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The Rise and Fall of the United Kingdom's Forgotten Utility Model

The Utility Designs Act 1843

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As discussed throughout this volume, utility models are a form of intellectual property law that offer protection for 'minor inventions' through a regime similar to the patent system.¹ The German *gebrauchsmuster*, introduced in the 1891 Utility Models Act, is widely regarded as the prototype for such second-tier protection.² Indeed, Hausser (1987) said that 'the utility model, as an industrial property right, was "invented" in Germany'.³ Utility models have also been seen as foreign to the United Kingdom. The Department of Trade and Industry's Green Paper on *Reform of the Law relating to Copyright, Designs and Performers' Protection* (1981), a follow up to the Whitford review of the British law of copyright and designs, declared that the United Kingdom has 'set its face' against such a scheme.⁴ In this chapter, we argue that while it has often been suggested that utility models are a product of late nineteenth-century German thinking and that they are foreign to the United Kingdom, utility model protection was first introduced to the United Kingdom in the Utility Designs Act 1843.⁵ As such, it is clear that utility model protection has a long-established (albeit somewhat tarnished) pedigree in British law and that utility model protection came into force in the United Kingdom some fifty years before its German counterpart. In this chapter we highlight the key features of the Utility Designs Act 1843, the way the Act was received, and speculate on the reasons why the Act was forgotten.

¹ Turner 2019.

² On the German *gebrauchsmuster*, see Chapter 6. See also Isay 1932; Stringham 1935; Mott 1963; Vossius and Hallman 1985, 129–168; Hausser 1987, 314; Kretschmer 1987, 780; Liesegang 1992; Grosse Ruse-Khan 2012, 38–46; Königer 2017.

³ Mott 1963 233; Hausser 1987; Segade 2008, 135; Grosse Ruse-Khan 2012, 38.

⁴ Segade 2008, 135.

⁵ 6 & 7 Vict., c. 65. This has occasionally been recognised. See e.g., Ladas 1975, 949 (Great Britain may have been the first); Chen 1983; Weston 1983, 372, [15]; Llewellyn 1996, 3, n. 14.

3.1 THE BACKGROUND TO THE UTILITY DESIGNS ACT

In the early part of the nineteenth century, patent law in the United Kingdom, which was a blend of custom, prerogative, statute law and judicial intervention, was a mess. As the 1829 Select Committee investigation revealed, there was uncertainty over what was protectable, over the nature and function of specifications, and of the role of claims and drawings.⁶ Moreover, the system for the administration of patents that existed at the time was complex: in order to obtain a patent for the whole of the United Kingdom, patent applications had to be lodged in offices in London, Edinburgh and Dublin. In order to obtain an English patent,⁷ applicants needed approval from at least eight offices.⁸ The upshot of this was that the procedure for the grant of patents was both time-consuming and costly. As the *Report on the Signet* concluded in 1849, ‘the number of successive stages through which a patent for a new invention must pass before its final completion is productive of great trouble, delay and expense to the party seeking the grant, without any corresponding benefit to the public’.⁹ Furthermore, it was very difficult to ascertain the nature of pre-existing patents because existing patent specifications were (until January 1, 1849) deposited in any of three offices (Rolls, Petty Bag and Enrolment) so all three had to be searched in order to ascertain whether an applicant’s invention was new and therefore whether any resulting patent would be valid.¹⁰ The complex nature of patent administration not only meant that it was very difficult to ascertain the nature of pre-existing patents,¹¹ it also had knock-on effects for the cost of a patent, which in the 1830s might be as much as £250 or £300.¹² One commentator, using the soubriquet ‘Vindicator’, bemoaned in 1835 the ‘exorbitant fees demanded, paid to and received by certain automatons who represent certain antiquated bags and things, whose vested interests are deemed sacred’.¹³

If obtaining patents was problematic, so too was their enforcement, which could be very expensive and time consuming.¹⁴ Although interim injunctions were readily granted in relation to patents that had subsisted for some time,¹⁵ infringement was

⁶ Report from the Select Committee on the Law Relative to Patents for Inventions (1829) 3 PP.

⁷ Bottomley 2014b.

⁸ SCLPI 1829, 48–49 (Francis Abbott); Report on Signet 1849, ix; MacLeod 1988, 76; Bottomley 2014a, esp. 36–39 (detailing the 10 stages), 40–41 (describing stages for Scotland and Ireland). A popular account was provided by Dickens (1850, 73–75).

⁹ Report on Signet 1849, ix.

¹⁰ Following the Act to regulate certain Offices in the Petty Bag (1848) specifications were enrolled at the Enrolment Office of the Court of Chancery. Prior to that, most specifications were entered at the Rolls Chapel.

¹¹ But cf. Bottomley 2019 (highlighting the wide dissemination of patents through journals).

¹² Bottomley 2014b, 61; 2014a, 61–62 (putting cost at £145 for England, £90 for Scotland and £145 for Ireland).

¹³ Vindicator 1835.

¹⁴ Hindmarch 1851, 1–2 (summarising three problems of procedure, cost and enforcement).

¹⁵ Bottomley 2014a, 127–130.

determined through proceedings at law, which required a trial (at so-called 'nisi prius') and was then usually subject to legal review by the relevant court (Common Pleas, Exchequer or Queen's Bench) sitting in full (with the possibility of further trials and further reviews). However, to obtain relevant evidence, proceedings first had to be commenced in Chancery seeking 'discovery'. Writing to the *Morning Chronicle*, Cornelius Ward (a woodwind instrument maker who had patented a drum and a flute) cited a situation where a patentee decided against litigating 'for fear of the direful expense and hopeless chicanery of law'.¹⁶ And at a meeting of the Inventors Patent Law Reform League early in 1851, the chairman reported an instance of litigation over a patent for military drums that had lasted for five and a half years at an expense of £7,000.¹⁷

A second significant aspect of the intellectual property landscape was the early system of protection for designs.¹⁸ In the late 1780s, protection was provided by Parliament to the designers of patterns for printed calicos, linens, cottons and muslins.¹⁹ While this protection was initially limited to two months, in 1794 it was extended to three months.²⁰ By the 1820s and 1830s, calls were made for extension of these laws to cover a wider array of designs and for the lengthening of the term of protection. In the 1830s this movement for reform was linked to arguments for reform of the law and administration of letters patent, through proposals for the introduction of laws of 'art and manufacture'.²¹ While it ultimately proved impossible to obtain any real reform of patents, the push for the protection of designs bore fruit in the form of the Design Registration Act 1839,²² which provided up to three years protection, on registration, to designers of the shape and configuration of any article of manufacture.

While the 1839 Design Registration Act brought about a number of significant changes, it was soon replaced by two new Acts. The first was the Ornamental Designs Act 1842, which gave protection to designs for purpose of ornamenting any article of manufacture.²³ The other Act, which was passed the following year, was referred to variously as the Utility Designs Act, the Non-Ornamental Designs Act, the Utility Registration Act, the Configuration Act, the Registration Act, and (perhaps facetiously) 'the Useful Act'.

¹⁶ Ward 1850; Anon 1850e, 5 (editorial) (costs of litigation). Ward had obtained an injunction from the Vice-Chancellor in 1843 to restrain Thomas Key from infringing the drum patent, but at the trial in 1847, Cresswell J. instructed the jury to find there had been no infringement. On the cost of litigation in courts of law in this period, see Polden 1999, 8.

¹⁷ Anon 1851b.

¹⁸ Bently 2018, 177–183.

¹⁹ 27 Geo. 3, c.23 (1787).

²⁰ 34 Geo. 3, c.24 (1794).

²¹ Sherman and Bently 1999, 104–105.

²² 2 Vict., c.17 (1839).

²³ 5 & 6 Vict., c.100 (1842).

The main impetus for reform was that the designers of patterns for cloth printing, previously protected automatically under the Calico Printers Acts, decided that they were prepared to accept registration as the quid pro quo for extension of the term of protection from 3 months to 9 months.²⁴ At the same time, the Registrar of Designs, F. B. Long, took the opportunity to rectify problems in the operation of the 1839 Registration Act.²⁵ The vague language of that Act, which *The London Journal of Arts and Sciences* described as ‘an undigested chaos of confusion, inutility and obscurity’²⁶ had led to the registration of many designs for objects of utility (some of which were enforced successfully, as in *Grassby v Westerdale* (Patrinton petty sessions 1842),²⁷ while others were treated as invalidly registered: *Evans v Harlow* (Stockport Borough Court 1843)). In response, the Registrar recommended that the Board of Trade remove the incentives to register such shapes as ornamental designs by establishing a separate regime. The Board of Trade did this through the Utility Designs Act.²⁸

The Utility Designs Act 1843 (UDA) protected ‘any new or original Design for any Article of Manufacture having reference to some purpose of Utility, so far as such design shall be for the Shape or Configuration of such Article’. Protection under the Utility Designs Act 1843 (as under the 1839 and 1842 Acts) required application to the Design Registry and, once granted, lasted for three years. The application was required to include a title, two drawings of the design, and such description in writing as was thought necessary to render the same intelligible.²⁹ According to the rules, the description was required (i) to indicate the useful purpose; (ii) distinguish the several parts of the design by reference to letters, figures or colours; and (iii) indicate which parts were not new and original.³⁰ The drawings were to be no more than 24 inches by 15 inches and ‘on a proper geometric scale’ (UDA 1843, s. 8). The price of registration was £10.³¹ Importantly, and in contrast to the Ornamental Design Act 1842, registrations were – like patent specifications – open

²⁴ Sherman and Bently 1999, 63–73, 77–79.

²⁵ On this, see Report of Registrar of Designs to the Board of Trade (November 3, 1841); First Report 1853.

²⁶ Anon 1840.

²⁷ The only report, in the *Mechanics Magazine*, incorrectly identifies the defendant as ‘John Westerdale Owthorne’ but it was John Westerdale, a wheelwright, of Owthorne.

²⁸ Anon 1850h, 144; Sherman and Bently 1999, 79–85.

²⁹ UDA, s. 8. Even greater flexibility was added by the 1850 Act, s. 11 (according to which the registrar could dispense with drawings and accept a written specification) and Copyright of Designs Act 1858, s.5 (allowing submission of portion of an article of manufacture). *The Practical Mechanic’s Journal* called the former ‘an utter absurdity’: Anon 1850c, 159.

³⁰ First Report 1853, 485; UDA, s. 8.

³¹ Johnston Committee 1962, 127. For criticism of this as too high, see Grafton 1846. From 1851, provisional registration for 1 year was permissible at a cost of a mere 10 shillings. See First Report 1853, 487–488.

to the public,³² and the titles of all the registered useful designs were widely circulated.³³ However, copying of the designs was not permitted until the rights had expired.³⁴

The scope of the new right was defined and its enforcement regulated by reference to the Ornamental Designs Act.³⁵ This meant that the right was infringed by applying 'any such design, or any fraudulent imitation thereof for the purpose of sale, to . . . any article of manufacture, or any substance' or publishing, selling or exposing for sale any such article or substance to which the design had been applied, knowing that consent had not been given to such application. In addition to proceedings for damages, and in Chancery for an injunction, remedies included the recovery of penalties of £5–£30 per offence (though not to exceed £100 per person per design), as well as costs, by way of an action for debt, an action on the case, or by way of summary proceedings before two magistrates.³⁶ Fifteen years later, the county court was also explicitly given jurisdiction to hear cases and award damages.³⁷

3.2 RECEPTION OF THE UTILITY DESIGNS ACT

The Utility Designs Act 1843 received a mixed reception. While some commentators welcomed the new regime, others, who complained that the Act was anything but transparent,³⁸ likened it to an attempt to present a picture to one ignorant of anatomy by using 'dry bones'.³⁹ Beyond these criticisms of the nature and form of the Act, a more serious dispute arose as to the relationship of the utility design system to the patent system: a matter over which the 1843 statute said nothing. The question of the relationship between the two legal regimes, which became more heated as the Utility Designs Act increased in popularity,⁴⁰ was played out in tracts, textbooks and in such specialist periodicals as the *London Journal of Arts and Sciences*, the *Repertory of Patent Inventions*, and the *Mechanics' Magazine*. While views on this matter varied somewhat, they fell into two general approaches.

On one hand, commentators such as Alexander Prince, Joseph C. Robertson (Editor of the *Mechanics' Magazine*) and Thomas Turner (barrister and legal

³² UDA, s. 10.

³³ First Report, 509 ff (list to December 31, 1853).

³⁴ That said, some of the registrations, with images, were published in journals such as the *Patent Journal and Inventors' Magazine* under the title 'specifications of articles registered': (1846) 1, 438–439; (1846–1847) 2, 910–911.

³⁵ UDA 1843, s. 6.

³⁶ ODA 1842, s. 8 (penalties), ss. 12–13 (costs).

³⁷ Copyright of Designs Act 1858, s. 8.

³⁸ Anon 1843a, 143–147; S.Y. 1844a, b; Webster 1851, 82; First Report 1853 in (1854) 28 PP 269, 463, App. N.

³⁹ Anon 1847c; Anon 1847e, 368.

⁴⁰ By 1850 the number of registrations had risen to 476 per annum, which was much the same as the annual number of patent grants.

commentator) took the view that the Utility Designs Act and the patent system were alternative ways of protecting mechanical devices. Under this view, applicants could elect between the protection offered by the Utility Designs Act, which cost £10 for three years of protection throughout the whole nation and the patent system, which cost £300 but lasted for the longer term of 14 years. As the *Mechanics' Magazine* explained:

We look upon it as a real boon conferred on the Genius and Industry of the people – as their Act of Emancipation from much, if not the whole, of that enormous load of oppression, which our wretched and monstrously expensive system of patent law has for ages imposed on them it is, in truth, an Act for the Protection of New Inventions of all classes and degrees (with a very few exceptions), those of the higher as well as those of least value; an Act, the benefit of which will be felt, and we doubt not, gratefully recognised in every workshop and every working nook of the United Kingdom. It is, in a word, AN ACT FOR MAKING PATENTS CHEAP.⁴¹

Other commentators such as William Carpmael (patent agent), William Spence (patent agent) William Hindmarch (barrister) and Thomas Webster (1811–1875, barrister and from 1865 QC) took a different view, arguing that the subject matter of each system was essentially distinct. In particular, they suggested that the Utility Designs Act merely protected the form of an article, whereas patent law protected the ‘principle’ by which an invention worked, that is, its ‘function’.⁴²

The divergence of opinion played an important role in the way the Utility Designs Act was perceived, utilised and evaluated. For example, the way the Act was interpreted influenced the way its success was measured. For those who took the view that the Act was ‘an act to make patents cheap’, its success was judged in terms of whether it offered a speedy, simple and cheap system of registration: irrespective of what was actually registered. As such they welcomed the registration of table lamps, ball cocks, heel tips, screw wrenches, sash fastenings, weft distenders, light reflectors and pneumatic life preservers which occurred in the first month of the Act’s operation.⁴³ For those who took the view that the Utility Designs Act merely protected the form of objects, most of these registrations were thought to be mistaken and worthless.⁴⁴ Carpmael called the Act ‘a perfect curse’ that had

⁴¹ Anon 1843b, 164; Billing and Prince 1845.

⁴² Spence 1847b, 11; Hindmarch 1851, 25. Yet others took a middling position, arguing that ‘some inventions’ could be protected under either regime, but quite how many was less clear. Anon 1847e, 367 (William Newton); Report on the Signet 1849, 63, Q. 1118 (evidence of William Newton); SCPB 1851, Q. 1103 (Alfred Newton) (suggesting that a great many inventions fell into the overlap); Anon 1848b, 276–277 (critiquing Spence’s narrow view); Anon 1851d (William Johnson, a Glasgow patent agent, critiquing Carpmael’s narrow view).

⁴³ Anon 1843c. The representations can be found at TNA: BT 45/1.

⁴⁴ Hindmarch 1846, 25; Spence 1847a, 16.

produced 'most pernicious results.'⁴⁵ According to Webster, registration was tantamount to robbery.⁴⁶

3.2.1 The Nature of the Conflict

At one level, the conflict over the appropriate scope of what ought to be registered under the 1843 Act was expressed in two different though related ways. The first turned on the notions of 'form' and 'principle'. For the proponents of the narrow view, the scope of the Utility Designs Act was confined to the outward or visible form of the object registered. It was said that form only extended to encompass principle – which was taken as the primary concern of patents – in the very limited circumstance where the form of the article happened to be the only shape that could be used to perform the function in question. This meant, for example, that while the Utility Design Act could protect the form of the stem or oil vessel of a table lamp, it could not protect any new way of raising the wick in the lamp or supplying the lamp with air.⁴⁷ Given the belief that utility model protection was limited to the visible exterior form of objects while patent protection extended to principles, and that form and principle were readily separable, those who favoured the narrow view were able to deny that there was any real overlap between the two systems of protection.⁴⁸ In contrast, the proponents of the broad view of the Utility Designs Act took a different view of the 'form/function' dichotomy. For these commentators, the divergence between form and principle was much less clear. As Robertson, writing in the *Mechanics' Magazine*, explained:

We really see it as a matter of some difficulty to imagine any cases of mechanical improvement which will not come within the exceedingly comprehensive terms of this Act. Such an invention as Watt's great discovery of condensing in a separate cylinder might possibly fall without the line; but the direct-setting engine, the oscillating engine, and a score of others of the like character, would as undoubtedly fall within it. All paddle-wheels, and all stern-propellers would be most clearly included. So would all agricultural machines; all railway bars, chairs, sleepers etc; all wood pavements. In short, mere processes only, and such chiefly as are of chemical description, will be excluded.

Arguing that every principle presumed some understanding of form, it was said that the two concepts were inseparable. Or, as Turner said, 'you cannot have principle without special form, more than you can have respiration without lungs'.⁴⁹

⁴⁵ SCPI 1851, Q. 191, p. 30 (evidence of Carpmael).

⁴⁶ SCPB 1851, Q.105, p. 26 (evidence of T. Webster); Webster 1851, iii–v.

⁴⁷ Carpmael 1846, 4–5.

⁴⁸ Spence 1851, iv–vi.

⁴⁹ Turner 1849, 63. See also Civis 1845 ('every variation of shape resolves itself into some sort of mechanical action or effect'); Liverpool Financial Reform Association 1851, 8 ('form, in many cases, embraces a principle of action.')

The second issue that distinguished the conflicting views of the Utility Design Act related to the way the design was represented. More specifically, it turned on a difference of opinion over how the visual and textual elements of the design registration were construed and the relative weight that each played in determining the scope of the property protected. It is important to recall that when registering a design, applicants were required to include three things: a title, two drawings of the design which were to be no more than 24 inches by 15 inches and on a 'proper geometric scale', and such description in writing as was thought necessary to render the same intelligible. In practice, the representations varied, with many (especially those prepared by registration agents) including lengthy written explanations of the drawings. For example, Registration Number 9, for an improved ball cock (Figure 3.1) (which had been drafted by Joseph Robertson) included two figures and the following description:

Fig. 1 is an external view of the ball cock. Fig. 2 is a sectional view. A is the water supply pipe. B is the ball cock which is connected to the supply pipe by means of a spur C and hinge D . . .

CLAIM

The parts of the said design which are not new or original are the branch A of the supply pipe and the ballcock B. The parts claimed as new are FIRST the spur C and hinge D by which the ballcock B is attached to the branch A of the supply pipe and SECOND the branch A₂ of the supply pipe with the valve box F and Valve G attached thereto.⁵⁰

When proponents of the narrow construction of the 1843 Act spoke of the outward form of objects, they meant the visible form which was represented in the drawings of the design. In this situation visual representation was assumed to have two characteristics: first, it was believed that drawings were capable of being appreciated and understood by any viewer; there was no specific knowledge or skill required to interpret the visual element of the design application. Secondly, the drawing or visual representation operated to confine protection to the detailed specific embodiment that was found in the registration. In this context, the textual features of a utility design application, which the Act required applicants to submit in order to render the drawing intelligible, were seen to perform the limited role of enabling the new and old elements of the shape to be differentiated: the text played no role whatsoever in understanding the drawing and thus determining the property protected. In contrast, these commentators believed that patents captured the essence of the invention – the principle – through the medium of text, that is, the patent specification: a document which was interpreted from the standpoint of the

⁵⁰ TNA: BT 45/1/9.

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Improved Ball Cock.

Robert Wilkins of St. Long and Pepper.

Fig. 1

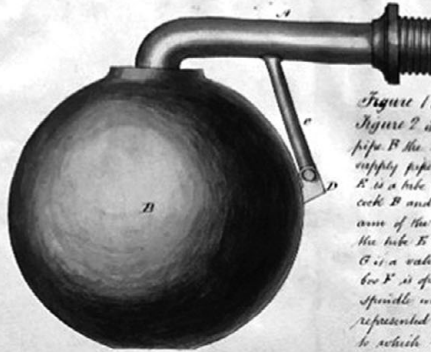
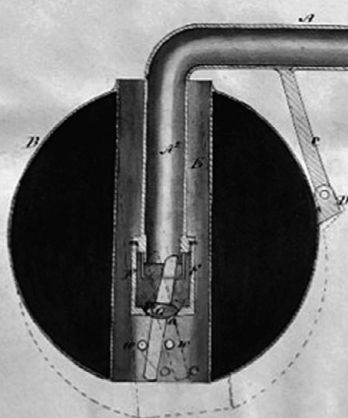


Fig. 2.



Description.

Figure 1 is an external view of this Ball Cock
 Figure 2 is a sectional view. A is the water supply
 pipe B the ball cock which is connected to the
 supply pipe by means of a spur C and hinge D
 E is a tube which passes down the centre of the ball
 cock B and is left open at both ends A' is an
 arm of the water supply pipe which dips into
 the tube B and terminates in a valve F
 G is a valve by which the orifice a of the valve
 box F is opened and closed it consists of a long
 spindle with a round top on the end
 represented out of in Figure 2 When the orifice
 to which this ball cock is attached is full the
 ball cock will be in the position shown in
 the drawings and the valve G will rest in an
 inclined position by the top at the middle and so
 cover the orifice a When the water
 falls the ball cock turns on its hinge
 and dips back into the position as
 indicated by the dotted lines in Fig
 2 bringing along with it the valve
 G which catching by the lower end of its spindle
 against one of the two cross pins or rods as it is
 shown in a reverse position when the water
 part of G leaves an opening for the water to flow into
 the orifice.

Claim

The parts of the said design which are not
 new or original are the branch A of the supply
 pipe and the ball cock B. The parts claimed
 as new are First the spur C and hinge D by
 which the ball cock B is attached to the branch
 A, and second the branch A' of the supply
 pipe with the valve box F and valve G attached
 thereto.

J C Robertson & Co
 Registration Agents
 16b Fleet Street
 London.

FIGURE 3.1 Improved ball cock, registered on September 9, 1843, by Robert Wilkins (with J. C. Robertson and Co as registration agent): BT 45/19

community skilled in the art and in such a way that the protection encompassed multiple embodiments.

While those who favoured a narrow reading of the 1843 Act prioritised the visual representation of the design over its textual supplements, opponents of this approach took a more open view of the relationship between the visual and the textual. Moreover, for this group the roles of the divergent techniques of representation – visual and textual – were by no means as fixed as the proponents of the narrow view made out. That is, they did not think that there was a single, universal relationship between text and image. Instead, they were able to imagine diverse ways in which text and image might interact in identifying an intangible object or subject matter of rights.

Proponents of the more expansive view of the 1843 Act differed from those who construed it more narrowly in two more specific ways. First, some of those who favoured a more open interpretation of the 1843 Act argued that visual representation was not as confined, specific and limiting as had been suggested. Importantly, this meant that the protection offered to registered designs extended to include geometrically different shapes which were functionally equivalent. This more expansive understanding of visual interpretation was based on the idea that visual representations did not require universal understanding. Rather, the visual representations were to be interpreted by a skilled community, a community which would understand the essential rather than the accidental shape of the article.⁵¹ As one commentator observed,

[T]he essential and important shape and configuration of an article of utility is not by any means necessarily outward and manifest, but may be such as can only be carefully appreciated by persons conversant with articles of its class . . .

In addition, based on the idea that ‘a word gives the essential principle of a shape’,⁵² it was also suggested that while visual images were capable of being interpreted in different ways, the text which was attached to the drawings informed the way the image could be construed. Specifically, it was argued that the text tied down the meaning of the visual image, allowing the image to constitute the basic representation of even functional attributes of the protected design.⁵³

3.2.2 *How Are We to Understand This Conflict of Views?*

In part, the conflict that took place over how the Utility Designs Act was to be construed can be traced to the fact that different groups had different understandings of how the image–text relationship was understood. In this sense, the experiences of the Utility Design Act are consistent with the view that the relationship between the visual and the textual is not determined by some universal truth: either system of

⁵¹ S.Y. 1844a, b.

⁵² Turner 1849, 63.

⁵³ Cf. Barthes 1977a, 25; 1977b, 39.

representation is interchangeable, though equally in a specific context each could be mutually exclusive.⁵⁴

While it is clear that the social environment of the mid-nineteenth century was capable of sustaining different understandings of how the image–text relationship was to be understood, this leaves open the more difficult question: how are we to make sense of the differences which took place at the time? Although at a general level the specificity of the image–text inter-relationship can be explained as a site where political, institutional, economic and social antagonisms played themselves out,⁵⁵ there are a number of more specific explanations for the differences.

3.2.2.1 Interests

One way to see the differences over techniques of representation and their interpretation is as a battle for money and power between two distinct groups: established patent agents who promoted a narrow interpretation of the 1843 Act, and a new class of ‘registration agents’ and aspiring patent agents who advocated for a broad construction of the Act.

ESTABLISHED PATENT AGENTS The parties who developed and peddled a narrow interpretation of the 1843 Act were for the most part established patent agents.⁵⁶ Although persons designating themselves as patent agents can be traced to the late eighteenth century,⁵⁷ in the 1840s there were only between seven and ten patent agents in London: William Carpmael and Moses Poole (from 1821, operating from ‘The Patent Office’, 4 Old Square Lincoln’s Inn); William Newton (from around 1818, operating from the ‘Office for Patents’ at 66 Chancery Lane); Joseph Clinton Robertson (from around 1828); Paul Rapsay Hodge (from around 1831); Frederick W. Campin (from 1838, at 156 Strand); William Spence (from 1839); Charles Barlow and Philip Le Capelain; and a few others.⁵⁸ While there were no legal barriers preventing a person from calling themselves a patent agent, it was difficult at this time to establish a profitable foothold. As a result a number of those who described themselves as patent agents were subject to bankruptcy proceedings.⁵⁹ In response to the difficulties, many ‘patent agents’ combined their patent work with other

⁵⁴ Mitchell 1984, 5; Cray 1990, 6.

⁵⁵ Mitchell 1986.

⁵⁶ See generally Dutton 1984, ch. 5; Van Zyl Smit 1985.

⁵⁷ For example, James Poole (father of Moses): Dutton 1984, 86; Bottomley 2014a, 67–68; Murfitt 2017, 85.

⁵⁸ Report on Signet 1849, 15, Q. 368 (Campin) (suggesting 10 patent agents in 1848); Robertson in Report on Signet 1849, 70, Q. 1242 (Robertson); SCPB 1851, 83, Q. 475 (Hodge); Anon 1846a (indicating 14 patent agents in London); Anon 1850d; Turner 1851, 98; Newton 1879, ch. 10; Edmunds 1890, v.

⁵⁹ For example, in 1842, Edwin Twizell Gough of the Strand and George Dellanson Clark; in 1847 George Drysdale Dempsey; and, in both the 1840s and 1850s, Masta Joscelin Cooke. The latter, at least, seems to have been a consequence of failed business ventures.

occupations such as editing journals: Joseph Clinton Robertson was editor of the *Mechanics' Magazine*; Luke Hebert was editor of *Register of Arts and Journal of Patent Inventions*; William Newton was the proprietor and editor of the *London Journal of the Arts and Sciences*; George Dellanson Clark was proprietor of *The Inventors' Advocate*; Charles Barlow and, successively Philip Le Capelain and Edward Haynes, operated the *Patent Journal and Inventors' Magazine*; while William Johnson, a Scottish patent agent, ran the *Practical Mechanics' Journal*. (In fact, in the case of Robertson and Johnson, they were involved in editing their journals before practising as agents).⁶⁰ Many of those offering their services as patent agents were solicitors, chemists or civil engineers with other sources of income;⁶¹ others combined acting as agents with the patenting and exploitation of their own inventions.⁶²

Amongst the established patent agents, the most vociferous advocate of the narrow interpretation of the 1843 Act was William Carpmael, who was recognised as 'the most eminent and successful agent of the day'⁶³ and who claimed he had 'half the business'.⁶⁴ Carpmael was widely respected: the professor of machinery at University College, Bennet Woodcroft called Carpmael 'a patent agent of great experience and talent'⁶⁵ – indeed both had frequently given expert evidence in patent cases. More sceptically, according to the barrister Thomas Turner, Carpmael and Poole looked on themselves as 'licensed gamekeepers of the manor of useful art and the registers as so many poachers'.⁶⁶

One of the consequences of a utility model regime that was permitted to operate as an alternative to the patent regime would have been to undermine the practices of patent agents. The reason for this was that the esoteric knowledge that was required to navigate a patent through the complex patent system – one of the unique commodities that patent agents purveyed – would have been rendered valueless. As a result, Turner observed, '[p]robably, if it were left to them, they would contract the limits of utility in form till nothing visible were left'.⁶⁷

The suggestion that it was the self-interest of the established patent agents which led them to argue for a narrow reading of the Utility Designs regime is consistent

⁶⁰ Anon 1866.

⁶¹ For example, George Shaw, who would become Birmingham's leading agent, was a chemistry professor at Queen's College medical school: Anon 1904; Benjamin Pickever Wilme, whose career as an agent never took off, was a civil engineer and wrote a handbook on mapmaking; John Yonge was an attorney.

⁶² For example William Baddeley (d. 1867): Timbs 1868, 281–282.

⁶³ Report on Signet 1849, 51, Q. 901 (barrister Thomas Webster).

⁶⁴ Report on Signet 1849, 28, Q. 627. This claim is borne out by Bottomley (2014a), 65–66 (calculating relative shares of the business from the Privy Seal account books as Poole & Carpmael (43 per cent), Newton & Co (24 per cent) and Robertson & Co (13 per cent).

⁶⁵ SCPB 1851, 237, Q. 1687.

⁶⁶ Turner 1849, 49.

⁶⁷ Turner 1849, 49.

with their opposition to the reform of the patent system.⁶⁸ For example, Carpmael's partner, Moses Poole, told the 1829 Select Committee on Patents that he could not 'see any defect in the present law' of patents – a view which corresponded closely with his interest in maintaining the advantage he had gained from his lengthy experience navigating the system. In the middle of the century, when patent law was variously described as a 'heap of injustice and extravagant persecution',⁶⁹ 'a stain upon the character of the nation',⁷⁰ and a 'disgrace to the intelligence of the country',⁷¹ Carpmael obdurately maintained the stance that the patent system 'works very well' and that 'the law could not be better than it is'.⁷² Although Carpmael repeatedly denied that his views on law were informed by his business interests,⁷³ when considering the related issue of patent law reform, contemporaries were sceptical that patent agents would be able to offer disinterested advice. Giving evidence to the 1851 Select Committee on bills to amend patent law and practice, Henry Cole explained that the Society of Arts had excluded patent agents from being involved in its reform proposals: 'they were not the parties who had to pay or to suffer; but the parties who gained by the patent system, and lost nothing'.⁷⁴

REGISTRATION AGENTS In contrast, one factor which may have influenced the likes of Alexander Prince and Joseph Robertson, who favoured the broader view, was that they had developed substantial practices acting as agents for registrants (in Robertson's case, in addition to a substantial practice as a patent agent). In fact, Prince played an important role in advocating for what became the 1843 Act itself: he was so aggrieved by the temporary removal of protection at the Design Registry by the 1842 Act that he sent a petition to Board of Trade.⁷⁵ This pleaded that the memorialists were aggrieved that applications that would have been registered under the 1839 Act had been rejected by the Designs Office on the ground the applications were not 'strictly and sufficiently ornamental'; despite the fact that there had been no suggestion that the 1842 Act was intended to restrict the scope of registrable designs. Once the Utility Designs Act was up and running, Prince was quick to get involved: as agent, he filed the first two applications, and five out of the first ten. Of the first 100 registrations under the Utility Designs Act, Prince acted as agent for

⁶⁸ SCLPI 1829, 82 (Moses Poole); see also Carpmael 1832, ch. 8; SCPB 1851, 10, Q.72; Webster 1852, 5 n.(a).

⁶⁹ Anon 1850b.

⁷⁰ Brewster 1850.

⁷¹ Robertson 1846, 175n. Anon 1850i ('disgraceful to the statute book of a wise and enlightened nation'); Webster 1853, 16 ('vicious' system had 'received the unqualified condemnation of every disinterested person').

⁷² SCPB 1851, 29 Q. 128; 80 Q. 471.

⁷³ SCPI 1851, 10–11, QQ. 72–75.

⁷⁴ SCPB 1851, 260, Q. 1845.

⁷⁵ BT/1/413, June 29, 1843 ('The Prince Memorial').

21 of the applicants while Robertson acted for 24.⁷⁶ Although we do not know what they charged, these agents obviously had a pecuniary interest in the success of the regime. Other, more traditional patent agents were less involved in registering designs: William Newton had a smaller but steady practice doing so; and William Spence drafted a few applications each year. As far as we have been able to ascertain, the names of the leading patent agents, Carpmael and Poole, do not appear anywhere in the register.⁷⁷

BARRISTERS What about the barristers? Following a rapid expansion in the size of the bar, competition for work was so great that the decade of the Utility Designs Act was widely dubbed ‘the hungry forties’.⁷⁸ Out of fear that there would be a simultaneous reduction in court business, many barristers opposed procedural reform, such as the establishment of the County Court as a cheap forum for civil litigation (Polden 1999, ch 1). Did the prospect of a cheap tribunal, namely proceedings before magistrates, when compared to lucrative patent proceedings (with long trials, frequently the subject of multiple sets of further proceedings at law and in Chancery, and typically involving larger teams of counsel), affect barristers’ attitudes to the Utility Designs Act?

In general, barristers favoured a narrow construction of the scope of the Act. For example, figures such as Thomas Webster and William Hindmarch, who were to become the pre-eminent patent barristers of the middle decades of the century, interpreted the 1843 Act in the same way as Carpmael and Spence.⁷⁹ That said, the view of the bar were not unanimous: the Chancery barrister, Thomas Turner,⁸⁰ was much more open-minded about the Utility Design Act, offering views that at least took account of those of Robertson and Prince.

Was Webster’s stance one of self-interest? By the time of the 1843 Act, Thomas Webster (who had done a degree in mathematics at Cambridge) was a member of

⁷⁶ BT 45/1. For Prince, see BT 45/1/1, 2, 4, 5, 8, 14, 15, 20, 25, 33, 41, 46, 47, 55, 62, 65, 71, 76, 79, 92. For Robertson, BT 45/1/9, 10, 16, 17, 19, 26, 29, 31, 32, 37, 38, 42, 44, 45, 48, 52, 54, 63, 64, 84, 86, 95, 99, 100.

⁷⁷ Based on browsing BT 45/1–7, 9, 12 and 14. Prince’s name disappears by the fifth volume, and the work at 14 Lincoln’s Inn Fields was taken over by J. C. Haddan. Prince reappears as an agent in BT 45/12 as Green and Prince 4 Trafalgar Square (e.g. BT 45/12/2317) and very strongly in BT 45/14, though that partnership with Thomas Green was dissolved in September 1852. By contrast, Robertson sustained his position over the first decade as the leading ‘agent for registration.’

⁷⁸ Anon 1851c; Cocks 1983, 57, 88 (in the decade between 1835 and 1845, the bar expanded from 1,300 to 2,317); Hay and Snyder 1989, 46; Polden 1999, 44; 2010, 1017 ff.

⁷⁹ See also Whitworth 1848, 287. Whitworth had no personal interest: he was an equity draftsman and conveyancer.

⁸⁰ He appeared in *Sealy v Browne* (Rolls Court 1843) and *Burnett v Smith* (VC 1844).

the common law bar⁸¹ and practiced on the Northern Circuit. Given the industrial centres of the North, Webster was able to specialise in patent cases. In 1844, for example, he was involved in at least three patent trials in Liverpool,⁸² five in London,⁸³ and two 'en banc' hearings consequent upon trials conducted in 1843.⁸⁴ Thus, although it is clear that in 1844 Webster had a thriving patent practice, it is doubtful that he would have lost much if any of this business as a result of the Utility Designs Act. In section III we discuss the case law under the Act, including 24 sets of proceedings before magistrates for infringement (see Appendix 1). In most of the cases, both complainant and defendant were legally represented,⁸⁵ usually by a barrister, sometimes by two: William Clarkson, a highly regarded criminal barrister,⁸⁶ appeared in eight of the eighteen cases where the reports mention counsel; while patent barristers Thomas Webster, Benjamin Rotch and William Hindmarch were counsel in ten of the cases. Webster appeared (usually alone) in seven trials in Utility Design Act design cases between 1843 and 1852,⁸⁷ and in one case that was heard in Queen's Bench, *Margetson v Wright*. It is true that the trials were shorter (patent trials were commonly 3–5 days) and the consequential hearings proportionately fewer, but it is probably the case that the low value of the innovations in issue meant that few if any of these disputes would have made it to Chancery for discovery or preliminary relief, let alone to nisi prius for trial.

The magistrate's cases do, however, suggest an explanation for Webster's trenchant critique of the 1843 Act. While, as in patent cases, Webster tended to represent the complainant, in this environment he was generally unsuccessful. Although formally victorious in *Margetson*, the defendant paid the fine and continued to manufacture the products (leading to further unsuccessful proceedings before the Vice-Chancellor and in Queen's Bench). The one Utility Design Act case in which Webster succeeded – *Kennedy v Coombs* – was the only one in which he

⁸¹ Despite being a member of the common law bar, Webster appeared in Chancery cases: e.g. before the Lord Chancellor and Master of the Rolls, sitting together in *R v Newton*, May 28, 1845, and the following year in *Rubery v Barr* (VC 1845).

⁸² *Pow v Taunton and Holt* (nisi prius, Liverpool Assizes 1844); *Bentley v Fleming* (nisi prius, Liverpool Assizes 1844); *Crosskill v Grounsell* (nisi prius, Liverpool Assizes 1844).

⁸³ *Bentley v Carver* (nisi prius, Westminster 1844); *Mangnall v M'Alpine* (nisi prius, Guildhall 1844); *Muntz v Foster* (nisi prius, Westminster 1844); *Woodcroft v Reyner* (nisi prius, Guildhall 1844); *Russell v Ledsam* (nisi prius, Westminster 1844).

⁸⁴ *Nickels v Haslam* (Common Pleas 1843); *Stead v Williams* (Common Pleas 1844).

⁸⁵ In *Motte v Lancaster* (Guildhall Police Court 1850), Alderman Challis advised the complainant to seek professional advice in drawing up an information to avoid technical defects that had marred the complaint). Cf. *Bentley* 1998, 22 (rare for lawyers to be involved in summary cases in general).

⁸⁶ Anon 1856.

⁸⁷ *Vine v Johnson* (Worship Street Police Court 1843); *Welch and Margetson v May* (Guildhall Police Court 1844); *Wolferstan v Warner* (Guildhall Police Court 1844); *Kennedy and Asprey v Coombs and Finlay* (Marlborough Street Police Court, London 1845); *Besley and Thorowgood v Gallie* (Guildhall Police Court 1848); *Margetson v Wright* (Guildhall Police Court 1848); *Gregory v Armstrong* (Thames Police Court 1851).

represented the defendant. In Webster's experience, owners of designs rarely won through, whereas, at least in patent trials before juries, patentees nearly always succeeded.⁸⁸ No wonder, then, that Webster thought registration worthless.

Giving evidence to the Select Committee on the Protection of Inventors Bill in March 1851, Webster expressed his dissatisfaction with proceedings before magistrates under both the Ornamental Design Act and Utility Design Act (SCPI 1851: 31–32, Q. 201):

Nothing can be worse than the tribunal; the justices are the great difficulty . . . it is so difficult, that I have in many cases advised parties not to attempt it; and where it has been attempted, there has been a failure, in the majority of cases, from technical objections . . . nothing can be worse than going before the justices.

If Webster's views on the Utility Design Act aligned with his professional interests, they also reflected his experiences as an advocate.

3.2.2.2 Professional Territory

Another way of reading the dispute over the interpretation of the 1843 Act is as a battle over professional territory and reputation. In this context, it is important to remember that patent agents, who were regarded as a 'comparatively recent self-instituted amphibious body (half lawyer half man of science),'⁸⁹ occupied an ambiguous and uncertain position (especially as regards the legal profession).⁹⁰ Indeed, until July 1, 1889 (when a requirement of registration was introduced by section 1 of the Patent, Designs and Trade Marks Act 1888) anyone could – and many did – set themselves up as 'patent agents'. This was particularly problematic at a time when reform of the system was being considered and reputation was the key to influence.⁹¹ Given their unprotected status, it is unsurprising that established patent agents would turn upon newcomers presenting themselves as 'registration agents' calling them an obscure and motley crowd of incompetent, unprincipled persons – a 'mushroom class'⁹² – who hang and prowl round the outskirts of the patent profession.⁹³ Amongst those charlatans, one who was directly referred to was Alexander Prince – one of the two key registration agents in the early years of the 1843 Act's operation, memorialist to the Board of Trade and co-author of a text

⁸⁸ In contrast, as another barrister, Matthew Davenport Hill, explained to the Select Committee on the Patent Bills, in patent cases 'verdicts are almost uniformly for the patentee'. SCPB 1851, 279, Q. 2001.

⁸⁹ Anon 1850d, 321.

⁹⁰ Turner 1850, 98; Anon 1851a, 'Invasion' (patent agency 'an anomalous offshoot' of the legal profession). The Post Office Directory for London for 1847 listed 26 'Patent and Design Registration Agents' including 7 solicitors.

⁹¹ Van Zyl Smit 1985, 99.

⁹² Anon 1850d, 323; 1858b, 486.

⁹³ Anon 1850d. This was to continue as a theme: Cunninghame 1894, Preface.

advocating a broad interpretation of the 1843 Act.⁹⁴ Like many, Prince's business was precarious and he faced bankruptcy in 1849, 1858 and again in 1868.⁹⁵ In an attempt at self-aggrandisement, the established patent agents suggested that the upstarts who promoted the utility designs system lacked the education, skill and experience necessary to obtain efficiently and securely a patent grant. In the absence of some bar to a man 'taking the cloth',⁹⁶ the effect of the introduction of the simple registration machinery would have been to create an opening for these new entrants. Whether or not they really lacked the esoteric knowledge of established patent agents, they would have been able to make a living from representing inventors.⁹⁷

3.2.2.3 Political Motivations

While concerns with finance and reputation go some way towards explaining the differing views over the 1843 Act, they only provide a partial picture. For example, while Robertson's promotion of the utility model system as an alternative to the patent system was motivated in part, by self-interest, he was also fired by a political fervour to support the working class and saw the new system as a way to open up the possibility for all inventors to acquire technological properties. Robertson had established the *Mechanics' Magazine* with Thomas Hodgskin,⁹⁸ who has frequently been seen as a 'Ricardian socialist'.⁹⁹ In the 1820s, Robertson had been a driving force behind the establishment of the London Mechanics' Institute (Hodgskin 1859; Anon 1859b), an initiative that sought to give mechanical operatives a chance for self-education (Flexnor 2014, 41). Robertson's political drive to remove obstacles facing the working classes to self-betterment, and thus to ensure their due reward for their ingenuity, may have constituted his primary motive for promoting the Utility Design Act as 'an Act for making patents cheap' (or what we would now think of as a utility model regime).

Views about the Utility Designs Act were intertwined with debates about the desirability of reducing the costs of patenting. As already noted, much of the criticism of the existing patent system focussed on the price of patents, with one particular focus being the accessibility of the system for the poor and working classes. For many commentators, it was this group of 'operatives' that were the 'real innovators',¹⁰⁰ and the price of protection needed to be reduced to reward those who really

⁹⁴ Billing and Prince 1845.

⁹⁵ Anon 1868. In the 1850s Prince went bankrupt with debts of £50,000, having attempted to exploit certain patents including one for imitation leather. See Anon 1858a.

⁹⁶ Anon 1850d, 323.

⁹⁷ It was objected that they had advertised that patent rights could be obtained for a smaller sum. Carpmael 1846, 14.

⁹⁸ Flexnor 2014, 72 ff.

⁹⁹ Claeys 2000, but cf. Mingardi 2021, who sees Hodgskin as a working class libertarian.

¹⁰⁰ SCPB 1851, 248, Q. 1782 (Isambard Kingdom Brunel stating that most inventions came from 'practical operatives.')

warranted it. For example, patent agent Paul Hodge favoured cheap patents precisely because ‘many inventions among the operatives of this country, who very often are the real inventors, would be encouraged to take out patents’.¹⁰¹ An Editorial in the *Morning Chronicle* in 1850 bemoaned the fact that the exorbitant price of patents prevented the real inventors from obtaining their due reward.¹⁰²

For others – typically those who opposed the registration of utility designs – protection through exclusive rights was seen as something that ought only to be granted to really meritorious inventions, and price was a way of ensuring that minor inventions were not protected. For example, Carpmael denied that allowing operatives to gain patents or other rights would in practice benefit them: he told one Select Committee that ‘a patent to a poor man is generally a curse’.¹⁰³ In addition, Carpmael adhered to the view that ‘cheap patents would be highly pernicious to the country’.¹⁰⁴ Carpmael worried that reducing the cost of registration would lead to a proliferation of patents, which would in turn increase the difficulties of clearing rights and getting business done. In many respects, his concerns parallel those of recent times in relation to patent thickets, non-practising entities and the so-called ‘anti-commons’.¹⁰⁵

The debate over ‘poor inventors’ was in turn linked to concerns over the desirability of servants gaining exclusive rights that could affect the master’s investments. For Carpmael, opening protection up to ‘operatives’ was fraught with danger. This was because it was the masters who were the inventors and the Utility Design Act presented an unfortunate mechanism that allowed servants to interfere with their master’s ‘property’. Most of those debating the Utility Design Act and patent reform would have been aware of cases such as *Haynes v Brown* and *Brown v Wigram*, which concerned a windlass or capstan for use with a ship’s anchor, that illustrated the confusion that could arise. Haynes, White and Bevis had been in the service of Thomas Brown when, as Charles White claimed, he was asked to make a windlass for different sizes of chain, and in response he made a model of a capstan which he gave to Brown. Subsequently, White, Haynes and Bevis registered the design under the Utility Design Act (on March 29, 1847), licensed the use of the design to a shipbuilder called Wigram at Blackwall, and brought proceedings in the Guildhall Police Court against their former employer, Brown, for infringement. Brown, who in the meantime (on April 20, 1847) had acquired a patent (it seems after effectively opposing White’s own patent application before the Attorney General on around

¹⁰¹ SCPB 1851, 83, Q. 477. Also 88, Q. 518 (Hodge). See also SCPB 1851, 212, Q. 1493 (Fothergill).

¹⁰² Anon 1850e, 5.

¹⁰³ Report on Signet 1849, 31, Q. 693 (Carpmael). For details as to how Carpmael dealt with ‘poor inventors’, by appraising their contribution and, if meritorious, linking them with capitalists, see SCPI 1851, 26, Q. 185.

¹⁰⁴ SCPB 1851, 30, Q. 137 (Carpmael).

¹⁰⁵ Heller and Eisenberg 1998.

April 8–10),¹⁰⁶ successfully resisted the proceedings for infringement (arguing that the design was not new and unpublished at the date of registration).¹⁰⁷ Brown, in turn, brought an action against Wigram, for infringement of the patent in December 1850, which Wigram defended by relying on the earlier registration by White et al.¹⁰⁸ The two cases were largely determined according to (what some contemporaries regarded as a dubious interpretation of) the substantive questions of publication and novelty, but both courts were made conscious of the master–servant dynamic, in particular the opportunity the Utility Design Act presented for opportunistic registration by aggrieved, disloyal or departing servants.¹⁰⁹

That said, a number of commentators who took a similar analytical line to Carpmael on the protection afforded by the Utility Design Act diverged from him on the matter of the desirability of cheap patents or something like a utility model regime. Chief amongst these was William Spence, who in publications in 1847 and 1851 argued in parallel with Carpmael that the registration of designs under the Utility Design Act could not afford the protection that registrants hoped for. However, Spence was sympathetic to the idea of what he called ‘little patents’ (1847b: 11, 1851: iv). As he explained in his evidence to the Select Committee on the Patent Bills in 1851:

My notion is this, that we require two sorts of patent, a short patent and a long patent. I have all along thought that the Legislature had a good object in view, as I stated in my former evidence, in the Utility Designs Act, but I can only recognise in that an intention in the right direction, and not a purpose carried into effect.¹¹⁰

Spence elaborated his ideas further in a letter to Aris’s *Birmingham Gazette*.¹¹¹ In a similar vein, Webster, though critical of the Utility Design Act, favoured reduction in the cost of patenting. Indeed, giving evidence to the Select Committee on the Protection of Inventors (1851), Webster asserted that the popularity of the Utility Design Act was itself a reason why the price of patents should be reduced.¹¹²

3.2.2.4 Patent Culture

A final explanation relates to what one might call ‘patent culture’, that is the assumptions and ways of thinking of the established patent professionals.¹¹³ More

¹⁰⁶ GB 11666 (April 20, 1847) (‘Machinery for raising and lowering weights (capstans’). The specification, enrolled on October 20, 1847 was published in *The Patent Journal and Inventor’s Magazine* (October 30, 1847) 524.

¹⁰⁷ *Haynes v Brown* (Guildhall Police Court 1848).

¹⁰⁸ *Brown v Wigram* (Exchequer 1850).

¹⁰⁹ Charles Barlow and Payne, patent agents and the editors of the *Patent Journal and Inventor’s Magazine*, were especially critical: Anon 1848a, 335.

¹¹⁰ SCPB 1851, 139, Q. 867 (Spence).

¹¹¹ Anon 1847b, 4.

¹¹² SCPI 1851, 32, Q. 201.

¹¹³ Cf. Gooday and Wilf 2020.

specifically, the culture with respect to drafting and interpretation of letters patents – the representation of the intangible – made it difficult for patent agents to feel comfortable with the machinery of the Utility Designs Act. While drawings were not required as part of the patent specification, by the 1830s they were commonly used.¹¹⁴ However, patent practice treated drawings in the specification as playing a secondary role as *illustrations* rather than aids to understanding ‘the principle’ of the patent.¹¹⁵ The job of identifying the invention in its full breadth was one for the written description, including claims (which, while not yet required, were increasingly common). In contrast, the drawing was an example, a representation of ‘an embodiment’, a particular instantiation, or, as one commentator put it, a kind of ‘test of the truthfulness’ of the description.¹¹⁶ Such views, when transported unmodified into the Utility Designs system, led to a view that design representation only supported a very limited property (whereas, as we have seen, proponents of broad interpretation of the Utility Design Act treated the textual description as pinning down the open meaning of the representations).¹¹⁷

3.3 JUDICIAL AND ADMINISTRATIVE RESPONSES

Although the 1843 Act allowed the Registrar to reject non-ornamental shapes from the register of ornamental designs under the 1842 Act, the Registrar was unable to reject an application from the utility designs register on the ground that the application was properly the subject of a patent.¹¹⁸ Nevertheless, shortly after the 1843 Act came into force on September 9, 1843, the Registrar issued a noticed stating that no design

will be registered, the description or statement respecting which shall be suggestive of a claim for any such mechanical action, principle, contrivance or application.¹¹⁹

Quite what was the legal basis for this notice (and the practise it purported to foreshadow) is unclear,¹²⁰ but the notice was influential. *The London Journal of the Arts and Sciences*, edited by the patent agent William Newton, which had regarded the scope of the Act as ambiguous,¹²¹ narrowed its position in response saying that

¹¹⁴ Spence 1847a, 72.

¹¹⁵ Godson 1823, 119; Spence 1847a, 72–73.

¹¹⁶ Spence 1847a, 72–73.

¹¹⁷ Turner 1851, 100 (‘The description [in a utility design] explains the drawing and defines the points claimed.’)

¹¹⁸ First Report 1853, 481.

¹¹⁹ Bowen 1843. In other respects, the Registrar left the decision as to what to register entirely to the applicant: Sherman and Bently 1999, 93.

¹²⁰ Cf. First Report 1853, 481 (registrar has no power to refuse application as long as rules are complied with). That said, see Anon 1846b, 297–299 (reporting that Registrar had refused to register application as lacking novelty).

¹²¹ Anon 1843a.

interpretation of the Utility Design Act as protecting inventions involved a 'misconception',¹²² and after listing the titles of designs registered under the 1843 Act, repeatedly warned readers of the dangers that these registrations were invalid.¹²³ The Registrar's notice had also emphasised that decision to register was a matter of personal risk for applicants.

As the patent agent William Spence pointed out, the subject matter and scope of protection under the Utility Design Act was not a matter that could be resolved administratively: it turned on the judicial interpretation of the Act. Unfortunately, a clear resolution of the different interpretations was unlikely. This was because proceedings to enforce the rights of registrants could be brought before magistrates and most complainants chose that course. If the Utility Design Act was an act to make patents cheap, and in the absence (until 1846) of a cheap county court,¹²⁴ there was a certain logic to their being enforced in the police courts which were thought of by some as a 'poor man's court'.¹²⁵

It was the view of contemporaries that the 1843 Act had not generated a great deal of litigation.¹²⁶ In the period between 1843 and October 1852 (when the Patent Law (Amendment) Act 1852 came into operation), there were at least twenty-four sets of proceedings before magistrates for infringement under the Utility Design Act (see Appendix 1). All but one (*Twigg v Kemp* (Public Office, Birmingham 1848)) were brought in London, including sixteen at the police court in the Guildhall. Just under half of the cases resulted in the defendant being fined – though the convictions in *Motte v Welch* and *Dixon v Bessell* (1850 Guildhall Police Court) were overturned. The fines were mostly £5, often referred to as the 'mitigated penalty' applicable where the accused undertook not to repeat the offence, but in at least one case, *Margetson v Wright*, the defendant made no such undertaking and the penalty (a mere 20 shillings) was insufficient to deter further infringements. Complainants do not seem to have sought to exploit the potential for very significant penalties through cumulation of the fine on a per article basis (up to a maximum of £100).¹²⁷

The issue of the relationship between design and patents was raised in many of the design cases by defendant's counsel. The argument was usually made that the subject-matter for which protection was being sought was properly a matter for the patent regime and thus the registration was invalid. In *Wolferstan v Warner* (Guildhall Police Court 1845), concerning an improved boiler tap (Figure 3.2), William Clarkson argued that

¹²² Anon 1843d.

¹²³ Anon 1843e.

¹²⁴ Polden 1999, ch. 1.

¹²⁵ Davis 1984, 315. For proposals in the 1830s to use the justices for civil claims, see Hanly 2006, 260.

¹²⁶ SCPB, 407.

¹²⁷ Anon 1843c.

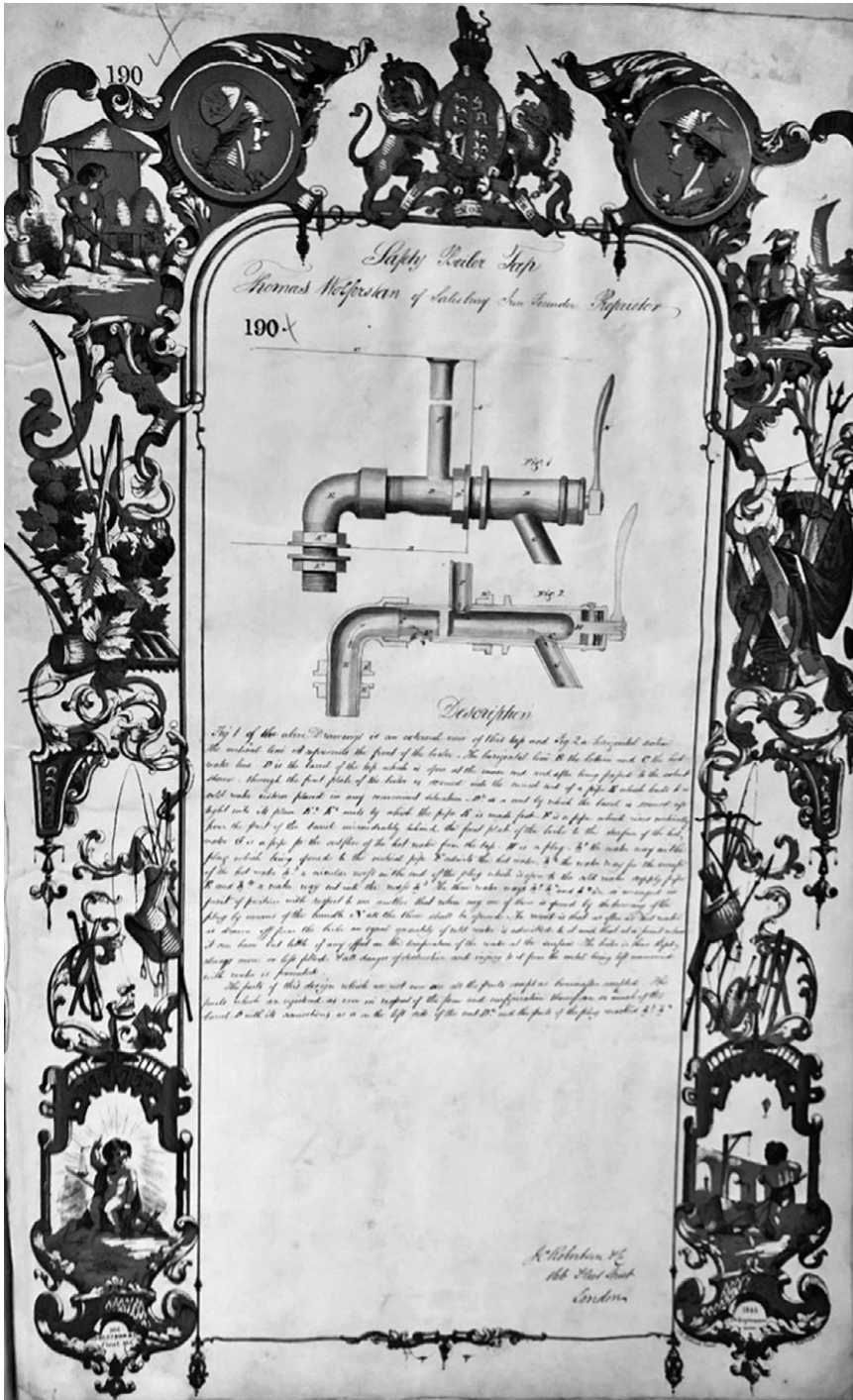


FIGURE 3.2 ‘Safety boiler tap’ registered by Thomas Wolferstan on May 28, 1844, and litigated in *Wolferstan v Warner* (November 5, 1844, Guildhall Police Court): BT 45/1190

by endeavouring to evade the expense of taking out a patent at an expense of as many pounds as he had paid shillings for the registration, had overreached himself. The part for which registration had been obtained was a mechanical contrivance, and not a mere change of form or configuration, to which alone that act applied.¹²⁸

The defendant raised other objections (including that the designs were different in important ways, and that the complainant had not marked all the taps sold with the word 'registered' as required by the 1843 Act). Although the magistrate dismissed the summons, the aldermen refused to explain their decision, so it was not clear whether doubts about whether the tap was eligible for protection influenced the decision (and the arguments of counsel were a subject of trenchant criticism in the *Mechanics' Magazine* (1844) 41: 331).

In *Webb v Hughes* (Guildhall Police Court 1847), the claimant's registration (Figure 3.3) related to a tray for storing lace ribbon; the defendant registered (Figure 3.4) and sold an improved version adapted to store more lace.¹²⁹ Clarkson, again appearing for the defendant, argued that the 'Act had reference only to matters of form. It was nothing that the same principle or idea was taken, if the form and means were different. Principles were protected by patent law, and mere shape by the registration law'.¹³⁰ The argument did not seem to land: the magistrates declined to decide the case, one thinking there was infringement, the other finding that the defendant's design was sufficiently different from Webb's and as such that there was no infringement.¹³¹ In *Haynes v Brown* (Guildhall Police Court 1848), concerning the design of a windlass controller, Benjamin Rotch and William Clarkson argued that as the complainant had themselves applied for a patent, the registration under the Utility Design Act was evidently invalid:

the whole thing being the proper subject of a patent as a new mechanical action, the registration under an Act which respected only new forms of known articles of utility was a nullity ... the Registration Act did not, and was not intended to supersede the patent law.

The magistrate dismissed the complaint, but on the basis of the absence of novelty of the design (given prior disclosure).

In three cases, the magistrates seem to have taken the broad view of the Act. In *Fox v Evans*, (Guildhall Police Court 1848) the magistrates found infringement of the complainant's 'Alarm for time pieces' (Figure 3.5) because the defendant reproduced the dial, even though the defendant's version had no alarm. The magistrates, Aldermen Finnis and Lawrence, were unmoved by the fact that the clocks involved different mechanical mechanisms. In *Dixon v Bessell* (Guildhall

¹²⁸ Anon 1844.

¹²⁹ BT 45/5/977, registered on February 25, 1847.

¹³⁰ Anon 847a, 383.

¹³¹ Anon 1847d.

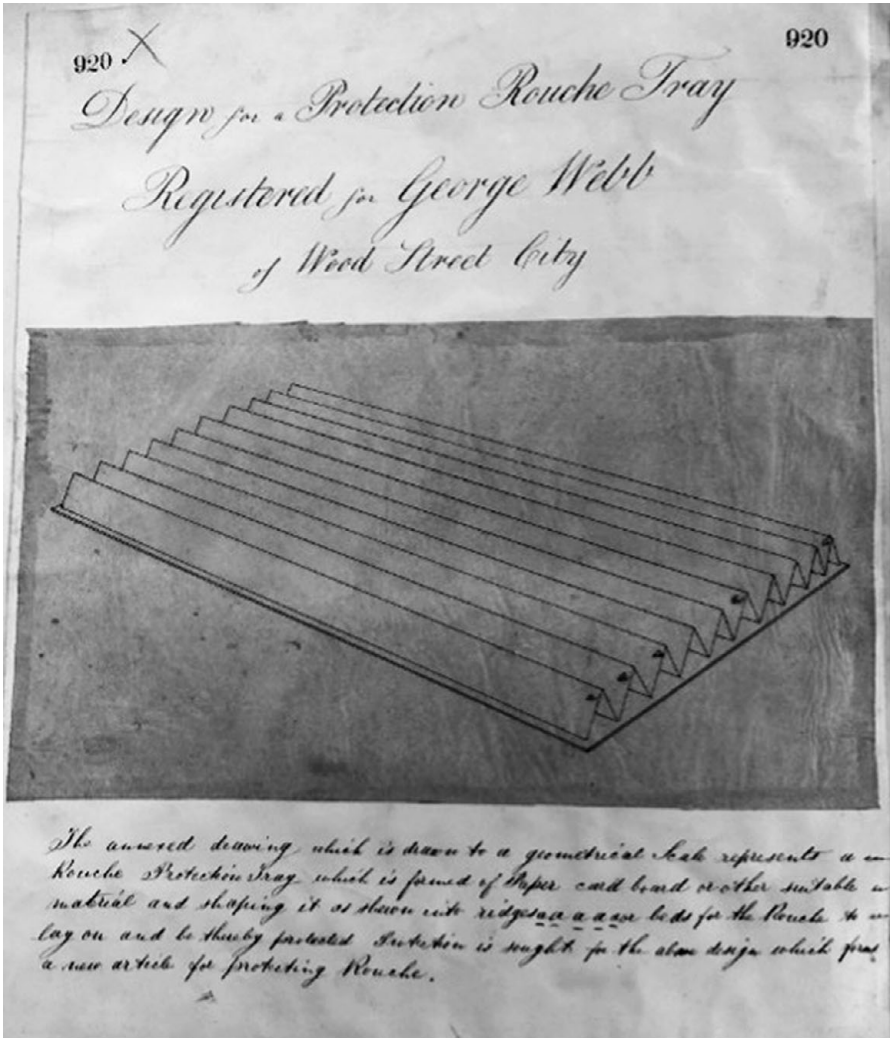


FIGURE 3.3 'Protection rouche tray' registered by George Webb on January 13, 1847, and litigated in *Webb v Hughes* (April 12, 1847, Guildhall Police Court): BT 45/5/920

Police Court 1850), in relation to a ventilator in a window (Figure 3.10), Alderman Wilson expressed the view that Dixon's design was so ingenious that he deserved at least seven years protection and the defendant had engaged in 'bare-faced piracy'. In neither *Fox* nor *Dixon* was the defendant represented by counsel, and likely the tribunal was not exposed to the narrow reading of the Utility Design Act. In contrast, in *Motte v Welch* (Guildhall Police Court 1850), concerning a registered design for an improved portmanteau (Figure 3.6), the defendant's counsel explicitly argued that as the improvements involved the use of rivets rather than sewing and the use of

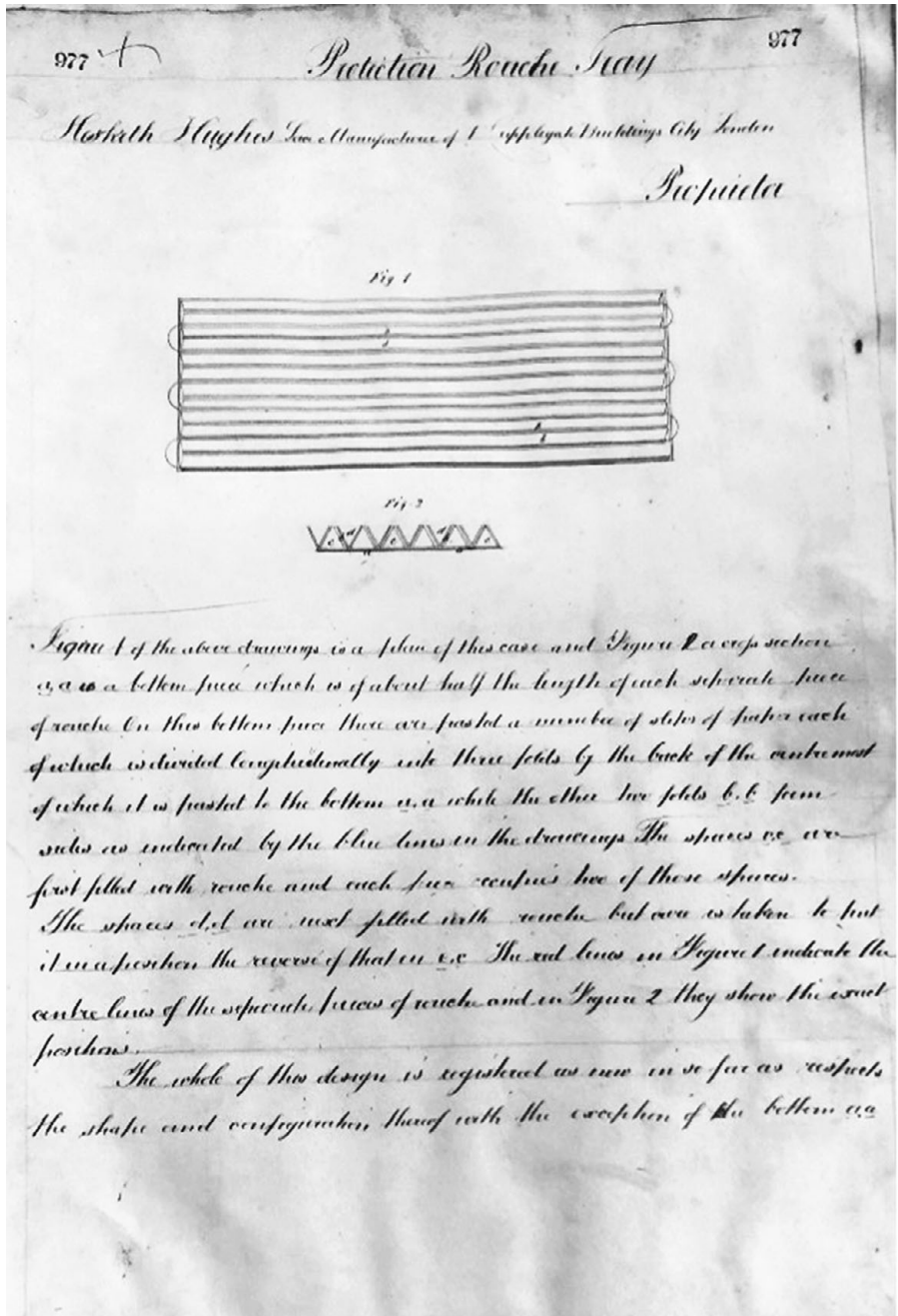


FIGURE 3.4 'Protection rouché tray' registered by Hosketh Hughes on February 25, 1847, and litigated in *Webb v Hughes*: BT 45/5/977

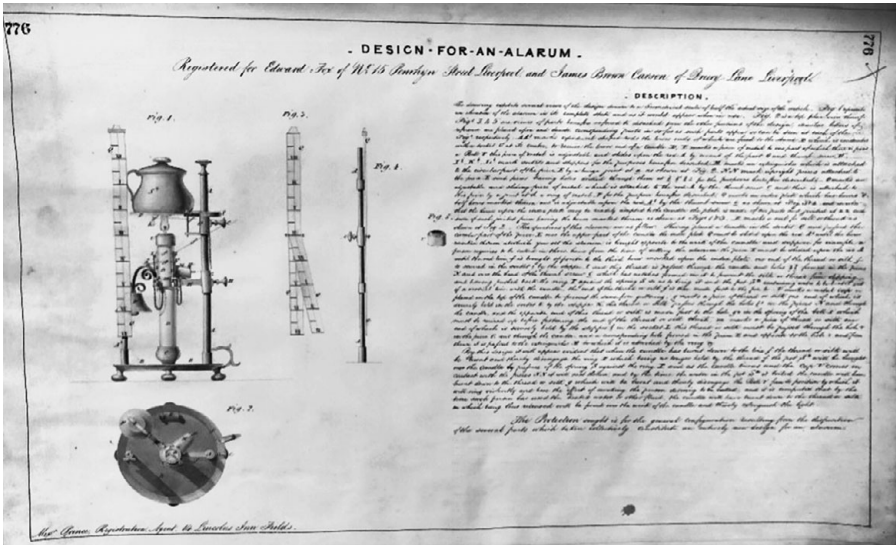


FIGURE 3.5 ‘Alarm for time pieces’ registered by Edward Fox and James Brown on July 25, 1846, and litigated in *Fox v Evans* (May 6, 1848 Guildhall Police Court): BT 45/4/776

one piece of leather, rather than several, there was no new shape and thus no new design. Nevertheless, having heard copious evidence, Alderman Challis found for the registrant.

Sometimes a narrow view of the Utility Design Act clearly motivated the decision of the tribunal. In *Kennedy and Asprey v Coombs and Finlay* (Marlborough Street Police Court 1845), the registration, which was drafted for the complainants by J. C. Robertson & Co, was for ‘an improved portable ink and light box for writing desks and travelling cases’ (Figure 3.7). The novelty lay in the hinging which enabled the lid of the box to be thrown back without pulling its base from the case. The experienced magistrate, John Hardwick, seems to have accepted Thomas Webster’s submission that the novelty was a matter of mechanical contrivance rather than a new design in shape or configuration. Dismissing the information, the magistrate explained:

The articles are nearly the same, except, for a particular use, there is a slight change of mechanical contrivance. I entertain very strong doubt as to the novelty of design, for the purposes of these proceedings.

In *Woolley v Warner* (Guildhall Police Court 1845), the dismissal of the action also seems to have turned on the view that the registered design was really an invention outside the Utility Design Act. The registration was entitled ‘Improvements in the shape and configuration of lamps and apparatus connected therewith for the burning of oil of turpentine, camphine, naphtha etc.’ (Figure 3.8).

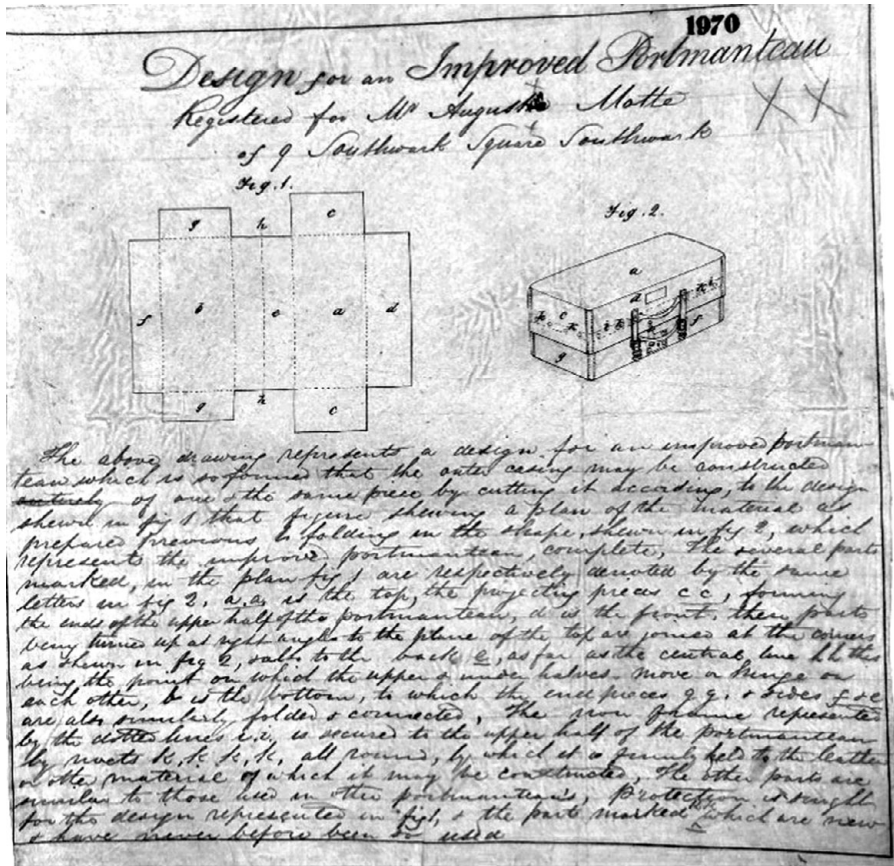


FIGURE 3.6 ‘Design for an improved portmanteau’ registered for Auguste Motte on July 23, 1849, and litigated in *Motte v Welch* (March 30, 1850 Guildhall Police Court) and *Motte v Lancaster* (June 19, 1850 Guildhall Police Court) : BT 45/10/1970

The description identified which of the different components were new and old. In defence, Clarkson argued that ‘any new mechanical action must, it is clear, be the subject of a patent’. Benjamin Rotch, counsel for the complainant, responded that he did not admit that. Nevertheless, the information was dismissed. Alderman Hughes Hughes – who, unusually for an alderman, had something of a legal background¹³² – said he was satisfied that ‘it was a new application of a mechanical action and not a mere alteration of form or configuration’, a conclusion with which Alderman Charles Farebrother agreed.¹³³ The decision received some criticism in

¹³² He had been an attorney in the Court of Common Pleas and later a barrister, though it is unclear whether he practiced in the latter capacity: www.historyofparliamentonline.org/volume/1820-1832/member/hughes-hughes-william-1792-1874

¹³³ Anon 1845.

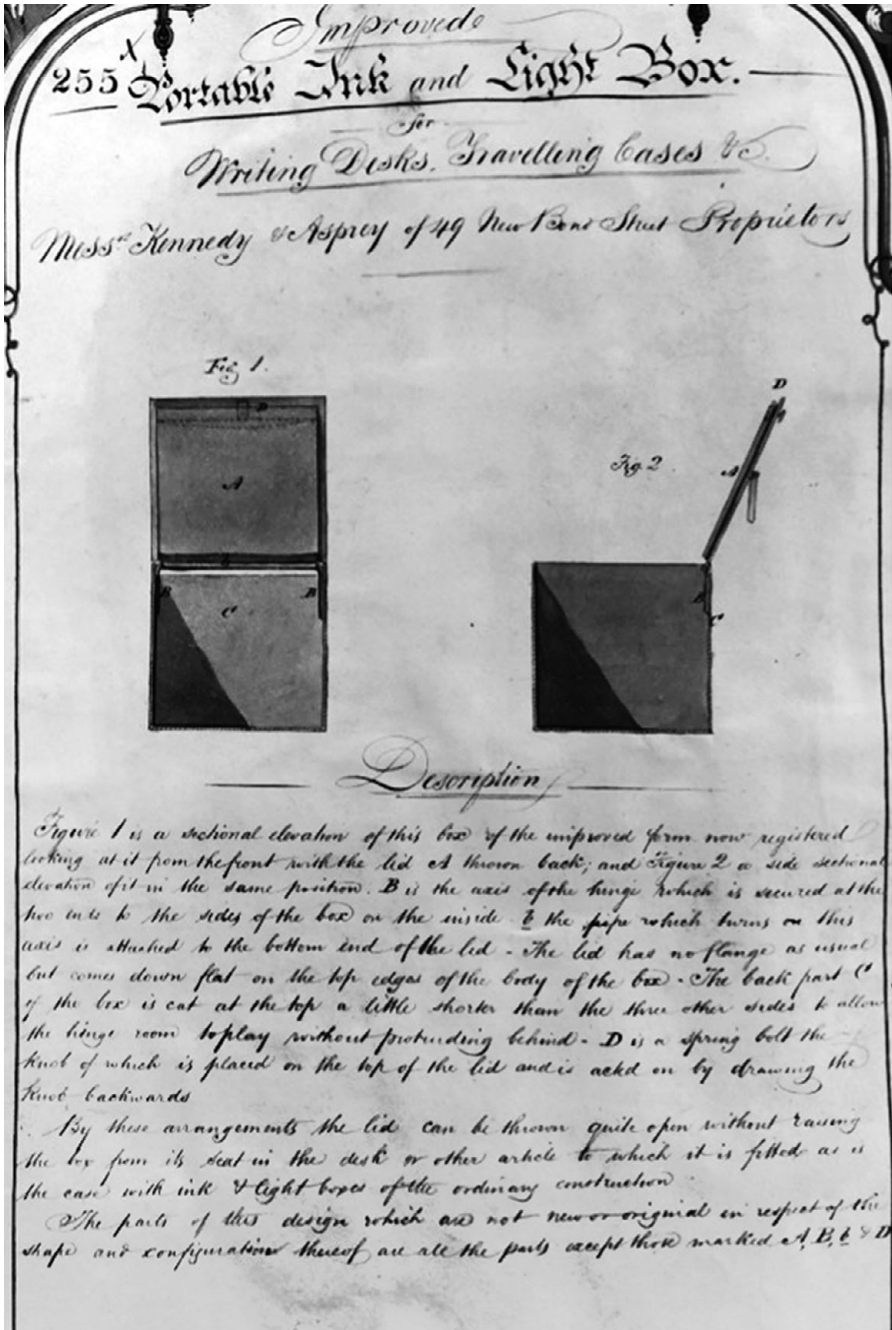


FIGURE 3.7 'Improved portable ink and light box' registered for Francis Kennedy and Charles Asprey on August 27, 1844, and litigated in *Kennedy and Asprey v Coombs and Finlay* (February 15, 1845 Marlborough St Police Court): BT 45/2/255

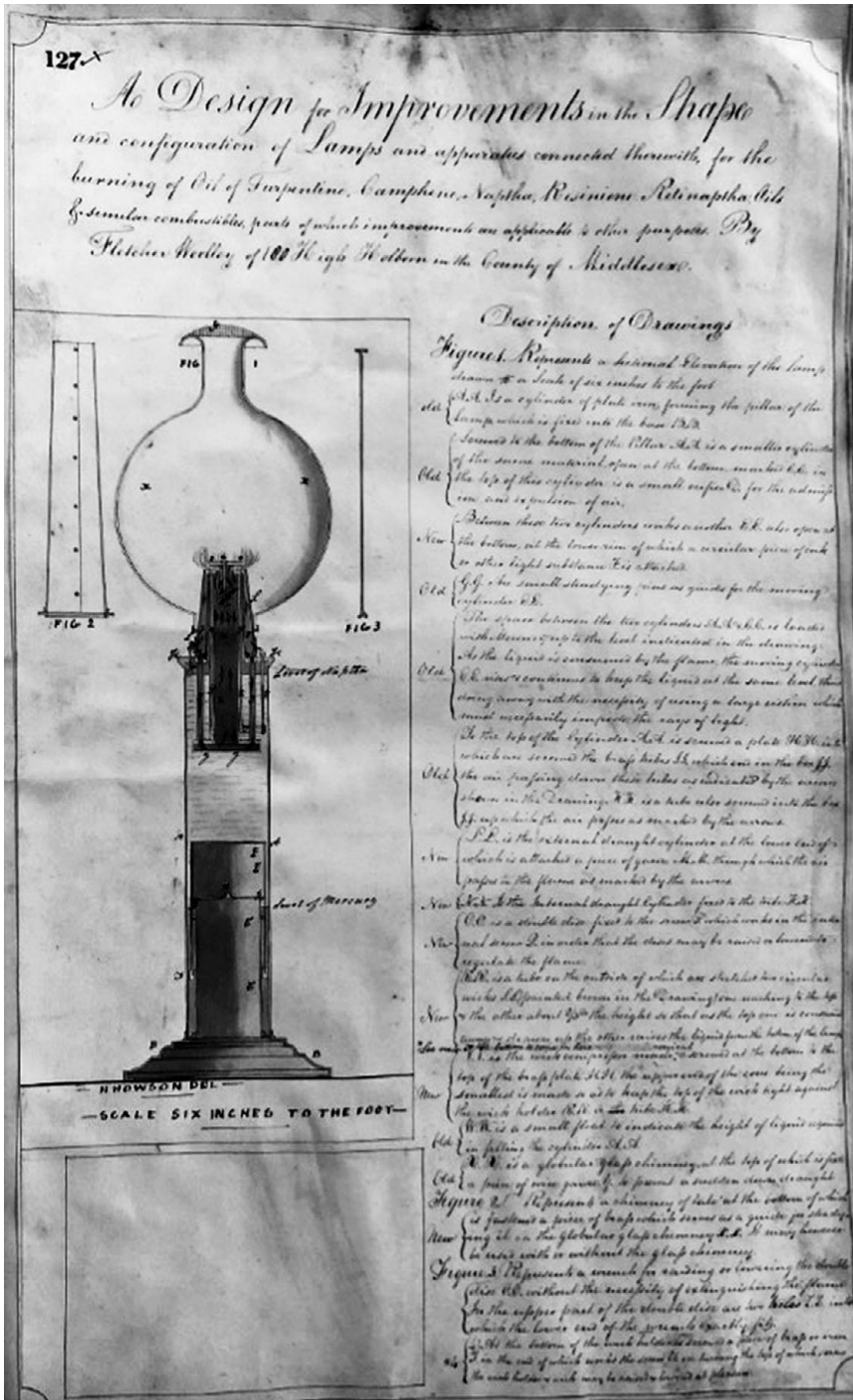


FIGURE 3.8 'Improvement in the shape and configuration of lamps' registered for Fletcher Woolley on February 21, 1844 (and litigated in Woolley v Warner (March 22, 1845 Guildhall Police Court): BT 45/1/127

Robertson's *Mechanics' Magazine*, albeit attributed to 'Civis of Gray's Inn Square'.¹³⁴ When reflecting on the fact that many of the prosecutions in the police courts had been unsuccessful, the barrister Thomas Turner explained that this was attributable to 'fastidiousness about mechanical action, etc.'

A writer in the legal journal *The Jurist*, using the initials 'G.S.', referred to the 'known incompetency' of the justices,¹³⁵ adding that 'such functionaries are naturally averse to be troubled with discussions for which they are so little qualified by education or habit'. The aldermen who sat in the police courts at the Guildhall were often businessmen rather than lawyers¹³⁶ and, despite having a legal clerk,¹³⁷ frequently seemed uncomfortable with their responsibilities. Writing to the *Mechanics' Magazine* after the first two decisions of the aldermen, S.Y. observed that 'the persons appointed by the Act to settle disputed points, are those most likely to prove unable to comprehend the merits of the question on which they have to decide, and [...] are in every way irresponsible for their decision'.¹³⁸ Reflecting this, the Guildhall judges seemed to have looked for ways to avoid dealing with the complaints. As Turner put it, the aldermen took 'prejudices and crotchets on the points of interpretation that arise'.¹³⁹ Thomas Webster gave a similar assessment to the Select Committee on the Protection of Inventors Bill (in March 1851) that¹⁴⁰

there has been a failure, in the majority of cases, from technical objections ... I have been before almost every magistrate in London, and, with one or two exceptions, I have always had the matter shirked, either upon some technical objection, or, if that has been got over, it has been said, 'there is an alternative

¹³⁴ Civis 1845.

¹³⁵ G.S. 1850. See also Anon 1847d (critiquing the tribunal and proposing a separate and competent tribunal for adjudication on scientific matters); Anon 1850g ('a very unfit arena' and favouring use of the county court); Liverpool Financial Reform Association 1851, 9 ('incompetency of the tribunal for the duties imposed upon it').

¹³⁶ Select Committee on Metropolis Police Offices 1837, 129, Q. 1223 (evidence of E. G. Wakefield); Select Committee on Metropolis Police Offices, 1838, p. 117, Q. 1212, p. 119, Q. 119 (Sir Peter Laurie). For example, Charles Farebrother, involved in three of the cases, was from a firm of auctioneers. In contrast, the stipendiary magistrates at the London police courts (such as Bow St, Worship St, Marlborough St and Hammersmith) were required to be barristers of seven years standing and given a salary of up to £1,200 per annum: Metropolitan Police Court Act 1839, 2 & 3 Vict., c.71, s. 3, s. 9. Of the four stipendiary magistrates who decided cases on the UDA, the most notable as a legal expert was Peregrine Bingham, who had operated as a law reporter of cases in the Court of Common Pleas between 1819 and 1840, before taking up a post at Worship Street (1840–1846) and later Marlborough Street police courts (1846–1860): Anon 1864. Outside London, a stipendiary magistrate was required to be a barrister of at least five years' standing. See Polden 2010, 1004–1012.

¹³⁷ Select Committee on Metropolis Police Offices, 1838, p. 117, Q. 1210, 119, QQ. 1219–1220 (Sir Peter Laurie) (on abilities of two clerks, Hobler and Paine); 144, QQ. 1594, 1598 (J. H. Eliot).

¹³⁸ S.Y. 1844a, 330. Also S.Y. 1844b.

¹³⁹ Turner 1851, 105.

¹⁴⁰ SCPI 1851, 31–32, Q. 201. See also First Report 1853, 493.

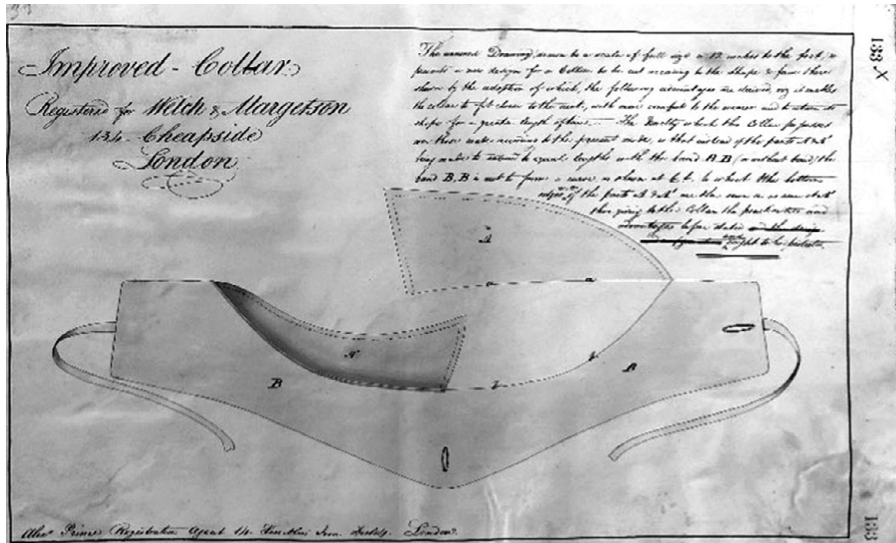


FIGURE 3.9 'Improved collar' registered for Welch, Margetson & Co on February 29, 1844, and litigated in *Margetson v May* (October 1844 Guildhall Police Court): BT 45/1/133

remedy; you can bring an action at law'; so that, practically, the rights are constantly being defeated.

There was certainly evidence to support such a conclusion. In an early case, *Margetson v May* (Guildhall Police Court 1844), concerning the design of a shirt collar (Figure 3.9), one of the magistrates, Alderman Charles Farebrother, an auctioneer, had been inclined to dismiss the proceedings because the matter was too trivial (though he was persuaded by his colleague not to do so).¹⁴¹ In *Wolferstan v Warner* (Guildhall Police Court 1845), the aldermen concluded that the complainant had not established its case, but when counsel asked in what respect, the alderman, Sir George Carroll, a stockbroker, refused to explain. In contrast, other magistrates thought that the issues were so serious that they were better dealt with elsewhere. In *Besley v Gallie* (Bow Street Police Court 1848), dismissing the summons on a technical point (that it was not sent to the defendant's residence as opposed to its business premises), the Bow Street Magistrate, barrister David Jardine (d. September 1860), said he thought the matter 'far too important to be disposed of by a magistrate in a summary way. It was quite foreign to the general business of the police courts'.¹⁴²

¹⁴¹ But cf. *Boswell v Denton* (Guildhall Police Court 1845) (ODA case, Alderman Moon suggesting it was a matter for the court of Chancery).

¹⁴² Turner 1851, 105.

One can easily imagine that the magistrates were ill at ease, as the cases often involved difficult points of law (particularly in terms of the relationship between patents and the Utility Design Act), whereas their usual diet would have been making findings of fact.¹⁴³ Moreover, the magistrates may have also resented the amount of time the cases were taking: the magistrates had plenty of work and were used to resolving matters speedily – ‘the justice that was meted out at the police courts could be very abrupt’.¹⁴⁴ Certainly those that reported the cases on designs noted that they consumed a considerable time.¹⁴⁵ On the other hand, it may be that some of the tribunals overcame their initial discomfort, particularly at the Guildhall Police Court given the frequency of hearings.¹⁴⁶ In *Motte v Welch* (Guildhall Police Court 1850), Alderman Challis initially asked counsel to present more evidence and in his conclusions explained that he had given ‘a great deal of time and careful attention to this case, in order that it might not be said he had decided hastily’.¹⁴⁷ The result was overturned, but the tribunal had certainly done its best.

While patent barristers such as Turner and Webster might have been able to point to instances such as these to justify their criticisms of the magistrates, their views might also have been informed by the fact that the day-to-day operation of magistrates was unfamiliar to them. Magistrates were used to exercising a wide degree of freedom which they often used to ensure that the outcome was consistent with their vision of their role.¹⁴⁸ One wonders whether the criminal barrister William Clarkson would have shared Webster’s view: the reports identify him as counsel in nine such prosecutions, four times for the complainant and five for the defendant, with a 75 per cent success rate (six wins, two losses, the ninth case being undecided). He probably had a better idea as to how to present cases to magistrates. Moreover, one might wonder what a criminal law barrister might have made of the practice of trying patent cases before juries (the value of which were increasingly questioned during the 1840s).¹⁴⁹ Even with the widespread use of special juries,¹⁵⁰ the outcomes were hardly always satisfactory. In *Ward v Key* (*nisi prius*, 1847), for example, the jury initially ignored Cresswell J.’s instruction to find that the defendant had not infringed, finding (as it seems all juries did at that time) for the plaintiff patentee.

¹⁴³ On the regular diet of assault, petty theft, drunkenness, vagrancy, etc., see Davis 1984, 316–321; Auerbach 2021, ch. 1.

¹⁴⁴ Davis 1984, 313. With respect to the Guildhall Police Court, it was suggested that the aldermen didn’t always give enough time to their duties: Select Committee on the Metropolis Police Offices 1838, 143–144, QQ. 1592–1593 (evidence of J. H. Eliot).

¹⁴⁵ *Haynes v Brown* (Guildhall Police Court 1848) (3 hours); *Webb v Hughes* (Guildhall Police Court 1847) (3 hours); *Motte v Welch et al* (Guildhall Police Court 1850) (evidence of fourteen witnesses heard over two days).

¹⁴⁶ But, outside this specific field, the aldermen had been criticised for their inconsistency: Select Committee on the Metropolis Police Offices 1838, 145, Q. 1607 (evidence of J. H. Eliot).

¹⁴⁷ *Motte v Welch et al* (Guildhall Police Court 1850).

¹⁴⁸ King 2006, 22–39.

¹⁴⁹ Hanly 2006, 261–262.

¹⁵⁰ Oldham 1987.

However, the jury revisited the matter when the judge explained to it that if it did not so find, the members would face the prospect of being compelled to hear the defendant's witnesses. Evidently, the lengthy and hugely costly processes of patent litigation were not guaranteed to produce just results.

Perhaps most significantly, the magistrates were not a suitable vehicle for establishing precedent. Not only were the cases reported inconsistently and sparingly in the newspapers,¹⁵¹ the magistrates rarely reserved judgment and never offered more than the briefest of reasoning. While many of the outcomes were noted in periodicals of interest to inventors (such as Robertson's *Mechanics' Magazine* or Newton's *London Journal*) and made their way into commentaries, these were not as precedents so much as indications of the inclinations or instincts of these tribunals. It is fair to say that the magistrates mostly preferred the narrow interpretation of the Utility Designs Act of the likes of Carpmael to the broader reading of Robertson and Prince – but whether this was because they wanted to minimise this part of their workload, avoid the consequences of wrongfully convicting a defendant,¹⁵² or because they thought this was the best interpretation of the statute, is difficult to say.

There was no appeal from the magistrates,¹⁵³ but proceedings could be taken to have their decisions quashed by way of the writ of certiorari,¹⁵⁴ and an authoritative view of the Utility Design Act was most likely to come from such decisions. This was the course of action taken by the defendants in *Motte v Welch* (Guildhall Police Court 1850) and *Dixon v Bessell* (Guildhall Police Court 1850). In *R v Welch* (Queen's Bench 1851), Lord Campbell overruled the magistrates' decision because of a technical defect, but in *R v Bessell* (Queen's Bench 1851) the Court ruled on the scope of the Utility Design Act. The design in issue was for a 'ventilator', that is a mechanism for opening the pane of a window (Figure 3.10). As can be seen, the drawings indicate the overall operation of the system for opening the window and focus in detail on the form of the screw. Apart from describing how the various components (pane, frame, screw and pulley) interacted, the textual component specified that '[t]he part or parts of this Design which are not new or original are all the parts and apart from the purposes thereof **What is Claimed** as new is the general configuration and combination of parts marked A, B, b, D, c, e, a, c exclusively of Figs 5.6. and which are subsidiary or illustrative'. . .). Quashing the conviction, the court held that Dixon's design was not within the statute because in

¹⁵¹ Davis 1984, 317 (citing Sir Thomas Henry, the Chief Magistrate of the Metropolitan Police Courts who explained that cases on pawnbroking went unreported: 'In every police court there are fifty to sixty cases in a day, and the reporters, perhaps, select the one case which would most likely interest the public.' Select Committee on Pawnbrokers, 1870, 170, Q. 3600).

¹⁵² As was found to have occurred in *Dixon v Bessell* (1850 Guildhall Police Court) leading to a successful damage claim for £100 for false imprisonment against Alderman Samuel Wilson – 'a highly respectable magistrate' – in *Bessell v Wilson* (nisi prius 1852, aff'd Queen's Bench 1853).

¹⁵³ Bentley 1998, 24 (noting that a general right of appeal from magistrates was first introduced in 1857).

¹⁵⁴ King 2006, 31–33.

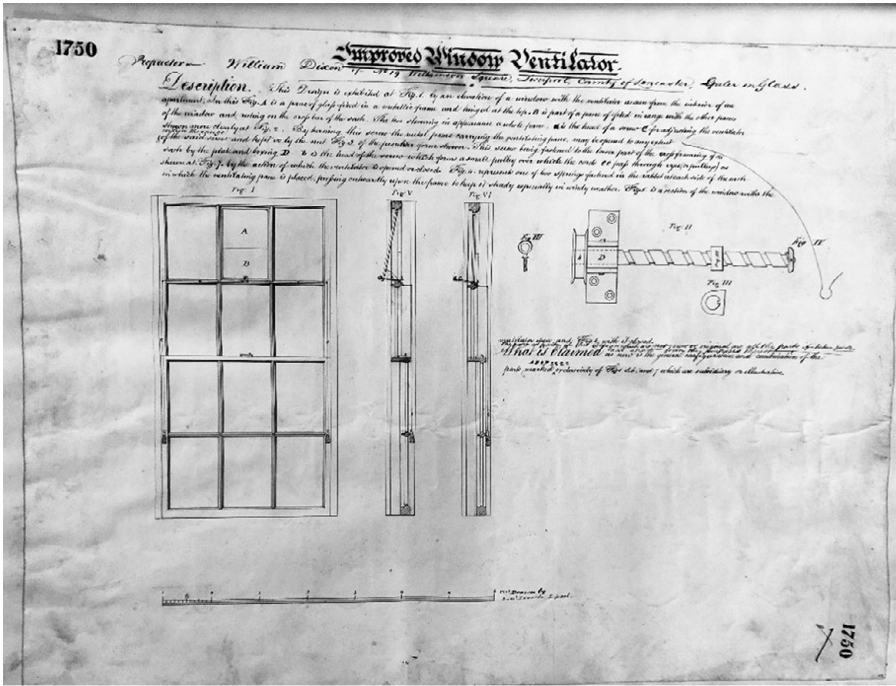


FIGURE 3.10 ‘Improved window ventilator’ registered by William Dixon on January 26, 1849, and litigated in *Dixon v Bessell* (October 1, 1850, Guildhall Police Court): BT 45/9/1750

the description it specified the design as being a combination of features to produce a result and thus was not dependent on the specific shape or configuration of those features. Indeed, the Court observed that the same effect could be produced using different shapes and that had Dixon’s protection been limited to the shape then Bessell, who used a different shape of screw, would not have infringed. The potential importance of the holding was apparent to patent agent Frederick Campin who suggested that it placed ‘some hundreds’ of registrations ‘at the mercy of the pirate’.¹⁵⁵

The only case in which the alternative route to the magistrates,¹⁵⁶ that of using the superior courts, was taken was *Margetson v Wright*, which concerned the design for a ‘Protector label’ with a metal eyelet that prevented the label being ripped off (Figure 3.11). The defendant had registered its own version, the ‘Direction label’ (Figure 3.12). The complainant succeeded in summary proceedings and was

¹⁵⁵ Campin 1851.

¹⁵⁶ After 1847, there was a further possibility – proceedings in the County Courts – and this avenue was used in at least one ODA case in the period: *Coalbrookdale Co v Page* (Warwickshire County Court 1851). For detail on such proceedings, see Polden 1999, ch. 1. The court was mostly perceived as a venue for reclaiming debt, though gradually, as damages limits were increased, became a more attractive venue for torts. See Smith 1960.

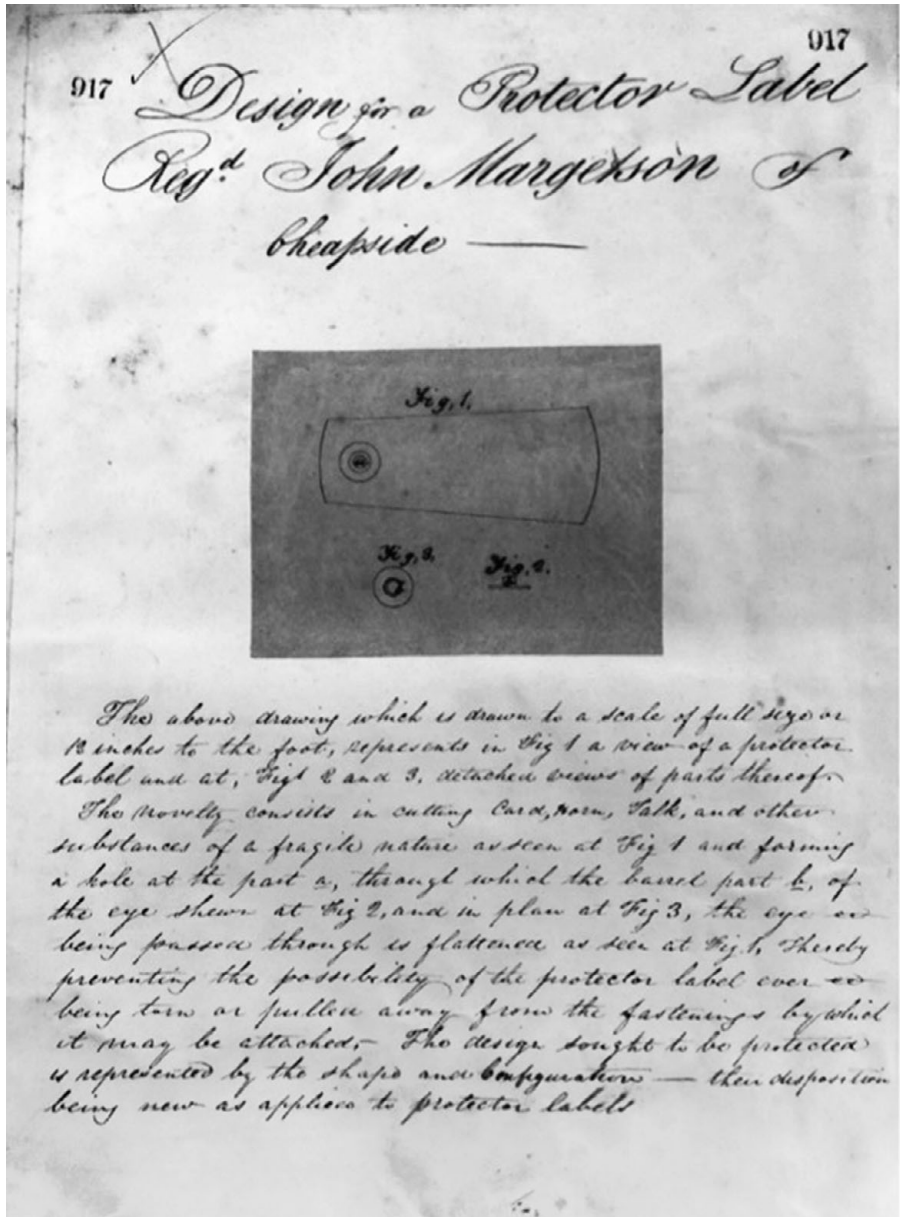


FIGURE 3.11 'Protector label' registered by Margetson on January 9, 1847, and litigated against Wright in the Guildhall Police Court on June 3, 1848: BT 45/5/917

awarded 20 shillings.¹⁵⁷ Nonetheless this did not prevent the defendant from continuing to make and sell its label. Margetson therefore issued a bill for an injunction.

¹⁵⁷ *Margetson v Wright* (Guildhall Police Court 1848).

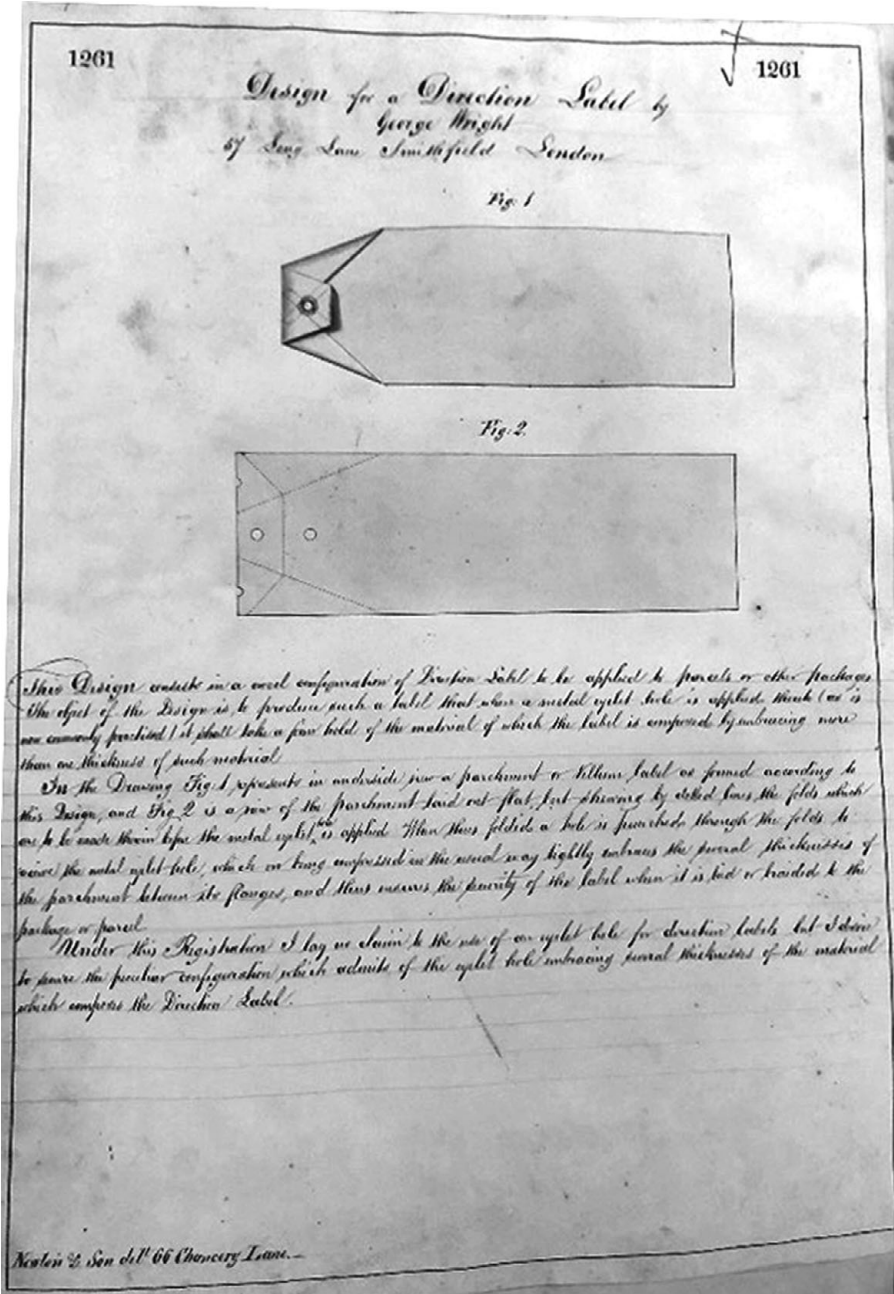


FIGURE 3.12 'Direction Label' registered by George Wright on November 17, 1847, and said by Margetson to infringe his registration in the Guildhall Police Court on June 3, 1848, as well as subsequent proceedings in Chancery and common law: BT 45/7/1261

When the Vice-Chancellor (Knight-Bruce) refused to grant injunctive relief,¹⁵⁸ Margetson sought to establish his rights at law. Unfortunately, in proceedings before Denman LCJ, sitting with a common jury out of term, the defendant was able to prove the availability of the design before the date of registration.¹⁵⁹ The authority thus gave no guidance on the interpretation of the Utility Design Act.

Two other cases concerning Utility Design Act registrations were brought in the common law courts for money owing under licensing arrangements and tried *in nisi prius*: *Millingen v Picken* and *Rogers and Beedle v Driver*. In both cases, the defendant sought to justify non-payment of licensing money ostensibly owed under the contracts by asserting that the registration was invalid. The more complicated of the two cases, *Millingen*, related to a parasol which could be opened using a single hand. The defendant had entered an agreement to make and sell the parasol. However, the defendant considered the design to fall within scope of an earlier patent for 'Constructing umbrellas and parasols' owned by Joseph Barker and wrote to parasol manufacturers, under Barker's name, asserting this.¹⁶⁰ The agreement between Millingen and Picken contained a penalty clause, for £100, should Picken do anything to prejudice Millingen's right and title. The plaintiff brought proceedings claiming that it was entitled to the sum. Millingen won at trial, but before the Court of Common Pleas *en banc*, Serjeant Byles argued that:

the invention . . . was a mechanical contrivance, and, therefore not within the meaning of [the Utility Design Act], which pointed only to pattern, shape, or configuration of the article manufactured, or for the ornamenting, thereof. He argued that the invention was the subject of a patent, and not of copyright.

Tindal LCJ initially awarded the rule *nisi*, but on June 3, 1845, the Court *en banc* affirmed the verdict stating that the defendant was not free to defend the action by claiming the plaintiff was not entitled to the registration. The case, therefore, ultimately provided no clarification as to the scope of the Utility Design Act.

In *Rogers and Beedle v Driver*, Beedle had invented a shape of brick, twice the size of a normal brick but with a cylinder cut out so that when laid against a corresponding brick the combination created a channel that would allow the passage of air (Figure 3.13).¹⁶¹ Calling the design the 'universal ventilating brick', Beedle had entered into a partnership with Rogers to exploit it. They licensed Driver to make the bricks for the Southampton area, Driver in return promising a fee of £100 plus a

¹⁵⁸ *Margetson v Wright* (Vice-Chancellor 1848).

¹⁵⁹ *Margetson v Wright* (Queen's Bench 1849).

¹⁶⁰ Patent Specification 7357 (April 29, 1837). Barker would later seek injunctive relief against Millingen: *Barker v Millingen* (Vice-Chancellor 1845) (Shadwell V-C, dissolving injunction initially granted on June 6, 1845).

¹⁶¹ Anon 1849a (describing registration); Anon 1849b (with illustration).

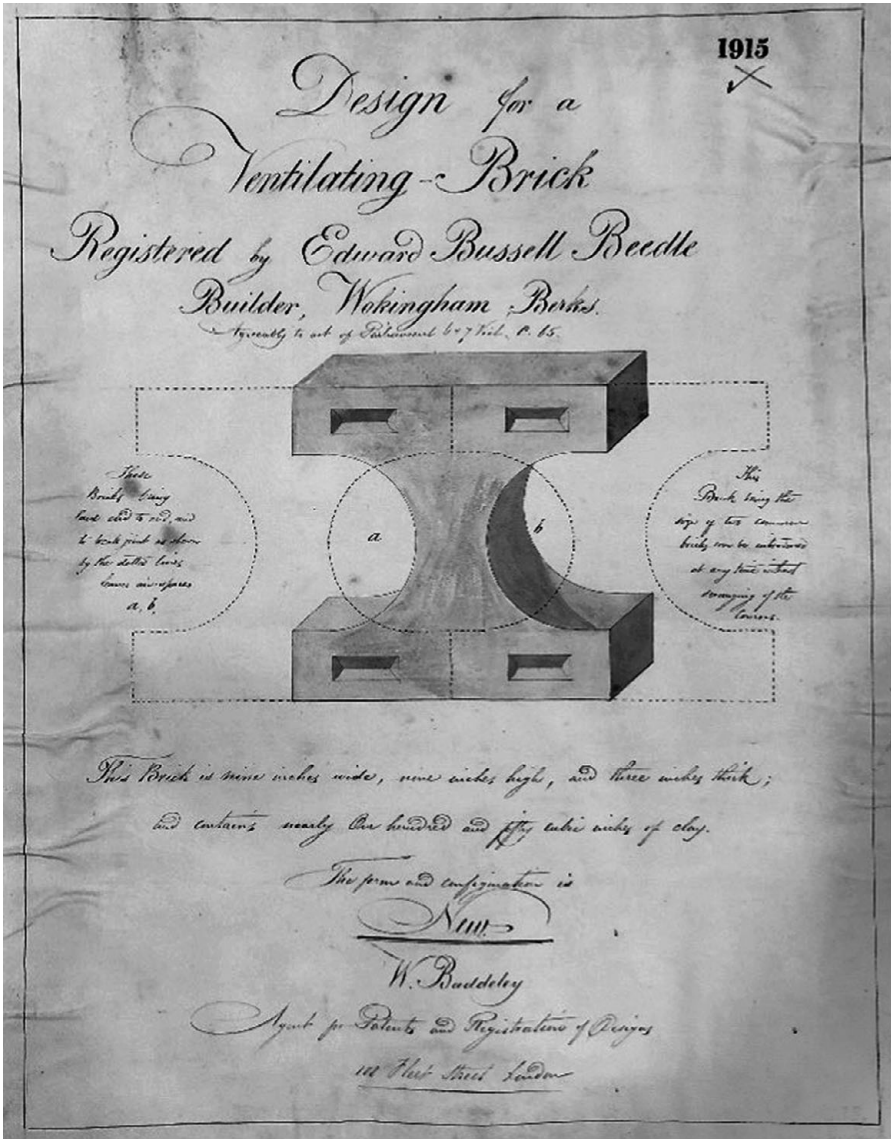


FIGURE 3.13 'Ventilating brick' registered by Edward Beedle on and litigated in the Berkshire Lent Assizes, 1850, in *Rogers and Beedle v Driver*: BT 45/10/1915

7 per cent royalty on sales. When Driver failed to pay the full fee, Rogers and Beedle brought an action at Berkshire Assizes for the remainder. Driver sought to argue that the registration was invalid on various bases including that the subject matter was properly that of a patent, and thus not registered design. Patteson J said he could see no reason why the statutory right should not be available for matters that were also

patentable,¹⁶² and the full court of Queen's Bench agreed. Without offering a conclusive view as to whether the brick was patentable, the judges were unanimous that there was no reason to think that the patentability of an article precluded its registration under the Utility Design Act.

It is hard to assess the impact of the 1843 Act. Writing in 1851, Thomas Turner noted that 'we have very little of an authoritative nature to guide us in deciding what proportion of the registered designs might have been or may be maintained'.¹⁶³ One 'eminent member of the bar' had, by 1850, apparently expressed the opinion that 'it is impossible to protect any machine, or portion of a machine, under [the Act]' leading one commentator to suggest that only one in ten had been validly registered.¹⁶⁴ Some thought the uncertainty merely an opportunity for 'puffing and pretence'.¹⁶⁵ Others offered more positive appraisals. Charles Barlow and Philip Le Capelain, patent agents, agents for registration and editors of the *Patent Journal and Inventors Magazine* argued that while the 1843 Act was 'singularly obscure and indefinite' nevertheless it 'has worked well, and conferred incalculable advantages on inventors'.¹⁶⁶ As we have seen, registrants succeeded in a reasonable proportion of cases and, magistrates frequently adhered to their own sense of justice. *The Builder* anticipated that in future reform proposals 'Justice will be done to the Registration Act as an irregular improvement in, or rather substitute for, the law as it stands – as a "small patent law" in short, as the public have not been slow in making it'.¹⁶⁷

According to the Society of Arts, the Act had a very positive effect on the morality of 'inventors'. Although offering no empirical evidence, the Society of Arts was convinced that manufacturers respected the registrations, irrespective of their validity.¹⁶⁸ Clement Johnson, the successor to F. B. Long as the Registrar of Designs, claimed that 'on the whole the Act has worked to the satisfaction of inventors and the public in general'.¹⁶⁹ In particular,

however theoretically imperfect the system of registration may have been, that practically a degree of protection was afforded at a cheap rate to . . . minor inventors, and secured to many a property in their own invention, which, without the existence of the system, must have been totally lost.¹⁷⁰

¹⁶² *Rogers and Beedle v Driver* (nisi prius, Berkshire Lent Assizes 1850).

¹⁶³ Turner 1849, 24 'the Act has, on the whole, worked well.' Liverpool Financial Reform Association 1851, 8 (estimating that only 1 in 3 registrations was valid).

¹⁶⁴ Anon 1850c, 560.

¹⁶⁵ Anon 1850a.

¹⁶⁶ Anon 1847c.

¹⁶⁷ Anon 1850f.

¹⁶⁸ SCPB, 407.

¹⁶⁹ First Report, 482.

¹⁷⁰ First Report, 482.

3.4 THE DEMISE OF THE UTILITY DESIGN ACT

While the parameters of the subject matter of the Utility Design Act and its relationship to patentable subject matter remained undefined, after 1852 the level of concern with the overlap between the two regimes waned rapidly. This was because of the reform of patent administration which simplified the patent system, united the three patents of England and Wales, Scotland and Ireland into one, and established a central patent office. Most importantly, reductions in the cost of a patent to £25 for three years enabled the patent system to compete with a £10 Utility Design Act registration.¹⁷¹ Although some had suggested that if the patent system was reformed that the Utility Design Act should be abolished,¹⁷² others suggested that it should be left to die a natural death,¹⁷³ which was what happened. Following the patent reforms, utility design registrations fell to about 100 per year after 1860 (a number maintained until 1883), while patent registrations increased exponentially after 1852 (prompting further reflection on the desirability of making patents even cheaper).

With fewer registrations, fewer cases were reported.¹⁷⁴ With no significant developments in the jurisprudence on the Utility Design Act in the next three decades, the precise boundary and the degree of overlap remained uncertain. In 1872, giving evidence to a further Select Committee on Letters Patent, Bennett Woodcroft, the clerk to the Commissioners of Patents (established under the 1852 Act), observed that there were many patents that had been taken out that were ‘properly the subjects for the registration of designs’ and that ‘many inventions go to the Design Office, which belong to the Patent Office’.¹⁷⁵ In line with this, treatises continued to warn of the dangers of assuming that protection under the Utility Design Act was in some way equivalent to that of a patent;¹⁷⁶ nonetheless, the practice continued.

In 1883, it was decided to merge the Ornamental and Utility Designs Acts into a single regime.¹⁷⁷ The Memorandum which accompanied the Patents, Designs and Trade Marks Act 1883 acknowledged that prior to 1883 many matters that were

¹⁷¹ An Act for amending the Law for granting Patents of Inventions, 15 & 16 Vict., c. 83. See Norman 1851, v (predicting reform of patent law would reduce interest in the 1843 Act); Webster 1852, 11. Reform of the patent system was heavily influenced by the design registration experience. See, SCPB 1851, App. E, 410; The Society of Arts ‘Inventions Registration and Protection Bill 1851: [it] is expedient to extend to inventors the protection afforded to Designs.’

¹⁷² SCPB 1851, 166, Q. 1099 (Alfred Newton).

¹⁷³ SCPB 1851, 167, Q. 1101 (Thomas Webster).

¹⁷⁴ *Loveridge v Gray*, *Bailey and Bartlett* (Birmingham Public Office 1861), *Holder v Osborn* (Birmingham Public Office 1862), *Taylor v Cowley* (Birmingham Public Office 1868), *Wright v Wells* (Balsall Heath Police Court 1875); *Wolverson v Law* (Birmingham Public Office 1877).

¹⁷⁵ SCLP 1872, 70, Q. 1325.

¹⁷⁶ Murdoch 1867, 13; Copinger 1870, 219; Craig 1879, 46, 52.

¹⁷⁷ Patents Designs and Trade Marks Act 1883 (46 & 47 Vict. c.57) (‘PDTMA’). The jurisdiction of the magistrates was also abolished.

patentable had been protected under the Utility Design Act.¹⁷⁸ As Joseph Chamberlain, the President of the Board of Trade, told the House of Commons, the Utility Design Act

had been largely used in order to obtain what we might call a cheap patent, because under [the Act] a mechanical invention could be registered for a period of one year's provisional and three years complete registration, for a sum of £10. Practically, registration under these provisions constituted a patent for four years for the sum of £10.¹⁷⁹

However, because the 1883 Act reduced the costs of patents to £4, the attraction of design registration (at £10) disappeared: 'such useful designs as embrace a mechanical action would be treated as subject matter for a patent'.¹⁸⁰

The implication from this was that the 1883 reform was not intended to change things substantively; the Registry would be simplified by removing the formal classification that relied on the distinction between shape, etc., which served the purpose ornament versus utility. As the barrister Edward Daniels observed, the distinction between the two forms of design 'was abolished'.¹⁸¹ Nothing in the move implied that if an applicant were to choose the now more expensive design protection over patenting, that utility of form would not remain a consideration in the assessment of the novelty of a design or its infringement.

Whatever the intention, the effect of the merger of the Ornamental and Utility Designs Acts did have important consequences. This is because, in practice, administrative changes and judicial interpretation ended the feasibility of using the design regime as a utility model scheme: it was not so much the 'distinction' between ornamental and utility designs that was abolished so much as the category of utility designs itself.

On the administrative side, presumably anticipating that such applications would no longer occur because of the cheapening of patents, the implementing apparatus for the registration of designs was altered so that it no longer provided for the application to include a title, let alone 'such description in writing as was thought necessary to render the same intelligible'.¹⁸² As Edmunds explained, 'no elaborate explanation by the author of the design is required or allowed'.¹⁸³ Moreover, while under the Utility Design Act, the drawings were to be 'on a proper geometric scale',¹⁸⁴ the drawings required under the 1883 Act only needed to enable the registry

¹⁷⁸ Quoted in Daniels 1884, 69.

¹⁷⁹ Hansard (HS), Vol 278, col 349–350 (April 16, 1883) (Second reading of Patents, Designs and Trade Marks Bill).

¹⁸⁰ Quoted in Daniels 1884, 69.

¹⁸¹ Daniels 1884, 69. See also Fulton 1894, 141.

¹⁸² UDA, s. 8.

¹⁸³ Edmunds 1895, 56.

¹⁸⁴ UDA, s. 8.

to ‘identify the design’.¹⁸⁵ While the 1883 Act still required a statement as to the ‘nature of the design’,¹⁸⁶ rule 9 of the Design Rules 1883 interpreted this as merely an indication of whether the design related to ‘pattern’, ‘shape’, or ‘configuration’ and an indication as to the method by which the design was to be applied to the article. Importantly, too, the 1883 Act conferred on the comptroller the power ‘if he thinks fit, to refuse to register any design presented to him for registration’.¹⁸⁷ Thereafter, the Office could reject applications that it thought inappropriate, for example because the application appeared to relate to mechanical actions or principles. Finally, under the 1883 Act, all designs were secret – so that if useful designs had remained protected a person could incur penalties even though they could not have known of the registered design.¹⁸⁸

In effect, the post-1883 design regime was no longer structured to function as a utility model. This is vividly illustrated by comparing the registrations under the 1843 Act with a registration under the 1883 regime.

On November 10, 1884, Walker, Hunter & Co registered a design for a fire door (Figure 3.14).¹⁸⁹ As is evident, the representation used under the 1883 Act had no text (whereas those used under the 1843 Act had plenty of text). Elsewhere in the register book, under ‘Statement of Design’ Walker, Hunter & Co wrote ‘range fire door with moulding on to fit. Moulding forming front of range. Shape to be registered’.¹⁹⁰ There was nothing to indicate the function of the moulding beyond the words ‘to fit’. (The entry in the newly published *Official Journal of the Patent Office* was even less informative, referring just to the registration number, proprietor, date of registration and class).¹⁹¹ As we will see, this change in form had implications for the judicial interpretation of the scope of protection afforded by a representation.

The administrative changes fed into judicial interpretation of the scope of eligible subject matter under the Patents, Designs and Trade Marks Act 1883. With the exception of one or two first-instance decisions,¹⁹² the courts began to develop case law that limited the potential to protect the function or functional components of an article through design registration. The first judicial move in this direction was to declare that the purpose of any particular shape was irrelevant and that novelty and infringement were to be assessed simply by ‘the eye’. The second was to re-evaluate the relationship between design and patents and bit by bit to embrace the principle that anything that could be patented was ipso facto not protectable as a design.

¹⁸⁵ PDTMA, s. 48.

¹⁸⁶ PDTMA, s 47(3).

¹⁸⁷ PDTMA, s 47(6).

¹⁸⁸ PDTMA, ss. 22, 52 and 88; Edmunds 1895, 69–70.

¹⁸⁹ BT 50/21.

¹⁹⁰ BT 51/9.

¹⁹¹ Anon 1884, 1087.

¹⁹² *Tyler v Sharpe* (1894), 36.

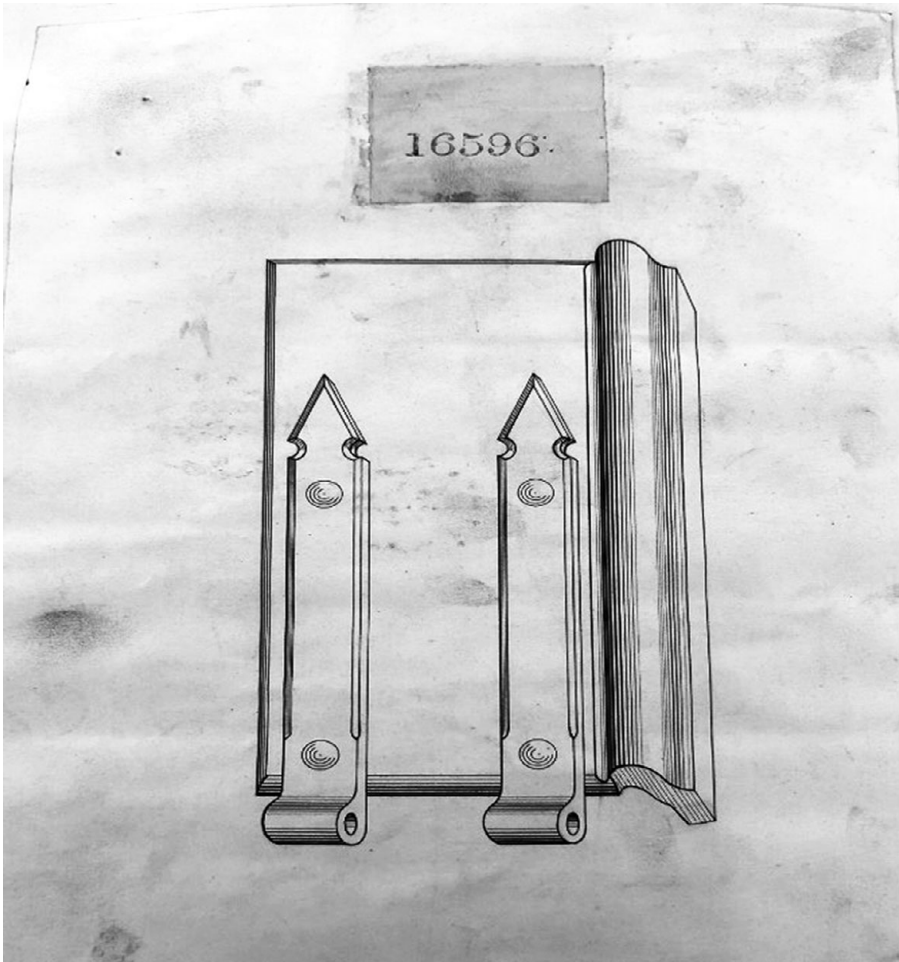


FIGURE 3.14 Walker, Hunter, & Co's registration under the Patents, Designs and Trade Marks Act 1883, dated November 10, 1884, litigated in *Walker, Hunter, & Co v Hecla Foundry* (1889 House of Lords): BT 50/21/16596

The first move was taken by the House of Lords in its 1889 decision in *Walker, Hunter, & Co v Hecla Foundry* (1889 House of Lords). In this case the claimants registered a design for a fire door for a kitchen range, with the representation as set out at Figure 3.14. The key characteristic of the door was the moulding on the door, which the registrant claimed operated to exclude cold air from the range (a function that would not have been obvious to a non-expert from looking at the representation). As already noted, the text accompanying the registration indicated that protection was for 'the shape' of the door but said nothing about function. While the court below had treated the purpose of the moulding as being relevant to

determine whether the defendant's fire door infringed (so that any suitable moulding would infringe), the House of Lords indicated that this was not the correct approach. Instead, they said that the purpose of the shape was an irrelevant consideration: all that mattered was the similarity of shape viewed by the eye. As Lord Herschell stated, 'I do not think the object which the designer has in view in adapting the particular shape, or the useful purpose which the shape is intended to serve, or does serve, ought to be regarded in considering what is the design protected'.¹⁹³

In many ways, this reasoning was the inevitable consequence of the changes in the administrative rules which precluded the possibility of claim-like descriptions that had been commonly used under the Utility Design Act. In the absence of such statements, courts would either have had to identify the purpose of a design from circumstantial matters, or treated the purpose of the shape as being irrelevant to its legal evaluation. The House of Lords chose the latter approach. The ruling meant that the 1883 Act had been more than a mere formal merger of two classes of ornamental and utility designs into one (as Chamberlain had put it). The removal of the textual aspect of the representation had deprived the courts of a key feature that had facilitated the identification/interpretation of designs.

By leaving the appraisal of any registration or alleged infringement to the 'eye' alone,¹⁹⁴ the merger effected in 1883 assimilated the scopic regime of representation/interpretation to that of the Ornamental Design Act. In *Hecla Foundry*, Lord Watson declared that the decision of the House of Lords in *Holdsworth v McRea* (1867 House of Lords), a case decided under the Ornamental Design Act, was equally applicable to the 1883 Act. In this case, the issue was whether depositing a specimen of a fabric pattern had been satisfactory for the purposes of section 5 of the 1858 Act. All members of the House of Lords held that the registrant had complied with the Act and as a result that the design protected was for the entire combination of features in the sample. Lord Westbury elaborated further: 'the appeal is to the eye, and the eye alone is the judge of the identity of the two things. Whether, therefore, there be piracy or not is referred at once to an unerring judge, namely, the eye, which takes the one figure and the other figure, and ascertains whether they are or are not the same'.

As there was nothing 'below the surface', it was assumed that no explanation was required as to the meaning and purpose of ornament. Lord Westbury's test was premised on the belief that vision was universal and self-explanatory, requiring neither education nor expertise.¹⁹⁵ In this context, it was the judge who determined similarity by comparing features side by side. As David Fulton explained, 'the Court will not look beneath the surface, but must find the reasons for registration apparent

¹⁹³ *Walker, Hunter v Hecla* (1889), 558.

¹⁹⁴ See also *In re Clarke* [1896] 2, ch 38.

¹⁹⁵ Cf. *Cooper v Symington* (High Court, Ch. D. 1893), 264, 265, 267 ('expert eyesight' which 'receives evidence'). In practice the parties were permitted to lead whatever evidence they chose: Edmunds 1895.

to the eye'.¹⁹⁶ The indirect effect was to exclude many functional features from consideration at all because they would go unnoticed to the 'universal' as opposed to the trained or informed 'eye'. As Baron Pollock indicated in *Moody v Tree* (High Court 1892), small changes to shape or configuration which achieved functional effects could be disregarded if they were not 'pleasing to the eye'.

The second move was to frame the concept of design within the broader context of other industrial property rights (a concept recognised internationally in the Paris Convention of 1883 and implicitly in domestic legislation enacted that same year). More specifically, judges started to define design protection by reference to patent protection, giving the latter some sort of historical precedential and normatively superior status. In this characterisation, patent protection was recognised as historically and normatively prior while design law was seen as a legislative supplement. As a result, whatever the purpose of design law may have been, it could not have been intended to overlap with the subject matter of patents. If subject matter were patentable, it ipso facto should not be regarded as falling within the field of design protection. This mode of thinking tallies with what we have referred to elsewhere as the 'denigration of design'.¹⁹⁷

This form of reasoning can be seen most clearly in *Moody v Tree*. The case, which concerned a registered design for a basket (Figure 3.15), had initially been heard at Kent County Court, where a jury ruled the claimant's design to be novel. The Court allowed the defendant to apply to the Divisional Court for a ruling on whether, even though new, the registration related to a design, and the superior court concluded it did not. Below the representation of the basket the applicant had indicated that the pattern involved the osiers being worked in singly and all the butt ends being outside.¹⁹⁸ The Divisional Court concluded that this described a mode of construction, not a design. Baron Pollock (a survivor from the pre-Judicature Court of Exchequer, though now in the High Court) initially expressed some discomfort in dealing with design protection 'in consequence of the novelty of this Act of Parliament, which in one sense is founded on patent law, but in another sense is entirely distinguishable from patent law'.¹⁹⁹ However, having satisfied himself that 'the Act with which we are dealing now is founded upon a different basis to the Patent Act', Baron Pollock reasoned that 'the Designs Act was intended to add to the Patent Act by making that which was not patentable – the subject of a design'. In contrast to previous authorities that had foreseen the possibility of overlap, Pollock utilised the historical priority of patent law to interpret the concept of design as necessarily excluding material that was patentable. Concurring, Vaughan

¹⁹⁶ Fulton 1902, 294.

¹⁹⁷ Sherman and Bently 1999, 163.

¹⁹⁸ Although this is stated in the report, the surviving register contains no such text. And the entry in the *Illustrate Official Journal* refers only to the number, class (III), proprietor's name and address and the date of registration: Anon 1891, 568.

¹⁹⁹ *Moody v Tree* (1892), 336.

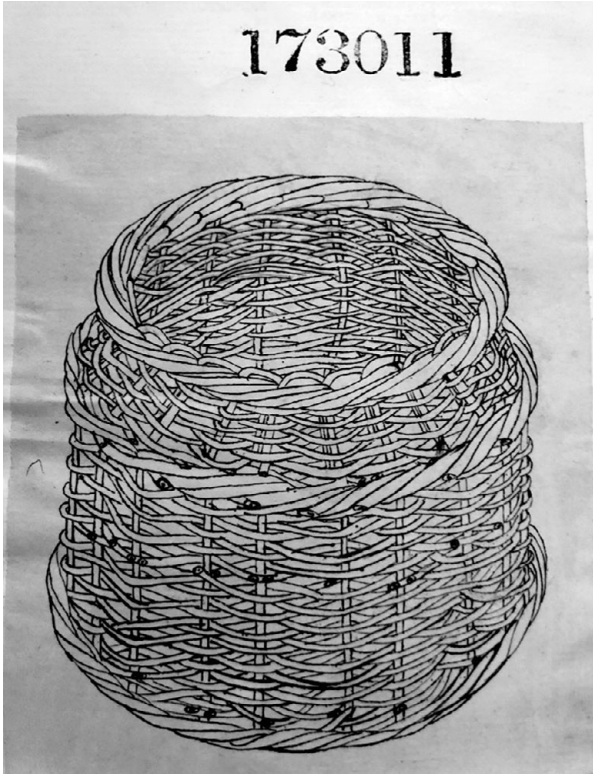


FIGURE 3.15 Thomas Isaac Moody's registration of a design for a basket, dated June 17, 1891, and litigated in *Moody v Tree* (High Court 1892): BT 51/64

Williams J. argued that 'it was not the intention of the Act of Parliament that processes which could not, either for want of novelty, or want of utility, or some other reason, be protected as patent rights should be protected by reason of . . . the provisions contained in this Statute with reference to designs'.²⁰⁰

These judicial manoeuvrings reinforced the perception that the protection of 'useful designs' had been abolished in 1883. In 1930, looking back, the Chair of the Sargant Committee observed that 'in 1883 registration of such [utility] designs was abolished, and that since that date registration had been possible only in respect of ornamentation'.²⁰¹ In turn, these judicial manoeuvrings also prepared the ground for statutory amendment of the definition of 'design'. Following a report of the Board of Trade in 1916,²⁰² judicial limitations were statutorily confirmed by the introduction of an exclusion from the registered design system of 'any mode or principle of

²⁰⁰ *Moody v Tree* (1892), 336.

²⁰¹ Minutes of 29th Meeting, June 25, 1930.

²⁰² The Board of Trade's Committee, chaired by Lord Parker, was never published officially, though some of it has recently been transcribed: Johnson 2017.

construction or anything which is in substance a mere mechanical device'.²⁰³ With these exclusions, the utility design regime was finally brought to an end.

3.5 FORGETTING THE UTILITY DESIGNS ACT 1843

Almost immediately after the final vestige of the 1843 Act was removed from British law in 1919, there were calls for the introduction of some kind of short-term, cheap and speedy protection for minor innovations in the United Kingdom. The first came in 1928 in the form of a report by the British Science Guild,²⁰⁴ a pressure group made up of scientists keen to have scientific insight incorporated into public policy.²⁰⁵ Entitled, *Reform of British Patent System*, the committee led by the electrical engineer, William Eccles, proposed the introduction of a 'short term patent' for new and useful variations of known constructional forms and arrangements and compositions characterised by new ingredients, but not for processes.²⁰⁶ The proposal was rejected by a governmental committee established by the Board of Trade,²⁰⁷ though it regarded the question as 'one of the most important and most controversial subjects' that it had to consider.²⁰⁸ The question was raised again in the early 1960s in another departmental inquiry on industrial design (the Johnston Committee), which indicated that though the question was a 'live one' it was outside the Committee's terms of reference. The idea was rejected again in the Banks report in 1971. Despite what might have been regarded as a conclusive rejection, just over a decade later a Green Paper issued by a committee headed by the then Chief Scientific Officer to the Cabinet Office recommended adoption of a regime of 'registered inventions'.²⁰⁹ The recommendation did not, however, make it onto the statute book.²¹⁰

Despite the persistent interest in some sort of utility model through the twentieth century, none of the various proposals or reports built upon the Utility Designs Act

²⁰³ Patents and Designs Act 1907–1919, s. 93, as amended by Patents and Designs (Amendment) Act, 1919, s. 19. In *Tecalemit Ltd v Ewarts Lts* (No. 2) (High Court, Ch.D. 1927), 506, Moritz KC submitted that this changed the words of the statute 'but the law remained the same'.

²⁰⁴ For internal consideration even earlier by the Board of Trade see Temple Franks (1912) and Hatfield (1912).

²⁰⁵ MacLeod 1994.

²⁰⁶ British Science Guild 1928, 22–24.

²⁰⁷ Sargent Committee 1931, 81–86. In fact, in its submissions to the Committee, the representatives put the case much less forcefully, stating 'While there is in some quarters a strong demand for the introduction of what we have called "short-term patents" – i.e. monopolies intermediate in character between patents and registered designs – account must be taken of certain difficulties': BT 209/282.

²⁰⁸ Sargent Committee 1931, 81, [371].

²⁰⁹ Nicholson Committee 1983.

²¹⁰ Department of Trade and Industry, *Intellectual Property and Innovation* 1986, 15–18, [3.4]–[3.16].

1843.²¹¹ Instead, the German *gebrauchsmuster* was consistently used as the legal model for the proposed new rights.²¹² The *gebrauchsmuster*, introduced in 1891 to fill the ‘gap’ perceived to exist between registered designs (which were limited to aesthetic appearance) and the high level of inventiveness necessary to merit patents,²¹³ protected ‘working appliances or articles of utility, or parts of the same in so far as they serve the object of the work or use through a new shape or arrangement’. Even though the *gebrauchsmuster* was itself very likely inspired by the British precursor,²¹⁴ it was the German version that had become the key reference point in the United Kingdom.

Why was the Utility Designs Act so quickly forgotten? One potential reason for this is strategic: whether one supported or opposed proposals for a second tier of protection, the 1843 Act probably offered little to buttress one’s case. For supporters, the experience of the 1843 Act could hardly have been presented as a huge success. While the German *gebrauchsmuster* proved to be as popular as patents in terms of registrations,²¹⁵ after 1852 there were rarely more than 100 utility designs registered each year in the United Kingdom. Moreover, the fact that the *gebrauchsmuster* was a feature of the law of an important foreign trade rival had rhetorical force: the fact that the *gebrauchsmuster* benefited and supported German innovators was a strong argument for its adoption in the United Kingdom.²¹⁶ For opponents of the adoption of a utility model in UK law, the experience of the 1843 Act might have enabled them to argue ‘we tried it, and it was a failure’. However, as we have seen, it would have been difficult to assert that it had clearly been a resounding failure.²¹⁷ For those aware of the history, it might have been better to ignore the British experience and instead emphasise that the German *gebrauchsmuster* was linked to distinct features

²¹¹ The records of the Parker Committee of 1916 do include a Memorandum by W. J. Tennant of patent agents Boulton, Wade & Tennant in which he observes ‘The reinstatement of the old design patent is very often spoken of as desirable’: BT 209/485.

²¹² British Electrical Allied Manufacturers Association 1916; British Science Guild 1928, 22, [25]; Sargant Committee 1931, 82, [374]; Johnston Committee 1962, 104–105, [164]; Banks Committee 1972, 145, [491] (also referring to Japan); Nicholson Committee 1983, 20, [4.7] (as well as those of Japan, France, Italy and Australia).

²¹³ Isay 1932, 268ff.

²¹⁴ The language and concept are close, and we are told the German government carefully reviewed the laws of the United States, France and Great Britain: Osterrieth 1912, 196. Weston 1983, 372, [15] who called the Utility Designs Act ‘the forerunner of German *Gebrauchsmuster*’.

²¹⁵ Hatfield 1912 (reporting that in 1909 there were 44,411 patent applications in Germany and 52,933 applications for *gebrauchsmuster*); British Science Guild 1928, 24, [30].

²¹⁶ Recommendations of the British Electrical Allied Manufacturers Association 1916 in BT 209/486. However, the Comptroller had considered and rejected the idea four years previously (Temple Franks 1912) and was not open to reconsidering it.

²¹⁷ Charles Sargant, who had declared himself opposed to adopting a British *gebrauchsmuster*, said he found a paper produced by the committee secretary, R. W. Luce, on ‘previous British legislation re utility designs’ to be ‘not very conclusive’: Minutes of 28th Meeting, June 4, 1930, 3, [5].

of German law and procedure – for example the high standard of patent examination – which made its adoption in the United Kingdom unnecessary or problematic. (Interestingly, perhaps, nothing was said at this point about divergent approaches to the drafting of claims and their interpretation.) This would also have allowed more xenophobic opponents to characterise the utility model not only as unnecessary or undesirable, but also as intrinsically foreign.

While strategic decisions to remember history selectively and to ignore inconvenient aspects from the past help to explain the absence of references to the 1843 Act, the collective amnesia is more likely as much a consequence of prevalent ways of thinking about intellectual property law. As we described in *The Making of Modern Intellectual Property Law*, by the end of the nineteenth century a particular way of thinking about ‘intellectual property law’ had fallen into place, according to which the field was divided into particular branches – patents, copyright, designs and trademarks – each with its own self-image and logic.²¹⁸ By the last decades of the nineteenth century each branch had its own treatises, many of which remain today – volumes by Copinger and Scrutton on copyright; Terrell, Edmunds, and Frost on Patents; Edmunds on designs. The distinctness of these categories was further cemented through the twentieth century, for example by way of international and regional arrangements for registration. In this categorisation, the history of the Utility Designs Act was included in the category of history of design law (even if only as a historical aberration),²¹⁹ whereas proposals for utility models and short-term patents were conceptualised within the field of patent law. As a result, the 1843 Act was simply not part of the ‘memory’ of British patent law.²²⁰

The dominance of such a way of thinking about the shape and nature of the law is evident in many of the twentieth century documents that considered introducing a utility model law into the United Kingdom. For example, in arguing for the adoption of a British *gebrauchsmuster* the British Science Guild said that ‘the new body of law that must be created should preferably conform to *the model of patent law* rather than of design law’.²²¹ The Sargant Committee’s response, rejecting the proposal, argued that the entire idea of a ‘useful design’ was confusing, if not self-contradictory, because the very word ‘design’ implied in law the protection of appearance rather than utility.²²² The Committee went on to suggest that the confusion arose because ‘patents’ and ‘designs’ were placed within the same legislation – a curious comment given that the Committee was itself charged with reviewing the law of patents and designs but one entirely consistent with the idea that the different branches of ‘intellectual property’ comprise distinct regimes with

²¹⁸ Sherman and Bently 1999, chs. 5–8.

²¹⁹ Edmunds 1895, 8–9, with Act at 211. Copinger 1893, 485.

²²⁰ It is not mentioned in Edmunds 1890 (even though he also authored a treatise on designs), Frost 1891, or Terrell 1884.

²²¹ British Science Guild 1928, 22, [26] (emphasis added).

²²² Sargant Committee 1931, 82–83, [378]; a better term was ‘useful devices’.

their own ontologies, epistemologies, teleologies and histories.²²³ When the Johnston Committee was asked by various parties in 1961 to consider recommending the introduction of a ‘utility model’,²²⁴ it regarded the matter as falling beyond its terms of reference:²²⁵ presumably conceiving the issue to be one for the ‘more important’ branch of patent law rather than design law.²²⁶ The Committee’s historical review of legislation had mentioned the protection of ‘useful designs’ under the 1843 Act,²²⁷ but clearly did not think this sufficient to consider utility models as falling within ‘law relating to protection of industrial designs’.²²⁸ Perhaps least surprisingly, the Banks Committee, with its focus on patent law treated the proposal as a ‘petty patent’ entirely within the normative (and implicitly historical) framework of patent law.²²⁹ Even though the Nicholson Committee came to a very different conclusion from Banks, the framing was the same, even if the language ‘two-tier patents’ and ‘registered inventions’ was slightly distinct.²³⁰ It seems likely that the dominance of the modern framework for intellectual property thinking, coupled with the characterisation of *gebrauchsmuster*/utility models/petty patents as properly belonging within patents, goes a long way to explaining why most commentators and policy-makers have failed to draw a connection between these various proposals for reform and the forgotten Utility Designs Act of 1843.

²²³ Sargent Committee 1931, 83, [378].

²²⁴ Johnston Committee 1962, 104–105, [164].

²²⁵ Johnston Committee 1962, 105, [164].

²²⁶ Johnston Committee 1962, 6.

²²⁷ Johnston Committee 1962, Appendix B, 127.

²²⁸ Johnston Committee 1962, 2 (terms of reference).

²²⁹ Banks Committee 1972, 145, [491].

²³⁰ Nicholson Committee 1983, 20, [4.7].

APPENDIX 1 *Cases under the Utility Design Act 1843*

Hearing date	Complainant	Defendant	Subject	Tribunal	Counsel	Outcome
December 28, 1843	Vine	John Johnston, 30 London Wall, Regn No 34	'Churn'. Regd. September 28, 1843; BT 45/1/20 (registered to Attwood, Wimble and Wame)	Worship St. Peregrine Bingham.	Webster for C; Gurney for D ^a	Dismissed (absence of novelty).
October 1844	Joseph Welch and John Margetson, haberdashers, 134 Cheapside	Mr May, Moorgate St, hosier	'Improved collar.' Regd. February 29, 1844; BT 45/1/133	Guildhall. Aldermen Charles Farebrother and William Hughes Hughes	Webster for C. Lott (a solicitor) for D ^b	Fined £5.
November 5, 1844	Thomas Wolferstan, Salisbury	John Warner & Sons, Jewin Crescent, Cripplegate, brassfounder	'Safety boiler tap.' Regd. May 28, 1844; BT 45/1/190	Guildhall. Sir George Carroll and Alderman John Johnson	Webster for C; Clarkson for D	Dismissed. No reason provided.
February 15, 1845	Francis Kennedy and Charles Asprey, 49 New Bond Street	Coombs and Finlay	'Portable ink and light box.' Regd. August 27, 1844; BT 45/2/255	Police Court, Marlborough Street, London. Mr John Hardwick ^c	Simons for C; Webster for D	Dismissed (absence of new shape/ configuration; only novelty lay in mechanical contrivance).
March 22, 1845	Fletcher Woolley, 180 High Holborn	John Warner, Crescent, Jewin St	'Improvements in the shape of lamps and apparatus connected for the burning of oil of turpentine etc.' Regd. February 21, 1844; BT 45/1/127	Guildhall (Aldermen Charles Farebrother and William Hughes Hughes)	Rotch for C; Clarkson for D	Dismissed: claim related to mechanical action rather than shape.

APPENDIX 1 (*continued*)

Hearing date	Complainant	Defendant	Subject	Tribunal	Counsel	Outcome
October 27, 1845	Luke Williams, Upper Marylebone St, ironmonger	William Rimell, King St, Hammersmith (quick boiling kettle, Regd. August 22, 1845); BT 45/3/524	Concave bottom tea-kettle. Regd. January 13, 1845; BT 45/2/347	Thomas Paynter, Magistrate. Hammersmith Police Court		Dismissed as D's design was substantially different.
March 12, 1846	Joseph Guise, Margaret St, Spa Fields, London	Thomas Walsh, Half Moon Passage, Aldersgate St	Regd. January 24, 1845; BT 45/2/358	Aldermen Challis and Hughes Hughes	Clarkson for C; Humphrey for D	£5 and 40 shillings cost.
April 12, 1847	George Webb, Wood St, City (lace manufacturer)	Hosketh Hughes, lace manufacturer (Regd. February 25 1847); BT 45/5/977	Protection Ruche Tray. Regd January 13, 1847; BT 45/5/920	Guildhall. Sir James Duke and Alderman Michael Gibbs.	Payne for C. ^d Clarkson and Wordsworth for D.	Dismissed without prejudice. Judges were divided on merits.
December 31, 1847	Vincent Price, 33 Wardour Street	George Chambers, Upper Thames St	'Improved Economical Ironing Stove'. Regd. February 8, 1847; BT 45/5/954.	Guildhall. Aldermen Samuel Wilson and Charles Farebrother	Clarkson for C; Ballantine for D	Dismissed.
February 19, 1848	George Lister Haynes, Charles White & Charles Bevis, of 61 Backchurch Lane, Whitechapel	Thomas Brown of Tower Hill	'Windlass'. Regd. March 29, 1847; BT 45/6/1020 [controller' for use in anchoring ships]	Guildhall. Aldermen Michael Gibbs and Francis Moon	Wolrych for C; Clarkson and Rotch for D	Dismissed as lacking novelty.
May 6, 1848	Fox, hairdresser/perfumer, St Georges Circus, Blackfriars Rd. The	Jeremiah Evans, furnishing ironmonger, King William St	'Alarum for time pieces'. Regd. July 25, 1846; BT 45/4/776	Guildhall. Aldermen Thomas Finnis and William Lawrence		D fined £5, 4 shilling costs. Infringement though no

						evidence of copying.	
June 3, 1848	registration was effected by 'Edward Fox and James Carson, both of Liverpool'	John Margetson, Cheapside	George Wright, Long Lane, Smithfield (Regd November 17, 1847; BT 45/7/1261 for 'Direction Label')	'Protector label'. Regd. January 9, 1847; BT 45/5/917	Guildhall	Webster for C; Bodkin for D ^c	D fined £1.
November 20, 1848	George Twigg, Powell St, Spring Hill Terrace, Birmingham	Smith and Kemp, Brearley St, Birmingham	'Double rim button'. Regd. February 11, 1848; BT 45/7/1351	'Double rim button'. Regd. February 11, 1848; BT 45/7/1351	Public Office, Birmingham. S. Thornton, Mayor and James James	Slaney for C ^f ; Harding for D	Dismissed.
December 29, 1848	Robert Besley and William Thorowgood, letter founders, Aldersgate, London	Gallie	'The Courthand Printing Type'. Regd. February 11, 1847; BT 45/5/957	'The Courthand Printing Type'. Regd. February 11, 1847; BT 45/5/957	David Jardine, Bow Street	Webster for C; Hindmarch for D	Dismissed (on basis defendant resided in Scotland).
March 30, 1850	Auguste Motte, 9 Southwark Square, London	Joseph James Welch et al. (of Welch & Margetson)	'Improved portmanteau'. Regd. July 23, 1849; BT 45/10/1970	'Improved portmanteau'. Regd. July 23, 1849; BT 45/10/1970	Guildhall, Alderman Thomas Challis	Clarkson for C; Hawkins for D	£5 and costs. ^g
June 19, 1850	Auguste Motte, 9 Southwark Square, London	Robert Lancaster, Bread St	'Improved portmanteau'. Regd. July 23, 1849; BT 45/10/1970	'Improved portmanteau'. Regd. July 23, 1849; BT 45/10/1970	Guildhall, Alderman Thomas Challis	–Hawkins for D ^h	Dismissed (information misdescribed the invention).

(continued)

APPENDIX 1 (continued)

Hearing date	Complainant	Defendant	Subject	Tribunal	Counsel	Outcome
October 1, 1850	William Dixon of Liverpool, dealer in glass	John Bessell of Farringdon St, London	'Improved window ventilator'. Regd. January 26, 1849; BT 45/9/1750	Guildhall, Alderman Samuel Wilson.	Hindmarsh for C; D not represented	Finéd £30 for each offence plus £10 costs. ⁱ
October 9, 1850	Thomas Ryan Pinches 27 Oxendon St, Haymarket. Die sinker and engraver	William Leschallas (also Le Challas), ³² Budge Row, Wholesale stationer	Purse envelope. Regd. June 26, 1850; BT 45/12/2350	Guildhall. Alderman Thomas Sidney	Clarkson for C; Watts for D	£5 plus costs.
Same	Same	Joseph Addenbroke 2 Bartletts Passage. Holborn (envelope maker)	Same	Same	Not stated	20 shillings and £5 costs.
Mar 8, 1851	Alfred Gregory	Herman Harbusch Armstrong, 184 St George St, Wellclose Sq	A safety plate for a ship's scuttle. Regd. April 20, 1850; BT 45/12/2274	Thames Police Court. Edward Yardley	Webster for C; Simpson (solicitor) for D	Dismissed: D's not an imitation of C's.
May 5, 1851	Samuel Levy Samuels and Jonas Engel, Wholesale parasol manufacturers, Mumford St, Milk St, Cheapside	Foster, Porter, & Co, Wholesale parasol manufacturers, 47 Wood St, Cheapside	'Fleur de lis Parasol'. Regd. by Alexander Grant, March 27, 1850; BT 45/12/2242	Guildhall. Alderman Francis Moon	Huddleston for C; Clarkson for D	£5 with £7 costs.
May 24, 1851	Same	Thomas and James Venables, linendrapers, High St, Whitechapel	Same	Worship St Police Court	Huddleston for C; Solicitor for D	£5 with £5 costs.

May 15, 1852	Samuel Scowen and Rowland M.H.S. White, 9 Noble St. Warehouseman/cravat manufacturer	Weston	'The Aptandum Collar'. Regd. April 16, 1850; BT 45/12/2265	Clerkenwell Police Court. Mr Corrie	Thomas Jones for C; Streeten for D	Withdrawn.
October 1852	Adolphus Biddell, 11 St John Square Clerkenwell	Rogers and De Costa, Commission agents (or hawkers?) Hutchinson Avenue, Petticoat Lane, London	'Alarm door and window wedge'. Regd. February 19, 1851; BT 45/14/2697	Guildhall. Alderman Moon	Hawkins for C; Lewis for D	£10.

^aProbably Russell Gurney (1804–1878), son of Baron John Gurney.

^bProbably Thomas Lott (d. July 28, 1869) of Bow Lane.

^cAlthough the Act referred to two justices, one of 'Jervis' Acts' of 1848 allowed for a single magistrate to hear a case: An Act to facilitate the Performance of the Duties of Justices of the Peace 1848, s. 30.

^dProbably Joseph Payne, who would later serve with William Bodkin at the Middlesex Sessions.

^eWilliam Henry Bodkin MP, d. 1874.

^fProbably Robert Agliouby Slaney, M. P. (1791–1862).

^gQuashed in *R v Welch* (Queen's Bench 1851).

^hPossibly Sir Henry Hawkins (1817–1907), later Lord Brampton, who was a junior barrister at this time.

ⁱQuashed in *R v Bessell* (Queen's Bench 1851). For enforcement of the penalty, see *Morning Advertiser*, November 2, 1850, p. 4; *London Evening Standard*, November 2, 1850, p. 1.