

No. XXXIX.

PATENTS  
LAW AMENDMENT.

An Act to further amend the law relating to  
Patents for Inventions and Improvements  
in Arts or Manufactures. [16th November,  
1896.]

BE 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:—

Application of Act.

1. This Act shall apply to all specifications deposited and letters patent granted before or after the commencement of this Act: Provided that in the case of specifications deposited and letters patent granted before or after the commencement of this Act any person adversely

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adversely affected may appeal by motion to the Supreme Court in its Equitable Jurisdiction against any leave to amend granted by the Examiner of Patents or the Minister of Justice, as provided in the second section hereof, and the costs of such appeal shall be in the discretion of such Court, and notice of such appeal shall be lodged within six months from such leave being granted.

2. (I) A petitioner for a grant of letters patent or a patentee may, from time to time, by request in writing to the Minister of Justice, 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.

Amendment of specification.  
46 & 47 Vic. c. 57,  
s. 18.

(II) 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.

(III) 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 of Justice.

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

(V) 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.

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

(VII) The Minister of Justice 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.

(VIII) 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.

(IX) 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.

(X) 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.

51 & 52 Vic. c. 50,  
s. 5.

3. 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 of that Court may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the Court or Judge may impose, be at liberty to apply to the Minister of Justice 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.

Power to disclaim during suit or action.  
46 & 47 Vic. c. 57,  
s. 19.

4. 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

Restriction on recovery of damages.  
46 & 47 Vic. c. 57,  
s. 20.

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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.

Revocation of patent.  
46 & 47 Vic. c. 57,  
s. 26.

5. (I) The proceeding by *scire facias* to repeal a patent is hereby abolished.

(II) Revocation of a patent may be obtained on petition to the Supreme Court in its equity jurisdiction.

(III) Every ground on which a patent might at the commencement of this Act be repealed by *scire facias* shall be available by way of defence to a suit or action of infringement, and shall also be a ground of revocation.

(IV) 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 within the Colony of New South Wales, before the date of the patent, anything claimed by the patentee as his invention or improvement.

(v) 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.

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

(vii) 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.

(viii) 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 (as the case may be), in accordance with the provisions of the Acts in force dealing with 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.

Definitions.

6. In this Act the word "patent" means letters patent as defined in the Patents Law Amendment Act of 1887, and the word "patentee" includes a person entitled for the time being to the benefit of letters patent.

Incorporation of Act  
and short title.

7. This Act shall be construed as one with the Act sixteenth Victoria number twenty-four, the Patents Law Amendment Act, and the Patents Law Amendment Act of 1887, and may be cited as the "Patents Law Amendment Act, 1895."