THE PATENT OFFICE EXAMINING STAFF MAGAZINE

MARCH 1970

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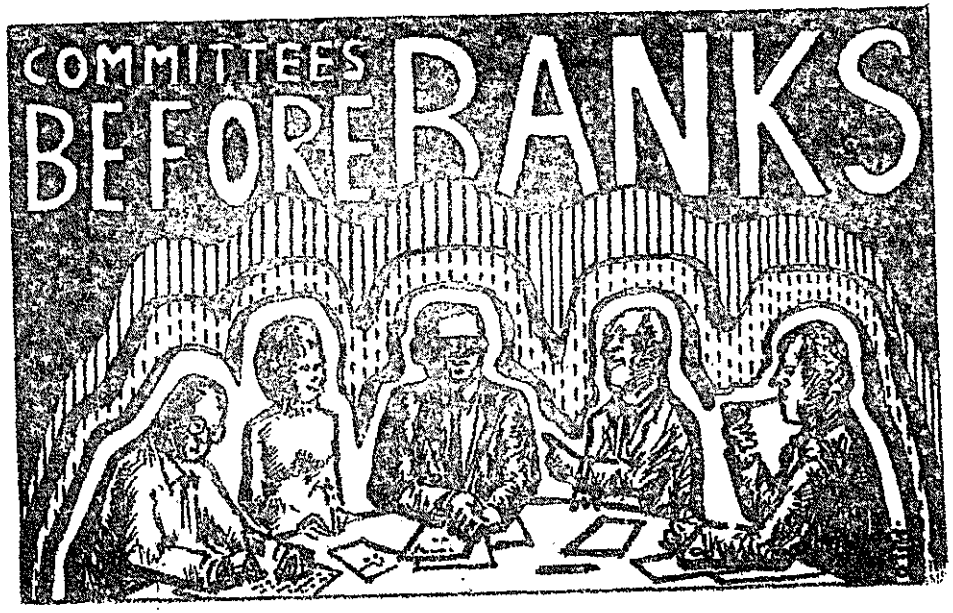

by H.W. Clarke, O.B.E.

Patents for inventions are a very ancient institution. The first recorded instance occurred in 1449, when Henry VI granted a patent to "John of Utynam" for making coloured glass for the windows of Eton College. Grants were made by the Sovereign as a purely personal act and in return for payment to him. The Sovereign possessed absolute powers and quickly realised that he was on a good thing. He certainly needed no Committee to advise him about that!

This simple and arbitrary method of increasing the Sovereign's pocket money led to the grant of patents, not only for new inventions, but also for sundry other privileges which the Sovereign equally had power to confer, such as the exclusive right to manufacture and sell certain commodities. These rights were of considerable value to their holders, some of whom abused the position by charging excessive prices for their goods. But despotic power was in decline, and in

1610 public outcry compelled James I to issue a declaration that he would only grant patents for "projects of new invention, so that they be not contrary to the law nor mischievous to the State, by raising prices of commodities at home, or generally inconvenient". Fourteen years later, in 1624, the Statute of Monopolies was enacted, Section 6 of which, broadly speaking, provided that patents should only be granted in respect of inventions which constituted a manner of new manufacture within the Realm. It is interesting to observe that Section 101 of the current Acts defines "invention" as meaning "any manner of new manufacture the subject of letters patent and grant of privilege within Section 6 of the Statute of Monopolies", whilst Section 102 preserves the Royal Prerogative to grant or to refuse the grant of a patent in any specific instance. Until recent years, this latter Section was, in fact, invoked to refuse the grant of patents for contraceptives.

The Statute of Monopolies was the first Act of Parliament enacted to control the grant of patents, and for the next 200 years the system jogged along in a manner more or less in keeping with the times. The Law Officers reported upon petitions for patents and advised the Crown and the Lord Chancellor whether patents should be granted. The procedure was cumbrous and expensive, but in the earlier part of the period the number of patentable inventions was relatively small and at least the system represented an improvement on the one that had preceded it. But as the industrial age came into being and the number of inventions increased, it was evident that such a system was no longer adequate to meet the growing demands that were being made upon it.

In 1829, a Parliamentary Committee sat to enquire into the state of the law and practice governing the grant of patents, but although it collected much evidence, it failed to issue a report. Meanwhile, invention was rapidly gathering speed and assuming an increasing importance in the life of the nation. Matters reached a climax at the time of the Great Exhibition of 1851, when

a number of unofficial committees or associations were actively campaigning for amendment of the law. These committees were self-appointed and were not, of course, committees of enquiry in the sense that we understand the term to-day. But they succeeded in making their voices heard, and their activities culminated in the Act of 1852, which resulted in the appointment of Commissioners of Patents. The Commissioners were the Lord Chancellor, the Master of the Rolls, the Attorney- and Solicitor-Generals for England, the Lord Advocate and Solicitor-General for Scotland and Ireland. This was a pretty formidable combination, and indicates the importance attached to the proper protection of inventions. The procedure for obtaining patents was simplified and cheapened, a single patent would henceforth extend to England, Scotland and Ireland. fees were reduced, and accepted specifications were required to be printed and published.

The industrial age had arrived, and this provided a considerable stimulus to invention, with a corresponding increase in the number of applications for patents. But it was not long before the inadequacies and shortcomings of the Act of 1852 began to make themselves apparent, and in 1863 a Royal Commission was appointed, under the Chairmanship of Lord Stanley, to enquire into the situation. The Commission reported two years later and recommended, among other things, that there should be a limited investigation for novelty.

No action was taken to implement the recommendations of the Royal Commission of 1863 and, not surprisingly, the Commissioners of Patents continued to receive numerous representations as to the need for amendment of the law. As a result, a Select Committee of the House of Commons was appointed in 1871 to enquire into patent law and practice. The Committee reported in May, 1872, and in many respects their report endorsed the main principles upon which the present patent system is founded. They agreed that patents stimulated invention, and recommended that patents should only be granted on a clear description of the alleged points of novelty, that specifications should be published prior to grant in

order to facilitate opposition, that fees should be low and ear-marked to meet the costs of the system, that a patent should be conditional upon the supply of the patented article on reasonable terms, and that reciprocal arrangements with foreign countries should be established.

Despite these clear-cut recommendations, no new legislation was enacted until 1883. Under the Patents, Designs and Trade Marks Act of that year, the Patent Office, under the direction of a Comptroller, was made a Department of the Board of Trade: the Commissioners of Patents disappeared from the scene. The Act implemented practically all the recommendations of the Select Committee which reported in 1872, but made no provision for investigating novelty, apart from requiring an Examiner to report the existence of any two concurrent applications comprising the same invention, and empowering the Comptroller to refuse to seal a patent on the later case. The remaining and controversial milestone of an official search for novelty was yet to be reached, as was also the era in which the Board of Trade would appoint Committees to enquire into the working of the law and to make recommendations for its amendment.

The first Departmental Committee of Enquiry was appointed in 1885. By a Minute dated the 30th December of that year, the Board appointed Sir Farrer Herschell, the Earl of Crawford and Baron Henry de Worms, M.P., "to enquire into the duties, organisation and arrangements of the Patent Office under the Patents, Designs and Trade Marks Act, 1883, having especial regard to the systems of examination of the specifications which accompany applications for patents now in force under the Act".

The obligations placed upon an Examiner to report on the existence of concurrent applications comprising the same invention, imposed by the Act of 1883, had given rise to numerous difficulties. The Committee recommended the repeal of this provision, and this was duly effected by the Act of 1888. That Act also made provision for the registration of Patent Agents.

Some of the evidence given before the Herschell Committee provides an interesting comparison with present-day practice, as will be seen from the following questions which the Earl of Crawford addressed to the Comptroller, and to the replies which were furnished:

Q. "When the Assistant Examiner reports that the specification and drawings have not been prepared in the prescribed manner, does he make a report by a minute attached to the specification?" A. "He does." Q. "And what is done with that specification and that minute so attached?" A. "That minute is sent to one of the Examiners, and he looks over it in a general way to see whether he thinks the Assistant Examiner is right. If he is right ....., a letter is written and sent down to be signed either by myself or the Deputy Comptroller, so that we see all the requirements that have been made by the Office".

The proceedings also reveal that the preparation of abridgments was "let out" from 1858 onwards, and that at the time of the enquiry the fee for preparing an abridgment was five shillings per case.

During the period which followed the passing of the Act of 1888, the question of ensuring the novelty of patented inventions received considerable attention, and in 1900 a Committee was appointed, under the Chairmanship of Sir Edward Fry, to enquire "whether any and, if so what additional powers should be given to the Patent Office to (a) control, (b) impose conditions on, or (c) otherwise limit, the issue of Letters Patent in respect of inventions which are obviously old, or which the information recorded in the Office shows to have been previously protected by Letters Patent in this country".

The Committee reported that it was undesirable for patents to be granted for inventions that were not novel and recommended that a search should be made to ascertain whether an invention claimed in a complete specification

had been claimed or described in any British patent specification dated less than 50 years previous to the date of application. The recommendations of the Fry Committee were incorporated in the Act of 1902. Three years later, in 1905, the provisions relating to trade marks were separated out and formed the subject of the Trade Marks Act of that year. In 1907, a consolidating Act, the Patents and Designs Act, 1907, extended the investigation to include specifications not published at the date of application, but bearing prior dates.

The Act of 1907 appears to have worked satisfactorily during the years preceding the outbreak of the First World War, and the number of applications and patents granted increased steadily; but during the course of the war questions arose which suggested that amendment of some of the provisions of the Act was desirable. For one thing, at a fairly early stage in hostilities it became evident that Germany had secured a stranglehold, in the field of dyestuffs, and this was believed to be largely due to the very broad claims for new dyestuffs, as such, made by German inventors in British patent specifications, but without restriction as to the method or methods of manufacture described. The Board of Trade did not, however, go to the length of formally appointing a committee to investigate the problems, but the Comptroller, Mr. Temple Franks, invited a number of eminent and well-informed persons to meet him and discuss the matters at issue. Among these persons was Lord Parker, who acted as Chairman of a small informal Committee. The report of this Committee was not published, but in 1919 the Act was further amended as a result of their recommendations. The principal changes were the adoption of a provision which provided that substances produced by chemical processes or intended for food or medicine could only be claimed when limited to particular processes of manufacture. The provisions for compulsory working of patented inventions were enlarged, "licences of right" were introduced, and the term of patents was increased from fourteen to sixteen years, thereby providing

a general compensation to patentees for the losses they had suffered as a result of the war.

The decade following the enactment of the Act of 1919 marked a continuing increase in the number of applications for the grant of patents. Patents were assuming a growing importance, both nationally and internationally. Some of the more industrialised countries had extended their search far beyond the limits of their own published patent specifications and the question whether the United Kingdom should follow their example was being extensively canvassed. In some quarters it was also felt that the informal nature of the investigations of the Parker Committee, which occurred under the stress of war-time conditions, might not have been sufficiently extensive and that the time for a more detailed and comprehensive investigation had arrived. In deference to these views, the Board of Trade, on the 18th May 1929, appointed a Committee, under the Chairmanship of Sir Charles Sargant, "to consider and report whether any, and if so what, amendments in the Patents and Designs Acts, or changes in the practice of the Patent Office, are desirable". These very comprehensive terms of reference were obviously intended to give the Committee power to carry out the widest possible investigation.

By comparison with earlier Committees, the Sargant Committee was a marathon affair. It held 43 meetings over a period of two years and produced a report of over 100 printed pages.

It would be impossible, within the limits of the present article, to refer to all the recommendations made by the Sargant Committee, but three outstanding matters call for special mention. It was recognised that certain countries, particularly the United States and Germany, were already carrying out an unrestricted search for novelty, whereas the British search was restricted to our own patent specifications. This had given rise to the suggestion that patents granted in countries carrying out a wider search might have a higher

value than British patents, and so offer better security to persons interested in their development. In the result, the Committee recommended that power should be granted for the search to be extended to documents other than British patent specifications.

The question of appeals from decisions of the Comptroller, or persons acting on his behalf, had also attracted a good deal of attention, stimulated by the fact that the increasing number of patent applications was giving rise to an increasing number of appeals.

Prior to the Act of 1883, it rested with the Law Officers of the Crown to determine whether any particular patent should be granted, and when, by the Act of 1883, this power passed to the Comptroller, the Law Officers were authorised to hear appeals from decisions of the Comptroller dealing with all matters prior to sealing. In practice, this arrangement gave rise to many difficulties. The Solicitor-General, who usually heard the appeals, was heavily burdened with parliamentary and other duties, and considerable delays occurred in the hearing of appeals. In addition, Law Officers generally lacked technical knowledge and experience, and changes in political appointments of this character were of frequent occurrence. To meet the situation, the Committee recommended that the jurisdiction exercised by the Law Officers should be transferred to a Judge of the High Court selected by the Lord Chancellor, but that such proceedings should not have the status of High Court proceedings. The establishment of the Patents Appeal Tribunal was the result of this recommendation.

The other outstanding matter dealt with by the Committee resulted in a negative recommendation. The Committee reported that one of the most important and controversial subjects that they had to consider was the proposal to introduce a form of short-term monopoly in respect of a class of subject-matter described as "useful designs" or "utility models". The representations

made on this subject appear to have been fairly evenly divided between approval and disapproval of the proposal, but the Committee were not satisfied that a case had been established for the introduction of such a system in this country. Although such a system operated in Germany, the substantial difference between the patent laws of the two countries would, they thought, make the system inappropriate to conditions in the United Kingdom.

Among the many lesser recommendations was the proposal that the Comptroller should be empowered to refuse an application if an invention was obviously contrary to well-established natural law, thereby enabling applications for alleged inventions for perpetual motion machines (some of which had been both colourful and troublesome) to be refused.

The Report of the Sargant Committee was published in March, 1931, and legislation to implement their recommendations was enacted during the following year. The amended legislation continued in substantially unaltered form until after the end of the Second World War.

Towards the end of the Second World War, a feeling developed that a further revision of the Patents and Designs Acts was desirable, and in April, 1944, the Board of Trade appointed a Committee, under the Chairmanship of Sir Kenneth Swan, K.C., then Leader of the Patent Bar.

The Committee was instructed "to consider and report whether any, and if so what, changes were desirable in the Patents and Designs Acts, and in the practice of the Patent Office and the Courts in relation to matters arising therefrom and, in particular, to give consideration to, and to submit an interim report on (a) the initiation, conduct and determination of legal proceedings arising under or out of the Patents and Designs Acts, including the constitution of the appropriate Tribunals;

and (b) the provisions of these Acts for the prevention of the abuse of monopoly rights, and to suggest any amendments of the statutory provisions, or of procedure thereunder, which would facilitate the expeditious settlement and the reduction of the cost of legal proceedings and would encourage the use of inventions and the progress of industry and trade".

If the Sargant Committee carried out a marathon investigation by comparison with its predecessors, so indeed did the Swan Committee, for its sessions lasted for over three years and it held no less than 81 full-day meetings, compared with the 43 meetings of the Sargant Committee. The Committee was most fortunate in having Sir Kenneth Swan as Chairman. His profound knowledge of the subject and the fact that he was able and willing to devote all his time to Committee business proved invaluable. He was ably supported by Mr James Mould, an eminent member of the Patent Bar, Mr H.A. Gill, the doyen of the Patent Agents, Mr. John Venning, an experienced Patent Solicitor, Sir Harold Saunders, the Comptroller, Captain B.H. Peter, an industrialist, Sir David Pye, Vice-Chancellor of London University and a well-known scientist, Mrs. Joan Robinson, the economist and Dr. A.J.V. Underwood, an industrial chemist. They were a splended team and admirably suited to their task.

The main reasons that prompted the setting-up of the Swan Committee were two-fold. Firstly, there had been several very costly and prolonged cases of High Court litigation on patent matters. These had aroused adverse public comment, and it was felt desirable to investigate possible means for reducing the cost and duration of such proceedings. There was also the fact that there was a large build-up of applications for extension of term of patent on the ground of war loss, and dissatisfaction was being expressed about the costly nature of these proceedings. Secondly, there had been widespread allegations that patents were being used obstructively, or in a restrictive manner. It had, for example, been alleged in various

quarters that patents were sometimes acquired and used to prevent development in a given direction, rather than to encourage it. There did not appear to be any great dissatisfaction with the more routine and general provisions of the Acts, or with the functions discharged by the Office, but the appointment of a Committee with the primary object of considering the two matters referred to above also afforded an excellent opportunity for looking at the general provisions of the Acts. The terms of reference of the Committee had accordingly been drafted with this in mind.

The war had been in progress for nearly five years when the Committee began its work, and by this time a considerable number of patentees were concerned with the question of securing extensions of the term of their patents to compensate for losses resulting from the war. But the only procedure available to them was by way of application to the High Court. This required the employment of Counsel, and for many patentees the cost of such proceedings was prohibitive. Numerous representations were made to the Committee in favour of simplifying and cheapening the procedure. In view of the urgency of this matter, the Committee concentrated their initial efforts upon this one problem, and in March, 1945, they issued their First Interim Report, recommending amendment of the Acts to enable patentees who had suffered loss as a result of the war to apply, at their option, either to the Comptroller or to the Court for an extension of the term of their patents. The following year, the Acts were amended to implement this recommendation. Needless to say, the vast majority of patentees elected to adopt the simpler and cheaper procedure of making application to the Comptroller, and the work of dealing with these applications formed an important addition to the duties of the Office in the post-war period.

The Committee next turned their attention, as a matter of urgency, to the remaining subjects upon which they had been instructed to issue an interim report,

namely, the initiation, conduct and determination of legal proceedings and the provisions of the Acts for the prevention of the abuse of monopoly rights.

Up to this time, High Court proceedings in respect of patent matters were liable to come before any one of the Judges of the Chancery Division. But Judges of the Chancery Division rarely possessed the advanced technical knowledge necessary to deal expeditiously and effectively with actions involving complex technology, with the result that considerable time was absorbed in instructing them in the elements of such cases. With leading and junior Counsel on both sides, and technical experts and witnesses waiting in the wings, it was not unusual, even in those days, for costs of at least £1,000 a day to be incurred. And several days were often occupied in "educating" a Judge in the technology of a case. It was also urged that when, as not infrequently occurred, expert witnesses disagreed, a Judge who was himself inexperienced in scientific matters was at a grave disadvantage in attempting to reconcile or assess the comparative value of conflicting evidence.

The Second Interim Report of the Committee was issued in February, 1946, and on the question of simplifying and cheapening patent litigation the Committee recommended the appointment of two special Judges possessing technical or scientific qualifications and experienced in patent litigation. The recommendation was accepted to the extent that one such Judge, the late Mr. Justice Lloyd Jacob, was so appointed. At this time, he was one of the leading Counsel at the Patent Bar. As is well known, in due course he also took over the duties of the Patents Appeal Tribunal.

The Report also dealt with the question of the alleged obstructive use of patents, concerning which many allegations had been made during the course of the war. Every effort was made to probe this subject. Communications were addressed to all persons who were

known to have made the allegation, but not a single witness came forward, and not a single instance of deliberate suppression of an invention was produced.

The Report also contained the somewhat drastic recommendation that the Comptroller should be given jurisdiction to reject applications for lack of subject-matter. The two legal members, Messrs. Mould and Venning, dissented from this view and issued a Minority Report. They were, however, prepared to agree to the exercise of such jurisdiction by the Comptroller in opposition and revocation proceedings and, in the event, the recommendation was implemented to this extent.

The Second Interim Report put firmly on record that the Committee were satisfied that the present patent system encouraged the making and use of inventions and the progress of industry and trade. They added that "some witnesses had expressed concern at the harm that would be caused to our foreign trade if, by any radical change in our patent system, we rendered ourselves ineligible for continued membership of the International Convention for the Protection of Industrial Property".

The two Interim Reports of the Swan Committee disposed of the most urgent and important aspects of their enquiry and their Final Report, published in July 1947, consisted largely of recommendations that were more or less of a routine or "clearing-up" character. These recommendations were implemented by the Act of 1949, which also picked up the recommendations made in the Second Interim Report. As an indication of the manner in which ideas can change, and then change again, it might be mentioned that the Swan Committee, in their Final Report, recommended a reversal of the provision adopted in 1919 in respect of substances produced by chemical processes or intended for food or medicine. The Act of 1919, for reasons already mentioned, laid down that such substances could only be claimed when limited to particular processes

of manufacture. But representations were made to the Swan Committee that this limitation was not in accordance with modern technical developments, since invention often lay in the discovery of a new substance, as such, whilst the actual process of manufacture might involve little novelty in itself. They accordingly recommended cancellation of the limitation, with the result that patents could again be granted for a new substance, as such, irrespective of the method of its manufacture. The Committee also took the opportunity of making the very timely recommendation that the provisions of the Acts respecting designs should be incorporated in a separate Statute and, just as trade marks went their separate way in 1905, so designs followed them in 1949, and the three subjects are now dealt with in separate Statutes.

In conclusion, it is interesting to recall the wording of a recommendation on the long-standing and homely subject of Office accommodation. The Committee recommend "that, as an interim expedient, the Patent Office building should be extended on the Took's Court site ....., and that a new building, adequate to accommodate the entire staff of the Office, should be undertaken as soon as conditions permit". Well, one never knows!

It will have been observed that legislation to implement the findings of Departmental Committees on patents has generally been enacted without much delay. The War-time recommendations of the Parker Committee were implemented by the Act of 1919; those of the Sargant Committee, published in 1931, by the Act of 1932; those of the First Interim Report of the Swan Committee, published in 1945, by the Act of 1946, and those of their Second Interim and Final Reports, published respectively in 1946 and 1947, by the Act of 1949. It is hoped that the recommendations of the Banks Committee will provide solutions to the problems with which the Office is now confronted and that legislation to implement them will be enacted at an early date.

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