The British Empire Patent 1901-1923: the ‘global’ patent that never was

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Abstract
Between 1901 and 1923 concerted efforts were made to introduce a unitary patent for the whole British Empire. This article reviews the origin of the proposal in 1901, the state of patent law across the Empire at the time, the progress made at several conferences, the principal features of the Empire Patent as proposed in 1919, and the issues discussed at the 1922 patent conference. It analyses the reasons for the subsequent failure of these proposals at the Imperial Conference of 1923, including the problems created by Canada’s claim for reciprocal treatment for its patents, and equal status for its own patent office. It concludes by asking if there are any lessons to be drawn for the European Community patent from these efforts, and considers whether the Community patent has a greater prospect of success.

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Introduction

The inspiration for the present article has nothing to do with nostalgia for an Imperial past, whether British or earlier. It is altogether more local and immediate. Since the beginning of the 1960’s, the European Community has been attempting to introduce a Community Patent. For not quite as long as that, I have been following these proposals with a degree of fascination scarcely diminished by their invariable, but never entirely final, cliff-hanging failure. But while waiting for the main event on the bill, we might at least take a look at some of the proposals for supra-national patents which have been made in the past, and which may still have something to tell us. Among these, the proposed British Empire Patent is quite frequently mentioned in passing, and with good reason, since it was the most ambitious proposal of the pre-WWII era to take concrete shape, and perhaps the one which came closest to success. It deserves more than just the footnote reference it normally receives.

The patent system of the British Empire was certainly in need of simplification as the twentieth century began, since the Empire entered the century with a diversity of patent laws and procedures which was barely comprehensible to the expert, let alone justifiable to the layman. But the United Kingdom’s efforts at harmonising this discordant state of affairs were to be overshadowed and ultimately frustrated by the growing discontent of the self-governing Dominions at their unequal status, and a revolution in the governance of the Empire by which its transformation into a “Commonwealth” of free and independent sovereign entities was formally recognised in 1926. By that time the British Empire was at its largest extent, comprehending a quarter of the World’s land surface, and an estimated quarter of its inhabitants, some 500 million in all. This was the “Empire on which the sun never set.” The British Empire Patent of this article would turn out be the “global” patent on which the sun never shone.

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1 See C. Wadlow, Enforcement of Intellectual Property in European and International Law (Sweet & Maxwell, London, 1998) Chapter 4, Section A, for an historical overview of the Community Patent. At the time of writing, Commissioner McCreevy has announced “I will go for one big, last push on the Community Patent. I still have to decide when the time is ripe.” (Speech of July 12, 2006, Brussels). http://europa.eu/rapid/pressReleasesAction.do?reference=SPEECH/06/453&format=HTML&aged=0&language=EN&guiLanguage=en (all links in this article last visited September 1, 2006).

2 So far as I am aware, there is no existing scholarly literature on the British Empire Patent. My sources have predominantly been UK Official Publications; unpublished papers in the UK National Archives (Public Records Office); and contemporary news reports.

3 In population (457 million), the European Union today is remarkably close to the British Empire of old; but in area (4 million km²) it is only about one-tenth the size. (Both figures for the EU are from http://europa.eu/abc/keyfigures/index_en.htm, estimates for the British Empire post-WWI are from http://en.wikipedia.org/wiki/British_Empire).
A Declaration by a Mr Balfour

In August 1901, the President of the Board of Trade, Gerald Balfour, addressed the House of Commons on the subject of patent law reform. Apart from briefly mentioning the prospect of reforms to domestic patent law, he noted that:

“The extraordinary multiplicity of colonial patent laws forms one of the most curious anomalies of the British patent system. We find in foreign countries that a single patent suffices to give protection both in the motherland and in all its possessions. The French patent, for example, taken out in Paris covers not only France, but all its colonies.... The same rule holds good for the United States, Germany, Austria, Italy—in short, for every country in the world except within the British Empire. ...

The material fact to be faced by the patentee is that, with one or two exceptions, all the colonies, from Canada to British North Borneo, have patent laws of their own. Each has to be approached as if it were a foreign country. The patentee who would protect his invention in all possible parts of the British Empire has to take out about 25 patents at a cost of something like £400 in Government fees alone to say nothing of incidental charges.”

This was no exaggeration, and Mr Balfour’s figure of £400 would amount to about £30,000 in today’s money. Even in Britain, it was only since 1852 that a single patent had been available for the whole of the United Kingdom, in place of the separate patents previously granted for England and Wales, Scotland and Ireland. This British patent extended to the Isle of Man, but not to the Channel Islands.

Outside the United Kingdom, the territory covered by a single patent might range in size and economic importance from the whole of British India (then including Pakistan, Bangladesh, Burma and Aden, though not Ceylon), down to individual islands or enclaves as small as Malta or Jamaica. The major self-

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4 Gerald Balfour’s political career as Conservative MP for Central Leeds from 1885 to 1906, and President of the Board of Trade from 1900 to 1905, was almost completely overshadowed by that of his older brother, Arthur, who became Prime Minister in 1902, was leader of the Opposition from 1906 to 1911, and continued an active public career into the 1920s. See Janet Oppenheim, “Balfour, Gerald William, second earl of Balfour (1853–1945)”, Oxford Dictionary of National Biography, Oxford University Press, Sept 2004.

5 A Committee on the Working of the Patents Acts (the Fry Committee) was appointed by Gerald Balfour in 1900, and reported in 1901: Report Cd.506 (1901); Evidence Cd.530 (1901). Its Report (which was confined to matters of domestic law) resulted in the Patents Act, 1902 (subsequently consolidated into the Patents and Designs Act, 1907), which introduced the official search and examination for novelty.

6 *The Times*, August, 29, 1901, p.6.


8 Prior to the Patent Law Amendment Act, 1852, the minimum cost of obtaining a patent was £310 for the whole United Kingdom, or £94. 17s 0d for England and Wales alone, but no renewal fees were payable. The 1852 Act reduced this to an initial fee of £25 for the whole UK, with renewal fees of £50 after three years and £100 after seven years, for the same total term of 14 years. N Davenport, *The United Kingdom Patent System, a Brief History* (Kenneth Mason, Havant, 1979) at pp.17 and 58.
governing Colonies or Dominions (principally what are now Canada, Australia, New Zealand and South Africa), as well as India, all had their own independent patent laws, as did most of the dependent or “Crown” Colonies governed from Westminster. In the case of Australia, this situation was in the process of being simplified by a transition between systems operated by the various states as independent sovereign entities prior to 1901, and a unified system for the whole Commonwealth of Australia after that date.\(^9\) The same trend would shortly be under way in South Africa (in which separate patents were granted under the various laws of Cape Colony, Natal, the Orange River Colony and the Transvaal);\(^10\) and had been completed in the mid-nineteenth Century for Canada,\(^11\) except that Newfoundland was to remain separate until 1949.\(^12\)

With a keen eye for the irony of the situation, Gerald Balfour noted that an inventor wishing to protect his trade throughout the British Empire might do best to concentrate on obtaining patent protection in the relatively few countries which could rival Britain in exporting manufactured goods, principally Germany, France and the United States, and ignore most of the places where his products would actually be sold:\(^13\)

> “It is sometimes said that colonial patents are, for the most part negligible quantities inasmuch as patents secured in the great manufacturing countries such as the United States, Germany and France, practically assure to the patentee the command of the colonial markets. This is admittedly not true in all cases, and, where it expresses the fact, amounts to an admission that the patentee has to take out not less than three foreign patents in order to secure protection in British countries which all the time are arrayed in the full panoply of patent legislation of their own. Surely anomaly can go no further.”

All this was clearly unsatisfactory, but the self-governing Colonies or Dominions were masters of their own laws, and though the United Kingdom might set a lead, it could not impose a solution. The opportunity which Balfour evidently foresaw was the forthcoming Conference of Colonial Premiers in 1902.\(^14\) If the Premiers could be persuaded to give some sort of high-level political commitment to the

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\(^9\) The first Commonwealth Patents Act was passed in 1903.

\(^10\) The four former separate colonies were united into the Union of South Africa in 1910, and the first Patents Act of the new Union was adopted in 1916.

\(^11\) The first Canadian Patent Act after federation was enacted in 1869, pursuant to the Constitution Act, 1867.

\(^12\) Newfoundland (with an economy entirely based on fishing, and a total population of less than 250,000 in 1901) was one of several Colonies which must have remained outside the contemplation of all but the most obsessive inventor. It had issued a grand total of 198 patents by 1899. See also fn.28, below.

\(^13\) *The Times*, fn.6 above.

\(^14\) See fn.39, below. Unlike his brother Arthur, Gerald Balfour aligned himself with the Imperialist wing of his party led by Jo Chamberlain—associated with higher tariffs, “Imperial Preference”, and a general fostering of ties with the Colonies.
principle of an Empire Patent, then it could then be developed to the point where uniform legislation would be ready to be adopted by the various parts of the Empire.

**Patent laws in the British Empire, circa 1900**

In preparation for the 1902 Conference, the Patent Office prepared a memorandum “Mutual Protection of Patents”, dealing with the legal position in the various self-governing Colonies. These almost invariably modelled their patent laws more or less closely on whatever legislation had been in force in the mother country at the time of adoption, with varying degrees of interest in, or indifference to, subsequent reforms. Whilst this state of affairs led to a certain degree of legal homogeneity within the Empire, it fell well short of corresponding to what we now think of as harmonisation, still less to legislative uniformity. The major exception to this rule of thumb was Canada, which borrowed much of its legislation from the United States, rather than Britain, so that the first (Federal) Canadian Patent Act of 1869 owed much to United States influence. Otherwise, several features of English patent law which were more or less slavishly adopted in the rest of the Empire tended in practice to increase the degree of fragmentation. One might cite the absence of any statutory definition of infringement (other than what was implicit in the terms of the Royal grant); the unsatisfactory and increasingly anachronistic reliance on the Statute of Monopolies 1623 for the definitions of “invention” and “inventor”; but above all the definition of novelty strictly in terms of what was previously known or used within the actual territory of the patent grant, so that one and the same inventor might be granted a perfectly valid patent in one part of the Empire, and quite rightly be refused one for the same invention in another.

Overall, the Memorandum may be said to have adopted a much more sceptical view than Gerald Balfour on the desirability, and even feasibility, of further unification of patent laws and procedures—many divergences may have been mere historical accidents of no benefit to anyone, but others were legitimate responses to local circumstances.

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15 Conference of Colonial Premiers—Mutual Protection of Patents. No stated date or author. UK National Archives (Public Record Office) file BT 209/656 (where its presence is out of chronological sequence). Page references in the following footnotes are to this version. The Memorandum is also reproduced as Appendix X to the Conference Papers, Cd.1299 (1902) at p.131 et seq., in which its authorship is attributed to the Comptroller (p.39).

16 i.e. Canada, Newfoundland, New South Wales, Queensland, South Australia, Victoria, Western Australia, Tasmania, New Zealand, Cape Colony, Natal. The post-1907 distinction between “Dominions” and “Colonies” was not yet current. India and the numerous Crown Colonies were not covered on this occasion.


18 Above, fn.15, at p.3.
“Where there are good and sufficient reasons for the existing divergencies, it would manifestly be a mistaken policy to endeavour to remove them merely for the purpose of bringing about any cast-iron uniformity. But where any divergency is the result of accident rather than design, and no good object is gained by retaining it, it would be well to bear in mind, in any future revision of the law, that unnecessary discrepancies between the Patent Laws of the Colonies and the United Kingdom cannot but add to the trouble and expense which confront inventors in the United Kingdom who are desirous of patenting their inventions abroad, and Colonial inventors who desire to patent their inventions in the United Kingdom or in Colonies in which they do not themselves reside. It will be generally admitted that some approach to uniformity is desirable, so far as it is not purchased too dearly by disregard of local circumstances and requirements.”

In law and logic, the first problem was whether the applicant had the status of “inventor” at all. Even before the Statute of Monopolies, and certainly ever since, English law had adopted an ambivalent definition of “inventor” which embraced both the actual devisor of a new invention in the intellectual sense, and the first person to introduce it (e.g. by applying for a patent on it) in a territory in which it was previously unknown, even if the latter “inventor” had simply copied it from abroad.

The response of the principal self-governing Colonies to this state of affairs differed widely.19 From the mid-nineteenth Century, Canada had followed the lead of the United States in adopting what is now called the “first-to-invent” model, but within the Empire it remained unique in this respect. Elsewhere, the status of an inventor/applicant tended to be based on the ambivalent United Kingdom model, but with numerous variations. Provisions for applications by the agents, successors, employers, or assigns of the real inventor were of considerable practical importance, but also differed widely. Definitions of “invention” differed little and usually followed that of the Statute of Monopolies.20

Invention and inventorship disposed of, the next legal question was that of novelty.21 Colonial patent offices did not necessarily conduct any substantive examination at all, and those that did so tended to search and examine for novelty by reference only to locally-published prior art patents or applications.22 This was partly a legacy of the English common law concept of novelty, which excluded from relevance any publication or use which was not known within the Realm, and partly dictated by convenience, since even the smallest and most remote patent office might be assumed to have something resembling a complete set of its own patents, even if it had nothing else. Once again Canada was the exception, with the official examination supposedly corresponding more closely to the United States model in scope, and

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19 ibid., at p.4 et seq.

20 ibid., at p.6.

21 ibid., at p.6 et seq.. Obviousness (or inventive step) in the modern sense had yet to emerge as a fully separate concept.

22 It is not clear from the 1902 Memorandum to what extent statutory powers to examine and/or refuse applications were actually exercised in practice. Colonial offices which did examine for novelty in 1902 were a step ahead of the United Kingdom. The 1902 Act provided for search and examination, but this was not implemented until 1905.
extending, at least in theory, to patents and publications from anywhere in the world. Consistently with its American origins and the “first-to-file” principle, Canada alone had a one year grace period. Provisions allowing inventions to be exhibited without affecting their subsequent patentability were more widespread, but again far from uniform.

Oppositions by third parties were provided for under the laws of all the self-governing Colonies except Newfoundland and (for practical purposes) Canada, since in the latter proceedings were only possible between conflicting applicants, in a manner reminiscent of United States interferences. The filing of a “caveat” was possible in Canada and South Australia only.23 Where oppositions were possible, the relevant procedures, provisions for locus standi, competent institutions, and permissible grounds of opposition varied widely.

With any oppositions disposed of, relevant post-grant legal procedures were again diverse and frequently anachronistic. The Comptroller's Memorandum stopped at the point of grant, but the action for infringement, and any incidental questions such as ones of jurisdiction or procedure, would depend on complicated local interactions between patent legislation and the general law, including local enactment (or not) of equivalents to the English Judicature Acts 1873-5, and whether the ancient writ of scire facias was still in use. At least the definition of infringement was nearly uniform, or uniformly vague, since it everywhere depended entirely on the terms of the Royal grant and on precedent. As to the latter, the appellate jurisdiction of the Privy Council and the respect accorded to English decisions everywhere did at least mean that the unmodified common law was fairly uniform throughout the Empire.

Queensland and New Zealand were identified as being parties to the Paris Convention,24 as was the United Kingdom. Colonies which were not part of the Union frequently had provisions of some sort for claiming or recognising priority in respect of specified foreign applications.25

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23 A caveat involved filing a detailed description of an invention, which was not intended to proceed to grant in the short term, but on the basis of which the person filing it was entitled to be notified of (and to oppose) any subsequent application to patent substantially the same invention.

24 *ibid.*, p.14 et seq., This does not mean that either had ratified the Paris Convention for the Protection of Industrial Property (1883) in its own right (which never happened in the case of Queensland, nor until 1931 for New Zealand). The legal position of dependencies was uncertain prior to the adoption of Art.16bis at the Washington Conference in 1911 (Art.24 of the 1967 Stockholm text now corresponds), but the practice already followed was that rights and obligations under the Convention did not automatically extend to dependencies, and Members notified the Swiss Government as to which of their dependencies the Convention would extend to, and in what capacity. The United Kingdom did so for Queensland and New Zealand (1891), Ceylon (1905), Australia (1907), and Trinidad and Tobago (1908). Of these, New Zealand and Australia were parties in their own right, with corresponding rights to vote, and obligations to contribute to the budget, by virtue of the UK's Declaration to that effect. See S. P. Ladas, *Patents Trademarks, and Related Rights: National and International Protection* (Harvard University Press, Cambridge Massachusetts, 1978) volume 1, §65. See further fn.134, below.

25 *ibid.*, p.16.
Patent system usage and economic issues

In 1901, 13,062 patents were issued in the United Kingdom. The highest number issued in any of the self-governing Colonies was 4,766, for Canada, and the Memorandum noted that the “great bulk” of these originated in the United States of America. The number for the constituent parts of Australia varied between 674 (NSW) and 208 (Tasmania), for New Zealand it was 536 and for the two South African Colonies 188 (Cape) and 152 (Natal). No annual figures were available for Newfoundland, and the total historically granted for that colony only amounted to 198. In all, Canada accounted for more than half of the 8,300 or so Colonial patents issued each year. No attempt was made in presenting these figures to distinguish between the same invention being patented in multiple jurisdictions, and applications unique to one of them. The Memorandum did allude to the obvious fact that many of the colonial patents corresponded to UK ones, and were probably for the benefit of UK applicants, but did not elaborate on this.

At the date of the Conference, the United Kingdom patent term was 14 years, the application fee was £4, and renewal fees were payable annually so that the total of official fees if the patent was maintained for the full term amounted to £99. The patent term was also 14 years in all the Colonies (except Canada, where it was 18 years), and most major Colonies had provisions for extensions of seven or 14 years for inadequate remuneration, similar to those in the United Kingdom. (The exceptions were Canada and New South Wales). Patent fees in individual Colonies were generally rather lower than in the United Kingdom, with renewal fees being payable (if at all) at less frequent intervals. However, value for money differed rather widely: the application fee was higher in Newfoundland ($25), than in Canada ($20), although Canada charged renewal fees ($20 each time in the 6th and 12th years) and Newfoundland did

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26 ibid., p.4.
27 ibid. The figures which follow are for 1901, or the latest available year.
28 As of 1899. Annual figures for patents granted in Newfoundland were given at subsequent conferences: 17 in 1905 (1907 Conference;) and 14 in 1909 (1911 Conference).
29 It is perhaps telling that all these figures were obtained from the International Bureau of the Paris Union, and not from British (or Imperial) Government sources.
30 ibid., p.11. Somewhat more than £7,000 in today’s money (above, fn.7).
31 ibid., p.11.
32 Plus an unspecified amount for issue under the Great Seal of the Colony, ibid., p.12. Newfoundland had a separate currency to Canada, but this was the age of the Gold Standard and the Newfoundland Dollar had the same official value as the Canadian one. Five dollars approximated to one Pound Sterling.
not. In Australia, official life-cycle fees ranged from £5 (NSW) to £38 (Tasmania), with South Australia at £8, Victoria at £9, and Queensland and Western Australia at £18; so that the total for what we now know as Australia would have been £96, or barely less than for the mother country. Comparable fees for New Zealand were £18, and for Cape Colony and Natal £35 and £19. 18s respectively.

Automatic termination of a local patent as a result of the expiry, revocation, non-renewal or forfeiture of an equivalent patent elsewhere was found in the laws of Canada, Cape Colony, Natal, Newfoundland, and South Australia, and is closely related to the kind of “economic clauses” which loomed large in late nineteenth century patent law. The most draconian economic clauses were found in Canada and Newfoundland; these two, and South Australia, were the only ones in which a patent could be forfeited for non-working. In Canada, patents automatically became null and void two years after issue, unless the patentee (or a licensee, etc.) actually worked the patent in Canada and made the invention available to all comers at a reasonable price. A similar but less detailed provision for non-working applied in Newfoundland. In South Australia, the period allowed was three years, and the patent was subject to discretionary forfeiture (as opposed to automatic nullity) on the order of the Governor. Canada was unique among the Colonies surveyed in also providing for automatic forfeiture of patents 12 months after issue in the event of articles protected by the patent being imported by or for the proprietor. Both the non-working and the importation provisions in Canadian law were attributed to its propinquity to the United States: “the most inventive country in the world”.

“Thus in Canada, several of the details of the Patent Law are assimilated to those of the United States, from which the great bulk of the inventions patented in Canada come: and the propinquity of the States, and the fear that obstructive patents may be taken out in Canada by inventors in the States for the purpose of preventing the manufacture of patented articles in Canada, have led to the passing of stringent enactments for the forfeiture of patents in the event of the importation into Canada of the patented goods, or if the patented inventions are not worked in Canada within a limited period.”

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33 £2 on application and £3 on petition for the patent, no renewal fees.

34 10/- on each of application and filing complete specification, £2 on grant and renewal fees of £15 and £20 at the 3rd and 7th years.

35 *ibid.*, p.11, under “Duration of Patents”. The Memorandum correctly noted that this state of affairs would be incompatible with the newly adopted Additional Act of the Paris Convention in 1900. See now Paris Convention (1967), Art.4bis(1) and (2).

36 *ibid.*, p.13. This period, and that for importation, below, were extensible (in advance) by the Commissioner for Patents in limited circumstances.

37 *ibid.*, p.14; followed by *ibid.*, p.3.
Some other Colonies (New Zealand, Queensland, Tasmania and Western Australia) had provisions for compulsory licences in terms similar to the law in the United Kingdom, but no instances were known of these being invoked. 38

**The Imperial Conferences of 1902, 1907 and 1911**

Imperial Conferences had been a rarity in the Victorian era, being confined to occasions when the political leaders of the more distant parts of the Empire found themselves drawn to London for some inescapable ceremonial event such as a Jubilee. The Conference of 1897 resolved to adopt these as more or less regular events, and the 1902 Conference of Colonial Premiers 39 usefully coincided with the Coronation of Edward VII. The agenda at this and future conferences was typically dominated by issues of high policy—trade and tariffs, foreign policy and defence, the status of the Dominions or Colonies and the constitution of the Empire itself—and worked its way down to whatever minor but worthy initiatives were thought deserving of a place. 40 At the 1902 Conference, these included the proposed British Empire Patent, the dual reasons for its inclusion being foreshadowed in this further extract from Gerald Balfour’s speech: 41

“If then consideration is about to be given to the amendment of the patent laws here would seem to be a condition of things which calls clearly for redress. The ideal to be aimed at is obviously an Imperial patent law the covering the whole Empire. Until a really satisfactory measure of that kind could be devised, something would be gained by extending the English patent, which now covers only the United Kingdom and the Isle of Man (but curiously enough not the Channel Islands), so that it, might include the colonies or as many of them as would be disposed to accept the aegis. The case of Imperial penny postage suggests that were the principle once established, a process of natural extension might be expected to set in which would perhaps in time include most or all of the colonies. As a means of giving practical expression to the desire for closer union among the scattered units of the Empire, an Imperial law would obviously possess a substantial value.”

At the 1902 Colonial Premiers’ Conference itself the Comptroller’s Memorandum “Mutual Protection of Patents” was circulated, 42 but the Report of the Conference noted that it was considered too technical for immediate discussion by those present. Instead, it was recorded that “there was a general feeling that it was desirable that the recognition throughout the Empire of a patent granted in one part of it should be facilitated” and a Resolution was passed to the effect that: 43

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39  Papers Relating to a Conference between the Secretary of State of the Colonies and the Prime Ministers of Self-Governing Colonies, June to August, 1902, Cd.1299 (1902).

40  Adoption of the metric system in 1902, to which was added decimal coinage in 1907.

41  Above, fn.6.

42  Above, fn 15.

43  Above, fn.39 at p.39.
“It would tend to the encouragement of inventions if some system for the mutual protection of patents in the various parts of the Empire could be devised. That the Secretary of State be asked to enter into communication with the several Governments in the first instance to invite their suggestions to this end.”

The next Colonial Conference was held in 1907. The Conference Papers recited that responses to the previous Resolution had been received from Canada, Natal, Cape, Newfoundland and New Zealand. Canada reported that its patent law had recently been revised and that it had been considered essential to retain the provisions for compulsory working and forfeiture for importation. (In fact, the rest of the Empire was increasingly at one with Canada on the necessity for such provisions, though Canada’s remained exceptionally stringent). These were not to be compromised, but Canada was prepared to consider other amendments in the interests of uniformity. Natal suggested that reciprocity was premature, but that Colonies might recognise United Kingdom patents subject to local registration and payment of fees. Cape Colony had recently failed in an attempt to amend its Patent Act in line with Imperial (British) law because of opposition in Parliament; Newfoundland favoured adoption of a uniform model law; and New Zealand suggested that the United Kingdom government should propose a scheme for mutual protection of patents.

Australia had not responded to the circular, but put forward a formal draft of a Resolution for consideration at the Conference:

“That it is desirable, in the interests of inventors and the public, that patents granted in Great Britain or in any Colony possessing a Patent Office of a standard to be specified should be valid throughout the Empire.”

However, in response to this proposal, the Comptroller, Mr C.N. Dalton, took a very dim view of the practicality of the scheme:

“Possibly, however, what is intended by the resolution of the Australian Government is … that every patent granted by any one of these Offices should, without prejudice to the views the local Courts may take of its validity, be of the same force and effect as if it were granted by other Patent Offices in the Empire, e.g., that a patent granted by the London Patent Office should have the same effect as if it had been taken out not only in the United Kingdom but in every Colony of the Empire, and that a patent granted by the Patent Office of any Colony should secure for the patentee throughout the Empire a monopoly in the invention patented, provided that the invention were of such a character that a valid patent could be granted for it.

Papers laid before the Colonial Conference, 1907, Cd.3524 (1907); and Minutes of Proceedings of the Colonial Conference, 1907, Cd.3523 (1907).

Cd.3524 (1907), pp. 7-8.

ibid., p.503. A second paragraph proposed “That the Imperial Patent Office be desired to recommend the necessary steps to secure this end.”

ibid., pp.503-4. The first three paragraphs (omitted) criticised the draft Resolution on the over-literal assumption that patents so granted were intended to be incontestable.
The difficulties in the way of bringing about such a result are very great. I am afraid they are insuperable. We have now in our own Patent Office a very elaborate examination for prior patenting, in which a staff of between two or three hundred technical experts is engaged, which is constantly increasing as the number of applications for patents increases. It is no disparagement to the Colonial Patent Offices to suggest that this examination is more searching than that which takes place in some of the Colonial Patent Offices. If the patents granted by the Imperial and some of the Colonial Patent Offices were to run throughout the Empire, the tendency of some inventors would certainly be to apply for a patent in the Patent Offices where the examination was the least searching, and the result would be that patents would be granted to run throughout the Empire in one Office, which would be refused if applied for in another. …

Another great difficulty in the granting of Imperial patents would arise in connexion with oppositions. At present when a complete specification is accepted, the acceptance is advertised and the specification and drawings published; and persons interested in opposing the grant may oppose on any of the statutory grounds of opposition within two months from the date of the advertisement of the acceptance. If the monopoly to be granted by the patent were to extend over the whole Empire, it would be necessary that facilities for opposing the grant should be provided for persons interested in whatever part of the Empire they might be residing. This could only be done by advertising the acceptance of every specification throughout the Empire and considerably extending the time allowed for opposition, thereby increasing the expenses and delaying the grant of the patent. It would also be necessary to determine whether the opposition should be heard and decided in the London Patent Office or in the Colonial Office in which the application for the patent had been made. In either case the opponent, if he lived in a different country from that of the applicant, would be subjected to considerable inconvenience and expense."

A different approach was advocated by Cape Colony, which proposed that after full consultation with the Colonies, uniform Imperial laws should be adopted for patents and trade marks. This draft Resolution also attracted reservations from the Comptroller, on the grounds that local variations in law might be beneficial, and that giving overriding priority to uniformity of law would delay or frustrate local initiatives and incremental reforms. The Conference Papers also included an updated version of the 1902 Memorandum on “Mutual Protection of Patents”. At the Conference itself, the two draft resolutions were once again considered only superficially and at senior ministerial level, with the Australian prime minister, Alfred Deakin, admitting that his own Commissioner of Patents had serious reservations about the Australian Resolution; and that as it stood it

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48 The ellipsis after the second paragraph marks a paragraph on the treatment of conflicting applications. Two concluding paragraphs on problems to be expected with fees are also omitted.

49 ibid., p.505. The draft Resolution referred to “merchandise marks” but this was later admitted to have been in error, and that “trade marks” had been intended.

50 ibid.

51 Appendix XXIX, p.507. Coverage was extended to include Transvaal.

52 Minutes of Proceedings of the Colonial Conference, 1907, Cd.3523 (1907) p.484 et seq. The United Kingdom was represented by David Lloyd George, then President of the Board of Trade.
set up a “practically impossible standard”, and represented an “unattainable ideal”. In the result, a Resolution was passed:\footnote{ibid., at pp. ix, 488.}

“That it is desirable that His Majesty’s Government, after full consultation with the self-governing Dominions, should endeavour to provide for such uniformity as may be practicable in the granting and protection of trade marks and patents.”

The final Imperial Conference of the pre-War period took place in 1911.\footnote{Imperial Conference 1911: Papers laid before the Conference, Cd.5746 (1911); Minutes of Proceedings, Cd.5741 (1911). Official correspondence taking place between the 1907 and 1911 Conferences is included in Cd.5273 (1910) and Cd.5513 (1911). The 1911 Conference Papers include (at p.140 et seq.) a further revised and updated version of the two previous memoranda under the title “Memorandum by the Board of Trade on the Protection of Patents and Trade Marks in the United Kingdom and the Self-Governing Dominions.”} Prior to this, in 1909, the possibility of a special conference on trade marks and patents had been the subject of consultation between the Colonial Office and the Dominions, but had received little or no encouragement from the latter, and had not proceeded further.\footnote{See 1911 Conference Papers (above) at pp.137-139 (correspondence); 140 (summary).} In the result, the Conference merely considered two similarly inoffensive resolutions proposed by New Zealand and Australia, and decided to adopt the former:\footnote{Minutes of Proceedings, Cd.5745 (1911), pp.15 (resolution), 162-165 (debate); Précis of Proceedings, Cd.5741 (1911) at p.35.}

“That it is in the best interests of the Empire that there should be more uniformity throughout its centres and dependencies in the law of copyright, patents, trade marks and companies.”

The limited discussion on patents was mostly occupied by a disagreement as to objectives between the New Zealand Prime Minister, Sir Joseph Ward, and his own Attorney-General, Dr J.G. Findlay—the former being mainly concerned with standardising matters of application formalities and procedure; while the latter argued enthusiastically, but unsuccessfully, for a genuinely unitary Imperial patent:\footnote{Minutes of Proceedings, p.164. In what follows the “cyanide process” is surely a reference to the McArthur-Forrest cyanide extraction process for gold, the English case being Cassel Gold Extracting Co v Cyanide Gold Recovery Syndicate (1895) 12 R.P.C. 232, CA. At p.165 Dr Findlay spoke of the cost to the patentees of the entire litigation (in Victoria, New South Wales, Western Australia, New Zealand, South Africa and England) as being about £½ million.}

“As this is a legal matter, may I say one word? It seems not only that uniformity is desirable but, if possible, unity is desirable. It seems that if we are going to give substance to the Imperial spirit we ought, where we can, to give an Imperial force to such a law as this is. If you get a patent in America at Washington it is a patent for about one hundred million people. You may get a patent in New Zealand which will not be recognised in Australia. We have litigated through our courts some of the greatest patents, including the cyanide process, for instance, and our courts arrived at a different result from that of the courts in Australia, based on a different interpretation of the different prevailing patent laws of both States, although the circumstances were the same and the offices which the patent was

\[\text{Christopher Wadlow}\]
discharging were the same; and it is anomalous, it seems to me, where you have an Empire like ours, that you should have in one part of it a patent valid and in the next part of it the patent invalid. It seems to me, therefore, that as far as we can accomplish it the system should have the force of Imperial uniformity. It is surely conceivable that the grant of a patent here in London might have validity right through the Empire. That is one branch of it, and the other is the uniformity to which Sir Joseph Ward has referred, but the uniformity should not, it seems to me, be limited to machinery merely, but might go still further.

In Canada the examination made before a patent is granted is much more exacting than in England, and hence a patent granted in Canada is looked upon as more valuable even than a patent granted in England, New Zealand, or Australia. In America the inquiry is more exacting still, but it seems to me that it would be a great advantage if uniformity of examination could be established in connection with patent law as well as mere uniformity of machinery, because what I desire to press upon the Conference is that if you are going to give some concrete expression of the Imperialistic spirit it might be done in such a direction as this, I think the scope of the suggestion might be even wider.”

The Economic Conference of the Allies held at Paris in 1916 passed a Resolution proposing “to convene a meeting of technical delegates to draw up measures for the assimilation, so far as may be possible, of their laws governing patents, indications of origins and trade marks”, but like the other resolutions passed at this Conference this had no legal effect, and it in fact led nowhere.\textsuperscript{58} Two Imperial War Conferences were held in 1917 and 1918.\textsuperscript{59} Although patent reform can hardly have been pressing (and one cannot be sure that it was on the agenda at all), the heavily censored public record of the 1917 Conference notes that a Resolution was passed approving a Board of Trade Memorandum on Patents and Trade Marks, although neither the Memorandum itself, nor any discussion, was made public. There was no published record of discussion of patents at the 1918 Imperial War Conference.

**The Comptroller’s 1919 Memorandum**

The two War Conferences, and the Empire’s involvement in the 1919 Versailles Peace Settlement, had left numerous economic and foreign policy issues outstanding, and a conference was eventually

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\textsuperscript{58} Recommendations of the Economic Conference of the Allies held at Paris, Cd.8271 (1916), Resolution C III, at p.8 (in an official translation from the original French). The Allies at this stage in the War included Britain (and its Empire), France, Belgium, Portugal, Italy, Russia, Serbia and Japan; though not then the United States. From its inclusion in Section C (“Permanent Measures of Mutual Assistance and Collaboration among the Allies”) it is clear that this was not intended as a wartime (or immediate post-war) measure, but as preparation for the relationship of undeclared economic warfare between the Allies and the Central Powers, which the organisers of the Conference expected to continue after any peace settlement (see Recitals II and III).

\textsuperscript{59} Imperial War Conference, 1917, Cd.8566 (1917); Imperial War Conference, 1918, Cd.9177 (1918).
convened in 1921 to address some of these. As 1919 gave way to 1920 the Comptroller composed and circulated a short note or memorandum on the two options for an Empire patent which he considered viable. By way of background, the situation had changed little since 1902:

“It is constantly urged that Patents granted in the United Kingdom and the Dominions should be valid throughout the Empire. At the present time, separate patent rights have to be obtained in India and all the self-governing Dominions. In the Crown Colonies, British Patents are for the most part registered and become valid in the Colony by registration. Under the existing system, all the Self-Governing Dominions, with the exception of South Africa, make an examination for novelty before the grant of patent rights. This is in addition to the investigation as to whether or not formalities have been properly observed. It is obvious therefore that an Empire Patent is practically impossible with the present system, as there is no security that a specification accepted in one country of the Empire will be accepted in another, or that amendment may not be required in each country modifying the original invention claimed. The United Kingdom cannot accept a Canadian or Australian specification without the examination required by the Patents Acts, 1907-19, and without the necessary amendments which may be required. Equally, the Dominion Patent Offices will not necessarily grant a patent on a specification accepted in the United Kingdom to which patent rights have been accorded.”

The first of two proposals in response to this situation was for all local patent offices in the Empire to be abolished in favour of a single Imperial Office, which would receive and examine applications, and issue patents, for the entire British Empire; just as the Federal Patent Office in Washington granted patents for the whole of the United States. The Comptroller noted two objections to this option. First, that the United Kingdom and the Self-Governing Dominions would be reluctant to give up their independent local patent offices (not to mention the fees they generated); and secondly, that there were too many practical arguments against it. The only plausible location for the Central Office would have been in London, but the delays inherent in dealing with a London office from remote parts of the Empire would have left applicants from the Colonies and Dominions much worse off than before.

The second proposal was that local Patent Offices would be retained in the United Kingdom and the rest of the Empire, which would receive patent applications and issue patents after examination for

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60 Conference of Prime Ministers and Representatives of the United Kingdom, Dominions and India (1921). See fn.68 below. The awkward official title was intended to cover up disagreement as to whether this was the full “Imperial Conference” which had been promised for after the War, or a holding exercise to address immediate issues (of which renewal or not of the Anglo-Japanese naval treaty was the most pressing).


62 ibid., p. i.

63 ibid., pp. i-ii.
formalities only. Substantive examination for novelty and the power to require amendments prior to
grant would be abolished, and fees could consequently be much reduced. There would still be a Central
Office, but this would simply keep records of the locally granted patents, and in the basic version of the
second proposal would conduct no kind of search or examination of its own. All such patents would
have *prima facie* effect throughout the Empire, but their validity and scope of protection would be
established on a case-by-case basis in the courts when any dispute arose.

As a variant on the second proposal, the Central Office might be equipped to conduct a full novelty
search and examination, either against all previous patents and applications in the various parts of the
Empire, or perhaps against those of the whole World. An applicant who had obtained a registration
patent from one of the local offices would have the option, on payment of a much more substantial fee,
to request this search and to amend his patent specification accordingly, if necessary. The outcome of the
search would be recorded, the specification might need to be reprinted, and a patent which had passed
through this procedure would be expected to be more valuable commercially, although it does not seem
to have been contemplated that its legal status should have been any different compared to unexamined
patents. The Central Office would also probably have to provide for opposition by prior patentees,
although it is not clear whether this was a proposed variant on the variant, and therefore dependent in
some way on the optional enhanced search and examination, or whether it was a likely feature of the
second proposal in its basic form.

The note concluded:

“This [the second proposal] probably is a more feasible proposal than 1, inasmuch as local
rights are not disturbed. Small fees only are payable for an unexamined patent, and a really
effective universal search is made for those who desire it on payment of a larger fee.

There is no substantial difference between the procedure and practice in the Dominions
and that of the United Kingdom in Patent matters, although there are a few minor
divergencies. The establishment of a Central Office would not in any way affect any special
local regulations such as those regarding working etc., as it would solely be concerned with
the examination and search for anticipations, with oppositions and with grant of a patent,
which would in consequence have a strong presumption of validity throughout the Empire.

The real complaints of inventors in the British Empire are:

(1) The expenses and difficulty of obtaining patent protection throughout the
Empire.

(2) The uncertainty as to the position and validity of his patent in the various
parts of the Empire.

The establishment of a Central Office would go some way to meeting these complaints if
the local fees were generally reduced. The central office might indeed finally become the

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64 ibid., pp. ii-iii.

65 As was done (at least in theory) by the German and United States Offices, ibid., p. iii.

66 ibid., pp. iii-iv.
means of transmitting the necessary documents and receiving the necessary fees for the purpose of obtaining patent rights in the various portions of the Empire.

It seems highly desirable in view of the demands for a more simple and effective protection of inventions throughout the Empire that some such scheme, of which but a bare outline is suggested above, should receive the consideration of the technical experts of the various patent offices throughout His Majesty’s Dominions.”

Somewhat surprisingly, the prospect of flooding the Empire with unexamined patents of dubious or no validity seems to have troubled the Comptroller not at all, despite the comparatively recent, and undoubtedly successful, introduction of examination for novelty in the United Kingdom following the Fry Report and the 1902 Act,67 and the complete lack of consultation with industry or the public over such a drastic reversal of policy.

The 1922 British Empire Patent Conference

The Comptroller’s 1919 Memorandum was submitted to the 1921 Conference of Prime Ministers and Representatives of the United Kingdom, Dominions and India,68 and the whilst the latter did not consider it in any detail, they did refer it to a Committee, which proposed a Resolution which was adopted by the full Conference, recommending a meeting of Patent Office representatives “to consider the practicability of instituting a system of granting patents which should be valid throughout the British Empire.”69 This duly took place in 1922 as the British Empire Patent Conference,70 at which the delegates were the present or former heads of the patent offices of the self-governing Dominions and India, except that Newfoundland was again not represented,71 and that the Colonies and Protectorates were collectively represented by the Solicitor-General of the Straits Settlements.72

The Conference held 10 meetings at the Patent Office in London, between 12th and 23rd June 1922. At the first meeting, the delegates decided against admitting oral evidence from outside bodies, and no witnesses were in fact called or heard, although the British Patent Office as host provided data as to applications throughout the Empire, and the delegates themselves would have been well able to describe their local laws and practices. Formal discussions fell under four heads: (1) the present situation in the

67 Above, fn.5.

68 Summary of Proceedings and Documents, Cmd.1474 (1921).

69 Cite.


71 Consequently, the summaries of the law and practice of the Dominions which follow do not include Newfoundland. India, however, was included for the first time.

72 Mr G. Seth, who also appears to have acted as the author of the Conference Report.
Empire, (2) the desirability of a British Empire Patent, (3) the various schemes in contemplation and their respective degrees of practicality or difficulty, and (4) absent (or pending) agreement on a particular Empire Patent scheme, what other proposals might be made for increasing the uniformity of patent law and practice in the Empire.  

**The present situation in the Empire**

The present situation in the Empire was addressed primarily in terms of patent office procedure, rather than substantive law. For the closest possible approximation to full geographical protection throughout the Empire (excepting certain remaining Indian Native States, Malayan protected states, and some other small territories which apparently lacked patent protection altogether) at least 46 separate applications would be necessary. Initial fees would have amounted to £5 for the United Kingdom, £32 for the five self-governing Dominions and India, and £250 for the Colonies and Protectorates, of which there were now 39. It may be noted that the typical initial fee was around £5 or £6 regardless of the size or status of the territory. Maintenance or renewal fees were payable in the United Kingdom, India, three of the five self-governing Dominions, and in the majority of the Colonies and Protectorates. These amounted to £126 for the United Kingdom, £94 for the self-governing Dominions and India together, and £1,170 for the Colonies and Protectorates. Life-cycle fees for the whole Empire were therefore £1,677, equivalent to about £60,000 in today’s money, or roughly twice the real figure for 1902, after allowing for inflation. In one respect the situation had improved since 1902, in so far as both Australia and South Africa now had unitary patent systems, with modest official charges. In another it had worsened, not so much because of the number of Colonies and Protectorates acquired by the Empire since then, but because most of them (old or new) now charged fees at a level quite disproportionate to the likely value of any patent granted.

So far as application and formal examination were concerned, all applications in the United Kingdom, the self-governing Dominions and India were subjected to an examination for sufficiency of the description and for clarity and conciseness of the claims. Many Colonies and Protectorates provided for this, but few were in a position to put even this minimal level of examination into practice. An examination for novelty took place in the United Kingdom, in India, and in all the self-governing Dominions except South Africa. In the United Kingdom, the relevant prior art for examination was confined to United Kingdom patent applications of the past 50 years. In general, where examination
took place elsewhere it was confined to local patents or applications, but in some of the Dominions, notably Canada, the examiner was able to cite any example of prior publication or prior use which could legally be invoked to challenge novelty. So far as the Colonies and Protectorates were concerned, provisions might exist for conducting substantive examination, but this never happened in practice.

Oppositions, typically allowed on wider grounds than were relevant for examination, were available in the United Kingdom, in India, and in all the Dominions except Canada. To the extent that oppositions were provided for in the laws of the Colonies and Protectorates the relevant provisions typically lacked effective machinery, and were rarely if ever employed.

**The desirability of a British Empire Patent**

On the desirability of a British Empire Patent in principle the Committee entertained no doubts:

> “From this survey of the position as regards the application for and grant of patents throughout the Empire, the general position appeared to be by no means satisfactory. To obtain protection throughout the Empire requires numerous applications at considerable expense, and the fees for maintenance are very onerous in many of the Colonies and Protectorates. While the chief principles of patent law are substantially the same there is considerable divergence of practice and procedure, and there is no certainty that an invention for which a patent has been secured in the United Kingdom or in any part of His Majesty’s Dominions will necessarily receive the same protection in any other part of the Empire.”

And after resolving to preserve all existing rights and freedoms, the Conference declared that it approved the idea of an Empire Patent:

> “The Conference unanimously adopts the view that provided that that autonomy of the self-Governing Dominions and India is preserved and the rights and facilities at present enjoyed by an inventor throughout the British Empire are not affected, the institution of an Empire Patent is desirable as a means of cheapening the cost and simplifying the procedure of obtaining protection for inventions throughout the Empire.”

**The schemes**

Turning to the two schemes which had been proposed in the Comptroller’s Memorandum, the Conference fairly rapidly seems to have come to the conclusion that the first, or “Central Office”, scheme was unworkable in view of the geographical separation between the various parts of the Empire; and that its adoption in place of local patents (even supposing that to be acceptable to the Dominions

78 *ibid.*, pp.5-6. Subject to Canada having an interference-like procedure of little practical importance.

79 *ibid.*, pp.6-7.

80 *ibid.*, p.7.
and India at Government level) would be at the expense of inventors who only needed local protection in their part of the Empire. A Resolution was passed to this effect declining to recommend the scheme.  

Turning to the second scheme, any variant which required abolition of the search and examination for novelty in the local patent offices of the self-governing Dominions and India was unacceptable to them, and inconsistent with the Resolution the Conference had already passed providing for their continuing and undiminished autonomy. The possibility was raised of abolishing examination for novelty altogether, and in all patent offices, but this was no more acceptable, if for different reasons. On the other hand it was recognised that the present situation should not be allowed to become any more complicated, and that some form of central examination was desirable.  

With both schemes from the Comptroller’s preparatory Memorandum rejected, the Conference turned to consider other proposals. A proposal from non-Governmental sources suggested that appropriately staffed Empire Patent Offices should be set up in (at least) all the Dominions, that each should have the same full set of documents including all the prior art patents of the various parts of the Empire, and that each should conduct a search and examination according to uniform procedural and substantive rules. A patent granted by any one such office would be effective for the whole Empire. Not surprisingly, the proposal was rejected as unworkable: not only would it be impossibly expensive, but there was no practical way of replicating the necessary libraries of patents and applications, and no reason to expect that the decisions of the various offices would actually correspond in practice.  

The next scheme to be rejected was one proposed by India, under which patents would be granted by local offices after minimal examination, but would have effect throughout the Empire, possibly subject to some kind of registration requirement. Prior to any action for infringement a thorough search at a Central Office would be required, with the result of the search being published.  

Finally, the Conference attempted to devise a compromise scheme of its own, under which local offices would be retained for the issue of local patents for those who wanted them, combined with a Central Office which would grant patents for the whole Empire. The first proposal, by Mr. Seth (representing the Colonies), was that since United Kingdom patents probably received the best and most comprehensive search, they should be eligible for registration in the Dominions and Colonies without further examination. This was immediately declared as unacceptable to Canada and Australia, in as much as it gave United Kingdom applicants an advantage over local ones, and might result in the former being

81 ibid., pp.8-9.  
82 ibid., p.9.  
83 ibid., p.10.  
84 ibid., p.11.  
85 ibid., pp.11-12.
granted patent protection despite the existence of invalidating prior art in the country of registration. The proposal as it stood was carried no further, and it was agreed that any proposal involving a Central Office could only proceed on the basis that the latter would examine patent applications against prior art from all the self-governing Dominions and India, as well as the United Kingdom. It was also agreed that any patent so granted by the Central Office would have to be open to opposition in the United Kingdom, the Dominions and India, though generally not in the Colonies and Protectorates, where the only forum for challenge would be before the local courts.

After lengthy discussion, a preferred final scheme was drawn up and recommended with the following features:

“(a) The existing rights of the United Kingdom, the self-governing Dominions, and India to grant patents in accordance with their laws and within their own territories to be maintained in full.

(b) The establishment of a Central Patent Office for the reception and examination of applications for, and the grant of, patents which shall extend to the United Kingdom, or to any of the self-governing Dominions, or to India, upon registration in the particular territory in which protection is desired. The application for registration to be open to opposition before registration is actually effected.

(c) The Central Patent Office, in examining applications submitted to it, to make a search coextensive with the field at present covered by the searches now made in the United Kingdom, the self-governing Dominions and India collectively.

(d) The scheme suggested above to be equally applicable to all the Colonies and Protectorates, subject to the qualification that the application for registration shall not be open to opposition unless the existing law makes provision for the hearing of opposition to the grant of patents, but in any case the local Courts to be empowered to declare that an exclusive privilege has not been secured in the territories within their jurisdiction.

(e) The fees for registration to be of such amount as would result in a considerable reduction in the total cost of obtaining patents throughout the Empire at the present time.”

This scheme was commended as having the following advantages:

“(a) One application and one specification only will be necessary for obtaining the grant of a patent throughout the Empire.

(b) There will be one examination in respect of formalities, the sufficiency of the documents, and the novelty of the invention, and consequently after the application in the Central Office has been accepted there will be less uncertainty as to the fate of the application throughout the British Empire.

(c) There will in consequence be a very great diminution of expense, both in regard to the preparation, supply and printing of documents and as a result of the abolition of the local examination and search on each application. If registration fees throughout the Empire are small, a still greater diminution of expense will be effected.


(d) There should be a very considerable diminution in agency fees. It was not possible for the Conference to obtain reliable figures upon this point, but the general opinion was that the agency fees at the present time for obtaining a patent throughout the British Empire were considerably greater than the fees actually charged by the various Patent Offices. On the other hand, the increase of business which may be anticipated should substantially benefit the Agents’ business.

(e) A patent so granted and registered will have a considerably greater commercial value than any individual patent at present issued in the British Empire by reason of the wider search which will be made in the Central Office.

(f) The establishment of such a system will undoubtedly encourage applications in the other parts of the Empire and particularly so if the expenses are diminished. The Canadian and South African Delegates pointed out that the decrease in fees in their Dominions had led to a very large increase in applications and in the gross amount of fees obtained.

(g) It will reduce the overlapping of functions in the various Offices and tend to prevent the multiplication of expensive machinery for examination into novelty.

(h) Finally the Establishment of any such Imperial system will create a further bond of union between the various parts of the British Empire.”

The conference considered going one stage further, and providing for a “universal” search on the American or German model, but decided this would be over-ambitious.  

As to the cost of establishment of the preferred Final Scheme, the Conference noted that:

“Unless one of the existing Offices were selected for this purpose the cost of equipping and establishing such an Office will undoubtedly be great, but it might be hoped that the revenue would meet the current expenses of working if any existing Office were selected the cost would be greatly diminished, and would be incurred only in the supply of the new material required and the necessary staff and buildings.”

This was so even though the Conference simultaneously recommended very substantial reductions in official fees.

“The Conference was of opinion that it is essential to the success of the scheme that the fees for the registration and maintenance of patents, should, if possible, be small, and appreciably less than the fees at present charged. The present initial fees in the self-Governing Dominions and India are not unreasonable but they amount in the case of the Crown Colonies to a very considerable sum, and the renewal fees at present levied in the Colonies and Protectorates are excessive and in many cases prohibitive. The Conference thought in consequence that at any rate in the case of the Colonies and Protectorates renewal fees in respect of patents registered under the scheme should not be charged, and that the registration fee might well be fixed at a nominal sum, say £1.”

Perhaps with the proposed low level of fees in mind, the Conference recommended that the (Final) Scheme should be treated as a domestic matter within the Empire, and that any Dominion adopting it

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88 ibid., pp.15-16.
89 ibid., p.15.
90 ibid., p.16.
should be free to confine its benefits to British subjects.\textsuperscript{91} No express consideration seems to have been given to the position of those states (particularly the United Kingdom, Australia and New Zealand) which would simultaneously be members of the Empire Scheme, and the Paris Union with its obligation of national treatment. The need for greater uniformity of substantive patent law, if the scheme was to work, was noted. There was no suggestion that membership of the Final Scheme would be anything over than voluntary for the Dominions, and adoption by a substantial majority of the Empire was an essential precondition to its working effectively.

Pending the adoption of the preferred or definitive scheme with its Central Office, as well as the likely delays in equipping the latter with a full complement of staff and reference material, the Conference considered whether a provisional solution was possible. A \textit{provisional scheme} was indeed proposed,\textsuperscript{92} which substituted the United Kingdom Patent Office in place of the proposed Central Office, required no changes to existing United Kingdom practice as to search and examination, and provided for application for registration of the examined UK patent in the applicant’s choice of Dominions\textsuperscript{93} and Colonies within 12 or 36 months of grant in the UK.\textsuperscript{94} A certified copy of the accepted UK specification would be deemed (at least for the purposes of registration) to comply with all requirements of local law as to lodgement of specifications, sufficiency of description, and claims. However, since the UK Office might have overlooked prior art relevant to a particular territory, this would be subject both to ordinary opposition procedures in the Dominion of registration (though not in the Colonies\textsuperscript{95}), and to the patent offices of the Dominions (but again, not the Colonies) being able to refuse registration \textit{ex officio}, in particular on the basis of earlier local patents, other local prior publications, or local prior user. Registration and renewal fees would be set locally, with the hope that they would be reduced from present levels, or in some cases eliminated all together.

The resolution proposing the Provisional Scheme formally provided that:\textsuperscript{96}

\begin{quote}
(a) Existing rights of the United Kingdom, self-governing Dominions and India to grant patents in accordance with their laws and within their own territory to be maintained in full.
\end{quote}

\textsuperscript{91} \textit{Ibid.}, p.17.

\textsuperscript{92} \textit{Ibid.}, pp.17-19.

\textsuperscript{93} For present purposes, it is clear that the Committee intended to include India with the Dominions properly so called.

\textsuperscript{94} 12 months for the Dominions and India, for the Colonies the application period would be three years.

\textsuperscript{95} In the Colonies, it was intended that only the local courts would have jurisdiction, and this would be post-grant.

\textsuperscript{96} \textit{Ibid.}, pp.18-19.
The patent obtained by examination and grant in the United Kingdom Patent Office to extend to any of the self-governing Dominions or to India upon registration in the particular territory in which protection is desired; the application for registration to be open to opposition, and to any lawful objection which the head of the Patent Office where registration is applied for may think fit to raise, before registration is actually effected.

(c) The scheme suggested above to be applicable to any of the Colonies and Protectorates with such modifications as may be suitable to local requirements and administrative machinery.

The Conference went on to make detailed proposals for procedures under the Provisional Scheme, separately for the Dominions and the Colonies. In both cases, registration in the Dominion or Colony would be deemed to relate back to the date of grant in the UK, and the patent term would run accordingly. So far as the intervening period was concerned, there was to be a kind of continued use defence for bona fide defendants in the Dominions, but in the Colonies this was reduced to bare immunity from liability for infringement for acts actually performed prior to registration. In the Colonies, but not the Dominions, the rights conferred by the registration would automatically cease if the parent UK patent ceased to be in force. The Conference concluded:

“It will be seen that the provisional scheme while not possessing the full advantages of the ‘preferred’ scheme, will still be a great advance in simplicity and cheapness over existing privileges. It will equally prevent over-lapping of duties of the various patent offices and multiplicity of machinery, and may be expected to encourage and multiply applications in the various parts of the Empire.”

It also suggested that the number of ex officio objections by local patent offices would probably be very few; and that the reduction in paperwork, agency fees and official fees would be highly beneficial for users. The Provisional Scheme was also endorsed for its potential to prepare the way for the preferred or Final Scheme. Finally, the Conference considered proposals for standardisation of various miscellaneous aspects of law and practice, but these are outside the scope of the present article.

The 1923 Imperial Economic Conference

Two conferences took place simultaneously in London in the Autumn of 1923, a full Imperial Conference which was concerned with general policy issues, and an Imperial Economic Conference whose sessions took place in parallel. The Report of the 1922 British Empire Patents Conference was submitted to the 1923 Imperial Economic Conference, with a Memorandum by the Board of Trade which

97 ibid., pp.19-20 and 22-24 (Dominions and India); pp.21-22 and 24-26 (Colonies and Protectorates).
99 Imperial Economic Conference 1923, Summary of Conclusions, Cmd.1990 (1923); Record of Proceedings and Documents, Cmd.2009 (1924).
100 Above, fn.70.
reiterated the “definitive” and “provisional” schemes proposed in 1922, but recommended only the provisional scheme for further consideration. Consultations by the Board with the governments of the Dominions and Colonies indicated that out of those which had taken a position by April 1923, only Canada was opposed to the provisional scheme; but at that time Australia, Newfoundland, India and the Irish Free State had not replied, South Africa had taken no decision, and of the Dominions only New Zealand was (provisionally) in favour. Among the Colonies and Protectorates more seem to have been in favour of the provisional scheme than against, but with many undecided or uncommitted.

The 1923 Imperial Economic Conference established a Patents Committee to examine the proposals and report back, and the formal terms of reference of the latter also covered trade marks and designs. So far as patents were concerned, the remit and the deliberations of the Committee were confined to the adoption (or not) of the provisional scheme recommended by the 1922 British Empire Patents Conference, and the latter’s preferred or definitive final scheme with its Central Office received no further consideration.

The Chairman of the Patents Committee was again the Comptroller of the UK Patent Office, William Temple Franks, but apart from him, his deputy, and one of two secretaries, its membership differed entirely from that of the 1922 Empire Patents Committee. The latter had been made up almost entirely of senior or retired patent office officials, but the membership in 1923 was varied and predominantly non-specialist, and about equally divided between elected politicians and civil servants.

In view of what was to occur, the most interesting entry on the list of members of the Patents Committee is that for the Canadian representative, Dr O D Skelton. In contrast to most of the other appointees, no description or official position is given for Oscar Skelton. The two Imperial Conferences of 1923 in fact marked a turning point in Skelton’s life, as they were to do in Britain’s relationship with Canada, and the Empire as a whole. Up to then, Skelton had been a successful career academic, a prolific author of both scholarly and popular political and economic works, and an outspoken polemicist for Canada.

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101 The Memorandum (I.E.C. (23)—8), with the Committee’s recommendations as to the “definitive” and “provisional” schemes (but not the full Report of the 1922 Conference), is reproduced in the Record of Proceedings and Documents (fn.99 above), at p.431. Also in UK National Archives File BT 209/657.

102 ibid., p.432. The responses for the Colonies were updated to October 1923, by which time most were in favour, none of the Dominions having changed their positions.


104 From 1909 to 1925 he was Sir John A. Macdonald Professor of Political and Economic Science at Queen’s University, Kingston, Ontario; and Dean of Arts between 1919 and 1925.
asserting the fullest possible degree of national autonomy. The newly elected Liberal Prime Minister William Mackenzie King recruited him as a foreign policy adviser after hearing him speak on Canadian foreign relations in January 1922, and in 1925 he would resign his academic positions to serve as Under-Secretary of State for External Affairs until his death in 1941. He may have had an uncertain status in the Canadian delegation in 1923, but he was already the Prime Minister’s right hand man on foreign policy, and totally opposed to any hint of deference or subordination in Canada’s dealings with the United Kingdom.\footnote{In preparation for the main 1923 Conference Skelton produced a briefing paper for Mackenzie King on “Canada and the Control of Foreign Policy” (unpublished), and King incorporated much of this into his addresses to the Conference: Stacey (1981), at p.66. Professor Stacey describes it as “an able and in many ways an impressive paper, but ... extraordinarily partisan. ... [I]t may have been good politics, but it was very bad history.”}

The Patents Committee held just three meetings in October 1923, of which the second was occupied with a visit to the Patent Office. At the first meeting, Dr Skelton confirmed his country’s written position that it was unable to accept the provisional scheme as there was no provision to extend patents granted in Canada to the United Kingdom.\footnote{Imperial Economic Conference, 1923, Record of Proceedings and Documents, Cmd.2009 (1924), p.435. (Page references are to this Report). The typewritten draft Report of the Patents Committee is in BT 209/657.} Of the other countries represented, only New Zealand was unequivocally in favour of the scheme; Australia and South Africa were cautiously supportive but hardly enthusiastic; India disliked the lack of reciprocity and the preferential treatment of United Kingdom applicants; Newfoundland was willing to accept whatever the Committee decided; and the newly independent Irish Free State was at too early a stage in formulating its patent policy to contribute. A large proportion of the Colonies and Protectorates were said to support the scheme, which differed little from the \textit{de facto} regime of registration to which many of them already subscribed.

Though there was disagreement on some matters of detail, as regards matters of principle the decisive issue was the absence of reciprocity. The opinion of the Comptroller as Chairman was that reciprocity was impossible in view of the different degrees of development of the various local patent offices, but that even if there should be any Dominion offices with comparable facilities and capabilities to that in London, then reciprocity would still be wasteful and uneconomical. In a memorandum circulated after the impasse at the first meeting he argued that:\footnote{\textit{ibid.}, p.436.}

\begin{quote}
“(i) A Complete Reciprocity not Possible.

A complete reciprocity of practice under the Provisional Scheme appears impossible owing to the differences of practice and procedure in the various offices of the Empire. It is practically admitted that the United Kingdom Patent Office is the one which at the present time possesses the most complete and efficient system, and consequently is most suited to act as a Central Office for the Empire.

\end{quote}
(ii) A Complete Reciprocity Wasteful and Uneconomical.

Even assuming that all the Patent Offices of the Empire were of equal efficiency, the mere fact that reciprocity could be accorded would not prevent such a system from being both wasteful and uneconomical. The reciprocal registration of Dominion Patents would not only introduce additional complications, but would accentuate the tendency towards the multiplication of Offices all performing the same difficult and technical examination of specifications, which it is the main object of an Empire Patent Scheme to prevent. The burden of the inventor would consequently be increased instead of decreased.

(iii) No Derogation of Autonomous Rights and no Undue Preference.

There is no real derogation of any powers at present exercised by the Dominions in the voluntary selection of an Office elsewhere for the purpose of making the necessary examination of an inventor’s claims.

(iv) Advantages to Empire Inventors

The advantages which would accrue from the Provisional Scheme are advantages which will accrue not only to inventors in the United Kingdom, but to inventors throughout the British Empire.”

These arguments notwithstanding, when the third and final meeting of the Committee took place Skelton (for the Canadian delegation) remained adamantly opposed, and the Indian representative remained doubtful. There was no support among the other Dominions for taking even the so-called provisional scheme forward without acceptance from these two. In the result, the Committee united in praising and burying the provisional scheme in the same breath: commending it to the Colonies and Protectorates, while admitting that they were unable to support its adoption for the Empire as a whole. In view of the lack of progress on patents any consideration of designs and trade marks was considered futile. The Committee adopted a Resolution which reflected the impossibility of further progress, and in due course this was adopted by the Conference itself:

“This Imperial Economic Conference have given careful consideration to the Provisional Scheme recommended in the Report of the British Patent Conference, 1922, and they are of opinion that, apart from one or two details which might receive further consideration by correspondence between the heads of the Patent Offices, the Provisional Scheme is a practicable one, and promises considerable advantages to British inventors throughout the Empire; but in view of the difficulties felt by the Dominion of Canada as regards the absence of any provision for reciprocal registration of Dominion patents, the Conference feel unable to make any recommendation so far as the Self-Governing Dominions and India are concerned.

The Conference, however, unanimously agree that it is very desirable that the Provisional Scheme should be adopted by the Colonies and Protectorates, and that considerable benefits would thereby be derived by inventors throughout the Empire.”

108 ibid., p.437.

109 ibid., pp. 430, 437. The resolutions are identical except for the substitution of “This Imperial Economic Conference” for “The Committee”, and minor consequential amendments.
Canadian strategy at the 1923 Conferences

To understand the failure of the 1923 proposals, it will be necessary to look rather more closely at the position of the Canadian Prime Minister, Mackenzie King, and the role of his special adviser, Oscar Skelton. William Lyon Mackenzie King so dominated Canadian politics from 1923 to 1948 that it is worth remembering that in 1923 he was known only as the recently-elected leader of the incoming Liberal government, with next to no experience of political power, high office or international diplomacy. King acted as his own Minister of External Affairs, and the civil service department supporting this function was not only small and ineffective, but from King’s point of view highly suspect in its loyalties. King and his Liberal Party had been elected on a platform of Canadian nationalism, and he suspected his civil servants of being far too attached to the Imperialist mindset of the recently defeated Tory government. His response was to place his trust in Skelton.\(^{110}\)

“King, within himself a very insecure man, approached his first Empire conference with trepidation: ‘It is much worse than a general election.’ But he had one great resource and comfort: O.D. Skelton, who now joined him for the first time.”

King’s strategy at the main 1923 Conference was cautious, and predicated upon his own position at home, and on the recent side-effects of two international events which had as little to do with patents as one can imagine. The first of these was the “Chanak Crisis,” a late development in the Turkish war of independence which had followed the break-up of the Ottoman Empire. With the victorious Turkish forces apparently on the point of regaining control of the Dardanelles if they were to attack a small British garrison, the Cabinet sent an urgent request to the Dominions appealing for diplomatic and military support. The particular quarrel between Britain and Canada arose from the fact that before any official response was possible, Lloyd George and Churchill unilaterally issued a public statement whose bellicose terms seemed to imply that the support of the Dominions was a foregone conclusion. It did not help that the public message inevitably overtook the private one, so that King himself first heard about the call to arms from a journalist, nor that the issue of military support for Britain was bitterly divisive within Canada.

The second event was more peaceable, but not entirely uncontentious. Canada and the United States had recently negotiated a treaty to redress over-fishing of Pacific halibut\(^{111}\) off their North-Western coasts.\(^{112}\) This was clearly of no practical interest to anyone except the parties themselves, and if normal practice had been followed then the Canadian plenipotentiary would have signed for Canada, with the British Ambassador in Washington adding his countersignature on behalf of the Empire as a purely

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\(^{110}\) Stacey (1981) at p.66 (citation omitted).

\(^{111}\) *Hippoglossus stenolepis*.

symbolic or ceremonial matter. The ceremony or symbolism, though, was sufficiently potent to be objectionable to the new Liberal Government, so King proposed to assert Canadian autonomy by dispensing on this occasion with the British countersignature, and after a diplomatic spat with the Foreign Office in London he carried the day.\textsuperscript{113}

Against this background, King had two negotiating priorities at London in 1923, driven as much by the need to maintain support for his party and Government at home, as by his own personal convictions. The first was to avoid as far as possible any legal or \textit{de facto} involvement in the foreign policy of the Empire, which in effect was the foreign policy of the United Kingdom government of the day. The second was to assert Canada's right to conduct its international relations in its own best interests, with no British or Imperial oversight unless genuinely Imperial issues were engaged. King had appointed Skelton as his personal adviser for the Conference precisely because the latter's nationalist and anti-Imperialist views seemed perfectly to match his own, and in Skelton's case they were supported by intellectual abilities to which King made no claim. It might be thought that the Empire Patent was perfectly consistent with both of these desiderata, but not so in the minds of the Canadian delegation.

Skelton himself was always profoundly suspicious of any British initiative which had any potential at all to undermine Canadian autonomy. According to one Canadian historian:\textsuperscript{114}

“He [Skelton] never stopped believing that behind almost every British Government scheme—constitutional, economic, military—lay a dark desire to introduce a consolidation of empire, or, at the very least to compromise Canadian freedom of action. Some of his adversaries thought him anti-British; all found him stubborn and difficult in defence of Canada.”

By way of a specific example at the 1923 Imperial Economic Conference, Skelton advised King:\textsuperscript{115}

“The proposal [for an Imperial advisory committee for economic co-operation] is simply another variant of the endless schemes for establishing a central government in London. Parliament or council or secretariat, it matters not, so long as the machinery of control can somehow be established in London.”

With respect to the 1923 Conferences as a whole, Skelton's advice to King seems to have been to oppose every policy initiative which had any tendency towards integration or centralisation, in whatever context, and regardless of the merits of any individual proposal. Skelton himself put that policy into effect in the Patents Committee, where he had a formal role, but the results were felt across the whole agenda. The

\textsuperscript{113} Even this episode was unnecessarily embittered by King releasing confidential inter-governmental correspondence without permission from the opposite parties, to the embarrassment of the British Government and the annoyance of the United States.

\textsuperscript{114} Hillmer (1976) at p.75. Hillmer does not underestimate Skelton, of whom he writes that “few men can have played a more important role in Anglo-Canadian history.” (\textit{ibid.}, at p.63).

\textsuperscript{115} King Papers, J4/85: memorandum, 2 October 1923; quoted in Wigley (1977), at p.202. On this occasion, the proposal went to a vote and was adopted by a majority despite continuing Canadian opposition.
way Canada’s position in 1923 is summed up by Professor Wigley demonstrates that Skelton’s unceremonious blocking of the Empire Patent proposals was entirely consistent with his policy for Canada across the board:116

“For both political and ideological reasons, therefore, the Canadian delegation to the Imperial Economic Conference maintained an attitude of wary independence. On schemes where participation held no hidden implications for Canadian autonomy, and where Britain and the dominions stood properly on an equal footing with each other in accordance with accepted notions of their status as commonwealth partners—the standardization of customs procedure, the development of forestry resources—cooperation could be accepted readily enough. But even at this routine administrative level other proposals were just as quickly rejected by the Canadians. A plan for registering patents, for instance, or another for the joint publication of trade statistics in London, came up against a Canadian veto because the practical responsibilities would rest disproportionately on the British government. Even where an imperial organization served Canada’s interests directly, still the government’s hostility to permanent centralized institutions proved to be implacable. In this way the Imperial Shipping Committee, set up on an ad hoc basis in 1920 and by 1923 of proven utility to the British and dominion authorities alike, was prevented by the Canadians from attaining a permanent status. They could endorse a resolution which praised the committee’s work, and in the coming years would continue to keep it busy with Canadian problems, but they would not see it established on a full-time basis.”

The reasons for failure in 1923

Why did the project for an Empire Patent fail so suddenly in 1923, after so much appearance of progress and agreement in the previous few years? Was it always an impossible dream, whose inherent failings and contradictions were suddenly and brutally exposed? Or was it like an innocent bystander in the gang warfare of the time, casually gunned down in a fire fight between old and new contenders for hegemony? Certainly, the Empire Patent had the consistent misfortune to be in the wrong place at the wrong time. After twenty years languishing at the bottom of the agenda, in company with such hopeless causes as decimal coinage and the metric system, it found itself at the centre of attention just as the Canadians, and Skelton in particular, were spoiling for a fight. It might be added that Canada, of all the Dominions, instinctively took a negative and defensive attitude to patents, reflected in the fact that the main preoccupation of their legislation was less to reward or encourage innovation, than to avoid having their economy dominated by foreigners.

This simple and compelling explanation for its failure is largely independent of anything to do with the merits or demerits of the Empire Patent scheme, and the conclusion would be consistent with the composition of the relevant Committee in 1923. Only the British delegation seems to have included any patent experts; and the Comptroller, William Temple Franks, was simultaneously Chairman. Though elected to this role, his position was itself a symbol of the old order, and may have been a source of conflict and embarrassment once it turned out that many of the countries represented were to a greater or lesser degree suspicious of any proposal which seemed too much centred on the United Kingdom.

116 Wigley (1977), at p.203.
Between a British Chairman who was a civil servant and a patent specialist, and other countries’ delegates who were typically neither of these, and who had no pre-existing moral commitments to the Empire Patent from previous negotiations, there was bound to be something of an impasse once consensus broke down. Perhaps a politically more astute Chairman could have outmanoeuvred Skelton, or called his bluff and found common ground for progress with the other delegates, as happened with the Imperial Economic Committee. On the other hand, a committee composed of patent specialists without political agendas of their own to pursue, like that of 1922, might have recognised the self-destructive quality of the reciprocity argument, and put national differences to one side in pursuit of a successful outcome. We shall never know.

However, while Dr Skelton was no patent specialist, he was an experienced economist, and he had a reputation for hard work and for being on top of his brief. He would certainly have noticed that reciprocity in patent-granting status was an issue on which Canada had a more plausible claim than any other participant; and it needed no great insight to see that if reciprocity looked like being conceded to Canada, then other Dominions would insist on it for themselves, and the whole scheme would fall apart. But it may be worth going on to consider whether a deeper level of dialogue was being conducted between Skelton and the Comptroller, and whether the apparently simple issue of reciprocity for Canada was more subversive than appears at first sight.

**The Problem of Canadian Reciprocity**

We have already seen numerous respects in which Canadian patent law and practice differed markedly from that in the United Kingdom and the rest of the British Empire, and often resembled much more closely the law and practice of the United States. This was no coincidence. To Canadians, the United States was simultaneously their only neighbour, their biggest trading partner, and a benign but ever-

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117 Above, fn.114. Skelton himself had referred to the Imperial Conferences as “these international poker games”: Wigley (1977) p.187 at fn.28, citing the first draft of Skelton’s paper “Canada and the Control of Foreign Policy” (above, fn.105).

118 Wigley (1977), at p.186, writes that Skelton “assumed control of the Canadian preparations for the Imperial Conference, prodigiously mastering the details of the subjects under review and turning out a wide range of comprehensive memoranda whenever required.”

119 It is quite likely that Skelton would have read the approving comments of Dr Findlay at the 1911 Conference (above, fn.57), either in the course of preparing for the 1923 Conference, or previously while researching his biography of the former Canadian Prime Minister, Sir Wilfrid Laurier. Laurier was present at the meeting, but only contributed the cautious remark “there is a good deal to be said in favour of what you say, Dr Findlay, but I think that if you adopted Sir Joseph Ward’s suggestion for uniformity at the present time that is as far as we could go.”

120 For example, the “first-to-invent” principle, the grace period, caveats, the effective absence of oppositions, and Global evaluation of novelty. Other unusual aspects of Canadian law, and in particular the strict forfeiture provisions for importation and non-working, had no such counterparts, but were undoubtedly motivated by Canada’s proximity to the United States.
present threat to their economic and cultural independence. Most relevantly for present purposes, Canada had adopted substantive examination of patent applications slightly before the United Kingdom; and on the face of the statute the Canadian Patent Office conducted a much more thorough search and examination than its UK counterpart, being unconstrained by the national origin, nature, or date of any relevant prior art.\textsuperscript{121} No other patent office in the Empire (and very few in the World) so much as pretended to do nearly as much. The claim of Canada to equal or reciprocal treatment for its own examined patents therefore had to be taken seriously, even if it was common ground that such treatment would have been premature for the patent office of any other Dominion or Colony.

However, if Canada’s claim to reciprocity was indeed based on an assertion of at least equal standing with the United Kingdom Patent Office, then it fails to stand up to examination. A description of the Canadian Patent Office, its Library, and its working methods by a visiting patent attorney from Washington just ten years later reveals a very different state of affairs.\textsuperscript{122}

In theory, the Canadian Act authorised the examiner to take into account all kinds of prior art, including foreign patents, books, and periodical literature. In practice, Rule 28 confined the actual field of search to Canadian patents. This must have been difficult enough, because Canadian patent specifications were never printed, and the only material the examiner had available to consult consisted of offprints of claims from the Office’s official journal,\textsuperscript{123} copies of drawings, and the original patent files if he called them up from store.\textsuperscript{124}

“No copies of Canadian patents are printed, and only typed or photostat copies can be ordered, at considerable expense. Until recently, the Canadian Record has usually printed three claims and one figure of a patent, but this has been reduced to printing one claim. For routine searching, the examiner has before him only the claim clipped from the Canadian Record and pasted on a card, and a complete lithographed set of the drawings. To obtain detailed information concerning a patent that seems of probable pertinency, he must order the patented file from the record room.”

The Office Library consisted of a single room of 50’ by 40’, with further storage off site. All new patents issued by Great Britain, Australia, the United States, France, Italy and the USSR were currently taken, with a wider selection of patent gazettes, but Germany was completely unrepresented. There were complete back sets of British patents and British Abridgements, and a near-complete back set of United

\textsuperscript{121} In the UK, the search and examination were confined to UK patent specifications published in the previous 50 years.

\textsuperscript{122} R Ould, “The Canadian Patent Office and its Library” (1933) 15 Journal of the Patent Office Society 380. With the possible exception of holdings of technical reference books (attributable to the initiative and generosity of an examiner who had retired before 1920) there is no suggestion that the state of the Office or its facilities had deteriorated over the previous decade.

\textsuperscript{123} The weekly Canadian Patent Office Record and Register of Copyrights and Trade Marks.

\textsuperscript{124} Ould (1933), at p.383.
States patents, but those after 1912 were unbound. Multiple copies of the United States Patent Office Gazette were received, but none were bound. Holdings of non-patent technical journals and books were very limited and in the latter case mostly obsolete, and translation resources were confined to one member of staff bi-lingual in English and French.

There were two grades of examiners, principal and assistant, with 19 of the former and one of the latter. With clerical staff (76), administrators, and senior officers the total headcount was 102. In 1932 (fiscal year) this staff handled 11,940 applications and issued 11,062 new patents, plus 62 reissues. With a working week of 5½ days (including Saturday mornings) this corresponds to each granted patent receiving on average about half a working day’s attention from an examiner; or to each examiner being responsible for the grant of about 550 patents per year. The income of the Office from patent-related fees was $399,286, and its surplus was $278,985 (which was rather less in 1932 than usual). It was perhaps with the quantity, rather than the quality, of the Office’s output in mind that the visitor commented:

“The results obtained by the Canadian Patent Office with a small examining staff and limited library and search facilities and a small budget, and the large annual profit turned in, are impressive.”

Be that as it may, from the point of view of the Comptroller the first and most obvious consequence of reciprocity between Canada and the United Kingdom would have been that Canadian patents, examined for patentability according to standards which diverged significantly from those of United Kingdom law, would have been entitled to automatic registration and respect in the United Kingdom and the rest of the Empire. Of course from the point of view of Canada the opposite applied: dubiously valid United Kingdom patents would have been entitled to registration and respect in Canada. However, for Canada the objection to reciprocity ended there and then; or, at the most, two years later, when Canada’s draconian non-working clauses could be relied on to take their toll of the majority. For the United

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125 Twenty technical journals were received by paid subscription, and fifty or so were received in exchange for the Canadian Patent Office Record.

126 By way of comparison, the British Patent Office at about the same time had just over 300 examiners, dealing with approximately 25,000 complete specifications per year. (Figures for 1930 in Cmd.3829 (1931), Appendix III, see fn.135 below). In round terms, each UK examiner had an output of about 80 patents per year, or rather less than two patents per week, as opposed to two per day in Canada.

127 Converting these figures into modern values is doubly imprecise because one has both inflation and exchange rates to allow for, but this annual surplus would be very approximately of the order of £2,500,000 in today’s money.

128 Ould (1933), p.388.

129 Compare above fn.37.
Kingdom, both in its own right and as the political and industrial leader of the Empire, there was a much more serious problem to follow, and it was one which cut only one way.

The fear of being technically dominated by their neighbour to the South explained several features of Canadian patent law, especially the imposition of strict economic clauses to pre-empt any monopolistic practices. Even so, in the early 1920s barely one tenth of granted Canadian patents were issued to Canadian residents—so dominance of United Kingdom or Empire industry by Canadian nationals was nothing to worry about. The majority of Canadian patents, by a large margin, were in fact issued to United States inventors. The article by Ould\textsuperscript{130} states that in 1932, of the 11,124 patents issued in Canada, 7,465 were to residents of the United States, 1,084 to residents of Canada; 921 to residents of the United Kingdom, 123 to other British possessions and 1,531 to all other countries.\textsuperscript{131}

When the British Empire Patents Committee had briefly discussed international relations in 1922, it had preferred to open the proposed Empire Patent system only to nationals of the Empire, although it is far from clear that this could have been done consistently with the United Kingdom’s obligations under the Paris Convention. For such a restriction to be effective would, in any event, have required the co-operation of the Dominions including Canada itself, and Canada was simultaneously asserting its right to pursue its international relations on its own terms, unencumbered by British or Imperial instructions. Unless the proposed Empire patent system could indeed have functioned as a closed shop, strictly confined to Empire nationals in fact as well as theory, then Canadian insistence on reciprocity would potentially have opened up the entire Empire to the numerous patent applications already being filed by American inventors in Canada. These applications would have been examined by overworked and under-resourced Canadian examiners according to Canadian law and practice (though in reality only against Canadian patents as prior art), and on issue by the Canadian Patent Office (with no opportunity for opposition) they would have taken effect not only in Canada, but potentially across the entire British Empire. In the name of reciprocity between the mother country and a particular Dominion, the whole Empire would have opened itself up to a flood of dubiously valid American-owned patents, without reciprocity (or consideration of any kind) from the Americans themselves.

As I say, it is impossible to know whether either party to the 1923 negotiations had anything like this scenario in mind, but it goes some way to explaining why Canada and reciprocity made such a particularly dangerous mix. And although this analysis is admittedly speculative, it is by no means fanciful. For much of the twentieth century American publishers and media interests obtained most of

\textsuperscript{130} Above, fn.122.

\textsuperscript{131} The percentage granted to United States residents was then on an upwards trend: 1930, 63%; 1931, 65%; 1932, 67%. It may seem barely consistent with the number of filings of United States origin that in 1932 only 1,381 applications were filed under the Paris Convention, but Canada (like the USA) had a first-to-invent system with a one year grace period, so that the possibility of self-anticipation for United States applicants was easily avoidable.
the benefits of the Berne Convention by such stratagems as arranging for so-called “simultaneous” publication in Canada, without having to concede to the rest of the world any of the obligations which Berne membership would have entailed.

1926, and another Balfour Declaration

The principal Imperial Conference of 1923 had ended inconclusively in so far as it had attempted to find a new constitutional settlement for the Empire. This discussion was resumed at the Imperial Conference of 1926,\textsuperscript{132} resulting in what became known in Commonwealth circles as the “Balfour Declaration”:\textsuperscript{133}

“[W]e refer to the group of self-governing communities composed of Great Britain and the Dominions. Their position and mutual relation may be readily defined. They are autonomous Communities within the British Empire, equal in status, in no way subordinate one to another in any aspect of their domestic or external affairs, though united by a common allegiance to the Crown, and freely associated, as members of the British Commonwealth of Nations.”

Though the status of Canada and the other Dominions was now fully assured, the Empire Patent was dead forever. No attempt was made to reintroduce it at this or subsequent Imperial Conferences. Both Canada and Australia ratified the Paris Convention in their own right in 1925, symbolically affirming their equal international status with the United Kingdom in patent matters.\textsuperscript{134} The Sargant Committee, which examined all aspects of British patent law and practice between 1929 and 1931, received some renewed suggestions that patents granted in the United Kingdom or the Dominions should extend throughout the whole Empire, but in view of the outcome of the 1923 Imperial Economic Conference, it declined to make any recommendation to that effect.\textsuperscript{135} The Committee did note with satisfaction that 32 Crown Colonies and Protectorates now provided for the registration of British patents.

\textsuperscript{132} Imperial Conference, 1926: Summary of Proceedings, Cmd.2768 (1926); and Appendices, Cmd. 2769 (1926).

\textsuperscript{133} Named after Arthur Balfour, the former Prime Minister and First Earl of Balfour, who was Chairman of the Committee on Inter-Imperial Relations at the 1926 Conference. The Declaration subsequently became the basis for the Statute of Westminster, 1931. There is a certain potential for irony in the passage which immediately follows the Declaration: “A foreigner attempting to understand the true character of the British Empire by the aid of this formula alone would be tempted to think that it was devised rather to make mutual interference impossible than to make mutual co-operation easy.”

\textsuperscript{134} Australia had already acceded to the Convention in 1907 by virtue of an appropriate Declaration by the United Kingdom Government under Art.16bis, likewise Canada in 1923. See fn.24, above, and Ladas (1978) §65.

\textsuperscript{135} Report of the Departmental Committee on the Patents and Designs Acts and the Practice of the Patents Office, Cmd.3829 (1931) at p.70.
Lessons and conclusions

This article began by asking if there were any lessons for the Community Patent in the story of the British Empire Patent. At first sight the answer is probably “no”. Unless one takes the view that every one of the various proposals for the Empire Patent was incurably flawed in some way, then it does seem to have been the victim of a particularly unfortunate combination of circumstances—and personalities—which occurred at a unique juncture in the history of the British Empire, and which have no obvious correlation, past or present, to circumstances in Europe today. None the less, it may be instructive to see how the two compare, and how they differ.

The British Empire Patent had several factors in its favour which proponents of the Community Patent can only envy: the latter is bedevilled by issues of languages and translations, but no one ever contemplated using any language but English for the Empire Patent; judicial arrangements (another bugbear of the Community patent) never caused any problem for the Empire Patent either (although this may have been because of the restricted patent office mindset of its proponents, and the lack of outside consultation); exhaustion of rights was never even mentioned, and as late as 1923 few would even have understood what it meant. More generally, the numerous differences in law and practice across the Empire should not be allowed to obscure the fact that the major participants shared a common culture, a common legal heritage, and what was at bottom a common system of substantive patent law.

Compare this to the Community Patent in its present stage of development. On the positive side, the European Patent Convention has already achieved much more than was ever expected of the less ambitious variants of the British Empire patent, and has demonstrated that communication with a central office from afar is no longer an issue, at least within one Continent. Substantive law has also been harmonised quite thoroughly over the past half-century as a result of the Strasbourg and Munich (European Patent) conventions, and the voluntary adoption of norms from the unratified Community Patent Conventions of 1975 and later. Most importantly, prior art is defined on a world-wide scale and is therefore the same (bar minor exceptions) for every state in Europe. One may compare this to the self-destruct mechanism implanted in the British system from the time of the Statue of Monopolies, as a result of which uniformity of substantive law virtually guaranteed that no two patents in different parts of the Empire would have their validity evaluated against the same prior art. Although language remains a major problem for the Community Patent, some other potential rallying points for chauvinism have long

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136 Even bilingual Canada said nothing about the use of French as well as English.

137 Convention on the Grant of European Patents (Munich, 1973).


been foreclosed: there was never any serious challenge to siting the European Patent Office in Munich, nor to Luxembourg being the seat for any superior judicial institutions for the Community Patent, no matter how inconvenient for litigants that will be. National patent offices would remain open for accepting applications of all kinds, and for granting patents restricted to the relevant local territory.

Perhaps the strongest point of comparison between the two proposals, though, is that the Empire and Community patents were both essentially political proposals, and both were originally motivated as much by a federalist or integrationist agenda as by any special concern for the real interests of patent users, industry, or society at large. Both have been characterised more often than not by political posturing, secret negotiating sessions, and desultory (or non-existent) consultation with interested parties.

Consistently with this analysis, both proposals exaggerated the scale of the problem they claimed to address, and both oversold the benefits of the proposed solution. Gerald Balfour’s speech in 1902 makes entertaining reading, but it begs the question of whether any rational businessman should be at all worried on discovering that it was neither cheap nor easy to take out 25 patents in 25 Colonies, when all but a few of those were tiny economic backwaters with no industry to speak of, few consumers with any money to spend, and no reliable means of enforcing any patent which might be granted. True, extractive industries and their associated technologies were central to the economies of several Colonies (especially those that were colonised for that very reason), and in others patented technology might be important in processing local staple agricultural crops, but industrialists in these specialised fields would know how to cope, and in neither case did this give rise to problems of general concern.

It might have offended Mr Balfour’s sense of patriotism that it typically made much more sense for Britain’s own manufacturers and exporters to obtain patents in Germany, France and the United States, but businessmen are used to putting profit ahead of pride and patriotism alike, and who is to blame them? Likewise, in Europe, the Commission has continued to assume that industry and inventors are seriously disadvantaged if they cannot easily take out patent protection in all 25 Member States of the Community, from Portugal to Estonia. There are a few industries (principally pharmaceuticals) where something approaching such blanket coverage is indeed sought after, but most industries have long since realised that patents in half-a-dozen well-chosen states (at most) are quite as effective in practice as patents in all 25. It is a tribute to the success of European integration that this is so.

Since both proposals were at least in part vehicles for a particular political agenda and its associated world-view, it is neither surprising nor particularly unfair that both succumbed (the Empire Patent permanently, the Community Patent we know not) to essentially political opposition. At the crucial point in time each appears to have been the victim of a single determined objector with an axe to grind: Canada in the case of the Empire Patent; and most recently France, in the case of the Community Patent. Neither of these opponents was concerned with the merits of the proposal, but with some collateral issue. Canada would not allow the sole office for the Empire Patent be in London, and France would not
allow the sole language of the Community Patent to be English. In both cases, there were enormous advantages to be had from standardisation, and no remotely credible alternative, but national pride insisted otherwise, and pride prevailed.

Is there any hope for the Community Patent to be drawn from this catalogue of missed opportunities in an Empire on which the sun has indeed long since set? It is suggested that there is indeed one clear distinction, and it is one which may make all the difference. It has already been pointed out that both proposals pursued an integrationist political agenda, thinly disguised under a façade of business-friendly rhetoric. But there are crucial differences. The components of the British Empire were drifting further and further apart throughout the twentieth century, and nothing could have stopped this. Efforts to preserve the Empire’s indefinable, but perfectly genuine, sense of identity might reverse or slow the trend for a time, but they were always fighting against a tide which was flowing in the opposite direction. Gerald Balfour’s 1901 commendation of the Empire Patent as “a means of giving practical expression to the desire for closer union among the scattered units of the Empire,”140 was wishful thinking by 1923.

The Community Patent has its own obstacles to acceptance, but though it may mark time, it is at little risk of being forced backwards. It can afford to be carried along with the tide in a Community which is far from having exhausted the opportunities for further integration. Progress for the Community Patent may be slow and uncertain, but it is hardly contrary to the zeitgeist in the same sense that the Empire Patent was fated to be an integrationist programme, within a gradually disintegrating polity. The peculiar misfortune of the Empire Patent was to have become a focal point for opposition to Britain’s Imperial hegemony, at a time when the tide against the latter was flowing at its fastest and roughest.

140 Above, fn. 41.