(e) To be signed by the applicant. (e).....

NOTE.—The above form is to be altered to suit the case when the application for the re-issue is made by the administrator or executor of a deceased patentee.

SURRENDER TO ACCOMPANY PETITION FOR RE-ISSUE.

(FORM 6)

To all to whom these presents shall come, (a).....

 within named,
 sends greeting:—

(a) Name, full address and calling of patentee.

Whereas the patent hereto attached, for a new and useful improvement in (b).....

(b) Title of invention.

is deemed defective, or inoperative, by reason of insufficient description, or specification, and the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention, and the Commissioner of Patents accordingly, in pursuance of the statute in such respects, hath agreed to accept the surrender of the same; now know ye, that the said (c).....
 within named, doth by these presents, surrender and yield up the hereto attached patent, granted to him for new and useful improvements in (d).....

(c) Name of patentee.

(d) Title of invention.

and bearing date the..... day of.....
 19.....

In witness whereof, the said (e).....
 hath set his hand
 and affixed his seal this..... day of.....
 A.D. 19.....

(e) Name of patentee.

(f)..... (L.S.)
 Signed, sealed and delivered at (g).....
 County of.....
 Province or State of.....
 in the presence of.

(f) To be signed by the patentee.

(g) Place where executed in full.

(h).....
 NOTE.—The above form is to be altered to suit the case when the surrender of the original patent is made by an assignee of the whole interest, or the administrator, or the executor of a deceased patentee.

(h) Signature of witness.

POWER OF ATTORNEY.

(FORM 7)

To the Commissioner of Patents, Ottawa:

(a) Name, full address and calling. The undersigned, (a).....

(b) Name and full address. hereby appoints (b).....

his attorney, with full powers of substitution and revocation, to prosecute an application for new and useful im-

(c) Title of invention. provements in (c).....

to make alterations and amendments therein, to sign drawings, to receive the patent, and to transact all business in the Patent Office connected therewith.

Signed at: (place).....

this.....day of.....19.....

(dd) To be signed by inventor and witness. (d)..... In presence of (d).....

REVOCATION OF POWER OF ATTORNEY.

(FORM 8)

To the Commissioner of Patents, Ottawa:

The undersigned (a)..... (a) Name, full address and calling.

having on or about the..... day of..... 19..... appointed (b).... (b) Name of attorney and full address.

his attorney to prosecute an application for a patent for a new and useful improvement in (c)..... (c) Title of invention.

hereby revokes the power of attorney then given.

Signed at (place).....

this..... day of..... 19....

(d)..... (dd) To be signed by inventor and witness.

In the presence of (d).....

SPECIFICATION.

(FORM 9)

FOR A MACHINE.

(Sole Inventor.)

To all whom it may concern:—

(a) Insert name, full address and calling.

Be it known that I (a).....

having invented certain new and useful improvements in

(b) Insert title of invention to be the same in all papers.

(b).....

(c) Insert the name of the country, number and date if foreign patent or patents has or have issued; if none omit the eight words preceding reference letter (c).

for which I have obtained a patent in (c).....

do hereby declare that the following is a full, clear and exact description of the same.

(d) Example, specification and claims.

(d) My invention relates to improvements in meat-chopping machines in which vertically-reciprocating knives operate in connection with a rotating chopping-block; and the objects of my improvement are, first, to provide a continuously-lubricated bearing for the block; second, to afford facilities for the proper adjustment of the knives independently of each other in respect to the face of the block; and, third, to reduce the friction of the reciprocating rod which carries the knives.

I attain these objects by the mechanism illustrated in the accompanying drawing, in which—

Figure 1 is a vertical section of the entire machine; Fig. 2, a top view of the machine as it appears after the removal of the chopping-block and knives; Fig. 3, a vertical section of a part of the machine on the line 1, 2, Fig. 2; and Fig. 4, a detailed view in perspective of the reciprocating cross-head and its knives.

Similar letters refer to similar parts throughout the several views.

The table or plate A, its legs or standards BB, and the hanger *a*, secured to the under side of the table, constitute the frame-work of the machine. In the hanger *a* turns the shaft D, carrying a fly-wheel E, a crank pin, on the hub of which is connected by a link *b* to a pin passing through a cross-head G, and to the latter is secured a rod H, having at its upper end a cross-head I, carrying the adjustable chopping knives *dd*, referred to hereinafter.

The cross-head G, reciprocated by the shaft D, is provided with anti-friction rollers *e e*, adapted to guides *ff*, secured to the under side of the table A, so that the reciprocation of this cross-head may be accompanied with as little friction as possible.

To the under side of a wooden chopping-block J is secured an annular rib *h* adapted to and bearing in an annular groove *i* in the table A. (See Figs. 1 and 2.) This annular groove or channel is not of the same depth throughout, but communicates at one or more points (two in the present instance) with the pockets or receptacles *j j*, deeper than the groove, and containing supplies of oil in contact with which the rib *h* rotates, so that the continuous lubrication of the groove and rib is assured. The rod H passes through and is guided by a central stand K, secured to the table A, and projecting through a central opening in the chopping-block without being in contact therewith, the upper portion of the said stand being contained within a cover *k*, which is secured to the block, and which prevents particles of meat from escaping through the central opening of the same.

The cross-head I, previously referred to, and shown in perspective in Fig. 4, is vertically adjustable on the rod H, and can be retained after adjustment by a set-screw x, the upper end of the rod being threaded for the reception of nuts, which resist the shocks imparted to the cross-head when the knives are brought into violent contact with the meat on the chopping-block.

The knives *d d* are adjustable independently of each other and of the said cross-head, so that the coincidence of the cutting-edge of each knife with the face of the chopping-block may always be assured.

I prefer to carry out this feature of my invention in the manner shown in Fig. 4, where it will be seen that two screw-rods *m m* rise vertically from the back of each knife and pass through lugs *n n* on the cross-head, each rod being furnished with two nuts, one above and the other below the lug through which it passes. The most accurate adjustment of the knives can be effected by the manipulation of these nuts.

A circular casing *p* is secured to the chopping-block, so as to form on the same a trough P for keeping the meat within proper bounds; and on the edge of the annular rib *h*, secured to the bottom of the block, are teeth for receiving those of pinion *q*, which may be driven by the shaft D through the medium of any suitable system of gearing, that shown in the drawing forming no part of my present invention.

This shaft D may be driven by a belt passing round the pulleys *s*, or it may be driven by hand from a shaft W, furnished at one end with a handle *i*, and at the other with a cogwheel R, gearing into a pinion on the said shaft D.

A platform T may be hinged, as at *w*, to one edge of the table A, to support a vessel in which the chopped meat can be deposited. The means by which it may be supported, and the most convenient method of disposing of it when not in use, are shown in Fig. 1.

I am aware that prior to my invention meat-chopping machines have been made with vertically-reciprocating knives operating in conjunction with rotating chopping-blocks. I therefore do not claim such a combination broadly; but

What I do claim as my invention, and desire to secure by letters patent, is—

1. The combination, in a meat-chopping machine, of a rotary chopping-block having an annular rib, with a table having an annular recess and a pocket communicating with the said recess, all substantially as set forth.

2. In a meat-chopping machine, the combination of a rotary chopping-block with a reciprocating cross-head carrying knives, each of which is vertically adjustable on the said cross-head independently of the other, substantially as described.

3. The knife *d*, having two screw-rods, *m m*, attached to its back, substantially as shown, for the purpose specified.

4. The combination, in a meat-chopping machine, of the reciprocating rod, carrying the knives, the cross-head secured to the said rod, and having anti-friction rollers, with guides, adapted to the said rollers, all substantially as set forth.

(e).....

(e) To be signed by the inventor

Place and date.....

Signed in the presence of.....

(f).....

(f) Signatures of two witnesses.

NOTE.—See instructions in regard to specifications on pages 351 and 352.

SPECIFICATION.

(FORM 10)

FOR AN ART OR PROCESS.

(Joint Inventors.)

To all whom it may concern:—

(a) Insert names, full addresses and calling.

Be it known that We, (a).....

(b) Insert title of invention, to be the same in all papers.

having jointly invented a certain new and useful process of (b).....

(c) Insert the name of the country, number and date of foreign patent or patents has or have issued; if none, omit the eight words preceding reference letter (c).

for which we have obtained a patent in (c).....

(d) Example, specification and claims.

do hereby declare that the following is a full, clear and exact description of the same.

(d) In the purification of hydrocarbon oils produced by the distillation of crude petroleum, asphalts, or bitumens, or by the destructive distillation of coal, resins, or bituminous sbales, the oils are agitated with 2 per cent. or more of concentrated sulphuric acid (60° Baumé, 1.86 specific gravity), in order to remove certain oils contained in the distillate which would, in course of time, absorb oxygen from the air, and cause the oil to become dark-coloured and gummy, and also to remove tarry substances and the disagreeable odour. Sulphuric acid combines chemically with these bodies and dissolves them, forming a dark-red, heavy liquid, which settles on the bottom of the agitator, and can then be readily drawn off from the purified oil. This peculiar compound of sulphuric acid and

hydrocarbon oils, dissolved in the excess of acid, is known as "sludge." At present it is purchased by superphosphate manufacturers, who mix it with a little water, which decomposes the compound of acid and oil, producing a weaker acid (about 50° Baumé) used in the manufacture of superphosphate of lime, and a dark-coloured offensive oil which rises to the surface of acid and usually is thrown away, no commercial use having been found for it. This waste product is called "sludge-oil."

The mode of practising our invention is as follows: In our process, when the sludge has been decomposed by the addition of water, the sludge oil is drawn off, and is then purified by repeated washings with water, until the acid remaining in it is removed. For this purpose equal volumes of water and sludge oil may be used; but the washing can be effected by a less quantity of water. The acid remaining in the oil, if any, is then neutralized with quicklime or caustic soda. The purified oil has a strong and somewhat disagreeable odour, and contains about 10 per cent. of volatile oils, which are converted into a hard resin with difficulty. To remove these volatile substances, the sludge oil thus purified is introduced into a still with the addition of from 2 to 4 per cent. of caustic soda and about 2 per cent. of the oxides of lead or manganese, to oxidize any sulphurous body which may be in the oil and combine with it, and steam is then blown through the oil, the oil being kept hot either by a fire under the still or by the use of steam heated to the required temperature (between 212 and 450° Fahrenheit). The action of the steam is continued until no more volatile oils are removed, usually from five to ten hours. The steam is then shut off, and the contents of the still allowed to settle, when a sediment of tarry impurities and soda subsides, from which the pure oil may be drawn off. The oil is then introduced into a still or tank, and oxidized by blowing currents of air through it, the oil being kept at a moderate temperature (from 200° to 300° Fahrenheit), either by a slow fire under the still, or by a steam coil in the bottom of the tank, or by heating the air by a hot-blast oven to the proper temperature before it is blown through the oil, and the action of the air is continued until complete oxidation is

effected, and a sample on cooling solidifies to a mors or less hard resin.

The time required to effect the oxidation varies with the working temperature and with the extent of surface of oil brought in contact with the air. We may define it as between four and twelve days. The action of the air upon the oil is stopped when samples on cooling, taken from the contents of the still, are found to be of the proper degree of hardness and toughness for the particular purpose to which the product is to be applied, and after letting the contents of the still settle the hot resin is drawn off from the sediment of soda and impurities.

The action of the air may be accelerated by adding other oxidizing agents—for example, about 2 per cent. of the oxides of lead or manganese, or about 2 per cent. of the manganates of soda and potassa to the oil. These substances act either by giving up oxygen to the oil or by their presence inducing a combination of the oxygen and the hydrocarbon.

An inferior quality of resin may be produced by treating the washed sludge oil in a still with caustic soda and litharge (5 per cent. soda to 1 to 2 per cent. litharge) and blowing a current of air through it at about the temperature of 350° Fahrenheit, which at the same time oxidizes the oil and removes the more volatile portions, which are distilled off until it is converted into a resin, which, on cooling, becomes hard and brittle. This process last mentioned requires from two to six days, but the resin produced is darker in colour than that made by first treating with steam and then with air at a lower temperature, as the colouring matter is not affected by the steam at 400°, while air at that temperature rapidly darkens it by oxidation. Sunlight bleaches the colour of sludge oil, and, at the same time, greatly accelerates the absorption of oxygen from the air. To produce the lightest-coloured resins the sludge oil is steamed with 5 per cent. of a solution of soda, 20° Baumé, at a low temperature (about 200° to 250° Fahrenheit for ten hours), to remove the more volatile portions, and then oxidized and bleached by exposing the oil, in shallow tanks covered by glass, to the action of the sunlight, the oil being kept hot and fluid by a steam coil

in the bottom of the tank, and currents of air blown through it to produce the oxidation.

Inferior qualities of sludge oil, as those produced in the purification of lubricating oils, and which contain a large quantity of tarry substances, are treated as follows: The oil is charged into a still, and caustic soda and black oxide of manganese, in the proportion of about 5 per cent. of soda and 2 per cent. of manganese, are added, and the charge distilled by a current of steam blown through the oil, assisted by a fire under the still, until only tar and coke remain behind. The distillation commences at about 350° Fahrenheit, and, the fire being increased, the temperature in the still gradually rises to about 800°, when only the thick pitch remains in the still.

By the use of steam under pressure the oil can be distilled with scarcely any decomposition, and the distillate, which is of a yellow light-red colour, can be converted into a superior resin by oxidizing it with a current of hot air. The resin produced by this oxidation of sludge oil is distinguished from all other known resins and resinous substances by its behaviour with different chemicals and solvents. It varies in colour from yellow to dark garnet red, according to the method of its production. It is hard, brittle, and odourless at ordinary temperatures, tasteless, insoluble, and not acted upon by water, soda, potassa, and ammonia, even when heated.

Alcohol of 95 per cent. dissolves but small quantities of this resin, even when boiled with it. Petroleum-naphtha dissolves it very quickly without the aid of heat, producing a varnish. Spirits of turpentine readily dissolves the melted resin, forming a varnish. Benzole, chloroform, and bisulphide of carbon all dissolve the resin, the solution being aided by warming. Ether and a mixture of ether and alcohol, in equal parts, quite readily dissolve it, but not so readily as pure ether. Linseed oil and olive oil dissolve the melted resin. A solution of the resin in linseed oil and spirits of turpentine forms an "oil varnish." Concentrated sulphuric acid dissolves it completely; the resin separates again on adding water. Nitric acid attacks it violently and converts it into a brown tarry or gummy substance, having a pleasant, peculiar odour. Hydrochloric acid seems to have little or no action on it.

It is well known that it has been proposed to use sludge oil as a paint oil, but this has not been attended with practical success. We do not wish to be understood, however, as making claim, broadly, to a process for freeing sludge oil from the acid by the use of water and caustic alkalis, or by still further purifying it by subjecting it to distillation, or by blowing steam through it, for the purpose of removing impurities, all of which, it is well known, have been practiced since the discovery of the present process of refining petroleum. Nor do we wish to be understood as laying claim in this application to the resinous substance produced by our process, as that forms the subject-matter of another application by us for letters patent.

We claim—

1. The process herein described for producing from sludge oil a resinous substance possessing the properties described, which consists in combining the oxygen of the air with the sludge oil with the aid of a moderate degree of heat.

2. The process of producing from sludge oil a substance of a resinous character, which consists in treating the sludge oil while heated to a moderate temperature, with the air and with other oxidizing agents, substantially as described.

3. The process of treating sludge oil in order to obtain from it a resinous substance, which consists in purifying such oil, distilling from it the volatile substances present therein, heating the residue to a temperature of from 200° to 300° Fahrenheit, and blowing air into it while it is so heated, substantially as described.

(e) To be signed by joint inventors.

(e).....

(Place and date)

Signed in presence of

(f) Signatures of two witnesses.

(f).....

NOTE.—See instructions in regard to specifications on pages 351 and 352.

SPECIFICATION.

(FORM 11)

FOR A COMPOSITION OF MATTER.

(Administrator.)

To all whom it may concern:—

Be it known that I, (a).....

(a) Insert name, full address and calling.

am the administrator of the estate of (b).....

(b) Insert name of deceased inventor and his late address and calling.

and that the said (c).....

(c) Name of deceased.

did invent a certain new and useful composition of matter to be used for (d).....

(d) Insert title of invention, to be the same in all papers.

for which I, or he the said (e).....

(e) Name of deceased inventor or administrator.

obtained a patent in (f).....

(f) Insert name of country, number and date of foreign patent or patents has or have issued; if none, omit the eleven words preceding the reference letter (f).

of which the following is a specification:

The composition of the said..... consists of the following ingredients, combined in the proportions stated, viz.:

Water substantially pure.....	500	gallons.
Unslacked lime.....	350	pounds.
Soda-ash (sodium carbonate).....	100	pounds.
Saltpeter (nitrate of an alkali metal).....	20	pounds.
Sulphur (preferable flowers of sulphur).....	10	pounds.

These ingredients are to be thoroughly mingled by agitation.

In using the above named composition the hides should first be freed from all salt and impurities, by soaking green hides one day and dry hides eight days. The hides so cleaned are then placed in the said solution, and allowed to remain in it forty-eight hours. They should then be removed from the solution and unhaired in the usual way.

By the use of the above composition the hair is speedily and thoroughly loosened, and the hides, while retaining all that portion of the substance which can be converted into leather, are at the same time entirely cleaned from grease and other substances which would prevent them from being tanned quickly.

I am aware that a composition consisting of soda-ash-water, lime, and sulphur has been used for the same purpose, and that a patent therefor was granted to (g).....

(g) Insert name of patentee, date and number of patent, if none, omit eight words preceding reference letter (g).

I am also aware that saltpeter has been used in depilatory processes; but I am not aware that all of the ingredients of my composition have been used together.

What I claim, and desire to secure by letters patent is—

1. The herein-described composition of matter, consisting of water, unslacked lime, soda-ash, saltpeter, and sulphur, substantially and for the purpose specified.

2. The herein-described composition of matter for depilating and preparing hides for tanning, consisting of pure water, five hundred gallons, unslacked lime three hundred and fifty pounds, soda-ash one hundred pounds, saltpeter twenty pounds, and flowers of sulphur ten pounds, substantially as described.

(h) To be signed by the administrator.

(h).....

(Place and date).....

(i) Signatures of two witnesses.

Signed in presence of (i).....

NOTE.—See instructions in regard to specifications on pages 351 and 352.

OATHS.

(FORM 12)

OATH BY SOLE INVENTOR.

Name of Country }
Province or State }
County }

I, (a)..... (a) Name, full address and calling.

make oath and say, that I verily believe that I am the inventor of the new and useful improvements in (b)..... (b) Title of invention to be the same in all papers.

described and claimed in the specification relating thereto, and for which I solicit a patent by my petition, dated the.....day of.....19..... (c) Insert the country or countries, giving the date and number of each patent. If not previously patented omit the five words preceding reference letter (c) and insert the words "in any country."

And I further say that the same has not been patented to me or to others with my knowledge or consent, except in the following countries (c)..... (d) To be signed by inventor.

And I further say that the several allegations contained in the said petition are respectively true and correct.

(d).....

Sworn before me at (place)..... the.....day of.....19.....

(e)..... (e) Signature of officer before whom oath is taken.

NOTE.—See instruction regarding oaths on pages 348 and 349.

OATH BY JOINT INVENTORS.

(FORM 13)

Country }
Province or State }
County }

(a) Names, full addresses and calling.

We, (a)

do hereby severally make oath and say:

(b) Name of first mentioned joint inventor.

1st. I, this deponent, (b).....

(c) Name of second mentioned joint inventor.

for myself do hereby make oath and say that I verily believe that I and the said (c)..... are the inventors of the new and useful improvement in

(d) Title of invention to be the same in all papers.

(d)..... described and claimed in the specification in duplicate relating thereto, for which we solicit a patent by our petition,

(e) Insert the country or countries, giving the date and number of each patent. If not previously patented, omit the five words preceding the reference letter (e) and insert the words "in any country."

tion, dated the.....day of.....19.... and I further say that the same has not been patented to us or to others with our knowledge or consent, except in the following countries (e).....

and I further say that the several allegations contained in the said petition are respectively true and correct.

2nd. I, this deponent, (f).....

(f) Name of second mentioned joint inventor.

.....for myself do here-

by make oath and say, that I verily helleve that I and the above named (g).....

(g) Name of first mentioned joint inventor.

are the inventors of the new and useful improvement in

(h).....

(h) Title of invention as giveo above.

described and claimed in the specification in duplicate, relating thereto, for which we solicit a patent by our pe-

tion dated..... the day of..... 19.....

and I further say that the same has not been patented to us or to others with our knowledge or consent, except in

the following countries (e).....

(e) Insert the country or countries, giving the date and number of each patent. If not previously patented, omit the five words preceding the reference letter (e) and insert the words "in any country."

and I further say that the several allegations contained in the said petition are respectively true and correct.

(i).....

(i) To be signed by joint inventors in the order mentioned.

Sworn before me, at (place).....

by the said (j).....

(j) Full names of joint inventors.

the..... day of..... 19.....

(k).....

(k) Signature of the officer before whom oath is taken.

NOTE.--See instructions regarding oaths on pages 348 and 349.

OATH FOR A RE-ISSUE BY INVENTOR.

(FORM 14)

Country }
Province or State }
County }

(a) Name and full address and calling.

I, (a).....

make oath and say that the several allegations contained in my petition, dated the.....day of19.....for a re-issue of the patent granted to me on the.....day of19.....for new and use-

(b) Title of invention.

ful improvements in (b).....

are respectively true and correct.

That I am the sole owner of the patent; and that I am the inventor of the improvement set forth and claimed in the amended specification in duplicate relating thereto.

(c) To be signed by the inventor.

(c).....

Sworn before me at (place).....

this.....day of.....19.....

(d) Signature of officer before whom the oath is taken.

(d).....

NOTE.—If the patent has not been exclusively assigned it must be stated in the oath that the application for the re-issue is made with the consent of the assignee or assignees.

OATH FOR A RE-ISSUE BY ASSIGNEE OF THE ENTIRE INTEREST.

(FORM 15)

Country
Province or State
County }

I, (a)..... (a) Name, full address and calling.

make oath and say that the several allegations contained in my petition, dated the.....day of.....19.....for the re-

issue of the patent granted to (b)..... (b) Name, full address and calling of the original patentee.

for new and useful improvements in (c)..... (c) Title of invention to be the same in all papers.

are respectively true and correct.

That I am the sole owner of the said patent; and that

(d)..... (d) Name of original patentee. was the inventor of the improvements set forth and claimed in the amended specification in duplicate relating thereto.

(e)..... (e) To be signed by the applicant. Sworn before me at (place).....the.....day of

.....19..... (f) Signature of the officer before whom the oath is taken. (f)



MICROCOPY RESOLUTION TEST CHART

(ANSI and ISO TEST CHART No. 2)



APPLIED IMAGE Inc

14, 3 East Main Street
Rochester, New York 14609 USA
(716) 482 - 0300 - Phone
(716) 288 - 5989 - Fax

PETITION FOR A CAVEAT.

(FORM 16)

To the Commissioner of Patents, Ottawa:

(a) Name, full address and calling.

The undersigned, (a).....

an intending applicant for a patent, who has made certain

(b) Title of invention.

new and useful improvements in (b).....

and has not perfected his invention, prays that his specifi-

(c) A description of the invention, as far as possible, should follow and refer to letters of reference in drawings.

cation may be filed as a caveat in the Patent Office (c)

(d) To be signed by the inventor.

(d).....

NOTE.—See instructions regarding caveats on pages 390 and 391.

OATH FOR CAVEAT.

(Form 17)

Country }
Province or State }
County }

I, (a)..... (a) Full name, address and calling.

make oath and say that I am the inventor of the invention described in the foregoing specification, and that the allegations contained therein are respectively true and correct.

(b)..... (b) To be signed by the inventor.

Sworn before me at (place).....

the.....day of

.....19.....

(c)..... (c) Signature of the officer before whom oath is taken.

Assignments.

ASSIGNMENT OF AN ENTIRE INTEREST (OR AN UNDIVIDED ONE-HALF INTEREST IN AN INVENTION BEFORE THE ISSUE OF PATENT).

(FORM 18)

In consideration of.....dollars, to me paid by (a)..... (a) Full name of assignee, address and calling.

I do hereby sell and assign to (b).....all (or an undivided half of all) my right, title and interest in and to my invention for new and useful improvements in (c)..... (b) Name only of assignee.

as fully set forth and described in the specification which I have signed preparatory to obtaining a patent; and I do hereby authorize and request the Commissioner of Patents, to issue the said patent to the said (d)..... (c) Insert same title of invention as in the papers for application for patent.

(or jointly to myself and the said) (d).....in accordance with this assignment. Witness my hand and seal this..... day of.....19.....at (e)..... (dd) Name only of assignee.

(e) Place where executed.

(f) To be signed by the inventor. (f).....(L.S.)

NOTE.—See instructions regarding assignments on pages 370, 371 and 372.

ASSIGNMENT OF AN ENTIRE INTEREST IN A PATENT.

(FORM 19)

In consideration of..... dollars, to me paid by (a)

(a) Full name and address of assignee and calling.

I do hereby sell and assign to the said (b)..... all my right, title and interest in and to the Patent of Canada number (c)..... for new and useful improvements in.....

(b) Name only of assignee.

(c) Insert number of patent, title of invention same as in patent and date.

granted to me on the..... day of..... 19..... the same to be held by and enjo by the said (d)

(d) Name only of assignee.

..... to the full end of the term for which said patent is granted, as fully and entirely as the same could have been held and enjoyed by me if this assignment and sale had not been made.

Witness my hand and seal this..... day of..... 19..... at (e).....

(e) Place where executed.

(f)..... (L.S.)

(f) To be signed by the patentee.

1 .E.—See instructions regarding assignments on pages 370, 371 and 372.

DISCLAIMER.
(FORM 20)

(a) Full name, address of patentee and calling.

I, (a).....
.....
.....
.....

having on the day of
19.....obtained a patent for the Dominion of Canada, for
certain new and useful improvements in (b).....

(b) Insert same title of invention as in original patent.

.....
and through mistake, accident or inadvertence, without any wilful intent to defraud or mislead the public, I have made the claim in my specification too broad (or as being the inventor of a material or substantial part of the invention patented of which I was not the inventor, and to which I had no legal right); I, therefore, hereby disclaim the part of the claim in the specification, which is in the following words:

"I also claim the use of the lever A, in combination with crank D, as described."

(c) To be signed by the patentee.

(c).....
(Place).....
The..... day of
..... 19.....

Signed in duplicate in presence of

(d) Signatures of two witnesses.

(d).....
.....

APPENDIX.

CANADIAN PATENT OFFICE PRACTICE.

LIST OF LIBRARIES RECEIVING THE CANADIAN PATENT OFFICE RECORD; ARRANGED ALPHABETICALLY ACCORDING TO COUNTRIES.

(See page 400).

AUSTRALIA.

The Australasian Institute of Patent Agents, Melbourne.
The Parliamentary Library, Melbourne.
The Department of Patents, Melbourne.
Public Library of Victoria, Melbourne.
Public Library, Perth.
The Registrar of Patents, Perth.
The Patent Office, Sydney.
Public Library, Sydney.
The Registrar of Patents, Tasmania.

AUSTRIA.

Imperial Patent Office, Vienna.

BELGIUM.

Musée Commercial.
Monsieur le Directeur Général de l'Industrie, Brussels.

CANADA.

Province of Alberta:—

Public Library, Calgary.
Provincial Library, Edmonton.

Province of British Columbia:—

Public Library, Vancouver.
The Legislative Library, Victoria.
Public Library, New Westminster.

Province of Manitoba:—

The Legislative Library, Winnipeg.
Public Library, Winnipeg.

Province of New Brunswick:—

Public Library, Fredericton.
The Public Library, St. John.

Province of Nova Scotia:—

The N.S. Institute of Science, Halifax.
The Legislative Library, Halifax.

Province of Ontario:—

Mechanics' Institute, Baden.
The Public Library, Belleville.
The Public Library, Berlin.
The Mechanics' Institute, Chatham.
The Public Library, Clinton.
The Public Library, Cohourg.
The Public Library, Drayton.
The Mechanics' Institute, Fergus.
The Public Library, Fort Francis.
The Mechanics' Institute, Galt.
The Mechanics' Institute, Gananoque.
The Mechanics' Institute, Glencoe.
The Mechanics' Institute, Gravenhurst.
The Public Library, Guelph.
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The Library, School of Mining, Kingston.
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Lancaster Public Library, Lancaster.
The Public Library, London.
The Mechanics' Institute, Midland.
The Public Library, Niagara Falls.
The Mechanics' Institute, Orillia.
The Mechanics' Institute, Oshawa.
The Archives, Ottawa.
The Carnegie Library, Ottawa.
The Parliamentary Library, Ottawa.
The Patent Office, Ottawa.
The Mechanics' Institute, Owen Sound.
The Mechanics' Institute, Penetanguishene.
The Mechanics' Institute, Peterborough.
The Public Library, Port Perry.
The Public Library, Sarnia.
The Public Library, Smith's Falls.
The Mechanics' Institute, Strathroy.
The Public Library, St. Mary's.
De LaSalle Normal School College, Toronto.
The Library, School of Practical Science, Toronto.
The Parliamentary Library, Toronto.

Province of Ontario—Continued.

The Public Library, Toronto.
The Public Library, Uxbridge.
The Public Library, Waubauskene.
The Mechanic Institute, Whithy.
The Public Library, Windsor.
The Public Library, Woodstock.

Province of Saskatchewan:—

The Public Library, Regina.
Public Library, Moose Jaw.
Public Library, Saskatoon.

Province of Quebec:—

Pettes' Memorial Library, Knowlton.
Antiquarian Society, Château de Ramezay Museum,
Montreal.
Chambre de Commerce Francaise, Montreal.
The Fraser Institute, Montreal.
The Macdonald College Library, Macdonald College, P.Q.
The Library, McGill University, Montreal.
The Mechanics' Institute, Montreal.
The Montreal Bar Association, Montreal.
The Parliamentary Library, Quebec.
Arts and Library Association, Sberbrooke.
The Public Library, Westmount.

ENGLAND.

The Reference Free Library, Birmingham.
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City Library, Bristol.
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Free Library, Beverley.
Free Library, Carlisle.
Free Library, Chester.
Public Library, Cornwall.
Free Library, Crewe.
Free Library, Darlington.
Free Library, Dorchester.
Free Library, Falmouth.
Free Library, Gateshead.
Free Library, Grimsby.
Free Library, Hanley.

England—Continued.

Free Lihrary, Mechanics' Institute, Halifax.
Free Lihrary, Hereford.
Public Lihrary and Art Gallery, Huddersfield.
Free Lihrary, Hull.
Free Lihrary and Museum, Ipswich.
Free Lihrary, Keighley.
Free Lihrary, Kidderminster.
The Mechanics' Institute, Lancaster.
Free Lihrary, Leeds.
Public Free Lihrary, Liverpool.
Board of Trade, London.
Free Library, British Museum, London.
Free Library, Society of Arts, London.
The Patent Office, London.
Royal Colonial Institute, London.
Free Lihrary, Maidstone.
Free Lihrary, Manchester.
The Mechanics' Institute, Newark.
Literary and Philosophical Society, Newcastle-upon-Tyne.
Public Lihrary, Newport.
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Free Lihrary, Nottingham.
Free Lihrary, Oldham.
Free Lihrary, Oxford.
The Mechanics' Institute, Plymouth.
The Institution, Avenham, Preston.
Board of Health Offices, Rotherham.
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Free Lihrary, Sheffield.
Public Museum, Shrewshury.
Corporation Lihrary, Southampton.
Free Lihrary, Stockport.
Free Lihrary, Sunderland.
Public Lihrary, Swansea, Wales.
Public Lihrary, Taunton.
Free Lihrary, Wigan.
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Science and Technical School, Wolverhampton.
Artillery Institute, Woolwich.
Lower Council Chamher, York.

FRANCE.

Académie des Sciences, Paris.
Conservatoire des Arts et Métiers, Paris.
Bibliothèque Nationale, Paris.

GERMANY.

Bibliothek der Königlichen Technischen Hochschule,
Aachen.
Polytechnische Schule, Aix-la-Chapelle.
Der Director der Herzoglichen Bibliothek, Gotha.
Polytechnische Schule, Hanover.
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IRELAND.

The Queen's College, Belfast.
Royal Dublin Society, Dublin.
Free Library, Dundalk.
Free Library, Waterford.
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ITALY.

Ministero de Agricoltura, Industria e Comercio, Rome.
President, International Institute of Agriculture, Rome.

JAPAN.

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Trades Library, Montrose.
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SOUTH AMERICA.

Argentine Republic:—

M. le Secrétaire d'Etat, Buenos-Ayres.
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Department de Engcnieros Civiles, Buenos Ayres.

SPAIN.

M. le Secrétaire d'Etat, Madrid.

SWEDEN.

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UNITED STATES OF AMERICA.

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Mechanics' Institute, San Francisco.

Colorado:—

State Library, Denver.

Dakota:—

The Library, Department of Emigration and Statistics.
Bismark.

Illinois:—

The John Crerar Library, Chicago.
The Newberry Library, Chicago.
The Public Library, Chicago.

*United States of America—Continued.**Indiana:—*

Morrison-Reeves Library, Richmond.
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The Public Library, Boston.

Michigan:—

The Public Library, Detroit.

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New Hampshire:—

Hillside Library, Manchester.

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State Library, Albany.
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Grosvenor Public Library, Buffalo.
Cornell University Library, Ithaca.
The New York Public Library, New York.

Ohio:—

The Public Library, Cincinnati.
Cleveland Public Library, Cleveland.

Pennsylvania:—

Franklin Institute, Philadelphia.
The Free Library of Philadelphia, Philadelphia.
Philadelphia Library Company, Philadelphia.
The Carnegie Library, State College.
Carnegie Library, Pittsburg.

United States of America—Continued.

Vermont:—

Fletcher Free Library, Burlington.

Wisconsin:—

The State Historical Society of Wisconsin, Madison.
Library of University of Wisconsin, Madison.

Washington, D.C.:—

The Catholic University, Washington, D.C.
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The United States Patent Office Library, Washington,
D.C.

WEST INDIES.

The Hon. Colonial Secretary, Antigua.
The Public Library, Barbadoes.
The Honourable Colonial Secretary, Jamaica.

INDEX TO APPENDIX.

	PAGE
Abandonment of application for patent.....	346
Abstracts from Register of Assignments.....	372
Acting Deputy Minister of Agriculture may act as Deputy Commissioner of Patents (Sec. 5, Sub- sec. 2).....	339
Amendments to specification and claims.....	352
Annual report to Parliament.....	399
Appeal to Deputy Commissioner from Examiner's decision.....	356
Appeal to Governor-General in Council (Sec. 19)	359
Appeal to Exchequer Court from Commissioner's decision.....	359
Appeal from judgment declaring a patent void (Sec. 37).....	376
Application for patent, What constitutes a com- plete.....	342
Application for patent, Incomplete.....	344
Application for patent restricted to one invention unless connected.....	344
Application for patent contains more than one invention, If.....	344
Application for patent presented without fee.....	345
Application for patent receives filing date under certain conditions.....	345
Application for patent may be re-instated.....	346
Applicant responsible for his allegations.....	339
Applicant responsible for delay in transmission of application.....	347
Applicant not aided in selection of an Attorney..	340
Applicant recommended to employ skilled Attorney	340
Applicant cannot be assisted by the Patent Office in preparing his application.....	340
Applicant refused preliminary searches by Patent Office.....	340
Applicant notified when Commissioner objects to grant patent (Section 18).....	359
Applicant dies while application for patent is pending, If.....	343

INDEX TO APPENDIX—*Continued.*

	PAGE
Applicant dies before making application for patent, If.....	343
Applicant's personal appearance unnecessary.....	340
Arbitration procedure.....	360-363
Assignments (Sections 26, 27, and 28).....	369-372
Assignment before issue of patent.....	370
Assignment must give Assignee's place of residence	370
Assignment after issue of patent.....	370
Assignment under certain conditions returned to sender, Original.....	371
Assignment, or other instrument referring to two or more patents.....	371
Assignment presented for registration relating to expired patent.....	371
Assignment containing errors discovered after registration.....	371
Assignment without date of execution.....	371
Assignment responsible for its validity, Person filing	372
Assignment may be drawn in either the French or English language.....	371
Assignment to be accompanied with a copy.....	370
Assignments furnished, Abstract from Register of	372
Assignment of Caveat refused registration.....	391
Attorney, Powers of.....	341
Attorneys, No registration of.....	340
Attorney recommended by the Patent Office, Skilled.....	340
Attorneys, Patent Office declines aid in selection of	340
Attorney's power may be revoked at any time and substitute appointed.....	341
Caveat (Section 46).....	389
Caveat, Documents required for filing a.....	390
Caveat will be refused, Registration of assignment of	391
Caveat recommended, Filing of drawings of.....	390
Caveat, Filing of a second.....	391
Caveat not confined to resident of Canada, Filing of a	390
Caveat fee.....	391
Claims in an application for patent, how drawn..	352
Claims, Third copy of.....	350
Clerical errors (Section 58).....	397

INDEX TO APPENDIX—*Continued.*

	PAGE
Commissioner of Patents, Minister of Agriculture shall be the (Section 3).....	338
Commissioner, Duties of (Section 4).....	338
Communications to Patent Office, how addressed..	339
Companies may apply for Patents.....	343
Compulsory License System (Section 44).....	383
Compulsory License System, Rules when enforcing	386-388
Conflicting applications for patent (Section 20)..	360
Copies of Office documents.....	393
Copies of drawings.....	393
Corporations may apply for Patents.....	343
Copy of lost or destroyed patent (Section 59)....	398
Correspondence, how conducted.....	339
Correspondence carried on with Applicant or Attorney.....	339
Deputy Commissioner, Deputy Minister of Agriculture shall be (Section 5).....	339
Deputy Commissioner given same power as the Commissioner (Section 5).....	339
Disclaimers (Section 25).....	368
Divisional applications.....	344
Documents for an application for patent, how prepared.....	342
Domicile in Canada by applicant for patent, Election of (Section 11).....	349
Drawings required for an application for patent, Number and kind of.....	353-355
Drawings recommended for caveat.....	390
Duration of patent (Section 23).....	364
Examination of applications for patent (Section 15)..	356
Exchequer Court, Reference to (Section 45).....	388
Exchequer Court has jurisdiction in cases of conflicting applications.....	363
Exchequer Court has jurisdiction in cases of appeal from Commissioner's decision.....	359
Extensions already granted for manufacture or importation, Validity of (Section 41).....	380
Extracts from granted patents may be made by the public.....	397
Expiry of foreign patents does not affect Canadian patents.....	348

INDEX TO APPENDIX—*Continued.*

	PAGE
Expounding the Law by Patent Office refused...	340
Falsely marking an article as patented (Section 65)	401
False entries are indictable offence (Section 66)..	402
Fees, Patent Office tariff of (Section 47).....	391
Fees, how paid.....	392
Fee payable on an application for re-issue of patent	368
Fee for recording an assignment.....	370, 371
Fee payable on filing a caveat.....	391
Fee payable on a disclaimer.....	369
Fee for registration of judgment <i>pro tanto</i>	372
Fees for office copies.....	393, 394, 398
Fees quoted before ordering copies, if desired....	393
Fees deposited by Patent Office, to credit of Minister of Finance (Section 50).....	394
Fees, Refund of (Section 51).....	394
Fees in tariff in full for all services by Patent Office (Section 49).....	394
Filing date of application for patent, Conditions for	345
Foreign patent has been issued, When (Section 8)	346
Foreign patent has issued time for filing Canadian patent cannot be extended, When.....	347
Foreign patent does not affect Canadian patent, Expiry of.....	348
Foreign vessels, Use of patented invention in (Section 53).....	395
Government may use patented invention (Section 52).....	395
Holidays intervene, When legal.....	402
Impeachment and other legal proceedings in respect to patents (Section 29).....	372
Impeachment of patent, Proceedings for (Section 34)	374
Importation and manufacture of patented invention (Section 38).....	376
Importation may be extended, Term for (Section 40)	379
Importation, When patent is under Section 44, Sub-section "b" remains in force as to	385
Improvements may be patented (Section 9).....	348
Injunction and appeal (Section 32).....	373
Inquiries as to patented inventions.....	340
Insane inventor, Application for patent for.....	343, 349

INDEX TO APPENDIX—*Continued.*

	PAGE
Inspection of documents by the public (Section 56)	396
International Convention.....	403
Interpretation of law refused by Patent Office...	340
Invention defined (Section 2).....	338
Inventor dies before applying for patent, If.....	343
Inventor dies after filing application for patent, If	
Interviews with examiners permitted.....	343
Judgment voiding a patent to be filed in the	
Patent Office (Section 36).....	357
Judgment <i>pro tanto</i> , Registration of.....	376
Legal holidays intervene, When.....	372
Legal representatives defined (Section 2).....	402
License system, Compulsory (Section 44).....	338
Libraries receiving Patent Office Record.....	383
Manufacture and Importation of patented in-	
ventions (Section 38).....	433
Manufacture may be extended, Term for (Section 39)	376
Marking of Patented Article.....	377
Medical compounds.....	396
Miscellaneous cases, how decided.....	343
Models and specimens dispensed with, except in	
special cases.....	341
Models of patented inventions, Sale of (Sec. 57).	356
Money paid through error.....	397
Notice of intention to apply for patent.....	402
Novelty of invention elsewhere as in Canada....	347
Oath for application for patent by inventor, joint	
inventors, administrator, executor, or guardian	
of insane person (Section 10).....	344
Oath should be taken, Before whom.....	348
Oath executed more than three months not accepted	348
Oath by joint inventors may be subscribed at	349
different places.....	349
Offences and penalties (Section 64).....	401
Office hours.....	402
Officers and clerks of the Patent Office appointed	
by Order-in-Council (Section 5).....	339
Officers and clerks of the Patent Office not to deal	
in patents (Section 61).....	399
Parliament, Special Act of.....	366
Partial fees, Payment of.....	365

INDEX TO APPENDIX—*Continued.*

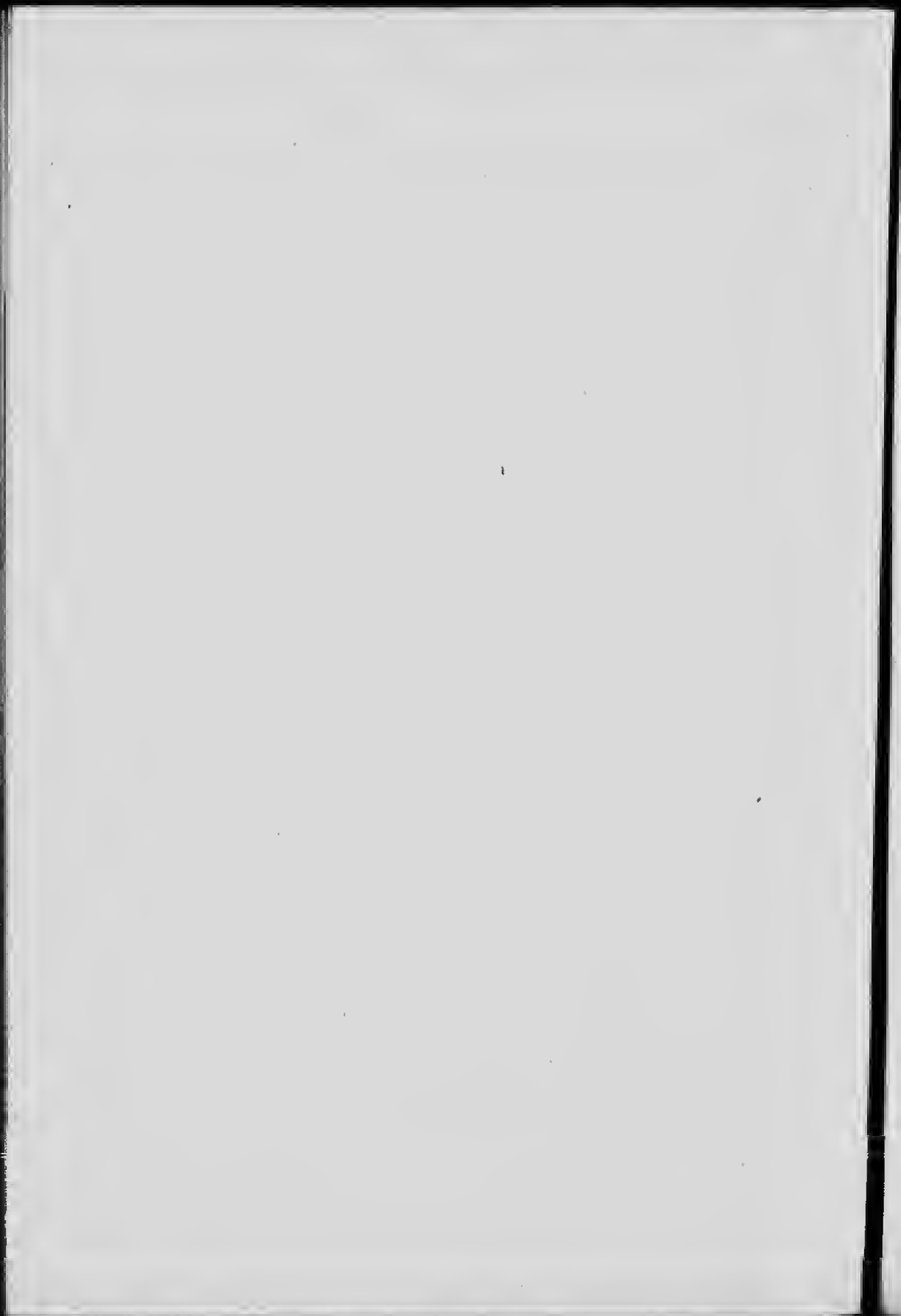
	PAGE
Patent Office attached to the Department of Agriculture (Section 3).....	338
Patent, Who may obtain a (Section 7).....	341
Patents are dated and issued, When.....	403
Patent shall contain and confer, What a (Section 21).....	363
Patent, Form of issue of (Section 22).....	364
Patent Office tariff of fees (Section 47).....	391
Patent, Payment of second or third term of.....	365
Patents are not printed.....	393
Patent not to affect a previous purchaser (Section 54).....	396
Patent, Duration of.....	364
Patent Office Record, Canadian.....	400
Patent in certain cases, Revocation of.....	375
Patented, What may not be.....	343
Patented article to be stamped or marked (Section 55).....	396
Penalty for default in not marking patented inventions (Section 64).....	401
Pending applications not open to the public.....	396
Personal appearance of inventor not required unless called by Commissioner.....	340
Postage free to and from Patent Office within Canada.....	339
Postal service, Delay through fault of.....	346
Powers of Attorney.....	341
Power of Attorney should not be included in petition for patent.....	350
Power of Attorney cannot be used for any subsequent action after patent has issued.....	341, 385
Power of Attorney may be revoked at any time.....	341
Preliminary searches not made by Patent Office..	340
Protests against issue of patents.....	403
Prosecution of Application to save it from abandonment.....	353
Publications by the Patent Office.....	399
Public inspection of Patent Office records.....	396
Record, Patent Office.....	400
Refund of fees (Section 51).....	394
Refusal to grant patents (Section 17).....	357

INDEX TO APPENDIX—*Continued.*

	PAGE
Re-issue of patents (Section 24).....	366
Renewal fees, Payment of Partial or.....	365, 366
Revival of fallen applications for patents.....	346
Revocation of Patent in certain cases.....	375
Rights of third persons (Section 43).....	382
Rules and forms of Patent Office.....	399
Rules for guidance under Compulsory License system.....	386
Seal of Patent Office (Sections 22, 35 and 60).....	364, 374, 398
Specification shall show, What.....	350
Stop orders.....	345
Telegrams.....	403
Title of inventions (Section 12).....	350
Trade mark registration in some cases recom- mended.....	343
Validity of certain patents granted before August 13, 1903 (Section 42).....	381
Withdrawal of application for patent (Section 16).....	357
Working.....	376, 379

INDEX TO FORMS IN APPENDIX.

Petition by sole inventor.....	404
By joint inventor.....	405
By administrator or executor.....	406
For re-issue by inventor.....	407
For re-issue by assignee.....	408
For caveat.....	428
Surrender to accompany petition for re-issue.....	409
Power of Attorney.....	410
Power of Attorney, Revocation of.....	411
Specification for a machine, sole inventor.....	412
For an art or process, joint inventor.....	416
For a composition of matter by administrator.....	421
Oath by sole inventor.....	423
By joint inventors.....	424
For re-issue by inventor.....	426
For re-issue by assignee of entire interest.....	427
For caveat.....	429
Assignment before issue of patent.....	430
After issue of patent.....	431
Disclaimer after patent.....	432



INDEX.

- ABANDONMENT,**
may result from actual or constructive dedication, 55
before patent applied for, 56
conduct from which inferred, 56
at time of application, 56
general rule; anything not claimed, presumed to be
abandoned, 57
general rule may be rebutted, 57
not presumed from failure to claim which can be cured
on re-issue, 57
by withdrawal or failure to prosecute application,
58, 87, 346
by public use or placing on sale. See *Public use or on
sale*
particulars of objection, 212
- ABSTRACTS,**
from Register of assignments, 372
- ACCOUNT.** See *Damages or Account.*
- ACQUIESCENCE,**
effect of laches in action for infringement, 233
on application for interlocutory injunction, 216
- ACT OF PARLIAMENT,**
special, 366
- ACTION,**
for infringement. See *Infringement; and Practice in
Infringement Cases.*
to restrain threats. See *Threats of Legal Proceedings.*
- AGGREGATIONS.** See *Combinations.*
- AGREEMENT,**
to assign. See *Assignments; Forms.*
- AMBIGUITY,**
in specification. See *Specifications.*

AMENDMENTS,

- to application, 86, 352
- rules respecting, 332

ANALOGOUS USE,

- application of old contrivance to, 10

ANTICIPATION. See Novelty.**APPEALS,**

- from Examiner to Commissioner, 92
- from Commissioner to Exchequer Court on refusal to grant patent, 92

APPLICATION,

- for patent, 72
- must be made within one year of grant of foreign patent. See *Foreign Patents*, 67, 303
- conditions, to entitle applicant to patent. See *Subject Matter*.
- formal documents and drawings required, 72
- formal documents and drawings, statutory provisions as to, 305-6
- patent void if material allegations untrue, 72, 312
- petition, domicile elected in, 72
- oath, must set out foreign patents, 73
 - who must make, 73, 303, 304
 - must be made within three months of filing, 73
 - effect of false oath, criminal law, 73
- petition, title or name of invention, 74, 305
- misleading or deceptive title may render patent void, 74
- title, fancy or trade names not permitted, 74
- specification. See *Specification*.
- drawings, rules with respect to, 84
 - misleading, 85
 - obvious error in, 85
 - to be read with specification, 86
- models, need be furnished only when required, 86
- examination, 86, 306
- amendments, 86, 332, 352
- communications from patent office must be replied to within one year, 87
- authorization to withdraw, 87

APPLICATION—Continued.

- conflicting, statute with respect to, 307
- conflicting or interfering, rules with respect to, 87
- appointment of arbitrators, 87
- fees of arbitrators, 89
- decision of arbitrators final, 89
- reference to Exchequer Court, 89
- procedure before arbitration board, 89
- division of, 90, 329
- refusal. See *Refusal to Grant Patents.*
- registration of assignment of invention, 112
- where inventor dead, 113
- joint, 309
- legal representatives may make, 304
- withdrawal of, 306
- rules as to prosecution of, 328
- information as to pending, 330
- incomplete, 344
- what constitutes complete, 342
- presented without fee, 345
- when filing date given, 345
- abandonment, 58, 87, 346

ARBITRATION,

- in case of conflicting applications. See *Application.*

ARGENTINE,

- patent law in, 246

ART,

- synonymous with process, 19, 20
- mechanical process, 21
- how far manufacturing provisions applicable to process,
144
- using or selling product of patented process is infringement,
185

ASSIGNMENT,

- statutory provisions, 113, 311, 312
- registration, 113, 117
- rules as to, 331, 369, 372
- formal requirements, 371, 372
- of right to a patent, 113

ASSIGNMENT—Continued.

section 27, copied from U.S. Act, 116
right to assign recognized by patent, 116
distinguished from license, 116, 122
need not be under seal, 117
must be in writing, 117
registration not necessary as between parties, 117
effect of notice in U.S.A., 118
 Canada, 118
 England, 118
equitable rights, 118
agreement to assign, 119
assignee takes subject to licenses of which he has
 notice, 119
rights of assignee, 120
mortgage in England, 120
 U.S.A., 120
 Canada, 120
assignor cannot manufacture, 120
 cannot set up invalidity of patent, 120
assignee cannot set up invalidity of patent, 121
of exclusive right to invention implies warranty, 121
invalidity may be set up where fraud exists, 121
invalidity may be set up where express warranty or
 covenant, 121
assignor may show what patent good for, 122
of improvements, 122
may be in either French or English, 371
abstract of register furnished, 372
of caveats not registered, 391
form. See *Forms*, 270

ATTACHMENT,

for breach of injunction, 226

ATTORNEY GENERAL,

fiat of, necessary for *sci. fa.*, 201

AUSTRALIA,

patent l.w in, 247

AUSTRIA,

patent law in, 243

- BELGIUM,**
patent law in, 243
- BILLS OR NOTES GIVEN FOR PATENT RIGHTS, 236**
statutory provisions require words "Given for a Patent Right" written or printed across face, 236, 237, 238
- BRAZIL,**
patent law in, 246
- BREACH,**
of injunction, 226
- BREACHES,**
particulars of. See *Practice in Infringement Cases.*
- BURDEN OF PROOF.** See *Practice in Infringement Cases.*
- BUSINESS SYSTEMS, 24**
- CARRIERS,**
of infringing articles may be restrained, 189
- CAVEAT, 158, 389, 391**
statutory provisions, 158, 320
purposes of, 159
renewal, 159
procedure, 160
assignment of, 160
fees, 160
Patent Office rules as to, 329
- CLAIMS.** See *Specification.*
- CLERICAL ERROR,**
correction of, 323, 397
- COMBINATION,**
defined, 13
if producing a new result or known result in new way,
patentable, 13
elements may be old, 13
may be separately claimed, 14
omission, addition, or substitution of element, 14
distinguished from aggregation, 15
claims to combinations, 81
infringement of patent for. See *Infringement.*

- COMBINES INVESTIGATION ACT, 4
- COMMERCIAL SUCCESS,
as evidence of invention, 18
- COMMISSIONER OF PATENTS,
statutory provisions, 302
duties of, 302
Minister of Agriculture to be, 302
Deputy, 302
Acting Deputy, 303
- COMMITTAL FOR BREACH OF INJUNCTION, 226
- COMMON KNOWLEDGE,
objection on grounds of, 211
- COMMON LAW,
no property in invention at, 1
- COMMUNICATIONS,
to patent office, how addressed, 339
- COMPANIES OR CORPORATIONS,
may apply for patent as assignees, 343
sequestration for breach of injunction, 227
- COMPOSITION OF MATTER, 24
- COMPULSORY LICENSES,
statutory provisions, 131
what patents may be placed under Sec. 44, 154
procedure to obtain, 154
rules with respect to, 332-86-88
- CONFLICTING APPLICATIONS. See *Application for Patent.*
- CONVEYANCING. See *Forms.*
- CO-OWNERS,
grant creates joint tenancy, 114
joint tenancy may be severed, 114
rights of, 115
change of English law by Act of 1907, 115
- COPIES OF OFFICE DOCUMENTS, 393

- CORRESPONDENCE,**
with Patent Office carried on free of charge in Canada,
327
- COSTS,**
as between solicitor and client on proceedings arising
from breach of injunction, 227
in infringement actions, 234
- COUNTY COURT,**
jurisdiction of, 203
- CROWN,**
right to use patented invention, 189
- CUBA,**
patent law in, 247
- DAMAGES OR ACCOUNT,**
alternative remedies, 227
plaintiff only entitled to account of actual profits, 228
plaintiff only entitled to profits attributable to paten-
ted invention, 229
plaintiff must show actual damages, 229
measure of damages, 229, 230
particulars on enquiry, 232
- DEATH,**
application where inventor dead, 73, 114, 304
of applicant during prosecution of application, 343
- DECEASED INVENTOR.** *See Death.*
- DELIVERY UP,**
of infringing articles, 232
- DESTRUCTION,**
of infringing articles, 232
- DEFENCE,**
statement of, form of, 252
- DELAY,**
effect of in bringing action for infringement, 233
on application for interlocutory injunction, 216

DENMARK,

patent law in, 244

DEVOLUTION. See *Assignment*.**DISCLAIMER,**

statutory provisions, 108, 310, 311

necessity for doubtful, Sec. 33, 109

must not change character of invention, 110

effect of delay, 111

effect of, 1

portion claimed must be distinguishable, 111

right of assignee to disclaim, 111

procedure, 112

fees on, 112

form of, 432

DISCOVERY. See *Practice in Infringement Cases*.

"discovered" not found in Canadian Act, 7

every discovery not necessarily invention, 7, 8

DIVISION OF APPLICATION. See *Application*.**DOCUMENTS,**

for an application for patent, how prepared, 342

See also *Application for Patent*.**DOMICILE OF INVENTOR,**

to be stated on application, 305

DRAWINGS,see *Application*.

rules as to, 329

DUPLICATE OF LOST PATENT, 324**DURATION OF PATENT,** 309**EMPLOYER AND EMPLOYEE,** 27, 130**EQUITABLE ASSIGNMENT.** See *Assignment*.**EQUITABLE RIGHTS.** See *Assignment*.**EQUIVALENTS.** See *Infringement; Subject Matter*.**ERROR.** See *Clerical Error*.**ESTOPPEL,**

assignor cannot set up invalidity of patent, 119

ESTOPPEL—Continued.

- assignee cannot set up invalidity of patent, 121
- assignor may show what patent good for, 122
- of licensee, 125
- licensee may set up invalidity where fraud exists, 125
- licensee may show that acts are not covered by patent, 125
- licensee may dispute validity of patent after termination of license, 126
- license arising from, 130b

EVIDENCE,

- of invention, 18
- what necessary to prove prior knowledge of invention, 48
- in action for infringement. See *Infringement; Practice in Infringement Cases.*
- expert, 223

EXAMINATION. See *Application for Patent.*

EXCHEQUER COURT,

- reference of conflicting applications to, 89, 319
- appeal from Commissioner's refusal to grant patent, 92
- rules relating to, 334a
- no jurisdiction to restrain threats of legal proceedings, 192
- jurisdiction in matter of impeachment, 194
- form of writ of *scire facias* in, 202
- See *Practice in Infringement Cases.*

EXPERIMENT,

- unsuccessful does not anticipate, 39
- manufacture for, does not infringe, 184
- use by way of, is not public use within section 38, 62

EXPERT EVIDENCE, 168, 170, 223

EXPIRY,

- of foreign patent does not affect Canadian patent, 71

FALSIFICATION,

- of documents and registers, 326

FEES,

- for application, 320

FEES—Continued.

- of arbitrators, 89
- on reissue, 107, 321
- on disclaimer, 112, 321
- for caveat, 160, 321
- refund on withdrawal, 322
- for copies of drawings, 321
- tariff of, 320
- transmission of, to patent office, 328

FILING DATE,

- of application, conditions for obtaining, 345

FOREIGN PATENTS,

- effect of on Canadian applications, 67, 303
- history of section 8, 67, 68
- Canadian patent must be applied for within one year from issue of, 67
- holder must comply with section 7, 69
- notice of intention to apply for Canadian patent, 70
- British patent is a foreign patent, 70
- expiry of foreign patent does not now affect Canadian patent, 71
- particulars of objection, 214

FOREIGN PATENT LAW, 239

- International Convention, 239
- date of publication of Canadian patents, 240
- United States, 241
- Great Britain, 242
- France, 242
- Germany, 243
- Austria, 243
- Hungary, 243
- Belgium, 243
- Denmark, 244
- Italy, 244
- Norway, 244
- Sweden, 244
- Portugal, 244
- Russia, 245
- Spain, 245

FOREIGN PATENT LAW—Continued.

- Switzerland, 245
- Turkey, 245
- Mexico, 245
- Argentine Republic, 246
- Brazil 246
- India, 246
- Japan, 246
- South Africa, 246
- Australia, 247
- New Zealand, 247
- Cuba, 247
- when foreign applications should be filed, 247
- provisional protection, 248
- patents of addition, 248
- marking patented articles, 248

FOREIGN SHIP OR VESSEL,
use of patented invention on, 190, 322**FORFEITURE,**
for importation or failure to manufacture. See *Importation; Manufacture; Impeachment.*

- FORMS,**
- statutory provisions, 324
 - in Patent Office, when not specially provided, 327
 - Exchequer Court,
 - statement of claim, 249
 - particulars of breaches, 251
 - statement of defence, 252
 - particulars of objections, 254
 - summons for interim injunction, 258
 - order granting interim injunction, 258
 - summons for further particulars, 260
 - order for further particulars, 261
 - order for inspection and particulars, 264
 - judgment for injunction, delivery up, account, etc., 266
 - judgment dismissing action and disclaiming patent invalid, 268
 - conveyancing,
 - assignment of patent with improvements, 270

FORMS—Continued.

- assignment of half share with division of profits, 272
- assignment of half share with provisions for working independently, 275
- assignment of patent for district, 277
- license, 280
- exclusive license for a district, 284
- mortgage of a patent, 289
- license to use patented machine, 293
- assignment of license, 295
- agreement with workman to perfect invention, 297
- agreement between joint inventors, 298

FORMS IN PATENT OFFICE,

- petition by sole inventor, 404
 - by joint inventors, 405
 - by administrator or executor, 406
 - for reissue by inventor, 407
 - for reissue by assignee, 408
 - for caveat, 428
- surrender to accompany petition for reissue, 409
- Power of Attorney, 410
 - revocation of, 411
- specification for a machine, sole inventor, 412
 - for an art or process, joint inventors, 416
 - for a composition of matter by administrator, 421
- oath by sole inventor, 423
 - by joint inventors, 424
 - for reissue by inventor, 426
 - for reissue by assignee of entire interest, 427
 - for caveat, 429
- assignment before issue of patent, 430
- assignment after issue of patent, 431
- disclaimer after patent, 432

FRANCE,

- Patent Law in, 242

GERMANY,

- Patent Law in, 243

GOVERNMENT,

- right of Government of Canada to use patented invention, 189

- GRANT,
in England, basis Royal prerogative, 2
in Canada, basis statutory, 2
form, 166
- GREAT BRITAIN,
Patent Law in, 242
- HOLIDAYS,
legal, effect of intervening, 402
- HUNGARY,
Patent Law in, 243
- IMPEACHMENT, 193, 314
jurisdiction of Courts, 193-4-5
jurisdiction of Courts to impeach for importation and
failure to manufacture, 195
scire facias, writ of, 196, 314
causes for, arising under Sec. 29, 196
false declaration, 196-7
failure to set out foreign patents, 197
misleading specification, 198
ambiguity or unnecessary detail in specification, 199
involuntary error, 199
Sec. 29 as applied to claims, 200
procedure in Exchequer Court, 201
Provincial Courts, 201
consent of Attorney-General necessary to *scire facias*
proceedings, 201
security for costs, 202
form of writ of *scire facias* in Exchequer Court, 202
- IMPLIED LICENSE. See *License*.
- IMPORTATION OF PATENTED ARTICLE, 131-46
statutory provisions, 131, 315
extension of term for, 132, 33
trifling, 147
of parts or ingredients, 148
infringement test, 149
of product or patented process, 152
only affects interest of person importing, 152
connivance equivalent to, 152

IMPORTATION OF PATENTED ARTICLE—Continued.

- extension of time for, 153, 316
- impeachment for, 195
- particulars of objection, 214

IMPORTER,

- not inventor under Canadian statute, 29

IMPROVEMENTS,

- on patented inventions, 26, 304
- suggested by workman, 27
- improver must have license of original patentee, 27
- assignment of, 122

INDIA,

- Patent Law in, 246

INFRINGEMENT,

- action for, statutory provisions, 313-4
- articles made or used prior to the issuing of a patent, 161
- injunction to restrain. See *Practice in Infringement Cases.*
- section 21 provides for exclusive grant, 166
- patent grants exclusive right, 166
- Canadian patent, unlike British, contains no prohibition, 167
- Canadian and English law same, 168
- mixed question of law and fact, 168
- construction of patent, 168
- patent protects only what is claimed, 169
- no such thing as infringement of equity of patent, 169
- infringer must take substance of invention, state of art must be known, 170
- relative importance of parts is matter of evidence, 170
- two classes of inventions, 171
- method of application of new principle, 171
- where new application of old principle, 172
- of both classes invention governed by same principle, 172
- rule in *Curtis v. Platt*, 173
- rule in *Proctor v. Bennis*, 173
- similar rule to that of *Proctor v. Bennis* in United States, 175

INFRINGEMENT—Continued.

- "colourable," 175
- doctrine of equivalents, 177
- American statement of doctrine of equivalents, 178
- patent covers only known equivalents, 178
- of patent for combination, 179-2
 - law same as in England, U.S. and Canada, 199
- of patent for combination
 - taking separate integers does not infringe, 179
 - variations, 179
 - additions, 180
 - subtraction, 180
 - substitution, 180
- no duty on patentee to warn infringers, 182
- knowledge or ignorance of patent immaterial, 183
- failure to mark does not affect right to recover for infringement, 183
- injunction justified by evidence of intention, 183
- any infringement evidence of intention to continue, 184
- taking out a patent for something that infringes is not infringement, 184
- granting licenses not infringement, 184
- one who puts in practice infringes, 184
- both employer and workman liable, 184
- manufacture for experiment only does not infringe, 184
- using or selling product of patented process is infringement, 185
- onus on patentee to show articles made by patented process, 185
- doctrine of contributory infringement in U.S.A., 185
 - no such doctrine in England or Canada, 186
- sale of all parts adapted to be put together, 187
- if one claim infringed, 187
- purchaser may repair but not rebuild, 188
- purchase, possession or transport where no intention to use, 188
- innocent carriers may be restrained, 189
- giving order to make, infringes, 189
- agreement to be executed outside of country does not constitute, 189
- right of Crown to use patented invention, 189
- use on foreign ship, 190
- practice. See *Practice in Infringement Cases.*

INJUNCTION,

evidence of intention to infringe justifies, 183
any infringement is evidence of intention to continue,
184

interlocutory. See *Practice in Infringement Cases.*
when granted, 225

stay of pending appeal, 226

terminates with patent, 226

committal or attachment for breach of, 226

sequestration, 227

costs as between solicitor and client, 227

breach of undertaking, 227

INQUIRIES,

at Patent Office as to patented invention, 340

INSANE,

inventor as applicant for patent, 343, 349

INSPECTION. See *Practice in Infringement Cases.*
by public, of documents in Patent Office, 323

INSUFFICIENCY,

of specification. See *Specification.*

INTERFERENCE. See *Application for Patent.*

INTERNATIONAL CONVENTION, 239

INTERVIEWS,

with examiners in Patent Office, 357

INVENTION. See *Subject Matter.*

INVENTOR,

master and servant, 27

joint inventors, 28

importer not considered, 29

See *Application for Patent; Subject Matter.*

ITALY,

Patent Law in, 244

JOINT OWNERSHIP. See *Co-owners.*

applicants. See *Application.*

JAPAN,

Patent Law in, 246

- JUDGMENT,**
for injunction, delivery up, account, etc., 266
dismissing action and declaring patent invalid, form, 268
- JURISDICTION.** See *Practice in Infringement Cases.*
- JURY,**
trial by, 221
- KNOWLEDGE OR USE.** See *Novelty.*
- LACHES,**
a bar to interlocutory injunction, 216
in applying for reissue, 58, 104
in bringing action, 233
- LEGAL REPRESENTATIVES,** 114, 304
- LEGISLATION,**
history of, 1
- LIBRARIES,**
receiving Patent Office Record, 433
- LICENSE,**
distinguished from assignment, 116, 122
agreement to, 123
must be in writing, 123
need not be registered, 123
licensee cannot grant sub-licenses unless intention to
allow him to do so expressed, 123
licensee may alter patented invention, 124
covenant to pay renewal fees, 124
when revocable, 124
licensee may not dispute validity of patent, 125
royalties where patent invalid, 125
validity of patent may be questioned where fraud ex-
ists, 125
licensee may show that acts are not covered by patent,
126
licensee may dispute validity of patent after termina-
tion of license, 126
general, limited exclusive, 126
restrictive agreements, 127
purchaser from holder limited, 127
exclusive, exclude patentee, 127

LICENSE—Continued.

exclusive and irrevocable, may be assignment, 128
right of licensee to sue, 128
effect of recording, 129
implied, 129
implied on sale, 129
implied to repair, 129
implied on sale in foreign country, 130
implied on dissolution of partnership, 130
implied in favour of employer, 130a
arising from estoppel, 130b

LICENSE FORMS,

general, 280
exclusive for district, 284
to use patented machine, 293

LOST PATENT,

certified copy of, 324

MACHINE, 19, 22**MANUFACTURE, 19, 22**

of articles prior to the issue of patent, 161
statutory provisions, as to working, 131
history of, 133, 315
term for, may be extended, 132
law in Great Britain, 137
no obligation in U.S.A., 138
decisions of Commissioner under Act before amended,
139
patentee must manufacture whether demand exists or
not, 140
patentee need not manufacture personally, 140
patentee must provide facilities to continue to, 140
invention must be wholly manufactured in Canada, 141
patentee must sell outright, 141
onus on party attacking patent to show refusal to sell,
142
obligation to sell does not prevent agreement imposing
conditions, 142
restrictions must be imposed at time of sale, 142
how far restrictions applicable to third parties, 143

MANUFACTURE—Continued.

- patentee must sell at reasonable prices, 144
- how far section applicable to process patent, 144
- patentee must protect himself against failure of licenses to manufacture, 146
- extension of time for, 153
- impeachment for failure to, 195
- failure to, particulars of objection, 213

MARKING PATENTED ARTICLES,

- statutory provisions, 163, 323-25
- penalty for failure, 164
- failure to mark does not affect right to recover damages, 164
- counterfeiting, 325
- falsely, 325

MASTER AND SERVANT, 27, 130, 130a**MECHANICAL EQUIVALENTS, 177****MECHANICAL SKILL,**

- not invention, 16
- substitution of one well-known material for another, 17

MEDICAL COMPOUNDS, 25, 343**MEXICO,**

- Patent Law in, 245

MODELS,

- need be furnished on application only when required, 86
- rules respecting, 327
- as showing anticipation, 44-5-6
- statutory provisions, 306

MONOPOLIES,

- Statute of, 1

MORTGAGE. See Assignment.

- of patent, form, 289

NEW ZEALAND,

- Patent Law in, 247

NEW USE,

- of known contrivance, 10

NORWAY,

Patent Law in, 244

NOTE GIVEN FOR A PATENT RIGHT. See *Bills or Notes Given for Patent Right.*

NOTICE,

of intention to apply for patent, 70, 347

of objection to grant patent, 92

warning infringers, unnecessary, 82

of equitable rights, 118

assignee takes, subject to licenses of which he has, 119

NOVELTY,

invention perfectly conceived probably anticipates, 47

English cases must be used with care, 48

evidence necessary to prove prior knowledge, 48

U.S. rules as to burden of proof where anticipation is set up, 49

want of particulars of objection, 210

idea in practical form though imperfect anticipates, 40

prior knowledge at any time defeats patent, 40

United States principles as to when an invention has been perfected so as to amount to anticipation, 41

how far United States principles likely to be adopted, 46

applicant must be first inventor anywhere, 30

what required, 35

prior invention known to inventor, 35

anticipation a question of fact, 38

something which cannot be reproduced no anticipation, 39

anticipatory idea must be capable of practical application, 39

unsuccessful experiments do not anticipate, 39

OATH. See *Application.*

OATH FORM,

for sole inventor, 423

for joint inventors, 424

for reissue by inventor, 426

for reissue by assignee, 427

for caveat, 429

- OFFENCES,**
for failure to mark or falsely marking, 163, 164, 323,
325
- ONUS OF PROOF.** See *Practice in Infringement Cases.*
- ORDER,**
granting interim injunction, form, 258
for further particulars, form, 261
for inspection and particulars, form, 264
- PARLIAMENT,**
special act of, 366
- PARTICULARS.** See *Practice in Infringement Cases.*
on enquiry as to damages or account, 232
of breaches, form for, 251
of objection, form of, 254
- "PATENT APPLIED FOR,"**
marking, 163
- PATENT MEDICINES,** 25, 343
- PATENT OFFICE,**
statutory provisions, 302
officers of, 303
not to deal in patents, 324
Record, Canadian, 400
rules, 327
- PENALTIES.** See *Offences.*
- PETITION.** See *Application.*
forms of,
to place patent under Compulsory License Clause,
299
for extension of time within which to import, 300
for extension of time within which to manufacture,
301
for patent for sole inventor, 404
for joint inventors, 405
for administrator or executor, 406
reissue by inventor, 407
assignee, 408
caveat, 428

PLEADINGS IN ACTION FOR INFRINGEMENT.
See Practice in Infringement Cases.

PORTUGAL,

patent Law in, 244

POSTAGE,

free, to and from Patent Office within Canada, 339

POWER OF ATTORNEY,

to prosecute application, 72, 391

may be revoked and substitute appointed, 341

form, 410

revocation of, form, 411

PRACTICE IN INFRINGEMENT CASES,

jurisdiction of Exchequer Court and Provincial Courts,
 203

jurisdiction as between Provincial Courts, 203

venue, 204

extent to which judgment binding in other actions, 204

particulars,

Exchequer Court rules, 205

Provincial Courts, 206

evidence coming under terms of, admitted, 207

when further particulars ordered, 207

plaintiff must give particulars of breaches, 208

greater particularity required where defendant ven-
 dor, 209

particulars of objections, 209

of want of subject matter, 209

subject matter not invented by patentee, 209

want of novelty, 210

common public knowledge, 211

specific anticipations, 212

claims affected must be specified, 212

want of utility, 212

abandonment, 212

public use or sale for more than year, 212

defective specifications, 213

misleading specifications, 213

failure to manufacture, 213

importation, 214

PRACTICE IN INFRINGEMENT CASES—*Continued.*

- existence of foreign patent for more than year, 214
- prior publication, 214
- prior user, 214
- discovery, 218
 - questions as to evidence may be allowed, 218
 - private affairs, disclosure of, 219
 - privileged communications, 220
- inspection, 220
 - samples may be ordered to be furnished, 221
- jury, 221
- onus of proof, 222
 - of patent, 222
 - of title, 222
 - of specification, 222
 - of infringement, 222
 - of defective specification, 223
 - of wilful omission or addition, 224
 - of novelty, 224
 - of utility, 225
- interlocutory injunctions,
 - evidence required, 214
 - circumstances must create a presumption of validity, 215
 - acquiescence or delay, 216
 - must be *prima facie* case of actual or threatened infringement, 216
 - balance of convenience, 217
 - undertaking to keep account, 217
 - as to damages, 217
- injunctions, when granted, 225
 - stay of, pending appeal, 226
 - terminates with patent, 226
 - committal or attachment for breach, 226
 - sequestration, 227
 - costs as between solicitor and client, 227
 - breach of undertaking, 227
- right to begin, 222
- damages. See *Damages or Account.*
- delivery up or destruction, 232
- delay in bringing action, 233
- acquiescence in infringement, 233
- costs, 234

- PRESUMPTION OF VALIDITY,**
patent *prima facie* evidence, 215
- PRINCIPLE,**
abstract not invention, 8
practical application may constitute invention, 8
old principle applied in new way, 10
- PRIOR KNOWLEDGE.** See *Novelty*.
- PRIVILEGED COMMUNICATIONS.** See *Practice in Infringement Cases*, 220
- PROCESS.** See *Art*.
- PROFITS.** See *Damages or Account*.
- PROTEST,**
against filing application, 329
- PUBLIC USE OR SALE, 55, 59**
invention must not have been in use or on sale for longer than one year anywhere, 60
no abandonment by use or sale within year, 60
to create abandonment must be public, 61
secret use probably does not prejudice right to patent, 61
use in hidden place may be, 62
for experimental purposes, 62
with consent or allowance of inventor, 64
surreptitious use, 66
particulars of objection, 212
- PUBLIC KNOWLEDGE,**
particulars of objection, 211
- PUBLICATION.** See *Refusal to Grant Patent*.
prior, particulars of objection, 214
date of, Canadian patents, 240
- PURCHASER,**
previous, rights of, 161, 322
- REASONABLE PRICE,**
patentee must sell at, 144

REFUSAL TO GRANT PATENTS, 91

statutory provisions, as to Sec. 17 and 18, 91

objections to application, 92

appeal from examiner, 92

to Commissioner, 92

to Exchequer Court, 92

functions of Commissioner probably ministerial, 93

causes for, 94

invention not patentable in law, 94

invention in possession of public no novelty, 94

invention described in book or printed publication,
94

already patented in Canada, 96

already patented in foreign country and year not
expired, 96

REGISTRATION. See *Assignment.*

effect of registering license, 127

REISSUE, 98

statutory provisions, 98

comparison U.S. statute, 100

discretionary power of Commissioner, 101

only after surrender of old patent, 102

inadvertence or mistake, 102

must be for same invention, 103

delay in applying for, 104

two year rule in U.S.A., 104

procedure on application for, 107

fees for, 107

Patent Office rules with respect to, 330

REPAIR,

right to. See *Infringement.*

REVIVAL OF FALLEN APPLICATIONS FOR PATENTS, 346**REVOCATION,**

under Combines Investigation Act, 4

RIGHT TO BEGIN, 222

RULES OF THE CANADIAN PATENT OFFICE,

correspondence, 327
forms not specially provided, 327
models, 327
transmission of fees, 328
prosecution of applications, 328
division of application, 329
protests, 329
caveats, 329
drawings, 329
reissues, 330
pending applications, information as to, 330
transactions to be in writing, 331
assignments, registration, 331
right to amend, 332
amendments, 332
compulsory licenses, 332

RUSSIA,

Patent Laws in, 245

SALE,

constructive abandonment by being on sale for one
year with consent of inventor, 63
actual sale not necessary, 63
a single sale sufficient, 63
for experimental purposes, 64
with consent or allowance of inventor, 64

SCIRE FACIAS,

writ of. See *Impeachment*.
right to bring, 222

SEAL OF PATENT OFFICE,

evidence of, 324

SECURITY,

for costs. See *Impeachment*.

SEQUESTRATION,

for breach of injunction, 227

SERVANT. See *Master and Servant*.**SHIP,**

right to use patented inventions on, 190

SOUTH AFRICA,

Patent Law in, 246

SPAIN,

Patent Law in, 245

SPECIFICATION, 75

requirements of statute, 75, 305

similar English and U.S.A., 75

functions of, 75

sufficiency, 76

to whom addressed, 76

may assume knowledge common to trade, 77, 78

must not leave anything new to be found out, 77

technical error in, 78

details where shape, size, etc., is material, 78

misleading, addition or omission wilfully made, 78

must set out contrivances and things claimed as new, 79

claims, 79

requirements of U.S. statute compared, 80

purpose of claims, 80

claims to be read with specification, 80

construction of, 81

too wide in language bad, 81

claim of principle alone had, 81

combination claims, 81, 82

reference from one claim to another, 83

British form allowed, 83

construction, 83, 84

amendments, 86

defective or misleading, particulars of objection, 213

form, for a machine, sole inventor, 412

for an art or process, joint inventors, 416

for a composition of matter by administrator, 421

STATEMENT OF CLAIM,

form, 249

STATEMENT OF DEFENCE,

form of, 252

STATUTE OF MONOPOLIES, 1

STATUTES,

- history Canadian Legislation, 2-5
- The Combines Investigation Act, 4
- The Bills of Exchange Act, 5
- Canadian Patent Act, R.S. c. 61, 302

STOP ORDERS,

- on patent applications, 345

SUBJECT MATTER,

- statutory provisions, 6, 303
- requirements of Section 7, 6
- section 7 copies from U.S. Act of 1836, 7
- invention defined, 7
- every discovery not necessarily invention, 8
- abstract principle not invention, 8
- practical application of principle may constitute invention, 8
- application of old contrivance to analogous use, 10
- old principle applied in new way, 10
- combinations, 12
- elements of combination may be separately claimed, 14
- mechanical skill not invention, 16
- substitution of one well known material for another, 17
- change of form or shape, 18
- simplicity not evidence of want of invention, 18
- commercial success as evidence of invention, 18
- operative success as evidence of invention, 19
- invention may be result of accident, 19
- invention must be art, machine, manufacture or composition of matter, 19
- art, 20
- mechanical process, 21
- machine, 22
- manufacture, 22
- composition of matter, 24
- business systems, 24
- systems of lettering, 25
- forms of contract, 25
- patent medicines, 25
- improvements on patented inventions, 26
- particulars of objection, subject matter not invented by patentee, 209

- SUMMONS,
for interim injunction, form, 258
for further particulars, form, 260
- SURRENDER FORM. TO ACCOMPANY REISSUE, 409
- SWEDEN,
Patent Law in, 244
- SWITZERLAND,
Patent Law in, 245
- TELEGRAMS,
to Patent Office, 403
- TENANCY,
in common. See *Co-owners*.
- THREATS OF LEGAL PROCEEDINGS,
British Statute, 191
law in Canada, 191
Exchequer Court has no jurisdiction to restrain, 192
- TITLE,
or name of invention. See *Application*.
- TRIAL. See *Practice in Infringement Cases*.
- TURKEY,
Patent Law in, 245
- UNITED STATES,
Patent Law (summary), 241
- UNPATENTABLE INVENTION. See *Subject Matter*.
- USER,
prior, particulars of objection, 214
- UTILITY, 50
no statutory requirement in England, 50
meaning of "useful" in Canadian Act, 51
In U.S.A., 51
useful for what? 52
misleading statements in specifications as to utility, 53
inventions having "illicit" objects, 53
inoperative inventions, 54
particulars of objection, want of, 212

VALIDITY OF PATENT,
prima facie, 214

VENUE, 204

VESSEL,
right to use patented inventions on, 190

WARRANTY,
none implied from assignment of patent, 120
implied from assignment of exclusive right, 120

WORKING,
patent. See *Manufacture*.

