

In the Privy Council.

ON APPEAL
FROM THE HIGH COURT OF AUSTRALIA.

UNIVERSITY OF LONDON
20 FEB 1957
ADVANCE

BETWEEN
HENRY GEORGE MARTIN (Plaintiff) . . . *Appellant*
AND
SCRIBAL PROPRIETARY LIMITED (Defendants) *Respondents.*

57089

Case for the Appellant

RECORD.

- 10 1. This is an appeal (pursuant to special leave granted to the Appellant by Her Majesty in Council) from two orders of the High Court of Australia both dated the 14th day of September 1954. By one of the said orders the High Court of Australia (Their Honours Chief Justice Sir Owen Dixon, Mr. Justice Fullagar and Mr. Justice Taylor) discharged two interlocutory orders of the Supreme Court of Victoria made by Mr. Justice Sholl on the 15th and 22nd days of June 1953. These interlocutory orders and the order of the High Court of Australia discharging them do not need to be separately considered, because the points arising thereunder (except as regards costs) must necessarily be dealt with and determined in the course of the appeal relating to the other of the said orders dated the 14th day of September 1954. By such last-mentioned order the High Court of Australia dismissed an appeal by the present Appellant from a final order of the Supreme Court of Victoria made by Mr. Justice Sholl on the 28th day of July 1953 (whereby Mr. Justice Sholl dismissed an action brought by the Appellant against the Respondents for alleged infringements of Letters Patent 133,163) unless within two months of the date of the order of the High Court of Australia the Appellant gave notice in writing that he desired a new trial in respect of certain issues, in which case there should be a new trial limited to those
- 30 issues.
2. The Appellant applied on the 11th November 1954 to the High Court of Australia to extend the said period of two months until such time as a Petition by the Appellant for leave to appeal had been heard, but such application was refused. Accordingly the Appellant gave notice that he desired such new trial in order to keep the position open, but stated in the said Petition that if leave to appeal was given he would withdraw the said notice. On the hearing of the said Petition it was
- Vol. I, p. 229.
Vol. I, pp. 223, 225.
Vol. I, pp. 24, 26.
Vol. I, pp. 223, 225.
Vol. I, p. 168.
Vol. I, p. 227.
Vol. I, p. 228.

submitted by the Respondents that, by reason of the giving of such notice, leave to appeal should be refused ; but notwithstanding such submission leave to appeal was granted. Following the grant of leave to appeal the Appellant has informed the Respondents in writing that he does not intend to proceed with such new trial.

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3. Letters Patent No. 133,163 relates to ball point pens, i.e. fountain pens which have a nib consisting of a small ball rotating in and protruding from a housing, which housing is fed with ink from the reservoir. The invention claimed in the specification of the said Letters Patent as finally accepted consists essentially of making the reservoir in the form of a vented capillary tube, i.e. a tube having a diameter less than about 3.5 mm. By this means an adequate flow of ink is always assured while at the same time leakage is avoided. 10

Vol. I, pp. 144-165.
Vol. I, pp. 176-209.

4. Mr. Justice Sholl held that the said patent was invalid for ambiguity and was not infringed. The High Court reversed the judgment of the trial Judge on both these points. None of the other usual grounds on which the validity of a patent is commonly attacked (e.g., anticipation, obviousness, inutility, insufficiency or failure to fulfil the result promised) were relied on by the Respondents in the High Court. Apart from the issues on which the High Court reversed the judgment of Mr. Justice Sholl and decided in the Appellant's favour, only three points were relied on by the Respondents as invalidating the patent, viz.: (1) prior claiming by Letters Patent No. 122,073, (2) that the amendments made to the complete specification between its first filing and its ultimate acceptance by the Commissioner of Patents went beyond anything contemplated by the Patents Acts 1905-1946 and were unauthorised by those Acts and that therefore the acceptance was a nullity and (3) that your Petitioner was not in possession of the invention at the date when the application was filed. Point (1) was ultimately abandoned by the Respondents. Both Mr. Justice Sholl and the High Court decided in favour of the Appellant on point (2), but the High Court decided against the Appellant's contentions on point (3). This latter point was not argued before Mr. Justice Sholl and is not referred to in his judgments. 20 30

5. Accordingly the sole ground on which the High Court have refused relief to the Appellant is that in their view *prima facie* the Appellant at the time of the application " was not in possession of the invention described and claimed in the specification No. 133,163," such conclusion being based mainly on a comparison of the complete specification as originally filed and the complete specification as accepted. In construing the specification of No. 133,163 and for the purpose of drawing inferences as to the state of mind of the Appellant when an applicant for the grant of that patent, the High Court also referred to the specification of No. 122,073. The Appellant submits that the High Court were in error in so doing when considering the validity of No. 133163 as every specification must be construed according to its own language and the only ground on which No. 122,073 could be relevant in relation to the validity of No. 133,163 (viz. prior claiming) was no longer relied on by the Respondents. 40

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Exhibit 1.

6. The Appellant submits that the ground on which the High Court held No. 133,163 to be invalid is one hitherto unknown in patent law.

There is no reported case in which such an objection has ever previously been suggested. Since the days when, by Statute, it became necessary to file with the application a specification setting out the nature of the invention such a ground of invalidity is an impossible one, because that for which the patent is granted must be that which is fairly disclosed in such specification. Substantial powers of amendment are granted by the Patent Acts and the Commissioner of Patents has a wide discretion in permitting or refusing amendments to the complete specification, but if amendments are allowed and the specification is accepted, the permissibility of the amendments cannot thereafter be examined, as Mr. Justice Sholl and the High Court have unanimously held. It follows that the judgment of the High Court in this respect is inconsistent with itself.

7. This difficulty was felt by Mr. Justice Taylor who said: "strictly speaking, the Respondent could not succeed . . . unless it appeared that the specification in its finally amended form claimed then as the invention something which was substantially different from the invention described and disclosed by the specification originally lodged. On this view of the matter the primary allegation that the Appellant was not, at the time when the original specification was lodged, in possession of the invention as finally described and disclosed would become immaterial and the only matter of importance would be, in effect, whether the invention finally described and claimed was substantially different from that originally described and disclosed. A conclusion favourable to the Respondent on this point would, of course, be precisely tantamount to holding that the amendments which resulted in the specification in its final form were improperly allowed by the Commissioner and this conclusion it seems to me is, for the reasons already given, not open to us." Vol. I, pp. 222, 223.

What the Defendant really sought to establish on the trial, however, was that the Plaintiff was not, in fact, in possession of the patented invention at the time when he made his original application and he sought to do this, in effect, by contending that the successive specifications described two different but related inventions and that a close examination of the terms of the original specification tended to show that at the time of the Plaintiff's application he did not appreciate or understand the principle of the second invention. To my mind this represents a doubtful approach to the determination of the question of fact which the Defendant sought to raise and an approach which, were it not for the contrary view held by the majority of the Court, I should be prepared to hold was precluded by the allowance of the amendments in question and the acceptance of the specification in its final form. The matter, however, is by no means free from doubt and I am not prepared to dissent from the orders proposed . . ."

8. No authority was cited by any member of the High Court to establish the existence of this suggested ground of invalidity. Chief Justice Dixon said:—

"It is, of course, a recognised ground for avoiding a patent, although one that can rarely arise." Vol. I, pp. 188, 189.

In speaking of the recitals in a grant as made at that time Mr. Terrell in the sixth edition of his work (1921), p. 6, said: 'The

first recites the patentee's name and address, that he has made a declaration, that he is in possession of the invention . . . These are the so-called " suggestions " which are supposed to have been made to the Sovereign prior to the patent being granted and are the representations upon which it has been granted. If either of these suggestions be untrue the patent is void.'

The recital in Australian letters patent is in a different form but the result is the same. The recital is that the patentee has made a declaration in the prescribed form. The prescribed form of declaration is part of the application and includes a declaration 10 that the applicant is in possession of the invention. In the present case the Plaintiff, who applied as assignee of the ' actual inventor ' declared that he, the Plaintiff, was in possession of the ' said invention.' The ' said invention ' was identified by the general description as ' an invention entitled " improvements in writing instruments " '. A point may perhaps be made that a plea of false suggestion based on this declaration cannot be made out except by showing that the patentee was not in possession of the invention described in the complete specification which accompanied the application ; as, on the Defendant's case, the grant related 20 to another and different invention the plea would not be established by proof that the patentee was not at the time of the application in possession of the latter invention. No such point was made on behalf of the Plaintiff and if it were a good one it would indeed be a strange result of the change in the form of the letters patent. The substantial answer to it is that, however much the specification may change its shape by amendment, the representation of the applicant that he was, at the date of applying, in possession of the invention therein described is continuing and operates upon it. Otherwise a grant would not be made as of the date of the 30 application."

The Appellant submits that the representation made by an applicant is that he is in possession of the invention described in his specification which accompanies the application. The nature of that invention cannot thereafter be changed and the Commissioner of Patents is charged with the duty of seeing that it is not changed, although he may allow extensive amendments in the form of the specification. The Appellant submits that if and when the Commissioner accepts a specification after amendment as of the date of the original application it is conclusively determined that the invention as finally claimed is the same invention as that which was 40 the subject of the original application. Indeed in one part of their judgment the High Court have in effect so held. But if this be so, it must necessarily follow that the patentee was in possession of the invention finally claimed when he made his original application.

9. Mr. Justice Fullagar said :—

" . . . acceptance does not preclude an attack on the patent on any ground on which a patent may be held to be invalid. Prior grant, prior publication, prior user, want of subject matter, and all other grounds of attack, remain open to an applicant for revocation or to a Defendant in an action for infringement. In 50

particular, it is open to such a Defendant to attack the patent on the ground that the patentee was not, at the date of his application, in possession of the invention protected by the grant. This is a good and sufficient objection to the validity of the patent. If it were otherwise, a valid patent could be granted on a false suggestion, and a monopoly could be obtained as from a particular date for something which the patentee had simply not invented at that date."

The Appellant submits that the considerations set out in paragraph 8 hereof are equally applicable to this judgment, as also are those set out in the next paragraph. In addition Mr. Justice Fullagar has failed to appreciate that, unlike all the usual defences in a patent action, the defence that the applicant was not in possession of the invention at the date of the application is actually inconsistent with the fact of acceptance.

10. The Appellant submits that the High Court have fallen into this error (*inter alia*) because they have failed to appreciate and distinguish between the various meanings of the word "invention" as clearly pointed out in the judgment of Fletcher Moulton, L.J., in *British United Shoe Machinery v. Fussell* 25 R.P.C. 631. These meanings are (1) a practical piece of apparatus or a practical process containing many details, the whole being adapted and designed to produce a commercially useful result; (2) the actual respect in which the apparatus or process shows an advance over the prior known art, this advance being commonly called "the inventive step"; (3) the delimitation of the monopoly, i.e., the actual "claims." Fletcher Moulton, L.J., points out that what the inventor may conceive to be the inventive step is quite irrelevant for any purpose. Working alone and in ignorance of the work of other people he probably has a totally mistaken idea of wherein his real invention lies. Fletcher Moulton, L.J., further points out that (1) and (3) are really mutually antagonistic as the inventor must on the one hand give the fullest directions in order to assist the public to exercise the invention after the monopoly has expired but on the other hand it would be unduly harsh to limit his monopoly to all the details. Consequently his claims may be as broad as he pleases, so long as they are based on the description and do not cover anything not new. Plainly it would be useless for any purpose for the inventor to be required to specify in what features he thought his inventive step lay. These principles have been for many years adopted and acted on by the Patent Offices both of England and of Australia. The practice has been to allow any claim which does not go outside the detailed description originally filed, irrespective of whether the features included within any claim were originally put forward as an inventive step or not. The High Court, Your Petitioner submits, have completely disregarded these fundamental propositions of Patent Law and appear to think erroneously (A) that what the inventor thought was his inventive step was of some importance, and (B) that the claims must be confined to something originally stated by the inventor to be "the inventive step." It was held by Mr. Justice Sholl and was not disputed by the Respondents in the High Court that all the actual features which form the combination ultimately claimed in Letters Patent No. 133,163 are disclosed in the Specification as originally filed as parts or characteristics

of an adequately described practical apparatus. What is alleged is that in the original specification the inventor did not point out the advantages of the particular combination ultimately claimed and appeared to think that the inventive step lay in a different combination of features. The Appellant submits that even if this be so, it is no ground for holding the patent invalid, having regard to the principles enunciated by Fletcher Moulton, L.J., in *British United Shoe Machinery v. Fussell (supra)*, which principles have never been disapproved, but, on the contrary, hitherto have been invariably followed.

11. Even without the authority of *British United Shoe Machinery v. Fussell (supra)* if, contrary to the Appellant's contention, it is a possible ground of invalidity that the patentee "was not in possession of the invention at the date of the application," the word "invention" in such context must, your Petitioner submits, as a matter of construction, mean a practical piece of apparatus or a practical process capable of forming the subject of a valid monopoly claim. The word "invention" in such context cannot mean an appreciation of the precise respects in which such practical apparatus or process constitutes an advance over the sum total of prior knowledge, most of which would probably be unknown to the inventor when filing his original application, nor can it mean a specified monopoly claim, which could not be adequately or accurately formulated until the searches into the prior art required by the Patent Acts had been made by the Patent Office Examiner and brought to the Applicant's notice. 10 20

12. The High Court gave to the Appellant an opportunity of seeking a new trial upon the issue whether he was, as a matter of fact, in possession of the invention at the date of the application for a patent. The appellant submits that by the very making of this order the High Court have shown that they have failed to appreciate the fundamental basis of patent law, viz., that a monopoly is granted to the patentee in consideration of the disclosure by him to the public of his invention. If an inventor is possessed of an invention but has "confined it to his closet" this is an entirely irrelevant circumstance (*Dollond's Case*, 1 Webster P.C. 49). But the judgment of the High Court in the present case appears to contemplate that if your Petitioner could show that he was in possession of the "invention," notwithstanding that he might have made no disclosure of it to anyone in the world, this would be sufficient to validate his patent, even though the public in that event could derive no advantage from the fact that the Appellant possessed the "invention." The Appellant submits that this demonstrates the erroneous way in which the High Court have approached this matter. 30 40

13. As to the allegations that the patent in suit is invalid for ambiguity and is not infringed by the Respondents, the Appellant will rely on the reasoning and the decision on these points of the High Court.

14. As to the contention of the Respondents that the amendments made to the complete specification between its first filing and its ultimate acceptance by the Commissioner of Patents went beyond anything contemplated by the Patent Acts 1905-1946 and were unauthorised by

those Acts and that therefore the acceptance was a nullity and the patent invalid, the Appellant will rely on the reasoning and decision on this point both of Mr. Justice Sholl and of the High Court.

15. The Appellant submits that Letters Patent 133,163 is valid and has been infringed by the Respondents and that accordingly the Appellant is entitled to the relief claimed by the Statement of Claim for the following among other

REASONS

- 10
- (1) THAT the High Court of Australia wrongly held Letters Patent No. 133,163 to be invalid.
 - (2) THAT the High Court of Australia rightly held the said patent to have been infringed.

K. E. SHELLEY

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HENRY GEORGE MARTIN

(Plaintiff) *Appellant.*

AND

SCRIBAL PROPRIETARY

LIMITED (Defendants) . *Respondents.*

Case for the Appellant

PAYNE, HICKS, BEACH & CO.,

10, New Square,

Lincoln's Inn, W.C.2,

Solicitors for the Appellant.