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## Act No. 19, 1899.

## PATENTS.

## An Act to consolidate the Acts relating to Letters Patent. [20th November, 1899.]

**B**E it enacted by the Queen's Most Excellent Majesty, by and with the advice and consent of the Legislative Council and Legislative Assembly of New South Wales in Parliament assembled, and by the authority of the same, as follows:—

## PART I.

*Repeal and Interpretation.*

Short title.

1. This Act may be cited as the "Patents Act, 1899," and is divided into Parts, as follows:—

PART I.—*Repeal and Interpretation*—ss. 1-3.

PART II.—PATENTS—

1. *Letters patent and certificates of provisional registration*—ss. 4-12.

2. *Assignments and licenses*—s. 13.

3. *Registration*—s. 14.

4. *Amendment of specifications*—ss. 15-18.

5. *Revocation of patents*—s. 19.

6. *Supplemental*—ss. 20-25.

Repeal.  
Schedule.

2. (1) The Acts mentioned in the Schedule to this Act are, to the extent therein expressed, hereby repealed.

Officers under Acts  
hereby repealed.

(2) All persons appointed under the Acts hereby repealed, and holding office at the time of the passing of this Act, shall continue in office as if this Act had been in force when they were appointed, and they had been appointed hereunder, and this Act shall apply to them accordingly.

Regulations under  
Acts hereby repealed.

(3) All regulations made under the authority of any Act hereby repealed, and being in force at the time of the passing of this Act, shall be deemed to have been made under the authority of this Act.

Interpretation.

3. In this Act, unless the context or subject-matter otherwise indicates or requires—

42 Vic. No. 27, s. 2.

"Invention" means any invention or improvement in the arts or manufactures for which a patent might have been obtained under the Acts hereby repealed, or for which a patent may be obtained under this Act.

*Ibid.*

"Exhibition" includes any exhibition held by the Agricultural Society of New South Wales, and any exhibition of works of scientific

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scientific invention, or of the fine arts or of industrial art, which the Governor may, by notification in the Gazette, declare to be an exhibition within the meaning and for the purposes of this Act.

“Letters patent” means the letters patent mentioned in section 51 Vic. No. 3, s. 17. five of this Act.

“Patent” means letters patent.

60 Vic. No. 39, s. 6.

“Patentee” includes a person entitled for the time being to the benefit of letters patent. *Ibid.*

“Prescribed” means prescribed by regulations made under the authority of this Act. 51 Vic. No. 3, s. 17.

“Minister” means the Minister of Justice.

PART II.

PATENTS.

1. *Letters patent and certificates of provisional registration.*

4. Any person claiming to be the author or designer of any invention in, or improvement to the arts or manufactures, or his agent or assignee who desires to obtain letters patent therefor, shall pay to the Treasurer the sum of five pounds, and shall after such payment lodge with the Minister a petition to the Governor setting forth that the petitioner is the author or designer, or the agent or assignee of such author or designer, of such invention or improvement, and specifying, and where necessary illustrating, the particulars of such invention or improvement, and that in connection therewith he has paid to the Treasurer the sum of five pounds.

Any person desiring to obtain letters patent may lodge a petition. 51 Vic. No. 3, s. 1.

5. (1) The Minister shall thereupon refer such petition to the Examiner of Patents, who shall examine and report to the Minister upon the petition, and the Minister may, after examination of the petition and of the report of the said Examiner thereon, report to the Governor that he approves of the prayer of the petitioner, and thereupon the Governor may grant letters patent under his sign manual and the seal of New South Wales, for the exclusive enjoyment and advantage, for a period of not less than seven nor more than fourteen years, for such invention or improvement to the petitioner or to his duly authorised agent or assignee.

The Governor may grant letters patent. 16 Vic. No. 24, s. 1. 51 Vic. No. 3, ss. 2, 15.

(2) Such letters patent shall be forwarded to the Examiner of Patents, who shall before issuing them to the grantee or his duly authorised agent, register them as hereinafter provided.

6. Any person so claiming to be such author or designer as aforesaid, or his agent or assignee, may in like manner obtain a certificate entitling him to provisional protection for any such invention

Certificate of provisional protection. *Ibid.* s. 3.

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or improvement, upon payment to the Treasurer of the sum of two pounds, and upon depositing with the Minister a petition addressed to the Governor, and a provisional specification in the prescribed form.

Protection to be for  
one year only.  
51 Vic. No. 3, s. 4.

7. A certificate of provisional protection shall be in force for twelve months and no longer, and shall be null and void if before the date of the expiration thereof the lawful holder of such certificate fails to make application for letters patent in terms of section four of this Act.

Letters patent may  
be issued upon  
certificate.  
*Ibid.* s. 5.

8. The Governor may grant and issue to the lawful holder of such certificate, or to his agent or assignee, letters patent for the invention or improvement provisionally specified :

Provided that the petitioner so entitled shall have deposited a complete specification setting forth how the invention or improvement is to be carried out and performed, and that all the other conditions of sections four and five of this Act have been complied with.

Upon the issue of such letters patent the certificate of provisional protection shall be deemed to be cancelled.

Payments to  
Treasurer.  
*Ibid.* s. 6.

9. The payment of two pounds to the Treasurer, on petition for provisional protection, and the payment of three pounds on petition for letters patent for the same invention, shall if both payments are made by the original petitioner, or the former payment by the original petitioner and the latter by his legal representative, be deemed to constitute the payment of five pounds provided for in section four of this Act.

Provisionally pro-  
tected invention may  
be used and  
published.  
*Ibid.* s. 7.

10. While a certificate of provisional protection remains in force the lawful holder thereof may use and publish his invention or improvement without prejudice to the issue of letters patent for the same, and such protection from the consequences of use and publication shall constitute the provisional protection provided for in this Act.

Date of letters patent.  
*Ibid.* s. 8.

11. Letters patent shall, unless the Minister in any case otherwise advises, be dated and sealed as of the day of the deposit of the petition for provisional protection, or if there has been no petition for provisional protection, then as of the day of the deposit of the petition for the said letters patent :

Provided that no action shall be maintainable in respect of any infringement of an invention or improvement committed before the deposit of the complete specification thereof, nor shall any person be entitled to institute any proceedings at law or in equity for infringement until after the actual registration of the letters patent granted to him for the invention or improvement alleged to be infringed.

Minister may grant  
more than one  
certificate.  
*Ibid.* s. 9.

12. A certificate of provisional protection shall be no bar to the granting of a like certificate for the same invention to other petitioners ;  
but

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but the Minister may, at his discretion, approve or refuse the issue of letters patent upon a second or other certificate during the continuance of a certificate of prior date for the same invention.

*2. Assignments and licenses.*

**13.** (1) Every lawful holder of a certificate of provisional protection and every patentee shall be at liberty to assign such certificate or patent, together with all the benefits and advantages derivable therefrom, to any person by an instrument in writing under his hand and seal.

Certificate or patent may be assigned.  
51 Vic. No. 3, s. 10.

(2) Every such grantee of letters patent shall also be at liberty, by an instrument in manner aforesaid, to grant to any person a license, either exclusive or otherwise, and for any portion of New South Wales, to manufacture, adopt, utilise, or exercise proprietary or co-proprietary rights over the whole or any portion of the invention or improvement which may be specifically protected by the said letters patent.

License to use patent may be granted.  
*Ibid.* s. 11.

*3. Registration.*

**14.** All letters patent and assignments thereof, or licenses thereunder, and all certificates of provisional protection and assignments thereof, shall be registered in the office of the Examiner of Patents by that officer, and in the prescribed time and manner; and any assignment made or license issued under the last preceding section shall be null and void if not so registered.

Patents, assignments and licenses to be registered.  
*Ibid.* ss. 12, 13.

*4. Amendment of specifications.*

**15.** (1) A petitioner for a grant of letters patent or a patentee may, whether his specification was deposited or letters patent granted before or after the commencement of this Act, from time to time, by request in writing to the Minister, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of such amendment and his reasons for the same. Such request shall be accompanied by a copy of the specification and of the drawings proposed to be amended, showing in red ink the proposed amendment.

Petition for leave to amend.  
60 Vic. No. 39, ss. 1, 2.

(2) The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the office of the Examiner of Patents of opposition to the amendment.

Opposition thereto.  
*Ibid.* s. 2.

(3) Where such notice is given the Examiner of Patents shall give notice of the opposition to the person making the request, and shall hear and determine the case, subject to appeal to the Minister.

(4) The Minister shall, if required, hear the person making the request, and the person so giving notice, and being, in the opinion of

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of the Minister, entitled to be heard in opposition to the request, and shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(5) Where no notice of opposition is given, or the person so giving notice does not appear, the Examiner of Patents shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

Appeal to the  
Minister.

(6) When leave to amend is refused by the Examiner of Patents, the person making the request may appeal from his decision to the Minister.

(7) The Minister shall, if required, hear the person making the request and the Examiner of Patents, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed.

(8) No amendment shall be allowed that would make the specification as amended claim an invention or improvement substantially larger than or substantially different from the invention or improvement claimed by the specification as it stood before amendment.

(9) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed except in case of fraud; and the amendment shall in all Courts and for all purposes be deemed to form part of the specification.

(10) The foregoing provisions of this section do not apply when and so long as any suit or action for infringement or proceeding for revocation of a patent is pending.

Appeal to the Equity  
Court.

60 Vic. No. 39, s. 1.

**16.** Any person adversely affected by any leave to amend granted under the next preceding section may appeal by motion to the Supreme Court in its equitable jurisdiction against the grant of such leave. Notice of such appeal shall be lodged within six months of the date when such leave was granted, and the costs of such appeal shall be in the discretion of the Court.

Power to disclaim  
during suit or action.

*Ibid.* s. 3.

**17.** In a suit or action for infringement of a patent and in a proceeding for revocation of a patent, the Supreme Court or a Judge thereof may at any time order that the patentee shall, subject to such terms as to costs and otherwise as such Court or Judge may impose, be at liberty to apply to the Minister for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the suit or action shall be postponed.

Restriction on  
recovery of damages.

*Ibid.* s. 4.

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

*Patents.**5. Revocation of patents.*

19. (1) The proceeding by scire facias to repeal a patent is hereby abolished. Revocation of patent.

(2) Revocation of a patent may be obtained on a petition to the Supreme Court in its equitable jurisdiction. 60 Vic. No. 39, s. 5.

(3) Every ground on which a patent might, before the Act sixtieth Victoria number thirty-nine, be repealed by scire facias shall be available by way of defence to a suit or action of infringement, and shall also be a ground of revocation.

(4) A petition for revocation of a patent may be presented by—

- (a) the Attorney-General ;
- (b) any person authorised by the Attorney-General ;
- (c) any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims ;
- (d) any person alleging that he, or any person under or through whom he claims, was the author or designer of any invention or improvement included in the claim of the patentee ;
- (e) any person alleging that he or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold in New South Wales, before the date of the patent, anything claimed by the patentee as his invention or improvement.

(5) The petitioner must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the Court, be admitted in proof of any objection of which particulars are not so delivered.

(6) Particulars delivered may be from time to time amended by leave of the Court.

(7) The patentee shall be entitled to begin and give evidence in support of the patent, and if the petitioner gives evidence impeaching the validity of the patent, the patentee shall be entitled to reply.

(8) When a patent has been revoked on the ground of fraud, the Governor may, on the application of the author or designer, or the agent or assignee of the author or designer, in accordance with the provisions of this Act relating to the grant of letters patent, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.

*6. Supplemental.*

20. All sums paid under this Act shall be carried by the Treasurer to the credit of the Consolidated Revenue Fund. Application of moneys paid.

21. 51 Vic. No. 3, s. 14.

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Exhibition and publication of an invention at an exhibition.

42 Vic. No. 27, s. 3.

**21.** The exhibition of any new invention at any exhibition shall not, nor shall the publication during the holding of such exhibition of any description of such invention, nor shall the user of such invention for the purposes of such exhibition and within the building or place where the same is held, nor shall the user of such invention elsewhere by any person without the privity and consent of the author or designer thereof, prejudice the right of the exhibitor thereof to apply for a certificate of provisional protection or for letters patent for such invention under this Act, nor shall the exhibition of such invention invalidate any certificate of provisional protection or letters patent granted in respect of such invention.

Governor may appoint an Examiner of Patents.

51 Vic. No. 3, s. 15.

Governor may make regulations.

*Ibid.* s. 16.

Proviso.

Crown prerogative.

*Ibid.* 3, s. 20.

Act No. 35, 1897.

**22.** The Governor may appoint an Examiner of Patents, who, under the direction of the Minister, shall examine and report to the Minister upon all petitions for letters patent.

**23.** The Governor may make and proclaim regulations for carrying into full effect the provisions of this Act and for regulating the collection and disposal of fees for registering assignments and licenses, and making searches of the records in the Examiner's office. All such regulations shall, upon publication in the Gazette, be valid :

Provided that a copy of every such regulation shall be laid before both Houses of Parliament within fourteen days after the issue thereof, if Parliament is then in session, or otherwise within fourteen days after the commencement of the next ensuing session.

**24.** Nothing in this Act contained shall be construed to the prejudice of the prerogative of the Crown.

**25.** Nothing in this Act contained shall be construed to overrule, restrain, or limit the operation or effect of the International Patents and Trades-marks Arrangement Act, 1897.

## SCHEDULE.

Reference to Act.	Title or short title.	Extent of repeal.
16 Vic. No. 24 ...	An Act to authorise the Governor-General, with the advice of the Executive Council, to grant Letters of Registration for all inventions and improvements in the Arts or Manufactures, to have the same effect as Letters Patent in England so far as regards this Colony.	The whole.
42 Vic. No. 27 ...	Patents Law Amendment Act ... ..	The whole.
51 Vic. No. 3 ..	Patents Law Amendment Act of 1887 ... .	The whole.
60 Vic. No. 39 ...	Patents Law Amendment Act, 1895 ... ..	The whole.