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Judgment  
22, 1956

No. 42 of 1955.

In the Privy Council.

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ON APPEAL  
FROM THE HIGH COURT OF AUSTRALIA

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BETWEEN  
HENRY GEORGE MARTIN (Plaintiff) . . . . . *Appellant*  
AND  
SCRIBAL PROPRIETARY LIMITED (Defendant) . . . . . *Respondent.*

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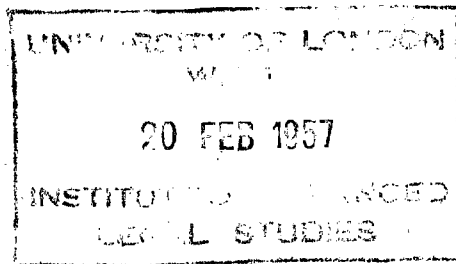
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RECORD OF PROCEEDINGS  
(IN TWO VOLUMES)

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(Pages 1-230)



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W.C.1.

**In the Privy Council.**

UNIVERSITY OF LONDON  
 20 FEB 1957  
 10018

**ON APPEAL**  
*FROM THE HIGH COURT OF AUSTRALIA.*

BETWEEN

HENRY GEORGE MARTIN (Plaintiff) . . . . . *Appellant*

AND

SCRIBAL PROPRIETARY LIMITED (Defendant) . . . . . *Respondent.*

**RECORD OF PROCEEDINGS**  
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# In the Privy Council.

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## ON APPEAL FROM THE HIGH COURT OF AUSTRALIA.

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BETWEEN  
HENRY GEORGE MARTIN (Plaintiff) . . . *Appellant*  
AND  
SCRIBAL PROPRIETARY LIMITED (Defendant) *Respondent.*

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# RECORD OF PROCEEDINGS

10

VOLUME I

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No. 1.  
ENDORSEMENT ON WRIT OF SUMMONS.

Suit No. 58 of 1951.

THE PLAINTIFF'S CLAIM is against the Defendant a Company incorporated in the State of Victoria for :—

1. An injunction to restrain the Defendant its servants and agents from infringing the Plaintiff's Australian Letters Patent dated the 31st day of December 1943 and numbered 133163 relating to "improvements in writing instruments."

20 2. Damages for such infringement or alternatively an account and payment of profits derived by the Defendant from such infringement.

3. An order for delivery up or destruction upon oath of all articles in the possession control or power of the Defendant made in infringement of the said Letters Patent.

4. Further or other relief.

TAKE NOTICE that the Plaintiff requires pleadings in this action.

*In the  
Supreme  
Court of  
the State  
of Victoria.*

No. 1.  
Endorsement on  
Writ of  
Summons,  
24th  
January  
1951.

*In the  
Supreme  
Court of  
the State  
of Victoria.*

No. 2.

STATEMENT OF CLAIM.

Suit 1951 No. 58.

IN THE SUPREME COURT OF VICTORIA.

No. 2.  
Statement  
of Claim,  
10th April  
1951.

Between HENRY GEORGE MARTIN . . . Plaintiff  
and  
SCRIBAL PROPRIETARY LIMITED . . . Defendant

(Writ issued 24th January, 1951)

1. The Defendant is a Company duly incorporated in the State of Victoria. 10
2. The Plaintiff is the grantee and registered owner of Australian letters patent No. 133163 dated the 31st day of December 1943 in respect of "Improvements in writing instruments."
3. The Defendant has infringed the said Letters Patent in the manner appearing in the Particulars of Breaches delivered herewith.
4. The Defendant threatens and intends unless restrained by this Honourable Court to continue the said infringements.

AND THE PLAINTIFF CLAIMS :

- (1) An injunction restraining the Defendant its officers servants and agents from infringing the Plaintiff's Letters Patent No. 133163. 20
- (2) Damages or at the Plaintiff's option an account of profits made by the Defendant by reason of such infringement.
- (3) Delivery upon oath of all writing instruments in the possession or control of the Defendant made in infringement of the Plaintiff's said Letters Patent.
- (4) Such further or other relief in the premises as to the Court shall seem just.

G. A. PAPE.

Delivered the Tenth day of April 1951.

30



**No. 3.**  
**PARTICULARS OF BREACHES.**

*In the  
Supreme  
Court of  
the State  
of Victoria.*

The following are the particulars of the breaches complained of in the Statement of Claim herein :—

No. 3.  
Particulars  
of Breaches,  
10th April  
1951.

1. Prior to the issue of the writ in this action and subsequent to the acceptance and publication of the complete specification of the Letters Patent in the Statement of Claim mentioned the Defendant has infringed the said Letters Patent by the manufacture, sale, offer for sale and/or supply in the State of Victoria of writing instruments known as the Scribal Secretary Pen made in infringement of the first, second, fifth and eighth claiming clauses of the Plaintiff's said letters patent No. 133163.

2. In particular the Plaintiff complains of :—

(A) The manufacture by the Defendant at its factory or place of business between the 19th day of February 1948 and the 24th day of January 1951 or thereabouts of writing instruments known as the Scribal Secretary pen made in infringement of the first, second, fifth and eighth claiming clauses of the Plaintiff's said letters patent. One of the said writing instruments is now in the possession of the Plaintiff's solicitors.

20 (B) The sale by the Defendant between the dates aforesaid to various persons firms and corporations within the Commonwealth of Australia (the precise names of which the Plaintiff is at present unaware) of writing instruments known as the Scribal Secretary Pen made in infringement of the first, second, fifth and eighth claiming clauses of the Plaintiff's said letters patent.

30 (c) The sale by the Defendant between the dates aforesaid of writing Instruments known as the Scribal Secretary pen to the Myer Emporium Ltd. of 314 Bourke Street Melbourne two of which writing instruments (having been purchased by Mr. Claude Woodward from the said Myer Emporium Ltd. on the 9th day of June 1950) are now in the possession of the Plaintiff's solicitors and which said writing instruments are made in infringement of the first, second, fifth and eighth claiming clauses of the Plaintiff's said letters patent.

The precise number and dates of the infringements committed by the Defendant are at present unknown to the Plaintiff, but the Plaintiff will claim to recover full compensation in respect of all such infringements.

Delivered the Tenth day of April 1951.

40 **MOULE HAMILTON & DERHAM,**  
of 394-396 Collins Street, Melbourne,  
Solicitors for the Plaintiff.

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*In the  
Supreme  
Court of  
the State  
of Victoria.*

No. 4.  
Defence,  
19th July  
1951.

No. 4.  
**DEFENCE.**

The Defendant as to the Plaintiff's Statement of Claim herein says that :—

1. It admits Paragraph 1 thereof.
2. It admits Paragraph 2 thereof.
3. It denies each and every allegation in Paragraph 3 thereof.
4. It denies each and every allegation in Paragraph 4 thereof.
5. The Letters Patent No. 133163 referred to in the Statement of Claim are and at all material times have been invalid— 10
  - (A) wholly ; or
  - (B) so far as they set forth and relate to the first second fifth and eighth claims therein ;

for the reasons set forth in the particulars of objections delivered herewith.

6. The Plaintiff has been guilty of laches acquiescence and delay and by reason thereof is not entitled to any of the relief sought.

7. The patentee under such Letters Patent, namely the Plaintiff, made and/or vended in Australia writing instruments made in accordance with the said Letters Patent and did not, as required by Section 125 of the Patents Act 1903-1950, give sufficient notice to the public within the 20 meaning of the said section that the aforesaid articles so made and/or vended were patented and the Defendants will rely upon the said section as an answer to any claim by the Plaintiff for damages.

Delivered the 19th day of July 1951.

STANLEY LEWIS.  
DOUGLAS MENZIES.  
R. L. GILBERT.

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## PARTICULARS OF OBJECTIONS (as amended)

Amended the 5th day of June 1953 pursuant to order of His Honour Mr. Justice Sholl made the 1st day of June 1953.

*In the  
Supreme  
Court of  
the State  
of Victoria.*

No. 5.  
Particulars  
of  
Objections  
(as  
amended)  
19th July  
1951.

TAKE NOTICE that the Defendant will on the trial of this action rely upon the following objections to the validity of Letters Patent No. 133163 :

1. The alleged invention was not proper subject matter for Letters Patent having regard to the common general knowledge at the date thereof.

2. The alleged invention was obvious and did not involve any inventive step having regard to what was known or used prior to the date of the said Letters Patent with respect to fountain pens of the ball tip type.

3. The Claiming Clauses relied on, namely the first, second, fifth and eighth Claiming Clauses of the Plaintiff's Letters Patent are all and each and every one of them is insufficient and vague uncertain and ambiguous and does not sufficiently or clearly define the monopoly intended to be thereby claimed.

20 4. (i) On the 8th day of December 1943 the Plaintiff made an application for a patent accompanied by a Complete Specification for an invention relating to improvements in fountain pens of the ball tip type, and pursuant to the said application a grant of Australian Letters Patent numbered 122073 was made.

(ii) On the 31st day of December 1943 the Plaintiff made an application for a patent accompanied by a Complete Specification for an invention relating to fountain pens and referring more particularly to fountain pens of the kind which comprise an ink reservoir formed by an extension of the channel for supplying the writing point with ink as  
30 further specified in the said Complete Specification, and after the happening of the events hereinafter set forth Australian Letters Patent Numbered 133163 were purported to be granted on the said application.

(iii) The Complete Specification of Australian Letters Patent Numbered 122073 was published on the 5th day of September 1946.

(iiiA) The unamended Complete Specification of United Kingdom Letters Patent Numbered 573747 dated the 21st day of February 1944 became available for public inspection at the Patents Office Library Canberra on the 29th day of May 1946.

40 (iv) On or about the 18th day of December 1946 the Plaintiff lodged in the Patent Office what purported to be but was not an amended Complete Specification as the Complete Specification accompanying the said application of the 31st December 1943, but the said Specification so lodged on or about the 18th day of December 1946 described and claimed then as

*In the  
Supreme  
Court of  
the State  
of Victoria.*

No. 5.  
Particulars  
of  
Objections  
(as  
amended)  
19th July  
1951,  
*continued.*

the invention something which was not the invention described and claimed in the Complete Specification previously lodged on the 31st day of December 1943 as aforesaid but something substantially different therefrom which was the same as the invention described and claimed in the document referred to in sub-paragraphs (i) and (iii) hereof or was not new by reason of the matters alleged in sub-paragraph (iii) hereof.

(ivA) The amended Complete Specification referred to in sub-paragraph (iv) hereof described and claimed the invention described and claimed in the document referred to in sub-paragraph (iiiA) hereof.

(v) On the 19th day of February 1948 the Complete Specification 10  
lodged on the 31st day of December 1943 as aforesaid was notified as open for public inspection under and pursuant to section 38A of the Patents Act 1903-1950.

(vi) On some date at present unknown to the Defendant the Plaintiff lodged in the Patent Office what purported to be but were not further amendments to the said Complete Specification lodged on the 31st day of December 1943 and such purported amendments described and claimed as the invention something which was not the invention described and claimed in the said Complete Specification so lodged on the 31st day of December 1943 as aforesaid but something substantially different there- 20  
from which was the same as the invention described and claimed in the document referred to in sub-paragraphs (i) and (iii) hereof or was not new by reason of the matters alleged in sub-paragraph (iii) hereof.

(vii) On the 14th day of June 1949 the Commissioner of Patents purported to allow the aforesaid amendments to the said Complete Specification lodged on the 31st day of December 1943, and on the said 14th day of June 1949 the Deputy Commissioner of Patents purported to accept the Complete Specification in respect of the said Australian Letters Patent numbered 133163, which purported acceptance was advertised in the Australian Official Journal of Patents Trade Marks and Designs on the 30  
30th day of June 1949.

(viiA) The Complete Specification referred to in sub-paragraph (vii) hereof described and claimed the invention described and claimed in the document referred to in sub-paragraph (iiiA) hereof.

(viii) None of the matters set forth in sub-paragraphs (iv) to (vii) hereof inclusive was made known to the Defendant or any other member of the public.

(ix) The said amendments allowance and acceptance and each of them purported to be made as aforesaid are and were at all times ultra vires 40  
contrary to law invalid and of no effect, and no grant of Australian Letters Patent Numbered 133163 should have been made and the said Letters Patent are of no legal effect.

(x) The said purported amendments were made by or at the instance of the Plaintiff who is not entitled to rely thereon or on anything done pursuant thereto including the grant of the said Letters Patent.

5. The Plaintiff as applicant for the grant of the said Letters Patent was not on the 31st day of December 1943 in possession of the invention

the subject matter of the Letters Patent ultimately granted as at that date and by reason thereof the grant thereof was made upon a false and improper and/or fraudulent suggestion and is and at all material times has been invalid void and of no effect.

*In the  
Supreme  
Court of  
the State  
of Victoria.*

6. On the 31st December 1943 the invention (if any) the subject matter of the Letters Patent ultimately granted had not been made and by reason thereof neither the Plaintiff nor any person by from or through whom or whose authority the Plaintiff derived the right then to make application for Letters Patent was the actual inventor of the invention  
10 (if any) the subject matter of the Letters Patent ultimately granted.

No. 5.  
Particulars  
of  
Objections  
(as  
amended)  
19th July  
1951,  
*continued.*

Delivered this 5th day of June 1953.

(Sgd.) J. T. BROCK,  
Solicitor for the Defendant.



**No. 6.  
REQUEST FOR FURTHER AND BETTER PARTICULARS OF STATEMENT  
OF CLAIM.**

No. 6.  
Request for  
Further  
and  
Better  
Particulars  
of  
Statement  
of Claim,  
19th July  
1951.

Suit No. 58 of 1951.

TAKE NOTICE that the Defendant requires you to deliver within  
14 days of the date of the service of this Notice further and better  
20 particulars of the Statement of Claim herein as follows :

UNDER PARAGRAPH 4 THEREOF

1. Full particulars of each and every allegation made in the said paragraph.

Dated the 19th day of July 1951.

COLTMAN WYATT & ANDERSON,  
Solicitors for the Defendant.



*In the  
Supreme  
Court of  
the State  
of Victoria.*

No. 7.

**FURTHER AND BETTER PARTICULARS OF STATEMENT OF CLAIM.**

Suit No. 58 of 1951.

No. 7.  
Further  
and  
Better  
Particulars  
of  
Statement  
of Claim,  
25th  
September  
1951.

**FURTHER AND BETTER PARTICULARS**  
under Paragraph 4 of the Statement of Claim delivered pursuant to  
request dated 19th July 1951.

**UNDER PAR. 4**

The Defendant has infringed the Plaintiff's Letters Patent in the manner and at the times set out in the Particulars of Breaches delivered with the Statement of Claim. The threat of and intention by the 10 Defendant to continue the infringements complained of is to be implied from the fact that the Defendant has infringed the said letters patent in the manner set out. Save as aforesaid the Defendant is not entitled to any further particulars.

Dated the 25th day of September, 1951.

**MOULE HAMILTON & DERHAM,**  
Solicitors for the Plaintiff.

No. 8.  
Request  
for  
Further  
Particulars  
of Defence  
and  
Notice of  
Objections,  
25th  
September  
1951.

No. 8.

**REQUEST FOR FURTHER PARTICULARS OF DEFENCE AND NOTICE OF  
OBJECTIONS.**

20

Suit No. 58 of 1951.

**TAKE NOTICE** that the Plaintiff requires within 7 days of the service of this notice Further and better particulars under the Defence and the Particulars of Objections delivered therewith as follows :—

**UNDER PAR. 6 OF THE DEFENCE of—**

- (A) the laches,
- (B) the acquiescence, and
- (C) the delay,

therein alleged, setting out all facts matters and things relied upon by the Defendant as constituting the said laches, the said 30 acquiescence and the said delay.

**UNDER PAR. 1 OF THE PARTICULARS OF OBJECTIONS** of the "common general knowledge" therein referred to setting out the relevant facts, matters and things which are alleged to constitute such common general knowledge.

UNDER PAR. 2 OF THE PARTICULARS OF OBJECTIONS of what was " known or used prior to the date of the said Letters Patent " setting out the relevant facts matters and things with respect to fountain pens of the ball tip type that were known as alleged, and giving particulars, with relevant dates, of what was " used " as alleged.

*In the Supreme Court of the State of Victoria.*

UNDER PAR. 3 of the PARTICULARS OF OBJECTIONS—

No. 8.  
Request for Further Particulars and Notice of Objections, 25th September 1951, *continued.*

10 (A) of the insufficiency, vagueness, uncertainty, and ambiguity therein alleged, setting out, in respect of each of the claiming clauses 1, 2, 5 and 8 in what precise respects each such claiming clause is—

- (a) insufficient,
- (b) vague,
- (c) uncertain,
- (d) ambiguous,

and in which words or phrases the alleged insufficiency, vagueness, uncertainty and ambiguity is alleged to reside.

(B) of the precise respects in which each of the said claiming clauses does not either sufficiently or clearly define the monopoly intended to be claimed.

20 UNDER PAR. 4 (IV) OF THE PARTICULARS OF OBJECTIONS of the precise respects in which it is alleged that the invention described and claimed in the specification lodged on or about the 18th day of December 1946 was " substantially different " from that described and claimed in the specification accompanying the application of the 31st December 1943.

UNDER PAR. 4 (VI) OF THE PARTICULARS OF OBJECTIONS of the precise respects in which it is alleged that the invention described and claimed in the amendments therein referred to was " substantially different " from the specification lodged on the 31st December 1943.

30 AND FURTHER TAKE NOTICE that the Plaintiff requires a further 10 days from the delivery of these particulars within which to deliver his Reply.

Dated the 25th day of September, 1951.

MOULE HAMILTON & DERHAM.

**FURTHER AND BETTER PARTICULARS OF DEFENCE AND PARTICULARS  
OF OBJECTIONS.**

Suit No. 58 of 1951.

No. 9.  
Further  
and Better  
Particulars  
of Defence  
and of  
Particulars  
of  
Objections,  
7th  
February  
1952.

**UNDER PARAGRAPH 6 OF THE DEFENCE**

All the facts alleged in the Statement of Claim and Particulars of Breaches herein were well known to the Plaintiff, so far as they had then occurred, on or shortly after the 19th day of February 1948 and/or on or shortly after the 30th day of June 1949, and the Plaintiff has also known of all the other facts alleged as aforesaid as the time of the same happening but the Plaintiff took no step in respect thereof or of any of the same until the issue of the writ in this action on the 24th day of January 1951 and has acquiesced therein and has been guilty of laches and delay as aforesaid. 10

**UNDER PARAGRAPH 1 OF THE PARTICULARS OF OBJECTIONS**

The defendant intends to rely on the specifications particulars of which are set out below as showing and/or forming part of the common general knowledge alleged but otherwise the Plaintiff is not entitled to particulars of common general knowledge :—

<i>Country</i>	<i>Number</i>	<i>Date of Lodgment</i>	<i>Date available at Patent Office Library, Canberra</i>	20
U.S.A. . . . .	2258841	23rd April 1941	29th April 1942.	
U.S.A. . . . .	2265055	27th December 1938	12th May 1942.	
Great Britain . . . . .	564173	10th June 1943	19th January 1945.	
Great Britain . . . . .	573747	22nd February 1944	29th May 1946.	
Australia . . . . .	121715		25th July 1946.	
Australia . . . . .	122073	8th December 1943	5th September 1946.	
Great Britain . . . . .	571698	18th August 1943	27th February 1948.	

**UNDER PARAGRAPH 2 OF THE PARTICULARS OF OBJECTIONS**

The Defendant refers to and repeats the Particulars set out above with respect to Paragraph 1 of the Particulars of Objections. 30

**UNDER PARAGRAPH 3 OF THE PARTICULARS OF OBJECTIONS**

The Plaintiff is not entitled to the Particulars sought.

**UNDER PARAGRAPH 4 (IV) OF THE PARTICULARS OF OBJECTIONS**

The Plaintiff is not entitled to the Particulars sought.

Dated the 7th day of February 1952.

(Sgd.) COLTMAN WYATT & ANDERSON,  
of 456 Little Collins Street, Melbourne,  
Solicitors for the Defendant.



## FURTHER AND BETTER PARTICULARS OF NOTICE OF OBJECTION.

Suit No. 58 of 1951.

*In the  
Supreme  
Court of  
the State  
of Victoria.*

## FURTHER AND BETTER PARTICULARS

(under paragraph 4 sub-paragraph (ix) of the Particulars of Objections herein) of the facts matters and circumstances which shewed—

No. 10.  
Further  
and Better  
Particulars  
of Notice of  
Objection,  
10th April  
1952.

(A) the amendments were *ultra vires* contrary to law invalid and of no effect ;

10 (B) why no grant of Australian Letters Patent No. 133163 should have been made ; and

(C) the said Letters Patent are of no legal effect.

The said facts matters and circumstances are constituted as follows :—

1. The facts matters and circumstances set out in the said paragraph 4 of the said Particulars of Objections herein.

2. Further the following facts matters and circumstances—

(A) the said application and complete specification referred to in sub-paragraph (ii) of paragraph 4 of the said Particulars of Objections were pursuant to the provisions of the Patents Act 1903-1950 referred to an examiner in the Patents Office for report.

20 (B) The examiner reported upon the said complete specification pursuant to the provisions of the said Patents Act.

(C) The examiner reported adversely to the said complete specification upon the matters referred to in section 41 of the said Patents Act and the Plaintiff was informed thereof pursuant to Section 45 of the said Patents Act.

(D) The Plaintiff thereupon purported to amend the said complete specification pursuant to section 45 of the said Patents Act and in so doing did what is alleged in sub-paragraph (iv) of paragraph 4 of the Particulars of Objection.

30 (E) The amendments which the Plaintiff purported as aforesaid to make to the said complete specification were not authorised by Section 45 of the said Patents Act in that there was substituted for the description of the alleged invention described in the said complete specification the description of a different invention as alleged in sub-paragraph (iv) of paragraph 4 of the Particulars of Objection and further the purported amendments went beyond the scope and ambit of the Examiner's Report and/or were not confined to the objections raised by the Examiner and/or to complying with requisitions arising from the Examiner's Report but on the contrary had the effect alleged in the said sub-paragraph (iv) of paragraph 4 of the said Particulars of Objection.

40

(F) The said specification was reported on again by the examiner pursuant to section 45 of the said Patents Act.

*In the  
Supreme  
Court of  
the State  
of Victoria.*

No. 10.  
Further  
and Better  
Particulars  
of Notice of  
Objections,  
10th April  
1952,  
*continued.*

(G) The Plaintiff thereupon purported to amend the said complete specification pursuant to Section 45 of the said Patents Act and in so doing did what is alleged in sub-paragraph (vi) of paragraph 4 of the Particulars of Objection.

(H) The amendments which the Plaintiff purported as aforesaid to make to the said complete specification were not authorised by section 45 of the said Patents Act in that there was substituted for the description of the alleged invention described in the said complete specification the description of a different invention as alleged in sub-paragraph (vi) of paragraph 4 of the Particulars of Objection and further the purported amendments went beyond the scope and ambit of the Examiner's Report and/or were not confined to the objections raised by the Examiner and/or to complying with requisitions arising from the Examiner's Report but on the contrary had the effect alleged in the said sub-paragraph (vi) of paragraph 4 of the said Particulars of Objection. 10

(J) The said complete specification purporting to have been amended as aforesaid could not have been lawfully accepted nor could letters patent have been lawfully granted in respect of the alleged invention described therein. 20

Dated the 10th day of April 1952.

COLTMAN, WYATT & ANDERSON,  
of 456 Little Collins Street Melbourne  
Solicitors for the Defendant.

No. 11.  
Amended  
reply  
23rd  
September  
1952.

No. 11.  
AMENDED REPLY.  
Suit No. 58 of 1951.

Amended pursuant to the Order of His Honour Mr. Justice SHOLL made on the 5th day of June 1953.

As to the Defence herein delivered the 19th day of July 1951 the 30  
Plaintiff says :—

1. Save as to admissions therein contained he joins issue with the Defendant thereon.

2. In so far as the Amended Particulars of Objections delivered with the said Defence allege in Para. 4 thereof that the amendments made by the Plaintiff to the complete specification before the acceptance thereof had the effect of describing and claiming a different invention from that originally described and claimed (without alleging any alteration in the invention originally disclosed) and/or had the effect of describing and claiming an invention which was the same as the invention described and claimed in the Complete Specification of Australian Letters Patent 35

No. 122073 and/or had the effect of describing and claiming an invention which was the same as the invention which was described and claimed in U.K. Letters Patent No. 573747 which said complete specification was published in the Patent Office Library on the 29th day of May 1946 and that such amendments were *ultra vires* contrary to law and of no effect, the Plaintiff says that even if the aforesaid amendments to the complete specification had the effects or any of them as above-mentioned (which is denied) nevertheless such amendments were not by reason of such effects or any of them in any way *ultra vires*, contrary to law and of  
 10 no effect and further that the Commissioner of Patents had in any event power to allow the amendments so made, and that upon acceptance, his decision to allow such amendments became final and conclusive, so that such matter was and is closed by acceptance, and by reason of the matters above stated the allegations in Para. 4 of the Amended Particulars of Objections above-mentioned afford no answer in law to the Plaintiff's claim.

3. In so far as the Further Particulars dated the 10th April 1952 of the Particulars of Objections delivered with the Defence allege that the said amendments were invalidly made by reason of the fact that they went  
 20 beyond the scope and ambit of the Examiner's report and were not confined to the Objections raised by the Examiner or to complying with the requisitions arising from the examiner's report the Plaintiff (whilst denying such allegations) says that the provisions of the Patents Act 1903-1950 do not require that such amendments should be so limited or confined and further that if the provisions of the Act so require and if such allegations be true, the amendments were admitted by the Commissioner in accordance with his powers to allow the amendments so made and that upon acceptance his decision to allow such amendments is not examinable in any court of law, and that such matter is closed by acceptance, and by reason of the  
 30 matters aforesaid the allegations in the Particulars of Objections in this paragraph first before mentioned afford no answer in law to the Plaintiff's claim.

4. If the Plaintiff was under any duty to give such notice to the Public as is referred to in Para. 7 of the Defence (which he denies) and if he did not give such notice as is alleged (which he denies) the Defendant at all material times before and at the time of infringing the Plaintiff's said Letters Patent in the manner alleged in Para. 3 of the Statement of Claim well knew that the said letters patent No. 133163 had been granted to the Plaintiff and that writing instruments had been and were being manufac-  
 40 tured in accordance therewith, and the Plaintiff will contend that by reason of such knowledge the Defendant at all times material was duly notified that the facts matters and things referred to in Para. 3 of the Statement of Claim and the particulars of breaches delivered therewith constituted an infringement of the Plaintiff's said letters patent and that after such notice it continued to make use or vend writing instruments made in infringement of the said Letters Patent.

Delivered the 23rd day of September, 1952.

50 Redelivered the 8th day of June 1953.

*In the  
 Supreme  
 Court of  
 the State  
 of Victoria.*

—  
 No. 11.  
 Amended  
 reply  
 23rd  
 September  
 1952,  
*continued.*

G. A. PAPE.

G. A. PAPE.

*In the  
Supreme  
Court of  
the State  
of Victoria.*

No. 12.

**SUMMONS FOR QUESTIONS of Law to be Tried.**

Suit No. 58 of 1951.

No. 12.  
Summons  
for  
Questions  
of Law to  
be tried,  
23rd  
September  
1952.

LET all parties attend the Judge in Chambers at the Practice Court Law Courts Melbourne on Monday the 29th day of September 1952 at 10.30 o'clock in the forenoon upon the hearing of an application by the Plaintiff under Order XXXIV R. 2 for an order that the questions of law arising in this action and referred to in Paragraphs 2 and 3 of the Plaintiff's reply, namely,

(A) Whether so much of the Defendant's particulars of 10  
Objection Para. 4 as are referred to in Para. 2 of the Plaintiff's  
reply afford no answer in law to the Plaintiff's claim by reason of  
the contention of law asserted by the Plaintiff in the said para. 2  
of the reply.

(B) Whether so much of the Defendant's Further Particulars  
of Objection dated 10th April 1952 as are referred to in Para. 3  
of the Plaintiff's reply afford no answer in law to the Plaintiff's  
claim by reason of the contentions of law asserted by the Plaintiff  
in the said Para. 3 of the Reply

be raised by a special case or in such other manner as the Court or a Judge 20  
may deem expedient and that in the meantime further proceedings be  
stayed and that the costs of this application be costs in the cause.

Dated the 23rd day of September 1952.

(Sgd.) E. G. COPPEL,  
Judge.

15/-  
duty  
stamp  
cancelled.

No. 13.

Order  
directing  
Argument  
of  
Question  
of Law,  
23rd  
November  
1952.

No. 13.

**ORDER Directing Argument of Question of Law.**

Suit No. 58 of 1951.

UPON HEARING Mr. Phillips one of Her Majesty's Counsel and  
Mr. Pape of Counsel for the Plaintiff and Mr. D. I. Menzies one of Her 30  
Majesty's Counsel and Mr. Gilbert of Counsel for the Defendant IT IS  
ORDERED that the following question of law be set down for argument :

Whether assuming the truth of all the allegations set out in para-  
graph 4 of the Defendant's Particulars of Objections and paragraphs 1  
and 2 of the Defendant's Further Particulars of Objections dated the  
10th day of April 1952 so far as the same are allegations of fact and having  
regard to the contents of the various documents referred to in the said

paragraph 4 of the Defendant's Particulars of Objections and paragraphs 1 and 2 of the Defendant's Further Particulars of Objections or so much of the same as are relevant—

(A) those allegations or any of them, or

(B) paragraphs 5 and 6 of the said Particulars of Objections so far as the last mentioned paragraphs depend exclusively upon the allegations set out in paragraph 4 of the said Particulars of Objections and paragraphs 1 and 2 of the said Further Particulars of Objections so far as the said allegations are allegations of fact,

10 constitute a good defence in law to the Plaintiff's claim herein.

AND I DIRECT that the question be argued during the sitting of this Court in February 1953 AND I FURTHER DIRECT that notice of the hearing be served on the Commissioner of Patents with an intimation that he may appear if he so wishes to assist and inform the Court.

AND I DO FURTHER ORDER that the questions of costs be reserved AND I CERTIFY that this is an application proper for the attendance of Counsel.

(Sgd.) R. R. SHOLL, J.

5s. duty stamp cancelled.

20 This Order was taken out by Messrs. MOULE HAMILTON & DERHAM, of 394-396 Collins Street, Melbourne, Solicitors for the Plaintiff.

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**No. 14.**

**ORDER for Certificate under Section 51 of the Patents Act 1903-1950.**

Suit No. 58 of 1951.

UPON HEARING Mr. P. D. Phillips one of Her Majesty's Counsel and Mr. G. Pape of Counsel for the Plaintiff and Mr. D. I. Menzies one of Her Majesty's Counsel and Mr. R. L. Gilbert of Counsel for the Defendant AND UPON READING the Affidavit of John Stanley Ogden sworn the Fourth day of February 1952 and filed herein and by consent I DO  
 30 CERTIFY in accordance with Section 51 of the Patents Act 1903-1950 of the Commonwealth of Australia that inspection by the parties herein of the Reports of Examiners upon the Application dated the 31st day of September 1943 and Specification upon which Australian Letters Patent

*In the  
 Supreme  
 Court of  
 the State  
 of Victoria.*

No. 13.  
 Order  
 directing  
 Argument  
 of  
 Question  
 of Law,  
 23rd  
 November  
 1952,  
*continued.*

No. 14.  
 Order for  
 Certificate  
 under  
 Section 51  
 of the  
 Patents  
 Act  
 1903-1950,  
 25th  
 November  
 1952.

*In the  
Supreme  
Court of  
the State  
of Victoria.*

No. 133163 were granted and production of the same to the Court is desirable in the interests of justice and ought to be allowed AND I DO FURTHER CERTIFY that this is an application proper for the attendance of Counsel AND I DO ORDER that the question of costs be reserved.

No. 14.  
Order for  
Certificate  
under  
Section 51  
of the  
Patents  
Act  
1903-1950,  
25th  
November  
1952,  
*continued.*

(Sgd.) R. R. SHOLL, J.  
Judge.

5/- duty stamp  
cancelled.

This order was taken out by J. T. BROCK, of 126 Grant Street, South  
Melbourne.

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No. 15.

ORDER FOR DIRECTIONS.

No. 15.  
Order for  
Directions,  
17th March  
1953.

Suit No. 58 of 1951.

UPON HEARING Mr. Phillips one of Her Majesty's Counsel and Mr. Pape of Counsel for the Plaintiff and Mr. Gilbert of Counsel for the Defendant AND UPON READING the Summons for Directions dated the 11th day of March, 1953 the following directions are hereby given AND IT IS ORDERED.

1. That the first day of June 1953 be fixed for the hearing of argument of the question set out in the Order of this Honourable Court made on the 25th day of November 1952. 20

2. If the question referred to in paragraph 1 of this Order be answered by this Honourable Court by deciding that the matters referred to in paragraph (A) and paragraph (B) of the Order of this Honourable Court made on the 25th day of November 1952 or any of such matters constitute a good defence in law to the Plaintiff's claim therein thereupon this Honourable Court will forthwith proceed to determine whether the allegations of the matters so decided to constitute a good defence and which are set out in paragraph 4 of the Defendant's Particulars of Objections and paragraphs 1 and 2 of the Defendant's Further Objections 30 dated the 11th Day of April 1952 are established to the satisfaction of this Honourable Court or are not so established.

3. If this Honourable Court decide that the allegations referred to in paragraph 2 of this Order are established to its satisfaction then this Honourable Court will give such judgment in this action as shall be appropriate taking into account the answer of this Honourable Court to the question referred to in paragraph 1 of this Order.

4. If the question referred to in paragraph 1 of this Order be answered by this Honourable Court by deciding that the matters referred to in paragraph (A) and paragraph (B) of the Order of this Honourable Court 40 made on the 25th day of November 1952 do not constitute a good defence

in law to the Plaintiff's claim herein, or if, though the question aforesaid be answered by this Honourable Court by deciding that the said matters or any of them do constitute a good defence in law to the Plaintiff's claim herein, this Honourable Court decide that the allegations as to the matters thus decided to constitute a good defence to the Plaintiff's claim are not established to the satisfaction of this Honourable Court, then in either of such events this Honourable Court will proceed to hear and determine such issues and matters arising upon the pleadings as are required to be determined in order that the action may be disposed of and judgment given herein AND IT IS FURTHER ORDERED that the costs of this Summons be costs in the cause AND IT IS CERTIFIED that this was a matter proper for the attendance of Counsel including leading Counsel for the Plaintiff.

*In the  
Supreme  
Court of  
the State  
of Victoria.*

—  
No. 15.  
Order for  
Directions,  
17th March  
1953,  
*continued.*

(Sgd.) R. R. SHOLL, J.

5/- duty stamp  
cancelled.

This Order was taken out by Messrs. MOULE HAMILTON & DERHAM of 394-396 Collins Street, Melbourne, Solicitors for the Plaintiff.

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No. 16.

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**PLAINTIFF'S Notice to Admit Facts.**

Suit No. 58 of 1951.

No. 16.  
Plaintiff's  
Notice to  
Admit  
Facts,  
14th May  
1953.

TAKE NOTICE that the Plaintiff in this cause requires the Defendant to admit, for the purposes of this cause only, the several facts respectively hereunder specified; and the Defendant is hereby required, within six days, from the service of this notice, to admit the said several facts, saving all just exceptions to the admissibility of such facts as evidence in this cause.

The facts, the admission of which is required, are :—

1. As to the "Scribal Secretary" pen referred to in the Plaintiff's Particulars of Breaches delivered with the Statement of Claim herein (which said Scribal Secretary pen is now in the possession of the Plaintiff's solicitors who will arrange for the inspection thereof) :—

(A) That the same was manufactured by the Defendant.

(B) That the same was sold by the Defendant to the Myer Emporium Limited of 314 Bourke Street Melbourne.

(C) That the same was manufactured at some time between the 5th day of September 1946 and the 24th day of January 1951.

2. That the Defendant manufactured at its factory or place of business between the 5th day of September 1946 and the 24th day of January 1951 writing instruments known as the Scribal Secretary pen

*In the  
Supreme  
Court of  
the State  
of Victoria.*

No. 16.  
Plaintiff's  
Notice to  
Admit  
Facts,  
14th May  
1953,  
*continued.*

and of the same type and construction as the "Scribal Secretary" pen referred to in paragraph 1 hereof and now in the possession of the Plaintiff's solicitors.

3. That the Defendant between the 5th day of September 1946 and the 24th day of January 1951 did—

(A) sell to firms persons and corporations within the Commonwealth of Australia writing instruments known as the "Scribal Secretary" pen and of the same type and construction as the "Scribal Secretary" pen referred to in paragraph 1 hereof and now in the possession of the Plaintiff's solicitors ;

10

(B) sell to the Myer Emporium Limited of 314 Bourke Street Melbourne writing instruments known as the Scribal Secretary pen and of the same type and construction as the "Scribal Secretary" pen referred to in paragraph 1 hereof and now in the possession of the Plaintiff's solicitors.

4. That prior to the date upon which the Defendant manufactured the Scribal Secretary pen referred to in the Plaintiff's particulars of Breaches delivered with the Statement of Claim herein the Defendant through its servants and agents was aware that the Plaintiff had made application for the grant to him of Letters Patent for and in respect of the invention comprised in Australian Letters Patent No. 133163.

5. That prior to the date upon which the Defendant manufactured the Scribal Secretary pen referred to in the Plaintiff's Particulars of Breaches delivered with the Statement of Claim herein the Defendant through its servants and agents was aware that Letters Patent No. 133163 had been granted to the Plaintiff.

6. That prior to the 24th day of January 1951 the Defendant through its servants or agents had inspected a copy of the complete specification of the said Australian Letters Patent No. 133163.

7. That prior to the date upon which the Defendant manufactured the Scribal Secretary pen referred to in the Plaintiff's Particulars of Breaches delivered with the Statement of Claim herein the Defendant through its servants and agents was aware that writing instruments made in accordance with the said Australian Letters Patent No. 133163 had been and were being manufactured and had been and were being sold in Australia.

Dated the 14th day of May 1953.

(Sgd.) MOULE HAMILTON & DERHAM  
of 394-396 Collins Street Melbourne,  
Solicitors for the Plaintiff.

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To

The Defendant and its solicitor, J. T. Brock, Esq., 126 Grant Street South Melbourne.



## DEFENDANT'S Admission of Facts.

Suit No. 58 of 1951.

*In the  
Supreme  
Court of  
the State  
of Victoria.*

No. 17.  
Defen-  
dant's  
Admission  
of Facts,  
21st May  
1953.

The Defendant in this cause, for the purpose of this cause only, hereby admits the several facts respectively hereunder specified, subject to the qualifications or limitations, if any, hereunder specified, saving all just exceptions to the admissibility of such facts or any of them, as evidence in this cause. Provided that this admission is made for the purposes of this action only and is not an admission to be used against the Defendant on any other occasion or by any one other than the Plaintiff.

*Facts admitted**Qualifications or Limitations if any subject to which they are admitted*

1. That the "Scribal Secretary" pen referred to in the Plaintiff's Particulars of Breaches delivered with the Statement of Claim and now in the possession of the Plaintiff's Solicitors—

- (a) was manufactured by the Defendant  
 (b) was sold by the Defendant to either Lonsdale Distributors Proprietary Limited or the Myer Emporium Limited  
 (c) was manufactured at some time between the 5th day of September 1946 and the 24th day of January 1951.

1. But not that the said pen is made in infringement of the first second fifth and eighth Claiming Clauses or of any of the said Claiming Clauses of the Plaintiff's Letters Patent No. 133163, or was manufactured until some time between the latter end of the month of February 1948 and the 24th day of January 1951.

2. That the Defendant manufactured at its factory or place of business between the 5th day of September 1946 and the 24th day of January 1951 writing instruments known as the Scribal Secretary pen and of the same type and construction as the Scribal Secretary pen referred to in Item 1 hereof.

2. But not that the said writing instruments are made in infringement of the first second fifth and eighth Claiming Clauses or of any of the said Claiming Clauses of the Plaintiff's Letters Patent No. 133163 or were manufactured until some time between the latter end of the month of February 1948 and the 24th January 1951.

3. That the Defendant between the 5th day of September 1946 and the 24th day of January 1951 did—

- (a) sell to persons firms and corporations within the Commonwealth of Australia writing instruments known as the "Scribal Secretary" pen and of the same type and construction as the "Scribal Secretary" pen referred to in Item 1 hereof  
 (b) sell to either Lonsdale Distributors Proprietary Limited or the Myer Emporium Limited writing instruments known as the Scribal Secretary pen and of the same type and construction as the "Scribal Secretary" pen referred to in Item 1 hereof.

3. (a) But not that the said writing instruments are made in infringement of the first, second, fifth and eighth claiming Clauses or of any of the said Claiming Clauses of the Plaintiff's Letters Patent No. 133163 or were sold prior to the 19th day of May 1948.

(b) But not that the said writing instruments are made in infringement of the first, second, fifth and eighth Claiming Clauses or of any of the said Claiming Clauses of the Plaintiff's Letters Patent No. 133163 or were sold prior to the 19th day of May 1948.

*In the  
Supreme  
Court of  
the State  
of Victoria.*

*Facts admitted*

No. 17.  
Defen-  
dant's  
Admission  
of Facts,  
21st May  
1953,  
*continued.*

4. That prior to the date upon which the Defendant manufactured the Scribal Secretary pen referred to in the Plaintiff's Particulars of Breaches delivered with the Statement of Claim herein the Defendant through its servants and agents was aware that the Plaintiff had made application for the grant to him of Letters Patent.

5. That prior to the date upon which the Defendant manufactured the Scribal Secretary pen referred to in the Plaintiff's Particulars of Breaches delivered with the Statement of Claim herein the Defendant through its servants or agents was aware that Letters Patent No. 133163 had been granted to the Plaintiff.

6. That prior to the 24th day of January 1951 the Defendant through its servants or agents had inspected a copy of the complete specification of the said Australian Letters Patent No. 133163.

Delivered the 21st day of May 1953.

(Sgd.) J. T. BROCK  
of Nolan St., South Melbourne.

To the Plaintiff  
and  
To his Solicitors  
Messrs. Moule Hamilton & Derham.

*Qualifications or Limitations if any subject  
to which they are admitted*

4. But not that the application was made for the grant of Letters Patent for the invention comprised in Australian Letters Patent No. 133163 until some time after the 30th day of June 1949, or that any invention is comprised in the said Letters Patent, or that the said pen is made in infringement of the aforesaid Claiming Clauses of the Plaintiff's said Letters Patent. 10

5. But not that the Defendant was so aware until some time after the 30th day of June 1949 or that the said Letters Patent are valid, or that the said pen is made in infringement of the aforesaid Claiming Clauses of the Plaintiff's said Letters Patent. 20

20

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No. 18.  
Defen-  
dant's  
Notice to  
Admit  
Facts  
26th May  
1953.

No. 18.  
**DEFENDANT'S Notice to Admit Facts.**

Suit No. 58 of 1951.

TAKE NOTICE that the Defendant in this cause requires the Plaintiff to admit for the purposes of this cause only the several facts respectively hereunder specified ; and the Plaintiff is hereby required within seven days from the service of this Notice to admit the said several facts, saving all just exceptions to the admissibility of such facts as evidence in this cause. 40

The facts, the admission of which is required, are :

1. (A) That on the 8th day of December 1943 the Plaintiff made an application for a patent,

(B) That the said application was for a patent for an invention relating to improvements in fountain pens of the ball tip type.

(C) That the said application was accompanied by a Complete Specification.

(D) That Australian Letters Patent No. 122073 were granted upon the said application.

(E) That the Complete Specification of Australian Letters Patent No. 122073 was published on the 5th day of September 1946.

10 2. (A) That on the 31st day of December, 1943 the Plaintiff made an application for a patent.

(B) That the said application was numbered 12499-43 in the Patents Office.

(C) That the said application was accompanied by a Complete Specification.

(D) That the said application was for a patent for an invention relating to fountain pens and referring more particularly to fountain pens of the kind which comprise an ink reservoir formed by an extension of the channel for supplying the writing point with ink.

20 (E) That the said Complete Specification was notified as open for public inspection on the 19th day of February 1948.

(F) That the said application and Complete Specification were referred to an examiner in the Patents Office for report.

(G) That the examiner reported upon the said Complete Specification.

(H) That the examiner reported adversely to the said Complete Specification upon the matters referred to in Section 41 of the Patents Act.

(I) That the Plaintiff was informed of the said report.

(J) That on the 18th day of December 1946 the Plaintiff lodged in the Patent Office a Complete Specification.

30 (K) That the said lastmentioned document was lodged in amendment of the Complete Specification lodged on the 31st day of December 1943.

(L) That the said document was lodged with respect to the said application made on the 31st day of December 1943.

(M) That the said Specification was reported on again by an examiner.

(N) That thereafter the Plaintiff lodged in the Patent Office amendments of his said Complete Specification.

(O) That on the 14th day of June 1949 the Commissioner of Patents allowed the aforesaid amendments.

40 (P) That on the 14th day of June 1949 the Deputy Commissioner of Patents accepted the Complete Specification in respect of Australian Letters Patent No. 133163.

(Q) That on the 30th day of June 1949 the said acceptance was advertised in the Australian Official Journal of Patents Trade Marks and Designs.

(R) That thereafter Australian Letters Patent No. 133163 were granted to the Plaintiff.

*In the  
Supreme  
Court of  
the State  
of Victoria.*

No. 18.

Defen-  
dant's  
Notice to  
Admit  
Facts,  
26th May  
1953,  
*continued.*

*In the  
Supreme  
Court of  
the State  
of Victoria.*

No. 18.  
Defen-  
dant's  
Notice to  
Admit  
Facts,  
26th May  
1953,  
*continued.*

(S) That the said grant was made upon the said application dated the 31st day of December 1943.

(T) That none of the facts set out above in sub-paragraphs (I) (J) (K) (M) (N) and (O) became known to the public until after the 30th day of June 1949.

3. That the Plaintiff did not seek leave to amend his Complete Specification under Section 71 of the Patents Act.

4. That the following patents granted in the countries set out became available for public inspection at the Patent Office Library Canberra on the dates respectively set out—

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United States of America	2258841	29th April 1942.
United States of America	2265055	12th May 1942.
Great Britain	564173	19th January 1945.
Great Britain	573747	29th May 1946.
Australia	121715	25th July 1946.
Great Britain	571698	27th February 1948.

5. (A) That on the date when Australian Letters Patent No. 133163 were granted to him the Plaintiff was aware that the Defendant had sold writing instruments known as the Scribal Secretary pen.

(B) That the Plaintiff was so aware on the 30th day of June 1949. 20

6. That the Plaintiff was aware on the said dates that the Defendant had manufactured writing instruments known as the Scribal Secretary pen.

7. That the action herein was commenced on the 24th day of January 1951.

8. That after the said date of grant the Plaintiff was aware that the Defendant was manufacturing and selling the said writing instruments.

9. That after the said 30th day of June 1949 the Plaintiff was aware that the Defendant was manufacturing and selling the said writing instrument. 30

10. That Messrs. Phillips, Ormonde LePlastrier and Kelson, Patent Attorneys were the Plaintiff's agents in all matters with respect to the applications for Letters Patent Nos. 122073 and 133163.

Dated the 26th day of May 1953.

(Sgd.) J. T. BROCK,  
of Nolan Street South Melbourne,  
Solicitor for the Defendant.

No. 19.

**PLAINTIFF'S Admission of Facts.**

Suit No. 58 of 1951.

*In the  
Supreme  
Court of  
the State  
of Victoria.*No. 19.  
Plaintiff's  
Admission  
of Facts,  
8th June  
1953.

The Plaintiff in this action, for the purposes of this action only, hereby admits the several facts respectively hereunder specified, saving all just exceptions to the admissibility of such facts or any of them as evidence in this action. Provided that this admission is made for the purposes of this action only, and is not an admission to be used against the Plaintiff on any other occasion or by any one other than the Defendant.

10 Dated the 8th day of June 1953.

(Sgd.) MOULE HAMILTON & DERHAM,  
Solicitors for the Plaintiff.

**FACTS ADMITTED.**

1. (A) That on the 8th day of December 1943 the Plaintiff applied for a patent.

(B) No admission is made as requested but the Plaintiff will admit a copy of the application.

(C) That the said application was accompanied by a complete specification.

20 (D) That Australian Letters Patent No. 122073 were granted upon the said application.

(E) That the complete specification of the said Letters Patent No. 122073 became open to public inspection on the 5th day of September 1946.

Save as aforesaid the Plaintiff makes no admission as to any of the matters upon which admissions are sought in Par. 1 of the Defendant's notice to admit facts dated 26th May 1953.

2. (A) That on the 31st day of December 1943 the Plaintiff made application for a patent.

30 (B) That the said application was numbered 12499/43 in the Patents Office.

(C) That the said application was accompanied by a complete specification.

(D) No admission is made as requested but the Plaintiff will admit a copy of the said application.

(E) That the said complete specification was notified as being open to public inspection on the 19th day of February 1948.

(F) That the said application and complete specification were referred to an examiner in the Patents Office for report.

40 (G) That the examiner reported upon the said complete specification.

*In the  
Supreme  
Court of  
the State  
of Victoria.*

No. 19.  
Plaintiff's  
Admission  
of Facts,  
8th June  
1953,  
*continued.*

(H) That the examiner reported adversely to the said Complete Specification and the Plaintiff will admit a copy of the Examiner's Report.

(I) That the Plaintiff was informed of the said report.

(J) (K) and (L) That on the 18th day of December 1946 the Plaintiff transmitted to the Patents Office a document containing proposed amendments to the Complete specification lodged on the 31st December 1943 and the Plaintiff will admit a copy of such document.

(M) That the Complete Specification lodged on the 31st December 1943 as altered in accordance with the proposed amendments was reported on again by an Examiner. 10

(N) That thereafter the Plaintiff transmitted to the Patents Office documents containing further proposed amendments to the said Complete Specification.

(O) That on the 14th day of June 1949 the Commissioner of Patents allowed the aforesaid proposed amendments.

(P) That on the 14th day of June 1949 the Deputy Commissioner of Patents accepted the Complete Specification in respect of Australian Letters Patent No. 133163.

(Q) That on the 30th day of June 1949 the said acceptance was advertised in the Official Journal of Patents Trade Marks and Designs. 20

(R) and (S) That Australian Letters Patents No. 133163 were granted to the Plaintiff dated the 31st December 1943 pursuant to application No. 12499/43.

(T) No admission is made as requested.

3. No admission is made as requested.

4. That the specifications of the patents hereinafter set out became available for public inspection at the Patent Office Library on the dates respectively set out :—

U.S.A.	..	..	..	2258841	29th April 1942.	
U.S.A.	..	..	..	2265055	12th May 1942.	
Great Britain	..	..	..	564173	19th January 1945.	30
Great Britain	..	..	..	573747	29th May 1946.	
Great Britain	..	..	..	571698	27th February 1948.	
Australia	..	..	..	121715	25th July 1946.	

5, 6, 8 and 9.

That on the 30th day of June 1949 the Plaintiff was aware that the Defendant had manufactured and sold writing instruments known as the Scribal Combination Writer.

7. That this action was commenced on the 24th January 1951.

10. That Messrs. Phillips Ormonde LePlastrier & Kelson acted as 40 Patent Attorneys for the Plaintiff in connection with the application for Letters Patent Numbers 122073 and 133163. Save as aforesaid, no admission is made as to the matters referred to in Paragraph 10 of the said Notice.

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## PLAINTIFF'S EVIDENCE.

No. 20.

EVIDENCE of Victor David Hopper.

*In the  
Supreme  
Court of  
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of Victoria.*

*To Mr. Shelley :* My full name is Victor David Hopper, and I live at 16 Hawkins Avenue, Box Hill. I am a Doctor of Science Melbourne University. I am a Fellow of the Institute of Physics of London. I now hold the post of Senior Lectureship at the University of Melbourne in Physics. I have held that post for the last 5-6 years. At one time in my career I won the David Syme Research Medal. In 1949 I held for a year a Nuffield Fellowship in Natural Science, and pursuant to that appointment I studied in Birmingham in England. I have published a number of papers on various scientific subjects. They include "The Oil Drop Method of the Determination of an Electronic Charge." That research work involved among other things a study of the viscosity of air. I am now engaged on research work on cosmic rays at Melbourne University. I was in court yesterday when you took His Honour through a memorandum on the basic principles of capillary forces. I was myself largely responsible for the preparation of that memorandum.

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tion.

*Mr. Shelley :* I ask Your Honour's ruling, it is a leading question of the grossest form, but in order to save time I was proposing to ask Dr. Hopper this question—are the technical matters set out in that memorandum accurate—and then leave it to my learned friend to cross examine if he wishes.

*Mr. Menzies :* I have no objection to my learned friend adopting that course.

*Witness to Mr. Shelley :* I believe the scientific facts and principles set out in the memorandum are accurately set out in that document.

*His Honour :* That is in the document and the figures to which it refers ?—Yes.

EXHIBIT " A "—Memorandum and drawings.

EXHIBIT " B "—Specification 133163 as granted.

*Witness to Mr. Shelley :* I take before me a copy of the specification of Australian Letters Patent 133163 and look at claim 1 of that document in column 5. Assuming that His Honour will construe that claim as follows: that it is a claim for a combination in regard to an instrument of the ball point type wherein the reservoir has these features, first of all a vented tube—and I am asked to assume that means a tube open to atmospheric pressure at one end—secondly that the reservoir is constituted by a tube of capillary size, thirdly that the reservoir is such that when charged with viscous ink a continuous liquid vein is maintained extending from the ball, fourthly that there is a feed duct leading from the reservoir to the ball and fifthly that the cross-section area of the feed duct particularly that portion adjacent to the ball, is less than the cross-sectional

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area of the reservoir, if those are the five features in relation to a reservoir, which results in the construction of a writing instrument of the type specified, and the claim is asserted of such an instrument having a reservoir with those five features, my opinion as to which of those features are essential in order to construct a practicable ball point pen is, I would say the most important part of those seems to be to maintain the continuous liquid vein, and the other parts seem to be factors that come in to enable that to happen. For instance, the feed duct is a part of the thing, the vented tube of capillary size means that it holds the liquid in the tube so that it does not break from a continuous vein—so they appear to me 10 to help to maintain this continuous liquid vein.

*His Honour :* Do you mean to answer Counsel's question by saying all these features are essential to make the instrument work?—As you pointed out yourself, with the duct part there, the essential part, of course, regarding that is purely to stop the ball moving backwards.

What do you call that duct part?—The feed duct leading from the reservoir to the ball. I presume that need not be there.

*Witness to Mr. Shelley :* I am referring to what you called the fifth feature, the cross-sectional area of the duct being less than that of the reservoir. The important point of that feature, I presume, is to prevent 20 the ball moving back into the reservoir when you are writing, and also falling back when it is held with the ball point upwards. It also acts as a slow down agent for the liquid itself in moving back and forward past that gap in some types of pens.

*His Honour :* What gap?—The gap between the ball and the duct, as the liquid has to move through the gap between them and that acts in the case of a viscous liquid as a drag on its movements. But it is not essential to this argument here, the main part that it has it to prevent the ball moving back into the tube when you press on the ball.

I understood you to say a moment ago that what Mr. Shelley called 30 the fourth feature was not essential at all, that is to say a feed duct leading from the reservoir to the ball. Do you mean by that only that it would not matter if the reservoir was continuous to the ball?—No, provided that the reservoir would then have to be small enough to stop the ball moving back.

*Witness to Mr. Shelley :* Or alternatively, you would have to provide a grip or collar or something of that kind to prevent the ball coming back—so that they are not essential in that sense. I have read the specification 133163. As to whether the principles of operation as 40 described in that specification are clear to me——

*Objection by Mr. Menzies.*

*Mr. Shelley :* If the question is objected to, Your Honour, certainly I do not press it. The purpose of it was in order to make sure there was no doubt about what the principles were. I don't know whether Your Honour wants to make the first specification an exhibit?



*Mr. Menzies* : We do desire the actual documents to be used.

*Mr. Gillard* : I have the original here, Your Honour, and the original application with it. I might add this, blue prints which I handed to Your Honour earlier are also attached to the application.

EXHIBIT "C."—Original specification and accompanying original application lodged 31/12/43 ; also original drawings accompanying same.

*Mr. Gillard* : There is one other matter. Your Honour will see that blueprints were originally filed with the application, that is, not in accordance with the regulations and requirements. Then there were drawings in conformity with the regulations filed on 10th October 1944. I don't know whether my friend Mr. Shelley desires those to be produced or not.

*Mr. Shelley* : I understand there is no difference except that they are in conformity with the regulations, being appropriate in size and form.

*His Honour* : Mr. Menzies, do you make any point about this, do you want those in as well ?

*Mr. Menzies* : Yes, Your Honour. I propose to follow the thing through.

20 EXHIBIT "D."—Amended original drawings filed by applicant 10/10/44. Produced by Counsel for the Commissioner.

*His Honour* : It occurs to me it would be convenient if Counsel for the Commissioner wants to ask the witness any questions, for him to make that suggestion to me. If I think proper to allow him to do that to assist the court I can do it and then you will know whether there is anything you want to cross-examine about, Mr. Menzies.

*Mr. Menzies* : I would, with respect, agree with Your Honour on that course.

*Mr. Gillard* : I do not desire to ask this witness any questions.

30 *Cross-examined by Mr. Menzies.*

*Mr. Menzies* : Would you please take the document, Exhibit "A," which you have verified, I think, as being scientifically accurate, and look at page 6 ?—Yes.

And would you also take the drawings which accompany it and I direct your attention particularly to 12 B in the letterpress referring to figure 12 b. You say that the pressure at A is less than the pressure at B, the difference in pressure being sufficient to hold up the liquid at height A-B. I pause there and I want you to understand we are not challenging that at all, we accept that. Am I right in thinking that the

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points A and B that you have there defined are the points as I might say in the centre of the meniscus just below and just above the meniscus ?  
—Yes.

*His Honour :* Is that right. A and B are not points just above and below the centre of the meniscus. B and C are, in my figure.

*Mr. Menzies :* A is just below the centre of the top meniscus and B is just below the centre of the meniscus at the bottom.

*His Honour :* It is the word above that troubled me. You are referring to A and B ?

*Mr. Menzies :* The point is just below the centre of the upper 10 meniscus, the point A ?—Yes.

And the point B is just below the centre of the lower meniscus ?—Above.

And I understand you to say that it is the difference in pressure which maintains the column of liquid only along the lines which actually extend from point to point ?—What do you mean by that ?

We have point A and point B ?—Yes.

And do I understand you to say that the difference in pressure maintains the column of liquid merely between those two points ?—Oh no, the idea of pressure is that at A there is a pressure which is produced 20 by the curved meniscus and that will be in the region of A below A for instance at any position there will be a certain pressure but the pressure in the liquid will be constant along the horizontal line at B you will have a constant pressure along that line there.

So you say you have the same pressure at the pressure at point A in any horizontal line passing through point A ?—That is right.

And at right angles with the sides of the container ?—Yes.

And similarly so far as B is concerned ?—Yes.

And you have dotted in certain lines ?—Yes.

Which as I understand the letterpress confine the area in which the 30 level of the column is maintained by virtue of the differences in pressure ?  
—Yes.

And you say that outside those dotted lines the column is not maintained by the difference in pressure between A and B at all ? The effect of having certain pressure at A, I would say by point A will produce another pressure at a section lower in liquid, but the pressure would be of course the same in that section of the liquid.

*Mr. Menzies :* I do not think you quite understand what I am getting at, let me read your own language. “The pressure at A is less than the pressure at B, the difference in pressure being sufficient to hold up the 40 liquid on the height A B and cross sectional area corresponding to dotted lines. The atmospheric pressure at C holds the remainder of the liquid in the tube. May I put to you my understanding of that, that it is merely between the dotted lines that the difference in pressure between A and B

operates to maintain the column and outside the dotted lines the column is maintained by atmospheric pressure. That is my understanding of it, is that what you intended?—The understanding is that we should consider the system as a whole—

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*His Honour* : Do you agree with his interpretation of what is there said?—Yes, I shall have to explain in more detail just to clear it for you I think but essentially that is what happens.

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*Mr. Menzies* : That is what you intended to convey?—Yes. That outside the cross sectional area indicated the column of liquid is maintained by atmospheric pressure?—That of course atmospheric pressure comes into it as well at the bottom of C and also above the meniscus at A there is atmospheric pressure all over the section and we have to take into account atmospheric pressure as well as the drop in pressure by meniscus.

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May I suggest this to you that as a matter of science if you had a column of liquid as shown in 12 (B) in a tube and that tube was in a vacuum nevertheless the column of liquid would remain in that position, would you agree with that?—Yes.

If the tube, if the column would be maintained in that position in a vacuum will you explain how it is that atmospheric pressure maintain it?—For the same reason as I said before that the effect at A of reducing the pressure due to curved meniscus at A is communicated to all parts of the fluid itself. If it is stationary you must have a balance of those and therefore you get the communicator of this pressure effect right down the liquid and the resultant effect of this reduction of pressure at A will balance that column.

The reference to atmospheric pressure between—disregard for the moment pressure within the liquid itself and deal with your words that the atmospheric pressure at C holds the remainder of the liquid, my frank suggestion to you is that it is a scientific error. I understood you to agree with me. If you take the figure 12 (B) you would have the column of liquid maintained as it is there shown even if the tube were in a vacuum and there were no atmospherics?—If I write down to the equations just to see what you are driving at, you have for the vacuum then at both A and C.

Vacuum, yes, a vacuum at either end, it is shown here as air inter-base, I am suggesting a vacuum?—This idea of pressure is the essential thing in it.

Atmospherics?—No, the pressure itself produced by curved meniscus, that is you get a reduction of pressure below that which will be communi-  
40 cated to the rest of the liquid and therefore will hold up the column.

The whole Column?—Yes.

And atmospheric pressure has nothing to do with it?—You have to take into account atmospheric pressure when it is at both ends you will have to get the pressure in this section here, we have atmospheric pressure up above the meniscus and we will have atmospheric pressure minus  $2T$  over  $r$ , below it in the column, then we come to the bottom and we have

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got atmospheric pressure down there minus  $2T$  over  $R$ . The result of that system must be a static one, it is balanced by the complete set of pressure, if you are going to put a vacuum there—

At either end?—Then we write down the equations in the same way, we have  $2T$  over  $r$  now without the atmospheric pressure, we have to have the combination setup.

*His Honour* : You subtract atmospheric pressure at both ends and you still get the same stability?—Yes.

*Mr. Menzies* : So if there is no atmospheric pressure at all at either end you still get the same stability?—Yes. 10

Now let me put to you then it is not the atmospheric pressure at  $C$  that holds the remainder of the liquid in the tube?—I put it in that way to try and simplify it for you but I can give you—

I asked you not whether it is simple or commonplace, is it right or is it wrong?—Well the atmospheric pressure is essential there to hold the—

Why is it essential?—Because there is atmospheric pressure at the top.

If you do not have it at either end?—If it is not—which statement are we talking about now? 20

I am talking about, I am asking you to assume for the moment there is no atmospheric pressure at either end?—Yes.

On that assumption will you tell me what holds the column of liquid outside the cross-sectional area shown in 12 (B)?—It is the pressure produced by meniscus.

I now want to put to you it is exactly the same thing that gives stability when you have atmospheric pressure at both ends?—It is the same thing that produces stability, yes.

Re-exami-  
nation.

*Re-examined by Mr. Shelley.*

*Mr. Shelley* : On the question of the scientific accuracy of this 30 explanation the original postulate is this that you have atmospheric pressure at both ends and therefore there is a small area subjected to atmospheric pressure at the top but a large area subjected to atmospheric pressure at the bottom and the suggestion in your letterpress is that the column is maintained by two factors, one the difference in pressure created by the menisci at  $A$  and  $B$  respectively, secondly the atmospheric pressure which results from the difference in area between the bottom meniscus and the top meniscus. Now is that right or not because if that is right it follows that when the atmospheric pressure is reduced to zero and that difference is no longer available then the column if it is long enough will 40 slide down. Would you tell His Honour what your view is about that consideration?—Will you just repeat the last part again to get it clear? (*Shorthand notes read to witness.*) We have got the case where the atmospheric pressure, first of all considering we have atmospheric pressure  $A$  at the top and then we have a narrow meniscus there we will therefore have just below the surface a resultant pressure of  $A$  minus  $2T$  over  $r$ . At the

bottom we will have atmospheric pressure of A and inside the liquid a pressure of A minus 2T over R and then to get the resultant force acting downwards on that section of the fluid, you will multiply the area of cross section by the pressures so that you know there is a vacuum at the bottom and the force is this small value of pressure times the area of cross section there and at the top you have a pressure of 2T over r and that times the area of cross section gives the upward force there.

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*His Honour* : You multiply the lower cross section which is the greater by the smaller pressure and you multiply the upper cross section which is smaller by the larger pressure, is that what you are saying ?—Yes. According to this 2T over r times A the liquid would fall down in a vacuum when I work it out from the formula, so that it does go back I am afraid.

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*continued.*

Then the result of all that is that atmospheric pressure has got a part in maintaining the liquid in the position shown in the diagram ?—Yes, you have to work it out completely with everything taken into account and you have to write down as far as I can see the formula with that.

The remaining thing that is not clear to me about this letterpress of yours if I may put my difficulty to you, is this, the diagram and the letterpress suggest that your formula would produce the following result, viz., that the pressure in the liquid at A when calculated by the multiplication that you have just explained would be the same as the pressure in the liquid at B within the area of cross section shown by the dotted lines although as far as I can see the shape of the meniscus at that point would differ ; now is there something wrong with what I have just been putting ?—The pressure of the liquid at A depends on the shape of the meniscus at A and then getting down to B there is a column of liquid of a certain length which will produce some pressure at B and this is balanced by the pressure at A due to the narrowing of liquid in that cross section which will be equal in a static case to this calculated pressure at B.

The difference in the meniscus is compensated by the additional force of gravity ?—Yes, and of course if you had a tube that was this diameter, that is corresponding to these dotted lines, that is all the way down then of course you would have the same meniscus at both ends and the whole thing would gradually fall just due to the weight of the liquid being the excess factor coming in.

*Mr. Shelley* : That is exactly 12 (A) ?—Yes, 12 (A).

*The witness withdrew.*

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## EVIDENCE of Hans Reinhard Fehling.

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tion.

HANS REINHARD FEHLING—Sworn and examined.

*To Mr. Shelley :* My full name is Hans Reinhard Fehling, and I received my technical and scientific education at the Universities of Munich and Berlin. I took my final degree in Mechanical Engineering and General Science in 1926. I took the final degrees at Berlin. In 1937 I qualified for the degree of Doctor of Engineering. I qualified for this degree in English. The thesis which I submitted for that degree was in respect of—in part—flow phenomenon in viscous liquids. Since leaving the University I have been continuously engaged in scientific and industrial research. I have been an independent consultant since 1933. 10

*His Honour :* Was the doctor's doctorate a Doctorate of Berlin ?

*Witness :* That is correct.

*Witness (continuing) :* During the war I was engaged, among other things, on the study of the behaviour of liquid jets, and I was also concerned with the study of the combined effects of surface tension and viscosity of liquids as it affected their mechanical behaviour. I have carried out research on the mechanical properties of liquids of very high viscosity.

*His Honour :* Where was your wartime research done, Doctor ?— 20  
In London.

*Witness (continuing) :* I am now a consultant to the company in London that is concerned with the exploitation of the Biro pen in Great Britain. The name of that company at the present moment is Fomento Sterling Area, Ltd. Previously the company was known as Biro Swan Limited. They both exist. The one is not superseded by the other. It was only that before the whole of the exploitation was done by Biro Swan Limited, and now Biro Swan Ltd. is only manufacturing, but not dealing with the exploitation of patents proper. The Company which is now known as Biro Swan Ltd., formerly known as the Miles Martin Pen Company, were the plaintiffs, or co-plaintiffs in an action before Mr. Justice Harmon based on two patents which were the British counterpart of the two patents which we are discussing here. I gave evidence in that case. I have been consultant for the Miles Martin Pen Company, later the Swan Company, and now the Fomento Company, in regard to ball point pens. I have been doing that advisory work from 1944—Autumn 1944. Since that time, Autumn 1944, I have been continuously engaged, substantially speaking, in ball point pen research. I listened to Mr. Shelley's reading of a memorandum about which Dr. Hopper gave evidence as regards the basic principles of capillarity (Exhibit A). These basic principles are accurately set out in that memorandum. One point arose in regard to that memorandum. It was suggested that if you have a capillary tube and a column of liquid in the capillary tube, and the orifice at the top was very small—indeed, comparable to the gap in a ball housing of a ball point pen, say two or three microns ; and the bottom and the top of the lower 30 40

- part of the tube were of larger diameter, say three millimetres, that if such a tube was put into a vacuum with the small orifice upwards, the column of liquid would nevertheless remain in the tube notwithstanding the withdrawal of atmospheric pressure. If the pressure in the system—at the top above the liquid, and at the bottom, below the liquid, is low enough—that means it must really be a vacuum in the true sense—then the tube will, in fact, behave like a barometer, because at the top there would be a pressure which is below zero, which cannot happen. Therefore the liquid must come off. This is putting it theoretically. Practically,
- 10 this will happen a little bit before that pressure is reached because liquids evaporate. There is no liquid which can exist at zero pressure, and therefore it depends on the type of liquid used to determine in what way it will actually happen. As a result, the main column will drop, but the top of the meniscus will in all probability stay there. In other words, the column will probably come off below the actual meniscus at the top, but I should like to emphasise that it is not possible to predict exactly where the column will come off, and that is due to a reason which, again, has nothing to do with this case. It is that a liquid has great difficulty in forming an initial bubble, and unless it does this it cannot come off.
- 20 It depends on a number of circumstances where exactly it will happen. Coming to this particular case, I have a copy of 122073. I have a copy of a drawing of the allegedly infringing pen (Exhibit J). The dimensions are admitted as appear on that report.

*Objection by Mr. Menzies upheld.*

- Assuming that I have a pen as constructed as shown in that drawing, assuming that the pen is filled with a viscous ink, up to a point extending from the ball to a little way short, say 3 or 4 millimetres—or, say 10 millimetres—as to the point (B), and assume the reservoir tube is of the dimensions stated in this report, that is to say, three millimetres, that pen in use acts
- 30 this way—the ink will remain in the tube as an unbroken vein. First of all, my answer applies to these various cases. In the writing position, the ink cannot escape, because it cannot do so other than pass the ball. If one assumes it will escape by accident on to the paper, it cannot escape at the top end. The ink will not escape when the pen is held ball down, and you are not actually writing—this only qualified to the extent that an extraordinarily small amount of ink would escape, and just wet the ball, no more. Take the next position, with the ball up. If the ball is upwards, which does, by the way, not normally happen with this pen, because it is a retractable one, but if it is held upwards, the ink will not run out because
- 40 at the top there is a strong meniscus between the ball and its housing, so that the ink column is held there, and at the bottom it cannot run out because the meniscus is strong enough. As you can observe if you make a bottle run out, the air goes up, the liquid goes down, therefore unless the meniscus distorts nothing can happen.

*His Honour* : In other words one side of the meniscus goes upwards to let the air in?—That is right, and the other downwards or nothing can happen.

When you said ink could not escape except past the ball in the writing position, if you stopped writing and held the pen up, does that depend

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on capillary force or on some obstruction by the ball?—The main reason is undoubtedly because of the obstruction by the ball, when the ball is in position it is also helped to some extent and under certain conditions by capillary forces, but the main reason is undoubtedly the ball and the fact that the gap as between the ball and the housing is so very small.

I had understood that the reason why the capillary forces retained the ink in the pen in the reverse position was that the meniscus at the ball was more sharply curved than at the point B in the drawing. If you have the pen in the writing position but not writing, that position does not obtain does it?—No, the meniscus in the writing position would be different 10  
from the inverted position.

So that it is primarily the ball that prevents leakage in that position?  
—That is correct.

*Witness (continuing)*: The normal clearance between ball and housing in a ball point pen when it is new and not worn, is nowadays between 2 and 4 microns, that is general practice, but it may vary anywhere between 1 micron and almost up to 10. A micron is one-thousandth of a millimetre. I have dealt with the position of the ball down and of the ball up. I now explain what happens when the pen is lying horizontal on a desk or in a drawer. Again if the pen is of 3 mm. diameter, experience shows that when 20  
that happens there is a slight distortion of the meniscus due to the gravity effect of the liquid affecting the meniscus—it does not flow—the moment you revert it into the normal position up or down, the meniscus comes back into its normal position again. I said a moment ago a pen of 3 mm., I meant a pen having a reservoir of 3 mm. bore.

*His Honour*: You mean that is not true if the bore is greater than 3 mm.?—No, there comes a point I would say, that if the bore of the reservoir is above 4 mm., let's say if it were 6 mm., then there is no doubt that distortion would be such that flow would actually commence and the ink would run down the bottom of the tube one way and the air in the 30  
reverse direction in the upper part.

*Witness (continuing)*: I put that at 6 mm. It is not always 6 mm. it depends on cleanliness of tube, whether it is horizontal or slightly inclined, things of that nature, but I would say that above 4 mm., the numbers which I would expect to run out of 100 would certainly become alarmingly greater, anywhere up to between 25 and 90 per cent. We have dealt with the first three cases. I now take the case of a ball point pen as shown in the drawing. With its reservoir of 3 mm. diameter full, but not absolutely full of ink, and with the pen being dropped off the desk on to the floor, if it is charged with viscous ink, with the normal ball point pen absolutely 40  
nothing would happen, the whole of the shock would be absorbed by very small temporary deformation of the viscous liquid forming the meniscus at the rear end of the column. When the shock ceases the original condition will be restored, nothing more happens which would affect the history of the pen afterwards. I am considering whether any conditions of normal use can arise in which in a pen of the kind shown in this drawing there is a risk of leakage of ink from the reservoir, of a pen having a reservoir of the dimensions we are considering. The only condition I



know and the user of a ball point pen is familiar with, if I write upwards then I am destroying the meniscus between the ball and its housing and there is the danger of the column of ink falling down bodily. If I prevent this by not doing this, I do not know off-hand of any condition in which anything would occur.

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*His Honour* : You mean if you were writing your name on a list on a wall ?—Yes, something like that.

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*Witness (continuing)* : If I write normally, that is to say, on a surface substantially horizontal or sloping not more than 45 degrees—as an extremely sloping desk—and keep the pen either in a drawer or in my pocket under such conditions there would be no risk of leakage.

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Fehling.  
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tion,  
*continued.*

*His Honour* : Everything you have been asked so far is in relation to this drawing part of Exhibit J is it, that is this one (*indicated*) ?—Yes.

EXHIBIT.—EXHIBIT K.—Laforest Specification and Illustrative Drawing Coloured.

*(Drawing handed to witness.)*

I think we will mark the original specification and the drawing as one exhibit.

*Witness (continuing)* : I have studied the specification of Laforest 1980625. That pen is intended to use in my opinion aqueous ink. In the first place I think a great number of parts, particularly the complicated mechanism described in the specification would make no sense with viscous ink at all because it would be useless, in particular you would not require three balls for regulating the flow, you would not require the shut-off valve to prevent leakage, nor would you require the archimedean priming device, because in the first place I very much doubt it would work with viscous ink, and I could not see the use of it. Further, I know that this type of reservoir would not work with viscous ink, as undoubtedly it is intended to work with aqueous ink, the main reason being that air is meant to travel down here (*indicated*) as the ink in the other tube is exhausted and is meant to pass up the annulus and to the air trap there, because when this is happening the ink in the annulus cannot be used for writing, it would stay there indefinitely. Those I think are the main reasons. Air trap in the top part of the annulus formed by the tube 9 and the central air intake, 32.

*His Honour* : Air intake ?—The inner tube I think is called the air inlet tube.

That is the tube that is 32, is it not, the intake is another hole leading from 32 to the outer area ?—Yes.

*Witness (continuing)* : With a ball point pen a suitable ink is a dense viscous ink. The original reason no doubt was that it is more suitable for writing with a ball point pen. The ball point pen is distinguished from other

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writing instruments by the fact that you have two parts rotating against each other, the one in the other inside the pen, the ball in its housing, therefore if you want to have a good and frictionless rotation or nearly frictionless rotation of the ball in its housing you must have lubrication, and therefore it was natural to use an oil. There are other reasons and no doubt—I do not know whether they were apparent to the earlier inventors, but it is a fact that the moment you are using a viscous ink there will be less danger from seeping of ink at the ball end as you would otherwise have or may have. Regarding the quantity of ink, it was found that a viscous ink could be made extremely dense, also from a point of view of dye content, 10 and for this reason it was possible to use an extremely small quantity of ink for the same length of writing and therefore a given quantity of viscous ink would be suitable for a much longer period of writing than ordinary ink. Going back to the Laforest pen, I have explained that it would not be possible to get the ink out of the annular space between 32 and 9 if a viscous ink was used—supposing I had used a viscous ink and somehow or other I did manage to run the ink, in my view it would be quite impossible to fill the pen so as to have ink in between the threads of the archimedean screw extending down to the chambers leading to the ball—quite impossible 20 for a normal user to do, because the whole of the air would be trapped between the writing ball and the little windows, air holes 24 and 25, and I could not remove it from the pen. With aqueous ink the air would bubble up the moment ink would come down. This cannot happen with viscous ink and therefore what would happen is that even if you could fill the interior of 9 completely with ink, it would stop at the cavity from the outlets 24 and 25 and from there past the screw down to the ball would remain practically full of air with little bits of ink residue from the last filling. May I add that these passages down here, on any reading of the drawing, I would say are so small that again the possibility of pushing the air out 30 downwards past the ball would be practically non-existent—at least not merely by pouring ink at the top. The pressure required to expel air that way would be vastly in excess of that. Assuming that aqueous ink had been used in the Laforest pen, as I suggested was the intention as far as I could understand it, I don't think that would have been satisfactory. I think one of the main reasons is that the moment you have aqueous ink in this pen and you have again, as is shown in the specification, air trapped at the top of the annulus, it is quite inevitable that if accidentally you turned the pen over and subjected it to the slightest shock, the ink will in effect spray downwards through the outer inlet tube, through the 40 hole on to the paper and surroundings. I have made experiments and am quite satisfied that you could not avoid it. The reason for that is that aqueous ink has a very low viscosity to start with and because of the air inside the pen, the column inside the inner tube could move sufficiently to spray ink out. That is one reason. The other I cannot speak about from experience but generally speaking, ball-point pens with aqueous inks have proved fairly unsuccessful—attempts have been made to use them but their writing is harsh and I don't think they are very satisfactory.

*His Honour* : Unsuccessful in what sense?—It has been attempted to put ball point pens for aqueous inks on the market, and if you make a ball housing in which the clearance between the ball and the housing is 50 very large, then what you in fact have is a kind of a style of the kind you

had before the war plus a ball which is very loosely held in the housing and you can get a continuous trace with such a pen but it is not very satisfactory.

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*Witness to Mr. Shelley :* If a Laforest pen is filled with a viscous ink of the kind normally used in ball point pens, it will not give a satisfactory result. One part of the lack of success has been explained. If this pen had been filled at the factory as shown by the blue ink in this large drawing filling in all cavities completely then, assuming that the ink could pass these narrow channels near the ball and the pen would in fact write, then

10 undoubtedly you would exhaust first the ink that is in the central tube and so far there would be no trouble. But the moment the ink arrives at the end of the inlet tube, the air bubble formed would not travel up into the main reservoir as was the intention, but would undoubtedly travel through the window and follow through the archimedean screw and downwards. Therefore the whole or practically the whole of the ink in the annulus would stay put—would not, in fact, be used at all. The second point is that if you examine the drawing a bit more in detail I think that if the pen were filled with normal ball point pen ink, which really means for all practical purposes an ink of roughly 100 poise—which is the yardstick for the

20 viscosity—and in practical terms is a liquid about 10,000 times more viscous than water or aqueous ink. It is about the same consistency as golden syrup. Then I think those passages down here would prove far too narrow and therefore you could only write with this pen if you wrote very slowly indeed because the ink could not follow. There would be what we now call starvation, it would either write only if you wrote very slowly or if you wrote a bit more quickly it would write discontinuously. The third objection is if in the course of filling, as would be so very easy to happen, there were air pockets left. I would like to show Your Honour one place which would be extremely difficult to fill with viscous ink, which

30 is the annulus above the holes 25, between the outer body or barrel of the pen and the tube 9. This is a blind hole which is shown filled with ink here. Going to the drawing of the specification, I am speaking of the annular space between the part opposite the No. 25 and the bottom of the packing or washer which is indicated by 12. The consequence of that would be that air would be trapped in this annulus, up near the top of the annulus of tube 9, and due to continuous expansion and contraction of this air, which is quite inevitable in the use of a pen because both the temperature and the barometric pressure varies while you are using it, little slugs of ink would be pushed into the central tube and this ink would not be completely

40 exhausted when you used it on the way down and it would drop bit by bit. That is the experience even if the central tube were free of ink—that ink creeps back and eventually comes out the top. Of course, that happens even if there are comparatively small increases and decreases of temperature or pressure. If you have a very large decrease of pressure or increase of temperature, it might well happen that it starts leaking straight away—like a fountain pen in an aeroplane if it is not completely filled. I have made some calculations of the dimensions of the figures of Laforest in the U.S. specification, on various assumptions, and I have those calculations with me.

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tion,  
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*His Honour :* Do you mean the dimensions of the various parts ?—

50 Yes.

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*Witness to Mr. Shelley:* The actual measurement of the internal diameter of the tube 9 as shown in the final copy of the specification is, as near as I can make it, 5.8 mm. Assuming that the diameter of the ball in real life would be 1 mm., I have made a calculation as to what the internal diameter of the tube 9 would be—5.2 mm. I am referring to the rotating ball indicated by the numeral 6. I have never seen a Laforest pen sold on the market. I have not ever seen one, except such as I may have made for my experimental purposes. It is a fact that there has been litigation between Biro Company and Laforest.

*Objection by Mr. Menzies overruled.*

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*Witness to Mr. Shelley:* I was concerned in that litigation but not as a witness because there are no witnesses heard in France. I was present at the hearing. There was not any Laforest pen produced at that litigation, but the patents were put to us by Laforest showing that that was what they were doing.

HANS REINHARD FEHLING—*Recalled and Warned.*

*Mr. Shelley (continuing):* Dr. Fehling, there was just one question on Laforest which I omitted to put to you yesterday. Will you please take the Laforest specification once more and turn to Claim 5, and follow with me while I read it. “In a fountain pen as claimed in claim 1, a tube arranged within the barrel of the fountain pen, this tube being freely rotatable in said barrel and being able to communicate with the latter, an Archimedean screw on the end of said tube for forcing the ink, when the fountain pen is opened, to pass under the ball valve and to immediately feed the tracing ball, a screw-threaded rod carried by the end of said tube which is adjacent to the tapered end of the fountain pen, a stem in which said screw-threaded rod is screwed and provided with longitudinal conducts, this stem constituting an abutment for said ball valve, projections carried by said stem and extending in grooves of the barrel for preventing this stem from rotating, and an outer control for said stem, a central tube of small diameter in constant communication with the atmosphere in order that atmospheric pressure should act only on a small section of the ink contained in the fountain pen, the regulation of the flow of ink being effected by the partial vacuum produced in the circular chamber existing about said central tube.” Now, Dr. Fehling, will you please concentrate on the words beginning at line 83 “A central tube of small diameter in constant communication with the atmosphere in order that atmospheric pressure should act only on a small section of the ink contained in the fountain pen” and will you tell His Honour how that works?—May I have the last drawing? (*Exhibit K handed to witness.*) The idea, Your Honour, is that after a very short time after filling, which is shown here as being level inside the tube 32, level with the annulus, as we discussed yesterday, the Central tube will be empty, and after that if kept in this position during writing, it will remain empty of ink and air will enter this tube—and assuming an aqueous ink, it will bubble up. Now the effect of this is that the air has always access, free access, to this point.

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30

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That point being—you are pointing to the bottom?—The bottom of the central tube. For this reason it follows that at this point there is always atmospheric pressure above the ink.

When you say always, you mean after the central tube has been emptied?—That is correct. Above the ink in the central tube and from this it follows that the only pressure which is exercised is the actual column of ink which actually presses on the ball and is the column which is defined by the distance between the end of the tube and the end of the pen. Irrespective of how much ink there is in this annulus, the pressure will remain constant and it is a device which is quite old in the fountain pen art; it was known before Laforest to obtain constant flow irrespective of the amount of ink in the reservoir. The effect was possible simply because the remaining ink, namely, the ink which is in the annulus, which is the main part of the ink, was held up by the partial vacuum formed at the top of the pen in the trap, where it is trapped, and where the reservoir is not vented.

*His Honour* : Where the air is trapped?—Where the air is trapped, and therefore the air is not at atmospheric pressure.

*Mr. Shelley* : Now, Dr. Fehling, I want you to deal with 133, and will you please therefore take the specification 133. I want you to have the report of Messrs. Alger dated 4th September, 1950, and also the actual Scribal pen—that is Exhibit G. Have you previously studied this report of Messrs. Alger dated 4th September, 1950?—Yes.

I need not, therefore, take you through it. Now have you also examined the Scribal pen identical with Exhibit E?—I presume it is according to this?

Yes. I just want you to see the actual pen to make sure we are talking about the same thing. Just look at it and dismantle it and look at the reservoir so that there is no possibility of mistake. Now is that a writing instrument having a ball mounted for rotation in a housing?—Yes.

And is part of the ball exposed?—Yes.

And is the ball supplied with ink from a reservoir?—Yes.

And is the arrangement such that as the ball is rotated such as being moved relatively to and in contact with the writing surface, the ball carries a quantity of ink through the housing?—Yes.

And is that ink deposited by the ball on the writing surface?—Yes.

So as to make a trace?—Yes.

Now, we can see for ourselves, Dr. Fehling, or His Honour can see, that the tube is opened at one end and from the diagrams it is apparent what the dimensions are. Will you tell His Honour whether that pen that is Exhibit E is charged with viscous ink?—Yes.

Well, your answer yes—you may mean that you will tell His Honour, or yes, it is charged with viscous ink?—It is charged with viscous ink.

And is the arrangement such that a continuous liquid vein is maintained extending from the ball?—Yes.

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And also when the pen is not writing is it maintained, when the pen is not being used, but is lying in a drawer or upside down in the pocket ?  
—Yes, it is.

Is the reservoir removable from the outer casing ?—Yes it is.

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I think to complete that, is the reservoir, so far as the user is concerned, permanently affixed to the nib unit ?—Yes, it is.

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And the reservoir plus nib unit are removeable from the outer casing ?  
—That is correct.

Now I want you to look at two United States specifications—those are not in yet, actually, Your Honour, I think. (*To witness*)—Have you 10  
got copies of those, Dr. Fehling ?—Yes, I have.

EXHIBIT.—EXHIBIT L.1.—U.S. Specification 2265055 Biro.

EXHIBIT.—EXHIBIT L.2.—U.S. Specification 2258841 Biro.

*Mr. Shelley (continuing)* : Dr. Fehling, do those specifications describe ball point pens ?—Yes.

And is the reservoir of the piston type ?—Yes.

And is the method of operation that pressure is exerted upon the ink urging it towards the ball by a piston ?—Yes, that is right.

In your experience is a piston type of pen, ball point pen, satisfactory ?  
—No, this type is not satisfactory. 20

Will you tell His Honour why it is not satisfactory ?—The reason is that you are using viscous ink, generally, of an oily type, and it is practically impossible to exert pressure on such ink by a piston without ink seeping past the piston towards the rear end of the reservoir. Now this ink collects, and eventually finds its way out of the air vent and soils the users hands.

When you say this ink collects, do you mean collects behind the piston on the opposite side of the piston from the ball ?—That is correct. It is not the only reason for dissatisfaction. It is also found that as soon as such an instrument has been used for some time, and that means that 30  
the gap between the ball and the housing for the ball has increased by wear, the application of pressure through the piston leads inevitably to oozing out of ink past the ball. This is considerably more than would occur by gravity and is objectionable.

Now on the question of general knowledge, when did you first see a ball point pen ? I do not mean a proposed ball point pen, but I mean an actual physical ball point pen ?—In the autumn of 1944.

And when you first saw the pen, did you see it in the form in which pens are normally sold—that is to say, with the works inside the outer casing ?—Yes, it was a complete pen. 40

Did you observe when you first saw it that it was a ball point pen ?  
—After looking at it, yes, but I could not recognise it, because I had never seen one in the flesh before.

When you saw it was a ball point pen, while the works were still inside the casing, was it obvious to you how the reservoir was constructed?—No, I had no idea.

And did you then dismantle the pen?—Yes, I asked permission to do so, and I did.

And did you—what did you then find inside?—A tubular reservoir.

Of what diameter?—A small diameter, in fact, a capillary tube.

And what was your reaction when you saw that reservoir—I mean from the point of view as to whether it seemed to you, to your mind, an obvious idea or not?—I was extremely surprised.

Since that time have you been concerned as consultant and technical assistant in connection with litigation in connection with ball point pens?—Yes.

You have been concerned, as we all know, with litigation in England and now Australia. What other countries have you been concerned with about ball point pens?

*Objection by Mr. Menzies.*

*Discussion.*

*Mr. Shelley :* The question I am leading up to, Your Honour—well, I will put the question straight away (*To witness*)—In the whole of your experience have you ever seen or had produced to you a ball point pen alleged to have been manufactured before December 1943?—No, I have not.

And if there had been such a pen, would you have expected to see it, having regard to your experience?

*Objection by Mr. Menzies.*

*After Discussion.*

*His Honour :* Well, I think you may go this far. You may ask him what circumstances existed which rendered it likely that he would see any such pens. I think he may tell you that, because they would be facts, but what his own expectation was, I think you cannot ask directly, but I will take evidence of what circumstances he knew of which would have rendered it likely that he would have heard of such a pen.

*Mr. Shelley :* Dr. Fehling, will you answer that—what circumstances existed which would have rendered it likely for you to have seen a pre-1943 pen, if such had existed in any part of the world?—Well, I know that in a Patent action in most countries, not in all, prior use is a defence, and if—not only regarding the reservoir, but other parts of the pen, there had been ball point pens on the market say, before the late War, it might well have been that some might have disclosed a feature which was thought to be novel, and in fact I do know that such attempts to find such pens were made, but to my knowledge, quite unsuccessfully.

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*His Honour* : Are you saying this, that in litigation so far as you have known it relating to the ball point pens, you have not seen an example manufactured before December 1943, or allegedly so manufactured, produced to any tribunal?—Not to any tribunal and not even—

In consultation?—Yes, in consultation, or in correspondence, or—

*Mr. Shelley* : Or negotiations?—Or negotiations—I have never come across it.

*His Honour* : Well, you have not yet told me in what countries that experience has been acquired. Is it in England and France?—England, France, Holland, Germany, Switzerland, Sweden. 10

*Mr. Shelley* : Since 1944 have you in the course of your work become familiar with a large number of Patent Specification relating to ball point pens?—Yes, I have.

And is the mere idea, or was the mere idea of a ball point as a writing instrument known prior to December 1943?—Yes, it is a very old idea.

And so far as the actual manufacture of the ball point itself, was there any difficulty prior to December 1943?—No. I would say that probably at the beginning of the century they had some difficulty in producing accurate and small balls, but certainly not, let us say, in the period between 1914 and 1942. 20

What was the difficulty prior to 1943 in producing a practicable ball point pen?—I can only answer this question on the basis of the research I did into what actually happened before I was concerned with ball point pens, and I think there is no doubt that the overwhelming reason was that no-one had produced a fully satisfactory reservoir.

What were the defects of previously proposed reservoirs?—I think it might be put in one word, for one reason or another, they all leaked.

And does the capillary tube reservoir, provided it is properly made and reasonably used, avoid that difficulty?—It does.

Since 1944 can you tell His Honour of your own knowledge whether 30 or not the ball point pen has become a popular article?—A very popular article, I should say.

Can you tell His Honour approximately the amount of ball point pens that are sold by the Biro-Swan Company in England?

*Objection by Mr. Menzies.*

*Legal Discussion.*

*Mr. Shelley* : May I preface it by saying are the instruments sold in England substantially the same in their principle of operation as the ones that we are talking about in this case, exemplified by Exhibit E?—Yes.

I am there referring of course to the ball, the housing, the reservoir 40 and the ink, and not concerned with the retractable parts?—Yes.

Well now, Your Honour, I ask this question—what to your knowledge are the approximate sales per annum of such ball point pens in England?



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*His Honour* : I think the objection goes rather to weight than admissibility. I think if it were a reasonable hypothesis that there may have been some compulsory use of such pens in England—that would no doubt be a ground for rejecting the question, but I think one may take it it is knowledge of the fact that the general nature of the civilisation in England is similar to that in Australia, more so one hopes, and I think the question is admissible.

10 *Mr. Shelley* : Then, Dr. Fehling, will you tell His Honour what are the approximate numbers of similar ball point pens sold in the United Kingdom?—By Biro-Swan Limited?

Yes?—I will give the rough figure 30,000,000 units per year.

And it follows from your evidence——

*His Honour* : Does that mean new instruments, or does that include refills for old instruments, or what?—Well call, say, everything that includes a nib, meaning pen or refill, one unit.

Yes?—In other words, 30,000,000 refills and pens all told.

*Mr. Shelley* : And I think it follows from your evidence that prior to 1945, I think, the sales were nil?—Nil as far as I can remember.

20 *His Honour* : Why 1945—why does that follow?

*Mr. Shelley (To witness)* : When were they first put on the market?—In summer 1945.

Was the first pen that you say a specially made pen or a commercial article, or what was it?—Do you mean the one I described first.

Yes?—I cannot say that with certainty. It looked like a commercial article, but it could have been a model at this time—I cannot say. It was shown to me by Mr. Martin, and he did not say whether that was one that was actually sold abroad or not.

30 Was it shown to you as a scientific consultant?—Yes, but I would not say what you would say, a laboratory mock-up. It was what you would call a commercially made product.

*His Honour* : A laboratory what?—A mock-up, Your Honour—it was not something you would make up in the laboratory, it was made by a manufacture under normal methods.

*Mr. Shelley* : Now, don't answer this question until my learned friend has had an opportunity of objecting. Can you tell His Honour whether or not ball point pens are now popular articles on the Continent of Europe. What is your answer?—Very popular.

40 Are ball point pens now popular articles on sale on the Continent of Europe?—Yes, very much so.

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*Mr. Menzies :* Dr. Fehling, am I right in assuming that since the Autumn of 1944, your principal business and scientific concern has been as consultant to the Biro organisation?—Not principal. I would say that most of the time it would say, occupy 50 per cent. of my time.

I was referring to the question my learned friend put to you, that you had been substantially engaged on that work since 1944?—Oh yes.

But not, say, 12 hours a day?—No.

I suppose about 10?—No, I told him 50 per cent. of my time was devoted to this work.

10

*His Honour :* Are you a consultant in general practice, or what?—Yes, I have always been.

*Mr. Menzies :* And I gather from your evidence that you have been, as it were, round the world for Biro?—Among other things, yes.

Well, I imagine you are being paid for it?—That also.

*His Honour :* I would like just to follow that. Are you paid a salary as consultant, that is to say an annual salary as consultant?—Yes, that is right.

And if you go to some other country to advise, then you are paid under some arrangement for expenses?—That is not included in my fee. 20

*Mr. Menzies :* I won't enquire about the size of your fee, Dr. Fehling it is a very substantial one?—It is a question of what you call substantial.

Now, I think I am right in saying that you expressed your agreement with the scientific data that was put before the Court by Dr. Hopper?—Yes, I think it was a fair statement.

And there is no matter in that statement with which you disagree?—No, I can find nothing.

Now I want to put to you the matters I was putting to Dr. Hopper himself. It is at page 6 of the report which I think was Exhibit A, and the passage that I want to put to you was in relation to Fig. 12B. You are familiar with that?—Yes. 30

Now I want to read just one or two lines to you, and ask you whether you agree with them. If you have 12B in front of you, the passage I want to put to you is "The pressure at A is less than the pressure at B, the difference in pressure being sufficient to hold up the liquid of height AB and cross sectional area corresponding to the dotted lines. The atmospheric pressure at C holds the remainder of the liquid in the tube," and I want you to assure, Dr. Fehling, if you would, that the reference there to the remainder of the liquid in the tube, or the reference to the remainder of the liquid, is a reference to the liquid in the tube which is outside the cross sectional area which is there shown?—Yes. 40

Now, do you agree with that statement?—Yes. I may have explained it differently, but it is a familiar way to explain what happens in Physics, to dissect what is in fact—

I am asking you the question at the moment, do you agree with it as it is expressed?—Oh, basically, yes.

So in effect if you have a very small opening which gives you a small and steeply curved meniscus, the view that you are putting is that that meniscus merely holds the liquid that is virtually underneath it and outside the cross section of the meniscus extended down through the column of liquid, it is the atmosphere alone that holds the liquid in the tube?—That is not strictly correct.

No?—If you put it as restrictively as this.

10 That is my understanding of this statement?—No, no—you see you interrupted me. I told you that this is a way of explaining it. You can make dotted lines in the picture for the way of explaining, but in physical reality there are no dotted lines, and it is continuity.

Oh well, that is what I wanted to put to you, that this is a misleading way of explaining it?—No, I disagree there, because it is commonly done in elementary physics, to put it this way.

And what is commonly done is never misleading?—If you please.

20 Now let me press this a little further—do you agree that taking this way of explaining it, that what is explained is that the smaller the meniscus the smaller the column of liquid it maintains?—No, no—oh no.

Why not?—You are not permitted to come to that conclusion because you see, you interrupted me just now. I was going to explain to Your Honour that the fact that there is a small meniscus, and that by virtue of that meniscus there is a low pressure, means that that pressure, low pressure, as Dr. Hopper said in his evidence, spreads throughout the cross section at the same level and therefore if you would measure the pressure under, as it were, the shoulders of the bottle, the pressure is low there, and it is only low because the meniscus at the top produces that low pressure—in other words, the meniscus produces the same effect as a 30 stopper would, or the sealed tube or type of tube on a barometer. It just seals that hole and it produces effects far beyond it.

Well now, Dr. Fehling, I want you to look at 12B again, and imagine that the cross section and the extension of the type that is the narrow part in the vicinity of A has been narrowed by half?—The one on A.

Yes, the cross section and the extension of the tube at A has been narrowed to half?—Yes, I follow.

Now adopting this method of explaining, wouldn't it follow that the cross sectional line would be shown in this diagram would only be half as narrow as it is?—The dotted line should be half as wide?

40 Yes, and then if you apply Dr. Hopper's explanation to it, the meniscus would maintain the liquid within the dotted lines and the atmosphere would maintain the liquid outside the dotted lines. Do you agree with that?—I have qualified, yes—with a qualification, I have already given it, that beyond holding it at that part, it creates the effect of producing low pressure throughout the section. That is all important.

Well now, Dr. Fehling, I just want to put this to you again. I want to suggest to you that this is incorrect, and I read these words—"The difference in pressure maintains or is sufficient to hold up the liquid to

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height AB—holds the remainder of the liquid in the tube.” Now I put it to you that that is scientifically incorrect?—No, it is completely correct. May I explain that to Your Honour?

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tion,  
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*His Honour* : Yes, I wish you would?—As I said, there is merely a convenient way of splitting up the problem and explain what are the balance of forces. Now I just said that the effect of the small meniscus, and it doesn't matter whether it is small or a little larger, as long as it holds it carries a certain pressure below the meniscus. This pressure is bound to be the same throughout the cross section, however large, therefore this low pressure is also exercised on the walls of the shoulders of the bottle, if I express myself clearly this way, that pressure is therefore at this point lower than atmospheric. In other words, the top walls bounding the annulus of liquid outside the dotted lines are at the top at a lower than atmospheric pressure. At the bottom below at C, at the meniscus, that part of the meniscus outside the dotted line, the pressure is evidently atmospheric, and it is that difference between the lower pressure at the top created by the small meniscus and the atmospheric pressure at the bottom which as a matter of fact and as a matter of balance of forces keeps that part from sliding down. 10

*His Honour* : Are you saying this, that if at any point on the dotted lines between A and B we draw a transverse or horizontal line the pressure in the liquid everywhere on that particular plane will be equal?—That is right. 20

Otherwise the liquid would be moving?—That is right, it would be moving.

And if therefore pressure at 2" below A is lower than the pressure at B, that is true of the whole of the column of liquid within the containing walls?—That is right.

*Mr. Menzies* : Well now, does that mean this, Dr. Fehling, that it is the meniscus that holds the liquid in the tube across the whole of the cross section?—Which? 30

The meniscus at the top in conjunction with the meniscus at the bottom?—You see, there are two.

*Witness* : What you are putting to me has two answers. There is one direct effect on that meniscus, namely, the very force—and by force I do not mean pressure—that occurs. That force can obviously only be balanced by one which is exactly of the same value and that is why you draw the dotted line, and so can it be balanced by the force of gravity contained in the weight of liquid within dotted lines. That is a direct effect on that meniscus. The indirect effect is to create the same low pressure—that is not force now—across the whole cross-section, and that indirect effect makes it possible for atmospheric pressure to hold the remainder of the liquid up. 40

If it is the atmospheric pressure that is holding the remainder of the liquid up, I suppose the narrower the meniscus, the greater atmospheric pressure we require to hold the remainder up?—No.

Why not?—It does not really matter how—let me put it the other way. If supposing at A the meniscus remains at the same cross-section and you widen the bottle within limits, always assuming the lower meniscus does not break, it does not matter at all, because you would always have the balance between the difference of atmospheric pressure at bottom and the lower pressure at the top. Both cross-sections increase and decrease in proportion.

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10 I want to put this to you—if your explanation is correct, would it not follow that if you had a meniscus strong enough in conjunction with atmospheric pressure to maintain the column of liquid A–B, let us say at ground level, if you take your pen 18,000 feet in the air, your ink would run out?—No.

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Why not?—Because the vacuum—using your word—at that height is not low enough. It would not affect it. May I correct myself to say this, if for instance your liquid had not been properly evacuated, but contained air dissolved or had a low bubble point like petrol or something like that, then yes, you might be in trouble.

20 I am asking you to assume that at ground level you have created a column of liquid of length A–B which is the maximum length that you can create in such an instrument with a meniscus of this size and I am asking you now if you take that 18,000 feet in the air, if your explanation is right, must not the ink run out?—Yes, that is different. In that case quite naturally the same thing would happen as if at sea level you would put it in a vacuum or an increasing vacuum, there would always be a point where the weight of the liquid itself would create at the top at one point or the other, zero pressure at which a liquid just cannot exist, therefore there would be a complete vacuum and the column would fall.

30 You disagree with me then that if you have a nicely balanced column at ground level—let us take a Biro pen which is nicely balanced at ground level, and you have a nice long one so it had plenty of ink, and you take it 10,000 feet up in the air, you get a pocket full of ink?—No, because the meniscus of any ball point pen will hold a column of ink of say, at least several feet, therefore such a thing just does not happen, cannot happen, because it is not practicable.

I gather from your evidence that you say that if you did put this bottle shown as 12B in a vacuum, the liquid would slip down?—Yes, I think I have explained it before.

I just want the answer—that is your view?—Yes, the column as a whole would come down.

40 It would move from A?—It would move from, as I said before, a point below A, but there is uncertainty about this point.

I just want to put to you that scientific experiments have been carried out here that prove that does not happen.

*His Honour* : That what does not happen ?

*Mr. Menzies* : That liquid is contained in a vacuum. That in a vacuum it does not move?—Then the vacuum was not high enough. I have made experiments myself long before this case and it happens that Mr. Shelley has been witness to such experiments. The fact is that there

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are many—and again I explained it yesterday—there are many factors affecting the result. The most obvious one is the character of the liquid and the degree of the vacuum which is created.

You say that Dr. Hopper is right?—Yes.

I think you also agree that, as Dr. Hopper says, the most important element is the description that you get in claim 1 of 133 is the element that my learned friend, Mr. Shelley, isolated as maintaining the liquid vein to the ball?—Yes.

And I gathered from the evidence you gave that the ball is old?—  
Yes. 10

That a feed duct of narrower channel than the reservoir is old?—  
Yes.

That a feed duct that itself narrows down to a smaller cross-section from the cross-section where it enters the reservoir, is old?—Yes.

And it is common knowledge that you have to have what might be described as a vented tube, you have an air intake for a pen to work?—  
Yes.

And that leaves us with this, that the significant element is the capillary tube?—That is correct.

*His Honour* : When you say that the feed duct is old and that a feed duct narrower than the reservoir itself is old, are you speaking of feed ducts as used in the ordinary former type of fountain pen, or what?—No, in ball point pens—may I draw attention to the last specification Mr. Shelley put in—the two American ones—I think they would show something of the kind. 20

*Mr. Menzies* : Both American 226 and 225 show that.

*His Honour* : What do you take to have been the purpose of using those capillary feed tubes in those models?—I think merely manufacturing convenience, I cannot see any other.

Has it anything to do with regulating the rate of flow?—No, I don't think so, because that is completely taken over by the plunger. 30

*Mr. Menzies* : You have experimented with a Scribal pen, have you?—Well, to a certain degree, yes.

Have you experimented to the extent of seeing that it will write?—  
Oh, yes.

And have you ascertained that it will write when the ball is below the horizontal?—In the normal position?

Yes, when the pen itself is held with the ball below the horizontal?—  
Yes.

Have you tested whether or not it will write if you hold the ball higher than the other end of the pen?—I may or may not, I cannot tell you, it is too long ago. 40

I will ask you to try now. We have one here and we have some paper. The one in evidence. (*Exhibit "E" handed to witness*)?—This one has

stopped writing, the ball has rusted and it does not roll. (*Exhibit "H" handed to witness.*) The other one does not contain any ink. The nib has been sectioned, it is still there but I cannot write with it of course.

Have a look at my pen and satisfy yourself it is a Scribal?—I don't know the model but it probably is, I accept your word for it.

It was presented to me as a Scribal for purposes of demonstration in this case.

EXHIBIT 3.—Scribal pen produced by Mr. Menzies.

(*Exhibit handed to witness.*)

10 *Mr. Menzies* : It writes with the ball down?—Yes.

I want you to write first of all with the pen held with the ball above the other end?—It stops.

And I take it that your experience of ball point pens is such as to lead you to believe that that is a necessary consequence—it always happens?—No, not always.

Does it happen with Biro pens?—It has nothing to do with the make. I know of two conditions in which it can be shown that the ink will write almost indefinitely, even if you write with it upwards like that. There are certain conditions that cannot be reproduced and guaranteed in every pen  
20 in which it will go on writing in that position.

Do you remember telling His Honour yesterday that the circumstance in which the ink would fall out of a Scribal pen by reason of gravity is if you have written with it upside down and then left it in that position?—Yes, it is quite correct. With a qualification there are artificial circumstances in which it will just hold.

You can create artificial circumstances?—Yes.

I suppose if you exerted some sort of pressure?—No, a perfectly normal refill. The first one is, you must have a pen which has uniformly a very small gap and if I may say so, very small, I mean small compared  
30 with a normal gap that a ball point pen should have.

Do you mean the gap at the ball?—Yes. In other words, it is usually a pen which will produce a fairly fine trace and secondly if at the same time you have a length of ink column which is not too long, then it may hold up, but with that qualification only, what I said yesterday normally happens.

*His Honour* : When you write like that and it stops writing, what is it that makes it stop?—The exhaustion of the ink in the ball cavity.

*Mr. Menzies* : Could I put it in this way, that the ink is no longer maintained to the ball?—Yes.

*His Honour* : What does that mean, that there is an air bubble or  
40 something in there?—Yes, the re-entrant of the ball—I mean on the one side of the ball when writing it goes out and draws ink, and if that ink is wiped clean off the ball, as it may, no ink can enter on the other side and there is a chance of air slipping into the ball housing and if on the other

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hand there is absolutely no assistance by gravity, on the contrary there is a pull, then air will gradually fill the ball cavity until it is exhausted and often it stops writing.

Will it begin again?—Yes, immediately, as I showed you here. It stops now, I turn it over and it comes back again.

*Mr. Menzies* : It comes back gradually, doesn't it, not immediately?—Well, it fades out and then you have to make two scribbles and it comes back.

The ink has to come back against the ball by gravity?—Yes.

You have the established contact again between the ink and the 10 ball?—It is not only by gravity, it is gravity plus surface tension.

Just let me take this a step further. You say that if you do write with the pen upside down so that there is no longer ink in contact with the ball and the pen is then kept in that position, you would expect all the ink to fall out of the pen by gravity?—There is a great danger of that happening, though it does not happen always.

It does not always happen?—But there is a danger.

A very real danger?—Yes.

*His Honour* : Is that because a different meniscus forms, or what?—No, if you have written the ball cavity free of ink completely then it 20 means that the ink has receded back into the feed capillary. That feed capillary has a diameter of about half a millimetre or .6 mm. That meniscus, though still quite a small one, is not sufficiently strong to hold up the whole of an ink column, assuming that the column is still there. It would hold up say one-third or one-quarter, but it cannot hold the whole, therefore it drops back.

*Mr. Menzies* : And atmospheric pressure at the bottom is not sufficient to hold it?—The same at the top.

I think you will agree, will you not, there are ball point pens on the market that are using aqueous ink?—Yes, there are. 30

And that all that can be said is that viscous ink is preferable?—Yes.

And as I follow it, one of the reasons why viscous ink is preferable is that, if the pen is either held at the horizontal position or jarred, you are less likely to get an escape with viscous ink than with aqueous ink?—Not when it is held, the main reason is shock.

You say there is greater resistance to shock with viscous ink than with aqueous ink?—Yes.

*His Honour* : What would happen to your leakage risk that you were discussing a minute ago if you placed another ball portion of the way 40 down the .6 mm. feed duct?—The trouble would be that either the clearance between the ball and whatever surrounds it is too large or large enough in fact for letting enough ink pass, and then it would be ineffective for sealing, or in the reverse case—it would starve. In fact such devices have been proposed.



*By agreement a different pen substituted for Exhibit 3.*

*Mr. Menzies* : Considering still further what happens when a tube containing viscous ink is dropped, you say, I think, that you have a certain distortion of the meniscus ?—Yes.

But not sufficient to break it ?—Yes.

And that is not due to the surface tension of the ink at all ?—What is not due ?

The fact that you have this distortion of the meniscus but not its breaking ?—Both come together naturally, but the effect of viscosity is merely to render it impossible for the liquid to be sufficiently deformed for something serious to happen.

And you have greater resistance to breaking of meniscus when you have a viscous ink with low surface tension than aqueous ink with a high surface tension ?—I cannot answer that generally, but if it means merely the values generally known for both ball pen ink and aqueous ink, yes.

I think we are agreed that aqueous ink has a far higher surface tension than viscous ink ?—Yes.

And yet you say that the meniscus of viscous ink is far less likely to break on jarring than with aqueous ink ?—On shock, yes.

And I am putting to you that the higher resistance cannot depend on higher surface tension ?—No, I didn't say so, but there is a difference between leakage on gravity and the leakage on shock.

That is why leakage under shock is not due to surface tension of the ink ?—If you confine those questions to tubes of, say, above 2 mm., I would say yes.

Let us come to the larger tubes, what would you say is the maximum size of the tube where if you charge with viscous ink the meniscus will not break by shock ?—Shock only ?

Yes, shock only ?—I would say 5 mm. certainly ; shock only ?

Yes ?—I don't think that even if you have a viscosity of 100 poise which is normal viscosity, I frankly have not made an experiment that way, but I doubt that with pure shock you would move a meniscus in a 10 mm. tube.

What is your opinion of pure shock ?—The nearest I can think of is to let a pen drop from a height very hard on to a hard surface and to examine by, say, photograph, what happens within one-tenth or two-tenths of a second after it has hit the table or the surface.

Your idea is that you have in mind as shock, the dropping of the pen on to some hard surface ?—Something like that.

So that there is a sudden shock ?—I want you to understand that you have to take other forces, like gravity, because they are always working, but the nearest I can get to it—

Would you say that the capacity of the meniscus in a tube charged with viscous ink to resist shock of that sort depended upon the interrelation of two elements at least, namely the viscosity of the liquid and the cross section of the tube ?—Yes.

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And therefore if you have a more viscous ink you could use a larger tube than with the less viscous ink?—Yes.

And I suppose the only way in which you can actually work out what would be the limits of the size of the tube with ink of any particular viscosity would be by experiment?—I think so, yes.

About the Laforest specification, I think you will agree with me that there is no sort of ink specified as such in the specification?—Yes.

And I think you have agreed that it is practicable to use aqueous ink in a ball point pen?—Yes.

*His Honour*: You said that earlier. I was not quite clear how far 10 that went. Do you mean that commercial pens are sold with aqueous ink—pens that work on the ball point principle?—Yes.

And do they work on this system of capillary forces?—The nearest I can describe it quickly to Your Honour is that they are normal fountain pens with normal filling mechanisms with a ball point fitted—a special type of ball point fitted where the normal nib usually is.

*Mr. Menzies*: Would you agree that if you start with the air intake in cap 30 in figure 1 of the Laforest specification and follow a line from that air intake to the ball, you could have what you would call an extended path from the air intake to the ball? 20

*Objection by Mr. Shelley.*

*Mr. Menzies*: I will adopt my learned friend's question. (*To witness*): You have a path from the air intake to the ball?—Yes.

Would you describe that path, by reference to the specification?—Assume that the pen will write with aqueous ink and that the liquid will follow down from the central tube.

Yes?—Am I right that I am now assuming aqueous ink?

Yes. I am asking you to define the path which you said to exist from the air intake to the ball?—It will follow down the central tube of 32, through the holes 24 or 25 in tube 9 and downwards past the archimedean 30 screw and then down to the narrow passages leading to the ball.

That is not a straight path?—No, it is not.

I want you to assume that you charge the capillary tube 32 with aqueous ink. You would agree that that is a capillary tube?—It is one possible explanation. It does not so specify in the specification.

This illustration is somewhat larger than the normal pen, is it not?—Yes, a good deal.

And you would have no doubt that if that was reduced to the size of a normal pen, the tube 32 would be capillary?—Yes.

I want you to assume that tube 32 is charged with aqueous ink?— 40 That tube only?

I want you to answer whether or not you could not write so as to exhaust that ink?—If the rest of the pen was not filled with ink, no it could not. If only the tube 32 were filled with ink there is no connection between that tube and the nib to start with.

But I am starting off with the idea that you fill that tube 32 with ink, and then you screw it in?—Yes.

*His Honour* : May I stop you before you finish putting the question. I had rather understood from Mr. Shelley yesterday that at the bottom of 32 there was an open end?—Yes, Your Honour.

How would you fill it?—You merely take it out, fill it, hold it upside down and screw it in.

It has a hole at each end?—I am assuming that you block up the small air hole in 30 for the purpose of filling it.

10 I see.

*Mr. Menzies* : There is no difficulty about doing that for the purpose of filling it?—No, and assuming therefore that you dip that tube into the ink, put your finger on the orifice and then screw it into the pen while still blocking the hole.

Yes, then I am asking you if you then hold the pen in the ordinary writing position would you not, by force of gravity, get that ink running through the rest of the pen and down to the ball?—You are lifting, of course, now your finger.

20 Yes?—The ink would run out of this tube 32 into the tube 9. In other words, it would go down, a little upwards, then it would pass out, though slowly, and only in as far as air can travel upwards through the holes 24 and 25 into the bottom of the pen. I cannot predict exactly what happens because as I say ever in this case it depends entirely what the air can do.

30 But I am assuming aqueous ink so that there would be no difficulty about the passage of air?—I would not say there is no difficulty. You see on your assumption that is to be a capillary tube all the other passages are not exactly wide and air must escape somewhere. I cannot predict exactly what happens but I would say eventually I would agree with you that most of that ink would probably find its way out of that tube into some other parts of the pen.

And down to the ball?—And down, yes.

And when that ink reached the ball, you would have an uninterrupted vein of ink extending from the ball to the upper surface of the tube down to the tube 32?—I don't think so, because the ink from that tube would have run out completely.

I am getting to the stage where it is exhausted?—Not exhausted, because you see, it does not contain enough ink to fill all the rest. I am not sure of this.

40 You suggest that the cubic content of the tube 32 is not sufficient to fill the interstices below the point 25 down to the ball?—I have never calculated, but I would make a guess that you are lucky if it does.

I want you to assume that it does. You are not in a position to say it doesn't. Now I put my question to you, wouldn't you have an uninterrupted vein of ink from the ball to the outer surface of the ink?—If I wait long enough until all the air is cleared—if it is—it may, I really cannot answer without experiment, there are too many things that can happen.

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But you agree, would you not, that is quite possible?—It is one possibility, I would not put it higher.

And can you see any reason why it would not happen, apart from your doubt as to the cubic content of the tube 32 and the interstices below that tube and down to the ball?—No, I think that the most likely thing to happen is that some ink would undoubtedly find its way downwards right to the ball, but what was described as the vein of ink extending towards, would be interrupted in many places by bubbles of air.

Why, would the bubbles of air clear in liquid ink?—They will clear eventually and then you have asked me to assume that I should consider 10 the state of the pen after filling, not after writing.

We will take it further—after writing?—You don't follow my answer. You ask whether there is an uninterrupted vein of ink in the sense there is one in the capillary tube. I must ask if that is what you mean?

Yes?—I say you will find in all probability that there are air bubbles somewhere all the way up, small ones in every nook and cranny and for all I know they may stay there.

But with liquid ink you would expect them to go, would you not?—No, not necessarily because what I say does not mean they would necessarily block the whole passage, but they still would be there. 20

But is the position that you do not know whether you would have an uninterrupted vein of ink or not?—I would say, and I cannot put it further, I think it would be unlikely that you would get an uninterrupted vein of ink.

Notwithstanding the experiments that you have made, you are not in a position to give a definitive answer, one way or the other?—Not completely definite, no.

Re-exami-  
nation.

*Re-examined by Mr. Shelley :*

*Mr. Shelley :* You were asked about what was old and you agree that the ball in its housing was old, that the feed duct was old, and then 30 you were asked the question as to whether the vent was old and you also agreed with that. I just want you to amplify that answer. In the case of a conventional fountain pen, how does the ink which is used up in writing have the space which it occupies filled?—By air.

In the case of a ball point fountain pen, how does the ink which is used up in writing have the space it occupies filled?—I beg your pardon.

How does the air get there?—Through the nib section.

And was that principle of replacement of ink by air very well known prior to December 1943?—Oh, yes.

And was it well known that when you used up ink in writing you must 40 replace that space that it occupied somehow or other so as to avoid creating a vacuum?—Yes.

*His Honour :* Was viscous ink used before 1943?—It is difficult to answer, Your Honour, because I have never come across anyone who could definitely give me a commercial pen, or even a model, or even news

about a commercial model. All I could say from my searching through the literature, Patent specification, it looks as though inventors at that time took such ink as being generally accepted as being the most suitable.

At what time?—I would say before 1942 or thereabouts—before the war.

*Mr. Shelley* : And in giving that answer, were you speaking of ball point pens?—Yes, certainly.

*His Honour* : Well then, I would just like to follow that through to one other question. What was indicated to you from your study as to the method of replacement of viscous ink, say, used by air?—I give you an example, Your Honour—that is the Biro United States specification. There of course the answer is frightfully simple. If you do not make the space behind the piston very tight, well the air will just fill the cavity behind the piston as the piston travels forward, therefore there was no real problem at all.

Well, that would involve supplying air from behind the column and not past the nib?—That is right, not past anything really.

*Mr. Shelley* : That was the point of what I was leading up to. Dr. Fehling, take this U.S. Specification, 2258841, for example—  
20 Exhibit L.1.—as the ink is used—look at Fig. 1?—Yes.

As the ink is used, does the piston 12 travel forward?—Yes.

By reason of the fact that there is a certain amount of latitude in the motion by the presence of the spring 19?—Yes—it is not shown like that, as you realise, because the piston happens to be at the end.

Yes?—Fig. 6 shows it.

Yes, it is in Fig. 1—it shows where the spring is fully extended?—I think Fig. 6 is easier to follow from your aspect.

Looking at Fig. 6, the spring is being rolled forward?—That is correct.

Well now, the ink that is being used, of course, comes from there—  
30 on the drawing the top end of the picture, that is to say the nib end, and the ink is replaced, or the space that the ink at the back occupied is replaced in the first place by the piston?—Yes.

And then the space that the piston occupied is replaced by air coming from outside?—That is right.

Now when you gave that answer about the vent being old, were you—had you in mind constructions of that kind?—Among others, yes.

Well then, just tell His Honour what you had in mind in connection with that answer?—For instance Laforest, he clearly says you must have an air vent.

40 Now, one other point. You were asked in connection with Laforest whether or not if you started with only the inner tube 32 filled with ink, and then allowed that to disperse into the pen, you would not get an uninterrupted vein of ink, and you answered that. Now supposing you do just what was suggested to you—let the ink disperse from the tube 32 into the rest of the pen, and you then turn the pen upside down, would

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you expect the ink that had dispersed throughout the pen to remain in a continuous vein or not?—No, part of it undoubtedly would not. Only that part which might have reached the narrow sections round the nib proper probably would stay there. The others might move about—I mean I couldn't say exactly how.

And assuming that there was still some ink in that central tube 32, that is on the assumption that the cubic contents of 32 are larger than that of the space into which the ink is dispersed, if it was turned upside down, and given a shock, would you expect the ink to remain in an uninterrupted vein so as not to come out or not?—The beginning of the question—if 10 there is still ink in 32?

Yes?—Yes. No, it would come out in shock.

*His Honour* : If it was aqueous ink?—Yes. I think I always assumed it was aqueous ink we followed.

Well you said, I think, earlier that it would not work at all with viscous ink?—Yes. I assume, I hope rightly, that Mr. Menzies put to me what would happen if he filled the tube 32 with aqueous ink, and then let it run out.

*Mr. Shelley* : Supposing we deal with viscous ink, and you fill the tube 32 with viscous ink, in the same manner as my learned friend 20 Mr. Menzies suggested it, and then you put the tube 32 into the pen and let go, so that air can pass through the orifice in the gap 30, you would then expect the viscous ink to flow out and fill up all the various cavities in your fountain pen?—No, it could not do that.

Why not?—Because the air could not escape from, at any rate, the whole of the space outside the tube 9—in other words it could not escape from that part through the hole 24 and then out of the pen.

And in the result with viscous ink, would you ever have a vein of ink in the sense of a continuous vein of ink leading from the ball ever established?—No. 30

*Witness withdrew.*

Further  
Cross-  
examina-  
tion.

HANS REINHARD FEHLING—Recalled by leave and further cross-examined by Mr. Menzies.

*Mr. Menzies* : I want to hand to you a writing instrument which you will see is formed by a combination of three tubes. The first—the outer tube—is 5 or 6 millimetres in diameter?—Yes.

And it has a hollow in what I might describe as the side of it. Can you see that?—Yes.

And inside you have, as it were, welded into it, a capillary tube?—Yes. 40

Of what—2 millimetres or so, in diameter?—May be. I cannot say.

Yes. About that. And then, leading from the narrower capillary tube, you have a tube to form a writing point of very small diameter indeed?—Is this the writing point, the wire? (*Indicating.*)

Yes. That is hollow?—The wire is hollow? I see. No, I cannot see it, but I take your word for it.

Perhaps you will take one that has some ink in it. It is the same sort of thing? (*Instrument handed to witness.*)—Are you supposed to write with it like that?

You see the ink goes through?—Yes.

*Mr. Menzies (to His Honour):* Perhaps I should tender it for identification.

*His Honour:* Are the two together? Is there any difference between  
10 them?—One, or the other.

EXHIBIT.—EXHIBIT 5 for identification. Two instruments, one charged with ink.

*Mr. Menzies (to witness):* With your wide scientific experience, you are no doubt familiar with that sort of instrument?—No, I have never seen a writing instrument of that shape, I must admit, with a crooked tube—I have not.

But, of course you do not imagine it is something to be written by hand?—It is a recording instrument?

Yes?—But I have not seen this one.

20 I want to put it to you, that these are instruments that are used automatically to record, an apparatus, by tracing a line upon a graph, temperature-recording instruments, used on boilers, and that sort of thing?—Yes.

And has the study of that sort of apparatus been outside your experience?—No. I know quite a number of them, but this one I have just never seen.

If you look at that, you will agree, will you not, that you have two capillary tubes?—Yes, one tube within another—that is all I can say.

I am not referring to the outer tube, I am speaking of the interior  
30 tube of the one that forms the stylograph?—Yes.

And you will notice that when you have the larger of these two capillary tubes charged with ink, that the ink does not run out when you hold the instrument as you are at present, so that the ink is facing the open end of the larger tube?—Yes, as far as I can judge, but it is leading up to that point (*indicating*).

That is so. The column goes from the end of the small capillary round the crack up to this point? (*Indicating*)—Yes.

*Mr. Shelley:* About 1 centimetre from the bend?—Yes, that is right. One centimetre below the bend.

40 *Mr. Menzies:* And with an instrument of that sort, you have an ink reservoir consisting of a capillary tube?—Yes.

And you have that feeding a writing point?—Yes.

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tion,  
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tion,

*continued.*

And you have, by virtue of capillary action, the ink maintained in an interrupted vein from the stylographic point to the interface between the ink and the air in the large capillary tube?—That is what it looks like, yes.

And you will agree, will you not, that that particular instrument works upon exactly the same principle as you have expounded in relation to the ball-point pen?—No. The instrument does not work—the reservoir may or may not. It is a capillary if it holds that way. It relies to that extent on the same fact.

The same principle is involved?—Yes. 10

And in this particular case it is applied to an instrument which—perhaps you will take my word for it—is used for making traces upon tracing paper?—Yes.

*His Honour* : Is there anything to indicate to you the nature of the ink?—As far as I can see it is aqueous ink, or, at least let me put it this way—if it is not aqueous it could not be very viscous because otherwise I doubt whether it would go out.

Such an instrument as that has been outside your experience?—I have not seen it before, as I said.

You did say you had seen other kinds of instruments for automatic recording. Do you mean other kinds not employing capillary forces?—No, I would say this: that there are always capillary forces existent whenever you use small quantities of liquid, but in the most common case I know, they have no importance beyond the fact that the ink has somehow to be transmitted to paper, and so you rely to some extent on the blotting effect, and the shape of the most common one is an open cup with a point from which the ink is absorbed. 20

*Mr. Menzies* : I am instructed, Dr. Fehling, that in use the instrument works at an angle so that the ink in the larger capillary tube has to flow, as it were, against gravity?—Yes. 30

In the way in which I am holding it, it means that the closed end of the instrument is lower than the open end of the instrument?—Yes.

*His Honour* : What do you call the closed end of the instrument?

*Mr. Menzies* : The end opposite the stylographic point.

That is closed, is it?—The outer tube and the inner tube is open.

So that the inner tube has a vented end?—Yes.

There is some little hole in the outer closed tube?—Yes.

*Mr. Menzies (to witness)* : And you would agree that the ink, to move from the reservoir to the stylographic point, and to make a tracing, is, of necessity, obliged to go against gravity?—Yes. 40

And would you agree that you would regard that flow as being an instance of capillary action?—If the instrument works as you have asked me to assume, the flow can only be produced by capillary forces acting at the end of the tube that is in contact with the writing surface.



*His Honour* : When it is not in contact with the surface, and writing, the position that Mr. Menzies has indicated to you puts the open end of the vented tube lower than the open end of the stylographic point?—Yes.

And what then stops the ink from flowing out?—I have to assume that—I do not know the construction—but if the description is correct it relies on the meniscus at the end of the small capillary.

It would mean that the small capillary must be of so minute a diameter, and the length of the pen sufficiently short to enable that to take place?—Yes, that is correct.

10 *Mr. Menzies* : And if, at the end of the stylographic point you were to insert a ball-point, you would have the same principle as in the ball-point pen we have been considering? You could not very well put one into this small tube?—If you put a ball-point in it at the end of a larger tube, yes.

I am suggesting that you put a ball in the narrower capillary which forms the stylographic point?—May I ask how large is that opening? I think it is so small that you would have some difficulty in doing it.

20 If maintained at that size, there would be no difficulty for a man of your experience to expand the stylographic point so as to accommodate a ball?—If somebody asks me to do that, I can do it.

*His Honour* : Did I follow you, Mr. Menzies, as saying that little point is made of glass, too?

*Mr. Menzies* : I think it is a wire.

30 *His Honour* : It is a metal thing, yes. If I rightly understand the scientific evidence, Doctor, expanding the wire to a larger diameter would not matter as long as your ball clearance was such as to ensure a meniscus substantially the same as your stronger meniscus at the open end as it at present exists?—No, provided it would take an ink of low enough viscosity. I cannot give a correct answer without knowing the complete dimensions of this very fine tube, but provided the gap is maintained, and provided that tube is not too narrow to supply a sufficient quantity of ink, that is so.

*Mr. Menzies* : And you would see no difficulty at all if you wanted to accommodate a ball there, to use a tube of larger cross-sections than the one that at present forms it?—Again, if you ask me to do it, there is no difficulty in doing so.

*The witness withdrew.*

HANS REINHARD FEHLING—Recalled and warned.

40 *Mr. Menzies* : Would you take Exhibit 3 and a piece of paper (*witness did so and tested the pen*). Now I want you to perform two experiments,

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I want you to hold the piece of paper horizontal so that you are writing with the nib pointing vertical, and I want you to write until the ink is exhausted.

*(Witness did as requested.)* It is now exhausted.

*Plaintiff's  
Evidence.*

EXHIBIT.—EXHIBIT 7.—Piece of paper marked by witness with pen held vertical point upwards.

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tion,  
*continued.*

*Mr. Menzies :* I want you to hold the paper in a vertical position and write with the ball of the pen held above the horizontal.

*His Honour :* With the paper vertical ?

*Mr. Menzies :* Yes. *(Witness did as requested.)*

10

EXHIBIT.—EXHIBIT 8.—Piece of paper marked by witness with paper vertical and pen writing with point above horizontal.

*His Honour :* Can you give me an indication of how far above the horizontal it was approximately ?—I would say 3 to 4". In degrees I would say 45 degrees, not quite, let us say 35 degrees.

*Mr. Menzies :* I understood your explanation of what happens is that writing in that way you exhaust the ink which is adjacent to the ball ?—Yes, the ball in the ball cavity, the ball housing.

And when the pen ceases to write you have reached a stage where the ink is no longer in contact with the ball ?—When there is absolutely no trace at all left then you can be sure that that is the fact. 20

And as you have put it on page 220 of the notes previously :—

*"His Honour :* When you write like that and it stops, what is it that makes it stop ?—The exhaustion of the ink in the ball cavity.

*Mr. Menzies :* Could I put it this way, the ink is no longer maintained to the ball ?—Yes " ?

Yes.

*His Honour :* In between the marking of the two exhibits that you have just marked you brought the ink back into contact with the ball by bringing it to the usual position in which one writes ?—Yes, in down position and scribbling on paper would bring it back. 30

*Mr. Menzies :* I think you would explain that the ink comes back by virtue of gravity ?—Plus fairly strong capillary force in the feed capillary, both together.

I think you explained to His Honour that in place of the ink that was in the cavity in contact with the ball there was an ingress of air ?—Yes.

And therefore there was air above the ink as it were between the ink and the ball ?—Yes.

And just so that this can be clear, I think you also said that if the ink around the ball was exhausted in the way which was demonstrated and the pen was then maintained in a vertical position there was a real danger of the ink coming away from the tube altogether?—Yes.

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*His Honour* : Does that mean in a completely vertical position?—Yes.

*Plaintiff's  
Evidence.*

*Mr. Menzies* : Would it also happen if you were in something less than the vertical, say an angle of 75 degrees?—At 75 degrees it depends how full it is.

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There will be a substantial danger there of the ink coming out of the tube altogether?—No, generally if the ink column is still full.

Further  
Cross-  
examina-  
tion,  
*continued.*

If it happened when the pen was fairly new?—Yes, that is right.

What would you say was the minimum angle at which you could be confident that the ink would not leave the tube altogether in circumstances such as you have envisaged?

*His Honour* : You mean an angle from the vertical?

*Mr. Menzies* : Yes.

*Witness* : It is not so much the question of angle but the question of the level difference between the rear of the ink column and the ball, therefore as I said before experiments have shown that on the average you will not get drying up of the ball in writing and therefore falling back if there is roughly an inch below the ball, i.e., if the level difference is an inch.

*Mr. Menzies* : If you get it more than an inch there is a danger?—Yes, you will understand that is averages.

If you get anything substantially longer than an inch you expect it to fall out?—Yes.

*His Honour* : What is the average length of the full column when the pen is quite new?—There are differences, this I suppose is about 4". May I just say one thing to add to my explanation, this danger of falling back, even the danger of falling back only occurs if you write the ball housing completely dry, if however you do only just a few squiggles and it just dries out a little, what usually happens you get air into the ball housing, but the ink in the ball housing is not exhausted and therefore it reforms the meniscus round the ball.

*Mr. Menzies* : I take it that in the writing that you did on Exhibits 7 and 8 you had reached the stage where the ball was completely dry?—Yes, that is right.

*Re-examined by Mr. Phillips.*

*Mr. Phillips* : First of all I would like you to give His Honour rather a more detailed explanation of what does happen when you are writing

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in this highly vertical position, tell His Honour what does happen inside the ball housing when you are writing up to the time the pen runs dry?—Up to the time?

Yes?—In this position the ink is rolled on to the paper by the ball as it would in fact do in any position, but the ball and in fact the housing have at the same time to function as it were like a pump because the ink is no longer fed by gravity to the ball and therefore its natural tendency is if anything to feed backwards. The ball while covered with ink is capable of doing this due to the effect which was explained to Your Honour that there is a meniscus and as long as there is a meniscus that meniscus will resist the pull of the column and therefore feed a certain amount of ink, but it cannot do so indefinitely because on the re-entrant side of the ball that side of the ball where the ball re-enters the housing after the ink is wiped off the ball on to the paper, there is no film of ink and therefore there is usually the effect that air enters the housing that way. In other words the meniscus is destroyed at that side and air goes through the entry just in the same fashion as ink comes out on the opposite side. This process goes on until the whole of the ink forming the meniscus between the ball and its housing is exhausted, and therefore no trace can be any longer produced. 10

Now it is the occurrence of this situation, that is to say the complete substitution of the film of air around the ball?—The film of ink. 20

The complete substitution of a film of air round the ball for the film of ink, does that or does that not depend upon the weight of the column of ink?—Yes, it does.

Will you tell His Honour whether you reach a minimum size of column at which it will not occur at all?—Yes.

That minimum size of column at which it will not occur at all is about how long?—About an inch.

*His Honour* : That must in part depend on the bore of the tube?— No, not so much on this, Your Honour, it depends in fact more on the actual gap between the ball and its housing, because it is the strength of that meniscus and its resistance to being destroyed in the act of writing which produces the pumping effect. 30

Why I thought it must in part depend on the bore of the tube was because I had imagined that the length of the column was material because of its result in producing weight and I thought that the cross section of the tube would also have an effect in producing weight?—No, Your Honour, because the pressure or the suction, whichever way you express it have the same level, it is quite independent of the cross section, it is purely the level that matters and not the cross section. 40

*Mr. Phillips* : As I understand you you said in certain conditions the attracting force of the meniscus would be overcome by the force of gravity in the opposite direction?—I would rather say it is the action of the ball. Let me say this, if the ball would not roll the force of gravity would never overcome the attracting force of the meniscus, but when the ball rolls in you are in fact distorting the meniscus very heavily and then that meniscus is a grave handicap as it were.

Correct me if I am wrong about this, may it be described by saying that the rotation of the ball will tend to introduce air?—That is right.

*His Honour* : That goes on I gather until the meniscus between the ball and its housing is destroyed ?

*Mr. Phillips* : Perhaps it may be a little inaccurate to talk about the meniscus being destroyed. Until a complete film of air is substituted around the lower circumference of the ball.

*His Honour* : I may have misunderstood you, but I thought the witness was saying and this can be cleared up if I am wrong, that ultimately  
10 you destroy the meniscus between the ball and the housing because there is no ink left there, and you then have a meniscus at the top of the column of ink in the feed tube, is that right or wrong?—That is right, it is always a bit difficult to attribute the correct meaning to the words destroying a meniscus because as long as there is ink there will be a meniscus.

*Mr. Phillips* : When the ball has been rotating in this position the first thing that will happen I take it is that the air will be introduced on one side of the ball?—Yes.

At that stage the meniscus between the ball and the housing on the opposite side will still exist?—Yes.

20 But the meniscus on the side in which the air has been introduced will exist at some other point than between the housing and the ball?—Yes.

As the rotation continues the area of air surrounding the ball extends, does it not?—That is right.

And eventually the area of air round the ball extends right round the ball to the other side?—That is correct.

And at that point the meniscus will no longer exist between the housing and the ball but at some other point?—That is correct.

30 Can you tell us the normal pen with which you are familiar ; you begin with a meniscus in a space of approximately what size?—I put it this way, if you look on to the nib on the exposed part of the ball the circumference is approximately a little bit over 3 mm. for a 1 mm. bore, excepting this, it starts at an area which is only outside .3 to .4 mm. out of the 3 mm. circumference.

Will you please begin with the ball in a normal position on the pen with which you are familiar, the upper meniscus is then annular in shape is it not?—Yes.

And the width of the annular shape is in the order of what size?—Two to 3 microns.

40 And the surface tension we have been told is proportionate to the radius of the curve?—Yes, roughly speaking.

So the relevant measurement for determining the strength of the meniscus will be the radius of the curve extending in the area of 2 to 3 microns?—Yes indeed.

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nation,  
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nation,  
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Now when the air film has been introduced over the whole of the circumference of the ball inside the housing, understand what I mean?—The whole?

When the air film has been introduced over the whole of the inner circumference of the ball it is concealed in the housing by reason of the pen having been held in vertical position and the ball writing?—Yes.

The radius of the curve of the ink in the upper meniscus will have ceased to be related to a space of 2 or 3 microns?—Yes.

*Mr. Phillips*: Can you give us an idea what will be the width of the space in which the upper meniscus will then be situated?—Well, the stage is reached where the pen does not write at all and therefore it must be presumed that there is no ink left in the ball housing. The ink, as I said, would have receded to the top of the feed capillary and therefore the width of the meniscus would be determined by the diameter of that feed capillary. 10

And in a Biro pen, with which you are familiar, what would be the measurements?

*Objection by Mr. Menzies.*

*Mr. Phillips*: I am concerned at the moment, not with it being a Biro pen as such. 20

*His Honour*: I think you may ask the witness what is the diameter of feed capillaries in pens with which he is familiar on which he has based the answers he has already given.

*Mr. Phillips*: Let me take first of all the Biro pen with which you are familiar, are you not?—Yes.

When this process of rotation of the ball in a vertical position has resulted in the introduction of a complete film of air below the ball and the ink has then fallen to the upper portion of the feed duct, what will be the open space in which the upper meniscus then exists—in the order of what size?—The order of .5 mm. diameter. 30

With these dimensions, if the ball is maintained in a vertical position, what will happen to the ink column?

*His Honour*: After it has reached the stage you are speaking of?

*Mr. Phillips*: Yes.

*Witness*: If the length of ink column below the feed duct is too low the whole column as a whole will drop back.

And can you tell His Honour at what length column will the column begin to fall down?—As I said before, roughly an inch.

Let me put it this way. The same length of column as causes the ink to fall away from the ball will also cause the ink to fall from the meniscus constituted by the upper portion of the feed duct?—Yes, because the reasons are really the same. They are two different ways of explaining the same thing. 40

(After discussion.)

*His Honour* : It is mutually admitted that Exhibit 3 corresponds in measurements with Exhibit E and with the measurements stated in Exhibit G.

(Exhibit G handed to witness.)

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*Mr. Phillips* : You see two boundary lines indicating the length of the feed duct nearest to the ball spanning a measurement of .084 inches ?  
—Yes.

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The right-hand one of those lines comes up approximately to the point where the meniscus would be constituted when a complete film of air was introduced underneath the ball ?—Yes.

Further  
Re-exami-  
nation,  
continued.

The bore of that tube is measured here in inches as .0215 inches ?  
—Yes.

And that is, translated into millimetres ?—Just slightly over .5 mm.

Am I right in supposing you would expect, therefore, this pen to act in a way with which you are familiar with pens you have described ?  
—Yes, indeed the pen I was just using displayed the very thing I was familiar with in a typical fashion.

You have told His Honour that the meniscus normally present in a ball point housing is of the order of 2 or 3 microns, and to translate this meniscus into microns it would be how many ?—Five hundred.

*His Honour* : You mean by “ this meniscus ” the one in the feed tube ?

*Mr. Phillips* : Yes (to witness) what would be the maximum practical size of the housing space in a normal ball point pen ?—You mean only the housing for the ball, without the feed duct ?

Let me go straight to it. I mean what would be the maximum practical size of the space which you have told us is normally two or three microns ?—You mean now, volume ?

Could it exceed two or three, and if so, by how much ?—I am sorry—you said space. I think it will never, even after wear, exceed 10 microns.

*His Honour* : Will you remind me, Doctor, at some stage there was a reference to spaces in width of up to 60 microns, to what did that refer ?—(No answer.)

It cannot apply to this gap between the ball and the housing ?—No.

*Mr. Phillips* : The size of this space, 2 or 3 microns, is determined, is it not, by the size of the ball and the normal way in which the pen is used ?—Yes.

*His Honour* : Do you mean by that it varies as the pen is used ?

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*Mr. Phillips* : No Your Honour. (*To witness*) : Doctor, the pen is normally used in the human hand within the limits of angle of incidence to the paper, depending on the hand, is it not ?—Yes.

And writes with a certain portion of the spherical ball projecting from its housing, does it not ?—Yes.

And with the angle of incidence of the pen and the size of the ball, the space at the housing, will within limits be fixed by or relative to these factors, will it not ?—Yes.

So that we may take it that given a ball of an order of 1 mm. in diameter and the human hand as it is known to be, the space at the housing will be in the order of 2 or 3 microns with a new pen ?—No, I am sorry, I didn't follow your first question. The size of 2 or 3 microns is determined by the thickness of the film of ink you want to produce on the paper. 10

That will depend upon what, the size of the ball projecting out of the housing ?—No, not necessarily. The main factor is that if you produce with a viscous, non-drying ink, a film which is considerably thicker than a matter of microns, that film will never dry and therefore the writing will be smudged.

Perhaps I should have introduced that factor as well. You have a ball a certain portion of which projects out of the housing ?—Yes. 20

You have a viscous ink ?—Yes.

You have a known width of trace ?—Yes.

*His Honour* : I rather thought that the Doctor said it did not matter how far the ball projected from the housing for this purpose. Have I misunderstood that ?—No, no, the amount the ball projects from the housing has no bearing on the width between the ball and the housing which you choose to make.

*Mr. Phillips* : Except this, you must have the diameter of the ball below the housing or it would fall out ?—You mean that ? Yes, I agree from that angle there has to be an upper limit, otherwise the ball will fall out. I completely overlooked this point. It is this, since the human hand is what it is and the normal incidence of writing against a surface in any condition is also fixed, it is obvious you have to expose the ball to some extent, this extent not being very large, or you are forced to write in a position which is inconvenient. For this reason, the retaining lip is very small, very short, and therefore it follows that if the gap between the ball and its housing is too large the ball would fall out. 30

A number of constant factors determine what the size of the meniscus at this end will be ?—Yes.

Taking all those factors into account, the size will be, when new, in the order of 2 or 3 microns ?—Yes. 40

After a certain time, a certain amount of wear, towards the end of the life of the ball in the refill, it may reach to 10 microns ?—Yes.

And that is something which follows, does it not, from the very nature of the ball point instrument itself ?—Yes.

*The witness withdrew.*

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No. 20B.  
EVIDENCE of Samuel Bartak.

*In the  
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SAMUEL BARTAK—Sworn and examined :

(*To Mr. Shelley*) : My full name is Samuel Bartak, and my private address is 24 Jacka Street, West Preston, Melbourne. I am employed by Messrs. H. Taft and Company, of 261 Collins Street, Melbourne. They are retailers of various fancy goods, including pens and pencils. Among my duties with H. Taft & Company, I act as Assistant Buyer. The chief buyer is Mr. B. Taft. The financial year of my firm begins on the 1st July.

10 In the period 1st July 1949 to 30th June 1950, we bought goods from Scribal—we have bought ball-point pens and refills.

*Plaintiff's  
Evidence.*

No. 20B.  
Samuel  
Bartak.  
Examina-  
tion.

EXHIBIT.—EXHIBIT E.—Scribal Secretary box. Scribal Secretary pen.

I recognize the carton. We know it is as a Scribal Secretary Box. The pen itself is a Scribal Secretary. In the financial year from the 1st July, 1949 to the 30th June, 1950, we bought from Scribal's, pens similar to Exhibit E. In the following financial year, from the 1st July 1950 up to the 24th January 1951—in that period—we bought Scribal ball-point pens. We bought them from Scribal Pty. Ltd., and they included pens similar to Exhibit E.

20 *Cross-examined by Mr. Menzies :*

*Mr. Menzies* : Are you an expert upon the construction of pens ?—  
Yes, sir.

Cross-  
examina-  
tion.

I saw you look at the box of that pen, and at the pen itself, the exterior of the pen. Did you look at the interior ?—As a matter of fact it fell apart in my hand. The refill was the old type metal refill.

Are you in a position to say that the pens that you bought during the periods mentioned by my learned friend were in all respects of the same construction as that pen that was handed to you ?—I can, yes.

30 What examination have you made of the pen ?—I pulled off the cap, took the pen out of the case. As a matter of fact, the thread on it is not very good. The barrel came off the section, so to replace the section on the barrel I had to take the cap off, and I examined it.

Will you tell me what it is in that pen that holds the ball ?—The ball is held by the housing of the refill.

And does the ball communicate directly with the reservoir ?—That is rather a hard question to put. As far as we know it does, but we have not had a refill apart to examine it to such a great degree. We are not manufacturers of the same.

So you have never had a refill apart ?—We have had the balls out.

40 But the refill ?—We have not had the refill apart. There is nothing else we can do to dissect it. We have not got the tools to do it.

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*His Honour* : You have not dissected the refill because you have not the tools to do it?—And also there is no purpose in our job for us to do so.

*Plaintiff's  
Evidence.*

*Mr. Menzies* : So, apart from taking the refill out of the casing, and taking the balls from the refill, you know nothing about the construction of the refill?—No.

No. 20B.  
Samuel  
Bartak.  
Re-exami-  
nation.

*Re-examined by Mr. Shelley* :

*Mr. Shelley* : Will you please take Exhibit E before you again, and just dismantle the pen so that you hold the refill in your hand. Do you recognize the refill from its external appearance as similar to the refills 10 that you bought, or your firm bought, in the year beginning 1st July, 1949? I do. I recognize the refill.

Thank you. Would you put it back again.

*His Honour* : Did you observe in relation to these pens what sort of ink was in them?—The colour is blue-black.

But the kind?—The viscosity?

Yes?—It is the same ink as most ball point refills. The ball point ink itself is rather thick. It is similar, I believe, to printers' ink.

*The witness withdrew.*

*Mr. Menzies* : Seeing that my learned friend has re-opened his case, 20 may I put one or two questions to Dr. Fehling?

*His Honour* : By all means.

HANS REINHARD FEHLING—Recalled by leave and further cross-examined.

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**DEFENDANT'S EVIDENCE.**

No. 21.

**EVIDENCE of William Harold Tetley.**

Suit No. 58 of 1951.

**WILLIAM HAROLD TETLEY**—sworn and examined.

*To Mr. Gilbert* : My name is William Harold Tetley, and I reside at 30 Lot 41, Little Street, Glen Waverley, and I am a Chartered Chemist employed by Imperial Chemical Industries of Australia and New Zealand Limited. I have been so employed since 1937, and I am at present attached to the Company's Development Department at Deer Park.

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tion.

*His Honour* : Do you mind telling me what a Chartered Chemist means—you are going to get this, are you, Mr. Gilbert ?

*Mr. Gilbert* : Yes, Your Honour.

*Witness (continuing)* : I am an Associate of the Royal Australian Chemical Institute, and an Associate of the Melbourne Technical College. These are my qualifications for my description as Chartered Chemist. Since about May 1940 I have been concerned with instruments for industrial measurements and control. For some time after 1940 I was in charge of the instruments section of the Company—that was for, I would  
10 say, until about a year ago.

*His Honour* : What does that mean—that means in charge of all the instruments used by Imperial Chemical Industries in Victoria, does it ?—The position originally, Your Honour, was when the Company was smaller, my domain was over Deer Park, where the only instruments the Company had were in use. Later it extended to the Company throughout New South Wales and Victoria, and as the Company grew further, the command was divided, because the field was too big for one person, and as other people became available, the command was divided still further until we  
20 have, as we had about a year ago, a number of divisions. The instruments that were under my control were those for any industrial measurements whatsoever, be it from scientific ones for measuring say, temperature, or pressure, or the things like cardiographs for measuring heart beats.

Does the Imperial Chemical Industries Company use a thing like a cardiograph ?—No, Your Honour, but I am familiar with it through friends of mine who supply these to the medical profession. We have had a chance to get familiar with it, and see it in operation.

I would like to distinguish, if I can, between what you know, or what you deal with for the Company, and what you know through friends of yours. I thought you were describing up to the present moment the  
30 nature of the instruments that you had to deal with for the Company ?—The nature of the instruments with which I have to deal for the Company are those which would normally be covered by industrial measurement for various controls—such examples would be temperature, pressure and flow meters, automatic control devices—in general instruments which would employ methods of physical chemistry, for plant or process control ; things like viscosity and surface tensions, and all other physical variables fell to my lot. It was quite a wide scope, electrical meters also was another branch.

*Witness (continuing)* : I have just told you that amongst those instruments in my charge were instruments for recording scientific data  
40 and conditions. (*Exhibit 5 handed to witness.*) Looking at this Exhibit 5, I can tell His Honour whether or not prior to the 31st December 1943 recording instruments under my charge included as part of them a component or components similar to those two Exhibits.

*Objection by Mr. Shelley.*

*Legal Discussion.*

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*His Honour* : I will receive the evidence subject to objection, and when I see what the whole of the evidence is, then I shall know what it goes to. I will take all of this evidence subject to objection.

*Witness (continuing)* : Looking at Exhibit 5, I will tell His Honour whether or not prior to the 31st December 1943 recording instruments which were in my charge included as a component, or part of them, similar articles to those included in Exhibit 5. Similar articles to those Exhibits here were in instruments under my control prior to December 1943. They were recording instruments, particular recording instruments were on temperature or pH. 10

*His Honour* : Oh—temperature and pH recording instruments?—Yes, sir.

*Witness (continuing)* : I have said they were similar articles or components. I can now describe those articles in Exhibit 5 and indicate whether there was any difference between them and the ones I was acquainted with before the 31st December 1943. Why I said similar to those, it is possible that the instruments under my control and containing a certain writing instrument—similar writing instruments could have been manufactured in Australia, because of the war-time conditions, but we could not import them, so these are not exactly in every detail the same as the particular ones I have in mind—just a small dimension here and there—nothing to detract from their principle of operation. Just to give an exact answer, these particular ones could have been locally made, whereas the ones I am familiar with of which these would be a copy were imported. 20

*His Honour* : You seem to be saying that the ones you knew were imported, is that it?—Yes.

*Witness (continuing)* : With regard to the principle on which they operate, I can describe for the record what those instruments in Exhibit 5 consist of. I agree that there is an outside glass sheath with a hole in it. The instruments with which I am familiar consist of a small metal tube at the top which is sealed into a larger glass tube, the major portion of this larger glass tube extends down into another larger tube sealed at the bottom. At the top, almost towards the top, there is a hole about  $\frac{3}{16}$ " diameter. That is the top of the outside tube. That constitutes the writing implement, the size of the metal tube would be roughly sufficient to accommodate about a 40 standard wire gauge wire—that would be in the order of a few thousandths of an inch. I can show on Exhibit 5 what I am referring to. The little metal tube at the top has an internal diameter sufficient to accommodate about a 40 gauge wire. That is only approximate, that is not an exact answer—it would be a few thousandths of an inch, possibly 3 or 4. The small internal tube would be about  $1\frac{1}{2}$  mm. bore and the external tube would be about 6 mm. The small hole at the top here through which the ink is poured—that is in the outer tube—is about  $\frac{3}{16}$ " diameter. 30

*His Honour* : Did you say that is the hole into which the ink is poured?—That is how we used to charge them—put an eye-dropper in there and squirt the ink in, for a start.

That would be aqueous ink ?—It was an aqueous ink. I do not know the exact composition, but it was fairly fluid ink. It might have been an alcoholic ink, but it was a fairly fluid ink.

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*Witness (continuing)* : I can tell His Honour whether there was any substantial difference in construction between the details which I have just been showing on Exhibit 5 and the instruments with which I am familiar. The ones with which I am acquainted would in essence be very similar to these—in fact people looking at the two together would hardly be able to distinguish them unless they were very familiar with them.

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10 *His Honour* : Is everything you have been saying to me referable to what you saw before the end of 1943 ? Are you still answering with reference to the knowledge you had of these things before the end of 1943 ?—This is all prior to the end of 1943 ?

Examina-  
tion,  
*continued.*

Yes. Once or twice you have slipped into the present tense, and I was not sure whether you were drawing on some information you had acquired since 1943 ?—No, this is all prior to 1943, I am sorry. These would be similar in every detail. For major detail, looking at this pen, I would suggest it is more, say, home made than the ones I was used to. I say that because the hole is not quite as symmetrical as the professionally  
20 made one, different there, that way, and I think the little tube on the top is becoming bent, but otherwise the thing is identical.

*His Honour* : Can you tell me in how many different types of instruments before the end of 1943 you had seen any such pen as Exhibit 5 ?—Different types, or different makes ?

I mean types—I do not mean on how many different makes, but on how many types of instruments were they fitted—only to one particular type of instrument, or to more than one ?—There are two types of instruments which used this principle prior to 1943, the one particular maker—may I mention the makers names ?

30 I don't see why not—yes ?—Messrs. George Kent, England, they produced an instrument called the Mk. 1 Multelec, and this type of pen was used in that instrument.

What did that instrument record ?—Temperature, or pH, depending on its use. I might add that these instruments are versatile. They are what are known as recording potentiometers—that means that they record the potential development between two terminals and if you can set up a potential from any variable, you can record it—therefore they could be used for a hundred and one different variables if you so require. The other instrument which used a pen of the similar principle, not giving the same  
40 dimensions, and the crook was a little different here, at the top—that is the writing end—the recording potentiometer manufactured by Leeds & Northrup, of America, in their Model R—Micromax Model R—the writing implement in the Micromax had a few little knobs on it, which serve no function in writing, mainly to keep the graph paper in a certain direction. The principle was very similar.

Did the pens write on some sort of writing drum, or what ?—The Mark 1 Multelec, the pen if you were to consider a pianola roll, and if

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you were to insert the instrument with the tail part of it towards the back of the pianola—if you consider the drum like that (*witness indicated*) and another drum down below, paper from a spool here revolving over this drum and down, and being re-wound on to another drum. This pen remained like that (*indicating*) and motion was imparted to the pen by some mechanical mechanism inside the instrument, which made it run up and down according to the potential supply of the chart wound round this way. So that thus the ink from here was transferred to this chart, the chart being graduated, and the units which you required. That was in the case of the Multelec Mark 1. In the case of the Micromax, it was a circular 10 chart.

*Mr. Gilbert (continuing)* : When the writing instrument, Exhibit 5, is on the drum on the paper, you have just described, Mr. Tetley, would you tell His Honour in relation to the horizontal here the open end of the inside tube is—is it above or below the horizontal?—The open end of the inside tube is in that direction, so the open end would be below the stylographic point.

And at an angle of what?—Oh, about 45 deg. or something like that.

*His Honour* : You mean the main shaft of the instrument would be at 45 deg. from the vertical?—The main shaft of the instrument? 20

The main shaft of the thing you have in your left hand—the main tube?—This pen actually travelled around in a way like that—the driving mechanism, the front of the instrument, as you read it, was up and down here—so this pen, this tail portion of the point made an angle of approximately 45 deg. with the vertical front surface of the instrument, of the panel—

*Mr. Gilbert* : The sheath body of the instrument made an angle of 45 deg. with the writing point is that it?—Yes, that would be correct.

You were about to deal with the construction of the Micromax?—Yes. In the case of the Micromax Model R, it was a circular chart held 30 in a vertical plane by means of a screw on a hub. The thing rotated by means of a clock. The pen travelled on a path at from 9 o'clock to the centre of the chart through the face of the clock. It would start at 9 o'clock and go horizontally across to the centre of the chart. The pen under those circumstances, the body of it, was vertical, and this section here went out at right angles.

When you say this section here, would you describe it?—The stylographic point was at right angles to the body of the writing implement in the case of the Micromax Model R, and if this was a circular chart, which was the centre, here is the outside, it moved in that direction, across 40 the chart.

*His Honour* : So that the writing pen was at the top of the instrument?—The writing point was at the top, and horizontal, and the body of the instrument was vertically downwards.

Yes—below the writing point?—Below the writing point.

But as I followed what you said before, you put ink into the outside portion of that tube through the feed hole, is that right?—Yes, the charging of this pen originally got ink from a little eye dropper, and dropped ink into this little outside portion—that was the first step in the outside charging. It was then necessary to tilt this slightly, and the ink would then flow up the tube here to the point when you reached a certain critical angle, the capillary attraction of the ink to the small tube runs up there and came down here, that was one method I tried to work it. The other method was to shake it.

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10 Well, when you had put in your charge of ink to the outer tube, and then induced the ink to run to the point, did ink remain in the outer tube?—There was some ink in the outer tube.

Yes, and then as the instrument continued to operate until the charge was exhausted, the ink would be exhausted altogether from the outer tube, is that right?—When the pen was thoroughly discharged the ink would be out of the outer tube, and would be out of the inner tube as well.

20 Yes, but would there be a stage between complete charge and complete exhaustion when ink was retained in the inner tube only?—Oh yes. It was not our normal method to allow the ink to get too low in the outer tube; the reason for that was we liked to be completely sure that we had records on the paper—not trusting scientific phenomena, we thought that the practical expedient of having the thing always full was better than no chart in the morning, but I have seen pens which were neglected and still were writing. It was not our normal method of doing it.

Well, as I follow it, it would not make any difference to the operation of the pen whether there was ink in the outer tube or not, so long as there was still the column of ink from the point to some point in the inner tube, is that right?—You might get a fainter line.

30 Oh, yes?—I don't know what would happen when it got very near the top here—the writing point. I have not been familiar with them, but I should say that when it is about half full—

When which is half full?—I think from memory when the inner tube was a little below half full, or a little below half way up the tube, it still continued to write, but fainter.

*Mr. Gilbert*: Would you look at the other part of Exhibit 5, Mr. Tetley—that I think has ink in it, has it not, in the inner tube only?—Yes, that is right, only a little way down. It is nearly empty.

I think 1 cm. before the point?—Below the crook, yes.

40 *His Honour*: How many instruments did you actually see before the end of 1943 that had this sort of pen in them? Now, I do not mean types, but individual instruments?—Saw, or actually used and looked after?

Well, saw to begin with?—There were four out with our company. The exact number is a little difficult in the various suppliers' offices, but I would say up to about a dozen. I wouldn't be absolutely certain, although I remember that I had seen them, several of them.

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*Mr. Gilbert (contd.)* : Could you say whether or not writing instruments of the type in Exhibit 5 were standard equipment prior to 1943 on recording instruments such as you have described?—In catalogues available from George Kent Ltd. and Leeds and Northrup Com., their parts list and their catalogues described the pens which I have now endeavoured to describe as standard equipment and you could re-order them as spares for replacement parts if you so desired. You only had to quote the part number and you got such-and-such a pen.

*His Honour* : George Kent & Co. are what?—They make recording instruments. Mainly they set themselves up as flow engineers originally, 10 and have since branched out to other fields, but prior to 1943 they were making flow meters and temperature meters and pH meters.

And they are an English firm, are they?—Yes.

Leeds & Northrup are in the same line of business in America?—That is right.

*Mr. Gilbert* : Perhaps we could have it clear whether or not prior to 1943 both Micromax and Multelecs were in Australia?—Yes, prior to 1943 they were present in Australia. As a matter of fact, the Micromax originally, before the Model R were manufactured first, George Kent & Co. were able to copy it on certain understandings, and then Leeds & Northrup 20 after that came out with a new model and George Kent subsequently came out with their more recent model.

You have told us, I think, that you have seen these instruments working with ink only in the inner tube of about  $1\frac{1}{2}$  mm. diameter before 1943. Would you tell His Honour, now, speaking as before 31st December 1943, what you then knew with regard to the properties regarding the stability or otherwise of the ink in your tube in such a condition?—I was always of the opinion that if you allowed the inner tube to become partially empty, you would leave yourself open to the risk of shock causing the ink to squirt back down the inner tube and be replaced by air, therefore 30 forming a series of ink air bubbles at will up the tube and under such circumstances the pen would quite possibly cease to write.

But supposing the condition was normal and no shock or jar was administered to the instrument, what would you then expect to be the position in regard to the stability of the ink in the tube.

*Mr. Shelley* : This is all subject to my objection, Your Honour.

*His Honour* : Yes, Mr. Shelley.

*Witness* : I was familiar with the fact that the pen would continue to write though depleted of ink to some extent in the inner tube, although that knowledge was not passed on to people under my control because if 40 it had been, they might have allowed particular instruments under their care to become neglected. We insist that they keep the outside full, but we add that further string to our bow, that even if they did neglect to fill the outside tube we had a few hours' run left.



*His Honour* : What did you understand at that stage to be the principle on which the ink continued to feed up the inner tube?—The principle which I have always understood that particular pen to work on, is the surface tension at the stylographic point balances a column of liquid and balances the force of the surface tension at the bottom end of the inner tube. If I might get away from this pen and just consider a stylographic point stuck in the end of another capillary tube, I might be able to explain what I mean without confusing everybody.

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tion,  
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Assume that you had Exhibit 5 with the sheath removed?—If we  
10 add that the surface tension at the tip of the stylographic point is balanced by the head of liquid below the level of the point, and the surface tension at the lower portion of the inner capillary tube, which is the open end, those two forces are against one another. In addition to those, you have the atmosphere at either end, which you can neglect because it is equal at both ends and does not come into the argument, provided there is some atmosphere there. I will explain that in a moment. The rate at which the ink is withdrawn is governed by the size of the stylographic capillary due to Poiseuille's law, and the sum total of it is that the writing of this particular  
20 instrument is a function of the free energy of the stylographic point, the length of the stylographic tube, and the viscosity of the fluid. The free energy, I might say, is a term which embodies the area of the meniscus and the surface tension, assuming that the contact angle of the fluid is zero. The contact angle is the angle the fluid makes with the wall of the container and for substances which wet the surface the contact angle is zero, or very near to it. This is knowledge which I had of the working of the capillary tubes prior to 1943.

*His Honour* : It is possible to state the Poiseuille's law in a short and simple fashion for the Court record?—I can give you the formula, and that is : the volume of the liquid discharged through a capillary in a given  
30 period is directly proportional to the difference in pressure between each end of the capillary ; directly proportional to the fourth power of the radius of the capillary tube ; inversely proportional to the length of the capillary tube and inversely proportional to the viscosity.

*Mr. Gilbert* : On the assumption that you had the sheath removed from that interior capillary tube of the instrument in Exhibit 5 and you then had that interior capillary tube filled with ink up to the stylographic point and you held it vertical what, before 1943, was your knowledge as to what you would have expected to happen to the ink in the capillary tube under normal conditions, without any jars or shocks?—The ink would  
40 have remained from the stylographic point down to the point in the capillary tube to which it was filled when given to me.

*Cross-examined by Mr. Shelley :*

*Mr. Shelley* : Just following that, supposing you had got your stylographic pen attached to the capillary tube and you were holding it point up and then you turn it over, the ink would immediately fall out from the stylographic point, wouldn't it?—No, if I were to take the pen with the crook section bent round straight and tip it upside down? If it were on a theoretical basis there is a different answer from on a practical basis.

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tion,  
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Let us have them both. What is the theoretical answer?—In a theoretical answer, the ink will flow out at a rate governed by Poiseuille's law and at will we can make that rate of flow very very slow, and therefore practically not flowing.

That is the practical answer is it?—It combines the two. Under normal circumstances therefore the ink would not run out.

*His Honour* : I don't quite follow that. Theoretically it will come out, practically it won't?—If you consider a flow of say one drop of ink in about two years as a practical loss of ink then the ink will run out.

*Mr. Shelley (continuing to witness)* : Have you done any experiments 10  
whatever, either before 1943 or afterwards, with these instruments to find out what is the rate of flow, say if you hold the point downwards?—Not with this particular instrument.

I repeat my question—please listen to it. Have you ever done any experiment whatever, with any instrument similar to these we are talking about, either before 1943 or afterwards, to decide what the rate of flow from the stylo point was, when you held it point downwards. Answer me please, yes or no?—I cannot answer that “yes” or “no,” because it would make me tell an untruth. Similar instruments leave the subject very wide open. If you are talking about a pen, I have not done experiments with a 20  
pen like this. If you asked me that question, dealing with capillaries, smaller capillaries attached, I have, in determination of surface tensions by capillarity methods.

*His Honour (to witness)* : The answer seems to be—no, I have not done it with any instrument of that type you hold in your own hand?—Although, Your Honour, an instrument for determining surface tension is similar in principle.

And dimensions?—Well, the dimensions you can make to suit yourself, provided they were capillary size.

*Mr. Shelley (to witness)* : Is this right—that you have done experiments 30  
with dropping tubes—by which I mean a tube with a smaller diameter at the bottom, a larger diameter at the top—dropping tubes of various dimensions to determine surface tensions for various liquids? Is that right?—I have.

Now, I repeat my first question. Have you ever made any experimental determination of what the rate of flow of any of these recording instruments was, when you turned it up the other way?—Not of a recording instrument pen.

I suggest to you that, in a period of about a week, an appreciable quantity of ink, by which I mean a drop or more, might easily have escaped 40  
from the stylographic point?—I would not agree.

Your disagreement is just purely theoretical. It doesn't depend on any actual quantitative experiment, does it?—It does not depend on an experiment which I intended to carry out. My answer is given on observations which I have made, which were not intended to be experiments, and that is, that certain pens have been stored with ink only, and those

pens were not all stored in the normal writing position. And there was not, to my knowledge, any mess in the container in which they were stored. I would not say that was an experiment. It was just an observation of something I saw. Whether somebody had interfered with those pens, or done something else, I don't know.

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If you have that instrument in the form in which it was used, and you turn it point down, the ink would immediately escape from the filling orifice, would it not?—If there were ink in the outside tube, the ink would flow out.

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tion,  
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- 10 And supposing somebody suggested—let us turn this instrument into a writing instrument that you can hold in your hand, for which purpose we will dispense with the crook, we will just have the point, the stylographic point, sticking straight out at the end. Follow me so far?—Just have the stylographic end sticking out at the end.

Otherwise the instrument unaltered. All the ink in the outer tube will run straight out of the hole when you started to write, would it not?—Not all of the ink would run out.

- 20 I said the ink in the outer tube, or some of the ink, in the outer tube, would run out, would it not, provided when it got to the other end of the tube it is large enough to come out of the filling orifice?—Not necessarily. If we were to invert this pen, assuming it were filled to just below the filling orifice—were to invert it, and invert it slowly—it is quite possible that the ink would not run out because of the surface tension of the ink across the filling hole.

But you tell me the size of the hole was three-sixteenths of an inch?—That is true. The hole is about three-sixteenths of an inch, but the clearance between the horizontal plane through the hole—the position I am holding it now—and the small inner capillary tube—is quite small. It can be sufficient to support the meniscus.

- 30 But the hole is in the exterior surface of the tube?—Yes, the hole is in the exterior surface.

Therefore, the space between the inner capillary and exterior tube has nothing whatever to do with this question, has it not?—I think it has a lot to do with it. A drop of liquid would not come out unless an air bubble can get into it. I don't quite see how the air bubble is going to break through the film.

- 40 *His Honour (to witness)*: To what?—To break through the meniscus—formed over this hole. Depends entirely on how you tip the tube—upside down—if held in this way, might never come out. Have to bring the tube slightly up this way—I would say it would run out.

*Mr. Shelley (to witness)*: If bring the tube slightly up to the position, point downwards, the ink would run out?—With the qualification that you bring it up in a certain way.

*His Honour (to witness)*: Well, under some conditions it would?—Yes, Your Honour, under some conditions.

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tion,  
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*Mr. Shelley (to witness):* Mr. Tetley's answers I challenge in their entirety, but I do not propose to pursue the matter because I do not want to spend time in irrelevancies.

*The witness withdrew.*

No. 21A.

**EVIDENCE of John William McMahon.**

No. 21A.  
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William  
McMahon.  
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tion.

**JOHN WILLIAM McMAHON—Sworn and examined.**

*To Mr. Menzies:* My full name is John William McMahon and I live at 64 Molesworth Street, Kew. My occupation is an engineer. I am a member of the Royal Australian Chemical Institute, and a member of the Institute of Engineers of Australia. My present employment is with the State Electricity Commission, Victoria. I have been employed with the Commission for about 30 years. 10

*Mr. Menzies (to witness):* Prior to your employment with the Commission were you employed by the Melbourne City Council in the Electric Supply Department?—Yes.

And while you were with the Melbourne City Council, were you in charge of instruments at its electricity power station at Spencer Street?—Yes, for a portion of the time.

And during the time of your employment with the Commission, was part of your duty, I think it was in 1922, to set up an instrument testing section—a testing section?—Was that the State Electricity Commission? 20

I am asking you about the State Electricity Commission?—Yes.

And did that involve the installation of testing instruments?—Yes.

And did your work also involve the supervision for the Commission, of the installation of recording instruments at the Yallourn Power Station?—Yes.

And was that all prior to 1943?—Yes.

And those recording—what type of recording instruments were you concerned with?—Recording instruments for pressure, temperature, flow. 30

And did those instruments have, as part of them something in the nature of a pen or writing instrument?—Yes.

Would you look at Exhibit 5, and tell me whether the pens those instruments have were of a similar type to Exhibit 5? This is Exhibit 5?—Yes.

*His Honour (to witness)* : The two pieces of instrument.

*His Honour* : This, Mr. Menzies, will be received, subject to the same objection.

*(Witness)* : Yes, both these exhibits are very similar to a pen that was supplied on a Micromax recorder, somewhere about 1928.

*Mr. Menzies (to witness)* : When you speak of Micromax recorder, is that the Leeds and Northrup machine ?—Yes.

Tell me, where was that instrument installed ?—It was installed at the back of the Yallourn Power Station to control the temperature of a tip opening furnace.

And how far back does your experience go of recording instruments, with pens of a type similar to Exhibit 5 ?—I would say to—now, they were not the instruments that I am thinking of—were not made in the same manner as this, but used the same principle.

Let me get it first of all—the instruments of the same manner as Exhibit 5 ?—1928.

1928, and you say that, prior to that, you had experience of other instruments employing the same principles ?—Yes.

And how far back does your experience of those instruments go ?—1915.

*His Honour (to witness)* : What do you mean by employing the same principle ?—Well, the instrument in 1915 was a Sarco Co<sup>2</sup>, gas symboliser.

You were going to tell me how it employed the same principle ?—Well, it consisted of a small capillary tube at one end, and the reservoir consisted of a straight tube, approximately 3 millimetres in diameter, and about two inches long.

*Mr. Menzies (to witness)* : When you speak of the diameter, you are speaking of the external or— ?—No, internal diameter.

Yes, and that instrument was used for recording on a roll chart, and used an ink that was made from water, gum arabic, methyl violet dye and glycerine.

The principle of its operation ?—The principle of its operation was that the larger tube acted as a reservoir, and the small tube acted as a stylographic point.

*His Honour (to witness)* : Did you hear Mr. Tetley describing the position in which the apparatus, such as is in Exhibit 5, operated on machines of which he was talking ?—Yes.

Do you agree with his description ?—Yes.

As to those positions—well, was the position the same as in this early instrument of 1915 ?—In this instrument, the reservoir was vertical, and the stylus was set at right angles.

*Mr. Menzies (to witness)* : With the stylus at the bottom ?—Yes.

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*His Honour (to witness):* That would be a feed which was either affected or assisted by gravity?—Yes.

*Mr. Menzies (to witness):* Did you, at that time, know what was the effect of turning one of those instruments upside down when it was charged with ink?—Yes.

What was the effect?—The effect was that there was a slight tendency for the ink to come out, but not sufficient to drain the tube. In—over the period—I had experience most of the time these pens were in operation—the stylus was in contact with the paper, and under these circumstances, we had no difficulty whatever with regard to the ink 10 running from the reservoir.

*His Honour (to witness):* Are you now talking of the 1915 instrument, or the ——?—Yes.

*Mr. Menzies (to witness):* Coming to the 1928 instrument. I think you said it was of the same type as Exhibit Five?—Yes.

And will you tell His Honour, when an instrument of that sort is in use, is the stylo-graphic point above or below the open end of the interior tube, forming part of the reservoir?—It is above.

Have you any experience of an instrument of that sort operating with ink in the interior capillary tube only?—I didn't quite get that question. 20

I understand that Exhibit Five contains what might be described as two reservoirs—the reservoir contained by the outer casing, and the reservoir which is constituted by the inner capillary tube. I am asking you whether you have any experience of those instruments working when the only ink that there was, was in the inner capillary tube?—Yes.

And the instrument worked?—Yes.

*His Honour (to witness):* When are you speaking about now?—This was in the year 1928, Your Honour.

You mean, an instrument made first was in 1928, or that you saw this phenomenon in 1928?—It was on the instrument that I saw in 1928. 30

And did you observe that particular characteristic in that year, or at some later time, if so, when?—I observed it then because it was my duty to hand over instruments, over to another section to operate, and in the trials before-hand, one point was to give them some direction as to how often they should charge the pen. That is, charge the pen with ink.

*Mr. Menzies (to witness):* Since 1928, have you been familiar with instruments of this sort—Exhibit Five?—Yes.

And can you speak as to the extent of their use?—Yes. I have knowledge of three instruments. One was installed in 1939, and I saw 40 it. I saw it in use in 1941.

Where was that?—That was at the Newport Power Station, and it was used for measuring the salinity of water passing through the condensers of the generating plant.

That is one.

—Then there was another instrument of which I have knowledge, for measuring temperature, and I also have knowledge of the fact that there have been a number of applications, one which I saw—

10 *His Honour (to witness)*: Just a minute. Before you leave the other one, the one for measuring temperature. Where was it, and where did you see it?—I saw the one for measuring temperature at the laboratories of the C.S.I.R.O.

And when?—I would say that would be 1941.

*Mr. Menzies (to the witness)*: There was a third one?—And the third one obtained from Kents in 1942.

Obtained by whom?—The State Electricity Commission.

And when was it installed?—It was installed in 1945, but it was subjected to a test in 1942. It did not go into continuous operation.

And do you know whether instruments of the sort which Exhibit 5 is, are standard equipment of recording instruments?—Yes.

20 And have been for some time?—Yes.

*His Honour (to witness)*: What do you mean by “some time”?—It was standard equipment on the Micromax in 1928, and on the Multelec that is, Kent’s instrument, to my knowledge from at least 1939, and it still is standard equipment on some types of Kent instruments.

*His Honour (to witness)*: Do I gather that you saw these instruments in 1928, and then not again till 1941?—No, I saw them on numerous occasions since, but those are the dates that are apparent to me. They are some particular incidents that occurred that I am able to relate the dates.

30 *Mr. Menzies (to witness)*: The 1928, I think I am right in saying, you said you installed?—Yes, my section actually installed that instrument, and supervised the installation of it.

*His Honour (to witness)*: That is the one at Yallourn?—Yes.

*Mr. Menzies (to witness)*: Is that in the power station?—No, it was in a repair bay set up to carry out repair work at the power station. It was later removed to the power station.

Remember when that was?—Well, I would say, somewhere about 1935.

*Cross-examined by Mr. Shelley.*

40 *Mr. Shelley (to witness)*: Instruments like Exhibit 5 were always used point upwards, or point up?—To the best of my knowledge.

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And it would be quite impossible to use that pen point down, would it not, because the ink would run out of the hole in the outer sheath?— I would say that the instrument that I used in 1915 was so close in design to this, that this one could be used that way.

That was not my question. Well, perhaps it was. Have you ever seen a pen like that used point down?—Yes.

When?—1915.

But did the 1915 pen have an outside sheath?—No, it had not got an outside sheath.

Please listen. Try to follow the question. Concentrate on Exhibit 5, 10 and imagine it is intended to be used by pouring ink into the outer tube, and then tilting the pen, so that it runs up the middle tube and, as Mr. Tetley says, always keeping the pen reasonably filled. Such an instrument, I suggest to you, could not at first, be used point down. Is that right?—I would not be able to say it was right or wrong until I tried it.

Now, come to the 1915 instrument, which consisted of a three-millimetres bore, with a very fine capillary stylographic point at the bottom of it, at right angles. Is that right?—That is correct.

Is this right? So long as the stylographic point was in contact with the paper, so that the paper was continuously absorbing the trace, 20 it worked alright?—Yes.

But if the pen was held point down, not in contact with paper, there was a risk that some ink might escape from the point. Is that right?—Yes.

*Mr. Menzies* : That is all my evidence, Your Honour.

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No. 22.

**ORDER for General Directions (Ruling by Sholl, J.).**

Suit No. 58 of 1951.

*His Honour* : This is an infringement action based upon the rights said to be conferred by Australian Patent No. 133163. The defendant 30 company has raised a number of defences which may be summarised as follows : (1) Invalidity on the following grounds :—

(A) Lack of subject matter.

(B) Non-novelty.

(C) Uncertainty and ambiguity.

(D) Non compliance with various provisions of the Patents Act as alleged in paragraph 4 of the particulars of objection—

substantially on the following basis, viz. :—

After publication of the complete specification of Australian Patent No. 122073 it is said that there was a purported amendment of the complete 40



specification which had already been lodged in support of the application for No. 133163, but that the purported amendment really claimed a different invention. That step was followed, it is said, by the publication of the original complete specification lodged in support of what became No. 133163. Then, in turn, there was, it is said, a further purported amendment of the complete specification, but which in fact claimed a different invention; followed by a purported allowance of both sets of amendments and a purported acceptance by the Commissioner of the complete specification for No. 133163 as affected by both sets of amendments.

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10 All these steps, it is said, were taken without notice to the Defendant or otherwise to the public, so far as the amendments were concerned and all such steps, the Defendant alleges, were contrary to the Patents Act and *ultra vires*.

That defence which I have called 1 (*d*) is expanded further by some additional particulars in this way. It is said that both sets of amendments followed on examiners' reports made under the provisions of the Patents legislation, but went beyond the permitted scope of amendments consequent upon such reports, in that they were not confined to the points raised in those reports, but respectively described different inventions.

20 I now resume the statement in summary form of the defences which the Defendant has raised, and I come to the fifth and sixth grounds of alleged invalidity :—

(E) Fraud in obtaining the grant, because the Plaintiff was not in possession on the 31st December, 1943, the purported date of the patent, of the invention for which it purported ultimately to be granted.

30 (F) It is alleged that the application made on the 31st December 1943 was not made by the actual inventor of the invention for which Letters Patent 133163 were ultimately granted, because that invention—that is to say the invention for which the grant was ultimately made—had not in December 1943 been made.

It appears to me, though it is not possible to be sure of this upon the particulars, that what I have called defences 1 (E) and 1 (F) are really intended to state other ways of putting invalidity upon the basis of the same facts as are raised by the particulars under what I have called defence 1 (D).

That summary indicates that there are six alleged grounds of invalidity.

There are, however, three further defences which may be summarised as follows :—

40 (2) Laches, delay, and acquiescence.

(3) Non-notice to the public of the Patentee's rights. This is raised as a defence only as to the claim for damages.

(4) Denial of infringement.

There are thus really nine defences raised by the pleading—six grounds of invalidity, laches, delay and acquiescence, non-notice to the public, and non-infringement.

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By his reply the Plaintiff, in addition to joining issue, makes three allegations. First, he says that even if the two sets of amendments claimed a different invention or different inventions, the Commissioner's allowance thereof was conclusive and the matter was closed by acceptance.

Secondly, he says that even if the two sets of amendments went beyond the points raised in the examiners' reports it was not necessary to confine the amendments to those points, and that even if it was, the Commissioner's allowance was nevertheless conclusive and the matter was closed by acceptance.

Thirdly, as to the defence of non-notice of the Patentee's rights, the Plaintiff says that the Defendant knew all the relevant facts. 10

The first two matters raised in the reply go to what I have called the fourth defence, that is to say the fourth ground of invalidity.

On the 25th November last, application was made to me by the Plaintiff for an Order whereby the questions of law raised by that fourth defence and the two paragraphs of the reply which related to it might be disposed of before the trial of the other issues in the action. I then made an Order under the provisions of Order XXXIV, Rule 2, which order I am to be taken as referring to in detail at this stage, though I think it unnecessary to read it. That order was an order which gave effect to the submissions then made by Counsel for the Plaintiff. It picked up, so to speak, the fourth of the nine defences and the first two paragraphs of the reply. Those first two paragraphs denied the validity in law of that particular defence, viz., the fourth defence. The order provides for the consideration of the fourth defence and the answers made to it, as a separate point of law. It leaves untouched the remaining eight defences. 20

In connection with the question of law directed to be so argued, the facts alleged by the Defendant in the relevant particulars and further particulars of objection are to be assumed to be proved, but the documents referred to in the particulars and further particulars are to be looked at so far as they may be relevant. 30

The order was made on the ground of its tendency to save expense and time. The Defendant resisted the order, but various safeguards were inserted in it to meet Defendant's objections. The general purpose of the order I conceive to have been this. If the defence should turn out to be a good defence in law, and the necessary facts to support it were established, the remaining eight defences need not be gone into. The facts relied on to establish this particular fourth defence were said mostly to be dependent on the mere examination of documents, and that, I would imagine, will turn out to be so. On the other hand, if the defence should be held not to be a good defence, it would be unnecessary to go even into the question of fact which is raised by the putting in issue by the Plaintiff of the facts which are said to support the fourth defence, and it would then be necessary to go on to deal with the other eight defences. The Plaintiff has now changed his view as to the convenience and desirability of this course—at least I think that is a fair summary of what has been said before me on the last two of the occasions when the matter has been discussed—and the Plaintiff clearly would now like the whole of the issues 40

dealt with at one trial. But the Defendant has also changed its view, or, as its Counsel prefers to put it, considers that the safeguards inserted in the order of November last meet its former objections.

One, of course, must regard anything which means further delay for the Defendant, with circumspection, but as I have said previously, I think the Defendant acquired a right to have this order carried out while it stands, and it may well, as Mr. Gilbert said, have shaped its arrangements on the faith of the order so standing.

10 Yesterday Mr. Phillips submitted that the course now to be taken should be this, viz., that the point of law should be argued first, and then—whichever way it was decided—the question of fact in relation to that fourth defence should also be determined. Whatever the result of that course, he said, the Court should then further go on to try the issues raised by the other defences. He argued various grounds for that view, mainly the ground of inconvenience, the consideration that if an appeal were taken by one or the other party in various contingencies, the splitting up of the trial might result in delay and further expense, and, finally, the applicability of the evidence relating to the fourth defence to some or all of the other defences.

20 Mr. Gilbert on the other hand argued that the point of law should be heard first, and if necessary—and only if necessary—the issue of fact relating to that defence should be decided. Further, he said, the Court should deal with the issues raised by the other defences only if that should become necessary.

I have considered since yesterday what I ought to do in these circumstances, and I think I should proceed on the basis of disregarding, first of all, the possibilities of appeals by the parties to any greater extent than I have already indicated I would do in the reasons which I gave for the Order made in November.

30 The second consideration which I think I should allow to guide me is this, that I ought to dispose of this action in the most expeditious and least expensive way that the law and the facts may turn out to require.

I think I must proceed on the basis that the Order made in November stands. The parties have not got rid of it by consent or by appeal, and I think I must therefore shape a course which will have regard to the existence of that Order and to the other two considerations which I have mentioned.

40 I think, therefore, I should proceed in this way. First, the Court should hear argument as to the point of law raised by the Order of 25th November. So much, indeed, is common ground, and I accordingly fix Monday the 1st of June for the argument of that point of law. Having heard argument on that matter, I shall deliver my decision as soon as possible, although, of course, I give no undertaking that it will be an unreserved decision or even that it will be an oral decision. I shall, however, deal with the matter having regard to the fact that I have been told that English Counsel will be coming here for the argument and that other parties may come from overseas for the same purpose. In the second place, if I decide that the fourth defence would be a good defence, I shall proceed forthwith with so much of the trial as is necessary to determine whether the assumed basis of fact is established; that is to say,

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whether the basis of fact alleged by the Defendant for the purpose of supporting that fourth defence is established. If, upon proceeding to the hearing of that matter, that basis of fact is established, that will be the end of the action and there will be judgment for the Defendant. If it is not established, then I shall proceed, after an adjournment, with the trial of the issues raised by the other defences. I shall hear argument then as to the length of adjournment required, although my present view is, that as the parties have considerable notice of the hearing, no more than an adjournment for a week or ten days ought to be requisite.

So far, I have indicated the course to be taken if it is held that the 10  
fourth defence would be a good defence in law provided the necessary facts were established.

Thirdly, if I hold that the fourth defence would not be a good defence in law, I shall decline, except by consent, to go on to make any finding as to the assumed facts upon which that defence is based, and I shall proceed, after an adjournment such as I have already referred to, with the trial of the issues raised by the other defences.

It may be that if I have to determine the issues of facts relating to the fourth defence there will, as Mr. Phillips says, have to be some evidence 20  
given which would be relevant to the other defences also, but I have no means of determining in advance how much of that evidence will be so relevant. Notwithstanding that consideration, therefore, I think the course I have outlined is the best course to adopt so far as I can form a proper judgment on the materials before me now.

A formal order to the effect I have indicated can be drawn up from the reasons which I have given this morning—an order outlining the steps described.

The costs of this summons, I think, ought to be costs in the cause. I will certify for Counsel, including senior Counsel for the Plaintiff.

There is one other matter I ought to mention. I was asked yesterday 30  
to fix the 1st of June also for the trial of an action, No. 314 of 1947, between the same parties in relation to a different patent. I need not refer in detail to the reasons with which I was provided for taking that course. The parties appear to be in agreement and it is proper to fix that case for trial concurrently with the hearing of the point of law in action No. 58 of 1951, and accordingly there will be an order to that effect. That will be a separate Chamber Order in action 314 of 1947. I make no separate order as to the costs in that case.

That, I think, disposes of all the matters raised by this Summons, 40  
or otherwise.

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## No. 23.

## Allowing Amendment of Pleadings (Ruling of Sholl, J.).

Suit No. 58 of 1951.

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*His Honour*: It now becomes necessary for me to state my ruling upon various matters which have been debated by way of preliminary discussion. The first matter to which I shall refer is the question of the right to begin upon the argument of the question of law set down in accordance with my Order of 25th November last. In my opinion, the party alleging the pleading as delivered is bad in law has the onus of sustaining that contention, and therefore should begin. As the Plaintiff by his reply is here alleging that the Defendant's pleading is a bad pleading, I think it is in accordance with the established practice to hold that the Plaintiff on the argument of the question of law should have the right to begin. There are a number of authorities to that effect and I have recently so held myself in the matter of *Edwards v. Joyce*.

The next matter to which I need refer is the matter of two applications by Mr. Menzies for the Defendant, to amend his particulars of objections dated 19th July 1951. As a result of the discussion which has taken place today, I propose to allow the two sets of amendments. The first set of amendments will consist of amendments to sub-paragraphs iv and vi of paragraph 4 of the particulars of objections. Mr. Menzies will have leave to amend those paragraphs to add words substantially to this effect "and so that the invention became the same as the invention described in paragraph iii above." Or it may be that he will prefer to say, "in paragraphs i and iii above." The effect of that amendment will be to raise expressly what Mr. Menzies says it was intended by implication to raise as the particulars formerly stood. The question so raised will, I think, be a question which was probably not within the Order of 25th November last prior to the opening of this discussion today, viz., the question whether the powers of the Commissioner by way of amendment under Part IV, Division 1 of the Patents Act include the power to allow an amendment which produces in the amended specification an identity with the description of an invention contained in an application made for another patent at an earlier date, the complete specification of which had been published at the date of the allowance of the amendment. The question of law as it stood earlier raised, I think, the question *ultra vires* in relation to the Commissioner only in respect of an allowance of an amendment which had the effect of permitting the complete specification to describe something which was different from the invention described and claimed in the complete specification previously lodged, different from—or perhaps I should say substantially different from—the invention previously described. But as a result of the discussion which has taken place, it has become clear that the Defendant entertained the notion that paragraphs i and iii when read in conjunction with the reference to documents in the Order of 25th November 1952, would enable it to raise what I have said is to my mind a different question. The result of the amendment will be that the further question which arises upon the same set of legislative provisions will now fall to be determined upon the hypothesis of the admission of the additional allegations to be made by amendment in

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paragraphs iv and vi. There will, of course, be liberty to the Plaintiff to amend his reply as he may be advised in the light of this amendment of the further particulars.

The second set of amendments stands upon a somewhat different footing. Mr. Menzies has now sought to amend the particulars under paragraph 4 of the particulars of objections by adding three additional paragraphs, which I shall state so that they may be recorded. They are in these terms: “(iii a) The unamended complete specification of U.K. Letters Patent No. 573747 dated the 21st day of February 1944 became available for public inspection in the Patents Office, Canberra, on the 29th day of May 1946; (iv a) The amended complete specification referred to in sub-paragraph (iv) hereof described and claimed the invention described and claimed in the document referred to in sub-paragraph (iii a) hereof; (vii a) the complete specification referred to in sub-paragraph (vii) hereof described and claimed the invention described and claimed in the document referred to in sub-paragraph (iii a) hereof.” The effect of those amendments would be to enable the Defendant to rely upon an additional allegation in connection with the same point as is raised by the first set of amendments, an allegation which I may summarise as an allegation of *ultra vires* by reason of non-novelty springing from the publication of the U.K. Patent referred to. I have had considerable hesitation as to whether I ought to allow that amendment but that hesitation has been removed by the fact that the Plaintiff’s advisers have stated that they have no objection to the amendments now being allowed, subject of course to the reservation by the court of the power to deal with the question of costs as it may be affected by the ultimate determination of the case, and subject also of course to the reservation of liberty to the Plaintiff to amend his reply as he may be advised. The reason I had hesitated was that it seemed to me that the Defendant in this case had been guilty of very great delay. The Writ is now over two years old, the particulars which it is sought to amend were delivered nearly two years ago, and the particular specification of the U.K. Patent which is now sought to be relied on in a different connection was raised in connection with the general defence of non-novelty on 7th February 1952. Mr. Menzies, however, has said that the omission was due to an oversight on the part of the Defendant’s advisers and, having regard to what I have said as to the Plaintiff’s attitude, I need say no more about the matter than that the amendments will be allowed. All questions of costs in relation to the amendments will be reserved. The Plaintiff will again have liberty to amend his reply as he may be advised and there will be a direction that the Defendant amend the further particulars on the Court file and deliver amended further particulars to the Plaintiff’s solicitors by ten o’clock next Friday morning.

There is one further matter which has been debated before me today and that is the question of the extent to which, if at all, the various documents referred to in the particulars and further particulars of objections may be referred to upon the argument of the question of law ordered by my Order of 25th November to be now argued. It is obvious of course that the content of that question has been enlarged by the permitting of the amendments with which I have been dealing, in so far as there will arise for discussion the question of the Commissioner’s powers not only in relation to an amendment which substantially alters the nature of the

patent described but in relation also to his powers to grant an amendment notwithstanding the identity of the invention described by the amendments with another specification previously lodged in the Australian Office and published, or with a U.K. specification previously lodged on the shelves of the Patents Office at Canberra. The widening of the content of the question of law set down, however, does not, in my opinion, mean that there will be any necessity to refer to the contents of the various documents described in the amended further particulars. As I understand the effect of the order, it is this, that there is to be debated on the hypothesis of assumed facts the question whether the powers of the Commissioner extend to the acceptance and allowance of the amendments referred to in the further particulars. Having regard to the amendments which have now been allowed, the effect and character of the amendments are described in the particulars. Those allegations are, I think, allegations of fact and they are, according to the Order of November, to be taken to be admitted for the purpose of the legal argument. Mr. Menzies' desire to refer to certain of the documents for the purpose of establishing by comparison facts for consideration in connection with the legal question or questions, was understandable, but I think the form in which the amendments have now been couched makes any reference to the detailed context of the documents unnecessary. That is, I think, very desirable because otherwise the court should be placed in the position of having to determine issues of fact in the midst of the consideration of a question of law which it was intended to decide upon the basis of an assumed set of facts. What I have said will, I trust, enable the parties now to frame their argument as to the questions of law which will arise upon the amended pleadings.

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No. 24.

**As to Right to Begin and as to Evidence (Ruling of Sholl, J.).**

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30 *His Honour* : It now becomes necessary to rule upon two questions which have been raised with respect to the course of the proceedings in that stage which is about to commence. Those two questions are respectively the right to begin, and the nature of technical evidence which may be admitted as relevant. I propose to deal with the questions in that order. First of all, with regard to the right to begin, it must be admitted that according to the ordinary course of civil procedure a defendant would begin if the only issue to be determined involved the establishment by him of facts which he had alleged and which were necessary to sustain his defence. It does not, of course, in an ordinary civil proceeding, at all necessarily follow that the plaintiff begins—that matter is a matter to be determined according to the state of the pleadings. That this was also the position in revocation proceedings in the middle of the 19th century is apparent from a passage from Hindmarsh on Patents at page 412. That work was written in 1846 and it is there stated that

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where a prosecutor was attacking a patent by way of *scire facias* it was for the prosecutor to begin and to establish the objections which he had taken to the validity of the patent. In infringement actions on the other hand, as appears from a passage in the work of the same learned author at page 293, the patentee usually began because there usually lay on him the onus of proof of some matters, that onus being cast upon him by the defendant's usual plea of not guilty. Hence arose a practice whereby the defendant in an infringement action sometimes had recourse to a *scire facias* in order that he might thereby challenge the validity of the patent and obtain the right to begin. Thus, if there were infringement proceedings, the patentee would normally begin; if there were *scire facias* proceedings, the person attacking the patent would normally begin. The time available to me has not permitted, since this question was discussed this morning, of an investigation sufficient to disclose just what was thought undesirable about the continuance of such a state of affairs, but the fact is that the position was altered by Section 41 of the Patents Act of 1852, which was continued in Section 26 of the Act of 1883 and is now to be found in Section 86 of the Commonwealth Patents Act. According to Section 41 of the Act of 1852, it was thereafter for the defendant, that is to say the patentee, in *scire facias* proceedings to begin, and that has ever since remained the position in *scire facias* proceedings until 1883 and in revocation proceedings since that time. Whether it was found that there was some racing for trial analogous to what used to be called racing for the grant, and which led to the second proviso to Section 69 of the Commonwealth Patents Act I do not know, or whether it was found by experience that it was better in revocation proceedings to let the patentee begin by explaining his alleged monopoly and the state of the art at the time he obtained his patent, likewise I do not know. One may speculate as to the cause of the change but the fact is that for over 100 years the practice of the courts in patent litigation has been such that, as I think Mr. Shelley rightly said this morning, it is a most unusual thing when a patent is attacked to find a case where the patentee does not begin. There are certain differences, of course, between the position of a patentee who begins in revocation proceedings and the position of an ordinary plaintiff, as is explained in Edmunds on Patents 1897, pages 607 and 610. It is further the case that a patentee may waive the right to begin in a revocation case, as is pointed out by Fletcher Moulton on Patents page 215. But what ultimately weighs with me here is this, that if this were a revocation petition on the ground and on the ground only which I have now held to constitute a good defence if established in fact, undoubtedly the patentee would have the right to begin—that right would be given to him by statute, and I am of opinion that if the same defence and the same defence only were taken in an infringement action, the court would in its discretion, on the analogy of the position which would obtain in a revocation proceeding, accord the patentee the right to begin in a similar way. I do not think I ought to make a different order in this case merely because the present point arises as a separate issue of fact tried before the rest of the issues arising on these pleadings. The stage of the proceedings which is now about to begin is still, it seems to me, part of an attack on the validity of the patent, and the fact that it happens to be made, so to speak, as an isolated incident before the trial of all the other issues raised in the case is not, in my opinion, sufficient



to induce the court to alter what would, as I understand the law and the practice of the court, be the position if the same question arose as the sole question for determination in an ordinary infringement or revocation proceeding. Accordingly, in my opinion, the plaintiff should begin. That right will normally give a plaintiff a right of reply, but the matter, of course, is in my discretion. If I think, after becoming more familiar with the issues which are now about to be presented to me, that such a course will involve any possible prejudice to the Defendant, I shall be prepared to consider granting to the Defendant's counsel an opportunity for adding comment, within reasonable limits, after I have heard the nature of the Plaintiff's reply. The second question relates to the limits of technical evidence. It is true, as Mr. Menzies says, that there is here involved in essence merely a comparison between two or it may be three documents, but the question ultimately to be decided upon that comparison is whether there was disclosure to the public through the Crown by the original document of what is claimed as an invention in the ultimate document. A patentee speaks to the initiated and informed and not to the multitude. It is necessary therefore, in order to know what he has said to the initiated and informed, to know what was the then state of knowledge with respect to the matter to which the alleged patent relates, in other words, to know what was the state of the art and what the patentee's words would then convey to one skilled in the art. That does not mean, of course, that an expert witness may be called expressly to say that the initial document did disclose to him what appears as the invention claimed in the ultimate document, seeing that that is essentially a question for the Court itself to determine, and it is not for expert witnesses to substitute their opinion for the judgment of the Court. But subject to that limit it seems to me that evidence which fairly goes to show what was the state of the art at the date of the initial document, and it may be at the date of the ultimate document, is admissible with a view to informing the mind of the Court so that it may understand the words which the patentee then spoke with the mind of a person—so far as that can be achieved by Court procedure—to whom the patentee was then intending to speak. What I have said amounts to no more than a general ruling, it is all that I can properly give at this stage of the matter, and I shall rule further on any specific matters that may be objected to as occasion arises.

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No. 25.

**Rejecting Tender of Examiners' Reports and Communications from Patent Office to Applicant—Exhibits 2 and 6 (Ruling of Sholl, J.).**

Suit No. 58 of 1951

*His Honour* : Mr. Menzies has applied to me to admit two different sets of documents, the Examiners' Reports which are referred to in his Particulars of Objections, and the communications from the Patent Office to the applicant which conveyed to the applicant the general effect

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of those reports and which led, or which are supposed to have led, to the various amendments or proposed amendments that now form part of Exhibit 2, subject to objection. Mr. Menzies has urged two grounds for the admission of the Examiners' Reports. The first is that he desires formally to tender them in order that he may hereafter again attack any Judgment which may be pronounced in the current proceedings on the basis that the amendments actually made by the applicant were not responsive to those reports. I have already held, in a Judgment which I delivered on Monday, that non-responsiveness in that sense is not a separate ground upon which validity of the ultimate grant may be attacked, and accordingly I reject the tendering of the reports upon the first ground suggested. 10

The second ground upon which Counsel tenders these documents is this, he says that although he has a formal admission made this morning that the amendments to the original complete specification were from time to time made or purported to be made under Section 45 in response to a communication from the Patent Office that adverse reports had been made by examiners, he is not bound to accept that admission and he desires to have the reports themselves in order to establish as a fact that the amendments ultimately made, and I think he says, the amendments from time to time made between the filing of the original complete specification and ultimate acceptance, were amendments made in the way described. In my opinion I should not admit these reports merely to supplement what appears to me to be a complete admission, so far as it is a relevant matter, of what Mr. Menzies wants to establish. After all, it is the fact that there was a report which had an adverse character, and the fact that that report led to the making of the particular amendments now sought to be challenged, which is alone material. The precise contents of the report need not be investigated except to show adverse character in the sense used in the section. That adverse character is admitted and it seems to me therefore that to examine the words in order again to establish the adverse character is something which is quite unnecessary and which I ought not to permit. Accordingly I reject the tender of the examiners' report. I do not receive them as I have received certain other documents, subject to objection, because I am unable to see how further argument would be likely to establish, or might be likely to establish their materiality. With regard to the communications from the Patent Office to the applicant, Mr. Menzies has relied in the first place upon the decision of Mr. Justice Clauson in *British Celanese v. Courtaulds*, in 50 Reports of Patent Cases 63, and particularly on the passage at page 82. As I followed that case, it was held by His Lordship that for the purposes of considering the question of lack of subject matter, that is to say, lack of inventive step, it is admissible to have produced the Patent Office file in order to look at the form in which the original application and the original complete specification were ultimately framed, and in order to consider the amendments which were from time to time proffered by the patentee. Indeed His Lordship seems further to have thought that it might possibly be material in considering subject matter to have regard to citations of prior patents drawn to the attention of the applicant by the examiners from time to time during the progress of the applications through the office. As I understand the decision, it was given upon the basis that those matters might be investigated in order to see whether in the result they afforded 30 40 50

evidence of some kind of admission by the applicant that what he was saying in court was the inventive step constituting subject matter was not what he had previously thought to be the inventive step. It may be that at a subsequent stage of this case I shall have to investigate subject matter, and that these communications will become material, or at all events, may be material on that investigation, but I do not understand Mr. Justice Clauson to have made any decision as to the relevance of communications between the applicant and the Patent Office for the same purposes as they are now tendered here. Mr. Menzies seeks to tender

10 them because he wants to show, as he says, that the applicant from time to time was told what the examiners' objections to his complete specification were, and that the applicant thereupon, in order to meet those objections, submitted amendments which resulted in the complete specification as ultimately accepted falling outside what I said in my judgment on Monday were, in my opinion, the permitted boundaries of amendment under Section 45. In my opinion the comparison must be between what the applicant said in his original specification and what he said in the specification in the form in which it was finally accepted. I can see that if he were in the witness box, questions as to what he was told by examiners

20 or rather as a result of examiners' reports and what he then said as a result of that information, might be put to his credit. That might perhaps be put to him, if it was suggested that he used some ambiguous expression in some amendment and that he meant it in one sense and now claimed that it was used in another sense. But apart from some such cross-examination as that I am not able to see how communications from the Patent Office to the applicant which he may have sought to deal with by various amendments, assist in considering the language which he ultimately used. After all, the language he ultimately used is there to be read by the public or at all events by so much of the public as is thereafter interested

30 in the trade to which the invention relates. Persons so addressed by a patentee have no knowledge of what the Patent Office told him of an examiner's objection. Neither the public nor the court, when ultimately construing the complete specification in its final form refers in any way to communications which may have taken place between the patentee and the applicant, and the question must be what the language means to a person in the position of the Court or the public, when the final specification is ultimately read by it or them. I think the communications are not admissible for the purpose suggested and that I ought to reject them. It appeared in the course of Mr. Menzies' submission on this matter that he

40 desired to put the view that it would be sufficient to constitute a good defence if he ultimately succeeded in showing that the invention claimed in the final form of the specification was not something which the applicant originally characterised by the term invention in the complete specification as originally filed. In the decision which I delivered on Monday, I limited the availability of the allegations in the particulars as a defence to the case where the invention ultimately claimed was, not, to use the words which I then employed, described and disclosed in the original. I had not then in mind, I think, the possible case of so great a disparity between documents as might arise in a case where the invention ultimately claimed was in no

50 way in the original document suggested as an invention at all, but I am disposed at the moment to think that the language which I used would cover even that case, that is to say, would cover that case in the sense

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that it would be a case of permissible amendment. Even, however, if my language does not go that far or even if it may be proper to introduce some qualification with regard to so extreme a case as that, I still do not see how what Mr. Menzies now wants to tender could help to make the case he wants to make. He has the form of the original complete specification in evidence without objection, and an examination of that document will disclose what the patentee then thought was an invention; examination of the final document would show what he then said was inventive and claimed was inventive, and I am unable, notwithstanding the careful argument of Mr. Menzies, to see how a comparison between those documents will really be assisted by bringing in communications between the applicant and the Patent Office, in the interval. For those reasons the documents sought to be tendered will be rejected. 10

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No. 26.  
**Admitting Exhibits 2 and 6 Subject to Objection (Ruling of Sholl, J.).**

Suit No. 58 of 1951.

*His Honour*: Mr. Menzies, in the course of his opening, has been dealing with the question of subject matter and has said that the Defendant proposes to produce evidence with a view to showing that the patentee's assignor had not achieved an inventive step by what is set out and claimed in the final complete specification No. 133163. For that purpose he seeks to tender in evidence and he has invited me now to deal with the question of his right to tender in evidence two classes of documents, first the various amending documents which were marked as Exhibit 2 at an earlier stage of these proceedings, subject to objection, and secondly the communications from the Patent Office to the patentee which gave rise to the various proposals for amendment and which I rejected at that earlier stage. Mr. Menzies relies upon the decision of Mr. Justice Clauson, to which I have already made some reference, in *British Celanese v. Courtaulds*, 50 R.P.C., and particularly at pages 82 and 83. Mr. Justice Clauson seems to me to have admitted there the various amendments which were from time to time made in the complete specification on the basis, as I have said before in this case, that they could be looked at to see whether in some way they might be found to constitute admissions by the patentee that what he had at one time considered to be the inventive step, he now stated not to be, and that what he now claimed to be the inventive step he had at one time not thought to be inventive. I think that on the authority of Mr. Justice Clauson's decision, which if I may respectfully say so seems to me to be plainly right, I ought to admit in evidence, subject to objection at least, the amending documents which formerly constituted Exhibit 2 subject to objection. I say that I ought to admit them at least subject to objection because it will be a matter for argument how far those documents did or did not constitute any such admission as is alleged by the Defendant and it may be that upon examination of them and after 20 30 40

hearing argument about them I shall ultimately come to the conclusion that they do not constitute any such admission or establish or tend to establish absence of inventive step. Accordingly, those documents will be admitted subject to objection and it will be convenient if I mark them with the same exhibit number as they bore earlier, that is, Exhibit 2 subject to objection.

The question of the communications from the Patents Office to the patentee in relation to those amendments raises, I think, some different considerations. I have rejected them in another connection but the matter now arises in quite a different way. Mr. Justice Clauson admitted in the *Celanese* case a certificate of citations by the British Patents Office drawing the attention of the patentee in that case to certain earlier specifications. He admitted the documents there in a fashion which seems to me to have been very much the same as admitting them subject to objection—he admitted them on the basis that they might be relevant, that they might be found to be relevant to the question of inventive step. He said at page 83, line 39, that the certificate would be evidence of one thing only, namely, that the specifications mentioned in it were drawn to the Plaintiff's attention during the period then in question, and that period was identical with the period which is here in question, namely the period between the lodging of the initial complete and the acceptance of the final complete. His Lordship added "the fact that the examiner thought something about them, that is to say about the previous specifications cited, or had some views as regards the relation of these specifications to the proposed inventions would of course be wholly and entirely immaterial, and I am sure that no attempt would be made, and if it is made it will certainly fail to use the certificate as evidence of anything of that kind." Now I understand His Lordship as meaning in that passage that the mere fact of the examiner's opinion was not evidence of anything, and if I may respectfully say so, one must entirely agree with that view, but the precise point which is raised here, I think, in relation to these communications was not clearly raised or decided by His Lordship. I gather that it is sought to use these communications from the Patents Office not merely to indicate that certain prior specifications, or it may be prior applications, were drawn to the mind of the patentee pending acceptance, but also that the examiner formed certain views about novelty, or it may be about other objections under Section 41, and that the patentee's subsequent actions, so far as those actions consisted of tendering amendments, should be examined in the light of those communications in order to find whether those subsequent actions of the patentee amounted or did not amount, to the suggested admission that there was no inventive step. Now that precise point does not seem to have been precisely raised at all in the English case, as I have already said. It really seems to involve the question whether the actions of the patentee in tendering the amendments can be investigated or examined in the light of the circumstances which led up to those actions; in other words whether in order to find what it was the patentee was doing—or as I should prefer to put it—what it was the patentee thought he was doing by tendering these amendments, one may look at what had been the motivating circumstances. Now it seems to me that that kind of evidence stands on the same footing as stood the examiner's citations in the *Celanese* case, that is to say, the citations must have been admitted by Mr. Justice Clauson because he considered that it might

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be that reference to those citations would indicate something with regard to the amendments tendered, and that the conduct of the patentee in tendering the amendments which he did tender was in some way explained or its interpretation was in some way affected by evidence of the particular circumstances which had led to that action. It may be, of course, that these communications will, when examined, show no such thing. It may be that they will show nothing more than do the amendments themselves, if the amendments show anything of the nature suggested by Mr. Menzies. But I think that the principle upon which His Lordship must have acted in the *British Celanese* case is applicable to and should guide me in the ruling which I have to give with relation to the tendered documents. Accordingly, it seems to me that I ought to admit these documents in the same way, that is to say, I ought to admit them subject to objection in order that by examination of their contents and by hearing argument about them, I may ultimately be in a position to say whether those documents considered with the amendments, do or do not establish any admission or concession by the patentee as to what he from time to time thought or did not think to be his inventive step. Of course, it follows from what I have said that, as Mr. Justice Clauson held, any opinions expressed in the communications are not evidence of the accuracy of the opinions or the soundness of the opinions which may be therein stated or referred to ; the documents are no more than circumstances in the light of which the patentee's conduct is to be examined. For those reasons it seems to me that I ought to admit these documents on the basis stated and they will form an exhibit subject to objection. I should add, that I am admitting them only in so far as they are documents which are documents communicated to the patentee and leading to or bearing upon the making of the amendments.

EXHIBIT 6.—Subject to objection.—6 Communications from Patents Office as follow :—

Letter 19th October 1945 from Patents Office to Patent Attorney.	
Letter 2nd December 1946	do.
Letter 26th August 1947	do.
Letter 11th March 1948	do.
Letter 24th December 1948	do.
Letter 27th April 1949	do.

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## Refusing to Accept Plea of False Suggestion on Pleadings as Drawn (Ruling of Sholl, J.).

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*His Honour* : Mr. Menzies has, in the course of his opening, sought to open evidence, or at all events sought to rely on a contention to the effect that the patent in suit is void as having been obtained upon a false suggestion. Mr. Menzies seeks to support that point by reference in part at least to the evidence of Dr. Fehling, and if the point was open to him, I gather he might seek also to lead further evidence himself, but whether that be so or not is immaterial. Dr. Fehling said, as I recall his evidence, that in the Defendant's pen, as indeed in all ball point pens relying upon this capillary principle, there may be produced, by holding the pen and writing with the nib above the opposite end, a state of affairs where the ink recedes from the ball and there is no longer a continuous vein of ink leading to the ball. He further said that in such a case if a pen was replaced in the pocket with the nib to the top, while the break in the continuity of the ink vein persisted there was a substantial risk of the ink leaking out the opposite end of the tube. He pointed out that there were circumstances under which that would not follow, but I need not go into the details of his evidence, at this stage. Mr. Menzies seeks to rely on that evidence in two ways. First of all he says that that is evidence of non-infringement because the first claim of the patent in suit claims an apparatus in which the ink vein is maintained to the ball, and he says that if the Defendant's pen so operates that in some circumstances that characteristic cannot be predicated of it, then it is not an infringing pen. No one disputes, I think, that that argument is open to him under the general plan whereby he denies infringement. But he seeks also to rely on that evidence as showing that the statements in the complete specification, column 2, line 1, and column 5, in claim 1, to the effect that in the patented pen a continuous liquid vein is maintained extending from the ball, are false. That, he says, amounts to an assertion in the patent that the liquid vein is maintained under all circumstances of reasonably possible use. He says that Dr. Fehling's evidence shows that that is not an accurate statement and therefore in accordance with the authorities to which reference is made in Terrell on Patents, 8th Edition, at page 109, the patent was obtained upon a false suggestion. The principle is well known and is exemplified by the decision of the Privy Council in *Kraft v. McAnulty* in 48, Reports of Patent Cases 536—the well-known *Kraft Cheese* case. In my opinion that defence is not open to the Defendant upon the Particulars of Objections as they stand. The only paragraph which it is suggested could cover such a ground is paragraph 5 with which I have already dealt at some length in so far as it is sought thereunder to rely upon the matters alleged in paragraph 4. It is now said that that paragraph is apt also to cover the suggested objection of false suggestion. In my opinion it would be a pernicious innovation in the practice of the Court as it applies to patent litigation if I were to allow the Defendant to rely upon such a defence under such a plea as this. The patentee in my opinion is not given fair and reasonable notice by such a paragraph as this is, of any such objection to the validity of his patent. As I read the paragraph

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it asserts invalidity by reason of false suggestion but further asserts that the false suggestion resulted from the fact that the Plaintiff on a particular date, namely, the 31st December 1943, was not in possession of the invention the subject-matter of the ultimate grant. That seems to me to amount to a plea that there is significance in the date, and to a plea of no more than that. In other words, the plea seems to me to concede that the Plaintiff may thereafter have obtained possession of the invention the subject-matter of the grant, and that that invention may thereafter have been a good invention. The point that the plea is devoted to making as I understand it is that it was not until some time after the 31st December 1943 that the Plaintiff obtained possession of the relevant invention. I think as a matter of mere grammar it might be possible to say that the plea on which Mr. Menzies wants to rely could conceivably be expressed in some such words as are here found, but when paragraph 5 is read with paragraph 4, its primary purpose is clearly seen to be to put in another way the point that paragraph 4 is devoted to making. I cannot leave out of account, as I pointed out during the argument, that the plea would never have conveyed to me that it was intended to rely upon the point now raised, nor can I leave out of account that it was not so construed by the Plaintiff, and that no evidence was led by the Plaintiff in relation to any such attack upon the patent. If the point is to be raised, I think it must be raised by some other plea than this. For those reasons, I think that the suggested defence is not pleaded and is not open.

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No. 28.

**REASONS FOR JUDGMENT of Sholl, J., on Question of Law.**

**MARTIN v. SCRIBAL PTY. LTD.**

Action No. 58 of 1951.

This is a question of law arising on the pleadings and set down for argument under an order which I made on the 25th November last. The question arises by reason of Paragraph 5 of the Defence, the Particulars of Objections delivered thereunder on the 19th July 1951 (as amended by leave on the 5th June 1953 pursuant to an order which I made on the 1st June), the Further Particulars of Objections delivered the 10th April 1952, and Paragraphs 2 and 3 of the Reply. When I gave leave to amend the Particulars of Objections, I gave leave also for the amendment of the Reply. No actual amendment of that pleading has, in fact, yet been made on the Court file, but with the consent of the Plaintiff expressed by his Counsel during the course of the argument before me, I proceed to give judgment upon the basis that the Reply may be taken to be amended so far as is necessary to concede, for the purpose of the argument upon the question of law set down, the additional facts now alleged by reason of the permitted amendments of the Particulars of Objections.

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Paragraph 5 of the Defence alleges that the patent now in suit, viz. Australian Letters Patent No. 133163, is and at all material times has been invalid (A) wholly, or (B) so far as relates to the first, second, fifth and eighth claims thereof. The Particulars of Objections set out some six grounds of invalidity which I have summarised in a judgment which I delivered on the 17th March last upon the hearing of a summons for directions. For the present purpose, three only of those grounds are material and the relevant paragraphs of the Particulars of Objections are Paragraph 4, and also Paragraphs 5 and 6 so far only as they depend

10 on the facts alleged in Paragraph 4 as now amended. When I refer to Paragraph 4 of the Particulars of Objections and the facts alleged in or under that paragraph, I am to be taken as referring to that paragraph and also to the Further Particulars of Objections dated 10th April 1952, which set out additional facts relied upon under Paragraph 4, subparagraph (ix), of the Particulars of Objections. Those three grounds of alleged invalidity, which are raised as I say by Paragraphs 4, 5 and 6 of the Particulars of Objections, come to this, viz., that it is alleged by the Defendant that the patent sued on is and was at all material times invalid by reason of (A) non-compliance with various provisions of the

20 Patents Act, prescribing the procedure to be followed from application to acceptance, (B) fraud in obtaining the grant, because the Plaintiff was not in possession on the original application date of the invention for which the patent purported ultimately to be granted, and (C) the fact that the original application made on the 31st December 1943 was not made by the inventor of the invention, if any, for which Letters Patent No. 133163, the patent sued on, were ultimately granted, because that invention, if any, had not in December 1943 been made. As I have said, the grounds of invalidity raised in (B) and (C) are material at this stage only in so far as they are said to be the consequence of the facts alleged in Paragraph 4

30 of the Particulars of Objections and the Further Particulars thereunder.

It is convenient at this stage to set out in chronological order the facts which are said to result in invalidity in the manner referred to. I set them out accordingly, so far as they appear in the Particulars and Further Particulars of Objections, or are facts relating to the enactment and operation of the Patents legislation of which I may take judicial notice.

(1) 8th December 1943.—Application was made by the Plaintiff for an invention relating to improvements in fountain pens of the ball-tip type, and this was accompanied by a complete specification. On this

40 application, a grant of Australian Letters Patent No. 122073 was afterwards made. By Section 69 of the Patents Act, the grant would date back to the initial application date.

(2) 31st December 1943.—Application was made by the Plaintiff for a patent for an invention relating to fountain pens, referring more particularly to those comprising an ink reservoir formed by an extension of the channel for supplying the writing point with ink. This was accompanied by a complete specification. At a later stage Australian Letters Patent No. 133163 (the patent now in suit) were granted, and purported to be granted on this application.

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(3) Date unspecified.—The original complete specification lodged as referred to in (2) above was referred to an examiner for report, pursuant to Division 1 of Part IV of the Patents Act.

(4) 29th May 1946.—The unamended complete specification of United Kingdom Patent No. 573747 was published in Australia by being placed upon the shelves of the Patent Office Library at Canberra. This patent was dated 21st February 1944. Nothing is alleged in the Particulars of Objections as to whether this patent was the Plaintiff's patent or that of another patentee.

(5) 5th September 1946.—The complete specification of the patent 10 which became No. 122073 referred to in (1) above was published. This presumably was after acceptance thereof, since it was before the commencing date of the Patents Act 1946.

(6) 11th September 1946.—The Patents Act 1946 came into operation and in particular the provisions of Section 38A thereof, which provided that after a complete specification had been lodged the Commissioner should publish in the Official Journal a notification that the complete specification was open to public inspection, and that thereupon the application, complete specification, and provisional specification (if any) should be open to public inspection and the complete specification should 20 be deemed to have been published. Section 38A did not apply to No. 122073 since, as I have said, the complete specification of that patent had already been published, but it did apply to the theretofore unpublished complete specification of what afterwards became No. 133163, which had not been published. No notification, however, under Section 38A was published in relation to that specification until later, as will hereafter appear.

(7) Date unspecified.—The Examiner reported adversely on the complete specification referred to in (2) above upon the matters referred to in Section 41 of the Patents Act, and notice thereof was given to the Plaintiff pursuant to Section 45 of the Patents Act. This must have 30 been between the 31st December 1943 and the 18th December 1946.

(8) 18th December 1946.—The Plaintiff lodged what purported to be an amended complete specification pursuant to Section 45 of the Patents Act, but—

(A) according to Paragraph 4 (iv) of the Particulars of Objections this described and claimed as the invention something which was not the invention described and claimed in the complete specification referred to in (2) above, but something substantially different therefrom; and according to Paragraph 2 (g) of the Further Particulars of Objections there was substituted for the 40 description of the alleged invention described in the original complete specification the description of a different invention as alleged in Paragraph 4 (iv) of the Particulars of Objections;

(B) it further described and claimed something which was the same as the invention described and claimed in No. 122073;

(C) it described and claimed something which was the same as the invention described and claimed in United Kingdom Letters Patent No. 573747 referred to in (4) above;

(D) it described and claimed an invention which was not new, by reason of the prior publication of No. 122073 on the 5th September 1946 ;

(E) the complete specification as amended was not responsive to the examiner's report, in the sense that the amendments went beyond the scope and ambit of that report, and/or were not confined to the examiner's objections, and/or were not confined to complying with requisitions arising therefrom.

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10 (9) 19th February 1948.—Pursuant to Section 38A of the Patents Act, the Commissioner published a notification that the complete specification as originally lodged on the 31st December 1943 was open for public inspection. Counsel for the Commissioner at the hearing before me confirmed the impression which the language of Paragraph 4 (v) had previously conveyed to my mind, viz., that it was the original specification without the amendments which was so notified and which thereupon was deemed to have been published.

20 (10) Date unspecified.—The amended complete specification referred to in (8) above was again referred to an Examiner under Section 41 in accordance with Section 45 ; the Examiner again reported thereon ; and notice was given to the Plaintiff. This must have been between 18th December 1946 and the 14th June 1949.

(11) Date unspecified.—The Plaintiff thereupon lodged further purported amendments. This also must have been between the 18th December 1946 and the 14th June 1949. These purported amendments possessed the same five characteristics as those referred to in (8) above.

(12) 14th June 1949.—The Commissioner purported to allow the amendments,—i.e., presumably, both sets of amendments,—and to accept the complete specification as so amended.

30 (13) 30th June 1949.—The purported acceptance was advertised in the Official Journal. This was presumably in purported pursuance of Section 50.

(14) Date unspecified.—The Commissioner granted Letters Patent No. 133163 in relation to the complete specification as so amended and accepted, and the Letters Patent were duly sealed. In accordance with Section 69, the Letters Patent were dated as of the date of the original application, viz., 31st December, 1943.

40 (15) None of the matters occurring between the 18th December 1946 and the 14th June 1949, (save, obviously, the notification referred to in (9) above), was made known to the Defendant or any other member of the public.

A question which requires determination at this stage is one which involves the construction of sub-paragraphs (iv), (ivA), (vi) and (viiA) of Paragraph 4 of the Particulars of Objections, and sub-paragraphs (E) and (H) of paragraph 2 of the Further Particulars of Objections, in so far as those sub-paragraphs allege a difference between the original complete specification and the complete specification in the form which it assumed as a result of the first and second sets of amendments respectively. It

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was argued by Mr. Shelley for the Plaintiff that when the Defendant alleged that the amended specifications “described and claimed” something which was not the invention “described and claimed” in the original specification, but something substantially different therefrom, it was alleging and alleging only a substantial difference between the claims in the original document and the claims in the amended documents. The relevance of that contention will appear hereafter. It was contended on the other hand by Mr. Menzies for the Defendant that the allegation was an allegation of a substantial difference between the respective descriptions of inventions in the three documents, as well as of a substantial 10 difference between the claims in the respective documents, and was sufficient to cover an allegation that the claims in the amended documents claimed an invention not described (as distinct from claimed) or claimed in the original document. Neither Counsel referred in this connection to the language of sub-paragraphs (E) and (H) of paragraph 2 of the Further Particulars of Objections. It is to be noted that the language of those sub-paragraphs refers to a substitution of one description for another.

It is there alleged that the effect of the amendment was to substitute for the description in the original specification the description of a different invention, and although the draftsman continues, “as alleged in sub- 20 paragraph (iv) of paragraph 4 of the Particulars of Objections,” I am of opinion that the language of the further particulars is sufficient to amount to an allegation of a difference between the respective descriptions in the sense that they (as distinct from the claims) are alleged to constitute descriptions of different inventions. Reading then the language of the Particulars of Objections in the light of this interpretation of the further particulars—and I should arrive at the same conclusion independently thereof,—I am of opinion that the allegation several times made in the Particulars of Objections should be construed as an allegation that there 30 was a substantial difference between, on the one hand, both the description of the invention and the claims in the original specification, and, on the other hand, both the description of the invention and the claims in the amended specifications. That is to say, the allegation should not be read as limited to an allegation of a substantial difference between the claims, so as to be consistent with there having been no substantial difference in the descriptions of the invention, or with the ultimate claims having continued to claim an invention which was described in the initial specification. The language of the pleading is not perhaps as full as it might have been, but I think that, fairly read, it does allege (*inter alia*) a substantial 40 dissonance between the ultimate claims and the invention originally described, as well as between the ultimate claims and the initial claims, between the ultimate description and the initial claims, between the ultimate description and the initial description, and between the ultimate description and the initial claims. The meaning which I have given to the pleading would have been clearer if the expression “which was not the invention described and claimed” had read “which was not the invention described or claimed,” or “which was not the invention described, and claimed, respectively.” But on the whole I think a fair reading of the pleading is as I have stated.

It follows also, however, that in so far as the pleading alleges identity 50 between the ultimate invention patented and the inventions the subject

of Nos. 122073 (Australian) and 573747 (U.K.), that identity is to be similarly understood as involving an identity of disclosure as well as of claims.

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I turn next to consider in more detail the nature of the invalidity which is alleged so far as that is material to the present question. By paragraph 4 (ix) of the Particulars of Objections it is alleged that the purported amendments, the purported allowance thereof, and the purported acceptance of the amended specification in its ultimate form were all *ultra vires* the Commissioner, contrary to law, invalid, and of no effect; 10 that no grant of Letters Patent No. 133163 should have been made; and that they are of no legal effect. By paragraph 4 (x) of the Particulars of Objections, it is alleged that the Plaintiff is not entitled to rely on anything so done; and by paragraph 2 (J) of the Further Particulars of Objections, it is alleged that the purported acceptance and grant were both unlawful. It is thus alleged by paragraph 4 of the Particulars of Objections and the further particulars thereunder that the amendments, the acceptance, and the grant were all invalid, for all or any one or more of the following five reasons,—

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(1) That the two sets of amendments purporting to have been 20 made under Division 1 of Part IV resulted in the ultimate description of the invention and the ultimate claims for the invention, as embodied in the grant, being substantially different from the description, and from the claims, respectively contained in the initial complete specification, so as in effect to result in the purported grant of a patent for an invention substantially different from that originally described, as well as from that originally claimed.

(2) That they resulted in the invention as ultimately described, and as ultimately claimed, respectively, being the same as the invention described, and the invention claimed, respectively, in 30 Letters Patent No. 122073; —which incidentally (it is alleged) was the invention of, and Letters Patent for which were granted to, the Plaintiff;

(3) That they resulted in the invention as ultimately described, and as ultimately claimed, respectively, being the same as the invention described, and the invention claimed, respectively in U.K. Letters Patent No. 573747;

(4) That they resulted in Letters Patent being granted for an invention which was not novel—*scil.*, at the date of the lodging of the respective sets of amendments,—because of the prior publica- 40 tion of the complete specification of Letters Patent No. 122073; (it is, curiously enough, not alleged that this want of novelty was related to the publication in Australia of U.K. Letters Patent No. 573747, though that preceded the first set of amendments);

(5) That they went beyond the scope and ambit of the respective examiners' reports which they followed upon, and were not responsive solely to them.

It may be noted in passing that the ground which I have numbered (4) is by no means the same as, nor of course does it depend solely on the identity alleged in, that which I have numbered (2).

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Paragraph 5 of the Particulars of Objections, so far as it is dependent solely upon the facts alleged in or under paragraph 4, alleges the invalidity of the grant of Letters Patent No. 133163, because those facts are said to show that the Plaintiff was not at the 31st December 1943 in possession of the invention for which No. 133163 purported ultimately to be granted and that therefore the grant was obtained upon a false and improper and/or fraudulent suggestion.

Paragraph 6, so far as it is dependent solely on the same facts, alleges a similar invalidity because the same facts are said to show that the invention for which No. 133163 purported ultimately to be granted had not been made at the 31st December 1943 and so the Plaintiff was not the actual inventor of the invention for which No. 133163 purported ultimately to be granted. By this I take the Defendant to mean that the Plaintiff was not *at the 31st December* 1943 such actual inventor. I do not think the paragraph as drawn actually so alleged but I shall assume in the Defendant's favour that it does. 10

I may deal at once with paragraphs 5 and 6 of the Particulars of Objections so far as they are here relevant. With regard to paragraph 5 it is to be noted in the first place that one allegation made by the Defendant is that No. 133163 ultimately described and claimed the same invention as No. 122073 and it is further alleged that it was the Plaintiff who on the 8th December 1943, twenty-three days before the initial application in relation to the Patent in suit, applied for what ultimately became No. 122073. That presumably amounts to an allegation, admitted for the purpose of the present question, that the Plaintiff was then in possession of the invention the subject of the earlier patent, and if that is so the facts alleged and taken to be admitted are inconsistent with the contention that the Plaintiff was not on the 31st December 1943 in possession of the invention for which No. 133163 was ultimately granted. I do not consider that the allegations of fact made in or under paragraph 4 are to be read distributively or in the alternative but rather as amounting to one single set of facts. If I am right in that, the ultimate fact alleged in paragraph 5, viz., the fact of non-possession, does not follow from but is contradicted by the facts alleged in or under paragraph 4, and accordingly paragraph 5 so far as it depends on those facts cannot constitute a good defence. 20 30

If however I am wrong in thinking that the aforesaid allegations of fact are capable of being construed as alleging a series of alternative situations, it is nevertheless quite consistent with the allegations, construed distributively, that at the 31st December 1943 the Plaintiff was in possession of the invention for which No. 133163 was ultimately granted, even if it was not the same as that described in No. 122073, and however much it differed from that described in the original specification lodged on the 31st December 1943. 40

Similar considerations in my opinion dispose of the defence raised by paragraph 6 of the Particulars of Objections, even if it is given the meaning which I have assumed in favour of the Defendant, so long as the allegations in or under paragraph 4 are construed as cumulative allegations of fact for then the ultimate fact of non-making at the 31st December 1943 is contradicted by those allegations. As I have pointed out, it is not alleged that the U.K. Letters Patent were not those of the Plaintiff. If it had been 50

specifically alleged, and admitted, that the Plaintiff had by one or both sets of amendments procured a grant of a patent for an invention which was different to a substantial degree from the invention which he originally described and the invention which he originally claimed, and that the difference consisted in the introduction into the complete specification of an invention, or portion of an invention, which was not the Plaintiff's invention, but that of another person, viz., the patentee under U.K. Letters Patent No. 573747, which however the Plaintiff by such amendment claimed as his own, I should have been of opinion that a good defence

10 was alleged. I should have been of that opinion upon the ground that it would have amounted to the same thing as a denial that the Plaintiff was the actual inventor of the invention for which the patent purported to be granted, or otherwise within the description of permitted applicants in Section 32 (3) of the Patents Act, and that that would be a ground for revocation, since it would have been a ground for *scire facias* at common law, as involving a "deceptious" statement or false suggestion misleading the Sovereign in his grant; see Frost on Patents, 3rd Ed., 1906, Vol. I, p. 297; Coke's Inst., IV., 88; Foster on *Scire Facias*, 1851, p. 242. But the allegation stops far short of anything of the sort.

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20 If, on the other hand, the allegations of fact in or under paragraph 4 are construed distributively, then insofar as paragraph 6 alleges non-existence of the invention at 31st December 1943, it appears in substance to be alleging in another form the first of the five reasons of invalidity which I have held to be alleged by paragraph 4, and I shall consider that reason hereafter. That is to say, it appears to be alleging invalidity because the ultimate grant was for an invention not described and therefore not disclosed at all by the original complete specification, with the added (and in my opinion irrelevant) allegation or comment that it could not have been so disclosed because it had not then been invented.

30 Accordingly I am of opinion that paragraph 5 of the Particulars of Objections, so far as it depends upon the facts alleged in or under paragraph 4 thereof, is not capable of constituting and does not constitute, a good defence to this action. I am of a similar opinion as to paragraph 6, save insofar as it alleges the same grounds of invalidity as paragraph 4 or any of such grounds, and insofar as it does so, paragraph 6 is to be understood as dealt with by what I say hereafter as to paragraph 4.

The remaining question therefore is whether the facts alleged in or under paragraph 4 or any of them afford a defence by reason of any or all of the five alleged consequences which I have earlier summarised. The

40 parties approached the consideration of these five matters somewhat differently. Mr. Phillips in his initial remarks on behalf of the Plaintiff propounded the view that there were four questions of law, viz., whether it was within the power of an applicant, on receiving notice of an examiner's report, to make under Section 45 amendments resulting in the complete specification describing and claiming an invention substantially different from that described and claimed in the original complete specification; whether, if not, the Commissioner might nevertheless accept the amended complete specification so as by such acceptance to conclude the matter against subsequent question; whether it was within the power of an

50 applicant, on receiving notice of an examiner's report, to make under

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Section 45 amendments resulting in the complete specification being non-responsive to the examiner's report; and whether, if not, the Commissioner might nevertheless accept the amendments so as by such acceptance similarly to conclude the matter. It will be observed that the first two questions propounded by Mr. Phillips are merely two aspects of what I have said to be the first ground of invalidity raised by paragraph 4, and the second two questions two aspects of what I have said to be the fifth ground alleged thereunder, and that no reference is made (since those questions were formulated before the final amendment of paragraph 4) to what I have said to be the second, third and fourth grounds alleged thereunder. 10

Mr. Menzies for the Defendant stated the questions to be whether it was within the power of an applicant to make amendments, or, even if it was not, whether it was within the power of the Commissioner conclusively to accept amendments, resulting (in either case) in a complete specification claiming an invention substantially different from that initially claimed; and whether it was within the power of an applicant to make amendments, or, even if it was not, whether it was within the power of the Commissioner conclusively to accept amendments, resulting (in either case) in the complete specification claiming an invention not novel at the time of the amendments. It will be observed that these are similar to but not identical with questions which I have referred to as raised by the first and fourth grounds of invalidity alleged by paragraph 4, and that no reference is made to the second, third and fifth grounds, relating respectively to identity with another prior Australian patent, identity with a U.K. patent previously published in Australia, and non-responsiveness. I have said that the two questions formulated by Mr. Menzies were not identical with those raised by the first and fourth grounds as stated by me earlier in this Judgment, because Mr. Menzies referred in formulating those questions merely to a difference in what was "claimed"; whereas, having regard to what I have said earlier, it will be apparent that it is important to deal with not only a difference in claims, or a substantial difference in claims, but a substantial difference in description of invention. I do not, however, regard the parties' formulation of the questions as binding upon me, but rather as made argumentatively only at an early stage of the discussion before me; and accordingly I propose to consider the five grounds which I have myself formulated as possible grounds of invalidity raised by the facts alleged in or under paragraph 4. 20 30

Each of those five questions, it is said, is capable of being divided into two, or rather of being considered from two aspects. The first is whether an applicant can properly make under Section 45 an amendment which has any of the five consequences here under debate, and the second is whether, even if the applicant cannot do so, the Commissioner may nevertheless by accepting a specification so amended so conclude any subsequent question in relation to those amendments as to preclude an objection based thereon being taken thereafter to the validity of the grant. For reason which I shall state, I consider that approach may tend to mislead. 40

As introductory to the consideration of the whole question, a conclusion must be reached as to the meaning of the code of procedural provisions 50



contained in Division 1, so far as they relate to steps to be taken from the stage where an application and specification are referred to an Examiner up to the stage of acceptance and possible appeal therefrom. It is not possible, I think, to read Sections 39–47 as describing the events which are to take place according to a strictly temporal sequence. Sections 39, 40, 42, 43 and 44 appear to me to constitute a set of provisions aimed at procuring compliance with the statutory requirements theretofore stated in Sections 33, 34, 35, 36, 37 and possibly 38; whereas Sections 41, 45, 46 and 47 are primarily directed to ensuring so far as possible that the application and complete specifications are limited to a new invention, which is not already the subject of a prior Commonwealth or State patent or of a prior Commonwealth or State application. It is clear that it cannot have been intended, for example, that a decision by a Law Officer under Section 43 (2) that the application and specification “shall be accepted” subject to certain conditions should oblige the Commissioner to accept the application and specification, notwithstanding outstanding objections by an Examiner under Section 41, or objections by the Commissioner himself on one or more of the grounds mentioned in Section 46. Furthermore, if Section 45 were to be read as referring, either in respect of examiners’ reports, or in respect of applicant’s amendments, to the matters referred to in Sections 39 and 40 or any of them, there might result an amendment under Section 45 still producing some non-compliance with the requirements referred to in Sections 39 and 40, although there would then be no provision for a fresh report by an Examiner under those sections, but only for a fresh report under Section 41. No doubt, however, the Commissioner could still notice under Section 46 non-compliance with the matters referred to in Sections 39 and 40, if it occurred as an accidental consequence of procedure under Section 45 adopted with reference to the subject-matter of Section 41. It is important to notice, I think, that Section 44 merely says in effect that if everything is in order under Sections 39 to 43 the application and specification may,—not must,—be accepted. That, I think, is in order to leave open the consideration of other matters, including the matters referred to in Sections 41, 45 and 46.

Sections 39–47 involve difficulties of interpretation. They are somewhat elliptically expressed, and they neither state in any express or clear fashion the inter-relation of the steps which they describe, nor set out all the possible contingencies to which their provisions may give rise. I shall set out the way in which, in my opinion, Sections 42–47 should be read in order to render them fully intelligible, and in so doing I shall underline those expressions which for that purpose I have either inserted or modified.

(1) *Section 42.* So far as the Examiner reports adversely to the application or specification on any matter referred to in Sections 39 and 40, the Commissioner may—

(A) require compliance by the applicant within a specified time with such directions for the amendment of the application or the specification, *designed to procure compliance with the provisions referred to in the said sections*, as the Commissioner sees fit to give; or

(B) direct that the application instead of dating from the time when it was lodged shall date from a later date *to be specified by him*; or

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(C) *do both, provided that in such a case he shall not give a later date to the application than the date of compliance with the directions for amendment ; or*

(D) *do none of those things (see Tate v. Haskins 53 C.L.R. 594 at p. 610).*

(2) *Section 43.*

(1) *An appeal shall lie to the Law Officer from any direction of the Commissioner under the preceding section.*

(2) *The Law Officer shall hear the applicant and the Commissioner and subject to any other matters requiring to be dealt with by the Commissioner or the Court under Section 41 or otherwise shall decide whether and subject to what conditions, if any, the application and specification, so far as relates to compliance with the matters referred to in Sections 39 and 40 shall be accepted.* 10

(3) *Section 44.* *If the Examiner reports favourably to the application and specification upon all matters affecting them under Sections 39 and 40, so that Sections 42 and 43 never come into operation, or if the Examiner reports adversely within the meaning of Section 42 and (a) under that section the Commissioner requires amendment, and all such directions for amendment are complied with, or (b) the Commissioner gives a direction to post-date the application under that section, or (c) there is an appeal to the Law Officer under Section 43, or (d) the Commissioner takes no action under Section 42, the application and specification may, subject however to other matters requiring to be dealt with under Section 41 or otherwise, and subject to any order of a Law Officer under Section 43, be accepted.* 20

(4) *Section 45.* *If the Examiner reports adversely to the complete specification regarding the matters mentioned in Section 41, the applicant shall be informed thereof and the applicant may within such time as may be prescribed amend the complete specification, with a view to removing the Examiner's objection, and the amended complete specification shall be again reported on by the Examiner under Section 41.* 30

(5) *Section 46.* *If the Commissioner is satisfied that no objection exists to the specification on the ground that the invention is already patented in the Commonwealth or in any State or is already the subject of any prior application for a patent in the Commonwealth or in any State or by reason of any other lawful ground of objection, including (subject to any decision of a Law Officer thereon under Section 43) any ground relating to the matters referred to in Sections 39 and 40, he shall accept the application and specification without any condition, but if he is not so satisfied he may either (A) accept the application and specification on condition that a reference to such prior specifications as he thinks fit be made thereon by way of notice to the public ; or (B) refuse to accept the application and specification.* 40

(6) *Section 47.*

(1) *An appeal shall lie to the High Court or the Supreme Court from any decision of the Commissioner under sub-paragraph (a) or sub-paragraph (b) of the preceding section.*

(2) The Court shall hear the applicant and the Commissioner and shall decide whether and subject to what conditions, if any, the application and specification shall be accepted, *but this section shall not confer on the Court jurisdiction to decide any matter which has been dealt with by a Law Officer under Section 43.*

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10 It was not intended by Section 47, in my opinion, to give to the Court jurisdiction to reverse or modify any decision of the Law Officer under Section 43; and I do not see anything to the contrary of that view in the observations of Rich, Dixon, Evatt *and McTiernan, J.J.*, in *Tate v. Haskins* (above) at p. 612, although, apparently, as there pointed out, it was the view of the High Court that a Commissioner's direction under Section 42, though not appealed from under Section 43, might nevertheless in some circumstances come in question on an appeal to the Court under Section 47.

20 Having now stated my interpretation of this set of statutory provisions, I return to the question of the power given to an applicant under Section 45 to amend his complete specification, and to the Commissioner to accept it as amended. As I have said, the Act contemplates that he will amend with a view to removing the ground of an adverse report under Section 41.

30 It is not contemplated that precise amendments may be or will be directed by the Commissioner for that purpose; the formulation of the necessary amendment is left to the applicant. The Act contemplates that that particular type of amendment will be an amendment made with a view to obtaining acceptance under Section 46, by rendering it unnecessary for the Commissioner to rely on the objection of prior patenting or prior application, referred to in Section 41 (a) or any "other lawful ground of objection" so far as the same might be constituted by the non-novelty referred to in Section 41 (b). There is, of course, no reason why an amendment in pursuance of a requirement under Section 42, with a view to compliance with the requirements referred to in Sections 39 and 40, and an amendment pursuant to Section 45, with the object which I have above stated, should not be made concurrently, or even as the result of the one Examiner's report. I do not agree with the contention of counsel for the Plaintiff and of counsel for the Commissioner that Section 45 refers (*inter alia*) to an adverse report under Section 39 or Section 40, or with the contention of counsel for the Plaintiff that under Section 46 the Commissioner if not satisfied as therein set out may reject both the alternatives set out in subparagraphs (A) and (B) of that Section, and accept the application and specification unconditionally. But I agree with Mr. Shelley that it makes

40 no difference to this matter which of these views are correct.

The reason why I consider that it is misleading approach the question in two steps is that if the Commissioner's acceptance of an application and specification is thereafter conclusive as against all the world with respect to the permitted character of an amendment of the complete specification under Section 45, the applicant's right is plainly a right not merely to submit or effect such amendment as shall answer some test defined without reference to the Commissioner's opinion, but to submit or effect any such amendment as shall, in the opinion, or at least the honest and not ridiculous opinion, of the Commissioner, fall within the purview of the statute.

50 There is, therefore, no point in seeking to define what would be the limits

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of the right or power of amendment independently of the provisions of Sections 42, 43, 44 and 46; the enquiry must be in the first instance whether the Commissioner's opinion, or at least his opinion being honest and not manifestly absurd, is the test of validity.

It was said by Mr. Shelley that in any event non-compliance, if any, with the various requirements laid down in Division 1, or with any requirements which could be deduced therefrom, as to the procedure of amendment, could not be relied upon as a defence in an infringement action, since they could not have been relied upon as ground for revocation. That followed, he said, from the fact that Section 86 (3) of the Patents Act has preserved as grounds of revocation those grounds only on which a patent might at common law have been repealed by *scire facias*. Since the procedure by reference to an Examiner and Commissioner's amendments was unknown before 1883, non-compliance with any such procedure could not, he said, have been available as a ground for a *scire facias* at common law. Now I agree with Mr. Shelley that there is no defence, going to the validity of the patent, open upon any infringement proceedings which would not also afford a ground of revocation in revocation proceedings, or at all events I have not been able to think of any. This was the common law position; see Hindmarch on Patents, 1846, p. 389. Otherwise, as Mr. Shelley pointed out, one would have a position in which there might be on the register a patent which could not be enforced, but which no one could get revoked.

In my opinion, it is not a correct approach to the question whether non-compliance with a statutory requirement can afford a ground for revocation proceedings and therefore a ground of defence in infringement proceedings to enquire merely whether such a requirement, or any similar requirement, actually existed before the Patents legislation in England of 1883, or at any time when *scire facias* was the proper procedure to obtain revocation of a patent. It is true that it was by Section 26 of the Patents Act 1883 that the procedure by *scire facias* was abolished and the procedure by petition substituted. But it was always a ground for repeal of a patent by *scire facias* if the Sovereign purported to grant something which he could not lawfully grant. Thus, Coke in his Fourth Institute, p. 88, says:—

“This writ of *scire facias* to repeal letters patents doth lie in this ordinary course of justice in three cases. First, when the King by his letters patents doth grant by several letters patents one and the self-same thing to several persons, the former upon which shall have a *scire facias* to repeal the second patent. Secondly, when the King granteth anything that is grantable upon a false suggestion, the King by his prerogative *jure regio* may have a *scire facias* to repeal his own grant. Thirdly, when the King doth grant anything which by law he cannot grant, he *jure regio* (for advancement of justice and right) may have a *scire facias* to repeal his own letters patents.”

Again in *R. v. Mussary*, 1738, I Webster's Patent Cases 41, the same rules were laid down by Lee, C.J., and the following additional propositions were stated:—

“Every false recital in a thing not material will not vitiate the grant if the King's intention is manifest and apparent. If

the King is not deceived in his grant by the false suggestion of the party, but from his own mistake upon the surmise and information of the party, it shall not vitiate or avoid the grant. Although the King is mistaken in point of law or matter of fact, if that is not part of the consideration of the grant it will not avoid it . . . where a patent is granted to the prejudice of a subject the King by right is to permit him upon his petition to use his name for the repeal of it."

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Foster on *Scire Facias* says :—

10 " Every such grant of letters patent of the sole right to make, use, exercise and vend any invention is void if the invention was not invented or found to by the grantee or first introduced into the Kingdom by him ; and also if the invention is not new and useful to the public. It is also void for uncertainty or for being too general, for misrecitals, for false suggestions, by which the Queen has been deceived or misinformed in her grant, or where she has granted more than she lawfully may, or what may be to the prejudice of the Commonwealth or to the general injury of the people, or where she has granted the same thing to two persons."

20 Godson on Patents, 2nd Ed., 1851, p. 268, in discussing the ground upon which a patent may be void and may accordingly be repealed by *scire facias*, observes, " If the patent has not been obtained in the usual mode or will not bear the construction that must necessarily be put upon it, it is also void." By a footnote to that passage, he refers the reader, in connection with the usual mode of obtaining a patent, to a passage beginning at p. 168 of his book, in which he describes the procedure in force at that time, whereby patents were obtained by means of a petition and declaration, which in effect corresponded with our present application and declaration. Thus it is, as one would expect, in accordance with authority to suppose that

30 where by the common law or by express statutory provision restrictions were placed upon the right of the Crown to grant letters patents for inventions, non-compliance with any restriction which constituted a condition precedent to the right to grant was a ground upon which a grant might be avoided ; see Hindmarch, pp. 265–6, where it was said :—

40 " It is a principle in law, that the Queen cannot be considered to intend wrong to any one ; or, as it is sometimes expressed, the Queen can do no wrong. And the law provides that any patent which is contrary to law, or prejudicial to the public, shall be absolutely void, not only by virtue of the law itself, but as being contrary to the Queen's intent. To allow such a patent to be put in force would be contrary to the Queen's intention ; and, therefore, the formal grant it contains is unavailing in a Court of Law, if the party proceeded against can show any valid objection to it. Every grant made by patent has this condition, either expressly or tacitly annexed to it ; —that it shall not be contrary to law, or operate to the prejudice of Her Majesty's subjects. And if the grant be contrary to this condition, it cannot be enforced against any person in any Court of Law or Equity

50 In an action brought upon a patent objections may be taken to it on three different grounds ; first, that it is contrary to the

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express provisions of the Common or Statute Law ; secondly, that the Queen has been deceived in some material particular, respecting the grant contained in the patent ; and, thirdly, that some of the conditions or provisoes contained in the patent have been violated. There are several objections, however, which may be taken to a patent on more than one of these three grounds, and some which may be taken upon all three of them."

Accordingly, the appropriate enquiry both before and since 1883 must have been and must be whether any particular requirement of a statute which dealt or deals with the Crown's right to grant patents for inventions was or is upon its proper construction a condition precedent to its right to make a valid grant. 10

Applying these considerations to the first ground of suggested invalidity, the question accordingly is whether it is a condition precedent to the right of an applicant to obtain from the Crown a valid grant of letters patent in the Commonwealth or to the Crown's right to grant him such a patent that the complete specification as originally lodged should not be so amended as to cause the patent when granted to incorporate a complete specification which claims a substantially different invention from that originally disclosed in the initial document. Mr. Menzies contends that 20 it is. Mr. Shelley on the other hand, and he was supported in this argument by Mr. Gillard, contends that the only condition precedent so far as this matter is concerned is that the ultimate grant should incorporate a complete specification which, according to the judgment of the Commissioner upon acceptance, arrived at honestly and not with manifest absurdity, does not claim an invention substantially different as aforesaid.

Mr. Menzies indeed contended that everything which the Commissioner had to decide under Division 1, including his decision as to everything with respect to which he has to be satisfied for the purposes of acceptance under Section 46, is decided by the Commissioner as an admin- 30 istrative decision only, and that his decision is challengeable by any subsequent defendant in an infringement action or any subsequent petitioner to revocation who desires to set up that the conditions or requirements which the Commissioner considered to be satisfied were not, in fact, satisfied. He pointed out that a decision by the Commissioner under Section 46 to accept, or even a decision of the Court under Section 47 directing acceptance, would not prevent such a person thereafter setting up the objection of non-novelty, even though the Commissioner or the Court respectively might have been satisfied that no lawful ground of 40 objection existed under Section 41 (B). Nor, he said, would a decision by the Commissioner or the Court prevent such a person raising a defence that the patentee was not the actual inventor. Mr. Menzies further contended that the very different provisions of Division 4, and particularly Sections 71-79, showed that an amendment under Division 1 was not intended to be conclusive after acceptance. He referred to the view taken in England, before the forerunner of the present Section 79 of our Act was construed by the House of Lords in *Moser v. Marsden* 13 R.P.C. 24, to the effect that amendments under what then corresponded with our Division 4 were examinable by a Court upon infringement proceedings, notwithstanding their allowance by the Patent Office ; see *re Van Gelder's* 50 *Patent* 6 R.P.C. 22 at pp. 27-29. He referred also to decisions before the

Act of 1883 to the effect that amendments by way of disclaimer made under the Act of 1832 were similarly examinable in infringement proceedings; see *Ralston v. Smith* 11 H.L.C. 223. It could not be intended, he said, that an applicant could be better off under Division 1 than under Division 4, since those divisions overlapped in point of time; under Division 4, even between the lodging of a complete specification and acceptance, an applicant was limited to disclaimer, correction or explanation; under Division 1, which also applied between lodgment of a complete specification and acceptance, and only between those steps, it could not have been intended that an applicant might (if an examiner objected) amend free of any such restriction, and to such extent as would enable him to claim an invention not disclosed in the unamended document. Mr. Menzies supported his argument by reference to Section 56 (*d*), which permits disconformity between provisional and complete specifications to be raised in objection proceedings after acceptance in one class of case only, and Section 65, which prevents objection after grant on the ground of double patenting or disconformity. These provisions, he said, indicated that otherwise such objections would survive acceptance.

Mr. Shelley and Mr. Gillard, on the other hand, contended that *prima facie* a statute when it commits to an official a duty of making a discretionary determination intends that to be final for all purposes, except in so far as it is specifically left open by the legislation to subsequent challenge. The Commonwealth Act, they said, left decisions of the Commissioner under Division 1 open to appeal (Sections 43 and 47), to opposition and appeal (Division 2), and to revocation proceedings on grounds only which would formerly have supported *scire facias* (Section 86). There was, they said, no provision for any one but the applicant and the Commissioner to be heard upon an appeal under Division 1. It could not have been meant by the legislature that acceptance might be ordered by a Court under Section 47, in an appeal to which the Commissioner and the applicant were alone parties, but that nevertheless a defendant in subsequent infringement proceedings could challenge the propriety of the acceptance; and if, they said, that was right, a decision of the Commissioner accepting an application and specification without putting the applicant to such an appeal could not be any less free from the possibility of subsequent challenge. Otherwise, it was said, an applicant, having a good and useful invention, might under Section 45 amend to satisfy the Examiner and the Commissioner, might have his documents accepted on the basis that the amendments were proper, and might yet find years later that a Court in infringement or revocation proceedings considered that the Commissioner had gone too far, in that the amendments had rendered the grant void on the basis that it was a grant for a patent substantially different from anything disclosed in the original application and specification. Such defences, it was said, as survived acceptance, notwithstanding examination by the Commissioner or his Examiners of similar questions, were such only as would have been ground for *scire facias* at common law, e.g., non-novelty. It was indeed common ground that non-novelty always was a ground for *scire facias*. As pointed out by Hindmarch, it was such a ground not only because it involved a conclusion of false suggestion, but also because it involved a breach of the condition for defeasance in the letters patent themselves; see as to this *Godson, op. cit., Ap x. p. 5.*

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Disconformity, Mr. Shelley said, was in Australia excluded by the express provisions of Section 65, only because it had remained in England as a ground of revocation by *scire facias*, notwithstanding the alteration of the procedure by the 1883 statute—see *Nuttall v. Hargreaves* 1892 1 Ch. 23—and would otherwise have remained in Australia. He and Mr. Gillard further contended that Section 38A, to which I shall refer more fully hereafter, had not altered the law, and that the fact that Section 51, protection Examiners' reports from disclosure save in particular cases, had been left unaltered was an indication that the legislature did not contemplate that objections to validity might be taken which would involve an examination of the procedure consequent upon such reports in the Patent Office. As to Division 4, Mr. Shelley contended that even in the absence of Section 79 an allowance of an amendment under the Division, if before acceptance, would have become conclusive upon acceptance. Section 56 (d), he said, permitted an examination, such as was made in *Goldman v. Bramley* 55 C.L.R. 74, into the validity of an amendment of a provisional specification, merely because in that particular case the statute in effect provided that acceptance should not be conclusive as to the validity of the amendment. Mr. Shelley and Mr. Gillard both relied upon the observations of number of the learned Judges of the High Court as to the nature of the discretionary determinations of the Commissioner in *Tate v. Haskins* (above), *Goldman v. Bramley* (above), and *ex parte Weiss* 61 C.L.R. 240. 10 20

The matter has been argued before me with much ability and I have had all the assistance which any Judge could reasonably expect in deciding what I have found a difficult question upon which there is no direct authority. The reason for this absence of authority is not difficult to discover. The position in England always has been—and in Australia until September 1946 it was the same—that a complete specification in the form in which originally filed was not open to public inspection until acceptance, and indeed the only form in which the complete specification ever became known to the public (save in a Convention case) was the form in which it was advertised upon acceptance. Those amendments made in the Patent Office before acceptance never became public property save in the exceptional case of a Convention patent, when the original specification was published after 12 months; see *re Sereax's Patent* 29 R.P.C. 284. But it was realised that amendments in the Office must be subject to some limiting principle, and there was developed in England the doctrine of amendment in the Office within the ambit of the original invention disclosed by the original complete specification. The statutory reference to amendment in the Office, of course, necessarily involved that, consistently with the statute, some changes might be made in the description and ascertainment of the invention before grant. The statutory examination for novelty clearly contemplated the same thing. On the other hand, the statutory principle that in general a grant was to be dated as of the date of the initial application imposed the necessity to deduce from the Statute some relation between that principle and the limit to which amendment in the Office might be permitted. I agree with Mr. Shelley that this problem was as a matter of theory, as well as of practice, solved by the adoption of the principle that amendment of claims might be permitted freely, and even amendment of description, so long as the invention ultimately claimed was, upon a fair reading of the original 30 40 50



specification, disclosed thereby. In the English legislation of 1949 and in the Commonwealth Act of 1952 this concept is referred to in the new statutory phrase "fairly based," i.e., on the matter described in the specification.

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The manner in which the question of amendment in the Office was worked out under the English legislation from 1833 onwards may be traced by reference to *Edmunds on Patents* 2nd ed. 1897 pp. 217-9. *Frost on Patents* 3rd Ed. 1906 pp. 17-18, *Pletcher Moulton on Patents* 1913 pp. 279-280; *re Serex's patent* (above); and *re Coutant's Patent* 48 R.P.C. 1. 10 Moulton, *lo. cit.*, stated that the proposed amendment must not introduce a wider or different invention from that originally described, and referred for that proposition to *re C's Application*, 7 R.P.C. 250. As reported, that case does not appear to deal with the point, but no doubt the practice was as described by the learned author. In *re Serex's Patent*, the Comptroller General at p. 287 said:—

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20 "With regard to English specifications, the practice of this office has always been generous towards the inventor. For example, claims are generally allowed in the final specification for any feature or detail which is disclosed in any way in the specification (including the drawings) as originally filed. Thus if the drawings clearly show a particular feature or a special form of construction this even though it were not described in the original specification would be allowed to form the basis of a claim in the complete specification. This may no doubt in some cases involve a more generous principle of construction than that applied in the Courts when a patent has been granted and its scope and validity are in issue; but even in these cases when drawings are put forward as descriptive of an invention and are unambiguous a feature shown therein may be held to be part of the invention."

30 In that case an application had been made to the Comptroller General under Section 26 of the English Act of 1907 (the "delayed opposition" section) to revoke a Convention patent on the ground that the nature of the invention or the manner in which it was to be performed was not sufficiently or fairly described and ascertained in the complete specification. That ground was one of the grounds of opposition. In Section 11 (1) (c) of the 1907 Act and Section 26 permitted a revocation application upon a similar ground within a limited time after grant. There the English specification as originally filed was extensively amended and one object of the revocation proceedings was to raise the question whether the 40 specification as finally accepted contained an invention substantially different from the invention as originally applied for in France. It was also contended, however, that the specification as finally accepted did not sufficiently or fairly describe the invention originally applied for in England, i.e., that the amendments allowed had resulted in a patent for a substantially different invention not disclosed in the original English specification. The Comptroller-General held that that ground was not open under Section 26 or Section 11 (1) (c). He said:—

50 "It was not intended to allow any person under this head to raise questions either as to the propriety of amendments made in the Office or as to what may be called disconformity between the

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invention as originally put forward and the invention as finally claimed. To hold otherwise would be to allow an opponent to raise the question of validity of all or any of the amendments which had been made during the passage of the specification through the Office, provided the original document could be seen. In practice this might not be difficult in the case of Convention applications where the original specification is always open to the public after a year from the date of the publication in the foreign country, but it would be difficult, if not impracticable, in the case of an English application where the original documents are at present not open to public inspection. Apart, therefore, from other serious objections, to extend this provision so as to include such cases would press more hardly on a foreign than on an English applicant, and I do not think I ought to hold that subsection (1) (c) is open to such a construction.” 10

The Comptroller General thus declined to put Convention patents in the position in which English patents could not then from a practical viewpoint be put, and he undoubtedly held that the opposition section, so far as it referred to insufficient description or insufficient ascertainment, did not cover the suggested ground of attack. He did not, however, and indeed he could not decide one way or the other whether ordinary revocation proceedings under Section 25 of that Act would have lain on the ground that *scire facias* would have been available at common law, because revocation under Section 25 was a matter for the Court and not for him, though I think it is fair to say that no one appears to have referred to such a possibility. 20

In *Coutant's* case, at p. 3, the Assistant Comptroller General described the process of amendment in the office in the following language :—

“ Even in a country where the patent is ultimately granted upon some specific and binding statement of claim—as in England and America—it is impossible to overlook the fact that the original statement of claim as first submitted by the inventor for criticism by the Patent Office, is purely tentative. Until a search has been made by the Patent Office the inventor cannot possibly know how much he is entitled to cover, or do more than guess vaguely what his final claims are likely to be. Hence, in all countries where an investigation is made as to novelty, there is the utmost liberty allowed during the progress of the application in recasting the claims, and practically any claim is permissible which is clearly warranted by the description as originally filed. The inventor can claim as much as he has in fact invented, or added to knowledge. Sometimes, all that can be saved from the wreck is a detail not even mentioned in the original statement of claim, but clearly included in the description or shown in the drawings. I am of course referring here to the progress of an ordinary application, and not to applications under the International Convention.” 30 40

Thus in England—where the matter of amendment in the Office has always been confidential—though the Comptroller General guides himself, subject to the statutory appeals to the Law Officers, by the doctrine which I have previously stated, no proceeding based upon the view that the 50

grant of a patent for a different invention from anything originally disclosed is a ground for revocation has ever been, so far as I know, initiated. Counsel for the Commissioner informs me that the same position has obtained in this country, but that the passing of Section 38A in 1946, with the result that the original complete specification now becomes open to public inspection, according to the practice of the Office, within two months of lodgment, has caused the Commissioner actually to narrow substantially the extent to which he was previously prepared to permit amendments under Division 1, I gather however, from Mr. Gillard that the

10 Commissioner never has regarded himself as entitled to go beyond the limits set by the English doctrine which I have stated.

I have said so much in order to illustrate the nature of the problem as well as to indicate why there is no express authority upon it.

In the result, I think that the whole question of permissible amendment under Division 1 comes back to the question which I previously posed, viz., how far the statute itself contemplates that the applicant may be permitted by the Commissioner to travel from his original complete specification without bringing about the defeat of the subsequent grant. In considering that question, it is important to bear in mind that the Patent

20 Office interpretation of the power has in England and in this country always been to restrict it within the limits of the invention disclosed by the original specification, though that fact does not by itself assist in determining the question whether the opinion of the Office is intended by the Statute to conclude by acceptance the question of *ultra vires* amendment.

The introduction of Section 38A into the Commonwealth Act has brought about a position in which it is no longer possible to say, as Starke, J., said in *Tait v. Haskins* (above), that one reason why acceptance must conclude the different question of disconformity between provisional and complete specifications was that otherwise such disconformity might invalidate

30 a perfectly good invention disclosed by a complete specification when opened to public inspection after acceptance. For Section 38A produces the consequence that the provisional and the initial complete specification must be open to public inspection either immediately after or at least within a reasonable time after lodgment in the patent office. It is true that the Commissioner has apparently adopted the practice of refraining from notifying them as open for public inspection until two months after lodgment, and that theoretically he might within that two months accept the application and the complete specification.

But in practice I should imagine that that would seldom happen,

40 and therefore a good invention, ultimately by amendment under Section 42, excised from the complete because not disclosed in the provisional, even before acceptance, might be lost to the inventor through disclosure brought about by publication of the complete before acceptance.

Furthermore, the Act now results in any interested person being able after acceptance or for that matter after grant to compare the original complete with the complete in its final accepted form.

Thus Section 38A by presenting such an opportunity to a defendant in an infringement action or a petitioner for revocation now squarely raises the question whether such a person can after acceptance and grant

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take advantage of the fact (if it be a fact) that by amendment under Division 1 before acceptance the Commissioner has permitted the creation of a patent for an invention which cannot be fairly said to be disclosed at all in the initial complete specification.

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Does then the Patents Act contemplate that by amendment under Division 1 an applicant may in the result obtain a patent for an invention not disclosed in the original complete specification? Does it contemplate that the question whether he has done so should be closed by acceptance?

Mr. Shelley conceded that, apart from the effect of acceptance, the Act did not contemplate that an applicant could by amendment under Section 45 so amend his complete specification as to claim something not disclosed in the initial complete specification. That view is in accordance with the view long taken by the Office, as I have already shown, and it is the view I should myself arrive at upon the basis of the various references to "the invention," which appear in Sections 32 (3) (c), 34, 35, 36, 39 (1) (b), 40 (a), 41 (a) and (b), 46, 53, 54, 56 (a), (b) and (c), 62, 78 and 82. Section 32 (3), when read with the definition of "patent" in Section 4, provides that the persons therein described may make application for Letters Patent for an invention; Section 33 (3) provides that subject to the Act an application shall date from the time of lodgment; and Section 69 provides that subject to the Act every patent shall be dated and sealed as of the date of the application. Thus what may be called the primary scheme of the Act is that an inventor may get a patent for an invention as of the date when he first disclosed it to the Crown—and not that he should get a patent as of that date for some invention which (whether he had then invented it or not) he did not then disclose. It is true that disconformity between a provisional specification and a complete specification, even if it results in the complete specification claiming an invention not disclosed in the provisional specification, is one case in which, by reason of Section 65, a patent for such a different invention is not challengeable in infringement or revocation proceedings. Such a case may be met by post dating under Section 42, but as the four judges pointed out in *Tate v. Haskins*, the Commissioner may not even require that.

It is further true that by virtue of Section 79 leave to amend under Division 4, even if it is erroneously permitted to produce the effect of making the complete specification as amended claim an invention not disclosed in the complete specification as initially lodged, is not challengeable, except for fraud. Thus there are two cases whereby under the legislation a disconformity between (in the one case) provisional and complete and (in the other) between original complete and amended complete, resulting in the grant of a patent for an invention not disclosed in the earlier document, is by the Statute itself made unavailable in infringement or revocation proceedings, and where accordingly the opinion of the Commissioner (or of the Court on appeal from him) leading to that result, is made conclusive.

It might well have been thought desirable to provide similarly in express terms with regard to similar disconformity between an initial complete specification and an amended complete specification resulting from amendment under Division 1, but no doubt prior to the enactment of Section 38A in Australia it never occurred to anyone that such matter might in practice be capable of being raised.

In my opinion it is not possible to imply or infer from the Statute that the "disconformity" between two complete specifications to which I am referring is to be, after and on account of acceptance, unavailable as an objection to validity in infringement or revocation proceedings. If as I think, and as Mr. Shelley concedes, Division 1 on the face of it contemplates that the complete specification if amended shall in its ultimate amended form claim an invention originally disclosed in the initial complete specification, I do not think it can be said that departure from that scheme becomes immaterial when the Commissioner accepts the complete specification in its final form. It is true that disconformity between the provisional and the complete, since it is no longer available in Australia as a ground of invalidity in infringement or revocation proceedings, has been held in *Tate v. Haskins* to be merely a matter upon which the Commissioner prior to acceptance has a discretionary power to found an objection. But I am unable to see any sound reason for saying that with respect to a different type of disconformity, viz., that between original and amended complete specification, as to which there is no provision similar to that contained in Section 65, or that contained in Section 56 (d), or Section 79, such disconformity becomes merely a matter for discretionary objection by the Commissioner before acceptance. It seems to me therefore that it remains a condition precedent to the validity of a grant that an amended complete specification in its final form shall at least not claim an invention not disclosed in the complete specification in its original form, save in the one case of an amendment under Division 4; and that the condition precedent is not accurately expressed by describing it merely as a condition that the amended complete specification shall not in the opinion (or the honest and not ridiculous opinion) of the Commissioner, or the opinion of the Court under Section 47, claim such a different invention. It is, of course, obvious that if a Court under Section 47 has allowed an appeal from the Commissioner in favour of an applicant, in proceedings between them alone, upon the ground that there is no such disconformity between initial and amended complete specification, it may be highly improbable that any defendant in infringement proceedings or petitioner in revocation proceedings will thereafter persuade another Court to the contrary. But clearly there can be no estoppel if the parties are different—neither estoppel by *res judicata* nor issue estoppel—and what is true of a Court decision under Section 47 must be equally true of a Commissioner's decision to accept under Section 46.

It seems to me clear that acceptance cannot be conclusive as to some other matters which fall to be decided by the Commissioner under Division 1. For example, under Section 38 a complete specification if it does not accompany the original application must be lodged within a maximum period of 10 months therefrom and if it is not so lodged the application shall lapse. Suppose the Commissioner made a mistake of fact or of law in relation to this matter and purported to accept a complete specification lodged 10 months and one day after the original application. Of course that is one of the matters upon which he ought to be satisfied before he accepts, but if he wrongly accepts notwithstanding such a breach of Section 38, it is in my opinion impossible to hold that there can thereafter be no challenge by a Defendant in infringement proceedings or by a petitioner for revocation to the validity of the grant founded upon such acceptance. It was contended by Mr. Menzies that a breach of Section 33 (1), constituted

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by a failure to lodge either a provisional specification or a complete specification with the original application, would stand in a similar position. I understood from Counsel for the Commissioner that such failure sometimes happens, but is attempted to be got over by treating the application as lodged in escrow, or conditionally, until the arrival of a specification. I need not decide in this case whether such a practice can result in a valid grant. But if, for example, the application by some mistake was not signed by the applicant, I do not see how a purported acceptance by the Commissioner, even if he purported in the exercise of his discretion to treat as a signed application something which in law was not such, could conclude the matter against subsequent attack. It does not, of course, follow that compliance with every procedural direction in Division 1 is to be construed as a condition precedent to the validity of the subsequent grant. It is necessary in each case to see whether the provision is directory only or essential. 10

One is bound to concede that the view at which I have arrived does involve an applicant in the risk of the subsequent loss of his patent if in attempting to meet the objections of an examiner he has produced such a disconformity as I have been discussing, and that such a view produces anomalous dissonances with the results of Sections 65 and 79 in cases to which they apply, but this was perceived and pointed out by Dixon J. in an analogous case in *Goldman v. Bramley*. One is bound to concede also that, as Mr. Shelley pointed out, difficult and borderline cases may arise, in which the Commissioner may consider that the amendment does not result in such disconformity but a Court upon subsequent objection or petition takes a contrary view. If however this is an undesirable position, as indeed it may well be thought to be, the matter appears to me to be one which must be dealt with by Statute. I cannot see how I can hold that the Statute, when it gives the Commissioner power, subject to appeal, to make discretionary decisions as between the office and the applicant, is to be read (save in the cases where it expressly says so) as also giving him, or the tribunals which sit on appeal from him, a power to make discretionary decisions as between the applicant and all the world. 20 30

Mr. Shelley submitted that the observations of Dixon J. (as he was then) in *Goldman v. Bramley* (above) at page 724, were not good law. His Honor there suggested that if the Commissioner under Sections 42 and 44 allowed amendments which went beyond the scope of his directions under Section 42 the Court might examine the validity of his action. Mr. Shelley relied strongly upon the observations of Starke J. in the same case at page 720 where His Honour said that it was the function of the Commissioner and not the function of the Court to consider whether the amendments put forward by the applicant were within the ambit of the invention disclosed in the provisional specification, whether they complied with his requirements, and whether the application should be post-dated. But the observations of Dixon J. were concurred in by Evatt J., and although the Court was there dealing with the matter of the amendment of a provisional specification which arose for consideration upon an opposition under Section 56 (*d*) of the Act, I think the view of the majority judges does indicate that the Commissioner's decision to amend, or to amend and accept, could not be conclusive as to compliance with all the 40 50

provisions of Division 1 or even conclusive in all cases except cases of *mala fides* or absurdly extreme non-compliance therewith. I have considered the various observations in the High Court cases to which I have been referred, and I do not think that, with the possible exception of Starke J., who, if I may respectfully say so, long maintained a strong view as to the Commissioner's discretionary powers, any of the learned Judges said anything to the contrary of the view I have expressed. All such observations, including those of Starke J., were made with reference to the rights of applicants or other persons actually parties to proceedings  
10 before the Commissioner.

I am not impressed by the consideration that to open up as a possible ground of invalidity after acceptance disconformity of the type under discussion may give to a Defendant in infringement proceedings or a petitioner for revocation a ground of attack which would not be open to him as an opponent under Division 2, since it has long been the policy of the Patents Legislation to limit the grounds of opposition at the stage of the proceedings before grant within a narrower compass than the grounds available in revocation proceedings—see *Frost on Patents, 3rd Ed., Vol. II*, p. 50. This may be seen by comparing in the English legislation as it  
20 stood after 1932 the provisions of Sections 11 (setting out the grounds of opposition) and 25 (in which for the first time an attempt was made to particularise most of the possible grounds of revocation). I am unable to think that non-compliance with Section 8A of the English Act of 1907–32, containing provisions of the same general character as our Section 38, would not have been available as a ground for revocation under the drag-net provision in Section 32 of that Act, which preserved as a ground for revocation any ground available at Common Law for repeal by *scire facias*, notwithstanding that no such ground was particularised in Section 11 of the same Statute relating to opposition.

30 I am therefore of the opinion that the allegations of fact made in or under paragraph 4 of the Particulars of Objections, and paragraph 6 of the same particulars so far as it depends solely upon the same allegations, would constitute a good defence in law to the Plaintiff's claim to the extent to which they allege that the two sets of amendments purporting to have been made under Division 1 resulted in the invention ultimately claimed and embodied in the grant being substantially different from that described and disclosed in the initial complete specification.

I turn now to the second reason for which those allegations are said to constitute a good defence, viz., that the amendments resulted in the  
40 invention ultimately described and claimed being identical with the invention described and claimed in the Plaintiff's Letters Patent No. 122073.

At Common Law, as I have already shown, one of the grounds for *scire facias* was that the Crown had already granted a patent for the same invention to another person. None of the authorities refers to a case in which there was a grant of the same invention by a prior patent to the same person. But in my opinion it is not contemplated by the Patents Legislation at present in force here that there shall be two grants to the same patentee of patents for the same invention, even if they should bear the same date, and fortiori if they bear different dates. Though I have  
50 not been able to find that such a case ever arose, I should imagine that any

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Court would have held that if the Crown had made identical grants to the same patentee under patents of different dates the latter might be repealed. I am accordingly of opinion that in so far as the allegations above referred to allege that the amendment procedure under Division 1 resulted in an identity between the invention claimed in Letters Patent No. 133163 and the invention claimed in the prior Letters Patent No. 122073, they allege a good defence. It is true that it may be said that the allegations in question constitute a most cumbrous method of alleging what could more properly be alleged by merely pleading that the Letters Patent in suit were granted for an invention which is identical with the invention 10 the subject of a valid prior grant to the same patentee, viz., No. 122073. But I do not think that the form which they take prevents them from being regarded as a good defence so far as they allege that particular consequence of what was done. Mr. Menzies indicated that he would not welcome success on this ground alone. But the point arises, and I accordingly decide it.

I come next to what was said to be the third reason why the allegations referred to resulted in invalidity, viz., that there was produced an identity between the invention ultimately described and claimed with the invention described and claimed in U.K. Letters Patent No. 573747. I have already 20 in part referred to this matter when dealing with paragraph 6 in an earlier portion of this judgment. I am unable to see that the alleged result can constitute a separate ground of invalidity. There is no allegation that a Convention Patent issued in respect of the U.K. patent, so as to raise any question of prior grant in the Commonwealth in relation thereto. If the U.K. Patent were relevant at all, one would suppose that it would be relevant either for the purpose of some such allegation of false suggestion as I earlier hypothesised, and which is not made, or for the purpose of some allegation of want of novelty, which as I have also pointed out is not 30 made in relation to the effect of the U.K. Patent. In so far, however, as it may have been intended by the reference to this patent to rely upon it by way of an allegation of want of novelty, the point will be covered by what I am about to say in relation to the fourth of the reasons why the allegations in the Particulars of Objections are said to result in invalidity.

That reason is that the amendments made in the Office resulted in a patent for an invention which was not novel at the date of lodging of the respective sets of amendments. The pleading alleges that that lack of novelty was due to the prior publication of the complete specification of No. 122073 but I shall assume that it was intended also to rely upon the publication in Australia of U.K. Patent No. 573747. In my opinion the 40 allegations made do not constitute a valid defence upon this ground. The mere fact that by amendment something was introduced, which was not novel at the date of its introduction into the complete specification, does not under the Australian legislation invalidate the resulting grant. I agree with Mr. Shelley that an applicant, so long as he is still claiming something fairly disclosed in his initial complete specification, and so long as he is still claiming something which was novel at the date of his initial application, may introduce something taken at the time of amendment even from a newspaper. The test must be novelty at the date of the original application.

By the amending Act of 1932 in England, Section 25 (2) (1), express 50 provision was made for revocation on the ground of (*inter alia*) a particular



and limited case of disconformity between provisional and complete specification, i.e., when accompanied by want of novelty in the excess matter at the date of filing the complete. But disconformity between provisional and complete specifications was always a ground for revocation, and although the 1932 amendment in England was apparently intended in the main to codify the common-law grounds, the element of want of novelty at the date of the complete was a statutory addition inserted to improve the position of patentees—see Section 42 of the 1907 Act and Fletcher Moulton on Patents, pp. 101–3. But in any case, even if such a  
 10 want of novelty had at common law been material in a case of disconformity, that fact would have given no support to the argument that an amendment, not producing disconformity, could produce invalidity for non-novelty in the matter added by amendment.

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It is true that Fletcher Moulton on Patents, p. 281, in discussing amendment under what then corresponded with our Division 4, said that an amendment would not be allowed which incorporated subsequently acquired knowledge. He referred as authority for that proposition to *Re Beck v. Justice's Patent*, 1886, Griff. L.O.C., p. 10; which hold that such additional material could not amount to mere correction or explanation of the original  
 20 specification.

It would not appear that the opinion expressed by the learned author on the authority of that case has anything to do with an amendment under Division 1 which brings in to the specification something fairly disclosed by the original specification even though it may have been used in the meantime. After all, if it is really part of an invention which was novel at the original application date, the fact that the applicant has used it publicly before the amendment, or allowed other members of the public to use it, or even the fact that it has been independently discovered and used in the meantime, cannot render unjust the prevention of its use by  
 30 others once the applicant has a patent dating back to the original application date.

I come lastly to the fifth reason for which it is said the allegations in or under paragraph 4 should be regarded as establishing invalidity. It is said that the amendments which the Commissioner purported to allow were not responsive to the examiners' reports. I have said that I think Section 45 authorises an amendment with a view to removing the objection taken by an examiner under Section 41. An applicant might amend in some fashion which could not conceivably be regarded as being for that purpose. But unless the amendment produces some  
 40 consequence which otherwise contravenes the Patents legislation and contravenes it in a manner which goes to validity in some other respects, I do not think it can be said that the mere making of an amendment which is not responsive to the report will of itself constitute a breach of a condition precedent to the validity of the ultimate grant. It seems to me that the appositeness of the amendment to the objection taken by the examiner is a matter that can be dealt with in the Patent Office and that the public is not subsequently concerned therewith unless the amendment results in some other defect than a mere departure from the point made by the examiner. If of course that departure has the conse-  
 50 quence that a man who has applied for a patent for one invention

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ultimately gets a patent, dated as of the date of his original application, for a different invention not fairly disclosed at the time of his application, that is an entirely different matter. But that would fall to be dealt with in relation to the first of the five reasons for invalidity which I have been considering and would not show that this fifth suggested reason is an independent reason.

In the result therefore I am of the opinion that the allegations referred to in the question of law set down—which question incidentally I treat as referring to such allegations in their now amended form—constitute a good defence in law to the Plaintiff's claim to the extent, and to the extent only, that they allege that the allowance of the amendments produced a patent for an invention not fairly disclosed in the original complete specification or a patent for an invention identical with the invention the subject of Letters Patent No. 122073. My decision does not involve the necessity for investigation of any of the examiner's reports, and I agree with Mr. Gillard that the making of the consent order under Sec. 51 has in the result been unnecessary. I agree with him also, on consideration, that it would be preferable that the Court should not make such orders merely by consent of parties, but only after notice to the Commissioner, and, if he so desires in any case, after hearing him.

There will accordingly be judgment on the question of law set down in accordance with the following minutes :—

(1) Adjudge and declare that the question of law set out in the order dated the twenty-fifth day of November 1952 be answered as follows, viz., "The said allegations set out in paragraph 4 of the said particulars of objections as amended on the fifth day of June 1953 and in paragraphs 1 and 2 of the said further Particulars of Objections, so far as the same are allegations of fact, and paragraph 6 of the said Particulars of Objections so far as it depends exclusively upon the aforesaid allegations of fact, constitute a good defence in law to the Plaintiff's claim herein to the following extent only and not otherwise, viz., so far as they allege that the effect of the amendments therein referred to or either of them was that the complete specification of the Letters Patent No. 133163 in its final form claimed an invention

(A) substantially different from the invention described and disclosed by the complete specification originally lodged with the application dated the thirty-first day of December 1943, or

(B) identical with the invention described and claimed respectively in the complete specification of Letters Patent No. 122073.

Paragraph 5 of the said Particulars of Objections, so far as it depends exclusively upon the said allegations of fact, does not constitute such a good defence.

(2) Reserve the question of costs of the argument upon the said question of law, including the costs of the Commissioner.

(3) Leave to either party to appeal from this judgment.

(4) This order to be passed and entered forthwith.

I think the question of costs should be reserved until it becomes apparent whether or not the Defendant has in fact gained anything by the limited extent to which I have upheld its contentions.

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In accordance with the order for directions which I made on the 17th March last, paragraph 2, I shall now proceed to determine whether such of the aforesaid allegations as would constitute a good defence according to the judgment I have just delivered are in fact established. Whether I am to determine that upon documentary evidence only, or also upon technical or other oral evidence, is a question which may be  
10 left until I am further informed as to the nature of the invention or inventions involved. I should appreciate the continued assistance of the Commissioner in relation to that branch of the case.

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JUDGMENT on Question of Law.

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THIS ACTION having come on for trial before this Honourable Court without a jury on the 1st, 3rd, 4th, 5th and 8th days of June 1953 AND UPON HEARING Mr. Phillips one of Her Majesty's Counsel Mr. Shelley one of Her Majesty's Counsel and Mr. Pape of Counsel for the  
20 Plaintiff Mr. Menzies one of Her Majesty's Counsel and Mr. Gilbert of Counsel for the Defendant and Mr. Gillard one of Her Majesty's Counsel and Mr. McInerney of Counsel for the Commissioner of Patents AND UPON READING the Pleadings herein and the Order of this Honourable Court made on the 25th day of November 1952 THIS COURT DID ORDER that the question of law stated in the said order should stand for judgment and the same standing for judgment this day THIS COURT DOTH ADJUDGE AND DECLARE that the question of law set out in the order dated the 25th day of November 1952 be answered as follows viz. :—

30 The allegations set out in paragraph 4 of the Defendant's Particulars of Objections as amended on the 5th day of June 1953 and in paragraphs 1 and 2 of the Defendant's Further Particulars of Objections so far as the same are allegations of fact, and paragraph 6 of the said Particulars of Objections so far as it depends exclusively upon the aforesaid allegations of fact, constitute a good defence in law to the Plaintiff's claim herein to the following extent only and not otherwise, viz., so far as they allege that the

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effect of the amendments therein referred to or either of them was that the complete specification of the Letters Patent No. 133163 in its final form claimed an invention

(A) substantially different from the invention described and disclosed by the complete specification originally lodged with the application dated the 31st day of December 1943

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(B) identical with the invention described and claimed respectively in the complete specification of Letters Patent No. 122073

AND that paragraph 5 of the said Particulars of Objections, so far as 10  
it depends exclusively upon the said allegations of fact, does not constitute such a good defence AND THIS COURT DOTH ORDER that the question of costs of the argument upon the said question of law including the costs of the Commissioner be reserved AND that either party be at liberty to appeal from this judgment AND that this judgment be passed and entered forthwith.

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No. 30.

**REASONS FOR JUDGMENT of Sholl, J., that Defence raised by Question of Law had not been Established.**

MARTIN *v.* SCRIBAL PTY LTD.

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Action No. 58 of 1951.

On Monday last, upon a question of law set down for argument, I held that the allegations set out in paragraph 4 of the Defendant's Particulars of Objections, as amended, and in paragraphs 1 and 2 of its Further Particulars of Objections, so far as the same were allegations of fact, and paragraph 6 of the said Particulars so far as it depended exclusively upon the aforesaid allegations of fact, constituted a good defence in law to the Plaintiff's claim in this action so far only as they alleged that the effect of the amendments referred to in the Particulars and Further Particulars, or either of such amendments, was that the complete specification of Letters 30  
Patent No. 133163 in its final form claimed an invention—

(A) substantially different from the invention described and disclosed by the Complete Specification originally lodged with the patentee's application, dated the 31st December, 1943, or

(B) identical with the invention described and claimed respectively in the Complete Specification of Letters Patent No. 122073.

Mr. Menzies announced that the Defendant would not contend that the evidence available to him was capable of sustaining the defence covered by

sub-paragraph (B) of what I have just recited, and accordingly, in accordance with the directions given by my order of March 17th last, I entered upon the trial of the issue whether in fact the Defendant could establish by evidence the defence covered by sub-paragraph (A).

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10 It became apparent in the course of the hearing of evidence and argument upon that issue that the declaration which I had made in answer to the question of law originally posed would require itself to be interpreted, or to be made to condescend upon further definition, with respect to the phrase, "the invention described and disclosed," as used in sub-paragraph (a) thereof. This is perhaps not surprising in view of the fact that the question of law was argued without reference to, and without my having seen, the documents upon which the question arose. The Defendant's Counsel had opposed that course, but it was in my opinion the right one, since it enabled the general questions of construction of the Statute to be considered and decided by a tribunal whose mental processes could at least not be affected by any preconceived notions arising from a perception of what has in fact now turned out to be the somewhat unusual nature of the amendments effected in relation to this patent. But the evidence and argument thereon have since demonstrated an ambiguity  
20 in the particular phrase to which I have referred.

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Mr. Menzies contended that an applicant could not be said to have "described and disclosed" an "invention," for the purpose of the comparison hypothesised by my judgment, save with respect to so much of the contents of his original complete specification as he therein stated or asserted to be inventive on his part. Mr. Menzies did not go so far, I think, as to say that the characteristics of "description and disclosure" could be predicted only of the contents of the final "claims," in the technical sense, of the original complete specification, but he did say that they could be predicted only of so much as could be said to be stated or  
30 asserted by the applicant in the whole of the original complete specification to be inventive in the same sense as it had been held that an invention might be said to be originally "claimed" for the purposes of considering a Division 4 amendment, i.e., it must be asserted to be and put forward by the inventor as being upon a reading of the body of the original specification, together with the technical claims, his invention. He referred, as authority for that conception of a "claim to an invention," to *May & Baker Ltd. v. Boots Pure Drug Co. Ltd.*, 65 R.P.C., 255, 66 R.P.C. 8, 67 R.P.C. 23, and particularly to the judgments of Jenkins, J., in the court of first instance, 65 R.P.C., at p. 294, and of Lord Greene, M.R., and Evershed, L.J., in the  
40 Court of Appeal, 66 R.P.C. at pp. 13 and 21 respectively, and to the opinions of Lords Simonds and Normand in the House of Lords, 67 R.P.C., at pp. 28 and 35, respectively.

In that case, the Courts were dealing with an application for amendment made after grant, and during revocation proceedings, under Sec. 22 of the English Patents Act 1907-46, the counterpart of which in the Commonwealth Act, in a general sense, is Section 81, to be found in Division 4. There are differences in arrangement between the two Statutes, and the power of amendment here is limited in such a case to disclaimer only; but, since Sec. 81 refers back to Sec. 80, which in turn  
50 brings in Secs. 71-79, there is no difference which is material for the purposes of the present discussion. Sec. 22 of the English Statute provided

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(so far as here material) that in revocation proceedings the court might by order allow the patentee to amend his specification (i.e. his complete specification) by way of disclaimer, correction, or explanation,—provided that no amendment should be so allowed that would make the specification as amended *claim* an invention substantially larger than, or substantially different from, the invention *claimed* by the specification as it stood before the amendment. I have italicised the two references to a “claim” in the proviso. One point about this proviso was common ground in that case, and it is summarised by Lord Normand, 67 R.P.C., at p. 35, l. 46—

“There are two terms of comparison, the invention claimed in the amended specification and the invention claimed in the un-amended. It is agreed that the inventions referred to are not the inventions as they are claimed in the ‘claims’ at the end of the respective specifications, but the inventions asserted by each specification read and construed as a whole, including the body of the documents as well as the ‘claims’ at the end.”

That is where Mr. Menzies got his expression “asserted.” Another point to be noted about the proviso is that the application of the prohibition against substantial difference to amendments by way of disclaimer (cf. Sec. 78 of the Commonwealth Act), since it is to be tested by a comparison of “claims” in the sense above-stated, involves the well-known difficulty referred to by Jenkins, J., in the following words, 65 R.P.C., at p. 294 :—

“It is also to be observed that the language of the section shows that the effect of an amendment may be to make the invention substantially different for the purposes of the section without making it substantially larger, and at the same time suggests that disclaimer (which *prima facie* connotes a process of reducing the invention or in other words making it smaller) may be such as to produce a substantially different invention.”

Now it was said by Mr. Menzies that such authorities on the construction and application of what I have called, since I am dealing with the Commonwealth Act, Division 4 amendments, are applicable by analogy to the question which I have to determine with respect to Division 1 amendments,—applicable, that is to say, both for the purpose of determining what are the “terms of comparison,” to use Lord Normand’s phrase, and for the purpose, where they are ascertained, of determining whether they are substantially different.

It follows that Mr. Menzies contends that, for the purposes of Division 1 as I have construed it, an invention is not “described and disclosed” unless it is “asserted” as such in the above-stated sense. It need not, that is to say, be actually claimed in the claims, but it must be asserted to be inventive. That is to say, if he is right, the only amendments which under Division 1 could be made in a complete specification, by way of adding to the actual claims, would be by the inclusion of something which the inventor had initially asserted in the body of the specification to be inventive, but for some reason had not embodied in the actual claims.

Mr. Menzies was disposed, I think, to put as an alternative the contention that at least there could not be introduced into an amended claim, 50

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under Division 1, something which in the body of the initial complete specification the applicant had either expressly stated to be old, or expressly disclaimed. At one stage of his argument, he further sought to say that everything not expressly claimed in the initial document was impliedly disclaimed. But that proposition, as he conceded, is usually put forward in relation to the interpretation of the claims proper in a final complete specification; and if applied to an original complete specification, would result, as I think Mr. Menzies recognised, in an inability to amend the "claims" proper except by leaving one or more of them out, or reducing  
 10 any individual claim by further disclaimer.

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Mr. Menzies also relied on a suggested analogy between Division 1 amendment cases and cases on (A) Convention disconformity, or (B) disconformity between provisional and complete specifications. As to the former class, he referred particularly to *Electrical and Musical Industries Ltd. v. Lissen Ltd.*, 56 R.P.C. 23, especially the speech of Lord Wright at pp. 47 *et seq.*; and *May and Baker Ltd.*'s case itself, in which the issue of Convention disconformity was also decided adversely to the patentees. In those cases, and in the intervening case, *Re British Celanese Ltd.*, 58 R.P.C. 81, referred to by Mr. Gillard, the question was whether the  
 20 "invention claimed" in the complete specification was or was not "the same as that for which protection had been applied for in the foreign State," with the additional feature that in the two later cases Section 91 (2B) of the English Act, added in 1938, provided that the measure of the protection applied for in the foreign country was to be the disclosure contained in the whole of the documents put forward at the same time as and in support of the application in the foreign country, and of which copies should have been left at the British Patent Office as prescribed. In the earlier case, Lord Wright had held that the protection applied for was to be ascertained  
 30 by reference to the foreign claims (where claims were required), and said that even if the word "describe" was used in practice to refer to the claim to protection, it must in that connection mean "describe as the invention"; see 56 R.P.C., at p. 49. In the *May and Baker* case, where Section 91 (2B) of course applied, the Courts all held, in effect, that the conclusion of convention disconformity was *a fortiori* to the conclusion of substantial difference under Section 22. But in that case no question, I think, arose of any "disclosure" in the foreign patents, in the statutory sense, being available to supplement or expand something expressly claimed in them; see Jenkins, J., 65 R.P.C., at pp. 289-90, 299. At the most, as it seems to  
 40 me, those cases can be relied on by Mr. Menzies only as showing (1) that Lord Wright, before the enactment of Section 91 (2B), would have regarded the word "describe," if used to express the same conception as "protection applied for," as meaning "describe as the invention"; and (2) that by Section 91 (2B) the legislature required the measure of protection applied for abroad to be the disclosure, and no longer the mere technical claims, in the foreign application documents. In deed, Maugham J. (as he then was) in the *British Celanese* case, 58 R.P.C., at p. 86, observed—

"If one finds, on perusing the whole of the documents mentioned in sub-section (2B), that an invention is described in clear terms in the Convention document, and that some measure of protection is sought for that invention, then the applicant is entitled to a patent  
 50 in the United Kingdom for that invention, with the priority

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mentioned in Section 91. It matters not that when applying for protection in the Convention country the applicant has, by inadvertence or by design, claimed for that invention a protection which is less extensive than the protection for that invention which he might have claimed. If he seeks a patent for the same invention in this country, he is entitled to a patent which gives him, in this country, all the protection which he might have claimed in the Convention country, and he is entitled to have for that patent the priority mentioned in Section 91."

Those cases by no means indicate that for all purposes of patent law in 10  
general, or for the purposes of Division 1 amendment in particular, either  
"disclosure" or "description" of an "invention" necessarily means and  
means only such disclosure or description as contains or is accompanied  
by an assertion that the matter disclosed or described is inventive.

With regard to disconformity with a provisional specification, Mr. Menzies relied particularly on *Dunlop v. Cooper*, 7 C.L.R. 146. That case did no more, in effect, than adopt the well-known test of Lord Chelmsford, L.C., in *Penn v. Bibby*, L.R. 2 Ch. 127, at p. 132—"if the claim in the complete specification is comprehended within the terms of the provisional specification that issue will be satisfied." 20

The question in the end, I think, comes back to the question whether "disclosure" and "Description" should be held to be restricted to what is asserted in the initial complete specification to be inventive. Mr. Menzies argued that according to any of the suggested tests this patentee had not "described" or "disclosed" the invention claimed in the amended complete specification.

Mr. Shelley, while contending that the original complete specification in this case did both "disclose" and "describe" everything claimed in the ultimate complete specification as amended, in the sense of asserting it to be inventive, even if not in the sense of claiming a monopoly in it by means 30  
of the technical claims, argued in the alternative that Mr. Menzies' suggested tests were not the correct tests under Division 1. If, he said, an inventor described and disclosed something which was in fact an invention, then, whether he "asserted" that more of his supposed discovery was inventive than was in fact inventive, or that less of it was inventive than was in fact inventive, he could in the end by amendment under Division 1 (assuming objection by an examiner) claim as his invention what was in fact his invention. Whichever way he had erred did not matter. He relied on *Re I. G. Farbenindustrie A.G.*, 48 R.P.C., 190, so far as it was a decision of the Assistant Comptroller General, though at that time reversed by the 40  
Law Officer, and *Re Andreas*, 51 R.P.C. 188, in which Luxmoore, J., restored the authority of the Assistant Comptroller General's earlier decision.

In the earlier case, Mr. Haycraft rejected an application on the ground of Convention disconformity. At p. 193, in describing the current British Office practice, he said:—

"So far as the question of the claims permitted in the British specification is concerned, practice has tended towards an increasing liberality. The present practice is to allow any claims to be made which would be allowed during the progress of the application to an



applicant who made an ordinary application in this country accompanied by a complete specification identical with the specification which was filed abroad. The applicant is in fact put in the same position as if he had applied simultaneously here and abroad, and had therefore no occasion to claim any priority. This means, in practice, that he may frame any claims that reasonably and fairly rest upon the subject matter that he has described. But when is it borne in mind that an application made in this country under the International Convention must be accompanied by a complete specification, it will be seen that principle of 'presumptive simultaneity' while giving to the Applicant the most liberal treatment possible as regards the scope of his claims, operates with considerable stringency as regards any variation in the manner in which he describes his invention. An ordinary applicant who files a complete specification in the first instance is not permitted to amplify it afterwards, except in so far as the Examiner may call for amplification; and if the Examiner does make such a demand there is always the possibility that the question of post-dating may arise. If the applicant is to be treated exactly as if he had lodged his specification here simultaneously with his application abroad, it follows that while his statement of claim can be freely recast as a result of the official search, or otherwise, the description of his invention must be the original description (as filed abroad) except in so far as amendment is called for by the British Patent Office."

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In the later case, Luxmoore, J., refused a grant on the ground of Convention disconformity, and referred with approval to Mr. Haycroft's statement of practice. Both cases were really concerned with the question whether the doctrine of legitimate development, applicable to provisional specifications in England, was applicable to a Convention application based on a foreign complete specification, and held that it was not. What was said as to practice was said incidentally only, but it may be compared with what was said in *Re Serex* and *Re Contant*, as cited in my earlier judgment.

Those cases do not appear really to decide the further point which I have now to consider. It must, I think, be decided upon a consideration of the scope and purpose of the amendment procedure under Division 1. In my opinion different considerations apply from those which are relevant to an examination of the scope and purpose of the legislative provisions with regard to Division 4 amendments, and Convention disconformity. The considerations which by way of analogy are most helpful are those which are relevant to disconformity with a prior specification, though even there the considerations are not identical.

Division 4 amendments, though undoubtedly permitted in aid of the patentee, must be regarded in the light of the fact that the procedure, while it may apply before acceptance, is, in much the greater number of cases, invoked after acceptance and indeed after grant. It may be invoked years after grant. Cases decided with relation to it are decided with reference to what the Statute directs, viz., a comparison of "claims," and with reference to the statutory intimation that substantial difference may exist notwithstanding reduction by disclaimer. A comparison of

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“claims,” even in the more extended sense of “assertions,” connotes a comparison of what, in the case of each of the two objects of comparison, is by the inventor alleged to be inventive—i.e., recognised and believed and stated by him to be inventive. Even under that procedure, *Re Thomson’s Patent*, 51 R.P.C. 541, to which Mr. Shelley referred, shows that a feature of an invention may be “claimed” though not mentioned in the words of the body or the claims of the complete specifications, but shown only in a drawing. Convention disconformity, again, depends on judicial and statutory interpretation of what amounts to an “application for protection”—not at all necessarily the same question 10 as I have to consider.

Disconformity with prior specification does involve a more analogous problem. The general trend of the cases on that topic has, I think, been more generous to a patentee, even before the amendment effected in England by Section 42 of the 1907 Act, than has that of Division 4 decision.

Consider how the matter may work out in practice. After all, Division 1 is designed to secure that an inventor’s complete specification is brought to a state where it complies with the Act in relation to the requirements of form and novelty. *Ex hypothesi* it may commence without complying with either, subject to the limits which I endeavoured last 20 week to define. The whole theory of our system of licensed monopolies under the name of patents is that inventors are useful people who should, subject to proper safeguards, be encouraged, and the Patent Office rightly regards itself as being by Division 1 placed under a duty to assist an applicant to find out what is new in what he believes he has invented and to describe and claim it in accordance with the law—see *Re Coutant*, cited at p. 35 of my earlier judgment. Suppose A describes in his initial complete specification X, Y and Z; says Y and Z constitute an invention; and claims them in his claims. The investigation for novelty may show 30 that Y is the subject of a prior application, and that there is nothing in merely adding it to Z. A can excise it from his claims, and in the body of the specification delete his statement that it is part of his invention; he may even expressly disclaim it. The result—a patent for Z—is not for what he originally “asserted” to be his invention, but it is for the actual invention he so disclosed. It may be substantially different from what he asserted. Hence I do not consider that substantial difference between the invention asserted before and after amendment, respectively, can be a general test of what falls outside the permitted limits of a system which includes Sections 41 and 45.

But a less extensive argument, than that of Mr. Menzies might perhaps 40 be put. It might be said that an amending applicant, though bound (as I have held) not to produce substantial difference from his original disclosure, might be permitted substantial difference from the original assertion of invention, so long as such difference was by way of reduction only, but not otherwise. It might then be said that this applicant had in part reduced his assertion (by bringing in the particular form of feed duct) and in part extended it (by omitting the limitation of a reservoir with a series of sections). This would be a more formidable argument. Suppose then that, in the example I was discussing, the examination shows not only that Y cannot be claimed, but that X and Z could, though X (described 50

from the beginning) has not so far been asserted to be inventive. A may expressly have disclaimed X, or expressly said it was well-known. Whether he should amend then to assert that X was inventive, and to Claim X and Z, I need not, I think, finally decide. Mr. Shelley argued that he could ; that he could be said to have "disclosed" and "described" X, though erroneously excluding it from his invention, and that an amendment to include it would only be "correcting" an error. Whether that would be so, at all events in the case of a complete specification opened to inspection under Section 38A, may be a difficult question. But if, as to X, he had

10 described it, but merely omitted to say expressly that it was inventive, and neither expressly disclaimed it nor said it was old, why should he not be allowed to include it by amendment in his "consistory" statement and in his claims? Since an initial complete specification is "purely tentative" (*Re Coutant*), any implied disclaimer is likewise tentative. It may indeed be argued that even any express disclaimer and even any publication under Section 38A of an express disclaimer, is likewise tentative.

But if A has merely made as to X an ambiguous statement, which is capable of meaning either that it is part of the invention or that it is not, and A has claimed only Y and Z in his "claims," I should have thought

20 that, on it appearing upon investigation that X and Z were inventive and patentable and Y was not, the very purpose of Sections 42 and 45 was to enable the complete specification to be amended to make it clear that X and Z were the invention and were claimed. It follows that in my opinion an invention is "described and disclosed" if there is in the initial complete specification a description and a disclosure of what in fact is inventive, even if at that stage the inventor does not, or does not clearly say so—at all events if he does not clearly and expressly say the contrary.

The next question which I must consider is the extent of the material upon which I am to determine in this case whether amendment went

30 beyond its proper limits. There are in evidence, without objection, the original complete specification of No. 133163, as lodged on the 31st December, 1943 (Ex. C)—and the complete specification as accepted, upon which the grant was made (Ex. B). But Mr. Menzies tendered four other classes of documents, two of which I admitted subject to objection. These were the printed complete specification of No. 122073, dated 8th December 1943 (Ex. 1, subject to objection); the various documents formulating amendments, from 18th December 1946 to 16th May 1949, both dates inclusive, and in portions of which the amendments ultimately

40 accepted are to be found (Ex. 2, subject to objection); the actual examiners' reports referred to in the particulars of objections (which I rejected); and the communications from the Patent Office to the applicant of the substance of those reports (which I also rejected). The first, second and fourth classes of documents were all tendered upon the ground that their contents were admissible for the purpose of construing the two complete specifications which had ultimately to be compared. The examiners' reports were tendered upon a different ground, and I need say no more about them than I said at p. 150 of the transcript. As to the other three classes of documents, I rejected the fourth, and although I admitted

50 the first and second subject to objection, I stated at the time that my view then was that they should ultimately be rejected. The ground upon which I rejected the one and indicated a disposition to reject the

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others was that the two documents which had ultimately to be compared must be construed according to the meaning which their language alone would convey—not, it is true to the uninitiated in the art—but to the initiated reader, unassisted by a knowledge of other documents known only to the Patent Office and the applicant.

But in the course of his later argument, Mr. Menzies referred to *May and Baker's* case, in which Lord Normand, for one, when discussing the method of comparison required by Section 22 of the English Act, in relation to what I call a Division 4 amendment, said there were two steps—first, a construction of the unamended document and the amended 10 document, respectively, and at that stage extraneous evidence was inadmissible, according to well-known principles; and secondly, a comparison of the “inventions” thus respectively found to have been “claimed”—at which stage extraneous evidence, including evidence as to what was or was not the “inventive step” disclosed by each document, might be availed of. Now in *British Celanese Ltd. v. Courtauld's Ltd.* 50 R.P.C. 63, Clauson J., upon a question of subject matter and therefore of “inventive step,” admitted evidence of the actual amendments formulated from time to time, and also of the citations of prior patents made by the examiners in the course of the examination. He admitted those facts as being 20 possibly relevant to the question of inventive step, on the basis that they might go to show that the inventor had himself altered his mind about what his invention was—i.e., as I understand the decision, on the basis that they tended in effect to prove admissions by him that what he was saying at the trial was the inventive step was not what he had earlier thought or said to be the inventive step at all. Now it was said by Mr. Menzies in his final address that the same kinds of documents could be looked at here, because at the stage when one was comparing the two “inventions,” after construing the documents, one must have regard to whether there was a difference in inventive step alleged. That is quite a different ground 30 from that on which Mr. Menzies supported the earlier tender of the documents—at least, if he put such a ground at the time of tender, I did not appreciate it. But I shall deal with No. 122073, the various amendment sheets, and, for that matter, with the rejected correspondence, as if he had urged such a ground.

If I were here required to make a comparison such as must be made under Section 78, between the inventions “claimed” by the respective documents, I should be of opinion that all the documents must be admitted and considered, on the authority of the analysis by Lord Normand and others in *May and Baker's* case of the process required by that provision. 40 But, thinking as I do that under Division 1 the task if one of comparing an original disclosure with an ultimate claim, I am of opinion that what the inventor did or did not consider to be the inventive step at each stage is not the test, save so far as, upon the language of the two crucial documents, it has affected what he actually originally disclosed and what he actually ultimately claimed, respectively.

Mr. Menzies submitted a further argument that the amendments in Ex. 2 when examined, were to be construed as having each become effective upon lodgment, under Section 45. I need not pursue all the alleged consequences of this argument, for two reasons. In the first place, I do 50

not think amendments under Section 45, not accepted by the Commissioner, can be irrevocable. If an applicant, having made (and, I will assume, made effectively and instantaneously, independent of acceptance) an amendment to his original complete specification, finds it not acceptable, why should he not amend again by deleting that, and making another amendment instead? And what is that but a method of proffering amendments, which are revocable, or further amendable, until acceptance? It cannot be said even on Mr. Menzies' hypothesis of immediately effective amendments, that, having made before acceptance an amendment which goes beyond Division 1 (and is therefore *ultra vires*) and being so told by the examiner, the applicant has thereby destroyed his whole document, has lost his whole invention, and is forever outside the Act.

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But in any case, the Commissioner as Mr. Gillard explained, adopts a practice of inviting proposals by correspondence of amendments to meet examiners' objections. Hence all but the first of the documents in Ex. 2 are headed "proposed amendments." Such proposals are regarded as tentative only until agreement is reached; the amendments which will be acceptable are then made, and the matter proceeds at once to acceptance. I do not see any reason why such a practice, which appears to be in accordance with convenience and commonsense, should not be adopted. Accordingly, in case another Court may hereafter disagree with my view about Mr. Menzies' submission as to the effect of amendment under Section 45, I should say that I find as a fact that all but the first document in Ex. 2 were tendered as proposed amendments, and not as immediately effective amendments, and none was actually effected, or treated as effected, till acceptance. As to the first document, that of 18th December, 1946, it bears the appearance of a document constituting an immediately effective amendment by complete substitution. But I am told by Mr. Gillard that other documents show that not to be so. If I had thought the question material, I should have given the parties an opportunity by further evidence to ascertain the precise status of the document.

I accordingly turn to compare only the original and the final complete specifications.

In the final document, there are nine claims. All but the last are tied to Claim 1, which is accordingly the most important. It claims an instrument of the type specified—*scil.*, specified in Col. 1, ll. 11–21, and which I may shortly refer to as a ball-point writing instrument supplied with ink from a reservoir. I now resume my statement of the claim, but I number and sub-head the elements claimed. It claims (as I read it) an instrument of the type specified, with five characteristics:—

(1) Such instrument having an ink reservoir—

(A) constituted by a vented tube—i.e., a tube open to air at the end remote from the ball (see col. 2, l. 18),

(B) of capillary size (defined in col. 2, ll. 8–21),

(C) in which, when charged with viscous ink a continuous liquid vein is maintained extending from the ball; and

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(2) Such instrument also having a feed duct—

(A) Leading from the reservoir to the ball,

(B) The cross-sectional area of which duct, particularly that portion, adjacent to the ball, being (*scil.*, is) less than that of the reservoir.

There are thus five essential elements in claim 1, two relating to the feed duct. Claim 2 claims an instrument according to claim 1, in which the tube is open to atmosphere at one end. That seems to be already covered by claim 1. Claim 3 claims an instrument according to claims 1 or 2, in which the tube is formed into limbs, substantially parallel to the longitudinal axis of the instrument. The purpose of this, which is said (col. 2, l. 22) to be a "preferable" form, is to accommodate more ink in a longer tube. Claim 4 claims an instrument according to Claim 3, in which the open end of the tube is directed towards but does not extend to the ball. The object clearly is to provide an additional means of preventing leakage when the pen is inverted and held upright in a pocket. Claim 5 claims the feature of a removable reservoir within the body of the instrument, and claim 6 claims the formation of the tube by a duct formed in a body, but each claims such feature only as a feature of an instrument according to the preceding claims. Claim 7 claims another form of an instrument according to claims 1-6, in which the series of parallel ducts is produced by channels made in the body of the instrument itself—presumably by boring or moulding. Claim 8 claims an instrument according to any of Claims 1-7, when charged with viscous or semi-fluid ink. Claim 9 claims an instrument substantially as described with reference to the accompanying drawings, but this closely accords with Claim 4. 10 20

The scientific evidence establishes that such an instrument does not leak, but gives a long supply of ink, because capillary forces so operate that the meniscus formed at the annular surface between the ball and its housing, being more curved than the corresponding meniscus at the opposite and vented end of the reservoir, sustains (within any practicable limits of length of tube) the latter surface against breaking on account of gravity due to the weight of the column of ink while at rest or in ordinary use, and the viscosity of the ink further operates to prevent such break up being occasioned by more powerful forces due to shock or other violent movement, but the duration of which is insufficient to overcome the stability of the surface due to such viscosity. 30

Now, as pointed out by Harman J. in *Martin v. Selsdon Fountain Pen Coy., Ltd.* 66 R.P.C., at pp. 208-210 and 213, that result is apparently obtained, within the limits of a capillary tube as defined in the complete specification, whether the tube or reservoir is a single straight one, or is helical, or is made up of a number of straight lengths as in Fig. 1; and Claim 1 is wide enough to claim such an instrument irrespective of the shape of the reservoir, save for the two requirements as to the feed duct. Neither the feed duct itself, nor the requirement as to its lesser cross-sectional area, is in any way necessary to make the pen work. It is a useful way of enabling a 1 m.m. diameter ball to be used (that being a convenient size for writing) with a reservoir of up to 4 m.m. diameter, which will hold more ink. But it is obvious that, as Mr. Shelley pointed 50

out, the small ball could still be used if a grid were placed at the end of the wider reservoir, and there were no narrower duct at all. Presumably also, exactly the same result could be achieved by terminating the reservoir at the ball housing, and so constructing the housing that the ball projected forwards of one of its faces, and backwards of the opposite face into the reservoir—in each case through a circular aperture of appropriately less diameter than the ball. Neither method would infringe any of the claims; consequently the two features relating to the duct are limiting and narrowing provisions. The first set of amendments (1946) in fact  
 10 proposed to cover a duct of equal or lesser cross-section.

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Let me now compare those claims with the description and disclosure made in the initial complete specification.

In some portions of that document the draftsman writes as if he conceived that the invention resided in a method of achieving, with simplicity and effectiveness, a substantial length of reservoir, and corresponding amplitude of ink supply, in ball-point fountain-pens which worked on the known principle of a capillary duct providing a reservoir of dense ink, and that the inventive method was to use a reservoir made up of a number of longitudinal sections joined by bends (if a single tube was bent  
 20 to the required shape) or grooves (if borings in a solid body were used to get a similar result). I agree with Mr. Menzies that the draftsman, at the commencement of the specification, appears to regard the principle of operating a ball-point pen by a capillary duct, providing a constant fluid vein, as an existing *datum*, and not itself a part of the particular inventive discovery which the application was currently directed to protect.

Thus on page 1a, l. 1, he refers to fountain pens “of the kind which comprises an ink reservoir formed by an extension of the channel for supplying the writing point with ink,” as if he is dealing with a known  
 30 type. He then, at l. 7, says—and the italics are mine—

“In fact, the extension of the feed channel for constituting the reservoir by means of a duct of small section allows of establishing a fluid vein of constant position, after the manner of an automatically replaceable lead rod in a pencil, *but*, in the provision of a duct of a certain length adapted to be fed with a relatively ample amount, several *difficulties* are encountered, owing to the necessity of arranging the duct in a winding or meandering form, or of otherwise arranging the same in such a way that it will occupy to the largest possible extent the capacity of the holder of the instrument.  
 40 *In accordance with this invention, these difficulties are overcome* in a rather simple way, thereby allowing of the manufacture of fountain-pens at a low cost, and adapted to receive a charge of considerable yield and duration.”

There is then described a feed channel of several sections connected together, longitudinal and preferably parallel to the axis of the pen. These, it is said (as I read the document at that point), are provided for the purpose of meeting the difficulties referred to. Reference is made at p. 2, l. 21, and also on page 5, l. 22, to the method of directing the air intake end of the tube towards the point of the pen to overcome the  
 50 influence of gravitation when the pen is reversed (cf. Claim 4 of the final

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document). On page 4, l. 9, reference is made to the reservoir being formed by a duct, “*but* comprising the several particular features which constitute the basis of this invention.”

So far, I think, one would regard the document as proceeding upon the basis that the inventive step resided in the particular form of the duct.

But from p. 4, l. 12, when the draftsman sets out to describe the “particular features,” the description alters in character. At l. 17, it is said that the ducts are so connected as to form “one single channel commencing at the inlet or air intake 6 and ending at the feed duct 4 10 of the sphere 3—In the embodiment according to Fig. 1, the reservoir *b* is formed by a duct or tube of the capillary type, which, being connected to the feed channel 4, extends parallel to the holder *a*, and as the tube is folded several times by a bend through 180°, the same will form a group of reduced length formed by several sections 5—the duct which forms the reservoir *b* is filled with a dense or semi-fluid ink, thus establishing a fluid vein extending from a point near the inlet or air intake 6 to the sphere 3, which is thus maintained in contact with the ink, in order that when causing the same to roll over a suitable surface, the sphere held by the mounting 2 will mark the strokes with the ink supplied from the channel 20 containing the said liquid vein.” On page 6, l. 20, this is said—“From the foregoing description, it will be seen that the invention substantially consists in the provision of sectional ducts 5, arranged as a whole to form a series or group, by means of bends or passages 5, said duct sections communicating in series, one in continuation of another, so that the whole of duct sections will form one single duct, commencing at an inlet hole and ending at a feed duct 4, connected to the mounting of the sphere, said duct constituting the reservoir *b*, to be filled with a dense or semi-fluid ink and to form therewith an uninterrupted liquid vein, extending to the mounting 2 of the sphere 3.” 30

Now the words from and including the expression “so that” as a matter of grammar, describe a consequence, but are capable of being read in the context as stating such consequence as part of the inventive concept. On the other hand, the earlier treatment of the matter may suggest that the stated consequence is a known result produced by new means.

All the claims, from 1–10, claim a fountain pen characterised by a reservoir formed of a duct consisting of a series of sections, together with ways of achieving that result. Claim 3 also claims the feature of an air intake directed towards the point of the pen (cf. claim 4 of the later document). But Claim 11 is in these terms— 40

“Fountain-pen, in which the duct which constitutes the ink reservoir consists of a series or group of duct sections, connected together and communicating in series by means of communication passages extending from one section to another, so as to form one single duct or channel, extending from an inlet open to the air, to the feed channel of the stylographic point, with a charge of dense ink filling the entire extension of said general duct formed



by said sections, said charge constituting an uninterrupted liquid vein extending to the stylographic point, all as above described, for the purpose set forth and with reference to the accompanying drawings.”

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The words “so as” in this claim may be compared with the words “so that” in the passage on page 6. Now this claim, though limited to a reservoir with a plurality of limbs in series, is capable of being read as claiming in relation to such a reservoir the other features mentioned. It is marked by the same ambiguity as the passage on page 6. Both thus  
10 refer to the reservoir constituted by a vented tube—which, by reference to the body of the specification, may be deduced to be of capillary size—filled with dense ink, providing an uninterrupted liquid vein to the ball-point; and both refer also to the duct extending to the feed channel of the stylographic point. Thus both refer to the first four of the five elements claimed in Claim 1 of the later document, and the drawings which accompanied the initial complete specification clearly show the fifth element, the narrower cross-section of the feed-channel.

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The draftsman has achieved a singular ambiguity in this earlier document. Read as a whole, it rather suggests the same conclusion as the  
20 earlier portion, on page 1a suggested, but it is perhaps difficult to be certain about it. On the other hand, all the elements claimed in Claim 1 of the final document are disclosed and referred to in it.

If it is to be read even as implying that, apart from the addition to them of the plurality of limbs in the duct, such elements were old, I am of opinion nevertheless that it was within the applicant’s right, if in fact they were—in combination, and without such plurality of limbs—inventive, to amend so as to say so and to claim them. If the earlier document is merely ambiguous on the point, the case is *a fortiori*.

One may suspect, with Harman, J.—see 66 R.P.C., at p. 208—  
30 that this applicant initially did not fully comprehend the nature and application of the principle of capillary forces in relation to his instrument, but became more clearly aware thereof as time went on. No doubt the preparation of technical evidence for the purpose of infringement proceedings led to that result. But if what he has now claimed was novel on the 31st December 1943 in Australia, and was inventive, then, seeing it was in fact disclosed in his initial complete specification, he can in my opinion rely on a complete specification which by amendment makes more clear how it was inventive. I do not think such a process equates him with the “unconscious inventor” whose legitimate existence Griffith, C.J., in  
40 *Dunlop v. Cooper* (above) denied.

If, of course, the matter now claimed in Claim 1 was not novel and inventive at the date in question, the claim will be void, and the applicant’s original complete specification will no doubt be admissible in so far as it constitutes, alone or in the light of other evidence, an admission by him of such non-novelty. For, if the first three elements claimed were not novel, it may well be contended that the fourth and fifth cannot have been either, and that a mere combination of old elements in Claim 1 was not inventive, even if any of the other claims might separately achieve validity by additional inventive features. On the other hand, it may be  
50 that the earlier document will be said to have been referring to matter in

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fact novel but contained in a prior application, and not to general knowledge, or to have been a careless adoption of a recital from an application made elsewhere.

In my opinion, the defence relied on is not made out.

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There will accordingly be judgment in accordance with the following minutes :—

(1) Adjudge and declare that the allegations of the Defendant the subject of the judgment in this action dated 15th June, 1953, so far only as they are the subject of such judgment and allege a good defence in law to the Plaintiff's claim herein, are not established, and that accordingly para. 5 of the Defendant's defence herein to that extent fails. 10

(2) Order that the Defendant pay the taxed costs of the Plaintiff and of the Commissioner of and incidental to the setting down and argument of the question of law stated in the order of November 25th, 1952, and of and incidental to the trial of the issues of fact arising thereout, including (A) the costs reserved by the two orders of November 25th, 1952, and (B) the costs of the present hearing before me, from and including June 1st, 1953, up to the date of this order, but excluding (C) the costs dealt with by the order of March 17th, 1952. 20

(3) Order that the trial of the action proceed forthwith as to the other issues remaining to be determined on the pleadings and particulars.

(4) Leave to the Defendant to appeal from this judgment so far as contained in minutes (1) and (2) hereof.

(5) This judgment to be passed and entered forthwith.

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**JUDGMENT that Defence not Established.**

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THIS ACTION having come on for further trial before this Honourable Court without a jury on the 15th, 16th, 17th and 18th days of June 1953 AND UPON HEARING Mr. Phillips one of Her Majesty's Counsel Mr. Shelley one of Her Majesty's Counsel and Mr. Pape of Counsel for the Plaintiff Mr. Menzies one of Her Majesty's Counsel and Mr. Gilbert of Counsel for the Defendant and Mr. Gillard one of Her Majesty's Counsel and Mr. McInerney of Counsel for the Commissioner of Patents AND UPON READING the Pleadings herein and the Order of this Honourable Court made on the 25th day of November 1952 AND UPON HEARING the evidence of Dr. Victor David Hopper given *viva voce* on oath on behalf 40

of the Plaintiff THIS COURT DID ORDER that this action should stand for judgment and this action standing for judgment this day accordingly

*In the Supreme Court of the State of Victoria.*

10 (1) THIS COURT DOTH ADJUDGE AND DECLARE that the allegations of the Defendant the subject of the judgment dated the 15th day of June 1953 of this Honourable Court in this action so far only as they are the subject of such judgment and allege a good defence in law to the Plaintiff's claim herein are not established and that accordingly paragraph 5 of the Defendant's defence herein to that extent fails AND

No. 31. Judgment that Defence not established, 22nd June 1953, continued.

20 (2) THIS COURT DOTH ORDER that the Defendant pay the taxed costs of the Plaintiff and of the Commissioner of and incidental to the setting down and argument of the question of law stated in the order of this Honourable Court dated the 25th day of November 1952 and of and incidental to the trial of the issues of fact arising thereout including (A) the costs reserved by the two orders of this Honourable Court dated the 25th day of November 1952 and (B) the costs of the present hearing before this Court from and including the 1st day of June 1953 up to the date of this order but excluding (C) the costs dealt with by the order of this Honourable Court dated the 17th day of March 1953

AND

(3) THIS COURT DOTH FURTHER ORDER that the trial of this action proceed forthwith as to the other issues remaining to be determined on the pleadings and particulars AND that the Defendant be at liberty to appeal from this judgment so far as contained in paragraphs (1) and (2) hereof AND that this judgment be passed and entered forthwith.

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No. 32.

30 REASONS FOR JUDGMENT of Sholl, J., that Patent Specification No. 122073 not Infringed and Specification No. 133163 Invalid.

No. 32. Reasons for Judgment that Patent Specification No. 122073 not infringed and Specification No. 133163 invalid, 28th July 1953.

MARTIN v. SCRIBAL PTY, LTD.

Suit No. 58 of 1951.

Under an order for directions made on the 17th March last, this action was tried concurrently with Action No. 58 of 1951, after I had disposed in the latter action of certain preliminary questions of law arising on the pleadings.

40 In the 1947 action, the Plaintiff, by writ issued on the 9th May, 1947, claimed relief on the ground of the alleged infringement of his Letters Patent No. 122073, dated the 8th December 1943. I have already made, in the interlocutory judgments which I gave in the other action, some reference to this patent. It is in all essential respects identical with

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U.K. Patent No. 571698, which is discussed at length by Harman J. in *Martin and Anor. v. Selsdon Fountain Pen Coy. Ltd.* [1949] 66 R.P.C. 193. The two principal claims in the Australian complete specification, Claims 1 and 9, are identical with those bearing the same numbers in the corresponding English specification, and are in the following terms:—

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“ 1. Improvements in writing instruments of the ball-tip type, wherein the ink reservoir of the said instrument is formed by one or more conduits starting at an air intake and, after following an extended path, communicating with the recess for the said ball, the said conduit or conduits being of so small a cross-section that a suitable ink cannot escape from the air intake under the effect of gravity.” 10

“ 9. Improvements in writing instruments, as claimed in Claim 1, wherein said conduit is smaller than 5 mm. in section.”

By his particulars of breaches, the Plaintiff relied upon the manufacture and sale by the Defendant, between the 5th September, 1946, i.e., the date of the advertisement of the acceptance of the complete specification of Patent No. 122073—and the 9th May, 1947—i.e., the date of the writ—of writing instruments known as the “Scribal Combination Writer.”

The Defendant denied infringement, alleged that the patent was invalid, and relied upon Section 125 of the Patents Act in answer to the claim for damages. The grounds of invalidity alleged were (1) want of subject-matter having regard to common general knowledge at the date of the patent; (2) obviousness, and lack of inventive step, having regard to prior knowledge and prior user; (3) prior publication, reliance being placed on Laforest's U.S. Patent No. 1980625, dated the 2nd October, 1933, and available to the public at the Patent Office Library at Canberra from the 3rd April 1935; and (4) ambiguity and uncertainty in relation to Claim 1. 20

On the issue of infringement, it was proved by admissions that between the dates previously referred to, viz., 5th September, 1946, and 9th May, 1947, the Defendant sold in Australia “Scribal Combination Writers” of the same type as, and the actual pen comprised in, Exhibit H, which is a “Scribal Combination Writer” referred to as an “Executive Model.” It was further admitted, as I understand paragraphs 3, 4, and 5 of the Defendant's Admissions of Fact, that at all events during some part of that period the Defendant was aware of the grant of the Plaintiff's Patent No. 122073 and of the contents of its specification. Whether the admissions would go far enough to found an inquiry as to damages for the whole of the period may be open to doubt, but for reasons which will shortly appear that question does not arise for my decision. A technical report (Exhibit J), admitted by consent, established that Exhibit H was a ball point pen, the reservoir of which was a straight capillary tube with an inside diameter of 3·0479 mm., and a length of 3·25 inches, from which three further straight ducts or capillary tubes, of diameters respectively measuring 1·1682 mm., ·50795 to ·88892mm., and of ·45716 mm., led to the ball at the point. It was common ground that it was filled with viscous ink. 40

Now in *Martin and Anor. v. Selsdon Fountain Pen Coy. Ltd.* (above), the alleged infringing pen had a similar straight reservoir. The U.K. 50

Patent No. 571698, corresponding with Commonwealth Patent No. 122073, was attacked in that action on the grounds of ambiguity, insufficiency, inutility, want of subject-matter, non-novelty, and prior publication (reliance being placed on, among other documents, Laforest's specification). Harman J. held that patent valid, but not infringed. He held (p. 213) that the feature of a reservoir following an "extended path" was an essential element in all the claims, and that a straight reservoir did not follow an "extended path." He also rejected all the grounds of alleged invalidity.

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10 In the present action before me, Laforest's patent was put in evidence by the Plaintiff, and dealt with by his technical witness, Dr. Fehling, since it was to be relied on by the Defendant.

During Mr. Menzies' opening, however, I indicated that, as then advised, I should consider it right to follow the decision of Harman J. as to infringement. Mr. Menzies then indicated that he would not call evidence on the question of validity. It was, I think, thereafter assumed by everybody that I would not make any final decision upon the issue of validity.

20 The decision of Harman J. was taken on appeal, but owing to a compromise between the parties, the Court of Appeal held that there was no *lis* for it to determine—see 66 R.P.C. 294. Consequently the judgment at first instance still stands as an authority. Certainly it is only a persuasive authority so far as I am concerned. But it is, if I may respectfully say so, a decision by a judge of long experience in this kind of litigation, and in any case it would be most undesirable that two courts of first instance in the British Commonwealth should (save in some very exceptional case) construe ordinary English words in identical patent specifications in different ways. I accordingly hold that the Defendant has not infringed Patent No. 122073, and I so hold for the same reason as the learned Judge of the Chancery  
30 Division in England, viz., because a reservoir in the form of a straight capillary tube is not within any of the claims.

With respect to the validity of No. 122073, although Mr. Menzies, after his opening, called evidence of common general knowledge in Australia before December 1943, I think that evidence must be regarded as having been directed to the validity of No. 133163 only. I have therefore not heard evidence from the Defendant on the validity of No. 122073, and accordingly I express no final opinion upon that issue. I may perhaps  
40 say just this, that as at present advised, I should have been disposed to follow the decision of Harman J. as to Laforest's patent, and as to ambiguity; and I should further have thought, for reasons which will more fully appear when I come to deal with No. 133163, that if the evidence of Messrs. Tetley and McMahon had been treated as applicable to the present action, there was no such common general knowledge established as to invalidate No. 122073. But those are, of course, tentative views only. Furthermore, no question was raised by the particulars of objections as to inutility or false suggestion. If it had been, questions might have arisen—such as I shall have to consider hereafter in the other action when I am dealing with infringement—as to whether the passages in the complete specification of No. 122073, at col. 2, ll. 5–13, and ll. 14–21, and col. 6, ll. 3–7, ll. 22–28,  
50 and ll. 29–38, contained false assertions or promises.

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There will accordingly be judgment for the Defendant in the action.

As there is no formal decision as to validity, I do not think this a proper case for a certificate under Section 91.

With regard to costs, Mr. Menzies contended at one stage that the Court could not order a defendant who succeeded on non-infringement, but failed on validity, to bear the plaintiff's costs on the latter issue, whether by way of set-off against other costs awarded to the defendant, or otherwise. I have no doubt that in a proper case there is jurisdiction to make such an order; see the cases collected in *Terrell on Patents*, 9th Ed., pp. 385-7. Here, however, the Defendant has not actually failed on validity; the issue is undecided. What precise order I should make in the exercise of my discretion in the present circumstances I shall consider when I have dealt with the other action. 10

#### ACTION No. 58 OF 1951.

I have already, in my judgments delivered in this matter on the 17th March, 15th June and 22nd June last, referred to the general nature of the action and the defences relied on in answer to it. As, however, I have not so far referred in any detail to the nature of the infringement alleged by the Plaintiff, it is desirable now to do so as briefly as possible. The Plaintiff by his particulars of breaches complains of the manufacture and sale by the Defendant of writing instruments known as the "Scribal Secretary Pen" between the 19th February 1948—which is the date of the "publication" under Section 38A of the Patents Act of the original complete specification of No. 133163 in the unamended form in which it was initially lodged on the 31st December 1943—and the 24th January 1951—which is the date of the writ; in particular, he complains of the sale by the Defendant to the Myer Emporium Ltd., of two such pens purchased by an agent of the Plaintiff from that establishment on the 9th June 1950. 20

As I have previously stated, the complete specification in its final amended form was not accepted until the 14th June 1949, and that acceptance was advertised in the Official Journal on the 30th June 1949 by way of intended compliance with Section 50. 30

The Plaintiff's proofs as to the alleged infringement stand thus. Exhibit E is a "Scribal Secretary Pen," which was admitted by Mr. Menzies to have been sold by the Defendant, to be one of the pens referred to in paragraph 2 (c) of the Plaintiff's particulars of breaches—i.e., as I understand the admission, one of the two pens bought by the Plaintiff's agent from Myer's on the 9th June 1950—and one of the pens referred to in paragraph 1 of the Defendant's Admissions of Facts; see Transcript, pp. 193-4. I shall refer again in a moment to these Admissions. Exhibit 3 is a Scribal pen produced by Mr. Menzies. The one first produced (see p. 219 of the Transcript) was Mr. Menzies' own pen, and was used by him in cross-examination of Dr. Fehling. Subsequently, see p. 222 of the Transcript—another pen, which I understood to be conceded to be identical with Exhibit 3, was by agreement between counsel substituted for the original Exhibit 3, in order that Mr. Menzies might have his own pen back again. Dr. Fehling was recalled at a later stage (see pp. 342 *et seq.* 40

of the Transcript), and made further tests with, and gave further evidence as to the working of the new Exhibit 3. It was mutually admitted (p. 348) that Exhibit 3 (*scil.*, Exhibit 3 in both its exemplifications) corresponded in measurements with Exhibit E, and with the measurements stated in Exhibit G, a technical report upon Exhibit E which was admitted by consent and conceded by the Defendant to be correct (see p. 193). The case proceeded, and the argument was delivered, upon the basis that everything which had been said or admitted of, or done with, the original Exhibit 3, was applicable to the pen which now forms that exhibit.

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- 10 The Defendant's Admissions of Fact, the whole of which were ultimately put in evidence as Exhibit F (see pp. 193 and 241 of the Transcript), established that "*the* Scribal Secretary Pen," referred to in the particulars of breaches and in the possession of the Plaintiff's solicitors—i.e., presumably, one of the two, or three, referred to in paragraph 2 (A) and (C) of the particulars of breaches,—was between the latter end of February, 1948 and the 24th January 1951 manufactured by the Defendant and sold by it to either Lonsdale Distributors Pty. Ltd. or the Myer Emporium Ltd.; that similar instruments were manufactured by the Defendant in Australia between the same dates; that similar instruments were sold by
- 20 the Defendant in Australia to purchasers, including either Lonsdale Distributors Pty. Ltd. or the Myer Emporium Ltd., between the 19th May 1948 and the 24th January 1951; that prior to the date of manufacture (*scil.*, as I understand the admission, the manufacture of *any* alleged infringing "Scribal Secretary Pen") the Defendant knew the Plaintiff had applied for letters patent; but did not know until some time after the 30th June 1949 that the application was for the patent comprised in No. 133163 in the form in which it was finally granted; that *prior* to the date of the manufacture of the "Scribal Secretary Pen" referred to in the particulars of breaches (*scil.*, I think, the manufacture of at least one
- 30 of the two, or three, therein in paragraphs 2 (A) and (C) referred to) but some time *after* the 30th June, 1949, the Defendant was aware that Patent No. 133163 had been granted to the Plaintiff; and that prior to the issue of the writ on the 24th January, 1951, the Defendant had inspected a copy of the complete specification of that patent in its final amended form.

- In the course of Mr. Menzies' argument upon infringement, he contended, for reasons which will appear hereafter, that there was no proof of the manufacture or sale by the Defendant of any allegedly infringing pen after the 30th June, 1949, since (as he argued) it was consistent with
- 40 the admissions that the actual manufacture and sale by the Defendant of Exhibit E., or of any pen proved to be in relevant respects identical, were before that date. I allowed the Plaintiff, for reasons which appear at pp. 231–3 of the Transcript, to call further evidence on the point, and he called Mr. Bartak. This witness deposed that between the 1st July, 1949, and the 24th January, 1951, Messrs. H. Taft & Coy., of Collins Street, Melbourne, for whom he was assistant buyer, purchased from the Defendant pens similar to Exhibit E. His evidence established that such pens were similar with regard to the case, and the external appearance of the reservoir and ball assembly (together referred to as the "refill"), which
- 50 "refill" may easily be seen by dismantling Exhibit E. But his evidence stopped short of showing anything as to the interior of the "refills"

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bought in the period of which he spoke. As it was essential to the proof of infringement, of Patent No. 133163 upon the Plaintiff's construction of Claim 1, that there should be shown to exist in the allegedly infringing instrument not only a vented reservoir of capillary size, but also a feed duct leading from the reservoir to the ball and having a cross-sectional area less than that of the reservoir, it was said by Mr. Menzies that Bartak's evidence, since it failed to prove that the pens his firm bought of the Defendant possessed the latter characteristic, carried the Plaintiff's case no further, as to infringement after the 30th June, 1949. If Bartak's evidence had stood alone, I should have been disposed to agree with 10  
Mr. Menzies' submission. But when it is read in conjunction with the Defendant's Admissions of Facts, particularly paragraph 5 thereof, there is in my opinion sufficient proof of manufacture and sale after the 30th June, 1949, for the Plaintiff's purposes. There is no suggestion in the Defendant's Admissions of Fact of any material changes having been made at any time in the pens there referred to. If it is said that paragraphs 1-4 are consistent with all manufacture and sale, though admitted to have occurred *between* a date in 1948 and a date in 1951, having nevertheless occurred before the 30th June, 1949, I am disposed to agree. But para-  
graph 5 is not consistent with that hypothesis. It is clearly drawn— 20  
and I refer to the admission and the qualification—upon the basis that the manufacture admitted included manufacture after the 30th June, 1949. If it be then said that only the admission can be used against the Defendant, and that the qualification can be used only in his favour, the answer, I think, is that the necessary evidence appears upon the proper construction of the admission itself, when read, as I think it may be read, in the light of the qualification. At all events, there is in my opinion sufficient in the Admissions, or alternatively in the Admissions together with the evidence of Bartak, to warrant me in drawing the inference which I do draw that the Defendant manufactured in the Commonwealth pens similar in all 30  
essentials to Exhibit E both between the end of February 1948 and the 30th June 1949 and between the 30th June 1949 and the date of the writ, and sold such pens in the Commonwealth both between the 19th May 1948 and the 30th June 1949, and between the 30th June 1949 and the date of the writ. Any other conclusion would in my opinion be contrary to all the probabilities in this case.

It remains to refer to the contents of Exhibit G, the technical report. That establishes that Exhibit E has as a reservoir a straight vented tube with an internal diameter of 2.695 mm., and a length of 3½ inches. From the reservoir, three consecutive straight but short capillary tubes lead 40  
on to the ball housing, their respective diameters being 1.69 mm., 1.52 mm., and 0.547 mm. This instrument clearly falls within so much of Claim 1 of No. 133163 (assuming it for the present to be valid) as refers to "an instrument of the type specified" (i.e., in col. 1, ll. 11-21), "having the ink reservoir constituted by a vented tube of capillary size" (as defined in col. 2, ll. 8-21), "having a feed duct leading from the reservoir to the ball, the cross-sectional area of which duct, particularly that portion adjacent the ball, being less than that of the reservoir."

But other questions arose as to infringement. In the course of discussing them, Mr. Menzies advanced arguments with respect to the 50  
construction of the Patents Act, and particularly Sections 54 and 69,



which appeared to me to suggest also an argument against the correctness of the decisions which I had given on the 15th and 22nd June last with respect to paragraphs 4, 5 and 6 of the Defendant's Particulars of Objections. The argument was one which, if suggested during the debate upon those paragraphs, was certainly not fully developed or considered, and accordingly I invited Mr. Menzies to develop it in relation both to validity and to infringement. This he did, and I heard Mr. Shelley in reply upon it. I rejected, however, Mr. Menzies' application that I should for the time being recall my earlier judgments, or stay the execution thereof as to costs, but I stated that if his argument ultimately led me to think my earlier decisions had been wrong I should here say so, in order that the Defendant might have the advantage of such a statement upon any appeal proceedings.

It will be convenient to state the arguments of counsel as to the construction of the Act, and to consider them both in relation to the limits of the power of amendment under Division 1 (and thus in relation to validity), and also in relation to infringement.

Mr. Menzies' first contention was that upon the proper construction of Sections 54 and 69 of the Patents Act, the "publication" there referred to was publication in the sense of the advertisement of the acceptance of the complete specification in its final form, in accordance with Section 50. The relevant date in the present case, upon that view, was the 30th June 1949—see the Plaintiff's Admissions of Facts, Exhibit 4, as expanded at p. 241 of the Transcript. If, Mr. Menzies said, the protection given by the Act to the Plaintiff after that date (assuming the patent to be valid) was protection in relation to the complete specification in its final amended form, there was no proof of infringement after that date, because no manufacture or sale by the Defendant after that date was proved.

I am of opinion that for two reasons that particular argument, as an answer to the allegation of infringement, fails. In the first place, assuming for the moment that Exhibit E is an infringing pen and that the patent is valid, I have already given reasons for holding that pens similar to Exhibit E were in fact manufactured and sold by the Defendant in the Commonwealth after the 30th June, 1949. In the second place, I am of opinion that the nature of the amendments effected by the Patents Act, 1946, which introduced sec. 38A, conclusively establishes that the "publication" now referred to in secs. 54 and 69 is the publication which is deemed by sec. 38A (2) to have taken place when a complete specification becomes open under that section to public inspection. In sec. 50, as it previously stood, it was provided that upon advertisement of acceptance the application and specification (i.e., the complete specification as accepted) should be open to public inspection. Sec. 54 referred to "acceptance," and sec. 69 referred to "publication." There seems at that time to have been an assumption on the part of the legislature that acceptance, and advertisement of acceptance, would be contemporaneous; for otherwise there would have been some apparent conflict between secs. 54 and 69 as to the earliest date at which an infringement might be actionable. But when in 1946, the reference to public inspection was deleted from sec. 50, and inserted in sec. 38A, which by subsec. (2) referred specifically to publication, and when, by the same amending Act, sec. 54

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was made to refer to publication instead of to acceptance, sec. 69 was clearly intended thereafter to refer to "publication" in the sense in which sec. 38A referred to it. There was no need to amend sec. 69; the denotation of its first proviso was changed by the amendment of the earlier sections, and any possibility of conflict with sec. 54 was removed by amending that section so as to make it refer to the same event as the proviso.

But Mr. Menzies next argued that, if that was so, sec. 54 should be read as meaning, in a case where the complete specification was amended between "publication" under sec. 38A and acceptance under sec. 50, that the protection given by the Statute was protection only in relation to the invention as claimed in the initial complete specification "published" under sec. 38A, and that that protection, and that protection only, was given during the whole life of the patent. 10

In sec. 54, he said, "the publication of a complete specification" must refer to the publication of the initial and unamended complete specification. So far, I agree. That is what sec. 38A provides for. Then, he said, the applicant was given by sec. 54 the same rights as if a patent for the invention had been sealed "on the date of publication of the complete specification"; that, again, must refer to the initial and unamended complete specification. 20

Again, I agree. But, he said, that meant, "as if a patent for the invention as claimed in the complete specification in that initial form had been sealed on that date." Mr. Menzies declined to contend that secs. 54 and 69 merely gave protection accordingly to such initial complete specification until acceptance, and thereafter, in the case of an amendment allowed before acceptance, protection according to the final and amended form of the complete specification—a view which I should have thought more arguable. Mr. Menzies pressed the argument that protection never extended, during the life of the patent, beyond the invention claimed in the original and unamended complete specification, because in the present case it was clear that if that were the test, the Defendant would not have infringed. The initial and unamended complete specification claimed only a pen in which the reservoir was a capillary tube comprising a series of limbs, and did not cover a single straight tube. 30

But I am of opinion that neither Mr. Menzies' construction, nor the suggested modification of it, can be accepted. Sec. 54 must in my judgment be so read that after the words "a patent for the invention" there are understood the words "in accordance with the complete specification as accepted." For in my opinion it cannot have been the policy of the Legislature to give to an applicant protection, even in relation to the limited period between lodgment and acceptance, on the basis of claims which it was the purpose of the examination under Division 1 to excise or amend as contrary to law. Furthermore, as Mr. Shelley pointed out, the "complete specification" referred to in the letters patent themselves—see the First Schedule to the Act—is the complete specification as finally accepted, and sec. 54 is designed, so to speak, to ante-date the protection given by the letters patent, when sealed, and only that protection, to the date there referred to. 40

But, said Mr. Menzies, if that view is taken of the legislation, it means that the Defendant, which was manufacturing and selling pens with 50

straight-tube reservoirs from at least early in 1947—as was established by the Admissions in the 1947 action—or at any rate from the first half of 1948—as was established by the Admissions in the present action—is alleged to be liable in damages from the 19th February, 1948, the date of the “publication” under sec. 38A of the initial and unamended complete specification, by reason of the manufacture of pens which—even if the patent was otherwise valid, and even if the pens did infringe the complete specification in its final form, as “published” on the 30th June, 1949,—did not infringe any claim in the document made public in February, 1948. Accordingly, he said, the Plaintiff was seeking to make the Defendant liable for manufacture and sale of articles which it was *bona fide* making and selling even before the publication of any complete specification, or at all events before the publication of any complete specification which such actions could be seen to infringe. Such a result, said Mr. Menzies, showed that the Court’s earlier decision as to the power of amendment under Division 1 must be wrong; it should be reconsidered and the amendments allowed should be held *ultra vires* and the patent invalid. He declined, however, to push his argument so far as to submit that no amendment was permissible under Division 1 save such as left the actual claims in the final complete specification identical with or narrower than those in the initial complete specification. And he conceded that he could not go so far as to contend that the power of amendment under Division 1 did not extend to anything which would bring in as an infringement something which was not an infringement before (cf., as to Division 4, sec. 82), and that that was the only doctrine which would entirely preserve an honest trade from possible liability.

Mr. Menzies supported his argument by reference to the amending Act of 1946. That must have been intended, he said, to let the world know as soon as possible what the applicant had achieved, and what he was asserting as his invention, so that others might be free at once to build on what he had discovered, and honest traders might be able to ascertain promptly what would and what would not be considered to have infringed the patent, if it were later granted. Mr. Shelley on the other hand argued that sec. 38A must have been inserted to aid patentees, not their possible competitors. It was notorious, he said, that the section was inserted in 1946 because of the great delays occasioned by the War in dealing with applications in the Patent Office. (Cf. *Walker on Australian Patents*, 1949, p. 125, where reference was made to a delay of two years.) Such delays meant that until acceptance no cause of action for infringement began to accrue, and in effect the life of patents was being reduced by official delays to well below the statutory period of 16 years. The amendments of 1946, according to Mr. Shelley, were thus designed to give patentees an earlier title to sue for infringement; and his submission was, I think, to a considerable degree supported by the argument of Mr. Gillard for the Commissioner at an earlier stage of this case.

But in my opinion the 1946 legislation was probably, as in the case of so many of the provisions of the patent law, a compromise, i.e., a set of provisions enacted in an endeavour to do justice to the interests of patentees and public alike, and I should think both the considerations urged by Mr. Menzies and those urged by Mr. Shelley influenced its form. Mr. Shelley indeed submitted that an honest trader would not be likely

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to be prejudiced by an amendment under Division 1 after sec. 38A, since, if what he was doing infringed a complete specification only as amended after publication under that section, but he was doing it before the date of the application, the patent would be bad for non-novelty; whereas if he began manufacture only after such publication, he must be taken to know the application was "fluid." But of course that argument overlooks the case of a manufacturer who begins after the initial application date, in a case where there is a provisional specification, and before the publication of the complete specification; and it does not deal with the many transitional cases, such as the present, where manufacture began 10 after the initial application date, and the lodging of a complete specification, and before the sec. 38A publication date.

Nevertheless, I have come to the conclusion that the further arguments which I have briefly outlined ought not to lead to the conclusion that my earlier decisions were wrong. Once it is conceded, as I think it must be, that since 1946 (as before) amendment under Division 1 may result in substantial alteration of the technical "claims" in a complete specification, and that such alteration cannot be limited to such alteration only as consists in the omission or narrowing of such claims, it then becomes a matter of choosing, as a *discrimen* by which to determine the validity of a Division 1 20 amendment, between some such principle as that put forward by Mr. Menzies in his earlier argument, viz., that the applicant must not go outside the "assertion of invention" made in his original complete specification, read as a whole, and some such principle, as that which I myself adopted in my judgment, viz., that he must not go outside the "disclosure of invention" so made. Whichever is adopted, a prospective manufacturer or trader has notice, when an application is made and the complete specification is published, that it is subject to possible amendment under Division 1, and on either basis an onus is put upon him—in the one case, the onus of deciding what is the "assertion" of invention; in the other, 30 what is the "disclosure" of invention. Section 38A has brought about a state of affairs where Sections 54 and 69 may impose liability in respect of infringements which were not such before acceptance, and once that position is reached I cannot see any significant difference in the possible hardship to an honest trader resulting from Mr. Menzies' suggested limitation upon the power of amendment and that which I have adopted. That being so, I am of opinion that the other considerations which I endeavoured to express in my earlier judgments, particularly in the second of them, render it preferable to adopt the "disclosure" test.

I agree that Section 38A may be used to support either an argument 40 that it demonstrates the original narrowness of the power of amendment, and has not changed the law, or an argument that it has itself narrowed the power of amendment. Either way it is put, however, the argument is merely an argument *ab inconvenienti*, and I have stated my reasons for rejecting it. It may well be, however, that, if I am right, it ought to have been seen that the presence of the section made desirable some provision limiting the right to recover damages under an amended claim, since Section 82 is clearly limited to Division 4. On the other hand, it may be observed that before 1883, damages could apparently be obtained from the date of the grant, even though the complete specification was not at 50 that time filed until later—see Hindmarch on Patents, 1846, pp. 254, 256.

It may be noted that in the English Act of 1949 and the Commonwealth Act of 1952, the test of initial "disclosure" has been adopted—e.g., in relation to the priority dates of claims—see the English Act, Section 5, and the Commonwealth Act, Section 45.

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It may further be pointed out that under the present Commonwealth Act—the 1952 Act not having yet come into operation—the Commissioner's practice has been not to "publish" the complete specification until three months after lodgment—see Walker, p. 47—so that *bona fide* manufacture begun during that period may still be found after publication to infringe,  
10 even where there is no amendment of the complete specification at all; while under the 1952 Act that possibility is increased, since the period between lodgment and "publication" of a complete specification is fixed at six months—see Section 43. Thus, even in the absence of any amendment under Division 1, the system may operate to the prejudice of *bona fide* traders, though not, it is true, by attaching a liability in damages to the trade carried on before publication and found on publication to infringe.

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I propose next to turn to the objection of ambiguity and uncertainty, before returning to the question of infringement. This objection was raised to Claim 1, which is the principal claim relied on by the Plaintiff,  
20 but if the objection is sound, Claims 2, 5 and 8, which are also alleged to have been infringed, would likewise fail of effect. It was argued that Claim 1 was ambiguous and uncertain, because in the first place, it was said, Claim 2 was presumably intended to add something to Claim 1, but it was impossible to tell with certainty what was a "vented tube" in Claim 1, if it was not the same thing as a "tube open to atmosphere at one end," referred to in Claim 2. It was said that a vented tube, if it was not the same thing as Claim 2 referred to, might have a number of holes, or only one, or might be open only at the end nearest the ball. But "a vented tube of capillary size" is defined in Col. 2, at ll. 8 *et seq.*,  
30 and that definition refers to an interface between the ink, the air, and the interior surface of the tube, at the end of the ink column remote from the ball. It is clear from that definition, and from the general description of the instrument, as well as the drawings, that Claim 1 refers to a tube of which the end remote from the ball is open to air, in the sense that air can reach it to replace the ink as used. It was said by Mr. Shelley that Claim 1 was intended to cover cases in which such end was open to atmospheric pressure, but not necessarily directly; e.g., that it would cover a case where the end of the tube was enclosed in a flaccid rubber or other bag, or was sealed with a valve which would admit air into the tube.  
40 This question has caused me some difficulty. If the claim is good, it must be possible to say whether such devices as Mr. Shelley mentioned would or would not infringe it. Now it cannot have been meant by either Claim 1 or Claim 2 that the end of the reservoir must necessarily be open directly to the surrounding atmosphere, in the sense of being completely uncovered, for that would exclude a reservoir within a case, as shown in the drawings, even if the case was itself vented. What was meant was that the end of the tube must be able to be reached by the surrounding atmosphere. Hence neither claim would exclude the valve referred to, but both, I think, would exclude the rubber bag. I can really see nothing in Claim 2 which  
50 is not in Claim 1. That may make Claim 2 superfluous, and useless, but on the whole I do not think it makes Claim 1 ambiguous or uncertain.

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Then it was said that it was uncertain whether the definition to be read into Claim 1 comprised ll. 12-21 of col. 2, or only ll. 12-14. I remain unable to perceive the point of this contention. It seems to me quite clear, as a matter of construction, that ll. 12-21 are all to be read into Claim 1, and I can see no inconsistency or ambiguity as a result of so reading it. Mr. Shelley indeed contended that only the first three lines should be read in, but he was influenced, I gathered, by some fear of the effect of reading in the whole definition upon the different question of the meaning of the expression, "in which when charged with viscous ink a continuous liquid vein is maintained extending from the ball." 10

It was next said that the expression, "the cross-sectional area of which duct, particularly that portion adjacent the ball, being less than that of the reservoir," was ambiguous, in that it was impossible to be certain whether an instrument having the feed-duct so constructed that the portion of it adjoining the reservoir was of the same cross-section as the reservoir, or of larger cross-section, while the portion of it adjacent to the ball was of smaller cross-section than the reservoir, did or did not infringe the Claim. It was said by Mr. Shelley on the other hand that the word "particularly" merely provided emphasis, and that if any portion of the feed-duct were of the same cross-section as or greater cross-section than the reservoir, there would be no infringement, except possibly in the case of a mere "colorable departure" within the doctrine of *Clark v. Adie*, 2 App. Cas. 315. 20

In the end, I have come to the conclusion that there is here an invalidating ambiguity. I am rather disposed to think the draftsman of Claim 1 wanted to have the best of both worlds, and that he may have thought he was saying, in effect—"I claim a monopoly in all instruments in which, in addition to the other three characteristics earlier mentioned, there is a feed duct leading from the reservoir to the ball, and having a lesser cross-section than the reservoir; but I go further than that and I also claim 30 all those with the same three previously mentioned characteristics, and a feed duct leading from the reservoir to the ball, if the portion of the feed duct adjacent to the ball has a lesser cross-section than the reservoir, whatever be the cross-section of the rest of the duct." Now that is just the opposite of the construction which Mr. Shelley sought to give the claim, although, as a matter of literal interpretation, there is much to be said for his reading of it. I simply do not know with any reasonable certainty which meaning the draftsman really intended, and there is no evidence on which I can say that the ordinary person skilled in the art of making pens, to whom the specification is addressed, could be reasonably certain. 40 The matter is perhaps made more rather than less difficult by the fact that, as Mr. Shelley stated early in the hearing, and as the technical evidence made clear, the element of the feed duct and its cross-sectional area is not technically essential at all to the operation of the capillary tube as a non-leaking reservoir, but is merely a convenient feature for the purpose of feeding an appropriately small amount of ink to the ball point of a practical pen. The patentee has chosen, for reasons associated (as will later appear) with the objections of the examiner, to claim a combination including this fifth element, but it cannot be said with certainty what the element is, and accordingly I think the first claim, and therefore all 50 the claims, are invalid for ambiguity and uncertainty.

As, however, it was obvious that either party, if unsuccessful before me, intended to take the case on appeal, I think it right to go on to deal with the many other points which were argued in the able and necessarily lengthy addresses of counsel.

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The final ground of ambiguity and uncertainty urged by Mr. Menzies was that it could not be known whether the expression "in which when charged with viscous ink a continuous vein is maintained extending from the ball," meant "in all circumstances," or "in all circumstances of normal use of the instrument." He contended that if the whole of the definition  
10 in col. 2, ll. 12-21, was read into Claim 1, it resulted in incorporating therein a reference to "shocks to which the instrument was subjected in normal use," and rather tended to support the conclusion that "normal use" was not to be understood as referred to elsewhere in the claim, even in the reference to the maintenance of the liquid vein.

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I do not think there is any ambiguity or uncertainty in the reference to the maintenance of the liquid vein. It clearly must refer to conditions of normal use. No one is likely to suggest that the claim is designed to cover only those instruments in which, in all conceivable circumstances—  
20 including, e.g., the case of the owner having it in his pocket when involved in a motor accident, or allowing it to fall into the sea—the continuous vein of ink is maintained to the ball. It must be a claim to a monopoly in those instruments in which, the other four features being present (and I assume for the moment that the last element is not uncertain or ambiguous), the vein is always maintained to the ball when it is used as a writing instrument in any manner in which such ball point instruments may normally be sought to be employed.

But, having construed the claims, it is now necessary for me to return to the question of infringement, because, on the assumption that the patent was valid, it was contended by Mr. Menzies that there was one further  
30 ground on which the Defendant's pen should be held not to infringe. If, he said, Claim 1 were read as I have in fact read it, in relation to the maintenance of the liquid vein to the ball, the Defendant's pen was not a pen in which the vein was always maintained to the ball when it was used as a writing instrument in any manner in which such ball point instruments might normally be sought to be employed. For, he said, the vein was not maintained when an attempt was made to write on a horizontal surface above the writer's head, or on a vertical or inclined surface in a position where the ball point of the instrument was above the horizontal—i.e., was raised substantially above the end remote from the ball.

40 Now I leave out of account altogether the case of attempting to write on a horizontal surface above one's head. There might be some extraordinary case in which someone might want to write on a ceiling, or in some similar position, but it would certainly not be a normal method of use. But the question of writing on a vertical or inclined surface with the point above the opposite end is quite a different matter. I must decide the matter as a jury would. I accordingly turn first to the evidence of Dr. Fehling, an expert witness called by the Plaintiff.

Dr. Fehling's qualifications to speak on technical matters relating to the operation of ball point pens in general, and the Biro pens in particular,

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were very high. Nor does the fact that he is a technical consultant to the owners of the patent rights in suit, and has for a good many years advised them and given evidence for them and their associates in patent litigation in various parts of the world, in the least disincline me to accept his evidence. The Courts would be fortunate indeed if all technical and expert witnesses were as competent, as clear, as detached and unbiassed, and as helpful, as I found Dr. Fehling to be.

He was asked in cross-examination to carry out some tests with Exhibit 3, to which I have already referred. He did this on two occasions —see pp. 218–221, and 342–350—and the results of the tests which he made on the second occasion appear in Exhibits 7 (writing above the head with the pen vertical) and 8 (writing on a vertical surface with the point of the pen about 35 degrees above the horizontal). The question first arose, however, in relation to Exhibit J, the technical report upon Exhibit H, which was one of the alleged infringing pens relied on in the 1947 action. Though Exhibits H, I and J were when originally tendered (see p. 194), marked as exhibits in the 1947 action only, Dr. Fehling's evidence was treated by both parties throughout as applicable in both actions, and the argument proceeded on that basis. Accordingly I think what he said at pp. 198–9 when he was discussing Exhibit J., is relevant also to the question I am now considering, since the substance of the evidence I am about to quote applied, as later evidence showed, to ball point pens generally. Furthermore, a comparison of Exhibit J, with Exhibit G discloses no difference, significant in relation to the present question, that I can see. But I should add that, even if the passage at pp. 198–9 were excluded as irrelevant, I should arrive at the same conclusion. As, however, it appears to me to reinforce what I think the other evidence shows, I shall quote it.

It is as follows :—

“ I am considering whether any conditions of normal use can arise in which in a pen of the kind shown in this drawing there is risk of leakage of ink from the reservoir, of a pen having a reservoir of the dimensions we are considering. The only condition I know and the user of the ball point pen is familiar with, if I write upwards then I am destroying the meniscus between the ball and its housing and there is the danger of the column of ink falling down bodily. If I prevent this by not doing this, I do not know off hand of any condition in which anything would occur.

*His Honour* : You mean if you were writing your name on a list on a wall ?—Yes, something like that.

*Witness (continuing)* : If I write normally, that is to say on a surface substantially horizontal or sloping no more than 45 degrees —as an extremely sloping desk—and keep the pen either in a drawer or in my pocket under such conditions there would be no risk of leakage.

*His Honour* : Everything you have been asked so far is in relation to this drawing, part of Exhibit J, is it, that is this one (indicated) ?—Yes.”

At pp. 219–221, the witness made specific tests with Exhibit 3, and again it is desirable to quote the evidence.



“ It writes with the ball down ?—Yes.

I want you to write first of all with the pen held with the ball above the other end ?—It stops.

And I take it that your experience of ball point pens is such as to lead you to believe that that is a necessary consequence—it always happens ?—No, not always.

10 Does it happen with Biro pens ?—It has nothing to do with the make. I know of two conditions in which it can be shown that the ink will write almost indefinitely, even if you write with it upwards like that. There are certain conditions that cannot be reproduced and guaranteed in every pen in which it will go on writing in that position.

Do you remember telling His Honor yesterday that the circumstance in which the ink would fall out of a Scribal pen by reason of gravity is if you have written with it upside down and then left it in that position ?—Yes, it is quite correct. With a qualification there are artificial circumstances in which it will just hold.

You can create artificial circumstances ?—Yes.

20 I suppose if you exerted some sort of pressure ?—No, a perfectly normal refill. The first one, is you must have a pen which has uniformly a very small gap and if I may say so very small, I mean small compared with a normal gap that a ball point pen should have.

Do you mean the gap at the ball ?—Yes. In other words, it is usually a pen which will produce a fairly fine trace and secondly if at the same time you have a length of ink column which is not too long, then it may hold up, but with that qualification only, what I said yesterday normally happens.

30 *His Honor* : When you write like that and it stops writing, what it is that makes it stop ?—The exhaustion of the ink in the ball cavity.

*Mr. Menzies* : Could I put it in this way, that the ink is no longer maintained to the ball ?—Yes.

40 *His Honor* : What does that mean, that there is an air bubble or something in there ?—Yes, the re-entrant of the ball—I mean on the one side of the ball when writing it goes out and draws ink, and if that ink is wiped clean of the ball, as it may, no ink can enter on the other side and there is a chance of air slipping into the ball housing and if on the other hand there is absolutely no assistance by gravity, on the contrary there is a pull, then air will gradually fill the ball cavity until it is exhausted and often it stops writing.

Will it begin again ?—Yes, immediately, as I showed you here. It stops now, I turn it over and it comes back again.

*Mr. Menzies* : It comes back gradually, doesn't it, not immediately ?—Well, it fades out and then you have to make two scribbles and it comes back.

The ink has to come back against the ball by gravity ?—Yes.

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You have established contact again between the ink and the ball?—It is not only by gravity, it is gravity plus surface tension.

Just let me take this a step further. You say that if you do write with the pen upside down so that there is no longer ink in contact with the ball and the pen is then kept in that position, you would expect all the ink to fall out of the pen by gravity?—There is a great danger of that happening, though it does not happen always.

It does not always happen?—But there is a danger.

A very real danger?—Yes.

10

*His Honor*: Is that because a different meniscus forms, or what?—No, if you have written the ball cavity free of ink completely then it means that the ink has receded back into the feed capillary. That feed capillary has a diameter of about half a millimetre or .6 m.m. That meniscus, though still quite a small one, is not sufficiently strong to hold up the whole of an ink column, assuming that the column is still there. It would hold up say one-third or one-quarter, but it cannot hold the whole, therefore it drops back.

*Mr. Menzies*: And atmospheric pressure at the bottom is 20 not sufficient to hold it?—The same at the top.”

In that passage, it does not clearly appear in what position the witness held the pen. My own recollection was that he held it both vertically, and with the point above the horizontal, writing respectively on a horizontal and a vertical surface. But as that was not clear, and there were two references in the passage to writing with the pen “upside down,” I raised the question again at p. 340. The result was that Dr. Fehling was recalled, and gave more detailed and explanatory evidence in relation to the operation of the pen in both positions. That evidence is too lengthy to quote, but it was made quite clear that if the pen was used to write on a vertical surface with the ballpoint some 35 degrees above the horizontal, it would write only to the approximate extent indicated by Exhibit 8 before the ball and the ball cavity or housing were completely devoid of ink, and no “continuous liquid vein” was any longer “maintained to the ball.” It was of course obvious that the surface written on need not be precisely vertical, since it was the position of the pen itself which produced the result stated. Reversion to a position with the point below the horizontal, and the rotation of the ball, would restore the vein fairly quickly.

30

Now can it be said that the Defendant’s pen is one in which “when charged with viscous ink a continuous liquid vein is maintained extending from the ball,” in what I shall, for brevity, describe as all conditions of normal user? I have come to the conclusion that it cannot. To begin with, Dr. Fehling, at p. 198, when considering whether any conditions of “normal use” could arise resulting in a risk of leakage, described one case by saying, “The only condition I know *and the user of the ballpoint pen is familiar with*,—if I write upwards . . .” But in the next place, I cannot say, viewing the matter as a jury would, and using my own general knowledge of everyday affairs and events, that it is not one perfectly normal

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method of using a writing instrument in general, or a fountain-pen or ball-point pen in particular, to write on a vertical or inclined surface with the point of the instrument above the horizontal. Nor can I say, looking at Exhibit 8, that it would be quite abnormal to seek to write in such a position more than there appears. Almost everyone, I suppose, has seen on the vertical notice boards of social or other clubs, or of sporting bodies, documents on which persons are invited or expected to write names or other particulars, and on which it is usual or preferable to write in ink—e.g., entries for tournaments, results of matches, subscriptions for  
 10 donations, and the like. Many persons have seen in the headquarters or other establishments of the armed forces, or in the laboratories or control rooms of many kinds of technical establishments, charts, lists, maps, or other documents on vertical walls or boards, on which it is the practice manually to write in ink entries from time to time of all kinds of particulars. Tradesmen and carriers are frequently seen to write in such a position against a wall. Viewing the matter again as a judge of fact, I entirely disagree with Mr. Phillips' suggestion that in such cases people attempt to write with the point below the horizontal; that would be most unusual. It is hardly a matter on which one can expect evidence to  
 20 establish any more than one's observation and commonsense tell one.

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Accordingly I am of opinion that the Defendant's pen, Exhibit E, and any similar pen relied on by the Plaintiff as an infringement, has not been shown to infringe Claim 1, nor, therefore, any other claim of the patent, if one construes Claim 1 as I have construed it (and as the Plaintiff's counsel construed it) in relation to the first four elements referred to in it, and assumes it not to be invalid for ambiguity as to the last element mentioned in that Claim.

It is not to the point, on this aspect of the case, for the Plaintiff to say, "But the evidence is that every pen, even a pen made according to  
 30 the patent would behave in a similar fashion to that described in Dr. Fehling's evidence." Upon infringement, the question must be determined according as the alleged infringing pen falls within the claim or not, and I hold that it does not. If a pen made according to the patent would not comply with the claim, or with the promise to the same effect contained in the body of the specification, so much the worse for the patentee if false suggestion had been pleaded as an objection to validity. In the body of the specification, col. 2, ll. 1-3, and col. 5, ll. 15-18, such a promise appears. But the Defendant did not raise the point in its particulars of objections. Mr. Menzies at one stage contended that  
 40 para. 5 of the particulars was sufficient to cover it, but at pp. 246-8 of the Transcript I held to the contrary, and no application to amend the particulars was made. The Plaintiff accordingly did not lead evidence specifically directed to such a plea. I will only say, therefore, that if the point had been properly raised on the pleadings in due time, and the evidence had stood in relation to that point as it now stands in relation to infringement, I should have been bound to hold the patent invalid on that ground.

It remains to deal with the objections of want of subject matter by reason of (A) lack of inventive step having regard to prior common general knowledge; (B) lack of inventive step having regard to what was known

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or used before 31st December 1943 with respect to ballpoint fountain-pens ; and (c) lack of inventive step having regard to the Plaintiff's own application for and obtaining of a grant of No. 122073, and to the course and nature of the Plaintiff's application for, and amendments of the complete specification of, No. 133163. The third ground is not, I think, really pleaded at all. It was, however, fully argued, being treated as arising out of the development in argument of para. 2 of the Particulars of Objections. It may be that it was, in a sense, forced on the Plaintiff by my allowing in evidence, subject to objection, the amendment documents (Exhibit 2) and the communications from the Patent Office to the Plaintiff which led to those amendments (Exhibit 6), as possibly relevant on the basis of the Defendant's contention that they would, when examined, amount to some kind of admission of lack of subject-matter, expressly or by conduct, on the authority of the decision of Clauson J. in the *British Celanese Case*, 50 R.P.C. 63, at pp. 82-3. But having regard to the course which the case took before me, I should if necessary give the Defendant leave to amend his Particulars of Objections to raise the matter specifically. 10

The first objection depends on certain cross-examination of Dr. Fehling, with respect to Exhibit 5, and the evidence of Messrs. Tetley and McMahon with respect to Exhibit 5 and similar instruments. The evidence of the two last-mentioned witnesses, so far at least as it related to Exhibit 5 and similar instruments, was received by me subject to Mr. Shelley's objection that common general knowledge could not be proved by evidence as to particular apparatus or instruments which had not been pleaded by way of particulars. I received the evidence *de bene esse* because it was in my opinion not practicable to decide until the evidence was all in to what extent the total of the evidence in relation to various individual devices of a similar type might establish common general knowledge. 20

Common general knowledge means "the information which, at the date of the patent in question, is common knowledge in the art or science to which the alleged invention relates so as to be known to duly qualified persons engaged in that art or science"—per Younger J. (as he then was) in *British Thomson-Houston Co. v. Stonebridge Electrical Co.*, 1916, 33 R.P.C. 166, at p. 171. 30

I accept the evidence of Messrs. Tetley and McMahon, so far as it goes. I thought them both to be witnesses who were truthful and accurate. The evidence of McMahon shows that about 1915 there was in use in Victoria a gas analyser in which a vertical capillary tube acted as a reservoir for the ink in a recording device, and a very fine capillary tube at right angles to the reservoir, and at the bottom of it, formed a point which made a trace on a roll-chart. The recording instrument operated in the stationary machine, and gravity assisted the feed ; no question of leakage seems to have been important, since the stylus was normally in contact with the paper of the roll. Furthermore, from 1928 McMahon, and from about 1940, Tetley, were familiar with recording pens, used in technical recording instruments, of the type appearing in Exhibit 5. These appear genuinely to operate on the basis of capillary forces, with the reservoir inclined upwards, and with the stylopoint above where the end of the ink column in the inner reservoir will for some period be when the outer reservoir is empty. 40 50

But again, they operate on a roll or other record in a stationary machine. Tetley before 1943 had seen four such instruments in use by Imperial Chemical Industries, his employers, in Victoria, and up to about a dozen in technical instrument suppliers' offices, for supply to other persons using them in industry or otherwise. McMahon had seen, in addition to the one he saw in 1928, three others—one installed in 1939 in the Newport Electricity Power Station in an instrument for measuring water salinity; another in the laboratories of the Commonwealth Scientific and Industrial Research Organisation, about 1941, in a temperature-measuring instrument; and another in an instrument tested by the State Electricity Commission in 1942. I am satisfied that Tetley, who was and is a highly qualified chemist, understood well enough before 1944 the physical principles of capillarity which caused the ink not to run back out of the inner reservoir when the stylopoint was above it, and the outer reservoir was empty. It should further be added that Dr. Fehling, at p. 240 of the Transcript, said in cross-examination that he could, if he were given Exhibit 5, and asked to expand the stylopoint to accommodate a ball, readily do so. He conceded that in 1943 the ball-point principle itself, the feed-duct of narrower cross-section than the reservoir, the venting of the reservoir to admit air, and the use of viscous ink, were all old (see pp. 218, 227, 228, of the Transcript).

Nevertheless, I am of opinion that no such common general knowledge has been shown to have existed in the Commonwealth before 1944 as to negative inventive step or subject matter. In the first place, no evidence whatever has been given of the then state of knowledge in the pen-making art or science in Australia, i.e., in the industry of making, for manual use, pens in general, or fountain-pens or ball-point pens in particular. Tetley and McMahon, and their associates who may have been in a position to see or use instruments employing recording devices similar to Exhibit 5, were technicians in the chemical and electric power industries, respectively, and the C.S.I.R.O., was a scientific research organisation. In the second place, the evidence completely fails to show that there was no inventive step in applying to ball-point fountain-pens for manual use the conception of a capillary tube as a reservoir. There was, I think clearly invention (and not the mere use of common general knowledge) in producing by the use of a capillary reservoir, with viscous ink, a fountain-pen which (save at all events in the particular case earlier discussed of writing with the ball above the opposite end) would not leak in practical use. No pen-manufacturer in Australia had before 1944, so far as the evidence shows, attempted anything of the kind. The manner and rate of writing achieved by the patented pen bore but little resemblance to those of Exhibit 5.

With respect, next, to the objection of want of subject matter having regard to what was known or used here before 1944, the same material is in substance relied on, plus two U.S. specifications available at the Patent Office Library at Canberra in April and May 1942, respectively. In my opinion, this ground also fails. The U.S. specifications were those of Biro himself, and were for ball-point pens with a reservoir of the piston type. The evidence of Dr. Fehling is that they were not satisfactory, and they certainly do not make the step taken in the present patent obvious.

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The third ground relied on as showing want of subject matter, however, i.e., lack of inventive step having regard to the history in the Patent Office of Nos. 122073 and 133163, raises questions of much greater difficulty and importance. Reduced to its shortest form, the Defendant's argument on this point is that the only really inventive step (if any) involved in the matters described and claimed in Nos. 122073 and 133163 was the application to ball-point fountain-pens of the capillary tube reservoir, and that, since this step was taken in No. 122073 (though unnecessarily limited, through misapprehension of the scientific principles involved, to reservoirs of a helical or similar "extended" form), it could not be used 10  
to support another patent, even by the same patentee, and even if the second patent was applied for while the application for the first was still secret.

Though the contention may be thus shortly stated, it is desirable to set out a little more fully the facts which appear in the evidence—subject to Mr. Shelley's objection, so far at least as Exhibits 2 and 6 are concerned.

On the 8th December, 1943, the Plaintiff applied for what became No. 122073. The complete specification (Exhibit 1) was lodged with the application and was not, so far as the evidence shows, amended. The 20  
complete specification, which I have already discussed earlier in this judgment, described and claimed the method of making a ball-point writing instrument which would not leak by the effect of gravity. The method was to use as a reservoir a conduit or conduits following an extended path, charged with a suitable (i.e., dense) ink, open to atmosphere at the end remote from the ball, and "of so small a cross-section that a suitable ink could not escape from the air-intakes under the effect of gravity." This, though the inventor, as Harman, J., has pointed out, probably did not fully understand it, was really the application of the simple principle of the capillary tube; and the "extended" helical or other shapes, to 30  
which alone the specification laid claim, were not essential to the technical success of the invention.

On the 31st December, 1943, the Plaintiff applied for what ultimately became No. 133163. The application for No. 122073 was still in the Patent Office, and did not become public for nearly three years thereafter. The original complete specification lodged on the 31st December, 1943 (Exhibit C), has already been analysed in detail in my judgment of June, 22nd last. It claimed, in substance, certain particular forms of reservoir in ballpoint pens—i.e., one formed of a series of sections connected together 40  
so as to form a single duct (Claim 1); one in which the sections were longitudinally parallel within the holder (Claim 2); one in which the air intake of such sections pointed in the same direction as the ball-point (Claim 3); and one in which such a duct was filled with a dense ink constituting an uninterrupted liquid vein to the point (Claim 11).

On the 19th October, 1945 (see Exhibit 6), the Patent Office informed the Plaintiff (*inter alia*) that the Examiner had cited under sec. 41 an application not yet open to inspection. That meant that the Examiner had reported that "the invention" was "already the subject of a prior application for a patent in the Commonwealth."

On the 21st August, 1946, the complete specification of No. 122073 was accepted, and on the 5th September, 1946, the acceptance was advertised under sec. 50.

On the 2nd December, 1946 (Exhibit 6) the Office informed the Plaintiff that the Examiner had reported that the invention the subject of the application of the 31st December, 1943, was already the subject of a prior application for a patent, viz., his own application for No. 122073, and that the basis of the report was that the earlier application "claimed" —having regard to Fig. 6 in the complete specification thereof—the subject  
 10 of Claim 1 of the later application. The Fig. 6 referred to, depicted a reservoir the shape of which was a series of unclosed annular rings, which was evidently regarded by the Examiner as the same thing as the series of duct sections connected together referred to in the document of the 31st December, 1943.

On the 18th December, 1946, the Plaintiff substituted (Exhibit 2) a completely rewritten specification. That, among other things, claimed a ball point pen in which the ink reservoir was constituted by a capillary tube (Claim 1); and separately, a similar instrument in which the tube communicated with the ball by a duct "of the same or smaller cross-  
 20 sectional area or diameter than the tube" [*sic*].

On the 26th August, 1947 (Exhibit 6), the Office stated the objection (among others) that the meaning of "capillary tube" was not defined, and that the invention was already patented under No. 122073, since Claims 1-3 thereof claimed an instrument of the same type, in which the reservoir was a capillary tube.

On the 28th January, 1948 (Exhibit 2), the Plaintiff submitted amendments which included a new "consistory clause" and a new Claim 1, which however still claimed any instrument in which (irrespective of shape) the reservoir functionally operated by capillarity to maintain  
 30 supply, and by capillarity and the viscosity of the ink to prevent leakage at the open end. On the 19th February, 1948, under sec. 38A, the now long abandoned original complete specification lodged in 1943 was advertised and deemed to be "published," as I have previously mentioned.

On the 11th March, 1948 (Exhibit 6), the Office repeated its objection based on No. 122073 as a prior patent.

On the 16th November, 1948 (Exhibit 2), the Plaintiff submitted further amendments, particularly a new consistory clause and a new Claim 1, which now each expressly put forward for the first time the combination of a vented tube of capillary size (defined in the text), "in  
 40 which when charged with viscous ink a continuous liquid vein is maintained extending from the ball," with a feed duct from the reservoir to the ball, of a cross-sectional area less than that of the reservoir. The former claim 3, to a duct of equal or smaller cross-section, was omitted.

On the 24th December, 1948 (Exhibit 6), the Office stated (in effect) that its objections based on No. 122073 were removed by the proposed amendments, but that the restricted feed duct was not sufficiently described, nor had it been originally claimed, ascertained, or described as a feature of the invention.

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On the 10th and 11th March, 1949 (Exhibit 2), the Plaintiff submitted amendments, which (*inter alia*) introduced into the reference to the cross-section of the feed duct the words, "particularly that portion adjacent the ball," to which I have earlier referred, described the feed duct in the body of the specification, and amended the definition of "capillary tube."

On the 27th April, 1949 (Exhibit 6), the Office approved these amendments, but required a clearer indication, in the drawings and in the references to the drawings, of the restricted feed duct—which, incidentally, the Assistant Chief Examiner described as "the essential feature of the invention."

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On the 16th May, 1949 (Exhibit 2), the Plaintiff submitted amendments which satisfied this requirement.

The matter then proceeded on the 14th June, 1949, to acceptance, and on the 30th June, 1949, to advertisement of acceptance, as I have previously stated.

It was said by Mr. Menzies that this series of events showed that the Plaintiff had really asserted three different inventive steps—first, merely the discovery of a new shape of capillary reservoir, consisting of a number of limbs, and of the feature of an air-intake pointing the same way as the ball-point; secondly, the whole principle of the application of the capillary tube reservoir to ball point pens; and lastly, the mere combination of such a reservoir with a particular kind of feed duct. The making of the combination last suggested involved, it was argued, no inventive step in itself, but the claim was merely a futile attempt to get over the objection based on No. 122073; the inventive step first asserted may have been a good one, but would not support any claim in the patent which the Defendant could be alleged to have infringed; and the second, and intermediate, assertion had been in substance admitted by the Plaintiff's conduct to be unsound on the ground that that step was already the step which supported, though it was not fully claimed in, No. 122073.

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I agree that—as Mr. Phillips conceded in his final reply on behalf of the Plaintiff—the real inventive step which must be relied upon to support both No. 122073 and No. 133163 is the same, viz., the application to ball-point pens of the principle of the capillary tube reservoir in combination with the use of viscous ink. But, unless it be the law that the same inventive step cannot constitute subject matter for more than one grant to the same patentee, I do not think that this particular attack of the Defendant's upon the patent now in suit succeeds. For I do not think it matters in the present case, on the question of subject-matter, how much the applicant shifted his ground in the course of the proceedings in the Office. I agree with Mr. Menzies that what the applicant says and does during such proceedings may be relevant to the inquiry what inventive step he has in fact taken, and cannot be excluded. I do not agree with Mr. Phillips that an applicant can make admissions against himself only in relation to "inventiveness," and not in relation to "inventive step." Nor do I agree with the submission by Mr. Shelley that the inventor's mentality and assertions are irrelevant to the question of inventive step, save to negative what would otherwise be a *prima facie* conclusion of the absence of such a step. In my opinion, what the inventor or other applicant

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from time to time asserts, or does not assert, or first asserts and then withdraws, as to inventive step, must be weighed with the rest of the evidence. Of course, he may be no expert at all. He may not, and usually will not, know the true frontiers of antecedent knowledge, as was pointed out by Fletcher Moulton, L.J., in *B.U.S.M. v. Fussell*, 1908, 25 R.P.C. 631, at p. 652. I do not see, however, why his supposed admissions, by words or conduct, in relation to the question, "has his supposed discovery really in fact advanced the frontiers of knowledge in the realm?" should not be just as much considered as his supposed admissions in relation to the different inquiry, "did his supposed discovery involve the exercise of the inventive faculty so far as he was concerned?" On the former question his supposed admissions may, it is true, have much or little weight; or they may be quite valueless. It depends who he is and what he is, and what he has admitted.

In the present case, the rest of the evidence makes it clear what the inventive step was, and I do not need the Plaintiff's supposed admissions to tell me that the mere adding of (1) a duct of restricted cross-section to (2) the reservoir formed of a capillary tube, was not an inventive step if both (1) and (2) were otherwise old. I am on the other hand satisfied that the application of the capillary tube to the reservoirs of such pens was a new and useful advance in knowledge, and also required the exercise of the "inventive" faculty.

But it is another and a much more interesting and difficult question whether that step can support both patents.

I may begin the consideration of this question by observing that if the objection is a good one, it was obviously open, but was not taken, in the proceedings before Harman J. upon the two U.K. patents, Nos. 571698 and 573747 (see 66 R.P.C. 193). Nor have I been referred to, nor have I found, any case in which an objection has been taken in such a form. I shall refer separately to cases in which the objection of prior grant has been put forward.

I may next put out of the way the provisions of sec. 33 (1) to the effect that an application for a patent shall be for one invention only, since it is trite logic that that proposition cannot lead of itself to the conclusion that there shall be only one patent for one invention.

Nevertheless, it may still be that the objection is valid, and that its basis is to be found elsewhere in the Act, as Mr. Menzies argued. He relied principally on sec. 41 (a), which makes prior patenting or prior application a ground of objection by an examiner, and sec. 46, which provides similarly in respect of the Commissioner's right, and (as I have held) duty, to refuse acceptance on those grounds.

Mr. Shelley contended that the same inventive idea might support the grant to the same applicant of any number of patents. Mr. Phillips, in his reply, qualified that proposition by conceding that it would not apply to the case of identical claims in two applications by the same applicant, or to the case where a second application, based on the same inventive step, was lodged by an applicant after his first application, based on the same step, had become public—i.e., where he had "anticipated" himself. He submitted that, in order to establish "prior grant" or "prior

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application" within the meaning of the Statute, identity of technical claims is requisite, and not merely identity of description, disclosure or assertion.

The last contention is, I think, borne out by the authorities, subject to this, that where a second grant is made, upon different claims, a reference to the prior grant may have to be inserted to prevent confusion in relation to infringement or otherwise; see *Birmingham Tyre Co. v. Reliance Tyre Co.*, 19 R.P.C. 298; *Blackett v. Dickson*, 26 R.P.C. 73, at p. 82; *Comptroller's Ruling (D)*, 29 R.P.C. (Appx.) ix; *Comptroller's Ruling (C)*, 39 R.P.C. (Appx.) v; *Rowland & Kennedy v. Air Council*, 42 R.P.C. 433, at p. 441; 10  
Fletcher Moulton on Patents, p. 77; Terrell on Patents, 9th ed., pp. 105-6; and *cf.* the discussion of the matter in my decision of June 15th, at pp. 44-5.

Mr. Phillips further submitted that if the objection taken by an examiner was based on a prior grant made after the application date of the current application—as distinct from prior publication before that date—the question which arose for the applicant was one of the possible alteration of claims. I think that is borne out by the case in 39 R.P.C. (Appx.) v, and the discussion by the Comptroller there reported. If, however, the objection was prior application, the applicant must see whether, on reference to dates, the earlier application involved prior publication (e.g., 20  
if under sec. 38A it had been published before the date of his own application), or would result at most in prior grant (e.g., if there was identity of a claim or claims, but no publication till after his own application date). In the former case, Mr. Phillips said, the objection might be fatal whatever the applicant did. In the latter, it was again a matter of amending the claim if possible. Again, I think this analysis is right.

But if, in the case of two different inventors, the same inventive step may support two patents, provided at all events the claims do not overlap—as in the case in 39 R.P.C.—it is difficult to see why the position is not *a fortiori* in the case of two patents sought by the one applicant. If, of 30  
course, his first application is published before the lodgment of his second, he will anticipate himself. But if not, it has been held that no theory of intended future dedication to the public of the whole of the inventive idea contained in the first document will, apparently, avail to defeat a grant on the second application, if the first is abandoned; see *Oxley v. Holden*, 1860, 8 C.B.N.S. 666; *Lister v. Norton*, 1886, 3 R.P.C. 199, at pp. 206-8; Fletcher Moulton, p. 77, note (c). Clearly, the obtaining of a patent on the first application, instead of abandoning it, cannot make any difference to that position as regards anticipation.

Again, if the test of prior grant or prior application as a valid objection 40  
is identity, or even practical identity, of the technical claims, the theory put forward by Fletcher Moulton, *op. cit.*, at p. 76, that another ground on which the objection of prior grant may be based is that the Crown cannot grant a monopoly for the same invention for a term exceeding 16 years in all, would not negative the validity of a second patent granted for a different monopoly, which would necessarily be the case if the claims therein were different from those of the first patent.

Again, why should not an applicant, for example, if he finds that his first application is too narrow, lodge, before publication of the first, another

application, based on the same inventive step, but containing a wider claim or claims? Why should he, as a condition of so doing, have to abandon his earlier application, and lose such protection as its earlier date might give him with regard both to anticipation by others and to infringement in relation at least to the more limited monopoly therein claimed? Such a view would not result, as it seems to me, in the consequence envisaged by Mr. Menzies that an applicant might, by a series of applications based on the one inventive step, indefinitely extend the period of protection contemplated by the Act; for once any application was  
 10 published he could not effectively lodge another.

I have considered the provisions of the Act, in secs. 63A and 85, as to cognate inventions and patents of addition, respectively, and of reg. 11, as to the division of applications relating to more than one invention. They are all related to, and, of course, entirely consistent with, the principle of the Act that a patent shall be for one invention only.

But I have not been able to find in them what seems to me any really sound ground for upholding Mr. Menzies' argument on this branch of the case. I confess that I originally approached this question with a strong impression that it would be contrary to the general scheme of the Act to  
 20 allow more than one patent to be based on a single inventive idea. But consideration of the Act and of the authorities has not confirmed that impression. I may add to what I have already said, that if, in one patent, an applicant is permitted to include a number of different claims, provided they relate to one "invention," and (as is usually the case) to claim in that way various embodiments of his inventive idea, or one embodiment in association successively with a number of other features not inventive in themselves, it is difficult to see any real prejudice to the public if he is also permitted to make instead a number of applications for different patents for those various embodiments.

30 If this view is right, it follows, I think, that the Commissioner was wrong in rejecting altogether the proposed amendment of December, 1946—which would have included in No. 133163 a claim for the general application of a capillary reservoir to ball point pens—on the ground of prior claiming or prior grant in No. 122073, though he might perhaps have required the exclusion from the new claim of the arrangements or exemplifications claimed in No. 122073.

40 If the Plaintiff had pressed such a view to the point of appeal from the Commissioner, he might have avoided such of his difficulties as have been occasioned by the attempt to introduce a particular type of feed-duct as an essential element. But—omitting for the moment what I have held to be other grounds of invalidity, or possible invalidity—I have for the reasons stated come to the conclusion—though not, I confess, without a good deal of doubt—that the separate ground of invalidity in relation to inventive step which I have last considered is not sound in law.

I have now dealt with all the questions which were argued before me and in the result there must be judgment for the Defendant, on the ground that the patent sued on is invalid for ambiguity in the claims, and that in any event it has not been infringed.

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## COSTS IN BOTH ACTIONS.

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It remains to deal with questions of costs in both actions.

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In the 1947 action, the costs incurred prior to the trial and referable to the issue of validity would not be large. There were, of course, pleadings and particulars of objections in which some separate costs might be so distinguished. At the trial, the two actions were heard together, and the general technical evidence of Dr. Fehling and Dr. Hopper largely related to both. The oral evidence relating to No. 122073, and to Laforest's specification, was quite short, and in any event, that which related to No. 122073 was relevant to more than one matter argued in relation to No. 133163. Consequently, although in the 1947 action the Defendant has succeeded on infringement, and there has been no decision on validity, whereas in the 1951 action it has succeeded on both heads, it is very undesirable that I should put upon the Taxing Master the difficult task of endeavouring to apportion the costs of the trial between the two actions. It is not a task which, even after having conducted the trial, I should find at all easy myself. 10

Turning to the 1951 action, although the Defendant Company has succeeded on validity and infringement, it raised some very important points in relation to validity on which it has failed, and which took up a substantial portion of the third stage of the hearing. I am not, of course, referring to the matters dealt with by my earlier judgments last month, but I have in mind the whole question of subject matter and some aspects of ambiguity. It also failed in some of its arguments on infringement. Here again I have come to the conclusion that I ought, if possible, to avoid an order which will involve the Taxing Master in attempting to apportion the costs of issues. 20

I think that, on the whole, I can best do justice in the matter of costs by awarding to the Defendant, in the exercise of my discretion, and according to the best estimate I can make having regard to my knowledge of the whole case, a fixed—and the same—proportion of its costs of both actions, excluding of course the costs in the second action dealt with by my judgment of June 22nd, but including any other costs reserved. I fix that proportion at three-quarters, and I shall direct a set-off of costs: cf. O. LXV, r. 14. There is no need under our Rules to certify as to particulars. 30

## MINUTES OF JUDGMENTS.

In Action No. 314 of 1947:—

(1) Judgment for Defendant.

(2) Order that Defendant's costs of and incidental to this Action, including costs of pleadings, and any costs reserved, be taxed; and further order that three-quarters thereof, together with such three-quarters of the Defendant's taxed costs in Action No. 58 of 1951 as are referred to in the judgment of this date in that action, be set off against the costs payable by the Defendant to the Plaintiff under the judgment of this Court in that action dated the 22nd day 40

of June, 1953 ; and that the balance so ascertained be paid, by the party found on such set-off to be owing it to the other, to that other.

(3) Stay of 42 days.

In Action No. 58 of 1951 :—

(1) Judgment for Defendant.

(2) Order that Defendant's costs of and incidental to this Action, including costs of pleadings, and (save as hereinafter provided) any costs reserved, but excluding all costs dealt with by the judgment in this Action dated the 22nd day of June 1953, be taxed ; and further order that three-quarters thereof, together with such three-quarters of the Defendant's costs in Action No. 314 of 1947 as are referred to in the judgment of this date in that Action, be set-off against the costs payable by the Defendant to the Plaintiff under the said judgment in this Action dated the 22nd day of June, 1953 ; and that the balance so ascertained be paid by the party found on such set-off to be owing it to the other, to that other.

(3) Stay of 42 days.

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**No. 33.**

**FINAL JUDGMENT IN ACTION No. 58 of 1951.**

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THIS ACTION having come on for further trial before this Honourable Court on the 22nd, 23rd, 24th, 25th and 26th days of June 1953 UPON HEARING Mr. Phillips one of Her Majesty's Counsel, Mr. Shelley one of Her Majesty's Counsel and Mr. Pape of Counsel for the Plaintiff and Mr. Menzies one of Her Majesty's Counsel and Mr. Gilbert of Counsel for the Defendant AND UPON READING the Pleadings herein and the several admissions of fact by the Plaintiff and the Defendant respectively filed herein AND UPON HEARING the evidence of the several witnesses called on behalf of the Plaintiff and of the Defendant respectively THIS COURT DID ORDER that this action should stand for Judgment AND this action standing for Judgment this day accordingly THIS COURT DOTH ORDER AND ADJUDGE that Judgment be entered for the Defendant AND THAT the Defendant's costs of and incidental to this action including the costs of Pleadings and (save as hereinafter provided) any costs reserved but excluding all costs dealt with by the Judgment in this action dated the 22nd day of June 1953 be taxed AND THAT three-quarters of the Defendant's costs as so taxed together with such three-quarters of the Defendant's taxed costs in Action No. 314 of 1947 as are referred to in the Judgment given by this Court this day in that Action be set off against the costs payable by the Defendant to the Plaintiff under the said Judgment in this action dated the 22nd day of June 1953, and that the balance so ascertained be paid by the party found on such set-off to be owing it to the other party to that other party AND THIS COURT DOTH FURTHER ORDER that the issue of execution upon this Judgment be stayed for a period of 42 days from the date hereof.

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No. 34.

ORDER giving Special Leave to Appeal.

*In the  
High Court  
of  
Australia.*

Appeal No. 30 of 1953.

Before THEIR HONOURS THE CHIEF JUSTICE, SIR OWEN DIXON,  
MR. JUSTICE WEBB, MR. JUSTICE FULLAGAR, MR. JUSTICE KITTO  
and MR. JUSTICE TAYLOR.

No. 34.  
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Special  
Leave to  
Appeal,  
28th  
September  
1953.

Monday the 28th day of September 1953.

UPON MOTION made to the Court this day at Melbourne AND  
UPON HEARING Mr. Phillips of Queen's Counsel and Mr. Pape of  
10 Counsel for the above-named Applicant, Henry George Martin and  
Mr. D. I. Menzies of Queen's Counsel and Mr. Gilbert of Counsel for the  
above-named Respondent Scribal Proprietary Limited AND UPON  
READING the affidavit of Stanley Avery sworn the 26th day of September  
1953 and filed herein and the exhibits referred to in the said affidavit  
THIS COURT DOTH ORDER that special leave be and the same is  
hereby granted to the said Applicant to appeal to this Court from the  
judgment given on the 28th day of July 1953 by His Honour Mr. Justice  
Sholl in the Supreme Court of the State of Victoria upon the trial of the  
above-mentioned action 1951 No. 58 AND THIS COURT DOTH ALSO  
20 ORDER that special leave be granted to the said Respondent to appeal  
to this Court from the judgments given on the 15th and 22nd days of  
June 1953 respectively by His Honour Mr. Justice Sholl in the Supreme  
Court of the State of Victoria in the said action 1951 No. 58.

By the Court,

(L.S.)

(Sgd.) J. G. HARDMAN,  
Principal Registrar.

*In the  
High Court  
of  
Australia.*

No. 35.

**PLAINTIFF (Appellants) Notice of Appeal.**

Appeal No. 30 of 1953.

No. 35.  
Plaintiff,  
Notice of  
Appeal,  
14th  
October  
1953.

TAKE NOTICE that (pursuant to an order of the High Court of Australia dated the 28th day of September 1953 granting the Appellant special leave to appeal) the High Court of Australia will be moved by way of appeal at the first sitting of the High Court at Melbourne for hearing appeals after the expiration of six weeks from the institution of this appeal or so soon thereafter as Counsel can be heard on behalf of the abovenamed Appellant for an order that the whole of the judgment of the Supreme Court of the State of Victoria delivered on the 28th day of July 1953 by His Honour Mr. Justice Sholl in an action numbered 1951 No. 58 wherein the Appellant was Plaintiff and the Respondent was Defendant whereby it was ordered and adjudged that judgment therein should be entered for the Defendant and that the Defendant's costs of and incidental to the said action including costs of pleadings and (save as therein provided) any costs reserved, but excluding all costs dealt with by the judgment in the said action delivered the 22nd day of June 1953 should be taxed and that three quarters of such taxed costs (together with such three quarters of the Defendant's costs in action No. 314 of 1947 as were referred to in the judgment of the 28th day of July 1953 in that action) be set off against the costs payable by the Defendant to the Plaintiff under the judgment in the said action delivered the 22nd day of June 1953 and that the balance so ascertained be paid by the party found on such set off to be owing it to the other, to that other, and that execution on such judgment be stayed for forty-two days **BE SET ASIDE AND REVERSED** and that in lieu thereof it be ordered and adjudged that Judgment be entered for the Plaintiff (Appellant) in the said action for an injunction and other relief claimed in the Statement of Claim and that the Defendant (Respondent) do pay to the Plaintiff (Appellant) his costs of the said action and this appeal or for such other order as to the High Court shall seem just **AND FURTHER TAKE NOTICE** that the grounds upon which the Appellant intends to rely in support of this Appeal are as follows :—

1. That the said judgment was wrong in law and in fact.
2. That the said judgment was against the evidence and the weight of the evidence.
3. That on the evidence judgment should have been entered for the Appellant.
4. That the learned judge was wrong in holding that Claim 1 of the complete specification of Letters Patent No. 133163 was invalid by reason of ambiguity in the same.
5. That the learned judge was wrong in holding that the said Claim 1 insofar as it referred to a feed duct leading from the reservoir to the ball point was open to two constructions.
6. That the learned judge should have held that there was no ambiguity in the said claim insofar as it referred to the feed duct and that on its proper construction the whole of the said feed duct was required to



be of lesser cross sectional area than the cross sectional area of the reservoir and that in consequence there was no uncertainty as to what the " fifth element " of the said Claim was.

*In the  
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of  
Australia.*

7. That on the evidence the learned judge should have held that the Scribal Secretary Pen sold by the Respondent had a feed duct leading from the reservoir to the ball and that the cross sectional area of that duct and in particular the cross sectional area of that portion of the duct adjacent the ball was of lesser cross sectional area than that of the reservoir, and that accordingly Claim 1 of the said Letters Patent had been infringed.

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No. 35.  
Plaintiff,  
Notice of  
Appeal,  
14th  
October  
1953,  
*continued.*

10 8. That the learned judge was wrong in holding that the Scribal Secretary Pen sold by the Respondent and alleged to constitute an infringement of the Appellant's Letters Patent was not a pen in which in all conditions of normal use when charged with viscous ink a continuous liquid vein was maintained extending from the ball.

20 9. That the learned judge was wrong in construing the words " in which when charged with viscous ink a continuous liquid vein is maintained extending from the ball " in Claim 1 of the Complete Specification of the said Letters Patent as covering and being applicable to the situation when the ball point pen was used in such a position that the ball point was substantially higher than the opposite end of the pen, and failed to give any or any sufficient weight in construing the said words to other words in the said specification which confirmed the conclusion that normal use was intended to mean use on or in connection with a normal writing surface.

10. That the learned judge was wrong in holding that the alleged infringing pen did not fall within the words of Claim 1 of the said complete specification.

30 11. That the learned judge should have held that in all circumstances of normal use the Respondent's pen was one in which a continuous liquid vein of ink was maintained extending from the ball and that accordingly it infringed Claim 1 of the said Complete Specification.

40 12. That upon the evidence the learned judge should have held that the Respondent's pen was an instrument of the type specified in the said Complete Specification, that it had an ink reservoir constituted by a vented tube of capillary size in which when charged with a viscous ink a continuous liquid vein was maintained extending from the ball, that it had a feed duct leading from the reservoir to the ball, that the cross sectional area of such duct and in particular the cross sectional area of that portion of the said duct adjacent the ball was less than that of the reservoir and that accordingly it infringed Claim 1 of the said Complete Specification, and also Claims 2, 5 and 8 thereof.

Dated the 14th day of October 1953.

MOULE HAMILTON & DERHAM,  
of 394-396 Collins St., Melbourne,  
Solicitors for the Appellant.

To The above-named Respondent Scribal Proprietary Limited and its solicitors, J. T. Brock, Esq., of Grant Street, South Melbourne.

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*In the  
High Court  
of  
Australia.*

No. 36.

**DEFENDANT (Respondent) Notice of Appeal.**

Suit No. 58 of 1951.

No. 36.  
Defendant,  
Notice of  
Appeal,  
19th  
October  
1953.

TAKE NOTICE that (pursuant to an Order of the High Court of Australia made the 28th day of September 1953 granting the Appellant special leave to appeal) the High Court of Australia will be moved by way of appeal at the first sitting of the High Court at Melbourne for hearing appeals after the expiration of six weeks from the institution of this Appeal or so soon thereafter as Counsel can be heard on behalf of the abovenamed Appellant **FOR AN ORDER OR ORDERS** that—

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(i) so much of the judgment of the Supreme Court of the State of Victoria delivered on the 15th day of June 1953 in action numbered 58 of 1951 wherein the Appellant was Defendant and the Respondent was Plaintiff whereby it was *inter alia* adjudged and declared that the question of law therein referred to be answered that the allegations set out in paragraph 4 of the Defendant's particulars of objections as amended on the 5th day of June 1953 and in paragraphs 1 and 2 of its further particulars of objections, so far as the same are allegations of fact, and paragraph 6 of the said particulars of objections, so far as it depends exclusively upon the aforesaid allegations of fact, constitute a good defence in law to the Plaintiff's claim herein to the following extent only and not otherwise, viz., so far as they allege that the effect of the amendments therein referred to or either of them was that the complete specification of the Letters Patent No. 133163 in its final form claimed an invention substantially different from the invention described and disclosed by the complete specification originally lodged with the application dated the 31st day of December 1943 and that paragraph 5 of the said particulars of objections so far as it depends exclusively upon the said allegations of fact does not constitute such a good defence **BE VARIED** so far as it was thereby adjudged and declared as aforesaid, and that **IN LIEU THEREOF** it be adjudged and declared that the said question of law be answered that the allegations set out in paragraph 4 of the said particulars of objections as amended on the 5th day of June 1953 and in paragraphs 1 and 2 of the said further particulars of objections, so far as the same are allegations of fact, and paragraph 6 of the said particulars of objections so far as it depends exclusively upon the aforesaid allegations of fact, constitute a good defence in law to the Plaintiff's action herein, and that paragraph 5 of the said particulars of objections, so far as it depends exclusively upon the said allegations of fact constitute such a good defence. **OR FOR SUCH OTHER ORDER** as to the High Court shall seem just ;

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30

40

**AND THAT**

(ii) so much of the judgment of the Supreme Court of the State of Victoria delivered on the 22nd day of June 1953 in the action aforesaid whereby it was *inter alia* adjudged and declared that the allegations of the Defendant the subject of the judgment in

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—  
No. 36.  
Defendant,  
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10 this action dated the 15th day of June 1953, so far only as they are  
the subject of such judgment and allege a good defence in law to  
the Plaintiff's claim herein, are not established and that accordingly  
paragraph 5 of the Defendant's defence herein to that extent fails  
and ordered that the Defendant pay the taxed costs of the Plaintiff  
and of the Commissioner of and incidental to the setting down and  
argument of the question of law stated in the Order of the 25th day  
of November 1952 and of and incidental to the trial of the issues of  
fact arising thereout, including (A) the costs reserved by the two  
orders of November 25th, 1952 and (B) the costs of the present  
hearing before the Judge from and including June 1st 1953 up to  
the date of this order but excluding (C) the costs dealt with by the  
order of March 17th 1952 BE SET ASIDE AND REVERSED  
OR VARIED SO FAR as it was thereby adjudged declared and  
ordered as aforesaid, and that in lieu thereof it be adjudged and  
declared that the allegations of the Defendant the subject of the  
judgment in this action dated the 15th day of June 1953 are  
established and that accordingly paragraph 5 of the Defendant's  
Defence herein succeeds, and ordered that the Plaintiff pay the  
20 taxed costs of the Defendant and of the Commissioner of and  
incidental to the setting down and argument of the question of law  
stated in the order of the 25th day of November 1952, and of and  
incidental to the trial of the issues of fact arising thereout, including  
(A) the costs reserved by the two orders of November 25th 1952,  
and (B) the costs of the hearing before His Honour Mr. Justice  
Sholl from and including June 1st 1953 up to the 22nd day of  
June 1953, but excluding (C) the costs dealt with by the order of  
March 17th 1953 AND the costs of this appeal OR FOR SUCH  
OTHER ORDER as to the High Court shall seem just.

30 AND FURTHER TAKE NOTICE that the grounds upon which the  
Appellant intends to rely in support of this appeal are as follows :—

A. AS TO THE JUDGMENT REFERRED TO IN (i) ABOVE

1. That the said judgment was wrong in law.

2. That the learned judge was wrong in holding that the allegations  
set out in paragraph 4 of the particulars of objections as amended and in  
paragraphs 1 and 2 of the further particulars of objections, so far as the  
same are allegations of fact, and paragraph 6 of the said particulars of  
objections, so far as it depends on the aforesaid allegations of fact, consti-  
tuted a good defence in law to the Plaintiff's claim to the following extent  
40 only, and not otherwise, viz., so far as they alleged that the effect of the  
amendments therein referred to or either of them was that the complete  
specification of the Letters Patent No. 133163 in its form final claimed an  
invention substantially different from the invention described and disclosed  
by the complete specification originally lodged with the application dated  
the 31st day of December 1943.

3. That the learned judge was wrong in holding that the allegations  
aforesaid constituted a good defence in law to the Plaintiff's claim to the

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extent only that they alleged that the allowance of the amendments aforesaid produced a patent for an invention not fairly disclosed in the original complete specification.

4. That the learned judge should have held that the said allegations and paragraph 6 as aforesaid constituted a good defence in law to the Plaintiff's claim in alleging that the effect of the amendments therein referred to or either of them was that the complete specification of the Letters Patent No. 133163 in its final form described and claimed an invention substantially different from the invention described and claimed by the complete specification originally lodged with the application dated 10 31st December 1943.

5. That the learned judge was wrong in holding that paragraph 5 of the said particulars of objections, so far as it depended exclusively upon the allegations of fact in or under paragraph 4 of the particulars of objections did not constitute a good defence to the Plaintiff's claim.

6. The learned judge should have held that the said paragraph 5 as aforesaid did constitute such a good defence.

B. AS TO THE JUDGMENT REFERRED TO IN (ii) ABOVE

1. That the said judgment was wrong in law and in fact.

2. That the said judgment was against the evidence and the weight 20 of the evidence.

3. That on evidence judgment should have been given for the Appellant.

4. That the learned judge was wrong in holding that the allegations of the Defendant the subject of his judgment of the 15th day of June 1953, so far only as they were the subject of such judgment and alleged a good defence in law to the Plaintiff's claim were not established and that accordingly paragraph 5 of the Defence to that extent failed.

5. That the learned judge should have held that the said allegations as aforesaid were established and that accordingly paragraph 5 of the 30 Defence to that extent succeeded.

6. That the learned judge was wrong in holding that an invention is described and disclosed if there is in the initial complete specification a description and a disclosure of what in fact is inventive even if at that stage the inventor does not or does not clearly say so—at all events if he does not clearly and expressly say the contrary.

7. That the learned judge was wrong in holding that an applicant can amend his complete specification so far as to claim thereby as an invention what he had not previously described as such.

8. That the learned judge was wrong in holding that the invention 40 claimed by the final complete specification of Letters Patent No. 133163 was the same as the invention described and disclosed in the original complete specification in respect thereof.

9. That the learned judge should have held that the said respective inventions were substantially different.

10. That the learned judge should have held that the invention claimed by the said final complete specification was not described and disclosed by the said original complete specification.

11. That the learned judge was wrong in holding that an applicant can by amendment of his complete specification claim as an invention any matter described and disclosed in his complete specification before amendment.

10 12. That the learned judge should have held that the invention described and claimed by the final complete specification was substantially different from the invention described and claimed in the original complete specification lodged with the application on the 31st day of December 1943 and that the patent was therefore invalid.

20 13. That in deciding whether or not the specification as finally amended described and disclosed or described and claimed an invention substantially different from that described and disclosed or described and claimed in the specification originally lodged the learned judge should have construed each specification as a whole to determine what invention it described and disclosed or described and claimed and then compared the two inventions so determined and the learned judge was in error in not doing so but in determining what was the invention claimed in the specification as finally amended and then deciding whether there was in the original specification anything that amounted to a description and disclosure of that invention.

14. That the learned Judge was wrong in rejecting as evidence the documents constituting Exhibit 2 (subject to objection) and the examiners reports referred to in the particulars of objection and the communications from the Patent Office to the applicant of the substance of such reports.

30 15. That the learned Judge should have admitted the said documents in evidence.

Dated the 19th day of October, 1953.

J. T. BROCK,  
Solicitor for the Appellant.

To :

Henry George Martin,  
the abovenamed Respondent

And :

40 To his solicitors,  
Messrs. Moule Hamilton & Derham,  
394 Collins Street, Melbourne.

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*In the  
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No. 36.  
Defendant,  
Notice of  
Appeal,  
19th  
October  
1953,  
*continued.*

*In the  
High Court  
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No. 37.  
Reasons for  
Judgment  
of Sir Owen  
Dixon, C.J.,  
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No. 37.

REASONS FOR JUDGMENT of Sir Owen Dixon, C.J.

Appeal No. 30 of 1953.

MARTIN

V.

SCRIBAL PROPRIETARY LIMITED

SCRIBAL PROPRIETARY LIMITED

V.

MARTIN.

The proceeding before us consists of two appeals and a cross appeal, 10  
all argued together. The appeals are by the Plaintiff from judgments of  
the Supreme Court of Victoria (Sholl J.) pronounced for the Defendant in  
two actions for infringement of patents. One action (No. 314 of 1947) was  
commenced on 9th May 1947. It was based on a patent granted to the  
Plaintiff as of 8th December 1943 which it was alleged the Defendant had  
infringed. The action failed because it was held that on the proper  
construction of the specification there was no infringement. The second  
action (No. 58 of 1951) was commenced on 24th April 1951. It was based  
on a patent granted to the Plaintiff as of 31st December 1943 which again  
the Defendant was alleged to have infringed. This action failed on the 20  
ground that the claims were void for ambiguity and in any case that they  
were so constructed or expressed that no infringement was committed.  
The cross appeal by the Defendant relates to action No. 58 of 1951. It is  
an appeal by leave from part of an interlocutory order determining certain  
questions of law before the trial of the action and from a further interlocutory  
order determining certain issues before such trial.

The subject of both patents is a ball pointed fountain pen employing  
viscous ink fed from the reservoir to the ball tip. Each patent is for an  
alleged invention for a pen of this type. Neither specification indicates 30  
the principles which, as is now ascertained, govern the operation of such a  
pen or precisely how they apply. Much of the attack on the two patents  
flows from this circumstance. It is therefore as well to begin with an  
abstract description of the working of an ordinary ball point pen. The  
ball which transfers the ink to the paper revolves in a collar. The inner  
revolving face is in contact with a column of viscous ink and carries the  
ink out as it rolls round so as to become the outer face of the ball. The  
reservoir which contains the column of viscous ink is a capillary tube or  
duct the diameter of which should not exceed 4 mm. The capillary tube  
is open to the air at the end furthest from the ball, or at all events at that 40  
end there is an air vent. At that end a concave meniscus is formed at the  
interface of the viscous fluid and the air. It is formed because of the  
surface tension of the liquid and its adhesion to the walls of the tube.  
The ball is very small. At the place where the viscous fluid is in contact  
with the ball the diameter of the vein is smaller and accordingly the  
meniscus of the surface of the viscous ink is of less radius. When the pen  
is turned down to write the ball suffices to overcome the effect of gravity.  
But when it is inverted the greater strength of the smaller meniscus, or

to state it more accurately, the decreased pressure at that surface and the atmospheric pressure operating over a greater surface at the other end, suffice to overcome gravity. The viscosity of the ink absorbs ordinary shocks which would break the meniscus of a more liquid ink. The result is to give a pen which will write until the vein of ink is exhausted and in which ordinary use will not interrupt or break the continuity of the vein. However if the pen is used to write vertically upwards or at a high angle the ball may lose contact with the ink and as the ball rotates draw in air causing a distortion of the meniscus and a consequent failure to sustain  
10 the weight of the column of ink. To restore the pen to its function it will be enough to point the pen downward again and write so as to rotate the ball. The ink will flow back to contact with the inner face of the ball and the pen will write again.

The first of the two patents put in suit (No. 122073) rests upon a specification which describes the invention it covers as relating to improvements in fountain pens of the ball tip type and particularly to means for providing a regular ink feed to the ball constituting the active or writing element of such instrument. The specification in fact discloses, in the drawings and the text explaining them, a construction which on the  
20 foregoing principles would result in a workable pen. But no one reading the specification can escape the impression that the inventor had missed the more essential points of the construction and was relying on certain features which he introduced unnecessarily as forming an integral part of his invention. One of these features is the taking of the tube forming the reservoir through an extended path between the air vent and the ball. He insists on a tube or conduit that is extremely small but describes its size by saying that it must be "of so small a cross section that a suitable ink cannot escape from the air intakes under the effects of gravity." To explain the drawings the specification says that the throat of the channel  
30 is relatively small for example of a section of less than 5 mm. It does not say that it must be of capillary size. The conduit is always described and depicted as in helical coils or in unclosed annular convolutions. Though these two forms are not given as essential, there is an insistence on the conduit following an extended path starting at the air intake and ending at the recess for the ball, and of course the two forms of construction shown do give it the required "extended path." Dense ink seems to be the only form of ink in contemplation but it is not definitely specified. A distinction is drawn at all events in some forms of construction between the conduit and a channel leading from the conduit to the ball. The specification says  
40 that, inasmuch as the conduit is of small section, when charged with ink it will contain an uninterrupted vein of liquid as if it constituted an extension of the channel. It proceeds to state that, due to this and other relatively adjusted arrangement of the ball in the setting for it whereby the tip of the instrument remains closed, the ink cannot be discharged by gravity. Notwithstanding this denial of the effects of gravity there follows a statement that, as the ink is used through the use of the instrument, the charge in the form of a vein of liquid will be displaced so as to occupy the space of the portion carried out by the ball. This is then explained on the ground that the vein of liquid remains uninterrupted and is displaced  
50 as a whole the rear terminal thereof being in contact with the atmosphere by means of the air intake and therefore the continuity thereof will subsist

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as the ink is used and there will be no risk of interruptions. It is not easy to suppose that the inventor thought that gravity had no part at all in this phenomenon. And yet he says later that, as the reservoir shown is formed by a coil of small section the instrument may be placed in any position and used in any manner without the vein of liquid being affected by gravity. It all reads as if the extension of the path of the tube by convolution or the like coupled with the exceedingly small diameter of the tube and the closure of the ball were relied upon to keep the vein of dense liquid within the pen when inverted and held with the ball upward.

The specification contains nothing amounting to a definition of the invention. Indeed where it might be expected that this would be done, there is found only a succession of objects which the invention achieves. Summarized they are, (1) to prevent even a dense ink leaking and to do so though the pen is held with the air intake down; (2) to overcome the difficulty that when a ball pen is held with the point up contact between the ball and the ink is lost; (3) to provide a reservoir in which the ink forms a continuous vein feeding the ball and its position is not altered by gravity; (4) to provide an ink reservoir at once strong and simple; (5) to provide detachable reservoirs so that the charge of ink may be replaced; (6) to provide a fountain pen without the need of auxiliary means to cause the ink to reach the ball. What no doubt purports to be a definition of the invention follows the statement of these objects. It begins with the traditional words "According to the present invention" and goes on—"an instrument of the ball tip type is provided in which the ink reservoir is formed by one or more conduits starting at an air intake, and after following an extended path, communicating with the recess for said ball, the said conduit or conduits being of so small a cross section that a suitable ink cannot escape from the air intakes under the effect of gravity." What is presented here as the essential features—those things which he has introduced into pens of the ball tip type—are the "extended path" and the small cross section of the tube. There is no definition or clear indication of what amounts to an extended path and the cross section is defined only in terms of a result and, at that, a result which actually the smallness of cross section cannot alone produce.

The first claim, upon which the other claims depend, makes these two features essential. It is in the following terms: "1. Improvements in writing instruments of the ball-tip type, wherein the ink reservoir of said instrument is formed by one or more conduits starting at an air intake and, after following an extended path, communicating with the recess for said ball, the said conduit or conduits being of so small a cross-section that a suitable ink cannot escape from the air intake under the effect of gravity."

Now the Defendant's pen which is said to infringe has a straight tube or conduit. A straight conduit has many advantages not the least being those in manufacturing. The greater the length of the tube or conduit the greater in fact is the weight of the contents and, when the pen is inverted, the greater is the balance of the force of gravity which the surface tension at the meniscus near the ball is called upon to equalize. Apart from admitting a greater charge of ink the "extended path" of the Plaintiff's tube or conduit does anything but contribute functionally to the invention. The inventor, however, clearly thought otherwise and therefore introduced



it as an element in his claim. He maintains nevertheless that his claim covers the Defendant's pen. He does so on the ground that the path may be extended though straight.

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I agree with Sholl, J., in thinking that this is not a tenable view of the meaning of the claim. It is of course true enough that there is nothing in the word "extended" simpliciter that is inappropriate to a straight tube. But a word seldom occurs simpliciter. Words are not used without a context and the difficulty is that the word "extended" is here applied to a path between two points. They are not points antecedently fixed, but they must both be placed somewhere in the barrel of a pen and what is specified is a tube following a path from one to the other that is "extended." Place them as far apart as may be, nevertheless the tube connecting them cannot truly be said to make the connection "after following an extended path" if it goes by the shortest distance. Every word of the description in the body of the specification, the drawings themselves, and every part of the explanation of the drawings is based upon the assumption that the course will be helical annular convoluted or will otherwise meander. It is difficult to see how, when the claim speaks of one or more conduits starting at an air intake and, after following an extended path communicating with the recess for the ball, it could be read as covering a straight tube. This view was adopted by Harman, J., in *Martin v. Selsdon Fountain Pen Company Ltd.*, 1949 66 R.P.C. 193. It is a view which of course results in a finding of no infringement and makes a consideration of the validity of patent No. 122073 unnecessary. On the ground that on the proper construction of the claims there was no infringement of this patent I think that the appeal from the judgment in action No. 314 of 1947 should be dismissed.

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The patent upon which the second action is based, No. 133163, was granted for an invention described and ascertained by a complete specification accepted on 14th June 1949, although the application was made on 31st December 1943. The latter of course is the date as of which the monopoly takes effect. The complete specification was in fact the result of many amendments made during the passage through the Patents Office. One defence which the Defendant has set up to the action upon this patent depends upon the history of the specification as it developed in the Office. But the defences upon which the Defendant succeeded in the Supreme Court arise upon the specification including the claims in the form the specification finally took. In the first instance, therefore, it is desirable to put aside the history of the development of the complete specification and to deal with the case upon the footing that the validity and effect of the patent and the issue of infringement depend upon the specification in the form in which it was accepted and made the subject of the grant of letters patent. It is a specification which, unlike No. 122073, does describe the features it embodies which in reality govern the working of the pen to which it relates. The invention is described by the specification as one relating to writing instruments of a type which it proceeds to define by reference to the following characteristics: (1) A ball is mounted for rotation in a housing with part of the ball exposed. (2) It is supplied with ink from a suitable reservoir. (3) The ball is rotated by its contact with the writing surface, carries a quantity of ink through the housing and deposits the ink on the surface of the paper. This general

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description is followed by something like a definition of the invention. It makes the three points that the tube is of capillary size, that it is to be charged with viscous ink, and that the capillary tube is to be vented, that is to say the column of ink is to be in contact with the air at its upper extremity. But making, as it does, these three points, the specification proceeds to introduce two more which reappear in the claims and they provide a foundation for the two defences upon which the Defendant has succeeded in the action. It is desirable to give the words in which these two features are described. After referring to the vented tube of capillary size the specification proceeds "in which when charged with viscous ink a continuous liquid vein is maintained extending from the ball and having a feed duct leading from the reservoir to the ball, the cross-sectional area of which duct, particularly that portion adjacent to the ball, being less than that of the reservoir." The two points lie in (1) the assertion that the pen maintains a continuous liquid vein extending from the ball, and (2) the reference to a feed duct and its characterization. As to the first the Defendant denies that in all conditions of use the pen does maintain a continuous liquid vein extending from the ball. With reference to this it is hardly necessary to say that, unless during the process of writing the column of viscous ink is held in contact with the ball and in this sense extends from it, the pen will not mark the paper. As to the second the Defendant contends that the description of the cross-sectional area of the duct is ambiguous and in respect of this feature does not disclose with sufficient precision what is the area of monopoly. As to the feature in question it is perhaps convenient before proceeding with the statement of the effect of the specification to recall that the meniscus at or in the vicinity of the ball point must be of less radius than the meniscus of the tube formed at its other end if the charge of ink is to be held by both menisci against gravity when the pen is inverted and the point is uppermost. 10 20

The specification goes on to define the expression "vented tube of capillary size." It means "a tube having an internal bore between 1 and 4 mm., subject to a manufacturing tolerance of the order of  $\pm$ ,  $-$ , 5%, so that when charged with a viscous ink the meniscus formed at the end of the ink column remote from the ball (at the interface between the ink, the air and the interior surface of the tube) is stable and will not break under shocks to which the instrument is subject in normal use." No point that is material arises on this definition although it may be said perhaps that it does not make it clear that it is the viscosity of the ink which prevents the shocks from breaking down the menisci. 30

The drawings which, according to the specification, embody the invention disclose various constructions in which a tube is either housed in or made part of the barrel of a fountain pen which has a ball tip housed as described. Close to the ball at distances varying in the different drawings there is a lessening of the diameter of the tube so as to make the duct of which the specification speaks. As has already been seen, for a pen to be effective in operation, the meniscus at the ball must be of less diameter than the meniscus at the other end of the column or vein of viscous ink, and this means a surface of less diameter than at the vented end of the tube or conduit. Physically the interpolation in the invention of a definite duct of less diameter than the tube is not necessary. At the same time it is one way of achieving an end which in any case the smallness of the ball 40 50

inevitably would accomplish. The drawings in fact show the tube or conduit and its duct as taking a course up and down the barrel of the pen and not as a single straight tube; but in no place is there anything to indicate that a lengthening of the conduit or tube by the parallel arrangement up and down the tube is part of the invention. It is therefore not material in this action that the Defendant's pen which the Plaintiff says is an infringement comprises a single straight tube or conduit to form the reservoir for the viscous ink. But the specification does emphasise, and at more than one point, that there must be a continuity of the liquid vein  
10 from the ball. For example the description of the drawings ends with the statement that in all the embodiments the duct is charged with a viscous ink so that a continuous liquid vein is formed communicating with the ball.

Of the claims it is unnecessary to consider more than the first. The remaining claims of which the Defendant's pen could possibly be considered an infringement are made to depend upon it. The first claim is as follows :  
" 1. An instrument of the type specified, having the ink reservoir constituted by a vented tube of capillary size in which when charged with viscous ink a continuous liquid vein is maintained extending from the ball, and having a feed duct leading from the reservoir to the ball, the cross sectional  
20 area of which duct, particularly that portion adjacent the ball, being less than that of the reservoir." This claim has been held void by Sholl, J., on the ground that it is ambiguous. His Honour considered that the words describing the cross-sectional area of the duct, especially the words " particularly that portion adjacent to the ball," gave no sufficiently precise or certain undersanding of the element of the claim manifested in or represented by the duct. The considerations regarded as causing the ambiguity may be briefly summarized as follows. The claim does not indicate how the duct is differentiated from the tube or conduit, except that the portion adjacent to the ball must be of less diameter. It does not  
30 indicate how much of the duct must be of less diameter. It does not indicate whether the rest of the duct may be of the same diameter as the conduit or may be of greater diameter than the conduit or may be of less diameter than the conduit, although of greater diameter than the portion of the duct adjacent to the ball.

These doubts or difficulties as to the intention of the patentee are said to make his claim ambiguous. If we were concerned only with a written instrument operating *inter partes* and not generally these difficulties would easily be overcome by construction. But the principles governing the definition of a monopoly operating over the public at large require a  
40 description which is not reasonably capable of misunderstanding. If an ambiguity is purposely introduced in order to produce a vagueness in the boundaries of a monopoly this purposeful introduction of an ambiguity destroys the patent, whether the ambiguity be great or small. Here there is no reason to suppose that there was any such design. The following passage, however, in the judgment of Lord Parker (*Natural Colour Kinematograph Co. Ltd. v. Bioschemes Ltd.*, 1915 32 R.P.C. 256, at p. 269) describes what is the duty of the Court and provides the test of ambiguity :—

" Further, though it may be true that in construing an instrument  
50 *inter partes* the Court is bound to make up its mind as to the true meaning, this is far from being the case with a Specification. It is

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open to the Court to conclude that the terms of a Specification are so ambiguous that its proper construction must always remain a matter of doubt, and in such a case, even if the Specification had been prepared in perfect good faith, the duty of the Court would be to declare the Patent void. Once again, though the Court may consider that the meaning of the Specification is reasonably clear, yet if the Specification contain statements calculated to mislead the persons to whom it is addressed, and render it difficult for them without trial and experiment to comprehend in what manner the patentee intends his invention to be performed, these statements may avoid the Patent. The above principles may be thought to bear somewhat hardly on patentees and their agents. A person may arrive at a valuable invention without adequately comprehending the particular point in which the invention is new or valuable, and a patent agent may be insufficiently instructed by his principal, and, however carefully he may consider the terms of the Specification he is employed to draw, he may quite easily fail to anticipate the points which may be raised, if and when the validity of the Patent comes in issue." 10

Notwithstanding the strictness and rigour with which these principles 20  
have repeatedly been applied, I find myself unable to concur with Sholl J. in the conclusion that they destroy the patentee's first claim for ambiguity. To begin with I do not think on a fair reading of the specification as a whole a man at all familiar with the subject of ball point fountain pens could suppose that any part of the duct might consistently with the claim be of greater diameter than the main conduit forming the reservoir. The whole invention is clearly described as requiring a tube of a capillary size with a reduction towards the ball. The complaint that there is no precise way of differentiating between the conduit forming the main reservoir and the duct appears to me to overlook the fact that 30  
the duct is only the terminal of the reservoir and strictness of definition is incompatible alike with its purpose and character. The specification conveys two ideas with respect to the duct, and they appear to me to suffice. One is that as the reservoir approaches the ball, it gives place to a different formation of tube, designated the duct. The other is that the formation must include a lessened diameter at and near the ball, though the lessened diameter may begin earlier. Each of these ideas involves a matter of degree and for that reason any distinction that is precise must be but an arbitrary restriction on the inherent variability of the feature which the specification describes as the duct. The difference in formation 40  
may lie simply in the lessening of the diameter or it may lie in the commencement of a new member of the construction. The drawings make it clear that in some embodiments there is a physical distinction in the members forming the tube or conduit and the duct. Doubtless a manufacturing advantage may be obtained by having a detachable portion which embraces the ball and the duct. But this advantage is no part of the claim. In the operation of the pen the length of the duct is not material. It is a matter which would be determined by convenience in manufacture. The words "particularly that portion adjacent to the ball" appear to me to express 50  
sufficiently an intention to emphasise the necessity of the reduction of the diameter in proximity to the ball. In limiting the monopoly the claim

seems fairly clearly to say that at the portion of the tube or conduit and duct which hold the column of ink there must be a reduced diameter in that part of the combined conduit and duct which feeds the ink to the ball. If this reduction of diameter occurs in a pen not manufactured in the exercise of the patent and if otherwise the pen exhibits the features enumerated in the first claim, it is difficult to see why it should not be an infringement. If the feature is absent the pen would not be an infringement except upon some doctrine of equivalence. The indefiniteness is more apparent than real. I am unable to agree that it is sufficient to

10 invalidate the claim for ambiguity.

The Defendant, however, denies that the claim has been or indeed could be, infringed, a defence which depends on the manner in which the claim is constructed and expressed. Sholl J. adopted this view which forms the second ground for his decision in favour of the Defendant in the second action, that putting in suit the patent No. 133163. The question depends upon the words in the claim which say that in the tube "when charged with viscous ink a continuous liquid vein is maintained extending from the ball." As was explained early in this judgment, the physical principles upon which ball point pens of the type under consideration

20 depend for their operation will not keep the column of ink in contact with the ball if the pen is used to write vertically upward or at a high angle. The Defendant's pen which is alleged to infringe the claim is no exception. If the pen is so used contact between the ink and the ball is lost, the rotation of the clean ball draws in air and a distortion of the meniscus ensues and the weight of the column of ink is not sustained. It appears that by chance it may happen that this may not occur. The column of ink may be very short and by some accident of manufacture there may be a very small gap between the housing and the ball. The slightness of the weight of the column of ink combined with the minute

30 gap may result in the ink being sustained while the pen writes at a high angle or vertically upwards. No one could ensure that these conditions were produced. Normally to invert the pen or hold it at a high angle and so to write must lead to the distortion of the meniscus round the ball with the result that the meniscus will be formed at a sufficient interval from the ball to deprive it of contact. Generally it may be said that this will take place if the writer holds the pen upwards at an angle of more than 35° with the horizontal and in that position writes with it on a more or less vertical surface for a short time. Because, in common with the Plaintiff's pen, the Defendant's pen possessed this characteristic it was held not to

40 fall within the claim. For its tube was not one "in which when charged with a viscous ink a continuous liquid vein is maintained extending from the ball" according to the true meaning and operation of those words. Consequently the pen produced by the Defendant was no infringement. If the words quoted do cover the maintenance of a vein of ink extending from the ball although the writer holds the pen at an angle of more than 35° with the horizontal point upward and writes in that position, it might perhaps be thought that the true defence is that the words amount to a false promise or representation on the part of the patentee invalidating the grant. The Defendant, however, took the position that it was enough

50 that if a claim made a particular result or operation of the invention an essential characteristic and that characteristic was not exhibited by the

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alleged infringement, it could be no infringement and it did not matter that the claim to the result or operation amounted to a false promise or representation. Perhaps this is logical, but it still remains necessary to ascertain what it is that the claim makes essential. Clearly enough the unqualified words do not mean that in all conditions which the pen may encounter a continuous vein will be maintained extending from the ball. It is not, for example, referring to ill usage. What the specification and the claim are talking about is the way the pen writes. Sholl J. put out of account writing upwards on an inverted horizontal surface. But His Honour took the view that the normal use of a pen includes writing with the point of the pen substantially above the other end. He said :— 10

“ Almost everyone, I suppose, has seen on the vertical notice-boards of social or other clubs, or of sporting bodies, documents on which persons are invited or expected to write names or other particulars, and on which it is usual or preferable to write in ink— e.g., entries for tournaments, results of matches, subscriptions for donations, and the like. Many persons have seen in the headquarters or other establishments of the armed forces, or in the laboratories or control rooms of many kinds of technical establishments, charts, lists, maps, or other documents on vertical walls or boards, on which it is the practice manually to write in ink entries from time to time of all kinds of particulars. Tradesmen and carriers are frequently seen to write in such a position against a wall.” 20

Perhaps it does not matter, but it is unlikely that the pen would cease to write before the purposes were accomplished that His Honour mentions. The process of severing the connexion of the column of ink from the ball when the pen is used in such a position is by no means instantaneous. A number of words may be written before the pen fails. It is only necessary then to point the pen downwards and make a few strokes so as to revolve the ball and the pen will write again as before. In all this it behaves much as would an ordinary fountain pen having a nib and employing aqueous ink, if it were used to write on a paper against a wall. If the usages of those who employ fountain pens give the standard which governs the statement in the specification it can hardly be said to be anybody's usage to write extensively either on a vertical surface or an inverted horizontal surface. But in the end the question is really one of the scope and meaning of the material part of the claim. Is it speaking of exceptional uses occasionally made of some writing instruments? For it is exceptional to write against a vertical or almost vertical surface. Would the words be naturally understood as going beyond the ordinary commonplace way of writing? It is a general unqualified statement but it is evident that what logicians call a “ universe of discourse ” is presupposed. It is to be read *secundum subjectam materiam*. I think that it would be read simply as describing what occurs in the pen when it is used in an ordinary way. The claim and the specification should be construed as it would be ordinarily understood. So construed I do not think that it should be taken to intend to state that even when the pen is used to write on vertical or highly inclined surfaces the contact with the ball will be maintained any more than it should be construed as intending to cover cases of violence, accident or other ill usage. I think this defence fails. 30 40 50

The plea of the Defendant that Patent No. 133163 is invalid was supported by particulars of objection containing certain grounds, really three in number, which now call for consideration. Briefly they are these. (1) That the complete specification in respect of which the patent was granted was the outcome of purported amendments of the complete specification lodged with the application which although made as under sec. 45 were not authorized by that or any other provision, with the consequence that the grant is void. (2) That at the date of the application the Plaintiff was not in possession of the invention the subject matter of the letters patent and therefore the patent was void for false suggestion. (3) That at that date such invention had not been made and therefore neither the inventor nor his assignor was the actual inventor thereof.

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The circumstances which the Defendant set up in order to establish these objections may be reduced to a compendious statement. Substantially what the Defendant alleged was this. The Plaintiff filed with his application on 31st December 1943 a complete specification which did not disclose or claim the invention that has already been discussed as that embodied in the specification in respect of which the patent was granted but related to a supposed invention depending upon the manner in which the tube or duct was constructed or arranged within the barrel of the pen. After some delays the examiner reported adversely to the specification and the Plaintiff took advantage of his doing so to substitute, as a purported amendment under sec. 45, another specification which in fact represented the complete specification for the United Kingdom patent No. 573747. It is the second of the two patents with which Harman J. dealt in *Martin v. The Selsdon Fountain Pen Co., Ltd.*, 1949 66 R.P.C. 193, and the material parts of it are set out in the report at pp. 199-202. This purported amendment was tendered on 18th December 1946 and the United Kingdom specification had been published in Australia in the previous September. The examiner made another adverse report on the new or "amended" specification, leading to the tendering of amendments therein, and the final result is the complete specification already discussed in this judgment, which the Defendant says is for a quite different invention from that to which the specification first filed related. The Plaintiff denies that the difference is so great and finds in the specification as originally filed indications of the invention as finally ascertained and claimed which the Plaintiff says are sufficient for any limitation that may be implied in sec. 45. It is hardly necessary to say that the Defendant, in the circumstances it alleges, puts forward additional aspects of what I have summarily stated under the foregoing first heading. But these aspects are rather *alia enormia* than independent legal reasons for avoiding the patent. For the reason invalidating the patent must be that the grant was made in respect of a purported specification which lacked legal authority because it was not warranted by sec. 45 or any other provision. However the Defendant says (A) that the invention the subject of the grant was not new when it was first placed before the Crown on 18th December 1946 because it had already been made public by the availability of the United Kingdom specification; (B) that pursuant to sec. 38A, which came into force on 11th September 1946, the specification as first filed, viz., on 31st December 1943, was made open for public inspection on 19th February 1948 and thereby published and that under sec. 54 as amended in 1946 the patentee gets protection retrospectively as from publication of a complete specification

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or a grant : as Sholl J. has held, it is in this case protection not for the invention then published but for that ascertained and claimed in the final specification in respect of which the patent was granted ; (c) that from September 1946 and onwards the Defendant was manufacturing ball point pens with a straight capillary tube or reservoir for viscous ink and in doing so infringed no exclusive right of the Plaintiff unless and until the Plaintiff secured protection as from 19th February 1948 for the invention the subject of the purported amendments tendered to the Patents Office on 18th December 1946 ; (d) that the purported amendment of 18th December 1946 was not really to meet or respond to the examiner's report as sec. 45 10 supposedly contemplates.

Sholl J., after a close and extensive examination of the provisions of the Act, reached the conclusion that it is a condition precedent to the validity of a grant that an amended complete specification in its final form shall at least not claim an invention not disclosed in the complete specification in its original form except in the case of an amendment under Division 4 and if purported amendments under Division 1 result in the invention ultimately claimed and embodied in the grant being substantially different from that described and disclosed in the initial complete specification the grant will be void. 20

The first answer made by the Plaintiff Appellant to this view is that the amendment was allowed by the Commissioner of Patents upon a written request by the applicant. It is therefore within the terms of sec. 71, and must be taken to have been made under Division 4, with the result that sec. 79 applies, making the leave to amend conclusive and the propriety of the amendment unexaminable. Of this contention it is enough to say that it does not appear to be satisfactorily made out that the amendment was sought or made under Division 4.

A suggestion was thrown out but not pursued that perhaps sec. 79 making leave to amend conclusive might directly apply to amendments under sec. 45. But that would be a strained interpretation, though no doubt sec. 71 may be taken into account as exhibiting the general policy of the legislature. 30

Sec. 45 gives an applicant a power of amending his complete specification after he has been informed that the examiner has reported adversely to the specification. The report may be under sec. 39 and if so it will deal with the questions whether the title has been stated as prescribed, whether the invention has been described as prescribed and whether the application and specification are as prescribed. If the complete specification has been preceded by a provisional specification the report may be under sec. 40 and deal with the question whether the invention fully described in the complete specification is substantially the same as the invention the nature of which is described in the provisional specification. Lastly the report may be under sec. 41 which requires the examiner to ascertain and report whether to the best of his knowledge the invention is already patented in the Commonwealth or in any State (that is before the grant of patents passed to the Commonwealth) or is already the subject of prior application for a patent in the Commonwealth or the State. Sec. 41 also requires the examiner to report whether to the best of his knowledge the invention is or is not novel. If the report is 40 50



under sec. 39 or sec. 40 the Commissioner may under sec. 42 give directions for amendment, but, even if he does not, the applicant may himself elect to amend under sec. 45. The purpose of sec. 45 is to enable the applicant to make what changes he thinks proper in his specification in view of the examiner's report. To say that its purpose is to enable him to obviate the examiner's objections is probably too narrow a statement. For the examiner's report about prior grants and applications may conceivably open up all sorts of difficulties or dangers which go beyond and outside his specific objections. Perhaps it is better to say that the purpose of

10 sec. 45 is to enable the applicant to make such changes in his complete specification by amendment as appear to him to arise out of the examiner's report.

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Sec. 49 (1) of the Patents Act 1952 introduces the words "so as to remove the grounds of objection," but these words do not occur in sec. 45 of the Act of 1903-1950 and in any case the new Act does not give rise to the same difficulties. There is no express limitation on the power to amend conferred by sec. 45 and since it forms part of the statutory regulation of what shall be done in the Patents Office and, as the Act stood before the amendments made by Act No. 38 of 1946, done in that

20 Office before the specification was accepted or published and so before the applicant obtained any protection, it is not an unreasonable inference that the extent and propriety of the amendments was left as a matter with which the office would be competent to deal. If the amendments tendered by the applicant would if made lay the specification open to any lawful objection under the Act, the specification would not be accepted. The making of an amendment sets going again the machinery of sec. 41. For sec. 45 ends with a direction that the amended specification shall again be reported upon by the examiner under sec. 41. In a general way it

30 amendment of a specification would be made thereunder which would substitute another invention for that disclosed by the original document accompanying the application. At the same time it must not be overlooked that if an examiner objected under sec. 41 that the invention was already patented, the objection if well founded could only be overcome under sec. 45 by amendments changing one or more essential elements of the invention. However, to say that the draftsman would not expect such an amendment is one thing and to imply a positive restriction resulting in the invalidity of the grant on that ground is another. Sec. 46 makes it necessary before the Commissioner accepts an application and specification

40 that he should be satisfied that no objection exists to it on the ground that the invention is already patented or is already the subject of a prior application and there must be no other lawful ground of objection. It would be a lawful ground of objection if the specification as amended did not conform with the provisions of the Act and it would be a lawful objection if a ground existed upon which a grant if made would be revoked or invalidated. That the applicant was not at the time of his application in possession of the invention would be such a ground. It may be said that conceivably he might be in possession of an invention at the time of his application which the original specification accompanying the

50 application did not disclose but which was afterwards disclosed by amendment under sec. 45. As the Act stood before 1946 the consequences

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would not be so dreadful. For the protection under sec. 54 would begin as from publication of the acceptance and the amendments cannot alter the construction of sec. 45 and sec. 46. It is after all only a logical possibility and the antecedent likelihood of its occurrence is small and it might well escape notice. It is to be noticed that the impropriety of an amendment is not a matter that could be raised in opposition to a grant under Division 2.

There is in my opinion no sufficient justification for introducing into sec. 45 an implication restricting the scope of amendments that can be made thereunder so as to make an amendment in excess of the restriction 10 a nullity and to invalidate a grant made thereon, independently of any other consideration. It is a matter of procedure in the office and as such does not go to the validity of the grant. Once there has been an acceptance followed by a grant the course of amendment ceases to be of any importance, unless and except in so far as it may supply evidence of one of the known grounds for revoking or invalidating a patent.

Sec. 46 speaks of the satisfaction of the Commissioner and submits the matter to his judgment. Sir Garfield Barwick for the Plaintiff said that the fifth particular of objection, which alleges that at the time of the application the Plaintiff was not in possession of the invention the 20 subject of the grant is the real defence in the case, if there were any defence. In this I agree. It is therefore necessary to turn to that defence. It is, of course, a recognized ground for avoiding a patent, although one that can rarely arise.

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. 30 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 that the applicant is in possession of the invention. In the present case the Plaintiff, who applies 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 40 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 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, 50

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 application.

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For proof of the issue raised by the plea contained in the fifth particular of objection, namely the issue whether the Plaintiff was on 31st December 1943 in possession of the invention the subject matter of the letters patent ultimately granted, the Plaintiff relied upon the contents of the specification that accompanied the application. The Defendant maintained that from these contents the inference arose that the Plaintiff was not at that date  
10 in possession of the invention actually patented because it clearly appeared that the inventor had then directed his attention to another object, and was not aware of the thing which he had in the end succeeded in patenting. Possibly the inference might be aided by a consideration of the specification in Patent No. 122073 lodged on 8th December 1943, that is twenty-three days before the application in No. 133163. There were also the examiner's reports and the amendments tendered to the office. These could only advance the matter as explaining the steps by which the final specification developed and thus perhaps showing the true source of the conceptions embodied therein. But no other evidence was adduced by the Defendant  
20 in proof of the issue.

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It is therefore necessary to ascertain from the document which accompanied the application what invention at that time the Plaintiff conceived he possessed and presented to the Crown as fit subject for a patent. To understand the document it is perhaps necessary to know how far the development of ball point pens had gone at that time. In the evidence given with reference to the ultimate specification for Patent No. 133163 we are told that five features contribute to maintain the liquid vein in the ball point pen as there described and we are informed which  
30 then were old. There is the ball and its housing, which were old. There is the feed duct narrower than the reservoir and that was old. So too was the reduction of the cross section of the feed duct itself from its cross section where it entered the reservoir. Then there is the venting of the tube, the providing it with an air intake; that too was old. The element, the fifth in number, described as the significant element in the invention ultimately claimed and made the subject of that patent is the capillary tube. The use of dense or viscous ink was of course old. Much of this appears inferentially from the complete specification No. 122073 where,  
40 it will be recalled, the convolutions, helical formations or other extensions of the path of a tube of small cross section were relied upon to achieve the objects, one of which was to prevent leakage even when the pen is held with the air intake downwards.

The original specification of No. 133163 refers, at the outset, to fountain pens more particularly to pens of the kind comprising an ink reservoir formed by an extension of the channel for supplying ink to the writing point, and says that the extension by a duct of small section allows of the establishing of a fluid vein of constant position, but that several difficulties are encountered owing to the necessity of arranging the duct in a winding or meandering form or otherwise arranging the same in such a way that it will occupy, to the largest possible extent, the capacity of  
50 the holder of the instrument. It will be seen that the tube reservoir

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and the small duct to the writing point are assumed, but the problem is stated to be in arranging the necessarily winding tube in the holder or barrel. In this conception of the problem it resembles No. 122073. The document then claims that in accordance with the invention these difficulties are overcome. It proceeds to describe how for the purpose a series or group of duct sections are arranged to form a feed channel fitted into the body of the holder. Ways of doing this are described and are illustrated by the drawings. At one point the words "capillary tube" are used, but not to state an element in what the applicant has invented : 10

"The duct consisting of a plurality of sections for forming the reservoir may be constructed in several manners, as use may be made indifferently of a capillary tube folded into several lengths until forming a series or whole, or a group of channels or ducts may be bored in a block which may then be connected to, or form an integral part of the fountain pen, provided the several sections of the duct be connected in series, so that one will be a continuation of another." But additional object after object is enumerated, e.g., the length of the reservoir and the minimising of the bends therein ; the simplification of the construction of the reservoir ; the possibility of boring the holder to form the reservoir ; the use of the very material composing the holder to form the reservoir ; the prevention 20 of gravitation influencing the reversed position of the pen by placing the air intake to the writing point of the pen. In the statement of these various objects the words "stylographic ball or point" occur, and later it is expressly said that instead of a sphere the stylographic point may comprise a pen or other common or known writing means. This makes it even clearer that it is in the formation of the tube reservoir that the alleged invention lies : for a ball point is an essential part of any pen in which a meniscus is to be maintained. At one place the reservoir is described as formed by a duct forming an extension of the feed channel but comprising several particular features which constitute the basis of 30 the invention. These particular features are never precisely enumerated but it is clear enough that they relate to the folding convolution connexion and construction within the barrel or holder. One figure in the drawings is described as having a reservoir formed by a duct or tube of the capillary type, but this is treated as accidental or incidental and the passage proceeds to deal with the folding of the tube and the communication of the parallel sections thereof one with another. The specification then mentions the use of dense ink to fill the reservoir which it says thus establishes a fluid vein extending from a point near the air inlet or air intake to the sphere which is thus maintained in contact with the ink in order that when 40 causing the same to roll over the suitable surface the sphere held by the mounting will mark the strokes with ink supplied from the channel containing the liquid vein. This may sound as if the applicant was drawing close to the invention embodied in the ultimate specification. But in truth it is only a statement of what will happen in consequence, as he supposes, of his arrangements of the tube in the holder which forms the invention. He has no conception of the essentiality of the capillary dimension of the tube, of the ball and of the lessened diameter of the duct at the orifice to the ball, and so on. It is all in the arrangement of the tube and the construction within the holder, as applied to old elements variously 50 assembled. This is again seen in the embodiment in which the air intake is directed towards the point but at a certain distance short of the point ;

“ this arrangement ” he says “ has for its object the prevention of the ink when the pen is in reversed position from being discharged by gravitation.” This of course it would not entirely do, if the reservoir were full. It is unnecessary to go through the claims of which there are eleven. It is enough to say that they take in turn various combinations which the body of the specification indicates. All of them make a particular construction folding or grouping of the tube and its sections a feature and one only makes a ball point essential. It is the tenth. It adds to a series or group of duct sections connected together the feature that the  
 10 stylographic point, to which the single channel thus formed extends, is “ characterised by the fact that the channel or duct which forms the reservoir ends with a mounting provided with a small loose sphere which constitutes the writing point.” It is obviously added as an additional feature to form a combination. But in that combination all the other elements essential to the invention ultimately specified are left out and the elements included are irrelevant to function and misconceived.

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The conclusion which I think flows from the foregoing is that the initial specification was directed to a supposed invention depending upon the arrangement of the tube or tubes within a pen of a known type and  
 20 that though some of the essential elements of the invention ultimately patented are referred to, it is as features already known to be used, and not as elements to be brought together under a new conception. I think that the initial specification accompanying the application is for an invention exhibiting none of the essential elements of the invention ascertained and claimed by the specification in respect of which Patent No. 133163 was granted but directed to other objects or points in the construction of the pen. The fact that this is so appears to me to raise a *prima facie* inference that at the time of the application the Plaintiff was not in possession of the invention patented by No. 133163. But it  
 30 is evidentiary only and not necessarily conclusive of the issue. Suppose for example that the Plaintiff as assignee of the invention were able to produce an assignment from him made before 31st December 1943 which clearly described the invention embodied in the ultimate specification. That surely would rebut the inference that the invention had not been then in the Plaintiff's possession. However I should be prepared, in the absence of any countervailing evidence, to draw the inference if the matter stopped there. The sixth particular of objection depends upon the invention not having been made and that inference too I think is a proper one in the state of the evidence if no other consideration entered into the  
 40 question of what this Court should do. But the matter does not stop there and other considerations do enter into the question of what order this Court should make. They are considerations arising out of the course the case followed in the Supreme Court.

That course raises some procedural and evidentiary difficulties which may stand in the way of our pronouncing a judgment upon the issue raised by paragraphs 5 or 6 of the particulars of objection. Both these particulars are pleaded as completely independent grounds of invalidity. They are not expressed so as to be in any way dependent either on one another or on any of the facts stated in particulars 1 to 4. There can,  
 50 however, be little doubt that to establish the facts stated in these particulars the Defendant, from the beginning, intended to rely on the inference to

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be drawn from the initial specification filed on 31st December 1943, aided possibly by the specification filed on 8th December in support of what became Patent No. 122073. The gist of the objection relied upon under the fourth of the particulars of objection is contained in sub-paras. (iv) and (vi) of that particular. What is alleged in sub-para. (iv) is that the specification lodged on or about 18th December 1946 described and claimed as the invention something which was not the invention described and claimed in the complete specification previously lodged on 31st December 1943 but something substantially different therefrom. It goes on to allege that it was the same as the invention No. 122073. Sub-para. (vi) uses the same terms in relation to the further amendments and says that they described and claimed as the invention something which was not the invention described and claimed in the complete specification lodged on 31st December, 1943 but something substantially different therefrom. The sub-paragraph goes on to say too that it was the same as No. 122073. In point of law that again is a ground independent of particulars 5 and 6 involving distinct issues of fact and law even if it was the Defendant's intention to prove the issues of fact by the same evidence. 10

By an order made on 25th November 1952 a question of law was framed and set down for argument before the trial. It dealt not only with the fourth particular of objection but also in part with the fifth and sixth. The question begins by requiring that the truth be assumed of all the allegations set out in the fourth particular, and in certain further particulars thereunder, so far as the same are allegations of fact and having regard to the various documents referred to in the fourth particular and the further particulars or so much of them as are relevant. On that assumption the question propounded was whether (A) those allegations or any of them; or (B) paragraphs 5 and 6 of the particulars of objection so far as the last mentioned paragraphs depend exclusively upon the allegations set out in paragraph 4 of the particulars and in the further particulars so far as the said allegations are allegations of fact constitute a good defence in law to the particulars claimed. The difficulty about this order is that in a logical and in a legal point of view paragraphs 5 and 6 of the particulars of objection do not at all depend, and certainly do not exclusively depend, upon the allegations set out in paragraph 4 of the particulars. The only common ground between them is in the evidence which the Defendant intended to adduce in order to prove them. That evidence, one may be sure, would have been supported by any further evidence which the Defendant was able to obtain, and any such further evidence would not likely be common to the proof of the three particulars. However this might not have appeared at the time to matter, because on 17th March 1953 an order for directions was made which provided for the various events which might arise according to the answer given to the question of law propounded in the previous order. In one event, that of the question being answered that the matters referred to or any of them did constitute a good defence of law, the court, according to the order for directions was to proceed to determine whether the allegations of such matters were established to the satisfaction of the court or not so established. If, to put it shortly, the particular defence dealt with in this manner failed either in fact or in law, then, said the order for directions, "in either of such events this honourable Court will proceed to hear and 30 40 50

determine such issues and matters arising upon the pleadings as are required to be determined in order that the action be disposed of and judgment given herein." This should have covered all residual matters pleaded by way of defence not entirely covered by the order setting down a preliminary point of law and of fact for determination.

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- On 15th June 1953 a decision was given on the question of law. It was decided that paragraph 5 of the particulars of objection, so far as it depends exclusively upon the allegations of fact in paragraph 4, did not constitute a good defence, and it was so ordered. The reason for this
- 10 decision was that the fourth and fifth sub-paragraphs of the fourth particular stated that the invention was the same invention as No. 122073. Sholl, J. said, "That presumably amounts to an allegation admitted for the purpose of the present question that the Plaintiff was then in possession of the invention the subject of the earlier patent and if that is so the facts alleged and taken to be admitted are inconsistent with the contention that the Plaintiff was not on 31st December 1943 in possession of the invention for which No. 133163 was ultimately granted." As the question before him as propounded was whether paragraph 5, so far as it exclusively depended on the allegations in paragraph 4 of the particulars,
- 20 was good in law, the rejection was inevitable of particular 5 as bad so far as it depended exclusively upon those allegations. But, as I have already said, except for the evidence by which it was to be supported, it does not depend in point of law or logic on paragraph 4 of the objections at all. It therefore remained a plea to validity which should have been dealt with as a matter of fact in pursuance of the order for directions remitting for trial all other issues, if the particular defence raised for prior determination failed. As to paragraphs 4 and 6 of the particulars of objection, an order was made determining that the allegations made in paragraph 4, so far as allegations of fact, and paragraph 6 so far as it depended exclusively
- 30 upon such allegations of fact, constituted a good defence in law to the Plaintiff's claim to the following extent only and not otherwise, viz., so far as they alleged that the effect of the amendments therein referred to or either of them was that the complete specification in its final form claimed an invention (A) substantially different from the invention described and disclosed by the complete specification originally lodged with the application of 31st December 1943; or (and this is no longer material) (B) identical with the invention described and claimed respectively in the complete specification of Letters Patent No. 122073. It is no longer material because the allegation that it is so identical has been abandoned.
- 40 This decision departs in what might have been a material respect from the allegation. The allegation in the first place was that the specification of 18th December 1946 described and claimed (not disclosed) an invention which was not the invention described and claimed (not disclosed) in the specification lodged on 31st December 1943 but something substantially different therefrom, that is from the invention described and claimed by the last-mentioned specification.

- By an order of 22nd June 1953 it was adjudged and declared that the allegations of the Defendant the subject of the judgment dated 15th June 1953 so far as they are the subject of such judgment and alleged a good
- 50 defence in law to the Plaintiff's claim are not established and that accordingly the paragraph of the Defendant's defence denying validity to

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that extent failed. A trial of the action then took place and on 28th July 1953 judgment was entered for the Defendant. From that judgment the Plaintiff appealed to this Court by a notice of appeal dated 14th October 1953. The Plaintiff's notice of appeal did not seek to appeal from any of the prior orders but only from the judgment of 28th July 1953. Order 70, rule 26, of the Rules of this Court provides that an interlocutory order or rule in which there has been no appeal does not operate so as to bar or prejudice the Court in its appellate jurisdiction from giving such decision upon an appeal as is just. The orders of 25th November 1952 formulating the question of law and of 15th June 1953 answering it are interlocutory orders. In so far as they might otherwise stand in the way of the Plaintiff Appellant they cannot so operate because of rule 26. It seems to me that in so far as they might stand in the way of the Defendant Respondent they could not operate to prevent his success upon the appeal. 10

The Defendant Respondent, however, obtained special leave to appeal from the orders given on 15th and 22nd June 1953. The notice of appeal given in pursuance of that special leave included, among the parts of the order of 15th June 1953 appealed from, so much of the order as decided that the fifth of the particulars of objection, so far as it depends exclusively upon the said allegations of fact, does not constitute a good defence. The same notice of appeal also included an appeal from so much of the judgment of 22nd June 1953 as adjudged and declared that the allegations of the Defendant the subject of the judgment dated 15th June so far as they are the subject of such judgment and allege a good defence in law to the Plaintiff's claim are not established and that accordingly paragraph 5 of the Defendant's defence herein to that extent fails. Paragraph 5 of the defence is that pleading invalidity and it is under that paragraph that the particulars of objection were delivered. It may be doubted whether, in view of Order 70, rule 26, this appeal or, if two appeals are included in the notice, either of them was necessary. It is a substantive appeal, not a cross appeal pursuant to Order 70, rule 13, although it is convenient to speak of it as a cross appeal to distinguish it from the Plaintiff's appeal. 20 30

As an independent issue the allegation made by the fifth particular of objection that the invention was not in the possession of the Plaintiff at the time of the application does not appear to have been separately investigated. On the argument of this appeal the Plaintiff Appellant by his counsel took up the position that that was the true issue on which the Defendant should have relied and that his contention that the amendments fell outside sec. 45 of the Patents Act was ill founded.

On the hearing of the appeals before this Court the argument took a strange turn. In supporting the Defendant's "cross appeal" against the orders of 15th June 1953 and 26th June 1953 counsel for the Defendant, in the course of explaining what Sholl J. had done, remarked that His Honour had decided that particulars 5 and 6 were not good defences and that he, counsel, was not attacking that part of the judgment. On being questioned as to whether the issue propounded by the order under particular 4 was the same as the issue tendered by particular 4, having regard to the substitution in the order of the words "described and disclosed" for "described and claimed" in the particular, counsel said that if what Sholl J. found was really something more limited than the 40 50



defence pleaded he was entitled to assert before this Court that the defence as pleaded was the correct defence. So far as the order of 15th June 1953 limited the legal area of his defence he complained of it under his notice of "cross appeal." In dealing with the power of amendment, however, he observed that the whole system of patent law depends on this, namely that the person should have his invention at the time that he makes his application. In the course of his argument for the Plaintiff as Respondent to the "cross appeal" by the Defendant from the orders of 15th June and 26th June 1953, counsel for the Plaintiff was asked by Taylor J.

10 whether paragraphs 5 and 6 were not independent objections, to which counsel answered in the affirmative and added that he would say that they were the real defences. He acquiesced in the view that Sholl J. must really have meant that the objection alleged in particular 5 was not made out of the facts specified elsewhere and added that there were no other facts. Particular 5, he submitted, was the real defence in the case if there were any defence. At one stage the Defendant's counsel made an interjection to the effect that he had no further facts to support particulars 5 and 6 than appeared under paragraph 4. In response to a question from me to learned counsel for the Plaintiff as to the course he took about

20 particulars 5 and 6 he said that he understood that particular 5 was out of the case. I remarked that the difficulty was that much of his argument had driven the case back on to particular 5 and that a question for our consideration was whether the Defendant could go back to particulars 5 and 6. Counsel for the Plaintiff urged in addition that the fact, if it were a fact, that the Plaintiff had not set the invention out in the initial specification of 31st December 1943 did not show that he did not possess the invention for which the letters patent were granted at the date of the application and that some extrinsic evidence would be necessary beyond the matters set out under the fourth particular in order to establish the

30 fifth particular. The amendments were irrelevant. In his reply the Defendant's counsel put the view first that if sec. 45 was limited in the manner for which he contended, that was enough; but if sec. 45 was not so limited then he turned to the defence raised by particulars 5 and 6 and said that on the facts it appeared that the applicant was not in possession of the invention described in the specification in its final form at the date when he made his application, namely 31st December 1943, and that it was common ground that it was a good defence if made out on the facts.

The foregoing account of the proceedings in the Supreme Court and here suggests that not a little confusion arose almost from the outset as

40 to the place the issues raised by the fifth and the sixth particulars took. Having regard to what has occurred it is not altogether easy to say what is the right course for this Court now to take. Left without other evidence I think that it might be difficult to resist the *prima facie* inference of fact which arises from the manner in which the initial specification is compiled, considered, as it should be, with the specification filed twenty-three days earlier in No. 122073. It is enough to justify the conclusion that at the time of the application of 31st December 1943 the Plaintiff was not in possession of the invention described and claimed in the specification No. 133163. But it is but a *prima facie* inference and the ultimate fact

50 is that the applicant had not possession of the invention in its final form. Owing to the peculiar course which the action took this issue seems never

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squarely to have been faced and determined, and yet it is the issue on which the Defendant's case in the end depends. At one stage of this appeal as an independent defence it was for the moment disavowed for the Defendant but for the Plaintiff it was insisted that it was the only true defence in law if the facts would support it. On the whole the course which justice seems to demand is that the issues raised by the fifth and sixth particulars be sent down for trial, unless the Plaintiff does not desire that course. It would not be satisfactory to determine the issue on the present material if the Plaintiff is in a position to offer any material evidence. A proper order to make in the appeal relating to action No. 58 of 1951 would be that if within two months the Plaintiff notifies the Defendant and the Principal Registrar that he desires these issues to be tried there be a further trial of the action limited to those issues, and that otherwise the Plaintiff's appeal be dismissed. In any case it seems unsatisfactory to leave the two orders of 15th June 1953 and 26th June 1953 standing. They should be discharged. The order in the appeal relating to action No. 314 of 1947 should be, appeal dismissed. 10

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These are appeals from judgments of the Supreme Court of Victoria (Sholl J.) in two actions, No. 314 of 1947 and No. 58 of 1951, which were heard together. In each case the Plaintiff claimed relief in respect of alleged infringements of letters patent, and in each case Sholl J. gave judgment for the Defendant. In the second case there is also a cross-appeal by the Defendant against two interlocutory orders made by Sholl J. in the action. The patent put in suit in the first case is No. 122073, and has been conveniently referred to as "No. 122." The patent put in suit in the second case is No. 133163, and has been conveniently referred to as "No. 133." In each case Sholl J. held that there had been no infringement. In the second action he also held that the patent (No. 133) was void for ambiguity in the complete specification. Each patent was granted in respect of improvements in writing instruments of the "ball-point" or "ball-tip" type, which have become well known and widely used in recent years. 30 40

In *Martin v. Selsdon Fountain Pen Coy. Ltd.* (1949) 66 R.P.C. 193, the same plaintiff sued in respect of alleged infringement of two English patents, which were shortly referred to respectively as Nos. 571 and 573. The pen which was said to be an infringement was in all material respects the same as the pen which was alleged to infringe in the two Victorian actions. The specification of No. 571 was identical with that of Australian patent No. 122, but the specification of No. 573 (though it figures indirectly in the second Victorian action) differed widely from that of Australian patent No. 133. The action in England was heard by Harman J., who held (1) that No. 571 was valid, but had not been infringed, and (2) that No. 573 was valid, and had been infringed.

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In holding that Australian patent No. 122 had not been infringed Sholl J. agreed with the reasoning of Harman J. in the English case. It is true that there was one factor which assisted Harman J. to his conclusion and which perhaps could not legitimately be used in the Victorian case, but it is clear to my mind that Harman J. would have reached the same conclusion in the absence of that factor. In the English case, as in the Victorian case, the question of infringement turned entirely on the construction of claim 1 of the specification.

20 So far as Australian patent No. 122 (English No. 571) is concerned, I find it sufficient to say that I am in agreement with the reasoning of Harman J. and Sholl J., and that, in my opinion, the appeal in action No. 314 of 1947 should be dismissed with costs.

The appeal in the other action, however, which is concerned with patent No. 133, raises questions of considerable difficulty, which require an examination of the relevant "art" and involve some consideration of the specification of No. 122 as well as those of English No. 573 and of No. 133 itself. It will also be necessary to consider the chequered passage through the Patents Office of the application for No. 133 from its lodgment in  
30 December 1943 to the sealing of the patent some time after June 1949. Because of the differences between the specifications of No. 573 and No. 133 the judgment of Harman J. in the English action is of no direct relevance, but on certain matters it is of assistance, and it will be convenient to quote a number of passages from it.

The essence of a ball-point pen is that the actual writing element consists of a ball of very small size which protrudes a minute distance from a spherical housing, within which it is rotatable. The ink used is of a "viscous" type, as distinct from the "aqueous" type used with an ordinary pen. The act of writing causes the ball to revolve in its housing  
40 and the ultimate object to be attained is that, as the ink is transferred from the ball to the paper in the process of writing, the ball shall be continuously re-coated with a thin surface of ink from a reservoir within the barrel of the pen. The problem which was found troublesome for a long time is explained by Harman, J. (66 R.P.C. at pp. 205-6) as follows:—  
"The merits of a ball point instead of a nib of the conventional type for fountain pens have long been canvassed, and many attempts have been made to produce a workable instrument of this kind. I was told that ball-pointed pens were proposed as far back as 1890. A ball point, it has been found, will not work with ink of the ordinary kind, called in

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this case aqueous ink. In order that a continuous trace may be made, a dense or sticky ink, called in the present case viscous ink is required. The use of viscous ink, of course, makes a ball point of no use except with a reservoir behind it, but, if a satisfactory reservoir of viscous ink can be provided, such a pen will write for a very long time, because the amount of ink used by the ball is very small. A further advantage is that the trace when made is absorbed immediately by the writing material and no blotting paper is required. These advantages had long been recognised, but before the Plaintiff's pen appeared on the market no practical ball-pointed instrument had ever been sold, at least in England, and the reason was that no one had solved the problem of the reservoir and the manner in which the ink should be fed to the ball. The essential problem is one of ventilation. Air must be allowed to enter the pen as ink is used up, because otherwise a vacuum is caused and the ink ceases to flow to the nib. This difficulty was not present in fountain pens of the ordinary type, owing to the fact that with an aqueous ink air is able to penetrate into the pen past the nib and so up into the air cavity at the base. With viscous ink, however, it was found that the air could not, or at any rate did not, at sufficient speed pass by the nib through the viscous ink behind it, and some other method of ventilation had to be discovered. Attempts were made to provide a piston or other device which would force the ink down as it was used and thus keep it in contact with the ball, but these were too elaborate and were never successful. The alternative was to have an air vent at the base of the reservoir, but the trouble always was that the ink, though viscous and therefore slow flowing, would, when the pen was inverted, sooner or later flow back through the air vent and the pen would leak. Moreover, if the ink did not remain in contact with the ball, air would enter and thus form a bubble which produced an air lock between the ball and the ink." 10 20

The actual inventor of No. 122 (571) was one Laszlo Josef Biro of Argentina, the Plaintiff, Martin, being his assignee. Biro provided a tiny air inlet in the ink reservoir at the end remote from the ball, his reservoir being constructed in a manner designed to prevent the ink from leaking through this air inlet when the pen was inverted. In the body of his specification he said :—" According to the present invention an instrument of the ball tip type is provided in which the ink reservoir is formed by one or more conduits starting at an air intake, and, after following an extended path, communicating with the recess for said ball, the said conduit or conduits being of so small a cross section that a suitable ink cannot escape from the air intakes under the effect of gravity." Claim 1 in the specification was in the following terms :—" Improvements in writing instruments of the ball-tip type, wherein the ink reservoir of said instrument is formed by one or more conduits starting at an air intake and, after following an extended path, communicating with the recess for said ball, the said conduit or conduits being of so small a cross-section that a suitable ink cannot escape from the air intake under the effect of gravity." Claim 9 is for instruments according to claim 1 wherein the conduit is smaller than 5 sq. mm. in section. It may be noted that there are several references in the body of the specification to a " feed channel " connecting the reservoir with the ball housing, and that this feed channel is shown in all the relevant drawings except Figure 3. In every case it 30 40 50

is shown as being of smaller diameter than the conduit or conduits which form the reservoir. This element, however, is not mentioned in any of the claims.

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10 Now, the pen which was alleged to infringe both in the English action and in the Victorian actions has a reservoir of "capillary size"—a term which Harman, J., found to bear a "functional sense" and to "mean no more than a tube of small bore, which for ordinary purposes does not go above 3.5 mm." It is formed by a single conduit starting at an air intake and communicating with the recess for the ball. There is no curve  
or bend in the conduit, which is cylindrical in shape throughout, and communicates with the ball housing by means of three extremely short cylindrical tubes—or "feed channels" or "ducts"—of which the first is of smaller diameter than the "conduit" or reservoir, the second is of smaller diameter than the first, and the third is of smaller diameter than the second. The axis of the conduit and of the succeeding tubes is (practically speaking) a continuous straight line.

20 This allegedly infringing instrument is an effective and successful writing instrument. Its effectiveness results from the operation of an elementary scientific principle, which was described by Harman, J. (66 R.P.C. at pp. 208–9) in these words:—"In fact the principle involved is now well recognised, and there was no dispute about it. This is that, if a tube with a narrow top and a wider bottom be filled with liquid up to the top and then held with its wider end downward, the liquid (within certain limits) will not fall out of the tube, by reason of the fact that the free surface or meniscus at the top, being narrower and having therefore a steeper curve, is stronger than the meniscus in the wider end at the bottom, and in effect the former will hold up the latter." Coming to the particular pen under consideration, his Lordship said:—"The clearance  
30 between the ball and its housing, which acts as the upper meniscus, being very much smaller than the diameter at the base of the reservoir, will hold the ink up against the ball" (i.e. even when the pen is inverted) "and prevent it from falling out at the base. It is common ground that this principle will operate effectively with a clearance at the ball of not more than 0.06 mm. (or 60 microns) and a reservoir of any bore that does not exceed 3.5 mm., though preferably it should be somewhat smaller."

40 The specification, however, of patent No. 122 (571) did not describe or claim an application of this principle. Harman, J. held, and Sholl, J. held, and I think it reasonably clear myself, that it was of the essence of the invention covered by No. 122 that the reservoir should "follow an extended path," i.e., that it should be of a helical or otherwise winding or convoluted shape. The inventor had not grasped, or set out to apply, the principle stated by Harman, J. in the passage which I have quoted. The article alleged to infringe No. 122 did apply that principle, and the reservoir did not "follow a winding path." It was not, therefore, an infringement.

50 Before leaving No. 122 I would observe that there seems to be something to be said for the view that claim 1 is bad for insufficiency, on the ground that neither therein nor in the body of the specification is there to be found any adequate description of the nature of the ink which it is necessary to use, or any statement as to the maximum cross-section

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of conduit which will be effective to prevent the ink from escaping. Both the ink and the cross-section are described merely by reference to the result which they are to attain in combination. A maximum cross-sectional area of 5 sq. mm. is mentioned in claim 9, but claim 9 was not alleged to have been infringed. It is unnecessary to pursue this matter further. I mention it only because it seems to indicate that the inventor is concentrating on his "extended path." The conduit must be of small cross-sectional area, and the ink must be "dense" or "viscous." The ideal combination can be found by experiment, but the essential thing is that the conduit should follow a path which is not direct but winding. 10

It is now necessary to turn for a moment to English No. 573. We do not know what form the original English specification took, but we do know (66 R.P.C. at p. 206) that it was amended several times, and that the last amendment was made a few days after the issue of the writ in the English infringement action. At this stage it is only necessary to say that, in the form in which it came before Harman, J., it stated that the invention was concerned with writing instruments of the ball-point type, and that claim 1 was in the following terms:—"An instrument of the said type in which the ink reservoir for the ball is constituted by a capillary tube." The meaning of the term "capillary tube" was the subject of much conflicting evidence given before Harman, J. His Lordship (66 R.P.C. at p. 212) stated his finding thus:—"on the evidence I hold that to the man of science a capillary tube is properly a hairlike tube of a very small bore, not above 1.5 mm., but that these words are sometimes used in a functional sense and have in the realms of commerce come to have a somewhat extended significance and mean no more than a tube of small bore, which for ordinary purposes does not go above 3.5 mm." So interpreting the claim, he held that the patent was infringed by the article described above. 20

As I have said, the claims in the specification of Australian No. 133 were widely different from the claims in the specification of English No. 573 which Harman, J. had to consider. The Plaintiff in the second Victorian action alleged infringement of claims 1, 2, 5 and 8 in the specification of No. 133, but only claim 1 need be considered. Claim 1 is in the following terms:—"An instrument of the type specified, having the ink reservoir constituted by a vented tube of capillary size in which when charged with viscous ink a continuous liquid vein is maintained extending from the ball, and having a feed duct leading from the reservoir to the ball, the cross-sectional area of which duct, particularly that portion adjacent the ball, being (*sic*) less than that of the reservoir." The article alleged to infringe is that which has been described above. 30 40

The Defendant's article does, in my opinion, infringe claim 1 of No. 133. All the elements mentioned in claim 1 are present in combination. Sholl, J. held that there was no infringement, but on what seems to me, speaking with all respect, to be a curious and somewhat unrealistic ground. It turned on the reference in the claim to a tube "in which, when charged with viscous ink, a continuous liquid vein is maintained extending from the ball." It may be said, as the witness Hopper in effect said, that these words really describe the result which is achieved by the other factors mentioned. But, be this as it may, the maintenance of the continuous 50

- liquid vein depends, of course, on gravity. If, therefore, an attempt is made to write with the Defendant's pen upside down or with the ball-point substantially lower than the top of the pen, the liquid vein will not be maintained, and the pen will either not write at all, or will write only for a short time, the time depending on the size of the angle at which the pen is held relatively to the plane of the material to be written on. Therefore, it was argued, it could not be said of the Defendant's pen that, when charged with viscous ink, it would maintain a continuous liquid vein extending from the ball. It was conceded that the words in
- 10 the specification must be read as referring only to normal uses of the instrument. Sholl, J. put out of consideration the possible case of an eccentric poet who might wish to write immortal verse on the ceiling of his bedroom, but he considered that normal uses of the pen would include its use for the purpose of writing on a vertical surface—for example, on a paper affixed to a notice-board in a club inviting entries for a sporting competition. It may be admitted that such a use is a normal use, but the pen would only be employed for such a purpose for a very short period at a time, and even in a completely inverted position the vein will be maintained for a brief period—more than long enough to write one's name.
- 20 If a person really wishes for some outlandish reason to write on a vertical surface for any length of time, there is no difficulty in holding the pen at such an angle that the vein of ink will be maintained indefinitely. The words in the specification must be read in a commonsense way and in the light of normal human needs and normal intelligence. I think that the Defendant's pen maintains a continuous vein of ink within any fair and reasonable reading of claim 1, and that it infringes claim 1.

- It remains to consider the question of the validity of claim 1 of No. 133. Here again I am unable to accept the view of the learned trial judge. His Honour held the patent invalid on the ground of ambiguity in claim 1
- 30 of the specification. The ambiguity was held to lie in the description of the feed duct, leading from the reservoir to the ball, as a duct "the cross-sectional area of which, particularly that portion adjacent to the ball, is less than that of the reservoir." It was held that the words "particularly that portion adjacent to the ball" lacked any precise meaning. It is true, of course, that the words in question cover a number of possible constructions, but what the inventor wishes to convey, and does convey, seems to me to be clear enough. He means that the feed duct *may* throughout its length be of less cross-sectional area than the reservoir, or it *may* be of varying cross-sectional area, but the portion which
- 40 immediately communicates with the ball housing *must* be of less cross-sectional area than the reservoir. On the one hand, the length of the feed duct within limits does not matter: it may be left to be determined by purely economic considerations. On the other hand, he may have feared that to describe the feed duct *merely* as being of less cross-sectional area than the reservoir might be to open the door to infringement, because it might be said that the claim covered only a feed duct which was of smaller cross-sectional area throughout its length. It is no real objection to this reading to say that he could have expressed himself more briefly and more clearly, and *might* perhaps even have got what he wanted if he
- 50 had omitted the words "particularly that portion." The patent is not, in my opinion, invalid for ambiguity in the specification.

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It remains, however, to deal with certain other attacks made on the validity of No. 133. Mr. Menzies said that No. 133 was anticipated by the specification of No. 122. He also said that the process of so-called "amendment" in the Patents Office, by which the specification reached its present form before acceptance, was not authorised by or permissible under, the Patents Act 1903-1946, and that in the result the grant was void. It was the pleading of this objection that really led to the two interlocutory orders, which have been mentioned above, and which are now the subject of the cross appeal to this Court. In the view which I take, it is not necessary to state the nature of those orders or the process of reasoning which led Sholl, J. ultimately to reject the argument. One cannot, however, help observing that the procedure adopted, by which the argument now in question was more or less isolated from the rest of the case, while doubtless adopted with the best of intentions, appears to have been most unfortunate and to have led to unnecessary complexity, if not to actual confusion. Mr. Menzies finally said that the patentee, at the date of his application for the patent granted as No. 133, was not in possession of the invention covered by the specification of No. 133 as it now appears. 10

Mr. Menzies's attack on the patent raises three distinct and separate arguments, only one of which depends directly on the course of the progress through the Patents Office of the application which ultimately led to the grant of No. 133. All of them, however, can be most conveniently considered after a brief examination of what happened in the Office. An order was made under sec. 51 of the Act for the production of the reports of the examiners, and these and other documents from the Patents Office were admitted subject to objection. No importance, I think attaches to the examiner's reports as such, though they serve to make what happened much clearer than it would have been without them. I set out hereunder in chronological order what appear to be the material events. 30

1. On the 8th December 1943 the application which led to the grant of No. 122 was lodged, with a complete specification, in the Patents Office.

2. On the 31st December 1943 the application which led to the grant of No. 133 was lodged, with a complete specification, in the Patents Office. The specification is a long document, and it will suffice to quote the introductory part of it, to mention one or two passages, and then to refer to the claims. Where italics occur, they are, of course, mine. The introductory part is as follows:—"This invention relates to fountain pens and refers more particularly to fountain pens of the kind which comprise an ink reservoir formed by an extension of the channel for supplying the writing point with ink, a system which by itself has yielded convenient results, although under certain conditions of arrangement only . . . In fact, the extension of the feed channel for constituting the reservoir by means of a duct of small section allows of establishing a fluid vein of constant position, after the manner of an automatically replaceable lead rod in a pencil, but, in the provision of a duct of a certain length adapted to be fed with a relatively ample amount, several difficulties are encountered, *owing to the necessity of arranging the duct in a winding or* 40



*meandering form*, or of otherwise arranging the same in such a way that it will occupy to the largest possible extent the capacity of the holder of the instrument . . . For this purpose, *a feed channel consisting of several sections* is provided, so arranged that the whole of the sections will form a *series or group of duct sections*, conveniently fitted in the body of the holder, thereby using the space to the best advantage. To this end, the duct sections, which form the ink reservoir, are connected together and communicate in series by means of passages leading from one section into the other, and as said sections are longitudinal and preferably parallel

10 to the axis of the pen, the whole of the sections will be of a length several times that of the holder." The applicant goes on to say that "the duct consisting of a plurality of sections" may be constructed in several ways, including that of a "capillary tube folded into several lengths." A further object of the invention, he says, is to have "a reservoir in the shape of a vein of great length with a minimum number of bends and occupying most of the body part of the holder of the pen." He then refers to the accompanying drawings. The drawings comprise eight figures, every one of which shows a reservoir consisting of a tube or duct longitudinally

20 folded so as to form a "series or group of tubular sections" communicating with each other, the whole forming a continuous but winding passage from an air inlet to a feed duct which leads to the writing point. The "*features which constitute the basis of the invention*" are thus described with reference to the drawings:—"In fact, said reservoir *b* is formed by a linear duct, constituted by a plurality of lengths or duct sections 5, preferably arranged as a whole and parallel to the body of the holder *a*, thus forming a series or group of duct sections which together occupy the greater part of the body *a*; said sections 5 are connected together and communicate in series, one in continuation of the other, so as to form, as a whole, one single channel commencing at the inlet or air intake 6 and ending at the

30 feed duct 4 of the sphere 3." After a description of the drawings comes this passage:—"From the foregoing description, it will be seen that *the invention substantially consists* in the provision of *sectional ducts, arranged as a whole to form a series or group*, by means of bends or passages, said duct sections communicating in series, one in continuation of another, so that the whole of duct sections will form one single duct, commencing at an inlet hole and ending at a feed duct, connected to the mounting of the sphere, said duct constituting the reservoir *b*, to be filled with a dense or semi-fluid ink and to form therewith an uninterrupted liquid vein, extending to the mounting of the sphere." Then follow the claims. Claim 1 is for :

40 "Fountain pen, of the type in which the ink reservoir is an extension duct of the feed channel for the stylographic point, *characterized by the fact* that the duct which forms the ink reservoir consists of a *series or group of duct sections*, provided with means for communicating in series one section with another, so as to form one single linear duct or channel, extending from an inlet open to the air, to the feed channel of said stylographic point." It is unnecessary to quote the other ten claims. It is sufficient to say that every one of them is for some specific form of a "series or group of duct sections," connected together so as to form a continuous line of communication from an air inlet to a stylographic point. General

50 comment on this specification may be postponed, but it is to be observed at this stage that the Defendant's pen could not possibly be said to infringe any claim contained in it.

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3. On the 29th May 1946 a copy of the complete specification of English No. 573 was made available for inspection in the Library of the Patents Office at Canberra. This means, of course, that that specification was published in Australia on that day. It is set out, so far as material, in the report of the English action, 66 R.P.C. at pp. 199 *et seq.* After stating that the invention relates to writing instruments of the ball-point type, it proceeds:—"An object of the present invention is to improve the construction of instruments of the aforesaid type. According to this invention an instrument of the said type is provided in which the ink reservoir for the ball is *constituted by a capillary tube*. The said tube is preferably open at one end to atmosphere and at the other end communicates with the rotatably mounted ball. It is preferably in the form of a series of limbs, each substantially parallel to the longitudinal axis of the instrument so that a comparatively long length of continuous tube can be accommodated in a comparatively small compass such as the usual type of fountain pen casing. The end of the tube remote from that end which is open to atmosphere conveniently communicates with the ball by way of a duct which is of the same diameter or cross-sectional area as the internal diameter or cross-sectional area of the tube or is smaller. The term tube as used herein, where the context so permits, includes a tube-like duct formed in a body." Then follow references to the accompanying drawings, which are substantially identical with those which accompanied the Australian application lodged on the 31st December 1943. Claim 1 (to which reference has already been made) is for "An instrument of the said type in which the ink reservoir is constituted by a capillary tube." Claim 4 is for "An instrument . . . in which the tube is formed into limbs substantially parallel with the longitudinal axis of the instrument."

4. On the 5th September 1946 acceptance of the complete specification of No. 122 was advertised under sec. 50.

5. On the 18th December 1946, certain objections having been taken by the examiners to the form and substance of the specification lodged with the application of the 31st December 1943, the patent attorneys of the applicant wrote to the Commissioner of Patents a letter in which, after dealing with the formal objections taken by the examiners, they said:—"As to the other matters raised by the examiner, it is proposed to remove them by a fresh description, statement of claim, and new drawings, all of which are submitted herewith." The document forwarded with the letter was a specification identical with that of English No. 573, the material parts of which have been set out above. This document, as has been seen, had been published in Australia on the 29th May 1946, and contained a claim for a monopoly in respect of all pens "in which the ink reservoir is constituted by a capillary tube."

6. On the 19th February 1948 *the original* specification lodged with the application of 31st December 1943 was notified as open for inspection under sec. 38A. Under that Section this amounted to publication.

7. Further "amendments" of the specification lodged on the 18th December 1945 (English No. 573) were submitted on the 28th January 1948, the 16th November 1948, the 10th March 1949, and the 16th May 1949,

with the result that the specification assumed the final form in respect of which patent No. 133 was granted. I will refer briefly to these later. It may be noted, however, at this stage that the examiner's objections to the specification lodged on the 18th December 1946 included an objection that claims 1-3 of the specification of No. 122 (the grant of which had by this time been sealed) were in fact "Claims to an instrument of the type in question in which the ink reservoir is constituted by a capillary tube." The answer made by the applicant's patent attorneys to this objection was that it was a feature of No. 122 that the conduit or conduits should follow an extended path, which feature was absent from the invention under consideration. This, of course, was true of the specification of English No. 573, but it was *not* true of the specification lodged with the original application.

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8. The complete specification in its final form was accepted on the 14th June 1949, and the acceptance was advertised on the 30th June 1949. The date of the actual sealing of the patent does not, I think, appear.

From this recital the fact on which Mr. Menzies's arguments depend seems to emerge clearly enough. That fact is that claim 1 of the specification accepted by the Commissioner is really for a different invention from that claimed by claim 1 of the specification lodged with the application. The truth is, in my opinion, that, when the patent attorneys forwarded with their letter of 18th December what they described as a "fresh description and statement of claim," they were submitting a claim for something much larger than, and different in substance from, what had been claimed by the original application lodged three years before. The essence of the position will appear from a brief analysis.

To begin with, in No. 122 the inventor had conceived a reservoir with an air inlet which followed an extended or winding path and was of so small a cross-section that a suitable ink could not escape under the influence of gravity. There are, I think, two possibilities. He may have thought that both the small cross-section and the extended path were essential to success. Or he may have thought that the vital thing was the very small cross-section, and that the winding path was practically necessary in order to provide a reservoir of reasonable capacity. I am much disposed to think that the former is the correct view. In any case, of course, in order to apply successfully the meniscus principle, the essential thing was that his reservoir-tube should be of larger cross-section at the top than at the end communicating with the ball-housing. But, for all that appears, he was completely innocent of any attempt to apply any such principle. I would not agree, with respect, with a suggestion, which seems implicit in the judgments of both Harman J. and Sholl J., that he had discovered a principle without realising it, or cleverly conceived an application of that principle without quite understanding why that conception worked. The truth is, I think, that nothing was more remote from his mind than the idea that a capillary tube, wider at one end than at the other, would solve the problem of the ball-point pen.

That such an idea was not less remote from his mind when he made the application which led to the grant of No. 133 seems to me to be made very clear by the complete specification lodged with that application. He refers to pens (i.e. such pens as are covered by No. 122) "of the kind

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which comprise an ink reservoir formed by an extension of the channel for supplying the writing point with ink." Some such arrangements, he says, have "yielded convenient results." But difficulty has arisen from the "necessity of arranging the duct in a winding or meandering form or of otherwise arranging the same in such a way that it will occupy to the largest possible extent the capacity of the holder." Clearly the problem which he purports to be about to solve is the problem of *arranging* a duct of small section within the holder in such a way as to provide a "relatively ample" amount of ink in the reservoir. There is a degree of confusion in the language. But the problem faced is purely and simply a problem of *arranging* a reservoir-tube within a holder, and that problem is solved by providing a "series or group of duct sections." "The invention," says the inventor himself, "*substantially consists* in the provision of sectional ducts" arranged in a particular way. He is concerned, of course, throughout with "a duct of small section," such as he was concerned with when he applied for the patent granted as No. 122. But there is nothing from beginning to end to suggest that he has discovered or invented an application of the meniscus principle. The claims are all, without exception, for some specific form of a "series or group of duct sections." If No. 133 had been granted on this original specification, it would have been idle to suggest that the Defendant's pen was an infringement. 10 20

When the original specification for No. 133 was lodged with the application of 31st December 1943, the major objection of substance taken by the examiner was that the invention was already covered by the specification of No. 122, which had already been lodged. There is obviously a great deal to be said for this view: indeed I think it is correct. The objection was ultimately met by the *substitution* of the specification of English No. 573. Claim 1 of this specification claimed, in effect, a "capillary tube" reservoir *simpliciter*. The folded or sectional tube is now referred to merely as a "preferable" form of construction. The amendment appears in fact to have been treated as if it were a fresh application. One objection taken by the examiner was that the capillary tube as such had already been claimed in the application for No. 122. To this objection of the Office the reply was on 28th January 1948 that under No. 122 the conduit followed an extended path, "whereas, according to the present invention, it would be in order to apply an appropriate conduit or tube of, say, 6 mm. in length and this could not be said to fall within the definition of an 'extended path'." What is meant by this is far from clear, but it may have been intended to refer to a conduit following a "straight" path. At any rate the examiner disagreed with it. He said: "Such an interpretation is nowhere obtainable from the original specification, whereas the contrary is plainly stated throughout that document." This statement appears to me to be perfectly true. To a new claim 1 submitted (which need not be set out) the objection was very properly taken that it was "directed to an instrument characterised by a specific result." 30 40 50

Further amendments submitted on 16th November 1948 included a new claim 1, which was identical with claim 1 as ultimately accepted except that it did not include the words "particularly that portion adjacent the ball." Corresponding alterations were made in the body of the specification. Here, with the express reference to a restricted feed duct,

we do get for the first time what is really an application of the meniscus principle. The objections taken by the Office to the new claim included what seems to be the perfectly sound objection that a "restricted feed duct" had not been claimed in the original specification. The answer made on the 10th March 1949 was that the restricted feed duct was indicated in the drawings. (A legitimate replication to this might have been that this feature was also shown in the drawings relative to No. 122.) It was also proposed to amend claim 1 so as to include the words "particularly that portion adjacent the ball." After this the only

10 substantial objection taken by the Office was that Fig. 1 of the drawings did not "include a restricted feed duct—the essential feature of the invention." This was, of course easily remedied, an amendment of the drawing being lodged on the 16th May 1949, and the specification was shortly afterwards accepted in the form in which it now appears.

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In this way it seems to me clear enough that a patent, bearing the date of the original application, came to be granted for an invention quite different from that described in the specification accompanying that application. The substance of what was done when the specification of English No. 573 was lodged on 18th December 1946 (three years after

20 the original application) was that a new application for protection for a different invention was being made. If, of course, such a new application had actually been made on the 18th December 1946, it would have been met at once by the fact that the invention had been published in Australia some seven months before. The real position was, I think, disguised by the fact that substantially the same drawings accompanied the 573. specification as had accompanied the specification lodged with the original application, coupled with the statement in the body of the specification that the tube was "*preferably*" in the form of a series of limbs folded longitudinally. The truth is that the series of limbs folded longitudinally

30 was the essence of the invention described in the original specification. The truth is also that the specification ultimately accepted described an invention for the purposes of which it was *not* preferable to have a tube composed of a series of limbs. On the contrary, when once the meniscus principle was applied by the provision of a tube wider at the top than at the ball, both the "winding path" and the "longitudinal folding" became not merely unnecessary but practically useless, for a straight tube would be just as efficient and obviously much easier and cheaper to manufacture. The drawings and the false statement about a "*preferable*" construction tended to conceal the nature of what was really being done.

40 To arrive at a correct understanding of what really happened in this case has been a long and tedious process. But, when once the position is understood, it is possible to deal quite shortly with the three arguments which I have understood to be submitted by Mr. Menzies.

One argument was that No. 133 was anticipated by No. 122. I think that this would have been a sound ground of attack if No. 133 had been granted on the specification lodged with the original application. But the specification accepted by the Commissioner is not, in my opinion, open to attack on this ground.

It is next said that the process of metamorphosis, by which the

50 specification originally lodged became the specification finally accepted,

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was not a process of amendment such as is authorised by secs. 42 *et seq.* of the Patents Act 1903–1950. The result is said to be that the grant is void. I have indicated my opinion that the accepted specification claimed a different invention from that claimed by the specification originally lodged, and I think that the substitution of the specification of English No. 573 for the specification as it stood before represented a departure from anything really contemplated either by sec. 42 or by sec. 45. And it is not an impossible view that a valid grant based on that substitution could not be made. On the whole, however, I am of opinion that it does not follow that the grant of No. 133 is void. Such a conclusion might follow if it could be said that that substitution was not really an “amendment” at all, and that it was actually unlawful for the Commissioner to allow it. But I do not think that this can be said. I am unable to avoid the conclusion that the effect of sec. 46 is to give to the Commissioner a discretion, and to place his acceptance of the specification beyond challenge as such. Considerable difficulty attaches to reading Division 4 of Part IV of the Act with those provisions of Division 1 of Part IV which authorise the amendment of a complete specification. But sec. 45—unlike sec. 71—does not impose on the making of any amendment the condition, imposed by sec. 78, that the amendment shall not have the effect of claiming an invention “substantially larger than or substantially different from” the invention for which protection was originally claimed. That it does claim such an invention may very well be a good ground for a refusal to accept a specification amended under sec. 45. But I do not think that an acceptance under sec. 46 can be challenged as such. And to say that the patent is void by reason of what happened in the Patents Office between application and acceptance is, in effect, to challenge the acceptance as such.

Clearly, however—and this brings us to the final argument for the Respondent—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 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.

In the present case, on the material before the Court, the only proper conclusion, in my opinion, is that the patentee was not on the 31st December 1943 in possession of the invention ostensibly protected by patent No. 133. An inventor cannot complain if we judge what he has invented by looking at what he says he has invented. Looking at the complete specification of No. 133 as it has existed from time to time, one can only say that the invention (if any) of which he was in possession on the 31st December 1943 was an invention of a different character from that described in the specification which was ultimately accepted by the Commissioner. The former was an invention much narrower and of much less utility than the latter.

The view indicated above would be decisive of the case, and would lead to a dismissal of the appeal in action No. 58 of 1951. The question, however, arises whether the patentee ought not to be given an opportunity to place before the Supreme Court, if he can, further material bearing on the question whether he was in possession of the relevant invention on the relevant date. The question is essentially a question of fact. The position which has arisen is peculiar. Largely because of the unfortunate course which the proceedings took in the Supreme Court, what I regard as the real and ultimate question in the case became to some extent lost to sight, and it did not receive the attention which, to my mind, it deserved. It is perhaps not very likely that the Plaintiff will be able to better his case. But it is not impossible, and, having regard to all the circumstances, I think on the whole that he ought to have an opportunity of doing so. Accordingly I agree with the order proposed by the Chief Justice.

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REASONS FOR JUDGMENT of Taylor, J.

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In these appeals the Appellant seeks to set aside orders made by the Supreme Court of Victoria in two suits in each of which the Appellant was the Plaintiff and the Respondent was the Defendant. In each suit the Appellant sought an injunction restraining the Respondent from infringing letters patent of the Commonwealth and claimed damages for past infringements. The suits were heard together by Sholl, J., who, after considering the matter at length, ordered that judgment in each suit should be entered for the Defendant.

The letters patent, the subject of the first suit, related to "Improvements in writing instruments." They were letters patent No. 122073 and they have throughout the hearing of the suit and this appeal been referred to as No. 122. Those the subject of the second suit—No. 133163 also relate to improvements in writing instruments and have been referred to as No. 133.

The defendant denied the infringements alleged by the Plaintiff in each suit, and, further, claimed, on several grounds, that the letters patent were invalid in whole or in part. Some of the issues originally raised by the pleadings, however, ceased to be of importance in the suits and were not debated on this appeal, whilst other issues arose before the trial as the result of preliminary discussions upon questions of law which were said to arise upon the pleadings. It is impossible to appreciate the issues which ultimately arose for decision and which are in question in this appeal without at least a brief reference to the specifications of the inventions the subject of each patent.

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No. 122 : As has already been said this invention purports to relate to "Improvements in writing instruments." More particularly the specification declares that the invention "relates to improvements in fountain pens of the ball tip type, and particularly to means for providing a regular ink feed to the ball constituting the active or writing element of said instrument." The most suitable ink for pens of this type is said to be "so-called 'dense' ink, which is very adhesive," and the ball, it is said, will, in rotating, "transfer to the exterior a regular and sufficient quantity to make neat and normal strokes." One of the objects of the invention is described by reference to a difficulty experienced in the use of "barrel-shaped reservoirs" in such writing instruments. The specification states that in the case of such a reservoir "the mass of ink will change its position as the instrument is moved about, so that when the tip of the pen is raised contact between the ink and the ball is lost, with the result that normal working of the instrument may be interrupted or impaired ; another object of the invention is to overcome this difficulty." A further object is declared to be "to provide an ink reservoir wherein gravity does not alter the position of the ink and wherein the charge is kept in a satisfactory condition and forms a continuous vein of liquid to provide a continuous feed as and when required without delay or interruption." Thereafter the specification declares "According to the present invention an instrument of the ball tip type is provided in which the ink reservoir is formed by one or more conduits starting at an air intake *and after following an extended path*, communicating with the recess for said ball, the said conduit or conduits being so small a cross section that a suitable ink cannot escape from the air intakes under the effect of gravity. According to one method of carrying the invention into effect the ink reservoir is constituted by one or more conduits arranged in the form of a helical coil." The specification then proceeds to indicate that the above and other objects and advantages of the invention will become apparent from the ensuing descriptive matter when read in conjunction with the attached drawings which purport to illustrate by way of example some of the preferred embodiments of the invention.

The italics in the above extracted matter are mine and merely serve to indicate at this stage a passage in the specifications concerning which considerable discussion took place on the appeal. I should add that the italicised expression is repeated in the first claim made by the patentee in the specification. This claim is in the following terms :—

"Improvements in writing instruments of the ball-tip type, wherein the ink reservoir of said instrument is formed by one or more conduits starting at an air intake and, after following an extended path, communicating with the recess for said ball, the said conduit or conduits being of so small a cross-section that a suitable ink cannot escape from the air intake under the effect of gravity."

It is, of course, impossible to appreciate fully the descriptive matter concerning the "preferred embodiments" without recourse to the drawings or diagrams accompanying the specification but it is not without significance that the ink reservoirs shown in the drawings are constituted in the form of helical coils or channels or inter-connected annular convolutions.



The article manufactured and sold by the Respondents is a ball pointed writing instrument constituted by an outer casing which contains a reservoir in the form of a very narrow gauge or capillary tube with an air intake at the end remote from that adjacent to the ball. In many respects it is similar to that described and for which claims are made in the specification of No. 122. The tube is of such small cross-section that "a suitable ink cannot escape from the air intake under the effect of gravity" and "gravity does not alter the position of the ink" which "forms a continuous vein of liquid to provide a continuous feed as and

10 when required without delay or interruption." The reservoir feeds, as in the invention described in the specification, to a rotatable ball which in, rotating, transfers a sufficient quantity of ink to the exterior of the ball to enable the user to write. The distinguishing feature of the instrument which is said to infringe the Appellant's patent—if, indeed, it be a distinguishing feature—is that the reservoir is constituted by a straight capillary tube. The evidence shows that if what is called a capillary tube is used as a reservoir in association with ball pointed instruments of this type the column or vein of ink contained in a fully charged reservoir will not be displaced by the force of gravity when the pen is moved or even inverted

20 and that it is unnecessary in order to obtain this result that the tube should take the form of a spiral or should in any way diverge from a straight course within the holder. The case of the Respondent was that this feature of its instrument clearly distinguished it from the Appellant's invention. It was, it was contended, of the essence of that invention that the reservoir of the instrument described and disclosed should consist of a helical coil or annular convolutions or take some other form of "extended path." Whilst conceding that the drawings of the "preferred embodiments" disclosed in each instance reservoirs of that type counsel for the Appellant contended that there was nothing in the description of these embodiments

30 —which were only *preferred* embodiments—to suggest that a bent tube was essential to or of the essence of the invention. Helical or spiral tubes might have been preferred, it was said, but they were not considered to be essential. Sholl, J., however, was of the contrary opinion though no doubt he was greatly influenced in coming to his conclusion by the decision of Harman, J., in *Martin and Anor. v. Selsdon Fountain Pen Coy., Ltd.* (66 R.P.C. 193) when he was called upon to consider precisely the problem which arises on this aspect of the appeal. The terms of the specifications of United Kingdom patent No. 571698, which were then under consideration, are identical with those of No. 122 and on this point Harman, J.,

40 said :—

"Now like canons of construction apply to specifications as to any other written instrument. (See Lord Esher's speech in *Nobel's Explosives Coy. v. Anderson*, 11 R.P.C. p. 523.) Plain language must be given its plain meaning, and clear words in a claim must not be tortured into an unnatural meaning by importing passages from the body of the specification. (See Lord Russell's speech in *Electrical & Musical Industries, Ltd. v. Lissen Ltd.*, 56 R.P.C. 41, l. 34.) The claims also must be construed without an eye on the alleged infringer's acts. (So said Greene, L.J., in *R.C.A. Photophone Ltd. v. Gaumont British Picture Corporation*, 53 R.P.C. at p. 202, l. 16.) On the other hand, it is right to construe a claim

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with an eye benevolent to the inventor and with a view to making the invention work—this is an application of the old doctrine *ut res magis valeat quam pereat*—and it is illustrated in *Nobel's* case at p. 524 ; and, where the language of a claim is obscure or doubtful, the doubt may sometimes be resolved by referring to words in the body of the document to explain it. This is known as the dictionary principle. (See Lord Haldane's speech in *British Thomson-Houston Coy., Ltd. v. Corona Lamp Works, Ltd.*, 39 R.P.C. p. 67, l. 44.) All these observations are indeed truisms. Turning then to 571, the argument on construction concerned chiefly the words in Claim 1, 10 repeated by reference in Claim 9, ' after following an extended path.' It is said by the Plaintiffs that these merely mean that the path which the vein of ink follows constitutes the extension of the feed channel from its start at the ball till it reaches the air intake, and they point to the words at l. 126 on p. 2 which I have already read and which speak of an extension of the feed channel. The Defendants, on the other hand, say that, in order to give these words any, or any adequate, meaning, they must be a reference to the fact that in all the embodiments of the invention the conduits are shown as either coiled or helical or twisted in some spiral, and that the 20 meaning of these words is that the conduits must not be straight, but must follow a path longer than that which they would take if they passed direct from the ball to the air intake. They point to the fact that at l. 30 on p. 3 the reservoir is described in so many words as being ' a coil of small section ' and argue that on a fair reading of the document it is clear that the inventor supposed, whether rightly or wrongly, that there was some virtue, beyond mere added area of the contents, in twisting the reservoir ; for instance, that the force of gravity would have less effect upon it, and there would be more resistance to the shock caused to the column of ink by dropping 30 the pen.

I have carefully considered these rival views and have come to the conclusion that the Defendants' construction is the right one. The words are no doubt capable of either meaning and I am, in my judgment, entitled, in order to interpret them, to look at ' 571 ' before its amendment. In doing so, I find these passages at l. 60 of p. 1 and, again, at l. 72 : ' According to the present invention an instrument of the said type is provided in which the ink reservoir is formed by one or more conduits starting at an air intake and, after following an extended path, leading into the feed channel or 40 cavity for said ball ' ; and (l. 72) ' To this end, the conduit constituting the reservoir is of helical or other similar shape or arrangement following an extended path from a corresponding air intake to said feeder.' These have been struck out of the amended specification, but seem to me to show that the author used the words in the sense attributed to them by the Defendants. The words appear in the first and primary claim and seem to me to signify something more than an indication that the conduit begins at the ball and ends at the air intake. Whether the inventor was right or wrong in supposing that there was any virtue in twisting or turning the 50 conduit seems to me to matter not at all. It is the direction he gave

which matters and that, as it seems to me, is a direction to follow a twisting path of some sort, though not necessarily exactly as his various figures show.”

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As will be observed his Lordship's decision was influenced by the consideration of words which appeared in the specification before it assumed its final form and which at that time had been struck out. Whether or not this represented a permissible approach to the question of construction involved is in this case immaterial for the complete specification for No. 122 lodged on the 8th December 1943 was accepted in its original form on the

10 5th September 1946. Accordingly its true construction depends upon a consideration of its terms alone. Nevertheless unaided by the extraneous matter to which Harman, J., thought it proper to refer I am of the opinion that the Respondent's instrument is not within the relevant claim made in No. 122. Claim 1, which, it is alleged, the Respondent's instrument infringes lays stress upon the feature that the reservoir follows an extended path “starting at an air intake and . . . communicating with the recess for the said ball.” It was, of course, contended that an “extended path” need not follow a helical or spiral course and with this I entirely agree. There is no doubt that, in the abstract, extension may take place along a

20 straight path; but the expression “extended” is a word of wide and elastic meaning and the sense in which it is used in any particular context must necessarily depend to some extent upon that context. In the present case it is used to describe the course which a narrow tube, with an air intake at one end, should pursue in its course inside a confined space to connect with the recess in which a rotatable ball is housed. In these circumstances if the word “extended” is to be given any significance at all surely it must be understood as an antonym of “direct” or “straight.” The holder, though of undefined is yet of finite size and within it the tube is to pursue an extended path. In my view this expression must be taken to connote

30 something other than direct and in my opinion this feature of the invention was described and claimed as vital. It may be, as Sholl, J., observed, that in 1943 the applicant for these letters patent “initially did not fully comprehend the nature and application of the principle of capillary forces in relation to his instrument, but became more clearly aware thereof as time went on.” But no claim was made founded simply upon the use or characteristics of a simple capillary tube. On the contrary the continuous vein of ink was to be maintained by a combination of features, i.e., a tube of small cross-section following an extended path within a fountain pen casing. If it be thought that the words of the first claim

40 are equivocal—and I do not think they are—ample support for the view which I have expressed may be found in the description of the various preferred embodiments and on this point particular reference might be made to the passage in column 6 commencing at line 34 where it is said: “Inasmuch as the reservoir is formed by a *coil* of small section the instrument may be placed in any position and used in any manner without the vein of liquid being affected by gravity.”

The view which I have expressed on this point is fatal to the appeal from the order in the first suit and accordingly I am of the opinion that it should be dismissed.

50 No. 133: A complete specification for this invention was lodged on the 31st December 1943 and after a number of amendments the specification

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as finally amended was accepted on the 14th June, 1949. The defences raised in answer to the Plaintiff's suit for infringement of these letters patent denied infringement and asserted that the letters patent were invalid for ambiguity, insufficiency and vagueness. These issues were resolved in favour of the Respondent and the questions which arise on this appeal are concerned with those matters. The Respondent also asserted by way of defence laches on the part of the Appellant, invalidity of the letters patent on the ground of want of subject matter and that no inventive step was involved and also that the letters patent were void because of amendments permitted and made after the lodging of the complete specification and before acceptance of the specification in its finally amended form. These additional matters of defence were determined against the Respondent and became the subject of an appeal by the latter. That appeal was heard immediately after the conclusion of the argument in the main appeals. 10

For the purpose of discussing the various points involved, it is convenient first of all to deal with the main appeal in respect of the suit leaving the matters which were debated on the Respondent's appeal to be stated with more particularity at a later stage of these reasons.

The Complete specification for letters patent No. 133 in the amended form in which it was ultimately accepted purported to relate to "writing instruments of the type in which a ball is mounted for rotation in a housing with part of the ball exposed and is supplied with ink from a suitable reservoir, the arrangement being such that as the ball is rotated such as by being moved relatively to and in contact with a writing surface the ball carries a quantity of ink through the housing, which ink is deposited on said surface and a trace is made." An object of the invention was said to be to improve the construction of instruments of that type. According to the applicant he provided "an instrument of the type specified, having the ink reservoir constituted by a vented tube of capillary size in which when charged with viscous ink a *continuous liquid vein is maintained extending from the ball*, and having a feed duct leading from the reservoir to the ball, the cross-sectional area of which duct, *particularly that portion adjacent the ball*, being less than that of the reservoir. The italics again are mine and draw attention to two expressions concerning which there was considerable discussion. The expression "vented tube of capillary size" is employed in the specification "in relation to the reservoir of a writing instrument of the type specified to mean a tube having an internal bore of between 1 and 4 mm. (subject to a manufacturing tolerance of the order of +, —, 5%) so that when charged with a viscous ink the meniscus formed at the end of the ink column remote from the ball (at the interface between the ink, the air and the interior surface of the tube) is stable and will not break under shocks to which the instrument is subjected in normal use." Claim 1, which it is alleged the Respondent's instrument infringes, is in the following terms:— 30 40

"An instrument of the stype specified, having the ink reservoir constituted by a vented tube of capillary size in which when charged with viscous ink a continuous liquid vein is maintained extending from the ball, and having a feed duct leading from the reservoir to the ball, the cross sectional area of which duct, particularly that portion adjacent the ball, being less than that of the reservoir." 50

The references which I have made to the specification are brief but they are sufficient, at least, to enable the two points made by the Respondent concerning vagueness and ambiguity to be appreciated. In the first place it was said that the words of the claim "the cross-sectional area of which duct, particularly that portion adjacent the ball, being less than that of the reservoir" make it quite impossible to determine whether the claim was intended to cover any instrument in which the cross-sectional area of the feed duct or any part thereof is the same as or greater than that of the reservoir. Concerning this submission Sholl, J., said :—

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10            "It was next said that the expression, 'the cross-sectional  
area of which duct, particularly that portion adjacent the ball,  
being less than that of the reservoir,' was ambiguous, in that it  
was impossible to be certain whether an instrument having the  
feed-duct so constructed that the portion of it adjoining the  
reservoir was of the same cross-section as the reservoir, or of larger  
cross-section, while the portion of it adjacent to the ball was of  
smaller cross-section than the reservoir, did or did not infringe the  
Claim. It was said by Mr. Shelley on the other hand that the  
word 'particularly' merely provided emphasis, and that if any  
20            portion of the feed duct were of the same cross-section as or greater  
cross-section than the reservoir, there would be no infringement,  
except possibly in the case of a mere 'colorable departure' within  
the doctrine of *Clark v. Adie*, 2 App. Cas 315.

              In the end, I have come to the conclusion that there is here  
an invalidating ambiguity. I am rather disposed to think the  
draftsman of Claim 1 wanted to have the best of both worlds, and  
that he may have thought he was saying, in effect—'I claim a  
monopoly in all instruments in which, in addition to the other three  
characteristics earlier mentioned, there is a feed duct leading from  
30            the reservoir to the ball, and having a lesser cross-section than the  
reservoir; but I go further than that, and I also claim all those  
with the same three previously mentioned characteristics, and a  
feed duct leading from the reservoir to the ball, if the portion of  
the feed duct adjacent to the ball has a lesser cross-section than the  
reservoir, whatever be the cross-section of the rest of the duct.'  
Now that is just the opposite of the construction which Mr. Shelley  
sought to give the claim, although, as a matter of literal interpreta-  
tion, there is much to be said for his reading of it. I simply do not  
know with any reasonable certainty which meaning the draftsman  
40            really intended, and there is no evidence on which I can say that  
the ordinary person skilled in the art of making pens, to whom the  
specification is addressed, could be reasonably certain. The matter  
is perhaps made more rather than less difficult by the fact that,  
as Mr. Shelley stated early in the hearing, and as the technical  
evidence made clear, the element of the feed duct and its cross-  
sectional area is not technically essential at all to the operation of  
the capillary tube as a non-leaking reservoir, but is merely a  
convenient feature for the purpose of feeding an appropriately  
small amount of ink to the ball point of a practical pen. The  
50            patentee has chosen, for reasons associated (as will later appear)  
with the objections of the examiner, to claim a combination including

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this fifth element, but it cannot be said with certainty what the element is, and accordingly I think the first claim, and therefore all the claims, are invalid for ambiguity and uncertainty.”

I confess that I do not experience the same degree of difficulty which his Honour experienced. It is true, of course, that the language of the claim is by no means clear but this does not conclude the matter. Imperfections of expression constantly give rise to difficulties in construction but only occasionally is a Court driven to the necessity of saying that no reasonable meaning can be found for the words used. In the present case it is clear that the reservoir, consisting of a vented capillary tube as described is not to exceed 4 mm. + 5% for manufacturing tolerance. From one end of this reservoir—if indeed no part of the feed duct itself should properly be regarded as part of the reservoir—a feed duct provides access for ink to the internal side of the rotatable ball. Now Claim 1 stipulates that the cross-sectional area of the feed duct shall be less than that of the reservoir and if the language of the claim stopped there the present contention could not have been advanced. The difficulty, if there be one, arises from the interpolation of the words “particularly that portion adjacent the ball.” The interpolation of these words does not make for clarity and literally does not make sense. But while it is clear that “the function of the claims is to define clearly and with precision the monopoly claimed, so that others may know the exact boundaries of the area within which they will be trespassers” (per Lord Russell in *Electrical and Musical Industries Ltd. v. Lissen Ltd.* (56 R.P.C. 23 at p. 39) it is equally clear that it is the duty of the Court to endeavour to ascertain from the language used the true meaning of any claim or claims. It is not the function of the Court lightly to discard the claims in a specification on the ground that the language used is vague and uncertain. Now, in the present case do the words used, bearing in mind the interpolation, bear any reasonable meaning? I think they do. It is clear that the cross-sectional area of the reservoir may vary from 1 mm. to 4 mm. so that in concerning oneself with the feed duct—if it be entirely separate and distinct from the reservoir—it is necessary to visualise a duct leading from a vented tube which may have a cross-sectional area of 1 mm. or 4 mm. or somewhere between those specifications. It would be quite foreign to the conception of a feed duct that the cross-sectional area of any part of it should exceed that of the reservoir from which it leads and the terms of clause 1 read without the interpolated words make it clear that no such thing was intended. Nor, in my opinion, is the effect of the interpolated words to indicate otherwise. Their purpose, it seems to me, is to indicate that particular attention must be devoted to that portion of the feed duct adjacent to the ball. The degree to which the cross-sectional area of the feed duct must be diminished below that of the reservoir will depend primarily upon the cross-sectional area of the latter. The ball is described as having a diameter “in the order of 1 mm.” so that it is apparent that where the cross-sectional area of the reservoir is of the maximum specified the degree to which the cross-sectional area of the feed duct must ultimately be diminished may be relatively great. In other cases it may be very little. In my view the purpose of the expression “particularly that portion adjacent the ball” must be taken to have been used with this circumstance in mind, and it was intended

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to indicate that, notwithstanding some general narrowing of the feed duct at or after its junction with the reservoir, a particular diminution was required at the point adjacent to the ball. This being so, I am of the opinion that the Respondent's first submission on this aspect of the case should be rejected.

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10 The second objection to the specification on the ground of vagueness was based on the words of Claim 1 "in which when charged with viscous ink a continuous liquid vein is maintained extending from the ball." The objection was that it was impossible to ascertain whether the claim was that the vein of ink extending from the ball would be maintained *in all* circumstances or *at all times during the normal use of the instrument*. I have no doubt that the claim should not be read in the wider sense. The invention relates to writing instruments and it would be doing an injustice to the language of the claim to read it otherwise than as a claim that the vein of ink would be maintained in the position indicated during conditions prevailing in the course of its normal employment and use as a writing instrument.

20 The matter remaining for consideration on the main appeal is the question of infringement and this question is in a considerable measure related to the question of construction to which I have just referred. For the respondent contends that, even conceding the narrower construction of the relevant words of Clause 1 to be correct, the pen which is alleged to infringe the Appellant's letters patent is not a pen in which a vein of ink extending to the ball is maintained in the relevant circumstances. It was shown that such a vein was not maintained "when an attempt was made to write on a horizontal surface above the writer's head, or on a vertical or inclined surface in a position where the ball point of the instrument . . . was raised substantially above the end remote from the ball." On this point Sholl J. said :—

30 "Now I leave out of account altogether the case of attempting to write on a horizontal surface above one's head. There might be some extraordinary case in which someone might want to write on a ceiling or in some similar position, but it would certainly not be a normal method of use. But the question of writing on a vertical or inclined surface with the point above the opposite end is quite a different matter."

After reviewing the evidence his Honour proceeded :—

40 "Now it can be said that the Defendant's pen is one in which 'when charged with viscous ink a continuous liquid vein is maintained extending from the ball,' in what I shall, for brevity, describe as all conditions of normal use? I have come to the conclusion that it cannot. To begin with, Dr. Fehling, at p. 198, when considering whether any conditions of 'normal use' could arise resulting in a risk of leakage, described one case by saying, 'The only condition I know *and the user of the ballpoint pen is familiar with*—if I write upwards . . .' But in the next place, I cannot say, viewing the matter as a jury would, and using my own general knowledge of everyday affairs and events, that it is not one

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perfectly normal method of using a writing instrument in general, or a fountain-pen or ballpoint pen in particular, to write on a vertical or inclined surface with the point of the instrument above the horizontal. Nor can I say, looking at Exhibit 8, that it would be quite abnormal to seek to write in such a position more than there appears. Almost everyone, I suppose, has seen on the vertical notice-boards of social or other clubs, or of sporting bodies, documents on which persons are invited or expected to write names or other particulars, and on which it is usual or preferable to write in ink—e.g., entries for tournaments, results of matches, subscriptions for donations, and the like. Many persons have seen in the headquarters or other establishments of the armed forces, or in the laboratories or control rooms of many kinds of technical establishments, charts, lists, maps, or other documents on vertical walls or boards, on which it is the practice manually to write in ink entries from time to time of all kinds of particulars. Tradesmen and carriers are frequently seen to write in such a position against a wall. Viewing the matter again as a judge of fact, I entirely disagree with Mr. Phillips' suggestion that in such cases people attempt to write with the point below the horizontal; that would be most unusual. It is hardly a matter on which one can expect evidence to establish any more than one's observation and common-sense tell one. Accordingly I am of opinion that the Defendant's pen, Exhibit E, and any similar pen relied on by the Plaintiff as an infringement, has not been shown to infringe Claim 1, nor, therefore, any other claim of the patent, if one construes Claim 1 as I have construed it (and as the Plaintiff's counsel construed it) in relation to the first four elements referred to in it, and assumes it not to be invalid for ambiguity as to the last element mentioned in that Claim."

In one sense it may, I think, be quite fairly stated that a pen is not normally used to write at a height on vertical surfaces. At all events pens ordinarily serve their purpose in less awkward circumstances. But, however this may be, there was abundant evidence which was not in dispute that both the patented instrument and the Defendant's pen would for a short period write, not only when the end remote from the ball was some distance below the latter, but even when held vertically with the ball point uppermost. It was only after use in this position for some short period that the possibility of air entering the ball point end occurred and made possible the displacement of the otherwise constant vein of ink. There was evidence, apparently acceptable to his Honour, that the Defendant's pen, and indeed other pens of the same type, will continue to write and that the vein of ink extending to the ball will otherwise be maintained indefinitely not only during the ordinary vicissitudes of the normal life of a pen, but also if used with the end remote from the ball poised below the level of the writing end to the extent of about one inch. It is only when the remote end is lowered further and the pen is used in that position for some little time that possibility of disturbance of the vein of ink occurs. Now, whatever may be thought of the learned trial judge's view of what may be considered to be the normal use of a pen, I am firmly of opinion that it is no part of the normal function of a pen and that a pen



is not normally used to write for long periods upon highly placed vertical surfaces. Nor can I believe that the relevant words of the claim would be so understood by "a reader ordinarily intelligent and versed in the subject matter." (per Lord Shaw in *British Thomson-Houston Coy. Ltd. v. Corona Lamp Works Ltd.* (39 R.P.C. 49 at p. 89). The use of a pen for the purposes indicated in the illustrations given by his Honour may be thought to constitute normal use, but none of such purposes require the use of a pen for long periods or, necessarily, in a position in which the infringing instrument or the patented instrument would not continue to function indefinitely. On the contrary, the evidence seems clear that the vein of ink would be maintained for considerably longer than it would take to complete entries or notations of the nature indicated by his Honour even if the pen were held in a vertical position with the writing end uppermost.

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These reasons lead me to conclude that the first appeal should be dismissed and that the matters debated in the second appeal should be decided in favour of the Appellant. Accordingly it becomes necessary to consider the matters which arise in the Respondent's appeal.

I have already stated in a general way the defences unsuccessfully raised in the suit. Not all of these defences were, however, pursued in the appeal. Those which we are concerned, in some way or other, with events which occurred between the lodging of the complete specification for No. 133 on the 31st December, 1943, and the acceptance of the specification in its finally amended form on the 14th June, 1949, and it is material to refer to some of those events. The first event of any significance was that on the 29th May, 1946, there became available for inspection in the library of the Patents Office at Canberra the complete specification of what was referred to as United Kingdom Letters Patent 573. Thereafter, on the 18th December, 1946, the specification for No. 133 was amended. The result of this amendment was to make the specification identical in terms with that of the United Kingdom patent. The next event was that the specification in its original form, was, pursuant to Section 38A of the Patents Act 1903-1946 (which came into force on the 11th September 1946) published in the Official Journal on the 19th February 1948. At later stages, namely on the 28th January, 1948, the 16th November, 1948, 10th March 1949 and the 16th May 1949, further amendments were made. The complete specification, as so amended, was, as I have said, accepted on the 14th June 1949 and such acceptance was duly advertised pursuant to Section 50 on the 30th June 1949.

The first point which is made upon a comparison of the specification in its original form and the form in which it was accepted is that the invention ultimately claimed was not the invention described or claimed in the original specification. The immediate result of this, it is contended, is that the letters patent are invalid. Several steps are involved in this argument. First of all, it is said, it is a condition precedent to the right of the Commissioner to seal letters patent that a complete specification of the invention shall have been lodged and accepted. In the present case, it is then said, no such specification was in existence at the relevant time. It is true, of course, that there was in existence a document which purported to be such a specification and that the Commissioner purported to accept it as a specification, but this document came into existence by

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the amendment of the original specification, and it is argued, the power implicit in Section 45 of the Act to allow amendment does not authorise amendments which would result in claims for an invention not described or claimed in the original specification. Any amendment which purports to produce this result, it is contended, is without legal effect and since, it is further claimed, this was the purport of the amendments in this case the specification as finally amended is not a specification at all and is entirely without legal effect.

It is possible, however, to concede that the power to allow the amendment of a specification is not unlimited without producing the result 10  
contended for by the Respondent. A mere perusal of the provisions of Division 4 make it appear clearly that amendments should not be made in pursuance of that division which "would make the specification as amended claim an invention substantially larger than or substantially different from the invention claimed by the specification before amendment" (Section 78) but it appears equally clearly that "Leave to amend shall, notwithstanding the last preceding section, be conclusive as to the right of the party to make the amendment allowed except in the case of fraud" (Section 79). Again, the question whether "all directions for amendment are complied with" under Section 44 is a matter for the 20  
consideration of the Commissioner alone. It would be strange if, these matters having been left to the decision of the Commissioner, the legislature, in enacting Section 45 and 46, intended to pursue the entirely different course of allowing the question of the validity of a patent to depend upon a subsequent judicial enquiry whether some particular amendment to the specification as originally lodged should have been permitted under Section 45. During the discussion concerning this problem counsel for the Respondent emphasised the difficulties created by Section 38A and Section 54 if the contrary view should be taken. After publication of a complete specification of an invention the applicant has, 30  
by virtue of the provisions of Section 54, "the like privileges and rights as if a patent [for the invention had been sealed on the date of the publication of the complete specification." But what happens if, after publication and before acceptance, the specification is amended in such a way as to claim a different invention? Is the later invention protected as from the date of the publication of the original specification? Or does protection for the invention as originally claimed exist until amendment and thereafter protection accrue to the new invention? But these and other like questions which may be asked concerning the effect of Section 54 in such cases do not serve to indicate that it was intended that the question 40  
of the propriety of amendments under Section 45 should be removed from the bona fide discretion of the Commissioner. At the most they go to show that it was not intended that the Commissioner should permit amendments, so to speak, at large and that it was intended the power would be exercised within limits not wider than those specified for the operation of Division 4 by Section 78 thereof. Moreover, it should be noted, the difficulties—which to me seem rather apparent than real—may present themselves fairly and squarely in relation to amendments allowed in the discretion of the Commissioner under that Division.

The question whether the propriety of amendments under Section 45 50  
is a matter for the bona fide discretion of the Commissioner is, I think,

best solved by an examination of that section and Section 46. Clearly Section 45 contemplates amendments to meet the adverse report of an examiner and the amendments contemplated are amendments to the specification of an invention already disclosed. This alone is sufficient to enable one to say that the section does not contemplate that by amendment the specification of one invention may become the specification of a new and different invention. But whether any proposed amendment would produce this result is, in my opinion, a matter for the Commissioner to determine. Under Section 46 "If the Commissioner is satisfied that

10 no objection exists to the specification on the ground that the invention is already patented in the Commonwealth or in any State or is already the subject of any prior application for a patent in the Commonwealth or in any State he shall *in the absence of any other lawful ground of objection* accept the application and specification without any condition." The Commissioner's opinion as to the particular matters specified is the condition upon which the application and specification may be accepted. But it is contended that the "absence of any other lawful ground of objection" refers to an existing state of fact and, further, that this state of fact does not exist when an amendment outside the scope and contemplation of Section 45 has been allowed. But what happens when the

20 Commissioner is not satisfied of some one or more of the matters referred to in the section? He may refuse to accept the application and specification or he may accept them "on condition that a reference to such prior specifications as he thinks fit be made thereon by way of notice to the public." Either course may be taken if he is not satisfied, not only of the particular matters specified in the section but also as to the absence of "any other lawful ground of objection." From his adverse decision on such a question an appeal lies to the High Court or the Supreme Court. But he can refuse to accept an application and specification only if he is

30 not satisfied. Accordingly he is bound to accept them if he is satisfied not only of the particular matters specified but also of the absence of any other lawful ground of objection. Surely in these circumstances it may well be said that the condition precedent to such acceptance is not that amendments which have been made are within the scope of Section 45 but that the Commissioner is satisfied that they are. There is in the present case no ground for any suggestion, and no suggestion is made, that the Commissioner's discretion was not exercised bona fide and this being so it is unnecessary to consider whether our own view as to the propriety of the amendments which were made coincides with that of the Commissioner.

40 It appears to me that the solution of this problem must also assist materially in the solution of the remaining questions which were debated on the Respondent's appeal. Based on the proposition that the invention claimed in the finally amended specification for No. 133 was substantially different from that described and claimed or described and disclosed in the specification as originally lodged, the Respondent alleged that the Appellant was not in possession of the former invention when the specification in its original form was lodged. In its particulars of objections the Respondent by paragraph 6 alleged quite unequivocally that the Appellant "as applicant for the grant of the said letters patent was not

50 on the 31st December 1943 in possession of the invention the subject matter of the letters patent ultimately granted as at that date and that by reason

*In the  
High Court  
of  
Australia.*  
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No. 39.  
Reasons for  
Judgment  
of  
Taylor, J.,  
14th  
September  
1954,  
*continued.*

*In the  
High Court  
of  
Australia.*

No. 39.  
Reasons for  
Judgment  
of  
Taylor, J.,  
14th  
September  
1954,  
*continued.*

thereof the grant thereof . . . is and at all material times has been invalid void and of no effect." The question whether this allegation, among others, constituted a good defence in law was argued as a preliminary matter of law and by the order then made it was declared that paragraph 6, "so far as it depends exclusively upon the aforesaid allegations of fact (i.e., allegations appearing in paragraph 4 of the particulars) constitutes a good defence in law to the Plaintiff's claim herein to the following extent and not otherwise, viz., so far as they allege that the effect of the amendments therein referred to or either of them was that the complete specification of the letters patent No. 133163 in its final form claimed an invention 10 substantially different from the invention described and disclosed by the complete specification originally lodged with the application dated 31st December 1943." But paragraph 6 did not and did not purport to depend in any way at all upon allegations of fact previously made in the particulars of objections, nor did the allegations previously made, so far as, apparently, they were thought to be material, go further than allege that "on or about the 18th December 1946 the Plaintiff lodged in the Patent Office what purported to be but was not an amended complete specification as the complete specification accompanying the said application of the 31st December 1943, but the said specification so lodged on or about the 20 18th December 1946 described and claimed then as the invention something which was not the invention described and claimed in the complete specification lodged on the 31st December 1943 as aforesaid but something substantially different therefrom." I fail to see how paragraph 6 of the particulars of objection depended substantially on this or any similar allegation for, if the truth of this objection be assumed, all that can be taken as established is that the Plaintiff first described one invention and at a later stage described another. These circumstances alone cannot give rise to the inference that the Plaintiff was not in possession of the second invention when he described the first. Nevertheless, the matter 30 proceeded to trial without any amendment of the pleadings or any further definition of this or any other issue.

In these circumstances the issue between the parties assumed a completely artificial aspect and, strictly speaking, the Respondent could not succeed upon it 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 40 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.

What the Defendant really sought to establish on the trial, however, was that the Plaintiff was not, *in fact*, in possession of the patented inven- 50 tion 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 in the Plaintiff's second appeal and the Defendant's appeal. The Plaintiff's first appeal must of course be dismissed.

*In the High Court of Australia.*  
 No. 39.  
 Reasons for Judgment of Taylor, J., 14th September 1954,  
*continued.*

No. 40.

ORDER DISMISSING APPEAL of (Plaintiff) Appellant Martin.

Appeal No. 30 of 1953.

IN THE HIGH COURT OF AUSTRALIA.

Principal Registry.

No. 40.  
 Order dismissing appeal of (Plaintiff) Appellant Martin, 14th September 1954.

On Appeal from the Supreme Court of the State of Victoria in Action 1951 No. 58.

20

Between HENRY GEORGE MARTIN (Plaintiff) . *Appellant*

and

SCRIBAL PROPRIETARY LIMITED

(Defendant) . . . . . *Respondent.*

Before THEIR HONOURS THE CHIEF JUSTICE SIR OWEN DIXON, MR. JUSTICE FULLAGAR and MR. JUSTICE TAYLOR.

Tuesday the 14th day of September 1954.

THIS APPEAL by the abovenamed Plaintiff from the judgment of the Supreme Court of the State of Victoria given by his Honour Mr. Justice Sholl on the 28th day of July 1953 upon the trial of Action 1951 No. 58 coming on for hearing before this Court at Melbourne on the 3rd 4th 5th 9th 10th 11th and 12th days of March 1954 pursuant to special leave to appeal granted by this Court on the 25th day of September 1953 UPON READING the transcript record of the proceedings herein AND UPON HEARING Sir Garfield Barwick and Mr. Phillips of Queen's

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*In the  
High Court  
of  
Australia.*

No. 40.  
Order  
dismissing  
appeal of  
(Plaintiff)  
Appellant  
Martin,  
14th  
September  
1954,  
*continued.*

Counsel and Mr. Pape of Counsel for Appellant and Mr. D. I. Menzies of Queen's Counsel and Mr. Gilbert of Counsel for the Respondent THIS COURT DID ORDER that this Appeal should stand for judgment and the same standing for judgment this day accordingly at Melbourne THIS COURT DOTH ORDER AND DIRECT that if within two months from the date of this order the Plaintiff Appellant notifies the Defendant Respondent and the Principal Registrar of this Court in writing that he desires that there be a further trial of the issues raised by the fifth and sixth particulars of objection dated the 19th day of July 1951, the said judgment of the Supreme Court of the State of Victoria 10 be set aside and that there be a further trial of the action limited to those issues, the other issues in the action being treated as determined in favour of the Plaintiff and that the costs of the action be disposed of by the Judge at such further trial AND THIS COURT DOTH FURTHER ORDER that if the Plaintiff Appellant does not so notify the Defendant Respondent and the Principal Registrar the appeal be dismissed AND THIS COURT DOTH ALSO ORDER that the costs of this Appeal be reserved for the further order of this Court.

By the Court,

J. G. HARDMAN, 20  
Principal Registrar.

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No. 41.

ORDER ALLOWING APPEAL of (Defendant) Appellant Scribal Pty. Ltd.

*In the  
High Court  
of  
Australia.*

Appeal No. 30 of 1953.

IN THE HIGH COURT OF AUSTRALIA.

Principal Registry.

No. 41.  
Order  
allowing  
appeal of  
(Defendant)  
Appellant  
Scribal  
Proprietary  
Limited,  
14th  
September  
1954.

On Appeal from the Supreme Court of the State of Victoria in  
Action 1951 No. 58.

Between SCRIBAL PROPRIETARY LIMITED  
(Defendant) . . . . . Appellant

10

and

HENRY GEORGE MARTIN (Plaintiff) . Respondent.

Before THEIR HONOURS THE CHIEF JUSTICE SIR OWEN DIXON,  
MR. JUSTICE FULLAGAR and MR. JUSTICE TAYLOR.

Tuesday the 14th day of September, 1954.

THIS APPEAL by the above-named Defendant from the orders or  
judgments of the Supreme Court of the State of Victoria made and given  
by his Honour Mr. Justice Sholl on the 15th and 22nd days of June 1953  
upon the trial of action 1951 No. 58 coming on for hearing before this Court  
at Melbourne on the 3rd 4th 5th 9th 10th 11th and 12th days of March  
20 1954 pursuant to special leave to appeal granted by this Court on the  
28th day of September 1953 UPON READING the transcript record of  
the proceedings herein AND UPON HEARING Mr. D. I. Menzies of  
Queen's Counsel and Mr. Gilbert of Counsel for the Appellant and Sir  
Garfield Barwick and Mr. Phillips of Queen's Counsel and Mr. Pape of  
Counsel for the Respondent THIS COURT DID ORDER that this  
appeal should stand for judgment and the same standing for judgment this  
day accordingly at Melbourne THIS COURT DOTH ORDER that  
the Defendant's appeal from so much of the said orders or judgments of  
the 15th day of June 1953 and the 22nd day of June 1953 as are referred to  
30 in the notice of appeal herein dated the 19th day of October 1953 be and the  
same is hereby allowed AND THIS COURT DOTH FURTHER ORDER  
that the said orders or judgments be and the same are hereby discharged  
AND THIS COURT DOTH ALSO ORDER that the costs of this appeal  
be reserved for the further order of this Court.

By the Court,

J. G. HARDMAN,  
Principal Registry.

*In the  
High Court  
of  
Australia.*

**NOTICE OF MOTION by (Plaintiff) Appellant (Martin).**

Appeal No. 30 of 1953.

**IN THE HIGH COURT OF AUSTRALIA.**

Principal Registry.

No. 42.  
Notice of  
Motion by  
(Plaintiff)  
Appellant  
Martin,  
5th  
November  
1954.

On appeal from the Supreme Court of the State of Victoria in  
Action 1951 No. 58.

Between HENRY GEORGE MARTIN (Plaintiff) . Appellant

and

SCRIBAL PROPRIETARY LIMITED . . . . . Respondent. 10  
(Defendant) . . . . .

TAKE NOTICE that the Full Court of this Honourable Court sitting at Sydney in the State of New South Wales will be moved by Counsel on behalf of the above Appellant Henry George Martin on Thursday the 11th day of November 1954 at 10.30 o'clock in the forenoon or so soon thereafter as Counsel can be heard for an Order that if the Appellant presents at any time prior to the 30th day of June 1955 a petition to Her Majesty in Her Privy Council praying leave to appeal from the Order of this Honourable Court made on the 14th day of September 1954 then the Appellant may give notice that he desires there be a further trial 20 of the issues raised by the fifth and sixth particulars of objection dated the 19th day of July 1951 within a period of two months from the date upon which Her Majesty in Her Privy Council either refuses such petition for leave to appeal from the said Judgment of this Honourable Court dated the 14th day of September 1954 or having granted such petition for leave to appeal issues a final order relating to the said appeal AND for an order that any notification by the Plaintiff Appellant that he desires that there be a further trial of the issues raised by the fifth and sixth particulars of objection dated the 19th day of July 1951 shall not be taken to exclude the right of the Plaintiff to present to Her Majesty in Her Privy Council 30 a petition praying leave to appeal against the judgment of this Honourable Court given on the 14th day of September 1954.

Dated the 5th day of November 1954.

MOULE HAMILTON & DERHAM,  
394-396 Collins Street,  
Melbourne,  
Solicitors for the (Plaintiff) Appellant  
Martin.

To the Principal Registrar  
and to the Defendant (Respondent)  
and to J. T. Brock, Esq.,  
its Solicitor.



No. 43.

ORDER Refusing Extension of Time in which to give Notice of Further Trial.

Appeal No. 30 of 1953.

IN THE HIGH COURT OF AUSTRALIA.

Principal Registry.

On Appeal from the Supreme Court of the State of Victoria in  
Action 1951 No. 58.

Between HENRY GEORGE MARTIN (Plaintiff) . . . Appellant

and

10            SCRIBAL PROPRIETARY LIMITED  
              (Defendant) . . . . . Respondent.

Before THEIR HONOURS THE CHIEF JUSTICE SIR OWEN DIXON,  
Mr. JUSTICE FULLAGAR and Mr. JUSTICE TAYLOR.

Thursday the Eleventh day of November 1954.

UPON APPLICATION made to the Court this day at Sydney on  
behalf of the abovenamed Appellant AND UPON READING the notice  
of motion dated the 5th day of November 1954 and filed herein AND  
UPON HEARING Sir Garfield Barwick of Queen's Counsel and Mr. Penman  
of Counsel for the Appellant and Mr. Gilbert of Counsel for the Respondent  
20 THIS COURT DOTH ORDER that this application be and the same is  
hereby dismissed AND THIS COURT DOTH ALSO ORDER that the  
costs of the Respondent of this application be taxed by the proper officer  
of this Court and when so taxed and allowed be paid by the Appellant  
to the Respondent.

By the Court,  
M. DOHERTY,  
Deputy Registrar.

*In the  
High Court  
of  
Australia.*

No. 43.  
Order  
refusing  
extension  
of time in  
which to  
give notice  
of further  
trial,  
11th  
November  
1954.

*In the  
High Court  
of  
Australia.*

**No. 44.**  
**NOTICE requiring Further Trial.**

Appeal No. 30 of 1953.

**IN THE HIGH COURT OF AUSTRALIA.**

**Principal Registry.**

**On Appeal from the Supreme Court of the State of Victoria in  
Action 1951 No. 58.**

Between **HENRY GEORGE MARTIN (Plaintiff)** . . . Appellant

and

**SCRIBAL PROPRIETARY LIMITED** 10  
(Defendant) . . . . . Respondent.

**TAKE NOTICE** that pursuant to the Judgment of this Honourable Court dated the 14th day of September 1954 the abovenamed (Plaintiff) Appellant desires a further trial of the issues raised by the fifth and sixth particulars of Objection dated the 19th day of July 1951.

Dated the 12th day of November 1954.

**MOULE HAMILTON & DERHAM,**  
394 Collins Street, Melbourne,  
Solicitors for the (Plaintiff) Appellant.

To the Principal Registrar of the High Court 20  
of Australia and to the abovenamed  
(Defendant) Respondent and to J. T.  
Brock, Esq., its Solicitor.



No. 45.

**ORDER OF HER MAJESTY IN COUNCIL GRANTING SPECIAL LEAVE  
TO APPEAL.**

AT THE COURT AT BALMORAL.

The 31st day of May 1955.

Present

THE QUEEN'S MOST EXCELLENT MAJESTY

LORD PRESIDENT.

Mr. GEOFFREY LLOYD.

EARL OF MUNSTER.

*In the  
Privy  
Council.*

No. 45.  
Order of  
Her  
Majesty in  
Council  
granting  
Special  
Leave to  
Appeal,  
31st May  
1955.

10       WHEREAS there was this day read at the Board a Report from the  
Judicial Committee of the Privy Council dated the 19th day of April 1955  
in the words following, viz. :—

20       “ WHEREAS by virtue of His late Majesty King Edward the  
Seventh's Order in Council of the 18th day of October 1909 there  
was referred unto this Committee a humble Petition of Henry George  
Martin in the matter of three Appeals from the High Court of  
Australia between the Petitioner (Plaintiff) Appellant and Scribal  
Proprietary Limited (Defendant) Respondent in Act No. 314 of  
1947 and between the same parties together with a cross-Appeal in  
30       Action No. 58 of 1951 setting forth (amongst other matters) that the  
Petitioner prays for special leave to appeal from the Judgment of  
the High Court dated the 14th of September 1954 whereby after  
hearing two Appeals by the Petitioner and a Cross-Appeal by the  
Respondent from Judgments of the Supreme Court of Victoria  
delivered respectively on 15th June 22nd June and 28th July 1953  
whereby the Court held (A) in Action No. 314 of 1947 that the  
Respondent did not infringe the Petitioner's Letters Patent  
No. 122073 and (B) in Action No. 58 of 1951 that your Petitioner's  
Letters Patent No. 133163 was invalid and that the Respondent did  
40       not infringe the same the High Court (A) dismissed the Appeal in  
the first action and (B) dismissed his appeal in the second action  
unless the Petitioner gave notice within two months that he desired  
a new trial on one issue viz. whether he was in possession of the  
invention at the date of the original application the said High  
Court having said that he was not : that the Petitioner applied on  
the 11th November 1954 to the High Court to extend the period of  
two months until such time as this present Petition had been heard  
but such application was refused and accordingly the Petitioner  
gave notice that he desired such new trial in order to keep the  
position open : And humbly praying Your Majesty in Council to

*In the  
Privy  
Council.*

No. 45.  
Order of  
Her  
Majesty in  
Council  
granting  
Special  
Leave to  
Appeal,  
31st May  
1955,  
*continued.*

grant the Petitioner special leave to appeal from the three Orders of the High Court of Australia dated the 14th September 1954 or for such other Order as to Your Majesty in Council may seem fit :

“ THE LORDS OF THE COMMITTEE in obedience to His late Majesty’s said Order in Council have taken the Humble Petition into consideration and having heard Counsel in support thereof and in opposition thereto Their Lordships do this day agree humbly to report to Your Majesty as their opinion that that part of the Petition praying for special leave to appeal from the Order of the High Court of Australia in Action No. 314 of 1947 dated the 14th September 1954 ought to be dismissed and that leave to be granted to the Petitioner to enter and prosecute his Appeal against the two Orders of the High Court of Australia in Action No. 58 of 1951 dated the 14th day of September 1954 upon depositing in the Registry of the Privy Council the sum of £800 as security for costs : 10

“ AND THEIR LORDSHIPS do further report to Your Majesty that the proper officer of the said High Court ought to be directed to transmit to the Registrar of the Privy Council without delay an authenticated copy under seal of the Record proper to be laid before Your Majesty on the hearing of the Appeal upon payment by the Petitioner of the usual fees for the same.” 20

HER MAJESTY having taken the said Report into consideration was pleased by and with the advice of Her Privy Council to approve thereof and to order as it is hereby ordered that the same be punctually observed obeyed and carried into execution.

Whereof the Governor-General or Officer administering the Government of the Commonwealth of Australia for the time being and all other persons whom it may concern are to take notice and govern themselves accordingly.

W. G. AGNEW. 30

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No. 42 of 1955.

**In the Privy Council.**

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**ON APPEAL**  
**FROM THE HIGH COURT OF AUSTRALIA**

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**BETWEEN**  
**HENRY GEORGE MARTIN (Plaintiff) . . . . . Appellant**  
**AND**  
**SCRIBAL PROPRIETARY LIMITED (Defendant) . . . . . Respondent.**

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**RECORD OF PROCEEDINGS**  
**(IN TWO VOLUMES)**

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**VOLUME I**  
**(Pages 1-230)**

**PAYNE, HICKS BEACH & CO.,**  
10 NEW SQUARE,  
LINCOLN'S INN, W.C.2,  
*Solicitors for the Appellant.*

**HAMILTON-HILL & PARTNER,**  
52 HAYMARKET,  
LONDON, S.W.1,  
*Solicitors for the Respondent.*